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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: 117

Serial No: 85192690

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

**EX PARTE APPEAL**

**APPLICANT'S 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.

### **B. EXAMINING ATTORNEY’S EVIDENCE**

The Examining Attorney appended 36 attachments to the April 2013 Office Action. These documents consist of registration records of other marks and screen shots from Internet websites. Some of these documents are not referred to specifically in the Office Action.

### **C. APPLICANT’S EVIDENCE**

Applicant did not present any evidence.

## ARGUMENT

### I. LEGAL STANDARD

Registration for a mark should not be refused in view of all similar registered marks, but only on the basis of those similar marks to create a likelihood of confusion or mistake on the part of the purchasing public. See T.M.E.P. § 1207.01. In applying the relevant factors to the instant case, the difference between Applicant's mark and registered marks and the difference between the goods and goods offered under the cited marks in the context of actual use, are more than sufficient to preclude a likelihood of confusion.

Likelihood of confusion "is synonymous with 'probable' confusion -it is not sufficient if confusion is merely possible." Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 23:3 (4th ed. 2006). The Court of Appeals for the Federal Circuit has stated that, "we are not concerned with mere theoretical possibilities of confusion, deception, or mistake or with de minimis situations but with the practicalities of the commercial world, with which the trademark law deals." *Elec. Design & Sales Inc. v. Elec. Data Sys. Com.*, 21 U.S.P.Q.2d 1388, 1391 (Fed. Cir. 1992) (quoting *Witco Chem. Co. v. Whitfield Chem. Co.*, 164 U.S.P.Q. 43, 44-45 (C.C.P.A. 1969)). In this case, it appears that the Examining Attorney's refusal is based on a merely theoretical possibility of a likelihood of confusion. See also *Signetics Com. v. Sigona*, 212 U.S.P.Q. 318, 320 (T.T.A.B. 1981) ("[W]hile confusion may be possible, it does not seem to us to be likely. Unfortunately for opposer's case, likelihood, not possibility, is the test that we are required under the Trademark Act to apply."); *Phoenix Closures Inc. Yen Shaing Corn. Ltd.*, 9

U.S.P.Q.2d 1891, 1894 (T.T.A.B. 1988) ("While it is theoretically possible for opposer's mark PHOENIX to be affixed to [its goods] in [a] manner such that it would be visible to an ultimate purchaser of [applicant's goods], this Board will not base a finding of likelihood of confusion upon such theoretical possibilities."); *Streetwise Maps Inc. v. VanDam Inc.*, 48

**PTO HAS FAILED TO ESTABLISH A LEGAL OR EVIDENTIARY BASIS FOR FINDING APPLICANTS MARK AND THE MARK "TRUE TOUCH" WOULD CAUSE LIKELIHOOD OF CONFUSION**

A. Examining Attorney's refusal is based on a merely theoretical possibility of a likelihood of confusion

Registration for a mark should not be refused in view of all similar registered marks, but only on the basis of those similar marks to create a likelihood of confusion or mistake on the part of the purchasing public. See T.M.E.P. § 1207.01. In applying the relevant factors to the instant case, the difference between Applicant's goods and goods offered under the cited marks in the context of actual use, are more than sufficient to preclude a likelihood of confusion. Likelihood of confusion "is synonymous with 'probable' confusion -it is not sufficient if confusion is merely possible." Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 23:3 (4th ed. 2006). The Court of Appeals for the Federal Circuit has stated that, "we are not concerned with mere theoretical possibilities of confusion, deception, or mistake or with de minimis situations but with the practicalities of the commercial world, with which the trademark law deals." *Elec. Design & Sales Inc. v. Elec. Data Sys. Com.*, 21 U.S.P.Q.2d 1388, 1391 (Fed. Cir. 1992) (quoting *Witco Chern. Co. v. Whitfield Chern. Co.*, 164 U.S.P.Q. 43, 44-45 (C.C.P.A. 1969).

In this case, it appears that the Examining Attorney's refusal is based on a merely theoretical possibility of a likelihood of confusion. See also *Signetics Com. v. Sigona*, 212 U.S.P.Q. 318, 320 (T.T.A.B. 1981) ("[W]hile confusion may be possible, it does not seem to us to be likely. Unfortunately for opposer's case, likelihood, not possibility, is the test that we are required under the Trademark Act to apply."); *Phoenix Closures Inc. Yen Shaing Corn. Ltd.*, 9 U.S.P.Q.2d 1891, 1894 (T.T.A.B. 1988) ("While it is theoretically possible for opposer's mark PHOENIX to be

affixed to [its goods] in [a] manner such that it would be visible to an ultimate purchaser of [applicant's goods], this Board will not base a finding of likelihood of confusion upon such theoretical possibilities."); *Streetwise Maps Inc. v. VanDam Inc.*, 48.

To support a conclusion that two marks are confusingly similar, the goods specified in the application must be related to the goods listed in the cited registration, such that consumers would be confused about the source of origin. See T.M.E.P. § 1207.01(a)(i). If the goods are not related or marketed in such a way that they would be encountered by the same people in situations that would create the incorrect assumption that they originate from the same source, then there is no likelihood of confusion, even if the marks are identical. Applicant's touch monitor is not sufficiently related to the "touch screen" listed under the cited mark as to likely cause confusion. They are two different goods with two different functionalities.

#### B. Applicant's Goods are Dissimilar to Registrants' Goods

TTAB and the Federal courts decisions indicate that there should be no "per se" rule when it comes to determining likelihood of confusion. Determining that goods in the same general field and bearing the same mark are so similar or related that confusion as to origin is likely is contrary to the trademark law. See *Interstate Brands v. Celestial Seasonings*, 576 F.2d 926, 928, 198 U.S.P.Q. 157 (C.C.P.A. 1978) (finding no "per se" rule that the use of the same mark on different food items); *In re The Shoe Works, Inc.*, 6 U.S.P.Q.2d 1890, 1891 (T.T.A.B. 1990) (finding no "per se" rule that the use of the same mark on different items of wearing apparel is likely to cause confusion). "There is no likelihood of confusion where the potential for confusion is a mere possibility, not a probability." *Castle Oil Com. v. Castle Energy Com.*, 26 U.S.P.Q.2d 1481, (E.D.Pa. 1992) (citing *Electronic Data Sales, Inc. v. Electronic Data Sys.*, 954 F.2d 713, 21 U.S.P.Q.2d 1388, 1393 (Fed.Cir. 1992)).

In this case, the Examining Attorney has provided no evidence that transposes the "mere possibility" that there is a likelihood of confusion between the marks into a "probability." In

applying the relevant factors to the instant case, the difference between the goods and the context of actual use, are more than sufficient to preclude a likelihood of confusion because Applicant's goods are display devices. Registered mark is used for touch screens and touch monitors are not listed as goods in the registered mark. Touch monitors and touch screens are two different products and it is very easy to differentiate these products from each other.

### C. The Marks Are Dissimilar In Appearance and Sound and Have Different Commercial Impressions

Consumers will recognize the differences between the marks and will be able to distinguish between the marks TRU TOUCH MONITOR and the mark TRUE TOUCH. TRUE TOUCH MONITOR is suggestive of touch monitor, while TRUE TOUCH is not suggestive of touch monitor.

TMEP Section 1207.01(b)(v) states that "even marks that are identical in sound and/or appearance may create sufficiently different commercial impressions when applied to the respective parties' goods so that there is no likelihood of confusion." *Id.* In this case, the marks are not identical as the marks do not include the same second word. A consumer viewing the trademarks would not confuse Applicant's mark for the cited mark as Applicant's mark evokes images of touch monitor while Registrants' mark bring to mind touch not a monitor.

### **PTO HAS FAILED TO ESTABLISH A LEGAL OR EVIDENTIARY BASIS FOR FINDING APPLICANT'S MARK AND THE MARK "DISPLAY SHOPPER", "POINDUS", "METALIST", "NGX" WOULD CAUSE LIKELIHOOD OF CONFUSION**

The April 2013 Office Action listed several registered marks indicating that Applicant's mark would cause likelihood of confusion compared with those marks. Among those marks listed by the Examiner were "DISPLAY SHOPPER", "POINDUS", "METALAST", "NGX".

Marks are compared in their entireties for similarities in appearance, sound, connotation, and commercial impression. In re Viterra Inc., 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (quoting In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973)); TMEP §1207.01(b)-(b)(v). Similarity in any one of these elements may be sufficient to find the marks 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).

In this case, the marks listed by the Examiner, namely, “DISPLAY SHOPPER”, “POINDUS”, “METALAST”, “NGX” are not similar to Applicant’s mark “TRU TOUCH MONITOR” in appearance, sound connotation and commercial impression. Even if these marks used on similar goods and sold in similar channels, there would not be a likelihood of confusion because marks are very different from each other.

**PTO HAS FAILED TO ESTABLISH A LEGAL OR EVIDENTIARY BASIS FOR FINDING APPLICANT’S MARK AND THE MARK “CYBERTOUCH”, “CNTOUCH”, “DELTATOUCH”, “FINGERTOUC**

The Examiner submitted several screen shots of Internet web sites showing marks “CYBERTOUCH”, “CNTOUCH”, “DELTATOUCH”, and “FINGERTOUC”. Although the Examiner has not made a specific argument Applicant asserts that Consumers will recognize the differences between the marks and will be able to distinguish between the marks TRU TOUCH MONITOR and the marks “CYBERTOUCH”, “CNTOUCH”, “DELTATOUCH”, and “FINGERTOUC”. These marks have completely different connotations and create different commercial impressions. TRUE TOUCH MONITOR is suggestive of touch monitor, while “CYBERTOUCH”, “CNTOUCH”, “DELTATOUCH”, and “FINGERTOUC” are not suggestive of touch monitor.

TMEP Section 1207.01(b)(v) states that "even marks that are identical in sound and/or appearance may create sufficiently different commercial impressions when applied to the respective parties' goods so that there is no likelihood of confusion." Id. In this case, the marks are not identical as the marks do not include the same second word. A consumer viewing the trademarks would not confuse Applicant's mark for the cited mark as Applicant's mark evokes images of touch monitor while Registrants' marks bring to mind only touch.

### CONCLUSION

For all the foregoing reasons, 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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