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

Proceeding	86931396
Applicant	Capital Schools
Applied for Mark	THE AUBURN SCHOOL
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

Applicant: Capital Schools
US Serial No.: 86931396
Filing Date: March 7, 2016
Mark: The Auburn School
Examining Att.: SMITH, Rebecca A.
Law Office: 110
Docket Number: 20611-138356

APPEAL BRIEF

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

December 1, 2017

Gentlemen:

This appeal brief is being submitted within sixty days of the letter resuming proceedings mailed October 2, 2017.

The Examining Attorney's likelihood of confusion refusal under Trademark Act Section 2(d), 15 U.S.C. §1052(d), is in error and should be reversed for the following reasons.

The court in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973) listed the principal factors to be considered when determining whether there is a likelihood of confusion under Section 2(d). See *Trademark Manual of*

Examining Procedure (TMEP) §1207.01. The following two factors are key considerations in any likelihood of confusion determination:

- The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.
- The relatedness of the goods or services as described in the application and registration(s).

See, e.g., *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 1103, 192 USPQ 24, 29 (C.C.P.A. 1976); *In re Iolo Techs., LLC*, 95 USPQ2d 1498, 1499 (TTAB 2010); *In re Max Capital Grp. Ltd.*, 93 USPQ2d 1243, 1244 (TTAB 2010); *In re Thor Tech, Inc.*, 90 USPQ2d 1634, 1635 (TTAB 2009); *TMEP §1207.01*.

As to the similarity of or dissimilarity of the marks, the determination requires that the marks be viewed in their entireties as to appearance, sound, connotation and commercial impression. While determining whether there is a likelihood of confusion requires careful consideration of the nature of the common elements of the marks at issue, the overall commercial impression created by each mark must be considered. *TMEP §1207.01(b)(iii)*. 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. *TMEP §1207.01(b)(iii)*. See, also, *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).

Applicant's mark is not simply "AUBURN," but "The Auburn School."

As to the cited registration for the word mark AUBURN, it is submitted the wording "The Auburn School" in applicant's mark in its entirety has a different appearance, sound, connotation and commercial impression than the lone word AUBURN. This is especially true in view of the numerous third party uses of the word AUBURN in connection with educational services. A brief Internet search turns up a plethora of schools using, e.g., Auburn Elementary School, Auburn Middle School, Auburn Junior High, and Auburn High School throughout the U.S. These third party uses are relevant to show that the word Auburn is so commonly used that the public will look to other elements to distinguish the source of the services. See, *TMEP* §1207.01(d)(iii).

Therefore, the wording of the mark of the subject application and the cited mark AUBURN are different in appearance, sound, connotation and commercial impression.

As to the cited registration for the word mark AUBURN UNIVERSITY, the addition of the word UNIVERSITY in the cited registration further distinguishes from the wording "The Auburn School" in applicant's mark in terms of appearance, sound, connotation and commercial impression. In combination with the fact applicant's services are provided to children at the early elementary to high school level, it is submitted this AUBURN UNIVERSITY mark is irrelevant.

The designs in cited registration numbers 2,066,511 and 3,746,544 further distinguish these marks from applicant's mark in appearance, connotation and commercial impression.

Additionally, applicant's services are all directed to children at the early elementary to high school level with special needs. Such services are highly specialized and different than general "community education, public lectures and workshops, seminars, and conferences" sponsored by a university.

Because of the dissimilarity of applicant's mark and the marks in the cited registrations in their entireties as to appearance, sound, connotation and commercial impression and the differences between the services as described in the application and registrations, there is no likelihood of confusion, consistent with the original determination of the Examining Attorney. June 22, 2016 Examiner's Amendment/Priority Action TSDR p. 1.

Additionally, evidence of third-party use (the sixth du Pont factor – the "number and nature of similar marks in use on similar goods") establishes that mark AUBURN is relatively weak and entitled to only a narrow scope of protection. Here, the evidence shows that the consuming public is exposed to third-party use of similar in connection with similar services. This "is relevant to show that a mark is relatively weak and entitled to only a narrow scope of protection." *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772*, 396 F.3d 1369, 1373-74, 73 USPQ2d 1689, 1693 (Fed. Cir. 2005); *TMEP* §1207.01(d)(iii).

Applicant has submitted copies of just a sampling of marks containing the word "Auburn" used in connection with various educational related services. August 23, 2017 Request for Reconsideration after Final Action (Evidence Section) TSDR All Pages. This evidence establishes that the consuming public is exposed to numerous third-party uses of marks containing the word "Auburn" on similar services and shows that the word "Auburn" itself is relatively weak and entitled to only a narrow scope of protection for specific services.

Because of the dissimilarity of applicant's mark and the marks in the cited registrations in their entirety as to appearance, sound, connotation and commercial impression, the differences between the services as described in the application and registrations, and the relatively weak nature of the word "Auburn" itself, there is no likelihood of confusion, consistent with the original determination of the Examining Attorney.

Therefore, the likelihood of confusion refusal should be reversed.

Please charge any shortage in fees due in connection with the filing of this paper

to the Deposit Account of Fitch, Even, Tabin & Flannery LLP, Deposit Account No. 06-1135 (Docket No. 20611-138356-US) and please credit any excess fees to such Deposit Account.

Respectfully submitted,

FITCH, EVEN, TABIN & FLANNERY LLP

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