

REMARKS

Initially by this amendment, Applicant has limited its services to "AIR TRANSPORT AND AIRLINE TRAVEL TICKET RESERVATIONS." Therefore, Applicant has deleted the services which were most similar to the cited registration, namely, "transportation information."

The refusal to register Applicant's proposed mark VIM (stylized) on the Principal Register for "air transport and airline travel ticket reservations" on the grounds that it is confusingly similar to U.S. Registration No. 3,687,481, for VIMS for, *inter alia*, providing information to drivers of vehicles on roads, is respectfully traversed. It is respectfully submitted that there is no likelihood of confusion between Applicant's mark and the cited registration in view of the differences in the marks themselves, the differences in the services, as now amended, and the differences in the channels of trade.

The basic and fundamental principle in determining likelihood of confusion between marks is that the marks must be compared in their entireties in connection with the particular goods or services for which they are used. *Shen Mfg. Co. v. Ritz Hotel, Ltd.*, 393 F.3d 1238 (Fed. Cir. 2004) (*citing In re National Data Corp.*, 224 USPQ 749 (Fed. Cir. 1985)). "The commercial impression of a trademark is derived from it as a whole, not from its elements separated and considered in detail. For this reason it should be considered in its entirety." *Estate of P.D. Beckwith, Inc. v. Commission of Patents*, 252 U.S. 538, 545-46 (1920).

Here, the goods sought by Applicant, as now amended, and the goods provided by the Registrant are not the same. Applicant's goods are now limited to "air transport and airline travel ticket reservations" as seen in the attached printout in Exhibit A and has deleted "transportation information." In contrast, the goods in the cited registration to VIMS are for information related to drivers of vehicles on the road as seen in the attached printout in Exhibit B. Particularly, it appears that VIMS is an acronym for "Vehicle Incident Management Services" and is only directed towards vehicle related information services. The VIMS product line is comprised of ten products such as: Roadside Assistance, Accident Scene Management, Vehicle Release Management, Telematics, Total Loss Replacement, Information Services, Motor Clubs, Tow Events, Catastrophe Support and Vehicle Transport Management. Clearly, these services are different from Applicant's, as informational services are not the same as air transport or airline travel ticketing services.

In fact, in *Ex Parte Reed Business Information Limited*, Application Serial No. 75/558,110, the Board found that air transportation services are dissimilar from air transportation industry information services, as applied to the same mark ATI. Here, the services are even more dissimilar than in that application and cited mark, as the Registrant provides information relating to drivers of vehicles on roads, and not airline information. Therefore, the services in the cited registration are not the same as those of the present application, as amended.

Moreover, the channels of trade are not the same. Applicant provides air transport services and airline travel ticket reservations which are directed towards retail consumers specifically seeking air flights and reservations. In contrast, it appears that the mark of the cited Registration is for wholesale services provided to a specific group of clientele. Particularly, the services of the cited registration are directed towards improving claim processing for motor vehicle service providers-namely insurers. Therefore, the services provided by the Applicant and the Registrant are in different channels of trade and to different consumers such that there is no likelihood of confusion.

Moreover, as previously indicated in the Office Action Response dated January 22, 2010 the USPTO has allowed registrations for more than one mark in Class 39 which include the mark component VIM which indicates that the USPTO has taken the position that no one entity should have exclusive rights to the term VIM, *per se*. If the USPTO found that there was no likelihood of confusion between these previously registered marks which include VIM, there too, should be no likelihood of confusion with Applicant's mark.

In addition, as also mentioned previously Applicant's mark uses VIM in a highly stylized format in the color pink. The cited Registration No. 3,687,481 uses VIMS with the addition of the letter "S" and in standard characters. Thus, the marks are clearly distinguishable and the only similarity to the cited mark is VIM which the Registrant does not have the sole right to possess.

Thus in the present case, in addition to the clear differences in the services and channels of trade, the above distinctions in the marks, Applicant's distinctive stylization and color of its mark in combination with the fact that more than one registration has been allowed to co-exist in Class 39 containing the component VIM, clearly substantiates Applicant's position of the registration of its mark. Indeed, it would be unfair and inconsistent to deny the present application based upon the USPTO's past policy to allow registrations for VIM or registration thereof to different entities within the same class, based upon differences in the marks and services, as is the case here.

In view of the foregoing, it is respectfully submitted that the refusal to register should be withdrawn and the mark approved for publication and such action at an early date is earnestly solicited.

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