

Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	85794896
LAW OFFICE ASSIGNED	LAW OFFICE 110
MARK SECTION (current)	
STANDARD CHARACTERS	NO
USPTO-GENERATED IMAGE	NO
LITERAL ELEMENT	ZRPICASSO
COLOR(S) CLAIMED (If applicable)	Color is not claimed as a feature of the mark.
DESCRIPTION OF THE MARK (and Color Location, if applicable)	The mark consists of The literal characters ZR with arc shaped paint brushes on the left and right respectively with the word PICASSO underneath the ZR element.
MARK SECTION (proposed)	
MARK FILE NAME	\\TICRS\EXPORT16\IMAGEOUT_16\857\948\85794896\xml9\RFR0002.JPG
STANDARD CHARACTERS	NO
USPTO-GENERATED IMAGE	NO
LITERAL ELEMENT	ZRPICASSO
COLOR MARK	NO
DESCRIPTION OF THE MARK (and Color Location, if applicable)	The mark consists of The literal characters ZR with arc shaped paint brushes on the left and right respectively with the word PICASSO underneath the ZR element, all letters painted by brush.
PIXEL COUNT ACCEPTABLE	YES
PIXEL COUNT	304 x 396

ARGUMENT(S)

Drawing

The Examiner has rejected the drawing of the mark on the basis that image size did not meet the USPTO limitations and that the drawing is not clear.

A substitute drawing is submitted with this filing and conforms to the pixel size constraints as given in the Examiner's Final Office Action.

With regard to the rejection that the drawing is not clear, the Examiner has maintained the drawing is not acceptable because the lines are not clear, sharp and solid. The applicant states that reason for the appearance as shown is intentional and an important characteristic of the mark. The graphic contains two paint brushes and it is intended that the mark give the appearance that it was painted using the brushes in broad strokes. The appearance is to look like "smearing" of the paint rather than crisp lines.

Refusal under Section 2 (d) – Likelihood of Confusion

The Examiner has maintained the Section 2 (d) refusal on the basis of resemblance to US Reg Nos 4175515, 4175517, and 3855619. The basis is grounded in similarity of the trade channels and a common impression of the marks.

The applicant respectfully requests the Examiner reconsider the rejection after review of the additional evidence submitted along with the explanations contained herein.

Comparison of the Marks

When determining the impression of a stylized mark and performing a comparison, the Examiner should be giving greater weight to whether there is visual similarity. The applicant's mark contains several distinctive visual elements namely two arching paint brushes, and the letters which are stylized in artistic manner. These elements dominate the overall commercial impression. None of these elements exist in the reference registrations.

With regard to PICASSO BY AMD LASERS, the mark consists of a phrase which not found in the applicant's mark. When combined with the dissimilarity based on visual the two marks fail under the DuPont factors, especially when considering the relatedness of the goods (as discussed below).

The Examiner has also cited a likelihood of confusion between the applicant's mark and Reg Nos. 4175515 & 4175517. The cited marks are commonly owned with the '515 mark being a standard character mark and the '517 mark being a stylized mark. When making the comparison between the applicant's mark and the '517 mark, the Examiner has not given proper weight to the visual appearance of the two marks.

With regard to the '515 mark, the word "PICASSO", the prior argument of evidence of prior registrations is probative to show the level of distinctiveness. See *In re Dayco Products-Eagle Motive Inc.*, 9 U.S.P.Q.2d 1910, 1911-1912 (TTAB 1988). Where the phrase (word) is found in registered marks or commonly used, it cannot be afforded wide latitude for purposes of distinctiveness because the public will investigate further in determining the commercial impression. The public will make further inquiry when viewing the mark. The words are merely descriptive or generic. Attached is a TESS listing showing 68 instances of the commercial use of the word "PICASSO". While not all records indicate a registration, the evidence supports the allegation that there is wide spread use of the term.

Therefore the Examiner should look consider that the inherent weakness in the word "PICASSO" which by itself is not dominant in creating the commercial impression. On this basis there is no

likelihood of confusion and the applicant requests that the rejection be withdrawn with regard to 4175515 and 4175517 marks.

Comparison of Goods

The Examiner has alleged that the goods are closely related. In support of this claim the Examiner only evidence is third party registrations where “dental crowns, dental implants”, “dental wax”, and “medical lasers” have been registered under a single mark.

With regard to “medical lasers” , the Examiner’s evidence does not establish that a third party has registered a single mark with covers “medical lasers” and products such as identified in the applicant’s description of goods. Applicant’s contention that the purchasers are sophisticated and that the purchase of a medical laser is conducted with great scrutiny is supported by the attached evidence where the Registrant (Reg No. 3655619) has stated “the purchasers are sophisticated, careful, and nonimpulsive”. (See highlighted text in Response to Office Action SN 77805095 page 2).

The Examiner has not established necessary evidence to support that the fact that medical lasers travel in the same trade channel as the applicant’s products, that the goods are encountered during purchasing decisions and based on the evidence from registrant it is established that the purchasers of medical lasers are sophisticated. Applicant requests that Examiner reconsider and withdraw her reference to Reg. No. 3655619. There is no similarity in the goods between the applicant’s goods and those covered by the mark “PICASSO BY AMD LASERS”.

With respect to “dental wax” and “dental crowns, dental implants”, the Examiner has relied upon it evidence of third party registrations which contain Class 005 and Class 010 for a single mark. However, the Examiner has not presented evidence that goods in Class 005 and Class 010 travel in similar trade channels. Nor has the Examiner established with this evidence that “they will be encountered by the same consumers under circumstances that would lead to the mistaken belief that the good originate from the same source”.

In determining whether goods and services are related, "it is not enough that the products may be classified in the same category or that a term can be found that describes the product." *Signature Brands, Inc. Substituted for Health OMeter, Inc. v. Dallas Technologies Corporation*, 1998 WL 80140 (T.T.A.B. 1998). The burden of proof is with the Examiner, and the Examiner has not and cannot show proof that dental wax and dental crowns are encountered by purchasers in the same circumstances.

Dental crowns, dentures and the types of dental appliances described in the applicant’s goods are custom ordered and custom measured. Where as dental wax and the goods identified in the listing for Class 005 (cited by the Examiner) are found in supply catalogs. The Examiner has not recognized and given sufficient weight to the care and circumstances under which the purchase of the products associated with the applicant’s description of goods. Furthermore the Class 010 goods listed in the references the Examiner has chosen are largely medical type instruments and tools. These tools and instruments are sold and encountered under different circumstances than the applicant’s goods. The Examiner has offered no evidence to rebut this fact and the burden of proof to do so lies with the Examiner.

With regard to the arguments previously made by the Applicant, the Applicant maintains its position with regard to those arguments and does concede the Examiner’s statements. Applicant has for efficiency purposes simply chose not to repeat them in totality , all rights are reserved with regard to asserting those arguments in any further proceedings.

Summary

In view of the evidence attached , the Examiner should reconsider and withdraw the refusal to register.

The Examiner has not met its burden of proof in rebutting the applicant's evidence and arguments regarding the relatedness of the goods and the overall commercial impression of its mark.

EVIDENCE SECTION

EVIDENCE FILE NAME(S)	
ORIGINAL PDF FILE	evi_64252116122-083225314_.140112_Picasso_TESS_List.pdf
CONVERTED PDF FILE(S) (2 pages)	\\TICRS\EXPORT16\IMAGEOUT16\857\948\85794896\xml9\RFR0003.JPG
	\\TICRS\EXPORT16\IMAGEOUT16\857\948\85794896\xml9\RFR0004.JPG
ORIGINAL PDF FILE	evi_64252116122-083225314_.140112_AMD_Laser_Evidence.pdf
CONVERTED PDF FILE(S) (8 pages)	\\TICRS\EXPORT16\IMAGEOUT16\857\948\85794896\xml9\RFR0005.JPG
	\\TICRS\EXPORT16\IMAGEOUT16\857\948\85794896\xml9\RFR0006.JPG
	\\TICRS\EXPORT16\IMAGEOUT16\857\948\85794896\xml9\RFR0007.JPG
	\\TICRS\EXPORT16\IMAGEOUT16\857\948\85794896\xml9\RFR0008.JPG
	\\TICRS\EXPORT16\IMAGEOUT16\857\948\85794896\xml9\RFR0009.JPG
	\\TICRS\EXPORT16\IMAGEOUT16\857\948\85794896\xml9\RFR0010.JPG
	\\TICRS\EXPORT16\IMAGEOUT16\857\948\85794896\xml9\RFR0011.JPG
	\\TICRS\EXPORT16\IMAGEOUT16\857\948\85794896\xml9\RFR0012.JPG
DESCRIPTION OF EVIDENCE FILE	TESS listing of the term "PICASSO" and the response to office action admissions of a party in a cited registration

SIGNATURE SECTION

RESPONSE SIGNATURE	/mario g ceste/
SIGNATORY'S NAME	Mario G. Ceste
SIGNATORY'S POSITION	Its Attorney , USPTO #44068
SIGNATORY'S PHONE NUMBER	203-678-6418
DATE SIGNED	01/12/2014
AUTHORIZED SIGNATORY	YES
CONCURRENT APPEAL NOTICE FILED	YES

FILING INFORMATION SECTION

SUBMIT DATE	Sun Jan 12 08:41:37 EST 2014
TEAS STAMP	USPTO/RFR-64.252.116.122-20140112084137290375-85794896-5008195273df58e38a2cf1a7deba956ff9a1ae239eab2d3d8b32a6c5ffaf02940-N/A-N/A-20140112083225314692

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. **85794896** has been amended as follows:

MARK

Applicant proposes to amend the mark as follows:

Current: ZRPICASSO (Stylized and/or with Design)

Color is not claimed as a feature of the mark.

The mark consists of The literal characters ZR with arc shaped paint brushes on the left and right respectively with the word PICASSO underneath the ZR element.

Proposed: ZRPICASSO (Stylized and/or with Design, see [mark](#))

The applicant is not claiming color as a feature of the mark.

The mark consists of The literal characters ZR with arc shaped paint brushes on the left and right respectively with the word PICASSO underneath the ZR element, all letters painted by brush.

ARGUMENT(S)

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

Drawing

The Examiner has rejected the drawing of the mark on the basis that image size did not meet the USPTO limitations and that the drawing is not clear.

A substitute drawing is submitted with this filing and conforms to the pixel size constraints as given in the Examiner's Final Office Action.

With regard to the rejection that the drawing is not clear, the Examiner has maintained the drawing is not acceptable because the lines are not clear, sharp and solid. The applicant states that reason for the appearance as shown is intentional and an important characteristic of the mark. The graphic contains two

paint brushes and it is intended that the mark give the appearance that it was painted using the brushes in broad strokes. The appearance is to look like “smearing” of the paint rather than crisp lines.

Refusal under Section 2 (d) – Likelihood of Confusion

The Examiner has maintained the Section 2 (d) refusal on the basis of resemblance to US Reg Nos 4175515, 4175517, and 3855619. The basis is grounded in similarity of the trade channels and a common impression of the marks.

The applicant respectfully requests the Examiner reconsider the rejection after review of the additional evidence submitted along with the explanations contained herein.

Comparison of the Marks

When determining the impression of a stylized mark and performing a comparison, the Examiner should be giving greater weight to whether there is visual similarity. The applicant’s mark contains several distinctive visual elements namely two arching paint brushes, and the letters which are stylized in artistic manner. These elements dominate the overall commercial impression. None of these elements exist in the reference registrations.

With regard to PICASSO BY AMD LASERS, the mark consists of a phrase which not found in the applicant’s mark. When combined with the dissimilarity based on visual the two marks fail under the DuPont factors, especially when considering the relatedness of the goods (as discussed below).

The Examiner has also cited a likelihood of confusion between the applicant’s mark and Reg Nos. 4175515 & 4175517. The cited marks are commonly owned with the ‘515 mark being a standard character mark and the ‘517 mark being a stylized mark. When making the comparison between the applicant’s mark and the ‘517 mark, the Examiner has not given proper weight to the visual appearance of the two marks.

With regard to the ‘515 mark, the word “PICASSO”, the prior argument of evidence of prior registrations is probative to show the level of distinctiveness. See *In re Dayco Products-Eagle Motive Inc.*, 9 U.S.P.Q.2d 1910, 1911-1912 (TTAB 1988)). Where the phrase (word) is found in registered marks or commonly used, it cannot be afforded wide latitude for purposes of distinctiveness because the public will investigate further in determining the commercial impression. The public will make further inquiry when viewing the mark. The words are merely descriptive or generic. Attached is a TESS listing showing 68 instances of the commercial use of the word “PICASSO”. While not all records indicate a registration, the evidence supports the allegation that there is wide spread use of the term.

Therefore the Examiner should look consider that the inherent weakness in the word “PICASSO” which by itself is not dominate in creating the commercial impression. On this basis there is no likelihood of confusion and the applicant requests that the rejection be withdrawn with regard to 4175515 and 4175517 marks.

Comparison of Goods

The Examiner has alleged that the goods are closely related. In support of this claim the Examiner only evidence is third party registrations where “dental crowns, dental implants”, “dental wax”, and “medical lasers” have been registered under a single mark.

With regard to “medical lasers”, the Examiner’s evidence does not establish that a third party has registered a single mark with covers “medical lasers” and products such as identified in the applicant’s description of goods. Applicant’s contention that the purchasers are sophisticated and that the purchase of a medical laser is conducted with great scrutiny is supported by the attached evidence where the Registrant

(Reg No. 3655619) has stated “the purchasers are sophisticated, careful, and nonimpulsive”. (See highlighted text in Response to Office Action SN 77805095 page 2).

The Examiner has not established necessary evidence to support that the fact that medical lasers travel in the same trade channel as the applicant’s products, that the goods are encountered during purchasing decisions and based on the evidence from registrant it is established that the purchasers of medical lasers are sophisticated. Applicant requests that Examiner reconsider and withdraw her reference to Reg. No. 3655619. There is no similarity in the goods between the applicant’s goods and those covered by the mark “PICASSO BY AMD LASERS”.

With respect to “dental wax” and “dental crowns, dental implants”, the Examiner has relied upon it evidence of third party registrations which contain Class 005 and Class 010 for a single mark. However, the Examiner has not presented evidence that goods in Class 005 and Class 010 travel in similar trade channels. Nor has the Examiner established with this evidence that “they will be encountered by the same consumers under circumstances that would lead to the mistaken belief that the good originate from the same source”.

In determining whether goods and services are related, "it is not enough that the products may be classified in the same category or that a term can be found that describes the product." Signature Brands, Inc. Substituted for Health OMeter, Inc. v. Dallas Technologies Corporation, 1998 WL 80140 (T.T.A.B. 1998). The burden of proof is with the Examiner, and the Examiner has not and cannot show proof that dental wax and dental crowns are encountered by purchasers in the same circumstances.

Dental crowns, dentures and the types of dental appliances described in the applicant’s goods are custom ordered and custom measured. Where as dental wax and the goods identified in the listing for Class 005 (cited by the Examiner) are found in supply catalogs. The Examiner has not recognized and given sufficient weight to the care and circumstances under which the purchase of the products associated with the applicant’s description of goods. Furthermore the Class 010 goods listed in the references the Examiner has chosen are largely medical type instruments and tools. These tools and instruments are sold and encountered under different circumstances than the applicant’s goods. The Examiner has offered no evidence to rebut this fact and the burden of proof to do so lies with the Examiner.

With regard to the arguments previously made by the Applicant, the Applicant maintains its position with regard to those arguments and does concede the Examiner’s statements. Applicant has for efficiency purposes simply chose not to repeat them in totality , all rights are reserved with regard to asserting those arguments in any further proceedings.

Summary

In view of the evidence attached , the Examiner should reconsider and withdraw the refusal to register. The Examiner has not met its burden of proof in rebutting the applicant’s evidence and arguments regarding the relatedness of the goods and the overall commercial impression of its mark.

EVIDENCE

Evidence in the nature of TESS listing of the term "PICASSO" and the response to office action admissions of a party in a cited registration has been attached.

Original PDF file:

[evi_64252116122-083225314 . 140112_Picasso_TESS_List.pdf](#)

Converted PDF file(s) (2 pages)

[Evidence-1](#)

[Evidence-2](#)

Original PDF file:

[evi_64252116122-083225314_.140112_AMD_Laser_Evidence.pdf](#)

Converted PDF file(s) (8 pages)

[Evidence-1](#)

[Evidence-2](#)

[Evidence-3](#)

[Evidence-4](#)

[Evidence-5](#)

[Evidence-6](#)

[Evidence-7](#)

[Evidence-8](#)

SIGNATURE(S)

Request for Reconsideration Signature

Signature: /mario g ceste/ Date: 01/12/2014

Signatory's Name: Mario G. Ceste

Signatory's Position: Its Attorney , USPTO #44068

Signatory's Phone Number: 203-678-6418

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: 85794896

Internet Transmission Date: Sun Jan 12 08:41:37 EST 2014

TEAS Stamp: USPTO/RFR-64.252.116.122-201401120841372

90375-85794896-5008195273df58e38a2cf1a7d

eba956ff9a1ae239eab2d3d8b32a6c5ffaf02940

-N/A-N/A-20140112083225314692



مدد سفید


United States Patent and Trademark Office
[Home](#) | [Site Index](#) | [Search](#) | [FAQ](#) | [Glossary](#) | [Guides](#) | [Contacts](#) | [eBusiness](#) | [eBiz alerts](#) | [News](#) | [Help](#)
Trademarks > Trademark Electronic Search System (TESS)

TESS was last updated on Sun Jan 12 03:10:45 EST 2014

[TESS HOME](#) | [NEW USER](#) | [STRUCTURED](#) | [FREE FORM](#) | [BROWSE DICT](#) | [SEARCH OG](#) | [PREV LIST](#) | [NEXT LIST](#) | [IMAGE LIST](#) | [BOTTOM](#) | [HELP](#)

Logout Please logout when you are done to release system resources allocated for you.

 Start List At: OR Jump to record:

68 Records(s) found (This page: 1 ~ 50)

Refine Search (live)[LD] AND (picasso)[COMB]

Current Search: S1: (live)[LD] AND (picasso)[COMB] docs: 68 occ: 213

	Serial Number	Reg. Number	Word Mark	Check Status	Live/Dead
1	86065231		PAWBLO PICASSO	TSDR	LIVE
2	86145899		PICASSO'S DELIGHTS	TSDR	LIVE
3	86129112		MINI PICASSO	TSDR	LIVE
4	86003079		PICASSO	TSDR	LIVE
5	86121490		PICASSO PIANO ACADEMY	TSDR	LIVE
6	86019990		PICASSOWHAT ART ON A HIGHER LEVEL STUDIO 201	TSDR	LIVE
7	86019312		PICASSO	TSDR	LIVE
8	86094839		TACO PICASSO	TSDR	LIVE
9	86094489		TONY PICASSO	TSDR	LIVE
10	86089016		PICASSO'S PALETTE	TSDR	LIVE
11	85881142		TONY PICASSO	TSDR	LIVE
12	85934682		PICASSO TILES	TSDR	LIVE
13	85768310		PICASSO'S PIZZA	TSDR	LIVE
14	85960594		JOOKS PICASSO	TSDR	LIVE
15	85958925		YP YOUNG PICASSOS	TSDR	LIVE
16	85952596		PROJECT PICASSO	TSDR	LIVE
17	85684673		PICASSO	TSDR	LIVE
18	85852820		PICASSO V	TSDR	LIVE
19	85794896		ZRPICASSO	TSDR	LIVE
20	85487362	4354815	PICASSO IN PINK	TSDR	LIVE
21	85479367	4326672	HILLBILLY PICASSO	TSDR	LIVE
22	85778352		ZRPICASSO	TSDR	LIVE
23	85595996	4253483	PICASSO PAWN LIKE NO PAWN SHOP YOU HAVE EVER SEEN!	TSDR	LIVE
24	85427176	4244532	LAWN PICASSOS	TSDR	LIVE
25	85480361	4175517	PICASSO	TSDR	LIVE

26	85480349	4175515	PICASSO	TSDR	LIVE
27	85463512	4167551	PICTURE PICASSO	TSDR	LIVE
28	85313929	4095742	PN	TSDR	LIVE
29	85315410	4070590	PICASSO	TSDR	LIVE
30	85166364	4054027	PICASSO EXOTIC AQUATICS	TSDR	LIVE
31	79037218	3527681	PICASSO	TSDR	LIVE
32	78711003	3320429	PICASSO	TSDR	LIVE
33	78855140	3388958	PRACTICALLY PIKASSO	TSDR	LIVE
34	78743943	3311844	JP JOHNNY PICASSO'S	TSDR	LIVE
35	78509602	3382771	PABLO PIGASSO	TSDR	LIVE
36	78840524	3390056	PICASSO DVDR	TSDR	LIVE
37	78799338	3279510	PICASSO BUILDERS BUILDING TIMELESS WORKS OF ART	TSDR	LIVE
38	78727803	3359578	PALOMA PICASSO	TSDR	LIVE
39	78475711	3223818	PICASSOFARM PRODUCT OF THE FUTURE THE FUTURE OF TASTE	TSDR	LIVE
40	78370462	3209561	PICASSO	TSDR	LIVE
41	77863022		JOE PICASSO'S THE ARTISTIC EXPERIENCE WITH TASTE	TSDR	LIVE
42	77805112	4415053	PICASSO SERIES	TSDR	LIVE
43	77841107	3912030	PICASSO PAWN	TSDR	LIVE
44	77980641	4133579	JOE PICASSO'S THE ARTISTIC EXPERIENCE WITH TASTE	TSDR	LIVE
45	77629169	3785706	PRETTY MUCH PICASSO	TSDR	LIVE
46	77910300	4127287	JOE PICASSO'S	TSDR	LIVE
47	77805095	3855619	PICASSO BY AMD LASERS	TSDR	LIVE
48	77975714	3522368	PICASSO MOULDINGS INC.	TSDR	LIVE
49	77911233	3831798	PICASSO VETERINARY FUND OF THE MAYOR'S ALLIANCE FOR NYC'S ANIMALS	TSDR	LIVE
50	77911215	3831796	PICASSO VETERINARY FUND OF THE MAYOR'S ALLIANCE FOR NYC'S ANIMALS	TSDR	LIVE

[TESS HOME](#)
[NEW USER](#)
[STRUCTURED](#)
[FREE FORM](#)
[BROWSE DICT](#)
[SEARCH OG](#)
[PREV LIST](#)
[NEXT LIST](#)
[IMAGE LIST](#)
[TOP](#)
[HELP](#)

[HOME](#) |
 [SITE INDEX](#) |
 [SEARCH](#) |
 [eBUSINESS](#) |
 [HELP](#) |
 [PRIVACY POLICY](#)

Response to Office Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	77805095
LAW OFFICE ASSIGNED	LAW OFFICE 106
MARK SECTION (no change)	
ARGUMENT(S)	
<p style="text-align: center;"><u>IN THE UNITED STATES PATENT AND TRADEMARK OFFICE</u> RESPONSE TO OFFICE ACTION</p> <p>Attention: Box Response - No Fee Commissioner for Trademarks P.O. Box 1451 Alexandria, Virginia 22313-1451</p> <p>Madam:</p> <p style="padding-left: 40px;">This responds to the Office Action dated November 20, 2009.</p> <p style="text-align: center;"><u>IDENTIFICATION OF THE GOODS</u></p> <p>Applicant requests deletion of Class 9 and 44 and requests amendment of the identification of services to "lasers for medical purposes" in Class 10.</p> <p style="text-align: center;"><u>ADDITIONAL INFORMATION</u></p> <p>Applicant's goods are not used in whole or in part in the treatment or therapy for age related macro degeneration or other eye related treatment. The term "AMD" has no meaning or significance in the industry and it not a term of art within applicant's industry.</p> <p style="text-align: center;"><u>SUBSTITUTE SPECIMEN</u></p> <p>A substitute specimen accompanies this Response to the Office Action. The substitute specimen consists of the PICASSO BY AMD LASERS product packaging that prominently displays Applicant's mark on the side of the box and used as a trademark.</p> <p>The substitute specimen was in use in commerce at least as early as the filing date of the application.</p> <p>The undersigned, being hereby warned that willful false statements and the like so made are punishable</p>	

by fine or imprisonment, or both, under 18 U.S.C. 1001, and that such willful false statements may jeopardize the validity of the application or any resulting registration, declares that the facts set forth in this application are true; all statements made of his/her own knowledge are true; and all statements made on information and belief are believed to be true.

RESPONSE to 2(d) REFUSAL: LIKELIHOOD OF CONFUSION

The Office has refused registration of Applicant's PICASSO BY AMD LASERS mark on the grounds of a likelihood of confusion with U.S. Registration Nos. 1732055, 3527681, and 3246686:

- (1) AMD, U.S. Registration No. 1732055, for "instruments for performing arthroscopic procedures";
- (2) PICASSO, Registration No. 3527681, for "X-ray apparatus for medical purposes; X-ray photographs for medical purposes"; and
- (3) PICASSO, U.S. Registration No. 3246686, for "Lasers not for medical use."

As discussed in greater detail below, Applicant respectfully disagrees that a likelihood of confusion exists between Applicant's Mark and Registrants' Marks because: (I) the marks present purchasers with separate and unique commercial impressions; (II) the purchasers are sophisticated, careful, and non-impulsive; (III) the marks are different in appearance and sound; (IV) the burden of proof to find a likelihood confusion has not been met; and (V) a significant number of the du Pont factors weigh heavily in Applicant's favor. As such, Applicant requests that the subject trademark application be approved for publication.

I. The Connotations and Commercial Impressions Presented are Substantially Different.

The differences in the connotation alone are enough to support a finding that the marks are not likely to be confused. *See Revlon Inc. v. Jerrell Inc.*, 713 F.Supp. 93 (SDNY 1989) ("differing connotations themselves can be determinative even where identical words with identical meanings are used."). Such is the case here. Applicant submits that upon review of the Registrants' goods, the nature and application of the parties' goods are very different, and therefore there is no likelihood of confusion.

(1) AMD, U.S. Registration No. 1732055

As made clear by the specimens submitted by U.S. Registration No. 1732055, to support registration and maintenance of Registrant's Mark, its AMD product is an "*arthroscopic microdiscectomy* surgery blade" or "full radius blade" and an "incisor shaver blade." (*emphasis added*). (See Exhibit A.)

Specimens submitted by Registrant consisting of product packaging indicating the product is an "**arthroscopic microdiscectomy** surgery blade", "Incisor shaver blade", and a "4.5 AMDT Full Radius Blade", and the packaging includes a drawing of the blade. Accordingly, consumers are without a doubt likely to perceive Registrant's use of AMD as an acronym for **arthroscopic microdiscectomy**, a term used to refer to minimally invasive surgical procedures in which part of a herniated disc is removed. (See Exhibit B: Definitions of the term arthroscopic microdiscectomy.)

On the other hand, Applicant's product is a soft tissue dental laser marketed and sold to dental professionals for use in treating aphthous ulcers and herpetic lesions. (See Exhibit C: press release of AMD Lasers, LLC.) The nature of Applicant's product helps to assure that no reasonable consumer would believe the dental product would necessarily emanate from the same source as Registrant's AMD product for operating on, and removing part of, a herniated disc.

Furthermore, Applicant's mark is an acronym for "**Alan Miller Designed.**" Alan Miller is the Chief Executive Officer and Present of AMD Lasers, LLC. Mr. Miller is integrally involved in the marketing of the Applicant's product. (See Exhibit D: Printouts from Applicant's homepage displaying a picture Alan Miller holding the AMD LASERS product at <http://www.amdlasers.com/> and third party website displaying a picture of Alan Miller in association with an interview with Alan Miller regarding the PICASSO BY AMD LASERS product.) Accordingly, to the extent a consumer were to perceive Applicant's mark as an acronym, it would be perceived as standing for "**Alan Miller Designed.**"

Accordingly, Applicant's PICASSO BY AMD LASERS trademark presents a very different commercial impression than does Registrant's AMD trademark ("Alan Miller Designed" versus "arthroscopic microdiscectomy") when considered in relation to the respective goods.

(2) *PICASSO, U.S. Registration No. 1732055*

Next, the PICASSO mark is registered in connection with "X-ray apparatus for medical purposes; X-ray photographs for medical purposes." Registrant's identification of goods is expressly limited to X-ray apparatuses; therefore the identification of services implicitly excludes lasers. In determining whether goods and services are related, "it is not enough that the products may be classified in the same category or that a term can be found that describes the product." *Signature Brands, Inc. Substituted for Health O Meter, Inc. v. Dallas Technologies Corporation*, 1998 WL 80140 (T.T.A.B. 1998). Specifically, all devices that fall into the category of "medical" are not considered so similar that they increase the likelihood of confusion simply because they involve types of medical equipment; there must be some

context in which additional evidence shows consumers would likely be confused.

Although the Applicant has requested a disclaimer the word LASERS, Applicant further submits that these words cannot be overlooked insofar as they inherently distinguish and narrow the category of services offered by Applicant. "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." TMEP § 1213.10; see also, *In re National Data Corp.*, 753 F.2d 1056, 224 U.S.P.Q. 749 (Fed. Cir. 1985); *Specialty Brands, Inc. v. Coffee Bean Distributors, Inc.*, 748 F.2d 669, 672, 223 USPQ 1281, 1282 (Fed. Cir. 1984); *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 1570, 218 U.S.P.Q. 390, 395 (Fed. Cir. 1983); *Schwarzkopf v. John H. Breck, Inc.*, 340 F.2d 978, 144 U.S.P.Q. 433 (C.C.P.A. 1965); *In re MCI Communications Corp.*, 21 U.S.P.Q.2d 1534, 1538-39 (Comm'r Pats. 1991).

In the present case, Applicant's mark is PICASSO BY AMD **LASERS** (*emphasis added*). The term LASERS is immediately telling of the nature or Applicant's Mark and immediately presents a very unique and distinct commercial impression telling consumers that the mark is used in connection with a laser. Accordingly, it is unlikely that a potential buyer would confuse the respective marks.

Applicant's goods cut and coagulate tissue with reduced trauma, bleeding, and necrosis of tissue and is used for soft tissue surgery. Thus, the laser is used for specialized procedures and not for X-raying. Furthermore, X-ray technicians must be well versed in the use of radioactive materials, and must follow strict guidelines to protect themselves and patients from the radioactivity used to capture X-ray equipment. Those who operated the X-ray machines must go through specialized training and are unlikely to confuse a dental laser marketed and sold to dental professionals for use in treating aphthous ulcers and herpetic lesions with X-ray equipment.

As a result, Applicant's PICASSO BY AMD LASERS trademark presents a very different commercial impression than does Registrant's PICASSO trademark when considered in relation to the respective goods.

(3) *PICASSO, U.S. Registration No. 3246686*

Finally, the PICASSO mark is registered in connection with "Lasers not for medical use." Registrant describes its services as "supporting the defense community by developing and manufacturing lasers [Registrant] is a recognized leader in innovative laser technologies in areas such as infrared

countermeasures (IRCM), laser radar (LADAR) and high power directed energy (DE)." (See Exhibit E: Printout from Registrant's website, evidencing the nature of Registrant's goods, *available at* <http://www.aculight.com/defense.htm>). Registrant's goods are used by the military in connection with fiber laser technology. (See Exhibit F: Press Release on the company's expansion of the Picasso product, *available at* <http://www.aculight.com/Downloads/Picasso%20Family%201-19-06.pdf>, and Exhibit G: Press Release discussing the capabilities of the company's Picasso laser, *available at* http://www.aculight.com/Downloads/Fiber%20laser%20contracts%20release_app.pdf). It is wholly unlikely that a consumer or company seeking laser technology for military defense would *ever* encounter Applicant's product; if a consumer did, he would not assume that the respective products emanate from the same source given the stark differences in the function and purpose the lasers.

(4) *Conclusion*

The connotation of a mark must be determined *in relation* to the goods. Even marks which 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. *See Electronic Design & Sales, Inc. v. Electronic Data Systems*, 954 F.2d 713, 716 (Fed. Cir. 1992) (reversing TTAB finding of likelihood of confusion between EDS for computer hardware component and E.D.S. for data processing services); *NEC Electronics, Inc. v. New England Circuit Sales*, 13 U.S.P.Q.2d 1059 (D. Mass. 1989) (no likelihood of confusion between the marks NEC and NECS where both companies sold computer chips to sophisticated purchasers with specific technical needs); *see also Information Resources v. X*Press Info. Serv.*, 6 U.S.P.Q.2d 1034 (TTAB 1988) (X*PRESS for a news service transmitted through cable television to a personal computer not likely to cause confusion with EXPRESS for highly specialized information analysis computer programs); *Aries Sys. Corp. v. World Book, Inc.*, 26 U.S.P.Q.2d 1926 (T.T.A.B. 1993) (no conflict between INFORMATION FINDER for programs containing general encyclopedic information sold primarily to elementary and secondary schools and KNOWLEDGE FINDER for programs for retrieval of information in specialized medical databases and sold primarily to medical professions).

Upon a closer examination of the specific goods in the Registrants' identifications, Applicant's goods are not related in a manner that would be likely to cause confusion.

II. The Purchasers are Highly Sophisticated

If the consumer of a particular good or service tends to be sophisticated, or if the consumer is inclined to

think carefully before purchasing a product or service, this may be sufficient to dispel any confusion, even between similar marks. *See, e.g., In re Software Design, Inc.*, 220 U.S.P.Q. 662 (T.T.A.B. 1983).

In the case at hand, the nature of the respective goods makes it likely that consumers of the goods would put a great deal of thought into a purchase, and would therefore be sophisticated purchasers.

High-end medical equipment is sold only after a considerable amount of discussion and negotiation between a manufacturer and the purchaser, and "confusion is less likely where goods are expensive."

Magnaflux Corp. v. Sonoflex Corp., 231 F.2d 669, 109 U.S.P.Q. 313, 315 (C.C.P.A. 1956). Both Applicant's and Registrant's goods qualify as high-end medical equipment and thus will be marketed and sold primarily to highly-trained medical professionals. These highly-trained medical professionals make careful, professional purchasing decisions. Such purchases would not be made spontaneously or without thought and, on the contrary, before making such an important purchase, buyers will research the market, and may even attend extensive training seminars to learn how to use a particular device.

Applicant's goods will be marketed and sold to those in the dental industry, and dentists are recognized as highly trained medical professionals who make these careful, professional purchasing decisions.

Through this careful research, purchasers will be aware that Applicant's laser cannot compete with, or be sold as an alternative to, the Registrant's PICASSO brand X-ray equipment. Moreover, purchasers make these careful decisions because they worry about malpractice. Thus, they deal with the manufacturer of these products and ask a lot of questions.

Similarly, the prior cited registrations for the AMD and PICASSO marks are also sold primarily to those in the medical industry and are only used by highly-trained medical professionals. When the goods of the parties are sophisticated medical equipment, they are selected with great care by purchasers familiar with the source or origin of the products. *See In re N.A.D. Inc.*, 754 F.2d 996 (Fed. Cir. 1985).

Any doctor or medical professional puts himself in danger of a malpractice lawsuit unless he carefully considers the medical device he will use to treat any patient. Because of the great care relevant consumers would put into a purchase, these consumers would be unlikely to mistakenly assume that the respective goods came from the same source.

Additionally, consumers purchasing laser technology for military defense are also highly sophisticated purchasers who make careful decisions regarding the defense of our country. Such goods are not purchased on a whim, and consumers will take great care to purchase these non-medical lasers.

For all these reasons, the consumers of these goods are sophisticated purchasers and confusion is unlikely.

III. The Appearance and Sound of the Marks are Different

In comparing the marks, the TMEP §1207.01(b)(i) specifically provides:

The points of comparison for a word mark are appearance, sound, and meaning or connotation. Similarity of the marks in one respect -- sight, sound or meaning -- will not automatically result in a finding of likelihood of confusion even if the goods are identical or closely related. Rather, the rule is that taking into account all of the relevant facts of a particular case, similarity as to one factor alone *may* be sufficient to support a holding that the marks are confusingly similar. *In re Lamson Oil Co.*, 6 U.S.P.Q. 2d 1041, 1043 (T.T.A.B. 1987).

First, in regards to Registrant's AMD mark, although both Applicant and Registrant incorporate the term AMD, the marks are different in appearance and sound in a meaningful way. Applicant's mark is PICASSO BY AMD LASERS which incorporates the term LASERS which, when considered in relation to Applicant's goods, helps to as assure no reasonable consumer would confuse Applicant's laser-based products with Registrant's arthroscopic microdiscectomy surgery blades.

Additionally, while Applicant's mark may be similar in some superficial respects to U.S. Registration No. 3246686 and 3527681, for example, each contain the word "PICASSO," the comparisons end there, and the differences between the marks are quite significant. Applicant's mark contains "BY AMD LASERS" after PICASSO, which creates a wholly distinct sound and impression from just the singular word "PICASSO".

For the foregoing reasons and authorities, Applicant prays that the refusal to register Applicant's mark on the Principal Register on the basis that the mark is confusingly similar to Registrants' Marks be withdrawn.

IV. The Burden of Proof

The burden of proof is on the Examining Attorney to establish the likelihood of confusion. A refusal should be based on an understanding of the relevant industries and an analysis of the marketplace and the likely reaction of prospective purchasers. Substantial evidence is before the Examining Attorney to show that no likelihood of confusion is possible. To maintain this refusal in view of these submissions, significant contrary evidence would be necessary.

V. A Significant Number of the *du Pont* Factors Weigh Heavily in Applicant's Favor

As clearly explained above, a significant number of the *du Pont* factors weigh in Applicant's favor.

These factors are each addressed below, in relation to the present case:

1. Applicant's goods are clearly different from the Registrants' goods;
2. The marks are not identical and present different commercial impressions;
3. The purchasers of Applicant's and Registrants' goods are sophisticated; and
4. The Examining Attorney has not submitted sufficient evidence to support the refusal.

DISCLAIMER

No claim is made to the exclusive right to "LASERS" apart from the mark as shown.

The Examining Attorney has also requested a disclaimer of the word "AMD", stating that the term merely describes "the purpose, characteristic or function of the goods or services *if* for use with age related macular degeneration." (emphasis added). As discussed in detail above, Applicant's "AMD" is an acronym for Alan Miller Designed, and has no relation to age related macular degeneration. As such, Applicant respectfully disagrees with the Examining Attorney's objection that a disclaimer is needed for "AMD."

CONCLUSION

For the foregoing reasons and authorities, Applicant prays that the refusal to register Applicant's mark on the basis that a likelihood of confusion may exist with the cited marks be withdrawn. Applicant has responded to all matters in the Office Action and should the Examining Attorney have any questions with regard to this Response or to any matter relating to this Application, in general, a telephone call to Applicant's undersigned representative at the telephone number listed below would be greatly appreciated.

Respectfully submitted,

/s/ David A. W. Wong _____

David A. W. Wong

BARNES & THORNBURG

Attorney for Applicant

11 South Meridian Street

Indianapolis, Indiana 46204

317-231-7238

david.wong@btlaw.com

INDS02 OFLEMING 1110108v3

EVIDENCE SECTION