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

Proceeding	78132209
Applicant	Allied Electronics Inc.
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MARKS ARE DISTINGUISHABLE

In the Examining Attorney's opening argument, she admits that the Registrant's mark is weak, but then she treats it as if it is worthy of more protection than it deserves by continuing the refusal. It is commonly held that the degree of similarity between marks needed to prove confusion likely varies inversely with the difference in the goods of the parties. In other words, where the goods of the parties are directly competitive, the degree of similarity required to prove likelihood of confusion is less than in the case of products sold to distinctly different consumers. Century 21 Real Estate Corp. v. Century Life of Am., 970 F.2d 874, 877 (Fed. Cir. 1992). Thus, when related goods are sold to distinctly different consumers, even if the marks are identical, there is no likelihood of confusion. See e.g., Beneficial Corp. v. Beneficial Capital Corp., 529 F. Supp. 445 (S.D.N.Y. 1982) (BENEFICIAL for consumer loans not confusingly similar to BENEFICIAL CAPITAL for business loans because marks are weak and not directly competitive).

The Examining Attorney states that the "dominant" component of each mark is the word ALLIED. While Applicant agrees that the only word in common between the instant mark and Registrant's mark is the word ALLIED, it is hardly "dominant" as suggested by the Examining Attorney. Applicant has submitted evidence that the Trademark Office has registered other marks that contain the term ALLIED for Registrant's direct goods (Registration No. 1313180 WRIGHT ALLIED TOOLS for "socket, wrenches, socket sets and wrench sets").

In addition, the Examining Attorney's choice of In re Chatam Int'l Inc. as supporting case law is inapposite. In this case, the Federal Circuit affirmed the Board's decision that JOSE GASPAR GOLD for tequila was confusingly similar to GASPAR'S ALE for beer and ale because both goods were alcoholic beverages and the dominant portion of the two marks was

GASPAR, which was an individual's name. Id. at 1946. When the two marks in question contain an individual's name, the courts consistently find confusion because consumers might assume that the source of the marks is the same family. See also E. & J. Gallo Winery v. Gallo Cattle Co., 21 USPQ2d 1824 (9th Cir. 1992) (GALLO for wine confusingly similar to GALLO for cheese because marks are surname and consumers would assume related goods come from same family). Here, the marks contain ALLIED, which is not a surname nor has it been asserted as such by the Examining Attorney. Consequently, In re Chatam Int'l Inc. is of no support for the Examining Attorney's argument that the identical dominant portion of two marks, may support a finding that a likelihood of confusion is present.

In truth, courts have consistently held that when a dominant portion of a mark is weak, "minor alterations may effectively negate any confusing similarity between the two marks." First Savings Bank F.S.B. v. First Bank System Inc., 40 USPQ2d 1865 1873 (10th Cir. 1996); see also Washington Speakers Bureau Inc. v. Leading Authorities Inc., 49 USPQ2d 1893 (E.D. Va 1999); Cooperative Quality Marketing, Inc. v. Dean Milk Co., 136 USPQ 644 (CCPA 1963); Pizzeria Uno Corp. v. Temple, 224 USPQ 185 (4th Cir. 1984) (holding no confusion between PIZZARIA UNO and TACO UNO both for restaurant services because dominant portion UNO was weak). There, as here, there are differences between the two marks. Applicant's mark contains the word ELECTRONICS, while Registrant's mark contains stylized letters and a rectangular box design. These differences are sufficient to distinguish the respective marks.

GOODS ARE UNRELATED

The Examining Attorney cites J & J Snack Foods Corp. v. McDonald's Corp., 18 USPQ2d 1889 (Fed. Cir. 1991) for the proposition that the actual use of the mark is not relevant

to the scope of the identification of goods in the registration. Again the cited case provides no support for the Examining Attorney's proposition. The J & J Snack Foods court first determined that McDonald's owned a family of marks that contained the "Mc" formative for all types of foods: for example, MCRIB, MCNUGGETS, MCDONUT, MCPIZZA, and MCMUFFIN. It then determined that while the family of marks did not contain "pretzels," a consumer seeing MCPRETZEL would naturally assume that such a product would originate from McDonalds. The J & J Snack Foods case is inapposite because the Examining Attorney has not asserted, nor can she, that Registrant's mark is part of a family of marks. Consequently, it is of no support for the Examining Attorney.

To be sure, the goods or services identified in a registration are relevant in that they logically define a registrant's channels of trade. Registrant's goods are "hand- and machine-tools; namely files, drill bits, trowels, screwdrivers, pliers, wrenches, chisels, punches, saws, snips and shears, scrapers, hammers, taps and dies." These clearly are industrial and construction tools, notwithstanding any assertion to the contrary by the Examining Attorney. See Exhibit 2 of Applicant's Brief. They do not, as the Examining Attorney asserts, cover the entire tool channels of trade. The Examining Attorney's entire argument is that these tools can be used in any industry. This is not true. Registrant's tools can only be used in the industrial and construction trade. This is supported by Registrant's own Web site, which states as much. See id. Saws, punches, trowels, scrapers, taps and dies can never be used in the electronics' industry. None of the tools of the parties overlap because they are sold in separate channels of trade: industrial and construction for Registrant and electronics for Applicant. See affidavits of consumers in Exhibit 4 of Applicant's Brief.

Furthermore, there cannot be a likelihood of confusion between the goods since Registrant's goods are sold through retail stores, while Applicant's goods are sold over the Internet. When goods do not travel through the same distribution channels, consumers cannot be confused as to their source. In re The Shoe Works Inc., 6 USPQ2d 1890 (TTAB 1988). The Examining Attorney has not sufficiently addressed this argument, nor can she. The ultimate question with respect to whether consumers may be confused as to the source of goods is directly related to whether those goods will be seen by the same consumers. Field Enterp. Ed. Corp. v. Cove Indus., Inc., 161 USPQ 243 (E.D.N.Y. 1969) (holding similar marks not likely to cause confusion because identical encyclopedia goods sold through different channels of distribution: door-to-door sales versus department store sales). Here, consumers buying Registrant's tools cannot come across Applicant's tools because Applicant's tools are not sold in retail stores. Similarly, consumers purchasing Applicant's goods over the Internet cannot likewise purchase Registrant's goods because Applicant's Web site does not sell Registrant's goods. Consequently, consumers can never be confused by the respective marks because they do not move in the same channels of distribution.

SOPHISTICATED CONSUMERS

The Examining Attorney argues that unsophisticated consumers in search of pliers or wire cutters for work around the house, namely installing a new home entertainment system, likely would be confused if they came across the tools of Registrant's and Applicant's companies. Applicant has already explained that even an unsophisticated consumer cannot come across the tools of the two companies because they are sold in different channels of distribution. Notwithstanding, the Examining Attorney has misstated Applicant's goods as being electrical

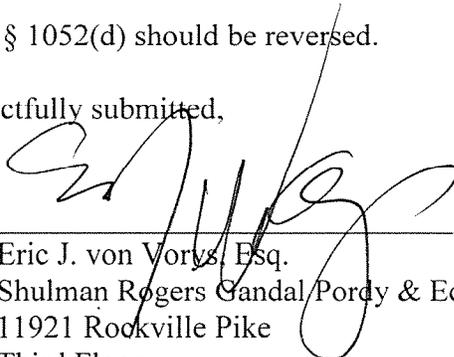
tools. In reality, Applicant's goods are electronics' tools. Applicant's wire strippers cannot be used to install a new home entertainment system because its wire cutters or wire strippers are made to be used in the electronics' industry, not the electrical industrial. Applicant's microelectronic wire cutters are too small and delicate to cut home entertainment system wire and even an unsophisticated consumer could obviously see as much. Accordingly, even an unsophisticated consumer searching for Registrant's industrial and construction tools will not be confused by Applicant's electronics' tools.

CONCLUSION

For all of the foregoing reasons, the Examining Attorney has not sustained her position that there would be a likelihood of confusion between Applicant's and Registrant's marks and the refusal under Trademark Act § 2(d), 15 U.S.C. § 1052(d) should be reversed.

Respectfully submitted,

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