

ESTTA Tracking number: **ESTTA1030286**

Filing date: **01/21/2020**

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

Proceeding	87707617
Applicant	T3 PRODUCTIONS, LLC
Applied for Mark	PORTAL
Correspondence Address	KEVIN M HAYES KLARQUIST SPARKMAN, LLP 121 SW SALMON STREET ONE WORLD TRADE CENTER, SUITE 1600 PORTLAND, OR 97204 UNITED STATES ptotmdocket@klarquist.com, kevin.hayes@klarquist.com 503-595-5300
Submission	Appeal Brief
Attachments	Appeal Brief - App. SN 87707617 for PORTAL.pdf(304064 bytes)
Filer's Name	Kevin M. Hayes
Filer's email	ptotmdocket@klarquist.com, kevin.hayes@klarquist.com
Signature	/Kevin M. Hayes/
Date	01/21/2020

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

Serial No. 87/707,617
Mark: PORTAL
Applicant: T3 Productions, LLC
Class: 41
Examining Attorney: Krystina E. Osgood
Law Office 121

APPLICANT'S APPEAL BRIEF

TABLE OF CONTENTS

	<u>Page</u>
TABLE OF AUTHORITIES	ii
INTRODUCTION	1
PROSECUTION HISTORY	1
SUMMARY OF EVIDENCE	3
ARGUMENT	4
CONCLUSION	10

TABLE OF AUTHORITIES

Page

Cases

Cases

Checkpoint Sys., Inc. v. Check Point Software Tech., Inc., 269 F.3d 270 (3d Cir. 2001) 8

Estee Lauder, Inc. v. The Gap, Inc., 42 U.S.P.Q.2d 1228 (2d Cir. 1997) 4

Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 1103, 192 U.S.P.Q. 24, 29
(C.C.P.A. 1976) 5

Freedom Sas. & Loan Ass’n v. Way, 757 F.2d 1176, 1183 (11th Cir. 1985) 6

Homeowners Grp. v. Home Mktg., 931 F.2d 1100, 1111 (6th Cir. 1991) 8

IDV N. Am., Inc. v. S & M Brands, Inc., 26 F.Supp. 2d 815 (E.D. Va. 1998)..... 6

In re Bed & Breakfast Registry, 791 F.2d 157 (Fed. Cir. 1986)..... 6

In re British Bulldog, Ltd., 224 U.S.P.Q. 854 (T.T.A.B. 1984)..... 6

In re E.I. DuPont de Nemours & Co., 476 F.2d 5, 8

In re Mars, Inc., 741 F.2d 395 (Fed. Cir. 1984) 5

Modular Cinemas of Am., Inc. v. Mini Cinemas Corp., 348 F. Supp. 578 (S.D.N.Y. 1972) 6

Kiekhaefer Corp. v. Willys-Overland Motors, Inc., 236 F.2d 423 (C.C.P.A. 1956)..... 5

Other Authorities

J. McCarthy, *Trademarks and Unfair Competition*, Section 23:3 5

I. INTRODUCTION

The Examiner in this matter has alleged that Applicant's mark PORTAL for "Entertainment services, namely, escape rooms attraction" in Class 41, if allowed, would likely be confused with Registration No. 5,397,743 for the mark PORTAL identifying "providing facilities for virtual reality gaming and entertainment experiences in the form of virtual reality arcades" in Class 41.

Applicant disagrees that its PORTAL mark, identifying escape room attractions, is likely to be confused with the mark of Registration No. 5,397,743 for the service of providing facilities, which facilities are for virtual reality gaming. There are many reasons why a consumer would not likely believe that the source of the two different services is the same.

Due to the differences in the services and the high sophistication level of consumer sets with respect to these services, Applicant disagrees that there is a likelihood of confusion.

Accordingly, the Board should reverse the refusal of Applicant's mark and direct that Applicant's application be published for opposition.

II. PROSECUTION HISTORY

On December 4, 2017, Applicant filed its application for PORTAL identifying the services "Entertainment services, namely escape rooms" in Class 41.

On March 20, 2018, the Patent and Trademark Office issued an Office action refusing Applicant's applied-for mark alleging a likelihood of confusion with U.S. Registration No. 5,397,743 for the mark PORTAL for "providing facilities for virtual reality gaming and entertainment experiences in the form of virtual reality arcades" in Class 41. The Examiner also cited prior-filed potentially conflicting U.S. Application Serial No. 87654998 for the mark WORMHOLE PORTAL covering "Entertainment services in the nature of an amusement park

attraction, namely, a themed area; Entertainment services in the nature of providing interactive entertainment facilities for live action multi-track adventure missions attractions; Entertainment services, namely, providing an amusement park ride simulating travel through a wormhole in space; Providing amusement facilities” in Class 41 as a possible bar should the application mature into a registration. The Examiner also requested that Applicant amend its services to “entertainment services, namely escape room attractions” in Class 41.

On September 20, 2018, Applicant filed a response rebutting the Patent and Trademark Office’s allegation that Applicant’s mark was likely to cause confusion with U.S. Registration No. 5,397,743 for the mark PORTAL. Applicant also submitted arguments that a likelihood of confusion did not exist with the cited prior-filed potentially conflicting U.S. Application Serial No. 87654998 for the mark WORMHOLE PORTAL. Applicant also amended its services to read “entertainment services, namely escape room attraction” in Class 41.

On October 11, 2018, the Patent and Trademark Office issued a suspension notice, suspending Applicant’s application pending the outcome of the U.S. Application Serial No. 87654998 for the mark WORMHOLE PORTAL. The Examiner also maintained the likelihood of confusion allegation with respect to U.S. Registration No. 5,397,743 for the mark PORTAL.

On March 21, 2019, Applicant filed a response to suspension inquiry requesting that Applicant’s application resume prosecution upon the registration of the cited prior filed U.S. Application Serial No. 87654998 for the mark WORMHOLE PORTAL, which had matured into U.S. Trademark Registration No. 5,618,855.

On April 19, 2019, the Patent and Trademark Office issued a final office action withdrawing the possible refusal of Applicant’s mark based on U.S. Application Serial No. 87654998, now U.S. Registration No. 5618855 for WORMHOLD PORTAL, entering in the

amendment to Applicant's services and making the refusal under Trademark Act Section 2(d) with respect to U.S. Registration No. 5,397,743 final.

On October 21, 2019, Applicant filed a request for reconsideration against the final refusal under Trademark Act Section 2(d) with respect to U.S. Registration No. 5,397,743. Applicant also filed an appeal of the final rejection with the Trademark Trial and Appeal Board.

On October 21, 2019, the Trademark Trial and Appeal Board instituted Applicant's appeal and suspended the appeal to remand the application back to the Examining Attorney to consider the request for reconsideration.

On November 13, 2019, Applicant's request for reconsideration was denied.

On November 20, 2019, the Trademark Trial and Appeal Board resumed the appeal and set January 19, 2020 as the date for Applicant's Appeal Brief, making this appeal brief due January 21, 2020, under 37 C.F.R. § 2.196.

III. SUMMARY OF EVIDENCE

A. Evidence Offered by Examining Attorney

1. Office Action of March 20, 2018

- screenshots of webpages from <https://www.rushhourgaming.com>
- screenshots of webpages from <https://www.escaperoomnj.com>
- screenshots of webpages from <https://www.urbanenigmas.com>

2. Office Action of April 19, 2019

- screenshots of webpages from <https://www.escaperealitysarasota.com>
- screenshots of webpages from <https://www.myescapemission.com>
- screenshots of webpages from <https://www.lakegenevaclueroom.com>
- screenshots of webpages from <https://www.escapechallengestl.com>
- screenshots of webpages from <https://www.xtremeactionpark.com>
- screenshots of webpages from <https://www.zenithfun.com>

3. Reconsideration Letter dated November 13, 2019

- screenshots of webpages from <https://www.vrzonedc.com>

- screenshots of webpages from <https://www.warriorvrarcade.lpages.co/home>
- screenshots of webpages from <https://www.vrtechlounge.com>
- screenshots of webpages from <https://www.questledge.com>
- screenshots of webpages from <https://www.orlando.vrterritory.zone/portfolio/escape-room-vr/>
- screenshots of webpages from www.xperiencekelowna.com/exit-escape-room
- screenshots of webpages from <https://www.mayzegames.ca/>

B. Evidence Offered by Applicant

1. Response to Office Action of September 20, 2018
 - None
2. Request for Reconsideration dated October 21, 2019
 - Certificate of Registration No. 5746440 (Exhibit 1)
 - Certificate of Registration No. 5646195 (Exhibit 2)
 - Certificate of Registration No. 5618855 (Exhibit 3)
 - Certificate of Registration No. 4980866 (Exhibit 4)
 - Certificate of Registration No. 3913390 (Exhibit 5)
 - screenshots of webpages from <https://www.portalrv.us> (Exhibit 6)
 - Declaration of Heidi Van Baalen in support of screenshots obtained from <https://www.portalrv.us>

III. ARGUMENT

Applicant disagrees that its mark, identifying escape room attractions, is likely to be confused with the mark of Registration No. 5,397,743 for the service of providing facilities, which facilities are for virtual reality gaming. There are many reasons why a consumer would not likely believe that the source of the two different services is the same.

At the outset, it must be borne in mind that under the Trademark Act, a refusal to register based upon a likelihood of confusion requires that confusion as to the source of the goods or services not merely be possible, but likely. The Second Circuit has stated that, "likelihood of confusion means a probability of confusion; it is not sufficient if confusion is merely 'possible.'" *Estee Lauder, Inc. v. The Gap, Inc.*, 42 U.S.P.Q.2d 1228 (2d Cir. 1997) (internal quotations

omitted) quoting J. McCarthy, *Trademarks and Unfair Competition*, Section 23:3)). A likelihood of confusion is based on the cumulative effect of the differences in the goods or services at issue, and a consideration of the differences in the marks themselves. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 1103, 192 U.S.P.Q. 24, 29 (C.C.P.A. 1976). No single factor is dispositive. *In re E.I. DuPont de Nemours & Co.*, 476 F.2d 1357, 1362, 177 U.S.P.Q. 563 (C.C.P.A. 1973).

It is also well established that even identical marks for arguably similar goods or services will not necessarily create a likelihood of confusion. *See, e.g., In re Mars, Inc.*, 741 F.2d 395 (Fed. Cir. 1984) (finding CANYON for fruit not likely to be confused with CANYON for candy bars); *Kiekhaefer Corp. v. Willys-Overland Motors, Inc.*, 236 F.2d 423 (C.C.P.A. 1956) (holding HURRICANE for outboard motors not likely to be confused with same mark for auto engines); *IDV N. Am., Inc. v. S & M Brands, Inc.*, 26 F.Supp. 2d 815 (E.D. Va. 1998) (holding BAILEY'S for liqueurs not likely to be confused with BAILEY'S for cigarettes); *Modular Cinemas of Am., Inc. v. Mini Cinemas Corp.*, 348 F. Supp. 578 (S.D.N.Y. 1972) (holding MINI CINEMA for family movie theaters not confusingly similar to MINI CINEMA for an erotic movie theater); *In re British Bulldog, Ltd.*, 224 U.S.P.Q. 854 (T.T.A.B. 1984) (finding PLAYERS for shoes not confusingly similar to same mark for men's underwear); *see also Freedom Sas. & Loan Ass'n v. Way*, 757 F.2d 1176, 1183 (11th Cir. 1985) (holding FREEDOM REALTY not confusingly similar to FREEDOM SAVINGS AND LOAN); *see also In re Bed & Breakfast Registry*, 791 F.2d 157 (Fed. Cir. 1986) (finding BED & BREAKFAST REGISTRY for making lodging reservations for others not likely to be confused with BED & BREAKFAST INTERNATIONAL for room booking services).

In this case, as set forth below, the services of the applicant and the registrant are of such a distinct nature and marketed to consumers exercising a high degree of care with regard to such services that it is unlikely consumers will be confused as to the source of the respective services. They are not even as close as the goods/services in the cases noted above where no likelihood of confusion was found.

Moreover, there are several other PORTAL formative marks registered by different owners for entertainment services in class 41, including PORTAL POINT for virtual reality services (see chart below). Consumers exposed to these PORTAL formative marks for closer services to the Cited Registration, including one for virtually identical services, are not likely to be confused by Applicant’s mark for much different services (as noted in the evidence of record submitted as Exhibits 1-5 with the Request for Reconsideration).

Exhibit	Mark	Goods	Reg. No.
1	PORTAL POINT	Virtual reality game services provided on-line from a computer network	5746440
2	PORTAL QUEST	Entertainment services, namely, non-downloadable computer games ...	5646195
3	WORMHOLE PORTAL	Entertainment services in the nature of providing interactive entertainment facilities for live action multi-track adventure missions attractions	5618855
4	FINAL FANTASY PORTAL APP	Providing on-line computer games	4980866
5	WARPPORTAL	Entertainment services, namely, providing temporary use of non-downloadable interactive games	3913390

Bearing in mind that the services are significantly different and there are other closer registrations that constrain the scope of the Cited Registration, there is further evidence that the source of the services of the Cited Registration is not likely to be confused with Applicant.

According to the website of the owner of the Cited Registration, as shown in the screen captures copied as Exhibit 6 of the record to the Declaration of Heidi van Baalen, the Registrant, Hypershow Ltd. DBA Hypershow, "provide[s] the highest-quality VR experiences in a **sophisticated**, but family-friendly atmosphere. You won't hear a cacophony of blaring arcade sounds here. Instead, players experience VR in **individual booths wearing headphones** while others relax in our lounge area enjoying snacks and drinks. High definition monitors throughout the space show what each player is experiencing." (Emphasis added). (As also shown in Exhibit 6 of the record, the Services of the Cited Registration are provided in booths and "[a]ll booths hold **one person** at a time.") (Emphasis added).

This shows that the services of the Cited Registration are "sophisticated" and enjoyed alone. The Registrant of the Cited Registration provides virtual reality booths for individuals and each player needs to book a separate booth to participate, so the players are never together in one booth. This is not a team or group activity.

In determining a likelihood of confusion, courts must examine "[t]he conditions under which, and buyers to whom, sales are made, i.e. 'impulse' vs. careful, sophisticated purchasing." *In re E.I. Du Pont Nemours*, 476 F.2d at 1361. Where consumers are likely to exercise attention and care in selecting the provider of the goods or services sought, there is less likelihood of confusion. *See Checkpoint Sys., Inc. v. Check Point Software Tech., Inc.*, 269 F.3d 270 (3d Cir. 2001) (noting that purchasers who "take care in making purchasing decisions and are not likely to be confused by the parties' similar marks"); *Homeowners Grp. v. Home Mktg.*, 931 F.2d 1100, 1111 (6th Cir. 1991) (no likelihood of confusion between HMS & Design for marketing and advertising services for real estate brokers and HMS & Design for real estate broker services because "selling one's property is likely the most significant commercial transaction ever

undertaken for most people, [Defendant's] customers are likely to carefully select the provider of sales services"). In this case, the Registrant of the Cited Registration calls out the sophistication of its services. This is strong evidence that consumers are indeed sophisticated and thus would not be confused between the services of the Cited Registration and Applicant's different services.

With further regard to the differences in the services, Applicant's services are escape rooms that are live-action team-based games where multiple players discover clues, solve puzzles, and accomplish tasks in one or more rooms in order to accomplish a specific goal (usually escaping from the room) in a limited amount of time. As players must work as a team, Applicant's services can also be used for hands-on team building services for companies. As such, Applicant's customers can include groups and local businesses who purchase admission for employees as team building activities. Applicant's services are not for individual players alone (as the services of the Cited Registration explicitly are, as also evidenced by Registrant's description of its services) – it is a team activity involving more than one person, in the same room, accomplishing a common goal – solving puzzles to escape the room.

A VR arcade is a video game arcade in the simplest of terms, except customers are wearing a VR headset. Also, as noted by the Registrant of the Cited Registration, only one person can participate at a time (see Exhibit 6 of the record). In addition, VR arcades have a high-tech experience associated with them.

By contrast, Applicant is not selling a high-tech, individual novelty to its customers. Rather, Applicant is selling a hands-on, team experience to its customers. The experience is escape, both literal and metaphorical. A group of friends/colleagues/strangers are "trapped" in some kind of space together and must collaboratively puzzle through a series of challenges to win their freedom, all while the clock is ticking. The experience is hands-on and

tactile. Usually, the escape room offers some kind of story to help explain why the players are solving puzzles in a room with a countdown clock. This is the diametric opposite of what the Registrant of the Cited Registration provides.

Accordingly, this sophisticated potential customer of the services in the Cited Registration, would not be confused if he/she were to come across the mark PORTAL used in connection with virtual reality arcades and escape rooms. Likewise, applicant's potential customer, when looking for a themed room filled with clues and puzzles for a group of friends or colleagues, would not be confused if he/she were to come across VR arcade services under the mark PORTAL.

Therefore, the customer is not likely to be confused as to the source of the services offered under the respective marks.

As set forth above, the Cited Registration is for services concerning the provision of facilities used for virtual reality gaming. Therefore, Registrant's provision of facilities services are specific to virtual reality games. This is made clear from Registrant's own website, as well as its registration. Since trademark rights are based on use of a mark in connection with specific services, the Registrant's rights in its mark should not extend significantly beyond those services on which it is using the mark.

Applicant's business is escape rooms, not arcades. Applicant is not involved in VR reality arcades. Applicant's services are not similar to those of the Registrant. Therefore, Applicant's use of PORTAL in connection with the escape rooms is not likely to be confused with Registrant's use of its mark on its VR reality gaming services (which point is buttressed by the number of coexisting PORTAL formative registrations noted above in Class 41).

In light of the foregoing discussion and considerations, the Applicant respectfully submits

that maintaining the Section 2(d) refusal in this instance would serve to establish a monopoly for the Registrant in an overly broad class of services. The result of the Examiner's 2(d) refusal to register the Applicant's mark is to extend protection of Registrant's mark over all entertainment services. If the Registrant wanted to seek protection for escape room services, such would have been included in the registration. To extend protection of Registrant's mark to include all items related to entertainment services improperly expands the scope of protection afforded by the Lanham Act.

IV. CONCLUSION

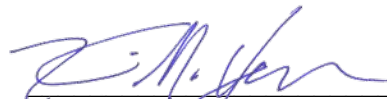
Applicant's PORTAL mark for its escape room attractions is not likely to cause confusion with the virtual reality arcades of the Cited Registration.

Therefore, given the differences between the services on which the parties' marks are used, the sophistication of the potential customers of the parties, and the number of coexisting PORTAL formative registrations, it certainly cannot be said that confusion is any more than merely "possible." In view of that, the higher and required threshold of "probability" is not reached in this case. Applicant therefore submits that consumer confusion is not likely, and respectfully requests that the application be approved for publication.

Respectfully submitted,

KLARQUIST SPARKMAN, LLP

By



Kevin M. Hayes, OSB #012801
KLARQUIST SPARKMAN, LLP
One World Trade Center, Suite 1600
121 S.W. Salmon Street
Portland, Oregon 97204
Telephone: (503) 595-5300

Fax: (503) 595-5301

Of Attorneys for Applicant
T3 Productions, LLC