

# BLAZIER CHRISTENSEN BROWDER & VIRR

A PROFESSIONAL CORPORATION  
ATTORNEYS AND COUNSELORS

JOHN C. BLAZIER  
FLEUR A. CHRISTENSEN  
THOMAS F. VIRR\*\*  
PAUL K. BROWDER  
JUSTIN M. WELCH  
JONATHAN S. CONNOR  
JOHN P. FERGUSON

BARTON OAKS PLAZA  
901 S. MOPAC EXPY., BLDG. V, STE. 200  
AUSTIN, TEXAS 78746

WWW.BLAZIERLAW.COM

TELEPHONE (512) 476-2622  
FACSIMILE (512) 476-8685

\*\*BOARD CERTIFIED-TAX LAW, TEXAS BOARD  
OF LEGAL SPECIALIZATION

writer's direct e-mail: [jwelch@blazierlaw.com](mailto:jwelch@blazierlaw.com)

March 10, 2017

Mr. Matthew J. Cuccias  
Trademark Examining Attorney  
Law Office 116  
P.O. Box 1451  
Alexandria, Virginia 22313-1451

*Via TEAS*

Re: Proposed amendments for application, serial no. 76 / 719477, for the Mark IRON WORKS, on behalf of The Iron Works Barbecue, Inc.

Dear Mr. Cuccias:

Pursuant to your Office Action letter for the above Mark, please consider the following in support of issuing an approval for its publication:

### **Likelihood of Confusion & Consent Agreement.**

The PTO refused registration claiming a likelihood of consumer confusion with the marks in U.S. Registration Nos. 4,731,387 and 4,731,609 for IRONWORKS and the following logo, respectively:



The marks are registered to the same owner, and used for “hotel services.”

The Office Action letter contends Applicant’s use of IRON WORKS for “restaurant services” would be likely to cause consumer confusion, arguing “[i]t is common for hotels to offer restaurant services.” Applicant respectfully disagrees that confusion is likely based on this contention. However, instead of addressing the contention directly at this time, Applicant has obtained the attached Consent Agreement from the Registrant of IRONWORKS and the corresponding logo.

Trademark Manual of Examining Procedure §1207.01(d)(viii) recognizes case law from the Federal Circuit for the proposition that “consent agreements should be given *great weight*,

and that the USPTO *should not substitute its judgment concerning likelihood of confusion for the judgment of the real parties in interest* without good reason.” The TMEP cites the Federal Circuit’s opinion in *In re E.I. du Pont de Nemours & Co.*, holding

“when those most familiar with use in the marketplace and most interested in precluding confusion enter agreements designed to avoid it, the scales of evidence are clearly tilted. It is at least difficult to maintain a subjective view that confusion will occur when those directly concerned say it won’t. A mere assumption that confusion is likely will rarely prevail against uncontroverted evidence from those on the firing line that it is not.”<sup>1</sup>

The Consent Agreement is not a “naked” one – *i.e.* an agreement with nothing more than the registrant’s consent to registration.<sup>2</sup> Rather, it cites various reasons for the Parties’ agreement that Applicant’s “use of IRON WORKS under the restrictions set forth below is unlikely to cause consumer confusion . . .” For example, Registrant recognizes that, although it does operate restaurants, they are not operated under IRONWORKS or IRON WORKS. Also, it recognizes that it is “not likely to allow [Applicant] to operate a restaurant within its hotel so as to create the impression that Iron Works is affiliated with [Registrant’s] hotel operations.” The tacit point is, that unless the restaurant is within the hotel, the Parties think source confusion is unlikely.

The agreement also recognizes that the restrictions placed on Applicant’s display of and use of IRON WORKS are sufficient to prevent a likelihood of confusion. Specifically, Applicant must display IRON WORKS “with a space between IRON and WORKS,” contrary to Registrant’s use without the space. Also, “no single letter of [IRON WORKS] may be underlined,” as is the “O” in Registrant’s logo. And finally, Applicant agreed not to “open a location within a hotel.” Again, the tacit point is, that unless the restaurant is located within a hotel, the Parties think source confusion is unlikely. When an agreement restricts use of the mark to certain markets or customers to reduce confusion, the consent agreement is given more weight.<sup>3</sup>

Please do not hesitate to call with questions or comments.

Sincerely,

  
Justin M. Welch  
For the Firm

cc: client *via email*

---

<sup>1</sup> *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1363 (Fed.Cir. 1973).

<sup>2</sup> *See* TMEP §1207.01(d)(viii) (citing *In re E.I. du Pont de Nemours & Co.*, 476 F.2d at 1362).

<sup>3</sup> *See* TMEP §1207.01(d)(viii) (citing *In re Permagrain Prods., Inc.*, 223 USPQ 147 (TTAB 1984) (finding that consent agreement that “did not restrict the markets or potential customers for their goods in such a way as to avoid confusion” was “naked” agreement, insufficient to change conclusion that confusion likely).