

## Response to Office Action

**The table below presents the data as entered.**

| Input Field  | Entered  |
|--|--|
| <b>SERIAL NUMBER</b>   | 86310204   |
| <b>LAW OFFICE ASSIGNED</b>   | LAW OFFICE 118   |
| <b>MARK SECTION</b>  |  |
| <b>MARK FILE NAME</b>  | http://tsdr.uspto.gov/img/86310204/large   |
| <b>LITERAL ELEMENT</b>   | ORION REALTY NYC LLC   |
| <b>STANDARD CHARACTERS</b>   | NO   |
| <b>USPTO-GENERATED IMAGE</b>   | NO   |
| <b>COLOR(S) CLAIMED<br/>(If applicable)</b>                            | Color is not claimed as a feature of the mark.   |
| <b>DESCRIPTION OF THE MARK<br/>(and Color Location, if applicable)</b> | The mark consists of a design of an archer using a bow with the stylized text "orion realty nyc llc" to the right. |
| <b>EVIDENCE SECTION</b>  |  |
| <b>EVIDENCE FILE NAME(S)</b>   |  |
| <b>ORIGINAL PDF FILE</b>   | <a href="#">evi_701095314-20141024150848106528_.ORION_REALTY_86310204_-_OA_Response.pdf</a>                        |
| <b>CONVERTED PDF FILE(S)<br/>(14 pages)</b>                            | <a href="#">\\TICRS\EXPORT16\IMAGEOUT16\863\102\86310204\xml6\ROA0002.JPG</a>                                      |
|  | <a href="#">\\TICRS\EXPORT16\IMAGEOUT16\863\102\86310204\xml6\ROA0003.JPG</a>                                      |
|  | <a href="#">\\TICRS\EXPORT16\IMAGEOUT16\863\102\86310204\xml6\ROA0004.JPG</a>                                      |
|  | <a href="#">\\TICRS\EXPORT16\IMAGEOUT16\863\102\86310204\xml6\ROA0005.JPG</a>                                      |
|  | <a href="#">\\TICRS\EXPORT16\IMAGEOUT16\863\102\86310204\xml6\ROA0006.JPG</a>                                      |
|  | <a href="#">\\TICRS\EXPORT16\IMAGEOUT16\863\102\86310204\xml6\ROA0007.JPG</a>                                      |
|  | <a href="#">\\TICRS\EXPORT16\IMAGEOUT16\863\102\86310204\xml6\ROA0008.JPG</a>                                      |
|  | <a href="#">\\TICRS\EXPORT16\IMAGEOUT16\863\102\86310204\xml6\ROA0009.JPG</a>                                      |
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|  | <a href="#">\\TICRS\EXPORT16\IMAGEOUT16\863\102\86310204\xml6\ROA0012.JPG</a>                                      |
|  | <a href="#">\\TICRS\EXPORT16\IMAGEOUT16\863\102\86310204\xml6\ROA0013.JPG</a>                                      |
|  | <a href="#">\\TICRS\EXPORT16\IMAGEOUT16\863\102\86310204\xml6\ROA0014.JPG</a>                                      |
|  | <a href="#">\\TICRS\EXPORT16\IMAGEOUT16\863\102\86310204\xml6\ROA0015.JPG</a>                                      |
| <b>DESCRIPTION OF EVIDENCE FILE</b>                                    | Response to September 30, 2014 Office Action   |
| <b>GOODS AND/OR SERVICES SECTION (current)</b>                         |  |
| <b>INTERNATIONAL CLASS</b>   | 036  |

|   |  |
|---|--|
| <b>DESCRIPTION</b>  |  |
| Real estate brokerage; Real estate investment services; Real estate investment trust management services; Real estate management consultation; Real estate management services; Real estate service, namely, rental property management             |  |
| <b>FILING BASIS</b>   | Section 1(b)   |
| <b>GOODS AND/OR SERVICES SECTION (proposed)</b>   |  |
| <b>INTERNATIONAL CLASS</b>  | 036  |
| <b>TRACKED TEXT DESCRIPTION</b>   |  |
| <del>Real estate brokerage</del> ; Real estate investment services; Real estate investment trust management services; Real estate management consultation; Real estate management services; Real estate service, namely, rental property management |  |
| <b>FINAL DESCRIPTION</b>  |  |
| Real estate investment services; Real estate investment trust management services; Real estate management consultation; Real estate management services; Real estate service, namely, rental property management                                    |  |
| <b>FILING BASIS</b>   | Section 1(b)   |
| <b>ADDITIONAL STATEMENTS SECTION</b>  |  |
| <b>DISCLAIMER</b>   | No claim is made to the exclusive right to use REALTY NYC LLC apart from the mark as shown.  |
| <b>DESCRIPTION OF THE MARK (and Color Location, if applicable)</b>  | The mark consists of a design of an archer using a bow with the stylized text "orion realty nyc llc" to the right with lines on either side of "llc".                    |
| <b>SIGNATURE SECTION</b>  |  |
| <b>RESPONSE SIGNATURE</b>   | /Seth Willig Chadab/   |
| <b>SIGNATORY'S NAME</b>   | Seth Willig Chadab   |
| <b>SIGNATORY'S POSITION</b>   | Associate Attorney, DunlapWeaver PLLC, Maryland Bar Member   |
| <b>SIGNATORY'S PHONE NUMBER</b>   | 7037777319   |
| <b>DATE SIGNED</b>  | 10/24/2014   |
| <b>AUTHORIZED SIGNATORY</b>   | YES  |
| <b>FILING INFORMATION SECTION</b>   |  |
| <b>SUBMIT DATE</b>  | Fri Oct 24 15:15:02 EDT 2014   |
| <b>TEAS STAMP</b>   | USPTO/ROA-XX.XXX.XX.XX-20<br>141024151502359812-863102<br>04-500aebfb4b4f5671c49f49<br>729dc4e84467b75998b325c74<br>c86b5c77d5a8da2a44c-N/A-N<br>/A-20141024150848106528 |

### Response to Office Action

#### To the Commissioner for Trademarks:

Application serial no. **86310204** ORION REALTY NYC LLC (Stylized and/or with Design, see <http://tsdr.uspto.gov/img/86310204/large>) has been amended as follows:

EVIDENCE

Evidence in the nature of Response to September 30, 2014 Office Action has been attached.

**Original PDF file:**

[evi\\_701095314-20141024150848106528 . ORION REALTY 86310204 - OA Response.pdf](#)

**Converted PDF file(s)** ( 14 pages)

[Evidence-1](#)

[Evidence-2](#)

[Evidence-3](#)

[Evidence-4](#)

[Evidence-5](#)

[Evidence-6](#)

[Evidence-7](#)

[Evidence-8](#)

[Evidence-9](#)

[Evidence-10](#)

[Evidence-11](#)

[Evidence-12](#)

[Evidence-13](#)

[Evidence-14](#)

**CLASSIFICATION AND LISTING OF GOODS/SERVICES**

**Applicant proposes to amend the following class of goods/services in the application:**

**Current:** Class 036 for Real estate brokerage; Real estate investment services; Real estate investment trust management services; Real estate management consultation; Real estate management services; Real estate service, namely, rental property management

Original Filing Basis:

**Filing Basis: Section 1(b), Intent to Use: For a trademark or service mark application:** As of the application filing date, the applicant had a bona fide intention, and was entitled, to use the mark in commerce on or in connection with the identified goods/services in the application. **For a collective trademark, collective service mark, or collective membership mark application:** As of the application filing date, the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce by members on or in connection with the identified goods/services/collective membership organization. **For a certification mark application:** As of the application filing date, the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce by authorized users in connection with the identified goods/services, and the applicant will not engage in the production or marketing of the goods/services to which the mark is applied, except to advertise or promote recognition of the certification program or of the goods/services that meet the certification standards of the applicant.

**Proposed:**

**Tracked Text Description:** ~~Real estate brokerage~~; Real estate investment services; Real estate investment trust management services; Real estate management consultation; Real estate management services; Real estate service, namely, rental property management

Class 036 for Real estate investment services; Real estate investment trust management services; Real estate management consultation; Real estate management services; Real estate service, namely, rental property management

**Filing Basis: Section 1(b), Intent to Use: For a trademark or service mark application:** As of the application filing date, the applicant had a bona fide intention, and was entitled, to use the mark in commerce on or in connection with the identified goods/services in the application. **For a collective trademark, collective service mark, or collective membership mark application:** As of the application filing date, the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce by members on or in connection with the identified goods/services/collective membership organization. **For a certification mark application:** As of the application filing date, the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce by authorized users in connection with the identified goods/services, and the applicant will not engage in the production or marketing of the goods/services to which the mark is applied, except to advertise or promote recognition of the certification program or of the goods/services that meet the certification standards of the applicant.

**ADDITIONAL STATEMENTS**

**Disclaimer**

No claim is made to the exclusive right to use REALTY NYC LLC apart from the mark as shown.

**Description of mark**

The mark consists of a design of an archer using a bow with the stylized text "orion realty nyc llc" to the right with lines on either side of "llc".

**SIGNATURE(S)**

**Response Signature**

Signature: /Seth Willig Chadab/ Date: 10/24/2014

Signatory's Name: Seth Willig Chadab

Signatory's Position: Associate Attorney, DunlapWeaver PLLC, Maryland Bar Member

Signatory's Phone Number: 7037777319

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: 86310204

Internet Transmission Date: Fri Oct 24 15:15:02 EDT 2014

TEAS Stamp: USPTO/ROA-XX.XXX.XX.XX-20141024151502359

812-86310204-500aebfb4b4f5671c49f49729dc

4e84467b75998b325c74c86b5c77d5a8da2a44c-

N/A-N/A-20141024150848106528

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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**Serial No.:** 86310204  
**Mark:** ORION REALTY NYC LLC  
**Applicant:** ORION REALTY NYC LLC  
**Office Action Date:** September 30, 2014

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**RESPONSE TO SEPTEMBER 30, 2014 OFFICE ACTION**

This Response is filed in reply to the Office Action e-mailed on September 30, 2014. The Applicant respectfully submits the following response. Applicant submits that the above-identified trademark application for ORION REALTY NYC LLC is in condition for allowance to publication.

**Potential Section 2(d) Refusal: 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 Anne M. Farrell raises a Section 2(d) refusal in a subsequent Office Action.

***Preliminary Response with Reservation of Rights***

The USPTO has refused registration of the Applicant's mark, ORION REALTY NYC LLC, "because of a likelihood of confusion with the marks in U.S. Registration Nos. 1974896, 2790239, and 2790240." "[T]he question of confusion is related not to the nature of the mark but to its effect 'when applied to the applicant.'" *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1360-61 (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 or relatedness of the goods and/or services, and similarity of the 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 ORION REALTY NYC LLC, and Registrant's

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