PTO Form 2194 (Rev 9/2005)

OMB No. 0651-0054 (Exp. 11/30/2008)

Petition To Revive Abandoned Application - Failure To Respond Timely To Office Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	78547096
LAW OFFICE ASSIGNED	LAW OFFICE 117
DATE OF NOTICE OF ABANDONMENT	10/25/2006
PETITION	
PETITION STATEMENT	Applicant has firsthand knowledge that the failure to respond to the Office Action by the specified deadline was unintentional, and requests the USPTO to revive the abandoned application.
RESPONSE TO OFFICE ACTION	
MARK SECTION (no change)	
ARGUMENT(S)	

REFUSAL - LIKELIHOOD OF CONFUSION

The Examining Attorney has maintained the refusal to register the proposed mark DECK OF SECRETS based on a likelihood of confusion with the mark THE BOOK OF SECRETS set forth in Reg. No. 2869047. Applicant's submits that the refusal has been rendered moot as a result of the clarifications made to the description of goods in the instant application. Furthermore, as explained below, Applicant submits that the refusal to register under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), is improper and respectfully requests that it be withdrawn.

First, the parties' marks are not, when compared in their entireties, similar in sound, appearance or meaning. The Examining Attorney found the parties' marks to be similar by asserting that the wording OF SECRETS is the dominant portions of those marks and noting that both marks share this wording. The Examining Attorney's analysis of the parties' marks is inherently flawed. Even assuming that the wording OF SECRETS is the dominant portion of both marks, it is inappropriate to dissect the parties' composite marks and then only consider the shared elements of the marks as the Examining Attorney has done. *See In re National Data Corp.*, 224 USPQ 749, 751 (Fed. Cir. 1985) ("[L]ikelihood of confusion cannot be predicated on dissection of a mark, that is, on only part of a mark") citing *Franklin Mint Corp. v. Master Mfg. Co.*, 212 USPQ 233, 234 (CCPA 1981) ("It is axiomatic that a mark should be not dissected and considered piecemeal; rather, it must be considered

as a whole in determining likelihood of confusion"). It is notable in this regard that the Examining Attorney does not even explicitly mention the initial portions of the parties' marks in her comparison of the marks. Moreover, the non-common matter, even if "equally suggestive or even descriptive," can be enough to avoid a likelihood of confusion. *See Wooster Brush Co. v. Prager Bruch Co.*, 231 USPQ 316, 318 (TTAB 1986) ("Poly Flo" for paint brushes does not so resemble "EASYFLO" and "Poly Pro" for paint brushes and "Poly-Glo" for paint applicators to result in confusion as to source or sponsorship where those marks are contemporaneously used in connection with same or closely related products); *see also United Foods v. J.R. Simplot Co.*, 4 USPQ2d 1172, 1174 (TTAB 1987). Thus, the Examining Attorney's failure to consider the non-common matter in the parties' marks constitutes clear error.

The Examining Attorney is also incorrect in her assertions that the wording OF SECRETS is the dominant portions of the parties' marks. With respect to Applicant's mark, the wording DECK is not, as discussed below in connection with the disclaimer requirement, merely descriptive of the identified goods. Therefore, it should not be accorded less weight, and the Examining Attorney's treatment of this word as though it were disclaimed is improper. With respect to both marks, the beginning of a mark is almost always the first part encountered by consumers and is also the portion of the mark more likely to form an impression upon the consumer's memory. *See Presto Prods. Inc. v. Nice-Pak Prods., Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) ("[I]t is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered."). Consumers confronted with the parties' marks will take away very different commercial impressions because of the stark differences in the initial portions of the marks. Applicant's mark begins with the wording DECK while the registered mark begins with the wording THE BOOK. The terms DECK and BOOK are not synonymous. In addition, the definite article THE contributes to the overall sound, appearance and meaning of the registered mark, and this contribution is not present in the proposed mark. Clearly, the initial wording of the two marks is in no way similar in sound, appearance or meaning. Moreover, the essential nature of the initial portions of the parties' marks is emphasized by the syntax of the two composite marks. The propositional phrase beginning with the preposition OF draws the consumer's attention back to the readily distinguishable initial portions of the parties' marks. Given that the dissimilar portions of the parties' marks appear at the critical beginning of those marks, it is extremely unlikely that consumers will disregard or dismiss these portions when calling for the parties' goods.

Lastly, as previously pointed out in Applicant's response to the initial Office Action, there are a number of third party marks ending with the prepositional phrase OF SECRETS used in connection with printed matter. Thus, this wording is used by a number of entities in otherwise distinguishable marks without confusion as to either source of origin or sponsorship. *See Tektronix Inc. v. Daktronics Inc.*, 189 USPQ 693, 694-95 (CCPA 1976); *Shoe Corp. of Am. v. Juvenile Shoe Corp. of Am.*, 121 USPQ 510 (CCPA 1959) ("[T]he registration of five such marks can scarcely be attributed to mere coincidence, but affords definite evidence that the word "Lazy" has a suggestive significance as applied to shoes"). As a result, consumers will look to the non-shared matter in the parties' marks which, as previously discussed, they will find to be readily distinguishable.

In sum, the wording DECK in Applicant's mark should not be dismissed or marginalized since it is not merely descriptive of Applicant's goods. In addition, the wording DECK in Applicant's mark and the wording THE BOOK in the registered mark should not be dismissed or marginalized given the importance of the initial portions of marks in creating the overall commercial impressions of marks. This is particularly true in this case where the initial and final portions of the parties' marks are grammatically tied together and where the common portions are frequently used by third parties in similar contexts. Consequently, Applicant avers that the initial portions of the parties' marks should be accorded at least the same amount of weight as the shared final portions of the marks. When

properly analyzed in their entireties, the marks are not confusingly similar.

Second, the parties' goods have not been shown to be closely related. The description of Applicant's goods has been revised to clarify their exact nature. Therefore, the goods in the instant application cannot in any way be considered to be broad enough to encompass the goods set forth in the cited registration. As Applicant has previously argued, the parties' goods are not closely related nor are the conditions surrounding their marketing such that they could be encountered by the same purchasers under circumstances that could give rise to the mistaken belief that the parties' goods come from a common source. The record is devoid of any evidence to the contrary.

Given the relatively low degree of similarity in the overall commercial impressions of the parties' marks and the absence of any evidence that the parties' goods are closely related, Applicant avers that instant likelihood of confusion is improper and, therefore, the refusal must be withdrawn.

DISCLAIMER REQUIREMENT

The Examining Attorney has required a disclaimer of the wording DECK apart from the mark as shown. A disclaimer is appropriate only if the wording merely describes a significant ingredient, quality, characteristic, feature, function, purpose or use of the goods. In this case, the wording DECK is defined by both Applicant and the Examining Attorney as "a pack of playing cards". While Applicant's goods are in the form of a collection of cards, these cards contain photographs, guide maps and guides and provide useful information about bars, cafes, shops, restaurants, taverns and tourist attractions. Thus, Applicant's goods are not a pack of playing cards. Consequently, this wording does not accurately describe any feature or characteristic of the identified goods and, therefore, a disclaimer of this wording is inappropriate.

GOODS AND/OR SERVICES SECTION (current)	
INTERNATIONAL CLASS	016
DESCRIPTION	
Printed publications, printed matter, photographs, books, guide books,including shopping guides, guide maps, guides for entertainment or recreational purposes; printed publications, printed matter, photographs, books, guide books,including shopping guides, guide maps, and guides for entertainment or recreational purposes in card format or in the form of a deck of card	
FILING BASIS	Section 1(b)
FOREIGN APPLICATION NUMBER	1011564
FOREIGN FILING DATE	07/16/2004
FILING BASIS	Section 44(e)
FOREIGN REGISTRATION NUMBER	1011564
FOREIGN REGISTRATION COUNTRY	AU
FOREIGN REGISTRATION DATE	07/16/2004
FOREIGN EXPIRATION DATE	07/16/2014
GOODS AND/OR SERVICES SECTION (proposed)	

INTERNATIONAL CLASS	016
DESCRIPTION	
printed matter, namely, printed informational cards and printed informational cards in the form of a collection of cards all featuring photographs, guides and reviews of bars, cafes, shops, restaurants, taverns and tourist attractions, printed guide maps and printed guides for entertainment or recreational activities	
FILING BASIS	Section 44(d)
FOREIGN APPLICATION NUMBER	1011564
FOREIGN APPLICATION COUNTRY	Australia
FOREIGN FILING DATE	07/16/2004
FILING BASIS	Section 44(e)
FOREIGN REGISTRATION NUMBER	1011564
FOREIGN REGISTRATION COUNTRY	Australia
FOREIGN REGISTRATION DATE	07/16/2004
FOREIGN EXPIRATION DATE	07/16/2014
PAYMENT SECTION	
TOTAL AMOUNT	100
TOTAL FEES DUE	100
SIGNATURE SECTION	
DECLARATION SIGNATURE	The filing Attorney has elected not to submit the signed declaration, believing no supporting declaration is required under the *Trademark Rules of Practice.*
RESPONSE SIGNATURE	/jmenker/
SIGNATORY'S NAME	James R. Menker
SIGNATORY'S POSITION	Attorney for Applicant
DATE SIGNED	11/20/2006
FILING INFORMATION SECTION	
SUBMIT DATE	Mon Nov 20 11:46:08 EST 2006
TEAS STAMP	USPTO/POA-65.182.34.5-200 61120114608554020-7854709 6-35096ea888ad80aa80bf835 3b24b5bffa4-CC-1623-20061 120100952284804

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OMB No. 0651-0054 (Exp. 11/30/2008)

Petition To Revive Abandoned Application - Failure To Respond Timely To Office Action

To the Commissioner for Trademarks:

Application serial no. **78547096** is amended as follows:

PETITION

Petition Statement

Applicant has firsthand knowledge that the failure to respond to the Office Action by the specified deadline was unintentional, and requests the USPTO to revive the abandoned application.

RESPONSE TO OFFICE ACTION

Argument(s)

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

REFUSAL - LIKELIHOOD OF CONFUSION

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Classification and Listing of Goods/Services

Applicant hereby amends the following class of goods/services in the application as follows:

Current: Class 016 for Printed publications, printed matter, photographs, books, guide books,including shopping guides, guide maps, guides for entertainment or recreational purposes; printed publications, printed matter, photographs, books, guide books,including shopping guides, guide maps, and guides for entertainment or recreational purposes in card format or in the form of a deck of card

Original Filing Basis: 1(b); and/or 44(e).

Proposed: Class 016 for printed matter, namely, printed informational cards and printed informational cards in the form of a collection of cards all featuring photographs, guides and reviews of bars, cafes, shops, restaurants, taverns and tourist attractions, printed guide maps and printed guides for entertainment or recreational activities

Deleted Filing Basis: 1(b)

New/Additional Basis:

Section 44(d) Priority based on foreign filing: Applicant has a bona fide intention to use the mark in commerce on or in connection with the identified goods and/or services, and asserts a claim of priority based on [Australia (AUX) application number 1011564 filed 07/16/2004]. 15 U.S.C.Section 1126(d), as amended.

Section 44(e) Based on Foreign Registration: Applicant has a bona fide intention to use the mark in commerce on or in connection with the identified goods and /or services, and will submit a copy of [Australia (AUX) registration number 1011564 registered 07/16/2004 with a renewal date of _____ and an expiration date of 07/16/2014], and translation thereof, if appropriate, before the application may proceed to registration. 15 U.S.C. Section 1126(e), as amended.

Fees

Fee(s) in the amount of $100 is being submitted.

Declaration Signature

I hereby elect to bypass the submission of a signed declaration, because I believe a declaration is not required by the rules of practice. I understand that the examining attorney could still, upon later review, require a signed declaration.

Petition/Response Signature

Signature: /jmenker/ Date: 11/20/2006
Signatory's Name: James R. Menker
Signatory's Position: Attorney for Applicant

Serial Number: 78547096
Internet Transmission Date: Mon Nov 20 11:46:08 EST 2006
TEAS Stamp: USPTO/POA-65.182.34.5-20061120114608554020-78547096-35096ea888ad80aa80bf8353b24b5bffa4-CC-1623-20061120100952284804

RAM SALE NUMBER: 1623

RAM ACCOUNTING DATE: 20061120

INTERNET TRANSMISSION DATE:

2006/11/20

SERIAL NUMBER:

78/547096

Description	Fee Code	Transaction	Total Fees Paid
POA	7005	2006/11/20	100