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

Proceeding	86314468
Applicant	Tango Card, Inc.
Applied for Mark	REWARDS GENIUS
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

Serial No.: 86/314,468
Mark: REWARDS GENIUS
Applicant: Tango Card, Inc.
Examining Attorney: Pamela Y. Willis
Law Office 106

APPLICANT'S *EX PARTE* APPEAL BRIEF

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Applicant, Tango Card, Inc., respectfully appeals the Examining Attorney's refusal to register Applicant's standard character REWARDS GENIUS mark in Application Serial No. 86/314,468 ("the Application"). The Examining Attorney's refusal to register Applicant's REWARDS GENIUS mark pursuant to Trademark Act Section 2(d), 15 U.S.C. § 1052(d), on the ground that the mark is likely to be confused with the GENIUS mark in Registration No. 4,478,749, is inappropriate because the two marks are not confusingly similar.

PROSECUTION HISTORY

Applicant seeks registration on the Principal Register for the mark REWARDS GENIUS in standard characters for use in connection with "Computer services, namely, providing a website featuring technology that allows enterprise business users of an online web interface to create and manage a rewards and recognition program, namely, account creation, account funding, catalog management, rewards delivery, and order management and history" in Class 42. The Application was filed on June 19, 2014, based on use of the mark in commerce.

On September 29, 2014, the Examining Attorney issued a Non-Final Office Action (the "OA"), refusing registration under Trademark Act §2(d) on the ground that Applicant's mark is likely to be confused with the mark in Registration No. 4,478,749.

On March 13, 2015, Applicant submitted an office action response (the "OAR"), in which Applicant offered arguments against the refusal to register the mark under Trademark Act §2(d).

On June 2, 2015, the Examining Attorney issued a Final Office Action (the "FOA") regarding the refusal under Trademark Act § 2(d).

On August 13, 2015, Applicant filed a Notice of Appeal with the Board and a Request for Reconsideration, along with a substitute power of attorney appointment. *See* Docket Docs. 1 & 4. The Board acknowledged and remanded the the appeal on the same day. *See* Docket Docs. 2-3. The Examining Attorney denied the RFR on October 2, 2015. On October 6, 2015, the Board resumed proceedings, allowing Applicant 60 days to file its appeal brief.

SUMMARY OF EVIDENCE

A. Examining Attorney's Evidence

Office Action of September 29, 2014:

Registration No. 4,478,749

Final Office Action of June 2, 2014:

Registration No. 4,651,208

Registration No. 4,740,103

Screenshot, <http://geniuscard.net>

B. Applicant's Evidence

OAR of November 30, 2014:

Exhibit A: Applicant's Website, <https://www.tangocard.com/rewardsgenius> (accessed Mar. 10, 2015).

Exhibit B: Third-Party Registration Certificates for Reg. Nos.: 4674921 4665851 4668497 4636733 4645126 4640883 4612567 4513903 4587063 4587061 4587059 4576724 4570753 4384929 4480728 4477570 4436167 4526454 4448604 4282642 4257468 4467074 4217675 4302550 4114917 4153082 4073296 4411434 3977682 4029844 3893410 3876770 3554215 3221931 2869102 3694739 3654461 4242200 3849624 3888658 3871202 3730991 3838752 3615717 3618626 3590448 3734761 3422196 3609449 3803526 4215749 4118761 2182071 2208378 1718587 and 3940304.

Exhibit C: Third-Party Registration Certificates for Reg. Nos.: 4674921 4645126 4497890 4587063 4576724 4526454 4448604 4257468 4302550 3977682 4029844 3876770 3694739 3730991 3609449 4118761 and 2182071.

Exhibit D: Definition of "Rewards," Merriam-Webster's Dictionary, <http://www.merriam-webster.com/dictionary/rewards> (accessed Mar. 11, 2015).

Exhibit E: Definition of “Genius,” Merriam-Webster’s Dictionary, <http://www.merriam-webster.com/dictionary/genius> (accessed Mar. 11, 2015).

RFR of August 13, 2015

Exhibit F: Screenshots showing promotion and use of REWARDS GENIUS by Applicant.

ARGUMENT

The Examining Attorney has refused registration pursuant to Trademark Act 2(d), 15 U.S.C. § 1052(d), on the ground that Applicant's REWARDS GENIUS mark for is likely to be confused with the GENIUS mark in Registration No. 4,478,749. For the following reasons, Applicant respectfully disagrees with the Examining Attorney's findings and requests that the Board reverse the statutory refusal and allow publication of Applicant's mark.

I. Likelihood of Confusion Standard

Likelihood of confusion between two marks at the PTO is determined by a review of all of the relevant factors under the du Pont test. *In re E.I. du Pont de Nemours & Co.*, 47 F.2d 1357, 177 USPQ 563 (CCPA 1973). The two key considerations in ex parte likelihood of confusion analysis are the similarity of the marks and the similarity of the goods or services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). The similarity or dissimilarity of established, likely-to-continue trade channels; the conditions under which and buyers to whom sales are made, i.e., "impulse" vs. careful, sophisticated purchasing, *see* TMEP § 1207.01(d)(vii); and the number and nature of similar marks in use on similar goods, *see* TMEP § 1207.01(d)(iii), may also be relevant in an ex parte likelihood-of-confusion determination and must be considered if there is pertinent evidence in the record. TMEP § 1207.01. There is no mechanical test for determining likelihood of confusion and "each case must be decided on its own facts." *du Pont*, 476 F.2d at 1361, 177 USPQ at 567. In some cases, a determination that there is no likelihood of confusion may be appropriate, "even where the marks are similar and the goods/services are related, because these factors are outweighed by other factors, such as differences in the relevant trade channels of the goods/services, the

presence in the marketplace of a significant number of similar marks in use on similar goods/services, . . . or another established fact probative of the effect of use.” TMEP § 1207.01

Here, the services used in connection with the respective marks are different, are offered to different classes of consumers, and are offered to sophisticated consumers. In addition, the shared term GENIUS is relatively weak, highlighting the differences between the marks in appearance, sound, and meaning. Thus, the relevant factors weigh against a finding of likelihood of confusion.

Serial No. 86/314,468	Reg. No. 4,478,749
<p data-bbox="214 827 769 898">Rewards Genius</p>	<p data-bbox="976 827 1284 898">GENIUS</p>
<p data-bbox="186 987 773 1264"><i>Class 42:</i> Computer services, namely, providing a website featuring technology that allows enterprise business users of an online web interface to create and manage a rewards and recognition program, namely, account creation, account funding, catalog management, rewards delivery, and order management and history</p>	<p data-bbox="823 987 1424 1199"><i>Class 35:</i> Administration of a customer loyalty program which provides cash rewards and incentives for sale and usage of transaction cards, electronic accounts, wireless communication devices and other payment devices or loyalty programs</p>

II. The Services Are Different and Travel Through Different Channels of Trade to Different Classes of Consumers

There is no likelihood of confusion between Applicant’s REWARDS GENIUS mark and the cited GENIUS mark because the services at issue are not related or marketed in such a way that they would be encountered by the same persons in situations that would create the incorrect assumption that they originate from the same source. TMEP § 1207.01(a)(i) (citing *Shen Mfg. Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 73 USPQ2d 1350 (Fed. Cir. 2004) (clothing and kitchen textiles not related)). The likelihood of confusion must be shown to exist, not in a purchasing

process, but in a customer or purchaser. *Electronic Design & Sales v. Electronic Data Sys.*, 954 F.2d 713, 21 USPQ2d 1388, 1391 (Fed. Cir. 1992). The mere purchase of goods and services of both parties by the same institution does not, by itself, establish similarity of trade channels or overlap of customers. *Id.* When the relatedness of the goods and services is not evident, well known, or generally recognized, “something more” than the mere fact that the goods and services are used together must be shown. *In re St. Helena Hosp.*, 774 F.3d 747, 754, 113 USPQ2d 1082, 1087 (Fed. Cir. 2014) (finding that substantial evidence did not support relatedness of hospital-based residential weight and lifestyle program and printed materials dealing with physical activity and fitness).

A) Applicant’s services are not related to the cited services and are marketed to a different class of consumers.

Applicant’s mark is used solely in connection with computer services that allow enterprise business users of an online web interface to create and manage a rewards and recognition program. In contrast, registrant provides a customer loyalty program that offers cash rewards and incentives for usage of transaction cards by ordinary consumers. Applicant’s recitation of services makes clear that Applicant’s REWARDS GENIUS services are marketed to enterprises, not individual consumers. Furthermore, the “rewards and recognition program[s]” in Applicant’s identification of services refer to employee rewards programs instituted by managers to incentivize employee performance in the workplace. *See* OAR Ex. A. Thus, Applicant’s services enable business owners and managers to create employee rewards and recognition programs. Registrant’s services differ from Applicant’s because registration is the name of a customer loyalty program used by individual consumers. By contrast, Applicant’s REWARDS GENIUS services enable enterprises to create their own incentives programs to reward employees.

The difference in services is clear from the way the services are used.¹ A REWARDS GENIUS user is a business professional, sitting at her desk in the office, filling out financial and reward recipient information into Applicant's system. The information is submitted to Applicant for processing. Applicant's REWARDS GENIUS services use a customized API interface tailored to the needs to each client, who undergo training on how to use the system. This process can be seen through Applicant's training videos. *See* RFR at 2 (<https://vimeo.com/133705770> and <https://vimeo.com/100927596>). Registrant's services, on the other hand, are used by consumers at the point of sale. Applicant's customers enter data at a computer; registrant's customers swipe their card at Wal-Mart. *See* RFR at 3-5 (showing registrant's specimen of use). The processes are different in both their nature and in their complexity.

Not only are Applicant's REWARDS GENIUS consumers a different class from the consumers of the registrant, but these consumers have different levels of sophistication. REWARDS GENIUS users are solely enterprises, represented by business managers and owners. The purchase of Applicant's REWARDS GENIUS services is not an impulse, but one made carefully according to business needs by sophisticated purchasers. Applicant's services are customized for each client, requiring Applicant to work closely with the clients to understand their needs. Similarly, registrant promotes its loyalty cards as functioning "just like a MasterCard." *See* RFR at 3-5 (showing registrant's specimen of use). While credit cards may be used by ordinary, non-sophisticated consumers, the application processes and credit decisions necessary still require consumers to exercise a degree of care. Circumstances suggesting care in purchasing tend to minimize the likelihood of confusion. *See, e.g., In re N.A.D., Inc.*, 754 F.2d

¹ Note: Applicant is willing to further amend its identification of services to emphasize the differences in services. If the Examining Attorney believes and amendment would eliminate the need for a Section 2(d) refusal, please call counsel to discuss.

996, 999-1000, 224 USPQ 969, 971 (Fed. Cir. 1985) (concluding that, because only sophisticated purchasers exercising great care would purchase the relevant goods, there would be no likelihood of confusion merely because of the similarity between the marks NARCO and NARKOMED).

The channels of trade and classes of consumers are significantly different between Applicant's services and the cited services. Accordingly, the marks are unlikely to be encountered by the same consumers, which weighs heavily against a finding of likelihood of confusion. Moreover, the consumers who purchase the respective services both exercise a degree of care. Therefore, it is highly unlikely that there is any likelihood of confusion based on the services and consumers of the respective goods.

B) The Examining Attorney's evidence is not sufficient to show relatedness.

When the relatedness of goods and services is not evident, well known, or generally recognized, "something more" than the mere fact that they are used together must be shown. *In re St. Helena Hosp.*, 774 F.3d at 754, 113 USPQ2d at 1087 (finding that substantial evidence did not support relatedness of hospital-based residential weight and lifestyle program and printed materials dealing with physical activity and fitness). Evidence consisting of "a few registrations" covering both the services at issue, with nothing more, is insufficient to establish relatedness. TMEP § 1207.01(a)(ii); *In re Coors Brewing Co.*, 343 F.3d 1340, 1346, 68 USPQ2d 1059, 1063 (Fed. Cir. 2003).

The Examining Attorney did not provide any supporting evidence in the initial refusal. In the Final Office Action, the Examining Attorney submitted only two pieces of evidence, both in the form of third party registrations. Neither of these registrations are relevant in the present proceeding. Neither show both Applicant's services and registrant's services offered under the same make. Neither registration includes enterprise services. The first of these registrations, Reg.

No. 4,651,208, is for online retailer FAB, and includes “administration of a customer loyalty program” in Class 35 and “providing a website featuring technology that enables users to complete e-commerce transactions, [and] administer and manage incentive award programs” in Class 42. The second registration, Reg. No. 4,740,103, is for a website that advertises and distributes to consumers gift cards, discount cards, and customer loyalty cards. These services do not resemble Applicant’s services, which allow enterprise users to create and administer a rewards program for employees. These two registrations are not sufficient to establish relatedness between the Applicant’s service and the services offered in connection with the cited mark. The Examining Attorney has not met the burden of establishing relatedness or that the services exist in the same channels of trade. Accordingly, the refusal should be overturned and Applicant’s mark should proceed to publication.

III. The Shared Term GENIUS is Entitled to Only a Limited Scope of Protection

The cited registration is entitled to only a limited scope of protection because the term GENIUS is weak and diluted, as well as highly suggestive. Marks containing common elements are not likely to be confused if “the matter common to the marks is not likely to be perceived by purchasers as distinguishing source because it is merely descriptive or diluted.” TMEP § 1207.01(b)(iii); *see e.g., Shen Mfg. Co.*, 393 F.3d 1238, 73 USPQ2d 1350. The weaker a mark is, the closer an applicant’s mark can come without causing a likelihood of confusion and thereby invading what amounts to its comparatively narrower range of protection.” *Juice Generation, Inc. v. GS Enters. LLC*, 14-1853 (Fed. Cir. July 20, 2015).

Applicant submitted 56 live, use-based third party registrations on the Principal Register in Class 35 as evidence of the mark’s weakness. *See* OAR Ex. B &C. Seventeen of those registrations are for marketing and promotional services highly related to those in the cited

GENIUS registration. *See* OAR Ex. C. For example, Reg. No. 4,448,604, CREATIVELY GENIUS, offers “Advertising, promotion and marketing services; Referral based marketing services; advertising and marketing services by way of solicitation, customer service and providing marketing information.” LOYALTYGENIUS, Reg. No. 4,587,063, offers “Marketing services for retailers and suppliers,” and GENIUS LINK, Reg. No. 4,674,921, offers “Advisory and consultancy services in the field of digital advertising and marketing; providing online advertising and directory services featuring links to the websites of others.” Widespread third-party use of a term in PTO registrations may be offered as evidence of a term’s weakness and dilution with respect to a particular field and weighs in favor of narrowing the scope of its protection against subsequent applications. *Pizza Inn, Inc. v. Russo*, 221 USPQ 281, 283 (TTAB 1983); *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1722*, 396 F.3d 1369, 73 USPQ2d 1689, 1693 (Fed. Cir. 2005). The evidentiary value of third party registrations is “to show the sense in which . . . a mark is used in ordinary parlance. Third party registrations are relevant to prove that some segment of the composite marks which both contesting parties use has a normally understood and well recognized descriptive or suggestive meaning, leading to the conclusion that that segment is relatively weak.” *Juice Generation, Inc. v. GS Enters. LLC*, 14-1853 (Fed. Cir. July 20, 2015) (citing 2 *McCarthy on Trademarks and Unfair Competition* § 11:90 (4th ed. 2015)).

The Examining Attorney erred by ignoring this evidence and failing to give inadequate consideration to the strength or weakness of the GENIUS mark. The strength of a mark is not a binary factor, but instead “varies along a spectrum from very strong to very weak.” *In re Coors*, 343 F.3d at 1345. Applicant’s evidence demonstrates that the term GENIUS is widely used in marks associated with similar promotional and marketing services to those of the registrant.

Those services may not be identical, but the marks co-exist in the same field. The co-existence of these marks shows that GENIUS is highly suggestive for the registrant's services.

The weakness of the cited mark, as evidenced by the third-party registrations, entitles the cited mark to only a narrow scope of protection. This weakness highlights the differences between the marks, discussed below. Combined with the significant differences between the classes of consumers that encounter the marks and the differences in the marks themselves, the weakness of the cited mark weighs against the likelihood of confusion refusal.

IV. The Marks Differ in Appearance, Meaning, and Commercial Impression

Applicant's REWARD GENIUS mark and the cited GENIUS mark convey different commercial impressions because they are dissimilar. Under *du Pont*, the marks are compared for similarity or dissimilarity *in their entireties* as to appearance, sound, connotation, and commercial impression. *du Pont*, 476 F.2d at 1631, 177 USPQ at 567. Therefore, even though the term REWARDS is disclaimed in Applicant's mark, it cannot be ignored in the analysis of the dissimilarity of the marks. *See In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985) ("The technicality of a disclaimer in National's application to register its mark has no legal effect on the issue of likelihood of confusion. The public is unaware of what words have been disclaimed...").

There is not necessarily a likelihood of confusion merely because the marks share a common term. *In re Hearst Corp.*, 982 F.2d 493 (Fed. Cir. 1992). For example, marks containing common elements are not likely to be confused if the marks in their entireties convey significantly different commercial impressions. *See Shen Mfg. Co.*, 393 F.3d 1238 (Fed. Cir. 2004); see also *In re Sears, Roebuck and Co.*, 2 USPQ2d 1312 (TTAB 1987) (finding no confusion where CROSS-OVER for "bras" suggests physical construction of goods while

CROSSOVER for ladies sportswear suggests a multi-sport product); *In re British Bulldog, Ltd.*, 224 USPQ 854 (TTAB 1984) (finding no confusion where PLAYERS for shoes suggests an athletic endeavor while PLAYERS for men’s underwear suggests a sexual double-entendre). Additions or deletions to marks may be sufficient to avoid a likelihood of confusion if the marks in their entireties convey significantly different commercial impressions; or the matter common to the marks is not likely to be perceived by purchasers as distinguishing source because it is merely descriptive or diluted. *See, e.g., Citigroup Inc. v. Capital City Bank Group, Inc.*, 637 F.3d 1344, 1356, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011) (affirming TTAB’s holding that contemporaneous use of applicant’s CAPITAL CITY BANK marks for banking and financial services, and opposer’s CITIBANK marks for banking and financial services, is not likely cause confusion, based, in part, on findings that the phrase “City Bank” is frequently used in the banking industry and that ”CAPITAL” is the dominant element of applicant’s marks, which gives the marks a geographic connotation as well as a look and sound distinct from opposer’s marks); *Shen Mfg. Co.*, 393 F.3d at 1245, 73 USPQ2d at 1356-57.

Applicant’s REWARDS GENIUS mark is two words, while the cited mark is only one. Applicant’s mark begins with a different word with unshared sounds and letters, and Applicant’s mark is twice as long as the cited mark in both appearance and sound. Because consumers are more inclined to focus on the first word, prefix, or syllable in any trademark or service mark, the differences have a heightened significance. *See Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 1372, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005); *see also Presto Prods., Inc. v. Nice-Pak Prods., Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988). Furthermore, more weight must be accorded to the first, unshared term because the only shared term, GENIUS, is weak and diluted and only entitled to a limited scope of protection. *See*

Continental Grain Co. v. Central Soya Co., 69 F.3d 555 (Fed. Cir. 1995) (holding that “where the mark is a composite of a weak common term and a modifying phrase . . . the common portion of the composite mark is to be given less weight on the rationale that the public will look to other portions of the marks and will not be confused unless the other portions are similar”).

The additional unshared term, REWARDS, changes the meaning and connotation of Applicant’s mark, further underscoring the differences between the commercial impressions conveyed by the marks. The unshared term, REWARDS, modifies the shared term, GENIUS, giving context and meaning the otherwise diluted term. *See* OAR Ex. D & E (definitions of “rewards” and “genius”).

As a result of the marks’ differences in appearance, sound, connotation, and meaning each creates a different overall commercial impression. The cumulative effect of these differences and the weakness of the shared term weigh against a likelihood of confusion. Accordingly, the statutory refusal should be overturned.

CONCLUSION

Applicant’s mark is unlikely to be confused with the cited mark because of significant differences in the classes of consumers that will encounter the associated services and in the marks themselves. Because the cited mark is weak and diluted, and highly suggestive, more attention must be paid to the differences between the marks than the weak, shared elements. Moreover, the Examining Attorney has not met her evidentiary burden to refuse the mark under Section 2(d). There is no likelihood that consumers will be confused as to the source of the respective services. Accordingly, Applicant respectfully requests that the statutory refusal be overturned and that the Application be permitted to proceed to publication.

WHEREFORE, Applicant respectfully requests that the Board reverse the likelihood of confusion refusal and allow Applicant's mark to proceed to publication.

Dated this 4th day of December, 2015.

Respectfully submitted,



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