


IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

MARK: 

SERIAL NO.: 88/349,045

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EXAM. ATTY.: Byron Barahona

LAW OFFICE: 127

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**RESPONSE TO OFFICE ACTION**

This is in response to the Office Action sent via e-mail on June 19, 2019. As an initial matter, the Applicant has amended the identification of services as suggested by the examiner but with further clarification. The goods and services are now identified as:

- International Class 012: Mobile storage carts for domestic, educational and commercial use
- International Class 020: Educational furniture; furniture used in restaurants and cafés; conference furniture; dining furniture; lunch room furniture; utility furniture for school, office or food service use; computer furniture for school, office or food service use; game furniture, not being a toy; office furniture for school, office or food service use; administrative furniture for school, office or food service use; tables; chairs; seating, namely stools, lounge chairs and ottomans for seating single and multiple people; science tables, namely, tables of metal or wood; art tables; computer tables; dining tables; library tables; utility tables; desks; lunch room tables and chairs, conference tables and chairs; furniture used for collaboration; carrels; cubbies being non-metal storage boxes for general use
- International Class 040: Manufacture of furniture for others; manufacture of furniture to the specifications of others; manufacture of furniture for order by others; Manufacture for others of educational furniture, furniture used in restaurants and cafés, conference furniture, dining furniture, lunch room furniture, utility furniture, computer furniture, game furniture, office furniture, administrative furniture, tables, chairs, seating, activity tables, science tables, art tables, computer tables,

game tables, dining tables, library tables, utility tables, desks, lunch room tables and chairs, conference tables and chairs, furniture used for collaboration, carrels, cubbies

International Class 042: furniture design services; design of furniture for others; design of furniture to the specifications of others; design of furniture for order by others; design for others of educational furniture, furniture used in restaurants and cafés, conference furniture, dining furniture, lunch room furniture, utility furniture, computer furniture, game furniture, office furniture, administrative furniture, tables, chairs, seating, activity tables, science tables, art tables, computer tables, game tables, dining tables, library tables, utility tables, desks, lunch room tables and chairs, conference tables and chairs, furniture used for collaboration, carrels, storage carts and cubbies

In addition to requesting revisions to the identification, the Examiner raised a section 2(d) refusal and provided notice of a prior pending application that may form the basis of a section 2(d) refusal if that application issues into a registration. The Applicant respectfully disagrees with the Examiner's refusal and submits the following in support thereof:

**1. Prior pending application serial number 88/063,335**

The Applicant advises that the prior pending application cited by the Examiner, serial number 88/063,335, has been abandoned and should no longer form the basis of a refusal.


**2. Registration numbers 2,713,585, 2,920,844 and 5,429,017**

The marks depicted in registration numbers 2,713,585, 2,920,844 and 5,429,017 do not create a likelihood of confusion with the Applicant's mark for at least six reasons. First, the Applicant's amendment to the identification adds additional specificity that distinguishes the Applicant's design, manufacture and sale of furniture for school, office or food service use from the products and services offered by the two other registrations, namely non-metal storage cabinets and drawers and machine shop manufacturing. The services and goods provided under the marks are dissimilar and unrelated. Second, the Applicant's mark and the marks depicted in the three registrations are offered using very different trade channels and to very different customers. There is no market interface among the marks. The Applicant's furniture products and services – sold for school, office or food service use, are not advertised and marketed very differently from the electronical component non-metal storage cabinets and drawers distributed by one of the cited registrants under its marks, and the machine shop manufacturing services provided by the other registered mark's registrant. There is no overlap between the purchasers of each parties' products and services. Purchasers of the Applicant's goods and services – furniture purchasers -- would not encounter or use the goods and services of the other registrants – machine shop and electrical component supplies. Third, the purchasers of each parties' goods and services are sophisticated

who make careful purchasing decisions that are not based on impulse. All of the services and products offered by the parties cost hundreds and thousands of dollars and require careful selection, design and assessment of quality. Fourth, the Applicant has used its ALLIED mark in connection with its furniture products and services since 1968 – over forty years – and has not experienced a single instance of actual confusion with either of the two registrants, include the ALLIED ELECTRONICS mark which has similarly been in use since 1965. Fifth, the term ALLIED is in widespread third party use in connection with manufacturing services, such that consumers distinguish among various manufacturing activities, particularly between the Applicant’s furniture manufacturing and the machine shop casting manufacturing performed under the *ALLIED MACHINERY* mark. In view of that use, consumers will distinguish among those uses of the term *ALLIED* with manufacturing services and not attribute that terms use to a single source of manufacturing services. And sixth, the parties’ marks have very different commercial impressions and connotations. The cited marks are *ALLIED MACHINERY* and *ALLIED ELECTRONICS*. Both of those marks contain added descriptors clarify to consumers their offerings of machine shop-related services and products for use with electrical components. For these reasons, as more fully discussed below, the section 2(d) refusals should be withdrawn.

**A. The Cited Registrations**

The Examiner cited the following three registrations as the basis of its section 2(d) refusal:

| <b>Reg. #</b> | <b>Mark</b>   | <b>Goods / Services</b>   |
|---------------|---|---|
| 2,713,585     | <b>ALLIED ELECTRONICS</b>   | Class 020: Non-metal wall mounted enclosures; non-metal storage bins; non-metal storage cases; wood knobs; plastic knobs; non-metal handles for electronic controls and instruments; non-metal screws; and non-metal storage cabinets and drawers   |
| 2,920,844     |  | Class 020: Non-metal wall mounted enclosures; non-metal storage bins; non-metal storage cases; wood knobs; plastic knobs; non-metal handles for electronic controls and instruments; non-metal screws; and non-metal storage cabinets and drawers.  |
| 5,429,017     | <b>ALLIED MACHINERY</b>   | Class 040: Machine shop services, namely, machining parts for others; manufacturing services for others; casting of metal, non-metals and/or a combination thereof; providing a website featuring information with regard to machining, casting; providing a website featuring information with regard to custom fabrication and production strategy of metal castings and items made of metal, including flask and pallet cars, metal engine parts, metal machinery parts. |

Registration numbers 2,713,585 and 2,920,844 are owned by Allied Electronics, Inc., and registration number 5,429,017 is owned by Allied Machinery Richland, LLC. The marks and the applicable good/services referenced by the Examiner are recited in the table above.<sup>1</sup>

<sup>1</sup> Registration number 5,429,017 (*ALLIED MACHINERY*) also identifies goods and services in Class 006 for metal castings, in Class 035 for inventory, transportation and logistics services, and in Class 042 for engineering services, software and technology services and a website featuring information in the field of management, manufacturing, transportation, fulfillment and logistics. The Examiner’s Office Action does not recite or reference any of these other

**B. The Goods and Services Offered Under the Applicant's Mark and those Under the Registered Marks are Very Different.**

The refusal should be withdrawn because the Applicant's office, consumer and educational furniture products and related design and manufacturing services are completely different from the electronic components products and machining in the two ALLIED ELECTRONICS registrations, and the machine shop manufacturing services in the ALLIED MACHINING registration. The law is clear there can be no likelihood of consumer confusion between two marks, even if they are identical marks, if the goods and services of the two parties are non-competitive and unrelated. See *DeCosta v. Viacom Int'l, Inc.*, 981 F.2d 602, 609 (1st Cir. 1992) (holding that a person may "take a pre-existing name or mark and use it on a different product in a different market"); *Societe Des Produits Nestle SA v. Casa Helvetia, Inc.*, 982 F.2d 633, 641 (1st Cir. 1992) ("using the same mark on two blatantly different products normally does not offend the Lanham Act, for such use is unlikely to cause confusion and is, therefore, unlikely to imperil the goodwill of either product"); *Blazon, Inc. v. Blazon Mobile Homes Corp.*, 416 F.2d 598, 599 (7th Cir. 1969) (stating that, "If the same trademark is used in an unrelated field there is no likelihood of confusion").

As to the two ALLIED ELECTRONICS registrations, the Examiner argues that the Applicant's utility furniture, computer furniture, office furniture and administrative furniture products encompass the ALLIED ELECTRONICS registrations' listed "non-metal storage cabinets and drawers" goods. As set forth above, the Applicant has amended the identification of services in International Class 020 to reflect the use of these furniture products for school, office or food service use. Those portions of the Class 020 identification have been amended as follows:

utility furniture for school, office or food service use  
computer furniture for school, office or food service use  
office furniture for school, office or food service use  
administrative furniture for school, office or food service use

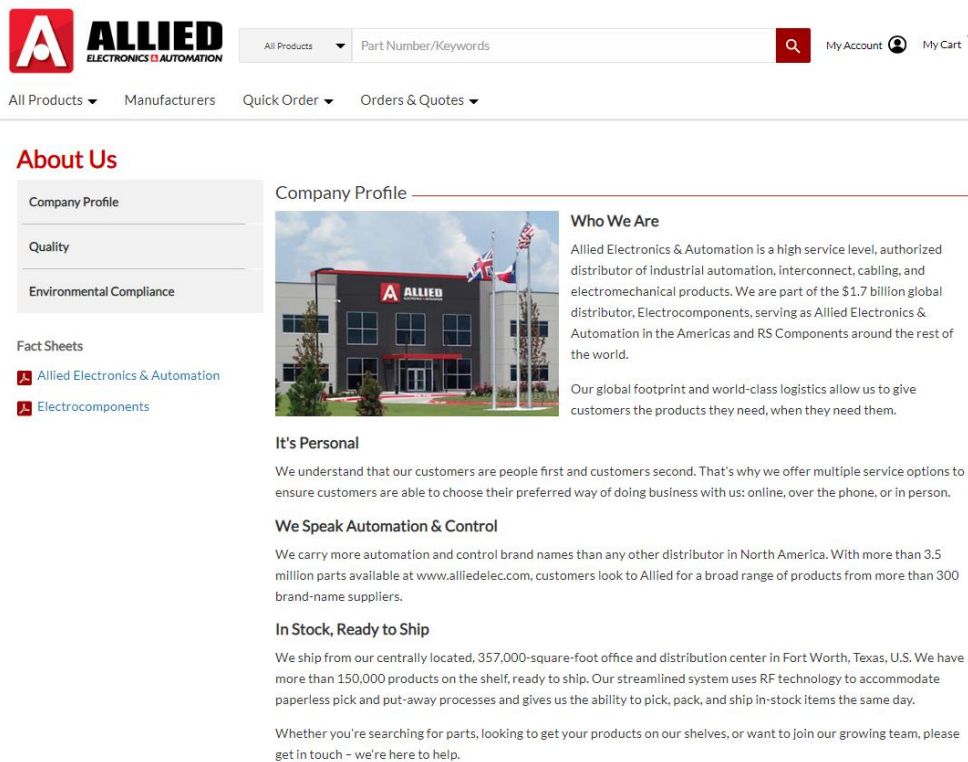
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goods or services or assert they form the basis of the section 2(d) refusal. These goods and services, which are also wholly unrelated to the Applicant's furniture business, are therefore not addressed in this response.

As recognized by the Examiner in its Office Action, the identification of goods in the ALLIED ELECTRONICS registrations use “more narrow ‘non-metal storage cabinets and drawers’ which describes a particular type of utility, computer, office and administrative furniture.” The Applicant agrees that these two registrations identify a very narrow category of products. The two ALLIED ELECTRONICS registrations identify goods that are completely different from the Applicants. The two registrations contain the identical identification of goods:

Non-metal wall mounted enclosures; non-metal storage bins; non-metal storage cases; wood knobs; plastic knobs; non-metal handles for electronic controls and instruments; non-metal screws; and non-metal storage cabinets and drawers<sup>2</sup>

As evidenced by this registrant’s website, [www.alliedelec.com](http://www.alliedelec.com), Allied Electronics Inc. is a distributor of electromechanical products in the fields of industrial automation, interconnect and cabling. They are not a manufacturer or seller of office, educational or food service furniture:



Attached hereto as Exhibit A are the Facts Sheets referenced on the “ABOUT US” page of their website (depicted in the left margin of the above screen capture).

<sup>2</sup> As cited in the Office Action, the Examiner asserted that the Section 2(d) refusal was based upon the “non-metal storage cabinet and drawers” language contained in the identification of both ALLIED ELECTRONICS registrations. The Applicant has therefore focused on those products in this response.

The “non-metal storage cabinets and drawers” sold under the *ALLIED ELECTRONICS* mark are not sold or used for office, educational or food service applications. Rather, they are storage cabinets and drawers used for storing electronic components, which is related to and consistent with Allied Electronics’ business of distributing automation, interconnect, cabling and electromechanical products. The screen shots of the cabinets and drawers sold by this registrant via its website are depicted below:

The screenshot shows the Allied Electronics website interface. At the top left is the Allied Electronics logo. A search bar contains 'Part Number/Keywords'. Below the search bar are navigation links: 'All Products', 'Manufacturers', 'Quick Order', and 'Orders & Quotes'. The main product title is 'Treston 60649101'. Below the title is a breadcrumb trail: '← Back | Tools & Hardware | **Workshop Equipment & Storage** | Storage & Shelving | Drawers | 60649101'. The 'Workshop Equipment & Storage' link is circled in blue. To the left is a product image of a grey metal drawer unit with three drawers. To the right of the image is the product description: 'Sovella: Drawer unit 45/56-1; 5x3.94', 'Manufacturer #: 60649101', and 'Allied Stock #: 70742237'. Below the description is a quantity selector showing '1' and an 'ADD TO CART' button. To the right of the product image is a 'Pricing (USD) & Availability' table.

| Pricing (USD) & Availability      |           |
|-----------------------------------|-----------|
| Standard Pricing                  |           |
| <b>\$1006.32</b> (Each)           |           |
| 1                                 | \$1006.32 |
| Availability                      |           |
| 0 can ship immediately.           |           |
| <a href="#">Request Lead Time</a> |           |
| Minimum Quantity: 1               |           |
| Multiples Of: 1                   |           |

Below the product image is a 'View larger image' link and a note: 'Image may be a representation. See specs for product details.' Below the product description is a 'Resources' section with a link 'View More from Treston >>' and a note: 'Drop Ship Only: This item must be shipped from the manufacturer directly to your location.'

| Product Specifications |                 |
|------------------------|-----------------|
| Product Attribute      | Attribute Value |
| Series                 | 60649 Series    |

As can be seen in the circled area above for emphasis, the drawers and cabinets are indexed/cataloged on the site under the grouping “Workshop Equipment & Storage” under “Tools and Hardware.” The Applicant does not sell these types of products, or any products for that matter in connection with electronic component applications. Rather, the Applicant sells furniture products that are purchased by businesses for offices, libraries, dining and cafeteria areas, and other uses by employees and individuals in an office, food service, business or educational environment. The Applicant’s products and services are not specialized for automation,

interconnect, cabling and electromechanical products or their storage. The Applicant's goods and services, especially when narrowed through the inclusion of "for school, office or food service use" are dissimilar and unrelated to those identified in the two *ALLIED ELECTRONICS* registrations. The section 2(d) refusal should therefore be withdrawn.

As to the *ALLIED MACHINERY* registration, the Examiner argues that the Applicant's manufacture of office furniture for others, manufacture of furniture to the specifications of others, manufacture of furniture for order by others, and manufacture for others of educational furniture services fall within the *ALLIED MACHINERY* registration's "manufacturing services for others." The Applicant and the *ALLIED MACHINERY* registrant manufacture wholly different and unrelated products.

The Applicant respectfully submits that the Examiner is taking Allied Machinery's manufacturing services out of context. The *ALLIED MACHINERY* registration lists its manufacturing services in International Class 040 with machining parts, such as metal casting, flask and pallet cars, metal engine parts and metal machinery parts:

Class 040: Machine shop services, namely, machining parts for others; manufacturing services for others; casting of metal, non-metals and/or a combination thereof; providing a website featuring information with regard to machining, casting; providing a website featuring information with regard to custom fabrication and production strategy of metal castings and items made of metal, including flask and pallet cars, metal engine parts, metal machinery parts.

Allied Machinery's manufacturing of machine parts and non-furniture items is evidenced by the specimen it submitted in connection with obtaining its registration on January 31, 2018. A copy of the specimen is attached hereto as Exhibit B. As evidenced by the following excerpts from the specimen, this registrant's manufacturing services are wholly unrelated to the Applicant's manufacture of furniture:

|  |   |  |
|--|---|--|
| <b>WE POUR</b><br><b>DUCTILE IRON</b><br>ASTM A536-60-40-18<br>65-45-12<br>80-55-06<br>100-70-03<br>120-90-02<br>SAE J434-(D4018-DQ&T)<br>ASTM A395<br>60-40-18<br><br><b>COMPACTED GRAPHITE</b><br>ASTM A842<br>(250-450) | <b>GRAY IRON</b><br>ASTM A48 – (GRADE 20-50)<br>ASTM A159-<br>SAE J431<br>(G1800-G4000) | <b>METHODS</b><br><br>Allied Machinery Richland, LLC produces castings in iron base alloys via the No Bake molding method. Our products fit into a size range from 75lbs on up to 5,000lbs in weight and sizes from 32×32 12/12 up to 96×144 36/36 with varying degrees of complexity.<br><br>Our objective is to be recognized by peers and consumers as the best in class supplier of cast products serving the world's best companies. Our facility shall be the safest work environment of its kind with an atmosphere of excellence and continuous improvement shared by all employees. |
|  | <b>AUSTEMPERED</b><br>A897-(1-5)  |  |

\* \* \* \*

Allied Machinery Richland is now an all No Bake mold facility serving consumers of both raw and finished castings along with fully machined parts used in non-Automotive markets including, but not limited to, Agriculture, Construction Equipment, Industrial Equipment, Power Generation (Diesel, Gas Turbine, Rail, and Alternative Energy), Power Transmission, and Commercial Refrigeration.

As evidenced above, the registrant’s “no bake” molding method produces products in the 75 to 5,000 pound weight for raw and finished castings in the field of agriculture, construction equipment, industrial equipment, power generation, power transmission and commercial refrigeration. Those manufacturing activities are wholly dissimilar and unrelated to the manufacture of furniture for office, educational and food service use.

The mere fact that Applicant’s services are in the field of office, educational and food service furniture and related manufacturing and that the product recited in the *ALLIED MACHINERY* registration also provides manufacturing services does not constitute a legally



relevant overlap under section 2(d) of the Trademark Act. See *UMC Industries, Inc. v. UMC Electronics Co.*, 207 U.S.P.Q. 861, 879 (T.T.A.B. 1980) (“the fact that one term, such as ‘electronic’, may be found which generally describes the goods of both parties is manifestly insufficient to establish that the goods are related in any meaningful way.”); *Harvey Hubbell, Inc. v. Tokyo Seimitsu Co.*, 188 U.S.P.Q. 517, 520 (T.T.A.B. 1975) (“In determining whether products are identical or similar, the inquiry should be whether they appeal to the same market, not whether they resemble each other physically or whether a word can be found to describe the goods of the parties.”); *Safeguard Business Systems, Inv. v. New England Business Systems*, 696 F. Supp. 1041 (E.D. Pa. 1988) (similarity in one, generalized aspect may not be enough if otherwise the goods are “plainly different things, different in size, shape concept, purpose, appearance, and price”). See also, e.g., *Electronic Data Systems Corp. v. EDSA Micro Corp.*, 23 U.S.P.Q. 2d 1460, 1461 (T.T.A.B. 1992) (rejecting “the view that a relationship exists between goods and services simply because each involves the use of computers”); *Hill, Inc. v. Comstock Partners, Inc.*, 743 F. Supp. 1029, 1034 (S.D.N.Y. 1990) (“while [both parties] furnish products related to the broad field of finance, [they] are as completely unrelated as night and day”). The section 2(d) refusal should therefore be withdrawn.

**C. Other Considerations Serve as Strong Evidence of No Likelihood of Consumer Confusion.**

Additional factors must be considered when testing for a likelihood of confusion under section 2(d). *In re E.I. DuPont de Nemours & Co.*, 476 F.2d 1357 (C.C.P.A. 1973); see also TMEP 1207.01. Several of these additional considerations include:



- (1) The similarity or dissimilarity of established, likely-to-continue trade channels;
- (2) The conditions under which and buyers to whom sales are made, i.e., “impulse” vs. careful, sophisticated purchasing;
- (3) The fame of the prior mark (sales, advertising, length of use);
- (4) The nature and extent of any actual confusion;
- (5) The length of time during and the conditions under which there has been concurrent use without evidence of actual confusion;
- (6) The variety of goods on which a mark is or is not used;
- (7) The market interface between applicant and the owner of a prior mark; and,
- (8) Any other established facts probative of the effect of use.

Several of these factors will be discussed below.

**(1) The Two Marks are Offered Using Very Different Trade Channels and to Very Different Customers**

In addition to the dissimilarity between the furniture products and manufacturing services offered by the Applicant and the industrial automation, interconnect and cabling products distributed by the *ALLIED ELECTRONICS* registrant, and the manufacturing services offered by the *ALLIED MACHINERY* registrant for its machining parts and casting, the refusal should be withdrawn because: (1) the Applicant and the registrants utilize very different and non-overlapping trade channels; and (2) there is no overlap of the Applicant's or the registrants customer bases. As stated in the amended recitation and discussed above, Applicant offers its goods and services under its mark to businesses, educational institutions and food service businesses looking to purchase desks, tables, chairs and other office-type of furniture. As explained on the Applicant's website, its furniture is sold through a network of office and furniture dealers and distributors:

Contact Allied Plastics Co. for a dealer near you at 1-800-999-0386 [Conformity](#) · [Order Tracking](#) · [FAQ](#)

**Allied**   *Top quality, custom crafted furniture since 1945*

Search By Model

[Home](#) [Furniture](#) · [Blog](#) [About Us](#) [Videos](#) [Find A Dealer](#) [Contact Us](#)

Allied Plastics Co. Inc., the Table Company headquartered in Jacksonville, Florida, manufactures tables, table tops and table legs for the school, office and food service industries. In business since 1945, and under third generation family ownership, Allied has served these industries by providing a wide range of top-of-the line, custom-crafted tables backed by superior customer service. Today, we sell our products through a diverse, non-exclusive network of distributors throughout the United States and internationally.



Allied's custom orders and ready-to-ship inventory includes a full range of school activity tables (pre-K through adult) as well as library tables, science tables, folding tables, computer tables and workstations, food service tables, conference tables, training tables and classroom furniture. And with Allied's full [30 year warranty](#) on all products, you can be sure that Allied is the clear choice for your school, office and food service table needs.

The *ALLIED ELECTRONICS* registrant is a distributor of industrial automation, interconnect and cabling products. It does not sell direct to consumer, and obviously does not sell or distribute those technical products and components to businesses, food service providers and educational institutions looking to purchase office furniture. Likewise, as explained above the *ALLIED MACHINERY* registrant provides a very specific type of “no bake” molding to produce finished castings in the field of agriculture, construction equipment, industrial equipment, power generation, power transmission and commercial refrigeration. These registrants offer their products in very distinct and separate product markets than the Applicant’s office and work furniture.

Businesses, educational institutions and food service providers will not encounter any of the registrant’s marks, products or services when they are looking to purchase or custom order the Applicant’s office and work furniture. They would not deal with the *APPLIED ELECTRONICS* registrant, who is a distributor of those industrial components. Likewise, purchasers of the *APPLIED MACHINERY* registrant’s casting manufacturing services will not encounter the Applicant’s marks or services, as machine and industrial manufacturing is a wholly unrelated field to office and work furniture.

Accordingly, the Applicant and the three registrants use entirely different trade channels to reach their customers. Sellers of the Applicant’s products and services do not sell those the products or services of the types listed in the registrations for *ALLIED MACHINERY* and *ALLIED ELECTRONICS*. Even assuming a limited number of Applicant’s customers were to seek the registrant’s goods or services, the Trademark Trial and Appeal Board has made clear that such a demonstration is still insufficient to find a legally sufficient overlap with the registrant’s customers to reach a finding of a likelihood of confusion. In *Borg-Warner Chem., Inc. v. Helena Chem. Co.*, the Board stated:

The board has found no likelihood of confusion even with respect to identical marks applied to goods and/or services used in a common industry where such goods and/or services are clearly different from each other and there is insufficient evidence to establish a reasonable basis for assuming that the respective goods as identified by the marks, would be encountered by the same purchasers.

225 U.S.P.Q. 222, 224 (T.T.A.B. 1983). The Examiner’s section 2(d) refusal should be withdrawn entirely on the basis of these two *DuPont* factors -- differing trade channels and types of consumers.

**(2) The Conditions Under Which, and Buyers to Whom Sales Are Made. I.e. “Impulse” vs. Careful, Sophisticated Purchasing and the Lack of Market Interface.**

The customers of the Applicant and of the three registrants are sophisticated purchasers. Purchasers of the Applicant’s products and services conduct a careful review and analysis of their furniture needs, including size, shape, colors, and coordination with interior design and work-flow. The Applicant’s furniture products cost hundreds and thousands of dollars. They are not impulse purchases or “grab and go” types of products or services. They also involve shipping and coordinate of delivery and, at times assembly. Consumers carefully focus upon the selection and qualification of their furniture suppliers. The three registrant’s also sell their products and services to sophisticated purchasers. Purchasers of the *ALLIED ELECTRONICS* registrant’s electrical components and purchasers of the *ALLIED MACHINERY* registrant’s machine shop manufacturing services closely consider qualifications of those businesses and the quality of their particular services. Those products and services are also shipped and delivered and involve a careful review of the purchaser’s requirements. Their products and services similarly can cost hundreds and thousands of dollars. These sophisticated consumers will not confuse the Applicant’s furniture products and manufacturing services with these other businesses. This factor alone supports withdrawal of the section 2(d) refusal. *See Perini Corp. v. Perini Constr., Inc.*, 915 F.2d 121, 122 (4th Cir. 1990) (ruling that the similarity of marks alone cannot be the basis of likelihood of confusion if the purchasers are highly sophisticated).

These facts and circumstances also demonstrate another *DuPont* consideration that favors the Applicant -- there is no market interface between the Applicant and these registrants’ products and services. Relevant consumers will not encounter the Applicants products and services in conjunction with any of the goods or services offered by any of the registrants. They are completely different businesses, selling completely different goods and services, to completely different groups of customers. For the reasons stated above, there is no likelihood of confusion. The Applicant’s and the registrants’ use of their marks can coexist in harmony in each of their respective service and product markets.

**(3) The Applicant’s ALLIED mark and the ALLIED ELECTRONICS marks have Peacefully Coexisted for Fifty Years.**

The Applicant and the ALLIED ELECTRONICS registrant have peacefully co-existed for more than 50 years. As stated in the Applicant’s application, it has made use of its applied-for ALLIED mark since 1968. The ALLIED ELECTRONICS marks have been in use since 1965. The Applicant is not aware of any actual confusion between the parties’ marks or products during this time. If actual confusion has not occurred over fifty years of co-existence, then a confusion is not likely. *See Nabisco v. PF Brands*, 191 F.3d 208, 228 (2d. Cir. 1999)(“The presence or absence of actual confusion can be highly effective in showing a high, or a low, likelihood of confusion if there has been ample opportunity for consumer confusion.”); *Cent. Soya Co. v. N. Am. Plant Breeders*, 212 U.S.P.Q. 37, 48 (TTAB 1981) (lack of actual confusion over a “reasonable” period of time significant).

**(4) The Term ALLIED is in Widespread Third Party Use With Manufacturing Services**


The term “ALLIED” is a relatively weak term because it is in widespread third party usage with manufacturing services. As a result, the term cannot be considered a dominant portion of the party’s mark and eliminates any likelihood of confusion. *See* TMEP § 1207.01(d)(iii) (explaining that third-party registrations are relevant to show that a portion of a mark is “so commonly used that the public will look to other elements to distinguish the source of the goods or services”). Evidence of third-party usage of this term falls under the sixth *DuPont* factor listed above – the “number and nature of similar marks in use on similar goods.” *DuPont*, 476 F.2d at 1361. If the evidence establishes that the consuming public is exposed to third-party use of similar marks on similar goods, it “is relevant to show that a mark is relatively weak and entitled to only a narrow scope of protection.” *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772*, 396 F.3d 1369, 1373-74 (Fed. Cir. 2005). Here, doing a quick Internet search, the Applicant has identified many uses of the term *ALLIED* in connection with manufacturing services:

| <b>Mark</b>                    | <b>Website</b>  |
|--------------------------------|---|
| Allied Manufacturers           | <a href="https://www.allied1.com/">https://www.allied1.com/</a>                                     |
| Allied Manufacturing Group LLC | <a href="http://www.allied-manufacturing-group.com/">http://www.allied-manufacturing-group.com/</a> |
| Allied Manufacturing           | <a href="https://alliedmfg.com/">https://alliedmfg.com/</a>   |

|                                  |   |
|----------------------------------|---|
| Allied Manufacturing Industry    | <a href="https://www.facebook.com/AlliedManufacturing/">https://www.facebook.com/AlliedManufacturing/</a>   |
| Allied Materials & Equipment Co. | <a href="https://www.alliedmaterials.com/">https://www.alliedmaterials.com/</a>   |
| Allied Machine & Engineering     | <a href="https://www.alliedmachine.com/INDUSTRIES.aspx">https://www.alliedmachine.com/INDUSTRIES.aspx</a>   |
| Allied Industries                | <a href="https://resourcecenter.org/services/manufacturing-services/">https://resourcecenter.org/services/manufacturing-services/</a>   |
| Allied Machine Products Corp.    | <a href="https://www.alliedmp.com/">https://www.alliedmp.com/</a>   |
| Allied Mechanical                | <a href="https://www.alliedmech.com/">https://www.alliedmech.com/</a>   |
| Allied Telesis                   | <a href="https://www.alliedtelesis.com/">https://www.alliedtelesis.com/</a>   |
| Allied Global Services           | <a href="https://www.alliedglobalservices.com/manufacturing-jobs">https://www.alliedglobalservices.com/manufacturing-jobs</a>   |
| Allied Industrial Sales          | <a href="http://alliedindustrialsales.com/fabrication/">http://alliedindustrialsales.com/fabrication/</a>   |
| Allied Moulded Products          | <a href="https://www.alliedmoulded.com/">https://www.alliedmoulded.com/</a>   |
| Allied PhotoChemical             | <a href="https://www.alliedphotochemical.com/">https://www.alliedphotochemical.com/</a>   |
| Allied Maker                     | <a href="https://www.alliedmaker.com/pages/about-new">https://www.alliedmaker.com/pages/about-new</a>   |
| Allied Mfg Tech., Inc.           | <a href="http://www.alliedmfgtech.com/">http://www.alliedmfgtech.com/</a>   |
| Allied Plastics, Inc.            | <a href="https://alliedplastics.com/">https://alliedplastics.com/</a>   |
| Allied Manufacturing Design      | <a href="https://www.mfg.com/discover/en/suppliers/Allied-Manufacturing-Design-WSI-Fabrication-1509953">https://www.mfg.com/discover/en/suppliers/Allied-Manufacturing-Design-WSI-Fabrication-1509953</a> |
| Allied Group Sales               | <a href="https://alliedgroupsales.com/">https://alliedgroupsales.com/</a>   |
| Allied Automation                | <a href="https://www.allied-automation.com/">https://www.allied-automation.com/</a>   |
| Allied Systems Company           | <a href="http://www.alliedsystems.com/about/about.htm">http://www.alliedsystems.com/about/about.htm</a>   |
| Allied Group                     | <a href="https://www.allied-group.com/template.php?rpage=company_profile&amp;l=en">https://www.allied-group.com/template.php?rpage=company_profile&amp;l=en</a>   |

Copies of printouts from each of this third party websites is attached hereto as Exhibit C. None of these websites are operated by the registrants/owners of the three registrations cited in the Office Action.

As further evidence of third party uses of the term ALLIED with manufacturing services, at least two registrations and two pending applications for registration with the United States Patent and Trademark Office also show use of this term with manufacturing services in Class 040:

| <b>Mark</b>   | <b>Reg. / App. #</b> | <b>Manufacturing Services in Class 040</b>   |
|---|----------------------|--|
|  | 4,379,696            | Contract manufacturing of general product lines in the field of bedding and apparel which contain feathers and down. |
| ALLIED RECREATION GROUP   | 4,605,582            | Custom manufacturing of motor homes.   |
| ALLIED SHIRTS   | 88/064,895           | Manufacturing of clothing to the order and specification of others.  |

|                |            |  |
|----------------|------------|--|
| ALLIED CONTROL | 88/475,414 | Rental of modular, portable, liquid cooling systems for electronic components and integrated circuits; rental of modular, portable computer data centers (modular installations); custom electronic and mechanical component manufacturing services for others; prototype fabrication of products for others |
|----------------|------------|--|

Copies of these registrations and applications are attached hereto as Exhibit D.

These third party websites, registrations and applications are evidence that a significant level of commercial manufacturing activity and services is occurring under each of these *ALLIED* marks for the goods and services recited in the respective registration certificates, thereby exposing consumers to the marks shown in the registrations. Notably, none of the cited third party uses make use of the mark *ALLIED* in connection with furniture manufacturing. This voluminous and significant evidence of third party usage shows that the term *ALLIED* is commercially weak when used in connection with manufacturing services. Consumers are likely to look to the other features of these respective marks to distinguish the source of the respective goods. *See First Savings Bank FSB v. First Bank Sys. Inc.*, 101 F.3d 645, 646 (10th Cir. 1996) (holding that when a mark is weak, “minor alterations may effectively negate any confusing similarity”); *Kenner Parker Toys, Inc. v. Rose Art Indus., Inc.*, 963 F.2d 350, 353 (Fed. Cir. 1992) (holding that, where a party uses a weak mark, his competitors may come closer to his mark than would be permitted with a strong mark); *Falcon Rice Mill, Inc. v. Community Rice Mill, Inc.*, 725 F.2d 336, 346 (5th Cir. 1984) (holding

**(5) The Two Marks Have Very Different Commercial Impressions, Connotations, Meanings and Appearances.**

Although the Applicant’s and the registrants’ marks contain the word “*ALLIED*”, the marks are different in connotation and commercial impression. Notably, the *ALLIED ELECTRONICS* mark contains the descriptive term “*ELECTRONICS*” to inform the consuming public that its “non-metal storage cabinets and drawers” are used in the field of electronics components, which is this registrant’s business. Likewise, the *ALLIED MACHINERY* mark contains the descriptive term “*MACHINERY*” to inform its consumers that it provides manufacturing services related to the casting metal as part of its machine shop services. The Applicant’s services are furniture for office, educational and food service purposes. Their consumers would recognize that the added terms “*ELECTRONICS*” and “*MACHINERY*”

indicate that those businesses do not offer any products or services related to the Applicant's therefore further reducing any likelihood of confusion among the marks. For these reasons, the Applicant's mark and the registrants' marks provide very different commercial impressions.

WHEREFORE, Applicant respectfully requests that the foregoing Application be amended to reflect the amendments set forth herein, the section 2(d) refusal be withdrawn, and the mark passed to an expedient allowance and registration.

Respectfully submitted,

/Richard S. Vermut/

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