

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Carmel Partners, Inc. Law Office : 111
Serial No. : 85/520,624
Filed : January 19, 2012 Examiner : Lucy Arant
Mark : CARMEL

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

RESPONSE TO OFFICE ACTION

This is intended to be a complete response to the Office Action e-mailed on April 25, 2012. The period for reply was set at six months from the date of the Office Action. This response is therefore timely filed.

Section 2(d) Refusal – Likelihood of Confusion

The Examining Attorney has refused registration based on an alleged likelihood of confusion with the mark in U.S. Registration No. 3,469,958. Applicant disagrees with this refusal for the following reasons.

The Examining Attorney has reasoned that the subject mark is identical to the dominant portion of the registered mark, *i.e.*, “CARMEL” and that the disclaimed portion of the registered mark, *i.e.*, “CITY CENTER” is generic and therefore presumably has been given little, if any, weight in analyzing similarity between the two marks. However, the Court has cautioned that “in articulating reasons for reaching a conclusion on the issue of confusion, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entireties”¹ (*emphasis added*). Applicant submits that

¹ *In re Nat'l Data Corp.*, 753 F.2d 1056, 1058, 224 USPQ 749, 750-51 (Fed. Cir. 1985). Although there is no mechanical test to select a “dominant” element of a compound word mark, consumers would be more likely to perceive a fanciful or arbitrary term, rather than a descriptive or generic term, as the source-

I hereby certify under 37 CFR §2.197 that this correspondence is being electronically transmitted to the Commissioner for Trademarks, U.S. Patent & Trademark Office, on the date indicated below.

Date of Deposit

October 25, 2012

Signature

/Diane L. Gardner/

Typed or Printed Name of Person Signing Certificate

Diane L. Gardner

there is nothing generic about the term “CITY CENTER” with respect to the identified services, *i.e.*, “Real estate services, namely leasing of commercial office and residential real estate property.” At best, the term might be considered descriptive, and therefore should be given at least some weight in the assessment of similarity of the two marks. Moreover, the terms “CARMEL” and “CARMEL CITY CENTER,” when taken as a whole, provide distinct commercial impressions. Notably, the term “CARMEL CITY CENTER” yields a distinct impression relating to a location, whereas the term “CARMEL” is ambiguous and could present many different connotations, as is more fully discussed in the following section.

Notwithstanding the foregoing arguments, Applicant attaches hereto a consent agreement entered into by and between Applicant and the owner of the cited registration for “CARMEL CITY CENTER.” The consent agreement indicates that neither party is aware of any actual confusion resulting from the existence of the respective marks in the marketplace, that neither party believes that a potential for consumer confusion exists as a result of future use of the respective marks, and that both parties agree to use best efforts to avoid any potential confusion that may arise.

In the *In re E. I. du Pont de Nemours & Co.* decision, the Court of Customs and Patent Appeals stated as follows:

[W]hen those most familiar with use in the marketplace and most interested in precluding confusion enter agreements designed to avoid it, the scales of evidence are clearly tilted. It is at least difficult to maintain a subjective view that confusion will occur when those directly concerned say it won't. A mere *assumption* that confusion is likely will rarely prevail against uncontroverted evidence from those on the firing line that it is not².

Having established that there is no likelihood of confusion, Applicant respectfully requests reconsideration and withdrawal of this basis for refusal.

indicating feature of the mark. *See, e.g., In re Dixie Rests., Inc.*, 105 F.3d 1405, 1407, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997) (affirming TTAB's finding that “DELTA,” not the disclaimed generic term “CAFE,” is the dominant portion of the mark THE DELTA CAFE); *In re Binion*, 93 USPQ2d 1531, 1534 (TTAB 2009) (finding that “BINION'S,” not the disclaimed descriptive wording “ROADHOUSE,” is the dominant portion of the mark BINION'S ROADHOUSE).

² *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1362, 177 USPQ 563, 568 (C.C.P.A 1973).

Section 2(e)(2) Refusal – Primarily Geographically Significant

The Examining Attorney has refused registration based on an allegation of it being primarily geographically significant. In order to establish a proper refusal on this basis, the Examining Attorney must establish that:

- 1) the primary significance of the mark is a generally known geographic location;
- 2) the goods or services originate in the place identified with the mark; and
- 3) purchasers would be likely to believe that the goods or services originate in the geographic place identified in the mark.

Applicant disagrees with the refusal for the following reasons.

1) The primary significance of the mark is a generally known geographic location

The Examining Attorney has indicated that Carmel-by-the-Sea (often referred to as “Carmel”) is a northern California city located approximately 120 miles south of San Francisco, CA. However, Applicant attaches hereto evidence that the term “Carmel” is the proper name for cities also located throughout the U.S., *i.e.*, in Indiana, Maine, New York, and Wisconsin. The term “Carmel” also refers to cities in the countries of Australia, Spain, and Wales. Moreover, the term “Carmel” refers to places such as Mount Carmel, to an Israeli settlement on the West Bank, to a neighborhood in San Diego (Carmel Valley), and to a neighborhood in North Carolina. The term “Carmel” also refers to a geographic region and American Viticultural Area (Carmel Valley).

Clearly the term “Carmel” is used worldwide in the designation of regions, locations and cities. Accordingly, the Examining Attorney has not established that the primary significance of the mark relates to any one of these particular regions, or that prospective purchasers of Applicant’s services would identify the term with any single place. Purchasers located on the east coast of the U.S. may identify the term “Carmel” as relating to a place in Maine, New York or North Carolina, for example, while purchasers in the Midwest may identify the term with as relating to a place in Indiana or Wisconsin.

Moreover, the Examining Attorney has not established that prospective purchasers would identify the term with having any geographic significance at all. While the Examining Attorney has identified the term “Carmel” as a rarely used given or surname, the term is more commonly used in connection with monasteries and schools, a type of daisy, and the Middle Jurassic rock unit in the southwestern U.S.

With the ubiquity of the term’s use universally for a wide variety of designations both geographic and non-geographic, the Examining Attorney has failed to establish that the primary significance of the term is a single geographic place.

2) The goods or services originate in the place identified with the mark

The Examining Attorney has indicated that Applicant offers rentals in San Francisco to substantiate her refusal. The Examining Attorney then concludes that it is presumable that the same services are offered in Carmel-by-the-Sea, approximately some 120 miles away. In reaching this conclusion, the Examining Attorney has also concluded that there is no genuine issue of fact as to whether the geographical significance of the term “Carmel” is the mark’s primary significance. Applicant has provided ample rebuttal evidence to the contrary, therefore such an assumption cannot be maintained.

Moreover, Applicant in fact does not offer the identified services in any area incorporating the term “Carmel.” That, in and of itself, rebuts the Examining Attorney’s basis for refusal under the second prong. In order to establish a proper refusal, Applicant’s services would necessarily be required to originate from a place known as “Carmel” or associated with a place known as “Carmel.” It is doubtful that purchasers would consider the term “San Francisco” to be “a place associated with Carmel.” Moreover, Applicant’s identified services have been or are also now offered on the east and west coasts of the U.S., and in Colorado, Arizona and Texas – places having no association whatsoever to the term “Carmel.”

Therefore, the Examining Attorney has failed to establish that the identified services originate from a place identified with the mark, *i.e.*, “Carmel.”

3) Purchasers would be likely to believe that the goods or services originate in the geographic place identified in the mark

The Examining Attorney has failed to address this third prong of the test and has therefore failed to establish a *prima facie* justification for refusal of the mark under Section 2(e)(2). Nevertheless, Applicant elects to address this requirement.

A customer typically receives services of the type identified (*e.g.*, leasing or renting of buildings; renting of apartments) at the location where they are offered. Having chosen to come to that place for the services, the customer is well aware of the geographic location of the service. This choice necessarily implies that the customer is less likely to associate the services with any geographic location that might possibly be invoked by the mark rather than the geographic location of the service. In this case, the customer leasing or renting property not located in an area identified by the term “Carmel” is less likely to believe that the services originate in any such area.

The Examining Attorney has therefore failed to establish that purchasers of Applicant’s services would be likely to believe that the services originate in an area identified with the term “Carmel.”

Having failed to establish *prima facia* evidence for any and all of the three prongs of a proper refusal based upon Section 2(e)(2), Applicant respectfully requests reconsideration and withdrawal of this basis for refusal.

Applicant submits that all outstanding refusals have been addressed and rebutted and that the subject application is now in conditions for publication, which action is respectfully requested.

Please apply any charges and/or credits to Deposit Acct. No. 50-3137.

Respectfully submitted,

Date: _____

/Diane L. Gardner/
Diane L. Gardner

Mastermind IP Law P.C.
421 Santa Marina Court
Escondido, CA 92029
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Facsimile: (760) 294-5161

Carmel

From Wikipedia, the free encyclopedia

Carmel in the Bible refers to two distinct places:

- **Mount Carmel**, coastal mountain range in Israel overlooking the Mediterranean Sea
- **Carmel** (biblical settlement), an ancient Israelite town in Judea

The word **Carmel** (Hebrew language: כַּרְמֶל) is portmanteau meaning "*God's vineyard*".

In modern times, the name was also given to:

Places

- **Mount Carmel** (disambiguation), places named after Mount Carmel
- **Carmel City**, a **Druze** town
- **French Carmel**, neighborhood in **Haifa, Israel**
- **al-Karmil**, a **Palestinian** village and modern-day successor to the Biblical Carmel
- **Carmel**, Har Hebron, an **Israeli** settlement in the West Bank, adjacent to the ancient site whose name it shares
- **Carmel Market**, a shuq in Tel Aviv, **Israel**

Australia

- **Carmel**, Western Australia, suburb of Perth, **Western Australia**

Spain

- **El Carmel**, district in the city of Barcelona, **Catalonia**

United States

- **Carmel, Indiana**, a city in Hamilton County
- **Carmel, Maine**, a town in Penobscot County
- **Carmel, New York**, a town in Putnam County
- **Carmel, Wisconsin**, an unincorporated community in Waupaca County
 - **Carmel Hamlet, New York**
- **Carmel-by-the-Sea, California**, or "Carmel", a city in Monterey County
- **Carmel Highlands, California**, a small, unincorporated town located in Monterey County
- **Carmel Valley** (disambiguation), a geographic region and **American Viticultural Area**
- **Carmel Valley Village, California**, another small, unincorporated town in Monterey County
- **Carmel Valley, San Diego, California**, a neighborhood of the city of San Diego
- **Carmel**, a neighborhood in Mecklenburg County, **North Carolina**

Wales

- **Carmel, Anglesey**
- **Carmel, Carmarthenshire**
- **Carmel, Flintshire**
- **Carmel, Gwynedd**

Contents

- 1 Places
- 2 People
- 3 Other
- 4 See also

People

- John Carmel Heenan (1905–1975), priest in the Roman Catholic Church in the United Kingdom
- Roger C. Carmel (1932–1986), American character actor
- Carmel (singer), female singer of the eponymous British band Carmel
- Carmel Myers (1899–1980), American actress
- Carmel Bakurski (born 1976), Australian field hockey defender

Other

- **Carmel** is the term used to refer to a monastery of the nuns of the Carmelite religious order
- Carmel School (disambiguation), various schools and colleges
- Carmel & District Cricket Club North Wales village cricket team
- Mission San Carlos Borromeo de Carmelo (Carmel Mission), a Spanish mission located in Monterey County, California
- *Carmel* and *Carmeleno*, other names for the Rumsen language and people, California
- Autocars Co., or Carmel automobile, fiberglass-shelled cars used in Israel during the 1960s and 70s
- Carmel daisy, flowering plant of the family Dipsacales
- Carmel Formation, a Middle Jurassic rock unit in the southwestern United States
- Carmel Winery, a vineyard and winery based in Israel, well known for producing and marketing kosher wine
- i840 'Carmel', a 1999 chipset for dual Pentium 3 and Pentium 3 Xeon processors
- Carmel, Carmarthenshire, a terrestrial broadcast transmission station in Carmarthenshire, Wales
- Carmel Ventures, an Israeli venture capital firm
- *Carmel* (film), a 2011 film starring Josh Hutcherson and Hayden Panettiere
- Carmel Agrexco, Israel's largest exporter of agricultural produce

See also

- Caramel
- Carmen (a unisex given name, its first root is a diminutive nickname for *Carmel*)

Retrieved from "http://en.wikipedia.org/w/index.php?title=Carmel&oldid=519315810"

Categories: Disambiguation pages | Place name disambiguation pages | Given names

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CONSENT AGREEMENT

THIS IS AN AGREEMENT by and between Carmel City Center, LLC, a limited liability company organized and existing under the laws of Indiana, having a place of business at 770 3rd Ave. S.W., Carmel, Indiana 46032 (hereinafter "CCC"), and Carmel Partners, Inc., a corporation organized and existing under the laws of California, having a place of business at 1000 Sansome Street, Suite 180, San Francisco, CA 94111 (hereinafter "CPI").

A. Background

1. CCC is engaged in real estate development and leasing of commercial, office and residential property in and around Indiana.
2. CCC is the owner of U.S. Trademark Registration Nos. 3,387,181 for the mark "CARMEL CITY CENTER," reciting the following services in International Class 037: Real estate development of commercial, office and residential property; and 3,469,958 for the mark "CARMEL CITY CENTER," reciting the following services in International Class 036: Real estate services, namely, leasing of commercial, office and residential real property.
3. CCC has been engaged in real estate development of commercial, office and residential property in and around Indiana since at least as early as February 1, 2003, and has been engaged in leasing of commercial, office and residential property in and around Indiana since at least as early as May 14, 2008.
4. CPI is engaged in real estate investment services, and in leasing and renting of buildings and apartments on the east and west coasts of the United States and in Colorado, Arizona, Texas and Hawaii, but not in the Indiana area.
5. CPI is the owner of pending U.S. Trademark Application Nos. 85/520,624 for "CARMEL," reciting the following services in International Class 036: Leasing or renting of buildings; Renting of apartments; and 85/520,710 for the mark "CARMEL PARTNERS," reciting the following services in International Class 036: Real estate investment services.
6. CPI has been engaged in leasing and renting of buildings and apartments on the east and west coasts of the United States and in Colorado, Arizona and Texas, but not in the Indiana area, since at least as early as May 1, 2009, and has been engaged in real estate investment services on the east and west coasts of the United States and in Colorado, Arizona, Texas and Hawaii, but not in the Indiana area, since at least as early as November 28, 2001.

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7. CPI's two aforementioned trademark applications have been refused registration, *inter alia*, on the basis of a likelihood of confusion with CCC's Registration No. 3,469,958.
8. Neither CCC nor CPI is aware of any actual consumer confusion that has arisen as a result of use of the respective marks during the several years that they have co-existed.
9. Neither CCC nor CPI believes that a potential for consumer confusion exists as a result of use of the respective marks for respective services recited herein.
10. CCC and CPI wish to enter into an agreement to allow each party to pursue use of its marks for the services identified in the respective registrations and applications in a manner that will avoid the likelihood of any future potential consumer confusion, and in consideration of the mutual promises set forth herein and other good and valuable consideration, the receipt and sufficiency of which are hereby acknowledged.

B. Terms and Conditions

1. All of the foregoing prefatory clauses are hereby incorporated by reference herein.
2. CCC shall have the exclusive right (*vis-à-vis* CPI) to use the mark "CARMEL" for the services recited herein in connection with real estate properties physically located in the geographical area limited to the states of Indiana, Michigan, Illinois, Kentucky and Ohio.
3. CPI shall have the exclusive right (*vis-à-vis* CCC) to use the marks "CARMEL" and "CARMEL PARTNERS" for the services recited herein in the geographical area excluding the states of Indiana, Michigan, Illinois, Kentucky and Ohio.
4. CCC and CPI agree to use best efforts to take any other such reasonable steps to avoid any potential confusion that might arise from use of the respective trademarks with the services recited herein.
5. CCC and CPI agree that should circumstances arise wherein a potential for confusion exists, the party having such knowledge will notify the other party of said circumstances, and both parties will use best efforts to take any such reasonable corrective steps.
6. CCC and CPI agree that should circumstances arise wherein actual confusion exists, the party having such knowledge will notify the other party of said circumstances, and both parties will use best efforts to take any such reasonable corrective steps.

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7. This Consent Agreement and its terms and conditions shall be binding upon the parties and their successors and assigns, and all others acting by, through, or with them, or under their authority or direction, or in privity with them, and shall inure to the benefit of the successors and assigns of the parties.
8. The terms and conditions of this Consent Agreement, or any part hereof, may be amended only by a writing executed by both parties.
9. Each of the parties warrants and represents that it has the capacity and right to enter into this Consent Agreement; that it has not assigned or otherwise transferred in any manner rights or duties which would relieve it from fulfilling the terms and conditions herein; that it intends to be bound by the terms and conditions herein; that this Consent Agreement was fully negotiated by the parties and that none of the provisions herein is to be considered as having been drafted by either party; and that it consents to the terms and conditions herein.
10. Each of the signatories to this Consent Agreement represents and warrants that he/she has the full right, power and authority to execute the same and to bind the party for which he/she is signing.
11. This Consent Agreement comprises the entire understanding of the parties with respect to the subject matter hereof, all prior oral or written communications or understandings being superseded and merged herein.
12. This Consent Agreement may be executed in duplicate and may be executed in counterparts, each of which shall be deemed an original, but all of which together shall constitute one and the same instrument.
13. Nothing contained in this Consent Agreement shall be construed as creating a joint venture, partnership, agency, employment or other business relationship or enterprise between the parties.
14. This Consent Agreement shall have perpetual duration unless one or both parties completely and perpetually abandons use of its marks indicated herein, in which case termination shall take effect without further action by either party.
15. This Consent Agreement shall be effective as of the date of execution, or if executed by the parties on different dates, as of the latter of the two dates.

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IN WITNESS WHEREOF, the parties have caused this Consent Agreement to be executed by the respective duly authorized representatives:

For Carmel City Center, LLC

Mel Averitt, v.p.
Signature

Melissa Averitt
Printed Name

Vice President
Title

10/24/12
Date

For Carmel Partners, Inc.

Signature

Printed Name

Title

Date

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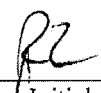
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For Carmel City Center, LLC

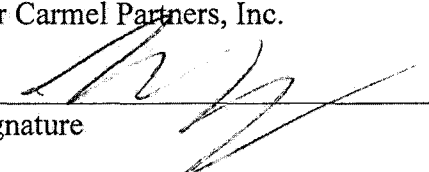
Signature

Printed Name

Title

Date

For Carmel Partners, Inc.



Signature

Ron Zeff

Printed Name

President

Title

10/24/12

Date