

Recon
10/4/06

Response to Office Action

The table below presents the data as entered.

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SERIAL NUMBER	78246849
LAW OFFICE ASSIGNED	LAW OFFICE 110
MARK SECTION (no change)	
ARGUMENT(S)	
<p>This Request for Reconsideration is offered in response to the Final Office Action, dated April 4, 2006, based upon Section 2(d) of the Trademark Act. For the reasons set forth below, Hoist Fitness Systems, Inc. ("Applicant") requests that the final refusal be withdrawn.</p> <p style="text-align: center;">BASIS OF RECONSIDERATION REQUEST/ARGUMENT</p> <p>The Examining Attorney has issued a final rejection of Applicant's application for ROX for "manually operated exercise equipment" ("Applicant's mark"), on the basis of an alleged likelihood of confusion with the registered ROCK BARBELL & FITNESS and Design mark for "barbells and dumb bells," ("Registrant's mark"). Applicant submits, with respect, that no likelihood of confusion exists and for that reason requests herein that the Examining Attorney reconsider her decision in this matter. As part of this request, Applicant incorporates by reference its Responses to prior Office Actions, and particularly the response dated December 10, 2004.</p> <p>The Examining Attorney must analyze each case in two steps to determine whether there is a likelihood of confusion between the applicant's mark and a registered mark. 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).</p> <p>Relying in part on argument raised in response to Office Action dated December 10, 2004, Applicant submits that the sound, appearance, meaning and commercial impression of Applicant's ROX mark is sufficiently distinct from that created by the Registrant's ROCK BARBELLS & FITNESS and Design mark, and that consumers will not be confused.</p> <p>The cited registrant's mark ROCK BARBELL & FITNESS and Design superimposed over the</p>	

graphic portrayal of a boulder, does not as a whole convey substantial similarity in appearance, sound, connotation and/or commercial impression as the word mark "ROX" in Applicant's mark. Granted, there is some slight similarity in sound of the isolated word ending in "ROCK" vs. "ROX," but even there, the hard sounding "CK" in "ROCK" is distinguishable from the "X" in "ROX." The marks are not to be taken out of context of the application/registration of record, and this is not a comparison of "ROCK" to "ROX," but a comparison of the marks as a whole. There are greater dissimilarities between the appearance, sound, connotation and commercial impression conveyed by the respective marks as a whole. There is no connotation or commercial impression of "rock" in "rox." Quite the contrary, the term "rox" cannot be taken to be synonymous with "rock." The term "rox" has no practical meaning in the English language and does not signify "rock" nor does it mean "rock" or stone. The term "rox" is used more to reference the female name "Roxanne" than to signify a stone. Thus, there is no similarity in appearance between the marks, connotation or commercial impression. Nor is there similarity and sound apart from isolating the "ROCK" word element from the cited registrant's overall mark, in comparing it to the "ROX" mark. The "ROX" mark has no practical meaning in the English language and certainly none signifying a stone or stones. Consumers are already distinguishing between Registrant and the other users of "ROCK" in the marketplace for exercise related products, such that the use by Applicant of its ROX mark for its exercise equipment is not likely to confuse the public. For example, a search of the Trademark.com database for "ROCK" marks in class 28, limited to active trademark references meaning issued or pending in the USPTO (and not abandoned, cancelled or expired) shows over 300 trademarks containing some form of the term "ROCK" in the text of the mark. (See Exhibit "A"). More pertinently, a further search on the same database identifies over twenty (20) active trademarks in the USPTO that contain the word "ROCK" used alone or with other terms in class 28 for goods or services involving "exercise." Attached hereto is a listing of the USPTO references by application number. (See Exhibit "B").

For the foregoing reasons, Applicant asks that its application for ROX be allowed. Applicant has concurrently filed a Notice of Appeal and requested suspension on the Notice of Appeal pending the Examiner's reply to this Motion for Reconsideration.

EVIDENCE SECTION

EVIDENCE FILE NAME(S)

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DESCRIPTION OF EVIDENCE FILE	Third party registrations - trademark.com searches
SIGNATURE SECTION	
RESPONSE SIGNATURE	/bfs/
SIGNATORY NAME	Barry F. Soalt
SIGNATORY POSITION	Attorney for Applicant
SIGNATURE DATE	10/04/2006
FILING INFORMATION SECTION	
SUBMIT DATE	Wed Oct 04 21:43:59 EDT 2006
TEAS STAMP	USPTO/ROA-209.242.145.136 -20061004214401688726-782 46849-34015925cab4ef0c48f 77e416aab36aeb9f-N/A-N/A- 20061004213556988071

Response to Office Action

To the Commissioner for Trademarks:

Application serial no. 78246849 has been amended as follows:

Argument(s)

In response to the substantive refusal(s), please note the following:

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BASIS OF RECONSIDERATION REQUEST/ARGUMENT

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Evidence

Evidence in the nature of Third party registrations - trademark.com searches has been attached.

Original PDF file:

http://teasgate/ROA/2006/10/04/20061004214401688726-78246849-002_001/evi_209242145136-213556988_.._TM17_ROA-EX_A.pdf

Converted PDF file(s) (12 pages)

[Evidence-1](#)

[Evidence-2](#)

[Evidence-3](#)

[Evidence-4](#)

[Evidence-5](#)

[Evidence-6](#)

[Evidence-7](#)

[Evidence-8](#)

[Evidence-9](#)

[Evidence-10](#)

[Evidence-11](#)

[Evidence-12](#)

Original PDF file:

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Converted PDF file(s) (36 pages)

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Response Signature

Signature: /bfs/ Date: 10/04/2006

Signatory's Name: Barry F. Soalt

Signatory's Position: Attorney for Applicant

Serial Number: 78246849

Internet Transmission Date: Wed Oct 04 21:43:59 EDT 2006

TEAS Stamp: USPTO/ROA-209.242.145.136-20061004214401

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