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

Proceeding	86651776
Applicant	BrandJourney Technologies, LLC
Applied for Mark	SOFTEQ
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Submission	Applicants Request for Remand and Amendment
Attachments	Remand Request for ID narrowing change 86651776 SOFTEQ.pdf(17845 bytes )
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Date	01/30/2017

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

In re: Application Serial No.: 86/651776  
For the Mark: SOFTEQ  
Filed: June 4, 2015  
Appeal Instituted: October 14, 2016  
Proceedings Resumed: December 19, 2016

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In re  
BrandJourney Technologies, LLC,  
Applicant.

Appeal of Serial No. 86/651776  
Attorney Docket Ref: 080874.000009

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**REQUEST FOR REMAND, SUSPENSION OF APPEAL PROCEEDINGS AND FOR  
RECONSIDERATION BY THE EXAMINING ATTORNEY**

**RECITATION OF FACTS AND PRESENTATION OF BASIS**

Applicant's trademark application pursuant to 15 U.S.C. § 1051, et seq, seeking to register in standard characters the mark "SOFTEQ" (the "Mark") has been made the subject of an Appeal. The Trademark Trial and Appeal Board (the "Board") has noted, by its Order of December 19, 2016, that the refusal by the examining attorney exists on the basis that the Mark was likely to be confused with prior Registration, the mark "SOFT-TEX", the subject of U.S. Registration No. 4,553,731 for "Clothing, namely gloves and inserts for gloves; headgear, namely, hats and caps, ski caps, headbands" based on a concept that originated at the first examination that the mark "SOFT-TEX" is similar to "SOFTEX", and "SOFTEX sounds like a plural version of SOFTEQ" and therefore, substantively the argument that the marks "SOFT-TEX" and "SOFTEQ" are similar; counter-argument has been presented the by Applicant that they are not so similar. Substantial evidence that clothing types are related to one another have been brought forward by the examining attorney; counter-argument has been presented by the Applicant that the goods of the Applicant and those of the Registrant are different and that the

conditions of the sale of each also allow for the determination that there is NOT a likelihood of confusion in consideration of the true nature of the purchase conditions for the Applicant's goods.

Each, the examining attorney and the Applicant, have cited to the same specific section of the TMEP, TMEP § 1207.01(a)(i), for support of their own analysis with the Applicant specifically noting that TMEP § 1207.01(a)(i) states:

Conversely, if the goods or services in question 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, then, even if the marks are identical, confusion is not likely. *See, e.g., Shen Manufacturing Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 73 USPQ2d 1350 (Fed. Cir. 2004) (cooking classes and kitchen textiles not related); *Local Trademarks, Inc. v. Handy Boys Inc.*, 16 USPQ2d 1156 (TTAB 1990) (LITTLE PLUMBER for liquid drain opener held not confusingly similar to LITTLE PLUMBER and design for advertising services, namely the formulation and preparation of advertising copy and literature in the plumbing field); *Quartz Radiation Corp. v. Comm/Scope Co.*, 1 USPQ2d 1668 (TTAB 1986) (QR for coaxial cable held not confusingly similar to QR for various products (e.g., lamps, tubes) related to the photocopying field).

TMEP § 1207.01(a)(i).

Applicant is of the opinion, and expects that the examining attorney may agree, which will dispense with the need for the time and effort of the Board and the need for this Appeal, that further narrowing of the Applicant's identification of its goods should obviate the need for the refusal. Should this modification of the identification of the goods resolve the outstanding issue, the continuation of the appeal need not occur; conversely, should that not resolve the outstanding issues, the appeal can readily be resumed.

Applicant hereby (a) requests the Board for a remand of the Application to the examining attorney to allow the examining attorney to evaluate and, if appropriate, accept the change in the identification of goods as well as (b) requests the Board for a suspension of the proceedings in the Appeal pending the Board's decision on the request for the remand and the examining

attorney's evaluation of the change in the identification of goods. In support thereof, the Applicant presents as follows:

### **RESPONSE TO REFUSAL**

The trademark examining attorney has stated a refusal for registration on the Principal Register because the Applicant's proposed registration for the mark conflicts with the existing Registration noted above. Applicant believes that a further modification in the identification of the goods, narrowing them significantly (principally to cover **ONLY underwear, briefs and thongs**), should allow for the examining attorney to withdraw the need for the refusal stated. Should this be true, this would resolve the sole remaining requirements, and, if this resolution should meet with the approval of the examining attorney, allow for this Application be deemed to be approved to be registered.

Applicant herein provides those modifications in the identification. In light of the denial of the request for reconsideration and the Applicant's present acts to amend the identification of goods accordingly, a remand will be appropriate to allow for an opportunity to obviate the reservations upon an approval to register the mark.

Applicant wishes to make amendment to the goods description in International Class 25 to be as follows:

underwear, briefs and thongs, all of the foregoing expressly exclusive of all other clothing in the form of gloves and inserts for gloves and of headgear, namely, hats and caps, ski caps, and headbands

Notably, this now makes clear that the Applicant is seeking registration for underwear articles -- worn under other clothing and hidden by such other clothing, while Registrant holds Registration only for gloves, inserts for gloves and headgear worn outside and plainly visible and principally outdoors.

Since (1) the appeal has just recently been reinstated, (2) the presentment of the amendment rises very directly from information already provided and discrete to the issue requirements of the examining attorney, (3) the remand will allow for the clarification of the application, and (4) in any event, the action to provide amendment will conserve the resources of the Board and fully illuminate any issues that might need to be returned in the appeal, in the unlikely event that such will be necessary, the Applicant believes that the good cause requirement for a remand upon the request of an Applicant (as is further set forth in TBMP § 1209) is well shown.

Applicant does note particularly that (as is further set forth in TBMP § 1205.01):

*Good cause will be found, for example, when the amendment is an attempt to comply with a requirement, such as an amendment to the identification of goods in response to a requirement for an acceptable identification, or when the amendment will obviate a ground for refusal, such as an amendment to the Supplemental Register or an amendment to assert a Section 2(f) claim (15 U.S.C. § 1052(f)) in order to avoid or overcome a refusal under Sections 2(e)(1), 2(e)(2) or 2(e)(4) of the Trademark Act, 15 U.S.C. §§ 1052(e)(1), 1052(e)(2) or 1052(e)(4).*

TBMP § 1205.01 (emphasis added by Applicant).

## CONCLUSION

Based upon the foregoing, the Applicant submits that it has provided an adequate basis for a remand, including good cause shown with the amendment herein provided, and the suspension of the appeal proceedings and requests that the Board take the action to have that remand be ordered and the appeal suspended for proceedings with the examining attorney upon any specific direction it believes is appropriate or warranted.

Applicant otherwise reserves argument and the right to request that the Trademark Trial and Appeal Board reject the determinations and findings of the examining attorney in the event that the foregoing amendments in identifications of goods does not allow this Application to be published in anticipation of eventual approval for Registration upon the requisite issuance of a

