



TTAB

12-10-2002

U.S. Patent & TMO/c/TM Mail Rcpt Dt. #71

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

Applicant: Microshield, Inc.
Application Serial No.: 76/246300
Filing Date of Application: April 25, 2001
Mark: MICROSIELD

NOTICE OF APPEAL TO THE TTAB

Dear Sir or Madam:

Applicant, Microshield, Inc., hereby appeals to the Trademark Trial and Appeal Board from the decision of the Examining Attorney refusing registration.

Applicant has filed a Request for Reconsideration under 37 CFR 2.142 concurrently with the filing of the Notice of Appeal.

Submitted herewith is the requisite appeal fee of \$100. Should additional charges be incurred in this matter, please charge them against the Deposit Account of Hogan & Hartson, Account No. 08-2550, and reference our client number 85624.0001.

Respectfully submitted,

By: Steven C. Petersen

Steven C. Petersen
Hogan & Hartson L.L.P.
Suite 1100
8300 Greensboro Drive
McLean, Virginia 22102
(720-406-5315
Attorneys for Applicant,
Microshield, Inc.

12/18/2002 MWILSON 00000230 76246300

01 FC:6403

100.00 DP

Date: December 9, 2002

Applicant: Microshield, Inc.
Trademark: MICROSIELD
Serial No.: 76/246,330

Certificate of Mailing by Express Mail

I certify that the following documents: 1. Transmittal letter; 2. Notice of Appeal to the TTAB; 3. Check in the amount of \$100 to cover the appeal fee; 4. Amendment and Response to Office Action Request for Reconsideration Under 37 CFR 2.142; and 5. Return card are being deposited on December 9, 2002 with the U.S. Postal Service "Express Mail Post Office to Addressee" service under C.F.R. 1.10 and is addressed to the Commissioner for Trademarks Box Response/FEE, 2900 Crystal Drive, Arlington, Virginia 22202-3513.



Signature of Person Mailing Correspondence

Susan L. Martin

Typed or Printed Name of Person Mailing Correspondence

EL 954339349 US

Express Mail Mailing Label Number



12-10-2002

U.S. Patent & TMO/TM Mail Rcpt Dt. #7

TAB

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: MicroShield, Inc.

Mark: MICROSIELD

Application Serial No.: 76/246,300

Box RESPONSES
NO FEE
Assistant Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

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TM/PTO/TM MAIL MID

AMENDMENT AND RESPONSE TO OFFICE ACTION
REQUEST FOR RECONSIDERATION UNDER 37 CFR 2.142

Attn: Charles L. Jenkins, Jr.
Trademark Examining Attorney
Law Office 105

Dear Mr. Jenkins:

MicroShield, Inc., hereby responds to the Office Action dated June 10, 2002, in which the U.S. Patent and Trademark Office continued its refusal to registration of the mark MICROSIELD.

AMENDMENT

Applicant hereby amends its identification of goods to the following:

Powered zeolite additives for use as an antimicrobial in the manufacture of porous plastic water filters that are prone to microbial contamination in International Class 1.

RESPONSE

While the Examiner has withdrawn Application Serial No. 75/697497 as a potential bar to the registration of Applicant's mark, he has denied registration under Section 2(d) of the Act, due to the finding that the proposed mark, when used on or in connection with the identified goods, so resembles the mark MICROSHIELD (reg. Number 1697232) for synthetic protective resin surface for fiberglass substrate as to be likely to cause confusion, to cause mistake, or to deceive.

Applicant's Goods are not Sufficiently Similar to the Goods Provided Under the Mark Cited by the Examiner for a Likelihood of Confusion to Exist.

As Applicant's revised recitation of goods makes clear, Applicant's goods are not sufficiently similar to the goods provided under the mark cited by the Examiner for a likelihood of confusion to exist. Applicant intends to use the mark in connection with an antimicrobial designed to be used with products prone to the formation of biofilms. In contrast, the cited registration is for a synthetic protective resin surface for a fiberglass substrate. Since fiberglass substrates are made up of extremely fine glass fibers in order to avoid pieces of fine glass from breaking off and imbedding within surfaces (such as hands) that the fiberglass comes in contact with, a protective resin is applied over the surface of the fiberglass substrate. Hence, resin as used by the cited registered mark is directed towards some viscous substance that is applied to the fiberglass substrate in need of encapsulation or protection. In this instance, the resin, after solidifying, serves as an inert barrier between the

fiberglass substrate and whatever comes in contact with the fiberglass. Conversely, the Applicant's use of zeolite is as an active antimicrobial material, not as an inert protective barrier. Thus, while the examiner has found the terms zeolite and resin used in the same breadth, this is not evidence that the substances are analogous; and in fact, in this particular situation they are not. The Applicant uses the term zeolite as an active antimicrobial, while the registered mark uses the term resin for an inert barrier.

Sophistication of Customers

Applicant respectfully submits that these goods are related only in the most general and non-specific way. It is significant that the nature of each party's goods requires consumers to make studied, deliberate purchases. Thus, confusion of sponsorship between the parties' respective goods is not likely.

It is significant that the nature of each party's goods requires consumers to make studied, deliberate purchases. Consumers would not be expected to whimsically purchase items for their own consumption. Thus, confusion of sponsorship between the parties' respective goods is not likely. See Haydon Switch & Instrument, Inc. v. Rexnord, Inc., USPQ 2nd 1510 (D.Conn. 1987) finding that "where the parties produce non-competitive industrial parts for custom-designed assemblies, this "tips the weight of evidence decisively" in favor of no likelihood of confusion. Sophisticated purchasers of the products of [the parties] enter the marketplace in search of specific products for specific industrial purposes. The sophistication of these purchasers makes the likelihood of confusion remote." See Castle Oil Corp. v. Castle Energy Corp., 26 USPQ2d 1481, 1489, (E.D. Pa. 1992), no likelihood of confusion found where buyers are sophisticated professionals in the fields of bulk heating oil and oil exploration investment. Here the court found "**where, as here, different goods are sold, even if sold under the same mark, to different discriminating purchasers, there is no likelihood of confusion.**"

Dissimilarity of Consumers

Applicant and the owner of the cited mark target their respective services to entirely different audiences. As explained above, while Applicant targets its goods to manufacturers of goods that are prone to microbial contamination, the owner of the cited mark targets its services to products made from fiberglass, such as rake handles and the like that require an inert barrier be formed over the fiberglass part so that glass particles do not break off in the consumer's hands. Accordingly, confusion as to sponsorship between each party's goods is unlikely.

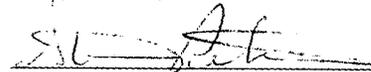
CONCLUSION

Applicant has amended its identification of goods to clarify and accurately reflect the goods rendered under its mark. For the above-referenced reasons, Applicant submits that there is no likelihood of confusion between its mark and the marks cited by the Examiner, and respectfully requests that its mark be allowed to proceed to publication.

Date: December 9, 2002

Respectfully submitted,

By:



Steven C. Petersen
Hogan & Hartson, L.L.P.
Suite 1100
8300 Greensboro Drive
McLean, Virginia 22102
(720) 546-5315

Attorney for Applicant,
MicroShield, Inc.

HOGAN & HARTSON
L.L.P.

STEVEN C. PETERSEN
PARTNER
(720) 406-5315
SCPETERSEN@HHLAW.COM

1470 WALNUT STREET, SUITE 200
BOULDER, COLORADO 80302
TEL (720) 406-5300
FAX (720) 406-5301
WWW.HHLAW.COM

December 9, 2002

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Box TTAB
FEE
Commissioner for Trademarks
U.S. Patent and Trademark Office
2900 Crystal Drive
Arlington, VA 22202-3513

Dear Sir or Madam:

Enclosed for filing is a Notice of Appeal to the TTAB for the following mark:

Applicant: Microshield, Inc.
Serial Number: 76/246300
Filing Date: April 25, 2001
Mark: MICROSHIELD

In accordance with 37 C.F.R. 2.6(a)(18), enclosed is a check in the amount of \$100 for the filing fee. Please date stamp the enclosed self-addressed, postage prepaid return and return it to our office via U.S Mail.

Sincerely,



Steven C. Petersen

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Enclosures

WASHINGTON, DC

\\BO - 85624/0001 - 145472 v1 BERLIN BRUSSELS LONDON PARIS BUDAPEST PRAGUE WARSAW MOSCOW TOKYO
NEW YORK BALTIMORE McLEAN MIAMI DENVER BOULDER COLORADO SPRINGS LOS ANGELES