

Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	85122365
LAW OFFICE ASSIGNED	LAW OFFICE 104
MARK SECTION (no change)	
ARGUMENT(S)	
Please see the actual argument text attached within the Evidence section.	
EVIDENCE SECTION	
EVIDENCE FILE NAME(S)	
ORIGINAL PDF FILE	evi_67132198254-214636375_.Request_for_Reconsideration_-_PERSONAL_SOUND_.pdf
CONVERTED PDF FILE(S) (6 pages)	\\TICRS\EXPORT11\IMAGEOUT11\851\223\85122365\xml17\RFR0002.JPG
	\\TICRS\EXPORT11\IMAGEOUT11\851\223\85122365\xml17\RFR0003.JPG
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ORIGINAL PDF FILE	evi_1-67132198254-214636375_.Notice_of_Appeal_PERSONAL_SOUND.pdf
CONVERTED PDF FILE(S) (3 pages)	\\TICRS\EXPORT11\IMAGEOUT11\851\223\85122365\xml17\RFR0008.JPG
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	\\TICRS\EXPORT11\IMAGEOUT11\851\223\85122365\xml17\RFR0010.JPG
DESCRIPTION OF EVIDENCE FILE	Submitted evidence consists of argument and attached copy of Notice of Appeal

GOODS AND/OR SERVICES SECTION (current)	
INTERNATIONAL CLASS	009
DESCRIPTION	
Assistive listening devices not for medical purposes, namely earphones, headphones, headphones having an attached lanyard, microphones, personal headphones for sound transmitting apparatuses and systems	
FILING BASIS	Section 1(b)
GOODS AND/OR SERVICES SECTION (proposed)	
INTERNATIONAL CLASS	009
TRACKED TEXT DESCRIPTION	
Assistive listening devices not for medical purposes, namely earphones, headphones, headphones having an attached lanyard, microphones, personal headphones for sound transmitting apparatuses and systems; Assistive listening devices not for medical purposes, namely earphones, headphones, headphones having an attached lanyard, microphones	
FINAL DESCRIPTION	
Assistive listening devices not for medical purposes, namely earphones, headphones, headphones having an attached lanyard, microphones	
FILING BASIS	Section 1(b)
ADDITIONAL STATEMENTS SECTION	
SUPPLEMENTAL REGISTER	The applicant seeks registration of the mark on the Supplemental Register (i.e., a change of the words 'Principal Register' to 'Supplemental Register'). NOTE: The applicant has separately filed an Allegation of Use, to change the basis of this application from Section 1(b), intent-to-use, to Section 1(a), use in commerce.
NEW CORRESPONDENCE SECTION	
NAME	Raymond J. Kurz
FIRM NAME	Hogan Lovells US LLP
INDIVIDUAL ATTORNEY DOCKET/REFERENCE NUMBER	039239.000004
STREET	555 13th St NW
CITY	Washington
STATE	District of Columbia
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COUNTRY	United States
PHONE	202-637-5600
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EMAIL	DCPTOTrademarkMail@hoganlovells.com
AUTHORIZED EMAIL COMMUNICATION	Yes
SIGNATURE SECTION	
RESPONSE SIGNATURE	/AKS/
SIGNATORY'S NAME	Anna Kurian Shaw
SIGNATORY'S POSITION	Attorney of Record, DC Bar Member
SIGNATORY'S PHONE NUMBER	202-637-5600
DATE SIGNED	02/28/2012
AUTHORIZED SIGNATORY	YES
CONCURRENT APPEAL NOTICE FILED	YES
FILING INFORMATION SECTION	
SUBMIT DATE	Tue Feb 28 22:32:04 EST 2012
TEAS STAMP	USPTO/RFR-67.132.198.254-20120228223204310371-85122365-4902a1480a3ed24743774380628e51eb53-N/A-N/A-20120228214636375314

**Request for Reconsideration after Final Action
To the Commissioner for Trademarks:**

Application serial no. **85122365** has been amended as follows:

ARGUMENT(S)

In response to the substantive refusal(s), please note the following:

Please see the actual argument text attached within the Evidence section.

EVIDENCE

Evidence in the nature of Submitted evidence consists of argument and attached copy of Notice of Appeal has been attached.

Original PDF file:

[evi_67132198254-214636375_. Request for Reconsideration - PERSONAL SOUND .pdf](#)

Converted PDF file(s) (6 pages)

[Evidence-1](#)

[Evidence-2](#)

[Evidence-3](#)

[Evidence-4](#)

[Evidence-5](#)

[Evidence-6](#)

Original PDF file:

[evi_1-67132198254-214636375_. Notice of Appeal PERSONAL SOUND.pdf](#)

Converted PDF file(s) (3 pages)

[Evidence-1](#)

[Evidence-2](#)

[Evidence-3](#)

CLASSIFICATION AND LISTING OF GOODS/SERVICES

Applicant proposes to amend the following class of goods/services in the application:

Current: Class 009 for Assistive listening devices not for medical purposes, namely earphones, headphones, headphones having an attached lanyard, microphones, personal headphones for sound transmitting apparatuses and systems

Original Filing Basis:

Filing Basis: Section 1(b), Intent to Use: The applicant has had a bona fide intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the identified goods and/or services as of the filing date of the application. (15 U.S.C. Section 1051(b)).

Proposed:

Tracked Text Description: ~~Assistive listening devices not for medical purposes, namely earphones, headphones, headphones having an attached lanyard, microphones, personal headphones for sound transmitting apparatuses and systems;~~ [Assistive listening devices not for medical purposes, namely earphones, headphones, headphones having an attached lanyard, microphones](#)

Class 009 for Assistive listening devices not for medical purposes, namely earphones, headphones, headphones having an attached lanyard, microphones

Filing Basis: Section 1(b), Intent to Use: The applicant has a bona fide intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the identified goods and/or services as of the filing date of the application. (15 U.S.C. Section 1051(b)).

CORRESPONDENCE ADDRESS CHANGE

Applicant proposes to amend the following:

Proposed:

Raymond J. Kurz of Hogan Lovells US LLP, having an address of 555 13th St NW Washington, District of Columbia 20004

United States
DCPTOTrademarkMail@hoganlovells.com
202-637-5600
202-637-5910
The attorney docket/reference number is 039239.000004.

ADDITIONAL STATEMENTS

Supplemental Register

The applicant seeks registration of the mark on the Supplemental Register (i.e., a change of the words 'Principal Register' to 'Supplemental Register'). NOTE: The applicant has separately filed an Allegation of Use, to change the basis of this application from Section 1(b), intent-to-use, to Section 1(a), use in commerce.

SIGNATURE(S)

Request for Reconsideration Signature

Signature: /AKS/ Date: 02/28/2012
Signatory's Name: Anna Kurian Shaw
Signatory's Position: Attorney of Record, DC Bar Member

Signatory's Phone Number: 202-637-5600

The signatory has confirmed that he/she is an attorney who is a member in good standing of the bar of the highest court of a U.S. state, which includes the District of Columbia, Puerto Rico, and other federal territories and possessions; and he/she is currently the applicant's attorney or an associate thereof; and to the best of his/her knowledge, if prior to his/her appointment another U.S. attorney or a Canadian attorney/agent not currently associated with his/her company/firm previously represented the applicant in this matter: (1) the applicant has filed or is concurrently filing a signed revocation of or substitute power of attorney with the USPTO; (2) the USPTO has granted the request of the prior representative to withdraw; (3) the applicant has filed a power of attorney appointing him/her in this matter; or (4) the applicant's appointed U.S. attorney or Canadian attorney/agent has filed a power of attorney appointing him/her as an associate attorney in this matter.

The applicant is filing a Notice of Appeal in conjunction with this Request for Reconsideration.

Mailing Address: Raymond J. Kurz
Hogan Lovells US LLP
555 13th St NW
Washington, District of Columbia 20004

Serial Number: 85122365
Internet Transmission Date: Tue Feb 28 22:32:04 EST 2012
TEAS Stamp: USPTO/RFR-67.132.198.254-201202282232043
10371-85122365-4902a1480a3ed247437743806
28e51eb53-N/A-N/A-20120228214636375314

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Able Planet, Incorporated

Mark: PERSONAL SOUND

Application Serial No.: 85/122,365

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

Attn: Verna B. Ririe
Trademark Attorney
Law Office 104

REQUEST FOR RECONSIDERATION

Dear Examiner Ririe:

AMENDMENT – RELEVANT TO ARGUMENT

Please amend the above-entitled Application to the Supplemental Register and replace the words "Principal Register" with the words "Supplemental Register."

Further, please amend the identification of goods and services to read as follows:

Assistive listening devices not for medical purposes, namely earphones, headphones, headphones having an attached lanyard, microphones in International Class 9

RESPONSE

Applicant, Able Planet Incorporated ("Able Planet") hereby responds to the Office Action dated August 28, 2011, in which the U.S. Patent and Trademark Office refused registration of the PERSONAL SOUND Mark ("Applicant's Mark") on the Principal Register.

I. MARK IS MERELY DESCRIPTIVE – 2(e)(1) Refusal

The Examining Attorney has refused registration of Applicant's Mark on the Principal Register under Trademark Act Section 2(e)(1), 15 U.S.C. Section 1052(e)(1), based upon the descriptiveness of Applicant's Mark. To address this refusal, Applicant now seeks registration of Applicant's Mark on the Supplemental Register as provided in an amendment above. In addition, Applicant now amends the recitation of goods and services as provided above.

II. LIKELIHOOD OF CONFUSION – 2(d) Refusal

The Examining Attorney has further refused registration of Applicant's mark under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d), based upon likelihood of confusion with the PERSONAL 3D SOUND Mark, Reg. No. 3,433,520 ("Cited Mark"), registered on the Supplemental Register. For the reasons set forth below, Applicant respectfully contends that Applicant's Mark is not likely to be confused with the Cited Mark because 1) the Marks are sufficiently dissimilar and 2) as amended, the goods and services offered under Applicant's Mark and the Cited Mark are distinguishable. Further, the Cited Mark is a weak descriptive mark and thereby afforded only a narrow scope of protection.

A. APPLICANT'S MARK AND THE CITED MARK ARE SUFFICIENTLY DISSIMILAR TO AVOID CONSUMER CONFUSION

Under the rule in In re E.I. du Pont de Nemours & Co., 476 F.2d 1357, 177 U.S.P.Q. 563 (C.C.P.A. 1973), when testing for likelihood of confusion under Section 2(d), one should consider various factors, including 1) the similarities or dissimilarities of the marks in their entireties as to appearance, sound, connotation and commercial impression and 2) the nature of the goods or services covered by the marks. In analyzing the similarities of sight, sound and meaning between two marks, a court must look to the overall impression created by the marks and not merely compare individual features. General Mills, Inc. v. Kellogg Co., 824 F.2d 622, 3 U.S.P.Q.2d 1442, 1445 (8th Cir. 1987). However, the fact that the marks share the same or similar wording does not mandate a finding of a likelihood of confusion. See, e.g., King Athletic Goods Corporation v. C. Itoh & Co. (America) Inc., 192 U.S.P.Q. 661 (TTAB 1976) (no likelihood of confusion between "SPORT PRO" and "PRO SPORTS"); Application of Ferrero, 479 F.2d 1395 (C.C.P.A. 1973) (no likelihood of confusion between "TIC TAC" and "TIC TAC TOE").

Importantly, where, as here, the common element of two marks consists of descriptive or otherwise “weak” elements of the prior user’s/registrant’s mark courts have refused to find a likelihood of confusion even in cases where the goods and/or services involved are closely related. See, e.g., Champagne Louis Roederer S.A. v. Delicato Vineyards, 148 F.3d 1373 (Fed. Cir. 1998) (“CRISTAL” for champagne not confusingly similar to “CRYSTAL CREEK” for wine); Tektronix, Inc. v. Daktronics, Inc., 187 U.S.P.Q. 588 (TTAB 1975), aff’d 534 F.2d 915, 185 U.S.P.Q. 693 (C.C.P.A. 1976) (marks “TEKTRONIX” and “DAKTRONICS” not confusingly similar due to weakness of suffix “TRONICS” / “TRONIX” in the context of electronic products); Affiliated Hospital Products, Inc. v. Merdel Game Mfg. Co., 513 F.2d 1183, 185 U.S.P.Q. 321 (2d Cir. 1975) (marks “KICK-ER” and “KIK-IT” not confusingly similar due to suggestive nature of term “KICK”/“KIK” in the context of tabletop soccer games; and In re Bed & Breakfast Registry, 791 F.2d 157 (Fed. Cir. 1986) (“BED & BREAKFAST REGISTRY” for making lodging reservations in private homes not likely to be confused with “BED & BREAKFAST INTERNATIONAL” for room booking agency services). More specifically, competitors of parties with weak marks may employ the use of closer marks than they would otherwise be able if faced with a stronger mark. See Sure-Fit Prods. Co. v. Saltzson Drapery Co., 254 F.2d 158, 160, 117 USPQ 295, 296 (CCPA 1958)(“Where a party uses a weak mark, his competitors may come closer to his mark than would be the case with a strong mark without violating his rights.”)

The fact that the Cited Mark is registered on the Supplemental Register is evidence that PERSONAL 3D SOUND is a weak descriptive mark entitled to a lesser scope of protection. See In re Hunke & Jochheim, 185 USPQ 188 (TTAB 1975); In re Texas Instruments, Inc., 193 U.S.P.Q. 678 (T.T.A.B. 1976) (Supplemental Registration is given only a narrow scope of protection; no conflict between COPPER CLAD and design and COPPERCLAD). As such, likelihood of confusion with Applicant’s Mark is reduced. See Colgate-Palmolive Co. v. Carter-Wallace, Inc., 432 F.2d 1400, 1401-02 (C.C.P.A. 1970) (no likelihood of confusion between “PEAK” and “PEAK PERIOD,” where the court found “Peak” “neither a coined nor fanciful nor arbitrary mark . . . simply a common noun or adjectival word of everyday usage in the English language”); Melaro v. Pfizer, Inc., 214 U.S.P.Q. 645, 648 (T.T.A.B. 1982) (no likelihood of confusion between “SILK” and “SILKSTICK”).

Here, the two marks in question are at least as distinguishable from one another as the above noted cases where no likelihood of confusion was found. Applicant's Mark, PERSONAL SOUND, and the Cited Mark, PERSONAL 3D SOUND, both share only the terms "personal" and "sound", which are descriptive as used by registrant of the Cited Mark and the Cited Mark includes the term 3D. Thus, the Cited Mark contains three words as opposed to the two words in Applicant's Mark. As a result, Applicant's Mark and the Cited Mark vary in both sound and appearance. See, e.g., Lederman Bonding Co. v. Sweetalia, 2006 WL 2949290, at 4 (D.Colo. 2006) (extra word "release" resulted in lack of similarity between "Speedy Bail Bonds" and "Speedy Release Bail Bonds"); see also First Sav. Bank, F.S.B. v. FirstBank Sys., 101 F. 3d 645, 650 (10th Cir. 1996) ("As to pronunciation, 'First Bank System' contains an additional word, and to that extent is pronounced differently than FirstBank.) The term 3D also adds a layer of meaning that is absent in Applicant's Mark. Given the weak descriptive nature of the Cited Mark, these differences should be sufficient to avoid consumer confusion. However, evaluation of the marks themselves is not the sole, definitive part of the likelihood of confusion analysis. The next inquiry is whether contemporaneous use of Applicant's Mark and the Cited Mark with the identified goods and services will cause confusion to an average consumer.

B. THE GOODS AND SERVICES MARKETED UNDER APPLICANT'S MARK AND THE CITED MARK ARE DISTINGUISHABLE

According to the Trademark Manual of Examining Procedure, "[i]f the goods or services in question are not related or marketed in such a way that they would be encountered by the same persons in situations that would create the incorrect assumption that they originate from the same source, then, even if the marks are identical, confusion is not likely." TMEP §1207.01(a)(i). As such, even a finding of identical marks and somewhat related goods and services, does not mandate a finding of likelihood of confusion. For example, in Harlem Wizards Entertainment Basketball, Inc. v. NBA Properties, Inc., the court found no likelihood of confusion between a senior user's use of WIZARDS as the name of a Harlem Globetrotters-style basketball team and a junior user's use of the same mark for an NBA team. 952 F. Supp. 1084 (D. N.J. 1997); see also, Sunenblick v. Harrell, 895 F. Supp. 616 (S.D.N.Y. 1995), aff'd 101 F.3d 684 (2d Cir. 1996), cert. denied, 519 U.S. 964 (1996) (no likelihood of confusion between jazz records and hip-hop records sold under UPTOWN RECORDS); Allstate Ins. Co. v. Allstate Inv.

Corp., 210 F. Supp. 25 (W.D. La. 1962), aff'd 328 F.2d 608 (5th Cir. 1964) (no likelihood of confusion between ALLSTATE for insurance and ALLSTATE for mortgage brokerage); Heartsprings, Inc. v. Heartspring, Inc., 143 F.3d 550 (10th Cir. 1998) (no likelihood of confusion between HEARTSPRINGS for educational materials and HEARTSPRING for residential school for disabled children); and Knaack Mfg. Co. v. Rally Accessories, Inc., 955 F. Supp. 991, (N.D. Ill. 1997) (no likelihood of confusion between WEATHERGUARD for tool boxes and storage equipment for vehicles and WEATHERGUARD for fitted fabric auto covers). Here, the amendment of Applicant's recitation of goods and services to remove "personal headphones for sound transmitting apparatuses and systems" and the Applicant's focus on consumers who require hearing assistance support a finding that confusion as to the source of goods marketed under Applicant's Mark and the Cited Mark is not likely.

The goods offered under Applicant's Mark, as amended, are limited to assistive listening devices and focused on consumers who require hearing assistance. Thus, the goods differ from those of the Cited Mark. As amended, Applicant's Mark covers "assistive listening devices not for medical purposes, namely earphones, headphones, headphones having an attached lanyard, and microphones." Thus, the goods of Applicant's Mark provide enhanced sound for persons requiring hearing assistance. By contrast, the goods of the Cited Mark cover "apparatus for recording, transmission or reproduction of sound; [a]pparatus for transmitting and reproducing sound; [a]udio speakers; [c]omputer software to control and improve computer audio sound quality' [d]igital audio players; electric audio playback units with lights and speakers; [p]ersonal headphones for use with sound transmitting systems; [s]oftware to control and improve audio equipment sound quality." The goods associated with the Cited Mark focus on recording and transmission of recorded sound, but do not address the needs of those who seek hearing assistance. Thus, as discussed above, the goods and services covered by the Applicant's Mark differ from those covered by the Cited Mark such that their sources are not likely to be confused.

Refusal of registration under Trademark Act Section 2(d) is not appropriate in this case because the Trademark Act supports refusal of registration only when confusion is likely, not when there is the "mere theoretical possibility" of confusion. *In re Massey-Ferguson, Inc.*, 222 U.S.P.Q. 367, 368 (TTAB 1983). Here, the differences in the marks, the goods and the

inherent weakness of the Cited Mark, when taken together weigh heavily against consumer confusion between Applicant's Mark and the Cited Mark.

CONCLUSION

Because the Examiner's objections have been met, Applicant respectfully requests that the Examining Attorney allow Applicant's Mark to proceed towards registration on the Supplemental Register. A Notice of Appeal to the Trademark Trial and Appeal Board is being filed concurrently herewith and is attached at Exhibit A. Further, an Amendment of Use is being filed concurrently.

Respectfully submitted,

By: _____

Raymond Kurz
Anna Kurian Shaw
Hogan Lovells US LLP
555 13th St, NW
Washington D.C. 20004
(202) 637-5600

Attorney for Applicant,
Able Planet, Incorporated

Date: February 28, 2012

Exhibit A

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

Applicant:	Able Planet Incorporated	:	
Application Serial No.:	85/122,365	:	Trademark Law Office 104
Filing Date of Application:	September 2, 2010	:	Trademark Attorney Ririe
Mark:	PERSONAL SOUND	:	

NOTICE OF APPEAL TO THE TRADEMARK TRIAL AND APPEAL BOARD

Dear Sir or Madam:

Applicant, Able Planet, Incorporated, hereby appeals to the Trademark Trial and Appeal Board from the decision of the U.S. Patent and Trademark Office ("PTO") Examining Attorney refusing registration of the above-referenced mark, which decision was mailed on August 28, 2011.

Applicant has filed a request for reconsideration of the final refusal, and requests suspension of the appeal pending consideration of the request by the Examining Attorney.

The undersigned hereby authorizes the PTO to debit Deposit Account No. XXXXX, for the requisite fee of \$100 under 37 CFR § 2.6(a)(6) and reference our client number, 039239.000004. In the event the fee is insufficient, please debit our deposit account for the difference.

Respectfully submitted,

Date: February 28, 2012

By: _____
Raymond Kurz
Anna Kurian Shaw
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