

Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	79093967
LAW OFFICE ASSIGNED	LAW OFFICE 104
MARK SECTION (no change)	
ARGUMENT(S)	
EVIDENCE SECTION	
EVIDENCE FILE NAME(S)	
ORIGINAL PDF FILE	evi_3898229171-170350868_.Argument.pdf
CONVERTED PDF FILE(S) (4 pages)	\\TICRS\EXPORT11\IMAGEOUT11\790\939\79093967\xml11\RFR0002.JPG
	\\TICRS\EXPORT11\IMAGEOUT11\790\939\79093967\xml11\RFR0003.JPG
	\\TICRS\EXPORT11\IMAGEOUT11\790\939\79093967\xml11\RFR0004.JPG
	\\TICRS\EXPORT11\IMAGEOUT11\790\939\79093967\xml11\RFR0005.JPG
DESCRIPTION OF EVIDENCE FILE	Argument relating to Section 2(d) refusal.
GOODS AND/OR SERVICES SECTION (007)(current)	
INTERNATIONAL CLASS	007
DESCRIPTION	
Compressors for machines; pump impellers; air compressors for machines, namely, radial compressors, isotherm compressors, air compressors, process air compressors, and single-shaft compressors	
GOODS AND/OR SERVICES SECTION (007)(proposed)	
INTERNATIONAL CLASS	007
TRACKED TEXT DESCRIPTION	
Compressors for machines ; Compressors for machines, namely, radial compressors, air compressors,	

process air compressors, and single-shaft compressors; ~~pump impellers; air compressors for machines, namely, radial compressors, isotherm compressors, air compressors, process air compressors, and single-shaft compressors~~

FINAL DESCRIPTION

Compressors for machines, namely, radial compressors, air compressors, process air compressors, and single-shaft compressors

GOODS AND/OR SERVICES SECTION (037)(no change)

SIGNATURE SECTION

RESPONSE SIGNATURE	/Lance J Lieberman/
SIGNATORY'S NAME	Lance J Lieberman
SIGNATORY'S POSITION	Applicant's Attorney of Record and Member of the Bar of the State of New York
SIGNATORY'S PHONE NUMBER	212-297-2697
DATE SIGNED	05/10/2012
AUTHORIZED SIGNATORY	YES
CONCURRENT APPEAL NOTICE FILED	NO

FILING INFORMATION SECTION

SUBMIT DATE	Thu May 10 17:10:22 EDT 2012
TEAS STAMP	USPTO/RFR-38.98.229.171-2 0120510171022204166-79093 967-490bcd7522f83fa3374e6 e3e8b41cf3c59e-N/A-N/A-20 120510170350868963

**Request for Reconsideration after Final Action
To the Commissioner for Trademarks:**

Application serial no. **79093967** has been amended as follows:

ARGUMENT(S)

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

EVIDENCE

Evidence in the nature of Argument relating to Section 2(d) refusal. has been attached.

Original PDF file:

[evi_3898229171-170350868_. Argument.pdf](#)

Converted PDF file(s) (4 pages)

[Evidence-1](#)

[Evidence-2](#)

[Evidence-3](#)

[Evidence-4](#)

CLASSIFICATION AND LISTING OF GOODS/SERVICES

Applicant proposes to amend the following class of goods/services in the application:

Current: Class 007 for Compressors for machines; pump impellers; air compressors for machines, namely, radial compressors, isotherm compressors, air compressors, process air compressors, and single-shaft compressors

Original Filing Basis:

Filing Basis Section 66(a), Request for Extension of Protection to the United States. Section 66(a) of the Trademark Act, 15 U.S.C. §1141f.

Proposed:

Tracked Text Description: ~~Compressors for machines;~~ [Compressors for machines, namely, radial compressors, air compressors, process air compressors, and single-shaft compressors;](#) ~~pump impellers; air compressors for machines, namely, radial compressors, isotherm compressors, air compressors, process air compressors, and single-shaft compressors~~

Class 007 for Compressors for machines, namely, radial compressors, air compressors, process air compressors, and single-shaft compressors

Filing Basis Section 66(a), Request for Extension of Protection to the United States. Section 66(a) of the Trademark Act, 15 U.S.C. §1141f.

SIGNATURE(S)

Request for Reconsideration Signature

Signature: /Lance J Lieberman/ Date: 05/10/2012

Signatory's Name: Lance J Lieberman

Signatory's Position: Applicant's Attorney of Record and Member of the Bar of the State of New York

Signatory's Phone Number: 212-297-2697

The signatory has confirmed that he/she is an attorney who is a member in good standing of the bar of the highest court of a U.S. state, which includes the District of Columbia, Puerto Rico, and other federal territories and possessions; and he/she is currently the applicant's attorney or an associate thereof; and to the best of his/her knowledge, if prior to his/her appointment another U.S. attorney or a Canadian attorney/agent not currently associated with his/her company/firm previously represented the applicant in

this matter: (1) the applicant has filed or is concurrently filing a signed revocation of or substitute power of attorney with the USPTO; (2) the USPTO has granted the request of the prior representative to withdraw; (3) the applicant has filed a power of attorney appointing him/her in this matter; or (4) the applicant's appointed U.S. attorney or Canadian attorney/agent has filed a power of attorney appointing him/her as an associate attorney in this matter.

The applicant is not filing a Notice of Appeal in conjunction with this Request for Reconsideration.

Serial Number: 79093967

Internet Transmission Date: Thu May 10 17:10:22 EDT 2012

TEAS Stamp: USPTO/RFR-38.98.229.171-2012051017102220

4166-79093967-490bcd7522f83fa3374e6e3e8b

41cf3c59e-N/A-N/A-20120510170350868963

This is submitted in response to the “final” Office Action of November 10, 2012.

Registration of Applicant’s mark “AR-MAX1” stands refused under Section 2(d) of the Trademark Act on the ground of confusingly similarity with several registered marks that each incorporate the lettering “AR” and which are owned by multiple unrelated entities. More particularly, the refusal is based on the registered mark “AR” in Design (No. 1,484,033) of Clyde Bergemann, Inc., and several registered marks of Annovi Reverberi S.p.A., namely, the marks “AR” in Design (No. 2,145,870), “AR ANNOVIA REVERBERI” (No. 3,008,291), “AR NORTH AMERICA” (No. 3,010,125) and “AR BLUE CLEAN” (No. 3,547,052). All of the cited marks are registered in respect of goods in International Class 007; Applicant’s goods are likewise classified in Class 007, and its services relate to Class 007 goods.

At the outset, Applicant points out that it has further amended the recitation of goods of the instant application to further clarify the products with which it is actually using, or intending to use, the AR-MAX1 trademark which is the subject of this application. In that regard, it is noted that the Examining Attorney, in the current Office Action, states that “applicant’s previous identification [of goods] indicated that many of the goods are used in furnaces, and the attached evidence from the applicant’s website supports this.” Applicant points out, as further discussed below, that although it is an extremely large multinational company that produces a wide variety of goods, and that offers many services, for a variety of industries and applications, nothing in the “attached evidence” either indicates or suggests that Applicant’s AR-MAX1 trademark is used, or intended for use, for anything other than the specific goods and services currently listed in the current recitation of goods of the instant application – and, indeed, it is *not*. Applicant’s right to register the instant trademark should not be determined on the basis of the breadth of its various businesses; only those goods and services specified in the Identification of Goods and Services are relevant to this determination.

In response to the prior Office Action in which registration was refused under Section 2(d) based on the same cited references, Applicant argued that the USPTO’s demonstrated determination that multiple registrants of the identical mark “AR” for various Class 007 goods can coexist on the Register without the likely development of confusion should be equally applied to the current Applicant whose mark is, moreover, *different* from the marks of the cited registrations. Applicant maintains and reiterates that argument. Specifically, Applicant argued, and continues to now assert, that:

As should be apparent, the USPTO has concurrently registered the cited marks of these two unrelated registrants. It is noted that both registrants have registered the *identical* wordmark “AR” for the very *same* types of machines, namely, “cleaning machines”. Concurrent registration of the same mark for the same types of goods by different, unrelated registrants indicates that the USPTO has acknowledged that marks consisting of or incorporating the letters “AR” for Class 007 industrial machines can peacefully coexist without the likely development of confusion in the relevant marketplace.

Applicant’s mark AR-MAX1 likewise includes the letters “AR”, for goods in Class 007. Significantly, Applicant’s mark also includes the suffix “-MAX1”, a

suffix distinctly different from any of the additional wording included in each of the cited composite marks of registrant Annovi Reverberi – i.e. “ANNOVIA REVERBERI”, “NORTH AMERICA” and “BLUE CLEAN”. Applicant’s mark is, as a consequence, quite clearly *different* from each of the registered marks applied in the Section 2(d) refusal by the Examining Attorney. Put another way, Applicant’s mark, when considered as a whole, leaves a distinctly different commercial impression than does any of the cited marks, including those consisting solely of the letters “AR”.

Applicant’s mark is moreover *at least* as different as are the respective marks of the two cited registrants from each other. Since the USPTO has determined that even the *identical* “AR” wordmarks of the cited registrants can peacefully coexist on the Register, Applicant’s mark “AR-MAX1” which is the subject of the present application should and must likewise be deemed to be registrable.

The Examining Attorney has nevertheless maintained his refusal on the same grounds and cited registrations.

In the current refusal, the Examining Attorney acknowledges that, in assessing the likelihood of confusion, it is appropriate to consider circumstances surrounding the sale of the goods and services, and that “[t]hese circumstances include the marketing channels, the identity of the prospective purchasers, and the degree of similarity between the marks and between the goods and/or services. [citations omitted]” These “circumstances” take on increased relevance where, for example, the marks of the Applicant and cited registrants are not the same, which is the case here; although Applicant’s and each of the cited registrant’s marks include the lettering “AR”; Applicant’s mark is “AR-MAX1”, whereas the various marks of the two cited registrants are “AR ANNOVIA REVERBERI”, “AR NORTH AMERICA” and “AR BLUE CLEAN” and for *each* of the two unrelated cited registrants, “AR” (standing alone) in a respective logo design.

The Examining Attorney has attached to the “final” Office Action, and thus made of record, printed copies of portions of the website of Applicant and of each of the two cited registrants. As is immediately apparent from a cursory review of those printouts, each of Applicant and the cited registrants is in fact in a *different* business, and the products – and, accordingly, the customers – of each are themselves *different*.

Applicant MAN, as reported on its record website printout, provides products and services for “four main areas”:

“...where the first two – **power plants** and **marine engines** and their accompanying systems, can be said to be related. **Turbomachinery**, encompassing train capabilities, compressors, turbines and turbochargers, is the third area that itself can be related to the **reactors and apparatus** area, that is, the design, construction and assembly of constituent elements for refineries and the petrochemicals industry. The fourth area, **green technology**, has to do with the development of technologies to reduce emissions and increase efficiency.”

According to *its* record website printout the products of the first cited registrant, Annovi Reverberi, are directed to high pressure pumping applications such as power jet cleaning (e.g. for car washes and industrial pressurized surface cleaning) and agricultural applications (e.g. crop irrigation). This application niche for the company's products is even more evident in a fuller examination of the company's full website. Not surprisingly, its cited registrations recite "power operated spray guns", "multi-purpose pressure cleaning machines", "power operated hydraulic pistols for washing", "multi-purpose pressure cleaning machines", and "machines for cleaning surfaces using high pressure water".

The products of the second cited registrant, Clyde Bergemann, Inc., according to its record website printout, are directed to cleaning systems, i.e. "furnace cleaning systems" and "backpass cleaning systems" for "sootblowing". Its cited registration, of the mark "AR", is for "machines for automatically cleaning combustion-air supply parts in a chemical recovery furnace".

Two things are immediately apparent from this information.

First, the products produced by each of the two cited registrants, and by Applicant, are all *different*. They are manufactured, promoted and sold for *different* applications and *different* industries. They are of interest to *different* purchasers, customers and end users. *They are not interchangeable*. A potential purchaser seeking the products of one of the three companies would not intentionally, or mistakenly, seek out or purchase the products of another of the three companies. This *greatly* minimizes, if not wholly obviates, the likely development of confusion between Applicant's and either of the cited registrant's marks which are, in any event, themselves *different* when (as they must be) viewed or considered as a whole.

Second, the respectively different end uses and applications and industries to which each of the cited registrants, and Applicant, direct its respective products – and in which those products are of any utility – are industrialized, complex and *sophisticated*. The purchasers and potential purchasers of the products of each of these three companies must themselves be sufficiently sophisticated and educated in the specific articles intended to be purchased that they are in fact *highly unlikely* to mistakenly purchase, or seek to purchase, the goods of one of the three companies believing them to be the goods of another of the companies. The various goods of each are not, and would never be considered, as "impulse" purchases; to even consider the purchase of any of the goods or services of Applicant's subject application, or of the cited registrations, would require an educated and sophisticated purchaser familiar with the application and machinery or the like with which the articles are to be used, and/or the services are to be applied. Accordingly the "circumstances" of this factor, too, *greatly* minimize, if not wholly obviate, the likely development of confusion between the marks of Applicant and either of the cited registrants.

When added to the fact that Applicant's mark, on the one hand, and the several marks of the two different and unrelated registrants cited in the Office Action in support of the Section 2(d) refusal, are themselves *different* – sharing only the letters "AM" (which, in the case of Applicant's mark, is present as an integrated whole of a unitary wordmark) – these "circumstances surrounding the sale of the goods" take on enhanced weight and significance sufficient in themselves to overcome the Examining Attorney's suggestion that Applicant's mark is likely be confused with the marks of the cited registrations.

The Section 2(d) refusal should accordingly be withdrawn.