

Response to Office Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	86058968
LAW OFFICE ASSIGNED	LAW OFFICE 116
MARK SECTION	
MARK	http://tess2.uspto.gov/ImageAgent/ImageAgentProxy?getImage=86058968
LITERAL ELEMENT	I LOVE PIZZA! U.S.A.
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.
EVIDENCE SECTION	
EVIDENCE FILE NAME(S)	
ORIGINAL PDF FILE	evi_701095314-162731423_.ILOVEPIZZA_-_Response_to_OA.pdf
CONVERTED PDF FILE(S) (4 pages)	\\TICRS\EXPORT16\IMAGEOUT16\860\589\86058968\xml5\ROA0002.JPG
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DESCRIPTION OF EVIDENCE FILE	Arguments in response to the 2(d) refusal
ADDITIONAL STATEMENTS SECTION	
DISCLAIMER	No claim is made to the exclusive right to use PIZZA U.S.A. apart from the mark as shown.
SIGNATURE SECTION	
RESPONSE SIGNATURE	/avann/
SIGNATORY'S NAME	Antonio Vann
SIGNATORY'S POSITION	Attonrey of record, VA bar member
SIGNATORY'S PHONE NUMBER	855.226.9661
DATE SIGNED	02/18/2014
AUTHORIZED SIGNATORY	YES
FILING INFORMATION SECTION	
SUBMIT DATE	Tue Feb 18 16:31:44 EST 2014
TEAS STAMP	USPTO/ROA-XX.XXX.XX.XX-20 140218163144083164-860589 68-5002b37b0d0a48db04b8e3 6d4da9cfffdf55177df0cc3fef

Response to Office Action

To the Commissioner for Trademarks:

Application serial no. **86058968** I LOVE PIZZA! U.S.A.(Standard Characters, see <http://tess2.uspto.gov/ImageAgent/ImageAgentProxy?getImage=86058968>) has been amended as follows:

EVIDENCE

Evidence in the nature of Arguments in response to the 2(d) refusal has been attached.

Original PDF file:

[evi_701095314-162731423_-_ILOVEPIZZA_-_Response_to_OA.pdf](#)

Converted PDF file(s) (4 pages)

[Evidence-1](#)

[Evidence-2](#)

[Evidence-3](#)

[Evidence-4](#)

ADDITIONAL STATEMENTS

Disclaimer

No claim is made to the exclusive right to use PIZZA U.S.A. apart from the mark as shown.

SIGNATURE(S)

Response Signature

Signature: /avann/ Date: 02/18/2014

Signatory's Name: Antonio Vann

Signatory's Position: Attorney of record, VA bar member

Signatory's Phone Number: 855.226.9661

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 applicant'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 applicant in this matter: (1) the applicant 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 applicant has filed a power of attorney appointing him/her in this matter; or (4) the applicant'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.

Serial Number: 86058968

Internet Transmission Date: Tue Feb 18 16:31:44 EST 2014

TEAS Stamp: USPTO/ROA-XX.XXX.XX.XX-20140218163144083

164-86058968-5002b37b0d0a48db04b8e36d4da

9cffdf55177df0cc3fefe75d1ae44393b634bf7e

-N/A-N/A-20140218162731423605

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: I Love Pizza!
Serial No.: 86/058968
Filed: September 9, 2013
Trademark Atty: Alice Benmaman
Word Mark: I LOVE PIZZA! U.S.A.

RESPONSE TO DECEMBER 23, 2013 OFFICE ACTION

This Response is filed in reply to the Office Action e-mailed on December 23, 2013. The Applicant respectfully submits the following response. Applicant submits that the above-identified trademark application for I LOVE PIZZA! U.S.A. is in condition for allowance to publication.

Potential Section 2(d) – Likelihood of Confusion

Applicant submits a preliminary response to the potential section 2(d) refusal; however, Applicant reserves all rights to provide a detailed and more descriptive response if Examining Attorney Alice Benmaman raises a Section 2(d) refusal in a subsequent Office Action.

APPLICANTS WORD MARK

I LOVE PIZZA! U.S.A.

Class 043: Restaurant Services

CITED REGISTERED MARK



Class 043: Restaurant; Take-out restaurant services

Preliminary Response with Reservation of Rights

The USPTO suggests that it will refuse registration of Applicant's mark, I LOVE PIZZA! U.S.A., "because of a likelihood of confusion with registered mark I PIZZA AN AUTHENTIC NY PIZZERIA & design, in U.S. Registration No. 3967125." "[T]he question of confusion is related not to the nature of the mark but to its effect 'when applied to the goods of the applicant.'" *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1360, 177 USPQ 563, 566 (C.C.P.A. 1973). The United States Court of Customs and Patent Appeals listed thirteen factors to weigh in the likelihood of confusion analysis and stated that all of the factors must be considered "when of record." *Id.* at 1361. The Examining Attorney has indicated that similarity of the marks, similarity of the goods and/or services, and similarity of trade channels of the goods and /or services weigh against the Applicant's mark. However, Applicant respectfully asserts that when all factors are weighed, the majority weighs against the existence of a likelihood of confusion.

(1) Similarity of Conflicting Designations

The first factor is the similarity of the conflicting designations, including in their appearance, sound, meaning or connotation, and commercial impression. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973). A similar phrase found in two marks is not dispositive of a confusing similarity between the marks when the marks give off different commercial expressions. *See Kellogg Co. v. Pack'em Enterprises, Inc.*, 951 F.2d 330 (Fed. Cir. 1991). When Applicant's mark (I LOVE PIZZA! U.S.A.), and Registrant's mark (I [HEART DESIGN] PIZZA AN AUTHENTIC NY PIZZERIA) are compared, the appearance is not similar despite the shared terms. The only shared terms are "I" and "PIZZA." It is important to note that the cited registration has disclaimed the term "PIZZA."

The overall appearance of the marks, as a whole, is dissimilar. The Applicant uses the term "U.S.A.," while the cited registration uses "AN AUTHENTIC NY PIZZERIA." Phonetically the marks differ in sound, as the Applicant's mark consists of six syllables and the Registrant's mark consists of twelve or thirteen syllables.

Visually, the phrase I LOVE PIZZA! U.S.A. is easily distinguished from the designs and phrase incorporated in the Registrant's I [HEART DESIGN] PIZZA AN AUTHENTIC NY PIZZERIA mark. The structure, format, and design elements are unique to the commercial impression of the Registrant's mark. These elements create a distinct commercial impression that is different from the Applicant's mark.

The two marks give distinctly different commercial impressions and visual representations. The Applicant's mark incorporates no design elements. The dominant portion of the Registrant's mark is a heart design. The marks also include different terms, which further supports a difference in commercial impression. For at least these reasons, Applicant asserts that the mark I LOVE PIZZA! U.S.A. is significantly different than the mark I PIZZA AN AUTHENTIC NY PIZZERIA & design. This factor weighs in Applicant's favor.

(2) Similarity or Dissimilarity and the Nature of the Goods or Services

The second factor is the similarity or dissimilarity and the nature of the goods or services as described in an application or registration or in connection with a prior use of the mark. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973). Both marks cover restaurant services. Under this factor, Applicant agrees that the nature of the services are similar.

(3) Similarity or Dissimilarity of Established Likely to Continue Trade Channels

The third factor is the similarity or dissimilarity of established, likely-to-continue trade channels. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d at 1361, 177 USPQ at 567. This factor heavily weighs against a finding of a likelihood of confusion. It is unclear as to the trade channels the Registrant uses. The trade Channels for the pizza industry are vast because the trade channels could be limited narrowly to a neighborhood region or it could be nation-wide. Applicant intends to initially use its mark within the state of New York. It being unclear as to the Registrant's trade channels, this factor neither weighs in favor or against the existence of a likelihood of confusion.

(4) Conditions Upon Sales Are Made

The fourth factor is the conditions under which and buyers to whom sales are made (i.e. impulse v. careful). *Id.* Consumers interested in Applicant's services will be local consumers of the city of New York. Therefore, consumers will carefully identify the uniquely formatted mark I LOVE PIZZA! U.S.A. when searching for the Applicant's services. This factor weighs heavily against a likelihood of confusion between these two marks.

(5) Fame of the Prior Mark

The fifth factor is the fame of the prior mark (*e.g.*, sales, advertising, length of use, *etc.*). *Id.* There is no evidence that the prior mark is famous, this factor weighs against a likelihood of confusion.

(6) Number and Nature of Similar Marks in Use on Similar Goods

The sixth factor is the number and nature of similar marks in use in connection with similar services. *Id.* In this case, the USPTO has not made any assertions as to the number and nature of marks used in connection with restaurant services. A search of the USPTO records for “I LOVE” related trademarks for restaurant services, reveals thirty-nine records. Therefore, Applicant asserts that this factor also weighs in his favor.

(7) Nature and Extent of Any Actual Confusion

The seventh factor concerns the nature and extent of any actual confusion. *Id.* No evidence exists that any consumer has been confused by the use of these two marks. Consequently, Applicant asserts that this factor weighs in his favor or is at least neutral in the likelihood of confusion analysis.

(8) Length of Time During and Conditions under which There Has Been Concurrent Use Without Evidence of Actual Confusion

The eighth factor is the length of time during and conditions under which there has been concurrent use without evidence of actual confusion. *Id.* Applicant’s mark is an intent-to-use mark. Therefore, there is no concurrent use of the marks. Therefore, this factor is also at least neutral.

(9) Variety of Goods on which a Mark Is or Is Not Used

The ninth factor is the variety of goods on which a mark is or is not used (house mark, “family” mark, product mark). *In re E. I. du Pont de Nemours & Co.*, 476 F.2d at 1361, 177 USPQ at 567. Both marks at issue here are used in connection with restaurant services. The Cited Registration is not a part of a family of marks. Consequently, this factor weighs against a likelihood of confusion.

(10) Market Interface Between Applicant and the Owner of a Prior Mark

The tenth factor is the market interface between Applicant and the owner of a valid, prior mark. *Id.* In this case, there has been no interface between the Applicant and the Registrant, and therefore this factor is also neutral.

(11) Extent to which Applicant has a Right to Exclude Others from Use of its Mark on its Goods

The eleventh factor is the extent to which Applicant has a right to exclude others from use of its mark on its goods. *Id.* The Applicant cannot claim rights to exclusive use of the mark because Applicant’s has not yet started using the mark. This factor is also neutral.

(12) Extent of Potential Confusion

The twelfth factor is the extent of potential confusion, *i.e.*, whether de minimis or substantial. *Id.* Because (1) it is unclear as to what trade channels the Registrant uses, (2) the Applicant’s mark is substantially different than the Registrant’s mark, and (3) there are numerous “I LOVE” related marks in the restaurant services industry, the potential for confusion is de minimis and weighs heavily against a likelihood of confusion.

(13) Whether There Are any Other Established Facts Probative of the Effect of Use

The thirteenth factor looks to whether there are any other established facts probative of the effect of use. Applicant reserves all rights to provide a detailed and more descriptive response on this factor if the USPTO should raise a Section 2(d) refusal in a subsequent Office Action. Applicant further asserts that

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