

Request for Reconsideration after Final Action

The table below presents the data as entered.

| Input Field | Entered |
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| SERIAL NUMBER | 85554445 |
| LAW OFFICE ASSIGNED | LAW OFFICE 107 |
| MARK SECTION (no change) | |
| ARGUMENT(S) | |
| <p>This request for reconsideration is being filed simultaneously with a Notice of Appeal. A divisional application has been already filed directed to the services in Class 35 which has been allowed. This application contains services in Class 39.</p> <p>The Examiner has finally refused registration stating that there is a likelihood of confusion with the mark ALL WAYS MOVING & STORAGE in U.S. Registration No. 4,015,760 (Class 39). As explained below, Applicant respectfully disagrees and states (i) that the Examining Attorney has failed to make a <i>prima facie</i> showing of likelihood of confusion; and (ii) Applicant's mark is <i>not</i> likely to be confused with Registrant's mark. Accordingly, Applicant's mark in Class 39 should be allowed to be registered on the Principal Register.</p> <p>Examiner argues that the dominant wording in the pending application is ALL-WAYS which is nearly identical to the cited registration ALL WAYS. Applicants respectfully disagree.</p> <p>The marks must be looked at in their entirety. Registrants mark is ALL WAYS MOVING & STORAGE whereas Applicant's mark is ALL-WAYS. The Examining Attorney is aware, merely altering, adding, or eliminating even a single letter can create a different commercial impression for prospective customers. See, e.g., <i>Nestle Co. v. Nash-Finch Co.</i>, 4 U.S.P.Q.2d 1085 (T.T.A.B. 1987) (DELIQUICK creates a different commercial impression from NESTLE QUICK and QUICK); <i>Nabisco Brands, Inc. v. Quaker Oats Co.</i>, 547 F.Supp. 1244, 216 U.S.P.Q. 770 (D.N.J. 1982) (CREAM OF WHEAT was found not to be confusingly similar to CREAMY WHEAT even though both marks are used for breakfast cereals); and <i>Jacobs v. International Multifoods Corp.</i>, 668 F.2d 1234, 212 U.S.P.Q. 641 (C.C.A.P. 1982) (BOSTON SEA PARTY was found not to be confusingly similar to BOSTON TEA PARTY). In the present case, the registered mark ALL WAYS MOVING & STORAGE, differs visually and phonetically from that of Applicant's, thereby creating an impression easily distinguishable from that of Applicant's mark. In addition the cited registrations contain the additional wording "Moving & Storage," thereby further creating unitary impressions completely unlike that of Applicant's mark.</p> <p>In addition, the services of the Registrant's mark are quite different from the Applicant's. The ALL WAYS MOVING & STORAGE Registration describes the services in general as being merely</p> | |

“moving company services.”

In contrast Applicant’s services are specifically: 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 her refusal, the Examiner asserts that the Applicant’s services are related to the Registrant’s services because she “presumes that the services are to the same class of consumers” and that the “broad wording of the Registrants moving company services is presumed to encompass the Applicant’s narrow identification.” The Examiner further states that “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.” Applicant respectfully disagrees on both points.

First, the Examiner has no basis to presume that the Registrants’ moving company services would encompass the narrow identification of services recited in Applicant’s application. An ordinary person hearing the term “moving company services” would assume these services to be related to moving ones home or business, and not the narrow recitation of Applicant’s services. In fact “moving company services” is not even recited in Applicant’s recitation of services.

Applicant is also not a “newcomer” to the market and in fact has used their mark in commerce at least as early as January 1, 1982, which predates the Registrant’s use in commerce by over eight years (May 18, 1990).

In sum, the mark ALL-WAYS is not similar to ALL WAYS MOVING & STORAGE nor are the services related other than that they overlap as being in Class 39. Accordingly, it is respectfully requested that in view of the argument and evidence presented herein the rejection should be withdrawn.

In view of the arguments presented herein, Applicant believes that the Examiner’s rejections have been overcome and that the trademark application should be allowed.

SIGNATURE SECTION

| | |
|---------------------------------------|---|
| RESPONSE SIGNATURE | /Dara L. Onofrio/ |
| SIGNATORY'S NAME | Dara L. Onofrio |
| SIGNATORY'S POSITION | Attorney of Record, New York State Bar Member |
| SIGNATORY'S PHONE NUMBER | 845.613.0880 |
| DATE SIGNED | 03/28/2013 |
| AUTHORIZED SIGNATORY | YES |
| CONCURRENT APPEAL NOTICE FILED | YES |

FILING INFORMATION SECTION

| | |
|--------------------|--|
| SUBMIT DATE | Thu Mar 28 12:11:35 EDT 2013 |
| TEAS STAMP | USPTO/RFR-24.218.64.115-2 0130328121135535382-85554 445-5002a98a9359a56a73418 c79d389b5072d96c6b1983b4f e7b9575ce4312c559b222-N/A -N/A-20130328115008534464 |

PTO Form 1930 (Rev 9/2007)
OMB No. 0651-0050 (Exp. 05/31/2014)

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

Application serial no. **85554445** has been amended as follows:

ARGUMENT(S)

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

This request for reconsideration is being filed simultaneously with a Notice of Appeal. A divisional application has been already filed directed to the services in Class 35 which has been allowed. This application contains services in Class 39.

The Examiner has finally refused registration stating that there is a likelihood of confusion with the mark ALL WAYS MOVING & STORAGE in U.S. Registration No. 4,015,760 (Class 39). As explained below, Applicant respectfully disagrees and states (i) that the Examining Attorney has failed to make a *prima facie* showing of likelihood of confusion; and (ii) Applicant's mark is *not* likely to be confused with Registrant's mark. Accordingly, Applicant's mark in Class 39 should be allowed to be registered on the Principal Register.

Examiner argues that the dominant wording in the pending application is ALL-WAYS which is nearly identical to the cited registration ALL WAYS. Applicants respectfully disagree.

The marks must be looked at in their entirety. Registrants mark is ALL WAYS MOVING & STORAGE whereas Applicant's mark is ALL-WAYS. The Examining Attorney is aware, merely altering, adding, or eliminating even a single letter can create a different commercial impression for prospective customers. See, e.g., *Nestle Co. v. Nash-Finch Co.*, 4 U.S.P.Q.2d 1085 (T.T.A.B. 1987) (DELIQUICK creates a different commercial impression from NESTLE QUICK and QUICK); *Nabisco Brands, Inc. v. Quaker Oats Co.*, 547 F.Supp. 1244, 216 U.S.P.Q. 770 (D.N.J. 1982) (CREAM OF WHEAT was found not to be confusingly similar to CREAMY WHEAT even though both marks are used for breakfast cereals); and *Jacobs v. International Multifoods Corp.*, 668 F.2d 1234, 212 U.S.P.Q. 641 (C.C.A.P. 1982) (BOSTON SEA PARTY was found not to be confusingly similar to BOSTON TEA PARTY). In the

present case, the registered mark ALL WAYS MOVING & STORAGE, differs visually and phonetically from that of Applicant's, thereby creating an impression easily distinguishable from that of Applicant's mark. In addition the cited registrations contain the additional wording "Moving & Storage," thereby further creating unitary impressions completely unlike that of Applicant's mark.

In addition, the services of the Registrant's mark are quite different from the Applicant's. The **ALL WAYS MOVING & STORAGE** Registration describes the services in general as being merely "moving company services."

In contrast Applicant's services are specifically: 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 her refusal, the Examiner asserts that the Applicant's services are related to the Registrant's services because she "presumes that the services are to the same class of consumers" and that the "broad wording of the Registrants moving company services is presumed to encompass the Applicant's narrow identification." The Examiner further states that "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." Applicant respectfully disagrees on both points.

First, the Examiner has no basis to presume that the Registrants' moving company services would encompass the narrow identification of services recited in Applicant's application. An ordinary person hearing the term "moving company services" would assume these services to be related to moving ones home or business, and not the narrow recitation of Applicant's services. In fact "moving company services" is not even recited in Applicant's recitation of services.

Applicant is also not a "newcomer" to the market and in fact has used their mark in commerce at least as early as January 1, 1982, which predates the Registrant's use in commerce by over eight years (May 18, 1990).

In sum, the mark ALL-WAYS is not similar to ALL WAYS MOVING & STORAGE nor are the services related other than that they overlap as being in Class 39. Accordingly, it is respectfully requested that in view of the argument and evidence presented herein the rejection should be withdrawn.

In view of the arguments presented herein, Applicant believes that the Examiner's rejections have been overcome and that the trademark application should be allowed.

SIGNATURE(S)

Request for Reconsideration Signature

Signature: /Dara L. Onofrio/ Date: 03/28/2013

Signatory's Name: Dara L. Onofrio

Signatory's Position: Attorney of Record, New York State Bar Member

Signatory's Phone Number: 845.613.0880

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.

Serial Number: 85554445

Internet Transmission Date: Thu Mar 28 12:11:35 EDT 2013

TEAS Stamp: USPTO/RFR-24.218.64.115-2013032812113553

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