

From: Paradowelai, Benji

Sent: 3/18/2019 8:14:00 PM

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Subject: U.S. TRADEMARK APPLICATION NO. 87652101 - GRASSHOPPER NATIONAL BANK - N/A -  
Request for Reconsideration Denied - Return to TTAB

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Attachment Information:

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Files: 87652101.doc

**UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)  
OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION**

**U.S. APPLICATION SERIAL NO.** 87652101

**MARK:** GRASSHOPPER NATIONAL BANK



**CORRESPONDENT ADDRESS:**

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**GENERAL TRADEMARK INFORMATION:**

<http://www.uspto.gov/trademarks/index.jsp>

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**APPLICANT:** Carpenter New York Development, LLC

**CORRESPONDENT'S REFERENCE/DOCKET NO:**

N/A

**CORRESPONDENT E-MAIL ADDRESS:**

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**REQUEST FOR RECONSIDERATION DENIED**

**ISSUE/MAILING DATE:** 3/18/2019

The trademark examining attorney has carefully reviewed applicant's request for reconsideration and is denying the request for the reasons stated below. See 37 C.F.R. §2.63(b)(3); TMEP §§715.03(a)(ii)(B), 715.04(a). The following requirement(s) and/or refusal(s) made final in the Office action dated Aug. 22, 2018 are maintained and continue to be final: Section 2(d) refusal as to Registration Nos. 4594031 and 4769250. See TMEP §§715.03(a)(ii)(B), 715.04(a).

In the present case, applicant's request has not resolved all the outstanding issue(s), nor does it raise a new issue or provide any new or compelling evidence with regard to the outstanding issue(s) in the final Office action. In addition, applicant's analysis and arguments are not persuasive nor do they shed new light on the issues. Accordingly, the request is **DENIED**.

If applicant has already filed a timely notice of appeal with the Trademark Trial and Appeal Board, the Board will be notified to resume the appeal. See TMEP §715.04(a).

If no appeal has been filed and time remains in the six-month response period to the final Office action, applicant has the remainder of the response period to (1) comply with and/or overcome any outstanding final requirement(s) and/or refusal(s), and/or (2) file a notice of appeal to the Board. TMEP §715.03(a)(ii)(B); see 37 C.F.R. §2.63(b)(1)-(3). The filing of a request for reconsideration does not stay or extend the time for filing an appeal. 37 C.F.R. §2.63(b)(3); see TMEP §§715.03, 715.03(a)(ii)(B), (c).

Applicant argues that since the registrant's mark CHAPULIN registered without the accent, it does not mean grasshopper. However CHAPULIN without the accent is commonly used in the US to mean grasshopper. See attachments to the Aug. 22, 2018 Final Office action. Second as the registrant's CHAPULIN mark is in standard character, it can be displayed in any format wherein the "I" in "CHAPULIN" forms or contains an accent. Mark in standard character form is not limited to the depiction thereof in any special form. See *Squirtco v. Tomy Corp.*, 697 F.2d 1038, 216 USPQ 937, 939 (Fed. Cir. 1983); TMEP §1207.01(c)(iii). Third, the registrant's specimen and usage confirms the grasshopper impression of the mark. See registrant's statement of use attached to the Jan. 31, 2018 Office action.

Applicant argues that registrant's software for financial purposes is extremely broad and indefinite. Applicant further argues that the registrant's software is only limited to services related to sending money from the U.S. to countries outside of the U.S., such as Mexico, Central America and South America, or related to users having their paychecks and Federal Benefits directly deposited to a prepaid card. However, as indicated in the previous office action since registrant's software is identified broadly and has no restriction or limitation as to the purpose or function, the software is presumed to encompass all goods of that type, including the same type of software as applicant, e.g., banking, account management, deposits, remote access bill payment, loan application, loan maintenance, and financial reporting by corporate venture capital customers. See, e.g., *In re Linkvest S.A.*, 24 USPQ2d 1716 (TTAB 1992) (noting that, where registrant's goods are broadly identified as "computer programs recorded on magnetic disks," without any limitation as to the kind of programs or the field of use, it must be assumed that registrant's goods encompass all such computer programs, including computer programs of the type offered by applicant, that they travel in the same channels of trade normal for such goods, and that they are available to all classes of prospective purchasers of those goods).

In addition, as to registrant's credit and debit card services, these services are closely related as those offering venture banking services also provide credit and debit card services. See websites of record from Square 1 Bank <https://www.square1bank.com>, First Republic <https://www.firstrepublic.com>, Silicon Valley Bank <https://www.svb.com>,

Bridge Bank - Western Alliance Bancorporation <https://www.westernalliancebancorporation.com>, City National Bank <https://www.cnb.com>.

While applicant limited its consumers to the venture capital customer, registrant did not. If the services of the parties have no restrictions as to nature, type, channels of trade, or classes of purchasers and are "presumed to travel in the same channels of trade to the same class of purchasers." *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (quoting *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1268, 62 USPQ2d 1001, 1005 (Fed. Cir. 2002)).

Applicant argues that there is no likelihood of confusion since the office allowed for publication applicant's "insect design mark" in Serial No. 87/652,113 and registrant did not oppose. However, the impression of that mark is different from the instant mark. The mark description indicates that it is an "abstract figure of an insect."

/Benji Paradewelai/

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