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

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Applicant	TÄñnjes ISI Patent Holding GmbH
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Applicant:	Tönnjes ISI Patent Holding GmbH		Law Office: 113
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**APPLICANT'S BRIEF ON EX PARTE APPEAL OF THE EXAMINER'S FINAL REFUSAL TO
REGISTER**

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TABLE OF CONTENTS

	TABLE OF AUTHORITIES	3
I.	INTRODUCTION AND DESCRIPTION OF THE RECORD	8
II.	ISSUES	9
III.	ARGUMENT: THERE IS NO LIKELIHOOD OF CONFUSION BETWEEN APPLICANT'S MARK AND REGISTRANT'S MARK	9
	A. THE MARKS ARE DISTINCT.	10
	1. The Marks Themselves Are Different.	10
	2. The Marks Have A Different Commercial Impression	13
	B. THE LISTING OF GOODS IS NOT DISPOSITIVE OF A LIKELIHOOD OF CONFUSION	16
IV.	ARGUMENT: APPLICANT'S MARK IS NOT MERELY DESCRIPTIVE OF APPLICANT'S GOODS	19
V.	CONCLUSION	24

TABLE OF AUTHORITIES

Cases

<i>Affiliated Hospital Products, Inc. v. Merdel Game Mfg. Co.,</i>	15
513 F2d 1183 (2d Cir. 1975)	
<i>Aries Systems Corp. v. World Book Inc.,</i>	17
26 USPQ2d 1926 (TTAB 1993)	
<i>Association of Co-operative Members, Inc. v. Farmland Industries, Inc.,</i>	21
216 USPQ 361 (5 th Cir. 1982)	
<i>Burger Chef Systems, Inc. v. Sandwich Chef, Inc.,</i>	21
608 F2d 875 (CCPA 1979)	
<i>Champagne Louis Roederer S.A. v. Delicato Vinewards,</i>	13
4714 USPQ2d 59 (Fed. Cir. 1998)	
<i>Coach Services, Inc. v. Triumph Learning LLC,</i>	14
668 F3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012)	
<i>Colgate-Palmolive Co. v. Carter-Wallace, Inc.,</i>	13, 19
167 USPQ 529 (CCPA 1970).	
<i>ConAgra, Inc. v. Saavedra,</i>	12
4 USPQ2d 1245 (TTAB 1987)	
<i>Conde Nast Publications, Inc. v. Miss Quality, Inc.,</i>	13
184 USPQ 422 (CCPA 1975).	
<i>Cotton Club Bottling Co. v. American Brands, Inc.,</i>	15
174 USPQ 343 (TTAB 1972)	
<i>Electronic Data Systems Corp. v. EDSA Micro Corp.,</i>	17
23 USPQ2d 1460 (TTAB 1992)	

<i>Firestone Tire & Rubber Co. v. Goodyear Tire & Rubber Co.,</i>	
186 USPQ 557 (TTAB 1975)	22
<i>Ford Motor Co. v. Ford,</i>	
174 USPQ 456 (CCPA 1972).	18
<i>Gruner + Jahr USA Pub., a Div. of Gruner + Jahr Printing and Pub. Co. v. Meredith Corp.,</i>	
26 USPQ2d 1583 (2d Cir. 1993)	13, 16
<i>In re August Storck KG,</i>	
218 USPQ 823 (TTAB 1983)	19
<i>In re Automatic Radio Manufacturing Co.,</i>	
404 F2d 1391, 160 USPQ 223 (CCPA 1969)	23
<i>In re Bright-Crest, Ltd.,</i>	
204 USPQ 591, 593 (TTAB 1979)	20
<i>In re Colonial Refining & Chemical Co.,</i>	
196 USPQ 46 (TTAB 1977)	20
<i>In re Corning Glass Works,</i>	
229 USPQ 65 (TTAB 1985)	19
<i>In re Dollar-A-Day Rent-A-Car Systems, Inc.,</i>	
173 USPQ 1972	22
<i>In re DuPont De Nemours & Co.,</i>	
476 F2d 1357, 177 USPQ 563 (CCPA 1973)	9, 12, 15
<i>In re Failure Analysis Associates,</i>	
1 USPQ2d (TTAB 1986)	22
<i>In re Ferrero,</i>	
178 USPQ 167 (CCPA 1973).	13
<i>In re Hamilton Bank,</i>	
222 USPQ 174 (TTAB 1984)	15

<i>In re Hearst Corp.</i> ,	
982 F2d 493 (Fed. Cir. 1992). 12
<i>In re LRC Products Ltd.</i> ,	
223 USPQ 1250, 1252 (TTAB 1984) 20, 24
<i>In re Micro Instrument Corp.</i> ,	
222 USPQ 252, 255 (TTAB 1984) 20, 24
<i>In re Minnetoka</i> ,	
3 USQP2d 1712 (TTAB 1987) 22
<i>In re National Data Corp.</i> ,	
753 F2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985) 14
<i>In re Omaha National Corp.</i> ,	
2 USPQ2d 1859 (Fed. Cir. 1987) 20
<i>In re Realistic Co.</i> ,	
169 USPQ 610 (CCPA 1971). 23
<i>In re Rexel, Inc.</i> ,	
223 USPQ 830 (TTAB 1984) 19
<i>In re Quadram Corp.</i> ,	
228 USPQ 863, 865 (TTAB 1985) 17
<i>In re Quik-Print Copy Shop, Inc.</i> ,	
203 USPQ 624 (TTAB 1979) 20
<i>In re Reynolds Metal Co.</i> ,	
178 USPQ 296, 296 (CCPA 1973) 22, 23
<i>In re Shutts</i> ,	
217 USPQ 363 (TTAB 1983) 20, 24
<i>Information Resources Inc. v. X*Press Information Services</i> ,	
6 USPQ2d 1034 (TTAB 1988) 17

<i>Interstate Brands Corp. v. Celestial Seasonings, Inc.,</i>	
576 F2d 926, 198 USPQ 151 (CCPA 1987)	19
<i>Lever Bros. Co. v. Barcolene Co.,</i>	
174 USPQ 392 (CCPA 1972).	13
<i>Mobil Oil Corp. v. Mobile Mechanics, Inc.,</i>	
192 USPQ 744 (DConn. 1976)	13
<i>MSI Data Corp. v. Microprocessor Systems, Inc.,</i>	
220 USPQ 658 (TTAB 1983)	18
<i>Nestles Milk Products, Inc. v. Baker Importing Company,</i>	
182 F2d 193 (CCPA 1950)	15
<i>Opryland USA, Inc. v. Great American Music Show, Inc.,</i>	
970 F2d 847, 851, 23 USPQ2d 1471 (Fed. Cir. 1992)	10
<i>Pacific Industries, Inc. v. Minnesota Mining and Manufacturing Co.,</i>	
425 F2d 1265, 165 USPQ 631 (CCPA 1970)	23
<i>Paula Payne Products Co. v. Johnson Publishing Co., Inc.,</i>	
176 USPQ 76 (CCPA 1973)	18
<i>Plus Products v. General Mills, Inc.,</i>	
188 USPQ 520 (TTAB 1975)..	13, 15, 21
<i>Stix Products, Inc. v. United Merchants & Mfrs., Inc.,</i>	
295 FSupp 479, 160 USPQ 777 (SDNY 1968)	23
<i>Time, Inc. v. Petersen Pub. Co. L.L.C.,</i>	
50 USPQ2d 1474 (2d Cir. 1999)	13
<i>Union Carbide Corp. v. Ever-Ready, Inc.,</i>	
188 USPQ 623 (7th Cir. 1976)	20
<i>Worster Brush Co. v. Prager Brush Co.,</i>	
231 USPQ 316 (TTAB 1986)	15

Statutes and Other Resources

15 USC §1052(d) 10, 12

McCarthy on Trademarks and Unfair Competition § 23.15[1][a] 10

McCarthy on Trademarks and Unfair Competition § 23.41 11

McCarthy on Trademarks and Unfair Competition § 23.42 11

McCarthy on Trademarks and Unfair Competition § 23:48 16

Restatement (Third) of Unfair Competition § 21 comment i (Tentative Draft No. 2, 1990) 15

TMEP Section 1209.01(a) 23

TMEP Section 1209.01(b) 19

US Patent No. 8,737,915 18

I. INTRODUCTION AND DESCRIPTION OF THE RECORD.

Applicant hereby appeals from the Examiner's final refusal to register Applicant's Mark. Applicant respectfully requests the Trademark Trial and Appeal Board (Board) reverse the Examiner's decision.

On 27 June 2013 Tönnjes ISI Patent Holding GmbH ("Applicant") filed a trademark application for the mark **IDEPLATE** ("Applicant's Mark") for various goods in International Classes 006, 009, and 020 ("Applicant's Goods").

On 30 July 2013 the Examiner initially refused registration of Applicant's Mark under a requirement for a definite identification of Applicant's Goods and for the significance of Applicant's Mark.

On 30 January 2014 Applicant provided a response to the 30 July 2013 office action by amending the identification of goods and indicating the mark has no significance.

On 4 March 2014 the Examiner (a) initially refused registration of Applicant's Mark under 15 USC §1052(d) ("Section 2(d)") based on the allegation that Applicant's Mark is likely to be confused with US Registration No. 4310718 for EPLATE ("Registrant's Mark") for "cards with integrated circuits, etc." in International Class 009 ("Registrant's Goods"); (b) provided information about a potential Section 2(d) refusal over prior pending Application No. 85583249 for EPLATE ("Prior Pending Mark") for "blank electronic chip cards, etc." in International Class 009; and (c) initially refused registration of Applicant's Mark under 15 USC §1052(e)(1) ("Section 2(e)(1)") based on the allegation that Applicant's Mark is merely descriptive of Applicant's Goods, and continued the request for a definite identification of Applicant's Goods.

On 3 September 2014 Applicant responded to the 4 March 2014 office action by presenting argument that Applicant's Mark is not likely to be confused with Registrant's Mark, that Applicant's Mark is not merely descriptive, and amending the identification of goods.

On 19 September 2014 the Examiner suspended action on Applicant's Application pending disposition of the Prior Pending Application and maintaining the refusal to register Applicant's Mark under Sections 2(d) and 2(e)(1).

On 29 October 2015 the Examiner issued a final refusal to register Applicant's Mark under Sections 2(d) and 2(e)(1) in which the reference to the now abandoned Prior Pending Application was removed as moot.

On 28 April 2016 Applicant filed a Notice of Appeal to the TTAB

II. ISSUES.

The issues before the TTAB are:

(a) Whether under Section 2(d) of the Trademark Act, 15 USC §1052(d), there is a likelihood of confusion between Applicant's Mark and Registrant's Mark; and

(b) Whether under Section 2(e)(1) of the Trademark Act, 15 USC §1052(e)(1), Applicant's Mark is merely descriptive of Applicant's Goods.

III. ARGUMENT: THERE IS NO LIKELIHOOD OF CONFUSION BETWEEN APPLICANT'S MARK AND REGISTRANT'S MARK.

In determining whether there is a likelihood of confusion, *In re DuPont De Nemours & Co.*, 476 F2d 1357, 177 USPQ 563 (CCPA 1973) listed a number of factors to consider in making such a determination, all of which Applicant submits favor registration of Applicant's Mark over Registrant's Mark. The Examiner's final refusal to register is premised only on two of these factors: the alleged similarity of the marks and the similarity of the listed goods. Applicant submits that when these *DuPont* factors are considered in their entirety, there is no likelihood of confusion between Applicant's Mark and Registrant's Mark.

A. THE MARKS ARE DISTINCT.

1. The Marks Themselves Are Different.

Applicant's Mark and Registrant's Mark are distinct in spelling, pronunciation, and sight under Section 2(d). It is readily apparent that in this case the distinctions are not limited to a mere term or a simple design, but to spelling, pronunciation, and visual differences that, when viewed as a whole, distinguishes Applicant's Mark from Registrant's Mark. Accordingly, the distinctions are significant to a degree that concurrent registration would be unlikely to cause confusion in the marketplace. Confusion will not occur, as both Applicant and Registrant must use the specific spelling versions of their respective marks with their respective goods, and cannot use each other's or other spellings of the their respective marks and remain within the scope of a granted registration. Thus, it is clear that the standards of the USPTO allow, and in fact require, registration of these separate marks due to such distinctions.

More specifically, Applicant's Mark is IDEPLATE. Registrant's Mark is EPLATE. These marks are not sufficiently similar in appearance, connotation, or meaning so as to cause a likelihood of confusion. When determining whether two marks are confusingly similar, one must consider the marks **in their entirety**:

As the Supreme Court observed: "The commercial impression of a trademark is derived from it as a whole, not from its elements separated and considered in detail. For this reason it should be considered in its entirety."

McCarthy on Trademarks and Unfair Competition § 23.15[1][a] (citation omitted). See also *Opryland USA, Inc. v. Great American Music Show, Inc.*, 970 F2d 847, 851, 23 USPQ2d 1471 (Fed. Cir. 1992) (no confusion between CAROLINA OPRY and Opryland's marks GRAND OLE OPRY or OZARK OPRY after excluding the word "opry") (citations omitted).

Although it may be appropriate in determining the likelihood of confusion to give greater weight to the "dominant" part of a mark in some circumstances, conflicting marks should be compared by looking at them as a whole, rather than breaking the marks up into their

component parts for comparison. See 4 McCarthy on Trademarks and Unfair Competition §§23:41 and 23:42 (4th ed.). “The rationale for the [anti-dissection] rule, is that the commercial impression of a composite trademark on an ordinary prospective buyer is created by the mark as a whole, not by its component parts.” *Id.* “It is the impression that the mark as a whole creates on the average reasonably prudent buyer and not the parts thereof, that is important. Further,

The anti-dissection rule is based upon a common sense observation of customer behavior: the typical shopper does not retain all of the individual details of a composite mark in his or her mind, but retains only an overall, general impression created by the composite as a whole. It is the overall impression created by the mark from the ordinary shopper's cursory observation in the marketplace that will or will not lead to a likelihood of confusion, not the impression created from a meticulous comparison as expressed in carefully weighed analysis in [USPTO Office Actions].

Id. As such, even if “ePLATE” in Registrant’s Mark deserves greater weighting for purposes of comparing similarity, the Examiner’s comparison of the marks should be based on the entirety of the marks; this includes comparing the “dominant” and “less dominant” elements of the Applicant’s Mark with those of Registrant’s Mark. Specifically, while Registrant’s Mark is for only “ePLATE”, Applicant’s Mark further comprises the differentiating initial addition of “ID”, which creates a distinct and different first impression to the consumer.

In the case at hand, Applicant’s Mark begins with the **subterm** ID, while Registrant’s Mark begins with the **subterm** E. Not only do these two subterms connote distinctly different meanings, their use as a prefix reinforces this distinction. ID and E are comprised of completely different letters, with no letters in common. Also, ID often can be considered as a complete word, conjuring up a mental function in Applicant’s Mark. For example, the word “id” can mean **at least** three things: the instinctive portion of a human mind, the word “that” in Latin, and a

short form of identification. Thus, when combined with the suffixes “e” and “plate”, Applicant’s Mark IDEPLATE does not conjure up any single or particular item. To the contrary, E is a non-word, has a very distinct **single** meaning, and conjures up the general well-known meaning of “electronic”. Thus, when combined with the suffix “plate”, Registrant’s Mark EPLATE conjures up a single item, namely, an electronic plate, and thus is a weak mark at best.

Although Applicant’s Mark and Registrant’s Mark contain a similar term, when viewed in their entireties, the marks are different. In *In re Hearst Corp.*, 982 F2d 493 (Fed. Cir. 1992), the Federal Circuit reviewed a Board decision to refuse registration of the mark VARGA GIRL on the ground of likelihood of confusion with the registered trademark VARGAS both for calendars. In reversing the Board decision, the court first noted that “marks tend to be perceived in their entireties, and all components must be given appropriate weight.” *Id.* at 494. The court concluded that the marks VARGA GIRL and VARGAS were sufficiently different in sight, sound, connotation, and commercial impression to negate the likelihood of confusion under Section 2(d) of the Lanham Act. By finding that Applicant’s Mark is confusingly similar to Registrant’s Mark the Examiner has engaged in the exact analysis criticized by the *Hearst* court. Accordingly, under the first *DuPont* factor, when considered in their entireties, Applicant’s Mark and Registrant’s Mark are dissimilar in sight, sound, connotation, and commercial impression, and there is no likelihood of confusion.

Further, the marks are aurally distinct in that Applicant’s Mark comprises the **additional initial syllable “ID”**. Thus, by sound, this will cause consumers to immediately recognize that the marks are disparate. As such, the marks from the sound alone are readily disguisable by ear. In a particular analogous case, the Board confirmed this rule in *ConAgra, Inc. v. Saavedra*, 4 USPQ2d 1245 (TTAB 1987) (the Board held that “TAPATIO” for hot sauce was found not confusingly similar to “PATIO” for Mexican style food, which is complimentary food to hot sauce).

There are numerous other examples of this situation in which marks, when viewed in their entireties, were held to be not confusingly similar in spite of the fact that they both contain a common term as in the present case: *Champagne Louis Roederer S.A. v. Delicato Vinewards*, 4714 USPQ2d 59 (Fed. Cir. 1998) (the marks CRISTAL for champagne and CRYSTAL CREEK for wine are not confusingly similar); *Colgate-Palmolive Co. v. Carter-Wallace, Inc.*, 167 USPQ 529 (CCPA 1970) (the marks PEAK for dentifrice and PEAK PERIOD for deodorant were not confusingly similar); *Mobil Oil Corp. v. Mobile Mechanics, Inc.*, 192 USPQ 744 (DConn. 1976) (MOBILE for gasoline not confusingly similar to MOBILE MECHANICS for auto repair and towing); *Lever Bros. Co. v. Barcolene Co.*, 174 USPQ 392 (CCPA 1972) (ALL CLEAR not confusingly similar to ALL); *In re Ferrero*, 178 USPQ 167 (CCPA 1973) (TIC TAC not confusingly similar to TIC TAC TOE); *Conde Nast Publications, Inc. v. Miss Quality, Inc.*, 184 USPQ 422 (CCPA 1975) (COUNTRY VOGUES not confusingly similar to VOGUE for magazines); *Plus Products v. General Mills, Inc.*, 188 USPQ 520 (TTAB 1975) (PROTEIN PLUS not confusingly similar to PLUS); *Gruner + Jahr USA Pub., a Div. of Gruner + Jahr Printing and Pub. Co. v. Meredith Corp.*, 26 USPQ2d 1583 (2d Cir. 1993) (PARENTS not confusingly similar to PARENTS DIGEST, both for magazines); *Time, Inc. v. Petersen Pub. Co. L.L.C.*, 50 USPQ2d 1474 (2d Cir. 1999) (TEEN and TEEN PEOPLE, both for magazines, not confusingly similar).

2. The Marks Have A Different Commercial Impact.

Rather than comparing the overall commercial impact of Applicant's Mark as applied to Applicant's Goods, and those of Registrant's Mark as applied to Registrant's Goods, the Examiner has exclusively considered the similarity of the matter shared between the marks. By downplaying the contribution of the difference in spelling, pronunciation, and the visual distinctions between the marks, the Examiner found that there was a likelihood of confusion

because the descriptive portion of Registrant's Mark allegedly is confusingly similar to the descriptive portion of Applicant's Mark.

Confusion is not likely due to the crucial differences between the marks, discussed above. In comparing the marks, "the proper test is not a side-by-side comparison of the marks, but instead 'whether the marks are sufficiently similar in terms of their commercial impression' such that persons who encounter the marks would be likely to assume a connection between the parties." *Coach Services, Inc. v. Triumph Learning LLC*, 668 F3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012) (citation omitted). While the Board must consider the marks in their entireties, it is entirely appropriate to accord greater importance to the more distinctive elements in the marks. See *In re National Data Corp.*, 753 F2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). Applicant's Mark includes three portions, "ID", "E", and "PLATE". On the contrary, Registrant's Mark includes only two portions. As such, when compared to each other, each mark provides a graphic device that serves to draw attention to the terms. In this context, the visual impression of Registrant's Mark is important and distinct from Applicant's Mark.

Further, the "ID" portion of Applicant's Mark IDEPLATE creates a commercial impression wholly different than that of the mark EPLATE with no additional initial term. Especially in International Classes 009, where the lead letter "e" is ubiquitous, meaning "electronic", the reality of the marketplace dictates that even tiny differences in marks describing electronic or electronic-related goods are sufficient to differentiate marks in the eyes of consumers.

The Examiner argued that Applicant's additional element "ID" is descriptive and a term short for identification. While "ID" may be a term short for identification, Applicant disagrees with the Examiner's position that the addition of this term does not obviate similarity, submitting that the Examiner has taken this to the extreme and has assigned too little, or no weight at all, to the term "ID". For example, as discussed above, the term "ID" has a number of other meanings:

The part of the psyche, residing in the unconscious, that is the source of instinctive impulses that seek satisfaction in accordance with the pleasure principle and are modified by the ego and the superego before they are given overt expression.

A cartoon country, as in "The Wizard of Id".

Latin for "that", as in id est.

Abbreviation for the state of Idaho.

Abbreviation for independent distributor.

Abbreviation for industrial design.

Abbreviation for inner diameter.

Thus, the term "ID" has a number of different meanings to the consumer, depending on the age, mood, maturity, and background of the consumer and, whether the marks are viewed in their entirety, improperly dissected, or considered based on the subjective strength of their component parts, the marks are distinct from each other, and there is no likelihood of confusion.

Following from above, *DuPont* recognizes that the less distinctive a mark, the greater the likelihood that use on non-competitive goods or services **will not cause confusion**. See Restatement (Third) of Unfair Competition § 21 comment i (Tentative Draft No. 2, 1990); *Plus Products v. Plus Discount Foods, Inc.*, 722 F2d 999 (2d Cir. 1983); *Cotton Club Bottling Co. v. American Brands, Inc.*, 174 USPQ 343 (TTAB 1972); *Nestles Milk Products, Inc. v. Baker Importing Company*, 182 F2d 193 (CCPA 1950). For example, the use of "KICK-ER" was found not to cause likely confusion with "KIK-IT" when both were used on tabletop soccer games, because the common element "kick" is suggestive of such games. *Affiliated Hospital Products, Inc. v. Merdel Game Mfg. Co.*, 513 F2d 1183 (2d Cir. 1975); see also *In re Hamilton Bank*, 222 USPQ 174 (TTAB 1984) (no likelihood of confusion found between "KEY" for banking services and other marks for banking containing the word "key"; the common word "key" is weak, is widely used in the financial field, and is suggestive of a desirable characteristic of banking); *Worster Brush Co. v. Prager Brush Co.*, 231 USPQ 316 (TTAB 1986) (no likelihood of confusion

between "POLY PRO" and "POLY FLOW" for paint brushes, because of weak descriptive "Poly" (made of polyester or polymers), and weak "PRO" (professional quality) and weak "FLO" (flows easily)).

Additionally, it is well established that when a registrant's mark is inherently "weak" even small distinctions between marks are sufficient to render confusion unlikely. "A portion of a mark may be 'weak' in the sense that such portion is descriptive, highly suggestive, or is in common use by many other sellers in the market." McCarthy, *supra*, §23:48 (4th ed.). If "the common element of conflicting marks is a word that is 'weak' then this reduces the likelihood of confusion." *Id.* For instance, in *Gruner + Jahr USA Pub. v. Meredith Corp.*, 991 F2d 1072 (2d Cir. 1993), the court found no likelihood of confusion between PARENTS and PARENTS DIGEST for directly competing goods, magazines, due to the inherent weakness of the term "PARENTS" when used in connection with parenting publications.

In the present situation, the term "ePLATE" makes for a weak mark when it comes to the electronics because "ePLATE" is highly suggestive of an electronic plate of some sort. Consequently, sufficient weight must be given to the addition of the term "ID" in Applicant's Mark, even if arguendo deserving of less weight according to the Examiner, in a similarity and likelihood of confusion analysis to counteract the weakness of the term "ePLATE".

Thus, under this analysis as well, when the marks are viewed in their entirety, or considered based on the subjective strength of their component parts, or even improperly dissected, the marks are distinct from each other, and there is no likelihood of confusion.

B. THE LISTING OF GOODS IS NOT DISPOSITIVE OF A LIKELIHOOD OF CONFUSION.

In determining a likelihood of confusion, another issue is whether an applicant's goods are so related to a registrant's goods so as to be likely to generate confusion as to source or sponsorship among relevant consumers. In the present case, although according to the

descriptions tendered in the registration and application, both Applicant and Registrant provide a type of electronically read device, the actual types of devices do not necessarily overlap in type or in use. Both Applicant's Goods and Registrant's Goods are specialty items designed for specific purposes.

One must look at the realities of the marketplace to determine whether the goods are sufficiently different and specialized, that there is no likelihood of confusion. See, e.g., *In re Quadram Corp.*, 228 USPQ 863, 865 (TTAB 1985). In *Quadram*, the Board found no likelihood of confusion between use of MICROFAZER for a specific specialized piece of computer peripheral equipment, namely a buffer, and the mark FASER for use in connection with computer programs in the field of energy conservation and management. The present situation is analogous in that Applicant's Mark and Registrant's Mark share a common second term, while Applicant's Mark has an additional first term. And, even using the Examiner's analysis that the term "ID" is descriptive, the term "MICRO" in *Quadram* is **at least as descriptive**. Other examples of cases in which the Board has recognized that distinctions can be made between marks used in the e-fields, so that use of two similar marks for related e-field goods does not automatically result in a likelihood of confusion include:

*Information Resources Inc. v. X*Press Information Services*, 6 USPQ2d 1034 (TTAB 1988)(EXPRESS for information analysis computer software packages not confusingly similar to X*PRESS for service consisting of transmittal of new and general information to home and business computers via satellite and cable television lines);

Electronic Data Systems Corp. v. EDSA Micro Corp., 23 USPQ2d 1460 (TTAB 1992) (EDSA for computer programs for electrical distribution system analysis and design not confusingly similar to EDS for computer data processing services, notwithstanding the fame of the EDS mark); and

Aries Systems Corp. v. World Book Inc., 26 USPQ2d 1926 (TTAB 1993) (INFORMATION FINDER for computer programs on compact disks for use in general

research not confusingly similar to KNOWLEDGE FINDER for computer programs that retrieve information from databases containing citations to, and abstracts of, biomedical journal articles that are sold primarily to medical professionals).

A similar result should be reached in this matter. Applicant's Goods are, summarily, specialized devices for use on vehicles or the like. See, e.g., Applicant's US Patent No. 8,737,915, already a part of the prosecution record. Applicant's Goods allow, for example, a vehicle to be contactlessly identified or identified without the necessity for reading a license plate, which could be damaged or altered. Registrant's Goods are, in effect, smart cards such as bank cards, credit cards, identification cards, gift cards, telephone cards, etc., all comprising an RFID chip for use in financial transactions.

First, Applicant's Goods are not used in financial transactions.

Second, both Applicant's Goods and Registrant's Goods are purchased by middle users, not end users. The ultimate user is the typical consumer - a person owning a vehicle in the case of Applicant's Goods and a typical consumer in the case of Registrant's Goods. However, the purchaser of Applicant's Goods is the license plate provider such as a governmental agency, and the purchaser of Registrant's Goods is a smart card provider, such as a bank. Thus, both Applicant's Goods and Registrant's Goods are previously made goods comprising the identified goods, already made for use by an end user. Thus, Applicant's Goods are dissimilar to Registrant's Goods.

In determining a likelihood of confusion, a critical issue generally is whether an applicant's goods are so related to a registrant's goods so as to be likely to generate confusion as to source or sponsorship among customers. "In making this determination, it is clear that [the Court] must proceed on the basis of the parties' goods and services as they are identified in the pertinent registrations and application for registrations" *Paula Payne Products Co. v. Johnson Publishing Co., Inc.*, 176 USPQ 76 (CCPA 1973); *Ford Motor Co. v. Ford*, 174 USPQ 456 (CCPA 1972); *MSI Data Corp. v. Microprocessor Systems, Inc.*, 220 USPQ 658 (TTAB

1983). In the present instance, Applicant provides devices that are distinct from Registrant's Goods, which, although arguendo related to the broad category of electronically readable devices, are not interchangeable. Under this analysis, when the goods are considered, the marks are distinct from each other, and there is no likelihood of confusion.

The present situation is analogous to *In re August Storck KG*, 218 USPQ 823 (TTAB 1983), in which the Board determined that the use of the marks "Juicy 2" on one type of food product was not confusingly similar to the use of the mark "Juicy Blend II" on another type of food product. Although both parties use the marks on food products, the Board found that the food products "are quite different" and "the goods ... are sufficiently different that their marketing under reasonably distinguishable albeit similar marks would not likely generate consumer confusion." *Id.* at 825; see also *Interstate Brands Corp. v. Celestial Seasonings, Inc.*, 576 F2d 926, 198 USPQ 151 (CCPA 1987) ("Zingers" for cakes not confusingly similar to "Red Zinger" for tea); *In re Rexel, Inc.*, 223 USPQ 830 (TTAB 1984) ("Little Goliath" for stationery products, namely a stapler and staples, not confusingly similar to "Goliath" for other stationery products, namely wood cased pencils). As in the cases decided before, Applicant's Goods and Registrant's Goods "are nevertheless essentially different and noncompetitive in that their application and utility serve different objectives." *Colgate-Palmolive Co. v. Carter-Wallace, Inc.*, 432 F2d 1400, 167 USPQ 529, 530 (CCPA 1970); see also *In re Corning Glass Works*, 229 USPQ 65 (TTAB 1985) (contemporaneous use of "CONFIRM" for buffered solutions equilibrated to yield predetermined dissolved gas values in blood analyzer and "CONFIRMCELLS" for diagnostic blood reagents for laboratory use would likely cause confusion).

IV. ARGUMENT: APPLICANT'S MARK IS NOT MERELY DESCRIPTIVE OF APPLICANT'S GOODS

TMEP Section 1209.01(b) recites the conditions under which a mark may be held to be merely descriptive: "To be refused registration on the Principal Register under Section 2(e)(1) .

. . . , a mark must be merely descriptive . . . of the goods or services to which it relates.” The cases decided under Section 2(e) establish that in order for a mark to be merely descriptive, it must convey “an immediate idea of an ingredient, quality, characteristic, function or feature of the product in connection with which it is used.” *In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979). Therefore, Applicant’s Goods and the relevant industry must be examined in view of the mark in assessing whether the mark is “merely descriptive” of the goods.

Applicant submits that Applicant’s entire mark “IDePLATE” does not fall within the definitions of “merely descriptive” under Section 2(e), but instead is at least suggestive of Applicant’s Goods. There is a thin line between a suggestive term and a descriptive term. *Union Carbide Corp. v. Ever-Ready, Inc.*, 188 USPQ 623 (7th Cir. 1976); *In re Quik-Print Copy Shop, Inc.*, 203 USPQ 624 (TTAB 1979). Any doubts concerning the descriptiveness of a mark are to be resolved in favor of the Applicant. *In re Micro Instrument Corp.*, 222 USPQ 252, 255 (TTAB 1984); *In re LRC Products Ltd.*, 223 USPQ 1250, 1252 (TTAB 1984).

Applicant’s Mark is a unique combination of terms formed into a unitary term. “IDePLATE” is not an English word, nor does it to Applicant’s knowledge have any meaning in a foreign language, any geographical significance, or any significance in the relevant industry. Applicant created the term as a brand name for Applicant’s Goods. For a mark to be descriptive, the mark must be understood to describe the goods. *In re Omaha National Corp.*, 2 USPQ2d 1859 (Fed. Cir. 1987); *In re Colonial Refining & Chemical Co.*, 196 USPQ 46 (TTAB 1977). Applicant’s Mark in general is an incongruous unitary term that would not be grasped by the consumer without some imagination and a mental pause. *In re Shutts*, 217 USPQ 363 (TTAB 1983).

Importantly, when confronted with Applicant’s Mark, Applicant’s Goods would not immediately come to mind. Applicant submits that the reasonable consumer in the relevant industry would have to make a mental leap from Applicant’s Mark to Applicant’s Goods in that when the reasonable consumer is presented with Applicant’s Mark and Applicant’s Goods, the

reasonable consumer would have an “Aha! moment” in connecting Applicant’s Mark with Applicant’s Goods. As such, Applicant submits that its mark functions as a trademark and is registrable.

Even assuming arguendo that one component in Applicant’s Mark may be a known term, the overall combination and arrangement of the components of Applicant’s Mark **into a single unitary mark** results in a suggestive and registrable trademark. Applicant is not using any of the components of Applicant’s Mark as separate terms, thus giving a distinctly different impression. This is an important distinction in that while those in the relevant industry often use the term “e” and the term “plate” in related products, **they do not refer to such products as an “IDePLATE”**, as evidenced by the Examiner failing to find the identical mark “IDePLATE” in the USPTO or on-line records.

Thus, Applicant’s Mark when taken **as a whole** and as used in the relevant industry does not inform the public of the nature of Applicant’s Goods. Under established law, a mark must not be dissected into individual parts and must be considered as a whole when assessing the descriptiveness or suggestiveness of mark. See, e.g., *Burger Chef Systems v. Sandwich Chef, Inc.*, 608 F2d 875 (CCPA. 1979). And, as a whole, Applicant’s Mark does not describe the nature or a “*significant* function or attribute” of Applicant’s Goods as would be required to render the mark merely descriptive. Specifically, Applicant’s Mark does not convey any particular ingredient, quality, characteristic, function or feature of Applicant’s Goods **in such specificity** to render Applicant’s Mark merely descriptive. The unique combination of the terms “id”, “e”, and “plate” creates a unique commercial impression that is greater than each term alone and of the sum of its parts. See *Association of Co-operative Members, Inc. v. Farmland Industries, Inc.*, 216 USPQ 361 (5th Cir. 1982).

Additionally, the **immediate idea** concerning the ingredients, qualities, characteristics, functions or features of the services must be conveyed with **particularity**. *Plus Products v. Medical Modalities Associates, Inc.*, 21 USPQ 1119, 1203-1205 (TTAB 1981). Applicant’s Mark

does NOT inform consumers as to the field in which Applicant's Goods may fit, and Applicant's Mark does NOT convey Applicant's Goods to the relevant consumer with the required amount of particularity to be considered merely descriptive. See *In re Reynolds Metal Co.*, 178 USPQ 296, 296 (CCPA 1973) (reversing the TTAB in allowing registration of "BROWN-N-BAG" for cooking bags).

The record shows that competitors of Applicant do **NOT** use Applicant's Mark to describe their similar goods. See, e.g., *In re Minnetoka*, 3 USQP2d 1712 (TTAB 1987) (holding that term "softsoap" was not generic, based at least in part on the finding that "there exists a fairly substantial number of competitors in the business of selling liquid soap ... [and] none of these competitors uses the term 'soft soap' descriptively, generically, or otherwise."). The Examiner supplied no trademark usages of "IDePLATE" for use in connection with goods that are equivalent to Applicant's goods or, indeed, any goods. Applicant also is not aware of a single competitor that promotes its goods as "IDePLATE". This **lack of use** of the mark by competitors also can be used to help elucidate whether a mark is descriptive or suggestive. See, e.g., *In re Failure Analysis Associates*, 1 USPQ2d (TTAB 1986). If other competitors are not using the mark descriptively, this is strong evidence that the mark is not descriptive. See *Firestone Tire & Rubber Co. v. Goodyear Tire & Rubber Co.*, 186 USPQ 557 (TTAB 1975) (others not using the mark descriptively is strong evidence that the mark is not descriptive); see also *In re Dollar-A-Day Rent-A-Car Systems, Inc.*, 173 USPQ 1972 (no descriptive use by others is a strong argument that the mark is not descriptive).

In the present case, as no one has even attempted to register a mark consisting of Applicant's Mark in connection with any goods or services, let alone the same or related goods, this is strong evidence that Applicant's Mark is not merely descriptive. See, USPTO TESS database where a search for "IDePLATE" only turns up Applicant's Mark. As such, the Examiner's initial refusal is deficient in that it does not show that a single competitor promotes its goods under Applicant's Mark. See *In re Failure Analysis Associates, infra* (the absence of

evidence showing competitors used the term “failure analysis associates” supported the finding that the term was not generic).

Under the “imagination test,” one must consider how much imagination on the ordinary buyer’s part is required to cull a direct message from the term about the product or service. *Stix Products, Inc. v. United Merchants & Mfrs., Inc.*, 295 FSupp 479, 160 USPQ 777 (SDNY 1968). The more imagination needed, the more probable the term is properly classified as “suggestive” rather than “descriptive.” Section 1209.01(a) of TMEP states:

Suggestive marks are those which require imagination, thought or perception to reach a conclusion as to the nature of the goods or services . . . Suggestive marks, like fanciful and arbitrary marks, are registrable on the Principal Register without proof of secondary meaning. Thus, a designation does not have to be devoid of all meaning in relation to the goods and services to be registrable.

Applicant’s Mark is suggestive in that it requires imagination, thought, and perception to reach a conclusion as to the nature of Applicant’s Goods, as discussed previously (the “Aha! moment” discussed above). In fact, competitors will not be deprived of the use of the terms “id” or “e” or “plate” to describe their goods or services but “only of the use of the words in combination as would be likely to confuse” consumers. *In re Reynolds Metal Co.*, 178 USPQ at 297. Thus, competitors merely will be precluded from using a combination of words and/or terms in a manner confusingly similar to Applicant’s Mark. See also, *Pacific Industries, Inc. v. Minnesota Mining and Manufacturing Co.*, 425 F2d 1265, 165 USPQ 631 (CCPA 1970) (“IMPACT” for carbonless transfer paper allowed registration); *In re Automatic Radio Manufacturing Co.*, 404 F2d 1391, 160 USPQ 223 (CCPA 1969) (“AUTOMATIC RADIO” for radios allowed registration); *In re Realistic Co.*, 169 USPQ 610 (CCPA 1971) (“CURV” for permanent wave solution allowed registration).

As a final rhetorical note, if Applicant's Mark is merely descriptive of Applicant's Goods, then why were Registrant's Mark and the Prior Pending Application (which was allowed during prosecution) not also considered merely descriptive?

Applicant's Mark is an incongruous term combination that would not be grasped by the relevant consumer without some imagination and a mental pause. *In re Shutts*, 217 USPQ 363 (TTAB 1983). Applicant's Mark is a collection and arrangement of terms that results in a suggestive and registrable trademark. As any doubts concerning the descriptiveness of a mark are to be resolved in favor of the Applicant, Applicant respectfully submits that its mark functions as a trademark and is registrable. *In re Micro Instrument Corp.*, 222 USPQ 252, 255 (TTAB 1984); *In re LRC Products Ltd.*, 223 USPQ 1250, 1252 (TTAB 1984).

V. CONCLUSION.

For the above reasons, Applicant respectfully requests that the Board reverse on appeal the Examiner's final refusal to register Applicant's Mark under Sections 2(d) and 9(e)91) of the Trademark Act (15 USC §1052(d) and (e)(1)) as there is no likelihood of confusion between Applicant's Mark and Registrant's Mark and Applicant's mark is not merely descriptive of Applicant's Goods. As such, Applicant's Mark should be allowed registration on the Principal Register pending satisfaction of all remaining requirements for registration.

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