

PTO Form 1957 (Rev 9/2005)

OMB No. 0651-0050 (Exp. 04/2009)

Response to Office Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	78063103
LAW OFFICE ASSIGNED	LAW OFFICE 106
MARK SECTION (no change)	
ARGUMENT(S)	
<p><u>REQUEST FOR RECONSIDERATION</u></p> <p>Applicant, SAFELITE OF AMERICA, INC., herein responds to the Final Office Action dated December 11, 2006 as follows:</p> <p style="text-align: center;">REMARKS</p> <p>A. Introduction</p> <p>Applicant has filed concurrently Notice of Appeal with the Trademark Trial and Appeal Board. However, applicant respectfully requests that the examining attorney reconsider her position and withdraw the rejection.</p> <p>B. Background</p> <p>The first Office Action on this matter was dated August 15, 2001, and rejected the present application on the basis of Reg. No. 2,449,396 for the mark STEALTH for "alarm, containment, and tracking system for tracking animals and/or humans." Applicant filed a response to the first Office Action on February 15, 2002, arguing no likelihood of confusion based the differences in the goods provided under the mark, namely that the cited mark was for an "invisible fence" that keeps pets in a specified area, whereas applicant's goods are automotive security systems. Applicant argued that the goods and channels of trades for these products are distinct, especially in light of the sophistication of consumers and significant third-party use of the term "stealth."</p>	

Applicant presumed that this ground of rejection was withdrawn because the next Office Action was not a final rejection. The TMEP states that, "Second actions should be final actions whenever possible. While an applicant is entitled to a full and fair hearing, it is in the interest of the public that prosecution be limited to as few actions as is consistent with proper examination. Neither the Act nor the rule of practice give an applicant the right to an extended prosecution." TMEP §714.03. Instead, the second action states, "The applicant's argument in support of registration have (sic) been considered." The second action was a notice of suspension based on two new pending marks. Had the examining attorney not withdrawn Reg. No. 2,449,396 as a ground for rejection, the proper course of action would have been a final office action, not a notice of suspension.

Applicant eventually had to request removal of suspension after being on suspension for almost three years. In response to this request, applicant received an Office Action mailed July 29, 2005, which, surprisingly, "maintained and continued" the refusal under Section 2(d) over Reg. No. 2,449,396. The Office Action simply stated, "The previous arguments are incorporated herein by reference." As in the earlier action suspending the application, there was absolutely no discussion of the arguments presented in applicant's response to the first Office Action. Instead, the examining attorney cited one of the two formerly pending applications which had registered during the nearly three years applicants file was placed on suspension. The newly cited basis for refusal was again under 2(d) based on the mark STEALTHAWARE (Reg. No. 2,486,663) for software that can be installed in electrical appliances that enables the appliances to be monitored and cease functioning if they are stolen.

Applicant filed a timely response to the Office Action. In the response, the applicant again pointed out that the two marks are used on entirely different products. Applicant's product is an automotive security device, whereas the STEALTHAWARE product is for appliances. These are two completely distinct markets. Applicant argued that consumers for each of the products would be highly sophisticated consumers and that the term STEALTH was very weak, even in its own class. Applicant cited 23 registered marks in class 009 that included STEALTH as part of the mark. Applicant further asserted that the differences in the marks was the most compelling factor to consider. Given the weakness of the term STEALTH in class 009, STEALTH AUTOMOTIVE

SECURITY and STEALTHAWARE are substantially different marks, easily distinguished by consumers.

Unfortunately, however, the examining attorney did not initially consider this response. Instead, the examining attorney erroneously issued a notice of abandonment. This required the applicant to prove that the response was indeed timely and to request reinstatement.

In response to the request for reinstatement, the applicant received a Final Office Action on the basis of both Reg. No. 2,449,396 (STEALTH for animal containment systems) and Reg. No. 2,486,663 (STEALTHAWARE for security systems for appliances). Please note that although the examining attorney repeatedly referred to one of the marks as STEALTHWARE, it is assumed that the examining attorney was actually referring to the STEALTHAWARE mark.

C. Argument

The analysis in the final rejection is flawed for a number of reasons.

1. The examining attorney has improperly focused only on the word STEALTH rather than considering the marks as a whole. It is fundamental that marks must be considered as a whole. There are significant differences between STEALTH AUTOMOTIVE SECURITY, STEALTHAWARE, and STEALTH that have been entirely ignored by the examining attorney. It would be completely inconsistent for the USPTO to consider AWARE an important and distinguishing part of the STEALTHAWARE mark and allow it to register over the STEALTH mark, but to ignore completely the terms AUTOMOTIVE SECURITY in applicant's STEALTH AUTOMOTIVE SECURITY mark and refuse registration.

2. The examining attorney wrongly asserts that STEALTH is arbitrary as applied to the goods. Applicant believes the mark STEALTH is a suggestive term as applied to the goods at issue. STEALTH clearly suggests a quality or characteristic of the goods.

3. The examining attorney states that "STEALTH" is "more than a mere member of a crowd." This position cannot be reconciled with the fact the examining attorney is citing two marks against applicant, both of which contain STEALTH and both of which are asserted to be for similar goods. If STEALTH for invisible fences for pets can co-exist with STEALTHAWARE for security systems for appliances, surely STEALTH AUTOMOTIVE SECURITY for auto security devices can

co-exist as well. There appears to be no basis to exclude applicant's mark, but to allow the other two.

4. The examining attorney has given no support for her assertion that security systems for pets, cars and appliances are all closely related. They are not. These channels of trade are distinct. Attached as Exhibit A is a declaration of Paul Grundy, General Manager for the applicant. Mr. Grundy's declaration states that in the more than five years that applicant's mark has been used, there has not been a single reported instance of confusion with the cited registrations. This is strong evidence that no likelihood of confusion exists between the marks.

5. The examining attorney asserts that the goods are related. However, this position does not make sense. Somehow, applicant's goods are deemed to be related to each of the two cited registrations, but those two registrations were apparently not related enough to prevent registration of the STEALTHAWARE mark. Thus, the examining attorney's position on this point is inconsistent not only with the USPTO's prior treatment of marks in the very same class, but also with the examining attorney's own assertions about the marks and goods. The examining attorney has not shown how purchasers will think that applicant's "automotive" security systems are somehow affiliated with STEALTH brand "alarm, containment, and tracking systems for animals...."

Sophisticated purchasers of such equipment would not affiliate such different products which would be encountered in entirely distinct channels of trade. The examining attorney has completely discounted applicant's arguments and evidence concerning channels of trade and the sophistication of consumers. There is no justification in the record for doing so. All of the DuPont factors must be considered. The examining attorney, however, has focused on the similarity of a single common word and an overly broad definition of the goods.

6. The examining attorney apparently takes the position that applicant's automotive security systems are within the normal field of expansion of each of the cited registrations. The examining attorney, however, offers no evidence at all that one selling and servicing pet containment systems would naturally expand into selling automotive security systems. In fact, these two products are unrelated and neither would be within the natural zone of expansion of the other. Likewise, security systems for appliances also are unrelated to automotive security systems. The examining attorney has taken an unsupportable position. If the examining attorney's position on this issue were

correct (i.e., that consumers would assume alarm systems for various purposes would be sold under the same STEALTH umbrella mark), then why did the USPTO allow the STEALTHAWARE mark to register. There is no basis for treating applicant's mark more strictly than the STEALTHAWARE mark was treated. The differences in the marks, goods, channels of trade, etc. are all just as different.

D. Conclusion

Based on the foregoing, applicant requests that the examining attorney withdraw the rejection. There is no likelihood of confusion given the differences in the marks, products and channels of trade. Applicant is willing to further clarify its goods and services, if necessary, so that these differences are apparent on the record.

The Examining Attorney is invited to contact the below signed Attorney should any questions arise concerning this Response.

Respectfully submitted,

/Phillip L. Free, Jr./
 PHILLIP L. FREE, JR.
 -For the Firm-
 Crowe & Dunlevy
 1800 Mid-America Tower
 20 North Broadway
 Oklahoma City, Oklahoma 73102
 Telephone: (405) 239-6656
 Fax: (405) 272-5947
 Attorney for Applicant,
 SAFELITE OF AMERICA, INC.

EVIDENCE SECTION

EVIDENCE FILE NAME(S)	<u>\\TICRS2\EXPORT13\780\631\78063103\xml1\ROA0002.JPG</u>
	<u>\\TICRS2\EXPORT13\780\631\78063103\xml1\ROA0003.JPG</u>
DESCRIPTION OF EVIDENCE FILE	Exhibit A-Declaration of Paul Grundy

SIGNATURE SECTION

RESPONSE SIGNATURE	/Phillip L. Free, Jr./
SIGNATORY'S NAME	Phillip L. Free, Jr.
SIGNATORY'S POSITION	Attorney of record

DATE SIGNED	-	06/11/2007
AUTHORIZED SIGNATORY		YES
FILING INFORMATION SECTION		
SUBMIT DATE		Mon Jun 11 20:00:26 EDT 2007
TEAS STAMP	-	USPTO/ROA-70.184.31.158-2 0070611200026787711-78063 103-37025c1bf9d4743b41bbc 7071762a318ba6-N/A-N/A-20 070611193513462182

PTO Form 1957 (Rev 9/2005)

OMB No. 0651-0050 (Exp. 04/2009)

Response to Office Action

To the Commissioner for Trademarks:

Application serial no. **78063103** has been amended as follows:

Argument(s)

In response to the substantive refusal(s), please note the following:

REQUEST FOR RECONSIDERATION

Applicant, SAFELITE OF AMERICA, INC., herein responds to the Final Office Action dated December 11, 2006 as follows:

REMARKS

A. Introduction

Applicant has filed concurrently Notice of Appeal with the Trademark Trial and Appeal Board. However, applicant respectfully requests that the examining attorney reconsider her position and withdraw the rejection.

B. Background

The first Office Action on this matter was dated August 15, 2001, and rejected the present application on the basis of Reg. No. 2,449,396 for the mark STEALTH for "alarm, containment, and tracking system for tracking animals and/or humans." Applicant filed a response to the first Office

Action on February 15, 2002, arguing no likelihood of confusion based the differences in the goods provided under the mark, namely that the cited mark was for an "invisible fence" that keeps pets in a specified area, whereas applicant's goods are automotive security systems. Applicant argued that the goods and channels of trades for these products are distinct, especially in light of the sophistication of consumers and significant third-party use of the term "stealth."

Applicant presumed that this ground of rejection was withdrawn because the next Office Action was not a final rejection. The TMEP states that, "Second actions should be final actions whenever possible. While an applicant is entitled to a full and fair hearing, it is in the interest of the public that prosecution be limited to as few actions as is consistent with proper examination. Neither the Act nor the rule of practice give an applicant the right to an extended prosecution." TMEP §714.03. Instead, the second action states, "The applicant's argument in support of registration have (sic) been considered." The second action was a notice of suspension based on two new pending marks. Had the examining attorney not withdrawn Reg. No. 2,449,396 as a ground for rejection, the proper course of action would have been a final office action, not a notice of suspension.

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Applicant filed a timely response to the Office Action. In the response, the applicant again pointed out that the two marks are used on entirely different products. Applicant's product is an automotive security device, whereas the STEALTHAWARE product is for appliances. These are two completely distinct markets. Applicant argued that consumers for each of the products would be highly

sophisticated consumers and that the term STEALTH was very weak, even in its own class. Applicant cited 23 registered marks in class 009 that included STEALTH as part of the mark. Applicant further asserted that the differences in the marks was the most compelling factor to consider. Given the weakness of the term STEALTH in class 009, STEALTH AUTOMOTIVE SECURITY and STEALTHAWARE are substantially different marks, easily distinguished by consumers.

Unfortunately, however, the examining attorney did not initially consider this response. Instead, the examining attorney erroneously issued a notice of abandonment. This required the applicant to prove that the response was indeed timely and to request reinstatement.

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against applicant, both of which contain STEALTH and both of which are asserted to be for similar goods. If STEALTH for invisible fences for pets can co-exist with STEALTHAWARE for security systems for appliances, surely STEALTH AUTOMOTIVE SECURITY for auto security devices can co-exist as well. There appears to be no basis to exclude applicant's mark, but to allow the other two.

4. The examining attorney has given no support for her assertion that security systems for pets, cars and appliances are all closely related. They are not. These channels of trade are distinct. Attached as Exhibit A is a declaration of Paul Grundy, General Manager for the applicant. Mr. Grundy's declaration states that in the more than five years that applicant's mark has been used, there has not been a single reported instance of confusion with the cited registrations. This is strong evidence that no likelihood of confusion exists between the marks.

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unrelated and neither would be within the natural zone of expansion of the other. Likewise, security systems for appliances also are unrelated to automotive security systems. The examining attorney has taken an unsupportable position. If the examining attorney's position on this issue were correct (i.e., that consumers would assume alarm systems for various purposes would be sold under the same STEALTH umbrella mark), then why did the USPTO allow the STEALTHAWARE mark to register. There is no basis for treating applicant's mark more strictly than the STEALTHAWARE mark was treated. The differences in the marks, goods, channels of trade, etc. are all just as different.

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Respectfully submitted,

/Phillip L. Free, Jr./
PHILLIP L. FREE, JR.
-For the Firm-
Crowe & Dunlevy
1800 Mid-America Tower
20 North Broadway
Oklahoma City, Oklahoma 73102
Telephone: (405) 239-6656
Fax: (405) 272-5947
Attorney for Applicant,
SAFELITE OF AMERICA, INC.

Evidence

Evidence in the nature of Exhibit A-Declaration of Paul Grundy has been attached.

Evidence-1

Evidence-2

Response Signature

Signature: /Phillip L. Free, Jr./ Date: 06/11/2007

Signatory's Name: Phillip L. Free, Jr.

Signatory's Position: Attorney of record

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.

Serial Number: 78063103

Internet Transmission Date: Mon Jun 11 20:00:26 EDT 2007

TEAS Stamp: USPTO/ROA-70.184.31.158-2007061120002678

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62a318ba6-N/A-N/A-20070611193513462182

UNITED STATES DEPARTMENT OF COMMERCE BEFORE
THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Safelite of America, Inc.)	
Serial No.:	78/063,103)	Trademark Law Office: 106
Mark:	STEALTH AUTOMOTIVE SECURITY)	
Filing Date:	May 11, 2001)	Examining Attorney:
Office Action Mail Date:	December 11, 2006)	Paula B. Mays

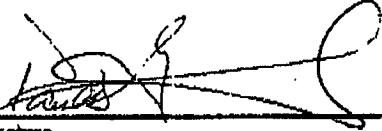
DECLARATION OF PAUL GRUNDY

I, Paul Grundy, hereby declare and state as follows:

1. My name is Paul Grundy and I am over 18 years old and fully competent to make this declaration.
2. I am the General Manager of Safelite of America, Inc., the Applicant for United States Trademark Serial No. 78/063,103 for the mark STEALTH AUTOMOTIVE SECURITY. I have personal knowledge of the facts stated herein.
3. Applicant, Safelite Automotive Security, Inc. has used the mark STEALTH AUTOMOTIVE SECURITY at least as early as February 4, 2001 for security systems in the nature of an immobilization relay to the fuel pump, ignition, or starter which allows the engine to start upon activation by a radio wave from a remote control.

4. To date, there have been no reports to Safelite of America, Inc. of any actual confusion between the STEALTH AUTOMOTIVE SECURITY (U.S. Serial No. 78/063,103) and STBALTH (U.S. Registration No. 2,449,396) or STEALTHAWARE (U.S. Registration No. 2,486,663).

The undersigned being warned that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001, and that such willful false statements and the like may jeopardize the validity of the application or document or any registration resulting therefrom, declares that all statements made of his/her own knowledge are true; and all statements made on information and belief are believed to be true.



Signature

Paul Grundy, General Manager
Name and Position

6/11/07

Date