ESTTA Tracking number: **ESTTA557130**
Filing date: **08/30/2013**

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

Proceeding	85528202
Applicant	Grain Audio, LLC
Applied for Mark	GRAIN AUDIO
Correspondence Address	ROBERT W SMITH MCCARTER & ENGLISH LLP 100 MULBERRY STREET, FOUR GATEWAY CENTER NEWARK, NJ 07102-4056 UNITED STATES rsmith@mccarter.com, kgarrone@mccarter.com, dpopovic@mccarter.com
Submission	Reply Brief
Attachments	Applicant's Reply Brief.pdf(912470 bytes)
Filer's Name	Robert W. Smith
Filer's e-mail	rsmith@mccarter.com, kgarrone@mccarter.com, dpopovic@mccarter.com
Signature	/robert w. smith/
Date	08/30/2013

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

In re Application of:

Applicant:	Grain Audio, LLC	Trademark Examining Attorney: Melissa Vallillo
Serial No:	85/528,202	
Filed:	January 30, 2012	Law Office 113
Trademark:	GRAIN AUDIO	

APPLICANT'S REPLY BRIEF

Robert W. Smith
Kelly J. Garrone
McCarter & English, LLP
100 Mulberry Street
4 Gateway Center
Newark, NJ 07102
(973) 622-4444 (phone)
(973) 624-7070 (fax)
rsmith@mccarter.com

TABLE OF CONTENTS

Page

TABLE OF AUTHORITIES ii

INTRODUCTION 1

ARGUMENT 1

I. Confusion is Not Likely Because the Marks are Not Similar in Sound, Appearance, Meaning and Overall Commercial Impression 1

II. The Applicant's Mark Is Not Likely To Be Confused With The Cited Mark Because The Marks Are Used In Connection With Different Goods That Are Sold In Different Channels Of Trade To Different Customers 4

III. The Goods Covered By The Marks Are Expensive And Will Be Purchased By Discriminating Purchasers 8

CONCLUSION 10

TABLE OF AUTHORITIES

Page(s)

FEDERAL CASES

In re CSI Collision Specialist, Inc., 2011 TTAB LEXIS 341 (TTAB September 30, 2011) 5

Edwards Lifesciences Corporation v. VigiLanz Corp., 2010 TTAB LEXIS 84, 94 U.S.P.Q.2D (BNA) 1399 (TTAB April 14, 2010) 5

Electronic Design & Sales v. Electronic Systems, 954 F.2d 713 (Fed. Cir. 1992) 9

J.Wiss & Sons Co. v. Gee Whiz Tool Corp., 364 F.2d 910 (6th Cir. 1966) 3

Lebow Bros., Inc. v. LeBole Euroconf. S.p.A, 503 F. Supp. 209 (E.D. Pa. 1980) 3

New England Fish Co. v. The Hervin Co., 179 U.S.P.Q. 743 (TTAB 1973) 3

Professional Art Distribution, Inc. v. Internationaler Zeichenverbank Fur Kunstdruckpapier, E.V., 11 U.S.P.Q. 2d 1735 (Fed. Cir. 1989) 1

Quartz Radiation Corp. v. Comm/Scope Co., 1 U.S.P.Q.2d 1668 (TTAB 1986) 7

In re Reach Electronics, Inc., 175 U.S.P.Q. 734 (TTAB 1972) 2

In re Software Design, Inc., 220 U.S.P.Q.2d 662 (TTAB 1983) 9

Sports Authority Michigan Inc. v. P.C. Authority Inc., 63 U.S.P.Q.2d 1782 (TTAB 2002) 6

Sure-Fit Products Co. v. Saltzson Drapery Co., 117 U.S.P.Q. 295 (CCPA 1958) 2

In re Sweet Victory Inc., 228 U.S.P.Q. 959 (TTAB 1986) 1

In re Trackmobile, Inc., 15 U.S.P.Q.2d 1152 (TTAB 1990) 5

OTHER AUTHORITIES

Trademark Manual of Examining Procedure, October 2012 ed. 3, 7

INTRODUCTION

There is no likelihood of confusion between the Applicant's Mark[1] GRAIN AUDIO and the Cited Mark EGRAIN. The Examining Attorney believes confusion is likely because the marks both include the term GRAIN. However, she ignores the fact that the marks neither look alike nor sound alike and they have different meanings. Consequently, they are vastly different in overall commercial impression. When viewed in their entireties, and in the context of the differences between the goods, channels of trade and consumers, there is no likelihood of confusion between the Applicant's Mark and the Cited Mark.

ARGUMENT

I. Confusion is Not Likely Because the Marks are Not Similar in Sound, Appearance, Meaning and Overall Commercial Impression

Confusion between the Applicant's Mark and the Cited Mark is not likely because the appearance, sound, meaning and overall commercial impressions of the Applicant's Mark and the Cited Mark are vastly different.

The Examining Attorney surgically dissects both the Applicant's Mark and the Cited Mark and focuses solely on similarities in the term GRAIN, ignoring the fact that the appearance, sound, meaning and overall commercial impressions of the marks are simply not similar. The Board should consider the appearance, sound and meaning of each mark in its entirety and focus on the total effect of each mark rather than undertake a comparison of individual features. See, e.g., Professional Art Distribution, Inc. v. Internationaler Zeichenverbank Fur Kunstdruckpapier, E.V., 11 U.S.P.Q. 2d 1735 (Fed. Cir. 1989); In re Sweet Victory Inc., 228 U.S.P.Q. 959, 961 (TTAB 1986). The Examining Attorney fails to consider

[1] All definitions set forth in Applicant's opening brief are incorporated by reference herein.

the effect of the entire mark, including elements other than the term AUDIO. See Sure-Fit Products Co. v. Saltzson Drapery Co., 117 U.S.P.Q. 295, 297 (CCPA 1958).

Here, the entirety of the Applicant's Mark GRAIN AUDIO and the entirety of the Cited Mark EGRAIN do not look alike or sound alike, do not have the same meaning and do not convey the same or similar overall commercial impressions. In its opening brief, the Applicant cited several cases in which the Board and courts found that confusion was not likely where the entireties of the marks at issue were determined to be distinguishable. The Examining Attorney attempts to differentiate the cases cited by the Applicant as concerning marks that include "additional" distinguishing elements, seemingly arguing that the instant case involves only one element that distinguishes the marks from one another. However, characterizing the marks at issue as having one distinguishing element is inaccurate.

The Applicant's Mark is comprised of two words and does not begin with or include the letter E, and the Cited Mark is comprised of one coined word that does not include the term AUDIO. These multiple distinguishing elements – one word vs. two, a coined term vs. two terms that have known meanings, beginning with the letter E vs. not even containing the letter E, and not containing the term AUDIO vs. including the term AUDIO – render the marks overall visually and aurally distinct.

The Examining Attorney's attempts to distinguish the cases cited by the Applicant actually serve to underscore the relevance of these cases. For example, in In re Reach Electronics, Inc., 175 U.S.P.Q. 734 (TTAB 1972), the TTAB considered the fact that one mark, REACH, consisted of a commonly used dictionary word whereas the other mark, REAC, did not have a dictionary definition, and that the marks were distinguishable in appearance and did not sound alike when spoken. Id. at 735. Similar to the marks at issue in In re Reach Electronics,

Inc., the Applicant's Mark consists of terms with dictionary definitions, whereas the Cited Mark is a coined term. In addition, the marks at issue are distinguishable in appearance and do not sound alike when spoken. The Examining Attorney also argues that in Lebow Bros., Inc. v. LeBole Euroconf. S.p.A, 503 F. Supp. 209 (E.D. Pa. 1980), the court found confusion was not likely because the marks LEBOW and LEBOLE CLOTHES were not similar in appearance and would not be pronounced similarly. Similar to the marks at issue in Lebow Bros., Inc., the Applicant's Mark and the Cited mark are not at all similar in appearance and are not pronounced similarly. Further, like the mark BLUE MOUNTAIN KITTY O's in New England Fish Co. v. The Hervin Co., 179 U.S.P.Q. 743 (TTAB 1973), the Applicant's Mark GRAIN AUDIO features wording in addition to the term GRAIN that is not included in the Cited Mark. See id.; see also J.Wiss & Sons Co. v. Gee Whiz Tool Corp., 364 F.2d 910 (6th Cir. 1966) (finding no likelihood of confusion between WIZZ and GEE WHIZ).

The Examining Attorney essentially argues that because both marks include the term GRAIN, and because the term AUDIO in the Applicant's Mark is disclaimed, the marks convey similar commercial impressions. However, a "disclaimer does not remove the disclaimed matter from the mark. The mark must still be regarded as a whole, including the disclaimed matter, in evaluating similarity to other marks." Trademark Manual of Examining Procedure, October 2012 ed. ("TMEP") §1213.10. Thus, the term AUDIO in the Applicant's Mark should not be ignored – the Board should consider the term AUDIO in the Applicant's Mark when assessing whether or not the parties' marks are confusingly similar. The presence of the term AUDIO in the Applicant's Mark, combined with the other differences in the marks discussed above, renders the marks wholly distinct in appearance, sound, meaning and overall commercial impression.

Accordingly, given the vast differences in the marks, confusion between the Applicant's Mark and the Cited Mark is not likely.

II. The Applicant's Mark Is Not Likely To Be Confused With The Cited Mark Because The Marks Are Used In Connection With Different Goods That Are Sold In Different Channels Of Trade To Different Customers.

Confusion between the Applicant's Mark and the Cited Mark is not likely because the Applicant's goods and the goods covered by the Cited Mark are not closely related, and the parties' goods are sold in different channels of trade to different customers. The Cited Mark is used in connection with highly technical, specialized products and services[2] unrelated to the Applicant's goods, that are sold in specific channels of trade to sophisticated customers. The goods covered by the Cited Mark do not include household audio equipment such as speakers, record players and compact disc players that are offered in connection with the Applicant's Mark.

The Examining Attorney asserts that the goods of the parties overlap because both parties' marks cover audio receivers and because the Cited Mark covers "computer peripherals," which could encompass goods sold by the Applicant. However, given the overall technical and unclear nature of the Registrant's goods, including the vague description "computer peripherals" in the context of the Registrant's other goods, the Board should consider the evidence presented

[2] The Cited Mark is registered for "[d]ata processing apparatus and systems, namely, computers and computer networks comprising functional electronic units with electronic circuit substrates; autarchic miniaturized microcomputers capable of build-up and organizing a network autonomously by themselves through wireless communication; microprocessors, computer memories, application-specific integrated circuits (asics); radio frequency (rf) receiver and sender, sensor circuit computer hardware; computer peripherals; electronic display panels and electronic display devices, namely, light-emitting diodes (led's); organic light emitting diodes (oled's); liquid crystal displays (lcd's); computer interface boards; transmitters and receivers for telecommunications, namely, radio transmitters, audio receivers; telephone receivers; transmitters and receivers for electronic, analog, and digital signals, namely, television, radio (rf); network software, namely, network access server operating software," in Class 9 and "[r]esearch and development on electronics, microelectronics, and informatics, namely, on the informatics of operating systems and of parallel decentralized data processing; design and development of computers, computer networks, namely, body area networks and computer programs, all for others," in Class 42.

by the Applicant that shed light on the meaning of the goods covered by the Cited Mark. See In re Trackmobile, Inc., 15 U.S.P.Q.2d 1152, 1153-54 (TTAB 1990); Edwards Lifesciences Corporation v. VigiLanz Corp., 2010 TTAB LEXIS 84, 94 U.S.P.Q.2D (BNA) 1399 (TTAB April 14, 2010) (finding it "entirely appropriate" to consider extrinsic evidence to determine the specific meaning of the description of goods where description of goods provided basic information, and the goods were of a technical nature); In re CSI Collision Specialist, Inc., 2011 TTAB LEXIS 341 (TTAB September 30, 2011) (considering extrinsic evidence to interpret goods identified in cited registration). Here, the Applicant has presented significant evidence explaining the nature of the goods covered by the Cited Mark. In particular, the Applicant presented evidence that the Registrant's products are miniature computers with wireless sensors, in which components are assembled to a substrate in layers and are or will be used in applications such as those relating to logistics and transport. See excerpt from www.theage.com.au, Garrone Decl., Exhibit 4; excerpt from http://cyberphysicalsystem.de/egrain-projekt/, Garrone Decl., Exhibit 5. The Applicant further presented evidence that the owner of the Cited Mark is focused on "developing methods and technologies that can eventually be used in low-cost, large-scale production environments," and that this entity is an applications-oriented research organization – it is not an audio equipment company like the Applicant Id. at Exhibit 4; excerpt from www.fraunhofer.de, Garrone Decl., Exhibit 7.

The Examining Attorney also asserts that the parties' goods are in part identical because they both feature "audio receivers." However, the "audio receivers" covered by the Cited Mark are specifically limited to "transmitters and receivers for telecommunications, namely, radio transmitters, audio receivers" – to ignore this limitation on the identification of goods covered by

the Cited Mark would be to render the specific limiting language used in the Registrant's identification of goods meaningless. The Registrant's audio receivers are specifically used in the field of telecommunications. Accordingly, the Registrant's audio receivers are highly specialized and are likely purchased by professionals in the telecommunications industry. The Examining Attorney further asserts that the Applicant's receivers relate to telecommunications (although this term is not in the Applicant's description of services) because all receivers function to receive signals. However, the term "telecommunications" has a specific meaning that serves to limit the type of "audio receivers" covered by the Cited Mark. The term "telecommunications" is defined as "the transmission of information, as words, sounds, or images, usually over great distances, in the form of electromagnetic signals, as by telegraph, telephone, radio or television."[3] In contrast, the Applicant's "audio receivers," like the Applicant's other goods such as audio speakers, compact disc players, and portable audio players, are products sold at retail to individual consumers – they are not highly technical products used in the telecommunications industry that involve transmitting signals across great distances. Further, the sole fact that the goods covered by the two marks relate in some manner to electronics or computers is insufficient to create a likelihood of confusion. See, e.g. Sports Authority Michigan Inc. v. P.C. Authority Inc., 63 U.S.P.Q.2d 1782, 1793 (TTAB 2002).

The Examining Attorney sets forth examples of online retail stores that purportedly sell goods of both parties and third party trademark registrations that purportedly cover the goods of both parties, arguing that these examples constitute evidence that the Applicant's goods and the Registrant's goods travel "in similar channels of trade." However, the Examining Attorney's examples oversimplify the Registrant's goods, describing them as "computers," "radio

[3] The Applicant respectfully requests that the Board take judicial notice of the attached definition of the term "telecommunications" from www.dictionary.com.

transmitters," and "audio receivers." In reality, the Registrant's "computers" are actually "[d]ata processing apparatus and systems, namely, computers and computer networks comprising functional electronic units with electronic circuit substrates; autarchic miniaturized microcomputers capable of build-up and organizing a network autonomously by themselves through wireless communication," and the Registrant's radio transmitters and audio receivers are actually specifically limited to transmitters and receivers for telecommunications. Thus, the information provided by the Examining Attorney regarding third party online retail stores and third party trademarks should be ignored.

Further, the Examining Attorney argues that the goods covered by the Cited Mark are presumed to travel in the same channels of trade to the same class of purchasers as the goods covered by the Applicant's Mark absent a restriction in an application and/or registration. However, the goods covered by the Cited Mark do include a restriction – some of them are explicitly restricted to goods used "for telecommunications." In addition, when the evidence set forth by the Applicant as to the Registrant's industry is considered, it is clear that the Registrant's highly technical goods would not be sold in ordinary retail trade channels. In fact, the Applicant provided evidence that the Registrant's goods are used in the logistics and transport industries. See Garrone Decl., Exhibits 4 and 5. Here, the goods 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, and consequently, confusion is not likely. See TMEP §1207.01(a)(i); see e.g., Quartz Radiation Corp. v. Comm/Scope Co., 1 U.S.P.Q.2d 1668, 1669-70 (TTAB 1986). Given the differences between the goods covered by the Cited Mark and the goods sold in connection with the

Applicant's Mark and the fact that they are sold in different channels of trade to different consumers, confusion is not likely.

III. The Goods Covered By The Marks Are Expensive And Will Be Purchased By Discriminating Purchasers.

In addition to the reasons set forth above, the Applicant's Mark and the Cited Mark are not likely to be confused with one another because the goods and services covered by the marks are relatively expensive and will be purchased by discriminating purchasers. The Examining Attorney asserts that consumers of the goods covered by the Cited Mark are not limited to "sophisticated" purchasers. Given the highly technical nature of the Registrant's goods and the fact that they are utilized in certain commercial applications such as the fields of logistics and transport, these goods are likely to be purchased by sophisticated professionals.

However, even if individual customers could potentially purchase the goods covered by the Cited Mark, considering the highly specialized and technical nature of the products covered by that mark, those products are likely to be expensive. As discussed in detail in the Applicant's opening brief, the Applicant's goods are also relatively expensive. Thus, the test for "likelihood of confusion" is conducted with respect to the perception of "discriminating purchasers." See 3 McCarthy on Trademarks and Unfair Competition, 4th ed. (2012) ("McCarthy"), §23:96 at 23-188 and cases cited therein.

As some, if not all, of these products are expensive as well as technical in nature, buyers spend time and effort carefully selecting their purchases during a relatively long sales cycle. Both discriminating individual consumers purchasing expensive products and professionals educated in the specialized fields in which the Registrant's products are used are likely to spend time and effort selecting their goods, carefully comparing the offerings of several providers and

evaluating them based on criteria such as technical specifications and price - these are far from impulse purchases.

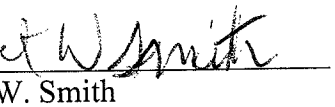
The Examining Attorney argues that even if purchasers of the Registrant's goods are sophisticated, this does not mean that they are knowledgeable in the field of trademarks or "immune" from confusion. However, the standard for "likelihood of confusion" does not contemplate a possibility of confusion or "immunity" from confusion – a probability of confusion is required. See 3 McCarthy §23:3 and cases cited therein; Electronic Design & Sales v. Electronic Systems, 954 F.2d 713, 716 (Fed. Cir. 1992). Given the expensive and technical nature of the goods sold by both parties, consumers are likely to spend time and care considering the features of each product and comparing products sold by different entities before purchasing a product, which would significantly lessen the likelihood that those discriminating consumers would be confused. See In re Software Design, Inc., 220 U.S.P.Q.2d 662, 663 (TTAB 1983).

CONCLUSION

The marks at issue are vastly different in appearance, sound, meaning, and overall commercial impression and they cover expensive goods that are unrelated to and are not substitutes for one another, and are sold in different channels of trade to different, discriminating consumers. Thus, when viewed in their entireties, and in the context of the differences between the goods, channels of trade and consumers, there is no likelihood of confusion between them. For these reasons and those argued in its opening brief and its prior response, the Applicant respectfully requests that the Board overturn the Examining Attorney's refusal, and remand the application for publication and registration.

Date: August 30, 2013

Respectfully submitted,



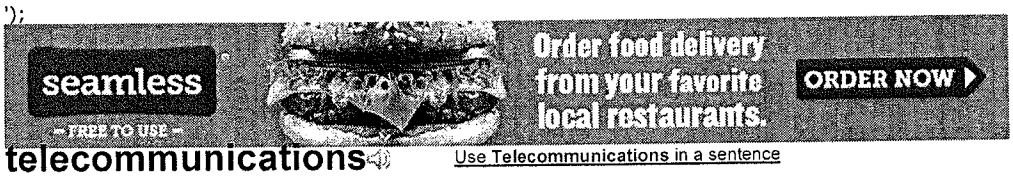
Robert W. Smith
Attorney for Applicant

McCarter & English, LLP
4 Gateway Center
100 Mulberry Street
Newark, NJ 07102
rsmith@mccarter.com

Dictionary Thesaurus Word Dynamo Quotes Reference Translator Spanish Log In Sign Up Premium

telecommunications

FAVORITES RECENT search dictionary

');


Related Searches

Telecommunications j...
History of telecommu...
Impact of telecommun...
Telecommunications i...
Telecommunications c...
Benefits of telecomm...
Telecommuting advant...
Telecommunications i...

Nearby Words

telecommunicati...
telecommunicati...
telecommunicati...
telecommunicati...
telecommunicati...
telecommunicati...
telecommunicati...

telecommunications

Use Telecommunications in a sentence

Ads
Comcast Business Services
www.comcastbusinessservices.com/
Help Your Business Grow w/ Comcast Business Internet, Phone & TV
NTT Group global business
www.ntt-global.com/
Offer **telecommunication** solutions, No. 2 IP Backbone in the world

tel·e·com·mu·ni·ca·tions [tel-i-k*uh*-myoo-ni-**key**-sh*uh* nz]

Show IPA

noun

1. Sometimes, **telecommunication.** (*used with a singular verb*) the transmission of information, as words, sounds, or images, usually over great distances, in the form of electromagnetic signals, as by telegraph, telephone, radio, or television.
2. Sometimes, **telecommunication.** (*used with a singular verb*) the science and technology of such communication.
3. **telecommunication,** a message so transmitted.

adjective

4. of or pertaining to telecommunications.

Origin:
1930–35; tele-[1] + communication + -s[3]

Dictionary.com Unabridged
Based on the Random House Dictionary, © Random House, Inc. 2013.
Cite This Source | Link To telecommunications

Example sentences

Li is a billionaire and a major player in the real estate market, and in

Electricity, fuel and **telecommunications** services are back.

And that miniscule machines she subsequently built solved a fundamental problem

The tightening of the global credit markets is crimping the world's largest

');

Upgrade to Ad-free Premium Membership!

Relevant Questions

What Is Telecommunicatio...
How To Invest In Telecom...
What Is Fixed Telecommun...
How To Become A Telecomm...

');

Telecommunications has a plethora of syllables. So is floccinaucinihilipilification. Does it mean: 00:09

- given to using long words.
- the estimation of something as valueless (encountered mainly as an example of one of the longest words in the English language).

LEARN MORE LONG WORDS WITH WORD DYNAMO...

Related Words

facsimile	asynchronous
modulate	babble
multiplex	background
teleport	bandwidth
access code	baud
ADTS	broadband

MORE

Quote Of The Day

"Just as language has no longer anything in common with the thing it names, so the movement..."

-Rainer Maria Rilke

MORE

');

World English Dictionary

Collins

telecommunications (ˌtɛlɪkəˌmjuːnɪˈkeɪʃənz)

— ***n***

(*functioning as singular*) the science and technology of communications by telephony, radio, television, etc

Collins English Dictionary - Complete & Unabridged 10th Edition
2009 © William Collins Sons & Co. Ltd. 1979, 1986 © HarperCollins Publishers 1998, 2000, 2003, 2005, 2006, 2007, 2009
Cite This Source

Science Dictionary

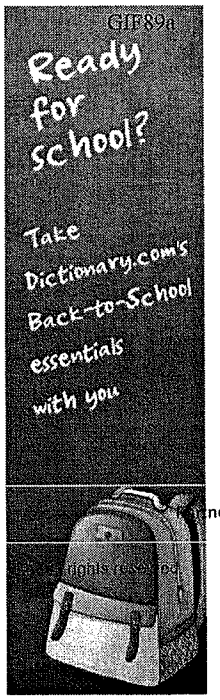
American Heritage

telecommunication (tĕl'ĭ-kə-my ōō'nĭ-kā'shən) Pronunciation Key
The science and technology of sending and receiving information such as sound, visual images, or computer data over long distances through the use of electrical, radio, or light signals, using electronic devices to encode the information as signals and to decode the signals as information.

FAVORITES RECENT search dictionary

The American Heritage® Science Dictionary
Copyright © 2002. Published by Houghton Mifflin. All rights reserved.
Cite This Source

');



tners: Word | Bloglines | Citysearch | The Daily Beast | Life123 | Sendori | Home Advisor

Copyright © 2013 Dictionary.com, rights reserved. About | PRIVACY POLICY | Terms | API | Caree tise with Us | ntact Us | Suggest a Word | Help

FAVORITES RECENT search dictionary