

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Dr. Ing. h.c.F. Porsche; Aktiengesellschaft	:	
	:	
Serial No.: 79/061,021	:	April K. Roach
	:	Examining Attorney
Mark: ROADSTER	:	Law Office 115
	:	
Filed: June 10, 2008	:	

RESPONSE TO OFFICE ACTION

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

This is in response to the Office Action mailed on December 8, 2008.

The Examining Attorney has issued a refusal of the present application under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d), stating that a likelihood of confusion exists between Applicant's mark and two prior Federal registrations consisting of (i) a U.S. Federal trademark registration for RAGTOPS & ROADSTERS (U.S. Reg. No. 2,554,366) for "bi-monthly magazine featuring convertible automobiles" in the name of MediaSource California, LLC (with said Section 2(d) refusal concerning Applicant's goods in connection with Classes 9 and 16 only); and (ii) a

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U.S. Federal trademark registration for ROADSTER (U.S. Reg. No. 3,485,043) for “amplifiers for musical instruments” in the name of Mesa/Boogie, Ltd. (with said Section 2(d) refusal concerning Applicant’s goods in Class 9 only).

That being said, Applicant wishes to point out to the Examining Attorney that U.S. Registration No. 2,554,366 has been cancelled by the U.S. Trademark Office. Accordingly, the Section 2(d) refusal concerning this registration no longer has any basis and should be withdrawn by the Examining Attorney.

Likelihood of Confusion Refusal Concerning U.S. Reg. No. 3, 485,043

As the Examining Attorney is aware, the issue of likelihood of confusion is based on an analysis of all the probative facts in evidence that are relevant to the factors set forth in *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). Generally speaking, this involves a first step consisting of comparing the marks in question in terms of sound, meaning, appearance and commercial impression, and a second step consisting of comparing the goods with which the marks are used and the stream(s) of commerce in which they move in order to evaluate whether the goods are likely to compete with each other for the same consumer. See *In re International Telephone and Telegraph Corp.*, 197 USPQ 910 (TTAB 1978).

In light of cited U.S. Registration No. 3,485,043 for ROADSTER, Applicant notes the Examining Attorney’s arguments are based on her conclusion that use of Applicant’s mark, ROADSTER, on or in connection with Applicant’s goods in Class 9 is likely to lead to confusion in the marketplace as to the source of the relevant goods on the part of potential purchasers.

Applicant wishes to point out that since Applicant’s goods are in no way related to or sold in the same trade channels as “amplifiers for musical instruments”, a finding of “likelihood of confusion” by the Examining Attorney is warrantless.

Accordingly, Applicant hereby amends its identification of goods for Class 9 to clarify to the Examining Attorney that in fact, there is no likelihood that purchasers will confuse Applicant’s goods with the “amplifiers” of Mesa/Boogie in the marketplace. Please see amended identification of goods as shown below.

“glasses, namely, eyewear; sunglasses; optical apparatus and instruments, namely, cases for eyeglasses; protective helmets; scientific, nautical, and surveying apparatus and instruments, namely, navigation computer systems for automobiles; photographic and cinematographic apparatus and instruments and apparatus for recording, transmission or reproduction of images, namely, cameras, radios, televisions, audio cassette recorders, video cassette recorders, blank magnetic data carriers, blank data recording discs, unexposed film, magnetic data carriers containing interactive multimedia computer game programs for use on personal computers and televisions, and magnetic data carriers comprised of computer hardware and software equipped with interactive video games of virtual reality; weighing equipment, namely, scales and balances; instruments for measuring length; signal processors; life jackets; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity, namely, electricity conduits, electric switches, electric transformers, electric accumulators for vehicles, voltage regulators, and electrical controllers;; automatic vending machines and mechanisms for coin-operated apparatus; cash registers, calculating machines, data processing equipment and computers; fire-extinguishing apparatus”, in International Class 9.

In light of the above, Applicant hereby requests that the Examining Attorney withdraw her Section 2(d) refusal and pass the application on to registration.

Informalities

Please note that all remaining informalities associated with the application are addressed in Applicant’s electronic response.

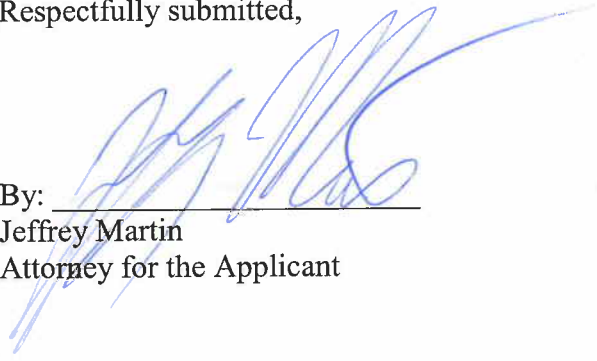
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Conclusion

Based on Applicant's amendment to its identification of goods for Class 9 and in view of the cancellation of U.S. Reg. No. 2,554,366, Applicant hereby requests that the Section 2(d) refusal be withdrawn and requests respectfully that Applicant's application be moved on to publication.

Dated: New York, New York
June 5, 2009

Respectfully submitted,

By: 
Jeffrey Martin
Attorney for the Applicant