



**IN THE APPLICATION**

The below amendments to the application **have been made in the TEAS Response to Office action** form concurrently with the attachment of this reply.

**Identification of Goods**

Please **replace** the Identification of Goods as indicated below:

**SAFETY GLASSES FOR PROTECTION WHILE GRINDING OR CUTTING AND FROM SMALL FLYING PARTICLES AND LIQUID SPLATTER FOR USE IN THE FIELD OF HEALTH CARE AND SOLD TO HEATH CARE PROFESSIONALS**

**Substitute Specimen**

**Filed** with this Amendment and Reply is a substitute specimen showing the mark as used in commerce on or in association with the goods. The specimen is a bag in which the goods are placed. Also **attached** is a Statement Supporting Use of Substitute Specimens, with Declaration.

## REPLY

The Examining Attorney required a Substitute Specimen. The Examining Attorney indicated that the specimen does not show the applied-for mark in use in commerce in connection with the goods specified in the application. The Examiner indicated that the specimen appears to be printed advertising material and that the text on the specimen is printed backwards and therefore is unreadable. The original specimen is an image of a plastic bag used for containing the goods. Filed with this Amendment and Reply is a better image of the specimen with the goods placed therein. The mark is clearly seen on the top portion of the bag containing the goods. The text seen through the transparent bag is printed on the back of the bag and therefore appears to be printed backward. However, when the bag is turned over the printing is not backward.

The Examining Attorney refused registration because of a likelihood of confusion with US registration No. 4,097,480 for the mark LENS PROVISION and design for retail store services featuring prescription and non-prescription eyeglasses and accessories, in international class 035, and US Registration No.

4,584,852 for the mark VISIONPROS for eyeglasses, eyeglass frames, eyeglass lenses, sunglasses, sunglass frames and contact lenses; (based on 44(E)) eyeglasses, eyeglass frames, sunglasses, sunglass frames and contact lenses, in international class 009; and online retail store services featuring contact lenses, eyeglasses, eyeglass frames, eyeglass lenses, sunglasses and sunglass frames (based on 44(E)) online retail store services featuring contact lenses, eyeglasses, eyeglass frames, sunglasses and sunglass frames, in international class 035.

#### **THERE IS NO LIKELIHOOD OF CONFUSION**

There is **no likelihood of confusion** between the mark in the present application and the marks in the cited Registration No. 4,097,480, hereinafter '480 registration, and cited Registration No. 4,584,852, hereinafter '852 registration.

#### **Weakness of the Common Formatives**

The literal elements of the mark in the cited '480 registration and the word mark in the cited '852 registration are relatively weak. The applicant of the '480 registration has disclaimed and is making no claim to the exclusive right to use

"LENS PRO" apart from the mark. This disclaimer in the cited '480 registration is appropriate and necessary. The formative "PRO" is therefore relatively weak.

The formative "vision" as applied to eyeglasses or retail store services for eyeglasses is highly suggestive and therefore relatively weak. This will result in there not being any possibility of a likelihood of confusion between the marks.

In general, consumers or purchasers have come to recognize the common formative "vision" to be associated with similar goods or services coming from different sources or entities. There are many registrations for marks owned by different entities that contain the common formative "vision". A few examples are indicated in the following summary table of United States registrations having the same common formative "vision" for related goods or services. As a result consumers can easily distinguish between related goods or services and marks containing the common formatives "vision". A copy of each registration is also **attached**.

<b>Reg. No.</b>	<b>Mark</b>	<b>Goods/Services</b>	<b>Owner</b>
4,146,841	V VISION (and design)	Cases for eyeglasses and sunglasses; Cases for spectacles and sunglasses; Chains for spectacles and for sunglasses; Eyewear, namely, sunglasses, eyeglasses and ophthalmic frames and cases therefor; Eyewear, namely, sunglasses; Frames for spectacles and sunglasses; Lenses for sunglasses; Nose guards which can be worn by attachment to eyewear such as sunglasses and ski goggles; Spectacles and sunglasses; Sunglass chains and cords; Sunglass lenses; Sunglasses; Sunglasses and spectacles, in IC 009	Time Plaza
3,979,581	3VISION	Eyewear, namely, eyeglasses and cases therefor, in IC 009	Dimensional Optics, Inc.
3,947,939	V VISION (stylized)	Cases for eyeglasses and sunglasses; Cases for spectacles and sunglasses; Chains for spectacles and for sunglasses; Eyewear, namely, sunglasses, eyeglasses and ophthalmic frames and cases therefor; Frames for spectacles and sunglasses; Lenses for sunglasses; Nose guards which can be worn by attachment to eyewear such as sunglasses and ski goggles; Spectacles and sunglasses; Sunglass chains and cords; Sunglass lenses; Sunglasses; Sunglasses and spectacles, in IC 009	Time Plaza
2,943,664	VISION MAX	Optical goods, namely, eyeglasses, contact lenses, sunglasses, eyeglass frames and lenses, in IC 009	Steven KRINER

2,545,708	SLIM VISION	Magnifying glasses and eyeglass accessories, namely, cases, chains, repair kits comprised of small screw drivers, screws, and other small tools to be used for the repair of eyeglasses, and leashes, in IC 009	Sunglass Products of California
1,160,457	NUVISION (stylized)	Testing Eyes and Fitting Eyeglasses, in IC 042	NuVision Optical of Michigan, Inc.

All of the above registered marks contain the same formative "VISION". Therefore, the consuming public has come to recognize the use of the formative "VISION" on related goods or services and has been able to distinguish between the marks and identify the related goods or services as coming from different sources. Accordingly, even though the formative "VISION" is common to all of the above prior registered marks, there is no likelihood of confusion as to the source of the goods or services. As a result, all of these prior registrations may coexist despite the common formative "VISION", even on related or very similar goods.

This weakness in the formatives of the mark will result in no likelihood of confusion. Marks are not rendered confusingly similar merely because they share words in view of the large number of marks embodying the words for similar services. *In re Bed & Breakfast Registry* 229 USPQ 818 (CAFC 1986; held *BED & BREAKFAST REGISTRY* not confusingly similar to *BED & BREAKFAST*

*INTERNATIONAL*); also see *H. D. Lee Co. v Maidenform, Inc.* 87 USPQ2d 1715 (TTAB 2008) (holding *ONE FAB FIT* for outerwear not likely to be confused with *ONE TRUE FIT* for underwear, foundation garments, and intimate apparel due to being highly suggestive and having a narrow scope of protection). In one case, an applicant's use of a stylized "BOX SOLUTIONS" mark for computer communications servers was found not likely to cause confusion with registrant's "BOX" mark and design for similar goods. In this case, several third party registrations showed that the term "BOX" for computer related goods is very weak. *In re Box Solutions Corp.* 79 USPQ2nd 1953 (TTAB 2006)

Similarly, in the present application the use of the terms "PRO" and "VISION" are weak for use in association with goods related to eyewear. Therefore, as in *In re Box Solutions Corp.*, even though a mark is used with a common formative, there is no likelihood of confusion with the mark. This was held despite the similarity in the goods in view of the weakness of the common formative "BOX".

Additional evidence that the marks may coexist without any likelihood of confusion is that the Applicant has been using the mark in the application since at least as early as January 24, 2002. This is prior to any alleged use by the owner in the cited



registrations, or filing date of the cited registrations.

Despite the coexistence with Applicant's prior use of a similar mark having the same common formatives "PRO" and "VISION" there has not been any evidence of a likelihood of confusion. This is likely due to the public perception of the differences in the marks and the goods or services, an different channels of trade or customers.

Even more compelling evidence that marks for similar goods or services containing the common formatives "PRO" and "VISION" can coexist without any likelihood of confusion are the two cited registrations for the marks LENS PRO VISION and VISIONPRO. These two very similar marks can coexist on nearly identical goods or services, retail store services and online retail store services, without any likelihood of confusion as evident by the granting of the two different registrations to two different entities. The slight differences in the marks, even on very similar services or goods in the same channels of trade (retail store services), is sufficient to result in no likelihood of confusion.

### **Differences in the Goods/Services**

The Identification of Goods in the present application has been amended to more specifically define and distinguish the goods as well as to indicate their use in the field of healthcare and sale to healthcare professionals.

The goods in the application are directed to completely different potential consumers and for the '480 registration are in a different class, international class 009, than the services in the cited '480 registration, international class 035. This assures that there would likely be no exposure of the mark to the same consumers for the cited registrations and that, therefore, there could be no likelihood of confusion. This is especially likely in view of the goods traveling in very different and distinct channels of trade, with little likelihood of overlap.

As was indicated in *In re Coors Brewing Co.* 68 USPQ2d 1059, 1061 (CAFC 2003) the court stated:

The Board concluded that even though beer and wine are sometimes sold by the same party under the same mark, the two beverages are not sufficiently related that the contemporaneous use of similar marks on the two products is likely to cause confusion as to source.

Similarly, providing safety glasses for protection while grinding or cutting and from small flying particles and liquid splatter for use in the field of health care and sold to health care professionals is not sufficiently related to retail store services featuring prescription and non-prescription eyeglasses and accessories as in cited registration '480 or eyeglasses, eyeglass frames, eyeglass lenses, sunglasses, sunglass frames and contact lenses; (based on 44(E)) eyeglasses, eyeglass frames, sunglasses, sunglass frames and contact lenses, in international class 009; and online retail store services featuring contact lenses, eyeglasses, eyeglass frames, eyeglass lenses, sunglasses and sunglass frames (based on 44(E)) online retail store services featuring contact lenses, eyeglasses, eyeglass frames, sunglasses and sunglass frames as in the cited registration '852 so that the contemporaneous use of similar marks on the two different goods or services is likely to cause confusion as to source. Use of the mark on safety glasses for use in the field of health care and sold to health care professionals will not overlap with retail store services featuring prescription and non prescription eyeglasses and accessories, therefore, there will not be any likelihood of confusion.

Additionally, the potential consumers in the health care field are generally knowledgeable consumers. Health care professionals are particularly discriminating consumers and often select products with great care. Accordingly, this will assure that there will be no potential of a likelihood of confusion.

Accordingly, it is respectfully requested that the Examining Attorney reconsider and allow the application, and forward the application for publication.

Respectfully submitted,



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September 10, 2015

# United States of America

United States Patent and Trademark Office



**Reg. No. 4,146,841**

**Registered May 22, 2012**

**Int. Cl.: 9**

**TRADEMARK**

**PRINCIPAL REGISTER**

TIME PLAZA (CALIFORNIA CORPORATION)  
350 S LOS ANGELES STREET  
LOS ANGELES, CA 90013

FOR: CASES FOR EYEGLASSES AND SUNGLASSES; CASES FOR SPECTACLES AND SUNGLASSES; CHAINS FOR SPECTACLES AND FOR SUNGLASSES; EYEWEAR, NAMELY, SUNGLASSES, EYEGLASSES AND OPHTHALMIC FRAMES AND CASES THEREFOR; EYEWEAR, NAMELY, SUNGLASSES; FRAMES FOR SPECTACLES AND SUNGLASSES; LENSES FOR SUNGLASSES; NOSE GUARDS WHICH CAN BE WORN BY ATTACHMENT TO EYEWEAR SUCH AS SUNGLASSES AND SKI GOGGLES; SPECTACLES AND SUNGLASSES; SUNGLASS CHAINS AND CORDS; SUNGLASS LENSES; SUNGLASSES; SUNGLASSES AND SPECTACLES, IN CLASS 9 (U.S. CLS. 21, 23, 26, 36 AND 38).

FIRST USE 1-14-2011; IN COMMERCE 7-5-2011.

OWNER OF U.S. REG. NO. 3,947,939.

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "VISION", APART FROM THE MARK AS SHOWN.

THE MARK CONSISTS OF THREE HORIZONTAL BARS CONNECTED BY TWO VERTICAL BARS AT THE EDGES FORMING A SYMBOL SIMILAR TO THE CHINESE WORD FOR "DAY" ABOVE THE WORDING "V VISION".

SER. NO. 85-508,893, FILED 1-4-2012.

JAMES LOVELACE, EXAMINING ATTORNEY



*David J. Kappas*

Director of the United States Patent and Trademark Office

# United States of America

United States Patent and Trademark Office

## 3Vision

**Reg. No. 3,979,581**

**Registered June 14, 2011**

**Int. Cl.: 9**

**TRADEMARK**

**PRINCIPAL REGISTER**

DIMENSIONAL OPTICS, INC. (CALIFORNIA CORPORATION)  
3590 SACRAMENTO DRIVE, SUITE 130  
SAN LUIS OBISPO, CA 93401

FOR: EYEWEAR, NAMELY, EYEGASSES AND CASES THEREFOR, IN CLASS 9 (U.S. CLS. 21, 23, 26, 36 AND 38).

FIRST USE 12-31-2010; IN COMMERCE 1-31-2011.

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT, STYLE, SIZE, OR COLOR.

SN 85-105,974, FILED 8-12-2010.

KAREN K. BUSH, EXAMINING ATTORNEY



*David J. Kappas*

Director of the United States Patent and Trademark Office

# United States of America

United States Patent and Trademark Office



**Reg. No. 3,947,939**

**Registered Apr. 19, 2011**

**Int. Cl.: 9**

**TRADEMARK**

**PRINCIPAL REGISTER**

TIME PLAZA (CALIFORNIA CORPORATION)  
350 SOUTH LOS ANGELES STREET  
LOS ANGELES, CA 90013

FOR: CASES FOR EYEGLASSES AND SUNGLASSES; CASES FOR SPECTACLES AND SUNGLASSES; CHAINS FOR SPECTACLES AND FOR SUNGLASSES; EYEWEAR, NAMELY, SUNGLASSES, EYEGLASSES AND OPHTHALMIC FRAMES AND CASES THEREFOR; FRAMES FOR SPECTACLES AND SUNGLASSES; LENSES FOR SUNGLASSES; NOSE GUARDS WHICH CAN BE WORN BY ATTACHMENT TO EYEWEAR SUCH AS SUNGLASSES AND SKI GOGGLES; SPECTACLES AND SUNGLASSES; SUNGLASS CHAINS AND CORDS; SUNGLASS LENSES; SUNGLASSES; SUNGLASSES AND SPECTACLES, IN CLASS 9 (U.S. CLS. 21, 23, 26, 36 AND 38).

FIRST USE 6-20-2009; IN COMMERCE 7-15-2010.

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "VISION", APART FROM THE MARK AS SHOWN.

THE MARK CONSISTS OF A CAPITAL "V" LETTER COMPOSED WITH A UNDERNEATH CURVED VISION AS IDENTIFIER.

SER. NO. 85-132,883, FILED 9-18-2010.

INGA ERVIN, EXAMINING ATTORNEY



*David J. Kappas*

Director of the United States Patent and Trademark Office

**Int. Cl.: 9**

**Prior U.S. Cls.: 21, 23, 26, 36 and 38**

**Reg. No. 2,943,664**

**United States Patent and Trademark Office**

Registered Apr. 26, 2005

**TRADEMARK  
PRINCIPAL REGISTER**

**VISION MAX**

KRINER, STEVEN, M (PENNSYLVANIA SOLE  
PROPRIETORSHIP)  
375 BUSH HILL RD  
WILLIAMSPORT, PA 17701

NO CLAIM IS MADE TO THE EXCLUSIVE  
RIGHT TO USE "VISION", APART FROM THE  
MARK AS SHOWN.

FOR: OPTICAL GOODS, NAMELY, EYEGLAS-  
SES, CONTACT LENSES, SUNGLASSES, EYEGLASS  
FRAMES AND LENSES, IN CLASS 9 (U.S. CLS. 21, 23,  
26, 36 AND 38).

SER. NO. 78-303,477, FILED 9-22-2003.

FIRST USE 2-14-2000; IN COMMERCE 2-14-2000.

RONALD AIKENS, EXAMINING ATTORNEY



**Int. Cl.: 9**

**Prior U.S. Cls.: 21, 23, 26, 36 and 38**

**Reg. No. 2,545,708**

**United States Patent and Trademark Office**

**Registered Mar. 12, 2002**

**TRADEMARK  
PRINCIPAL REGISTER**

**SLIM VISION**

SUNGLASS PRODUCTS OF CALIFORNIA (CALIFORNIA CORPORATION), DBA CABLE CAR EYEWEAR  
1700 SHELTON DRIVE  
P.O. BOX 261  
HOLLISTER, CA 950230261

FOR: MAGNIFYING GLASSES AND EYEGLASS ACCESSORIES, NAMELY, CASES, CHAINS, REPAIR KITS COMPRISED OF SMALL SCREW DRIVERS, SCREWS, AND OTHER SMALL TOOLS TO BE USED FOR THE REPAIR OF EYEGLASSES, AND

LEASHES, IN CLASS 9 (U.S. CLS. 21, 23, 26, 36 AND 38).

FIRST USE 5-0-1995; IN COMMERCE 5-0-1995.

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "VISION", APART FROM THE MARK AS SHOWN.

SER. NO. 75-742,015, FILED 7-1-1999.

ALICE BENMAMAN, EXAMINING ATTORNEY

**Int. Cl.: 42**

**Prior U.S. Cl.: 100**

**United States Patent and Trademark Office**

**Reg. No. 1,160,457**

**Registered Jul. 7, 1981**

**SERVICE MARK**

**Principal Register**



NuVision Optical of Michigan, Inc. (Michigan  
corporation)  
2284 S. Ballenger  
Flint, Mich. 48503

For: TESTING EYES AND FITTING  
EYEGLASSES, in CLASS 42 (U.S. Cl. 100).  
First use Feb. 1964; in commerce Feb. 1964.

Ser. No. 232,742, filed Sep. 26, 1979.

DAVID SOROKA, Primary Examiner

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

*Statement Supporting Use of Substitute Specimen, with Declaration*

Mark : **PROVISION (stylized)**  
Serial Number : **86/453,102**

TO THE COMMISSIONER FOR TRADEMARKS:

Applicant: **J. Palmero Sales Company, Inc.**

Applicant makes the following claim with respect to the substitute specimen submitted herewith:

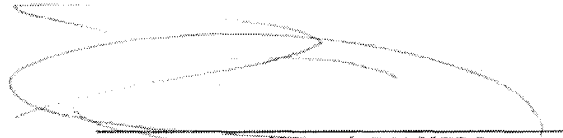
**The substitute specimen was in use in commerce at least as early as the application filing date.**

**DECLARATION**

The undersigned, being hereby warned that wilful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001, and that such wilful false statements may jeopardize the validity of the application or any resulting registration, declares that he/she is properly authorized to execute this **Statement Supporting Use of Substitute Specimen** on behalf of the applicant; he/she believes the applicant to be the owner of the trademark/service mark sought to be registered; and that all statements made of his/her own knowledge are true and all statements made on information and belief are believed to be true.

08/13/2015

Date

  
\_\_\_\_\_  
Kenneth PALMERO  
President

#3720E

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