TTAB

Attorney Ref. No. 26992.000

Serial No. 75/334,378
Mark: OMEGA METER & Design

IN THE UNITED STATES TRADEMARK TRIAL AND APPEAL BOARD

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In re Application of :
Specialty Coating Systems, Inc. (by assignment from Alpha Metals, Inc. d/b/a Fry's Metals, Inc.) :

Serial No. 75/334,378 :

Filed August 1, 1997 :

For Mark OMEGA METER & Design

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Commissioner for Trademarks
ATTN: Trademark Trial and Appeal Board
P.O. Box 1451
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REPLY APPEAL BRIEF OF APPLICANT

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SHARON Lynch (Print name)

Sharon Lynch (Signature)

26992/000/762000.1

TABLE OF AUTHORITIES

FEDERAL CASES

Aktiebolaget Electrolux v. Armatron International, Inc., 999 F.2d 1, 27 U.S.P.Q. 2d 1460 (1st Cir. 1993) 3

Barre-National, Inc. v. Barr Laboratories, Inc., 773 F. Supp. 735, 21 U.S.P.Q. 2d 1755 (D.N.J. 1991) 3

In re Buckner Enterprises Corp., 6 U.S.P.Q. 2d 1316 (TTAB 1987) 2

In re Perez, 21 U.S.P.Q. 2d 1075 (TTAB 1991) 1

ARGUMENT

1. Applicant's Mark OMEGA METER and Design is Entitled to Registration because the Examining Attorney, John Tingley, Esq., Previously Concluded that the Parties' Marks May Coexist on the Principal Register

The Examining Attorney argues that prior decisions made by Examining Attorneys are not binding upon the Trademark Office. The Examining Attorney's argument is misplaced because Applicant is not trying to enforce an Examining Attorney's decision on another Examining Attorney. Rather, Applicant requests that the TTAB reverse Examining Attorney John Tingley, Esq.'s 1998 denial of registration under Section 2(d) because such denial is inconsistent with his own decision four years earlier that there is no likelihood of confusion between the mark shown in the present application and the mark shown in the cited registration. Mr. Tingley did not provide evidence of a change in the marketplace or any other reason why he found a likelihood of confusion between the marks in 1998 when he believed that none existed in 1994. In fact, there was no change in the marketplace or any reason why there would have been a likelihood of confusion in 1998 or now.

The Examining Attorney's reliance on In re Perez, 21 U.S.P.Q.2d 1075 (TTAB 1991) is misplaced because this case does not address how to treat one Examining Attorney's inconsistent position that is unsupported by evidence. Moreover, In re Perez presents a very different factual situation from the present situation because the goods at issue in that case were tomatoes, peppers and citrus fruit. As discussed in Applicant's Appeal Brief and *infra*, Applicant's OMEGA METER and Design device costs approximately $20,000 and a decision to purchase such device from Applicant is made with extreme care and deliberation.

Accordingly, Applicant respectfully submits that the Examining Attorney's 1998 refusal be reversed, and that the refusal under Section 2(d) of the Lanham Act be removed on these grounds alone.

2. There is no Likelihood of Confusion because the Parties' Customers are Sophisticated

The Examining Attorney argues that there may be overlap between the purchasers of Applicant's goods and the goods of the cited registrant because there is a close relationship between the parties' goods. As evidence of this claim, the Examining Attorney attached copies of third party registrations that include goods similar to the parties' goods. Applicant respectfully submits that this evidence is inconclusive and does not prove that its goods are similar to the cited registrant's goods, or that they are sold in the same channels of trade.

There is no evidence in the record supporting the claim that the parties' goods are sold in the same channels of trade. In fact, the parties' goods are not sold in the same channels of trade. Rather, Applicant's goods are sold directly by Applicant or through Applicant's exclusive manufacturers and distributors, to the end users of the OMEGA METER and Design device. Neither Applicant nor its exclusive manufacturers or distributors sell the goods of any other entity, and Applicant's OMEGA METER and Design apparatus is not sold through any other channels of trade. Where, as here, there is no evidence in the record that the parties' goods are sold in the same channels of trade, the TTAB should find that the parties' goods are not sold in the same channels of trade. See In re Buckner Enterprises Corp., 6 U.S.P.Q.2d 1316 (TTAB 1987) (TTAB found parties' goods not sold in same channels of trade where Examining Attorney provided no evidence that same stores sell goods of both parties).

Applicant does not dispute that the parties' goods may be marketed towards the same potential customers. As noted by the Examining Attorney, the cited registrant sells highly specialized parts and devices for process measure and control, which may be marketed towards the same sophisticated, highly-trained and educated professional purchasers who could potentially purchase Applicant's OMEGA METER and Design device, which costs

approximately $20,000. However, Applicant respectfully submits that any likelihood of confusion as to source will be dispelled given the fact that Applicant's device is sold exclusively by Applicant or its exclusive manufacturers and distributors, so the sophisticated purchasers of such device are fully aware that they are dealing with Applicant or Applicant's manufacturers and distributors. Even if these potential purchasers are also aware of the cited registrant's goods, the extreme care used by these individuals ensures that there will be no likelihood of confusion.

3. The Parties' Long Coexistence Without Evidence of Confusion Demonstrates That There Would be No Likelihood of Confusion

Applicant agrees with the Examining Attorney's assertion that it is unnecessary to show actual confusion to establish likelihood of confusion. However, the Examining Attorney does not sufficiently weigh the absence of actual confusion, which is highly probative of the fact that no likelihood of confusion exists between the marks. Barre-National, Inc. v. Barr Laboratories, Inc., 773 F. Supp. 735, 21 U.S.P.Q.2d 1755, 1762 (D.N.J. 1991) (absence of actual confusion for seventeen years between BARR and BARRE "weighs heavily against a finding of likelihood of confusion"); Aktiebolaget Electrolux v. Armatron Int'l, Inc., 999 F.2d 1, 27 U.S.P.Q.2d 1460 (1st Cir. 1993) (absence of actual confusion after long period of coexistence is highly probative in showing that no likelihood of confusion exists). Thus, the parties' coexistence of over thirty years with no evidence of actual confusion is proof that there is no likelihood of confusion.

CONCLUSION

For all of the foregoing reasons and those previously set forth in Applicant's Appeal Brief, the Examining Attorney's refusal to register should be reversed and the application should be passed to publication.

Dated: New York, New York
September 5, 2006

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