



June 17, 2002
MAIN OFFICE

Nachman Cohen-Zedek, J.D.
 A. Tally Eitan, B.Sc., J.D.*
 Zeev Pearl, B.Sc., M.Sc., LL.B.
 Doron Latzer, LL.B.*
 Mark S. Cohen, B.A., M.S., J.D.*
 Joel M. Stein, B.A., M.B.A., J.D.*
 Iris Pappo, LL.B.
 Ellen B. Shankman, B.A., J.D.*
 Kalila Klein, LL.B., LL.M.
 Ken Lalo, LL.B., M.C.L. (Of Counsel)
 Maty Barzani, B.Sc., M.B.A., LL.B.
 Ora Rapaport-Iwanir, M.Pharm., LL.B.
 Amir M. Gruber, LL.B., LL.M.
 Daniel Bustanai, B.Sc., LL.B.
 Ujamar Rosen, LL.B., M.B.A.
 Yvirella Moshe, B.A., LL.B.
 Shalhevet Moor, LL.B., LL.M.
 Dor Cohen-Zedek, B.A., LL.B.*
 Shirley Gal Zaken, B.A., LL.B.
 Linda Reiss Wolicki, B.A., J.D.*
 Ohad Mayblum, B.A., LL.B.
 Yosi Barkai, B.Sc., LL.B.
 Hili Feferman, LL.B.
 Haleli Barath, LL.B.
 Irad Rekem, B.A., LL.B.
 Eil D. Clark, B.A., J.D.
 Hila Laufer, LL.B.
 Oded Rehan, LL.B.
 Hanni Rosenzweig, B.A., LL.B.
 Tal Frieman, LL.B.
 Alon Hillu, LL.B., B.A.
 Gal Sperber, B.A., LL.B.
 Sara Gillis, B.A., LL.B.*

Patent Attorneys:

Heidi M. Brun, B.S., M.S.
 Lihu Kolton, B.Sc., M.Sc., Ph.D.
 Miriam Paton, B.Sc., M.Sc.
 Ricki Abboudi, B.A., M.S., Ph.D.
 Adele Marcus, B.A.

Of Counsel (Patents):

Daniel J. Swirsky, B.Sc.
 Rachel Bentov, B.Sc., M.Sc.
 David Klein, B.A., M.S.

Admitted in Other Jurisdictions:

Robyn S. Lederman, B.A., J.D.
 Vladimir Sherman, B.E.E., J.D.
 Caleb Pollack, B.S.E., J.D.

Technology Specialists:

Yael Webb, B.Sc., M.A., Ph.D.
 Naomi Liver, B.Sc., M.Sc., M.B.A.
 Ronit Zango, B.Sc., M.Sc., LL.B.
 Irit Gordon, Ph.D.
 Osnat Bar-Peled, Ph.D.
 Vardit Segal, B.Sc., M.Sc.

Shlomo Cohen-Zedek (1906-1997)
 Dr. Erich Rapaport (1928-2001)

*also admitted in other jurisdictions

ADVOCATES, NOTARIES and PATENT ATTORNEYS

Main Office:

2 Gav Yam Center, 7 Shenkar St.,
 POB 12688, Herzliya 46733, ISRAEL
 Telephone: 972-9-9709000
 Facsimile: 972-9-9709001
 main@technolawgy.co.il

Haifa Office: Omega Center,
 Advanced Technology Center,
 Haifa 31905 ISRAEL
 Telephone: 972-4-8550917
 Facsimile: 972-4-8550918
 haifa@technolawgy.co.il

VIA HAND

BOX TTAB – NO FEE
 The Assistant Commissioner for Trademarks
 United States Patent and Trademark Office
 2900 Crystal Drive
 Arlington, Virginia 22202-3513
U.S.A.

Re: Applicant: NUR MACROPRINTERS LTD.
 Mark: NUR
 Serial No.: 75/638992
 Appeal Filed: April 18, 2002
 Atty. Dkt No.: 970027-12-03

Dear Sir:

Enclosed herewith is a Brief on Appeal. If any fee is required, please charge our Deposit Account No. 500810.

Very truly yours,

Avital (Tally) Eitan
 Attorney for Applicant
 Registration No. 129,566

c/o LANDON & STARK ASSOCIATES
 One Crystal Park - Suite 210
 2011 Crystal Drive
 Arlington, VA 22202-3709
 USA

israel\nur\12-03\fee-appeal.doc (mw) (17/06/02: 1)

02 JUN 17 AM 9:20

02 JUN 19 AM 8:33

TRADEMARK TRIAL AND APPEAL BOARD

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In re application of:

Applicant: Nur Macroprinters Ltd.

Mark: **NUR**

Serial No.: 75/638992

Appeal Filed: April 18, 2002

Attorney Dkt. No.: 970027-12-03

BOX TTAB – NO FEE

Assistant Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

BRIEF ON APPEAL - INDEX

1. PROCEDURAL BACKGROUND-----	1
2. SUMMERY OF FACTS-----	2
3. ARGUMENT-----	3
A. The Examiner refused to recognize the significant differences between the goods, buyers and channels of trade which overcome any likelihood of confusion between the marks-----	3
B. The respective goods are sold to highly sophisticated purchasers who are not confused by the arguable similarities between the marks-----	11
C. The Examiner failed to consider new facts and evidence submitted in Appellant's Requests for Reconsideration, including the factor of NO ACTUAL CONFUSION which, if there was any doubt before, serves to tip the scale in favor of Appellant-----	13
D. The marks are sufficiently different in appearance, sound and meaning to avoid a finding of likelihood of confusion-----	16
4. CONCLUSION-----	18

TABLE OF CASES

1.	<i>In re Elbaum</i> , 211 USPQ 639 (TTAB 1981)-----	4
2.	<i>FBI v. Societe: "M.Brill & Co."</i> , 172 USPQ 310 (TTAB 1971)-----	7
3.	<i>Faultless Starch Co. v. Sales Producers Assoc., Inc.</i> , 189 USPQ 141 (C.C.P.A. 1976)-----	7
4.	<i>In re British Bulldog, Ltd.</i> , 224 USPQ 854 (TTAB 1984)-----	7
5.	<i>In re Dixie Restaurants</i> , 41 USPQ2d 1531 (Fed.Cir. 1997)-----	9
6.	<i>In re National Novice Hockey League, Inc.</i> , 222 USPQ 638 (TTAB 1984)-----	9, 15
7.	<i>In re Matter of the Application of E.I. DuPont De Nemours & Co.</i> , 177 USPQ 563 (CCPA 1973)-----	11, 14
8.	<i>Lawn Tennis Assoc. v. British Tennis Agency Ltd.</i> , 1 USPQ2d 1283 (SDNY 1986)-----	11
9.	<i>Stouffer Corp. v. Health Valley Natural Foods, Inc.</i> , 1 USPA 2d 1900 (TTAB 1986)-----	12
10.	<i>In re Software Design, Inc.</i> , 220 USPQ 662 (TTAB 1983)-----	12, 16
11.	<i>Lifton Sys., Inc. v. Whirlpool Corp.</i> , 221 USPQ 97 (Fed.Cir. 1984)-----	12
12.	<i>Blue Bell, Inc. v. Jaymar-Ruby, Inc.</i> , 182 USPQ 65 (2d Cir. 1974)-----	12
13.	<i>Pignons S.A. De McCanique De Precision v. Polaroid Corp.</i> , 212 USPQ 246 (1 st Cir. 1981)-----	12, 15
14.	<i>In re General Motors Corp.</i> , 23 USPQ2d 1465 (TTAB 1991)-----	14
15.	<i>Nabisco Inc. v. PF Brands Inc.</i> , 51 USPQ2d at 1896 (1999)-----	15
16.	<i>Libman Co. v. Vining Indus., Inc.</i> , 69 F.3d 1360 (7 th Cir. 1995)-----	15
17.	<i>NEC Electronics, Inc. V. New England Circuit Sales, Inc.</i> , 13 USPQ2d 1058 (BNA) -----	15, 17
18.	<i>In re Reach Electronics, Inc.</i> , 175 USPQ (BNA) 7834 (TTAB 1972)-----	17

TABLE OF EXHIBITS ATTACHED TO BRIEF

Exhibit A: Print out of Appellant's details for NUR Application from USPTO TARR system (2 pages).

Exhibit B: Print out from Registrant's web site (2 pages).

Exhibit C: In relevant part, the USPTO registrations that Examiner submitted to support position that ink dispensers and printers are related goods (10 pages).

Exhibit D: Registrations submitted by Appellant to show identical and similar marks registered for related goods are not confusingly similar (9 pages).

Exhibit E: In part, Appellant's promotional and web site material submitted to show nature of goods completely different from those of Registrant (20 pages).

Exhibit F: Customer testimonials (20 pages).

Exhibit G: Exhibitions lists of participants (7 pages).

Exhibit H: Declaration and attachment of 2000 revenues (3 pages).

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In re application of:

Applicant: Nur Macroprinters Ltd.

Mark: **NUR**

Serial No.: 75/638992

Appeal Filed: April 18, 2002

Attorney Dkt. No.: 970027-12-03

BOX TTAB – NO FEE

Assistant Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

BRIEF ON APPEAL

Appellant filed a Notice of Appeal pursuant to Rule 2.141 of the Trademark Rules of Practice on April 18, 2002. This brief is submitted in accordance with Rule 2.142 in support of Appellant's appeal from the Final refusal of Examining Attorney Kelly A. Choe of Law Office 113, to register the mark NUR (word mark) for goods in Classes 2, 7, 9, 16 and 24, under Section 2(d) of the Trademark Act. Appellant respectfully requests that the Board reverse the refusal to register the mark because no likelihood of confusion exists between Appellant's mark, NUR, and the cited Registration No.2047781, for NER for "ink dispensers for printers" in Class 16.

1. **PROCEDURAL BACKGROUND**

Appellant filed this use-based application on February 9, 1999. In Office Actions dated July 23, 1999, March 22, 2000 and January 18, 2001, registration was refused on the ground that Appellant's mark when used on or in connection with the identified goods, so resembles U.S. Registration No. 2,047,781 for the mark NER as

likely to cause confusion. The remainder of the issues raised by the Examiner have been withdrawn or accepted and are not the subject of this Appeal. Appellant responded to all actions arguing that there was no likelihood of confusion between the marks. In an Office Action by Examiner Choe, dated October 24, 2001, the refusal to register based on the cited registration was made Final. Appellant filed an Amendment and Request for Reconsideration on March 5, 2002. Examiner Choe issued "OFFICE ACTION NO. 3", dated April 3, 2002, which denied the request for reconsideration and continued the Final refusal under Section 2(d) based on failure to raise new factual or legal issues. Appellant filed a further Response to reiterate the new facts, law and evidence that were submitted with the Request for Reconsideration, but were improperly ignored.

In refusing registration, the Final Actions of Oct. 24, 2001 and April 3, 2002, argued that the difference between the marks was not sufficient to obviate the similarities in appearance, sound, connotation and overall commercial impression [Office Action ("OA"), Oct. 24, 2002, pg.2]. The Examiner further relied on an inaccurate presumption that the goods in the cited registration, 'ink dispensers for use in printers', include all printers, all channels of trade and all potential customers [OA, Oct. 24, 2002, pg.3], despite evidence that clearly illustrates the overwhelming differences between the marks. For the reasons set forth below, Appellant respectfully submits that the Examiner's arguments are unpersuasive and that no likelihood of confusion exists between Appellant's mark and the cited registration.

2. SUMMARY OF FACTS

- **Different Goods.** Appellant sells super-wide printing machines for creating gigantic images for use on billboards, banners, trucks and other oversized commercial use under the mark NUR, while the cited registration covers 'ink dispensers for use with printers'. Registrant's ink dispensers **can not** be used in connection with NUR printers. The Examiner failed to properly consider the significant differences in the

goods which led to the erroneous conclusion that the Registrant's goods move through all channels of trade and to all potential customers.

- **Different Buyers and Channels of Trade.** Once the difference in the goods is understood, it becomes clear that the goods move in different channels of trade and are purchased by different buyers. Appellant's goods are sold to production printing companies through digital imaging, advertising and signage exhibitions, industry publications and repeat face to face meetings. According to public records, the cited goods are sold through regional salesmen as well as data center exhibitions. Appellant and Registrant do not appear or participate at the same exhibitions.
- **Sophisticated Purchasers.** The buyers of the respective products are sophisticated and the purchase process is carefully designed to eliminate even a remote likelihood of confusion, including lengthy sales cycles, repeated personal contact, complex machine and technical requirements, and the high cost of the goods.
- **No Actual Confusion.** The marks have co-existed for at least 5 years without any actual confusion in the marketplace. Appellant's mark has been used as a trademark in commerce since 1993. According to the cited registration, this is three years prior to the cited mark.
- **The Marks are Different in Appearance, Sound and Connotation.**

3. ARGUMENT

The Examining Attorney overstates the similarity of the marks primarily as a result of improperly according too broad a scope of protection to the registered mark and failing to properly consider all of the relevant factors that serve to significantly distinguish the marks, such as the difference in the respective goods, channels of trade and customers. The Examining Attorney's position is further compromised by the complete disregard of new facts and evidence submitted with the Request for Reconsideration concerning, inter alia, lengthy co-existence of the marks without any actual confusion.

- A. **The Examiner refused to recognize the significant differences between the goods, buyers and channels of trade which overcome any likelihood of confusion between the marks.**

Different Goods.

The Examiner failed to give proper weight to the difference between the goods, relying on the cited registration for 'ink dispensers for use in printers' as broad enough to extend to all printers. The Examiner, in reliance on *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981), presumed that the cited registration in Class 16 encompasses all ink dispensers of the type described, including those in Appellant's more specific identification – in other classes-, that they move in all normal channels of trade and that they are available to all potential customers [OA, Oct. 24, 2001, pg.3]. In order to remove the conflicting goods, Appellant amended its Class 7 identification of goods to specifically delete 'dispensers'. See USPTO TARR system print out of Appellant's application for complete identification of goods as most currently amended, **Exhibit A**. The fact is that the Examiner's presumption is wholly inaccurate since Registrant's ink dispensers can NOT be used with Appellant's printers. Since only NUR ink dispensers can be used with NUR printers, by definition Registrant's product can not be used in connection with 'all printers' as the Examiner would have us believe. According to Registrant's own information available through the Internet, the printers to which the Registrant's products are applied are specifically identified as Epson, Canon and Hewlett Packard ink jet printers. [Attachment to Response to OA, Mar. 22, 2000. See **Exhibit B** attached hereto]. The presumption that Registrant's ink dispensers apply to all printers was overcome by a plethora of highly probative evidence by both the Appellant's and Examiner's submissions. [Examiner's attachments to OA, Oct. 24, 2002]. In fact, the Examiner relies on information from Registrant's web site concerning toner and ribbons while ignoring the ink dispensers. Nonetheless, there would still be no confusion between the marks, even if Registrant's ink dispensers were sold to Appellant's customers due to the

carefully orchestrated sales contact, lengthy sales cycle and pricing differentials, among several other factors – as discussed further herein.

The Examiner further mistakenly relies on third party registrations that cover both 'ink dispensers' and 'printers' to allege that they often come from a common source and thus it follows that such goods will be mistaken as coming from a common source in this instance [OA, Oct. 24, 2002, pg. 4]. However, the registrations are completely irrelevant because most of these cited registrations DO NOT cover the combination of ink dispensers as well as printers which are the issue of the current appeal. The third party registrations cited by the Examiner should not result in a finding that the marks at issue are confusingly similar. See Appellant's response to OA, Apr. 3, 2002, concerning detailed examples of the registrations submitted by the Examiner [OA, Oct. 24, 2001] which have no relevance to this case, including **INTELLIDGE**, **INFORIDGE**, **INTERIDGE**, **NECTRON**, **N** and **STAMCO**, none of which cover printers. See **Exhibit C** attached hereto.

On the other hand, the USPTO database supports registration of similar and identical marks for related, but not identical, goods. As in this case, the cited mark for ink dispensers and Appellant's mark for superwide digital printing machines are not likely to be confused. Appellant submitted evidence to support this position, by way of USPTO TARR print outs that demonstrate that there are other identical or similar marks with different owners that co-exist on the register under similar circumstances. [Appellant's Res. to OA, Apr. 3, 2002. See **Exhibit D** attached hereto]. Appellant submitted third party registrations, as follow: **INDIGO** owned by Indigo N.V. (cl. 009) for registered computer software for personalized printing, **INDIGO** owned by Silicon Graphics (cl. 009) for computer hardware....computer workstations and **INDIGO** owned by Ford Motor Company (cl. 16) for ...prints and postcards; **NIR** (cl.

007) approved for publication for metal, wood and plastic working machines...all for use in paper and print processing and **NER** (cl. 016) for ink dispensers for use in printers.

The Appellant's products are digital printing equipment which includes specialist inks and substrates (the consumable products upon which digital printers produce graphic output) for use in production environments. Appellant's goods are used in commercial wide and super-wide format digital color printing and not in routine office environments. More specifically, Appellant's products are used in the production of banners, billboards, building murals, building scaffolding, fleet graphics, bus wraps, transit station posters, shopping mall displays, indoor signage, window displays, sporting events, and scenery backdrops for theater, television and film. Appellant's goods are specialized printing machines with physical dimensions ranging between, 6.5 ft. x 12.5 ft. and up to 16.5 ft. in width. One of Appellant's printers are for the purpose of printing onto materials approximately 6 ft. in width and have the capacity to print up to 1,000 square feet an hour. The finished products produced by using Appellant's machines are of gigantic proportion and size.

Appellant submitted evidence by way of promotional materials, web site information [Res. to OA, Mar. 22, 2000. See **Exhibit E** attached hereto] and customer testimonials [Res. to OA, Apr. 3, 2002. See **Exhibit F** attached hereto] to illustrate the nature of its goods and to show that the finished printed products can be as large as 400 square meters – think 'Times Square' in New York City. See also Appellant's specimens. The use of Appellant's printing machines demonstrate that there is no connection between Appellant's digital production equipment and Registrant's ink dispensers. Registrant's own web site shows that the cited goods are used in connection with inkjet printers that are for general office use, stating: "**NER**

Replacement Cartridges are 100% guaranteed to be compatible with the most popular Canon®, Apple® and Epson® inkjet printers.”

The test, according to sources relied upon by the Examiner, for whether goods are related depends on whether the relevant purchasing public would mistakenly assume that the applicant's goods originate with, are sponsored by, or are in some way associated with those offered under the registrant's mark, *FBI v. Societe: "M.Bril & Co."*, 172 USPQ 310 (TTAB 1971). Based on this test, the Examiner is wrong to conclude that 'purchasers encountering both the applicant's various printer goods, and the registrant's dispensers, are likely to mistakenly believe that they come from a common source' [OA, Oct. 24, 2001, pg. 3]. Registrant sells **ink dispensers** for use in printers. All of Appellant's goods are **wide and super-wide format digital production equipment for commercial use** and their components and replacement parts used therewith. The relevant purchasers do not mistake the origin of the respective goods.

Case law supports the premise that **even identical marks**, when used on **unrelated goods** are not confusingly similar. In the case of *Faultless Starch Co. v. Sales Producers Assoc., Inc.*, 530 F.2d 1400, 189 U.S.P.Q. 141 (C.C.P.A. 1976), the court upheld the Trademark Trial and Appeal Board in that the mark 'FAULTLESS' for canned foods was not confusingly similar to the mark 'FAULTLESS' for laundry starch, based on large part to the wide variety of different goods in supermarkets. See also, *In re British Bulldog, Ltd.*, 224 U.S.P.Q. 854 (TTAB 1984), where the mark "PLAYERS" for shoes and the mark "PLAYERS" for men's underwear were found not to be confusingly similar. The Board observed that shoes and underwear "are distinctively different even when sold in the same store". These cases support that identical marks which cover different goods are not confusingly similar. Then even

more so, this solidly supports that the similar (non-identical) marks in this instance for different goods can not be confusingly similar.

Different Buyers.

Once the differences in the respective products are understood, the difference in the nature of the respective purchasers become clear. The purchasers of Appellant's goods are commercial and industrial printers in the field of wide and super-wide production printing, including commercial printers who provide digital printing of large format jobs, specialist digital printing establishments that are built around printing machines supplied by Appellant, media companies, photo labs and prepress service bureaus. Appellant submitted customer testimonials to illustrate who its customers are. [See attachments to Response to OA, Apr. 3, 2002].

In contrast, Registrant's buyers are businesses and data center operators who use printers suitable for use with Registrant's ink dispensers. Registrant's website at www.nerdata.com clearly illustrates that salesmen are assigned to sell and service offices that utilize ink jet printers for the sale of Registrant's ink dispensers based on regional territories. The nature of the exhibitions at which Registrant hosts booths, such as AFCOM, suggests that the market is data center operations. A data center manager, however sophisticated, shopping for ink dispensers for PC printers is far from the customer shopping for a \$500,000.00 printing machine to operate a multi-million dollar commercial printing enterprise. Clearly, these purchasers are different, not only in the specific knowledge necessary to purchase the goods in question, but also with regard to the manner in which the purchase takes place, the location of the point of purchase, and most importantly **the purpose of the purchase** [emphasis supplied].

The respective buyers DO NOT come into contact with the goods under the other mark when buying their goods of interest in the marketplace. This further distinguishes between the marks and insures that there is no likelihood of confusion in the marketplace.

Different Channels of Trade.

Due to the difference in purchasers, the goods travel through different channels of trade and are each marketed in a focused manner. It appears that the Examiner did not consider Appellant's submissions that illustrate the distinct differences between the marks, in reliance upon *In re Dixie Restaurants*, 41 USPQ2d 1531 (Fed.Cir. 1997), et al, that "an applicant will not be heard on matters that constitute a collateral attack on the cited registration, such as brochures or web pages from the registrant's company that seek to show that the registrant only sells its goods in certain trade channels" [OA, Apr. 3, 2002, pg.2]. This refusal to consider any evidence that shed light on marketplace realities was contradictory to the Examiner's admission that additional factors may be considered if relevant evidence is contained in the record, citing *In re National Novice Hockey League, Inc.*, 222 USPQ 638 (TTAB 1984). The Examiner, by her own admission [OA, Oct. 24, 2001, pg.2] should have considered the Appellant's specimens and other submissions on the record to evaluate the issue of likelihood of confusion.

Appellant's products are sold either directly or by wholly owned subsidiaries which also provide post-purchase support and maintenance. Likewise, Registrant's products are sold through regional sales offices, both requiring face-to-face contact. The purchase process for the respective goods are calculated and require careful inspection of the product as well as its qualities and source. In particular, the

purchase of unique wide format digital printing equipment requires a careful and highly considered purchase pattern.

The Examiner ignored the submissions of Appellant that illustrate how potential customers learn about Appellant's products through trade shows [Res. to OA, Apr. 3, 2002. See **Exhibit G** attached hereto] such as the 9th International Advertising Show, Visual Communication Europe 2002, SGIA, Visual Communication 2002 and ImageWORLD (where Registrant was not listed as a participant – See print outs attached to Appellant's Response, id.), print industry trade publications such as The Big Picture, Signs of the Times, and through advertising. Whereas, Registrant participates in very different conferences such as AFCOM, Network and Interop, Recharger and Storage-Tek Forum, where Appellant does not attend or participate. Due to the nature of Appellant's products, direct sales efforts and direct contact with purchasers are required. These channels do not include off the shelf purchases and specifically call for personal contact with buyers who, in most instances need services following the purchase. The purchase process is both intimate and carefully tailored. Hasty or uneducated "spare of the moment" decisions are not likely. The fact that Appellant's products are sold at **prices that range from \$399,000.00 to \$599,000.00** and require after sales services which is provided exclusively by Appellant or its subsidiaries and the fact that Appellant's printing machines may be used only with printing accessories produced by Appellant, is further proof that the purchase is not taken lightly. The conditions and channels in which Appellant's goods are sold strengthens the argument that the source of the products can not be confused with another manufacturer. Appellant's consumers make the decision to purchase the digital production equipment only after careful

consideration due to the complexity of the machines, technical requirements and the high cost of the goods.

The conditions surrounding the marketing of the respective products and services are such that they could not be encountered by the same purchasers under circumstances that could give rise to the mistaken belief that the goods of the Applicant and Registrant come from a common source.

B. The respective goods are sold to highly sophisticated purchasers who are not confused by the arguable similarities between the marks.

While different Circuits and the Board employ variations of a multi-factored test for determining likelihood of confusion most, if not all, of those varying standards include the sophistication of purchasers as a factor that is indicative of likely confusion. See, e.g., *In re Matter of the Application of E.I. DuPont De Nemours & Co.*, 177 USPQ 563 (CCPA 1973)(impulse vs. careful, sophisticated purchasing). Regardless of the prevailing standard, the Examiner did not address this factor, but should have given it the weight it deserves in favor of Appellant's request for registration. The respective buyers in this instance are highly sophisticated. The law is very precisely summarized in McCarthy on Trademarks, Section 23:101, pages 23-196:

"Many cases state that where the relevant buyer class is composed of professionals or commercial buyers familiar with the field, they are sophisticated enough not to be confused by trademarks that are closely similar. That is, it is assumed that such professional buyers are less likely to be confused than the ordinary customer. Thus while two marks might be sufficiently similar to confuse an ordinary consumer, a professional buyer of an expert in the field may be more knowledgeable and will not be confused." (citations omitted).

Furthermore, the level of purchaser sophistication may be inferred from the type of goods or services offered, rather than from evidence submitted. See, e.g., *Lawn*

Tennis Assoc. v. British Tennis Agency Ltd., 1 USPQ2d 1283, 1288-89(SDNY 1986)(inferring sophistication of buyers based on nature of services).

Case law is quite explicit with regards to the issue of purchasing environments. Where the decision is made by a sophisticated buyer and concerns a product whose purchase is made after *careful examination of the product*, it may be sufficient to negate a likelihood of confusion even between marks of great similarity. See for example *Stouffer Corp. v. Health Valley Natural Foods, Inc.*, @ 1 USPA 2d 1900 (TTAB 1986); *In re Software Design, Inc.* 220 USPZ 662 (TTAB 1983); *Lifton Sys., Inc. v. Whirlpool Corp.*, 221 USPQ 97, 112 (Fed.Cir. 1984).

Prospective purchasers of Appellant's goods are sophisticated consumers, well-versed in the particular and unique needs of their field. Prospective purchasers come from the high end wide-format digital printing field used for advertising and set design. These uniquely-qualified purchasers must not only be knowledgeable of the particular needs of their respective area but must also hold a sophisticated understanding of printing equipment and accessories; an attribute likely to be reserved for a select few. Purchasers must take greater care in purchasing Appellant's goods because their decision has far-reaching consequences that directly affect the quality of products and services provided to their customers further on in the distribution chain.

Appellant submits that the nature of the goods provided by both parties and the sophistication of both parties' customers, render confusion unlikely. See, e.g., *Blue Bell, Inc. v. Jaymar-Ruby, Inc.*, 182 USPQ 65(2d Cir. 1974)(the price range and the fairly detailed purchasing process of the goods in question suggest that consumers are unlikely to be misled); *Pignons S.A. De McCanique De Precision v. Polaroid Corp.*, 212 USPQ 246(1st Cir. 1981)(Courts have found less likelihood of confusion where goods are expensive and purchased after careful consideration).

Whereas Registrant's buyers are sophisticated in the data operations field and common sense dictates that these sophisticated purchasers are not confused between high-end digital production equipment and ink dispenser replacements for ink jet printers.

C. The Examiner failed to consider new facts and evidence submitted in Appellant's Requests for Reconsideration, including the factor of NO ACTUAL CONFUSION which, if there was any doubt before, serves to tip the scale in favor of Appellant.

Despite a plethora of new and highly probative evidence submitted by Appellant [See Response to OA, Oct. 24, 2001 and Apr. 3, 2002], the Examiner denied Appellant's request for reconsideration "since the applicant has not raised any new factual or legal issues". Appellant replied with an outline of the factual and legal support that was newly submitted in response to the Final Action and submitted further evidence, in part as follows [All Attachments to Response to OA, Apr. 3, 2002]:

1. Facts of lengthy co-existence without actual confusion;
2. Declaration in support thereof;
3. Customer testimonials to further distinguish the goods and customers;
4. Exhibition lists to support different channels of trade; and
5. Third party registrations to support identical and similar marks for related goods.

Appellant filed its trademark application based on Section 1(a), use of the mark in commerce. As a matter of record, Appellant first used the mark in 1989 and first used the mark in commerce in 1993. According to USPTO records, registrant used its mark since 1996, at least three years after the Appellant. From 1996 to present, at least 5-6 years, the marks have co-existed in the marketplace without any actual confusion. In fact, Appellant has never bumped into the registrant, its products or the mark and was not at all familiar with NER until it was cited against this

application. Appellant submitted a declaration and other evidence to support this contention which was ignored by the Examiner. [See Declaration of Hilel Kremer attached to Response to OA, Apr. 3, 2002 and attached hereto as **Exhibit H**].

It is logical that where there is **no actual confusion** in the marketplace, it must be followed by the conclusion that there is no likelihood of confusion between these respective marks. The USPTO's Trademark Manual of Examination Procedure (TMEP), Section 1207.01 set forth the DuPont factor of 'no actual confusion', which the Examiner failed to consider upon Appellant's Request for Reconsideration which states in relevant part:

"In considering what factors are relevant to a determination of likelihood of confusion, it is helpful to turn to *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973)...

... But the **question of confusion is related not to the nature of the mark but to its effect "when applied to the goods of the applicant." The only relevant application is made in the marketplace.** The words "when applied" do not refer to a mental exercise, but to all of the known circumstances surrounding use of the mark. [emphasis supplied]

In testing for likelihood of confusion under Sec. 2(d), therefore, the following, when of record, **must be considered**: [1 - 6 and 9, 10 omitted]

7. *The nature and extent of any actual confusion.*
8. The length of time during and the conditions under which there has been concurrent use **without evidence of actual confusion.** [emphasis supplied]

duPont, 476 F.2d at 1360-62, 177 USPQ at 566-67.

Furthermore, the Board identified three factors in an ex parte setting which allow it to assess the probative value of the absence of actual confusion: (1) a long period of marketing success [See Declaration, id. at para. 9]; (2) marketing expensive products and services; and (3) no reported instances of actual confusion. *In re General Motors Corp.*, 23 USPQ2d 1465 at 1470-71 (TTAB 1991). In this instance, these three factors justify giving significant probative weight to the lack of actual confusion because, similar to *General Motors*, there are a "confluence of facts which persuasively point to confusion as being unlikely". Id at 1470.

Case law has routinely supported consideration of this factor. In *Nabisco Inc. v. PF Brands Inc.*, 51 USPQ2d at 1896 (1999), the Court restated that "the presence or absence of actual confusion can be highly effective in showing a high, or a low, likelihood of confusion if there has been ample opportunity for consumer confusion". Certainly, more than five years of concurrent use has provided 'ample opportunity for consumer confusion' but since none has occurred, this is highly persuasive that there is no likelihood of confusion. When comparing the marks **MovieBuff** and **The Movie Buff's Movie Store**, when it was conceded by one party that there had been no actual confusion, the Court stated that [it could] "not think of more persuasive evidence that there is no likelihood of confusion between these two marks than the fact that they have been simultaneously used for five years without causing any consumers to be confused...". Citing, *Libman Co. v. Vining Indus., Inc.*, 69 F.3d 1360, 1361 (7th Cir. 1995). The Court also stated in *NEC Electronics, Inc. V. New England Circuit Sales, Inc.*, 722 F.Supp 861 (US Dist. 1989); 13 U.S.P.Q.2D (BNA) 1058, that "absent evidence of actual confusion, when the marks have been in the same market, side by side, for a substantial period of time, there is a strong presumption that there is little likelihood of confusion". The Court of Appeals for the First Circuit held that "four years is a substantial amount of time". In re Pignons, 657 F.2d at 490. See also, *In re National Novice Hockey League, Inc.*, id.

In addition to the fact that there have been many years of concurrent use, Appellant's rights to its mark are senior to that of the cited registrant. Appellant began to use its mark in 1989 and in commerce in 1993, seven (7) and three (3) years respectively before the cited mark appeared in connection with the registered goods and has since that time gained worldwide recognition as a leader in the super-wide format printing industry, a highly specialized field. The respective trademark owners are concerned with completely different goods, services, customers, markets and channels of trade. For consideration of all of the DuPont factors, see Appellant's attachment to response to Final Action.

The fact that the marks have co-existed for many years without any actual confusion in the marketplace was argued by Appellant [See Response to OA, Oct. 24, 2001], including submission of a supporting Declaration, id. It follows that the legal support to show that the eighth DuPont factor (no actual confusion) should weigh heavily in Appellant's favor should have been considered by the Examiner.

D. The Marks are sufficiently different in appearance, sound and meaning to avoid a finding of likelihood of confusion.

Different Appearance and Sound

The Examining Attorney summarily disregarded the differences in sound and appearance between the marks. The Examiner stated "the only real difference between the marks is the substitution of the letter U with the letter E" [OA, Apr. 3, 2002, pg. 2]. However, the Examiner failed to recognize that the change in one letter was sufficient to change the appearance and pronunciation between the marks and although the marks may be **similar**, together with the cumulative differences outlined herein, it is sufficiently compelling to find no likelihood of confusion. The different vowel in Appellant's mark creates a 33.33% difference in the appearance of the marks and shifts the appearance and pronunciation. The Examiner's unfounded position that the marks being phonetic equivalents and similar in appearance warrant a finding of likelihood of confusion is tantamount to granting a monopoly to Registrant in the letters N + R + any vowel. To the contrary, the fact that the marks are not identical, coupled with the significant differences in the products, buyers and purchasing processes summons a decision that confusion is not likely. Of particular interest is the analysis concerning the marks "DOX" and "DOC'S" in the ruling set forth in *In re Software Design, Inc.*, 220 U.S.P.Q. (BNA) 662 (TTAB 1983), as follows:

"This is a close case. However, for the reasons indicated above, we are of the opinion that the cumulative differences between the respective marks and services of applicant and registrant, considered in light of the nature of those services, are sufficient to obviate any reasonable likelihood of confusion."

Both marks in the *Software Design Appeal* were for services in the computer industry and were phonetically identical. However, since the services were highly sophisticated, technical and relatively expensive, they were found likely to be

purchased only with care and deliberation after investigation. The phonetic similarity was found not to be significant since the goods were not likely to be orally requested in retail stores. In the case at hand, the marks are not identical in appearance or sound. Under the analysis of this case and given the "cumulative differences" plus the sophistication of the buyers, the subject marks are even more compelling to find that confusion is not likely. Also analogous, are the facts and findings of *Nec Electronics, Inc. V. New England Circuit Sales, Inc.*, 13 U.S.P.Q.2c (BNA) 1058 ("NECS" held not confusingly similar with the mark "NEC", both for chips/integrated circuits), which held:

"the parties are in the same industry, seek to sell to some of the same organizations and advertise in some of the same media. However, the nature of the products they sell, the different individuals they deal with, the sophistication of respective customers [emphasis supplied], and the nature of their self-promotion all weigh against a finding that potential purchasers are likely to confuse [the marks]".

Furthermore, see *In re Reach Electronics, Inc.*, 175 U.S.P.Q. (BNA) 7834 (TTAB, 1972), where the one letter difference between "REAC" and "REACH" both for "power supplies" in the electronics field, resulted in a decision of no likelihood of confusion by the Appeal Board. These cases follow a continuing line of cases where the TTAB as well as the Federal Courts have found that merely altering, adding or eliminating a single letter can create a different commercial effect for prospective customers.¹ All of these cases support Appellant's well-founded assertion that the difference between the U and the E is sufficient for the marks not to be confusingly similar.

¹ See also, *Nabisco Brands, Inc. v. Quaker Oats Co.*, 216 U.S.P.Q. 770 (D.N.J. 1982)(CREAM OF WHEAT not confusingly similar to CREAMY WHEAT, both for breakfast cereals); *Jacobs v. International Multifoods Corp.*, 212 USPQ 641(C.C.P.A. 1982)(BOSTON SEA PARTY not confusingly similar to BOSTON TEA PARTY).

Different Meaning.

The Examiner's position that the marks have the same connotation is contradicted by Appellant's submission of search results of on-line dictionaries found at www.onelook.com which revealed a variety of meanings for NER and a few for NUR, none of which are comparable [Response to OA Mar. 22, 2000, pg. 4, 7]. Appellant's mark means "a hard knot of wood", whereas Registrant's mark means "nearer", "father of Abner in the Bible", slang for "interjection an exclamation of ridicule", or several acronyms such as "Navy Emergency Relief" and "No Evidence of Rejection".

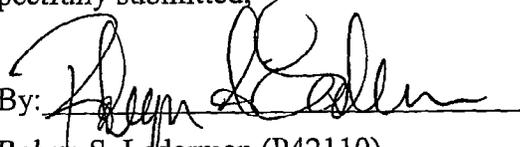
Regardless of Appellant's overwhelming evidence, the Examiner states that the marks hold the same connotation, but fails to illustrate how. If the connotations for the marks were the same, it would follow that Examiner would have included evidence indicating such similarity.

CONCLUSION

Applicant respectfully requests that the Board reverse the decision of the Examining Attorney refusing registration and pass the mark for registration on the Principal Register.

Dated: June 16, 2002

Respectfully submitted,

By: 

Robyn S. Lederman (P42110)

Eitan, Pearl, Latzer & Cohen-Zedek

Attorneys for Applicant/Appellant

7 Shenkar Street

Herzeliya, Israel 46725