

PTO Form 1930 (Rev 9/2007)

OMB No. 0651-0050 (Exp. 4/30/2009)

## Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	76656306
LAW OFFICE ASSIGNED	LAW OFFICE 112
MARK SECTION (no change)	
ARGUMENT(S)	
<p>The Examining Attorney has finally refused registration for the mark RETAILERS EDGE based on a likelihood of confusion with Registration No. 2,259,194 for the mark RETAIL.EDGE. Applicant respectfully requests that the Examining Attorney withdraw the refusal of registration.</p> <p><b>Weakness of the Marks</b></p> <p>Applicant believes that the mark RETAILEDGE is a weak mark and entitled to a narrow scope of protection. In support of its assertion, attached is a copy of Registration No. 2,530,639 for the mark RETAIL EDGE for "providing business, consumer, market, sales, logistics, and statistical information and data in the field of food products." These services appear to be related to the products of the cited registrant, yet this mark was allowed for registration over the cited registration. The scope of protection accorded such terms is obviously so limited as to permit their use and registration by different parties for the same or similar goods or services. Case decisions have clearly and consistently held that the mere fact that the two marks include an identical or root word, even where the goods or services are commercially related or marketed through similar channels of trade, is not sufficient to establish likelihood of confusion. The following list is representative of trademarks/service marks that have been determined NOT likely to cause confusion:</p> <p>BARRE and BARR, both for liquid pharmaceuticals, <u>Barre-National Inc. v. Barr Laboratories Inc.</u>, 21 U.S.P.Q.2d 1755 (DC NJ 1991);</p> <p>VARGAS and VARGA GIRL, both for calendars, In re <u>Hearst Corp.</u>, 25 U.S.P.Q.2d 1238 (CAFC 1992);</p> <p>APPROVALFIRST for mortgage payment financial consulting services, and APPROVAL PLUS for mortgage banking and mortgage brokering services, <u>Sears Mortgage Corp. v. Northeast Savings, FA</u>, 24 U.S.P.Q.2d 1227 (TTAB 1992);</p> <p>FRESH COUNTRY 98.5 and FRESH COUNTRY, both for radio stations, <u>Nationwide Communications, Inc. v. Citadel Communications Corp.</u>, 27 U.S.P.Q.2d 1868 (DC ED Cal. 1993);</p>	

GLENCRAFT and GLEN, both for shirts, In re Variety Supply Co., 147 U.S.P.Q. 537 (TTAB 1965);

NO. 12 OUZO and NO. 1 OUZO, both for ouzo drink, Paddington Corp. v. Attiki Importers & Distributors, Inc., 27 U.S.P.Q.2d 1189 (CA2 1993);

CA-SIMPLY TAX v. TAX\$IMPLE, both for income tax preparation software, Computer Associates international, Inc. v. AJV Computerized Data Management, Inc., 36 U.S.P.Q.2d 1430 (DC ENY 1995);

WEBSTER'S NINTH NEW COLLEGIATE DICTIONARY and WEBSTER'S COLLEGE DICTIONARY, both for dictionaries, Merriam-Webster, Inc. v. Random House, 32 U.S.P.Q.2d 1010 (CA 2 1994);

MILDEX PLUS and MILDEW PLUS, both for mildew stain remover, Atlanta Sundries, Inc. v. S.C. Johnson & Sons, Inc., 30 U.S.P.Q.2d 1175 (DC NGa 1994).

KEY and BANKEY, KEYCHECK, CB KEY, and KEYBANKER, both for banking services, In re Hamilton Bank, 222 U.S.P.Q. 174 (TTAB 1984);

WONDERBOND PLUS and BOND PLUS, both for adhesives, Industrial Adhesive Company v. Borden, Inc., 218 U.S.P.Q. 945, 951 (TTAB 1983);

CORN-ROYAL and ROYAL, both for shortening, Standard Brands, Inc. v. Peters, 191 U.S.P.Q. 168 (TTAB 1975); and

EASY and EASY TINT, both for paints, Murray Corporation of America v. Red Spot Paint and Varnish Company, Inc., 126 U.S.P.Q. 390 (CCPA 1960).

Where commonly used or highly suggestive words are involved, the degree of difference, rather than the degree of similarity, is more likely to be noticeable and, therefore, utilized by purchasers to distinguish two given marks. See Proctor & Gamble Co. v. Johnson & Johnson, Inc., et al., 205 U.S.P.Q. 697 (S.D.N.Y. 1979) (the mark "SURE" held not confusingly similar to the marks "ASSURE!" and "SURE & NATURAL").

#### **Different Channels of Commerce and Classes of Purchasers**

The Registrant has registered its mark RETAILEDGE for "computers and computer programs" related to "point of sale reporting for use by retail establishments in point of sale transactions." Applicant's mark is used on software for use solely in connection with PDA's. The Examining Attorney suggests that Applicant's more narrowly worded goods could be encompassed within the registrant's more broadly worded goods. Specifically, it has been suggested that Applicant's "service and merchandising activity" are similar to registrant's "inventory control." The Examining Attorney has parsed the language incorrectly. It should be understood to read "managing the collection, dissemination, and analysis of service" and "managing the collection, dissemination, and analysis of merchandising activity." There is no suggestion by the wording that this feature relates to "inventory control." Furthermore, Applicant's "analysis of retail sales" do not have anything to do with Registrant's "point of sale reporting" which clearly means that Registrant's software merely prints out a report of the sales numbers from the cash register. There is no analysis being provided. Applicant's program does not "report" sales numbers, but provides an in depth analysis of sales using a collection

of information.

In view of the foregoing, it is requested that the refusal of registration be withdrawn and the application allowed for publication in the U.S. Patent and Trademark Office *Official Gazette*.

### EVIDENCE SECTION

EVIDENCE FILE NAME(S)	
ORIGINAL PDF FILE	http://tgate/PDF/RFR/2009/08/24/20090824182404968206-76656306-001_001/evi_7266806-180922272_._RetailEDge.pdf
CONVERTED PDF FILE(S) (2 pages)	\\TICRS\EXPORT7\IMAGEOUT7\766\563\76656306\xml1\RFR0002.JPG
	\\TICRS\EXPORT7\IMAGEOUT7\766\563\76656306\xml1\RFR0003.JPG
DESCRIPTION OF EVIDENCE FILE	copy of registration No. 2,530,639

### ADDITIONAL STATEMENTS SECTION

DISCLAIMER	No claim is made to the exclusive right to use RETAILERS apart from the mark as shown.
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### SIGNATURE SECTION

RESPONSE SIGNATURE	/mvh/
SIGNATORY'S NAME	Maria v. Hardison
SIGNATORY'S POSITION	Attorney for Applicant, VA Bar member
DATE SIGNED	08/24/2009
AUTHORIZED SIGNATORY	YES
CONCURRENT APPEAL NOTICE FILED	YES

### FILING INFORMATION SECTION

SUBMIT DATE	Mon Aug 24 18:24:04 EDT 2009
TEAS STAMP	USPTO/RFR-72.66.80.6-2009 0824182404968206-76656306 -430f787f213d1cc795c72eb2 1b82cc1b857-N/A-N/A-20090 824180922272954

**Request for Reconsideration after Final Action****To the Commissioner for Trademarks:**

Application serial no. 76656306 has been amended as follows:

**ARGUMENT(S)**

**In response to the substantive refusal(s), please note the following:**

The Examining Attorney has finally refused registration for the mark RETAILERS EDGE based on a likelihood of confusion with Registration No. 2,259,194 for the mark RETAILEDGE. Applicant respectfully requests that the Examining Attorney withdraw the refusal of registration.

**Weakness of the Marks**

Applicant believes that the mark RETAILEDGE is a weak mark and entitled to a narrow scope of protection. In support of its assertion, attached is a copy of Registration No. 2,530,639 for the mark RETAIL EDGE for "providing business, consumer, market, sales, logistics, and statistical information and data in the field of food products." These services appear to be related to the products of the cited registrant, yet this mark was allowed for registration over the cited registration. The scope of protection accorded such terms is obviously so limited as to permit their use and registration by different parties for the same or similar goods or services. Case decisions have clearly and consistently held that the mere fact that the two marks include an identical or root word, even where the goods or services are commercially related or marketed through similar channels of trade, is not sufficient to establish likelihood of confusion. The following list is representative of trademarks/service marks that have been determined NOT likely to cause confusion:

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CA-SIMPLY TAX v. TAXSIMPLE, both for income tax preparation software, Computer Associates international, Inc. v. AJV Computerized Data Management, Inc., 36 U.S.P.Q.2d 1430 (DC ENY 1995);

WEBSTER'S NINTH NEW COLLEGIATE DICTIONARY and WEBSTER'S COLLEGE

DICTIONARY, both for dictionaries, Merriam-Webster, Inc. v. Random House, 32 U.S.P.Q.2d 1010 (CA 2 1994);

MILDEX PLUS and MILDEW PLUS, both for mildew stain remover, Atlanta Sundries, Inc. v. S.C. Johnson & Sons, Inc., 30 U.S.P.Q.2d 1175 (DC NGa 1994).

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In view of the foregoing, it is requested that the refusal of registration be withdrawn and the application allowed for publication in the U.S. Patent and Trademark Office *Official Gazette*.

#### **EVIDENCE**

Evidence in the nature of copy of registration No. 2,530,639 has been attached.

#### **Original PDF file:**

[http://tgate/PDF/RFR/2009/08/24/20090824182404968206-76656306-001\\_001/evi\\_7266806-180922272\\_.\\_RetailEDge.pdf](http://tgate/PDF/RFR/2009/08/24/20090824182404968206-76656306-001_001/evi_7266806-180922272_._RetailEDge.pdf)

**Converted PDF file(s) (2 pages)**

Evidence-1

Evidence-2

**ADDITIONAL STATEMENTS**

**Disclaimer**

No claim is made to the exclusive right to use RETAILERS apart from the mark as shown.

**SIGNATURE(S)**

**Request for Reconsideration Signature**

Signature: /mvh/ Date: 08/24/2009

Signatory's Name: Maria v. Hardison

Signatory's Position: Attorney for Applicant, VA Bar member

The signatory has confirmed that he/she is an attorney who is a member in good standing of the bar of the highest court of a U.S. state, which includes the District of Columbia, Puerto Rico, and other federal territories and possessions; and he/she is currently the applicant's attorney or an associate thereof; and to the best of his/her knowledge, if prior to his/her appointment another U.S. attorney or a Canadian attorney/agent not currently associated with his/her company/firm previously represented the applicant in this matter: (1) the applicant has filed or is concurrently filing a signed revocation of or substitute power of attorney with the USPTO; (2) the USPTO has granted the request of the prior representative to withdraw; (3) the applicant has filed a power of attorney appointing him/her in this matter; or (4) the applicant's appointed U.S. attorney or Canadian attorney/agent has filed a power of attorney appointing him/her as an associate attorney in this matter.

The applicant is filing a Notice of Appeal in conjunction with this Request for Reconsideration.

Serial Number: 76656306

Internet Transmission Date: Mon Aug 24 18:24:04 EDT 2009

TEAS Stamp: USPTO/RFR-72.66.80.6-2009082418240496820

6-76656306-430f787f213d1cc795c72eb21b82c

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**Typed Drawing**

**Word Mark** RETAIL EDGE  
**Goods and Services** IC 035. US 100 101 102. G & S: Providing business, consumer, market, sales, logistics, and statistical information and data in the field of food products. FIRST USE: 20000415. FIRST USE IN COMMERCE: 20000415  
**Mark Drawing Code** (1) TYPED DRAWING  
**Serial Number** 75955899  
**Filing Date** March 10, 2000  
**Current Filing Basis** 1A  
**Original Filing Basis** 1B  
**Published for Opposition** November 14, 2000  
**Registration Number** 2530639  
**Registration Date** January 15, 2002  
**Owner** (REGISTRANT) Nabisco Brands Company CORPORATION DELAWARE 1105 North Market Street, Suite 803 Wilmington DELAWARE 19801  
 (LAST LISTED OWNER) KRAFT FOODS GLOBAL BRANDS LLC LIMITED LIABILITY COMPANY DELAWARE THREE LAKES DRIVE NF 584 NORTHFIELD ILLINOIS 60093  
**Assignment Recorded** ASSIGNMENT RECORDED  
**Attorney of Record** Susan H. Frohling  
**Disclaimer** NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "RETAIL" APART FROM THE MARK AS SHOWN

Type of Mark      SERVICE MARK  
Register            PRINCIPAL  
Affidavit Text     SECT 15. SECT 8 (6-YR).  
Live/Dead  
Indicator           LIVE

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