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

Proceeding	88380382
Applicant	Royal Realty Corp.
Applied for Mark	LIVE ON POINT
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Submission	MOTION FOR LEAVE TO FILE AMENDED APPEAL BRIEF
Attachments	201014 Motion Appeal Brief LIVE ON POINT.pdf(360415 bytes) 201014 Appeal Brief LIVE ON POINT.pdf(827951 bytes)
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Date	10/14/2020

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

In re Application of: Royal Realty Corp.	Examining Attorney:
Serial No.: 88380382	Jules J. Dean
Filing Date: April 10, 2019	Law Office 120
Mark: LIVE ON POINT	

MOTION FOR LEAVE TO FILE AMENDED APPEAL BRIEF

Applicant, Royal Realty Corp. (“Applicant”), through its undersigned counsel, files this motion for leave to file an amended Appeal Brief and states as follows:

1. Applicant appealed to the Board a final refusal to register its mark LIVE ON POINT as shown in Ser. No. 88380382.
2. Applicant’s deadline to file its Appeal Brief was set for October 11, 2020, which was extended until October 13 due to the fact October 11 was a Sunday and October 12 was a Federal Holiday.
3. Applicant timely filed its Appeal Brief on October 13, 2020 (“Filed Brief”).
4. Applicant is, however, seeking leave to file the attached Amended Appeal Brief (“Amended Brief”) to correct typographical, wording, stylistic and citation errors in the Filed Brief.
5. Specifically, due to the COVID-19 outbreak and Applicant’s counsel’s office closure, Applicant’s counsel did not have adequate word processing support. As a result, while counsel had the contents of the brief ready, there was a delay in finalizing and proofreading the brief, resulting in Applicant timely filing a version that contains the above-mentioned errors.

6. Applicant's Amended Brief does not differ in any substantive or material way from the Filed Brief. Specifically, the Amended Brief neither contains evidence, arguments, statutory or case law or regulations (collectively "Material Content") not in the Filed Brief nor does it omit any Material Content that appears in the Filed Brief.

7. The Amended Brief only corrects the above-mentioned errors. Correction of such errors will make it easier for the Board and the Examining Attorney to read the Brief and to access the authority to which Applicant cites.

8. It is within the Board's discretion to accept a late brief. Applicant's filing of its amended Appeal Brief is unintentional and only one day. The Board exercised its discretion and accepted briefs that were only a few days late in the past. *See, e.g. In re Dimitric*, 2011 TTAB LEXIS 435, *3 (TTAB 2011) (the Board exercised its discretion and considered the brief filed one day late); *In re Sansa Corporation (Barbados) Inc.*, 2017 TTAB LEXIS 222, *2 (TTAB 2017) ("Inasmuch as all briefing has been completed and Applicant's main brief was only two days late, Applicant's request to accept its late-filed brief is granted."); *Bibiji Inderjit Kaur Puri v. Ole Mexican Foods, Inc.*, 2019 TTAB LEXIS 310, *2 (TTAB 2019) (the opposer's brief was two days late, but the Board exercised its discretion and accepted the brief.); *In re Shuffle Master, Inc.*, 2011 TTAB LEXIS 391, *4 (TTAB 2011) (the applicant's brief was late by only one business day, the applicant's motion to accept its late-filed brief was granted.).

9. A one-day delay in filing of Applicant's brief is minor and will not negatively impact the proceeding, prejudice the Examining Attorney, hamper the Board's review of the matter or affect efficient administration of this proceeding.

10. If the Board denies the Applicant's motion, the Applicant requests that it consider the Appeal Brief as filed on October 13, 2020.

Based on the foregoing, Applicant requests that the Board grant its motion to file the attached Amended Brief.

Respectfully Submitted,

LOEB & LOEB LLP

Dated: October 14, 2020

By: /Daniel D. Frohling/

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

In re Application of: Royal Realty Corp.

Serial No.: 88380382

Filing Date: April 10, 2019

Mark: LIVE ON POINT

Examining Attorney:

Jules J. Dean

Law Office 120

To: Commissioner for Trademarks

BRIEF ON BEHALF OF APPLICANT – APPELLANT

I. INTRODUCTION

Applicant-appellant, Royal Realty Corp. (“Applicant”), through its undersigned counsel, appeals the Examining Attorney’s final refusal to register Applicant’s mark LIVE ON POINT (“Mark” or “Applicant’s Mark”), and respectfully requests that the Trademark Trial and Appeal Board (“Board”) reverse the Examining Attorney’s refusal and allow Applicant’s Mark to proceed to publication.

A. Prosecution History

On April 10, 2019, Applicant applied to register LIVE ON POINT for “real estate services, namely, leasing and management of buildings” in International Class 36 (“Applicant’s Services”).

The Examining Attorney refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground of likelihood of confusion with a third-party’s registered marks ON POINT CAROLINAS REALTY in standard characters (Reg. No. 5058585) and



(Reg. No. 5058586) for “real estate sales management; real estate advertising services; real estate marketing services” in International Class 35 and “real estate valuation services; residential real estate agency services; providing a database of information about residential real estate listings in different neighborhoods and communities” in International Class 36 (collectively the “Cited Marks”). *May 22, 2019 Office Action*, TSDR p. 3.

In doing so, the Examining Attorney improperly dissected the parties’ marks, claimed that the shared “ON POINT” element is the dominant part of the Cited Marks, brushed aside the marks’ differences, including “LIVE,” the first and dominant element of Applicant’s LIVE ON POINT mark, and found the marks confusingly similar. *Id.* He also found the parties’ services to be related. *Id. at* 3-4.

Applicant filed a timely response. In it, Applicant proffered evidence showing forty three (43) active, third-party common law uses of “ON POINT” for services that are identical or similar to registrant’s services. Registrant’s mark and just three (3) of the third-party uses are shown below (the registrant’s mark is depicted third in the row):



Applicant argued that the extensive use of “ON POINT” for the same or similar services as the registrant demonstrates the crippling weakness of the “ON POINT” element of the Cited Marks, shows that consumers have been educated to distinguish among different “ON POINT” marks based on minute distinctions and that the material differences between LIVE ON POINT and the Cited Marks – differences the Examining Attorney brushed aside - are sufficient to distinguish the parties’ marks. *Nov. 22, 2019 Response to Office Action*. Further, assuming that the parties’ services are related, Applicant cited and explained controlling Federal Circuit and Board decisions that confirm that the relationship is here is insufficient to overcome the impact of the third-party uses and the marks’ differences. *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671 (Fed. Cir. 2015); *Jack Wolfskin Ausrustung Fur Draussen GmbH v. New Millennium Sports, S.L.U., Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129 (Fed. Cir. 2015); *Primrose Ret. Cmty., LLC v. Edward Rose Senior Living, LLC*, 122 USPQ2d 1030 (TTAB 2016).

In both his Final Office Action and Reconsideration Letter, the Examining Attorney categorically refused to consider Applicant’s third-party use evidence. *Dec. 17, 2019 Final Office Action*; *Jul. 9, 2020 Reconsideration Letter*. In his Final Office Action, the Examining Attorney

stated "...these registrations will not be considered."¹ *Dec. 17, 2019 Final Office Action*, TSDR p. 5. In his Reconsideration Letter, he said, "...applicant's argument is not being considered..." *Jul. 9, 2020 Reconsideration Letter*, TSDR p. 1.² He did assert, for the first time and without case support or elaboration, (1) that "the registrant's mark is neither weak nor diluted because, [sic] the registrant's mark is the only registered use of the wording 'ON POINT' for real estate services"; and (2) because ON POINT is not disclaimed in the registrant's registrations. *Id.* at 2. He did not explain how these two items overcome the enfeebling effect of the dominant element of the mark co-existing in the market with over forty (40) businesses that prominently use the same element in their marks in the same field. *Id.*

In neither his Final Office Action nor his Reconsideration Letter, did the Examining Attorney materially add to his prior insufficient arguments regarding the similarity of the marks and services. In his Final Office Action, he again compared the marks by dissecting them, declaring "ON POINT" the dominant element of the Cited Marks and dismissing the dissimilarities between the marks as deserving little credence – including "LIVE," the first and dominate element of Applicant's mark. *Dec. 17, 2019 Final Office Action*, TSDR pp. 3-4. In his Reconsideration Letter, the Examining Attorney avoided addressing the new evidence and arguments Applicant had raised in its Request For Reconsideration. In its Request, the Applicant (1) elaborated on the meaning of LIVE ON POINT, which unassailably confirmed that "LIVE" is the dominant element of Applicant's Mark and a major differentiator of the marks, and (2) demonstrated that "ON

¹ The Examining Attorney mischaracterized Applicant's evidence as consisting of registrations when it consists of common law uses.

² The Examining Attorney also completely ignored the new argument Applicant had raised in its Request For Reconsideration, *i.e.*, that its third-party use evidence is entitled to particularly significant weight since, as it demonstrated, the third-party marks it proffered are generally more similar – in some cases, much more similar – to the Cited Marks than the third-party marks were to the opposer's mark in *Primrose Ret. Cmtys.*, 122 USPQ2d 1030, wherein the Board found the third-party evidence to be "powerful on its face" and entitled to "significant weight in the likelihood of confusion analysis." *Primrose Ret. Cmtys.*, 122 USPQ2d at 1036.

POINT” has very different and substantially distinguishing meanings in the parties’ marks. *Jul. 9, 2020 Reconsideration Letter; July 9, 2020 Request For Reconsideration*, TSDR pp. 15-16, 19-20. Instead, the Examining Attorney cited an abandoned application for ONPOINT APPRAISALS for “real estate appraisal and valuation” (App. Ser. No. 87061758). The application had initially been refused based on the registrant’s registrations here, and the Examining Attorney attempted to bootstrap this into a claim that the Trademark Office has a “position” regarding the words “ON POINT” for real estate services, *i.e.*, it refuses applications for marks that include them.³ *Jul. 9, 2020 Reconsideration Letter*, TSDR p. 2. In asserting this, the Examining Attorney jettisoned the well-established rule that each application must be evaluated on its own merits. He also ignored the fact that, unlike Applicant’s Mark here, which is inherently distinctive, the disclaimed word “APPRAISALS” was generic or highly descriptive of the applicant’s services and that there the refusal was an initial refusal, and the applicant did not respond.

B. Issues on Appeal

The Examining Attorney made material factual, legal and analytical errors on three (3) key facets of the likelihood of confusion analysis. Applicant addresses these facets here and demonstrates that when the real facts are correctly analyzed under the controlling legal precedent, it is clear that the Examining Attorney did not prove that confusion is likely; indeed, it is apparent that the opposite conclusion is proper. The facets are as follows:

1. The Applicant’s evidence of forty three (43) active, third-party common law uses of “ON POINT” should have been and must be considered in the likelihood of confusion analysis and, be given very significant weight;

³ Specifically, he stated, “...the attached application shows that the office’s position for the wording ‘ON POINT’ for real estate services is in favor of protecting the wording ‘ON POINT’ for the registration.” *Jul. 9, 2020 Reconsideration Letter*.

2. Cognizant of the severe weakness of the “ON POINT” element in the Cited Marks and considering the marks in their entities, they are not confusingly similar; and

3. Assuming, arguendo, that the services at issue are related, this single factor is woefully insufficient to prove a likelihood of confusion.

II. ARGUMENT

A. The Standard and Burden of Proof, and the Board’s Review.

1. The Likelihood of Confusion Standard

An application is properly refused under Section 2(d) of the Trademark Act when the Trademark Office (through the Examining Attorney) proves that use of the mark, as applied for, is likely to cause confusion with a mark already on the register. *See In re Mavety Media Group Ltd.*, 33 F.3d 1367, 1371 (Fed. Cir. 1994).

The “likelihood of confusion” determination under Section 2(d) is based on an analysis of the probative facts in evidence in relation to the “*DuPont*” factors. *See In re E.I. DuPont DeNemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). Not all the factors and evidence may be relevant or need be given equal weight in any particular case, and any one of the factors “may be dispositive in a likelihood of confusion analysis, especially when that single factor is the dissimilarity of the marks.” *Champagne Louis Roederer, S.A. v. Delicato Vineyards*, 148 F.3d 1373, 47 USPQ2d 1459, 1460 (Fed Cir. 1998), *quoted in Odom’s Tennessee Pride Sausage, Inc. v. FF Acquisition, LLC*, 600 F.3d 1343, 93 USPQ2d 2030, 2032 (Fed. Cir. 2010); *Alliance Technical Services, Inc.*, Opp. No. 91159099 (TTAB 2006).

2. The Examining Attorney Bears the Burden of Proving Confusion is Likely, and the Board Reviews His Decision to Determine if He Met the Burden and Correctly Decided the Matter.

It is axiomatic that the Examining Attorney must prove Applicant's Mark is likely to cause confusion with the Cited Marks and, if he fails to do so, his refusal to register must be reversed. See *In re Mavety Media*, 33 F.3d at 1371 ("The PTO has the burden of proving that a trademark falls within a prohibition of §1052.").

On appeal, the Board must, on the basis of the record, determine whether or not the Examining Attorney's decision was correctly made. *In re AFG Industries Inc.*, 17 USPQ2d 1162, 1163 (TTAB 1990); *In re Avocet, Inc.*, 227 USPQ 566, 567 (TTAB 1985); TBMP §1217.

B. Applicant's Prodigious Evidence of Active, Relevant Third-party Common Law Uses of "ON POINT" Must be Accorded Great Weight, and the Evidence Proves That The "ON POINT" Element is so Weak Even Small Differences Between the Parties' Marks are Wholly Sufficient to Prevent a Likelihood of Confusion

The Examining Attorney based his likelihood of confusion finding in substantial part on his conclusion that the parties' marks are confusingly similar. *May 22, 2019 Office Action, TSDR* p. 3; *Dec. 17, 2019 Final Office Action, TSDR* pp. 3-5. Essential to this conclusion was his determination that "ON POINT" is *the single* dominant portion of the Cited Marks and, as such, it (1) dictates the Cited Marks' consumer impressions; (2) is the element consumers will remember; and (3) dwarfs the Cited Marks' other elements in determining whether consumers will find the parties' marks confusingly similar. *May 22, 2019 Office Action, TSDR* p. 3; *Dec. 17, 2019 Final Office Action, TSDR* pp. 3-5. Among many statements stressing the dominance of "ON POINT" the Examining Attorney stated:

"...ON POINT is the dominant portion of the registrant's marks."

“...ON POINT would be the commercial impression of the registered marks because it is the only dominate portion of the marks.”

“...the overall commercial impression of the marks is the same because specific components of the marks that carry more weight when determining their commercial impressions are confusingly similar; specifically the wording ON POINT in the applicant’s and registrant’s marks is confusingly similar.” (emphasis added)

May 22, 2019 Office Action, TSDR p. 3; *Dec. 17, 2019 Final Office Action*, TSDR p. 4.

However, when the Examining Attorney made the above determination, he did not have evidence of the widespread prominent use of “ON POINT” by third parties. Thus, he could not factor its fundamental weakness into his analysis of the marks’ similarity. *May 22, 2019 Office Action*, TSDR p. 3.

Applicant remedied the Examining Attorney’s dearth of probative evidence by introducing at least forty three (43) active third-party common law uses of “ON POINT” that currently coexist with the registrant in connection with the same or similar real estate services. *Nov. 22, 2019 Response to Office Action*, TSDR pp. 35-163. A microcosm of this co-existence picture is presented below:



Real estate brokerage, management (“mgt.”) and development



Real estate brokerage



Real estate mgt.



Real estate brokerage



Real estate brokerage, appraisal and mgt.



Real estate brokerage



Real estate brokerage, valuation, and real estate listings



Real estate brokerage



Real estate brokerage



Real estate brokerage.



Real estate brokerage and investment



Real estate brokerage and investment



Real estate mgt.



Real estate mgt.



Real estate mgt.



Real estate brokerage

Applicant notes that the registrant's mark is in the first place in the third row.

The sixth *DuPont* factor requires that the Examining Attorney consider evidence pertaining to the number and nature of similar marks *in use* for similar services (emphasis added). *DuPont*, 476 F.2d at 1361.

Unfortunately, in both his responding Final Office Action and his Reconsideration Letter, the Examining Attorney refused to consider Applicant's evidence. In the former, he primarily reasoned that the "third party marks submitted by the applicant appear to be marks that have not been registered with the USPTO." *Dec. 17, 2019 Final Office Action*, TSDR p.5. In his Reconsideration Letter, he rationalized that the evidence and Applicant's related argument were an attack on the validity of the Cited Marks. *Jul. 9, 2020 Reconsideration Letter*, TSDR pp. 1-2. The Examining Attorney was indisputably wrong, twice. Indeed, *In re Peace Love World Live, LLC*, 127 USPQ2d 1400 (TTAB 2018), a case the Examining Attorney cited *against* consideration of Applicant's evidence, actually instructed him to consider it. *Dec. 17, 2019 Final Office Action*, TSDR p. 5. There, the Board declined to give much, if any, weight to a mere list of applications and registrations, but it embraced evidence of actual third-party common law uses. *In re Peace*, 127 USPQ2d at 1406. *See also, In re Primary Invs. Grp. Ltd.*, Ser. No. 86732652, 2017 TTAB LEXIS 265, *13 (TTAB 2017); *Chamber of Commerce of the United States v. United States Hispanic Chamber of Commerce*, 2012 TTAB LEXIS 517, *72-73 (TTAB 2012).

The Examining Attorney compounded his error in refusing to consider Applicant's evidence by finding that, even if he had, it would have been entitled to little weight on the issue of confusing similarity. *Dec. 17, 2019 Final Office Action*, TSDR p. 5. Indeed, controlling case law Applicant repeatedly cited and described to the Examining Attorney dictates the exact opposite; it

requires that he have accorded Applicant's evidence great weight. Two such cases are *Juice Generation*, 794 F.3d 1334, 115 USPQ2d 1671 and *Primrose Ret. Cmty.*, 122 USPQ2d 1030.

In *Juice Generation*, as here, the parties' marks shared an element - "Peace & Love." *Juice Generation*, 794 F.3d at 1336. Specifically, the registrant's marks/services were PEACE & LOVE for "restaurant services" (four registrations, two with designs). The applicant's mark/services were PEACE LOVE AND JUICE for "juice bar services" ("juice" disclaimed). The applicant introduced testimony about twenty-seven (27) registered and unregistered third-party uses of similar marks for similar services. *Juice Generation*, 794 F.3d at 1337. The central issue on appeal was how much weight the Board should have given the evidence. The Federal Circuit first repeated the longstanding rule that sufficient evidence of similar marks in use on similar goods or services demonstrates that a registrant's mark (or an element of it) is weak, that consumers are accustomed to distinguishing among such marks based on minute distinctions and, as a result, other parties can come much closer to the registrant's mark without causing confusion. The Court stated:

"...evidence of third-party use bears on the strength or weakness of an opposer's mark. [] The weaker an opposer's mark, the closer an applicant's mark can come without causing a likelihood of confusion and thereby invading what amounts to its comparatively narrower range of protection.

...sufficient evidence of third party use of similar marks can "show that customers . . . 'have been educated to distinguish between different . . . marks on the basis of minute distinctions.'"

Id. at 1338 (citations omitted). The Court went on to declare the applicant's evidence "powerful on its face" and remanded the case for the Board to reconsider the evidence, stating,

The Board here did not conduct an analysis of all evidence relevant to where on that spectrum [strength] GS's [registrant's] marks fall and the resulting effect on the overall likelihood-of-confusion determination. We remand for the Board to undertake this inquiry in the first instance.

Id. at 1340.

In *Primrose*, which the Board decided soon after *Juice Generation*, the parties' marks shared the element "Rose" (PRIMROSE v. ROSE SENIOR LIVING ("Senior Living" disclaimed)). *Primrose Ret. Cmtys.*, 122 USPQ2d 1030. The marks both identified "senior care living services." *Id.* at 1034. The applicant introduced the same type of evidence Applicant submitted here, *i.e.*, third-party websites showing uses of "Rose" in connection with senior living communities and related services. *Id.* at 1034 – 1035. The Board found the evidence powerful, stating:

"We find the evidence of third-party uses and registrations in the present case to be "***powerful on its face,***" and ***accord this factor significant weight in the likelihood of confusion analysis.***"

Id. at 1036 (emphasis added). The Board concluded:

The testimony and evidence demonstrate that relevant customers have been exposed to so many different ROSE and ROSE-formative marks and names in connection with senior living communities that they likely have become alert to "minute distinctions" among the various marks. ... As a result, a mark comprising, in whole or in part, the word "Rose" in connection with senior living community services should be given a restricted scope of protection.

Id. (citations omitted).

Moreover, the facts in *Primrose* provide a benchmark by which the Examining Attorney should have judged the power of Applicant's evidence. And the facts show that Applicant's evidence is unusually powerful. As is well-established, third-party use evidence demonstrates weakness when it consists of similar marks in use on similar goods or services. *Id.* at 1033. The oft-stated logic is that significant numbers of third-party uses educate consumers to distinguish among marks based on minute distinctions. Thus, the more similar the third-party marks or are to the registered mark, the smaller the distinctions on which consumers are able to rely.

Comparing the evidence in *Primrose* to Applicant’s evidence, it is clear that Applicant’s third-party uses of “ON POINT” are closer – in many cases, much closer – than the uses on which the Board relied in *Primrose*. Specifically, while the *Primrose* uses all included “Rose,” they varied considerably in their similarity to the opposer’s mark PRIMROSE. Some included “Primrose,” but many more only included “Rose” or variations of it (e.g., “Rosa”). In many cases, “Rose” or “Rosa” was merged with another word. Examples include the following:

ROSEBROOK	VILLA DEL ROSA	ROSEDALE
BELLA ROSA PLACE	MELROSE GARDENS	GREEN
CASA DE ROSA	PARKROSE CHATEAU	ROSEGATE
THE CEDARS AT PARK ROSE	PARKROSE ESTATES	ROSEHAVEN
COMPASS ROSE	PENROSE	ROSEMARK
CRESTMARK OF ROSELAWN	ROSECRANS	ROSEMONT

Primrose Ret. Cmtys., 122 USPQ2d at 1034-1035.

As shown through the microcosm Applicant presents on pages 8 to 9 above and the table attached to Exhibit A in Applicant’s Nov. 22, 2019 Response to Office Action, “ON POINT” is by far the most prominent element in almost every one of Applicant’s third-party uses; in many uses it is the word mark. *Nov. 22, 2019 Response to Office Action*, TSDR pp. 35-163.

Having made the critical error of refusing to consider Applicant’s evidence, the Examining Attorney cannot possibly be deemed to have carried his burden of proof or to have correctly decided the similarity of the marks or likelihood of confusion.⁴

In correctly applying the controlling law to Applicant’s evidence, the Board should deem it powerful and find that it is more than sufficient to demonstrate that: (1) the “ON POINT” portion

⁴ The related arguments the Examining Attorney first floats in his Reconsideration Letter are easily dispensed with. The claim that “ON POINT” is “neither weak nor diluted” because the Cited Marks are the only registered use of the wording is nothing more than an implicit repetition of his erroneous rejection of Applicant’s third-party use evidence. *July 09, 2020 Reconsideration Letter*, TSDR, p. 2. His parallel argument that “ON POINT” is “neither weak nor diluted” because it is not disclaimed in the registrant’s registrations and, thus, must be distinctive, misses Applicant’s position. Applicant has never claimed that “ON POINT” is not distinctive; rather, it has appropriately and correctly argued that the “ON POINT” element in the Cited Marks is so weak the parties’ marks other elements, including “LIVE” and “CAROLINAS REALTY,” more than adequately distinguish their marks.

of the Cited Marks is very weak; and (2) consumers will successfully distinguish between the parties' marks on the basis of the marks' other, differentiating elements, such as "LIVE," "CAROLINAS REALTY" and the registrant's design.

C. The Parties' Marks Are Sufficiently Dissimilar to Avoid a Likelihood of Confusion, Especially Given the Weakness of "ON POINT".

There is no dispute that marks are compared in their entireties for similarities in appearance, sound, connotation, and commercial impression. *May 22, 2019 Office Action, TSDR p. 3; Dec. 17, 2019 Final Office Action, TSDR p. 3; Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 1321, 110 USPQ2d 1157, 1160 (Fed. Cir. 2014) (*quoting Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 1371, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005)); TMEP §1207.01(b)-(b)(v). There is also no dispute that "there is nothing improper in stating that . . . more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entireties." (emphasis added). *May 22, 2019 Office Action, TSDR p. 3; Dec. 17, 2019 Final Office Action, TSDR p. 3; Jack Wolfskin*, 797 F.3d at 1371; *Primrose Ret. Cmty., LLC*, 122 USPQ2d at 1037.

The Examining Attorney's analysis of the similarity of the marks was fatally flawed because he: (1) failed to consider the Cited Marks in light of the major weakness of "ON POINT," thereby grossly overestimating the element's dominance in the Cited Marks' overall commercial impressions and in the weight to which it is entitled in the similarity of the marks analysis; and (2) paid lip service to the principle that the parties' marks must be compared in their entireties while he functionally dissected them, effectively dispensing with the dissimilar elements of the parties' marks – especially the dominant and powerfully differentiating term "LIVE" in Applicant's Mark.

May 22, 2019 Office Action, TSDR p. 3; Dec. 17, 2019 Final Office Action, TSDR pp. 3-4. These errors radically skewed the Examining Attorney’s analysis and led him to a false positive on the marks’ similarity. Telling is his following conclusory comment:

Thus, although the registrant’s and applicant’s marks have different components that differentiate the marks, the overall commercial impression of the marks is the *same* ... specifically the wording ON POINT in the applicant’s and registrant’s marks is confusingly similar.

Final Office Action, TSDR p. 4. (emphasis added).

1. The Examining Attorney failed to ascribe to the “ON POINT” element of the Cited Marks the feeble role it deserves.

In Section 2 above, Applicant established the great weight to which its third-party use evidence is entitled and explained how the multitude of uses eviscerates the strength of “ON POINT” in the Cited Marks. Since the Examining Attorney refused to consider Applicant’s evidence, he never took measure of its proper impact on the Cited Marks and the similarity of the marks analysis. Thus, where the Federal Circuit instructs that “...sufficient evidence of third party use ... can show that customers . . . ‘have been educated to distinguish between [the parties]’ . . . marks on the basis of minute distinctions,” the Examining Attorney inverted the significance of “ON POINT”, concluding, solely because of that element, that “...the marks are substantially similar. Specifically, the applicant merely adds one additional word to [ON POINT,] the beginning and dominant portion of the registrant’s marks.” *May 22, 2019 Office Action, TSDR p. 3.*

2. The Examining Attorney’s Improper Dissection of the Marks Facilitated His Myopic focus on “ON POINT” and His Distorting Dismissal of the Marks’ Dissimilar Elements.

The Examining Attorney formally embraced the rule that the marks must be compared in their entireties. However, his improper dissection of the parties’ marks, and his dismissal of the

dissimilar elements of the parties' marks is evident on the face of his initial and final office actions.⁵ For example, in these office actions, he discussed what he deemed the dominance of the single element "ON POINT" six (6) times. *May 22, 2019 Office Action, TSDR p. 3; Dec. 17, 2019 Final Office Action, TSDR pp. 3-4.* Conversely, he alluded or referred to a distinguishing element in either parties' marks (of which there are three (3)) only five (5) times collectively. When he did refer to "LIVE," "CAROLINAS REALTY," or the registrant's design, he addressed it in isolation and only to either denigrate its significance or bolster that of "ON POINT." *May 22, 2019 Office Action, TSDR p. 3; Dec. 17, 2019 Final Office Action, TSDR pp. 3-4.* Further, the words "ON POINT" appear in the similarity of the marks analysis in his initial Office Action seven (7) times; the words "LIVE" and "CAROLINAS REALTY" never appear there. The Examining Attorney only articulated these words in his Final Office Action when responding to Applicant's arguments and, again, he only addressed them in isolation and in the service of denigrating their significance. *Dec. 17, 2019 Final Office Action, TSDR pp. 3-4.* The Examining Attorney did not analyze the marks as wholes; indeed, he never wrote or displayed any of them as a whole in his analysis. *May 22, 2019 Office Action, TSDR p. 3; Dec. 17, 2019 Final Office Action, TSDR pp. 3-4.* The Examining Attorney's improper approach crystallized in his pronouncement that:

[T]he overall commercial impression of the marks is the same because specific components of the marks that carry more weight when determining their commercial impressions are confusingly similar; specifically the wording ON POINT in the applicant's and registrant's marks is confusingly similar.

Dec. 17, 2019 Final Office Action, TSDR p. 4.

⁵ The Examining Attorney does not address the similarity of the marks in his Reconsideration Letter.

3. The Term “LIVE” is the Dominate Portion of Applicant’s Mark, Does Not Appear in the Cited Marks and Gives LIVE ON POINT an Overall Commercial Impression that is Fundamentally Different than the Cited Marks.

“LIVE” is the dominant element in LIVE ON POINT, and it does not appear in either of the Cited Marks.

As an initial matter, the fact that “LIVE” appears first in Applicant’s Mark strongly suggests it is dominant. *See Presto Products Inc. v. Nice-Pak Products, Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) (“[I]t is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered”); *see also Palm Bay Imps.*, 73 USPQ2d at 1692 (“Veuve” is the most prominent part of the mark VEUVE CLICQUOT because “veuve” is the first word in the mark and the first word to appear on the label). The Examining Attorney cannot dispute this because he makes precisely the same argument regarding ON POINT’s place as the first element of the Cited Marks. *May 22, 2019 Office Action, TSDR p. 3; Dec. 17, 2019 Final Office Action, TSDR p. 3.*

Significantly, the single fact of LIVE’s position in Applicant’s Mark renders inapposite all of the case law the Examining Attorney cites in support of his analysis of the similarity of the marks; in all of the cited cases, the identical or similar elements of the parties’ marks were positioned first in both marks. *May 22, 2019 Office Action, TSDR p. 3; Dec. 17, 2019 Office Action, TSDR pp. 3-5.*

Applicant’s position on the dissimilarity of the marks, on the other hand, is supported by many analogous cases where proper weight was given to the first, dominant but different portions of the parties’ marks. *See e.g., Primrose Ret. Cmty*, 122 USPQ2d 1030 (PRIMROSE and ROSE SENIOR LIVING not confusingly similar for “senior care living services”); *Nautilus Grp., Inc. v.*

Savvier, Inc., 427 F. Supp. 2d 990, 996 (W.D. Wash. 2006) (the different first parts of the marks BOWFLEX and BODY FLEX for exercise equipment helps to create different commercial impression); *Sleepmaster Prods. Co. v. Am. Auto-Felt Corp.*, 44 C.C.P.A. 784, 788, 241 F.2d 738, 741 (C.C.P.A. 1957) (SLEEPMASTER for mattresses is not confusingly similar to RESTMASTER, DREAMMASTER, and HEALTHMASTER for mattresses); *Long John Distilleries, Inc. v. Sazerac Co.*, 57 C.C.P.A. 1286, 426 F.2d 1406 (C.C.P.A. 1970) (FRIER JOHN for brandy is not confusingly similar to LONG JOHN for scotch whiskey).

Moreover, because “LIVE” is dominant, the parties’ “ON POINT” elements and their marks as wholes, have fundamentally different meanings and, critically, different overall commercial impressions. Specifically, while the Examining Attorney inaccurately claims that “LIVE is merely a verb that draws attention to the wording ON POINT . . .”,⁶ “LIVE,” is actually the central focus of a suggestion or command: “LIVE ON POINT.” It tells consumers what to do – “LIVE” – while “ON POINT” modifies “LIVE,” telling consumers how to live. Since “on point” can mean “extremely good, attractive, or stylish,” “LIVE ON POINT” recommends or commands consumers “to live well and stylishly.” See, www.lexico.com/en/definition/on_point and *Jun. 17, 2020 Request for Reconsideration*, TSDR pp. 27-29. This meaning and commercial impression is far from that created by the Cited Marks. There, “ON POINT” does not even refer to consumers; it refers to the registrant, and it tells consumers that the registrant’s services are directly relevant and attuned to Carolina homebuyers’ needs. *Id.* These differences in connotation and overall commercial impression substantially differentiate the parties’ marks.

⁶ *Id.* at p. 5.

4. “CAROLINAS REALTY” and the Registrant’s Design Element Must be Accorded Weight.

It is axiomatic that less distinctive or disclaimed elements of a mark cannot be ignored in the similarity of the marks analysis. *Juice Generation*, 794 F.3d at 1341 quoting *Nat’l Data Corp. v. Computer Sys. Eng’g, Inc.*, 753 F.2d 1058, 1059 (Fed. Cir. 1985) (“The technicality of a disclaimer in National’s application to register its mark has no legal effect on the issue of likelihood of confusion. The public is unaware of what words have been disclaimed during prosecution of the trademark application at the PTO”). Clearly, more weight should have been, and should be given, to the wording “CAROLINAS REALTY” and the design element in the Cited Marks. The wording “CAROLINAS REALTY” clearly places the registrant and its services in a particular geographic area, and the picket fence is a strong indicator that registrant deals in homes. Neither of these things is true of Applicant’s Mark.

In sum, although the marks share an element, when viewed in their entireties, the marks are dissimilar in appearance, sound, connotation and commercial impression. When further viewed against the background of third-party use, Applicant’s Mark is plainly not sufficiently, similar to the Cited Marks to be likely to cause confusion.

D. Evidence About the Relatedness of the Parties’ Services Cannot Overcome the Weakness of “ON POINT” and the Overall Dissimilarity of the Marks.

The Examining Attorney argues that the registrant’s and Applicant’s Services are similar and related, both for overall likelihood of confusion purposes and for determining how similar the marks need to be to be confusingly similar. *May 22, 2019 Office Action*, TSDR pp. 3-4, *Dec. 17, 2019 Final Office Action*, TSDR p. 5. Based on the premise that, when the services are similar, a lower degree of similarity between the marks is required to support a likelihood of confusion

finding, the Examining Attorney argues that, given the similarity or relatedness of the services, the marks here are sufficiently similar to find that confusion is likely. *Dec. 17, 2019 Final Office Action*, TSDR p. 5. However, the Examining Attorney cites no cases with facts parallel to the facts here. Thus, his declaration that the level of relatedness here, by itself, is sufficient to compel both the conclusion that the marks are confusingly similar and that he has proved a likelihood of confusion rings hollow.

What rings true is the controlling case law, which emphatically supports the conclusion that a similarity or even overlap in the services does not automatically render the marks confusingly similar. In the case law Applicant has relied in its arguments, the parties' goods or services were similar and the marks shared similar elements, yet no likelihood of confusion was found. *See, e.g., Juice Generation*, 794 F.3d 1334, 115 USPQ2d 1671; *Jack Wolfskin*, 797 F.3d 1363, 116 USPQ2d 1129; *Primrose Ret. Cmty's.*, 122 USPQ2d 1030. This is because all facts of the case must be considered. In this application, considering all the facts as discussed above, the similarity of the services factor is not sufficient to drive a finding that confusion is likely. The controlling cases, combined with the Examining Attorney's failure to present facts, analysis or authority to support his leap to the contention that the services' similarities are sufficient to overcome the weakness of "ON POINT" and the dissimilarity of the marks, show that his contention simply cannot be a basis for refusing registration. Based on the facts of the case, Applicant's Mark is not likely to cause confusion with the Cited Marks.

E. The Controlling Cases Support a "No Likelihood of Confusion" Finding in This Case.

Applicant's arguments against the finding of confusion are supported by the controlling Federal Circuit cases *Juice Generation, Inc. v. GS Enters. LLC* and *Jack Wolfskin Ausrüstung Fur*

Draussen GmbH v. v. New Millennium Sports, S.L.U., Sports, S.L.U., and the Board's decision in *Primrose Ret. Cmty., LLC v. Edward Rose Senior Living, LLC*, all of which are very closely analogous to the situation here. *Juice Generation*, 794 F.3d 1334; *Jack Wolfskin.*, 797 F.3d 1363, 116 USPQ2d 1129; *Primrose Ret. Cmty.*, 122 USPQ2d 1030.

In the cited cases, it was held that the Board or Examining Attorney (1) inadequately weighed substantial evidence of third party uses and/or registrations of the common elements of the parties' marks for similar services (which showed that the relevant elements of the registrants' mark(s) were weak, and that consumers could distinguish among marks containing those elements based on minute differences), and (2) improperly dissected the marks and focused on the common elements of the marks while disregarding the dissimilar elements.

In *Juice Generation*, the parties' marks/services were PEACE & LOVE for "restaurant services," (four registrations, two with designs) and PEACE LOVE AND JUICE for "juice bar services" ("JUICE" disclaimed). The Court first found that the Board had failed to give appropriate weight to twenty-seven (27) third party uses and registrations of marks that included "Peace" and "Love" for "restaurant services or food products." *Juice Generation*, 794 F.3d at 1338. For its part, the Federal Circuit found the evidence "powerful on its face," and remanded the case for the Board to adequately consider the evidence. *Juice Generation*, 794 F.3d at 1340. The Court also found the Board's errors in dissecting the marks and considering them piecemeal potentially pivotal, and it remanded the case for the Board's consideration of the marks as a whole. *Juice Generation*, 794 F.3d at 1341. Within a short period after the Federal Circuit's remand, the applicant's mark registered (Reg. No. 4,923,032).

In *Jack Wolfskin*, the parties' marks shared a paw print and were used for many overlapping goods in Class 25. *Jack Wolfskin*, 797 F.3d 1363. Specifically, the registrant's mark was



and the applicant's mark was



. The Federal Circuit

reversed the Board's finding of confusion, holding that the Board failed to properly compare the parties marks, *as a whole* and failed to recognize, in light of the significant evidence of paw prints appearing in third-party registrations and usage for clothing, the narrow scope of protection afforded to marks involving paw prints, including the registrant's mark. *Jack Wolfskin*, 797 F.3d at 1366. Specifically, the Federal Circuit found the applicant's "extensive evidence" of twenty-eight (28) third-party internet uses of marks consisting of or including paw prints was "powerful on its face." *Jack Wolfskin*, 797 F.3d at 1374. The Court also found improper the Board's discounting of the non-similar verbal portion of the registrant's mark - "KELME." *Jack Wolfskin*, 797 F.3d at 1372.

In *Primrose*, the Board found no likelihood of confusion between PRIMROSE and ROSE SENIOR LIVING ("Senior Living" disclaimed), for, inter alia, "providing assisted living facilities." *Primrose Ret. Cmty.*, 122 USPQ2d 1030. Specifically, it found the applicant's evidence of eight (8) federal registrations and eighty-four (84) common law uses of ROSE or ROSE-formative marks for senior care living communities and related services "powerful on its face" to show the weakness of the opposer's mark. *Primrose Ret. Cmty.*, 122 USPQ2d 1036. The Board also found that the marks' differences in sound, appearance and meaning, when viewed against the significant third-party uses and registrations of similar marks, outweighed the similarities between the marks resulting in different overall commercial impression. *Id.*

Similar to the cited cases, Applicant has submitted internet evidence showing over forty (40) third-party uses of marks that prominently use "ON POINT" for services in the real estate field. Just as in the cited cases, this evidence is "powerful on its face," and shows that the "ON

POINT” element of the Cited Marks is weak. Moreover, Applicant has demonstrated the powerful differentiating effect of the word “LIVE” in its Mark. “LIVE” is the first word and dominant element, and it causes the “ON POINT” element to have a drastically different meaning than it does in the Cited Marks. Indeed, it causes the marks to create decidedly different commercial impressions. Finally, Applicant illustrated the differentiating effect of “CAROLINAS REALTY” and the registrant’s design and the weight to which they are entitled when comparing the parties’ overall marks. Therefore, the differences between the marks’ appearance, sound and meaning, when viewed against the background of significant third-party uses, outweigh the relatedness of the services, easily permitting the co-existence of Applicant’s Mark with the Cited Marks and the registration of the Applicant’s Mark.

III. CONCLUSION

Based on the foregoing, Applicant respectfully requests that the Examining Attorney’s refusal be reversed, and the application for the Mark be approved for publication.

Respectfully Submitted,

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