

TTAB

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



In re Trademark Application of)
)
Hughes Supply Management)
Services, Inc.)
)
Serial No.: 75/907,894)
)
Filed: February 2, 2000)
)
For: OH-SO-SOFT)
_____)

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APPLICANT'S REPLY BRIEF

Applicant, Hughes Supply Management Services, Inc., by and through its undersigned counsel, hereby files this reply brief in response to the Examining Attorney's Appeal Brief filed on or about January 2, 2002.

Difference in Sight, Sound and Meaning of the Trademarks

The crux of the Examining Attorney's argument is that because the two marks OH-SO-SOFT and O-SO-PURE contain phonetically similar prefixes, and these prefixes are dominant portions of the mark, then similarity in sound alone is sufficient to find a likelihood of confusion. The Examining Attorney cites the case of *Molenaar, Inc. v. Happy Toys Inc.*, 188 U.S.P.Q. 469 (TTAB 1975), and the case of *In re Cresco Mfg. Co.*, 138 U.S.P.Q. 401 (TTAB) 1963, for the proposition that in regard to prefixes of the mark,

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similarity in sound alone is sufficient to find a likelihood of confusion. *See, Examiner's Brief, pg. 3 – para. 2.* However, the Examiner has stretched the rationale of these cases to apply to the present case.

In the *Molenaar* case, the two marks in question included FINGER.MAGIC for building toys and RINGA.MAJIGS for toys, namely connectible members and blocks. In *Molenaar*, the Board, while noting the marks were phonetically similar, did not distinguish between prefixes and suffixes. Indeed, the marks' prefixes and suffixes are very similar in the *Molenaar* case. In contrast, in the present case, the last syllables "SOFT" and "PURE" bear no resemblance; nor do the words "SOFT" and "PURE" sound similar. Thus, *Molenaar* is clearly distinguishable.

Similarly, in the case of *In re Cresco*, the Board found the likelihood of confusion between "CRESCO" and "KRESSCO." As in the *Molenaar* case, the Court considered the marks as a whole, and while noting certain differences in appearance, found that "CRESCO" and "KRESSCO" were phonetically identical. In contrast, there are phonetic differences in this case, which is not consistent with the decisions in *Cresco* or *Molenaar*. In each of these cited cases, the board did not separate the marks into prefixes and suffixes because the entire marks sounded identical, which is not the case in the present application.

The Examining Attorney also attempts to diminish the application of *In re Hearst Corporation*, 982 F.2d 493, 25 USPQ2d 1238 (Fed. Cir. 1993). In doing so, however, the Examiner does not accurately set forth the reasoning of the Court's opinion in that case. The Examiner tries to distinguish *Hearst* arguing that both marks in the *Hearst* case had

some descriptive significance as compared to the present marks, which incorporate allegedly dominant arbitrary prefixes.

The Applicant cited this case for its reliance upon the long-standing proposition that the Federal Circuit considered the appearance, sound, sight and commercial impression of the mark “VARGA GIRL.” The Board considered the principal factors relevant to the case as relating to the similarity of “VARGA GIRL” and “VARGAS” and the identity of the goods (calendars) and channels of trade. While the Examiner makes some issue that the calendars included drawings of females created by an artist, Alberto Vargas, the Federal circuit noted that the Applicant’s proposed registration was not restricted as to the theme of the “VARGA GIRL” calendars. Accordingly, the Court did not apply any descriptive distinctiveness of these terms as suggested by the Examiner.

Relevant Purchasers, Trade Channels – Conditions under which goods are purchased

The Applicant has provided undisputed evidence that the Applicant’s goods are sold at a wholesale level, and include goods that are very expensive. The purchases include water well drillers, plumbing contractors, etc. See Applicant’s Initial Brief, pg. 9, para. 3-5. The Examiner argued that the Applicant offers no reason why wholesale water well drillers, water treatment specialists, plumbing contractors, etc., are likely to be confused. The Applicant is somewhat dismayed at this statement, inasmuch as the Applicant’s initial brief is quite clear in setting forth why these purchasers, or the relevant purchasing public, will not likely be confused.

The Applicant sets forth, on page 9 of its brief, that sophisticated purchasers obtain Applicant’s goods since they are sold wholesale to water well drillers, water

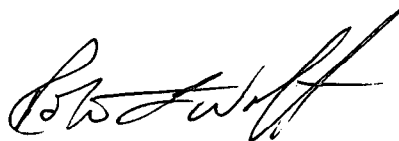
treatment specialists, etc. The Applicant clearly provides that these are expensive dollar items, which the relevant purchasing public will not rush in to purchase without prior information or being well informed. Thus the purchases will have prior knowledge of the Applicant's goods before making such a purchase. This evidence is undisputed.

The Examiner takes the position that the relevant purchasing public is not so limited, but may include any category of persons who may encounter the marks, including truckers or transporters. The appropriate category of purchasers is the "relevant purchasing public." Truckers and transporters are not purchasers of the goods of the Applicant. While the cited registration may carry a presumption that the goods recited therein move through wholesale and retail distribution channels, Applicant has clearly provided evidence that the relevant purchasing public is not so varied.

The cases of *In re Optica International* and *In re Arctic Electronics*, cited by the Examiner, certainly do not support the contention that the relevant purchasing public may be include truckers or transporters of the products. See Examiner's Brief, pg. 7-8. These cases support the position that the relevant public may not only include those who purchase the product, but also those who use the product. Distributors or transports of the products are not users of the products. Moreover, there is no evidence before the Board that any users of the product would be confronted with both of these marks. Accordingly, the evidence of the relevant purchasing public as sophisticated and knowledgeable purchasers must mitigate against a finding that the goods or the parties are related, or that there exists any confusion in the present case.

WHEREFORE, Applicant respectfully requests that the Board reverse the Examiner's final refusal to register Applicant's mark and allow the application to pass to publication.

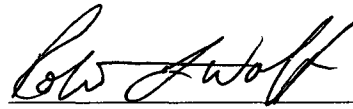
Respectfully submitted,



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CERTIFICATE OF MAILING

I HEREBY CERTIFY that this Reply Brief is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: BOX TTAB/FEE, Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3513, on this 22nd day of January, 2002.

A handwritten signature in cursive script, appearing to read "Robert L. Wolter", written over a horizontal line.

Robert L. Wolter