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Subject: U.S. TRADEMARK APPLICATION NO. 85554445 - ALL-WAYS - ALL-100 - EXAMINER BRIEF

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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NO. 85554445

MARK: ALL-WAYS



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GENERAL TRADEMARK INFORMATION:

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

TTAB INFORMATION:

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

APPLICANT: All-Ways Forwarding Int'l Inc.

CORRESPONDENT'S REFERENCE/DOCKET NO:

ALL-100

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EXAMINING ATTORNEY'S APPEAL BRIEF

STATEMENT OF THE CASE

The applicant has appealed the examining attorney's final refusal to register the mark **ALL-WAYS** for

Air freight shipping services; Airline and shipping services; Freight forwarding services; Freight loading services; Global transportation of freight for others by all available means; Supply chain logistics and reverse logistics services, namely, storage, transportation and delivery of documents, packages, raw materials, and other freight for others by air, rail, ship or truck; Warehousing services, namely, storage, distribution, pick-up, packing, and shipping of gourmet food and spirits, fresh fruits and vegetables, garments, textiles and other general merchandise

on grounds that the applicant's mark, when used on the services, so resembles the mark in U.S.

Registration No. 4015760, **ALL WAYS MOVING & STORAGE** (with a disclaimer of "MOVING & STORAGE")

for "Moving company services," as to be likely to cause confusion, mistake or deception under

Trademark Act Section 2(d), 15 U.S.C. §1052(d).

FACTS

All-Ways Forwarding Int'l Inc., a New Jersey Corporation ("applicant"), filed this use-based application

on February 28, 2012, to register the mark **ALL-WAYS** for

Business advisory services in the field of FDA specialists for food imports; Business services, namely, freight information management services, shipment processing, preparing shipping documents and invoices, tracking documents, packages and freight

over computer networks, intranets and Internets; Customs clearance services; Import-export agencies in the field of gourmet food and spirits, fresh fruits and vegetables, garments, textiles and other general merchandise; Information management services, namely, shipment processing, preparing shipping documents and invoices, tracking documents, packages and freight over computer networks, intranets and internets, in International Class 35, and

Air freight shipping services; Airline and shipping services; Freight forwarding; Freight loading services; Global transportation of freight for others by all available means; Supply chain logistics and reverse logistics services, namely, storage, transportation and delivery of documents, packages, raw materials, and other freight for others by air, rail, ship or truck; Warehousing services, namely, storage, distribution, pick-up, packing, and shipping of gourmet food and spirits, fresh fruits and vegetables, garments, textiles and other general merchandise, in International Class 39.

In the first Office action dated June 7, 2012, the examining partially refused registration, as to the services in International Class 39 only, under Trademark Act Section 2(d), 15 U.S.C. §1052(d), due to a likelihood of confusion with the mark in U.S. Registration No. 4015760.

In a response filed September 20, 2012, applicant argued against the Section 2(d) refusal.

In a final Office action dated September 28, 2012, the examining attorney maintained and made final the Section 2(d) refusal, as to the services in International Class 39, due to a likelihood of confusion with the mark in U.S. Registration No. 4015760.

On January 2, 2013, applicant filed a request to divide out the services in International Class 35 that had not been refused registration. On January 16, 2013, the Office notified applicant that the divisional request had been processed, placing the services in International Class 35 in (child) Application Serial No. 85/978444. The examining attorney approved (child) Application Serial No. 85/978444 for publication on January 16, 2013; it registered as U.S. Registration No. 4338901 on May 22, 2013.

On March 28, 2013, applicant filed a notice of appeal and request for reconsideration of the final refusal.

On April 14, 2013, the examining attorney denied applicant's request for reconsideration.

On July 31, 2013, applicant filed its appeal brief.

On August 5, 2013, the file was forwarded to the examining attorney for a statement.

ISSUE

The sole issue on appeal is whether there is a likelihood of confusion, mistake or deception, under Trademark Act Section 2(d), 15 U.S.C. §1052(d), between applicant's mark **ALL-WAYS** for

Air freight shipping services; Airline and shipping services; Freight forwarding services; Freight loading services; Global transportation of freight for others by all available means; Supply chain logistics and reverse logistics services, namely, storage, transportation and delivery of documents, packages, raw materials, and other freight for others by air, rail, ship or truck; Warehousing services, namely, storage, distribution, pick-up, packing, and shipping of gourmet food and spirits, fresh fruits and vegetables, garments, textiles and other general merchandise, in International Class 39,

and the mark in U.S. Registration No. 4015760, **ALL WAYS MOVING & STORAGE** (with a disclaimer of “MOVING & STORAGE”) for “Moving company services” in International Class 39.

OBJECTION TO UNTIMELY EVIDENCE

Applicant’s brief includes a list of fourteen third-party registrations for marks containing the wording “ALL WAYS” or “ALL-WAYS” for goods and services in assorted international classes other than International Class 39. The mere submission of a list of registrations does not make such registrations part of the record. *In re Promo Ink*, 78 USPQ2d 1301, 1304 (TTAB 2006); TBMP §1208.02; TMEP §710.03. Moreover, the record in an application should be complete prior to the filing of an appeal. 37 C.F.R. §2.142(d); TBMP §§1203.02(e), 1207.01; TMEP §710.01(c). Because applicant’s new evidence was untimely submitted during an appeal, and is not properly made of record, the examining attorney requests that the Board disregard this evidence. *See In re Luxuria s.r.o.*, 100 USPQ2d 1146, 1147-48 (TTAB 2011); *In re Giovanni Food Co.*, 97 USPQ2d 1990, 1990-91 (TTAB 2011); *In re Van Valkenburgh*, 97 USPQ2d 1757, 1768 n.32, 1769 (TTAB 2011); TBMP §§1203.02(e), 1207.01; TMEP §710.01(c).

ARGUMENT

Trademark Act Section 2(d) bars registration of an applied-for mark that so resembles a registered mark that it is likely a potential consumer would be confused, mistaken, or deceived as to the source of the goods and/or services of the applicant and registrant. *See* 15 U.S.C. §1052(d). A determination of likelihood of confusion under Section 2(d) is made on a case-by case basis and the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973) aid in this determination. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d 1344, 1349, 98 USPQ2d 1253, 1256 (Fed. Cir. 2011) (citing *On-Line Careline, Inc. v. Am. Online, Inc.*, 229 F.3d 1080, 1085, 56 USPQ2d 1471, 1474 (Fed. Cir. 2000)). Not all the *du Pont* factors, however, are necessarily relevant or of equal weight, and any one of the factors may control in a given case, depending upon the evidence of record. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d at 1355, 98 USPQ2d at 1260; *In re Majestic Distilling Co.*, 315 F.3d 1311, 1315, 65 USPQ2d 1201, 1204 (Fed. Cir. 2003); *see In re E. I. du Pont de Nemours & Co.*, 476 F.2d at 1361-62, 177 USPQ at 567.

In this case, the following factors are the most relevant: similarity of the marks, similarity and nature of the services, and similarity of the trade channels of the services. *See In re Viterra Inc.*, 671 F.3d 1358, 1361-62, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *In re Dakin's Miniatures Inc.*, 59 USPQ2d 1593, 1595-96 (TTAB 1999); TMEP §§1207.01 *et seq.*

The overriding concern is not only to prevent buyer confusion as to the source of the 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).

1) SIMILARITY OF THE MARKS

Applicant's mark is **ALL-WAYS** and the registrant's mark is **ALL WAYS MOVING & STORAGE** (with a disclaimer of "MOVING & STORAGE").

Marks must be compared in their entireties and should not be dissected; however, a trademark examining attorney may weigh the individual components of a mark to determine its overall commercial impression. *In re Chatam Int'l Inc.*, 380 F.3d 1340, 1342, 71 USPQ2d 1944, 1946-47 (Fed. Cir. 2004); *In re Nat'l Data Corp.*, 753 F.2d 1056, 1058, 224 USPQ 749, 751 (Fed. Cir. 1985) ("[I]n articulating reasons for reaching a conclusion on the issue of confusion, there is nothing improper in stating that, for rational

reasons, more or less weight has been given to a particular feature of a mark”); *In re Kysela Pere et Fils, Ltd.*, 98 USPQ2d 1261, 1267 (TTAB 2011).

In this case, “**ALL WAYS**” in the registrant’s mark should be given more weight in determining its overall commercial impression. “**ALL WAYS**” is the dominant wording in the registrant’s mark, as the remaining wording “MOVING & STORAGE” has been disclaimed. Disclaimed matter 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 1056, 1060, 224 USPQ 749, 752 (Fed. Cir. 1985); TMEP §1207.01(b)(viii), (c)(ii).

Moreover, “**ALL WAYS**” is the first wording in the registrant’s mark. Consumers are generally more inclined to focus on the first word, prefix, or syllable in any trademark or service mark. *See Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F. 3d 1369, 1372, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005); *Presto Prods., Inc. v. Nice-Pak Prods., Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) (“it is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered” when making purchasing decisions).

Applicant’s **ALL-WAYS** mark and the dominant wording “**ALL WAYS**” in the registrant’s mark use the same letters and are essentially the same terms. Applicant’s assertion that the hyphen in its **ALL-WAYS** mark changes the pronunciation of the mark is not persuasive. There is no correct pronunciation of a mark because it is impossible to predict how the public will pronounce a particular mark. *See In re*

Viterra Inc., 671 F.3d 1358, 1367, 101 USPQ2d 1905, 1912 (Fed. Cir. 2012) (finding a likelihood of confusion between XCEED and X-SEED (and design)); *Centraz Indus. Inc. v. Spartan Chem. Co.*, 77 USPQ2d 1698, 1701 (TTAB 2006); TMEP §1207.01(b)(iv). The wording **ALL-WAYS** and “**ALL WAYS**” in the marks in question clearly *could* be pronounced the same. See *Viterra*, 671 F.3d at 1367, 101 USPQ2d at 1912 (quoting the Board’s statement that “it is hard to imagine that [XCEED and X-SEED] will not sound alike when spoken”).

The mere deletion of wording from a registered mark may not be sufficient to overcome a likelihood of confusion. See *In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257 (Fed. Cir. 2010); *In re Optica Int’l*, 196 USPQ 775, 778 (TTAB 1977); TMEP §1207.01(b)(ii)-(iii). Applicant’s **ALL-WAYS** mark does not create a distinct commercial impression because it contains the same common wording “ALL WAYS” as the registrant’s **ALL WAYS MOVING & STORAGE** mark, and there is no other wording to distinguish it from the registrant’s mark. The marks are confusingly similar.

2) SIMILARITY AND NATURE OF THE SERVICES

With respect to applicant’s and the registrant’s services, the question of likelihood of confusion is determined based on the description of the services stated in the application and registration at issue, not on extrinsic evidence of actual use. See, e.g., *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1369-70, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012); *Octocom Sys. Inc. v. Hous. Computers Servs. Inc.*, 918 F.2d 937, 942, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990).

Absent restrictions in an application and/or registration, the identified services are “presumed to travel in the same channels of trade to the same class of purchasers.” *In re Viterro Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (quoting *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1268, 62 USPQ2d 1001, 1005 (Fed. Cir. 2002)). Additionally, unrestricted and broad identifications are presumed to encompass all services of the type described. See *In re Jump Designs, LLC*, 80 USPQ2d 1370, 1374 (TTAB 2006) (citing *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981)); *In re Linkvest S.A.*, 24 USPQ2d 1716, 1716 (TTAB 1992).

In this case, the identification set forth in the application and registration has no restrictions as to nature, type, channels of trade, or classes of purchasers. Therefore, it is presumed that these services travel in all normal channels of trade and are available to the same class of purchasers. Further, the application uses broad wording to describe the services and this wording is presumed to encompass all services of the type described, including those in applicant’s more narrow identification.

The evidence of record clearly establishes that the registrant’s broadly-identified moving company services are related to the storage, forwarding, transportation, warehousing and delivery services in applicant’s more narrow identification of services because moving company services encompass storage, forwarding, transportation, warehousing and delivery services for others.

The Internet evidence of record consists of screenshots from three moving company websites describing their services (see attachments to final Office action dated September 28, 2012, and incorporated

herein by reference). Specifically, the *Ford Storage and Moving Company* website states that it offers relocation and moving services for homes and businesses as well as public warehousing, fulfillment, distribution, delivery and transportation services (see evidence from <http://www.fordstorage.com/ford/index.php>). The *Desert Moving Company* website states that it offers residential moving, corporate moving, storage, global freight, warehousing, logistics, shipping and delivery services (see evidence from <http://dmcmoving.com>). The *White Glove Storage & Delivery* website states that it offers local and long-distance moving services and receiving, storage and delivery services (see evidence from <http://www.whitegloveusa.com>). This evidence establishes that the same entity commonly provides the relevant services under the same mark through the same trade channels. Therefore, applicant's and the registrant's services are considered related for likelihood of confusion purposes. See, e.g., *In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1202-04 (TTAB 2009); *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266, 1268-69, 1271-72 (TTAB 2009).

The additional evidence of record from the USPTO's X-Search database consists of numerous third-party marks registered for use in connection with the same or similar services as those of both applicant and the registrant in this case (see attachments to Office actions dated June 7, 2012, September 28, 2012, and April 14, 2013, and incorporated herein by reference). This evidence shows that the services listed therein, namely "moving company services" and "supply chain logistics and reverse logistics services, namely, storage, transportation and delivery of documents, packages, raw materials, and other freight for others by air, rail, ship or truck" and/or "freight forwarding" services and/or "warehousing services," are of a kind that may emanate from a single source under a single mark. See *In re Anderson*, 101 USPQ2d 1912, 1919 (TTAB 2012); *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993); *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988); TMEP §1207.01(d)(iii).

Applicant's claim of priority of use is not relevant to this ex parte proceeding. See *In re Calgon Corp.*, 435 F.2d 596, 168 USPQ 278 (C.C.P.A. 1971). Trademark Act Section 7(b), 15 U.S.C. §1057(b), provides that a certificate of registration on the Principal Register is prima facie evidence of the validity of the registration, of the registrant's ownership of the mark, and of the registrant's exclusive right to use the mark in commerce on or in connection with the goods and/or services specified in the certificate. During ex parte prosecution, the examining attorney has no authority to review or to decide on matters that constitute a collateral attack on the cited registration. TMEP §1207.01(d)(iv).

Applicant's argument that its activities are geographically separate from those of the registrant, in that applicant's services "expand the globe" while the registrant offers "localized" services in Pennsylvania, is not persuasive. Applicant seeks, and the registrant owns, a geographically unrestricted registration. The owner of a registration without specified limitations enjoys a presumption of exclusive right to nationwide use of the registered mark under Trademark Act Section 7(b), 15 U.S.C. §1057(b), regardless of its actual extent of use. *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 1568, 218 USPQ 390, 393 (Fed. Cir. 1983). Therefore, the relative geographical scope of applicant's and the registrant's activities is not relevant to a likelihood of confusion determination.

Applicant's claim that the parties have co-existed for twenty-three years without any actual confusion has little, if any, probative value. The test under Trademark Act Section 2(d) is whether there is a likelihood of confusion. It is not necessary to show actual confusion to establish a likelihood of confusion. *Herbko Int'l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1165, 64 USPQ2d 1375, 1380 (Fed. Cir.

2002) (citing *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 1571, 218 USPQ 390, 396 (Fed. Cir. 1983)); TMEP §1207.01(d)(ii). The Trademark Trial and Appeal Board stated as follows:

[A]pplicant's assertion that it is unaware of any actual confusion occurring as a result of the contemporaneous use of the marks of applicant and registrant is of little probative value in an ex parte proceeding such as this where we have no evidence pertaining to the nature and extent of the use by applicant and registrant (and thus cannot ascertain whether there has been ample opportunity for confusion to arise, if it were going to); and the registrant has no chance to be heard from (at least in the absence of a consent agreement, which applicant has not submitted in this case).

In re Kangaroos U.S.A., 223 USPQ 1025, 1026-27 (TTAB 1984).

In sum, the proposed mark **ALL-WAYS** is confusingly similar to the registered mark **ALL WAYS MOVING & STORAGE** for related services. Registration is properly refused on the Principal Register under Section 2(d) of the Trademark Act.

CONCLUSION

Based on the record evidence and case law, the applied-for mark, when used on or in connection with the identified services, so resembles the mark in U.S. Registration No. 4015760 that it is likely a potential

consumer would be confused, mistaken, or deceived as to the source of the services of the applicant and registrant. The examining attorney, therefore, respectfully requests that the Board affirm the refusal to register the mark under Trademark Act Section 2(d), 15 U.S.C. §1052(d).

Respectfully submitted,

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