

T.T.A.B

12550/102

08/13/2003TTAB
08/13/2003TTAB

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

Applicant : Bowne & Co., Inc.
Serial No. : 76/269,850
Filed : June 11, 2001
Mark : BOWNE GLOBAL SOLUTIONS
Examining Attorney : Judy Grundy
Law Office : 106

Express Mail® mailing label No.: EV 232315372 US
Date of Deposit: August 13, 2003

I hereby certify that this paper or fee is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 on the date indicated above and is addressed to the Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA 22202-3513.
Name: Victoria Serrano

Signature: Victoria Serrano



08-13-2003

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

Trademark Trial and Appeal Board
Assistant Commissioner for Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3513

Attn: Box T.T.A.B.
NO FEE

REPLY BRIEF

03 AUG 18 03 9:22

09/19/2003 10:51 AM
09/19/2003 10:51 AM
09/19/2003 10:51 AM

Introduction

Applicant/Appellant (“Applicant”) submits this Reply Brief, pursuant to 37 C.F.R. §2.142(b)(1), in response to the Examiner’s Brief filed May 29, 2003. On July 10, 2002, the Examining Attorney issued a final refusal (the “Final Refusal”) to register Applicant’s mark BOWNE GLOBAL SOLUTIONS (“Appellant’s Mark”), in International Class 42, under Trademark Act Section 2(d), 15 U.S.C. §1052(d). Registration was refused on the ground that it is likely to be confused with the mark GLOBAL SOLUTIONS of U.S. Trademark Registration No. 2,061,051 (the “Cited Mark”).

II. The Examining Attorney Has Not Applied The Correct Legal Standard

As a threshold matter, in her brief the Examining Attorney did not address Applicant’s concern that the Examining Attorney applied an incorrect and overly prohibitive legal standard in evaluating the likelihood of confusion between the Cited Mark and the Applicant’s Mark. The Examining Attorney stated that Applicant had a legal duty to select a mark that was “totally dissimilar” to the Cited Mark. Applicant believes application of this improper standard resulted in the erroneous refusal to register Applicant’s Mark. Denial of registration based upon application of this improper standard should not be upheld. Therefore Applicant respectfully requests that the Board recognize that the appropriate standard was not applied in denying registration of Applicant’s Mark and determine that under the proper standard Applicant’s Mark is entitled to registration.

III. There is No Likelihood of Confusion Between the Cited Mark and Applicant’s Mark

In contrast to the “totally dissimilar” test which the Examining Attorney used as the ultimate basis for the Final Refusal, the correct test to be applied in determining likelihood of confusion is articulated in In re E.I. Dupont De Nemours & Co., Inc., 476 F.2d 1375 (C.C.P.A. 1973). This test first looks at the marks themselves for similarity in

09/19/07 09:08:11 AM
09/19/07 10:08:11 AM
appearance, sound, connotation and commercial impression (the “Sight, Sound and Meaning Test”), second, requires that the Examining Attorney compare the goods or services to determine if they are related or if the activities surrounding their marketing are such that confusion is likely, and considers other enumerated factors that have a bearing on a determination of likelihood of confusion (e.g. sophistication of purchasers).

When Applicant’s Mark is compared, in its entirety, to the Cited Mark, there is no likelihood of confusion. Applicant’s mark is distinguished from the Cited Mark by the addition of the BOWNE house mark. Although the Examining Attorney has argued that the addition of the famous BOWNE mark “does not diminish the likelihood of confusion in this case” Examining Attorney’s Appeal Brief (“Examiner’s Brief”) p. 5. Applicant respectfully disagrees.

Use of a famous company name or house mark can significantly lessen any likelihood of confusion which may exist between two marks. W.W.W. Pharm. Co. v. Gillette Co., 984 F.2d 567 (2d Cir. 1993)(RIGHT GUARD SPORTS STICK was not confusingly similar to SPORTSSTICK). In addition, the incorporation in an otherwise similar mark of a well-known and widely recognized brand name can significantly reduce, if not completely eliminate, likelihood of consumer confusion. Nabisco, Inc. v. Warner-Lambert Co., 220 F.3d 43 (2nd Cir. 2000)(critical distinction between DENTYNE ICE and ICE BREAKERS was prominent use of DENTYNE house brand, which essentially eliminated any likelihood of confusion). Similarly, the prominent addition of the famous BOWNE mark to Applicant’s Mark is sufficient to dispel any such confusion.

Consumers in the international business market are sophisticated. Thus, such consumers will recognize that the vast number of uses of the phrase “global solutions” merely describe international problem solving. The phrase “global solutions” as applied to a variety of international business ventures lessens the capacity of the phrase alone to signify origin. See, e.g., In re Merchandising Motivation, Inc., 184 U.S.P.Q. 364

09/20/73 09:07:14 AM
09/21/07 09:06:11 AM

(Inclusion of the merely descriptive word “menswear” in the composite mark MMI MENSWEAR did not render mark confusingly similar to mark MENSWEAR) Thus, consumers of such services are able to readily distinguish between such services and their various providers. Those consumers will also recognize the BOWNE name as identifying the world’s largest financial printer and a leader in international information dissemination. Thus, the relevant consumers will understand that services provided under the BOWNE GLOBAL SOLUTIONS mark emanate from the Applicant, and would not be confused between Applicant’s services and those of another entity providing similar services under the cited GLOBAL SOLUTIONS mark.

IV. Applicant’s Services Are Distinguishable From Those Of Registrant

While it is true that both Applicant and Registrant provide some similar services, this does not mandate a finding of likelihood of confusion. The only identical services which the parties both provide are language translation and interpretation services. The other services provided by Applicant, while in the same general field of international business services, are not identical to Registrant’s services. Further, any similarities in those services do not dictate a determination that consumer confusion is likely. Registration should not be automatically denied because Applicant’s marks is applied to some services which are similar to Registrant’s services. See, e.g. Ferro Corp. v. Nicofibers, Inc., 196 U.S.P.Q. 41(T.T.A.B. 1977) (UNIFORMAT and CONFORMAT were not confusingly similar despite being used on the same fiberglass product); Iodent Chem. Co. v. Dart Drug Corp., 207 U.S.P.Q.602 (T.T.A.B. 1980)(BIODENT and IODENT not confusingly similar for denture care products).

09/10/2003 11:11 AM
09/10/2003 11:11 AM
09/10/2003 11:11 AM

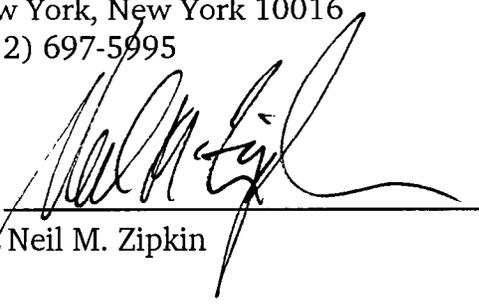
Conclusion

In view of the foregoing, and the arguments presented by Applicant in its Brief on Appeal, Applicant submits that the Examining Attorney's refusal to register Applicant's BOWNE GLOBAL SOLUTIONS mark is in error, and respectfully requests that the Board reverse the refusal to register and allow Applicant's mark to pass to publication.

Respectfully submitted,

AMSTER, ROTHSTEIN & EBENSTEIN
Attorneys for Applicant
90 Park Avenue
New York, New York 10016
(212) 697-5995

Dated: New York, New York
August 13, 2003

By: 
Neil M. Zipkin

EV 232315372 US



UNITED STATES POSTAL SERVICE®
Post Office To Addressee

Mailing Label
Label T-F June 2002

ORIGIN (POSTAL USE ONLY)

PO ZIP Code	Day of Delivery <input type="checkbox"/> Next <input type="checkbox"/> Second	Flat Rate Envelope <input type="checkbox"/>
Date In Mo. Day Year	<input type="checkbox"/> 12 Noon <input type="checkbox"/> 3 PM	Postage \$
Time In <input type="checkbox"/> AM <input type="checkbox"/> PM	Military <input type="checkbox"/> 2nd Day <input type="checkbox"/> 3rd Day Intl Alpha Country Code	Return Receipt Fee
Weight lbs. ozs.	Acceptance Clerk Initials	COD Fee Insurance Fee
<input type="checkbox"/> No Delivery <input type="checkbox"/> Weekend <input type="checkbox"/> Holiday		Total Postage & Fees \$

CUSTOMER USE ONLY
METHOD OF PAYMENT: **X100082**
Express Mail Corporate Acct. No.

FROM: (PLEASE PRINT) PHONE **212 336-8800**

AMSTER ROTHSTEIN & EBENSTEIN
90 PARK AVE FL 21
NEW YORK NY 10016-1463

DELIVERY (POSTAL USE ONLY)	
Delivery Attempt	Time <input type="checkbox"/> AM <input type="checkbox"/> PM
Employee Signature	
Mo. Day	Time <input type="checkbox"/> AM <input type="checkbox"/> PM
Employee Signature	
Delivery Date	Time <input type="checkbox"/> AM <input type="checkbox"/> PM
Employee Signature	
Mo. Day	Time <input type="checkbox"/> AM <input type="checkbox"/> PM
Employee Signature	

NO DELIVERY: Weekend Holiday

WAVER OF SIGNATURE (Corporate Only): Addressee must be a resident of the United States and must be at least 18 years of age. Signature of addressee or authorized agent (with name and address) must be obtained. Signature of addressee or authorized agent (with name and address) must be obtained. Signature of addressee or authorized agent (with name and address) must be obtained. Signature of addressee or authorized agent (with name and address) must be obtained.

Customer Signature

TO: (PLEASE PRINT) PHONE

Trademark Trial & Appeal Board
Assistant Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513
BOX T.T.A.B. - NO FEE

FOR PICKUP OR TRACKING CALL 1-800-222-1811 WWW.USPS.COM



12/ 250 F:02 T:

09/20/2002TAG
09/19/2002TAG

6/11/2005 10:05 AM

The stamp of the Patent/Trademark/Copyright Office Mail Room hereon acknowledges the receipt of the below-identified document(s) on the date indicated by such stamp.

Client/Matter No.: 12550.102 Exp. Mail No.: EV 232315372 US
Date Mailed: August 13, 2003 Atty.: NMZ Sec.: vls
In re: (Applicant or Parties): Bowne & Co., Inc.
Serial No. or Proceeding No.: 76/269,850
Title of Document(s) Forwarded: 1. Reply Brief
