

PTO Form 1957 (Rev 8/2005)

OMB Control #0651-0050 (Exp. 04/30/2006)

## Response to Office Action

The table below presents the data as entered.

Input Field	Entered
<b>SERIAL NUMBER</b>	78285760
<b>MARK SECTION (no change)</b>	
<b>ARGUMENT(S)</b>	
<p>The applicant respectfully requests that the examining attorney reconsider her determination that applicant's AZIMUTH DIRECTOR mark so resembles the AZIMUTH INC. (&amp; Des.) mark as to be likely to cause confusion, to cause mistake, or to deceive. Specifically, the applicant requests that the examiner closely reconsider whether the fact that the applicant owns the AZIMUTH mark, when coupled with the arguments presented by the applicant in response to the first Office action, militates in favor of withdrawing the 2(d) refusal.</p> <p style="text-align: center;">Applicant's Prior AZIMUTH Registration Supports Publication of AZIMUTH DIRECTOR for Highly Similar Goods</p> <p>The examiner's refusal to register the AZIMUTH DIRECTOR application on grounds that it is likely to cause confusion with AZIMUTH INCORPORATED (&amp; Des.) mark, despite the fact that the applicant owns a registration for the AZIMUTH mark for similar goods, should be withdrawn.</p> <p>As the examiner may recall, because this issue was not expressly addressed in the Final refusal, counsel for the applicant telephoned the examiner to confirm that she appreciated that the applicant owns a registration for the AZIMUTH mark for goods that are very similar to those identified in its AZIMUTH DIRECTOR application. <u>See Exhibit A.</u> In her voice mail reply the examiner stated that "the law is actually quite clear" that ownership of the prior AZIMUTH registration doesn't preclude refusal of the AZIMUTH DIRECTOR application. While this may be true as a technical matter, as a practical matter such a refusal is extraordinarily rare, and is unwarranted here.</p> <p>Most decisions in which the Board has determined that prior registrations are not controlling as to subsequent applications for the same, or virtually the same, mark involve issues other than likelihood of confusion, such as: whether incontestable status compelled registration of same mark for broader services (<u>In re Merrill Lynch, Pierce, Fenner &amp; Smith, Inc.</u>, 828 F.2d 1567, 4 USPQ2d 1141 (Fed. Cir. 1987) (incontestable registration of CASH MANAGEMENT ACCOUNT for credit card services did not automatically entitle applicant to registration of the same mark for broader financial services)); whether a disclaimer should be required (<u>In re Best Software Inc.</u>, 58 USPQ2d 1314 (TTAB 2001) (applicant's ownership of registration for the mark BEST! did not preclude the examining attorney from requiring a disclaimer of "Best" in applications seeking registration of BEST! SUPPORT PLUS and BEST! SUPPORT PLUS PREMIER for the same services plus additional services)), (<u>In re Medical Disposables Co.</u>, 25 USPQ2d 1801 (TTAB 1992) (disclaimer of the unitary term "MEDICAL DISPOSABLES" required, notwithstanding applicant's ownership of a prior registration in which a piecemeal disclaimer of the words "MEDICAL" and</p>	

"DISPOSABLES" was permitted)); whether a mark is geographically misdescriptive (In re Loew's Theatres, Inc., 769 F.2d 764, 226 USPQ 865 (Fed. Cir. 1985) (examining attorney could properly refuse registration on ground that mark DURANGO for chewing tobacco is primarily geographically deceptively misdescriptive, even though applicant owned incontestable registration of same mark for cigars)); whether a particular specimen is acceptable (In re McDonald's Corp., 229 USPQ 555 (TTAB 1985) (Board not bound to allow registration of APPLE PIE TREE for restaurant services merely because applicant had succeeded in registering the character and name as trademarks and the character as a service mark where the specimen did not evidence use as a trademark)); whether a mark is descriptive (In re Lean Line, Inc., 229 USPQ 781 (TTAB 1986) (LEAN found merely descriptive of low-calorie foods, even though applicant had registered the term for other goods and services and a third party had registered the term "LEAN CUISINE" with no disclaimer)), (In re Harcourt Brace Jovanovich, Inc., 222 USPQ 820 (TTAB 1984) (LAW & BUSINESS incapable of distinguishing the services of arranging and conducting seminars in the field of business law, notwithstanding applicant's ownership of a registration on the Supplemental Register for the same mark for books, pamphlets and monographs)), (In re Pilon, 195 USPQ 178 (TTAB 1977) (prior registration of a chapter title does not compel registration of a different chapter title because such titles are merely descriptive); or whether services are properly identified (In re Local Trademarks, Inc., 220 USPQ 728 (TTAB 1983) (refusal of registration on the ground that WHEN IT'S TIME TO ACT did not identify advertising services upheld; Board not bound to allow registration simply because applicant owned registrations bearing similar recitations of services)).

The few reported decisions that involve likelihood of confusion are readily distinguishable from the instant case. For example, In re Perez, 21 USPQ2d 1075 (TTAB 1991) the applicant's prior registration had expired. In re Sunmarks Inc., 32 USPQ2d 1470 (TTAB 1994) concerned the same mark but for additional goods that overlapped with those in the third party registration.[1] Even there the Board found such a refusal "troublesome," *id.* at 1472, but reached its conclusion in part because the applicant's goods are, like the instant applicant's, "relatively inexpensive and, thus, are subject to casual purchases. As stated in the past, purchasers of such products are held to a lesser standard of purchasing care and are more likely to be confused as to the source of the goods." *Id.* at 1473. And In re Wilson, 57 USPQ2d 1863 (TTAB 2001) is most remarkable not for the determination that the "Reasoned decisionmaking" doctrine, which prohibits a federal agency from creating conflicting lines of precedent governing identical situations, did not entitle applicant to registration of PINE CONE BRAND for packaged fresh citrus fruit, even though Office issued registration for similar PINE CONE mark in 1933 despite the then-existing registration for PINE CONE mark that was cited against applicant. Rather, In re Wilson is most notable for the finding that, "even assuming that the "reasoned decisionmaking" doctrine were applicable to this case, we find that there is a plausible, rational explanation for the apparent inconsistency inherent in the Office's registration of applicant's PINE CONE mark and its refusal to register applicant's mark today. Simply put, the law has changed. In 1933, the Trademark Act of 1905 governed the federal registration of marks. Under that statute, a prerequisite to the refusal of registration on the ground of likelihood of confusion was that the goods of the applicant and the prior registrant be "of the same descriptive properties." Trademark Act of 1905, Section 5. The Lanham Act of 1946 replaced that standard with the more flexible modern "related goods" test, which does not require that the goods themselves be the same or similar to each other, but rather requires only that they be sufficiently related that source or other confusion is likely." *Id.* at 1871. Put another way, In re Wilson is most notable for the "rational explanation" as to why the earlier registration issued. No such "rational explanation" as to why the instant applicant's registration issued; there is no "apparent inconsistency" that the examiner need now attempt to rectify.

#### Conclusion

Applicant's prior AZIMUTH registration supports publication of its AZIMUTH DIRECTOR application for highly similar goods. This is particularly the case, as set forth in greater detail in the applicant's earlier response, given (i) the visual differences between

AZIMUTH DIRECTOR  
v.  
AZIMUTH INCORPORATED (& Design)  
[See attached jpg file]

(the examiner's side-by-side comparison for purposes of arguing that the AZIMUTH component is dominant, showing the AZIMUTH component in bold, cannot displace the overriding rule that trademarks are to be considered in their entireties, and visual differences as between the registrant's word-plus-design mark and the applicant's word mark are striking) (ii) the aural differences arising from the DIRECTOR and INCORPORATED components, (iii) that highly specialized software is not so closely related to consulting services as to be likely to cause confusion among an appreciable number of prospective purchasers, and (iv) that the applicant's products are relatively expensive and, thus, are not subject to casual purchases such that its customers are held to a higher standard of purchasing care and are less likely to be confused as to the source of the goods.

Based on the foregoing, the applicant respectfully requests that the examiner withdraw the refusal, and allow the application to proceed to publication.

**Exhibit A**

On February 4, 2003, the Office registered the AZIMUTH INCORPORATED (& Des.) mark to Azimuth, Inc. for the following products:

Computer development software services in the field of information operations; computer network design engineering services; and technical consultation and research in the fields of navigation and communications.

On June 1, 2004, the Office registered the AZIMUTH mark to the instant applicant for the following products:

Electronic and optical testing hardware and software for use in testing communications equipment functionality, conformance, interoperability and performance; electronic and optical testing hardware and software for use in analysis of communications equipment behavior under different test conditions; electronic and optical testing hardware and software for use in verification of communications equipment security functionality and performance of security features.

The applicant here requests that the AZIMUTH DIRECTOR mark in Application Ser. No. 78/285,760 be published for use with the following products:

Computer software, namely, software for synchronized setup, operation and reporting of test equipment and procedures in the wireless network test environment.

[1] As set forth in Exhibit A, the instant application for software used in the "in the wireless network test environment" is narrower than the applicant's registration for software for use "in testing communications equipment functionality, conformance, interoperability and performance."

**EVIDENCE SECTION**

EVIDENCE FILE NAME	\\TICRS\EXPORT8\IMAGEOUT8\782\857 \78285760\xml1\RO A0002.JPG
DESCRIPTION OF EVIDENCE FILE	the registrant's word plus design mark

**GOODS AND/OR SERVICES SECTION (no change)****SIGNATURE SECTION**

RESPONSE SIGNATURE	/Thomas F. Dunn/
SIGNATORY NAME	Thomas F. Dunn
SIGNATORY POSITION	Counsel for applicant
SIGNATURE DATE	10/23/2005

**FILING INFORMATION SECTION**

SUBMIT DATE	Sun Oct 23 21:22:38 EDT 2005
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TEAS STAMP	USPTO/OA-6445173162-20051 023212238157023-78285760- 200c4f9d83aa2381fe7423b89 83cc8a83f-N-N-20051023212 153871143
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## Response to Office Action

### To the Commissioner for Trademarks:

Application serial no. **78285760** is amended as follows:

#### Argument(s)

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

The applicant respectfully requests that the examining attorney reconsider her determination that applicant's AZIMUTH DIRECTOR mark so resembles the AZIMUTH INC. (& Des.) mark as to be likely to cause confusion, to cause mistake, or to deceive. Specifically, the applicant requests that the examiner closely reconsider whether the fact that the applicant owns the AZIMUTH mark, when coupled with the arguments presented by the applicant in response to the first Office action, militates in favor of withdrawing the 2(d) refusal.

#### Applicant's Prior AZIMUTH Registration Supports Publication of AZIMUTH DIRECTOR for Highly Similar Goods

The examiner's refusal to register the AZIMUTH DIRECTOR application on grounds that it is likely to cause confusion with AZIMUTH INCORPORATED (& Des.) mark, despite the fact that the applicant owns a registration for the AZIMUTH mark for similar goods, should be withdrawn.

As the examiner may recall, because this issue was not expressly addressed in the Final refusal, counsel for the applicant telephoned the examiner to confirm that she appreciated that the applicant owns a registration for the AZIMUTH mark for goods that are very similar to those identified in its AZIMUTH DIRECTOR application. See Exhibit A. In her voice mail reply the examiner stated that "the law is actually quite clear" that ownership of the prior AZIMUTH registration doesn't preclude refusal of the AZIMUTH DIRECTOR application. While this may be true as a technical matter, as a practical matter such a refusal is extraordinarily rare, and is unwarranted here.

Most decisions in which the Board has determined that prior registrations are not controlling as to subsequent applications for the same, or virtually the same, mark involve issues other than likelihood of confusion, such as: whether incontestable status compelled registration of same mark for broader services (In re Merrill Lynch, Pierce, Fenner & Smith, Inc., 828 F.2d 1567, 4 USPQ 2d 1141 (Fed. Cir. 1987) (incontestable registration of CASH MANAGEMENT ACCOUNT for credit card services did not automatically entitle applicant to registration of the same mark for broader financial services)); whether a disclaimer should be required (In re Best Software Inc., 58 USPQ2d 1314 (TTAB 2001) (applicant's ownership of registration for the mark BEST! did not preclude the examining attorney from requiring a disclaimer of "Best" in applications seeking registration of BEST! SUPPORT PLUS and BEST! SUPPORT

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[1] As set forth in Exhibit A, the instant application for software used in the "in the wireless network test environment" is narrower than the applicant's registration for software for use "in testing communications equipment functionality, conformance, interoperability and performance."

**Evidence**

Evidence in the nature of the registrant's word plus design mark has been attached.

Evidence-1

**Response Signature**

Signature: /Thomas F. Dunn/ Date: 10/23/2005

Signatory's Name: Thomas F. Dunn

Signatory's Position: Counsel for applicant

Serial Number: 78285760

Internet Transmission Date: Sun Oct 23 21:22:38 EDT 2005

TEAS Stamp: USPTO/OA-6445173162-20051023212238157023

-78285760-200c4f9d83aa2381fe7423b8983cc8

a83f-N-N-20051023212153871143



The logo features the word "azimuth" in a bold, lowercase, sans-serif font. A horizontal line with arrowheads at both ends passes through the middle of the letters. A vertical line with arrowheads at both ends passes through the middle of the letter "i". Below the word "azimuth" is the word "incorporated" in a smaller, lowercase, sans-serif font.

**azimuth**  
incorporated