PTO Form 1960 (Rev 10/2011)
OMB No. 0651-0050 (Exp 09/20/2020)

Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	87233729
LAW OFFICE ASSIGNED	LAW OFFICE 123
MARK SECTION	
MARK	https://tmng-al.uspto.gov/resting2/api/img/87233729/large
LITERAL ELEMENT	BOHEMIAN
STANDARD CHARACTERS	YES
USPTO-GENERATED IMAGE	YES
MARK STATEMENT	The mark consists of standard characters, without claim to any particular font style, size or color.
ARGUMENT(S)	

The following is in response to the Final Office Action dated August 14, 2017 in connection with the above-identified trademark application.

Please amend the Identification of Goods in the application as follows:

Calendars and planners, namely, daily planners, including blank coloring designs of varying complexity on separate pages that are intended to be customized using coloring implements not included with the calendars and planners, in International Class 16.

REMARKS

Refusal Under §1052(d) – Likelihood of Confusion

In the Office Action, the Examiner has refused registration due a likelihood of confusion found by the Examining Attorney between the proposed mark and the marks MODERN BOHEMIAN & Design covered by US Trademark Registration No. 4,437,402 and MODERN BOHEMIAN covered by US Trademark Registration No. 4,441,176.

Applicant respectfully traverses the Examining Attorney's finding of a likelihood of confusion between the respective marks.

Initially, applicant again asserts that the differences in sound, appearance, connotation and commercial appearance of applicant's mark, BOHEMIAN, when compared to the marks of the cited registrations, MODERN BOHEMIAN and MODERN BOHEMIAN & Design, do not create a likelihood of confusion.

The registration for MODERN BOHEMIAN & Design includes a design for the mark that creates a significantly different appearance from the applicant's mark. In addition, both the registered marks include the term MODERN which is not present in applicant's mark. *Bass Pro Trademarks, L.L.C. v. Sportsman's Warehouse, Inc.*, 89 USPQ2d 1844, 1857-58 (TTAB 2008) (finding that, although cancellation petitioner's and respondent's marks were similar by virtue of the shared descriptive wording "SPORTSMAN'S WAREHOUSE," this similarity was outweighed by differences in terms of sound, appearance, connotation, and commercial impression created by other matter and stylization in the respective marks).

Additions or deletions to marks may be sufficient to avoid a likelihood of confusion if: (1) the marks in their entireties convey significantly different commercial impressions; or (2) the matter common to the marks is not likely to be perceived by purchasers as distinguishing source because it is merely descriptive or diluted.

In the present situation, the Examining Attorney has held in a prior Office Action that applicant's mark is merely descriptive of a characteristic of applicant's goods. Thus, the term BOHEMIAN alone is merely descriptive. This conclusion is confirmed with regard to the

Office Actions issued by the Examining Attorney with regard to two (2) other registered marks of the applicant, namely, US TM Reg. No. 5,308,585 for BOHEMIAN GARDEN and US TM Reg. No. 5,298,497 for BOHEMIAN DESIGNS. In both of these registrations the Examining Attorney initially rejected the marks as being merely descriptive of a characteristic of applicant's goods. As such, the term BOHEMIAN is a descriptive term with regard to the goods covered in the present application and thus cannot be considered the dominant portion of any mark including the term BOHEMIAN and used on the same or related goods.

As such, with regard to the citation of the MODERN BOHEMIAN marks as creating a likelihood of confusion with regard to this application, the comparison of the marks cannot end with the comparison of the term BOHEMIAN present in each of these marks. In essence, it is the term MODERN that is the dominant portion of the MODERN BOHEMIAN marks, otherwise there would have been issues between the MODERN BOHEMIAN marks and the BOHEMIAN GARDENS and BOHEMIAN DESIGNS marks registered by the applicant, and that dominant portion or term is entirely missing from applicant's mark. *See, e.g., Safer, Inc. v. OMS Invs., Inc.*, 94 USPQ2d 1031, 1044-45 (TTAB 2010) (holding DEER-B-GON for animal repellant used to repel deer, other ruminant animals, and rabbits, and DEER AWAY and DEER AWAY PROFESSIONAL for repellant for repelling deer, other big game, and rabbits, not likely to cause confusion, noting that "DEER" is descriptive as applied to the relevant goods and thus has no source-indicating significance).

This conclusion is also confirmed upon a review of the Office Actions issued with regard to the other registrations of the applicant in which those marks were not perceived to create a likelihood of confusion with the MODERN BOHEMIAN marks cited here by virtue of the use of the dominant terms GARDEN and DESIGNS in those mark, which provided a significant difference in sound, meaning and appearance from the registrations cited here.

Therefore, if the addition of a different dominant term is sufficient to negate a finding of a likelihood of confusion between two marks including the descriptive term BOHEMIAN with the other terms GARDEN and DESIGNS, it follows that the removal of a dominant term would also negate such a finding, as with the removal of the dominant term MODERN in the present case, the matter common to the marks (i.e., the term BOHEMIAN) is not likely to be perceived by purchasers as distinguishing source because it is merely descriptive or diluted.

Thus, the cited registered marks are not similar in sound, meaning and appearance to create a likelihood of confusion with applicant's mark.

Further, with this response applicant has amended the identification of goods to specify that the calendars and planners each include blank coloring designs of varying complexity on separate pages that are intended to be customized using coloring implements not included with the calendars and planners.

As such, it is also believed that the differences in the goods also do not merit a finding of a likelihood of confusion between the marks. More specifically, regarding the goods, according to §1207.01(a) (iii) of the TMEP, "The nature and scope of a party's goods or services must be determined on the basis of the goods or services recited in the application or registration. *See, e.g., Stone Lion Capital Partners, L.P. v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014)." When considering the goods covered by the present application and the cited registration, the goods are not closely related enough to support a finding of a likelihood of confusion.

In particular, the goods covered in the cited registrations, namely, journals, notebooks and stationery-type portfolios, are each intended for writing within the goods without any designs present within those goods intended for customization of the goods other than the writing to be placed within the goods of the registrations.

In contrast, the nature of the goods covered in the present application have the primary purpose of providing blank coloring designs in conjunction with the representation of the days of the respective months in the calendar and planner. These designs enable the consumer to customize the calendars and planners by coloring in the designs as they see fit in order to enhance the aesthetics of the calendars and/or planners with their individualized design interpretation. Therefore, while calendars and daily planners covered in the present application are found in Class 16 with the goods of the cited registrations, the nature and significance of this primary design aspect of the goods covered by the present application is more than sufficient to distinguish them from the notebooks and journals covered by the cited registrations to additionally merit against any finding of a likelihood of confusion.

CONCLUSION

In light of the above information and amendments, Applicant believes the application is now in proper form for publication, and such action is respectfully requested.

The Examining Attorney is invited to contact the undersigned by telephone if it would help expedite prosecution and publication of this application.

GOODS AND/OR SERVICES SECTION (current)	
INTERNATIONAL CLASS	016
DESCRIPTION	Calendars and Planners, namely, daily planners
FILING BASIS	Section 1(a)
FIRST USE ANYWHERE DATE	At least as early as 12/31/2015
FIRST USE IN COMMERCE DATE	At least as early as 12/31/2015
GOODS AND/OR SERVICES SECTION (proposed)	
INTERNATIONAL CLASS	016
TRACKED TEXT DESCRIPTION	
~~Calendars and Planners, namely, daily planners~~; Calendars and Planners, namely, daily planners, including blank coloring designs of varying complexity on separate pages that are intended to be customized using coloring implements not included with the calendars and planners	
FINAL DESCRIPTION	
Calendars and Planners, namely, daily planners, including blank coloring designs of varying complexity on separate pages that are intended to be customized using coloring implements not included with the calendars and planners	
FILING BASIS	Section 1(a)
FIRST USE ANYWHERE DATE	At least as early as 12/31/2015
FIRST USE IN COMMERCE DATE	At least as early as 12/31/2015
SIGNATURE SECTION	
RESPONSE SIGNATURE	/Mathew E. Corr/
SIGNATORY'S NAME	Mathew E. Corr
SIGNATORY'S POSITION	Attorney of Record, WI Bar Member
SIGNATORY'S PHONE NUMBER	414-225-9755
DATE SIGNED	02/14/2018
AUTHORIZED SIGNATORY	YES
CONCURRENT APPEAL NOTICE FILED	NO
FILING INFORMATION SECTION	
SUBMIT DATE	Wed Feb 14 15:10:11 EST 2018
TEAS STAMP	USPTO/RFR-XX.XXX.XXX.XXX- 20180214151011280997-8723 3729-510b974b9b82165b6d55 773063c5278ecb48fa3b151b8 9aec8cff40f1bf1e818-N/A-N /A-20180214150548806518

Request for Reconsideration after Final Action

To the Commissioner for Trademarks:

Application serial no. **87233729** BOHEMIAN(Standard Characters, see https://tmng-al.uspto.gov/resting2/api/img/87233729/large) has been

amended as follows:

ARGUMENT(S)
In response to the substantive refusal(s), please note the following:

The following is in response to the Final Office Action dated August 14, 2017 in connection with the above-identified trademark application.

Please amend the Identification of Goods in the application as follows:

Calendars and planners, namely, daily planners, including blank coloring designs of varying complexity on separate pages that are intended to be customized using coloring implements not included with the calendars and planners, in International Class 16.

REMARKS

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CONCLUSION

In light of the above information and amendments, Applicant believes the application is now in proper form for publication, and such action is respectfully requested.

The Examining Attorney is invited to contact the undersigned by telephone if it would help expedite prosecution and publication of this application.

CLASSIFICATION AND LISTING OF GOODS/SERVICES
Applicant proposes to amend the following class of goods/services in the application:
Current: Class 016 for Calendars and Planners, namely, daily planners
Original Filing Basis:
Filing Basis: Section 1(a), Use in Commerce: The applicant is using the mark in commerce, or the applicant's related company or licensee is using the mark in commerce, on or in connection with the identified goods and/or services. 15 U.S.C. Section 1051(a), as amended. The mark was first used at least as early as 12/31/2015 and first used in commerce at least as early as 12/31/2015 , and is now in use in such commerce.

Proposed:
Tracked Text Description: ~~Calendars and Planners, namely, daily planners~~; Calendars and Planners, namely, daily planners, including blank coloring designs of varying complexity on separate pages that are intended to be customized using coloring implements not included with the calendars and planners

Class 016 for Calendars and Planners, namely, daily planners, including blank coloring designs of varying complexity on separate pages that are intended to be customized using coloring implements not included with the calendars and planners
Filing Basis: Section 1(a), Use in Commerce: The applicant is using the mark in commerce, or the applicant's related company or licensee is using the mark in commerce, on or in connection with the identified goods and/or services. 15 U.S.C. Section 1051(a), as amended. The mark was first used at least as early as 12/31/2015 and first used in commerce at least as early as 12/31/2015 , and is now in use in such commerce.
SIGNATURE(S)
Request for Reconsideration Signature

Signature: /Mathew E. Corr/ Date: 02/14/2018
Signatory's Name: Mathew E. Corr
Signatory's Position: Attorney of Record, WI Bar Member

Signatory's Phone Number: 414-225-9755

The signatory has confirmed that he/she is an attorney who is a member in good standing of the bar of the highest court of a U.S. state, which includes the District of Columbia, Puerto Rico, and other federal territories and possessions; and he/she is currently the owner's/holder's attorney or an associate thereof; and to the best of his/her knowledge, if prior to his/her appointment another U.S. attorney or a Canadian attorney/agent not currently associated with his/her company/firm previously represented the owner/holder in this matter: (1) the owner/holder has filed or is concurrently filing a signed revocation of or substitute power of attorney with the USPTO; (2) the USPTO has granted the request of the prior representative to withdraw; (3) the owner/holder has filed a power of attorney appointing him/her in this matter; or (4) the owner's/holder's appointed U.S. attorney or Canadian attorney/agent has filed a power of attorney appointing him/her as an associate attorney in this matter.

The applicant is not filing a Notice of Appeal in conjunction with this Request for Reconsideration.

Serial Number: 87233729
Internet Transmission Date: Wed Feb 14 15:10:11 EST 2018
TEAS Stamp: USPTO/RFR-XX.XXX.XXX.XXX-201802141510112
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N/A-N/A-20180214150548806518