

**RESPONSE TO OFFICE ACTION BEFORE THE  
UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of :  
APPLICANT : Divorce Solutions, Inc.  
MARK : DIVORCE SOLUTIONS  
SER. NO. : 78/217384  
FILING DATE : February 21, 2003  
ATTORNEY REF. : DSNTM01


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Box Responses - No Fee  
Commissioner for Trademarks  
2900 Crystal Drive  
Arlington, Virginia 22202-3513

Attention: Teresa Rupp  
Trademark Senior Attorney  
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Request for Reconsideration

Responding to Office Action dated March 25, 2004:

  
10-01-2004  
U.S. Patent & TMO/TM Mail Rpt Dt. #64

**RESPONSE TO REFUSAL**

1. The examining attorney states that “[r]egistration was refused under Trademark Act Section 2(d), 15 U.S.C. §1052(d), because the mark for which registration is sought so resembles the mark shown in U.S. Registration No. 1976820 as to be likely, when used on the identified goods/services, to cause confusion, or to cause mistake, or to deceive.” The examining attorney continues by stating that “the refusal under Section 2(d) is maintained and made FINAL.”

“The examining attorney must analyze each case in two steps to determine whether there is a likelihood of confusion. First, the examining attorney must look at the marks themselves for similarities in appearance, sound, connotation and commercial impression. *In re E. I. DuPont de Nemours & Co.*, 476 F.2d

1357, 177 USPQ 563 (CCPA 1973). Second, the examining attorney must compare the goods or services to determine if they are related or if the activities surrounding their marketing are such that confusion as to origin is likely. *In re August Storck KG*, 218 USPQ 823 (TTAB 1983); *In re International Telephone and Telegraph Corp.*, 197 USPQ 910 (TTAB 1978); *Guardian Products Co., v. Scott Paper Co.*, 200 USPQ 738 (TTAB 1978).

As a preliminary matter in addressing the examining attorney's FINAL refusal under Section 2(d), Applicant respectfully incorporates here the arguments from its Response to Office Action dated February 4, 2004. Furthermore, Applicant respectfully disagrees with the additional points raised by the examining attorney in the Office Action dated March 25, 2004.

First, Applicant respectfully contends that the examining attorney has failed to show why the Applicant's argument -- that the Registrant's and Applicant's services are unrelated because they are recited in different International Classes -- is somehow flawed. The Applicant believes that the mere statement that the Applicant's argument is "not persuasive" is itself not persuasive.

Second, and more importantly, Applicant believes that the examining attorney has improperly defined the Applicant's services as incorporating some sort of dispute resolution element. The Applicant's services do not recite any such element. The Applicant's recitation of services does not include mediation; it does not include arbitration; and, it does not include litigation. Yet, every time the examining attorney attempts to compare the Applicant's and Registrant's services using a "financial" link, the comparison is, instead, always made within the context of dispute resolution.

For example, the examining attorney offers a number of advertisements from "divorce mediators" in an attempt to show that mediation services are usually offered in connection with services similar to the Applicant's "consulting services in the field of finance related to divorce matters." However, the examples provided make no such showing. In every example, the service described is a dispute resolution service, rather than a consulting service. In particular, the Dianne Neumann & Associates example recites services that "help you and your spouse reach a fair financial and legal settlement ...," which is nothing more than a clear recitation of a dispute resolution service. And, the Divorce with Dignity example begins with "[d]uring the course of the mediation process ...," which is also nothing more than a clear recitation of a dispute resolution service. Finally, the Cohen & Associates example describes the creation of an "agreement," which is the natural result of a dispute resolution service.

Furthermore, the Applicant believes that including a copy of Reg. No 2564735, "which shows that mediation and 'ancillary accounting services related to divorce' are offered under the same mark," is without evidentiary value. This is because 1) the registration is not cited against the Applicant, and 2) the

combination of "mediation" and "ancillary accounting services related to divorce" recited in Reg. No. 2564735 is not probative of whether there is a likelihood of confusion between the Applicant's services and those recited in Reg. No. 1976820.

Applicant respectfully states that the above arguments demonstrate that the respective marks are not likely to cause confusion, to cause mistake, or to deceive. Therefore, Applicant requests that the examining attorney withdraw the refusal to register the Applicant's mark under Trademark Act Section 2(d).

#### RESPONSE TO REQUIREMENTS

2. The examining attorney states that the Applicant must disclaim the wording "INC." apart from the mark as shown under Trademark Act Section 6, 15 U.S.C. §1056; TMEP §§1213 and 1213.03(a).

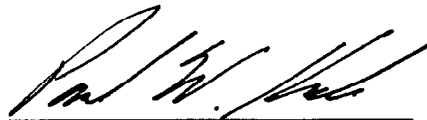
In response, Applicant requests an amendment to its application by adding the disclaimer "No claim is made to the exclusive right to use 'INC.', apart from the mark as shown."

#### CONCLUSION

Accordingly, the applicant requests that its application be approved for publication.

Respectfully submitted,

By:



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Dated: September 25, 2004

SERIAL NO.: 78/217384  
LAW OFFICE 106  
EXAMINING ATTORNEY: RUPP, TERESA

**Certification under 37 C.F.R. §1.8**

9/25/2004

Date of Deposit

I hereby certify that this Request for Reconsideration and postcard are being deposited with the United States Postal Service as First Class Mail under 37 C.F.R. §1.8 on the date indicated above and is addressed to the Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3513.

PAUL W. KODA

Typed or printed name of person  
mailing Response



Signature of person mailing  
Response