

Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	86194609
LAW OFFICE ASSIGNED	LAW OFFICE 101
MARK SECTION (no change)	
EVIDENCE SECTION	
EVIDENCE FILE NAME(S)	
ORIGINAL PDF FILE	evi_102011299-20150603173902858449_.Request_for_Reconsideration_NEXUSTOURS_Class_43.p
CONVERTED PDF FILE(S) (8 pages)	\\TICRS\EXPORT16\IMAGEOUT16\861\946\86194609\xml11\RFR0002.JPG
	\\TICRS\EXPORT16\IMAGEOUT16\861\946\86194609\xml11\RFR0003.JPG
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DESCRIPTION OF EVIDENCE FILE	Request for Reconsideration argument.
GOODS AND/OR SERVICES SECTION (current)	
INTERNATIONAL CLASS	043
DESCRIPTION	
Travel agency services, namely, the making of reservations and bookings for temporary lodging, meals and temporary accommodations; making hotel reservations for others; arranging and reserving temporary accommodations and providing facilities for meetings, seminars, conferences and for exhibits	

FILING BASIS	Section 1(b)
GOODS AND/OR SERVICES SECTION (proposed)	
INTERNATIONAL CLASS	043
TRACKED TEXT DESCRIPTION	
<p>Travel agency services, namely, the making of reservations and bookings for temporary lodging, meals and temporary accommodations; arranging and provisioning of temporary lodging, meals and temporary accommodations; making hotel reservations for others; in-destination making of hotel reservations for others; arranging and reserving temporary accommodations and providing facilities for meetings, seminars, conferences and for exhibits; in-destination arranging and reserving temporary accommodations and providing facilities for meetings, seminars, conferences and for exhibits.</p>	
FINAL DESCRIPTION	
<p>In-destination arranging and provisioning of temporary lodging, meals and temporary accommodations; in-destination making of hotel reservations for others; in-destination arranging and reserving temporary accommodations and providing facilities for meetings, seminars, conferences and for exhibits.</p>	
FILING BASIS	Section 1(b)
SIGNATURE SECTION	
RESPONSE SIGNATURE	/peter j. riebling/
SIGNATORY'S NAME	Peter J. Riebling
SIGNATORY'S POSITION	Attorney of Record, District of Columbia Bar Member
SIGNATORY'S PHONE NUMBER	202 625 3598
DATE SIGNED	06/03/2015
AUTHORIZED SIGNATORY	YES
CONCURRENT APPEAL NOTICE FILED	YES
FILING INFORMATION SECTION	
SUBMIT DATE	Wed Jun 03 17:41:49 EDT 2015
TEAS STAMP	USPTO/RFR-10.20.112.99-20 150603174149051074-861946 09-530f1aedd8eb7a8c73af67 c364ff1611ea8977945b42f7c 2ad9593f0d98d7fa1-N/A-N/A -20150603173902858449

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

Application serial no. **86194609** has been amended as follows:

EVIDENCE

Evidence in the nature of Request for Reconsideration argument. has been attached.

Original PDF file:

[evi_102011299-20150603173902858449_. Request for Reconsideration NEXUSTOURS Class 43.pdf](#)

Converted PDF file(s) (8 pages)

[Evidence-1](#)

[Evidence-2](#)

[Evidence-3](#)

[Evidence-4](#)

[Evidence-5](#)

[Evidence-6](#)

[Evidence-7](#)

[Evidence-8](#)

CLASSIFICATION AND LISTING OF GOODS/SERVICES

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

Current: Class 043 for Travel agency services, namely, the making of reservations and bookings for temporary lodging, meals and temporary accommodations; making hotel reservations for others; arranging and reserving temporary accommodations and providing facilities for meetings, seminars, conferences and for exhibits

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: ~~Travel agency services, namely, the making of reservations and bookings for temporary lodging, meals and temporary accommodations;~~ [In-destination arranging and provisioning of temporary lodging, meals and temporary accommodations;](#) ~~making hotel reservations for others;~~ [in-destination making of hotel reservations for others;](#) ~~arranging and reserving temporary accommodations and providing facilities for meetings, seminars, conferences and for exhibits;~~ [in-destination arranging and reserving temporary accommodations and providing facilities for meetings, seminars, conferences and for exhibits.](#)

Class 043 for In-destination arranging and provisioning of temporary lodging, meals and temporary accommodations; in-destination making of hotel reservations for others; in-destination arranging and reserving temporary accommodations and providing facilities for meetings, seminars, conferences and for

exhibits.

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: /peter j. riebling/ Date: 06/03/2015

Signatory's Name: Peter J. Riebling

Signatory's Position: Attorney of Record, District of Columbia Bar Member

Signatory's Phone Number: 202 625 3598

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: 86194609

Internet Transmission Date: Wed Jun 03 17:41:49 EDT 2015

TEAS Stamp: USPTO/RFR-10.20.112.99-20150603174149051

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A-N/A-20150603173902858449



word mark and Registration No. 3,783,189 for the different mark  in Class 39. Applicant respectfully requests that the Examining Attorney reconsider the refusal to register for the new reasons set forth below.

When determining a likelihood of confusion, applications must be examined on a case-by-case basis to determine the appropriate weight given to each likelihood of confusion factor. See In re E.I. du Pont de Nemours & Co., 476 F. 2d 1357, 177 USPQ 563 (C.C.P.A. 1973). Furthermore, it is important to consider *the commercial realities* that exist when determining whether the “relevant consumers” for Applicant's services are likely to be confused. As the Federal Circuit has said:

We are not concerned with mere theoretical possibilities of confusion, deception, or mistake or with de minimis situations but with the practicalities of the commercial world, with which the trademark laws deal.

Electronic Design & Sales Inc. v. Electronic Data Systems Corp., 21 U.S.P.Q.2d 1391 (Fed. Cir. 1992).

When those commercial realities are properly considered, the following Du Pont factors are most relevant:

- The similarity or dissimilarity and nature of the goods or services; and
- The similarity or dissimilarity of trade channels.

Applicant respectfully submits that an application of the factors stated here will demonstrate that no likelihood of confusion exists between Applicant's mark and the cited Registrant's mark for at least two primary reasons: (1) Applicant and Registrant provide dissimilar services targeted to distinct sets of consumers; and (2) Applicant's and Registrant's respective services are sold in different markets through dissimilar trade channels.

The Applicant’s and Registrant’s Services Are Very Dissimilar

A likelihood of confusion may be said to exist only where *both* (1) an applicant’s mark is similar to the cited registered mark in terms of sound, appearance or commercial impression, and (2) the applicant’s services are so related to the registrant’s services that a confusion as to the source of the services is likely. See In re E.I. DuPont de Nemours & Co., 177 USPQ 563 (CCPA 1973); In re August Storck KG, 218 USPQ 823 (TTAB 1983).

Registrant’s Services	Applicant’s Services
Travel agency services, namely, making reservations and bookings for <i>transportation</i> .	<i>In-destination</i> arranging and provisioning of temporary lodging, meals and temporary accommodations; in-destination making of hotel reservations for others; in-destination arranging and reserving temporary accommodations and providing facilities for meetings, seminars, conferences and for exhibits.

Applicant has substantially narrowed its description of services. The respective services are unequivocally *not* identical. Nor are they highly related.

The narrowed description defines the Applicant's services in such a way that the Applicant’s services are distinguishable from those in the cited registration. In particular, the amendment places a further narrowing *limitation and restriction* that the Applicant’s services are all provided "in destination" (i.e. literally at the actual destination). Applicant's services have been restricted such that there is no overlap in the nature of local on-site events products being "reserved" and arranged and the distant "transportation" services of the cited registration provided to Registrant’s consumers many months before when an airline flight was booked. In addition, the amended services still lack any reference whatsoever to "transportation."

Applicant's and Registrant's services are dissimilar and serve very different purposes. Applicant's services are *not* travel agency services. Applicant's services are *not* arranging bookings and reservations for transportation or airline flights to far away destinations. Rather they are services of reserving of various dining and lodging products, provided *in-destination*, well *after* and far removed from the point at which the cited registration's "travel agency services" are engaged. The two services could not be farther apart.

The mere fact that the services of Applicant and the cited Registrant both broadly involve "reservations and bookings" is too tenuous a connection to conclude that the services are sufficiently similar to create a likelihood of confusion. The cases are legion that more than merely the same broad field, category or industry is required for similarity of services. See, e.g.:

In re Reed Business Information Limited, Serial No. 75558110 (T.T.A.B. June 22, 2001) (travel agency services not similar to air transportation industry information services nor to computer software used in air transportation industry);

In re Iberia, Lineas Aereas de Espana S.A., Serial No. 75743430 (T.T.A.B. August 27, 2001) (travel agency services not similar to airline baggage inspection services);

In re Above & Beyond, Serial No. 75167440 (T.T.A.B. August 27, 1999) (travel agency services not similar to travel agent training services);

American Automobile Association v. Diamond Tours, Proceeding No. 92022491 (T.T.A.B. December 29, 1997) (travel agency services not similar to hotel certification services);

Calypso Tech. Inc. v. Calypso Capital Mgmt., 100 U.S.P.Q.2d 1213, 1222 (T.T.A.B. 2011) ("CALYPSO" can co-exist in the same broad field of financial services);

In re Force Technology, Serial No. 79040079 (T.T.A.B. June 19, 2009) (non-precedential) (goods falling in the broad category of "nautical" or "marine" goods found to be distinctly different);

Homeowner's Group, Inc. v. Home Marketing Specialists, Inc., 18 U.S.P.Q.2d 1587, 1594 (6th Cir. 1991) (no likelihood of confusion between marketing and advertising support services for real estate brokers under **HMS** and providing real estate brokerage services under **HMS HOME MARKETING SPECIALISTS**);

Electronic Design & Sales, Inc. v. Electronic Data Systems Corp., 954 F.2d 713 (Fed. Cir. 1992) (finding there was no likelihood of confusion between **E.D.S.** for computer services and **EDS** for power supplies and battery chargers, even when, in some instances, both products were sold to the same hospitals);

M2 Software, Inc. v. M2 Communications, Inc., 450 F.3d 1378, 78 U.S.P.Q.2d 1944 (Fed. Cir. 2006) (finding **M2 COMMUNICATIONS** for interactive CD-ROMs containing educational information in the pharmaceutical and medical fields not confusingly similar to **M2** for use with multimedia applications for entertainment, education and information, in the music and film industries);

CBS, Inc. v. Liederman, 33 U.S.P.Q.2d 1333, 1337 (S.D.N.Y. 1994) (television production facility and a restaurant are both "tourist attractions" but they are not "related");

Amstar Corp. v. Domino's Pizza, Inc., 205 U.S.P.Q. 969, 977 (5th Cir. 1980) (sugar and pizza are both "food," but they are not considered "related" goods for purposes of the likelihood of confusion analysis);

In re British Bulldog, 224 U.S.P.Q. 854, 856 (TTAB 1984) (shoes and men's underwear are both "clothing," but they are not "related");

Jacobs v. International Multifoods Corp., 212 U.S.P.Q. 641, 642 (C.C.P.A. 1982) (“Food products” are not related to “food services”);

In re Quadram Corp., 228 U.S.P.Q. 863 (TTAB 1985) (“Hardware” is not automatically related to “software”);

In re Mars, Inc., 741 F.2d 395, 22 U.S.P.Q. 938 (Fed. Cir. 1984) (use of **CANYON** for candy bars not likely to cause confusion with registered mark **CANYON** for fresh citrus fruit);

AM General Corp., 311 F.3d at 828, 65 U.S.P.Q.2d at 1023 (different types of SUV's at different price points not sufficiently similar); and

Westward Coach Manuf. Co., Inc. v. Ford Motor Co., 388 F.2d 627, 635 (7th Cir. 1968) (trailers and automobiles, both marketed under the “MUSTANG” trademark, not sufficiently similar).

Determining the similarity of services is ultimately based on common sense and common experience. ITT Corp. v. XTRA Corp., 225 U.S.P.Q. 723, 732 (D. Mass 1985). “The Board... has found no likelihood of confusion even with respect to identical marks applied to goods and or services used in a common industry where such goods and or services are clearly different from each other and there is insufficient evidence to establish a reasonable basis for assuming that the respective goods as identified by their marks, would be encountered by the same purchasers.” Borg-Warner Chem, Inc. v. Helena Chem. Co., 225 U.S.P.Q. 222, 224 (TTAB 1983).

The same is true in this situation. Each party offers services that have some nexus to reservations and bookings. Beyond that broad and vague similarity, however, Applicant respectfully submits that the respective services have wide and significant differences. The

services at issue here in App. No. 86/194,609 are sufficiently remote and different to allow for Applicant's services to coexist in the broad category of “reservations and bookings” without any appreciable likelihood of confusion.

The Examining Attorney cited a small number of registrations to support a finding that consumers would believe Applicant's services may come from the same source as the cited Registrant. Applicant respectfully submits, however, that this is insufficient to overcome the other factors discussed herein that weigh heavily against a conclusion that the relevant consumers for Applicant's services are likely to be confused. See In re Itec Mfg., Ltd., Serial No. 78621722 (T.T.A.B. February 13, 2008) (non-precedential) (five third-party registrations deemed unpersuasive evidence on the relatedness of goods, particularly in light of the sophisticated nature of purchasers of the medical equipment covered by the application at issue); see also In re Coors Brewing Co., 68 U.S.P.Q.2d 1059, 1063 (Fed. Cir. 2003) (a small number of third-party registrations cited for the purpose of proving the relatedness of goods can actually suggest that it is quite uncommon for two different types of products to emanate from the same source).

The Channels Of Trade Of The Respective Services Are Very Dissimilar

In addition to all of the above factors which make confusion extremely unlikely, the services of Applicant and those of the cited Registrant are marketed primarily through very different channels of trade. Applicant’s local in-destination reservations market is an entirely different market from the arranging transportation to a destination before a trip market. The cited Registrant markets to consumers long *before* a trip or airline flight to a destination is taken. Applicant by stark contrast markets to consumers *after* consumers have arrived and checked-in at a destination, when they are searching for local, in-destination and immediate on-site

restaurants or lodging. Applicant's services are far removed from the point at which the cited registration's "travel agency services" are engaged. There is an undeniable difference in the channels of trade between Registrant's consumer buying a future flight over the Internet or telephone while still at work or home, and Applicant's consumer, after in-destination arrival, making a reservation for dinner at local restaurant from Applicant after "places to eat" recommendations from a local hotel desk concierge.

NOTICE OF APPEAL

Applicant is filing a Notice of Appeal to the Trademark Trial and Appeal Board in conjunction with this Request for Reconsideration.

CONCLUSION

In addition to the differences between the marks in appearance and connotation as previously outlined by Applicant in its prior Response, the additional new reasons of Applicant's amended services, dissimilar services and dissimilar channels of trade provide a further basis supporting no likelihood of confusion. For all of these reasons, Applicant respectfully submits that it is highly unlikely that relevant consumers of Applicant would be confused as to source or origin of Applicant's services marketed under the Applicant's mark. Applicant, therefore, requests that the application be allowed to proceed to publication. There will be an opportunity for other parties to raise an objection, if they see a need to do so, notwithstanding the marketplace realities described herein.