

Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	85197830
LAW OFFICE ASSIGNED	LAW OFFICE 115
MARK SECTION (no change)	
ARGUMENT(S)	
<p style="text-align: center;"><u>RESPONSE TO REFUSAL TO REGISTER</u></p> <p style="text-align: center;"><u>Arguments</u></p> <p>A copy of these remarks are provided.</p> <p>Applicant has amended the identification of goods and services as “stationary surveillance and security cameras; wireless transceivers and software for communicating with surveillance and security cameras”.</p> <p>Applicant respectfully traverses the Examining Attorney’s final refusal to register on the basis of likelihood of confusion with Registration No. 3,319,731 (the “cited” mark).</p> <p><u>A. The Similarity of the Marks</u></p> <p>The Examining Attorney argues that it is improper to consider the goods when analyzing the commercial impression of a mark. However, to ignore the goods when analyzing the commercial impression of a mark means to look at the mark in the abstract. This is improper, because a mark is always used in conjunction with goods or services. For example, when looking at the commercial impression of mark “Amazon”, how is one to know which “Amazon” is being used, unless one knows the particular goods or services:</p> <p>Reg. No. 2,541,433 (breakfast cereals); Reg. No. 2,116,562 (non-alcoholic and non-carbonated soft drinks); Reg. No. 2,832,943 (electronic retailing services featuring books, etc.)</p> <p>The above three registrations are owned by different companies. The latter registration is the well-known Amazon.com.</p>	

B. Applicant's Goods are Different from the Goods of the Cited Mark

The cited mark is used on vehicle tracking goods and services using a global positioning system (GPS). In contrast, Applicant's mark is to be used on stationary surveillance and security cameras. Applicant's cameras are designed to be mounted to buildings or support structure that doesn't move. Because Applicant's cameras are not on vehicles, there is no need to use GPS. Nor is there a need to "track" as provided by the cited mark.

The goods and services are specifically different and non-competitive. Vehicle tracking goods are very different from cameras, even surveillance and security cameras. Vehicle tracking goods do not take pictures. Cameras do not track vehicles. The differences are even greater when comparing vehicle tracking services to cameras as cameras do not provide tracking services. Nor does the Applicant compete with the owner of the cited mark. (Exhibit 12, previously provided).

In *Electronic Design & Sales, Inc. v. Electronic Data Systems Corp.*, 954 F.2d 713, 716-717 (Fed. Cir. 1992), the court said it was error to deny the registration on the basis of relatedness of goods and services simply because the applicant sold some of its goods in some of the same fields in which the Opposer provided its services, without determining who the relevant persons (or purchasers) were. The court said this was especially true where the goods and services were specifically different and non-competitive, as in this instant case involving "Skyguard". The evidence shows that the relevant purchasers of Applicant's goods would not look to Applicant for vehicle tracking goods and services and would not look to the owner of the cited mark for. (Exhibit 12).

Relevant purchasers would not mistakenly believe that the respective goods originate from the same source, even if the same mark was used on both. *In re Princeton Electronics, Inc.*, Ser. No. 77/436,425 (TTAB 2010, precedential).

C. The Trade Channels are Different

As the owner of the cited mark explains, the vehicle tracking goods and services are marketed to owners of fleet vehicles, not retailers. (Exhibits 1, 7-8). Applicant sells the goods along with the tracking service. Conversely, Applicant's goods are marketed to retailers (Exhibit 12). Applicant does not sell a service along with the goods. Thus, the channels of trade are very different.

D. The Cited Marks Goods Require Sophistication and Care in Purchasing

Since the goods and services of the cited mark are marketed to owners of fleet vehicles, those customers are sophisticated and exercise care in purchasing. Sophistication is important and often dispositive. *Electronic Design*, supra, p. 718.

Also, the goods are relatively expensive. For example, GPS tracking devices cost hundreds of dollars (\$329 from Brickhouse; \$349 and up from Spy Associates; \$429 from Landseaair). (Exhibits 9-11). These prices are for the devices themselves; the tracking services are more. Applicant's camera goods sell for \$249-399. (Exhibit 12).

Such prices deter the casual shopper who buys on a whim. Instead, a customer is likely to spend

some time in studying the product before purchasing, therefore minimizing any likelihood of confusion.

E. “Skyguard” is Not Entitled to Broad Protection

One of the third party “Skyguard” registrations, Reg. No. 3975498, is for providing weather information. Such information is useful for tracking vehicles, so there is similarity in goods and service between the cited mark and a third party mark of the same mark.

In view of the foregoing, Applicant believes that the withdrawal of the refusal is in order, and such withdrawal is respectfully requested.

EVIDENCE SECTION

EVIDENCE FILE NAME(S)

ORIGINAL PDF FILE	evi_381223222-134550058_.Remarks_Skyguard.pdf
CONVERTED PDF FILE(S) (2 pages)	\\TICRS\EXPORT11\IMAGEOUT11\851\978\85197830\xml10\RFR0002.JPG
	\\TICRS\EXPORT11\IMAGEOUT11\851\978\85197830\xml10\RFR0003.JPG
DESCRIPTION OF EVIDENCE FILE	A copy of the remarks

GOODS AND/OR SERVICES SECTION (current)

INTERNATIONAL CLASS	009
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DESCRIPTION

Surveillance and security cameras; wireless transceivers and software for communicating with surveillance and security cameras

FILING BASIS	Section 1(b)
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GOODS AND/OR SERVICES SECTION (proposed)

INTERNATIONAL CLASS	009
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TRACKED TEXT DESCRIPTION

~~Surveillance and security cameras~~; [Stationary surveillance and security cameras](#); wireless transceivers and software for communicating with surveillance and security cameras

FINAL DESCRIPTION

Stationary surveillance and security cameras; wireless transceivers and software for communicating with surveillance and security cameras

FILING BASIS	Section 1(b)
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SIGNATURE SECTION

RESPONSE SIGNATURE	/Geoffrey A Mantooth/
SIGNATORY'S NAME	Geoffrey A Mantooth
SIGNATORY'S POSITION	Attorney for Applicant, Texas bar member
SIGNATORY'S PHONE NUMBER	817-336-2400
DATE SIGNED	03/26/2012
AUTHORIZED SIGNATORY	YES
CONCURRENT APPEAL NOTICE FILED	NO
FILING INFORMATION SECTION	
SUBMIT DATE	Mon Mar 26 13:50:54 EDT 2012
TEAS STAMP	USPTO/RFR-38.122.32.22-20 120326135054440150-851978 30-4908d21ab3cb4fe8c2dbf3 7774906ab09a-N/A-N/A-2012 0326134550058098

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

Application serial no. **85197830** has been amended as follows:

ARGUMENT(S)

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

RESPONSE TO REFUSAL TO REGISTER

Arguments

A copy of these remarks are provided.

Applicant has amended the identification of goods and services as “stationary surveillance and security cameras; wireless transceivers and software for communicating with surveillance and security cameras”.

Applicant respectfully traverses the Examining Attorney’s final refusal to register on the basis of likelihood of confusion with Registration No. 3,319,731 (the “cited” mark).

A. The Similarity of the Marks

The Examining Attorney argues that it is improper to consider the goods when analyzing the commercial impression of a mark. However, to ignore the goods when analyzing the commercial impression of a mark means to look at the mark in the abstract. This is improper, because a mark is always used in conjunction with goods or services. For example, when looking at the commercial impression of mark “Amazon”, how is one to know which “Amazon” is being used, unless one knows the particular goods or services:

Reg. No. 2,541,433 (breakfast cereals); Reg. No. 2,116,562 (non-alcoholic and non-carbonated soft drinks); Reg. No. 2,832,943 (electronic retailing services featuring books, etc.)

The above three registrations are owned by different companies. The latter registration is the well-known Amazon.com.

B. Applicant’s Goods are Different from the Goods of the Cited Mark

The cited mark is used on vehicle tracking goods and services using a global positioning system (GPS). In contrast, Applicant’s mark is to be used on stationary surveillance and security cameras. Applicant’s cameras are designed to be mounted to buildings or support structure that doesn’t move. Because Applicant’s cameras are not on vehicles, there is no need to use GPS. Nor is there a need to “track” as provided by the cited mark.

The goods and services are specifically different and non-competitive. Vehicle tracking goods are very different from cameras, even surveillance and security cameras. Vehicle tracking goods do not take pictures. Cameras do not track vehicles. The differences are even greater when comparing vehicle tracking services to cameras as cameras do not provide tracking services. Nor does the Applicant compete with the owner of the cited mark. (Exhibit 12, previously provided).

In *Electronic Design & Sales, Inc. v. Electronic Data Systems Corp.*, 954 F.2d 713, 716-717 (Fed. Cir. 1992), the court said it was error to deny the registration on the basis of relatedness of goods and services simply because the applicant sold some of its goods in some of the same fields in which the Opposer provided its services, without determining who the relevant persons (or purchasers) were. The court said this was especially true where the goods and services were specifically different and non-competitive, as in this instant case involving “Skyguard”. The evidence shows that the relevant purchasers of Applicant’s goods would not look to Applicant for vehicle tracking goods and services and would not look to the owner of the cited mark for. (Exhibit 12).

Relevant purchasers would not mistakenly believe that the respective goods originate from the same source, even if the same mark was used on both. *In re Princeton Electronics, Inc.*, Ser. No.

77/436,425 (TTAB 2010, precedential).

C. The Trade Channels are Different

As the owner of the cited mark explains, the vehicle tracking goods and services are marketed to owners of fleet vehicles, not retailers. (Exhibits 1, 7-8). Applicant sells the goods along with the tracking service. Conversely, Applicant's goods are marketed to retailers (Exhibit 12). Applicant does not sell a service along with the goods. Thus, the channels of trade are very different.

D. The Cited Marks Goods Require Sophistication and Care in Purchasing

Since the goods and services of the cited mark are marketed to owners of fleet vehicles, those customers are sophisticated and exercise care in purchasing. Sophistication is important and often dispositive. *Electronic Design*, supra, p. 718.

Also, the goods are relatively expensive. For example, GPS tracking devices cost hundreds of dollars (\$329 from Brickhouse; \$349 and up from Spy Associates; \$429 from Landseair). (Exhibits 9-11). These prices are for the devices themselves; the tracking services are more. Applicant's camera goods sell for \$249-399. (Exhibit 12).

Such prices deter the casual shopper who buys on a whim. Instead, a customer is likely to spend some time in studying the product before purchasing, therefore minimizing any likelihood of confusion.

E. "Skyguard" is Not Entitled to Broad Protection

One of the third party "Skyguard" registrations, Reg. No. 3975498, is for providing weather information. Such information is useful for tracking vehicles, so there is similarity in goods and service between the cited mark and a third party mark of the same mark.

In view of the foregoing, Applicant believes that the withdrawal of the refusal is in order, and such withdrawal is respectfully requested.

EVIDENCE

Evidence in the nature of A copy of the remarks has been attached.

Original PDF file:

[evi_381223222-134550058_Remarks_Skyguard.pdf](#)

Converted PDF file(s) (2 pages)

[Evidence-1](#)

[Evidence-2](#)

CLASSIFICATION AND LISTING OF GOODS/SERVICES

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

Current: Class 009 for Surveillance and security cameras; wireless transceivers and software for communicating with surveillance and security cameras

Original Filing Basis:

Filing Basis: Section 1(b), Intent to Use: The applicant has had a bona fide intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the identified goods and/or services as of the filing date of the application. (15 U.S.C. Section 1051(b)).

Proposed:

Tracked Text Description: ~~Surveillance and security cameras~~; [Stationary surveillance and security cameras](#); wireless transceivers and software for communicating with surveillance and security cameras

Class 009 for Stationary surveillance and security cameras; wireless transceivers and software for communicating with surveillance and security cameras

Filing Basis: Section 1(b), Intent to Use: The applicant has a bona fide intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the identified goods and/or services as of the filing date of the application. (15 U.S.C. Section 1051(b)).

SIGNATURE(S)

Request for Reconsideration Signature

Signature: /Geoffrey A Mantooth/ Date: 03/26/2012

Signatory's Name: Geoffrey A Mantooth

Signatory's Position: Attorney for Applicant, Texas bar member

Signatory's Phone Number: 817-336-2400

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: 85197830

Internet Transmission Date: Mon Mar 26 13:50:54 EDT 2012

TEAS Stamp: USPTO/RFR-38.122.32.22-20120326135054440

150-85197830-4908d21ab3cb4fe8c2dbf377749

06ab09a-N/A-N/A-20120326134550058098

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