

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Mark: HEROQUEST CLASSIC )  
)  
Applicant: HQ25, LLC ) Examining Attorney  
)  
Serial Number: 86834134 ) Jacob Vigil  
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Filing Date: 11/30/2015 ) Law Office: 113  
)  
International Class: 28 )

Hon. Assistant Commission for Trademarks  
2900 Crystal Drive  
Arlington, Virginia 22202-3513

Attn: Box RESPONSES  
NO FEE

**RESPONSE TO OFFICE ACTION DATED MARCH 18, 2016**

The Applicant HQ25, LLC (“Applicant”), by and through its undersigned counsel, hereby submits this response to the Office Action dated March 18, 2016, in which the Examining Attorney refused Applicant’s application for the registration of “HEROQUEST CLASSIC” (the “Mark”) under Section 2(d), based on the likelihood of confusion of the mark.<sup>1</sup> In support of the Mark’s registration on the Principal Register, Applicant respectfully states as follows:

**I. Section 2(d) Refusal—The Mark Does Not Create a Likelihood of Confusion**

The Applicant respectfully submits that the Examining Attorney’s determination that the Mark will likely cause confusion is in error.

**A. The Marks are Not Related**

Applicant’s Mark is used in connection with board games whereas Registrant’s mark is merely used in connection game equipment in the nature of game book manuals. Specifically, the Applicant’s Mark identifies a particular board game marketed by the owner and not a brand

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<sup>1</sup> Applicant is proceeding under Section 1(b) basis. As such, there is no response required on the remaining items contained in the March 18, 2016 Office Action.

under which game equipment or manuals are sold. The different use of the marks establishes that the marks are not related or competitive. The marks are not advertised in the same forum nor do the marks emanate from the same source. The Examining Attorney's determination that the mere use of manuals within board games creates a close relationship between the marks lacks support and reasoning. Additionally, the Examining Attorney failed to provide a connection between the two consumer products.

Additionally, the Applicant's Mark is a new rendition of a specific board game that existed in the past and developed a very wide fan base. Registrant's mark is in the nature of game book manuals. These two different uses further shows that the use of the marks is in different streams of commerce. Finally, Registrant, who has used his mark in commerce since 2001, has yet to register his mark in connection with game boards. As such, the refusal to register under Section 2(d) of the Trademark act should be reversed.

### **B. *Du Pont* Factors**

A determination of likelihood of confusion under Section 2(d) is made on a case-by-case basis and the factors set forth in *In re E.I. du Pont de Nemours & Co.*, aid in this determination. 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973).

#### **a. Similarity of the Marks**

Applicant's Mark and Registrant's mark are not similar. The uses, pronunciation, relationship, and function of the marks are not similar. In *Genband*, the Board instructed that "under the first *du Pont* factor regarding the similarity or the dissimilarity of the marks, we consider whether applicant's mark and the registered mark, when viewed in their entireties, are similar in appearance, sound, connotation and commercial impression." *In re Genband Inc.*, 2011 WL 1495451, at 2 (Mar. 30, 2011). In *Genband*, the Board concluded that the manner in which the Registrant and the applicant displayed their mark was different and that the marks were dissimilar. *Id.* In this matter, Applicant's Mark is a specifically-designed mark with

elaborate curves and unique lighting used in board games. Registrant's mark is merely a word mark that is written in a manual. Applicant's Mark and Registrant's mark are dissimilar in that the depiction differs, similar to *Genbard*.

Unlike Registrant's mark, Applicant's Mark contains the additional term "Classic." This additional term substantially changes the pronunciation and recognition of the mark. In addition, the additional term elicits a specific connotation within the minds of consumers and cannot be categorized as purely descriptive. In *Paul D. Miller*, the Board concluded that the terms were confusingly similar because hyphens in a word are a negligible difference in appearance and might be overlooked by potential consumers, and the two marks would be pronounced precisely the same. *In re Paul D. Miller*, 2010 WL 667924, at 3 (Jan. 27, 2010). The Board explained that the focus on likelihood of confusion is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. *See id.* Unlike in *Paul D. Miller*, the Applicant's Mark has additional words and the appearances of the marks are different. The terms are pronounced differently and the marks have distinctive connotations because Applicant's Mark contains additional words than Registrant's mark. Since Registrant has never had board game with the same name, consumers can clearly ascertain prior uses of the Mark in connection with a board game and not confuse the source. As a result of these differences in appearance, pronunciation and meaning, it is unlikely that a consumer will be confused by the two marks. The average purchaser would not confuse the Registrant's mark with the Applicant's Mark, particularly if the average purchaser retains a general rather than specific impression of the marks. As such, the refusal to register under Section 2(d) of the Trademark act should be reversed.

**b. Similarity of the Trade Channels of the Goods and Similarity and Nature of the Goods**

Applicant's Mark requires actual participation of players in a board game whereas Registrant's mark merely provides literature in a manual. Clearly, the Applicant's Mark is used to represent a board game while the Registrant's mark is used in separate game equipment, particularly a game manual. The dissimilar use of each of the marks in a field of sophisticated users makes it unlikely that a consumer will be confused by the marks.

In *Genband*, the Board explained that the conditions under which the buyers to whom sales are made would be made with some care and that both goods using the marks would not be bought without deliberation. *Genband at 5*. The Board ultimately concluded that this manner of purchasing reduces the likelihood of source confusion. *See id.* Similar to *Genband*, Applicant's Mark is marketed towards sophisticated board-game users and it is unlikely that the mark would be confused by consumers of Registrant's mark. As such, the refusal to register under Section 2(d) of the Trademark act should be reversed.

**c. Balancing of *Du Pont* Factors**

Ultimately, each of the *du Pont* factors is balanced to make a determination of likelihood of confusion. *Id. at 5*. In *Genband*, the Board concluded that because "the marks are dissimilar and purchases of both applicant's and Registrant's goods are made with care, we [the board] find that there is no likelihood of confusion between Registrant's mark for its goods and applicant's mark for its goods." *Id.* In this matter, Applicant's Mark and Registrant's mark are not similar and elicit different connotations. In addition, the consumers of each good make their purchases with the requisite care. Therefore, it is unlikely that a consumer will be confused. As such, the refusal to register under Section 2(d) of the Trademark act should be reversed.

### **C. Different Class of Goods**

The marks in *Paul D. Miller* were in the same international class of goods, which supported the Registrant's position that the marks were confusingly similar. *Paul D. Miller* at 1. In this matter, Applicant's Mark and Registrant's mark are classified in different classes. Applicant's Mark is registered in International Class 28, whereas Registrant's mark is registered in International Class 16. Applicant's Mark is for use with board games sold as a unit. However, Registrant's mark is for use in connection with role playing game equipment in the nature of game book manuals. The different classifications of the two marks indicate their different uses and the unlikelihood of confusion.

### **II. Conclusion**

Applicant has presented sufficient arguments to establish that the Examining Attorney was incorrect in refusing to grant Applicant's registration. Applicant's Mark is not likely to cause confusion with the Registrant's mark, contrary to the Examining Attorney conclusion. Accordingly, Applicant respectfully requests that this Office approve the above application for registration.

Dated: September 18, 2016

Respectfully submitted,

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