

Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	77042491
LAW OFFICE ASSIGNED	LAW OFFICE 111
MARK SECTION (no change)	
ARGUMENT(S)	
<p>REQUEST FOR RECONSIDERATION</p> <p>This is in response to the Office Action mailed on September 7, 2007.</p> <p style="text-align: center;"><u>REMARKS</u></p> <p>The Examining Attorney issued her final refusal to register E.A. Sween Company's ("Applicant") CHUCKWAGON mark in connection with "sandwiches" on the ground that it is likely to cause confusion with U.S. Reg. No. 2,281,803 for the mark CHUCK WAGON in connection with "meat, namely, bacon, ham, sausage, frankfurters, ground beef and luncheon meats" ("Cited Mark"). Because confusion is unlikely, Applicant respectfully requests that the Examining Attorney reconsider her position, withdraw the registration refusal, and issue the Notice of Publication.</p> <p style="text-align: center;"><u>ARGUMENT</u></p> <p>The Examining Attorney did not give Applicant's co-existence evidence sufficient weight. Applicant recognizes that the standard under Section 2(d) of the Lanham Act is whether there is a likelihood of confusion. Lanham Act § 2(d), 15 U.S.C. § 1052(d) (2008). And determining the existence of a likelihood of confusion is made by balancing 13 factors. <i>In re E.I. DuPont DeNemours & Co.</i>, 476 F.2d 1357, 1367 (C.C.P.A. 1973).</p>	

However, the Federal Circuit Court of Appeals, the Trademark Office's reviewing court, and the Trademark Trial and Appeal Board (the "Board") recognize that no evidence of actual confusion in the past is highly probative of whether confusion is likely to occur in the future. *See In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 1317 (Fed. Cir. 2003); *Molenaar, Inc. v. Happy Toys, Inc.*, 188 U.S.P.Q. 469, 471 (T.T.A.B. 1975). And the longer the time period of concurrent use with no actual confusion, the more probative this element becomes as an indication that confusion between two trademarks is unlikely. *See Genesco Inc. v. Gregory Martz*, 66 U.S.P.Q.2d 1260 (T.T.A.B. 2003) (finding concurrent use without actual confusion for 20 years a significant amount of time). The Board's finding in *In re Parfums Schiaparelli, Inc.*, 37 U.S.P.Q.2d 1864 (T.T.A.B. 1995), *overruled as to standard review by, In re Sambado & Son, Inc.*, 45 U.S.P.Q.2d 1312 (T.T.A.B. 1997) is instructive of the significance of long periods of concurrent use with no actual confusion:

Here, the course of conduct manifested by applicant and the cited registrant, as reflected in the state of the register over a period of more than 50 years, plainly indicates that such parties, who are in the best position to know the realities of the marketplace for their respective products and are the ones most likely to be harmed if confusion occurs, have repeatedly shown, by their behavior toward the acquisition and maintenance of their registrations, their belief that contemporaneous use of marks which consist of or contain the surname "SCHIAPARELLI" is not likely to cause confusion.

Therefore, long periods of concurrent use also demonstrate consent to use and register a particular trademark. *Id.*

In *In re Kangaroos U.S.A.*, 223 U.S.P.Q. 1025 (T.T.A.B. 1984), cited by the Examining Attorney, Envoy U.S.A., Inc. ("Envoy") claimed to have used its BOOMERANG mark in commerce since June 12, 1981. Envoy filed its trademark application to register the BOOMERANG mark (i.e., Application Serial No. 73/319,021) (the "Application") on July 15, 1981. The filing of Envoy's Application was about one month after it began using the BOOMERANG mark in commerce. Envoy's Application was refused registration based on a likelihood of confusion with United States Registration No. 1,076,499 for BOOMERANG & Design.

Envoy concurrently used its BOOMERANG mark with the BOOMERANG & Design mark

for about eight months before receiving an Office Action and about two years before instituting an appeal. Therefore, it is understandable why the Board in the *Kangaroos* case would accord the evidence of no actual confusion little weight because the BOOMERANG and BOOMERANG & Design marks had not co-existed for a significant period of time. However, the facts in Applicant's case are much different than the facts in the *Kangaroos* case.

Applicant's CHUCKWAGON mark has co-existed with the Cited Mark for almost 44 years, and Applicant has used its CHUCKWAGON mark openly and notoriously for those 44 years. As stated in the Declaration of Tom Sween, over 50,000 CHUCKWAGON brand sandwiches are sold each week. Furthermore, the CHUCKWAGON sandwich is sold in over 25,000 convenience stores, delis, resorts, drug stores, vending machines, and other retail outlets across the United States. There is no question that given Applicant's open and notorious use of its CHUCKWAGON mark and concurrent use with the Cited Mark for almost 44 years that at least one instance of actual confusion would have occurred if in fact the marks are so close as to create a likelihood of confusion. However, no evidence of actual confusion exists because Applicant's CHUCKWAGON mark and the Cited Mark do not create a likelihood of confusion.

Applicant's open and notorious use of its CHUCKWAGON mark is also significant because it demonstrates that the owner of the Cited Mark cannot claim ignorance of Applicant's CHUCKWAGON mark. In other words, the owner of the Cited Mark would be estopped from asserting its rights in the Cited Mark against Applicant's use of its CHUCKWAGON mark. *See, e.g., Borg-Warner Corp. v. York-Shibley, Inc.*, 293 F.2d 88 (7th Cir. 1961) (35-year delay while the parties co-existed under the mark YORK prevented the senior user from obtaining an injunction and expanding into the junior user's product line). If the owner of the Cited Mark would be estopped from asserting rights in the Cited Mark against Applicant's use of its CHUCKWAGON mark, then the Trademark Office should not rely on the Cited Mark as its basis to deny Applicant a federal registration in its CHUCKWAGON mark. Furthermore, 44 years of concurrent use demonstrates that the owner of the Cited Mark implicitly consents to Applicant's use and registration of its CHUCKWAGON mark.

CONCLUSION

Applicant's CHUCKWAGON mark is unlikely to cause confusion with the Cited Mark.
Therefore, Applicant respectfully requests that the Examining Attorney withdraw the refusal register
Applicant's CHUCKWAGON mark and issue the Notice of Publication.

Respectfully submitted,

SIGNATURE SECTION

RESPONSE SIGNATURE	/Bradley J. Walz/
SIGNATORY'S NAME	Bradley J. Walz
SIGNATORY'S POSITION	Attorney of record
DATE SIGNED	03/07/2008
AUTHORIZED SIGNATORY	YES
CONCURRENT APPEAL NOTICE FILED	YES

FILING INFORMATION SECTION

SUBMIT DATE	Fri Mar 07 18:03:36 EST 2008
TEAS STAMP	USPTO/RFR-207.250.219.130 -20080307180336633503-770 42491-420465cb9cd61222823 d8f72b6a9f7be38-N/A-N/A-2 0080307175644699606

PTO Form 1960 (Rev 9/2007)
OMB No. xxx-xxxx (Exp. x/xxxx)

Request for Reconsideration after Final Action

To the Commissioner for Trademarks:

Application serial no. **77042491** has been amended as follows:

ARGUMENT(S)

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

This is in response to the Office Action mailed on September 7, 2007.

REMARKS

The Examining Attorney issued her final refusal to register E.A. Sween Company's ("Applicant") CHUCKWAGON mark in connection with "sandwiches" on the ground that it is likely to cause confusion with U.S. Reg. No. 2,281,803 for the mark CHUCK WAGON in connection with "meat, namely, bacon, ham, sausage, frankfurters, ground beef and luncheon meats" ("Cited Mark"). Because confusion is unlikely, Applicant respectfully requests that the Examining Attorney reconsider her position, withdraw the registration refusal, and issue the Notice of Publication.

ARGUMENT

The Examining Attorney did not give Applicant's co-existence evidence sufficient weight. Applicant recognizes that the standard under Section 2(d) of the Lanham Act is whether there is a likelihood of confusion. Lanham Act § 2(d), 15 U.S.C. § 1052(d) (2008). And determining the existence of a likelihood of confusion is made by balancing 13 factors. *In re E.I. DuPont DeNemours & Co.*, 476 F.2d 1357, 1367 (C.C.P.A. 1973).

However, the Federal Circuit Court of Appeals, the Trademark Office's reviewing court, and the Trademark Trial and Appeal Board (the "Board") recognize that no evidence of actual confusion in the past is highly probative of whether confusion is likely to occur in the future. *See In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 1317 (Fed. Cir. 2003); *Molenaar, Inc. v. Happy Toys, Inc.*, 188 U.S.P.Q. 469, 471 (T.T.A.B. 1975). And the longer the time period of concurrent use with no actual confusion, the more probative this element becomes as an indication that confusion between two trademarks is unlikely. *See Genesco Inc. v. Gregory Martz*, 66 U.S.P.Q.2d 1260 (T.T.A.B. 2003) (finding concurrent use without actual confusion for 20 years a significant amount of time). The Board's finding in *In re Parfums Schiaparelli, Inc.*, 37 U.S.P.Q.2d 1864 (T.T.A.B. 1995), *overruled as to standard review by, In re Sambado & Son, Inc.*, 45 U.S.P.Q.2d 1312 (T.T.A.B. 1997) is instructive of the significance of long periods of concurrent use with no actual confusion:

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of marks which consist of or contain the surname "SCHIAPARELLI" is not likely to cause confusion.

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Respectfully submitted,

SIGNATURE(S)

Request for Reconsideration Signature

Signature: /Bradley J. Walz/ Date: 03/07/2008

Signatory's Name: Bradley J. Walz

Signatory's Position: Attorney of record

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: 77042491

Internet Transmission Date: Fri Mar 07 18:03:36 EST 2008

TEAS Stamp: USPTO/RFR-207.250.219.130-20080307180336

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