TTAB
LAW office 105

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

BOARD FILE
RECD 10/7/02

In re Application of:	V Technologies International Corporation	
App. Ser. No.:	75/833293	Trademark Trial and Appeal Board
Filed:	May 11, 2000	
Mark:	AGILQUEST	

12-11-2001
U.S. Patent & TMOfc/TM Mail Rcpt Dt. #11

TO: Assistant Commissioner for Trademarks
Box TTAB/NO FEE
2900 Crystal Drive
Arlington, Virginia 22202-3513

Renewed Request for Suspension of Appeal

Applicant, V Technologies International Corporation, by counsel, hereby renews its request that the Trademark Trial and Appeal Board suspend the subject appeal. Applicant requests that the Board date stamp and return the enclosed pre-addressed, postage pre-paid postcard to acknowledge its receipt of this Renewed Request for Suspension of Appeal.

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Assistant Commissioner for Trademarks, Box TTAB/NO FEE, 2900 Crystal Drive, Arlington, Virginia 22202-3513, on December 7, 2001.

David D. Addison, Jr.

Date of Signature: 11-7-01

Applicant V Technologies International Corporation filed on October 2, 2001 a Notice of Appeal, a Request for Reconsideration of Office Action No. 2, and a Request for Suspension of Appeal. In its Request for Suspension of Appeal, Applicant requested that the Trademark Trial and Appeals Board suspend the appeal pursuant to TBMP §§ 1204 and 1213 while the request for reconsideration was pending. Applicant also requested suspension of the appeal pursuant to TBMP § 1213 because the registration cited by the Examining Attorney (Reg. No. 1,972,552) as a reference under Section 2(d) of the Act, 15 U.S.C. § 1052(d), will soon be due for an affidavit of continued use under Section 8 of the Act, 15 U.S.C. § 1058.

On November 1, 2001, the Board suspended the appeal and remanded the file to the Examining Attorney. The notice sent to Applicant on November 1, 2001, stated that "in the event the refusal of registration is maintained, the file should be returned to the Trademark Trial and Appeal Board, proceedings will be resumed and applicant will be allowed time in which to file its brief on appeal." The notice did not address Applicant's second grounds for suspension, namely that the registration cited as a reference under Section 2(d) of the Act will soon be due for an affidavit of continued use under Section 8 of the Act.

The Examining Attorney has denied Applicant's request for reconsideration and upheld the final refusal. Therefore, the current suspension presumably will be lifted unless the Board expressly suspends the appeal again or maintains the current suspension, based upon TBMP § 1213.

The registration date of Registration No. 1,972,552 was May 7, 1996, meaning that a Section 8 affidavit must be filed not later than May 7, 2002. Based on Applicant's investigation of PTO records, no affidavit has been filed to date, and Applicant has reason to believe none will be filed. If none is filed, the basis for refusal (and this appeal) will be moot.

According to TBMP § 1213, when a registration cited as a reference, under Section 2(d) of the Act, 15 U.S.C. § 1052(d), against applicant's mark is due, or will soon be due, for an affidavit of continued use under Section 8 of the Act, 15 U.S.C. §1058, the Board may suspend an ex parte appeal pending a determination of whether registration will continue in existence or will instead be cancelled under Section 8.

For the above reasons, Applicant renews its request that the Board suspend consideration of its appeal (or, alternatively maintain the present suspension) pending the possible filing of a Section 8 affidavit for Registration No. 1,972,552.

Richmond, Virginia
December 7, 2001

By .....

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cc: Sheila Marsh, Esquire

UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO. 75/833293	**APPLICANT** V Technologies International Corporation
MARK AGILQUEST	
ADDRESS DAVID D. ADDISON, JR. LeCLAIR RYAN 707 EAST MAIN STREET, 11th FLOOR RICHMOND, VA 23219	**ACTION NO.** 03 **MAILING DATE** 11/20/01 **REF. NO.**

FORM PTO-1525 (5-90) U.S. DEPT. OF COMM. PAT. & TM OFFICE

PAPER NO.

ADDRESS:
Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513
www.uspto.gov

If no fees are enclosed, the address should include the words "Box Responses - No Fee."

Please provide in all correspondence:

1. Filing Date, serial number, mark and Applicant's name.
2. Mailing date of this Office action.
3. Examining Attorney's name and Law Office number.
4. Your telephone number and ZIP code.

RE: Serial Number: 75/833293

Applicant is requesting reconsideration of a final refusal dated October 3. 2001.

After careful consideration of the law and facts of the case, the examining attorney must deny the request for reconsideration and adhere to the final action as written since no new facts or reasons have been presented that are significant and compelling with regard to the point at issue.

The examining attorney has determined that the term "QUEST" is the dominant element or portion of the applicant's proposed mark. Here, the applicant has simply added the term "AGIL" to the registrant's mark to create its mark. The mere addition of a term to a registered mark is not sufficient to overcome a likelihood of confusion under Section 2(d). *Coca-Cola Bottling Co. v. Joseph E. Seagram & Sons, Inc.*, 526 F.2d 556, 188 USPQ 105 (CCPA 1975) ("BENGAL" and "BENGAL LANCER"); *Lilly Pulitzer, Inc. v. Lilli Ann Corp.*, 376 F.2d 324, 153 USPQ 406 (CCPA 1967) ("THE LILLY" and "LILLI ANN"); *In re El Torito Restaurants Inc.*, 9 USPQ2d 2002 (TTAB 1988) ("MACHO" and "MACHO COMBOS"); *In re United States Shoe Corp.*, 229 USPQ 707 (TTAB 1985) ("CAREER IMAGE" and "CREST CAREER IMAGES"); *In re Corning Glass Works,* 229 USPQ 65 (TTAB 1985) ("CONFIRM" and "CONFIRMCELLS"); *In re Riddle*, 225 USPQ 630 (TTAB 1985) ("ACCUTUNE" and "RICHARD PETTY'S ACCU TUNE"); *In re Cosvetic Laboratories, Inc.*, 202 USPQ 842 (TTAB 1979) ("HEAD START" and "HEAD START COSVETIC"). The addition of this term does not obviate the similarity between the marks.

A search of the Office's database for the term "QUEST" for computer software used to make reservations or send and/or receive electronic mail produced 11 cites.[1] Of the 11 cites listed, the cited registered mark is similar to the applicant's mark and the goods of the applicant and the

[1] See the attached listing of cites.

goods of the registrant are closely related, for the transmission of reservation information is likely to be via electronic mail, as such, consumers who are familiar with the registrant's mark and goods upon encountering the applicant's mark and goods are likely to mistakenly believe that the goods emanate from a common source.

If the goods or services of the respective parties are closely related, the degree of similarity between marks required to support a finding of likelihood of confusion is not as great as would apply with diverse goods or services. *ECI Division of E Systems, Inc. v. Environmental Communications Inc.*, 207 USPQ 443 (TTAB 1980).

Moreover, the examining attorney must resolve any doubt as to the issue of likelihood of confusion in favor of the registrant and against the applicant who has a legal duty to select a mark which is totally dissimilar to trademarks already being used. *Burroughs Wellcome Co. v. Warner-Lambert Co.*, 203 USPQ 191 (TTAB 1979).

Accordingly, applicant's request for reconsideration is *denied*. The time for appeal runs from the date the final action was mailed. 37 C.F.R. Section 2.64(b); TMEP Section 1110.

RESPONSE:

If the applicant has any questions or needs assistance in responding to this Office action, please telephone the assigned examining attorney.

Marlene D. Bell
Examining Attorney
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(703) 308-9105 X 173

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2	76265678	20010604		REQUESTERIZER
3	76322144	20011005		RESORTQUEST TECHNOLOGIES
4	76303155	20010822		REQUEST SWITCHING
5	75833293	19991027		AGILQUEST
6	75766787	19990803		SPAGHETTI QUESTIONS
7	75876315	19991220		I Q IQUEST
8	75356010	19970912	®	INNQUEST
9	75241521	19970213	®	CRUISEQUEST
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