

Applicant responds herewith to a non-final Office action which has been sent as of February 06, 2017 (creating a Monday, August 7, 2017 response due date). The February 06, 2017 Office Action is referenced as a "SUPPLEMENTAL ACTION" which "supersedes the previous Office action issued on February 3, 2017, in connection with this application."

The subject Office Action raises three issues:

1. Section 2(d) Refusal – Likelihood of Confusion
2. Mark Differs on Drawing & Specimen
3. Specimen of Use Unacceptable

Applicant respectfully traverses such refusal grounds as attached.

### **Specimen of Use Unacceptable**

The subject Office Action states in pertinent part (emphasis added):

Registration is refused because the specimen in International Class 10 **appears to be mere advertising material** and thus the specimen fails to show the applied-for mark in use in commerce. Trademark Act Sections 1 and 45, 15 U.S.C. §§1051, 1127; 37 C.F.R. §§2.34(a)(1)(iv), 2.56(a); TMEP §§904, 904.07(a). Specifically, **applicant submitted a flyer** accompanying a shipment of the goods. If material inserted in a package with the goods is merely advertising material, then it is not acceptable as a specimen of use on or in connection with the goods. Material that is only advertising does not necessarily cease to be advertising because it is placed inside a package. ...

Such refusal grounds are traversed.

The specimen materials of record provide no pricing whatsoever, nor any exhortation to call or contact for pricing, which if present would be recognized by most consumers as a major hallmark of what constitutes an advertisement.

Further, in this instance, the original identification of goods specified (emphasis added) adjustable bed frames, **for medical use**, and has now been amended restrictively (without entry of any new matter) as "sold to medical service providers" to further recite and emphasize the medical service limited usage of the subject goods. Consequently, the specimen materials of record would be recognized by the medical service providers to whom the goods are directed as a summary of application and use instructions – in effect, a visual summary of a manual for when the subject goods would be appropriate for a particular patient setting and how the subject goods would be used in such setting.

For example, the specimen materials indicate weight limits, and how those are to be determined (by including the "resident, mattress, head and foot board and accessories."

Further, the specimen materials indicate multiple images showing for example, the subject goods in different conditions (with or without mattress), in an articulated position or flat position, in an unfolded or folded position. Also for example, an assist rail is shown in plural of possible positions, and an associated hand pendant is shown in optional holder uses.

The TMEP states in pertinent part:

#### **904.03(j) Manuals**

If printed matter included with the goods functions as a part of the goods, such as a manual that is part of a kit for assembling the product, then placement of the mark on that printed matter does show use on the goods. In re Ultraflight Inc., 221 USPQ 903, 906 (TTAB 1984) ("We believe the instruction manual is as much a part of applicant's goods as are the various parts that are used to build the gliders. Application of the mark to the manual of assembly instructions, then, must be considered affixation to the goods.").

Further, Applicant submits that the subject refusal grounds take Applicant's use of the term "flyer" out of proper context. Merriam-Webster (see below) refers to the first listed synonym of flyer as "booklet", which is clearly out of the context of being a mere advertisement.

<https://www.merriam-webster.com/thesaurus/flyer>

Synonyms and Antonyms of flyer

a short printed publication with no cover or with a paper cover

Synonyms booklet

Accordingly, Applicant submits that the original specimen materials of record fully comply with the statute and regulations, and should be deemed acceptable. Therefore, reconsideration of such issue is requested.

#### **Mark Differs on Drawing & Specimen**

The subject Office Action states in pertinent part:

Specifically, the mark on the drawing is ADVANTAGE, and the mark on the specimen is M.C. ADVANTAGE SERIES and M.C. ADVANTAGE. Thus, the mark on the specimen is not a substantially exact representation of the mark on the drawing because it creates a different commercial impression with the addition of M.C. and SERIES, and does not match the mark shown on the drawing.

Such refusal grounds are traversed.

The subject Office Action seemingly refutes the possibility of separable marks appearing together, or the possibility of a portion of a recitation on a specimen constituting a registrable mark. Common practices in the marketplace, and USPTO registration practices would differ.

**For example, the terms "FORD FOCUS" and "FOCUS" are registered for the same goods while both were approved with specimens which stated "FORD FOCUS."**

Specifically, Federal Registration Nos. 3636749 and 2455794 per USPTO records recite as follows, and have the following specimens of record:

<b>Word Mark</b>	FORD FOCUS
<b>Goods and Services</b>	IC 006. US 002 012 013 014 023 025 050. G & S: Metal key chains and rings. FIRST USE: 20080630. FIRST USE IN COMMERCE: 20080630  IC 028. US 022 023 038 050. G & S: Toy replica of automobiles, remote controlled toy model vehicles. FIRST USE: 19990401. FIRST USE IN COMMERCE: 19990401
<b>Standard Characters Claimed</b>	
<b>Mark Drawing Code</b>	(4) STANDARD CHARACTER MARK
<b>Trademark Search Facility Classification Code</b>	SHAPES-MISC Miscellaneous shaped designs
<b>Serial Number</b>	78486902
<b>Filing Date</b>	September 21, 2004
<b>Current Basis</b>	1A
<b>Original Filing Basis</b>	1B
<b>Published for Opposition</b>	February 7, 2006
<b>Registration Number</b>	3636749
<b>Registration Date</b>	June 9, 2009
<b>Owner</b>	(REGISTRANT) Ford Motor Company CORPORATION DELAWARE One American Road Dearborn MICHIGAN 48126
<b>Attorney of Record</b>	Elizabeth F. Janda
<b>Prior Registrations</b>	2070776;2092385;AND OTHERS
<b>Type of Mark</b>	TRADEMARK
<b>Register</b>	PRINCIPAL
<b>Affidavit Text</b>	SECT 15. SECT 8 (6-YR).

**Live/Dead Indicator** LIVE

Specimen of Record for Federal Registration No. 3636749:



<b>Word Mark</b>	<b>FOCUS</b>
<b>Goods and Services</b>	IC 028. US 022 023 038 050. G & S: toys, namely, miniature models of vehicles, toy vehicles, hobby kits for the construction of toy vehicles, radio controlled toy vehicles, collectable toy cars [ and Christmas tree ornaments ]. FIRST USE: 19990401. FIRST USE IN COMMERCE: 19990401
<b>Mark Drawing Code</b>	(1) TYPED DRAWING
<b>Serial Number</b>	75505831
<b>Filing Date</b>	June 19, 1998
<b>Current Basis</b>	1A
<b>Original Filing Basis</b>	1B
<b>Published for Opposition</b>	January 26, 1999
<b>Registration Number</b>	2455794
<b>Registration Date</b>	May 29, 2001
<b>Owner</b>	(REGISTRANT) FORD MOTOR COMPANY CORPORATION DELAWARE The American Road Dearborn MICHIGAN 48121
<b>Attorney of Record</b>	Elizabeth F. Janda

**Type of Mark** TRADEMARK  
**Register** PRINCIPAL  
**Affidavit Text** SECT 15. SECT 8 (6-YR). SECTION 8(10-YR) 20110908.  
**Renewal** 1ST RENEWAL 20110908  
**Live/Dead Indicator** LIVE

Specimen of Record for Federal Registration No. 2455794:



Accordingly, similar treatment of Applicant's specimen of record would be to recognize that such specimens properly show use of Applicant's "ADVANTAGE" mark. Therefore, reconsideration of such issue is requested.

### **Section 2(d) Refusal – Likelihood of Confusion**

The subject Office Action states in pertinent part (emphasis added):

Registration of the applied-for mark is refused because of a likelihood of confusion with the mark in U.S. Registration No. 5105967 PRO ADVANTAGE. Trademark Act Section 2(d), 15 U.S.C. §1052(d); see TMEP §§1207.01 et seq. See the attached registration.

Trademark Act Section 2(d) bars registration of an applied-for mark that so resembles a registered mark that it is likely a **potential consumer**

would be confused, mistaken, or deceived as to the source of the goods and/or services of the applicant and registrant. See 15 U.S.C. §1052(d). A determination of likelihood of confusion under Section 2(d) is made on a case-by-case basis and the **factors set forth** in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973) aid in this determination. ... Not all the du Pont factors, however, are necessarily relevant or of equal weight, and **any one of the factors may control in a given case**, depending upon the evidence of record. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d at 1355, 98 USPQ2d at 1260; *In re Majestic Distilling Co.*, 315 F.3d 1311, 1315, 65 USPQ2d 1201, 1204 (Fed. Cir. 2003); see *In re E. I. du Pont de Nemours & Co.*, 476 F.2d at 1361-62, 177 USPQ at 567.

Such refusal grounds are traversed.

The identification of goods are amended herewith to read "Int'l Class 10, adjustable bed frames, for medical use, sold to medical service providers" in order **to emphasize a pertinent du Pont factor which has heretofore been totally unrecognized by the subject Office Action. Specifically, the subject du Pont factor referenced by Applicant herewith**

**(4) The conditions under which and buyers to whom sales are made, i.e. "impulse" vs. careful, sophisticated purchasing.**

In this instance, Applicant urges that the buyers to whom sales are made for both the goods of Applicant **and** the goods of Registrant qualify for the highest category of careful, sophisticated purchasing. Accordingly, such factor should count strongly in favor of registration, given literal differences between the subject goods and between the subject marks (when considering the proper scope of protection for the registered mark).

Without entry of any new matter, Applicant's amended identification of goods specify in pertinent part: "for medical use, sold to medical service providers." Likewise, the Registrant's subject goods **literally specify eight times**, all in Int'l Class 10, "for use by medical personnel" or "for medical purposes", and recite in a number of places other "medical" or "dental" context descriptions.

**The evidence of record clearly shows that both Applicant's and Registrant's goods are intended for medical and/or dental professionals.** Such fact is bolstered by the fact that the term "PRO" is disclaimed in the subject '967 registration.

Further, even for an incontestably registered mark, it is entirely proper to consider whether such mark is descriptive and/or a weak mark in determining a likelihood of confusion issue. A decision maker should consider the strength or distinctiveness of an incontestably registered mark, among other factors, when deciding a likelihood of confusion. See *Petro Stopping Centers L.P. v. James River Petroleum, Inc.*, 44 USPQ

2d 1921 (4th Cir. 1997); cert. denied, 118 S.C. 1561 (1998) (holding that the incontestable status of Plaintiff's registered marks did not preclude considering whether the mark is descriptive for likelihood of confusion analysis, and holding that parallel use of "PETRO" marks by the parties in conjunction with, inter alia, filling stations, was not likely to result in confusion).

In Petro, the Court of Appeals affirmed the district court holding of no likelihood of confusion. The district court had found PETRO to be descriptive and weak. Plaintiff contended "that because eight of its PETRO marks [were] incontestable, the district court was legally precluded from reaching its conclusion. ...We disagree. [Plaintiff] confuses the issue of a trademark's validity with the separate inquiry into a mark's strength for purposes of the likelihood of confusion determination." Id. at 1924.

"Even a mark held to be suggestive may be found weak under the first likelihood of confusion factor. [citing authority]" Id. at 1925.

Evidence of third party registrations alone is sufficient to support conclusion that a mark is relatively weak. Id. at 1926.

In this instance, USPTO records show sixty-two different registrations in IC 10 and including the term "ADVANTAGE" in the subject mark, as follows:

Current Search: S2: [advantage\[mn\]](#) and [010\[ic\]](#) and [live\[ld\]](#) docs: 73 occ: 219

	Serial Number	Reg. Number	Word Mark	Check Status	Live/Dead
8	<a href="#">87068207</a>	<a href="#">5128128</a>	<a href="#">ADVANTAGE</a>	TSDR	LIVE
9	<a href="#">87030651</a>		<a href="#">THE INNOVATION ADVANTAGE</a>	TSDR	LIVE
10	<a href="#">86854803</a>		<a href="#">SPORTS ADVANTAGE</a>	TSDR	LIVE
11	<a href="#">86434190</a>	<a href="#">5137999</a>	<a href="#">ADVANTAGE-MR</a>	TSDR	LIVE
12	<a href="#">86769696</a>	<a href="#">5106204</a>	<a href="#">VISION ADVANTAGE</a>	TSDR	LIVE
13	<a href="#">86703008</a>	<a href="#">5105967</a>	<a href="#">PRO ADVANTAGE</a>	TSDR	LIVE
14	<a href="#">86618299</a>	<a href="#">4877269</a>	<a href="#">U A UNIFORM ADVANTAGE</a>	TSDR	LIVE
15	<a href="#">86373050</a>	<a href="#">4775703</a>	<a href="#">UA UNIFORM ADVANTAGE</a>	TSDR	LIVE
17	<a href="#">86785278</a>	<a href="#">5034852</a>	<a href="#">ADVANTAGE MAGAZINE</a>	TSDR	LIVE
19	<a href="#">86667451</a>	<a href="#">4944661</a>	<a href="#">PRO ADVANTAGE BY NDC</a>	TSDR	LIVE
20	<a href="#">86163904</a>	<a href="#">4596363</a>	<a href="#">3 ARCH ADVANTAGE</a>	TSDR	LIVE
21	<a href="#">86163847</a>	<a href="#">4596360</a>	<a href="#">3 ARCH ADVANTAGE</a>	TSDR	LIVE
22	<a href="#">86479184</a>	<a href="#">4785622</a>	<a href="#">YOUTHFUL ADVANTAGE</a>	TSDR	LIVE
23	<a href="#">85215952</a>	<a href="#">4103120</a>	<a href="#">K SHIELD ADVANTAGE</a>	TSDR	LIVE
24	<a href="#">85955007</a>	<a href="#">5156383</a>	<a href="#">SHARP ADVANTAGE</a>	TSDR	LIVE
25	<a href="#">85671494</a>	<a href="#">4446033</a>	<a href="#">UNIFORM ADVANTAGE</a>	TSDR	LIVE
26	<a href="#">85606525</a>	<a href="#">4389063</a>	<a href="#">ADVANTAGE BY UA</a>	TSDR	LIVE
27	<a href="#">85606326</a>	<a href="#">4389062</a>	<a href="#">ADVANTAGE BY UA</a>	TSDR	LIVE

28	85499579	4605877	LABSCO ADVANTAGE	TSDR	LIVE
29	85661172	4724143	THE CHLORHEXIDINE ADVANTAGE	TSDR	LIVE
30	85745307	4342387	ADVANTAGE PLUS	TSDR	LIVE
31	85676050	4511507	CUSTOMER ADVANTAGE CONSUMER CONFIDENCE	TSDR	LIVE
32	85647797	4452059	BALANCE ADVANTAGE	TSDR	LIVE
33	85571965	4267319	CLEAR ADVANTAGE	TSDR	LIVE
34	85368008	4200976	ADVANTAGE-LOAD	TSDR	LIVE
35	85367999	4200975	ADVANTAGE-STRAND	TSDR	LIVE
36	85296748	4073503	TRI-MEDICS THE SHEAR ADVANTAGE	TSDR	LIVE
37	85004889	4060821	PRO ADVANTAGE BY NDC	TSDR	LIVE
38	79177295	5158353	TRUSCO PRO TOOL SKILLED PROFESSIONALS NEED PROFESSIONALLY QUALIFIED TOOS. THIS LINE OF PRODUCTS BRINGS MANUFACTURERS ALL THE ADVANTAGES OF USIHG EXCELLENT EQUIPMENT, AND WILL SATISFY EACH AND EVERY USER IN THE WORKPLACE.	TSDR	LIVE
39	79188791	5102622	OXYGEN ADVANTAGE	TSDR	LIVE
40	78659204	3185970	ADVANTAGE	TSDR	LIVE
41	78613343	3182701	ADVANTAGE CERVICAL SYSTEM	TSDR	LIVE
42	78856053	3321445	SHORTSTOP ADVANTAGE	TSDR	LIVE
43	78965764	3376620	THE ADVANTAGE POLYP TRAP	TSDR	LIVE
44	78075152	2543115	THE CLINICAL ADVANTAGE	TSDR	LIVE
45	78229757	2953339	ADVANTAGE	TSDR	LIVE
46	78494444	3020616	PRO ADVANTAGE	TSDR	LIVE
47	78462431	3005854	CLEAR ADVANTAGE	TSDR	LIVE
48	78439835	3005789	ADVANTAGE	TSDR	LIVE
49	78252671	2978845	ADVANTAGE	TSDR	LIVE
50	78234281	2895345	GLOBAL ADVANTAGE	TSDR	LIVE
51	77896564	3906553	CLEAN & CLEAR ADVANTAGE	TSDR	LIVE
52	77515802	3796416	PRO ADVANTAGE BY NDC	TSDR	LIVE
53	77515660	3796415	PRO ADVANTAGE BY NDC	TSDR	LIVE
54	77516235	3590514	PRO ADVANTAGE BY NDC	TSDR	LIVE
55	77673795	4063731	CLEAR ADVANTAGE COLLAR	TSDR	LIVE
56	77595114	3926103	THE EXTRACTION ADVANTAGE	TSDR	LIVE
57	77085316	3296849	KCI THE CLINICAL ADVANTAGE	TSDR	LIVE
58	77347941	3481986	ADVANTAGE FIT	TSDR	LIVE
59	77081115	3463168	GLIDEWIRE ADVANTAGE	TSDR	LIVE
60	77272668	3444360	ADVANTAGE PLUS	TSDR	LIVE
61	77225511	3442059	MEDIVATORS ADVANTAGE	TSDR	LIVE
62	76436974	2719241	KCI THE CLINICAL ADVANTAGE	TSDR	LIVE
63	76142952	2560329	ADVANTAGE PD-103	TSDR	LIVE
64	76058155	2789136	THE HEALING ADVANTAGE	TSDR	LIVE
65	76356907	2860786	TRUE ADVANTAGE	TSDR	LIVE



66	76142531	2560328	ADVANTAGE I-125	TSDR	LIVE
67	75573637	2504988	ADVANTAGE	TSDR	LIVE
68	75302346	2231204	PRESS-MATE ADVANTAGE	TSDR	LIVE
69	75347964	2388141	FLEX ADVANTAGE	TSDR	LIVE
70	75257381	2281953	ADVANTAGE ARM	TSDR	LIVE
71	74531400	1902581	ADVANTAGE	TSDR	LIVE
72	74717086	2096415	CLEAR ADVANTAGE	TSDR	LIVE
73	74204903	1742236	CLEAR ADVANTAGE	TSDR	LIVE

The duty of care owing in a medical or dental context clearly indicates careful, sophisticated purchasing practices, such that literal differences between the respective **marks when properly considering the relatively limited scope of protection due the registered mark in this instance**, and the respective goods, would be noted and understood by the subject consumers, such that no likelihood of confusion would result.

In view of the foregoing, Applicant respectfully traverses all grounds of refusal of record, and requests reconsideration thereof.