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

Proceeding	85192690
Applicant	TPK U.S.A., LLC
Applied for Mark	TRU TOUCH MONITOR
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: TPK USA LLC

Examining Attorney: James B. Lovelace

Mark: TRU TOUCH MONITOR

Law Office: 119

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

EX PARTE APPEAL

APPLICANT'S REPLY BRIEF

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DESCRIPTION OF RECORD

A. PROSECUTION HISTORY

The Application was initially refused on March 15, 2011 via a nonfinal office action (the “March 2011 Office Action”) on the ground that a likelihood of confusion between Applicant’s mark and prior pending applications. Applicant filed a response on August 24, 2011 addressing issues. The Examining Attorney issued a suspension notice on August 25, 2011 indicating that action on the application would be suspended until the earlier-filed reference application is either registered or abandoned. The Examiner issued an office action on September 26, 2012 refusing registration. Applicant sought reconsideration via submission dated March 26, 2013. The Examining Attorney issued a final office action on April 15, 2013 refusing registration under Section 2(d) – likelihood of confusion. Applicant filed a Notice of Appeal on October 15, 2013. Trademark Examiner filed the Examiner’s Brief on February 21, 2014.

ARGUMENT

THE MARKS OF APPLICANT AND REGISTRANT ARE NOT HIGHLY SIMILAR, AND THE GOODS DESCRIBED IN THE APPLICATION AND REGISTRATION ARE DIFFERENT, SUCH THAT THERE IS NO LIKELIHOOD OF CONFUSION UNDER SECTION 2(d) OF THE TRADEMARK ACT.

I. LEGAL STANDARD

It is a general rule that likelihood of confusion regarding additions or deletions to marks may arise if the marks in their entireties convey significantly different commercial impressions. See, e.g., *Shen Manufacturing Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 73 USPQ2d 1350 (Fed. Cir. 2004)

(RITZ and THE RITZ KIDS create different commercial impressions); In re Farm Fresh Catfish Co., 231 USPQ 495 (TTAB 1986) (CATFISH BOBBERS (with "CATFISH" disclaimed) for fish held not likely to be confused with BOBBER for restaurant services); In re Shawnee Milling Co., 225 USPQ 747 (TTAB 1985) (GOLDEN CRUST for flour held not likely to be confused with ADOLPH'S GOLD'N CRUST and design (with "GOLD'N CRUST" disclaimed) for coating and seasoning for food items); In re S.D. Fabrics, Inc., 223 USPQ 54 (TTAB 1984) (DESIGNERS/FABRIC (stylized) for retail fabric store services held not likely to be confused with DAN RIVER DESIGNER FABRICS and design for textile fabrics). TMEP 1207.01(b)(iii).

II. Trademark Examiner's Arguments

Trademark Examiner states that marks are substantially similar.

US Registration No. 3944837 TRUETOUCH

Trademark Examining Attorney states that it is appropriate to give less weight to the term "MONITOR" because it merely identifies a type of good sold by applicant and has been disclaimed in the application. However, the Examiner does not cite any case showing that disclaiming a word should be a factor in determining to give less weight to the disclaimed term. As a matter of fact the case law is in contrary to what the Examiner states. For example see, In re Farm Fresh Catfish Co., 231 USPQ 495 (TTAB 1986) (CATFISH BOBBERS (with "CATFISH" disclaimed) for fish held not likely to be confused with BOBBER for restaurant services). In that case, TTAB did not place less weight to the word CATFISH just because it was disclaimed. Likewise see In re Shawnee Milling Co., 225 USPQ 747 (TTAB 1985) (GOLDEN CRUST for flour held not likely to be confused with ADOLPH'S GOLD'N CRUST and design (with "GOLD'N CRUST" disclaimed) for coating and seasoning for food items), In re S.D. Fabrics, Inc., 223 USPQ 54 (TTAB 1984)

(DESIGNERS/FABRIC (stylized) for retail fabric store services held not likely to be confused with DAN RIVER DESIGNER FABRICS and design for textile fabrics), e.g., Shen Manufacturing Co. v. Ritz Hotel Ltd., 393 F.3d 1238, 73 USPQ2d 1350 (Fed. Cir. 2004) (RITZ and THE RITZ KIDS create different commercial impressions).

US Registration Nos. 4181663 TRU (standard characters) and 4188770 (stylized)

Trademark Examining Attorney states that “Applicant’s mark “TRUE TOUCH MONITOR” is also substantially similar to the registered marks “TRU” in both standard characters and stylized lettering because the dominant and recognizable portion of applicant’s mark is the word “TRU” which is identical to the dominant and recognizable portion of the registered mark.”

The fundamental rule is that the marks must be considered in their entireties. See *Massey Junior College, Inc. v. Fashion Institute of Technology*, 492 F.2d 1399, 181 USPQ 272 (C.C.P.A. 1974).

The Court of Appeals for the Federal Circuit has cautioned, however, that "[t]here is no general rule as to whether letters or designs will dominate in composite marks; nor is the dominance of letters or design dispositive of the issue." *In re Electrolyte Laboratories Inc.*, 929 F.2d 645, 647, 16 USPQ2d 1239, 1240 (Fed. Cir. 1990) (K+ and design for dietary potassium supplement held not likely to be confused with K+EFF (stylized) for dietary potassium supplement).

The comparison of composite marks must be done on a case-by-case basis without reliance on mechanical rules of construction. See, e.g., *Spice Islands, Inc. v. The Frank Tea & Spice Co.*, 505 F.2d 1293, 184 USPQ 35 (C.C.P.A. 1974) (SPICE TREE and tree design held not confusingly similar to SPICE ISLANDS and tree design, both for spices).

Here, Trademark Examiner suggests to place more weight on the word "TRU" as a dominant and recognizable portion of Applicant's mark. As Federal Circuit stated in re Electrolyte Laboratories Inc., there is no general rule as to whether letters or designs will dominate in composite marks.

Applicant's mark is a design mark that would be easily distinguished by public from the mark "TRU". Furthermore as discussed supra, it is improper to give less weight to words "TOUCH MONITOR".

Trademark Examiner states that Applicant's and Registrants' goods are legally identical in part and otherwise closely related. Specifically Examiner states that Applicant's "computer screens" are legally identical to the various type of screens used in connection with the registered mark. Examiner further states that Applicant has provided no evidence to support the contention that touch monitors and touch screens are different products." Applicant hereby provides the evidence that "computer screen" definition in dictionary.com is a screen used to display the output of a computer to the user. The definition of a touch screen is a touch sensitive display screen. See www.dictionary.com. These two components are different from each other. Touch screens are different components and placed on computer screens or incorporated in computer screens so that human machine interface can be accomplished by touching the screen.

US Registration Nos. 4181663 TRU (standard characters) and 4188770 (stylized)

Examiner states that applicant's "computer software, namely, game engine software for video game development and operation" is legally identical to the registrant's "computer games software; software incorporating computer games; software incorporating computer games for mobile phones."

If it appears that confusion may be likely as a result of the contemporaneous use of similar marks by the registrant and the applicant with the identified goods or services, the next step is to evaluate the marks themselves, in relation to the goods and services. Under *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973), the first factor requires examination of "the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression." The test of likelihood of confusion is not whether the marks can be distinguished when subjected to a side-by-side comparison, but whether the marks are sufficiently similar that there is a likelihood of confusion as to the source of the goods or services. When considering the similarity of the marks, "[a]ll relevant facts pertaining to the appearance and connotation must be considered." *Recot, Inc. v. M.C. Becton*, 214 F.3d 1322, 1329, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000). In evaluating the similarities between marks, the emphasis must be on the recollection of the average purchaser who normally retains a general, rather than specific, impression of trademarks. *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975).

Here, marks are not similar as discussed supra. As a result even if the goods are similar, there will be no likelihood of confusion.

CONCLUSION

For all the foregoing reasons and the reasons submitted with the appeal brief, Applicant respectfully submits that the Examining Attorney has failed to meet his burden to demonstrate that Applicant's mark TRU TOUCH MONITOR and other registered marks would cause 'probable' confusion. Applicant respectfully requests that the grant this Ex Parte Appeal and allow the registration of Applicant's mark TRU TOUCH MONITOR on the Principal Register.

Respectfully submitted,

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Dated: April 16, 2013

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