

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: **Associated Engineered Systems, Inc.**
Serial Number: **77/252194**
Mark: **AES**

Trademark Attorney: **Priscilla Milton**
Trademark Law Office: **110**

Response to Office Action Dated November 20, 2007

REMARKS

I. Likelihood of Confusion with Marks in U.S. Registration Numbers 2,754,236, 2,770,112, 1,086,674, and 1,220,404.

In her office action, Trademark Examining Attorney has refused registration under Trademark Act §2(d) because Applicant's mark, when used on or in connection with its services, so resembles the marks in U.S. Registration Nos. 2,754,236, 2,770,112, 1,086,674, and 1,220,404 as to be likely to cause confusion, to cause mistake, or to deceive. Specifically, she believes that Applicant's mark, AES, for "business consultation services in the field of telecommunications systems, security systems, closed-circuit television systems, intercom and paging systems, and fire detection systems; repair, maintenance, and installation of telecommunications systems, security systems, closed-circuit television systems, intercom and paging systems, and fire detection systems" (as amended), is likely to cause confusion with the marks AES and AES & design, both of which are registered for "electronic equipment store services," as well as AES AUGUSTA ELECTRICAL SYSTEMS and AES AUGUSTA ELECTRICAL SYSTEMS & design, both of which are registered for "security system installation and maintenance services; and fire, burglar and/or flood warning alarm system installation and maintenance services." For the reasons set forth below, Applicant respectfully asserts that there is no likelihood of confusion between Applicant's mark and the marks in the cited registrations.

ARGUMENT

In every case turning on likelihood of confusion, it is the duty of the Board to find, upon consideration of all the evidence, whether or not confusion appears likely. *In re E.I. du Pont de*

Nemours & Co., 177 U.S.P.Q. 563, 568 (C.C.P.A. 1973). The Lanham Act refers to likelihood of confusion, not the mere possibility thereof. *Bongrain International (American) Corporation v. Delice de France Inc.*, 1 U.S.P.Q.2d 1775, 1779 (Fed. Cir. 1987). Mere possibility of confusion will not, under the law, prevent registration. *Norton Company v. Bear Manufacturing Company*, 169 U.S.P.Q. 44, 45 (C.C.P.A. 1971).

As a preliminary matter, Applicant notes that two of the cited registrations are owned by one entity and the other two cited registrations are owned by an entirely separate and unrelated entity. All four registrations consist of the dominant acronym AES and both Registrants provide services that are somewhat related. Yet, all four registrations have been allowed to coexist on the Principal Register apparently without a likelihood of confusion. Applicant strongly believes that since the marks in the four cited registrations coexist with each other despite two of them being significantly similar in appearance, sound, and commercial impression to the other two, then there is absolutely no reason why Applicant's mark cannot coexist with them.

In addition, a cursory search of the Trademark Office's records revealed at least two other registrations that (1) incorporate the acronym AES, (2) are used in association with goods that are highly related to the services of both Registrants, and (3) coexist with Registrants' registrations despite the fact that they are owned by an entirely separate and unrelated entity. These registrations are:¹

AES CORPORATION & design (Reg. No. 3,203,422) for "security systems, namely access control and alarm monitoring systems"

AES INTELLINET (Reg. No. 1,907,185) for "wireless data transmission systems, namely remote transceivers and central station transmitters and receivers"

Applicant strongly believes that since Registrants' marks coexist with the above-mentioned marks, there is absolutely no reason why Applicant's mark cannot join them on the Principal Register. As such, Applicant's mark is entitled to registration.

A. Applicant's Consulting and Installation Services are Substantially Different from the Electronic Equipment Store Services of Amateur Electronic Supply, LLC.

In testing for likelihood of confusion under §2(d), the similarity or dissimilarity and nature of services as described in an application or registration or in connection with which a prior mark is in use must be considered. *In re E. I. Du Pont De Nemours & Co.*, 177 U.S.P.Q. 563, 567 (C.C.P.A. 1973). In this case, Applicant uses its mark in conjunction with "business consultation services in the field of telecommunications systems, security systems, closed-circuit

¹Applicant has attached printouts of these registrations from the TESS database accessed via the USPTO website.

television systems, intercom and paging systems, and fire detection systems; repair, maintenance, and installation of telecommunications systems, security systems, closed-circuit television systems, intercom and paging systems, and fire detection systems” (as amended).

In regard to the AES and AES & design marks owned by Registrant Amateur Electronic Supply, LLC, registered for “electronic equipment store services,” Trademark Examining Attorney states that “registrant’s services are described broadly and could include security systems and equipment.” Although that is certainly possible, it is clear from Registrant’s own website that Registrant is not engaged in providing any consulting or installation services in the field of security systems and related equipment.² Rather, Registrant appears to be exclusively engaged in the ordinary retail sale of radios, ham radios, and radio accessories. On the other hand, Applicant’s business involves consulting with companies regarding their security and telecommunication system needs, choosing the proper systems to meet those needs, and installing, maintaining, and repairing the systems. To be sure, Applicant is not a retailer or distributor of telecommunications and security systems in the traditional sense, but instead provides these systems as part of its larger business of consulting with companies and designing and installing an appropriate and cost-effective integrated solution. In sum, because the consultation and installation/maintenance services provided by Applicant are wholly unrelated to the retail electronic equipment store services of Registrant Amateur Electronic Supply, LLC, Trademark Examining attorney should withdraw her refusal and allow Applicant’s mark to proceed to publication.

In regard to the AES AUGUSTA ELECTRICAL SYSTEMS and AES AUGUSTA ELECTRICAL SYSTEMS & design marks owned by Registrant Augusta Electrical Systems, Inc., Applicant concedes that its services appear to overlap with those listed in the two cited registrations. However, as will be discussed immediately below, the differences in appearance, sound, and commercial impression between Applicant’s mark and Registrant’s marks are enough to avoid any likelihood of consumer confusion.

B. Applicant’s Mark is Sufficiently Distinct from the Marks Owned by Registrant Augusta Electrical Systems, Inc. in Appearance, Sound, and Commercial Impression.

When it is the entirety of the marks that is perceived by the public, it is the entirety of the marks that must be compared. *Opryland USA Inc. v. The Great American Music Show Inc.*, 23 U.S.P.Q.2d 1471, 1473 (Fed. Cir. 1992). All relevant facts pertaining to appearance, sound, and connotation must be considered before similarity as to one or more of those factors may be sufficient to support a finding that the marks are similar or dissimilar. *Recot Inc. v. M.C. Becton*, 54 U.S.P.Q.2d 1894, 1899 (Fed. Cir. 2000). Because marks tend to be perceived in their entireties, all components thereof must be given appropriate weight. *In re Hearst Corp.* 25

²Applicant has attached a printout of the home page of Registrant’s website accessed on April 14, 2008.

U.S.P.Q.2d 1238, 1239 (Fed. Cir. 1992) (VARGAS and VARGA GIRL not likely to be confused as applied to calendars). Of paramount interest is not the descriptive nature of the mark, but the overall commercial impression derived by viewing the marks in their entirety in determining whether a likelihood of confusion exists. *Spice Islands, Inc. v. The Frank Tea and Spice Company*, 184 U.S.P.Q. 35, 37 (C.C.P.A. 1974).

In regard to the AES AUGUSTA ELECTRICAL SYSTEMS and AES AUGUSTA ELECTRICAL SYSTEMS & design marks owned by Registrant Augusta Electrical Systems, Inc., it is Applicant's belief that when the marks are compared *in their entirety*, Applicant's mark is dissimilar enough to distinguish between its security systems installation and maintenance services and those of Registrant. First, Applicant's mark is distinct in appearance and sound because (1) Registrant's marks uses the phrase AUGUSTA ELECTRICAL SYSTEMS, while Applicant's mark does not, and (2) Applicant's mark consists of one acronym while Registrant's marks consist of the same acronym plus the three words for which the acronym stands, and (3) Applicant's acronym stands for "Associated Engineered Systems" (see specimens) while Registrant's acronym stands for "Augusta Electrical Systems."

As far as commercial impression is concerned, there is no question that Applicant's mark is substantially distinct from Registrant's marks. Registrant's marks incorporate descriptive wording which immediately tells consumers the nature of Registrant's services (i.e. something to do with "electrical systems"). In contrast, Applicant's mark, by itself, does not describe or suggest anything about Applicant's services and consumers would need more information in order to determine what goods/services Applicant provides. Furthermore, Applicant notes that the term "Augusta" in Registrant's marks is not disclaimed, which is further evidence that Registrant may be known as "AES Augusta" rather than just "AES" as Applicant is known. Because Applicant's mark is significantly different in appearance, sound, and commercial impression, Trademark Examining Attorney should withdraw her §2(d) refusal.

In regard to the AES and AES & design marks owned by Registrant Amateur Electronic Supply, LLC, Applicant concedes that its mark is essentially identical in appearance, sound, and commercial impression to the both of them. However, as discussed earlier, Applicant's consulting and installation/maintenance services in the field of telecommunications and security systems are so distinct from Registrant's retail electronic equipment store services that any likelihood of confusion is practically non-existent. Moreover, as depicted on Registrant's website, Registrant's acronym stands for "Amateur Electronic Supply." This additional wording is used by Registrant on its website in very close association with the acronym. Therefore, Trademark Examining attorney should withdraw her §2(d) refusal as to these two marks as well.



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Word Mark	AES CORPORATION
Goods and Services	IC 009. US 021 023 026 036 038. G & S: WIRELESS DATA TRANSMISSION SYSTEMS, NAMELY REMOTE TRANSCEIVERS AND CENTRAL STATION TRANSMITTERS AND RECEIVERS; SECURITY SYSTEMS NAMELY, ACCESS CONTROL AND ALARM MONITORING SYSTEMS. FIRST USE: 20040421. FIRST USE IN COMMERCE: 20040421
Mark Drawing Code	(3) DESIGN PLUS WORDS, LETTERS, AND/OR NUMBERS
Design Search Code	26.01.02 - Circles, plain single line; Plain single line circles 26.01.15 - Circles, exactly three circles; Three circles 26.13.12 - Quadrilaterals with bars, bands and lines 26.13.21 - Quadrilaterals that are completely or partially shaded
Serial Number	78517794
Filing Date	November 16, 2004

Current Filing Basis 1A
Original Filing Basis 1A
Published for Opposition November 14, 2006
Registration Number 3203422
Registration Date January 30, 2007
Owner (REGISTRANT) AES CORPORATION CORPORATION MASSACHUSETTS 285
Newbury Street Peabody MASSACHUSETTS 019601315
Attorney of Record HERBERT DUBNO
Prior Registrations 1907185
Disclaimer NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE CORPORATION APART
FROM THE MARK AS SHOWN
Description of Mark The mark consists of the letters AES above the smaller word CORPORATION and grid/
network design to the left of the writing.
Type of Mark TRADEMARK
Register PRINCIPAL
Live/Dead Indicator LIVE

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Word Mark	AES INTELLINET
Goods and Services	IC 009. US 021 026. G & S: wireless data transmission systems, namely remote transceivers and central station transmitters and receivers. FIRST USE: 19940513. FIRST USE IN COMMERCE: 19940513
Mark Drawing Code	(3) DESIGN PLUS WORDS, LETTERS, AND/OR NUMBERS
Design Search Code	01.15.02 - Electricity; Lightning; Sparks (jagged lines) 26.17.13 - Letters or words underlined and/or overlined by one or more strokes or lines; Overlined words or letters; Underlined words or letters
Serial Number	74539064
Filing Date	June 17, 1994
Current Filing Basis	1A
Original Filing Basis	1A

Published for Opposition May 2, 1995

Registration Number 1907185

Registration Date July 25, 1995

Owner (REGISTRANT) AES Corporation CORPORATION MASSACHUSETTS 285 Newbury Street Peabody MASSACHUSETTS 01960

Attorney of Record HERBERT DUBNO

Description of Mark The lining is a feature of the mark and does not indicate color.

Type of Mark TRADEMARK

Register PRINCIPAL

Affidavit Text SECT 15. SECT 8 (6-YR). SECTION 8(10-YR) 20050615.

Renewal 1ST RENEWAL 20050615

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