

UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 78/706879

MARK: PEBBLE

CORRESPONDENT ADDRESS:
EDWARD P. KELLY
TIAJOLLOFF & KELLY
405 LEXINGTON AVE
NEW YORK, NY 10174-0002



GENERAL TRADEMARK INFORMATION:
<http://www.uspto.gov/main/trademarks.htm>

TTAB INFORMATION:
<http://www.uspto.gov/web/offices/dcom/ttab/index.html>

APPLICANT: L-3 Communications Corp.

CORRESPONDENT'S
REFERENCE/DOCKET NO:
N/A

CORRESPONDENT E-MAIL ADDRESS:

EXAMINING ATTORNEY'S APPEAL BRIEF

INTRODUCTION

The applicant has appealed the trademark examining attorney's final refusal to register the mark PEBBLE because the applicant's mark so resembles the mark in U.S. Registration No. 3412719, PEBL, as to be likely to cause confusion, to cause mistake, or to deceive under Section 2(d) of the Trademark Act of 1946 (as amended), 15 U.S.C. §1052(d).

FACTS

The applicant has applied for registration on the Principal Register for the mark PEBBLE for the following goods:

"Signal intelligence system comprised of satellites, satellite receivers, radio receivers and computer hardware for remotely detecting and monitoring radio frequency activity" in International Class 009.

The application was filed on September 5, 2005 under Trademark Act Section 1(b). In a March 20, 2006 Office Action, prior pending Application Serial No. 78536511 was cited for potential likelihood of confusion under Trademark Action Section 2(d). At that time, requirements were also made for the

applicant to specify its state of incorporation, address the significance of the wording in the mark and provide a more definite identification of goods. In its first response, the applicant provided a more definite identification of goods but failed to address the other two requirements. The application was suspended in an October 11, 2006 letter pending the disposition of prior pending Application Serial No. 78536511, and the two unresolved requirements were continued. Applicant addressed the two remaining requirements in an April 11, 2007 response, and the application was re-suspended (pending the disposition of prior pending Application Serial No. 78536511) in a May 8, 2007 Suspension Letter. Prior pending Application Serial No. 78536511 later matured to U.S. Registration No. 3412719, and registration was then refused under Trademark Act Section 2(d) in a June 5, 2008 non-final action. Applicant subsequently argued against the refusal but Applicant's arguments were unpersuasive, and the refusal under Trademark Act Section 2(d) was repeated and made final in an October 23, 2008 Final Action. Applicant appealed the final refusal on April 22, 2009 and subsequently filed a request for reconsideration. However, Applicant's arguments were considered but found to be unpersuasive in a May 6, 2009 action denying Applicant's request for reconsideration and continuing the final refusal under Trademark Act Section 2(d). Applicant then filed its Appeal Brief on July 13, 2009. This is the Examining Attorney's Appeal Brief.

ISSUES

The sole issue on appeal is whether the applicant's mark PEBBLE, when used in connection with the following goods: "Signal intelligence system comprised of satellites, satellite receivers, radio receivers and computer hardware for remotely detecting and monitoring radio frequency activity", so resembles the registered mark for PEBL when used in connection with the registrant's International Class 009 goods, which include:

"radio receivers, radio transceivers, radio transmitters, two-way radios, antennas; radio transceivers and receivers for data, voice, image and video communication; computer software for sending and receiving short messages and electronic mail and for filtering non-text information from the data; and computer software and programs used for transmission and reproducing and receiving of sound, images, video and data over a telecommunications network".

Trademark Act §2(d).

ARGUMENT

(1) Applicant's mark, PEBBLE, and the registered mark, PEBL, sound the same and are highly similar in appearance and commercial impression.

Trademark Act Section 2(d) bars registration of an applied-for mark that so resembles a registered mark that it is likely that a potential consumer would be confused or mistaken or deceived as to the source of the goods and/or services of the applicant and registrant. *See* 15 U.S.C. §1052(d). The court in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973) listed the principal factors to be considered when determining whether there is a likelihood of confusion under Section 2(d). *See* TMEP §1207.01. However, not all of the factors are necessarily relevant or of equal weight, and any one factor may be dominant in a given case, depending upon the evidence of record. *In re Majestic Distilling Co.*, 315 F.3d 1311, 1315, 65 USPQ2d 1201, 1204 (Fed. Cir. 2003); *see In re E. I. du Pont*, 476 F.2d at 1361-62, 177 USPQ at 567.

In this case, the following factors are the most relevant: similarity of the marks, similarity of the goods, and similarity of trade channels of the goods and/or services. *See In re Opus One, Inc.*, 60 USPQ2d 1812 (TTAB 2001); *In re Dakin's Miniatures Inc.*, 59 USPQ2d 1593 (TTAB 1999); *In re Azteca Rest. Enters., Inc.*, 50 USPQ2d 1209 (TTAB 1999); TMEP §§1207.01 *et seq.*

In a likelihood of confusion determination, the marks are compared for similarities in their appearance, sound, meaning or connotation and commercial impression. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973); TMEP §1207.01(b). Similarity in any one of these elements may be sufficient to find a likelihood of confusion. *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988); *In re Lamson Oil Co.*, 6 USPQ2d 1041, 1043 (TTAB 1987); *see* TMEP §1207.01(b).

In this case, Applicant's mark is PEBBLE while the registered mark is PEBL.

The marks in question are identical in sound, and are highly similar in appearance and commercial impression. The registered mark PEBL lacks the final *silent* letter "e" which appears in Applicant's mark and only contains one of the double letters "b" appearing in the middle of the mark. However, these slight differences between the marks have little impact on the marks' similarity in

appearance, and have *no* impact on similarity of sound or commercial impression.

Consumers are generally more inclined to focus on the first word, prefix or syllable in any trademark or service mark. *See Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F. 3d 1369, 1372, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005); *see also Mattel Inc. v. Funline Merch. Co.*, 81 USPQ2d 1372, 1374-75 (TTAB 2006); *Presto Prods., Inc. v. Nice-Pak Prods., Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) (“it is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered” when making purchasing decisions). In this case, the first portion or syllable of the parties’ marks (“PEB”) is identical in sound *and* appearance, while the remaining second syllable (be it “-LE” or “-L.”) results in the same sound.

Contrary to Applicant’s arguments, there is no correct pronunciation of a trademark because it is impossible to predict how the public will pronounce a particular mark. *In re Great Lakes Canning, Inc.*, 227 USPQ 483, 484 (TTAB 1985); TMEP §1207.01(b)(iv); *see In re Energy Telecomm. & Elec. Assoc.*, 222 USPQ 350, 351 (TTAB 1983). The marks in question could clearly be pronounced the same; such similarity in sound alone may be sufficient to support a finding of likelihood of confusion. *See RE/MAX of Am., Inc. v. Realty Mart, Inc.*, 207 USPQ 960, 964 (TTAB 1980); *Molenaar, Inc. v. Happy Toys Inc.*, 188 USPQ 469, 471 (TTAB 1975); TMEP §1207.01(b)(iv). Additionally, the pronunciation of the registered mark is advertised as “pebble” (*See* supplied web page printouts at 10/22/2008 TICRS Outgoing, pgs. 7, 11 and 14.)

The question is not whether people will confuse the marks, but whether the marks will confuse people into believing that the goods and/or services they identify come from the same source. *In re West Point-Pepperell, Inc.*, 468 F.2d 200, 201, 175 USPQ 558, 558-59 (C.C.P.A. 1972); TMEP §1207.01(b). For that reason, the test of likelihood of confusion is not whether the marks can be distinguished when subjected to a side-by-side comparison. The question is whether the marks create the same overall impression. *See Recot, Inc. v. M.C. Becton*, 214 F.2d 1322, 1329-30, 54 USPQ2d 1894, 1899 (Fed. Cir. 2000); *Visual Info. Inst., Inc. v. Vicon Indus. Inc.*, 209 USPQ 179, 189 (TTAB 1980). The focus is on the recollection of the average purchaser who normally retains a general rather than specific impression of trademarks. *Chemetron Corp. v. Morris Coupling & Clamp Co.*, 203 USPQ 537, 540-41 (TTAB 1979); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975); TMEP §1207.01(b).

Contrary to Applicant's arguments, the parties' marks are phonetic equivalents and are highly similar in appearance and commercial impression.

(2) The parties' goods are related such that consumers would believe they originate from the same source.

As noted previously, the applicant's goods are identified as:

"Signal intelligence system comprised of satellites, satellite receivers, radio receivers and computer hardware for remotely detecting and monitoring radio frequency activity" in International Class 009.

The cited registration specifies a variety of communications equipment in International Class 009, including:

"radio receivers, radio transceivers, radio transmitters, two-way radios, antennas; radio transceivers and receivers for data, voice, image and video communication; computer software for sending and receiving short messages and electronic mail and for filtering non-text information from the data; and computer software and programs used for transmission and reproducing and receiving of sound, images, video and data over a telecommunications network".

In a Section 2(d) analysis, the goods and/or services of the parties need not be identical or directly competitive to find a likelihood of confusion. *See Safety-Kleen Corp. v. Dresser Indus., Inc.*, 518 F.2d 1399, 1404, 186 USPQ 476, 480 (C.C.P.A. 1975); TMEP §1207.01(a)(i). Rather, they need only be related in some manner, or the conditions surrounding their marketing are such that they would be encountered by the same purchasers under circumstances that would give rise to the mistaken belief that the goods and/or services come from a common source. *In re Total Quality Group, Inc.*, 51 USPQ2d 1474, 1476 (TTAB 1999); TMEP §1207.01(a)(i); *see, e.g., On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 1086-87, 56 USPQ2d 1471, 1475-76 (Fed. Cir. 2000); *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 1566-68, 223 USPQ 1289, 1290 (Fed. Cir. 1984).

Moreover, the fact that the goods or services of the parties differ is not controlling in determining likelihood of confusion. The issue is *not* likelihood of confusion between particular goods or services, but likelihood of confusion as to the *source* of those goods or services. *In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993); *Safety-Kleen Corp. v. Dresser Indus., Inc.*, 518 F.2d 1399, 1404, 186 USPQ 476, 480 (C.C.P.A. 1975); TMEP §1207.01.

In this case, the record contains numerous third party registrations in which communications equipment such as that specified by the registrant is offered under the same mark and in the same channels of trade as intelligence or surveillance equipment, such as that identified by the applicant. (See U.S. Registration Nos. 1279663, 2548992, 2549315, 2788387, 2837711, 3219885, 3244442 and 3401570, at 06/05/2008 and 10/23/2008 TICRS Outgoing). These printouts have probative value to the extent that they serve to suggest that the goods listed therein are of a kind that may emanate from a single source. *In re Infinity Broad. Corp.*, 60 USPQ2d 1214, 1217-18 (TTAB 2001); *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993); *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988); TMEP §1207.01(d)(iii).

Any goods or services in the registrant's normal fields of expansion should be considered when determining whether the registrant's goods and/or services are related to the applicant's goods and/or services. TMEP §1207.01(a)(v); see *In re 1st USA Realty Prof'ls, Inc.*, 84 USPQ2d 1581, 1584 (TTAB 2007). Evidence that third parties offer the goods and/or services of both the registrant and applicant (such as that noted above) suggest that it is likely that the registrant would expand its business to include applicant's goods and/or services. In that event, customers are likely to believe the goods and/or services at issue come from or, are in some way connected with, the same source. *In re 1st USA Realty Prof'ls*, 84 USPQ2d at 1584 n.4; see TMEP §1207.01(a)(v).

Most significantly, however, the applicant itself offers communications equipment and intelligence gathering equipment under the same mark and in the same channels of trade. (See Applicant's U.S. Registration No. 2531073 for "L3 COMMUNICATIONS" at 06/05/2008 TICRS Outgoing, pgs. 11-13, and web page printouts from Applicant's web site at 06/05/2008 TICRS Outgoing, pgs. 5 and 35-39).

Since the instant applicant offers such goods under the same mark and in the same channels of trade, the applicant's arguments against similarity of the respective goods ring hollow, especially in light of other evidence contained in the record.

In considering the applicant's identified "signals intelligence system", "signals intelligence" can be defined as:

A category of intelligence comprising either individually or in combination all *communications* intelligence, electronic intelligence, and foreign instrumentation signals intelligence, *however transmitted*. [Emphasis added.]

(See supplied entry from www.dtic.mil at 05/06/2009 TICRS Outgoing, pg. 2.) Contrary to Applicant's arguments, its "signal intelligence system", like any such communications intelligence gathering system, is comprised of communications equipment such as that specified in the cited registration (*e.g.*, antennas and radio receivers) in order to receive the "radio frequency" signal(s) meant to be "remotely detect[ed] and monitor[ed]". (See also supplied third party U.S. Registration Nos. 2193293, 2223650, 2248611, 3018652, 3099310 and 3350638, which list components of such intelligence gathering equipment, at 06/05/2008 and 10/23/2008 TICRS Outgoing.) The only real difference for such a "system" occurs by way of additional hardware and/or software that allows the user to decode or decrypt the signal being received via the antenna(s) and receiver(s).

Although the cited registration contains no limits as to channels of trade, the applicant's arguments also incorrectly assume that users of registrant's goods are limited to those outside of the government or military. A determination of whether there is a likelihood of confusion is made solely on the basis of the goods and/or services identified in the application and registration, without limitations or restrictions that are not reflected therein. *In re Dakin's Miniatures, Inc.*, 59 USPQ2d 1593, 1595 (TTAB 1999); TMEP §1207.01(a)(iii). If the cited registration describes the goods and/or services broadly and there are no limitations as to their nature, type, channels of trade or classes of purchasers, then it is presumed that the registration encompasses all goods and/or services of the type described, that they move in all normal channels of trade, and that they are available to all potential customers. *In re Linkvest S.A.*, 24 USPQ2d 1716, 1716 (TTAB 1992); *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981); TMEP §1207.01(a)(iii).

Moreover, Applicant's arguments wrongly presuppose that military and/or government users of intelligence gathering systems will not also need or use communications equipment in support of such systems. Since Applicant states that its goods are used to "add to the situational awareness of the battlefield", gathered intelligence would be disseminated via communications equipment for it to be of value to the relevant military and/or government users.

As to Applicant's argument that purchasers of its goods are sophisticated buyers, the fact that purchasers are sophisticated or knowledgeable in a particular field does not necessarily mean that they are sophisticated or knowledgeable in the field of trademarks or immune from source confusion. TMEP

§1207.01(d)(vii); see *In re Decombe*, 9 USPQ2d 1812 (TTAB 1988); *In re Pellerin Milnor Corp.*, 221 USPQ 558 (TTAB 1983).

Lastly, the overriding concern is not only to prevent buyer confusion as to the source of the goods and/or services, but to protect the registrant from adverse commercial impact due to use of a similar mark by a newcomer. See *In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993). Therefore, any doubt regarding a likelihood of confusion determination is resolved in favor of the registrant. TMEP §1207.01(d)(i); see *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1265, 62 USPQ2d 1001, 1003 (Fed. Cir. 2002); *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 464-65, 6 USPQ2d 1025, 1025 (Fed. Cir. 1988).

CONCLUSION

The applicant's mark, PEBBLE, is highly similar in sound, appearance and commercial impression to the registered mark PEBL, and the parties' specified goods are closely related. For the foregoing, reasons, the examining attorney respectfully requests that the refusal to register the intended mark under Trademark Act Section 2(d), 15 U.S.C. §1052(d) be affirmed.

Respectfully submitted,

September 11, 2009

/Nelson B. Snyder III/
Trademark Examining Attorney
Law Office 107
(571) 272-9284
(571) 273-9107 (fax)

J. Leslie Bishop
Managing Attorney
Law Office 107