

Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	86029696
LAW OFFICE ASSIGNED	LAW OFFICE 102
MARK SECTION (no change)	
ARGUMENT(S)	
<p>In the Office Action dated June 18, 2014 (“Office Action”), the Examining Attorney, Dominic Ferraiuolo, finally refuses registration to the application of Pleiades Consulting Inc. (“Applicant”) to register the trademark “PLEIADES” and design (“Applicant’s Mark”) for “Small robotic aerial vehicles for non-military use” in International Class 012. (Application 86/029,696; the “Application”)</p> <p>The Examining Attorney bases his refusal upon Section 2(d) of the Trademark Act (15 U.S.C. § 1052(d)), specifically, the resemblance of the Applicant’s Mark to Registered Trademark No. 3,567,816 for “PLEIADES” specifying, inter alia, “Vehicles and apparatus for locomotion by air, namely, satellite launch vehicles and space shuttles” also in International Class 012 (“Cited Mark”).</p> <p>Contemporaneously with the filing of this response, the Applicant has applied to amend its specification of goods to “Small robotic aerial vehicles for non-military <u>and non-governmental</u> use”. [additional restriction of specification highlighted]</p> <p>Applicant can hardly deny that the Applicant’s Mark and the Cited Mark are similar, even considering the design element of the Applicant’s Mark or that a Section 2(d) refusal is not limited to cases where the goods or services are not identical as asserted by the Examining Attorney.</p> <p>But the similarity of the marks and the similarities in the goods or services being compared consider only two of the factors set out in <i>In re E. I. du Pont de Nemours & Co.</i>, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) and “Not all <i>du Pont</i> factors are relevant to every case, and only factors of significance to the particular mark need be considered.” <i>In re Mighty Leaf Tea</i>, 601 F.3d 1342, 1346, 94 USPQ2d 1257, 1259 (Fed. Cir. 2010).</p> <p>In this case, Applicant draws the attention of the Examining Attorney to the third and fourth <i>du Pont</i> factors, namely, the similarity or dissimilarity of established , likely to continue trade channels and the conditions under which, and buyers to whom, sales are made.</p> <p>In comparing the goods offered with the trademarks at issue, the goods identified in the applications and registrations are to be compared. <i>Paula Payne Products v. Johnson Publishing Co.</i>, 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973)</p> <p>Without doubt, the channels of trade for consumers buying “small robotic aerial vehicles for non-military and non-governmental use” – consumers buying drones for personal use – is vastly different from that used by the governments of cities, states and countries to buy “satellite launch vehicles and space shuttles”. None of the materials attached to the Office Action suggests otherwise.</p> <p>Just as certainly, the buyers of drones for personal use (for hundreds of dollars) will always be far different than the military and governmental buyers who will spend millions of dollars and use sophisticated purchasing apparatus to buy satellite launch vehicles and space shuttles. [The</p>	

sophistication of these latter buyers provides certain protection against any confusion in the marketplace.]

In a case very similar to this, *In re Shipp*, 4 USPQ2d 1174, 1176 (TTAB 1987), the Board overturned a refusal to register a trademark for laundry and dry-cleaning services where the “literal portion of the applicant’s mark [was] identical to the registered marks”, the registered marks relating to commercial dry-cleaning equipment and dry-cleaning preparations. In doing so the Board held:

Turning to the goods, we believe that the applicant's services and the goods in the cited registrations, while related in the sense that they are all in the laundry and dry cleaning industry, are not so related that they would come to the attention of the same kinds of purchasers and we believe that confusion as to source or sponsorship, while possible, is not likely. Applicant's services are offered to the general public while the pertinent goods of the cited registrations are for use by owners or operators of laundries or dry cleaning establishments. These goods are not ordinarily sold to the general public and we agree with applicant that it is unlikely that applicant's customers would encounter any of the goods encompassed by the cited registrations sold under the PURITAN mark. See: *In re Fesco, Inc.*, 219 USPQ 437 (TTAB 1983).

In summary, in any particular case, any of the *du Pont* factors may play a dominant role. In some cases, a single factor may be dispositive. *Kellogg Co. v. Pack'em Enterprises Inc.*, 9511 F.2d 330, 21 USPQ2d 1142, 1145 (Fed. Cir. 1991) (“we know of no reason why, in a particular case, a single *du Pont* factor may not be dispositive”) In this case, it is not a single factor but rather two factors -- the third and fourth *du Pont* factors – which are dispositive: Consumers buying PLEIADES drones are not going to associate them with launch vehicles for satellites and space shuttles and the military and governments are not going to be confused as to the provenance of the launch vehicles either.

GOODS AND/OR SERVICES SECTION (current)

INTERNATIONAL CLASS	012
DESCRIPTION	Small robotic aerial vehicles for non-military use
FILING BASIS	Section 1(b)

GOODS AND/OR SERVICES SECTION (proposed)

INTERNATIONAL CLASS	012
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TRACKED TEXT DESCRIPTION

~~Small robotic aerial vehicles for non-military use~~; [Small robotic aerial vehicles for non-military or non-governmental use](#)

FINAL DESCRIPTION

Small robotic aerial vehicles for non-military or non-governmental use

FILING BASIS	Section 1(b)
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SIGNATURE SECTION

RESPONSE SIGNATURE	/varlawyer/
SIGNATORY'S NAME	Elliott J. Stein
SIGNATORY'S POSITION	Attorney of Record. Admitted in CA, DC, NJ & NY.

SIGNATORY'S PHONE NUMBER	609.987.7050
DATE SIGNED	12/18/2014
AUTHORIZED SIGNATORY	YES
CONCURRENT APPEAL NOTICE FILED	YES
FILING INFORMATION SECTION	
SUBMIT DATE	Thu Dec 18 17:33:23 EST 2014
TEAS STAMP	USPTO/RFR-64.9.27.98-2014 1218173323797873-86029696 -500e6123daef94155f6f18c5 3af65344e63e1e7adadf468a5 a1269c97b4b8c57-N/A-N/A-2 0141218172511992666

PTO Form 1960 (Rev 9/2007)
OMB No. 0651-0050 (Exp. 07/31/2017)

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

Application serial no. **86029696** has been amended as follows:

ARGUMENT(S)

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

In the Office Action dated June 18, 2014 (“Office Action”), the Examining Attorney, Dominic Ferraiuolo, finally refuses registration to the application of Pleiades Consulting Inc. (“Applicant”) to register the trademark “PLEIADES” and design (“Applicant’s Mark”) for “Small robotic aerial vehicles for non-military use” in International Class 012. (Application 86/029,696; the “Application”)

The Examining Attorney bases his refusal upon Section 2(d) of the Trademark Act (15 U.S.C. § 1052(d)), specifically, the resemblance of the Applicant’s Mark to Registered Trademark No. 3,567,816 for “PLEIADES” specifying, inter alia, “Vehicles and apparatus for locomotion by air, namely, satellite launch vehicles and space shuttles” also in International Class 012 (“Cited Mark”).

Contemporaneously with the filing of this response, the Applicant has applied to amend its specification of goods to “Small robotic aerial vehicles for non-military and non-governmental use”. [additional restriction of specification highlighted]

Applicant can hardly deny that the Applicant’s Mark and the Cited Mark are similar, even considering the design element of the Applicant’s Mark or that a Section 2(d) refusal is not limited to cases where the goods or services are not identical as asserted by the Examining Attorney.

But the similarity of the marks and the similarities in the goods or services being compared consider only two of the factors set out in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) and “Not all *du Pont* factors are relevant to every case, and only factors of significance to the particular mark need be considered.” *In re Mighty Leaf Tea*, 601 F.3d 1342, 1346, 94

USPQ2d 1257, 1259 (Fed. Cir. 2010).

In this case, Applicant draws the attention of the Examining Attorney to the third and fourth *du Pont* factors, namely, the similarity or dissimilarity of established, likely to continue trade channels and the conditions under which, and buyers to whom, sales are made.

In comparing the goods offered with the trademarks at issue, the goods identified in the applications and registrations are to be compared. *Paula Payne Products v. Johnson Publishing Co.*, 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973)

Without doubt, the channels of trade for consumers buying “small robotic aerial vehicles for non-military and non-governmental use” – consumers buying drones for personal use – is vastly different from that used by the governments of cities, states and countries to buy “satellite launch vehicles and space shuttles”. None of the materials attached to the Office Action suggests otherwise.

Just as certainly, the buyers of drones for personal use (for hundreds of dollars) will always be far different than the military and governmental buyers who will spend millions of dollars and use sophisticated purchasing apparatus to buy satellite launch vehicles and space shuttles. [The sophistication of these latter buyers provides certain protection against any confusion in the marketplace.]

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In summary, in any particular case, any of the *du Pont* factors may play a dominant role. In some cases, a single factor may be dispositive. *Kellogg Co. v. Pack'em Enterprises Inc.*, 9511 F.2d 330, 21 USPQ2d 1142, 1145 (Fed. Cir. 1991) (“we know of no reason why, in a particular case, a single *du Pont* factor may not be dispositive”) In this case, it is not a single factor but rather two factors -- the third and fourth *du Pont* factors – which are dispositive: Consumers buying PLEIADES drones are not going to associate them with launch vehicles for satellites and space shuttles and the military and governments are not going to be confused as to the provenance of the launch vehicles either.

CLASSIFICATION AND LISTING OF GOODS/SERVICES

Applicant proposes to amend the following class of goods/services in the application:

Current: Class 012 for Small robotic aerial vehicles for non-military use

Original Filing Basis:

Filing Basis: Section 1(b), Intent to Use: The applicant has had a bona fide intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the identified goods and/or services as of the filing date of the application. (15 U.S.C. Section 1051(b)).

Proposed:

Tracked Text Description: ~~Small robotic aerial vehicles for non-military use;~~ [Small robotic aerial](#)

[vehicles for non-military or non-governmental use](#)

Class 012 for Small robotic aerial vehicles for non-military or non-governmental use

Filing Basis: Section 1(b), Intent to Use: The applicant has a bona fide intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the identified goods and/or services as of the filing date of the application. (15 U.S.C. Section 1051(b)).

SIGNATURE(S)

Request for Reconsideration Signature

Signature: /varlawyer/ Date: 12/18/2014

Signatory's Name: Elliott J. Stein

Signatory's Position: Attorney of Record. Admitted in CA, DC, NJ & NY.

Signatory's Phone Number: 609.987.7050

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: 86029696

Internet Transmission Date: Thu Dec 18 17:33:23 EST 2014

TEAS Stamp: USPTO/RFR-64.9.27.98-2014121817332379787

3-86029696-500e6123daef94155f6f18c53af65

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N/A-20141218172511992666