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UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 78/126947

APPLICANT: The Phone Works Inc

CORRESPONDENT ADDRESS:
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BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD ON APPEAL

MARK: PATTI

CORRESPONDENT'S REFERENCE/DOCKET NO: N/A

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Please provide in all correspondence:

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2. Date of this Office Action.
3. Examining Attorney's name and Law Office number.
4. Your telephone number and e-mail address.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	The Phone Works, Inc.,	:	BEFORE THE
Trademark:	PATTI	:	TRADEMARK TRIAL
Serial No:	78/126947	:	AND
Attorney:	Eugene E. Renz, Jr.	:	APPEAL BOARD
Address:	P.O. Box 2056 205 North Monroe Street Media, Pennsylvania 19063-9056	:	ON APPEAL

EXAMINING ATTORNEY'S APPEAL BRIEF

The Phone Works, Incorporated [Applicant], has appealed the final refusal to register the mark, PATTI for what the applicant last lists its services as "telecommunication services, namely, providing personnel attendance and tracking services, namely, prompt notification of call-outs and lateness for on-premise employees and the tracking off-premise employees, including but not limited to independent contractors and sales representatives, enabling employers to facilitate the invoicing of time and expenses for such employees via the Internet, telephone and interactive voice response systems." Registration was refused under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d), because the mark for which registration is sought so resembles the mark shown in U.S. Registration No. 2330637 as to be likely, when used on the identified services, to cause confusion, or to cause mistake, or to deceive. It is respectfully requested that the likelihood of confusion refusal under Section 2(d) of the Trademark Act be affirmed.

STATEMENT OF FACTS

In an application dated May 7, 2002, the applicant applied to register the mark, PATTI for "personnel attendance tracking by telephone and Internet – an integrated web and interactive voice response service." In an Office Action dated September 3, 2002, the examining attorney refused registration of the proposed mark because of a likelihood of confusion with the marks in U.S. Registration Nos. 2330637 and 2111092.[1] Trademark Act Section 2(d), 15 U.S.C. §1052(d); TMEP §§1207.01 *et seq*. Additionally, the examining attorney required the applicant to provide an acceptable identification of goods/recitation of services inasmuch as the identification as submitted in the original application was unacceptable as indefinite. The examining attorney made two suggestions, one relating to goods and one relating to services.

On March 3, 2002, the Applicant submitted a new recitation of services and submitted arguments to overcome the Section 2(d) refusal, arguing that although the marks of the parties are similar, the services of the parties are so different such that there would be no likelihood of confusion.

Based on the applicant's response, the examining attorney issued a final refusal under Section 2(d) of the Trademark Act with respect to Registration No. 2330637 for the mark, PATI, for services described as "telephone calling card services," "telephone answering services, namely, receiving, receipt, notification, transcription and narration of voice messages and telecommunications consultation rendered in connection therewith"

[1] Since the Initial Office Action, Registration No. 211092 has cancelled and is no longer a bar to registration. Accordingly, the Brief in the instant case deals solely with Registration No. 2330637.

and "telecommunication services, namely, electronic mail services, electronic telephone voice messaging services, telephone call forwarding services, audio teleconferencing services, electronic mail and facsimile transmissions via computer terminals, telephones, telecommunication networks and facsimile machines; electronic voice messaging, namely, recording, storage, transmission and broadcasting of voice messages." The examining attorney rejected the applicant's contentions that the marks and the goods and services of the parties are so different such that there would be no likelihood of confusion. Finally, the examining attorney further noted that the applicant's amendment to the recitation of services was still unacceptable.

In Response to the Final Refusal, the applicant timely filed a Notice of Appeal on April 23, 2004 and subsequent Appeal Brief[2] and Request for an Oral Hearing on February 2, 2006. The applicant's Brief relates only to the likelihood of confusion refusal under Section 2(d) of the Trademark Act and fails to address the requirement relating to the recitation of services.

ARGUMENT

IN ITS BRIEF, THE APPLICANT FAILS TO ADDRESS THE REQUIREMENT THAT THE RECITATION OF SERVICES, AS AMENDED, IS STILL UNACCEPTABLE

[2] It should be noted that in its Appeal Brief, the applicant submitted evidence at the appeal stage, namely, a brochure relating to its product. This evidence is identical to what was previously attached by the examining attorney in the Final Refusal.

In the initial Office Action dated September 3, 2002, the examining attorney indicated that the goods/services listed by the applicant was so vague that it was unclear as to whether the applicant was providing goods or performing a service. Accordingly, the examining attorney required the applicant to submit samples of advertisements or promotional materials for goods and services of the same type and/or describe the nature, purpose and channels of trade of the services with which the applicant has asserted a bona fide intent to use the mark. 37 C.F.R. §2.61(b); TMEP §§814 and 1402.01(d).

In its Response, the applicant provided a booklet entitled *Personnel Reporting*, which provided information concerning a Web and telephone reporting service for businesses. The applicant also provided the following recitation:

> Telecommunication services, namely, providing personnel attendance and tracking services, namely, prompt notification of call-outs and lateness for on-premise employees and the tracking off-premise employees, including but not limited to independent contractors and sales representatives, enabling employers to facilitate the invoicing of time and expenses for such employees via the Internet, telephone and interactive voice response systems

In the Final Refusal dated November 5, 2003, the examining attorney found the applicant's amendment to the recitation of services to be unacceptable as indefinite because as worded, the exact nature of the services is remained unclear. Specifically, the examining attorney found that the applicant's services appear to be a business-related tracking and monitoring service that uses telephone and telecommunication contacts rather than a telecommunication-type service. Moreover, the examining attorney found that recitation of services needs clarification because the applicant used "including but

not limited to" in its amended recitation inasmuch as a recitation must be specific and all-inclusive. 37 C.F.R. §2.71(a); TMEP §§1402.01 and 1402.03(a). The examining attorney provided the following suggestion that the applicant could adopt, if accurate:

> Business employee personnel reporting and tracking services, namely, providing personnel attendance and tracking services by means of notification of call-outs and lateness for on-premise employees and the tracking off-premise employees, enabling employers to facilitate the invoicing of time and expenses for such employees via the Internet, telephone and interactive voice response system.

In its Brief, the applicant does not specifically accept/reject the above suggestion nor does the applicant provide its own new recitation. The applicant merely states as follows:

> Appellant's services broadly stated provides prompt notification of call-outs and lateness for on-premise employees and the tracking off-premise employees, including but not limited to independent contractors and sales representatives, enabling employers to facilitate the invoicing of time and expenses for such employees via the Internet, telephone and interactive voice response systems

Brief at 2. Accordingly, inasmuch as the applicant has failed to provide an acceptable recitation of services, the most recently submitted recitation will be used in the instant case, specifically, "telecommunication services, namely, providing personnel attendance and tracking services, namely, prompt notification of call-outs and lateness for on-premise employees and the tracking off-premise employees, including but not limited to independent contractors and sales representatives, enabling employers to facilitate the invoicing of time and expenses for such employees via the Internet, telephone and interactive voice response systems."

THE APPLICANT'S MARK, PATTI, IS NEARLY IDENTICAL TO THE REGISTRANT'S MARK, PATI

In its Brief, the applicant initially notes that the marks of the parties are similar, however, the applicant then appears to make arguments with regards to the strength of the mark, the similarity of the mark as well as the applicant's intent in selecting its mark. As indicated in the prior Office Actions, the applicant has applied for registration of the proposed mark, **PATTI**, which the applicant indicates is the acronym for **P**ersonal **A**ttendance **T**racking by **T**elephone and **I**nternet. The registrant's mark is **PATI**. As indicated in the prior Office Actions, the respective marks are nearly identical in appearance, sound, commercial impression and connotation. The marks are essentially phonetic equivalents. Contrary to the applicant's contention in its Brief, *see* Brief at 6, similarity in sound alone is sufficient to find a likelihood of confusion. *Molenaar, Inc. v. Happy Toys Inc.*, 188 USPQ 469 (TTAB 1975); *In re Cresco Mfg. Co.*, 138 USPQ 401 (TTAB 1963). TMEP §1207.01(b)(iv). The fact that the mark is an acronym for something else is irrelevant. The examining attorney is required to look at the mark within the four corners of the submitted application, rather than on the applicant's "intent" in selecting the mark.

Additionally, the applicant's contention that the registered mark "has not developed widespread and immediate recognition in the marketplace to a point that consumers would recognize it outside the telecommunication services industry" is not persuasive. *See* Brief at 6. Even if applicant has shown that the cited mark is "weak," such marks are still entitled to protection against registration by a subsequent user of the

same or similar mark for the same or closely related goods or services. *See Hollister Incorporated v. Ident A Pet, Inc.,* 193 USPQ 439 (TTAB 1976) and cases cited therein. Similarly, contrary to the applicant's contention, it is irrelevant that a consumer would recognize it **outside** the telecommunication services industry. Emphasis Added. Rather, Trademark Act Section 2(d) bars registration where an applied-for mark so resembles a registered mark that it is likely, when applied to the goods and/or services, to cause confusion, mistake or to deceive the potential consumer as to the source of the goods and/or services. TMEP §1207.01. The determination is based on consumers of such goods. The overriding concern is to prevent buyer confusion as to the source of the goods and/or services. *In re Shell Oil Co.,* 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993). Therefore, any doubt as to the existence of a likelihood of confusion must be resolved in favor of the registrant. *In re Hyper Shoppes (Ohio), Inc.,* 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988); *Lone Star Mfg. Co. v. Bill Beasley, Inc.,* 498 F.2d 906, 182 USPQ 368 (C.C.P.A. 1974).

THE APPLICANT'S CONTENTION THAT THE SERVICES OF THE PARTIES ARE SO DIFFERENT SUCH THAT THERE WOULD BE NO LIKELIHOOD OF CONFUSION IS INSUFFICIENT TO OVERCOME THE REFUSAL UNDER SECTION 2(d) OF THE TRADEMARK ACT

With respect to the similarity of the services of the parties, the applicant contends that the services of the parties are easily distinguishable such that there would be no likelihood of confusion. Specifically, the applicant states that its services track personnel attendance via the Internet, telephone and interactive voice response, that it uses its own hardware and software, that it focuses its marketing to companies who require advance

notice of personnel who are unavailable and provides the ability for employees to record work time without coming in to the office. The applicant contends that the registrant is merely providing a telephone answering service and is not concerned with a specific niche business such as its tracking services. As indicated above, the applicant describes its services as "telecommunication services, namely, providing personnel attendance and tracking services, namely, prompt notification of call-outs and lateness for on-premise employees and the tracking off-premise employees, including but not limited to independent contractors and sales representatives, enabling employers to facilitate the invoicing of time and expenses for such employees via the Internet, telephone and interactive voice response systems." The relevant services of the applicant are described as "telephone calling card services," "telephone answering services, namely, receiving, receipt, notification, transcription and narration of voice messages and telecommunications consultation rendered in connection therewith" and "telecommunication services, namely, electronic mail services, electronic telephone voice messaging services, telephone call forwarding services, audio teleconferencing services, electronic mail and facsimile transmissions via computer terminals, telephones, telecommunication networks and facsimile machines; electronic voice messaging, namely, recording, storage, transmission and broadcasting of voice messages."

The presumption under Trademark Act Section 7(b), 15 U.S.C. §1057(b), is that the registrant is the owner of the mark and that use of the mark extends to all goods and/or services identified in the registration. The presumption also implies that the registrant operates in all normal channels of trade and reaches all classes of purchasers of

the identified goods and/or services. *RE/MAX of America, Inc. v. Realty Mart, Inc.*, 207 USPQ 960, 964-5 (TTAB 1980).

The services of the parties need not be identical or directly competitive to find a likelihood of confusion. Instead, they need only be related in some manner, or the conditions surrounding their marketing be such that they could be encountered by the same purchasers under circumstances that could give rise to the mistaken belief that the services come from a common source. *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984); *In re Melville Corp.*, 18 USPQ2d 1386, 1388 (TTAB 1991); *In re Corning Glass Works*, 229 USPQ 65 (TTAB 1985); *In re Rexel Inc.*, 223 USPQ 830 (TTAB 1984); *Guardian Prods. Co., Inc. v. Scott Paper Co.*, 200 USPQ 738 (TTAB 1978); *In re Int'l Tel. & Tel. Corp.*, 197 USPQ 910 (TTAB 1978); TMEP §1207.01(a)(i). Additionally, any services in the registrant's normal fields of expansion must also be considered in order to determine whether the registrant's services are related to the applicant's identified services for purposes of analysis under Section 2(d). *In re General Motors Corp.*, 196 USPQ 574 (TTAB 1977). The test is whether purchasers would believe that the services provided are within the registrant's logical zone of expansion. *CPG Prods. Corp. v. Perceptual Play, Inc.*, 221 USPQ 88 (TTAB 1983); TMEP §1207.01(a)(v).

In the present case, the services of the parties are similar inasmuch as the services of the parties all relate to telecommunication services. With respect to the applicant's services and the services which Registration No. 2330637 provides, the registrant's

“telephone answering services, namely, receiving, receipt, notification, transcription and narration of voice messages,” and its “telecommunication services, namely, electronic mail services, electronic telephone voice messaging services, telephone call forwarding services, audio teleconferencing services, electronic mail and facsimile transmissions via computer terminals, telephones, telecommunication networks and facsimile machines; electronic voice messaging, namely, recording, storage, transmission and broadcasting of voice messages,” could all be used as a provision of the applicant’s telecommunication services in which individuals call in or out for attendance and tracking purposes and well as notifications of call-outs and lateness. The registrant’s services allow the consumer to call in with the same information that the applicant’s services would perform.

CONCLUSION

Based on the foregoing, the applicant's mark, PATTI, is confusingly similar to the registered mark, PATI in that a significant portion of the applicant's mark is nearly identical in appearance, connotation and meaning and to the registered mark. Moreover, the services of the parties, the class of purchasers and the channels of trade are highly similar. Accordingly, the examining attorney's final refusal to register the mark is proper and should be affirmed.

Respectfully submitted,

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