

ESTTA Tracking number: **ESTTA319491**

Filing date: **12/01/2009**

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

Proceeding	77501046
Applicant	Pantech Co., Ltd.
Applied for Mark	PANTECH BREEZE
Correspondence Address	HAE-CHAN PARK H.C. PARK & ASSOCIATES, PLC 8500 LEESBURG PIKE, STE 7500 VIENNA, VA 22182-2498 UNITED STATES patent@park-law.com, whelge@park-law.com, ychong@park-law.com
Submission	Reply Brief
Attachments	2009-12-01 TM1036US00 Applicant's Reply Brief.pdf (11 pages)(55418 bytes)
Filer's Name	Hae-Chan Park
Filer's e-mail	patent@park-law.com, whelge@park-law.com
Signature	/hae-chan park/
Date	12/01/2009

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

Mark: PANTECH BREEZE)	Trademark Law Office 108
)	
Applicant: Pantech Co., Ltd.)	Examining Attorney:
)	Courtney McCormick
Serial No.: 77/501,046)	
)	
Filed: June 17, 2008)	
)	
Class: 009)	

APPLICANT'S REPLY BRIEF

TABLE OF CONTENTS

TABLE OF AUTHORITIES.....2

I. STATEMENT OF THE ISSUE.....3

II. PROCEDURAL HISTORY/STATEMENT OF THE RECORD.....3

III. SUMMARY OF REPLY ARGUMENT.....5

IV. REPLY ARGUMENT.....5

 A. The Examining Attorney Improperly Failed to Analyze the Respective
 Marks In Their Entireties.....5

 B. The Goods Identified in the Respective Marks are not Identical.....9

V. CONCLUSION.....10

TABLE OF AUTHORITIES

CASES

In re Bed & Breakfast Registry, 791 F.2d 157, 229 U.S.P.Q. 818 (Fed. Cir. 1986).....9

STATUTES, MANUALS OF PROCEDURE, AND TREATISES

Trademark Act of 1946, As Amended, § 1(a) (15 U.S.C. §1051(a))3

Trademark Act of 1946, As Amended, § 2(d) (15 U.S.C. §1052(d))4

Trademark Manual of Examining Procedure, 5th Edition8, 9

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

Mark: PANTECH BREEZE)	Trademark Law Office 108
)	
Applicant: Pantech Co., Ltd.)	Examining Attorney:
)	Courtney McCormick
Serial No.: 77/501,046)	
)	
Filed: June 17, 2008)	
)	
Class: 009)	

APPLICANT’S REPLY BRIEF

I. STATEMENT OF THE ISSUE

An applied-for mark, used in connection with specified goods and satisfying other criteria, will register over a registered mark if a potential consumer would not likely be confused, mistaken, or deceived as to the source of applicant’s goods. Applicant’s applied-for mark, PANTECH BREEZE, includes the arbitrary PANTECH portion that renders it distinct from the registered mark, BREEZEACCESS, when the marks are compared in their entireties. Is there a likelihood of confusion created between PANTECH BREEZE and BREEZEACCESS where the goods associated with the respective marks are not identical?

II. PROCEDURAL HISTORY/STATEMENT OF THE RECORD

Pantech Co., Ltd. (hereinafter “Applicant”) filed its application to register the mark PANTECH BREEZE on the Principal Register pursuant to Section 1(a) of the Trademark Act of 1946, As Amended, 15 U.S.C. §1051 *et. Seq.* (hereinafter “Trademark Act”) based on Applicant’s first use and first use in commerce since at least as early as

May 27, 2008. Applicant sought registration for the following goods: “Wireless Telephone Transmitters and Receivers” in International Class 009.

The United States Patent and Trademark Office Examining Attorney issued the initial Office Action on August 7, 2008 contending, pursuant to Section 2(d) of the Trademark Act, that Applicant’s mark, PANTECH BREEZE, was likely to be confused with Registration No. 2,671,4323 for the mark BREEZEACCESS. BREEZEACCESS is also registered in International Class 009 for goods directed generally to broadband wireless access. On February 9, 2009, Applicant submitted arguments against the Section 2(d) refusal, distinguishing the applied-for mark from the registered mark, and amended the specified goods to “Wireless Telephone Transmitters and Receivers for use other than broadband wireless access” in International Class 009.

The Examining Attorney issued a final Office Action on February 10, 2009. In this Office Action, Applicant’s applied-for mark PANTECH BREEZE was finally rejected for a likelihood of confusion with BREEZEACCESS. Applicant noticed its appeal from the final rejection on August 7, 2009. Applicant submitted Applicant’s Appeal Brief on October 5, 2009. The Examining Attorney submitted the Examining Attorney’s Appeal Brief on November 12, 2009. This Applicant’s Reply Brief is timely filed on or before December 2, 2009.

As set forth in the following sections of this Reply Brief, the Examiner Attorney’s contentions are made in error. For these reasons, Applicant respectfully requests that this Board reverse the current rejection.

III. SUMMARY OF REPLY ARGUMENT

Given the dissimilarities between the respective marks and goods, there is no likelihood of confusion between Applicant's mark, PANTECH BREEZE, and the registered mark BREEZEACCESS. In finding that there was a likelihood of confusion, the examiner erred first by failing to compare the two marks in their entireties. Further, in comparing the marks in their entireties, the Examiner should have recognized that PANTECH was the dominant portion of Applicant's mark, and should have found that this dominant portion of Applicant's mark rendered the marks at issue as sufficiently distinct. Finally, not only are the two marks sufficiently distinct, but the goods covered by the respective marks are not identical. In view of these factors, the examining attorney should have concluded that there was no likelihood of confusion between Applicant's mark and the registered mark, and should have approved Applicant's mark for publication.

IV. REPLY ARGUMENT

A. The Examining Attorney Improperly Failed to Analyze the Respective Marks In Their Entireties

Applicant seeks registration for PANTECH BREEZE. In examining Applicant's mark against registered mark BREEZEACCESS, the Examining Attorney violated the Anti-Dissection Rule by focusing solely on the BREEZE portion of both marks, and disregarded the PANTECH portion of Applicant's mark as a house mark. But the Examining Attorney failed to consider the exceptions to that general rule regarding house marks, including (i) when recognizable differences exist between the shared elements

such that the addition of a trade name or house mark may render the marks *as a whole* distinguishable, and (ii) when the shared elements are descriptive or highly suggestive or play upon commonly used or registered words. This argument was presented in Applicant's Appeal Brief beginning at page 8 (citations omitted).

In response, the Examining Attorney concludes that such exceptions do not apply first "because the marks do not create a significantly different commercial impression." Examining Attorney's Appeal Brief at page 8. Notably, however, the Examining Attorney never considers the marks in their entireties to determine if they create a significantly different commercial impression. Rather, in arguing that the marks do not create a significantly different commercial impression, the Examining Attorney once again concludes that PANTECH is a house mark. Examining Attorney's Appeal Brief at page 4. In essence, the Examining Attorney's reasoning is circular: she concludes that the exception to the house mark rule does not apply *because PANTECH is a house mark*. Never once does the Examining Attorney properly compare the marks in their entireties to determine whether the first exception to the house mark rule applies.

Regarding the second exception, Applicant argued in its Appeal Brief that "when the shared elements are descriptive or highly suggestive or *play upon commonly used or registered words*' the addition of a house mark may avoid confusion with a registered mark." Examining Attorney's Appeal Brief at page 6 (emphasis added) (citing Applicant's Appeal Brief at 9). The Examining Attorney responds that the "Applicant has provided no evidence whatsoever as to this alleged 'weakness'" of the shared element, BREEZE. Examining Attorney's Appeal Brief at page 6. The Examining Attorney also concludes that the second exception to the general house mark rule does not apply

because “the matter common to the marks is not merely descriptive or diluted.” Examining Attorney’s Appeal Brief at page 8. But the Examining Attorney’s next statement recites that the “Applicant and Examining Attorney both appear to agree as to the meaning of the term ‘BREEZE’ in this context, that is to say that the connotation is a *play on the expression ‘in a breeze’ to signify ease of use.*” Examining Attorney’s Appeal Brief at page 8 (emphasis added). In essence, this statement concedes that, in fact, the matter common to the marks *is merely descriptive or highly suggestive of a good that is easy to use.* Thus, the BREEZE portion is clearly weakened as a descriptive portion of the mark. No further evidence is necessary. The matter common to the marks is descriptive, and the second exception to the house mark rule applies.

The rejections of record stand on the Examining Attorney’s disregard of PANTECH as a house mark in Applicant’s mark. But without properly considering the exceptions to this rule, the PANTECH portion of Applicant’s mark cannot be disregarded. The Examining Attorney’s failure to properly consider these exceptions is, in itself, enough to render the rejections invalid.

Other inconsistencies dot the Examining Attorney’s Appeal Brief. At one point, the Examining Attorney argues that “consumers, understanding that ‘PANTECH’ is the company name and house mark, will focus on the ‘BREEZE’ portion of Applicant’s mark.” Examining Attorney’s Appeal Brief, page 5. Less than one full page later, the Examining Attorney hops the fence and argues that “‘BREEZE’ is the dominant term in Registrant’s mark because consumers are generally *more inclined to focus on the first word, prefix, or syllable in any trademark or service mark.*” *Id.* (emphasis added) (citations omitted). As applied to Applicant’s applied-for-mark, these two rules are

contradictory, and the Examining Attorney never attempts, much less recognizes the need for, any reconciliation. Indeed, by applying the Examiner's later rule to Applicant's mark PANTECH BREEZE, consumers would focus more on the first word (PANTECH), prefix or syllable (PAN). Had the Examining Attorney applied a consistent rule to both marks, the entire calculus would change since PANTECH could no longer be disregarded. Instead, as presented, the Examining Attorney's arguments seem to serve the purpose of establishing BREEZE as the dominant portions of both marks. But this runs afoul of the Examining Attorney's own concession that "BREEZE" is descriptive as "*a play on the expression 'in a breeze' to signify ease of use.*" Examiner's Appeal Brief at page 8. (emphasis added) "BREEZE" may be the dominant portion of registrant's mark, but it clearly is not the dominant portion of Applicant's mark as compared to the arbitrary PANTECH portion.

To the contrary, it is well-known that "consumers would be more likely to perceive a fanciful or arbitrary term rather than a descriptive or generic term as the source-indicating feature of the mark." TMEP, Chapter 1207.01(b)(viii). PANTECH is exactly that: an arbitrary term. Hence, the Examiner should recognize that PANTECH is the dominant portion of Applicant's mark. The Examiner improperly refuses to do so, as shown in the Examining Attorney's Appeal Brief at pages 4 and 5.

Further, had the Examining Attorney properly compared the marks in their entireties, including Applicant's PANTECH portion, it could be seen that Applicant's mark and the registered mark are easily distinguishable by the consumer and no likelihood of confusion would result. As stated in the TMEP, if "the common element of two marks is 'weak' in that it is generic, *descriptive or highly suggestive of the named*

goods or services, consumers typically will be able to avoid confusion unless the overall combinations have other commonality.” TMEP, Chapter 2107.01(b)(ix) (emphasis added) (citing to *In re Bed & Breakfast Registry*, 791 F.2d 157, 229 USPQ 818 (Fed. Cir. 1986) (BED & BREAKFAST REGISTRY held not likely to be confused with BED & BREAKFAST INTERNATIONAL)). Here, the common element of the two marks—BREEZE—is “weak” in that it is descriptive of goods that are easily operated. Further, there is no other common ground between the marks. Finally, using the Examining Attorney’s own standard, consumers would be more inclined to focus on PANTECH in Applicant’s mark. Thus, given that PANTECH is the dominant portion of Applicant’s mark, consumers would be able to avoid confusion between the marks at issue when compared in their entireties.

In summary, the Examining Attorney continues to (i) discount PANTECH entirely from Applicant’s mark, and (ii) examine the marks based solely on the shared element BREEZE. By violating the Anti-Dissection Rule without regard for the applicable exceptions to this general rule, the Examiner has not properly analyzed the marks in their entireties. Proper analysis of the marks in their entireties would show that the marks are not confusingly similar in appearance, meaning and overall commercial impression.

B. The Goods Identified in the Respective Marks are not Identical

Finally, the goods associated with the marks at issue are not identical, particularly in view of the amendment to Applicant’s goods made in the Reply filed on February 9, 2009. The goods covered by BREEZEACCESS includes “equipment and accessories *for*

broadband wireless access, namely, computer hardware, computer software for broadband access, cables, modems, telephones, telecommunications switches, antennas, transmitters, receivers, boards for broadband wireless access, wireless adapters, and wireless network bridges.” (emphasis added). Applicant’s class of goods was amended to include “Wireless Telephone Transmitters and Receivers *for use other than broadband wireless access.*” (emphasis added). Thus, the goods are not identical.

Further, the examiner relied upon both the comparison of the marks and the comparison of the goods in concluding that there was a likelihood of confusion created between the marks. But given that Applicant’s mark is distinct from the registered mark for the reasons set forth above, and since the goods covered by the respective marks are not identical, both factors now fall in Applicant’s favor.

The Examining Attorney argues that the goods do not need to be “identical or directly competitive to find a likelihood of confusion.” Examining Attorney’s Appeal Brief at page 8. But the comparison of the goods is indeed a factor for determining whether there is a likelihood of confusion, as the Examining Attorney admits. Examining Attorney’s Appeal Brief at page 2. And since the goods are not identical, and since the marks have been distinguished above, these factors fall in Applicant’s favor.

V. CONCLUSION

Properly analyzed, the applied-for mark, PANTECH BREEZE, as used on or in connection with the specified goods, does not so resemble the currently registered mark, BREEZEACCESS, as to create a likelihood of confusion. Because it has been established that the two marks are sufficiently distinct, and that the goods are not

identical, the factors show no likelihood of confusion between the marks at issue. For at least the foregoing reasons, Applicant respectfully requests that the Board reverse the Examiner's finding of likelihood of confusion.

Respectfully submitted,

/hae-chan park/

Hae-Chan Park, Esq.
hpark@park-law.com
Wayne M. Helge, Esq.
whelge@park-law.com
Yunup D. Chong, Esq.
ychong@park-law.com
H.C. PARK & ASSOCIATES, PLC
8500 Leesburg Pike, Suite 7500
Vienna, VA 22182-2498
United States
Telephone: (703) 288-5105
Facsimile: (703) 288-5139
Attorneys of Record, Members of Virginia
State Bar

Date: December 1, 2009