

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO.: 85/446,671

Examining Attorney:
Sara N. Benjamin
Law Office 110

APPLICANT: Frigid Fluid Company

TRADEMARK: STANDARD

RESPONSE TO OFFICE ACTION DATED FEBRUARY 7, 2012

In response to the Office Action dated February 7, 2012, Applicant hereby responds as follows:

REMARKS

The Examining Attorney has refused registration of Applicant's mark, **STANDARD**, on the grounds that it so resembles an existing trademark registration that its use is likely to cause confusion, mistake or deception. The cited registration is as follows:

STANDARDFIT GR (Reg. No. 3,496,200) – This is a registration of Rossi S.P.A. (Italy) which was issued on May 22, 2007, in Class 7.

PRELIMINARY STATEMENT

This application has been refused because of one registration which includes but does not constitute the word “Standard.”

In evaluating the potential confusion between the cited registration, it is essential to recognize four independent and compelling points:

1. The marks are different and distinguishable on their face;

2. The marks are different in their commercial impressions;
3. The goods, the classes and the channels of trade for the respective marks are vastly different; and
4. There are numerous "Standard" trademarks in Class 7 which all peacefully coexist.

The Applicant submits that its mark is different in sound, appearance and meaning from the cited registration. Their commercial impressions are wholly different. And, the channels of trade and the goods themselves are different from the cited marks suggesting that not only is confusion not "likely," it is virtually impossible.

I. THE TRADEMARKS ARE DIFFERENT

The Applicant has applied for **STANDARD** for the following services:

Class 8 -- Gravity-powered casket lowering device for use in cemeteries and other places of interment."

Because this is a *gravity*-powered product (which the Applicant will agree is in Class 8) and given the Applicant's agreement to the Examiner's request to modify the identification of goods accordingly, this modification automatically sets this mark apart from the cited registration. When evaluating two (or more) marks as here, it is critical to examine the *differences* – not just a lone similarity. Here, the similarity consists of one common word -- "Standard."

However the cited registration is STANDARDFIT R & Gear design within a rounded square. This mark is registered in Class 7 for the following:

"Gear power transmissions for machines; gear reducers, other than for land vehicles, namely gear cutters; electric motors, other than for land vehicles, namely planetary gear motors, starter motors, airplane motors, gear motors, other than for land vehicles, namely planetary gear motors,

starter motors, airplane motors,; integrated motor-inverters, other than for land vehicles, namely direct current motors."

The *difference* between these marks is not only dramatic -- but the respective marks actually *speak* of the difference. The cited registration displays (in the design) and otherwise references *gear* (electrical) motor "power" of the goods. The implicit power source alone suggests a difference in the two marks. And this difference points to how consumers might also view the marks in a side-by-side comparison. The Applicant's mark contains 8 letters. The cited registration has 11 letters in the initial mark plus another letter ("R") following within a gear design. The cited registration is *powerful*. Electric power. Gear power.

When you have such fundamental -- and discernible -- differences in the underlying marks (and of course the respective goods and the overall commercial impression), it takes a great leap of faith to conclude that confusion is "likely." The Applicant submits that there is no likelihood of confusion and that the citation of this registered mark should be withdrawn.

It is well-settled that distinctive letters added to a mark distinguish the mark and eliminate likely confusion. See *Champagne Louis Roederer S.A. v. Delicato Vineyards*, 47 U.S.P.Q.2d 1459, 1461 (Fed. Cir. 1998) (no likelihood of confusion between CRYSTAL CREEK for wine and CRISTAL for champagne; *Interstate Brands Corp. v. Celestial Seasonings, Inc.*, 576 F.2d 926, 928-29 (C.C.P.A. 1978) (RED ZINGER for herb tea and ZINGERS for cakes not confusingly similar); *In re Jacques Bernier, Inc.*, 1 U.S.P.Q.2d 1924, 1925

(T.T.A.B. 1987) (SPORTS CLUB for men's cologne and INTERNATIONAL SPORTS CLUB for men's clothing not confusingly similar); *Electronic Realty Associates, Inc. v. Kayser-Roth Corp.*, 216 U.S.P.Q. 61, 64 (T.T.A.B. 1982) (GOLDEN ERA for clothing and ERA for clothing not confusingly similar).

Likelihood of confusion? Not likely. The Applicant submits that the marks are suitably different to allow the Applicant's mark to proceed.

II. THE GOODS AND CHANNELS OF TRADE ARE DISTINGUISHABLE

It is critical to look at the *goods* of the Applicant's mark and those of the cited registration -- and the anticipated channels of trade for those goods. The cited registration deals with a variety of motors, transmissions and "gear reducers" in Class 7. The motors and transmissions are designed for non-land vehicles. The term "Airplanes" is mentioned twice. "Land vehicles" (albeit limiting in the goods description) is mentioned four times.

The Applicant's mark? You probably cannot get any more limited in terms of product identification, channels of trade, markets and consumer recognition. The Applicant's mark is used in one place: the funeral and cemetery industry. And this mark has been used in this highly-specialized industry *for over sixty years!* No electrical power is needed. No motors. It is quiet. It works by itself. It is in Class 8 not Class 7. None of the goods in the cited registration are even related much less confusingly similar. Unlike the cited registration which provides motors for airplanes which soar, the Applicant's mark provides a quiet, gravity-powered device -- which buries the dead. Beneath the ground.

Where there are differences in the purpose or intended use of goods, confusion is less likely. *See, e.g., In re Hair Standards Goods, Inc.*, 17 U.S.P.Q. 2d 1335, 1336 (Fed. Cir. 1990) (difference between HAIR STANDARDS for hair styling goods and HAIRSTANDARD for hair tonic sufficient to permit registration of mark); *G.H.Mumm & Cie v. Desnoes & Geddes, Ltd.*, 917 F. 2d 1292, 1295 (Fed. Cir. 1990) (no likelihood of confusion between RED STRIPE for premium champagne and RED STRIPE for beer); *In re Jacques Bernier, Inc.*, 1 U.S.P.Q. 2d 1924, 1925 (T.T.A.B. 1987) (differences between SPORTS CLUB for men's cologne and INTERNATIONAL SPORTS CLUB for men's clothing sufficient to permit registration); *In re Mars, Inc.*, 741 F. 2d 395, 396 (Fed. Cir. 1984) (CANYON for candy bars and CANYON for fresh citrus fruits not confusing); *In re Donnay International, Societe Anonyme*, 31 U.S.P.Q.2d 1953 (T.T.A.B. 1994) (THE GHOST for soccer balls and GHOST for tennis, table tennis, squash and badminton rackets and bags not confusingly similar).

We therefore ask the pivotal question -- *likelihood* of confusion? Answer? It is just not possible.

III. THE MARKS HAVE DIFFERENT COMMERCIAL IMPRESSIONS AND MUST BE VIEWED AS A WHOLE

These two marks have completely different commercial impressions to consumers. The universe of consumers for the Applicant's product is not just limited -- it is *extremely* limited. While likelihood of confusion should be based upon a similarity of letters, the overall commercial impression needs to be factored in to any analysis. Here, the Examining Attorney engages in a

casual dissection of Applicant's mark (ignoring the cited marks' differences). In *Packard Press, Inc. v. Hewlett-Packard Co.*, 56 U.S.P.Q.2d 1351, 1354 (Fed. Cir. 2000), the Court of Appeals found that the Board improperly dissected the marks PACKARD TECHNOLOGIES and HEWLETT-PACKARD by discussing only the similarity of the shared word "Packard." The Board undertook no analysis of the similarity of the PACKARD marks in their entirety.

In the present case, a finding of similarity based on the common use of the word "Standard" without any consideration for the commercial impact of the respective marks and the corresponding products is superficial and erroneous. These are marks which are different and create dramatically different commercial impressions in their respective (and quite distinguishable) markets.

In the present case, a finding of similarity based on the common use of one word without any consideration for the overall commercial impression of the marks (as well as the goods and channels of trade) is misguided. The Applicant submits that it is the differences that compel this application to proceed.

IV. THE CITED REGISTRATION AND THE INSTANT APPLICATION CAN COEXIST

What is especially "telling" is that the cited registration and the cited application have coexisted for more than half a century. Quite peacefully in fact.

This fact of coexistence should be given just a bit of added weight given the dilution of the word "Standard" in PTO records. There are no fewer than

3,500 "Standard" trademarks in PTO records. (See Exhibit A). In recent years, 37 "Standard" applications have been filed in Class 8 alone! (See Exhibit B). The sheer deluge of "Standard" trademarks in PTO records suggests that one more "Standard" trademark is not going to suddenly create confusion -- especially when it is as distinguishable as it is (and in a class different from the cited registration). A Boolean search of "Standard" with "casket" and/or "cemetery" as the goods reveals one mark -- the Applicant's.

Given the abundance of other "Standard" trademarks in PTO records, this metric -- the lone "Standard" trademark used for the "casket" or "cemetery" industry is quite instructive.

It would thus seem that a second -- more accurate -- test of likelihood of confusion would be to examine whether goods or services are offered -- or focused -- in the same industry. Will the goods of the cited registration and the Applicant's mark ever "cross paths" in commerce? If you have a gravity-powered casket lowering device destined for use *only* in cemeteries, one would be hard-pressed to find that there was potential confusion with airplane motors, elevator motors or planetary gear motors.

Thus the Applicant respectfully asks that these significant -- and pivotal -- differences be considered when viewing the instant application and the cited mark.

V. INFORMALITIES

A. **Identification of Services** -- The Applicant would agree to modify its identification of services to the following:

Class 8 -- "Gravity powered casket-lowering device for use in cemeteries and other places of interment."

B. **Specimens** -- The Applicant has attached a substitute specimen (a label for the Applicant's product) which was in use at least as early as the filing date of this application. An appropriate declaration is filed with this specimen.

C. **2(f) Claim** -- The Applicant will agree to withdraw the 2(f) claim per the Examiner's request.

VI. CONCLUSION

For the reasons set forth above, Applicant respectfully requests approval of its application for publication.

Date: May 31, 2012

Respectfully submitted,

FRIGID FLUID COMPANY



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CERTIFICATE OF FILING

I hereby certify that on May 31, 2012, the above Response to Office Action dated February 7, 2012, is electronically filed with the United States Patent & Trademark Office.

A handwritten signature in black ink, appearing to read "Scott W. Petersen", written over a horizontal line.

Scott W. Petersen
Attorney for Applicant

#665174_v82

EXHIBIT A



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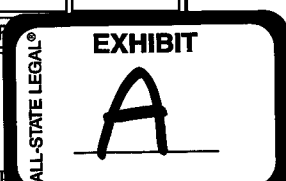
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3595 Records(s) found (This page: 1 ~ 50)

Refine Search (standard)[COMB]

Current Search: S1: (standard)[COMB] docs 3595 occ 8478

	Serial Number	Reg. Number	Word Mark	Check Status	Live/Dead
1	85632261		P PRINCE ORGANIZATION ROYAL HOSPITALITY IS OUR STANDARD	TARR	LIVE
2	85538705		H M. HOLLAND THE GOLD STANDARD IN PLASTICS	TARR	LIVE
3	85538703		H M. HOLLAND THE GOLD STANDARD IN PLASTICS	TARR	LIVE
4	85505532		KNOT STANDARD	TARR	LIVE
5	85439671	4150077	CTEMS	TARR	LIVE
6	85238819		GPCI GRANT PROFESSIONALS CERTIFICATION INSTITUTE PROVIDING A STANDARD OF EXCELLENCE FOR THE GRANT PROFESSION	TARR	LIVE
7	85218704		HEALTH STANDARD	TARR	LIVE
8	85122124	4150869	ARM & HAMMER THE STANDARD OF PURITY	TARR	LIVE
9	85101041		GSU	TARR	LIVE
10	85101002		GSI	TARR	LIVE
11	85100983		GSA	TARR	LIVE
12	85248137		APPROVED AMERICAN NATIONAL STANDARD ANSI	TARR	LIVE
13	85633752		S STANDARD FURNITURE GRAND DESIGNS	TARR	LIVE
14	85633746		MARBELLA BY STANDARD	TARR	LIVE
15	85633699		S STANDARD FURNITURE	TARR	LIVE
16	85633694		ORANGE STANDARD	TARR	LIVE
17	85633152		KITCHEN STANDARD	TARR	LIVE
18	85632663		THE INDUSTRY STANDARD FOR PROFESSIONAL ORGANIZERS	TARR	LIVE
19	85631325		STANDARDSINSIGHT	TARR	LIVE
20	85522884		THE SUBSTANCE OF THE STANDARD	TARR	LIVE
21	85632314		THE MAN STANDARD	TARR	LIVE
22	85631294		HUDSON VALLEY THE LIGHTING STANDARD	TARR	LIVE
23	85631288		HUDSON VALLEY THE LIGHTING STANDARD	TARR	LIVE
24	85630935		HEADSHOTS AND MORE (THE MARK CONSISTS OF STANDARD CHARACTERS, WITHOUT CLAIM TO ANY PARTICULAR FONT, STYLE, SIZE, OR COLOR.)	TARR	LIVE
25	85541744		HIGHER STANDARDS. LOWER IMPACT	TARR	LIVE



26	85630551		VERIFIED REVIEWS, THE GOLD STANDARD FOR REVIEWS	TARR	LIVE
27	85629685		OCULARIP ASSURED THE STANDARD FOR ETHERNET PERFORMANCE ANALYSIS & REPORTING	TARR	LIVE
28	85542499		STANDARDXCHANGE	TARR	LIVE
29	85397125		GOLD CANYON GOURMET ANGUS. TASTE THE GOLD STANDARD	TARR	LIVE
30	85629097		NATIONAL LOCUM TENENS NLT THE GOLD STANDARD IN PHYSICIAN STAFFING	TARR	LIVE
31	85629011		CENTRAL STANDARD	TARR	LIVE
32	85628406		INDUSTRY DRIVEN MESSAGING STANDARD	TARR	LIVE
33	85628341		GOLD STANDARD RATING	TARR	LIVE
34	85404540		THE GOLD STANDARD	TARR	LIVE
35	85263658		GOLD STANDARD	TARR	LIVE
36	85213632		PRIME US STANDARD TABLE WATER	TARR	LIVE
37	85157728		DS	TARR	LIVE
38	85065333		S STANDARD COMMUNICATIONS	TARR	LIVE
39	85044670		THE GOLD STANDARD OF REMOTE DEPOSIT CAPTURE	TARR	LIVE
40	85036141		THE GOLD STANDARD OF RDC	TARR	LIVE
41	85552646		GOLD STANDARD	TARR	LIVE
42	85538050		STANDARD SOUNDS	TARR	LIVE
43	85441323	4146655	IIASB	TARR	LIVE
44	85360051		S&P RISK CONTROL INDICES	TARR	LIVE
45	85065327		S	TARR	LIVE
46	85532718		HI STANDARD	TARR	LIVE
47	85293658		THE NEW AUDIO STANDARD FOR YOUR NEW MEDIA WORLD	TARR	DEAD
48	85065354		STANDARD COMMUNICATIONS	TARR	LIVE
49	85976779		ARM & HAMMER THE STANDARD OF PURITY	TARR	LIVE
50	85622768		TODAY'S STEEL STANDARD	TARR	LIVE

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37 Records(s) found (This page: 1 ~ 37)

Refine Search (standard)[MN] and (008)[IC]

Current Search: S3: (standard)[MN] and (008)[IC] docs: 37 occ: 74

	Serial Number	Reg. Number	Word Mark	Check Status	Live/Dead
1	85976779		ARM & HAMMER THE STANDARD OF PURITY	TARR	LIVE
2	85595751		STANDARD ISSUE BY HOGY	TARR	LIVE
3	85344786	4087735	SETTING SOPHISTICATED STANDARDS	TARR	LIVE
4	79070735		ANEL STANDARD	TARR	DEAD
5	79056387		STANDARD	TARR	DEAD
6	78960494		X-CELL LAWN & GARDEN A STANDARD OF "EX-CELL-ENCE"	TARR	DEAD
7	78562526		GOLD STANDARD POOPER SCOOPER	TARR	DEAD
8	77911272	4023439	TRUE SUISSE STANDARD ISSUE SINCE 1973	TARR	LIVE
9	77321382	3747293	ARM & HAMMER THE STANDARD OF PURITY	TARR	LIVE
10	76545851		AMERICAN STANDARD TOOL WORKS	TARR	DEAD
11	76529328		AMERICAN STANDARD	TARR	DEAD
12	76461111		STANDARD KNIFE COMPANY	TARR	DEAD
13	76460499	3155482	STANDARD	TARR	LIVE
14	76024883	2691907	INTERNATIONAL STANDARD OF EXCELLENCE	TARR	DEAD
15	75544948	2416277	GOURMET STANDARD	TARR	DEAD
16	75906819	2412608	STANDARD OF THE WEST	TARR	LIVE
17	75799861		GOLD STANDARD	TARR	DEAD
18	75630758	2742297	SETS THE STANDARD IN MECHANICS TOOLS	TARR	DEAD
19	75518654	2281309	HELD TO A HIGHER STANDARD	TARR	DEAD
20	75313549	2205199	US STANDARD TOOLS	TARR	DEAD
21	75243148	2297238	ADVANCING THE STANDARD OF FASTENING	TARR	LIVE
22	74800010	1620875	SERVOQUICK STANDARD NICKS	TARR	DEAD
23	74699628	2051936	FORGING THE STANDARD OF QUALITY	TARR	DEAD
24	74526778	1926295	STABLE STANDARD	TARR	DEAD
25	73394021	1325169	THE WORLD STANDARD BY WHICH ALL GUNLEATHER IS JUDGED	TARR	DEAD
26	73084464	1061544	HIGH STANDARD	TARR	DEAD
27	71700393	0627776	DAVIS-STANDARD	TARR	DEAD
28	89001204		TSE TURKISH STANDARDS INSTITUTION	TARR	DEAD



29	89001202		TURKISH STANDARDS INSTITUTION	TARR	LIVE
30	89001032		HOLLAND STANDARD QUALITEIT NEDERLANDSE MELKPRODUCTENCONTROLE	TARR	LIVE
31	89001031		HOLLAND STANDARD QUALITEIT NEDERLANDSE MELKPRODUCTENCONTROLE	TARR	LIVE
32	89000691		THE STANDARD OF THE PRSEIDENT OF TURKMENISTAN	TARR	LIVE
33	89000477		TUNISIAN STANDARDS	TARR	LIVE
34	89000232		HOLLAND STANDARD QUALITEIT NEDERLANDSE X BACON-CONTROLE	TARR	LIVE
35	72280758	0880047	WORLD'S STANDARD OF QUALITY	TARR	DEAD
36	72183251	0784783	TRU TEST STANDARD OF QUALITY TEST FOR YOUR PROTECTION	TARR	DEAD
37	71132464	0140773	STANDARD	TARR	DEAD

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