

Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	86170852
LAW OFFICE ASSIGNED	LAW OFFICE 102
MARK SECTION (no change)	
ARGUMENT(S)	
I. LIKELIHOOD OF CONFUSION REFUSAL	
A. INTRODUCTION	
<p>The Examining Attorney has maintained his refusal of U.S. Trademark Application No. 86/170,852 for the mark GREE, for use in connection with, as amended herein: "providing on-line chat rooms and electronic bulletin boards via proprietary social networking websites and software applications for electronic transmission of messages and data, namely, documents, videos, images and digital music via a global communication network for social networking in the fields of social games, video games, and general interest," in International Class 38 (the "Application") due to an alleged likelihood of confusion with U.S. Registration No. 4362969 (the "Cited Registration"), owned by Gree Electric Appliances, Inc. of Zhuhai, for the mark G GREE & Design for use in connection with: "radio broadcasting; television broadcasting; broadcasting of television; cable television broadcasting; information about telecommunication; telecommunication connections to a global computer network; teleconferencing services; providing user access to a global computer network; voice mail services," in International Class 38.</p> <p>As noted previously, in an <i>ex parte</i> appeal, the issue of likelihood of confusion typically revolves around the similarity or dissimilarity of the marks and the relatedness of the goods or services. See TMEP §1207.01; <i>In re E.I. du Pont de Nemours & Co.</i>, 476 F.2d 1357 (C.C.P.A. 1973). The issue is not whether the actual goods are likely to be confused, but, rather, whether there is a likelihood of confusion as to the <i>source</i> of the goods. <i>Id.</i> See also, <i>In re Shell Oil Co.</i>, 992 F.2d 1204 (Fed. Cir. 1993).</p>	
B. THE SERVICES IDENTIFIED IN THE APPLICATION, AS AMENDED, ARE DISTINGUISHABLE FROM THE SERVICES IDENTIFIED IN THE CITED REGISTRATION SUCH THAT A LIKELIHOOD OF CONFUSION WILL NOT OCCUR.	
<p>The services offered by the Applicant and the services recited in the Cited Registration are different, such that there is no likelihood of confusion. Specifically, as reflected in the amended recitation of services appearing in the Application, Applicant provides online chat rooms and electronic bulletin boards via its proprietary GREE-brand social networking websites only. Applicant is not an Internet service provider and does not provide radio, television, cable or other broadcasting services. Consumers of the services appearing in the recitation of services for the Application access such services only from within the ambit of Applicant's GREE-branded social network. Moreover, as noted in the amended recitation of services, the electronic transmission of messages and data, namely, documents, videos, images and digital music via a global communication network, occurs only within the context of Applicant's proprietary social network. In other words, Applicant is not an email service provider or SMS/MMS service provider. Rather, Applicant's</p>	

social networking service happens to facilitate end-user communication via chat rooms and electronic bulletin boards that enable the electronic transmission of messages and data among other users of Applicant's proprietary social network in the field of social games, video games, and general interest.

Conversely, the services covered under the Cited Registration include: radio broadcasting; television broadcasting; broadcasting of television; cable television broadcasting; information about telecommunication; telecommunication connections to a global computer network; teleconferencing services; providing user access to a global computer network; voice mail services. As noted above, the Application does not cover radio, television, or cable television broadcasting, or similar variations of those services, nor does it relate to the provision of information about telecommunication, telecommunications connections to a global network, teleconferencing services, user access to a global communication service, or voicemail services. Instead, Applicant provides a service to users of its proprietary social network which enables such users to interact and exchange messages within the framework of Applicant's proprietary social networking website only. Applicant respectfully notes that the Cited Registration does not relate to social networking services or electronic transmission of messages via such proprietary services. Accordingly, there is no overlap between the services identified in the Application and the Cited Registration. Any conclusion to the contrary would be speculative and contrary to the record.

C. THE CONSUMERS AND THE CHANNELS OF TRADE FOR THE SERVICES COVERED UNDER THE APPLICATION AND THE CITED REGISTRATION ARE DIFFERENT, SUCH THAT A LIKELIHOOD OF CONFUSION WILL NOT OCCUR.

The Examining Attorney has alleged that it is common for Applicant's and Registrant's services to travel in the same channels of trade, based on attachments received from the GOOGLE® search engine.

As made apparent by the amended recitation of services appearing in the Application, the services intended to be offered by Applicant under the applied-for mark are offered strictly within the context of its proprietary social networking website. Therefore, a consumer will only encounter the services covered under the present Application within the framework of Applicant's proprietary social networking website. This means that a consumer will not have access to the services appearing in the Application unless they have already registered an account on Applicant's proprietary social network. Clearly, under such circumstances there would be no doubt in the minds of the relevant consumers from what source the recited services are originating. Additionally noteworthy is the fact that Applicant's services are specifically limited to consumers with interests related to video and social games.

As noted in the Final Office Action, the services appearing in the Cited Registration may potentially travel in "all normal channels of trade" given that the recitation of services for the Cited Registration in Class 38 is not limited to more specific trade channels. This is in stark contrast to Applicant's services, which are offered through very specific channels of trade to a very specific and sophisticated target audience. Importantly, the services appearing in the Application and the services associated with the Cited Registration are not, and cannot function as substitutes for each other. In light of these considerations, there can be no reasonable possibility of confusion between the Application and the Cited Registration. Thus, confusion is not likely in this case.

D. THE MARKS ARE VISUALLY DISTINGUISHABLE SUCH THAT A LIKELIHOOD OF CONFUSION WILL NOT OCCUR.

Applicant respectfully notes that the Cited Registration depicts a highly stylized G GREE design mark. The highly stylized mark depicted in the Cited Registration is unique and readily distinguishable from Applicant's mark. Thus, given the visual differences between the respective marks, consumers will be readily able to distinguish between the marks, such that there is no danger of any likelihood of confusion between the Applied-for Mark and the mark depicted in the Cited Registration, particularly in light of the discreet channels of trade discussed above.

II. CONCLUSION

In light of the foregoing, given the differences between the services at issue, Applicant's narrow group of target consumers, and the fact that Applicant's services can only be accessed once consumers are registered users within the ambit of Applicant's proprietary social networking websites and mobile applications, Applicant respectfully asserts that no likelihood of confusion exists between Applicant's GREE mark and the marks identified in the Cited Registration. Therefore, Applicant respectfully requests that the Examining Attorney withdraw the likelihood of confusion refusal and allow the Application to proceed to publication.

GOODS AND/OR SERVICES SECTION (current)

INTERNATIONAL CLASS 038

DESCRIPTION

providing on-line chat rooms and electronic bulletin boards for transmission of messages among users in the fields of social networking and general interest; electronic transmission of messages and data, namely, documents, videos, images and digital music via a global communication network

FILING BASIS Section 1(b)

GOODS AND/OR SERVICES SECTION (proposed)

INTERNATIONAL CLASS 038

TRACKED TEXT DESCRIPTION

~~providing on-line chat rooms and electronic bulletin boards for transmission of messages among users in the fields of social networking and general interest;~~ Providing on-line chat rooms and electronic bulletin boards via proprietary social networking websites and software applications for electronic transmission of messages and data, namely, documents, videos, images and digital music via a global communication network for social networking in the fields of social games, video games, and general interest; ~~electronic transmission of messages and data, namely, documents, videos, images and digital music via a global communication network~~

FINAL DESCRIPTION

Providing on-line chat rooms and electronic bulletin boards via proprietary social networking websites and software applications for electronic transmission of messages and data, namely, documents, videos, images and digital music via a global communication network for social networking in the fields of social games, video games, and general interest

FILING BASIS Section 1(b)

FILING BASIS Section 44(e)

FOREIGN REGISTRATION NUMBER 4887424

FOREIGN REGISTRATION DATE 08/12/2015

STANDARD CHARACTERS OR EQUIVALENT YES

SIGNATURE SECTION

DECLARATION SIGNATURE The filing Attorney has elected not to submit the signed declaration, believing no supporting declaration is required

	under the <i>Trademark Rules of Practice</i> .
RESPONSE SIGNATURE	/David M. Kramer/
SIGNATORY'S NAME	David M. Kramer
SIGNATORY'S POSITION	Attorney of record, District of Columbia bar member
SIGNATORY'S PHONE NUMBER	202-799-4153
DATE SIGNED	05/13/2015
AUTHORIZED SIGNATORY	YES
CONCURRENT APPEAL NOTICE FILED	NO
FILING INFORMATION SECTION	
SUBMIT DATE	Wed May 13 18:35:32 EDT 2015
TEAS STAMP	USPTO/RFR-206.205.117.10- 20150513183532678968-8617 0852-530c1323919123d2c15b 782361cd676de8b165a1603d6 edd4242bed2c2a974867-N/A- N/A-20150513183119053408

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

Application serial no. **86170852** has been amended as follows:

ARGUMENT(S)

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

I. LIKELIHOOD OF CONFUSION REFUSAL

A. INTRODUCTION

The Examining Attorney has maintained his refusal of U.S. Trademark Application No. 86/170,852 for the mark GREE, for use in connection with, as amended herein: "providing on-line chat rooms and electronic bulletin boards via proprietary social networking websites and software applications for electronic transmission of messages and data, namely, documents, videos, images and digital music via a global communication network for social networking in the fields of social games, video games, and general interest," in International Class 38 (the "Application") due to an alleged likelihood of confusion with U.S. Registration No. 4362969 (the "Cited Registration"), owned by Gree Electric Appliances, Inc. of Zhuhai, for the mark G GREE & Design for use in connection with: "radio broadcasting; television broadcasting; broadcasting of television; cable television broadcasting; information about telecommunication; telecommunication connections to a global

computer network; teleconferencing services; providing user access to a global computer network; voice mail services,” in International Class 38.

As noted previously, in an *ex parte* appeal, the issue of likelihood of confusion typically revolves around the similarity or dissimilarity of the marks and the relatedness of the goods or services. See TMEP §1207.01; *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357 (C.C.P.A. 1973). The issue is not whether the actual goods are likely to be confused, but, rather, whether there is a likelihood of confusion as to the *source* of the goods. *Id.* See also, *In re Shell Oil Co.*, 992 F.2d 1204 (Fed. Cir. 1993).

B. THE SERVICES IDENTIFIED IN THE APPLICATION, AS AMENDED, ARE DISTINGUISHABLE FROM THE SERVICES IDENTIFIED IN THE CITED REGISTRATION SUCH THAT A LIKELIHOOD OF CONFUSION WILL NOT OCCUR.

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Conversely, the services covered under the Cited Registration include: radio broadcasting; television broadcasting; broadcasting of television; cable television broadcasting; information about telecommunication; telecommunication connections to a global computer network; teleconferencing services; providing user access to a global computer network; voice mail services. As noted above, the Application does not cover radio, television, or cable television broadcasting, or similar variations of those services, nor does it relate to the provision of information about telecommunication, telecommunications connections to a global network, teleconferencing services, user access to a global communication service, or voicemail services. Instead, Applicant provides a service to users of its proprietary social network which enables such users to interact and exchange messages within the framework of Applicant’s proprietary social networking website only. Applicant respectfully notes that the Cited Registration does not relate to social networking services or electronic transmission of messages via such proprietary services. Accordingly, there is no overlap between the services identified in the Application and the Cited Registration. Any conclusion to the contrary would be speculative and contrary to the record.

C. THE CONSUMERS AND THE CHANNELS OF TRADE FOR THE SERVICES COVERED UNDER THE APPLICATION AND THE CITED REGISTRATION ARE DIFFERENT, SUCH THAT A LIKELIHOOD OF CONFUSION WILL NOT OCCUR.

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originating. Additionally noteworthy is the fact that Applicant's services are specifically limited to consumers with interests related to video and social games.

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II. CONCLUSION

In light of the foregoing, given the differences between the services at issue, Applicant's narrow group of target consumers, and the fact that Applicant's services can only be accessed once consumers are registered users within the ambit of Applicant's proprietary social networking websites and mobile applications, Applicant respectfully asserts that no likelihood of confusion exists between Applicant's GREE mark and the marks identified in the Cited Registration. Therefore, Applicant respectfully requests that the Examining Attorney withdraw the likelihood of confusion refusal and allow the Application to proceed to publication.

CLASSIFICATION AND LISTING OF GOODS/SERVICES

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

Current: Class 038 for providing on-line chat rooms and electronic bulletin boards for transmission of messages among users in the fields of social networking and general interest; electronic transmission of messages and data, namely, documents, videos, images and digital music via a global communication network

Original Filing Basis:

Filing Basis: Section 1(b), Intent to Use: 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. (15 U.S.C. Section 1051(b)).

Proposed:

Tracked Text Description: ~~providing on-line chat rooms and electronic bulletin boards for transmission of messages among users in the fields of social networking and general interest;~~ Providing on-line chat rooms and electronic bulletin boards via proprietary social networking websites and software applications for electronic transmission of messages and data, namely, documents, videos, images and digital music via a global communication network for social networking in the fields of social games, video games, and general interest; ~~electronic transmission of messages and data, namely, documents, videos, images and digital music via a global communication network~~

Class 038 for Providing on-line chat rooms and electronic bulletin boards via proprietary social networking websites and software applications for electronic transmission of messages and data, namely, documents, videos, images and digital music via a global communication network for social networking in the fields of social games, video games, and general interest

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)).

Filing Basis: 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 [_____ registration number 4887424 registered 08/12/2015 with a renewal date of _____ and an expiration date of _____], and translation thereof, if appropriate, before the application may proceed to registration. 15 U.S.C. Section 1126(e), as amended.

The foreign registration that is the basis of the U.S. application under §44(e) of the Trademark Act (15 U.S.C. §1126(e)) includes a claim of standard characters or the country of origin's standard character equivalent.

SIGNATURE(S)

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.

Request for Reconsideration Signature

Signature: /David M. Kramer/ Date: 05/13/2015

Signatory's Name: David M. Kramer

Signatory's Position: Attorney of record, District of Columbia bar member

Signatory's Phone Number: 202-799-4153

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 not filing a Notice of Appeal in conjunction with this Request for Reconsideration.

Serial Number: 86170852

Internet Transmission Date: Wed May 13 18:35:32 EDT 2015

TEAS Stamp: USPTO/RFR-206.205.117.10-201505131835326

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