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

Applicant: Shark Abrasion Systems Pty. Ltd.

Serial No.: 76/417,366

Mark: SHARK

Filed: May 31, 2002

Examining Attorney: William T. Verhosek

Law Office: 114

Attorney's Reference: 31848-181422

Hon. Assistant Commissioner for Trademarks
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03-10-2004

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

APPLICANT'S REPLY BRIEF

In order to establish a relatedness of Applicant's goods and registrant's goods, the Examining Attorney has relied upon (a) the fact that there exist third-party registrations that allegedly show that there are third-party marks which cover both the applicant's goods and the registrant's goods; and (b) internet printouts that purport to show the relatedness of the applicant's goods and the registrant's goods.

Both the applicant and the Examining Attorney recognize that goods must be related in some manner, or the conditions surrounding their marketing be such that they could be encountered by the same purchasers under circumstances that could give rise to the mistaken belief that the goods come from a common source.

Applicant respectfully submits that the fact that different goods are listed in a third-party registration is insufficient, in and of itself, to prove that such goods are sufficiently related to sustain a refusal of registration under Section 2(d) of the Trademark Act based upon a likelihood of confusion.

If the standard for determining relatedness of goods is whether or not such goods are listed in the same third-party registration, then, as a practical matter, such goods as "pickles and light bulbs" and "taco shells and toilet paper" would be related goods (see Registration No. 2,380,362), as would "watches" and "bottled water" and "umbrellas" and "freeze-dried ice cream" (see Registration No. 2,783,160). In fact, it is most likely that any two items chosen at random are likely both listed in at least one trademark registration.

Perhaps the fact that the Examining Attorney could only locate 24 third-party registrations¹ in which the Applicant's goods and the Registrant's goods allegedly appear is evidence that it is quite rare for both products to be associated with a single source.

Finally, on page 5 of the Examining Attorney's Appeal Brief, the Examining Attorney has completely mischaracterized the registrant's goods.

The Examining Attorney has made the following statements:

"The broadness of registrant's identification, namely 'trenching machines' encompasses those goods in applicant's identification, namely 'excavators, diggers and loaders.'"

"Since there are no limitations in the identification by registrant with respect to the type of goods and channels of trade, then there is the presumption that registrant's goods are 'chains for excavators, diggers, loaders' and other earthmoving equipment."

First, the Registrant's identification of goods is not broad; rather, it is limited to "chain comprised of digging bits for trenching machine." The wording "excavators, diggers, loaders" is nowhere to be found.

¹ As indicated in Applicant's Brief, it is Applicant's contention that only four of the third-party registrations relied upon by the Examining Attorney come even close to covering both the Applicant's goods and the Registrant's goods.

Second, the identification of the Registrant's goods is strictly limited to "chain comprised of digging bits for trenching machine." Based upon that limitation, Applicant takes issue with the Examining Attorney's contention that "there are no limitations in the identification by registrant with respect to the type of goods" offered by the Registrant. The registrant's goods are clearly limited to "chain comprised of digging bits for trenching machine." There is no presumption that the Registrant's goods are also "chains for excavators, diggers, loaders" and other earthmoving equipment.

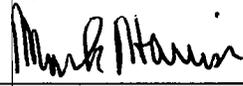
As indicated in Applicant's Appeal Brief, in order to maintain a rejection under Section 2(d), it is not sufficient if confusion is merely "possible." A higher standard is required. See Shatel Corp. v. Mao Ta Lumber & Yacht Corp., 697 F.2d 1352, n.2, 220 U.S.P.Q. 412 (11th Cir. 1983) (likelihood is synonymous with probability); Rodeo Collection, Ltd. v. West Seventh, 812 F.2d 1215, 2 U.S.P.Q.2d 1204, 1206 (9th Cir. 1987) ("Likelihood of confusion requires that confusion be probable, not simply a possibility."); Blue Bell Bio-Medical v. Cin-Bad, Inc., 864 F.2d 1253, 9 U.S.P.Q.2d 1870, 1875 (5th Cir. 1989) ("[Plaintiff] must show, however, that confusion is probable; a mere possibility that some customers might mistakenly identify the [defendant's product] as [plaintiff's] product is not sufficient.").

This burden has not been met in this case.

Based upon the foregoing, it is respectfully requested that the refusal of registration be reversed, and that this mark be forwarded for publication in the *Official Gazette*.

Date: March 10, 2004

By: _____



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