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Applicant: L-3 Communications Corporation  
(a Delaware Corporation)

**TTAB**

Serial No.: 78/706877

Mark: PEBBLE

Filed: September 5, 2005

BEFORE THE  
TRADEMARK TRIAL AND  
APPEAL BOARD

APPEAL BRIEF OF APPLICANT

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## I. INTRODUCTION

Applicant L-3 Communications Corporation (a Delaware Corporation), (hereinafter “Applicant”) appeals from the final decision of the Examiner on Applicant’s request for reconsideration issued May 6, 2009.

Applicant has applied for registration of its trademark PEBBLE for **“signal intelligence system comprised of satellites, radio receivers and computer hardware for remotely detecting and monitoring radio frequency activity.”**

The Examining Attorney refused registration under Trademark Act § 2(d), 15 U.S.C. § 1052(d), on grounds of likelihood of confusion between Applicant’s mark and U.S. Registration No. 3,123,788 to Motorola (hereinafter “Registrant”) of PEBL, for use on

“TELEPHONES, CELLULAR TELEPHONES, RADIO TELEPHONES, PAGERS, TWO-WAY RADIOS, RADIO TRANSMITTERS, RADIO RECEIVERS, RADIO TRANSCEIVERS, ELECTRONIC PERSONAL ORGANIZERS, AND RELATED ACCESSORIES FOR THE FOREGOING GOODS, NAMELY, HEADSETS, MICROPHONES, SPEAKERS, CARRYING CASES, AND BELT CLIPS; COMPUTER SOFTWARE AND PROGRAMS USED FOR TRANSMISSION AND REPRODUCING AND RECEIVING OF SOUND, IMAGES, VIDEO AND DATA OVER A TELECOMMUNICATIONS NETWORK AND SYSTEM BETWEEN TERMINALS AND FOR ENHANCING AND FACILITATING USE AND ACCESS TO COMPUTER NETWORKS AND TELEPHONE NETWORKS; COMPUTER SOFTWARE FOR USE IN GENERAL PURPOSE DATABASE MANAGEMENT; COMPUTER E-COMMERCE SOFTWARE TO ALLOW USER TO SAFELY PLACE ORDERS AND MAKE PAYMENTS IN THE FIELD OF ELECTRONIC BUSINESS TRANSACTIONS VIA A GLOBAL COMPUTER NETWORK OR TELECOMMUNICATIONS NETWORK; COMPUTER SOFTWARE FOR TRAINING AND PRODUCT SUPPORT FOR COMPUTERS AND MOBILE PHONES IN THE FIELD OF COMMUNICATIONS; COMPUTER GAME SOFTWARE FOR MOBILE HANDSETS; COMPUTER SOFTWARE AND PROGRAMS FEATURING MUSIC, MOVIES, ANIMATION, ELECTRONIC BOOKS; COMPUTER SOFTWARE FOR THE DISTRIBUTION OF INFORMATION AND INTERACTIVE MULTIMEDIA CONTENT CONTAINING TEXT, IMAGES, VIDEO AND SOUND TO USERS IN THE FIELD OF COMMUNICATIONS; COMPUTER SOFTWARE AND PROGRAMS FOR MANAGEMENT AND OPERATION OF WIRELESS TELECOMMUNICATIONS DEVICES; COMPUTER SOFTWARE FOR ACCESSING, SEARCHING, INDEXING AND RETRIEVING INFORMATION AND DATA FROM GLOBAL COMPUTER NETWORKS AND GLOBAL COMMUNICATION NETWORKS, AND FOR BROWSING AND NAVIGATING THROUGH WEB SITES ON SAID NETWORKS; COMPUTER SOFTWARE FOR SENDING AND RECEIVING SHORT MESSAGES AND ELECTRONIC MAIL AND FOR FILTERING NON-TEXT INFORMATION FROM THE DATA; ANALOG AND DIGITAL RADIO TRANSCEIVERS AND RECEIVERS FOR DATA, VOICE, IMAGE AND VIDEO COMMUNICATION; ELECTRONIC GAME SOFTWARE FOR MOBILE HANDSETS. CAMERAS, NAMELY,

PHOTOGRAPHIC CAMERAS, DIGITAL CAMERAS, MOTION PICTURE CAMERAS, VIDEO CAMERAS; SYSTEMS AND APPARATUS FOR ELECTRIC MONEY TRANSACTIONS, NAMELY, SMART CARDS, SMART CARD READERS; CALCULATORS; CARDS FOR COMMUNICATIONS PURPOSES, NAMELY, MEMORY CARDS, MODEM CARDS AND FAX MODEM CARDS FOR COMMUNICATION PURPOSES, ALL FOR USE WITH COMMUNICATIONS APPARATUS; MODEMS, GLOBAL POSITIONING UNITS, BATTERIES, BATTERY CHARGERS, POWER ADAPTERS, AND ANTENNAS”.

The Examining Attorney’s refusal to allow registration of Applicant’s mark is erroneous as a matter of law. In the present case, as more fully discussed below, Applicant’s mark and Registrant’s mark, considered in their entirety, create substantially different commercial impressions and are therefore not likely to be confused. Additionally, Applicant’s goods, namely, a signal intelligence system, are quite distinct from the goods of the cited reference. Although, some of the individual components of the cited reference may be generally contained in Applicant’s goods, Applicant’s goods function in a completely separate manner.

## **II. FACTS AND PROCEDURAL HISTORY**

On June 5, 2008, the Examiner issued an office action refusing registration under Trademark Act Section 2(d), 15 U.S.C. §1052(d), on grounds of likelihood of confusion between Applicant’s mark and Registrant’s mark. Specifically, the Examiner found that Applicant’s mark and Registrant’s mark are similar in appearance, sound, connotation and commercial impression, stating that:

Further, the Examiner compared the goods of the respective marks to determine if they are related or if the activities surrounding their marketing are such that confusion as to origin is likely. On this point, the Examiner found that Applicant’s and Registrant’s goods were sufficiently related to issue a rejection.

Applicant filed a response on September 2, 2008, arguing that their mark is entitled to registration because it creates a different commercial impression from Registrant's mark and the goods are not similar or related.

On April 27, 2009, the Examining Attorney issued a final office action refusing registration solely on the basis of likelihood of confusion between Applicant's and Registrant's marks. On April 27, 2009, Applicant made a request for reconsideration and the Examiner rejected that request.

Applicant timely appealed.

### III. ARGUMENT

A. **The Examiner Erred in Finding a Likelihood of Confusion Because Applicant's Mark and Registrant's Mark so Differ in Appearance, Sound, and Meaning so as to Create Separate Commercial Impressions.**

Section 2(d) of the Trademark Act provides, in pertinent part, that a mark is unregistrable when the mark:

“...so resembles a mark registered in the Patent and Trademark Office...when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive.” 15 U.S.C. § 1052(d).

The Examining Attorney's first step in the likelihood of confusion analysis must be to look at the marks themselves for similarities in appearance, sound, meaning, connotation and commercial impression. *See* TMEP Section 1207.01 *et. seq.*, *citing In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973).

A likelihood of confusion analysis must entail consideration of the distinguishing features of Registrant's mark as compared to an Applicant's mark. In analyzing these differences,

the Federal Circuit has plainly stated that all aspects of a trademark must be considered when determining likelihood of confusion, and that conflicting marks must be compared in their *entireties* to determine likelihood of confusion. *In re Electrolyte Laboratories, Inc.*, 929 F.2d 645, 647 (Fed.Cir. 1990); *Columbian Steel Tank Co. v. Union Tank & Supply Co.*, 125 U.S.P.Q. 406 (C.C.P.A 1960). The Board of Appeals, in *In re Lamson Oil Co.*, 6 U.S.P.Q.2d 1041, 1042 n.4 (T.T.A.B. 1987) stated:

It should be noted that similarity of the marks in one respect – sight, sound, or meaning – will not automatically result in a finding of likelihood of confusion even if the goods are identical or closely related. Rather, the rule is that taking into account all of the relevant facts of a particular case, similarity as to one factor (sight, sound or meaning) alone “may be sufficient to support a holding that the marks are confusingly similar.”

(citing *Trak Inc. v. Traq Inc.*, 212 U.S.P.Q. 846, 850 (T.T.A.B. 1981), emphasis in original); *see also Lebow Bros., Inc. v. Lebole Euroconf S.P.A.*, 503 F.Supp 209, 211 (E.D.Pa. 1980).

Therefore, similarity in one respect alone is often not sufficient to find a likelihood of confusion.

Here, Applicant’s mark of PEBBLE and Registrant’s mark of PEBL create substantially different commercial impressions and therefore are not likely to be confused.

**B. “PEBBLE” and “PEBL” Are Not Identical and Differ in Both Sound and Appearance and Differ in Meaning**

Under *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973), the first factor in a likelihood of confusion analysis requires examination of “the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.” The test of likelihood of confusion is not whether the marks can be distinguished when subjected to a side-by-side comparison, but whether the marks are sufficiently similar that there is a likelihood of confusion as to the source of the goods or

goods. When considering the similarity of the marks, "[a]ll relevant facts pertaining to the appearance and connotation must be considered." *Recot, Inc. v. M.C. Becton*, 214 F.3d 1322, 1329, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000). The emphasis must be on the recollection of the average purchaser who normally retains a general, rather than specific, impression of trademarks. *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975).

Applicant respectfully disagrees with the Examiner's determination that applicant's mark, "PEBBLE" and Registrant's mark, "PEBL" are "virtually identical in sight, sound, meaning and commercial impression." The "PEBBLE" mark clearly differs from "PEBL" both in appearance and in meaning.

Registrant's mark of "PEBL" does not seem to have a clearly defined meaning, since it is not an English word and is not necessarily evocative of the word "PEBBLE." Nor is "PEBL" a commonly used abbreviation or known novelty spelling of the term "PEBBLE." "PEBL," may, in fact, be an acronym. On the other hand, the word "PEBBLE" is clearly defined as a small stone.

Further, Registrant's mark of "PEBL" does not look like Applicant's mark of "PEBBLE." "PEBL" has fewer characters than "PEBBLE," and further does not contain distinctive side-by-side letter B's, or end with a vowel. In addition, the fact that customers would be familiar with the term "PEBBLE," makes them more likely to distinguish this mark from "PEBL."

As described above, Applicant's mark and Registrant's mark so differ in appearance and meaning so as to create different commercial impressions upon buyers.

**C. Applicant's Amended Goods Are Not Similar or Related to the Goods Covered By Registrant's mark.**

Registrant's Mark and Applicant's goods are not similar or related and the goods of Registrant's goods, which the Examiner has defined as "various receivers and antennas." Applicant's mark clearly identifies the goods as a "signal intelligence system... for remotely detecting and monitoring radio frequency activity," and also identifies the system's various components (satellite receivers, radio receivers and computer hardware).

Applicant's goods are a system for intercepting radio signals to determine the source of those transmissions. For instance the system has a military use namely the interception of radio signals to pinpoint an enemy location or to add to the situational awareness of the battlefield. The goods of the cited reference do not perform this function. Applicant's identification of goods makes clear that it is not claiming receivers or antennas, but a composite system that includes receiver components. As such, Applicant's amended goods are sufficiently dissimilar from the cited mark's goods so as to create a separate commercial impression upon buyers.

#### **IV. Purchasers of Applicant's Amended Goods Are Careful and Sophisticated.**

Among the considerations in a likelihood of confusion determination are the conditions under which and buyers to whom sales are made, *i.e.*, whether the buyers engage in "impulse" or careful, sophisticated purchasing. See TMEP 1207.01.

In the present case, likelihood of confusion between Applicant's goods and Registrant's goods is unlikely because purchasers of Applicant's goods are sophisticated buyers. Applicant is a large corporation dealing within the defense industry, and Applicant's customers are seeking highly specialized defense products, to be used for instance in military applications. Due to the nature of Applicant's products, numerous detailed negotiations are often necessary to consummate sales, and confusion between Applicant's products and those of a business organization outside of the defense industry is improbable.

## CONCLUSION

The Examining Attorney has rejected Applicant's mark on the basis of likelihood of confusion with Registrant's mark. This finding is erroneous, in that PEBBLE and PEBL differ in sound, appearance and meaning, and therefore create different commercial impressions.

For the foregoing reasons, the refusal to register should be reversed.

By: \_\_\_\_\_

  
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