

Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	79190282
LAW OFFICE ASSIGNED	LAW OFFICE 106
MARK SECTION	
MARK FILE NAME	https://tmng-al.uspto.gov/resting2/api/img/79190282/large
LITERAL ELEMENT	GENESIS
STANDARD CHARACTERS	NO
USPTO-GENERATED IMAGE	NO
COLOR(S) CLAIMED (If applicable)	Color is not claimed as a feature of the mark.
DESCRIPTION OF THE MARK (and Color Location, if applicable)	The mark consists of the stylized word "GENESIS" and design. The design features wings with the term GENESIS inside of the shield.
ARGUMENT(S)	
Please see the actual argument text attached within the Evidence section.	
EVIDENCE SECTION	
EVIDENCE FILE NAME(S)	
ORIGINAL PDF FILE	evi_38104197154-20170728124123585626_. 2017-07-28_Arguments.pdf
CONVERTED PDF FILE(S) (4 pages)	\\TICRS\EXPORT17\IMAGEOUT17\791\902\79190282\xml10\RFR0002.JPG
	\\TICRS\EXPORT17\IMAGEOUT17\791\902\79190282\xml10\RFR0003.JPG
	\\TICRS\EXPORT17\IMAGEOUT17\791\902\79190282\xml10\RFR0004.JPG
	\\TICRS\EXPORT17\IMAGEOUT17\791\902\79190282\xml10\RFR0005.JPG
DESCRIPTION OF EVIDENCE FILE	arguments
ADDITIONAL STATEMENTS SECTION	
ACTIVE PRIOR REGISTRATION(S)	The applicant claims ownership of active prior U.S. Registration Number(s) 5153286.
SIGNATURE SECTION	
RESPONSE SIGNATURE	/Amanda M. Prose/
SIGNATORY'S NAME	Amanda M. Prose
SIGNATORY'S POSITION	Attorney of Record; MN bar member
SIGNATORY'S PHONE NUMBER	6123343222
DATE SIGNED	07/28/2017
AUTHORIZED SIGNATORY	YES
CONCURRENT APPEAL NOTICE FILED	NO

FILING INFORMATION SECTION	
SUBMIT DATE	Fri Jul 28 14:11:31 EDT 2017
TEAS STAMP	USPTO/RFR-XX.XXX.XXX.XXX- 20170728141131708014-7919 0282-51043f5d40fbc470ea90 315f2e4b1578118c9185699dd 310e0894ebc471d5b7-N/A-N/ A-20170728124123585626

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PTO Form 1960 (Rev 10/2011)

OMB No. 0651-0050 (Exp 07/31/2017)

Request for Reconsideration after Final Action

To the Commissioner for Trademarks:

Application serial no. **79190282** GENESIS (Stylized and/or with Design, see <https://tmng-al.uspto.gov/resting2/api/img/79190282/large>) has been amended as follows:

ARGUMENT(S)

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

Please see the actual argument text attached within the Evidence section.

EVIDENCE

Evidence in the nature of arguments has been attached.

Original PDF file:

[evi_38104197154-20170728124123585626_.2017-07-28_Arguments.pdf](#)

Converted PDF file(s) (4 pages)

[Evidence-1](#)

[Evidence-2](#)

[Evidence-3](#)

[Evidence-4](#)

ADDITIONAL STATEMENTS

Claim of Active Prior Registration(s)

The applicant claims ownership of active prior U.S. Registration Number(s) 5153286.

SIGNATURE(S)

Request for Reconsideration Signature

Signature: /Amanda M. ProsE/ Date: 07/28/2017

Signatory's Name: Amanda M. Prose

Signatory's Position: Attorney of Record; MN bar member

Signatory's Phone Number: 6123343222

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 owner's/holder'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 owner/holder in this matter: (1) the owner/holder 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 owner/holder has filed a power of attorney appointing him/her in this matter; or (4) the owner's/holder'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.

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Internet Transmission Date: Fri Jul 28 14:11:31 EDT 2017

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e4b1578118c9185699dd310e0894ebc471d5b7-N

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In addition to the Applicant's previously submitted remarks, the Applicant provides the following clarifications to illustrate that there is no likelihood of confusion between the applied for mark and the cited registration (US 4,278,958).

As an initial note, it cannot be discounted that the applied for mark includes a design element, or is otherwise a logo. The logo itself is the subject of multiple prior registrations owned by the Applicant for various goods related directly to the sales of automobiles and automobile parts (in the identical design mark is registered for the actual automobile parts subject to the sales of those said parts as recited in the instant application). The design element provides a distinct commercial impression relating to the source of the applied for services (Applicant) from the cited registration. The marks are distinct and thus likelihood of confusion is diminished.

Next, the Examiner is further reminded that according to TMEP 1216.01, "each case must be decided on its own facts", and the facts in this case illustrate that there is no likelihood of confusion between the applied for mark and the cited registration, for at least the reasons discussed previously and those reasons now discussed below.

On page 3 of the outstanding Office Action the Examiner alleges that "applicant's prior registration and application are not for the same goods and services and the parties have not co-existed for five years. Thus applicant's prior registration does not obviate the Section 2(d) refusal."

While the "applicant's prior registration and application are not for the same goods and services", it is respectfully submitted that established precedent indicates that the applied for services are sufficiently related to the goods identified in the Applicant's prior registration that the Section 2(d) refusal is obviated (along with the at least nearly ten (10) years coexistence of the parties as discussed further below).

The Applicant's goods in its prior registration No. 3,531,628 are "automobiles" while the applied for services are "*Wholesale and retail store services featuring automobiles*; wholesale and retail store services *for parts and accessories for automobiles*; wholesale and retail store services for used *cars*; *automobile dealerships*; dealerships in the field of *automobile parts and automobile accessories*; commercial information agency services; business management of sports people; arranging of commercial car exhibitions for promotional purposes" (whereas the

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services “commercial information agency services; business management of sports people; arranging of commercial car exhibitions for promotional purposes”) are not subject to the Section 2(d) refusal.

There is in fact a high degree of similarity or relatedness between the goods and services in the application and Applicant’s prior registration, respectively. See *In re Best Prods. Co.*, 231 USPQ 988, 989 n.6 (TTAB 1986) (“[W]e infer in the instant case that the differences between the marks BEST & Des. and BEST JEWELRY & Des., and between the identifications of services in their respective registrations [‘mail order and catalog showroom services’ and ‘retail jewelry store services’], were deemed to be immaterial differences.”); *In re Owens-Illinois Glass Co.*, 143 USPQ 431, 432 (TTAB 1964) (holding applicant’s ownership of prior registration of LIBBEY for cut-glass articles acceptable as prima facie evidence of distinctiveness of identical mark for plastic tableware, the Board stated, “Cut-glass and plastic articles of tableware are customarily sold in the same retail outlets, and purchasers of one kind of tableware might well be prospective purchasers of the other.”); *In re Lytle Eng'g & Mfg. Co.*, 125 USPQ 308, 309 (TTAB 1960) (holding applicant’s ownership of prior registration of LYTLE for various services, including the planning, preparation, and production of technical publications, acceptable as prima facie evidence of distinctiveness of identical mark for brochures, catalogs, and bulletins).

The decision in *In re Strategic Partners, Inc.*, 102 USPQ2d 1397 (TTAB 2012) may be applied and weighed against a §2(d) refusal in the limited situation where: (1) an applicant owns a prior registration for the same mark or a mark with no meaningful difference from the applied-for-mark; (2) the identifications of goods/services in the application and applicant’s prior registration are identical or identical in relevant part; and (3) the applicant’s prior registration has co-existed for at least five years with the registration being considered as the basis for the Section 2(d) refusal. See *Id.* at 1400.

When the goods and services in question are well known or otherwise generally recognized as having a common source of origin, the burden of establishing relatedness is easier to satisfy. *In re St. Helena Hosp.*, 774 F.3d 747, 113 USPQ2d 1082 (Fed. Cir. 2014). For example, relatedness would generally be recognized when the services clearly include or encompass the goods in the identification, such as when the services are “brewpubs” and the goods are “beer” or when the services are “electronic transmission of data and documents via computer terminals” and the goods are “facsimile machines, computers, and computer software.”

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In re Coors Brewing Co., 343 F.3d 1340, 1347, 68 USPQ2d 1059, 1064 (Fed. Cir. 2003); *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1268, 62 USPQ2d 1001, 1005 (Fed. Cir. 2002).

Given that the services recited in the instant application are for the identical goods recited in Applicant's prior registration, it is respectfully submitted that there is no likelihood of confusion.

The prior registration is directed to goods that are identical in relevant part as the applied for mark related to the sale of those identical goods (automobiles/cars are identical goods).

It should next be understood that the parties have co-existed for more than five years. The cited mark has been in use since May 1, 1993 per the cited registration. The Applicant's GENESIS mark has been in use in connection with automobiles for almost 10 years. (See 3,531,628). The cited registration claims a first date of use prior to 2007 such that the cited registration and the Applicant's use of GENESIS on automobiles have concurrently existed, without any known instances of confusion since at least as early as April 4, 2007.

Further, Applicant is also the owner of prior Registration No. 5,153,286 for "Retail store services featuring automobiles; retail store services featuring parts and accessories of automobiles; sales agency services, namely retail stores featuring automobiles, distributorships in the field of automotive parts for automobiles, automobile dealerships; dealerships in the field of automobiles; sales agency services, namely, retail stores, distributorships, dealerships for parts and accessories of automobiles; retail store services for used automobiles" and the parties have co-existed without confusion for almost ten (10) years. This prior registration is for a mark with no meaningful difference from the applied-for-mark and the identifications of goods/services in the application and applicant's prior registration are identical or otherwise identical in relevant part and the registration covers services that have been in use since at least as early as 2008.

The Applicant has been using its logo and GENSIS mark in connection with cars, automobiles since 2008 and the mark is recognized in the goods and services related to "cars" as well as the retail store services featuring automobiles, for almost ten (10) years. The parties have co-existed without any known instance of confusion for almost ten years. It is respectfully submitted there is no likelihood of confusion.

It is respectfully requested this refusal be withdrawn and the application allowed to proceed to registration, however, the Applicant respectfully encourages the Examiner to contact

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the undersigned attorney, Amanda M. Prose, directly at 612-852-0619, for discussion of this response and actions for potential allowance.