

ESTTA Tracking number: **ESTTA177671**

Filing date: **11/29/2007**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92046606
Party	Plaintiff Blaire Allison Kitrosser
Correspondence Address	David H.E. Bursik, Esq. 401 Hamburg Turnpike, Suite 210 Wayne, NJ 07470 UNITED STATES dheb@bursik.com
Submission	Testimony For Plaintiff
Filer's Name	David H.E. Bursik, Esq.
Filer's e-mail	dheb@bursik.com
Signature	/David H.E. Bursik, Esq./
Date	11/29/2007
Attachments	Metro Event Planners - Certification of Blaire Allison Kitrosser.pdf (3 pages) (52977 bytes) Metro Event Planners - Use Exhibit 1.pdf (1 page)(140539 bytes) Metro Event Planners - Use Exhibit 2.pdf (1 page)(39180 bytes) Metro Event Planners - Use Exhibit 3.pdf (2 pages)(26712 bytes) Metro Event Planners - Use Exhibit 4.pdf (1 page)(35661 bytes) Metro Event Planners - Use Exhibit 5.pdf (1 page)(13508 bytes) Metro Event Planners Trademark Office Status Report.pdf (3 pages)(52628 bytes) METRO EVENT PLANNERS PTO Office Action 10-21-05.pdf (8 pages)(114199 bytes) METRO EVENT PLANNERS PTO Office Action 05-01-06.pdf (5 pages)(18188 bytes)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

_____	:	Cancellation No. 92046606
BLAIRE ALLISON KITROSSER,	:	Registration No. 2923986
Petitioner,	:	Mark: METRO INVITES
v.	:	
	:	Certification of
PROMO INK, A SOLE	:	Blaire Allison Kitrosser
PROPRIETORSHIP OWNED BY	:	
DONNA BOGATIN,	:	
Registrant.	:	
_____	:	

BLAIRE ALLISON KITROSSER hereby certifies as follows:

1. I am a citizen of the United States with a residential address of 39 Union Street, #208, Hackensack, New Jersey 07601.
2. On July 31, 1999, I adopted the phrase METRO EVENT PLANNERS as a trademark to identify the event planning services which I provide.
3. I have continuously used the METRO EVENT PLANNERS trademark in interstate commerce since July 31, 1999. Copies of examples of the use of the trademark are submitted herewith and identified as Use Exhibits.
4. I filed an application for registration of the METRO EVENT PLANNERS trademark on March 26, 2005, and the application was assigned Serial Number 78595725. A copy of the Trademark Office status report confirming this filing is submitted as an Exhibit herewith.
5. The Trademark Office issued an Office Action refusing to register the METRO EVENT PLANNERS trademark based upon the Registration No. 2923986 issued for the METRO INVITES trademark on October 21, 2005 and on May 1, 2006. A copy of these Office Actions are submitted herewith as Exhibits.

6. Further action by the Trademark Office on my application for registration of the METRO EVENT PLANNERS trademark has been suspended pending the disposition of this cancellation proceeding.

7. According to the application by Promo Ink for registration of the METRO INVITES trademark, the registrant Promo Ink has used the METRO INVITES trademark since September 18, 2003, which is over four years after I first used the METRO EVENT PLANNERS trademark.

8. I was and remain willing to agree to a concurrent use of the METRO EVENT PLANNERS trademark and the METRO INVITES trademark notwithstanding that I have the priority of first use. I tried to discuss this issue with the owner of Promo Ink, Conna Bogatin, but she was unwilling to discuss this issue.

9. Accordingly, if a concurrent registration is not allowed, then I respectfully request that the METRO INVITES trademark registration be cancelled based upon my priority of use of the METRO EVENTS PLANNERS trademark.

I certify that the foregoing statements made by me are true under penalty of perjury. I am aware that if any of the foregoing statements made by me are willfully false, that I am subject to punishment.


Blair Allison Kitrosser

Executed on this 29th day
of November, 2007
in Hackensack, New Jersey.

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METRO

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Serial Number: 78595725 Assignment Information Trademark Document Retrieval

Registration Number: (NOT AVAILABLE)

Mark

METRO EVENT PLANNERS

(words only): METRO EVENT PLANNERS

Standard Character claim: Yes

Current Status: Further action on the application has been suspended.

Date of Status: 2007-06-08

Filing Date: 2005-03-26

Transformed into a National Application: No

Registration Date: (DATE NOT AVAILABLE)

Register: Principal

Law Office Assigned: LAW OFFICE 113

Attorney Assigned:
MURRAY DAVID T Employee Location

Current Location: M40 -TMO Law Office 113

Date In Location: 2007-06-08

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. BLAIRE ALLISON KITROSSER

Address:
BLAIRE ALLISON KITROSSER
816 Oneida Trail

Franklin Lakes, NJ 07470
United States
Legal Entity Type: Individual
Country of Citizenship: United States
Phone Number: 1-973-904-1040
Fax Number: 1-973-904-1050

GOODS AND/OR SERVICES

International Class: 041
Class Status: Active
Special event planning services
Basis: 1(a)
First Use Date: 1999-07-31
First Use in Commerce Date: 1999-07-31

ADDITIONAL INFORMATION

Disclaimer: "EVENT PLANNERS"

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

2007-06-08 - Report Completed Suspension Check Case Still Suspended
2006-11-29 - LETTER OF SUSPENSION E-MAILED
2006-11-29 - Suspension Letter Written
2006-11-29 - Teas/Email Correspondence Entered
2006-11-29 - Communication received from applicant
2006-11-28 - Assigned To LIE
2006-11-01 - TEAS Response to Office Action Received
2006-05-01 - Final refusal e-mailed
2006-05-01 - Final Refusal Written
2006-04-28 - Teas/Email Correspondence Entered
2006-04-20 - Communication received from applicant

2006-04-20 - TEAS Response to Office Action Received

2005-10-21 - Non-final action e-mailed

2005-10-21 - Non-Final Action Written

2005-10-20 - Assigned To Examiner

2005-03-31 - New Application Entered In Tram

ATTORNEY/CORRESPONDENT INFORMATION

Attorney of Record

DAVID H.E. BURSIK, ESQ.

Correspondent

DAVID H.E. BURSIK, ESQ.

DAVID H.E. BURSIK, ESQ.

401 HAMBURG TPKE STE 210

WAYNE, NJ 07470-2139

Phone Number: 1-973-904-1040

Fax Number: 1-973-901-1050

To: BLAIRE ALLISON KITROSSER (dheb@bursik.com)
Subject: TRADEMARK APPLICATION NO. 78595725 - METRO EVENT PLANNERS - N/A
Sent: 10/21/05 2:55:24 PM
Sent As: ECOM113@USPTO.GOV
Attachments: Attachment - 1
Attachment - 2

UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 78/595725

APPLICANT: BLAIRE ALLISON KITROSSER

78595725

CORRESPONDENT ADDRESS:

DAVID H.E. BURSIK, ESQ.
DAVID H.E. BURSIK, ESQ.
401 HAMBURG TPKE STE 210
WAYNE, NJ 07470-2139

RETURN ADDRESS:

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

MARK: METRO EVENT PLANNERS

CORRESPONDENT'S REFERENCE/DOCKET NO: N/A

CORRESPONDENT EMAIL ADDRESS:

dheb@bursik.com

Please provide in all correspondence:

1. Filing date, serial number, mark and applicant's name.
2. Date of this Office Action.
3. Examining Attorney's name and Law Office number.
4. Your telephone number and e-mail address.

OFFICE ACTION

RESPONSE TIME LIMIT: TO AVOID ABANDONMENT, THE OFFICE MUST RECEIVE A PROPER RESPONSE TO THIS OFFICE ACTION WITHIN 6 MONTHS OF THE MAILING OR E-MAILING DATE.

Serial Number 78/595725

The assigned examining attorney has reviewed the referenced application and determined the following.

Registration Refused –Likelihood of Confusion

Registration of the proposed mark is refused because of a likelihood of confusion with the mark in U.S. Registration No. 2923986. Trademark Act Section 2(d), 15 U.S.C. §1052(d); TMEP §§1207.01 *et seq.* See the enclosed registration.

A likelihood of confusion determination requires a two-part analysis. First the marks are compared for similarities in appearance, sound, connotation and commercial impression. *In re E. I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973). Second, the goods or services are compared to determine whether they are similar or related or whether the activities surrounding their marketing are such that confusion as to origin is likely. *In re August Storck KG*, 218 USPQ 823 (TTAB 1983); *In re Int'l Tel. and Tel. Corp.*, 197 USPQ 910 (TTAB 1978); *Guardian Prods. Co., v. Scott Paper Co.*, 200 USPQ 738 (TTAB 1978); TMEP §§1207.01 *et seq.*

In this case, the mark of the applicant is METRO EVENT PLANNERS for event planning services and the mark of the registrant is METRO INVITES for services that include planning special events.

Comparison of the Marks

The marks are compared for similarities in sound, appearance, meaning or connotation. *In re E. I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973). Similarity in any one of these elements is sufficient to find a likelihood of confusion. *In re Mack*, 197 USPQ 755 (TTAB 1977); TMEP §§1207.01(b) *et seq.* Additionally, when applicant's mark is compared to a registered mark, "the points of similarity are of greater importance than the points of difference." *Esso Standard Oil Co. v. Sun Oil Co.*, 229 F.2d 37, 108 USPQ 161 (D.C. Cir.), *cert. denied*, 351 U.S. 973, 109 USPQ 517 (1956); TMEP §1207.01(b).

In the present case, the marks of the parties are highly similar in terms of sound, appearance, meaning and connotation in that they are dominated by the word METRO. Please note that in issues involving a likelihood of confusion, the question is not whether people will confuse the marks, but whether the marks will confuse people into believing that the goods they identify come from the same source. *In re West Point-Pepperell, Inc.*, 468 F.2d 200, 175 USPQ 558 (C.C.P.A. 1972). For that reason, the test of likelihood of confusion is not whether the marks can be distinguished when subjected to a side-by-side comparison. The question is whether the marks create the same overall impression. *Recot, Inc. v. M.C. Becton*, 214 F.2d 1322, 54 USPQ2d 1894, 1890 (Fed. Cir. 2000); *Visual Information Inst., Inc. v. Vicon Indus. Inc.*, 209 USPQ 179 (TTAB 1980). The focus is on the recollection of the average purchaser who normally retains a general rather than specific impression of trademarks. *Chemetron Corp. v. Morris Coupling & Clamp Co.*, 203 USPQ 537 (TTAB 1979); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975); TMEP §1207.01(b). Here, the average consumer, when confronted with the marks of the parties is likely to retain only the dominant portion of the marks, the word METRO.

Additionally, it is noted that the registrant has disclaimed the term "INVITES" from its mark. Please note that the registrant must also disclaim the descriptive wording "EVENT PLANNERS" from its mark (see below). It is well settled that disclaimed matter is typically less significant or less dominant when comparing marks. Although a disclaimed portion of a mark certainly cannot be ignored, and the marks must be compared in their entireties, one feature of a mark may be more significant in creating a commercial impression. *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997); *In re National Data Corporation*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985); and *In re Appetito Provisions Co. Inc.*, 3 USPQ2d 1553 (TTAB 1987). See also *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ 2d 1001 (Fed. Cir. 2002); *Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 189 USPQ 693 (C.C.P.A. 1976); *In re El Torito Rests. Inc.*, 9 USPQ2d 2002 (TTAB 1988); *In re Equitable Bancorporation*, 229 USPQ 709 (TTAB 1986).

As noted above, the term “metro” is the dominant word in the mark. It is the first term in each mark and it is the term likely to be retained by the average consumer. The addition of the descriptive wording in the applicant’s mark does little to obviate the strong similarities between the marks.

Thus, because the marks are highly similar in terms of sound, appearance, meaning and connotation, the first prong of the likelihood of confusion test has been satisfied.

Comparison of the Services

The goods and/or services of the parties need not be identical or directly competitive to find a likelihood of confusion. Instead, they need only be related in some manner, or the conditions surrounding their marketing be such that they could be encountered by the same purchasers under circumstances that could give rise to the mistaken belief that the goods and/or services come from a common source. *In re Martin’s Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984); *In re Melville Corp.*, 18 USPQ2d 1386, 1388 (TTAB 1991); *In re Corning Glass Works*, 229 USPQ 65 (TTAB 1985); *In re Rexel Inc.*, 223 USPQ 830 (TTAB 1984); *Guardian Prods. Co., Inc. v. Scott Paper Co.*, 200 USPQ 738 (TTAB 1978); *In re Int’l Tel. & Tel. Corp.*, 197 USPQ 910 (TTAB 1978); TMEP §1207.01(a)(i).

In this case, the services of the parties are highly related in that they provide special event planning. These services are likely to be advertised and performed for the same targeted audiences. Thus, because the services are so highly related, the second prong of the likelihood of confusion test has been met.

For the above stated reasons, the applicant’s mark is found to likely cause confusion with the cited registered mark, and therefore, must be refused registration.

Identification of the Services/Classification of the Services

The wording “event planning services” in the identification of services needs clarification because it is too broad and could include services classified in other international classes. TMEP §§1402.01 and 1402.03. The applicant must denote that its services are special event planning services. Additionally, the applicant must correct the classification of the services in the application and amend the application to classify them in International Class 41. 37 C.F.R. §§2.32(a)(7) and 2.85; TMEP §§1401.02(a) and 1401.03(b).

In the identification of services applicant must use the common commercial or generic names for the services, be as complete and specific as possible, and avoid the use of indefinite words and phrases. If applicant chooses to use indefinite words and phrases such as “services in connection with,” “such as,” “including,” “and like services,” “systems,” “products,” “concepts,” or “not limited to,” then such terms must be followed by the word “namely” and a list of the specific services identified by their common commercial or generic names. TMEP §§1402.01 and 1402.03(a).

Applicant may substitute the following wording, if accurate:

“Special event planning services” in International Class 41.

TMEP §§1402.01 and 1402.03.

Please note that, while the identification of services may be amended to clarify or limit the services, adding to the services or broadening the scope of the services is not permitted. 37 C.F.R. §2.71(a); TMEP §1402.06. Therefore, applicant may not amend the identification to include services that are not within the scope of the services set forth in the present identification.

For assistance with identifying goods and/or services in trademark applications, please see the online searchable *Manual of Acceptable Identifications of Goods and Services* at <http://tess2.uspto.gov/netahtml/tidm.html>.

Combined Application

If applicant prosecutes this application as a combined, or multiple#class application, then applicant must comply with each of the requirements below for those goods and/or services based on actual use in commerce under Trademark Act Section 1(a):

- (1) Applicant must list the goods/services by international class with the classes listed in ascending numerical order;
- (2) Applicant must submit a filing fee for each international class of goods and/or services not covered by the fee already paid (current fee information should be confirmed at <http://www.uspto.gov>); and
- (3) For each additional class of goods and/or services, applicant must submit:
 - (a) dates of first use of the mark anywhere and dates of first use of the mark in commerce, or a statement that the dates of use in the initial application apply to that class; the dates of use, both anywhere and in commerce, must be at least as early as the filing date of the application;
 - (b) one specimen showing use of the mark for each class of goods and/or services; the specimen must have been in use in commerce at least as early as the filing date of the application;
 - (c) a statement that “the specimen was in use in commerce on or in connection with the goods and/or services listed in the application at least as early as the filing date of the application;” and
 - (d) verification of the statements in 3(a) and 3(c) in an affidavit or a signed declaration under 37 C.F.R. §2.20.
(NOTE: Verification is *not* required where (1) the dates of use for the added class are stated to be the same as the dates of use specified in the initial application, or (2) the original specimens are acceptable for the added class.)

37 C.F.R. §§2.6, 2.34(a), 2.59, 2.71(c), and 2.86(a); TMEP §§810, 904.09, 1403.01 and 1403.02(c).

Disclaimer

Applicant must insert a disclaimer of EVENT PLANNERS in the application because the wording is generic for the applicant’s event planning services. Trademark Act Section 6, 15 U.S.C. §1056; TMEP §§1213 and 1213.08(a)(i).

The Office can require an applicant to disclaim exclusive rights to an unregistrable part of a mark, rather than refuse registration of the entire mark. Trademark Act Section 6(a), 15 U.S.C. §1056(a). Under Trademark Act Section 2(e), 15 U.S.C. §1052(e), the Office can refuse registration of the entire mark where it is determined that the entire mark is merely descriptive, deceptively misdescriptive, or primarily geographically descriptive of the goods. Thus, the Office may require the disclaimer of a portion of a mark which, when used in connection with the goods or services, is merely descriptive, deceptively misdescriptive, primarily geographically descriptive, or otherwise unregistrable (e.g., generic). TMEP §1213.03(a). If an applicant does not comply with a disclaimer requirement, the Office may refuse registration of the entire mark. TMEP §1213.01(b).

A “disclaimer” is thus a written statement that an applicant adds to the application record that states that applicant does not have exclusive rights, separate and apart from the entire mark, to particular wording and/or to a design aspect. The appearance of the applied-for mark does not change.

The following is the accepted standard format for a disclaimer:

No claim is made to the exclusive right to use “EVENT PLANNERS” apart from the mark as shown.

If the applicant has any questions or needs assistance in responding to this Office action, please telephone the assigned examining attorney.

/Ty Murray/

Examining Attorney

United States Patent and Trademark Office

Law Office 113

(571) 272-9438

HOW TO RESPOND TO THIS OFFICE ACTION:

- **ONLINE RESPONSE:** You may respond formally using the Office's Trademark Electronic Application System (TEAS) Response to Office Action form (visit <http://www.uspto.gov/teas/index.html> and follow the instructions, but if the Office Action has been issued via email, you must wait 72 hours after receipt of the Office Action to respond via TEAS).
- **REGULAR MAIL RESPONSE:** To respond by regular mail, your response should be sent to the mailing return address above and include the serial number, law office number and examining attorney's name in your response.

STATUS OF APPLICATION: To check the status of your application, visit the Office's Trademark Applications and Registrations Retrieval (TARR) system at <http://tarr.uspto.gov>.

VIEW APPLICATION DOCUMENTS ONLINE: Documents in the electronic file for pending applications can be viewed and downloaded online at <http://portal.uspto.gov/external/portal/tow>.

GENERAL TRADEMARK INFORMATION: For general information about trademarks, please visit the Office's website at <http://www.uspto.gov/main/trademarks.htm>

FOR INQUIRIES OR QUESTIONS ABOUT THIS OFFICE ACTION, PLEASE CONTACT THE ASSIGNED EXAMINING ATTORNEY SPECIFIED ABOVE.

Print: Oct 20, 2005

76541948

DESIGN MARK

Serial Number

76541948

Status

REGISTERED

Word Mark

METRO INVITES

Standard Character Mark

No

Registration Number

2923986

Date Registered

2005/02/01

Type of Mark

SERVICE MARK

Register

PRINCIPAL

Mark Drawing Code

(1) TYPED DRAWING

Owner

Promo Ink SOLE PROPRIETORSHIP NEW YORK P.O. Box 4157 New York NEW YORK
10163

Goods/Services

Class Status -- ACTIVE. IC 041. US 100 101 107. G & S:
Entertainment services, namely, planning and conducting parties and
special events for businesses and individuals in a variety of
locations including bars, restaurants, shops, and the like. First
Use: 2003/09/18. First Use In Commerce: 2003/09/18.

Disclaimer Statement

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "INVITES" APART FROM
THE MARK AS SHOWN.

Filing Date

2003/08/29

Examining Attorney

KIM, YONG

METRO INVITES

To: BLAIRE ALLISON KITROSSER (dheb@bursik.com)
Subject: TRADEMARK APPLICATION NO. 78595725 - METRO EVENT PLANNERS - N/A
Sent: 5/1/06 5:56:53 PM
Sent As: ECOM113@USPTO.GOV
Attachments:

UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 78/595725

APPLICANT: BLAIRE ALLISON KITROSSER

78595725

CORRESPONDENT ADDRESS:

DAVID H.E. BURSIK, ESQ.
DAVID H.E. BURSIK, ESQ.
401 HAMBURG TPKE STE 210
WAYNE, NJ 07470-2139

RETURN ADDRESS:

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

MARK: METRO EVENT PLANNERS

CORRESPONDENT'S REFERENCE/DOCKET NO: N/A

CORRESPONDENT EMAIL ADDRESS:

dheb@bursik.com

Please provide in all correspondence:

1. Filing date, serial number, mark and applicant's name.
2. Date of this Office Action.
3. Examining Attorney's name and Law Office number.
4. Your telephone number and e-mail address.

FINAL OFFICE ACTION

RESPONSE TIME LIMIT: TO AVOID ABANDONMENT, THE OFFICE MUST RECEIVE A PROPER RESPONSE TO THIS OFFICE ACTION WITHIN 6 MONTHS OF THE MAILING OR E-MAILING DATE.

MAILING/E-MAILING DATE INFORMATION: If the mailing or e-mailing date of this Office action does not appear above, this information can be obtained by visiting the USPTO website at <http://tarr.uspto.gov/>, inserting the application serial number, and viewing the prosecution history for the mailing date of the most recently issued Office communication.

Serial Number 78/595725

This FINAL Office Action is in reply to the Applicant's Response of April 20, 2006.

The applicant's amended identification of the services is acceptable and has been made of record. Likewise, the applicant's disclaimer has been made of record. However, the applicant has not responded to the Section 2(d) refusal in a manner that refutes the evidence and arguments offered by the examining attorney. Therefore, the refusal under Section 2(d) is made FINAL.

Registration Refused –Likelihood of Confusion -FINAL

In the first Office Action, registration of the proposed mark was refused because of a likelihood of confusion with the mark in U.S. Registration No. 2923986. Trademark Act Section 2(d), 15 U.S.C. §1052(d); TMEP §§1207.01 *et seq.*

A likelihood of confusion determination requires a two-part analysis. First the marks are compared for similarities in appearance, sound, connotation and commercial impression. *In re E. I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973). Second, the goods or services are compared to determine whether they are similar or related or whether the activities surrounding their marketing are such that confusion as to origin is likely. *In re August Storck KG*, 218 USPQ 823 (TTAB 1983); *In re Int'l Tel. and Tel. Corp.*, 197 USPQ 910 (TTAB 1978); *Guardian Prods. Co., v. Scott Paper Co.*, 200 USPQ 738 (TTAB 1978); TMEP §§1207.01 *et seq.*

In this case, the mark of the applicant is METRO EVENT PLANNERS for event planning services and the mark of the registrant is METRO INVITES for services that include planning special events.

Comparison of the Marks

The marks are compared for similarities in sound, appearance, meaning or connotation. *In re E. I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973). Similarity in any one of these elements is sufficient to find a likelihood of confusion. *In re Mack*, 197 USPQ 755 (TTAB 1977); TMEP §§1207.01(b) *et seq.* Additionally, when applicant's mark is compared to a registered mark, "the points of similarity are of greater importance than the points of difference." *Esso Standard Oil Co. v. Sun Oil Co.*, 229 F.2d 37, 108 USPQ 161 (D.C. Cir.), *cert. denied*, 351 U.S. 973, 109 USPQ 517 (1956); TMEP §1207.01(b).

In the present case, the marks of the parties are highly similar in terms of sound, appearance, meaning and connotation in that they are dominated by the word METRO. Please note that in issues involving a likelihood of confusion, the question is not whether people will confuse the marks, but whether the marks will confuse people into believing that the goods they identify come from the same source. *In re West Point-Pepperell, Inc.*, 468 F.2d 200, 175 USPQ 558 (C.C.P.A. 1972). For that reason, the test of likelihood of confusion is not whether the marks can be distinguished when subjected to a side-by-side comparison. The question is whether the marks create the same overall impression. *Recot, Inc. v. M.C. Becton*, 214 F.2d 1322, 54 USPQ2d 1894, 1890 (Fed. Cir. 2000); *Visual Information Inst., Inc. v. Vicon Indus. Inc.*, 209 USPQ 179 (TTAB 1980). The focus is on the recollection of the average purchaser who normally retains a general rather than specific impression of trademarks. *Chemetron Corp. v. Morris Coupling & Clamp Co.*, 203 USPQ 537 (TTAB 1979); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975); TMEP §1207.01(b). Here, the average consumer, when confronted with the marks of the parties is likely to retain only the dominant portion of the marks, the word METRO. Additionally, it is noted that the registrant has disclaimed the term "INVITES" from its mark. Please note that the registrant must also disclaim the descriptive wording "EVENT PLANNERS" from its mark (see below). It is well settled that disclaimed matter is typically less significant or less dominant when comparing marks. Although a disclaimed portion of a mark certainly cannot be ignored, and the marks must be compared in their entireties, one feature of a mark may be more significant in creating a commercial impression. *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997); *In re National Data Corporation*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985); and *In re Appetito Provisions Co. Inc.*, 3 USPQ2d 1553 (TTAB 1987). *See also Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261,

62 USPQ 2d 1001 (Fed. Cir. 2002); *Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 189 USPQ 693 (C.C.P.A. 1976); *In re El Torito Rests. Inc.*, 9 USPQ2d 2002 (TTAB 1988); *In re Equitable Bancorporation*, 229 USPQ 709 (TTAB 1986).

As noted above, the term "metro" is the dominant word in the mark. It is the first term in each mark and it is the term likely to be retained by the average consumer. The addition of the descriptive wording in the applicant's mark does little to obviate the strong similarities between the marks.

Thus, because the marks are highly similar in terms of sound, appearance, meaning and connotation, the first prong of the likelihood of confusion test has been satisfied.

Comparison of the Services

The goods and/or services of the parties need not be identical or directly competitive to find a likelihood of confusion. Instead, they need only be related in some manner, or the conditions surrounding their marketing be such that they could be encountered by the same purchasers under circumstances that could give rise to the mistaken belief that the goods and/or services come from a common source. *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984); *In re Melville Corp.*, 18 USPQ2d 1386, 1388 (TTAB 1991); *In re Corning Glass Works*, 229 USPQ 65 (TTAB 1985); *In re Rexel Inc.*, 223 USPQ 830 (TTAB 1984); *Guardian Prods. Co., Inc. v. Scott Paper Co.*, 200 USPQ 738 (TTAB 1978); *In re Int'l Tel. & Tel. Corp.*, 197 USPQ 910 (TTAB 1978); TMEP §1207.01(a)(i).

In this case, the services of the parties are highly related, if not identical, in that they provide special event planning. These services are likely to be advertised and performed for the same-targeted audiences. Thus, because the services are so highly related, the second prong of the likelihood of confusion test has been met.

For the above stated reasons, the applicant's mark is found to likely cause confusion with the cited registered mark, and therefore, must be refused registration.

This refusal is made FINAL.

Applicant's Response

It is noted that in its response, the applicant alludes to a cancellation of the registered mark. Please note that a petition to cancel a registration owned by another party may be filed with the Trademark Trial and Appeal Board under §14 of the Trademark Act, 15 U.S.C. §1064. *See* TBMP §§303, 307, 308, and 309, for the requirements and fees for filing a petition to cancel a registration. The petition can be filed through the Electronic System for Trademark Trials and Appeals ("ESTTA") at <http://estta.uspto.gov/>.

It is also noted that the applicant states that it would be willing to use its mark concurrently with the mark of the registrant. Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), contains a proviso under which an eligible applicant may request issuance of a registration concurrent with the registration of a conflicting mark.

In a concurrent use application, the applicant normally requests a geographically restricted registration. The applicant seeks registration for a specified geographical area of the United States and lists one or more parties who concededly have rights in the mark in other geographical areas of the United States. These other parties may own applications or registrations, or they may have common law rights in a mark, but no application or registration. "Incontestable" registrations (*i.e.*, where the registrant's right to use the mark has become incontestable pursuant to 15 U.S.C. §1065) are subject to concurrent use registration proceedings. *See Holiday Inn v. Holiday Inns, Inc.*, 534 F.2d 312, 189 USPQ 630 (C.C.P.A. 1976); *Thriftmart, Inc. v. Scot Lad Foods, Inc.*, 207 USPQ 330 (TTAB 1980). However, registrations and applications to register on the Supplemental Register and registrations under the Act of 1920 (*see* are not subject to concurrent use registration proceedings. 37 C.F.R. §2.99(g).

Concurrent use registration is requested by the applicant; it should not be suggested or initiated by the examining attorney.

If applicant fails to respond to this final action within six months of the mailing date, the application will be abandoned. 15 U.S.C. §1062(b); 37 C.F.R. §2.65(a). Applicant may respond to this final action by:

- (1) submitting a response that fully satisfies all outstanding requirements, if feasible (37 C.F.R. §2.64(a)); and/or
- (2) filing an appeal to the Trademark Trial and Appeal Board, with an appeal fee of \$100 per class (37 C.F.R. §§2.6(a)(18) and 2.64(a); TMEP §§715.01 and 1501 *et seq.*; TBMP Chapter 1200).

In certain circumstances, a petition to the Director may be filed to review a final action that is limited to procedural issues, pursuant to 37 C.F.R. §2.63(b)(2). 37 C.F.R. §2.64(a). *See* 37 C.F.R. §2.146(b), TMEP §1704, and TBMP Chapter 1201.05 for an explanation of petitionable matters. The petition fee is \$100. 37 C.F.R. §2.6(a)(15).

If the applicant has any questions or needs assistance in responding to this Office action, please telephone the assigned examining attorney.

/Ty Murray/

Examining Attorney

United States Patent and Trademark Office

Law Office 113

(571) 272-9438

HOW TO RESPOND TO THIS OFFICE ACTION:

- **ONLINE RESPONSE:** You may respond using the Office's Trademark Electronic Application System (TEAS) Response to Office action form available on our website at <http://www.uspto.gov/teas/index.html>. If the Office action issued via e-mail, you must wait 72 hours after receipt of the Office action to respond via TEAS. **NOTE: Do not respond by e-mail. THE USPTO WILL NOT ACCEPT AN E-MAILED RESPONSE.**
- **REGULAR MAIL RESPONSE:** To respond by regular mail, your response should be sent to the mailing return address above, and include the serial number, law office number, and examining attorney's name. **NOTE: The filing date of the response will be the *date of receipt in the Office*, not the postmarked date.**

To ensure your response is timely, use a certificate of mailing. 37 C.F.R. §2.197.

STATUS OF APPLICATION: To check the status of your application, visit the Office's Trademark Applications and Registrations Retrieval (TARR) system at <http://tarr.uspto.gov>.

VIEW APPLICATION DOCUMENTS ONLINE: Documents in the electronic file for pending applications can be viewed and downloaded online at <http://portal.uspto.gov/external/portal/tow>.

GENERAL TRADEMARK INFORMATION: For general information about trademarks, please visit the Office's website at <http://www.uspto.gov/main/trademarks.htm>

FOR INQUIRIES OR QUESTIONS ABOUT THIS OFFICE ACTION, PLEASE CONTACT THE ASSIGNED EXAMINING ATTORNEY SPECIFIED ABOVE.