

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

| | | | | |
|-------------|--------------------------------------|---|---------------|-----------------|
| Applicant: | InterCorr International, Inc. | § | Int'l. Class: | 9 |
| | | § | | |
| Serial No.: | 78 / 089,697 | § | PTO Office: | TTAB |
| | | § | | |
| Mark: | "CORRMETER" | § | Docket No.: | I71855US |

CERTIFICATE OF FACSIMILE TRANSMISSION
I hereby certify this correspondence was facsimile transmitted to the USPTO Trademark Trial and Appeal Board on February 25, 2003.


Raymond R. Ferrera


Commissioner for Trademarks
Box TTAB – Fee Attached
Arlington, Virginia 22202-3513

02/25/2003 18:19

NOTICE OF APPEAL

Applicant InterCorr International, Inc. hereby notices its appeal of the final Office Action issued August 25, 2002 in the above-identified U.S. trademark application. Applicant's substantive traversal of the Examiner's final determinations, and authorization to debit Applicant's counsel's account for the \$ 100.00 filing fee associated herewith, are attached.

Respectfully submitted,


Raymond R. Ferrera, Esq.
USPTO Registration No. 47,559
Texas State Bar No. 00796541
INTELLECTUAL PROPERTY SERVICES
2502 Lively Lane
Sugar Land, Texas 77479
Tel: (281) 313-1885
ATTORNEY FOR APPLICANT

PTO-2038 (02-2000)

Approved for use through 01/31/2003. OMB 0651-0043

United States Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

United States Patent & Trademark Office
Credit Card Payment Form
Please Read Instructions before Completing this Form

Credit Card Information

Credit Card Type: Visa MasterCard American Express Discover
Credit Card Account #: 3717 277330 71004
Credit Card Expiration Date: 06/06
Name as it Appears on Credit Card: RAYMOND R. FERRERA
Payment Amount: \$(US Dollars): \$ 100.00
Signature: RAYMOND R. FERRERA Date: 2/25/03

Refund Policy: The Office may refund a fee paid by mistake or in excess of that required. A change of purpose after the payment of a fee will not entitle a party to a refund of such fee. The Office will not refund amounts of twenty-five dollars or less unless a refund is specifically requested, and will not notify the payor of such amounts (37 CFR 1.28). Refund of a fee paid by credit card will be via credit to the credit card account.

Service Charge: There is a 50.00 service charge for processing each payment refused (including a check returned "unpaid") or charged back by a financial institution (37 CFR 1.21(m)).

Credit Card Billing Address

Street Address 1: 2502 LIVELY LANE
Street Address 2:
City: SUGAR LAND
State: TX Zip/Postal Code: 77479
Country: USA
Daytime Phone #: 281.313.1885 Fax #: 800.654.3459

Request and Payment Information

Description of Request and Payment Information: NOTICE OF APPEAL FEE - ONE (1) CLASS
Table with columns: Patent Fee, Patent Maintenance Fee, Trademark Fee, Other Fee. Includes fields for Application No., Patent No., Attorney Docket No., Serial No., Registration No., and Identify or Describe Mark ("PARAMETER").

If the cardholder includes a credit card number on any form or document other than the Credit Card Payment Form, the United States Patent & Trademark Office will not be liable in the event that the credit card number becomes public knowledge.

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

| | | | | |
|-------------|--------------------------------------|---|---------------|-----------------|
| Applicant: | InterCorr International, Inc. | § | Int'l. Class: | 9 |
| | | § | | |
| Serial No.: | 78 / 089,697 | § | PTO Office: | TTAB |
| | | § | | |
| Mark: | "CORRMETER" | § | Docket No.: | I71855US |

CERTIFICATE OF FACSIMILE TRANSMISSION
I hereby certify this correspondence was facsimile transmitted to the USPTO Trademark Trial and Appeal Board on February 25, 2003.



Raymond R. Ferrera

Commissioner for Trademarks
Box TTAB – Fee Attached
Arlington, Virginia 22202-3513

RESPONSE TO OFFICE ACTION ISSUED AUGUST 25, 2002

In response to the outstanding Office Action issued August 25, 2002, Applicant InterCorr International, Inc. hereby amends the above-referenced U.S. trademark application as follows:

I. SPECIMEN OF USE

The specimen originally filed in the application stands objected to as comprising advertising materials rather than an appropriate trademark specimen evidencing the mark as actually used in U.S. commerce. To overcome the objection, Applicant has today filed an electronic amendment in which a proper trademark specimen was attached as a file.

In particular, Applicant has transmitted an electronic file version of the mark as it is applied directly to metal identification plates subsequently affixed to each of Applicant's relevant goods. A copy of Applicant's filing receipt for the amendment is attached hereto as an exhibit. Since this objection to registration has been overcome, Applicant kindly requests it now be reconsidered and withdrawn by the Office.

II. SECTION 2(d) OBJECTIONS

Registration of the mark claimed herein also stands objected to as being likely to cause confusion with the mark set forth in prior U.S. Registration No. 0665713. The objection is respectfully traversed.

A. The marks are quite dissimilar in respective appearance and sound.

The Office Action alleges that the respective marks in the case are confusingly similar because they "sound and appear alike"; Applicant contends this conclusion is both factually and legally incorrect.

The mark proposed herein is "CORRMETER"; the prior registrant's mark is "CORROSOMETER". By inspection, it is plain that the prior mark contains at least three additional letters and, even more compellingly, at least *two* additional syllables when spoken. Thus, it is obviously factually incorrect to conclude the respective marks are "alike".

Legally, while it is true there is no one correct pronunciation of a trademark, it is simply inescapable that the prior mark CORROSOMETER contains at least two additional syllables when spoken as compared to the instant mark, and thus it would be easy for consumers, especially relatively sophisticated consumers, to recognize that the marks are in fact quite different from one another.

Applicant takes note of the fact that the prior mark is also not famous (and therefore not entitled to broader coverage than any other registration), nor is it especially arbitrary or fanciful. In fact, each of the parties' marks comprises portions that are suggestive of a meter of some sort used in the corrosion industry. The fact that the prior mark is itself suggestive of its related goods creates an inference that the mark should be

viewed narrowly, not broadly, when considered as a possible source of objection *vis-à-vis* a junior user's subsequent application for registration.

Applicant also notes that the parties in question have an ongoing business relationship, and that the prior registrant is fully aware of the Applicant's use of the CORRMETER mark in commerce, and that the prior registrant has neither complained in any way of Applicant's commercial activities nor advised of even a single known instance of actual confusion over the course of a significant time period.

B. The Office has utterly failed to carry its burden of showing that the goods offered by the respective parties are "closely related."

The Office Action states that a determination whether the parties' respective goods are closely related is an important element of the analysis to determine whether a junior user's mark is likely to be confused with the mark of a prior registrant, and even goes so far as to recite the relevant case law regarding the point, but then fails to apply those standards in the Action in any meaningful way. For example, in the portion of the Action directed to this argument, the Office completely fails to discuss *any* of the goods offered by the respective parties. In fact, to the extent the Office addresses the issue at all, only the following conclusory statement regarding the parties' purportedly related goods is offered:

"Trademarks are source indicators and tell consumers from whom the goods or services emanate from. Based on a given trademark, a consumer is likely to buy from that manufacturer or provider. If a consumer sees the mark CORRMETER and CORROSOMETER, a consumer is likely to think that the goods come from the same source."

What is plainly missing from the analysis is *which goods* are allegedly closely related, and *why* the Office believes such goods are related (and thus more likely to lead to a determination that the respective marks are in fact likely to be confused).

As a first matter, Applicant strongly disagrees that the parties' goods are closely related, and urges the Board to consider that Applicant's goods cannot in fact be acquired from the prior registrant, nor can the prior registrant's goods in fact be acquired from the Applicant.

In any event, it is incumbent upon the Office, not the Applicant, to demonstrate whether goods are allegedly closely related, and in this respect the Office has plainly failed to meet its burden.

C. The level of sophistication of the pertinent consuming group is extremely high in this instance, and thus the likelihood of confusion, if any, is *de minimis*.

Even if it is assumed, *arguendo*, that the parties' respective marks are similar in appearance and sound, and that the respective goods in the case are closely related (propositions the Applicant vigorously disputes above), it is still the case that the relevant consumers for the goods in question are *especially* sophisticated as compared to consumers involved in a typical commercial transaction, and thus the likelihood of confusion in the case, if any, is *de minimis* at most.

For example, in the corrosion sciences, the average practitioner likely to employ the respective parties' goods holds either a master's degree or doctorate's degree in some material science, or perhaps in an engineering science. Such is true, for example, for virtually every technical employee in the Applicant's business, and a reasonable inference may be drawn that average members of the public, who otherwise lack the requisite interest and training in the corrosion sciences to be considered a pertinent consumer for these purposes, will have little need for the parties' commercial corrosion-related goods, and thus are exceedingly unlikely to ever be confused between them.

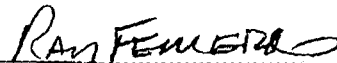
Thus, when considering which types of devices to purchase for its scientific needs, the parties' true consumers will in fact have very little difficulty distinguishing between the sources of origin of the goods offered by the respective parties.

Finally, Applicant's own marketing techniques help to still further reduce any possibility of confusion between the parties' devices, since the Applicant's products all bear metal plates having imprinted upon them the artwork mentioned above in the 'Specimen' portion of this response. As seen, each identification plate bears the name of Applicant's company "InterCorr International", as well as its CORRMETER trademark, and thus even if a sophisticated consumer *were* briefly confused about the respective origins of the parties' products, the Applicant's goods are still clearly distinguishable from all others due to the manner in which they are marked and marketed.

III. CONCLUSION

In view of the foregoing amendment, Applicant submits that all outstanding grounds of objection pending in the case have been overcome, and the application is now in condition for allowance. Remand to the Examining Attorney for reconsideration and withdrawal of the pending objections, and publication of the case at an early date, are respectfully requested.

Respectfully submitted,



Raymond R. Ferrera, Esq.
USPTO Registration No. 47,559
INTELLECTUAL PROPERTY SERVICES
2502 Lively Lane
Sugar Land, Texas 77479
Tel: (281) 313-1885
Fax: (800) 654-3459
ATTORNEY FOR APPLICANT

MSN Hotmail -

Page 1 of 3



Hotmail® rferrera@msn.com

Inbox | Previous Page

From : PrinTEAS@uspto.gov
To : rferrera@msn.com
CC : teas@uspto.gov, e-receipt@teas1.uspto.gov
Subject : Received your Response to Office Action Form
Date : Tue, 25 Feb 2003 14:32:37 -0500 (EST)

We have received your Response to Office Action Form below.

Please amend application serial no. 78089697 as follows:

* Specimens

Applicant hereby submits a specimen for Class 009.
 The specimen(s) submitted consists of The specimen is an electronic file of the artwork applied to metal plates affixed to Applicant's goods in commerce..
 For an application based on 1(a), Use in Commerce, "The substitute specimen(s) was in use in commerce as of the filing date of the application."

* Correspondence Address Change

Applicant proposes to amend the following:
 Original: RAYMOND R. FERRERA, ESQ. INTELLECTUAL PROPERTY SERVICES 2502 LIVELY LANE SUGAR LAND TX 77479 US
 Proposed: Raymond R. Ferrera, Esq. of INTELLECTUAL PROPERTY SERVICES having an address of 2502 Lively Lane Sugar Land TX USA 77479-1746 whose e-mail address is rferrera@msn.com, whose phone number is (281) 313-1885 and whose fax number is (800) 654-3459.

* Declaration Signature

Signature: /Raymond R. Ferrera/ Date: 02/25/2003
 Signatory's Name: Raymond R. Ferrera, Esq.
 Signatory's Position: Attorney

* Response Signature

Signature: /Raymond R. Ferrera/ Date: 02/25/2003
 Signatory's Name: Raymond R. Ferrera, Esq.
 Signatory's Position: Attorney

```

=====TEAS XML RESPONSE=====
<?xml version = '1.0' encoding = 'ISO-8859-1'?>
<uspto-tm-document document-type="roa" description="Response to Office Action"
system-creator="eteas" version="1.0" version-date="2002-01-24"
copyright="Copyright 1999-2002 United States Patent and Trademark Office">
<trademark-case-files>
<trademark-case-file>
<case-file-header>
<serial-number>78089697</serial-number>
<marks>
<mark action-code="read" version="reference">
<typed-mark>
<mark-text>CORRMETER </mark-text>
</typed-mark>
</mark>
</marks>
<law-office-assigned-location-code>TMO Law Office
110</law-office-assigned-location-code>
<filing-date>20011023</filing-date>
</case-file-header>
<office-action-form>
<specimens>

```


MSN Hotmail -

Page 2 of 3

```

<specimen action-code="create" version="new">
<class-code>009</class-code>
<statement-type>SP1</statement-type>
<file-name
image-type="jpeg">6616284150-25143117742-corrmeter_label.jpg</file-name>
<description-text>The specimen is an electronic file of the artwork applied to
metal plates affixed to Applicant's goods in commerce.</description-text>
<description-statement>The substitute specimen(s) was in use in commerce as of
the filing date of the application.</description-statement>
</specimen>
</specimens>
<signatures>
<signature action-code="create" version="new">
<signature-type>D</signature-type>
<signature-entry-number>1</signature-entry-number>
<signature-name>/Raymond R. Ferrera/</signature-name>
<signatory-date>20030225</signatory-date>
<signatory-name>Raymond R. Ferrera, Esq.</signatory-name>
<signatory-position>Attorney</signatory-position>
</signature>
<signature action-code="create" version="new">
<signature-type>R</signature-type>
<signature-entry-number>2</signature-entry-number>
<signature-name>/Raymond R. Ferrera/</signature-name>
<signatory-date>20030225</signatory-date>
<signatory-name>Raymond R. Ferrera, Esq.</signatory-name>
<signatory-position>Attorney</signatory-position>
</signature>
</signatures>
</office-action-form>
<correspondence-form>
<source-form>roa</source-form>
<correspondences>
<correspondence action-code="create" version="correction">
<type-code>c</type-code>
<original-address>
<address-line>RAYMOND R. FERRERA, ESQ.</address-line>
<address-line>INTELLECTUAL PROPERTY SERVICES</address-line>
<address-line>2502 LIVELY LANE</address-line>
<address-line>SUGAR LAND TX 77479</address-line>
<address-line/>
<address-line>US</address-line>
</original-address>
<new-address>
<name>Raymond R. Ferrera, Esq.</name>
<firm-name>INTELLECTUAL PROPERTY SERVICES</firm-name>
<street>2502 Lively Lane</street>
<city>Sugar Land</city>
<state>TX</state>
<postal-code>77479-1746</postal-code>
<country-name>USA</country-name>
<phone>(281) 313-1885</phone>
<fax>(800) 654-3459</fax>
<email authorized="y">rferrera@msn.com</email>
</new-address>
</correspondence>
</correspondences>
</correspondence-form>
</trademark-case-file>
</trademark-case-files>
<filing>
<filing-identifier>20030225143237879036-78089697</filing-identifier>
<xml-create-date>20030225 14:31:13</xml-create-date>
<submit-date>Tue Feb 25 14:32:37 EST 2003</submit-date>
<teas-stamp>USPTO/OA-6616284150-20030225143237879036-78089697-200564c56f257ed46d696b842e94151f5-N-N-
<filing-description>Reponse to Office Action Form Filing</filing-description>
<reply-email>rferrera@msn.com</reply-email>
</filing>
</uspto-tm-document>

```

TEAS support team

MSN Hotmail -

Page 3 of 3

Tue Feb 25 14:32:37 EST 2003

STAMP:

USPTO/OA-6616284150-20030225143237879036-78089697-200564c56f257ed46d696b842e94151f5-N-N-200302251431

RAYMOND R. FERRERA
INTELLECTUAL PROPERTY SERVICES
2502 Lively Lane
Sugar Land, Texas 77479
Tel: (281) 313-1885
Fax: (800) 654-3459
rferrera @ msn.com

FACSIMILE COVER SHEET

Date: February 25, 2003

Fax To: United States Patent and Trademark Office
Trademark Trial and Appeal Board

Fax No.: (703) 308-9333

From: Raymond R. Ferrera, Esq.

Total Pages: 12 (including fax cover sheet)

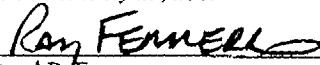
Re: U.S. Trademark Application No. 78 / 089,697
Mark: "CORRMETER"
Applicant: InterCorr International, Inc.
Our Ref.: I71855US

The information contained in this message is confidential and privileged, and is intended only for the use of the individual or entity named above. If the reader of this message is not the intended recipient, or the employee or agent responsible to deliver it to the intended recipient, you are hereby notified that any unauthorized dissemination, distribution or copying of this communication is strictly prohibited. If you have received this communication in error, please immediately notify our offices at the number provided above.

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

| | | | | |
|-------------|--------------------------------------|---|---------------|-----------------|
| Applicant: | InterCorr International, Inc. | § | Int'l. Class: | 9 |
| | | § | | |
| Serial No.: | 78 / 089,697 | § | PTO Office: | TTAB |
| | | § | | |
| Mark: | "CORRMETER" | § | Docket No.: | I71855US |

CERTIFICATE OF FACSIMILE TRANSMISSION
I hereby certify this correspondence was facsimile transmitted to the USPTO Trademark Trial and Appeal Board on February 25, 2003.


Raymond R. Ferrera

Commissioner for Trademarks
Box TTAB - Fee Attached
Arlington, Virginia 22202-3513

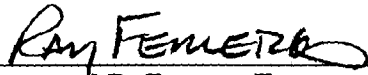
03 FEB 26 11:30

TRANSMITTAL LETTER

Applicant InterCorr International, Inc. transmits herewith the following documents for filing in association with the above-identified U.S. trademark application:

- (1) Response to Office Action issued August 25, 2002 (with attachment);
- (2) Notice of Appeal; and
- (3) Authorization to charge filing fees.

Respectfully submitted,


 Raymond R. Ferrera, Esq.
 USPTO Registration No. 47,559
 Texas State Bar No. 00796541
 INTELLECTUAL PROPERTY SERVICES
 2502 Lively Lane
 Sugar Land, Texas 77479
 Tel: (281) 313-1885
 ATTORNEY FOR APPLICANT