

SERVICEMARK

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: )  
 )  
ETFCU Service Organization, LLC )  
 ) Mark: ET REALTY  
Serial No.: 78/715,882 )  
 )  
Examining Attorney: Carolyn V.C. Gray )  
 )  
Law Office: 111 )

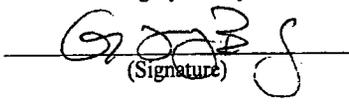
REQUEST FOR RECONSIDERATION

Commissioner for Trademarks  
P.O. Box 1451  
Alexandria, VA 22313-1451

Sir:

In response to the Final Office Action dated November 29, 2006, please consider the following.

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Commissioner for Trademarks, P.O. Box 1451, Alexandria, Virginia 22313-1451 on the date shown below:

Gregory B. Coy  
  
(Signature)

Date of Signature: May 22, 2007



## REMARKS

This Request for Reconsideration is offered in support of federal registration of the mark ET REALTY on the Principal Register. A Notice of Appeal is also being submitted in this case.

In the Final Office Action dated November 29, 2006, the Examining Attorney maintained a refusal to register the subject mark, ET REALTY, under Trademark Act Section 2(d), 15 U.S.C. §1052(d) upon an assertion that there is a likelihood of confusion between the Applicant's proposed mark and the mark depicted in U.S. Trademark Registration No. 1,255,538 (hereinafter "the '538 mark") when the respective marks are used in connection with the respectively recited services. The '538 mark is presented below for convenient review.



For the reasons provided below, Applicant submits that there is no likelihood of confusion between the respective marks when used in connection with the identified services, and respectfully requests that the present application be passed to publication in the *Official Gazette for Trademarks*.

In the outstanding Final Action, the Examining Attorney continues to treat the '538 mark as being merely the letters "ET" and to characterize the distinction between the '538 mark and Applicant's proposed mark as "the mere addition of a term to a registered mark." Applicant traverses both of these characterizations, and submits that basing the analysis under Section 2(d)

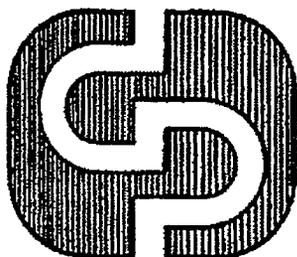
on these characterizations is improper. For the reasons reiterated below, Applicant submits that (1) the correct characterization of the '538 mark is as a design mark, and (2) the distinctions between the '538 mark and Applicant's proposed mark are sufficiently great as to eliminate any likelihood of confusion between the respective marks.

Even a mark that is formed from letters of the alphabet is to be treated as a design mark if the stylization is so significant as to mask the appearance of the letters from which it is formed. The '538 mark is a classic example of such a mark that would be perceived as a design mark and would not be perceived by the consuming public as the letters "ET." Indeed, Applicant submits that the only distinctive, potentially source-identifying feature of the '538 mark is its utilization of specific design features. The stylization and integration of the components of the mark is so high that a consumer encountering the '538 mark in the normal course of trade would more likely consider the '538 mark to be solely a design mark than a combination of letters. Therefore, the '538 mark is more properly treated as being akin to a pure design mark rather than simply a stylized display of a word mark.

The '538 mark cited in the present case is analogous to the mark in issue in *Georgia-Pacific Corporation v. General Paper Corporation of Pittsburgh* 196 USPQ 762 (TTAB 1977) (hereafter, "the *Georgia-Pacific* TTAB case"), which was formed from the letters "GP," but which included such significant stylization to make the mark more akin to a design logo. The *Georgia-Pacific* TTAB case is also analogous to the present case in that it involved a later-filed application to register a mark (hereinafter "Petitioner's Mark") that clearly included a literal component. The prior registration in the *Georgia-Pacific* TTAB case was for a mark (hereinafter "Registrant's Mark") that was deemed to include no clear literal element, even though it was

formed from the letters "GP." Specifically, the *Georgia-Pacific* TTAB case involved the two marks presented below:

Registrant's Mark:



Petitioner's Mark:



Applicant submits that the TTAB's analysis in the *Georgia-Pacific* TTAB case should be applied to the present case. In the *Georgia-Pacific* TTAB case, the TTAB supported its conclusion that there is no likelihood of confusion between these marks as follows:

Petitioner's mark is clearly and recognizably the letters "GP." Registrant's mark, while undoubtedly incorporating the letters "GP," falls far short of being considered a literal mark. That is, the letters "GP" have been so artistically arranged or incorporated in the overall logo that, at first impact, the mark projects the image of a distinctive design mark without any attempt by the viewer to penetrate the intricacies of the design to uncover the letters "GP" which would take on this significance only by reference to respondent's trade name. Under these circumstances and even taking into consideration the fallibility of consumers in their recollection of trademarks ... , it is not believed that a purchaser would equate the two marks or even form an association therewith. 196 USPQ 762, 772 (TTAB 1977) (citations omitted).

Considering the present case, with the above in mind, Applicant submits that the '538 mark also is so highly stylized that, at first sight, "the mark projects the image of a distinctive design mark," and that there is no suggestion of the letters "ET" therein.

Because the '538 mark projects the image of a distinctive design mark, and would be viewed as such by the consuming public, it would not be vocalized. Further guidance regarding

the treatment of a mark of this type is found in the decision of the Court of Customs and Patent Appeals in *Georgia-Pacific Corp. v. Great Plains Bag Co.*, 204 USPQ 697 (CCPA 1980), (hereafter, “the “*Georgia-Pacific* CCPA case”) which addresses the mark of Registration No. 911,935 (hereinafter “the ‘935 mark”), reproduced below:



In that decision, the CCPA stated that, “[Registrant’s] mark consists of highly stylized letters and is therefore in the gray region between pure design marks which cannot be vocalized and word marks which are clearly intended to be.” *Id. at 699*. The Court in that case stated that, “we hold the likelihood of confusion between [the ‘935 mark and the mark “G-P”] as applied to their respective goods unlikely.” Applicant submits that in the present case, the ‘583 mark is even further along the spectrum toward purely design marks than the ‘935 mark in suit in the *Georgia-Pacific* CCPA case because the ‘583 mark bears even less resemblance to letters than does the above-depicted ‘935 mark.

Furthermore, as stated by the Court of Appeals for the Federal Circuit in *In re Electrolyte Laboratories Inc.*, discussing the *Georgia-Pacific* CCPA case, “In *Georgia-Pacific* the court observed that even if the letter portion of a design mark could be vocalized, that was not dispositive of whether there would be likelihood of confusion. A design is viewed, not spoken, and a stylized letter design can not be treated simply as a word mark.” *In re Electrolyte Laboratories Inc.*, 16 USPQ2d 1239, 1240 (Fed. Cir. 1990) (citations omitted).

Even marks that are clearly formed of letters have been found by the Trademark Trial and Appeal Board (“TTAB”) to be “more properly treated, in our view, as being akin to pure design

marks rather than simply stylized displays of word marks.” Specifically, in *In re TSI Brands Inc.*, 67 USPQ2d 1657 (TTAB 2002), the following two registered (and co-owned) “AK” and design marks (referred to below as “registrant’s marks”) were considered by the TTAB in connection with the registerability of a later-filed mark that included the letters AK, together with the words “American Khakis”:



Upon consideration of these marks, the TTAB stated in *In re TSI Brands* that, “the degree of stylization and integration of the letters forming both of registrant’s ‘AK’ and design marks is so high that they are more properly treated, in our view, as being akin to pure design marks rather than simply stylized displays of word marks.” *Id.* at 1663. The TTAB concluded that, “even when allowance is made for the fallibility of consumers’ memory of marks, applicant’s and registrant’s marks in their entireties are not so similar in sound, appearance, connotation or commercial impression that, merely because such marks share the letters ‘AK,’ confusion as to origin or association is likely.” *Id.* Based on this analysis, the TTAB reversed the Examining Attorney’s refusal to register the AK AMERICAN KHAKIS (stylized) mark. In coming to this conclusion, the TTAB relied heavily upon the decision in the *Georgia-Pacific* TTAB case discussed above.

Applicant submits that the differences between Applicant’s mark and the ‘538 mark in the present case are much more significant than are the differences between the marks in suit in *In re TSI Brands* because the “AK” and design marks in the *In re TSI Brands* case clearly included the

letters "AK," whereas the '538 mark cited in the present case does not clearly include any two letters, and certainly not the letters "ET." Indeed, a consumer encountering the '538 mark would be at least as likely, if not more likely, to consider the mark to be the letter "a" or a modified form of the word "at" or to resemble a combination of the letters "ct" than to represent the letters "ET." For the same reasons that the TTAB found no likelihood of confusion in the *In re TSI Brands* case, Applicant submits that it would be improper to conclude that there is a likelihood of confusion between Applicant's mark depicted in the present application and the '538 mark, which are even more distinct from one another than are the marks in suit in *In re TSI Brands*.

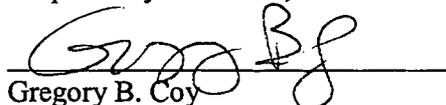
Applicant submits that, as in the *Georgia-Pacific* TTAB case and as in *In re TSI Brands*, the Examining Attorney erred in her dominant focus on the letters "ET" in the respective marks to the substantial exclusion of the other, significantly different elements therein. Moreover, while Applicant acknowledges that certain elements of a composite mark can have more source-identifying power than other elements of the mark, the term "REALTY" in Applicant's mark is not subordinate matter and, even if this term is considered to be descriptive of the recited services, it would be recalled and spoken when consumers look for and/or ask about Applicant's services. Thus, the term "REALTY" forms a significant element of Applicant's mark, in terms of sound, appearance, meaning and overall commercial impression, and cannot be ignored.

In summary, Applicant's ET REALTY mark is not so similar to the '538 mark that the contemporaneous use of the respective marks in connection with the respective services would be likely to cause confusion. Because the '538 mark is a design mark that includes significant elements absent from Applicant's mark, and because distinctive, source-identifying features of Applicant's mark are absent from the '538 mark, and following the guidance of the above

decisions of the U.S. Court of Customs and Patent Appeals, the U.S. Court of Appeals for the Federal Circuit, and the Trademark Trial and Appeal Board, Applicant submits that the respect marks have significantly different appearances and make significantly different commercial impressions. The whole line of reasoning presented in the outstanding Office Action in support of the asserted refusal under Section 2(d) is premised upon a characterization of the '538 mark as merely being the letters "ET" and the suggestion that Applicant's mark is a "mere addition of a term to a registered mark." These generalizations are inappropriate in that they fail to take into proper account the fact that the '538 mark is primarily a design mark.

For all of the reasons stated above, the Applicant submits that the present application is in condition for passage to publication in the *Official Gazette for Trademarks*, and requests a prompt Notice of Publication. If there are any remaining issues that can be addressed by telephone, the Examining Attorney is invited to contact the undersigned at the number set forth below.

Respectfully submitted,



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