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

Proceeding	86141386
Applicant	Integrated Embedded dba Barr Group
Applied for Mark	B G
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In re Application of	)	
	)	
Integrated Embedded, DBA Barr Group	)	
	)	EX PARTE APPEAL
App. No.: 86/141,386	)	
	)	
Trademark: B g	)	
	)	
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APPLICANT'S REPLY BRIEF

I. INTRODUCTION

Applicant appeals the trademark examining attorney's refusal to register the applied-for mark consisting of a *portion* of an *uppercase* "B" and a *portion* of a lower case "g" in a box in International Class 045 based on a likelihood of confusion with a mark consisting of *capital* "B" and *capital* "G" in U.S. Registration No. 3073394 under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d).

II. SECTION 2(d) LIKELIHOOD OF CONFUSION REFUSAL TO REGISTER

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. 15 U.S.C. §1052(d). While the 13 factors identified *In re E.I. DuPont De Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (CCPA 1973) are considered (when they are of record), "any one of the factors may control a particular case." *Id.* at 1361-62. "Whether a likelihood of confusion exists is 'a question of law based on underlying facts' [and it] is determined on a case-specific basis." *In re Dixie Rests., Inc.*, 105 F.3d 1405, 1406 (Fed. Cir. 1997).

In this case, the examiner has focused on the alleged: (a) similarity of the marks; and (b) similarity or relatedness of the services. Examiner's Brief, at 2. In light of Applicant's arguments of record, Applicant believes that the examiner has failed to meet her burden of proof to show that there is a likelihood of confusion between U.S. Registration No. 3073394 and the applied-for mark.

A. Similarity of the Marks: The examiner argues that the "applied-for mark is comprised of the letter "B" followed by the letter "G" in a box and the registered mark is the letters "BG" in minimally stylized type." Examiner's Brief, at 2. Based on the examiner's limited description, the examiner concludes that "the marks are similar in all aspects." *Id.* Contrary to the examiner's description, and as further described in applicant's Appeal Brief, there are a number of differences between the applied-for mark and the registered mark. While the examiner describes these differences as "minor" the examiner fails to specifically address the similarities and differences between the marks, and to weigh these against one another to see which dominate the respective marks and whether or not there is a likelihood of confusion.

In considering the issue of likelihood of confusion, it is the impression that the mark as a whole creates on the average reasonably prudent buyer and not the parts thereof that is important. *Estate of P.D. Beckwith, Inc. v. Commissioner of Patents*, 252 US 538-545-46 (1920). The marks are compared in their entireties for similarities in appearance, sound, connotation, and commercial impression. *In re Viterra Inc.*, 671 F.3d 1358, 1362 (Fed. Cir. 2012). Whether there are both similarities and differences between marks, these must be weighed against one another to see which predominate. *Price Candy Co. v. Gold Medal Candy Corp.*, 105 USPQ 266, 268 (C.C.P.A. 1955).

As admitted by the examiner, the registered mark is the letters "BG" in a minimally *stylized* type. Examiner's Brief, at 2. Viewing the stylized type, the dominant portion of the mark BG is the capital "G" which appears to be at least twice as wide as the capital "B".

Conversely, the dominant portion of the applied-for mark is the *portion* of the capital "B" which occupies approximately 2/3 of the box the applied-for mark is included within. Accordingly, the dominant portion of the registered mark is the capital "G" and the dominant portion of the applied for mark is a portion of a capital "B" and it cannot be said that the dominant portion of the registered mark and the applied-for mark are the same. Rather, they are dissimilar.

The facts of this case are similar to the facts before the United States Court of Customs and Patent Appeals in *Price Candy Co. v. Gold Medal Candy Corp.*, 220 F.2d 759 (C.C.P.A. 1955) where the Court found that the dominant portion of the opposer's mark was not Turkish and the dominant portion of the applied-for mark was Turks. As that Court said "when these parts of the respective marks are compared, there is no confusing similarity since they do not look alike or sound alike." *Id.*, at 834. Here, there is no confusing similarity between the dominant portion "G" of the registered mark and partial B in the applied-for mark. Moreover, applicant's contention that the partial B is the dominant portion of the applied-for mark over the small "g" is further supported by the differences between the portion of the *capital* "B" and the portion of the *lower case* "g". Clearly, the examiner failed to meet her burden of proof of showing likelihood of confusion because she failed to consider both the similarities and dissimilarities of the registered mark and the applied-for mark. *See Price Candy Co.*, 220 F.2d at 762 ("in determining the question of confusing similarity of trade-marks, similarities and dissimilarities therein should both be considered.").

B. <u>Relatedness of Services:</u> U.S. Registration No. 3073394 is for services in International Class 042 and not for services in International Classes 041 or 045. The services for the applied-for mark are in International Classes 041, 042 and 045.

1. IC 045: The services listed for U.S. Registration No. 3073394 in International Class 042 are for: "Legal services." Conversely, the services for the applied-for mark in IC 045 are for "Expert witness services in legal matters in the field of design of computer hardware, integrated circuits, communications hardware and software and computer networks for others."

In its Appeal Brief, applicant argued that a "review of the owner of the registered mark's (Bracewell & Giuliani) website shows that the firm does not appear to offer expert witness services in legal matters in the field of design of computer hardware, integrated circuits, communications hardware and software and computer networks for others – *i.e.*, the services associated with Applicant's applied-for mark in IC 045." Applicant's Brief, at 8. Relying on this difference, applicant argued that the "nature of services are different and there is no likelihood of confusion between the registered mark and Applicant's applied for mark." *Id.* The examiner responses by arguing that applicant's "expert witness services in legal matters in the field of design of computer hardware, integrated circuits, communications hardware and software and computer networks for others" are related to the "legal services" in the registration as shown by the third party website evidence of record." Examiner's Brief, at 4. The examiner continues by arguing that "[t]he evidence of record shows that legal services and expert witness are commonly offered together by the same entity, under the same mark, and in the same channels of trade." *Id.*, at 5. The examiner then cites to material from the Internet that allegedly show that a number of law firms offer both legal services and expert witness services. However, not one of the law firm's websites demonstrate a relationship between a law firm that offers legal services and "[e]xpert witness services in legal matters in the field of design of computer hardware, integrated circuits, communications hardware and software and computer networks for others." Accordingly, the websites relied on by the examiner fail to show that law firms that offer legal services also offer "[e]xpert witness services in legal matters in the field of design of computer hardware, integrated circuits, communications

hardware and software and computer networks for others."

C. The Number and Nature of Similar Marks In Use on Similar Goods: Applicant has relied on a number of third party registrations that include the term "BG" to show that the mark is weak and diluted. The examiner has stated that applicant's reliance on these third party registrations "are generally entitled to like weight in determining the strength of a mark." Examiner's Brief, at 3. The examiner argues that the "weakness or dilution of a particular mark is generally determined in the context of the number and nature of similar marks *in use in the marketplace* in connection with *similar* goods and/or services. *Id.* Contrary to the examiner's argument, "third-party registrations may be considered to show that a registered mark is weak because it is descriptive or suggestive" as long as the goods are considered. *In re Thor Tech, Inc.*, 90 USPQ2d 1634 (P.T.O. Apr. 22, 2009). U.S. Registration Nos. 3893374; 3034480; 3814849; 1887647; and 1878202 are each in International Class 042 – the same class as U.S. Registration No. 3073394. Copies of these registrations are of record.

III. CONCLUSION

Applicant has demonstrated that there is no likelihood of confusion between the applied-for mark in International Class 045 with U.S. Registration No. 3073394 for BG in IC 042. In view of the foregoing, it is respectfully requested that the Board reverse the refusal and allow the applied-for mark to proceed to publication.

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Respectfully submitted,

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