

TTAB

TRADEMARK

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Sideshow, Inc.

Correspondence Address:

Steven M. Weinberg
Pablo Tapia
Greenberg Traurig LLP
2450 Colorado Ave., STE 400E
Santa Monica, CA 90404

Mark: SIDESHOW COLLECTIBLES

Serial No.: 78/447,237

Docket No.: 72539-010300

Notice of Appeal Filed: February 23, 2006

**REQUEST FOR
RECONSIDERATION OF FINAL
REFUSAL**

Fred Mandir
Trademark Attorney
Law Office 105

Box TTAB - FEE
Assistant Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

Applicant files this Request for Reconsideration with the express permission of Examining Attorney, Fred Mandir. In a telephonic conversation between Trademark Examining Attorney Fred Mandir and counsel for Applicant Pablo Tapia at the USPTO on April 24, 2006, Mr. Mandir agreed to reconsider his final refusal to register the Applicant's mark in light of new evidence.

Furthermore, a Request for Suspension of Appeal is being submitted concurrently herewith.

ARGUMENT

The Trademark Examining Attorney has maintained and made final a refusal of registration under Section 2(d) of the Trademark Act, stating as the ground that Applicant's mark



SIDESHOW COLLECTIBLES is confusingly similar to Registration Number 1,295,738 for SIDESHOW, and that the description of goods is unacceptable. As shown below, the owner of the SIDESHOW registration has consented to the use and registration of the SIDESHOW COLLECTIBLES mark on the basis that it does not believe that confusion is likely between the two marks. Accordingly, Applicant respectfully requests that the refusal of registration be withdrawn.

LIKELIHOOD OF CONFUSION

The likelihood of confusion between two marks “is determined on a case-specific basis, applying the factors set out in In re E.I DuPont DeNemours & Co., 476 F.2d 1357, 1361, 177 U.S.P.Q. 563, 567 (CCPA 1973) (enumerating factors that may be considered when relevant evidence is of record).” Recot, Inc. v. Becton, 214 F.3d 1322, 1326, 54 U.S.P.Q.2d 1894 (2000). Notwithstanding the above, “[t]here is no mechanical test for determining likelihood of confusion. Each case must be decided on its own facts.”

A significant element that disavows likelihood of confusion of two marks is the agreement of the parties owning the marks to use the marks concurrently with the understanding that the marks are not confusingly similar. The Court of Customs and Patent Appeals in In re E.I DuPont endorsed the importance of consent agreements indicating that “when those most familiar with use in the marketplace and most interested in precluding confusion enter agreements designed to avoid it, the scales of evidence are clearly tilted. It is at least difficult to maintain a subjective view that confusion will occur when those directly concerned say it won't. A mere *assumption* that confusion is likely will rarely prevail against uncontroverted evidence from those on the firing line that it is not. Id. at 476 F.2d 1357, 1363, 177 USPQ 563, 568.

The Registrant of the mark SIDESHOW, Registration Number 1,295,738, has consented to Applicant's registration and continued use of the mark SIDESHOW COLLECTIBLES as applied for herein. Applicant attaches a copy of Registrant's consent as Exhibit A.

The consent to Applicant's registration and continued use of SIDESHOW COLLECTIBLES is not a naked consent, but details the reasons why the parties agree that there is no likelihood of confusion. The consent also details the parties' co-existence in the

marketplace without any confusion and provides that in the unlikely event that confusion arises, the parties will take every reasonable action to rectify the situation.

The Court of Appeals for the Federal Circuit has been clear in its position that the U.S. Patent and Trademark Office is to give proper consent agreements great weight, and is not to substitute its own judgment concerning likelihood of confusion. Amalgamated Bank of New York v. Amalgamated Trust & Savings Bank, 6 U.S.P.Q.2d 1305 (Fed. Cir. 1988); Bongrain International (American) Corp. v. Delice de France Inc., 1 U.S.P.Q.2d 1775 (Fed. Cir. 1987).

Applicant submits that based on the consent agreement, and all other evidence and arguments previously submitted and now in the record, Applicant's mark and Registrant's mark are not confusingly similar.

In view of the foregoing, Applicant respectfully requests that the Examining Attorney withdraw his citation of the registration for SIDESHOW, Registration No. 1,295,738, in the name of Spade and Archer Productions.

IDENTIFICATION OF SERVICES

The Examining Attorney has indicated that the identification of services is too broad and has suggested that Applicant amend its identification of services to include the word "store." Accordingly, Applicant requests that the identification of services be amended to read as follows:

"Online retail store services featuring action figures, dolls, toy collectibles, plaques, busts replica movie props, books, posters and fantasy character toys."

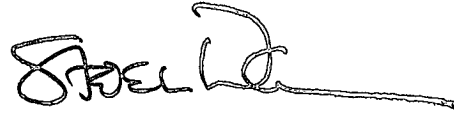
CONCLUSION

Accordingly, for all the foregoing reasons, Applicant respectfully requests that the SIDESHOW COLLECTIBLES application be approved for publication. Please charge any fees to Deposit Account No. 12-1820.

Date: April 24, 2006

Respectfully submitted,

GREENBERG TRAUIG, LLP
2450 Colorado Avenue, Suite 400E
Santa Monica, CA 90404



By _____

Steven M. Weinberg
Pablo Tapia
Attorneys for Applicant,
Sideshow, Inc.

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CONCURRENT USE AND REGISTRATION AGREEMENT

This Agreement is effective as of March 14, 2006, and is between SIDESHOW INC. ("SI"), a California corporation, with offices at 31238 Via Colinas Suite E, Westlake Village, California 91362 and SPADE & ARCHER PRODUCTIONS, a California corporation, c/o Turner & Adams LLP 142 South Woodburn Drive, Los Angeles CA 90049 (S&A).

WHEREAS, S&A is the owner of the mark SIDESHOW for retail store services featuring magic and novelty items, which is registered in the U.S.P.T.O. under Reg. No. 2891731 (the "S&A Mark");

WHEREAS, SI is the owner of the mark SIDESHOW COLLECTIBLES for online retail store services featuring action figures, dolls, toy collectibles, plaques, busts, replica movie props, books, posters, fantasy character toys, which is the subject of application Serial No. 78447237 and for books featuring fiction and movie related subjects and posters; toys, namely, toy action figures, collectible toy figures and dolls and accessories therefor, and toy plaques; busts made of bone, bronze, metal, plastic, wood and porcelain and statutes made of bronze, bone, metal, plastic, wood and porcelain, all subject to Serial No. 78445670; and the mark SIDESHOW TOY for toy action figures and accessories therefor, toy figures, plush toys and stuffed toys, which is registered in the U.S.P.T.O. under Reg. No. 2355163 (the "SI Marks").

WHEREAS, the parties believe that they can concurrently use their respective marks without likelihood of confusion and are entering into this agreement to confirm their understanding and to establish guidelines for their concurrent use.

Now, therefore, the parties agree as follows:

1. The parties agree that confusion should not be likely as long as the parties continue to use their respective marks substantially in the manner in which the marks have been used.
2. Subject to the parties' mutual compliance with this Agreement, S&A will not oppose, seek to cancel or otherwise challenge the ownership, use or registration of the SI Marks, and SI will not oppose, seek to cancel or otherwise challenge the ownership, use or registration of the S&A Mark.

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3. The parties each acknowledge that neither is aware of the occurrence of an actual confusion between their respective marks, and agree that confusion is unlikely in light of the differences in the nature of their respective goods and services.

4. In the event that either party becomes aware that other than de minimus actual confusion is occurring between their respective Marks, that party will notify the other party, and the parties will negotiate in good faith to attempt to alleviate such confusion prior to commencing any legal action.

5. The parties each agree that a copy of this agreement may be filed with the U.S. Patent and Trademark Office and such other government trademark offices as required to assist in the registration their respective Marks in the U.S. and elsewhere.

7. The parties each agree that it shall provide to the other party such other consents, assistance and instruments as requested by the other part at that other party's expense, as is or may be necessary to assist the other in using or registering their respective marks.

8. No supplement, modification or amendment of this agreement shall be effective unless made in writing and signed by all the parties hereto.

9. This Agreement is binding upon and inures to the benefit of the parties' respective heirs, successors and assigns.

10. No waiver of any of the provisions of this Agreement shall be deemed or shall constitute a waiver of any other provision of this Agreement, whether similar or not similar, nor shall such waiver constitute a continuing waiver unless otherwise expressly provided.

11 This Agreement shall be governed by and construed in accordance with the laws of the State of California

12. If any provision, clause or part of the Agreement, or the application thereof, under certain circumstances is held invalid, the remainder of this Agreement or the applications of such provision,

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clause or part under other circumstances, shall not be affected thereby, and a court of competent jurisdiction shall have the power to reform any invalid part to make it valid.

13. The parties each represent and warrant to one another they have not sold, assigned, transferred, conveyed or otherwise disposed of any claim or demand covered by this Agreement except as contained in this Agreement.

14. This Agreement constitutes the entire agreement between the parties hereto pertaining to the subject matter hereof and supersedes all prior and contemporaneous agreement, understanding, negotiations and discussions, whether oral or written, of the parties, and there are no warranties, representations or other agreements between the parties in connection with the subject matter hereof other than as set forth herein.

IN WITNESS WHEREOF, the parties have caused this agreement to be executed as stated below with the intent to be fully bound.

SIDESHOW INC.

By: 

Name: KENTON COBB

Title: SECRETARY

SPADE & ARCHER PRODUCTIONS

By: 

Name: HARRY ANDERSON

Title: PRESIDENT

