

ESTTA Tracking number: **ESTTA122194**

Filing date: **01/29/2007**

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

Proceeding	76621488
Applicant	IKON Office Solutions West, Inc.
Applied for Mark	IKON FINANCIAL SERVICES
Correspondence Address	Allison Z. Gifford Duane Morris LLP 30 S. 17th Street Philadelphia, PA 19103 UNITED STATES azgifford@duanemorris.com
Submission	Applicants Request for Remand and Amendment
Attachments	ikonfinansvcsremand.pdf (1 page)(100938 bytes) ikonfinansvcsamend.pdf (2 pages)(196320 bytes)
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Signature	/allison z gifford/
Date	01/29/2007

**REQUEST OF APPLICANT-APPELLANT TO SUSPEND APPEAL AND REMAND TO
THE EXAMINING ATTORNEY FOR CONSIDERATION OF AMENDMENT
PURSUANT TO TBMP 1205.01, 1209.04**

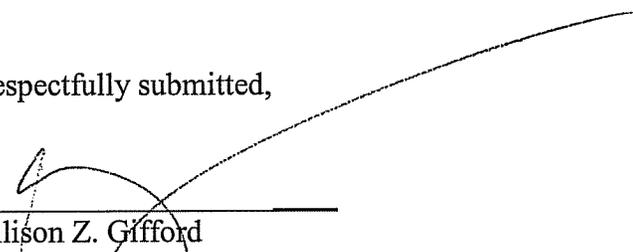
Applicant respectfully requests suspension of the appeal in the above-captioned application and requests remand of the application to the Examining Attorney for entry of the accompanying amendment.

The amendment clarifies and narrows Applicant-appellant's services in Class 36, by indicating the specific financing services provided by Applicant-appellant and indicating the specific consumers for Applicant-appellant's financing services. The amendment should render moot the likelihood of confusion refusal based on the mark ICON INTERNATIONAL, Registration No. 2,506,318, for "exchange services, namely, providing barter services enabling businesses to exchange goods and services, including media advertising, for other goods and services, in Class 35, and financial services, namely, providing a source of financing to businesses in exchange for excess inventories, excess or future capacity, equity or other securities or other excess assets, in Class 36", and will place the application in condition for approval for registration, which renders the appeal moot.

This Request for Remand is submitted within the extended time limit for the filing of Applicant-appellant's brief. If the request for remand is refused, a further period of time for filing of Applicant-appellant's brief is respectfully requested.

Respectfully submitted,

Date: January 29, 2007



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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: IKON Office Solutions, Inc. (formerly IKON Office Solutions West, Inc.)

Serial No.: 76/621,488

Filed: November 19, 2004

Examining Attorney: Paul E. Fahrenkopf

Law Office: 101

Mark: IKON FINANCIAL SERVICES

AMENDMENT UNDER 37 C.F.R. §2.62

Applicant requests that the services recitation in the above-identified application is amended as follows:

--financing services for leasing of office equipment and related accessories, provided only to qualified commercial customers utilizing image reproduction, maintenance, and management services of Applicant company, in International Class 36.--

Applicant was refused registration based on the mark ICON INTERNATIONAL, Registration No. 2,506,318, for "exchange services, namely, providing barter services enabling businesses to exchange goods and services, including media advertising, for other goods and services, in International Class 35, and financial services, namely, providing a source of financing to businesses in exchange for excess inventories, excess or future capacity, equity or other securities or other excess assets, in Class 36." Applicant's amendment clarifies that it is providing financing services for leasing of office equipment and providing those services to only its customers who are already contracted with Applicant for its image reproduction, maintenance, and management services.

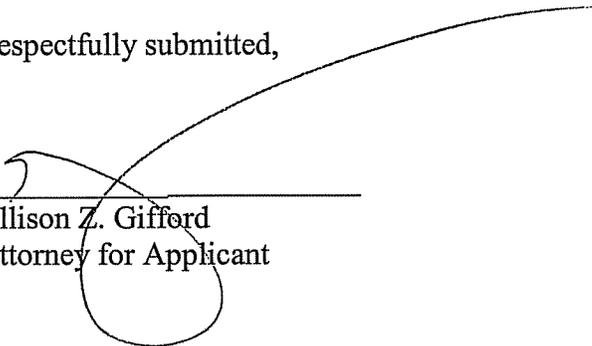
In Applicant's response to the first Office Action in this application, Applicant argued that the marks were not similar, and further argued that the services of Applicant and the cited registrant, Icon International, Inc., were not related and were provided to sophisticated purchasers, so that confusion would not exist. For example, Applicant submitted with its response copies of promotional materials for Applicant's financing services, www.ikon.com, as well as copies of cited registrant's web site, www.icon-intl.com. Applicant clearly provides its financing services for leasing equipment to its qualified customers, and not to the general public. As such, Applicant's financing services customers are already familiar with Applicant, and will know the source of financing services provided with the mark IKON FINANCIAL SERVICES. On the other hand, cited registrant provides sources of financing for businesses in exchange for excess inventories, etc., and provides corporate bartering for goods and services. Cited registrant is clearly in a niche market, and its customers will more than likely be sophisticated business people who are savvy in business and finance. Such business people will clearly know the difference between a transaction for financing excess inventory and financing for equipment leases through a company already providing image reproduction services. Thus, there can be no confusion between the marks IKON FINANCIAL SERVICES and ICON INTERNATIONAL.

Applicant's clarification and narrowing of its Class 36 financing services renders moot the likelihood of confusion refusal, as the services of Applicant and cited registrant are not related, are not competitive, and are provided to sophisticated purchasers.

Applicant requests entry of the above amendment, and requests withdrawal of the 2(d) refusal to register. Favorable action is requested.

Respectfully submitted,

Date: January 29, 2007



Allison Z. Gifford
Attorney for Applicant