

**** Please place on Upper Right Corner**
** of Response to Office Action ONLY.****

Examining Attorney: CROWLEY, SEAN
Serial Number: 76/658663



TRADEMARK
Atty. Dkt. No. STE01 T-535

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Law Office : 116
TM Attorney : Sean Crowley
Applicant : Steelcase Development Corporation
Serial No. : 76/658,663
Filed : April 18, 2006
Atty. Dkt. : STE01 T-535
Mark : TRAIN

Commissioner for Trademarks
PO Box 1451
Alexandria, Virginia 22313-1451

Dear Sir:

RESPONSE

In response to the Office action dated April 10, 2007, Applicant offers the following additional remarks.

REMARKS:

Reconsideration of the application is requested.

The Examining Attorney's additional remarks have been received and carefully considered.

In response to the Examining Attorney's objection to the specimen of record, which has now been made final, Applicant again points out that the same is a name plate or plaque which is physically attached to the goods and bears the "TRAIN" trademark. Three photographs of the "TRAIN" brand table with the plate specimen of record attached thereto are enclosed for the Examining Attorney's review. The plates bearing the "TRAIN" trademark are clearly visible when the tabletop is flipped up into the storage position, as shown in the



09-17-2007

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attached photograph. Contrary to the Examining Attorney's statement, the specimen of record is not advertising material for the goods, but rather is in the form of a tag that is applied directly to the goods. In the latest Office action, the Examining Attorney states that,

"In this case however, applicant's specimen of use merely serves to inform applicant of different features of the goods but fails to provide purchasing information, such as the cost of the goods or how the goods may be purchased."

As is clear from § 904.04(a) of the TMEP, which is reproduced below, there is no requirement that a label or tag specimen, such as the specimen of record, include the cost of the goods or how the goods may be purchased.

094.09(a) Labels and Tags

"In most cases, where the trademark is applied to goods or the containers for the goods by means of labels, a label is an acceptable specimen."

The specimen of record is not a catalog specimen under § 904.06(a) of the TMEP that requires the type of additional information noted by the Examining Attorney, but is rather a label or tag specimen under § 904.04(a) of the TMEP. Applicant asserts that the specimen of record does demonstrate use of the mark in commerce on the recited goods, and is appropriate, such that the associated objection should be withdrawn.

The Examining Attorney has again refused registration of under § 2(d) of the Trademark Act in view of prior Registration 1,715,817 on "SLEEP TRAIN" for furniture, and made the rejection final. Enclosed is a copy of an executed Consent Agreement signed on

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behalf of The Sleep Train, Inc., the owner of the cited prior Registration 1,715,817, which attests to the fact that likelihood of confusion does not exist. As set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1363, 177 USPQ 563, 568 (CCPA 1973), the Court of Customs and Patent Appeals stated as follows:

“[W]hen those most familiar with use in the marketplace and most interested in precluding confusion enter agreements designed to avoid it, the scales of evidence are clearly tilted. It is at least difficult to maintain a subjective view that confusion will occur when those directly concerned say it won't. A mere assumption that confusion is likely will rarely prevail against uncontroverted evidence from those on the firing line that it is not.”

“The Court of Appeals for the Federal Circuit has made it clear that consent agreements should be given great weight, and that the Office should not substitute its judgement concerning the likelihood of confusion for the judgment of the real parties in interest without good reason, that is, unless other factors clearly dictate a finding of likelihood of confusion. *Amalgamated Bank of New York v. Amalgamated Trust & Savings Bank*, 842 F.2d 1270, 6 USPQ2d 1305 (Fed. Cir. 1988; *Bongrain International (American) Corp. v. Delice de France Inc.*, 811 F.2d 1479, 1 USPQ2d 1775 (Fed. Cir. 1987); and *In re N.A.D. Inc.*, 754 F.2d 996, 224 USPQ 969 (Fed. Cir. 1985).”

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“The examining attorney should give great weight to a proper consent agreement. The examining attorney should not interpose his or her own judgment concerning likelihood of confusion when an applicant and registrant have entered into a credible consent agreement and, on balance, the other factors do not dictate a finding of likelihood of confusion.”

As is apparent from the enclosed Consent Agreement, the “SLEEP TRAIN” mark is used only in conjunction with mattresses for beds and related sales services. The mattresses on which the “SLEEP TRAIN” mark is used are sufficiently divorced from the nesting flip-top tables for offices, classrooms, and computer labs on which Applicant’s mark is used so as to avoid likelihood of confusion.

In view of the enclosed executed Consent Agreement, and associated arguments in support of the registrability of the present mark, Applicant requests that the § 2(d) refusal be withdrawn.

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Applicant believes that the application is now in condition for allowance and publication. A notice to this effect is earnestly solicited.

Respectfully submitted,

STEELCASE DEVELOPMENT
CORPORATION

By: Price, Heneveld, Cooper,
DeWitt & Litton, LLP



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616/949-9610

CERTIFICATE OF MAILING

I hereby certify that this correspondence, and all identified enclosures and attachments, are being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Trademarks, PO Box 1451, Alexandria, Virginia 22313-1451 on 9/11/07.


Carl S. Clark

CSC/jkrp
Enclosures

June 25, 2007

Steelcase Development Corporation
CD-6W-02
P.O. Box 1967
Grand Rapids, Michigan 49501

Re: Letter of Consent for U.S. Trademark Application Serial No.
76/658,663 on "TRAIN"

Gentlemen:

As owner of the trademark "SLEEP TRAIN" and associated Federal Trademark Registration 1,715,817, this will confirm Sleep Train, Inc.'s position that there is no conflict or likelihood of confusion between our mark "SLEEP TRAIN" as used for the goods specified in our registration, and your mark "TRAIN" as used for nesting flip-top tables for offices, classrooms and computer labs, as covered in your pending Federal Trademark Application Serial No. 76/658,663.

This belief is based upon the fact that both marks have coexisted for over six years, without causing a single incidence of actual confusion.

Furthermore, the goods, although both fall within International class 20, are quite dissimilar in nature, and travel through completely different channels of trade.

Accordingly, as owner of Registration 1,715,817 on the mark "SLEEP TRAIN", we consent to the use and registration by Steelcase Development Corporation of the trademark "TRAIN" for nesting flip-top tables for offices, classrooms and computer labs, as specified in Steelcase's pending Trademark Application Serial 76/658,663. For those reasons set forth above, we feel that there is no likelihood of confusion between the two trademarks.

Sleep Train, Inc., as well as Steelcase Development Corporation, will execute and file with the United States Patent and Trademark Office, any and all documents which may be necessary or proper to effectuate the terms of this consent. If this consent is accepted by the Examining Attorney handling Steelcase Development Corporation's Trademark Application

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June 25, 2007
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Serial No. 76/658,663, Sleep Train, Inc. and Steelcase Development Corporation will take any further actions and execute any further agreements necessary to carryout the spirit and intent of this consent.

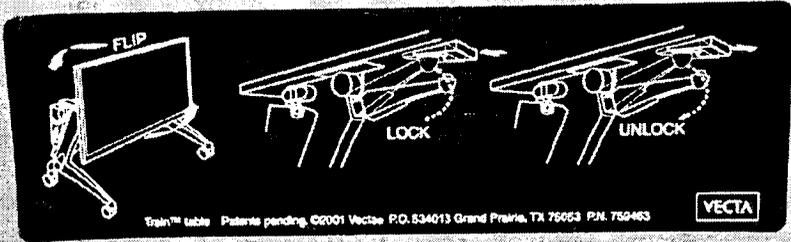
Sincerely yours,



7/19/07

Signed by an Officer of The Sleep Train, Inc.

*PAUL L. GRIMM, General Counsel,
Vice President of Real Estate*



Train™ table Patents pending. ©2001 Vecta P.O. 834013 Grand Prairie, TX 75053 P/N: 750463

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