PTO Form 1930 (Rev 9/2007)
OMB No. 0651-0050 (Exp. 05/31/2014)

Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	86013199
LAW OFFICE ASSIGNED	LAW OFFICE 109
MARK SECTION (no change)	
ARGUMENT(S)	

Responsive to the final Office Action of February 6, 2014, the following remarks are hereby submitted and reconsideration is respectfully requested. Withdrawal of the objections to the goods and services, based on the amendments in the previous response, is acknowledged.

Section 2(d) Refusal

The Examining Attorney withdrew the refusal to register in relation to all of the classes of the application with the exception of Classes 9 and 37, to which the refusal based on U.S. Registration No. 3789306 ("the '306 registration") for the mark HORNETTEK and Design is maintained and made final.

Applicant respectfully requests withdrawal of the refusal of Classes 9 and 37 based on the differences between marks, specifically, the differences in overall appearance, sound, commercial impression, and the differences between the goods of the cited registration and the goods/services of the instant application. For these and the other reasons set forth below, Applicant believes that registration of its mark will not generate a likelihood of consumer confusion with the '306 registration. Accordingly, reconsideration and withdrawal of the refusal to register is respectfully requested.

The Marks are Not Confusingly Similar

The Examining Attorney indicates that the factors of the *DuPont* case, while considered, are not necessary relevant or given equal weight. *In re E.I. DuPont de Nemours & Co.*, 476 F.2d 1357, 1360-51 (C.C.P.A. 1973). However, it is reiterated that the comparison of two marks must be based on the marks in their entirety: their appearance, sound, connotation, and commercial impression must all be taken into account. When all of these factors are considered, Applicant respectfully submits that there is no likelihood of confusion between Applicant's mark and the mark in the cited registration.

The Examining Attorney relies heavily on the word "HORNET" appearing in both marks and considers it to be the dominant portion of the marks. The '306 registration includes "HORNETTEK" as a single word, which creates a different sound and commercial impression than the word "HORNET" of Applicant's mark. It is erroneous to assert that consumers will extract "HORNET" from the word

portion of the mark of the '306 registration and that it alone will create a dominant commercial impression in the minds of consumers. If the assertion in the Office Action that consumers request goods and/or services by the word portion of a mark is correct, the word portion of the mark of the '306 registration in its entirety is dominant. The difference between "HORNET" of the instant application and "HORNETTEK" of the cited registration should be given significant weight given the two words do not sound the same, especially in light of the additional syllable of the mark of the '306 registration. Additionally, "TEK" which is a commonly recognized misspelling of "tech" creates a dominate commercial impression in the minds of consumers, further eliminating any possibility of confusion in the marketplace.

The Courts and the TTAB have found no confusion in similar cases where marks merely share one or more words in common. *See A&H Sportswear Inc. v. Victoria's Secret Stores Inc.* 49 USPQ2d 1493 (3d Cir. 1999) (upholding a lower court decision that MIRACLE BRA for lingerie is not confusingly similar to MIRACLESUIT for swimwear); *Safeway Stores, Inc. v. Bel Canto Fancy foods Ltd.*, 5 USPQ2d 1980, 1982 (TTAB 1987) (holding that in terms of pronunciation, BEL AIR and BEL ARIA "are only slightly similar" and, therefore, there is no likelihood of confusion between the marks.). In addition, *General Mills, Inc. v. Kellogg Company*, 824 F.2d 622, 627 (8th Cir. 1987), established that OATMEAL RAISIN CRISP for breakfast cereal is not confusingly similar to APPLE RAISIN CRISP for breakfast cereal and recognized that "[t]he use of identical, even dominant, words in common does not automatically mean the two marks are similar."

Additionally, the mark of the '306 registration includes an animated hornet that is placed before the word "HORNETTEK." The location of the animated hornet also reduces the importance within the mark of the word portion of the '306 mark. The significant differences between the word portions of the marks and the importance of the design portion of the mark of the '306 registration lead to very different perceptions by consumers. *General Mills*, in which the TTAB found no confusion between two marks for identical products, in which the only difference is a word describing a flavor. Furthermore, the decision in *A&H Sportswear* noted above again found no likelihood of confusion between two marks that are clearly more similar than Applicant's mark and the cited mark. The comparison between the MIRACLE BRA and MIRACLESUIT marks is analogous to the comparison between HORNETTEK and Design and HORNET, in that both marks contain a word in common. Applicant's and Registrant's marks are less similar than MIRACLE BRA and MIRACLESUIT due to the differences between the word portions of the marks.

The Respective Goods and Services are Not Confusingly Similar

Under the test set forth in *DuPont*, determining whether confusion is likely also involves consideration of the similarity or dissimilarity and nature of the goods and services. *DuPont*, 476 F.2d 1357 at 1361.

It is important to note is that the scope of the cited registration is limited to goods in Class 9. The registration does not including any services, much less services in Class 37, for which the refusal was maintained. Although the services of the instant application relate to the general category of electronics/computers, withdrawal of the refusal based on the cited registration in relation to the services in Classes 37 is appropriate and respectfully requested based on the lack of any services in the cited registration and the additional differences identified herein.

In relation to the goods of Class 9, "the analysis of proximity should focus on the specific attributes of the products in question rather than on broad product categories." *Paco Sport Ltd. v. Paco Rabanne Parfums*, 86 F.Supp.2d 305, 54 U.S.P.Q.2d 1205 (S.D.N.Y. 2000). The Applicant respectfully asserts that the Examining Attorney's refusal is premised on a comparison of the "broad product category" of

electronics/computers, as opposed to the “specific attributes” of the goods in the respective registration and application, which are markedly different. Furthermore, Applicant’s goods and services are primarily available to aircraft developers, sophisticated consumers who are less likely to be confused by any similarities between the mark of the instant application and those of the cited registration.

Based on the foregoing, Applicant submits that there is no likelihood of confusion, and respectfully requests withdrawal of the refusal.

SIGNATURE SECTION	
RESPONSE SIGNATURE	/William J. Sauers/
SIGNATORY'S NAME	William J. Sauers
SIGNATORY'S POSITION	Attorney for Applicant
DATE SIGNED	08/05/2014
AUTHORIZED SIGNATORY	YES
CONCURRENT APPEAL NOTICE FILED	NO
FILING INFORMATION SECTION	
SUBMIT DATE	Tue Aug 05 13:33:03 EDT 2014
TEAS STAMP	USPTO/RFR-69.195.247.116-20140805133303333070-86013199-500e18d66521261fb252446d8d363d50215b91a5a231305899f9df35f3125243b0-N/A-N/A-20140804125716335189

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OMB No. 0651-0050 (Exp. 05/31/2014)

Request for Reconsideration after Final Action

To the Commissioner for Trademarks:

Application serial no. **86013199** has been amended as follows:

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

Responsive to the final Office Action of February 6, 2014, the following remarks are hereby submitted and reconsideration is respectfully requested. Withdrawal of the objections to the goods and services, based on the amendments in the previous response, is acknowledged.

Section 2(d) Refusal

The Examining Attorney withdrew the refusal to register in relation to all of the classes of the application with the exception of Classes 9 and 37, to which the refusal based on U.S. Registration No. 3789306 ("the '306 registration") for the mark HORNETTEK and Design is maintained and made final.

Applicant respectfully requests withdrawal of the refusal of Classes 9 and 37 based on the differences between marks, specifically, the differences in overall appearance, sound, commercial impression, and the differences between the goods of the cited registration and the goods/services of the instant application. For these and the other reasons set forth below, Applicant believes that registration of its mark will not generate a likelihood of consumer confusion with the '306 registration. Accordingly, reconsideration and withdrawal of the refusal to register is respectfully requested.

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the word portion of the ‘306 mark. The significant differences between the word portions of the marks and the importance of the design portion of the mark of the ‘306 registration lead to very different perceptions by consumers. *General Mills*, in which the TTAB found no confusion between two marks for identical products, in which the only difference is a word describing a flavor. Furthermore, the decision in *A&H Sportswear* noted above again found no likelihood of confusion between two marks that are clearly more similar than Applicant’s mark and the cited mark. The comparison between the MIRACLE BRA and MIRACLESUIT marks is analogous to the comparison between HORNETTEK and Design and HORNET, in that both marks contain a word in common. Applicant’s and Registrant’s marks are less similar than MIRACLE BRA and MIRACLESUIT due to the differences between the word portions of the marks.

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SIGNATURE(S)
Request for Reconsideration Signature
Signature: /William J. Sauers/ Date: 08/05/2014
Signatory's Name: William J. Sauers
Signatory's Position: Attorney for Applicant

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: 86013199
Internet Transmission Date: Tue Aug 05 13:33:03 EDT 2014
TEAS Stamp: USPTO/RFR-69.195.247.116-201408051333033
33070-86013199-500e18d66521261fb252446d8
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