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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

APPLICANT'S REPLY BRIEF

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

February 6, 2018

Gentlemen:

This reply brief is being submitted within twenty days of the Examining Attorney's Appeal Brief mailed January 17, 2018.

The Examining Attorney cites a dictionary definition of a number of registrations owned by Auburn University to conclude that "The Auburn University is a famous and well known entity." As noted by the Examining Attorney,

Fame may be measured indirectly by the volume of sales of and advertising expenditures for the goods and services identified by the marks at issue, "the length of time those indicia of commercial awareness have been evident," widespread critical assessments, notice by independent sources of the products identified by the marks, and the general reputation of the products and services. Bose Corp. v. QSC Audio Products Inc., 63 USPQ2d at 1305-06, 1309. Because of the nature of the evidence required to establish the fame of a registered mark, the Board does not expect Trademark Examining Attorneys to submit evidence

as to the fame of the cited mark in an ex parte proceeding, and they do not usually do so. See *In re Thomas*, 79 USPQ2d 1021, 1027 n.11 (TTAB 2006). Rather, in an ex parte appeal the “fame of the mark” factor is normally treated as neutral because the record generally includes no evidence as to fame. See *id.*

Here, aside from a dictionary definition, no evidence has been presented as to “the volume of sales of and advertising expenditures for the goods and services identified by the marks at issue, ‘the length of time those indicia of commercial awareness have been evident,’ widespread critical assessments, notice by independent sources of the products identified by the marks, and the general reputation of the products and services.” Therefore, the alleged “fame of the mark” factor should be treated as neutral because the record includes no evidence as to fame.

The Examining Attorney has improperly dismissed applicant’s evidence of third-party use (the sixth du Pont factor – the “number and nature of similar marks in use on similar goods”) establishing that mark AUBURN is relatively weak and entitled to only a narrow scope of protection. The apparent reason for the dismissal of this evidence is that “[t]hese local schools are located in geographical places that include the term Auburn.” This allegation is incorrect.

While some of the included Internet evidence featuring the use of the term Auburn was from schools located in locales named “Auburn,” clearly a number of schools including the word AUBURN are not in in locales named “Auburn.” See, e.g., “Auburn Career Center” and “Auburn Career Center High School” located in Concord Twp., Ohio, “Auburn Elementary School” (part of Salem-Keizer Public Schools) located in Salem, Oregon, and Auburn Elementary School, Auburn Middle School and Auburn High School, all located in Riner, VA.

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.

For these reasons and the reasons in applicant's Appeal Brief, 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,

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