

From: Delaney, Zhaleh

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Subject: U.S. TRADEMARK APPLICATION NO. 79153474 - ARCO - 50314-004TMK - Request for
Reconsideration Denied - Return to TTAB - Message 1 of 5

Attachment Information:

Count: 20

Files: atf-1.jpg, atf-2.jpg, e-1.jpg, e-2.jpg, e2-1.jpg, e2-2.jpg, e3-1.jpg, e3-2.jpg, e3-4.jpg, e4-1.jpg, e4-2.jpg, e6-1.jpg, e6-2.jpg, e7.jpg, e8-1.jpg, e8-2.jpg, e10-1.jpg, e10-2.jpg, e11-1.jpg, 79153474.doc

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

U.S. APPLICATION SERIAL NO. 79153474

MARK: ARCO



CORRESPONDENT ADDRESS:

ANTHONY KING

WPAT, PC

SUITE 510

2301 DUPONT DR

IRVINE CA 92612

GENERAL TRADEMARK INFORMATION:

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

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APPLICANT: Public Joint Stock Company Gazprom neft

CORRESPONDENT'S REFERENCE/DOCKET NO:

50314-004TMK

CORRESPONDENT E-MAIL ADDRESS:

inbox@wpatca.com

REQUEST FOR RECONSIDERATION DENIED

ISSUE/MAILING DATE: 5/16/2016

INTERNATIONAL REGISTRATION NO. 1219549

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. §2.63(b)(3); TMEP §§715.03(a)(ii)(B), 715.04(a). The following refusal made final in the Office action dated July 10, 2015 is maintained and continued to be final: Section 2(d) refusal regarding cited U.S. Registration Numbers 0837783, 1557559, 1559511, 1421446, 1411681, 1411680, 2378072, 1496212, and 1495419. See TMEP §§715.03(a)(ii)(B), 715.04(a).

In the present case, applicant's request has not resolved all the outstanding issue, nor does it raise a new issue or provide any new or compelling evidence with regard to the outstanding issue 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 that the applicant has already filed a timely notice of appeal with the Trademark Trial and Appeal Board, the Board will be notified to resume the appeal. See TMEP §715.04(a).

As to the Section 2(d) refusal, the applicant again argues that its proposed mark, ARCO in slightly stylized form, and the registrant's family of ARCO marks in typed form and stylized form combined with background designs, are "dissimilar in their entireties". In particular, the applicant argues that the respective marks are "not visually similar." The examiner finds this argument unpersuasive. The literal portions of the respective marks are either identical (ARCO vs. ARCO), or highly similar (ARCO vs. ARCO ATF), rendering confusion likely in this instance. The only literal difference among the respective marks is the disclaimed lettering ATF in cited U.S. Registration Number 1559511 which is generic for "automatic transmission fluid", and which cannot obviate the likelihood of confusion. See the attached excerpt from acronymfinder.com in this regard indicating that ATF means "automatic transmission fluid." See also the attached Internet excerpt from Mobileoil.com showing use of ATF to refer to "automatic transmission fluid" in trade: "As with our motor oils, we offer a wide variety of Mobil™ automatic transmission fluids (ATF) for your car. Choose from conventional, synthetic blend and fully synthetic ATFs." Disclaimed matter that is generic for a party's goods, such as ATF in cited U.S. Registration Number 1559511, is typically less significant or less dominant when comparing marks. See *In re Dixie Rests., Inc.*, 105 F.3d 1405, 1407, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997); *In re Nat'l Data Corp.*, 753 F.2d at 1060, 224 USPQ at 752; TMEP §1207.01(b)(viii), (c)(ii). In any event, marks may be confusingly similar in appearance where similar terms, such as ARCO, appear in the compared marks and create a similar overall commercial impression. See *Crocker Nat'l Bank v. Canadian Imperial Bank of Commerce*, 228 USPQ 689, 690-91 (TTAB 1986), *aff'd sub nom. Canadian Imperial Bank of Commerce v. Wells Fargo Bank, Nat'l Ass'n*, 811 F.2d 1490, 1495, 1 USPQ2d 1813, 1817 (Fed. Cir. 1987) (finding COMMCASH and COMMUNICASH confusingly similar); *In re Corning Glass Works*, 229 USPQ 65, 66 (TTAB 1985) (finding CONFIRM and CONFIRMCELLS confusingly similar); *In re Pellerin Milnor Corp.*, 221 USPQ 558, 560 (TTAB 1983) (finding MILTRON and MILLTRONICS confusingly similar); TMEP §1207.01(b)(ii)-(iii). In that the respective marks all create the same overall commercial impression of an ARCO brand, confusion is likely.

While it is true that the applicant's proposed mark does not feature a design element whereas some of the registrant's marks do feature design elements, this factor does not obviate the stated refusal. As previously indicated, for composite marks containing both words and a design, the word portion is generally more likely to be impressed upon a purchaser's memory as it is used when requesting the goods or service in trades. *Joel Gott Wines, LLC v. Rehoboth Von Gott, Inc.*, 107 USPQ2d 1424, 1431 (TTAB 2013) (citing *In re Dakin's Miniatures, Inc.*, 59 USPQ2d 1593, 1596 (TTAB 1999)); TMEP §1207.01(c)(ii). Thus, although such marks must be compared in their entireties, the word portion is often considered the dominant feature and is accorded greater weight in determining whether marks are confusingly similar, even where the word portion has been disclaimed. *In re Viterra Inc.*, 671 F.3d at 1366, 101 USPQ2d at 1911 (Fed. Cir. 2012) (citing *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 1570-71, 218 USPQ2d 390, 395 (Fed. Cir. 1983)). Accordingly, the design elements shown in cited U.S. Registration Numbers 1557559, 1411681, 1411680, 2378072, and 1495419 do not obviate the likelihood of confusion. This is particularly true in that the design elements shown in these cited marks are essentially carriers for the distinctive element common to all of the respective marks, i.e. ARCO.

The applicant made no arguments regarding the similarity of the respective goods. However, as previously indicated, the respective goods are either identical (gasoline, lubricating oils, including motor oil, and transmission fluid), or highly similar, and likely to interest the same end consumer rendering confusion likely in this instance. For example, the same consumer interested in the applicant's power steering fluid, antifreeze and brake fluid is also likely to be interested in the registrant's automatic transmission fluids and lubricating fluids, all presumably for vehicular use. When goods all offered under an ARCO name in trade are encountered by the same end consumer, confusion is likely. In fact, confusion is particularly likely in that the respective non-identical goods emanate from the same sources in trade. See the Internet evidence already of record in this regard. The applicant's attention is now drawn to further Internet evidence attached in this regard. For example, see the attached Internet excerpt regarding Schaefferiol brand fuel additives, transmission fluids and engine oils in trade. See also the attached Internet excerpt regarding Chevron brand coolants, fuel additives and motor oils in trade. See also the attached Internet excerpt regarding Prolong brand fuel additives and oils in trade, among others.

The applicant also made no arguments regarding the similarity of the respective services.

As previously stated, the respective services are either identical (i.e. the applicant's and the registrant's refueling services for vehicles), presumed identical (i.e. the registrant's motor vehicle service station services presumably include the applicant's automobile lubrication and greasing services), or highly related (i.e. the applicant's refueling services and the registrant's distributorships featuring fuel), rendering confusion likely. See the Internet evidence already of record in this regard indicating that service stations such as the registrant's typically offer automotive maintenance services such as the

applicant's in trade, i.e. vehicle greasing and lubrication services. Moreover, the Internet evidence already of record indicates that those that provide fueling services also distribute fuel in trade. See additional Internet evidence now attached in this regard. For example, see the attached Internet excerpt regarding Osco fueling and fuel distributorship service. See also the attached Internet excerpts regarding SC Fuels offering fueling and fuel distributorship services, in addition to lubricating oils, transmission fluids, fuel additives, antifreeze and gasoline. See also the attached Internet excerpts regarding Richard Oil and Fuel offering fueling and fuel distribution services, in addition to fuel, lubricants and coolants in trade. See also the attached Internet excerpt regarding Cardell's fueling and fuel distribution services, in addition to Cardell brand fuels, fuel additives, lubricants, coolants. Finally, the evidence already of record establishes a cross over between vehicular and aircraft fueling services rendering confusion on this basis additionally likely as previously indicated.

Please note that the overriding concern is not only to prevent buyer confusion as to the source of the goods and 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, 1026 (Fed. Cir. 1988).

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Rank	Abbr.	Meaning	
	ATF	Bureau of Alcohol, Tobacco, Firearms and Explosives (US Department of Justice)	
	ATF	Bureau of Alcohol, Tobacco and Firearms	
	ATF	Alabama Tobacco Farm	

ATF	Automatic Transmission Fluid	
ATF	Alcohol, Tobacco & Firearms	
ATF	Activating Transcription Factor	
ATF	After the Fact	
ATF	Armored Task Force (warfare game simulation)	
ATF	AJAX Toolkit Framework	
ATF	Aviation Turbine Fuel	
ATF	ASEAN Tourism Forum (annual travel convention)	
ATF	After the Fire (Band)	
ATF	Acquire the Fire	
ATF	Advanced Tactical Fighter	
ATF	After the Fall	
ATF	All Time Favorite	
ATF	All-Time Favorite	
ATF	Fleet Ocean Tug	
ATF	Above The Fold (web/print advertising)	
ATF	Association des Tunisiens en France (French: Association of Tunisians in France)	
ATF	Amphibious Task Force	
ATF	Arab Thought Forum (Palestine)	
ATF	As Trustee for (finance)	
ATF	American Type Foundry	



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February 29th, 2016



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February 2nd, 2016



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The highest specification fully synthetic technology lubricant designed to meet multiple OEMs requirement and recommended for all high performance gasoline engine cars equipped with direct-injection, multi-valve & turbo-charger technologies.

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semi-synthetic oils

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QUARTZ 7000 FUTURE GF5 5W30



QUARTZ 7000 SN 10W40





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Total Fluide LDS Hydraulic synthetic oil for Citroen hydroactive 3 suspension systems.

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Oil & Fuel Additives



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Premium Performance



SWEPKO 503
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A dirty fuel system causes poor fuel



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