

Final Exam for Law 227, Summer 2005

Note: The Model Answers provided here do not necessarily reflect every relevant argument or idea, and credit may have been given for other creative ideas.

Scenario One

Your firm represents the New Zealand company Kiwi Tour Group (“KTG”). Last November, you filed a United States trademark application on behalf of KTG to register HOBBITQUEST in connection with various travel-related services. A few months ago, the Examining Attorney issued an office action refusing registration. One of the Summer Associates at your firm was assigned to draft a response to the office action, and his “buddy,” a litigation associate, provided feedback. The draft now has come to you for review. The deadline for filing the response is October 4, 2005.

The file contains the following documents:

- Office Action dated April 4, 2005 (1 page)
- Printout of the TARR Status for the cited application (2 pages)
- Printout of two pages from www.hobbittravel.com (4 pages)

Office Action No. 1

The applicant seeks to register HOBBITQUEST in connection with “organizing, booking, arranging and conducting excursions, day trips, sightseeing tours, holidays, tours and travel.”

The Mark is Merely Descriptive of the Services

Applicant is located in New Zealand and, according to its web site, conducts tours of various locations in New Zealand. Of particular relevance is applicant’s tour of “the rolling countryside of South Waikato to visit the set of ‘Hobbiton’” which was featured in the movie *The Fellowship of the Ring*. The movie tells the story of how nine travelers, including among them four “hobbits,” set out on a quest to destroy the “ring of power.” Applicant’s mark immediately identifies a significant feature or characteristic of its services, that its tours relate to the sets and scenery used in depicting the hobbits’ quest in the movie *The Fellowship of the Ring*. Accordingly, the mark is merely descriptive and must be refused registration. TMEP §1209.

The Mark May Create a Likelihood of Confusion with an Earlier Mark

The Examining Attorney’s search uncovered no registered mark which would bar registration of the applicant’s mark. However, the Examining Attorney provides information on pending Application Serial No. 78/572,111, which may, if it becomes registered, bar registration of applicant’s mark. If the applicant satisfactorily addresses all other issues raised in this action, the Examining Attorney will suspend further

processing of the application pending the disposition of Application Serial No. 78/572,111. TMEP §716.02(c).

[TARR Record for HOBBIT TRAVEL omitted, details include:

Serial Number: 78572111

Mark (words only): HOBBIT TRAVEL

Current Status: Newly filed application, not yet assigned to an examining attorney.

Date of Status: 2005-03-07

Filing Date: 2005-02-22

LAST APPLICANT(S)/OWNER(S) OF RECORD

Wozniak Travel, Inc.

88 South Sixth Street, Suite 640, Minneapolis, MN 55402

GOODS AND/OR SERVICES

International Class: 039

travel agency services; namely, arranging and conducting travel tours and vacation packages; arranging air, land and sea transportation for individuals and groups; coordinating travel arrangements for individuals and for group tours; organizing packaged vacation and travel tours

First Use Date: 1976-12-00; First Use in Commerce Date: 1976-12-00]

[Website excerpt from <http://www.hobbittravel.com/> omitted, one page indicates:

The screenshot shows the top portion of the Hobbit Travel website. The header features the company name 'Hobbit Travel' in a large, stylized font, with the tagline 'The Low Fare Company' below it. To the right of the logo is an illustration of a commercial airplane. Further right, a call-to-action reads 'Call Us Today 612.338.8880 or 800.916.0000'. Below the header is a horizontal navigation menu with buttons for 'Home', 'Weekly Ad', 'Flights', 'Vacations', 'Cruises', 'Golf', 'Hotels', 'Contact Us', and 'About Us'. The main content area is split into two columns. The left column, which has a blue background, contains several promotional links: 'Welcome To Hobbit Travel.com', 'Sign Up for Our Hot Deals Email!', 'Wedding Packages', 'New Book Your Flight Online!', 'Book Your Vacation Package Online!', and 'Stay, Park & Fly Packages'. The right column features the heading 'About Us' in a blue, italicized font. Below this heading, the text reads: 'Welcome to Hobbit Travel. We are your Low Fare Company! Hobbit Travel has offered the travelers of Minnesota low fares for over 25 years. We offer special contracted rates with many airlines, cruise lines, hotels and car rental agencies and pass the savings on to you! Our special low fares are not available anywhere else. Each of our many travel consultants specialize in specific destinations. Whether you are traveling in the United States, Europe, the Caribbean or taking a cruise, We Have An Agent For You! We look forward to helping you make your travel dreams come true!

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Note: The comments on the draft response are identified by their indentation from the left margin, a vertical bar on the left side, and a different typeface.

1 AMENDMENT AND RESPONSE UNDER 37 C.F.R. §2.62

2 In response to the Office Action dated April 4, 2005, concerning the
3 above application for trademark registration, please amend the
4 application so that the recitation of services reads, in its entirety, as
5 follows: “conducting sightseeing tours in New Zealand.” All other
6 services should be deleted from the application.

7 REMARKS

8 ***Refusal of Registration.*** The Examining Attorney refused
9 registration of applicant’s HOBBITQUEST mark on the grounds that the
10 mark merely describes applicant’s services of conducting sightseeing
11 tours in New Zealand. With all due respect to the Examining Attorney,
12 the mark does not ***immediately*** convey significant information about the
13 services and therefore is suggestive and entitled to registration.

14 | Dude, this is a nice touch. It’s always a good idea to be
15 | respectful of your finder of fact (judge or otherwise).

16 First, a relevant consumer would not be able to ***immediately***
17 ascertain from the mark HOBBITQUEST that applicant’s business
18 involves sightseeing tours, much less sightseeing tours of New Zealand.
19 Accordingly, the mark does not meet the definition of a descriptive mark.

20 Second, even if a relevant consumer were to become aware of the
21 information described in the office action, she still would need to make a
22 number of mental leaps before being able to determine the meaning of the
23 HOBBITQUEST mark in relation to the services. As the Examining
24 Attorney points out, the recently released motion picture The Fellowship
25 of the Ring was filmed in New Zealand. And the story of the movie
26 involves “hobbits,” fictional beings who inhabited a fictional Middle
27 Earth. And the story also involves a quest undertaken by four hobbits,
28 along with two men, one elf, one dwarf, and one wizard, to destroy a ring.
29 As is apparent from the Examining Attorney’s argument, the connection
30 between hobbits (and others) undertaking a quest in a fictitious Middle
31 Earth, on the one hand, and a tour of present day New Zealand, on the
32 other, is tenuous and indirect. This “piecing together” of information to
33 derive meaning is the hallmark of a ***suggestive*** rather than a ***descriptive***
34 mark.

35 | Are you maybe giving this theory too much credence
36 | here? How many Americans even know that the film was
37 | made in NZ? Our fellow countrymen are notoriously ill-
38 | informed about geography, and I’m sure a lot of people
39 | would think it was made in Europe. People who know

40 anything about the books know they were written by a
41 Brit.

42 I think you should try to put the burden on the Examiner
43 to show that most people associate Middle Earth with New
44 Zealand, otherwise, our client should get the mark.

45 Third, the mark should be considered ambiguous due to the
46 multiple meanings of the word “hobbit.” In addition to the storybook
47 characters referenced by the Examining Attorney, there have been
48 numerous news reports during the past year regarding the discovery of a
49 specimen of a short species of human, dubbed “the hobbit,” on the
50 Indonesian island of Flores. See Exhibit 1 (articles TBD). Accordingly,
51 consumers encountering the HOBBITQUEST mark may well interpret it as
52 suggesting an archaeological expedition. The Federal Circuit and TTAB
53 have ruled that a word or phrase capable of multiple interpretations
54 cannot convey the kind of “immediate” information necessary to be
55 refused registration as merely descriptive.

56 Fourth, the mark should be deemed suggestive due to its peculiar
57 and ungrammatical structure, which forces readers to perform additional
58 “mental processing” in order to derive its significance. The mark
59 HOBBITQUEST might equally be thought to refer to a quest *by* a hobbit,
60 or a quest *to find* a hobbit. What the mark does *not* immediately convey is
61 the notion of a quest by nine travelers, four of which are hobbits, in a
62 literary work, much less a sightseeing tour of present day New Zealand.

63 For all of these reasons, applicant’s mark should be considered
64 suggestive rather than descriptive, and the Examining Attorney should
65 withdraw the refusal of registration.

66 Nice work! An unfair comp case I handled a while back
67 leads me to suggest a couple more arguments. The first
68 is that competitors in the field of conducting tours in New
69 Zealand do not use the mark HOBBITQUEST in connection
70 with their services. A little Googling shows that various
71 companies offer “middle earth” and “fellowship” and “Lord
72 of the Rings” tours, but I didn’t find anyone using
73 HOBBITQUEST. Maybe the client can give a declaration?
74 Second, you would want to argue that competitors do not
75 need to use HOBBITQUEST. In other words, there are
76 plenty of ways to brand this type of service without using
77 that phrase. In a court case, this could help avoid an
78 injunction, so I can’t help but think it will help win over
79 the Examiner.

80 ***Citation of Pending Application.*** The Examining Attorney
81 reported that she might refuse registration of applicant’s HOBBITQUEST
82 mark if the pending application for HOBBIT TRAVEL (the “111
83 application”) were to mature to registration. For the reasons that follow,
84 there is no likelihood of confusion between the two marks, and therefore

85 applicant's mark should be approved for publication without awaiting the
86 disposition of the 111 application.

87 First, in comparing the marks, there is a significant difference in
88 appearance, sound, meaning, and overall commercial impression. In
89 particular, the words QUEST and TRAVEL contain almost no overlap of
90 letters, and sound nothing like one another. While the word "travel"
91 blandly refers to movement from one place to another, the term "quest"
92 calls to mind bold adventures, with or without a long journey. The marks
93 could not be more different.

94 | I think it's common to argue the "strength" factor next.
95 | Shouldn't we point out that TRAVEL is a generic term in
96 | relation to the earlier applicant's travel agency services?

97 Second, there is no overlap between the parties' goods. The
98 applicant draws the Examining Attorney's attention to the amendment of
99 its recitation of services to "conducting sightseeing tours in New
100 Zealand." To "conduct," in the context of sightseeing tours, means "to
101 lead" or "to guide"; it is somewhat synonymous with the word "to
102 accompany." While the 111 application mentions "conducting travel
103 tours," this phrase should be understood in its full context: "travel agency
104 services; namely, arranging and conducting travel tours and vacation
105 packages." The fact is, travel agents do not "lead" or "guide" or
106 "accompany" tours — they sell them on behalf of others. Inasmuch as the
107 entire wording must be interpreted in a sensible manner, the Examining
108 Attorney should disregard the phrase "and conducting" in the 111
109 application.

110 Furthermore, the use of HOBBIT TRAVEL is, in fact, limited to
111 travel arrangements in the United States, Mexico, the Caribbean and
112 Europe. See Exhibit 2 (website printout in file). New Zealand, located to
113 the South of Australia, is about the furthest habitable point on Earth from
114 the destinations booked by the HOBBIT TRAVEL agency. Accordingly,
115 the Examining Attorney should not stretch the recitation of services in the
116 111 application to reach "sightseeing tours in New Zealand." Instead, the
117 Examining Attorney should resolve any uncertainty about the scope and
118 use of the earlier applicant's mark by approving this application for
119 publication, and letting the public decide whether to file an opposition.

120 | A trip to New Zealand from the United States costs
121 | several thousand dollars and may be a once-in-a-lifetime
122 | journey. Shouldn't we make the argument that
123 | purchasers will exercise a high degree of care in choosing
124 | a tour so that they can make sure they are spending their
125 | vacation time and dollars wisely? I'm fairly certain this is
126 | a valid argument under the LOC test used in the Federal
127 | Circuit these days.

128 Third, the two companies have used their respective marks
129 simultaneously for several years without any actual confusion.
130 For all of these reasons, the Examining Attorney should withdraw
131 the citation and approve this application for publication.
132 | Congratulations! Now, don't let your next four weeks
133 | with the business department dull your fighting spirit. ;-)

Note: For short essay answers, 5 points are for correctly spotting and explaining the issue, and up to 2 more points may be awarded for crispness and/or thoroughness of the answer. (Partial credit may have been given for making relevant points but not spotting the issue.)

Q1. Consider the first argument in response to the descriptiveness rejection (lines 16-19). Briefly describe the most glaring reason that this argument must fail. Please answer in a blue book or in the exam software, referring to Q1.

5-7 points: The first argument states, essentially, that consumers could not guess the services from merely being exposed to the mark. This "blindfold" argument is not the correct test: the mark must be considered in the context of the services as described in the application.

Q2. Consider the second argument in response to the descriptiveness rejection (lines 20-34). How good are the prospects for success in overcoming the refusal of registration based on this argument?

- A. Very good, because the "imagination test" is sanctioned by the TMEP as the appropriate test to differentiate a suggestive mark from a merely descriptive one.
- B. Not very good, because applicant's recitation of services is broad enough to cover tours of Hobbiton, and no mental gymnastics are required with respect to at least that subset of services.
- C. Very good, because relevant consumers planning a trip rely on "real world" information about the destination, rather than works of fiction.
- D. Not very good, because pervasive media hype about the Lord of the Rings trilogy would cause relevant consumers to draw the connection pretty quickly, if not actually immediately.
- E. It depends on whether KTG's sightseeing tours reenact any of the scenes from the movie, rather than on the scope of services in the application.

5 points: Answer B is best, and this is highlighted by the very wrong Answer E – the issue is whether the mark describes any significant characteristics of the services, and a logical subset of the services is tours of Hobbit-related destinations. One student pointed out that

there is no such place as Hobbiton; true, but there is a place that was Hobbiton in the movie, and that is one of the places visited by the tour. Answer C could be a reasonable answer, but there is no evidentiary basis for it in the draft response. Answer D would seem to concede suggestiveness, if the connection is not "actually [made] immediately," and is thus self-contradictory. Answer A, correct as far as it goes, very tempting in light of the well-reasoned draft response, and by far the most popular answer, is too conclusionary and does not present a reason that the Examiner would should agree with the argument.

- Q3. Consider the comment on the second descriptiveness argument (lines 35-44). Assuming that you were only able to submit evidence of (i) Americans' general ignorance of geography and (ii) author J.R.R. Tolkien's nationality, how much might the litigation associate's suggested argument help in overcoming the descriptiveness refusal (when combined with or added on to the Summer Associate's argument)?**
- A. A good deal, since the Examining Attorney has the burden of proof to "connect the dots," and this evidence would increase the pressure on the Examining Attorney to come forward with actual evidence of the awareness of relevant consumers that the films were shot in New Zealand.**
 - B. Hardly, because customers will eventually reach the pages on applicant's web site making the direct connection between the shooting of the Lord of the Rings films and the sightseeing tours.**
 - C. A good deal, because consumers will not perceive a descriptive meaning if the connection is "remote or obscure," by analogy to the analysis of marks containing geographic elements.**
 - D. Hardly, since the portion of the public that is relevant for purposes of the descriptiveness analysis would be limited to those evaluating sightseeing tours in New Zealand.**
 - E. It would backfire and solidify the refusal, because the Examining Attorney could then show that the special features included on the DVD revealed the location.**

5 points: This question is difficult to parse because it asks "how much" an *argument* might help when only a limited subset of *evidence* supporting that argument is submitted. The answer thus depends both on the argument suggested *and* on the persuasiveness of the evidence, not on the evidence along. For that reason, Answer A is best. It is true that the Examining Attorney has the burden of proof, and she would need to respond to the applicant's evidence, no matter how seemingly useless it might be. Answer D is a close second, because it contains an excellent point – people interested in sightseeing tours of New Zealand presumably are more knowledgeable about New Zealand than the average ill-informed America. Nevertheless, even people interested in

traveling to New Zealand might not make the Lord of the Rings connection, and the Examining Attorney has the burden of proof. Answers B and E, suggesting that at some point consumers would have an "Aha!" does not support the immediacy required to refuse registration. Answer C seems logical, but the analogy is flawed: the question is not whether the HOBBITQUEST mark has a primary geographic significance, but whether consumers would immediately recognize a descriptive meaning of the mark in relation to sightseeing tours of New Zealand, and New Zealand certainly is not remote or obscure.

- Q4. Suppose that in your efforts to strengthen the argument discussed in Q3 that your research uncovers some news stories along the following lines: about five years ago, some University researchers set out the debunk the claim of several industry unions that moving production out of the United States to Toronto, Vancouver, Sydney, and other locations with lower labor costs, would damage the appearance of authenticity in American films. 1,132 citizens were polled at random and asked to identify certain locations in the popular films Titanic (1997), As Good as It Gets (1997), Primary Colors (1998), Being John Malkovich (1999), Boys Don't Cry (1999), and Erin Brockovich (2000). Respondents accepted the authenticity of interior locations 100% of the time, and of exterior locations 93% of the time, regardless of their actual locations. Does this evidence disprove the Examining Attorney's implicit assertion that relevant consumers will equate Middle Earth with New Zealand?**
- A. Yes, the remaining 7% is just noise.**
 - B. No, there is no "authentic" Middle Earth to compare, so this poll would give invalid results if it were run for Fellowship of the Ring.**
 - C. Yes, it tends to suggest that moviegoers accept what they're told in the film, and the Fellowship of the Ring does not refer to New Zealand.**
 - D. No, even if viewers accept that New Zealand looks like what they imagine Middle Earth looked like, they might know full well where it was shot.**
 - E. Because a survey constitutes hearsay evidence, this article would not even be considered.**

5 points: Answer D is best. The survey proves that filmmakers almost always succeed in creating the illusion of a particular location, but it does not prove that consumers are ignorant or will ignore information they receive through other means about the production location. Answer A gives too much relevance to the survey, and Answer C ignores other means of education of moviegoers (such as reviews and the applicant's own promotional information). Answer E is too extreme. The most popular answer, Answer B, misses the critical point, which was set out in Answer D.

- Q5. Consider the third argument in response to the descriptiveness rejection (lines 45-55). Which of the following would be necessary to give this argument a chance to succeed?**
- I. Evidence that this scientific discovery was widely reported, so that it would be plausible that relevant consumers might think of this “hobbit” in addition to the ones in the Lord of the Rings.**
 - II. Evidence that there are at least one or two more “hobbit” skeletons to be excavated, so that it would be plausible that one might undertake an archaeological “quest” to do so.**
 - III. Revising the recitation of services to cover lands where this new species of humans might be found.**
- A. Both I and II.**
 - B. Both II and III.**
 - C. Both I and III.**
 - D. I, II, and III.**
 - E. None of the above.**

5 points: Answer C is best. Proposition II is not *necessary* because archaeological digs often are based merely on hunches, without specific evidence of the presence of fossils. In fact, many quests involve setting off into the “unknown.” The other two propositions do appear necessary: if the public never heard about this discovery, then the second meaning would not occur to them, and if the sightseeing tours are limited to countries where archaeologists have no expectation of finding these other “hobbits,” then the second meaning would not be relevant to the applied-for services. On the other hand, if you were introducing evidence that Americans are ill-informed about geography (discussed in Q3), you might be tempted to say that proposition III isn’t really *necessary*. However, it is preferable not to rely on an argument that consumers might misunderstand your mark in relation to your goods to avoid getting in trouble with deceptive misdescriptiveness.

- Q6. Consider the fourth argument in response to the descriptiveness rejection (lines 56-62). Let’s assume that you cite the TTAB’s decision in the case involving ZEROSURGE for surge suppressors, which supports the argument that an ungrammatical construction can render a mark suggestive. Is the argument likely to be persuasive?**
- A. Not really, because HOBBITQUEST is readily dissected into its parts and interpreted from there.**

- B. Yes, the dictionary defines a quest as a search, so an analogy to the puzzling phrase HOBBITSEARCH would show that a little extra thinking would be needed to process the terms out of order.**
- C. Not really, because consumers would either have one of the listed interpretations or the other, and not get bogged down in choosing.**
- D. Maybe, but more evidence and/or argument would need to be presented as to why it was such an unusual or incorrect usage in order to make the argument work.**
- E. Never, because it is not listed as a factor to consider in the TMEP.**

5 points: Answer D is best, by process of elimination. Both Answer A and Answer C involve an extra step in the chain of reasoning, so neither supports the view that the mark provides *immediate* information. Answer B makes an argument that is missing an essential step: will consumers interpret the word QUEST as the word SEARCH? Just because a term has a particular dictionary definition does not mean it would be interpreted that way in the context of the services and the rest of the mark. Thus, this is not the best answer. Finally, Answer E is incorrect because TTAB and Federal Circuit rulings are controlling authority in the examination process, whether or not those rulings are codified in the TMEP.

Q7. Consider the comment following the descriptiveness arguments (lines 66-79). What impact are these arguments likely to have on the Examining Attorney?

- A. A significant impact, because the first film in the Lord of the Rings trilogy was released in the Fall of 2001, so there has been ample opportunity for third parties to use HOBBITQUEST, and their failure to do so proves that the phrase is not necessary to compete.**
- B. Very little, because even if the applicant was the first or is the only present user of the mark, that does not render it distinctive.**
- C. A significant impact, if KTG can persuade some of its competitors to submit declarations in support of its having obtained secondary meaning in the mark.**
- D. Very little, because others must have the right to make fair use of a descriptive mark.**
- E. None, because it is not listed as a factor to consider in the TMEP.**

5 points: Answer B is best, despite the long period of non-use by others. Examiners are reluctant to rely on competitors' need and competitors' use arguments in the *ex parte* process because third parties are not able to submit evidence of need or use. Moreover, as a logical matter, even if lack of use by others shows the availability of suitable alternatives, and therefore an absence of "need," it does

not show that a term or phrase is not descriptive or that it has attained secondary meaning. For that reason, Answer A is second best. Answer C raises issues from an entirely different context, the argument that HOBBITQUEST has attained secondary meaning. There is no other argument or evidence in support of that point, so the declarations in Answer C would not be applicable. Answer D is a red herring, since the right to make classic fair use never prevents registration of a mark that is or has become distinctive as applied to the applicant's goods. Finally, Answer E is incorrect because TTAB and Federal Circuit rulings are controlling authority in the examination process, whether or not those rulings are codified in the TMEP.

Q8. The draft response does not make any argument that combining "HOBBIT" and "QUEST" creates a mark that is "incongruous" or has a "double entendre." Does the reasoning behind allowing registration of the following marks—which combine words that are not themselves distinctive in relation to the goods or services—apply to the compound mark HOBBITQUEST? Briefly explain why or why not. (Answer here or, if you prefer, in a blue book or in the exam software, in which case you should refer to Q8(1), Q8(2) and Q8(3), respectively.)

(1) MOUSE SEED

5-7 points: The mark MOUSE SEED, for use in connection with mouse poison, was deemed "incongruous." The word MOUSE was considered descriptive for the vermin who would be eating the poison, and the word SEED was considered descriptive for the small shape of the pellets. However, the combination was considered "bizarre" because compared with a more common term like "sunflower seeds," which is life-giving either to sunflowers or to people as food, MOUSE SEED refers to a poison.

It is difficult to think of any similar "incongruity" in the mark HOBBITQUEST for use in connection with sightseeing tours. The word QUEST is consistent with travel, and there is nothing about combining QUEST with the word HOBBIT that would strike a relevant consumer as bizarre.

(2) LA YOGURT

5-7 points: The mark LA YOGURT, for use in connection with yogurt, was deemed "incongruous." The French-language prefix LA is not any more distinctive than the English-language prefix THE, and the word YOGURT is generic in connection with yogurt. However, the combination of French and English-language words would cause consumers to pause and think, which breaks the immediacy of what otherwise might be considered a descriptive phrase (THE YOGURT).

Relevant consumers are unlikely to think of HOBBIT as being a foreign-language word. As the recently invented name of a fictional creature, HOBBIT is a word that would be the same in all languages. Also, the name was coined by an Englishman, so even if one could imagine HOBBIT

being "translated" into other languages, the word HOBBIT does not require any translation in the United States. Thus, when combined with the English-language word QUEST, the mark is not similar to the incongruous combination LA YOGURT.

(3) SUGAR & SPICE

5-7 points: The mark SUGAR & SPICE, for use in connection with bakery goods, was deemed to contain a "double entendre" or double meaning. The individual words in the mark – SUGAR and SPICE – merely name ingredients of bakery goods, but when combined in the form of SUGAR & SPICE, they call to mind the nursery rhyme whose next line is "and everything nice." Because an appreciable number of consumers are likely to make the nursery rhyme connection, the mark is not merely descriptive.

HOBBITQUEST is not like SUGAR & SPICE because combining HOBBIT and QUEST does not change the significance of the individual words or call to mind some other meaning. The whole is not greater than the sum of the parts. [The opposite argument, if well made, also was accepted.]

Q9. Arguing that a mark is not descriptive always involves some degree of risk that the Examining Attorney will, in a second office action, refuse registration on the ground that the mark is deceptively misdescriptive under Lanham Act §2(e)(1). What arguments, if changed or added, would reduce this risk?

- I. Stop denying that the phrase merely describes *some* sightseeing tours of New Zealand.
 - II. In a footnote, point out that movie viewers know hobbits do not actually exist, so relevant consumers would not believe that there are tours where they can find and see actual living hobbits.
 - III. In a footnote, point out that New Zealand is brimming with beautiful natural and cultural attractions, so the inclusion or exclusion of purported "hobbit" content from a particular tour package would not materially affect a consumer's decision to purchase it.
- A. I only.
 - B. II only.
 - C. III only.
 - D. I and II together, but not III.
 - E. II and III together, but not I.
 - F. None of the above.

5 points: Answer F is best, but no one chose it. Proposition I is an element of the test for deceptive misdescriptiveness – that the mark

describes *something* (something other than the applicant's goods or services). Thus, that argument or lack thereof would make the situation worse, not better. Proposition II is not relevant to the Examining Attorney's argument, which is that the descriptiveness arises from the sets and scenery associated with the hobbits' quest. Even if relevant consumers know that hobbits are fictional creatures, the mark could be interpreted to promise a tour that retraces their journey in the film, which would support a deceptive misdescriptiveness refusal. So Proposition II simply doesn't help. Proposition III refers to the materiality requirement for a deceptive mark under Lanham Action section 2(a), and is not relevant to the test under section 2(e)(1).

Q10. Consider the first argument in response to the potential likelihood of confusion rejection (lines 87-93). In what way(s) is this argument flawed?

- I. It admits that, at least in some cases, a quest involves travel, and therefore admits that the marks are legally identical.
 - II. It simply ignores half of the mark and, as a result, fails to explain why the marks are different when considered as a whole.
 - III. It analyzes the meaning of the words travel and quest "out of context," rather than in relation to the services listed in the applications.
- A. Both I and II.
 - B. Both II and III.
 - C. Both I and III.
 - D. I, II, and III.
 - E. None of the above.

5 points: Answer B is best. Proposition II points out a classic failing of this type of argument, which is focusing the entire emphasis on a part of the mark rather than comparing the marks as a whole. Proposition III is similarly on point because a "sightseeing tour" is more like travel than like the "bold adventure" the argument cites. However, proposition I is too extreme: even if the meaning were admitted, in some respects, to be identical, the overall appearance and sound were not.

Q11. Consider the comment after the first likelihood of confusion argument (lines 94-96). It would be easy to demonstrate that "travel" is a generic term in relation to the earlier applicant's travel agency services. Would making this argument help or hurt KTG's effort to overcome the potential refusal?

- A. Help, because a weak mark is given the narrowest scope of protection.

- B. Hurt, because the non-generic element them would become “dominant,” and that would make the overall comparison less favorable to KTG.
- C. Help, because if HOBBIT is descriptive, then the entire HOBBIT TRAVEL mark consists of unprotectable elements and, assuming there is no incongruity or double meaning to the phrase as a whole, it can be disregarded by the Examining Attorney.
- D. Hurt, because the Examining Attorney then would argue that quest, too, is generic, which could have negative implications in later litigation to enforce rights in KTG’s mark.
- E. Neither — the strength of a mark is not listed in TMEP §1207.01 as part of the limited six factor likelihood of confusion test applied in trademark prosecution, so it would be ignored.

5 points: Answer B is best. If the dominant portion of the earlier-filed mark is HOBBIT, and the commercial impression of the mark on relevant consumers is HOBBIT, then it is more difficult to differentiate HOBBITQUEST from the earlier-field mark than if consumers are giving significant weight to both elements of the mark. Answer A conveniently ignores the fact that the mark contains other wording, and that the argument therefore does not prove that the mark is weak as a whole. Answer C reaches the wrong conclusion; the Examining Attorney can never “disregard” a pending application or registered mark on the grounds that it is unprotectable. Answer D, the second most popular, is beyond the scope of the question: it specifically asks whether the argument would help in overcoming the refusal, so consequences in later litigation are not relevant. Answer E mistakes the TMEP’s list of the “most relevant” factors for a binding test that excludes other *DuPont* factors; in fact the Examining Attorney is required to consider evidence on the strength of the marks if submitted by the applicant.

Q12. Consider the second argument in response to the potential likelihood of confusion rejection (lines 97-109). What do you see as the problem(s) with this argument?

- I. The Examining Attorney can consider a wide range of evidence in determining the meaning of the services in an earlier application, but disregarding a phrase deemed to be incorrect would conflict with her obligation to maximize protection for the earlier mark.
- II. The services normally provided under the rubric of “travel agency services” is a question of fact, so there is a lack of evidentiary support for the argument in the current draft.
- III. Even if the phrase “and conducting” were disregarded as requested, the change from overlapping services to related services

cannot, under the TMEP and applicable law, have any effect on the likelihood of confusion analysis.

- A. Both I and II.
- B. Both II and III.
- C. Both I and III.
- D. I, II, and III.
- E. None of the above.

5 points: Answer A is best. Proposition III is too extreme – while relatedness is a factor in the likelihood of confusion test, the *degree* of relationship is relevant to an assessment of whether the marks are so similar that confusion is likely. Propositions I and II seem inconsistent, in that the first says that this argument simply has no chance as a legal matter, while the second seems to imply that it could succeed if there were more evidence. However, both are simply *independent* problems that undermine the argument, so the seeming conflict should not lead one to choose Answer E.

Q13. Consider the “furthermore” argument in response to the potential likelihood of confusion rejection (lines 110-119). Assume that the facts stated in the argument about the actual use of HOBBIT TRAVEL are true, and forgive the slight exaggeration about the distance between those destinations and New Zealand. Why is the Examining Attorney nevertheless likely to reject this argument?

- I. The 111 application does not need to be “stretched” to cover New Zealand because it contains no geographic limitations.
 - II. Arguments based on lack of use of a cited mark in connection with some or all of the services belong in a TTAB or court proceeding, and will not be decided in the examination process.
 - III. The three year presumption of abandonment doesn’t start running until the earlier mark becomes registered, so the non-use argument is simply premature.
- A. I only.
 - B. II only.
 - C. III only.
 - D. I and II together, but not III.
 - E. II and III together, but not I.
 - F. None of the above.

5 points: Answer D is best. Proposition I credits the Office practice of giving the earlier applicant the full scope of its recitation of services, regardless of actual use. Proposition II correctly states the rule against “collateral attacks” during the *ex parte* examination process. Proposition III may be relevant in a TTAB proceeding, but is not a point that the Examining Attorney would ever consider, since non-use abandonment is not a valid reason to disregard an earlier-filed application during the examination of a later-filed application.

Q14. Continuing the scenarios of Q12-Q13, your legal research reveals a potential basis on which to challenge the 111 application: an opposition alleging fraud on the PTO. Your client KTG would have to prove the following elements with clear and convincing evidence: (1) the statement in the 111 application that the HOBBIT TRAVEL mark is in use in connection with all of the listed services was either (a) literally false or (b) contained a willful omission; (2) the false statement or willful omission is material because the PTO would have acted differently had the true or complete information been filed; and (3) the applicant knew (or should have known) that the statement was false. Might such an opposition aid in responding to the pending office action?

- I. The failure to specify North and Central America, the Caribbean and Europe was *not* fraudulent, because a travel agency’s use of a mark depends not on the number of destinations booked, but the locations of its customers.
 - II. If an investigation proves that HOBBIT TRAVEL was not used in connection with “conducting tours” at the time of filing, then that false statement *was* fraudulent because the PTO could not grant registration without a sworn allegation of use for all of the services.
- A. Only I is correct, so No.
 - B. Only II is correct, so Yes, *if* the application is published for opposition in the very near future.
 - C. Both I and II are correct, so Yes, to some extent, *if* the application is published for opposition in the very near future.
 - D. No, because even if the mark had not been used for “conducting tours,” TMEP §806.03(c) would have allowed the Examining Attorney to convert those goods to an “intent to use” basis upon request before publication.
 - E. None of the above.

5 points: Answer C is the best choice in this complicated scenario. Proposition I considers the argument that the services *omit* information about the destinations booked by the earlier applicant. This omission would be material if the Examiner would differentiate among the destinations had they been stated. But even if the applicant

had listed those particular destinations, the application would have been treated the same. Moreover, it's difficult to make out a case of intent-to-mislead or knowledge of falsity. It is fairly common for applications to contain broad wording (such as "travel agency services") when the industry is not separated into different sub-markets, and with respect to that broad phrasing, the applicant legitimately can claim use of its mark as long as its services are in commerce that Congress can regulate. While proposition I is not a complete or even especially clear statement of this reasoning, it is correct.

Proposition II is more straightforward: claiming use of a mark on services for which the mark is not in use allows the applicant to satisfy the use requirement in the original filing, without undertaking the usual later submission of proof required in intent-to-use (§1(b)) application. Thus the outcome of the case could have been different had the applicant been truthful, and the TTAB has been fairly strict about sorting out the goods and services for which the mark has been used from those for which it hasn't. *See, e.g., Medinol Ltd. v. Neuro VasX*, Supplement p. 35.

For these reasons, Answer A is incorrect and Answer B is second best. Answer D exonerates the applicant too easily when it "should have known" that its statement was false. Answer E could have been correct if not for the qualifying phrases on Answers B and C about timing: an opposition could only aid the applicant in its response if commenced before that response is filed.

- Q15. Consider the comment before the third likelihood of confusion argument (lines 120-127). It would be easy to demonstrate the long flight time and high airfare involved in traveling to and from New Zealand. Supported by that evidence, would this proposed argument about purchaser care play a significant role in the Examining Attorney's likelihood of confusion analysis in this case?**
- A. Yes, the exercise of care by purchasers is one of the six likelihood of confusion factors that made the short list in TMEP §1207.01.**
 - B. Yes, if the argument is also supported by evidence showing that people carefully research overseas vacation packages before purchasing them.**
 - C. No, the website at www.hobbittravel.com constantly emphasizes "low fares," so even if KTG charges high prices, there could be reverse confusion among customers using HOBBIT TRAVEL services.**
 - D. No, unless both applications are amended to refer to expensive tours.**
 - E. Frankly, it is impossible to say because the balancing test is very subjective.**

5 points: Answer D is best, following the reasoning of the *In re Opus One* case, but no one chose it. The "real" facts take a back seat to

the recitations of services in the two applications, which do not contain any restrictions as to price. Answers A and B ignores the possibility of confusion among customers of the earlier applicant, whose products may not require such a careful purchasing process. Answer C recognizes that possibility, but is second best because the more important consideration in the examination process is the recitation of services rather than the actual current use. Answer E should strike you immediately as nonresponsive!

Q16. Consider the third argument in response to the potential likelihood of confusion rejection (lines 128-129). Assume that this is expanded to explain that both companies operate on the internet, that HOBBITQUEST sightseeing tours also are sold by independent travel agents in various U.S. cities, and that KTG has never received any inquiries evidencing consumer confusion. Why is the Examining Attorney nevertheless likely to reject this argument?

- I. It is not possible to obtain a complete picture of whether there have been incidents of “actual confusion” without hearing from the owner of the 111 application, and the PTO has no procedure for obtaining that information.**
 - II. Past experience reflects a narrower geographic usage of HOBBIT TRAVEL than the 111 application describes, and the Examining Attorney needs to consider whether confusion is likely if HOBBIT TRAVEL is used to the full extent of its recited services.**
 - III. The Examining Attorney must decide whether there is a likelihood of confusion in the future, and past coexistence is irrelevant because as consumers’ memories of the Lord of the Rings trilogy fade, they will find the similarity of the marks much more striking.**
- A. Both I and II.**
 - B. Both II and III.**
 - C. Both I and III.**
 - D. I, II, and III.**
 - E. None of the above.**

5 points: Answer A is best. Propositions I and II accurately describe the Trademark Office’s approach to analyzing evidence of a lack of actual confusion. Proposition III implies that future changes in the public’s understanding of the HOBBIT element of the marks may change them from having a referential quality to have a more fanciful quality, thus rendering them more similar. Such a speculative suggestion is not the type of argument an Examiner would made in rejecting evidence of the lack of instances of actual confusion.