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

In re Application of  
The Murray Company  
Serial No: 76/465,812  
Filed: November 8, 2002  
Mark: MURRAY COMPANY & DESIGN

Law Office 116

Examining Attorney:  
Kristina Kloiber

**APPLICANT'S REPLY TO THE EXAMINING ATTORNEY'S APPEAL BRIEF**

The Murray Company ("Applicant") submits this Brief in reply to the Examining Attorney's Appeal Brief (the "Examiner's Brief") electronically mailed to Thad N. Leach of the Lewis, Rice and Fingersh, L.C. law firm on March 17, 2005. This Reply Brief is timely filed within twenty (20) days of the date that the Examiner's Brief was mailed. For the reasons cited herein and in the Brief for Applicant filed on June 25, 2004 and re-filed on January 18, 2005 (the "Applicant's Brief"), Applicant respectfully requests that the Trademark Trial and Appeal Board (the "TTAB") reverse the Examining Attorney's decision on the grounds that Applicant's mark MURRAY COMPANY & Design (Ser. No. 76/465,812) ("Applicant's Mark") does not create a likelihood of confusion with the registered mark M MURRAY (stylized) (Reg. No. 1,264,473) (the "Cited Mark").

**STATEMENT OF THE ISSUE**

The Examining Attorney correctly framed the issue on this appeal as whether Applicant's Mark, when used in connection with the identified services, so resembles the Cited Mark so as to be likely to cause confusion, to cause mistake or to deceive under Trademark Act Section 2(d).

**POSITIONS OF THE PARTIES CONCERNING THE ISSUE**

The Examining Attorney maintains that the dominant portion of each of the marks is the surname MURRAY, and therefore, the marks are likely to cause confusion in the marketplace



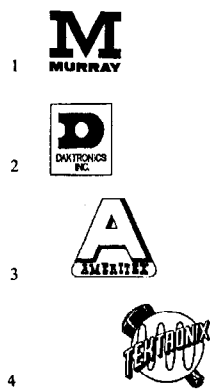
when used in connection with services in the field of construction management and general contracting (collectively, the “Construction Industry”). *Examiner’s Brief*, p. 5. The Examining Attorney also argues that consumers of Construction Industry services can be presumed to be relatively unsophisticated in purchasing such services, due to the fact that neither Applicant nor the owner of the Cited Mark expressly limits the description of services associated with each application to sophisticated purchasers. *Examiner’s Brief*, p. 11. Conversely, Applicant argues that it is evident that (i) the “M” portion of the Cited Mark predominates over the other elements of the Cited Mark, (ii) Applicant’s Mark contains no similar design or stylized element and (iii) the “MURRAY” elements of each mark are substantially dissimilar in appearance, design and stylization. Accordingly, both marks create a distinct commercial impression on consumers that could not logically cause confusion in the Construction Industry. *Applicant’s Brief*, pp. 4-6. Applicant also maintains that it is not necessary to expressly limit the Construction Industry services described in Applicant’s application and in the cited registration as both logic and reality serve to inherently limit the usual and customary purchasers of Construction Industry services. The usual and customary purchasers of such services are sophisticated Construction Industry professionals and careful consumers who are purchasing expensive services, therefore, there is no likelihood that the marks could cause consumer confusion. *Applicant’s Brief*, pp. 8-10.

#### ARGUMENT

**APPLICANT’S MARK IS NOT LIKELY TO BE CONFUSED WITH THE CITED MARK BECAUSE BOTH MARKS CREATE A VERY DIFFERENT OVERALL COMMERCIAL IMPRESSION AND THE SERVICES ARE PURCHASED BY SOPHISTICATED CONSTRUCTION INDUSTRY PROFESSIONALS AND CAREFUL PURCHASERS AT SIGNIFICANT EXPENSE.**

**(A) THE APPEARANCE OF THE MARKS AND THE COMMERCIAL IMPRESSION CREATED THEREBY ARE DIFFERENT**

Notwithstanding the Examining Attorney's arguments, it simply cannot be stated that the surname MURRAY is the dominant portion of the Cited Mark, as it is clear that the large stylized "M" is intended to, and does, form the dominant portion of the Cited Mark. There is no distinction between the display of the Cited Mark<sup>1</sup> and the D DAKTRONICS INC. & Design mark<sup>2</sup> analyzed in *Tektronix, Inc. v. Daktronics, Inc.*, 189 U.S.P.Q. 693 (C.C.P.A. 1967) or the A AMERITEX & Design mark<sup>3</sup> analyzed in *Cohn-Hall-Marx Co. v. Am. Silk Mills, Inc.*, 89 U.S.P.Q. 215 (Comr. Pats. 1951). In the *American Silk Mills* case, the fact finder correctly determined that the capital letter "A" that was much larger and disposed above the word element of the mark was the dominant portion of the mark. *See American Silk Mills*, 89 U.S.P.Q. at 215. In *Daktronics*, the fact finder similarly determined that the large capital "D" was a significant factor in the display of the mark in determining that there was no likelihood of confusion with mark TEKTRONIX & Design<sup>4</sup> because it had no similar display. *See Daktronics*, 189 U.S.P.Q. at 695. The Examining Attorney provided that "Applicant cites several cases in which it was held that the dominant feature of a mark was an enlarged letter. However, none of the contentious marks in the cited cases contained an identical, or even phonetically equivalent, primary word portion as is in the present case with the word MURRAY." *Examiner's Brief*, p. 6. Applicant does not



believe a word portion of two marks should be considered dominant just because such word portions are similar. The determination should be made based upon the commercial impression created by the display and use of the marks and with the guidance provided by the TTAB and other decisions with similar factual circumstances. Further, it is apparent that the word portions of the marks analyzed in the *Daktronics* case, namely, TEKTRONIX and DAKTRONICS, are phonetically similar. Based upon the foregoing decisions, it is apparent that the dominant portion of the Cited Mark is the large "M".

The Examining Attorney also stated that the cited cases do not address situations where a word portion of the mark is identical and the same letter is emphasized through design and stylization. *Examiner's Brief*, p. 6. It is true that none of the cases cited by Applicant or the Examining Attorney are directly on point; therefore, what must be done is to look to past TTAB and similar decisions for guidance on the proper analysis of the likelihood of confusion with respect to circumstances that are similar to the facts in this appeal.

The decision of *In re Dakin's Miniatures Inc.*, 59 U.S.P.Q.2d 1593 (T.T.A.B. 1999) cited by the Examining Attorney is largely irrelevant, as the applicant in that case was attempting to register the marks DAKIN'S CIRCLE B & Design (Ser. No. 74/706,610)<sup>5</sup> and DAKIN'S QUALITY GRAFTED MINIATURES & Design (Ser. No. 74/706,577)<sup>6</sup> for certain toys, which incorporated the whole of registrant's word mark DAKIN (Reg. No. 1,770,192) for certain toys and Christmas ornaments. *Dakin's Miniatures Inc.*, 59 U.S.P.Q.2d at 1596. The fact that the registrant owned a word mark for DAKIN and that such goods are neither expensive nor of a

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Dakin's Circle 

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type sold to a class of sophisticated or discriminating purchasers makes *Dakin's Miniatures* largely irrelevant to the case at hand.

The Examining Attorney also drew the conclusion from the *Cohn-Hall-Marx Co. v. Am. Silk Mills, Inc.*, 89 U.S.P.Q. 215 (Comr. Pats. 1951) decision that was cited by Applicant that the marks at issue in this appeal are confusingly similar. *Examiner's Brief*, p. 7. It cannot be disputed, however, that the facts and the display of both of the subject marks in *American Silk Mills* are wholly distinct from the facts and the display of the marks at issue in this case. In *American Silk Mills*, the applicant's mark consisted of the initial capital letter "A" about five times larger than the remaining word portion of the mark "amer-Mill" and was used in connection with silk, rayon and nylon. The opposer's mark was also used in connection with wool, cotton, rayon, nylon and/or silk and displayed with a large capital "A" about five times as large as and disposed above the word "AMERITEX." *American Silk Mills*, 89 U.S.P.Q. at 216. Significant in aiding the analysis of this appeal was that (i) the goods were neither expensive nor of a type sold to a class of sophisticated or discriminating purchasers and (ii) the court found that the dominant portion of *both* of the marks was the exceedingly large capital letter "A". *American Silk Mills*, 89 U.S.P.Q. at 217. Unlike the facts analyzed in *American Silk Mills*, *only* the Cited Mark contains a large capital letter "M" that is about five times as large as the word portion of the mark, therefore, the logical conclusion that can be drawn from *American Silk Mills* is that confusion would not be likely as the most significant features of each mark are not similar.

Finally, the Examining Attorney cited the case of *In re Appetito Provisions Co. Inc.*, 3 U.S.P.Q.2d 1553 (T.T.A.B. 1987) wherein it was held that APPETITO'S & Design (Ser. No.

73/423,405)<sup>7</sup> was confusingly similar to the marks A APPETITO & Design (Reg. No. 1,250,699)<sup>8</sup> and A APPETITO'S INC. & Design (Reg. No. 1,259,650)<sup>9</sup> for Italian style foods and restaurant services specializing in Italian dishes, respectively. *Appetito Provisions*, 3 U.S.P.Q.2d at 1556. Unlike the facts of this case, the applicant's mark in *Appetito Provisions* was only minimally stylized and the goods associated with all of the marks were not expensive or directed to a class of sophisticated purchasers. Further, the court noted that when dealing with restaurant services special focus should be placed on the word elements of a mark, due to the "propensity of persons to try restaurants based on word-of-mouth recommendations." *Id.* at 1554.<sup>10</sup>



<sup>10</sup> The Examining Attorney also briefly attempted to distinguish the facts in *In re Electrolyte Laboratories, Inc.*, 929 F.2d 645 (Fed. Cir. 1990) on the grounds that the Federal Circuit Court held that the following marks:  and

**K+EFF** were "highly stylized," and therefore, would not create a likelihood of confusion. *Examiner's Brief*, p. 6-7. The Examining Attorney then determined that that the marks at issue in this appeal are not "highly stylized." The court in *Electrolyte Laboratories* did not find the above marks "highly stylized," but rather, such phrase was simply quoted from *Georgia-Pacific Corp. v. Great Plains Bag Co.*, 204 U.S.P.Q. 697 (C.C.P.A. 1980) with approval. Rather, the *Electrolyte Laboratories* court held that the above marks were distinguishable on the grounds that "the design is a *significant feature* . . . and the design of the marks is substantially different." *Electrolyte Laboratories*, 929 F.2d at 647-48 (emphasis added). The design elements of the Cited Mark and Applicant's Mark are also significant features of the marks and show the Federal Circuit Court's position on marks that have a virtually identical word portion with substantially differing designs or stylization, which are the facts that the Examining Attorney believed important in comparing and analyzing in this appeal. See *Examiner's Brief*, p. 7 ("In instances such as this one, where a word portion of the mark is similar, it is more appropriate to look to those cases considering marks that have identical wording with differing designs or stylization.")

The most appropriate decision to look to in obtaining guidance to resolving this appeal is the *Daktronics* decision. Like the marks analyzed in the *Daktronics* case,<sup>11</sup> the Cited Mark and Applicant's Mark contain substantial stylized and design elements. Applicant's Mark is displayed as



and the Cited Mark is displayed as



The obvious visual prominence of the "M" portion of the Cited Mark is an element that must be considered and given appropriate weight. *See, e.g., Daktronics*, 929 F.2d at 695. The exceedingly large "M" portion of the Cited Mark is the dominant portion of the Cited Mark and finds no counterpart in Applicant's Mark. Applicant's Mark further differs from the display and use of the Cited Mark by reason of the unusual type font, partially overlapping letters, the long rectangular impression created by the overall shape of the design, and the plumb bomb in the cradle of the "M." These substantial differences in the style and design of each of the marks serves to distinguish them in their entireties, as they obviously create a very different overall commercial impression and appearance.

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<sup>11</sup> Namely,  and 

**(B) THE USUAL AND CUSTOMARY PURCHASERS OF CONSTRUCTION INDUSTRY SERVICES ARE SOPHISTICATED CONSTRUCTION INDUSTRY PROFESSIONALS AND CAREFUL CONSUMERS WHO ARE PURCHASING EXPENSIVE SERVICES**

Also similar to the *Daktronics* case and material to this appeal is the fact that Applicant's services and the services offered by the owner of the Cited Mark are expensive and of the type purchased by sophisticated Construction Industry professional purchasers. *See, Daktronics*, 929 F.2d at 695 n.3 ("The goods of both parties appear to be expensive and the type purchased by sophisticated purchasers."); *Applicant's Brief*, pp. 8-10. The Examining Attorney argued that since there is no limitation as to the prospective purchasers in either identification of the services associated with the subject marks, it is presumed that such services are available to all potential customers, even unsophisticated property owners who only wish to develop a single tract. *Examiner's Brief*, p. 11. The goods in the *Daktronics* decision neither limited the class of purchasers nor specified the price of such goods, but the court was able to logically conclude based upon the type of goods offered for sale that they were expensive and sold to sophisticated consumers. *Daktronics*, 929 F.2d at 695 n.3.<sup>12</sup> Applicant has adequately set forth its position on this issue in Applicant's Brief, so Applicant will only stress that the nature of Construction Industry services serves to *inherently* limit the class of purchasers to construction industry professionals (i.e., commercial property owners, real estate developers, architects, etc.), which are a discriminating and sophisticated class of consumers. Further, planning, designing and developing real estate (even a single tract of real estate) would likely be expensive and made after careful consideration. Accordingly, Applicant disagrees with the Examining Attorney that

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<sup>12</sup> The goods associated with the D DAKTRONICS INC. & Design mark were "electronic voting systems, including a plurality of voting stations, at least one display unit and recording unit and one or more control units for the same; and electronic scoreboards for athletic events, including a control unit for the same." *Daktronics*, 929 F.2d at 694. The goods associated with the TEKTRONIX & Design mark were "electronic measuring instruments and auxiliary apparatus - namely, oscilloscopes, wave generators, amplifiers, and preamplifiers for use with oscilloscopes and time mark generators for use in testing and calibration [and] electronics display products, graphic computer terminals, broadcast equipment, electronic testing instruments, signal sources, and electronic calculators. *Id.*

logic and reality would not serve to inherently limit Construction Industry services to a particular class of careful and/or sophisticated consumers, thereby eliminating any likelihood of potential confusion between the Cited Mark and Applicant's Mark in the marketplace.

#### CONCLUSION

Based upon the foregoing, and the reasons more fully discussed and set forth in Applicant's Brief, Applicant asserts that the mark MURRAY COMPANY & Design is registerable upon the Principal Register. While the Trademark Attorney is to resolve doubt as to the likelihood of confusion in the registrant's favor, in this case there is no real doubt. Although the services offered in connection with the subject marks are related, the display and use of the marks, the nature of the purchasers at the time of purchase, and the fact that all other factors cited by the *In re E.I. DuPont DeNemours & Co.*, 476 F.2d 1357 (C.C.P.A. 1973) case weigh in Applicant's favor<sup>13</sup> resolves any initial doubt in favor of a finding of no likelihood of confusion. Applicant respectfully requests that the TTAB reverse the Examining Attorney's refusal and approve its application to register MURRAY COMPANY & Design and permit Applicant's Mark to be published for opposition.

Respectfully submitted,

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<sup>13</sup> See Applicant's Brief, p. 11.

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