

## RESPONSE TO OFFICE ACTION

This is in response to an Office Action e-mailed on March 26, 2008. Applicant has carefully reviewed the Examining Attorney's comments and respectfully submits this response.

### DISSIMILARITY OF MARKS

The Examining Attorney pointed out that the Applicant has applied to register the term "HILLSBORO," while the cited marks (U. S. Reg. Nos. 2,074,630, 2,427,233, 2,336,591, and 2,755,395) all include the term "HILLSBORO," along with additional material. The Examiner then asserted that the dominant term of both Applicant's mark and Registrant's marks is the word "HILLSBORO," which the Examining Attorney contends makes the marks highly similar in meaning and commercial impression. The Examining Attorney concluded that the Applicant's mark, when used in connection with the identified services, so resembled the Registrant's marks as to be likely to cause confusion, to cause mistake, or to deceive.

Applicant contends that while Applicant's and Registrant's marks sound alike, they are dissimilar in meaning and commercial impression, so as to preclude any likelihood of confusion. Although marks may be phonetically similar, confusion is prevented by different suggestive connotations. See Gulf States Paper Corp. v. Crown Zellerbach Corp., 417 F.2d 795, 163 U.S.P.Q. 589 (C.C. P.A. 1969) (although E-Z and CZ may sound alike, each suggests a different connotation).

According to Wikipedia, the suffix "boro" is common to cities in the American South, while the suffix "borough" is considered a rarer variation of the term. This is consistent with the spellings of Greensboro (NC) and Jonesboro (AK). Greensboro and Jonesboro are expected spellings of these two southern towns. In comparison, the odd spellings of Greensborough and Jonesborough look clearly out of place. A review of American cities found that there are eight Greensboros and eight Jonesboros, and these "boros" are located primarily in the South. In contrast, there are no American cities named Greensborough and only one city with the Jonesborough (TN) name. Similarly, there are 19 American cities named Hillsboro, but only three cities that use the Hillsborough variation.

Registrant's use of the name Hillsborough for its business is obviously based on the fact that its headquarters are located in Tampa, Florida, which sits in Hillsborough County, through which flows the Hillsborough River, that empties into Hillsborough Bay. Registrant clearly wanted to make a connection with the

historically geographical designations of that area. In contrast, Applicant's name Hillsboro is an old name that was used for a 20-year span in the mid-1800's for the present site of Helena, Alabama (See Exhibit 1). Applicant resurrected the name for its present real estate development.

The point here is that there is clearly a difference in both meaning and commercial impression between a location ending in "boro" and a location ending in the rarer variation "borough." These days, "boro" has a meaning and commercial impression suggestive of a contemporary locale, while "borough" has a meaning and commercial impression suggestive of a more traditional and older locale. "Boro" is a distinctive and more familiar spelling of the archaic-looking "borough," making it less likely that the two terms might be confused.

Additionally, applicant has submitted a corresponding application for the HILLSBORO design mark. The design depicts two children running up a hill towards a tree, thus providing a word/picture association between the hill in the design and the "hill" in the name HILLSBORO. Word marks that are accompanied by logos or designs are sufficiently distinguishable from similar word marks appearing alone. See Rite Aid Corp. v. Rite-Way Discount Corp., 508 F.2d 828, 184 U.S.P.Q. 351 (C.C. P.A. 1975) ("Rite-Way" octagon design sufficiently different from "Rite Aid" shield design to preclude likelihood of confusion). Applicant expects its distinctive hill-tree design to always accompany the HILLSBORO word mark. Applicant's word mark and the design mark will either appear together as a single combined mark, or else they will appear separately but in close proximity to each other, such as on different pages but in the same sales brochure, thus further minimizing the likelihood of confusion.

### COMPARISON OF SERVICES

Examiner points out that both Applicant and the Registrant have identified real estate development and sales as services covered under their respective marks. However, the fact that Applicant's services involve what is normally a person's most expensive investment – a home – means that the ordinary buyer standard is elevated to the higher standard of "discriminating purchaser." Weiss Assoc., Inc. v. HRL Assoc., Inc., 902 F.2d 1546, 14 U.S.P.Q. 2d 1840 (Fed. Cir. 1990) ("In making purchasing decisions regarding 'expensive' goods, the reasonable prudent person standard is elevated to the standard of the 'discriminating purchaser.'") Other things being equal, confusion is less likely where goods are expensive and purchased after careful consideration than when they are purchased casually. Magnaflux Corp. v. Sonoflux Corp., 231 F.2d 669, 109 U.S.P.Q. 313 (C.C. P.A. 1956). Thus, the reasonably prudent buyer is assumed to take more care in purchasing "expensive" items which she buys infrequently, than in buying everyday, relatively inexpensive items. See Sears Roebuck & Co. v. Allstate Driving School, Inc., 301 F. Supp. 4, 163 U.S.P.Q. 335 (E.D. N.Y. 1969). This is especially true where the item being purchased is a home.

As the Court pointed out in Charles F. Ryan & Son, Inc. v. Lancaster Homes, Inc., "when persons are considering a purchase as substantial as a . . . home, it is almost incomprehensible that they would not thoroughly investigate the identity of the proposed builder at the very outset." Charles F. Ryan & Son, Inc. v. Lancaster Homes, Inc., 22 A.D. 2d 186, 254 N.Y.S. 2d 473, 144 U.S.P.Q. 234 (4<sup>th</sup> Dep't 1964), aff'd, 15 N.Y. 2d 812, 257 N.Y.S. 2d 934, 205 N.E. 2d 859, 144 U.S.P.Q. 546 (1965).

In the present case, according to Applicant's website, hillsboroal.com, Applicant is looking to create an upscale community where the cost of the houses will range from \$199,900 to \$329,900. Thus, it is expected that buyers will be "discriminating purchasers," not likely to be confused, misled, or deceived by the name of Applicant's real estate development.

Also, Examiner is no doubt aware that Applicant's mark is used to identify a residential real estate development in north central Alabama, 15 miles south of Birmingham near the town of Helena. In contrast, Registrant's mark is used to identify its commercial and retail real estate development business located along the Gulf Coast in Tampa, Florida. The fact that Applicant and Registrant operate in separate territorial markets – and that applicant has no plans to enter the Florida market with real estate development activities under the Hillsboro name – would tend to preclude a finding of likelihood of confusion. What-A-Burger of Virginia, Inc. v. Whataburger, Inc., 357 F.3d 441, 69 U.S.P.Q. 2d 1829 (4<sup>th</sup> Cir. 2004). Further, even where there is a precise identity between two parties' marks, there may be no confusion if the parties operate in different geographic area. Brookfield Communications, Inc. v. West Coast Entertainment Corp., 174 F.3d 1036, 50 U.S.P.Q. 2d 1545 (9<sup>th</sup> Cir. 1999).

In the present matter, the geographic separation between Applicant's and Registrant's business should preclude any likelihood of confusion. Because of the geographic distance separating Applicant's and Registrant's respective real estate businesses, customers seeking real estate services or desiring to purchase real estate properties are not likely to confuse Registrant's commercial and retail real estate business activities in Tampa, Florida, with Applicant's residential real estate business activities in Helena, Alabama.

### GEOGRAPHIC DESCRIPTIVENESS

Examiner contends that Applicant's mark is "primarily geographically descriptive" of Applicant's services. Further, Examiner provides specimens that Examiner contends shows that the term "Hillsboro" is the name of a geographic locale. However, Applicant should point out that the Hillsboro referred to by Examiner is an existing town 12 miles west of Decatur, Alabama. In contrast, the Hillsboro that Applicant seeks to register is not an existing town, but rather a resurrected mid-19<sup>th</sup> century name that identifies Applicant's real estate

development near Helena, Alabama, 15 miles south of Birmingham and 90 miles from the Hillsboro that Examiner cites. Therefore, Applicant's use of the name Hillsboro is not descriptive of the geographic location of Applicant's real estate business, but instead is an obsolete term that Applicant resurrected for modern day usage by Applicant's real estate business near Helena, Alabama.

#### PRIOR PENDING APPLICATION ABANDONMENT

The Examining Attorney cited pending Application Serial No. 77-250046 against Applicant's application. However, the cited pending application was abandoned on May 22, 2008, and thus should not be a bar to Applicant's application to register its mark.

**EXHIBIT 1**



Ken Penhale and Martin Everse



# INTRODUCTION

On a spring day in 1814, General Andrew Jackson and his army of Tennessee volunteers decisively defeated the Creek Indians at Horseshoe Bend, ending a war and opening a vast new territory for white settlement. Within a year, land-hungry pioneers began making their way into what would become Shelby County and present-day Helena. Attracted by what a government surveyor called "a valley of very inviting land, with the finest springs and fairest prospect of health," whole communities from the older states packed up and moved into the area. The rush became so great, it was known as "Alabama Fever."

The Griffin and Lee families were two of the first to hack their way into what would become Helena. As the land filled with settlers, roads were cut and where the Ashville-Elyton-Selma and Tuscaloosa Roads crossed, a small community grew. A post office named Cove was established there in 1849. Seven years later, the name was changed to Hillsboro. Today, the intersection of County Roads 52, 17, and 261 roughly corresponds to the location of this original village.

The Civil War transformed Hillsboro, and a romance in the middle of that war changed the name of the town once again. To equip armies, the South was forced to industrialize nearly overnight. The Scotch miner, Billy Gould, and two partners, Charles and Fred Woodson, acquired 1,700 acres of land and dug two mines, a vertical shaft 130 feet deep near the Cahaba and a roughly horizontal slope 400 feet. On good days, these men could produce 75 tons of coal, all of which was transported to a weapons manufacturing plant at Selma. The 12 coke ovens that now serenely guard the confluence of Buck Creek and the Cahaba River may have been constructed at this time. Monk, Edwards, and company also opened mines nearby, as did the Red Mountain Iron and Coal Company. Smaller operations, called "bomb proofs," which were shallow drifts in seams close to the surface, were scattered through the hills and hollows near town. Indeed, by 1864, there were so many people mining coal or wanting to mine coal that the chief engineer for the Red Mountain Company complained that "coal fever" prevailed in the area, and coal land sold for the exorbitant price of \$100 per acre.

About 1864, a rolling mill capable of producing bar iron was built by Hannon, Offutt, and Company of Montgomery on Buck Creek, under the direction of Thomas S. Alvis, an experienced ironmaster from Virginia. Called the Central Iron Works, this mill was situated on the South and North Railroad, a track that had been pushed just north of Hillsboro from Limekilns (Calera) during the war, on its way to the Red Mountain Company's blast furnace at what is today called Oxmoor. The line had been graded and bridged all the way to Brock's Gap

by the spring of 1865 by Peter Boyle, the construction engineer for the railroad, but in all probability the working railhead was near the rolling mill on Buck Creek. Here Peter Boyle met the beautiful and enchanting daughter of Needham Lee Jr., and fell in love. When it came time to call this terminal something, Boyle named it Helena Station, forever memorializing his war-time romance with Helen Lee.

James Harrison Wilson, a 27-year-old Union general who loved to discuss poetry, and 10,000 Federal troopers would, in a few hours, put an end to four years of industrialization. On March 30, 1865, they poured across the South and North Alabama Railroad bridge and torched everything of significance in their path. It would be years before the destruction wrought by the brief raid through Helena would be overcome, and physical scars would heal much sooner than emotional ones.

A few years after the war, development began anew. The railroad was rebuilt in the early 1870s, and in 1873, the rolling mill was reopened by Rufus Cobb, a future governor, B.B. Lewis, a future University of Alabama president, and Richard Fell, an experienced ironmaster. Railroad spurs branched out from Helena in all directions to serve new coal mines. The Eureka Company constructed a large battery of coke ovens in the 1870s to turn coal from Helena mines into coke for the reconstructed blast furnaces at Oxmoor. With all activity centering on the railroad, rolling mill, and Buck Creek, and stores springing up there to profit from this busy area, Hillsboro slowly ceased to exist and the new town of Helena was incorporated in 1877.

In 1880, Helena was described by a news correspondent as a "mining and manufacturing town." It was a rough place that contained six mercantile stores, one drugstore, two hotels, and a number of boardinghouses. The federal census also enumerated a number of women listed as prostitutes. By the following decade, the town was truly prospering. The rolling mill had been expanded and modernized and the number of merchants had increased. There were barber shops, shoe shops, doctors, a dentist, dry goods and drugstores, a blacksmith, meat market, and furniture store. The Louisville and Nashville Railroad had also built a large yard at Helena to facilitate the shipping of coal and coke.

At the beginning of the 20th century, prospects for the town were mixed. The rolling mill fell on hard times and was eventually dismantled in 1923. The coal mines in the area suffered from shrinking markets and labor unrest with the exception of a few years during WW I. The mine at Mossboro, just outside Helena, was closed after a horrible explosion killed a number of miners. During this same time, electricity and telephone service began and a swimming pool, skating rink, and movie theatre were built. The town was reincorporated in 1917 and elected Charles Hinds its mayor.

Yet the economic uncertainties were nothing compared to what happened on Friday morning, May 5, 1933. Out of the morning darkness a little after 3 a.m., a tornado ripped through the heart of Helena. First reports listed 12 dead and 75 injured. The Baptist, Presbyterian, and Methodist churches were all destroyed, and many of the town's old and fine homes demolished. The town slowly struggled back, again.

For the following 40 years, not much changed. Most of the coal mines were closed, though Acton, just north of Helena, operated until after World War II. County roads were paved in the 1950s, but for the most part, Helena was off the beaten path, a sleepy little town that had seen better days. Then, beginning in the early 1970s, things began to change. The metropolitan sprawl from Birmingham spread south into Shelby County and Helena became a very desirable place to live and raise a family. Today, Helena is one of the fastest growing municipalities in the state and has far outgrown even the wildest dreams of its most ardent promoters in the heady days of the 1880s and 1890s.