

UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 78/217384

APPLICANT: Divorce Solutions, Inc.



CORRESPONDENT ADDRESS:

Paul W. Koda
Koda Law Firm
4 Baederwood Court
Rockville MD 20855

RETURN ADDRESS:

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

Mailed: 11-4-04

If no fees are enclosed, the address should include the words "Box Responses - No Fee."

MARK: DIVORCE SOLUTIONS, INC.

CORRESPONDENT'S REFERENCE/DOCKET NO: DSNTM01

Please provide in all correspondence:

CORRESPONDENT EMAIL ADDRESS:

1. Filing date, serial number, mark and applicant's name.
2. Date of this Office Action.
3. Examining Attorney's name and Law Office number.
4. Your telephone number and e-mail address..

Serial Number 78/217384

Applicant is requesting reconsideration of a final refusal dated March 25, 2004.

After careful consideration of the law and facts of the case, the examining attorney must deny the request for reconsideration and adhere to the final action as written since no new facts or reasons have been presented that are significant and compelling with regard to the point at issue.

Accordingly, applicant's request for reconsideration is *denied*. Because a Notice of Appeal was filed in this application, jurisdiction is being returned to the TTAB for resumption of the appeal.

The applicant states that the examining attorney's evidence supporting the finding of a likelihood of confusion is flawed for a number of reasons. The Trademark Manual of Examining Procedure sets forth the type of evidence often used to support a Section 2(d) refusal. Evidence of relatedness might include news articles and/or evidence from computer databases showing that the relevant goods or services are used together or used by the same purchasers; advertisements showing that the relevant goods or services are advertised together or sold by the same manufacturer or dealer; or copies of prior use-based registrations of the same mark for both applicant's goods and services and the goods and services listed in the cited registration. 1207.01(a)(vi)

The applicant believes the classification of its services, which differs from the classification in the cited registration, has some bearing on the Section 2(d) refusal. This is not true. As stated in TMEP Section 1207.01(d)(v), the classification of goods and services has no bearing on the question of likelihood of confusion. Rather, it is the manner in which the applicant and/or registrant have identified

their goods or services that is controlling. *Jean Patou Inc. v. Theon Inc.*, 9 F.3d 971, 29 USPQ2d 1771 (Fed. Cir. 1993); *National Football League v. Jasper Alliance Corp.*, 16 USPQ2d 1212, 1216 n.5 (TTAB 1990).

The applicant also believes that the third party registration that shows mediation services and consulting services offered by the same party is without evidentiary value. On the contrary, the fact that a third party offers both the applicant's services (consulting) and the registrant's services (mediation) is very probative. It supports the examining attorney's belief that the public would expect the applicant and registrant to offer both services. When these two related services are offered under the same mark, the public would be confused as to the source.

The examining attorney has not attempted to define the applicant's services as dispute resolution services. The Internet evidence was intended to show that the registrant's services (mediation) and the applicant's services (financial consulting) are related because a party that offers mediation (i.e. the registrant) also offers advice on financial matters. The mediation services offered to a divorcing couple are often closely linked to providing financial advice or consulting. The applicant's services and the registrant's services need only be related to support a refusal under Section 2(d). The examining attorney does not have to show that the services are identical.

NOTICE: TRADEMARK OPERATION RELOCATING OCTOBER AND NOVEMBER 2004

The Trademark Operation is relocating to Alexandria, Virginia, in October and November 2004. Effective October 4, 2004, all Trademark-related paper mail (except documents sent to the Assignment Services Division for recordation, certain documents filed under the Madrid Protocol, and requests for copies of trademark documents) must be sent to:

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

Applicants, registration owners, attorneys and other Trademark customers are strongly encouraged to correspond with the USPTO online via the Trademark Electronic Application System (TEAS), at www.uspto.gov.

/Teresa Rupp/
Trademark Senior Attorney
Law Office 106
Phone - (571) 272-9329
Fax No. (571) 273-9106