

ESTTA Tracking number: **ESTTA102865**

Filing date: **10/05/2006**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	78479366
Applicant	Alarmax Distributors, Inc.
Applied for Mark	ALARMAX
Correspondence Address	THOMAS C. WETTACH COHEN & GRIGSBY, P.C. 11 STANWIX ST STE 15 PITTSBURGH, PA 15222-1312 UNITED STATES iptrademark@cohenlaw.com
Submission	Reply Brief
Attachments	Appeal Brief-ALARMAX.pdf (4 pages)(19834 bytes)
Filer's Name	Thomas C. Wettach
Filer's e-mail	iptrademark@cohenlaw.com
Signature	/Thomas C. Wettach/
Date	10/05/2006

REPLY

This Reply is in response to the Examining Attorney's Appeal Brief in the above-captioned appeal.

ARGUMENT

Applicant respectfully submits that the differences between the Examining Attorney and Applicant involves the pragmatic factor whether there can be a likelihood of confusion in the trade channels of Applicant and Registrant. The marks are different but similar. Applicant submits that the similarity of the marks is not likely to cause confusion in the respective trade channels of the services provided by either. The Registrant's mark, "ALARMEX", shown in U.S. Registration No. 1,784,455 (the "455 mark") is for the installation, maintenance, and repair of burglar, holdup, fire alarms and closed circuit tv systems for surveillance and for the design of such systems whereas Applicant's application for "ALARMAX" (Serial No. 78/479366) is for wholesale distribution featuring security systems and alarm equipment. The Examining Attorney's position in the Appeal Brief, p.5., based on dictionary definitions, is that "applicant is selling security systems and alarm equipment, and the Registrant is providing the design and maintenance services of such systems." The Examining Attorney states that "[a]s a result, the parties' services are highly related because they all involve a stage of service in the ownership of security alarm systems." And, finally concluding that "[t]he marks are therefore used in the same manner and in closely related channels of trade." Applicant respectfully submits that this analysis is flawed since it is not based on the realities of the market place. The customers of these services are those who one looks to determine if there is a likelihood of confusion. It is submitted that Applicant's wholesale distributorship has totally different customers than the customers of Registrant's services which are retail purchasers.

Applicant agrees with Examining Attorney that the printouts submitted with the Examining Attorney's Appeal Brief show third-party marks used in connection with the same or similar services as Registrant. However, Applicant does not agree that they are the same as its services. As Applicant has attempted to show, they do not show "wholesale distributorships". The fact that Applicant is a wholesale distributorship defines a different customer base from retail sales, retail distributorship and installation and maintenance services. Accordingly, the services of Applicant and Registrant do not emanate from the same source, but different sources. There is no likelihood of confusion under Section 2(d).

To support a refusal to register pursuant to § 2(d), the Examining Attorney must show that Applicant's mark is likely to cause confusion among potential purchasers. To sustain the § 2(d) rejection, it is not enough to show that confusion among potential purchasers is "possible." *Am. Steel Foundries v. Robertson*, 269 U.S. 372 (1926). As previously mentioned in Applicant's Appeal Brief, to merit registration, it is only necessary that a reasonably prudent purchaser is *not likely* to be confused. See, e.g., *In re E.I. DuPont de Nemours & Co.*, 476 F.2d 1357 (C.C.P.A. 1973).

In particular, *DuPont* instructs that two factors that should be considered in evaluating likelihood of confusion are the nature and extent of any actual confusion and the length of time that the marks have been used concurrently without evidence of actual confusion. *In re DuPont*, 476 F.2d at 1361. It is notable that Applicant and Registrant of the '455 mark have been using their marks concurrently since 1992 with no known instances of actual confusion. "[T]he absence of any evidence of actual confusion over a substantial period of time...creates a strong inference that there is no likelihood of confusion." *Carefirst of Maryland, Inc. v. First Care, P.C.*, 434 F.3d 263, 269 (4th Cir. 2006); *Amstar Corp. v. Domino's Pizza, Inc.*, 615 F.2d 252,

263 (5th Cir. 1980). Applicant and Registrant have used their marks concurrently for more than fourteen (14) years without any known instances of actual confusion strongly suggests that confusion between the marks in the future is highly unlikely. "A mere assumption that confusion is likely will rarely prevail against uncontroverted evidence from those on the firing line that it is not." *In re DuPont*, 476 F.2d at 1362. This is the critical difference between wholesale and retail customers and installers.

DuPont states that likelihood of confusion may also be determined by the similarity or dissimilarity of the goods or services and the buyers to whom sales of such goods or services are made. *Id.* at 1361.

Contrary to what the Examining Attorney has stated, Applicant's and Registrant's services are not "highly related" as to those who are likely to be confused. Applicant is a wholesale distributor of security systems and alarm equipment to licensed dealers and installers. Applicant uses its mark to promote its distributorship services to licensed dealers and installers only. Applicant's online catalog can only be accessed by licensed dealers/installers who have an account, user name, and password registered with the company. Contrast that to Registrant which offers commercial-grade security solutions tailored to retailers. Thus, Applicant's and Registrant's services do not overlap and as such there is little likelihood of confusion between their marks.

Further, where the predominant consumers of goods or services are different, "the possibility of confusion, mistake, or deception" is lessened. *Amstar*, 615 F.2d at 262. Applicant and Registrant offer their services to different and distinct target markets and buyers. *See, e.g., Homeowners Group, Inc. v. Home Mktg. Specialists, Inc.*, 931 F.2d 1100, 1109 (6th Cir. 1991).

There is little chance of confusion between Applicant's mark and the '455 mark because the predominant purchasers of the services associated with each are different.

Finally, with respect to expansion of trade by either Applicant or Registrant, Examining Attorney states that expansion of trade by either Applicant or Registrant "must be assumed that either party could pursue any logical avenue of trade at anytime." While the assumption may be correct, it cannot be inferred therefrom that it is logical for either Applicant or Registrant to expand into the other's trade since both would most likely lose its current customer base. Wholesale and retail are very different channels of trade, even for the same security devices, and the customers are different. Further, Applicant and the Registrant of the '455 mark have been using their respective marks concurrently for more than fourteen years and neither Applicant nor Registrant has expanded the services offered to include those offered by the other party.

CONCLUSION

Applicant's "ALARMAX" mark does not create a likelihood of confusion among potential purchasers. Applicant is unaware of any instances of actual confusion between Applicant's mark and the '455 mark during fourteen years of concurrent use. Most importantly, the nature of the goods and services described in Applicant's application and in the '455 registration, and the purchasers of those goods and services, are different. And, neither Applicant nor Registrant have expanded their services to include those offered by the other in the past fourteen years. Finally, the Patent and Trademark Office previously recognized that Applicant's "ALARMAX" mark was entitled to registration despite the '455 mark. For at least these reasons, Applicant is entitled to registration of the "ALARMAX" mark on the Principal Register and such registration is respectfully requested.