

Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	76701345
LAW OFFICE ASSIGNED	LAW OFFICE 110
MARK SECTION (no change)	
ARGUMENT(S)	<p>Applicant responds as follows to the refusal to register under Section 2(d) of the trademark statute. Registration has been refused because in the Examining Attorney's view there is likelihood of confusion between Applicant's mark BRIGHT HOUSE NETWORKS & DESIGN BRIGHT COMMUNITIES for "providing financial assistance to community organizations to develop and maintain programs" (ID amended and indicated below) and the mark in registration No. 3258493 BRIGHHOUSE TUTORING & EDUCATIONAL SERVICES for "Education services, namely, providing classes, seminars, workshops, tutoring and mentoring in the field of middle school and high school reform. Education services, namely providing tutoring in the field of kindergarten through 12th grade, all subjects."</p> <p>Applicant respectfully contends that the refusal to register on this basis is erroneous and should be withdrawn. While both marks contain the words, "BRIGHT HOUSE" as an element, this alone is an insufficient predicate for a refusal to register. As courts and the Trademark Trial and Appeal Board have consistently held, marks may not be dissected into component parts and then compared to determine likelihood of confusion. <u>Colgate-Palmolive Co. v. Carter-Wallace Inc.</u>, 432 F.2d 1400 (CCPA 1970) (PEAK PERIOD not confusingly similar to PEAK); <u>Lever Bros Co. v. Barcolene Co.</u> (CCPA 1972) (ALLCLEAR not confusingly similar to ALL); <u>Plus Products v. General Mills Inc.</u>, 188 USPQ 520 (TTAB 1975) (PROTEIN PLUS and PLUS not confusingly similar) In the instant case the mere fact that both marks contain the words "BRIGHT HOUSE" does not mean that confusion is likely, and the focus cannot be solely on this element - In fact, in Applicant's mark BRIGHT HOUSE is part of its the house mark BRIGHT HOUSE NETWORKS & design and indeed, this house mark and logo are elements in the overall mark and are shown in the same presentation as on Applicant's home web site www.brighthousenetworks.com. Moreover, the marks when viewed in their entireties are very different in overall appearance, sound, meaning and commercial impression - Applicant's mark is BRIGHT HOUSE NETWORKS & DESIGN BRIGHT COMMUNITIES in stylized lettering, whereas the registrant's mark is BRIGHT HOUSE TUTORING & EDUCATIONAL SERVICES with no particular stylization. The marks are clearly not similar when viewed completely and not dissected.</p> <p>Moreover, the services themselves are very different. As noted previously Bright House Networks is a cable and digital television and communications company with operations in Florida, Alabama and other states. The services offered under the mark in the instant application are part of its outreach efforts to communities it serves. The registrant provides tutoring in all subjects. Applicant is not offering services in the nature of all and tutoring services; rather, applicant provides support of a quite different kind. That both marks might be used in the broadest sense to support communities does not</p>

mean that they necessarily fall under the same rubric or that there is a per se basis for finding likelihood of confusion. Electronic Data Systems Corp. v. ESDA Corp. 23 USPQ 2d 1460 (TTAB 1992) Therefore applicant respectfully requests that the refusal to register be withdrawn.

GOODS AND/OR SERVICES SECTION (036)(current)

INTERNATIONAL CLASS 036

DESCRIPTION

Providing financial assistance and support in the nature of public service announcements to community organizations enabling them to develop and maintain programs

FILING BASIS Section 1(a)

FIRST USE ANYWHERE DATE At least as early as 02/00/2009

FIRST USE IN COMMERCE DATE At least as early as 02/00/2009

GOODS AND/OR SERVICES SECTION (036)(proposed)

INTERNATIONAL CLASS 036

TRACKED TEXT DESCRIPTION

~~Providing financial assistance and support in the nature of public service announcements to community organizations enabling them to develop and maintain programs;~~ Charitable services-namely, providing financial assistance to community organizations to meet the needs of children and families

FINAL DESCRIPTION

Charitable services-namely, providing financial assistance to community organizations to meet the needs of children and families

FILING BASIS Section 1(b)

GOODS AND/OR SERVICES SECTION (041)(class added)

INTERNATIONAL CLASS 041

DESCRIPTION

Providing ongoing television public service announcements in the field of importance of supporting local or community organizations by providing monetary donations or volunteering so they can develop and maintain programs.

FILING BASIS Section 1(b)

PAYMENT SECTION

NUMBER OF CLASSES 1

FEE PER CLASS 325

TOTAL FEES DUE 325

SIGNATURE SECTION

DECLARATION SIGNATURE	/Pamela Rask/
SIGNATORY'S NAME	Pamela Rask
SIGNATORY'S POSITION	Attorney of record, New York bar member
DATE SIGNED	07/05/2011
RESPONSE SIGNATURE	/Pamela Rask/
SIGNATORY'S NAME	Pamela Rask
SIGNATORY'S POSITION	Pamela Rask
DATE SIGNED	07/05/2011
AUTHORIZED SIGNATORY	YES
CONCURRENT APPEAL NOTICE FILED	YES
FILING INFORMATION SECTION	
SUBMIT DATE	Tue Jul 05 16:37:27 EDT 2011
TEAS STAMP	USPTO/RFR-38.150.246.3-20 110705163727275330-767013 45-480746cfc2ba1e3778c813 134f0d5bfb1d9-DA-3438-201 10705155627365329

PTO Form (Rev 4/2000)
 CIB No. 0851-... (Exp. 08/31/2004)

**Request for Reconsideration after Final Action
 To the Commissioner for Trademarks:**

Application serial no. **76701345** has been amended as follows:

ARGUMENT(S)

In response to the substantive refusal(s), please note the following:

Applicant responds as follows to the refusal to register under Section 2(d) of the trademark statute. Registration has been refused because in the Examining Attorney's view there is likelihood of confusion between Applicant's mark BRIGHT HOUSE NETWORKS & DESIGN BRIGHT COMMUNITIES for "providing financial assistance to community organizations to develop and maintain programs" (ID amended ans indicated below) and the mark in registration No. 3258493 BRIGHTHOUSE TUTORING & EDUCATIONAL SERVICES for "Education services, namely, providing classes, seminars, workshops, tutoring and mentoring in the field of middle school and high school reform. Education services, namely providing tutoring in the field of kindergarten through 12th grade, all subjects."
 Applicant respectfully contends that the refusal to register on this basis is erroneous and should be

withdrawn. While both marks contain the words, "BRIGHT HOUSE" as an element, this alone is an insufficient predicate for a refusal to register. As courts and the Trademark Trial and Appeal Board have consistently held, marks may not be dissected into component parts and then compared to determine likelihood of confusion. Colgate-Palmolive Co. v. Carter-Wallace Inc. 432 F2d 1400 (CCPA 1970) (PEAK PERIOD not confusingly similar to PEAK); Lever Bros Co. v. Barcolene Co. (CCPA 1972) (ALLCLEAR not confusingly similar to ALL); Plus Products v. General Mills Inc., 188 USPQ 520 (TTAB 1975) (PROTEIN PLUS and PLUS not confusingly similar) In the instant case the mere fact that both marks contain the words "BRIGHT HOUSE" does not mean that confusion is likely, and the focus cannot be solely on this element -In fact, in Applicant's mark BRIGHT HOUSE is part of its the house mark BRIGHT HOUSE NETWORKS & design and indeed, this house mark and logo are elements in the overall mark and are shown in the same presentation as on Applicant's home web site www.brighthousenetworks.com . Moreover, the marks when viewed in their entirety are very different in overall appearance, sound, meaning and commercial impression-Applicant's mark is BRIGHT HOUSE NETWORKS & DESIGN BRIGHT COMMUNITIES in stylized lettering, whereas the registrant's mark is BRIGHT HOUSE TUTORING & EDUCATIONAL SERVICES with no particular stylization. The marks are clearly not similar when viewed completely and not dissected. Moreover , the services themselves are very different. As noted previously Bright House Networks is a cable and digital television and communications company with operations in Florida, Alabama and other states. The services offered under the mark in the instant application are part of its outreach efforts to communities it serves. The registrant provides tutoring in all subjects. Applicant is not offering services in the nature of al and tutoring services;rather, applicant provides support of a quite different kind. That both marks might be used in the broadest sense to support communities does not mean that they necessarily fall under the same rubric or that there is a per se basis for finding likelihood of confusion. Electronic Data Systems Corp. v. ESDA Corp. 23 USPQ 2d 1460 (TTAB 1992) Therefore applicant respectfully requests that the refusal to register be withdrawn.

CLASSIFICATION AND LISTING OF GOODS/SERVICES

Applicant proposes to amend the following class of goods/services in the application:

Current: Class 036 for Providing financial assistance e and support in the nature of public service announcements to community organizations enabling them to develop and maintain programs
Original Filing Basis:

Filing Basis: Section 1(a), Use in Commerce: The applicant is using the mark in commerce, or the applicant's related company or licensee is using the mark in commerce, on or in connection with the identified goods and/or services. 15 U.S.C. Section 1051(a), as amended. The mark was first used at least as early as 02/00/2009 and first used in commerce at least as early as 02/00/2009, and is now in use in such commerce.

Proposed:

Tracked Text Description: ~~Providing financial assistance e and support in the nature of public service announcements to community organizations enabling them to develop and maintain programs;~~ Charitable services-namely,providing financial assistance to community organizations to meet the needs of children and families

Class 036 for Charitable services-namely,providing financial assistance to community organizations to meet the needs of children and families

Deleted Filing Basis: 1(a)

Filing Basis: Section 1(b), Intent to Use: The applicant has a bona fide intention to use or use through

the applicant's related company or licensee the mark in commerce on or in connection with the identified goods and/or services as of the filing date of the application. (15 U.S.C. Section 1051(b)).

Applicant hereby adds the following class of goods/services to the application:

New: Class 041 for Providing ongoing television public service announcements in the field of importance of supporting local or community organizations by providing monetary donations or volunteering so they can develop and maintain programs.

Filing Basis: Section 1(b), Intent to Use: The applicant has a bona fide intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the identified goods and/or services as of the filing date of the application. (15 U.S.C. Section 1051(b)).

FEE(S)

Fee(s) in the amount of \$325 is being submitted.

SIGNATURE(S)

Declaration Signature

If the applicant is seeking registration under Section 1(b) and/or Section 44 of the Trademark Act, the applicant has had a bona fide intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the identified goods and/or services as of the filing date of the application. 37 C.F.R. Secs. 2.34(a)(2)(i); 2.34 (a)(3)(i); and 2.34(a)(4)(ii); and/or the applicant has had a bona fide intention to exercise legitimate control over the use of the mark in commerce by its members. 37 C.F. R. Sec. 2.44. If the applicant is seeking registration under Section 1(a) of the Trademark Act, the mark was in use in commerce on or in connection with the goods and/or services listed in the application as of the application filing date or as of the date of any submitted allegation of use. 37 C.F.R. Secs. 2.34(a)(1)(i); and/or the applicant has exercised legitimate control over the use of the mark in commerce by its members. 37 C.F.R. Sec. 2.44. The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. Section 1001, and that such willful false statements may jeopardize the validity of the application or any resulting registration, declares that he/she is properly authorized to execute this application on behalf of the applicant; he/she believes the applicant to be the owner of the trademark/service mark sought to be registered, or, if the application is being filed under 15 U.S.C. Section 1051(b), he/she believes applicant to be entitled to use such mark in commerce; to the best of his/her knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive; that if the original application was submitted unsigned, that all statements in the original application and this submission made of the declaration signer's knowledge are true; and all statements in the original application and this submission made on information and belief are believed to be true.

Signature: /Pamela Rask/ Date: 07/05/2011

Signatory's Name: Pamela Rask

Signatory's Position: Attorney of record, New York bar member

Request for Reconsideration Signature

Signature: /Pamela Rask/ Date: 07/05/2011

Signatory's Name: Pamela Rask

Signatory's Position: Pamela Rask

The signatory has confirmed that he/she is an attorney who is a member in good standing of the bar of the highest court of a U.S. state, which includes the District of Columbia, Puerto Rico, and other federal

territories and possessions; and he/she is currently the applicant's attorney or an associate thereof; and to the best of his/her knowledge, if prior to his/her appointment another U.S. attorney or a Canadian attorney/agent not currently associated with his/her company/firm previously represented the applicant in this matter: (1) the applicant has filed or is concurrently filing a signed revocation of or substitute power of attorney with the USPTO; (2) the USPTO has granted the request of the prior representative to withdraw; (3) the applicant has filed a power of attorney appointing him/her in this matter; or (4) the applicant's appointed U.S. attorney or Canadian attorney/agent has filed a power of attorney appointing him/her as an associate attorney in this matter.

The applicant is filing a Notice of Appeal in conjunction with this Request for Reconsideration.

RAM Sale Number: 3438

RAM Accounting Date: 07/06/2011

Serial Number: 76701345

Internet Transmission Date: Tue Jul 05 16:37:27 EDT 2011

TEAS Stamp: USPTO/RFR-38.150.246.3-20110705163727275

330-76701345-480746cfc2ba1e3778c813134f0

d5bfb1d9-DA-3438-20110705155627365329

RAM SALE NUMBER: 3438
RAM ACCOUNTING DATE: 20110706

INTERNET TRANSMISSION DATE:
2011/07/05

SERIAL NUMBER:
76/701345

Description	Fee Code	Transaction Date	Fee	Number Of Classes	Total Fees Paid
New App	7001	2011/07/05	325	1	325