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

[redacted]

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

07-21-2003
U.S. Patent & TMOfc/TM Mail Rcpt Dt. #22

CERTIFICATE OF EXPRESS MAILING
I hereby certify this correspondence was deposited with the United States Postal Service as Express Mail Post Office to Addressee (Label No. ER066816664US), in an envelope addressed to: Commissioner for Trademarks, Box TTAB – No Fee, Arlington, Virginia 22202-3513, on July 21, 2003.

Raymond R. Ferrera

Commissioner for Trademarks
Box TTAB – No Fee
Arlington, Virginia 22202-3513

APPLICANT'S APPEAL BRIEF IN RESPONSE TO THE AFTER-OFFICE ACTION ISSUED MAY 9, 2003

In response to the after-final Office Action issued May 9, 2003, Applicant InterCorr International, Inc. hereby submits the following Appeal Brief in connection with the above-referenced U.S. trademark:

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 previously transmitted an electronic file comprising a substitute specimen of the mark that was in use at least as early as the filing date of the instant application.*

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 own knowledge are true, and that all statements made on information and belief are believed to be true.

Dr. Russell D. Kane, Vice President
InterCorr International, Inc.

7-21-03
Date

Applicant acknowledges with appreciation the Examiner's willingness to rescind the objection to the specimen in view of the executed Declaration provided above.

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". While it is true there is no one correct pronunciation of a trademark, it is obvious by inspection in this case that the prior mark CORROSOMETER contains three additional letters when seen, and *two additional syllables* when either spoken or heard, 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 different from one another when seen, spoken or heard.

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 had an ongoing business relationship over the course of several years, and that the prior registrant is fully aware of the Applicant's ongoing use of the CORRMETER mark in commerce. To date, the prior registrant continues to do business with the Applicant, and has never complained of or voiced any concern regarding Applicant's commercial activities. The prior registrant has also never advised Applicant of even a single instance of any actual or potential market confusion regarding the parties' respective products over a several year period.

While Applicant appreciates the Office's willingness to reconsider this application generally following a final objection, it is noted that the distinctions raised above (and in Applicant's previous reply papers) were not even addressed in the after-final Office Action.

B. The Office had previously failed to carry its burden of showing that the goods offered by the respective parties are "closely related," and Applicant has never had a chance to consider or respond to such arguments prior to the instant appeal; nonetheless, Applicant submits the goods are not closely related as a matter of law, and that they would instead be clearly distinguishable to an ordinary practitioner in the corrosion arts.

The recently-issued Office Action states that the respective parties' goods are so closely related that pertinent consumers are likely to be confused as to their source of origin, and then presents entirely new arguments that Applicant has never before been allowed to consider or traverse. Since the appellate record is predicated on the arguments and counterarguments raised during prosecution, Applicant believes such arguments are

improper at this time, and that the case should be returned to the Examining Attorney for further discussion based on the merits of said new arguments.

In particular, the Office admits that the prior registrant's claimed goods comprise only a device for precisely measuring how deep the effects of corrosion have manifested in a suitable medium. The device is therefore primarily mechanical in nature, and in any event, relates solely to after-the-fact measurement of certain corrosive effects.

In contrast, Applicant's goods comprise an electrical device with numerous sensors coupled to an analytical processor, which provides users with real-time acquisition and control data regarding a wide variety of electrochemical phenomena, including modality data, pitting factors, scaling factors and *rates* of corrosion as it occurs.

Thus the prior registrant's devices are simply incapable of performing the complex tasks handled by Applicant's device, and the Office should therefore rescind its finding that the goods in question are closely related. As discussed in greater detail below, the users of such devices generally have a master's or Ph.D. (or greater) level of education and training, and would be incredibly unlikely to confuse the parties' respective goods because of the entirely different functions they serve. Not surprisingly, there are very few commercial outlets that even offer such products for sale. Thus, even if, *arguendo*, a pertinent consumer were to be momentarily confused as to a given product's source of origin, even a simple inquiry would dispel any such confusion and clearly establish in the consumer's mind which products perform which functions, and to which vendor they should turn given their particular laboratory needs.

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), 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.

Also, 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 remaining in the case have been overcome, and the application is now in condition for publication. 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,

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TRANSMITTAL LETTER

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

(1) Applicant's Appeal Brief in Response to the After-Office Action Issued May 9, 2003; and

(2) Return Postcard.

Applicant kindly requests that USPTO receipt of the mentioned papers be confirmed by timely date stamping and returning the postcard enclosed herewith.

Respectfully submitted,

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