

From: Benjamin, Sara

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Subject: U.S. TRADEMARK APPLICATION NO. 79104109 - GROOVEX - 62159 - Request for Reconsideration Denied - Return to TTAB - Message 1 of 0

Attachment Information:

Count: 45

Files: 71455152P001OF003.JPG, 71455152P002OF003.JPG, 71455152P003OF003.JPG, 72356544P001OF001.JPG, 73212948P001OF002.JPG, 73212948P002OF002.JPG, 73245349P001OF002.JPG, 73245349P002OF002.JPG, 73554593P001OF001.JPG, 73664737P001OF002.JPG, 73664737P002OF002.JPG, 73687269P001OF002.JPG, 73687269P002OF002.JPG, 73697447P001OF003.JPG, 73697447P002OF003.JPG, 73697447P003OF003.JPG, 74058776P001OF003.JPG, 74058776P002OF003.JPG, 74058776P003OF003.JPG, 74353447P001OF001.JPG, 74446399P001OF002.JPG, 74446399P002OF002.JPG, 74627098P001OF001.JPG, 74678982P001OF003.JPG, 74678982P002OF003.JPG, 74678982P003OF003.JPG, 75014787P001OF002.JPG, 75014787P002OF002.JPG, 75064601P001OF002.JPG, 75064601P002OF002.JPG, 75591510P001OF003.JPG, 75591510P002OF003.JPG, 75591510P003OF003.JPG, 75865731P001OF002.JPG, 75865731P002OF002.JPG, 75917359P001OF003.JPG, 75917359P002OF003.JPG, 75917359P003OF003.JPG, 76031675P001OF003.JPG, 76031675P002OF003.JPG, 76031675P003OF003.JPG, 76209632P001OF003.JPG, 76209632P002OF003.JPG, 76209632P003OF003.JPG, 79104109.doc

**UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)
OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION**

U.S. APPLICATION SERIAL NO. 79104109

MARK: GROOVEX



CORRESPONDENT ADDRESS:

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GENERAL TRADEMARK INFORMATION:
<http://www.uspto.gov/trademarks/index.jsp>

APPLICANT: Vargus Ltd.

CORRESPONDENT'S REFERENCE/DOCKET NO.:

62159

CORRESPONDENT E-MAIL ADDRESS:

REQUEST FOR RECONSIDERATION DENIED

ISSUE/MAILING DATE:

INTERNATIONAL REGISTRATION NO. 1094674

The trademark examining attorney has carefully reviewed applicant's request for reconsideration and is denying the request for the reasons stated below. *See* 37 C.F.R. §2.64(b); TMEP §§715.03(a)(2)(B), (a)(2)(E), 715.04(a). The refusal made final in the Office action dated August 3, 2012 are maintained and continue to be final. *See* TMEP §§715.03(a)(2)(B), (a)(2)(E), 715.04(a).

In its Request for Reconsideration, applicant argues "...the sophistication of the relevant purchasers ensures that likelihood of confusion is highly unlikely."

But the fact that purchasers are sophisticated or knowledgeable in a particular field does not necessarily mean that they are sophisticated or knowledgeable in the field of trademarks or immune from source confusion. TMEP §1207.01(d)(vii); *see, e.g., Imagineering Inc. v. Van Klassens Inc.*, 53 F.3d 1260, 1265, [34 USPQ2d 1526, 1530](#) (Fed. Cir. 1995); *Top Tobacco LP v. N. Atl. Operating Co.*, 101 USPQ2d 1163, 1170 (TTAB 2011). This is especially true, here, where the marks are nearly identical and the goods are identical, in part, and otherwise very closely related.

Accordingly, in the present case, applicant's request has not resolved the outstanding issue, nor does it raise a new issue or provide any new or compelling evidence with regard to the outstanding issue in the final Office action. In addition, applicant's analysis

and arguments are not persuasive nor do they shed new light on the issue. Accordingly, the request is denied.

The filing of a request for reconsideration does not extend the time for filing a proper response to a final Office action or an appeal with the Trademark Trial and Appeal Board (Board), which runs from the date the final Office action was issued/mailed. *See* 37 C.F.R. §2.64(b); TMEP §715.03, (a)(2)(B), (a)(2)(E), (c).

If time remains in the six-month response period to the final Office action, applicant has the remainder of the response period to comply with and/or overcome any outstanding final requirement(s) and/or refusal(s) and/or to file an appeal with the Board. TMEP §715.03(a)(2)(B), (c). However, if applicant has already filed a timely notice of appeal with the Board, the Board will be notified to resume the appeal when the time for responding to the final Office action has expired. *See* TMEP §715.04(a).

Pursuant to TMEP §715.03, the trademark examining attorney has attached additional evidence from the USPTO's X-Search database consisting of a number of third-party marks registered for use in connection with the same or similar goods as those of both applicant and registrant in this case. This evidence shows that the goods listed therein, namely, cutting, boring, grooving and thread cutting tools are of a kind that may emanate from a single source under a single mark. *See In re Anderson*, 101 USPQ2d 1912, 1919 (TTAB 2012); *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993); *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988); TMEP §1207.01(d)(iii).

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