

From: Tooley, David

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Subject: U.S. TRADEMARK APPLICATION NO. 79115255 - SEASTAR - 218537-33515 - Request for Reconsideration Denied - Return to TTAB - Message 1 of 4

Attachment Information:

Count: 4

Files: garminn-1.jpg, garminn-2.jpg, garminn-3.jpg, 79115255.doc

**UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)
OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION**

U.S. APPLICATION SERIAL NO. 79115255

MARK: SEASTAR



CORRESPONDENT ADDRESS:

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BLOOMFIELD HILLS, MI 48304-5151

GENERAL TRADEMARK INFORMATION:

<http://www.uspto.gov/trademarks/index.jsp>

APPLICANT: Fugro N.V.

CORRESPONDENT'S REFERENCE/DOCKET NO:

218537-33515

CORRESPONDENT E-MAIL ADDRESS:

tmdocketing@honigman.com

REQUEST FOR RECONSIDERATION DENIED

ISSUE/MAILING DATE: 12/13/2013

INTERNATIONAL REGISTRATION NO. 1122349

Applicant's amended identification of goods is acceptable and made part of the record.

The trademark examining attorney has carefully reviewed applicant's request for reconsideration and is denying the request for the reasons stated below. See 37 C.F.R. §2.64(b); TMEP §§715.03(a)(2)(B), (a)(2)(E), 715.04(a). The requirement made final in the Office action dated May 5, 2013 is maintained and continue to be final. See TMEP §§715.03(a)(2)(B), (a)(2)(E), 715.04(a).

In the present case, applicant's request has not resolved all the outstanding issues, nor does it raise a new issue or provide any new or compelling evidence with regard to the outstanding issues in the final Office action. In addition, applicant's analysis and arguments are not persuasive nor do they shed new light on the issues. Accordingly, the request is denied.

In particular, applicant argues that registrant is currently only selling consumer GPS systems. However, a trademark registration on the Principal Register is prima facie evidence of the validity of the registration and the registrant's exclusive right to use the mark in commerce in connection with the specified goods. See 15 U.S.C. §1057(b); TMEP §1207.01(d)(iv). Thus, evidence and arguments that constitute a collateral attack on a cited registration, such as information or statements regarding a registrant's nonuse of its mark, are not relevant during ex parte prosecution. See *In re Dixie Rests.*, 105 F.3d 1405, 1408, 41 USPQ2d 1531, 1534-35 (Fed. Cir. 1997); *In re Peebles Inc.*, 23 USPQ2d 1795, 1797 n.5 (TTAB 1992); TMEP §1207.01(d)(iv). Such evidence and arguments may, however, be pertinent to a formal proceeding before the Trademark Trial and Appeal Board to cancel the cited registration.

In this case, registrant's goods are written so broadly that they include all GPS devices. Applicant's attempt to limit both its goods and the registered goods beyond the plain meaning of their respective identifications is not appropriate. The presumption under Trademark Act Section 7(b), 15 U.S.C. §1057(b), is that the registrant is the owner of its mark and that its use of its mark extends to all goods identified in the registration. The presumption also implies that the registrant operates in all normal channels of trade and reaches all classes of purchasers of the identified goods. *In re Melville Corp.*, 18 USPQ2d 1386, 1389 (TTAB 1991); *McDonald's Corp. v. McKinley*, 13 USPQ2d 1895, 1899 (TTAB 1989); *RE/MAX of Am., Inc. v. Realty Mart, Inc.*, 207 USPQ 960, 964-65 (TTAB 1980); see TMEP §1207.01(a)(iii).

For the sake of argument, however, the same providers of typical consumer GPS devices also provide nautical GPS equipment. See attached evidence from Garmin, Lowrance, and Magellan. Although applicant argues it only provides very specialized GPS equipment for narrow professional use, these details are not reflected in its identification of goods, which describes all nautical GPS devices.

Furthermore, as indicated above, even if applicant were to limit its goods further, the registered goods would include any conceivable limitation.

Applicant also argues that the examining attorney did not take into account the sophistication of the consumer. However, as explained above, the registered goods encompass the applicant's goods; in cases where the goods could be identical, no level of sophistication could help a consumer distinguish them.

Applicant then argues that the examining attorney "violated a basic trademark examination principle" by improperly dissecting the mark. Marks must be compared in their entireties and should not be dissected; however, a trademark examining attorney may weigh the individual components of a mark to determine its overall commercial impression. *In re Chatam Int'l Inc.*, 380 F.3d 1340, 1342, 71 USPQ2d 1944, 1946-47 (Fed. Cir. 2004); *In re Nat'l Data Corp.*, 753 F.2d 1056, 1058, 224 USPQ 749, 751 (Fed. Cir. 1985) ("[I]n articulating reasons for reaching a conclusion on the issue of confusion, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark"); *In re Kysela Pere et Fils, Ltd.*, 98 USPQ2d 1261, 1267 (TTAB 2011). Furthermore, the marks are essentially phonetic equivalents and thus sound similar. Similarity in sound alone may be sufficient to support a finding that the marks are confusingly similar. *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988); see *In re 1st USA Realty Prof'ls, Inc.*, 84 USPQ2d 1581, 1586 (TTAB 2007); TMEP §1207.01(b)(iv).

Finally, applicant argues that no actual confusion exists. The test under Trademark Act Section 2(d) is whether there is a likelihood of confusion. It is not necessary to show actual confusion to establish a likelihood of confusion. *Herbko Int'l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1165, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002) (citing *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 1571, 218 USPQ 390, 396 (Fed. Cir. 1983)); TMEP §1207.01(d)(ii). The Trademark Trial and Appeal Board stated as follows:

[A]pplicant's assertion that it is unaware of any actual confusion occurring as a result of the contemporaneous use of the marks of applicant and registrant is of little probative value in an ex parte proceeding such as this where we have no evidence pertaining to the nature and extent of the use by applicant and registrant (and thus cannot ascertain whether there has been ample opportunity for confusion to arise, if it were going to); and the registrant has no chance to be heard from (at least in the absence of a consent agreement, which applicant has not submitted in this case).

In re Kangaroos U.S.A., 223 USPQ 1025, 1026-27 (TTAB 1984).

The filing of a request for reconsideration does not extend the time for filing a proper response to a final Office action or an appeal with the Trademark Trial and Appeal Board (Board), which runs from the date the final Office action was issued/mailed. *See* 37 C.F.R. §2.64(b); TMEP §715.03, (a)(2)(B), (a)(2)(E), (c).

If time remains in the six-month response period to the final Office action, applicant has the remainder of the response period to comply with and/or overcome any outstanding final requirement and/or to file an appeal with the Board. TMEP §715.03(a)(2)(B), (c). However, if applicant has already filed a timely notice of appeal with the Board, the Board will be notified to resume the appeal. *See* TMEP §715.04(a).

Contacting the Examining Attorney

If applicant has any questions concerning the above action, it is encouraged to contact the examining attorney at the number listed below.

/DETJr/

David E. Tooley, Jr.

Trademark Examining Attorney

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Description | **Specs** | The West Advisor | Reviews

GPSMAP 740 is a stand-alone touchscreen chartplotter that brings a new level of functionality to your vessel. Featuring a brilliant 7-inch display, GPSMAP 740 puts all the information you need right at your fingertips. GPSMAP 740 is preloaded with U.S. coastal maps. In addition, GPSMAP 740 accepts radar input and offers full NMEA 2000® connectivity for



http://www.westmarine.com/webapp/wcs/stores/servlet/Product_11151_10001_263729_-1?ci_src=14110944&ci_sku=263729&cid=sc_googlepla&device=c&network=g&matchtype=&gclid=Cj0CjMGMxq7sCF5U0OgodhUoA2w12/12/2013 04:32:18 PM

Input and extra features allow connectivity for greater convenience when adding extra sensors.

Explore the Seas

GPSMAP 740 contains preloaded map data for all U.S. coastal areas, including Alaska and Hawaii, plus Explorer Charts for the Bahamas. GPSMAP 740 also features an internal, high-sensitivity GPS receiver for superior satellite tracking and quicker acquisition times. And as an added benefit, GPSMAP 740 can receive graphical weather data for North America through the optional GXM™ 51 satellite receiver/antenna



Take Control by Touch

Input is easy with GPSMAP 740. Whether you're changing course or simply reviewing information in front of you, the intuitive touchscreen interface makes for simple operation. The device also offers flexible brightness levels for daytime readability along with low-light dimming during night use. And with a widescreen display that's rugged and waterproof, it's made to perform in any situation.

Expand with Radar

Featuring a built-in radar port, GPSMAP 740 can be interfaced with Garmin's line of affordable GMR™ marine radar systems. Whether you're adding radar now or in the future, you'll enjoy the convenience of "plug-and-play installation" as well as the power, range and high-definition targeting of our proven radar offerings.¹

Add Sonar with GPSMAP 740s

GPSMAP 740s comes standard with a 1kW-capable sonar transceiver. This powerful sonar can help you define fish targets and underwater structures as far down as 2,000 feet when used with a 1kW transducer.²

Add Extras with BlueChart g2 Vision

With the optional BlueChart® g2 Vision SD™ card, you can add a whole new dimension of exceptional features to your chartplotter.

- MarinerEye view and FishEye view provide you a 3-dimensional perspective of map information, both above and below the waterline.
- High-resolution satellite images and aerial photographs help you orient yourself in unfamiliar areas.
- Auto Guidance technology searches through all relevant charts to create a route you can actually follow - one that avoids obstacles, shallow water, buoys and other obstructions.

¹Garmin Marine Network not supported.

²Depth capacity is dependent on water salinity, bottom type and other water conditions (with 1 kW transducer).

Physical & Performance:

- Unit dimensions, WxHxD: 8.8" x 5.6" x 3.1" (22.4 x 14.2 x 7.9 cm)
- Display size, WxH: 6.0" x 3.6", 7.0" diagonal (15.2 x 9.1 cm, 17.8 cm diagonal)
- Display resolution, WxH: 800 x 480 pixels
- Display type: WVGA display
- Weight: 2.48 lb (1.1 kg)
- Battery: none



18" GMR HD Digital Radar, 5.0° Horiz. Beamwidth, 36nm Max. Range \$1,199.99



GARMIN 24" GMR HD Digital Radar, 3.6° Horiz. Beamwidth, 48nm Max. Range \$1,999.99



GARMIN GHP 10 Marine Autopilot System \$1,999.99



GARMIN GFS 10 Fuel-Flow Sensor \$199.99



GARMIN Bronze 20° Thru-hull Tilted Element Transducer, 1kWatts \$879.99

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- Battery: none
- Battery life: none
- Waterproof: yes (IPX7)
- High-sensitivity receiver: yes
- Antenna: internal
- NMEA input/output: NMEA 0183 compatible and NMEA 2000® certified

Maps & Memory:

- Basemap: yes
- Preloaded maps: yes (coastal maps)
- Ability to add maps: yes
- Built-in memory: none (cannot load maps to internal memory)
- Accepts data cards: SD™ card slot
- Waypoints/favorites/locations: 3,000
- Routes: 100
- Track log: 20,000 points; 50 saved tracks

Features:

- Garmin radar compatible: yes
- Garmin sonar compatible: yes (included with sounder version)
- Garmin Marine Network™ compatible: no
- Touchscreen: yes
- Supports AIS (tracks target ships' position): yes
- Supports DSC (displays position data from DSC capable VHF radio): yes
- Audible alarms: yes
- Tide tables: yes
- Hunt/fish calendar: no
- Sun and moon information: yes
- 3-D map view: yes (with optional BlueChart g2 Vision card)
- Auto Guidance: yes (with optional BlueChart g2 Vision card)
- XM WX Weather & Radio for U.S. & Canada compatible: yes
- Automatic routing (turn by turn routing on roads): no
- Voice prompts (e.g. "Turn right in 500 ft."): no
- Speaks street names (e.g. "Turn right ON ELM STREET in 500 ft."): no
- Headphone jack/audio line-out: no
- Audio/video input/output: no
- Portable: no
- Automotive/motorcycle-friendly: no

What You'll Need

The 50/200 kHz Traditional Transducers - 6 Pins operate with either 500W, 600W or 1kW transducers, sold separately. Depending on the style of the transducer, you'll get depth, speed and/or temperature readings. To complete your installation, order one of the following transducers: