

Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	86054033
LAW OFFICE ASSIGNED	LAW OFFICE 116
MARK SECTION (no change)	
EVIDENCE SECTION	
EVIDENCE FILE NAME(S)	
ORIGINAL PDF FILE	evi_20766122-20141224162822789170_ OA_Response.pdf
CONVERTED PDF FILE(S) (2 pages)	\\TICRS\EXPORT16\IMAGEOUT16\860\540\86054033\xml8\RFR0002.JPG
	\\TICRS\EXPORT16\IMAGEOUT16\860\540\86054033\xml8\RFR0003.JPG
GOODS AND/OR SERVICES SECTION (current)	
INTERNATIONAL CLASS	037
DESCRIPTION	Vehicle reconditioning services
FILING BASIS	Section 1(a)
FIRST USE ANYWHERE DATE	At least as early as 06/23/2013
FIRST USE IN COMMERCE DATE	At least as early as 06/23/2013
GOODS AND/OR SERVICES SECTION (proposed)	
INTERNATIONAL CLASS	037
TRACKED TEXT DESCRIPTION	
Vehicle reconditioning services ; Repair, maintenance and reconditioning services for motor vehicles, excluding electric motors	
FINAL DESCRIPTION	
Repair, maintenance and reconditioning services for motor vehicles, excluding electric motors	

FILING BASIS	Section 1(a)
FIRST USE ANYWHERE DATE	At least as early as 06/23/2013
FIRST USE IN COMMERCE DATE	At least as early as 06/23/2013
SIGNATURE SECTION	
RESPONSE SIGNATURE	/Deborah A. Peacock/
SIGNATORY'S NAME	Deborah Peacock
SIGNATORY'S POSITION	Attorney of record, New Mexico bar member
SIGNATORY'S PHONE NUMBER	505-998-1500
DATE SIGNED	12/24/2014
AUTHORIZED SIGNATORY	YES
CONCURRENT APPEAL NOTICE FILED	NO
FILING INFORMATION SECTION	
SUBMIT DATE	Wed Dec 24 16:46:16 EST 2014
TEAS STAMP	USPTO/RFR-207.66.12.2-201 41224164616961665-8605403 3-500bdeaa6a357acc4d8754f e183f2bac7cb95a5192fb2aef 8bf73ce515e5df38-N/A-N/A- 20141224162822789170

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

Application serial no. **86054033** has been amended as follows:

EVIDENCE

Original PDF file:

[evi_20766122-20141224162822789170_._OA_Response.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 037 for Vehicle reconditioning services

Original Filing Basis:

Filing Basis: Section 1(a), Use in Commerce: The applicant is using the mark in commerce, or the applicant's related company or licensee is using the mark in commerce, on or in connection with the identified goods and/or services. 15 U.S.C. Section 1051(a), as amended. The mark was first used at least as early as 06/23/2013 and first used in commerce at least as early as 06/23/2013 , and is now in use in such commerce.

Proposed:

Tracked Text Description: ~~Vehicle reconditioning services~~; [Repair, maintenance and reconditioning services for motor vehicles, excluding electric motors](#)

Class 037 for Repair, maintenance and reconditioning services for motor vehicles, excluding electric motors

Filing Basis: Section 1(a), Use in Commerce: The applicant is using the mark in commerce, or the applicant's related company or licensee is using the mark in commerce, on or in connection with the identified goods and/or services. 15 U.S.C. Section 1051(a), as amended. The mark was first used at least as early as 06/23/2013 and first used in commerce at least as early as 06/23/2013 , and is now in use in such commerce.

SIGNATURE(S)

Request for Reconsideration Signature

Signature: /Deborah A. Peacock/ Date: 12/24/2014

Signatory's Name: Deborah Peacock

Signatory's Position: Attorney of record, New Mexico bar member

Signatory's Phone Number: 505-998-1500

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: 86054033

Internet Transmission Date: Wed Dec 24 16:46:16 EST 2014

TEAS Stamp: USPTO/RFR-207.66.12.2-201412241646169616

65-86054033-500bdeaa6a357acc4d8754fe183f
2bac7cb95a5192fb2aef8bf73ce515e5df38-N/A
-N/A-20141224162822789170

To the Commissioner of Trademarks

In response to the communication from the Trademark Examining Attorney dated July 8, 2014, please amend the application as follows:

Please amend the description of services from: ~~Vehicle reconditioning services~~

To: Repair, maintenance and reconditioning services for motor vehicles, excluding electric motors in International Class 037.

REMARKS

Section 2(d) Refusal – Likelihood of Confusion – Final Action

The Trademark Examining Attorney refused registration on the grounds that there is a likelihood of confusion between Applicant's mark LIFEXTEND and the registered mark EXTENDALIFE Reg. No. 1,357,182. The following factors most relevant to this determination include: Similarity of the marks, similarity and nature of the goods and/or services, and similarity of the trade channels of the goods and/or services.

Comparison of the Services

The Examining Attorney found the services listed by Applicant as being substantially similar to the services offered by Registrant. Registrant's recitation of services is limited to "reconditioning of electric motors." Applicant has amended its description of services to:

Repair, maintenance and reconditioning services for motor vehicles, excluding electric motors

As the Trademark Examining Attorney will note, Applicant's amendment specifically excludes electrical motors making Applicant's services completely different from Registrant's services. Because the marks cover different services, consumers will not be confused as to the source and Applicant's mark is entitled to registration.

Comparison of the Words in the Marks

Confusion at the source is likely between two marks consisting of reverse combinations of the same elements if they convey the same meaning or create substantially similar commercial impressions (TEMP § 12007.01 (b)(vii)). Applicant has now amended its application to exclude repair, maintenance and reconditioning services for electric motors. Applicant's mark now covers services distinct from the services offered by Registrant's. Examining Attorney's reliance on the Board's holding in In re Wine Soc'y of Am. Inc., 12 U.S.P.Q.2d 1139 (P.T.O. Apr. 6, 1989) is no longer applicable because the Board's decision in that case rested on: "where the sole significant difference between marks applied to similar goods or services is the transposition of the words which compose those marks and where the transposition of words does not change the overall commercial impression, confusion has been

found.” With the amendment of the description of services the marks can longer be said to represent similar services as so the analysis must change to include the fact the marks represent different services.

This application should be entitled to registration under the holding of In re Akzona Inc., 219 U.S.P.Q. (BNA) ¶¶ 94 (P.T.O. May 20, 1983). The marks in dispute in that case were SILKY TOUCH and TOUCH O’ SILK and the Board also noted that while the respective goods in question both evoked connotations of silk, a likelihood of confusion was not found. While the Board noted that the goods were commercially related the Board still found the goods (synthetic yarns versus men’s clothing) sufficiently distinct and weighed this as a decisive factor in its decision of a finding of a lack of confusion. The distinction between Applicant’s services and Registrant’s services is much more pronounced than that between the goods in In re Akzona Inc. as the Applicant does not claim electric motors as a description of its services. The present case is also similar, in that In re Akzona Inc. the marks are reverse combinations principally distinguished by one or two letters. The Board in In re Akzona Inc. found the incorporation of the letter “O’ as sufficient to distinguish the two marks in both sound and appearance. In the present case, Applicant’s mark is not only distinguished from Registrant’s mark by lacking the word “A” but Applicant’s mark LIFEXTEND also lacks an extra “E” that is found in Registrant’s mark. The distinction in the present Application is more pronounced than the distinction in In re Akzona Inc. and yet the mark at issue in that case was permitted registration.

With the amendment to the description of goods that distinguishes the services covered by Applicant’s mark with the services offered by Registrant’s mark as well as the precedent provided by the Board in In re Akzona Inc., Applicant’s mark is entitled to registration.

CONCLUSION

For the forgoing reasons, it is submitted that the present application is in condition for publication and registration, and such action is requested.