

ESTTA Tracking number: **ESTTA515825**

Filing date: **01/14/2013**

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

Proceeding	85316592
Applicant	Zinpro Corporation
Applied for Mark	PROCARE 4
Correspondence Address	EDMUND J SEASE MCKEE VOORHEES & SEASE PLC 801 GRAND AVENUE, SUITE 3200 DES MOINES, IA 50309-2721 UNITED STATES patatty@ipmvs.com
Submission	Reply Brief
Attachments	Reply Brief for PROCARE 4.pdf (1 page)(749396 bytes)
Filer's Name	Edmund J. Sease
Filer's e-mail	patatty@ipmvs.com
Signature	/Edmund J. Sease/
Date	01/14/2013

I. INTRODUCTION

The Examiner acknowledges in his brief that the only remaining issue between the Applicant and the Examiner is likelihood of confusion (§ 2d). The Examiner's argument is a confusing long list of string cites from the MPEP, most of which have little do with the facts of the present case.

II. THE REAL ISSUE

Applicant mainly relies on the anti-dissection rule and the Examiner's improper dissection before any analysis to support the position that PROCARE is distinguishable from PROCARE 4 in a registerable way.

III. REPLY ARGUMENT

The Examiner's only response to Applicant's argument is that it is "factually incorrect and legally suspect", arguing "the Examiner gave proper consideration to the mark as a whole". While he says this, his office actions are to the contrary. As an example, in the Final Rejection the Examiner begins his analysis by comparison of the marks, pointing out his conclusion (without any reasoning to support it) that PROCARE is a dominant portion of the mark and that consumers are more inclined to focus on the first word and finally that the mere addition of the term 4 does not obviate the similarity (see final rejection page 3).

It is urged and argued in Applicant's main brief along with case authority that the Examiner's analysis should start out by pointing that for Applicant's mark is PROCARE 4, PROCARE and 4 are of same size characters and enjoy equal positioning; and that the number 4 is not understood by the public to mean anything in particular when associated with PROCARE; to them it is arbitrary. This is what led him astray, *Recot, Inc v. Becton*, 214 F.3d 1322 (Fed. Cir. 2000).

Why is the Examiner's conclusion that PROCARE is more important necessarily correct? It cannot be simply because it is first. Is "United" any more important than "States" in the name United States? Mark Twain said "the difference between the almost right word and right word is really a large matter....it's the difference between the lightning bug and the lightning"! Sometimes small words or numerals (as here) can be important creating a dramatically different commercial impression, consider Pennsylvania (state) versus Pennsylvania 6-5000 (Glenn Miller song).

The Examiner argues Applicant's evidence of many PROCARE registrations (and even some applications) is not reliable; but Applicant submitted those to show the registry is crowded and that PROCARE alone is weak, and that the public is educated to distinguish between the multitude of PROCARE marks by the rest of the mark. The Examiner argues hypothetically there may be coexistence agreements for some of the identically registered PROCARE marks, but even if there are, the public is still educated to discern differences necessitated by the crowded registry.

This Examiner's actions were wrong. He began with dissection rather than analysis of the mark as a whole. This let him astray and nothing later said in hindsight reconstruction corrects it. He should be reversed.