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

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| Proceeding | 86388395 |
| Applicant | Clarity Telecom, LLC |
| Applied for Mark | VAST |
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| Submission | Reply Brief |
| Attachments | VAST - Reply Brief.pdf(199153 bytes ) |
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| Date | 07/12/2016 |

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| Applicant: | Clarity Telecom, LLC | ) | |
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| Serial No.: | 86/388,395 | ) | Examining Attorney: |
| | | ) | Brin Anderson Desai |
| Filed: | September 8, 2014 | ) | |
| | | ) | Law Office 113 |
| Mark: | VAST | ) | |
| | | ) | |

**APPLICANT'S REPLY BRIEF**

Applicant respectfully disagrees with the position and arguments in the Examining Attorney's Response Brief filed June 22, 2016, and therefore submits this brief in reply.

First, the Examining Attorney inappropriately discounts Applicant's evidence of third-party registrations for VAST-formative marks, stating that these registrations are for "predominantly different" goods and services than those offered by Applicant and Registrant. However, the third-party registrations Applicant cited are for similar and closely-related goods and services in the broadband/telecommunications/computing market segment, such as "providing a search engine on the internet, intranets, extranets and/or other communication networks" (VAST, Reg. No. 3,680,715); "information technology consulting services" (VAST HUB, Reg. No. 4,703,595); "Consulting services in the field of computer platform design and operation" (DCVAST, Reg. No. 2,413,775); and "Computer accessories namely, computer cables, monitor cables, surge protectors, and computer switchboxes" (VASTER, Reg. No. 4175040). Applicant is not trying to argue that the goods and services covered by these and the other third-party registrations cited in its brief are identical to those offered by Applicant and Registrant; instead, Applicant is arguing that the term "vast" is seen on the Register to such a great degree in connection with goods and services in this market segment that any mark

containing "vast" must be confined to a very narrow scope of protection. *See Basic Vegetable Prod., Inc. v. General Foods Corp.*, 165 U.S.P.Q. 781, 784 (TTAB 1970) ("Highly suggestive, laudatory, and descriptive designations . . . because of their obvious meaning or suggestion and possible frequent employment in a particular trade as a part of trade designations, have been considered to fall within the catergory [sic] of "weak" marks, and the scope of protection afforded these marks has been limited to the substantially identical designation and/or to the subsequent use thereof on substantially similar goods.").

Further, the Examining Attorney discounts Applicant's significant evidence of third-party *use* of VAST-formative marks for similar and closely-related goods and services because "likelihood of confusion is determined based on the description of the services stated in the application and registrations and issue, not on extrinsic evidence of actual use." However, the case the Examining Attorney cites for this proposition, *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317 (Fed. Cir. 2014) is inapposite, as it is simply discussing the comparison of goods and services in an applicant's and registrant's respective application/registration. In fact, evidence of third-party use of similar marks on similar services *can* be relevant to establishing the weak nature of a mark that contains a term or terms that consumers have grown accustomed to seeing in connection with similar goods and services. TMEP 1207.01(d)(iii). Applicant's evidence shows that consumers are confronted in the marketplace with third-party marks such as VAST: ACADEMIC VIDEO ONLINE (for educational video services delivered online), VAST EDGE (for IT consulting), VAST INTERACTIVE CONSULTING (for digital marketing consulting) and VASTPLANET (for digital marketing and e-commerce web design). This evidence is relevant to establish that marks

containing the term "vast" are relatively weak in Applicant and Registrant's market segment, and that consumers will therefore not be confused between Applicant's and Registrant's marks.

Finally, the Examining Attorney disagrees with Applicant's argument that, because the Applicant's and Registrant's marks are most likely to be confronted by consumers on Applicant and Registrant's websites, where the marks will be presented in full and in context (and, in Registrant's case, in connection with a design element), consumers are not likely to be confused. The Examining Attorney takes this position because the parties' respective applications/registrations are not restricted to particular channels of trade, and therefore consumers may simply ask for the parties' respective services by name, without reference to the design element in Registrant's mark. However, even where the parties' respective applications/registrations are not restricted to particular trade channels, the real-world context of how their marks will be confronted by consumers can be highly relevant. *See, e.g.*, *In re Covalinski*, 113 U.S.P.Q.2d 1166, 1168 (TTAB 2014) ("Since these goods are clothing, consumers would be likely to encounter the mark in a retail setting on hang tags or neck labels. In that context, the visual impression of the mark is likely to be more important"; REDNECK RACEGIRL & Design found not confusingly similar to RACEGIRL for clothing items—neither the applicant's application nor the registrant's registration were confined to particular trade channels such as retail stores). That the parties' respective marks are most likely to be requested and confronted online is therefore relevant to the confusion analysis, and weighs in favor of a finding that confusion is not likely.

## CONCLUSION

For the reasons stated above and in Applicant's opening brief, Applicant respectfully requests the refusal to publish Applicant's mark be reversed.

Respectfully submitted this 12th day of July, 2016.

/Sam Gunn/

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