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U.S. Patent & TMO/TM Mail Rcpt Dt. #22

ATTORNEY'S DOCKET NO.: H00654/20001 (DRW/LWM)

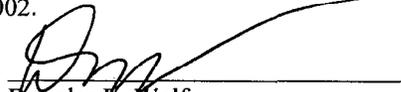
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : HelpMagic.Com Ltd.
 Serial No. : 76/121865
 Filed : September 5, 2000
 For : CALLBACKMAGIC
 Examiner : Susan Kastriner Lawrence
 Law Office : 113

*Miscellaneous
Exhibits*

CERTIFICATE OF MAILING UNDER 37 C.F.R. § 1.8 (a)

The undersigned hereby certifies that this document is being placed in the United States mail with first-class postage attached, addressed to BOX RESPONSE NO FEE, Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA 22202-3513, on the 15th day of May, 2002.


 Douglas R. Wolf

BOX RESPONSE NO FEE
 COMMISSIONER FOR TRADEMARKS
 2900 CRYSTAL DRIVE
 ARLINGTON, VA 22202-3513

TRADEMARK TRIAL AND
 APPEAL BOARD
 02 JUN 11 AM 8:23

Sir:

Transmitted herewith are the following documents:

- Response to Office Action Dated November 15, 2001
- Copy of Ex Parte Appeal from Examiner of Trademarks to Trademark Trial and Appeal Board
- Acknowledgement Postcard

If the enclosed papers are considered incomplete, the Mail Room and/or the Application Branch is respectfully requested to contact the undersigned at (617) 720-3500, Boston, Massachusetts.

A check is not enclosed. If a fee is required, the balance may be charged to the account of the undersigned, Deposit Account No. 23/2825. A duplicate of this sheet is enclosed.

Respectfully submitted,


 Douglas R. Wolf
 Wolf, Greenfield & Sacks, P.C.
 600 Atlantic Avenue
 Boston, MA 02210-2211
 (617) 720-3500

Date: May 15, 2002
 X05/15/02

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TRADEMARK LAW OFFICE 16

Serial Number: 76/121865

Mark: CALLBACKMAGIC

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**of Response to Office Action ONLY **

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Douglas R. Wolf

Box Response No Fee
Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

Sir:

RESPONSE

The Applicant acknowledges the Office Action dated November 15, 2001 in the above matter. In response hereto, the Applicant responds as follows:

Identification of Services

Amend the identification of services to read as follows:

-- Telecommunications services, namely, facilitating live communication between customer support and third parties via computer or telephone contact in International Class 38;

Technical support services, namely, trouble shooting of computer hardware and software problems via telephone, e-mail and chat rooms; providing a searchable database of information relating to computer hardware and software problems; consultation in the

field of information technology, computer hardware and computer software in International Class 42.--.

REMARKS

The Examining Attorney has issued the November 15, 2001 Office Action in the above-matter. The Examining Attorney has requested that the Applicant amend the identification of services. In response, the Applicant has amended the identification of services as requested by the Examining Attorney.

The Examining Attorney rejected this application under Trademark Act Section 2(d) on the grounds that Applicant's mark, CALLBACKMAGIC, when used on or in connection with the identified services, is confusingly similar to U.S. Registration No. 2,393,857 for the mark CALL MAGIC & Design for "telecommunication services, namely, telephony services such as call and facsimile forwarding, call routing, paging, E-mail notification, audio conferencing, and providing local and long distance services." The Applicant respectfully traverses this rejection.

There are distinct differences in the marks to preclude a likelihood of confusion. It is noted that "confusion is related not to the nature of the mark but to its affect when applied to the goods of the Applicant. [Therefore] the only relevant application is made in the marketplace." In re E.I. DuPont de Nemours & Co., 177 U.S.P.Q. 563 (C.C.P.A. 1973).

The cited mark is used in association with services that are distinctly different from Applicant's services. The services of the cited mark are to be used in connection with telecommunication services, more specifically, telephone services for the home, business, mobile phones and the like. The Applicant uses its mark on help desk based services that are installed on the customers system in order to enhance client services. A consumer with a need for telephony services will not be confused with Applicant's help desk services.

Further, the facts in each case vary and the weight to be given each factor may be different in light of the varying circumstances; thus, there can be no rule that certain goods or services are "per se" related, such that there must be a likelihood of confusion from the use of similar marks in relation thereto. TMEP 1207.01(a)(iv). *See also*, Information Resources Inc. v. X*Press Information Services, 6 U.S.P.Q.2d 1034, 1038 (T.T.A.B. 1988) (regarding computer hardware and software). Applying this analysis to the present case, the fact that the

identification of services both include telecommunication services does not necessitate a finding of likelihood of confusion, especially where the services are not the same and are used for distinctly different purposes.

Conditions under which the services are encountered in the marketplace and purchasing decisions are made must also be considered when evaluating the likelihood of confusion. TMEP 1207. If the decision is made by a sophisticated purchaser concerning an expensive product, it may be sufficient to negate a likelihood of confusion even between marks of great similarity. Litton Sys., Inc. v. Whirlpool Corp., 221 U.S.P.Q. 97, 112 (Fed. Cir. 1984). In the present case, it is noted that Applicant's mark is used on complex services for high level technical merchants that are beyond the general public. In relation to the cited registration, consumers are purchasing telephony services. With respect to the Applicant's goods, a purchaser cannot walk into a store and purchase the relevant goods. A purchaser of Applicant's goods would have to obtain the goods directly from the Applicant. On the other hand, when purchasing goods related to the cited mark, the purchaser would have to go directly to a telephone or telecommunications company that offers these specific services, whose knowledge and expertise would greatly differ from the Applicant's since the goods are in completely different channels of trade. Consumers would not accidentally purchase products for telephony services when they mean to purchase items for help desk and customer service problems. Moreover, goods such as those under the proposed mark are typically advertised in different industry specific journals and the cited marks goods are typically advertised in newspapers, glossy inserts, and the like. It is highly unlikely that consumers of the cited marks services would encounter Applicant's goods. Therefore, these goods do not move in the same channels of trade. As such, there would be no likelihood of confusion between Applicant's mark and the cited registrations. Moreover, in view of the labor intensive services provided by the Applicant the cost is significant to the purchasing company that confusion is mitigated.

Additionally, it is requested that the Examining Attorney consider and compare the marks in their entireties as to appearance, sound, connotation and commercial impression in view of the goods. See In re E.I. du Pont de Nemours & Co., 476 F.2d 1357, 1361 (C.C.P.A. 1973); T.M.E.P. §1207.01. In evaluating the issue of likelihood of confusion, it is suggested that the Examining Attorney compare Applicant's mark, CALLBACKMAGIC, in its entirety with the cited mark, CALL MAGIC. Moreover, it is respectfully suggested that the Examining Attorney

erroneously considered the similar sound of only a *portion* of the Registrant's mark before concluding that the marks are similar. See Packard Press, Inc. v. Hewlett-Packard Co., 56 U.S.P.Q.2d 1351, 1357 (Fed. Cir. 2000) (noting that *all* relevant facts pertaining to appearance, sound, and connotation must be considered before similarity as to one or more of those factors may be sufficient to support a finding that the marks are similar or dissimilar); Spice Island, Inc. v. Frank Tea & Spice Co., 184 U.S.P.Q. 35, 37 (C.C.P.A. 1974) (noting that it is improper to ignore a portion of a composite mark).

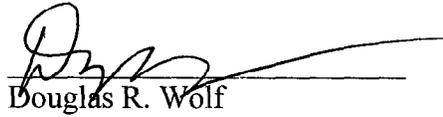
The present mark, in its entirety, can be distinguished from the cited mark and avoid any likelihood of confusion by the average consumer. In the present case, Applicant's trademark is a composite mark formed from the combination of the the words "CALL," "BACK," and "MAGIC." The cited registration is a composite mark formed from the combination of the the words "CALL," and "MAGIC." The marks, therefore, are different in terms of their overall appearance, sound and commercial impression.

It is not likely or probable that such consumers would confuse Applicant with others. Courts have consistently interpreted the likelihood of confusion standard as requiring much more than a "possibility" of confusion. McGregor- Doniger Inc. v. Drizzle, Inc., 599 F.2d 1126 (2d Cir. 1979) (an "appreciable number of ordinary prudent purchasers are likely to be misled, or indeed simply confused"); Int'l Assoc. of Machinists & Aerospace Workers v. Winship Green Nursing Center, 103 F.3d 196 (1st Cir. 1996) ("the law has long demanded a showing that the allegedly infringing conduct carries with it a likelihood of confounding an appreciable number of reasonably prudent purchasers exercising ordinary care"); Estee Lauder Inc. v. The Gap, Inc., 108 F.3d 1503 (2d Cir. 1997) ("likelihood of confusion means a probability of confusion; it is not sufficient if confusion is merely 'possible'"); Elvis Presley Enterprises Inc. v. Capece, 141 F.3d 188 (5th Cir. 1998) ("likelihood of confusion is synonymous with a probability of confusion, which is more than a mere possibility of confusion"). In this case, the differences in the goods and services; the sophistication of the consumer; and the differences in the channels of trade and appearance sound and commercial impression eliminate the probability of confusion between Applicant's mark and the cited registration.

Since this refusal to register is final, Applicant has preserved its rights by submitting contemporaneously with this amendment a Notice of Ex Parte Appeal from Examiner of Trademarks to the Trademark Trial and Appeal Board, a copy of which is enclosed.

In view of the foregoing, the Applicant respectfully requests reconsideration of this application.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'D. Wolf', is written over a horizontal line.

Douglas R. Wolf
Wolf, Greenfield & Sacks, P.C.
600 Atlantic Avenue
Boston, MA 02210-2211
(617) 720-3500

FILE NO.: H00654/20001

DATE: May 15, 2002

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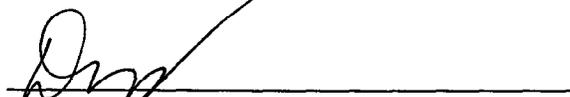
EX PARTE APPEAL FROM EXAMINER OF TRADEMARKS
TO TRADEMARK TRIAL AND APPEAL BOARD

Dear Sir:

Applicant hereby appeals to the Trademark Trial and Appeal Board from the final decision of the Examiner of Trademarks refusing registration under Trademark Act Section 2(d).

The Appeal Fee of \$200.00 is enclosed. If for any reason the fee is insufficient, please charge the balance to Deposit Account 23/2825 of the undersigned attorneys. A duplicate of this sheet is enclosed.

Respectfully submitted,



Douglas R. Wolf
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600 Atlantic Avenue
Boston, MA 02210-2211
(617) 720-3500

Dated: May 15, 2002