

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

Applicant: Desert Rock Enterprises II, LLC  
Serial No.: 88/257,654  
Mark: **GARAGE MAHAL AT CIRCA**  
Class: 39  
Filed: January 10, 2019  
To: U.S. Patent and Trademark Office  
Attn: Rebecca Lee  
Trademark Examining Attorney  
Law Office 122  
[Rebecca.Lee1@uspto.gov](mailto:Rebecca.Lee1@uspto.gov)

**RESPONSE TO OFFICE ACTION**

In the Office Action dated March 30, 2019 (“Office Action”) concerning the pending trademark application for **GARAGE MAHAL AT CIRCA** the Examining Attorney refuses registration of this application for “Parking Garage Services” in Class 39 (“Application” or “Applicant’s Mark”) under Trademark Act Section 2d, based on a prior registration for GARAGE



MAHAUL SELF STORAGE for rental of garage spaces.<sup>1</sup> Due to the clear overall differences in the marks and the associated services, Applicant respectfully requests that this refusal be withdrawn.

**I. The Cited Registration is Different from Applicant’s Mark**

The Applicant’s mark for GARAGE MAHAL AT CIRCA must be viewed in its entirety and the presence of additional terms in both marks are critical in distinguishing the marks. *See*

---

<sup>1</sup> The Office Action also requests a disclaimer of “garage” which has been provided.

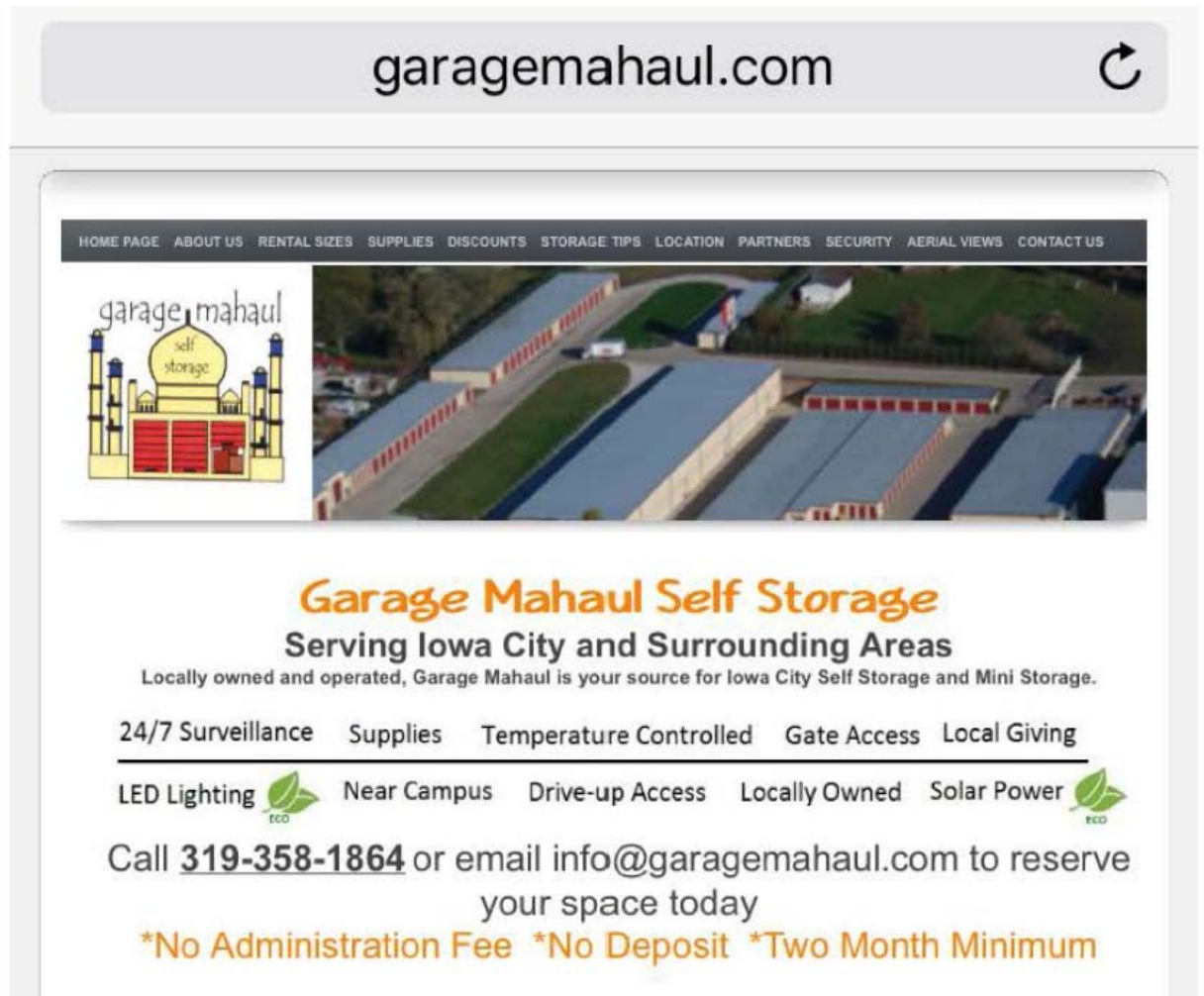
*Franklin Mint Corp. v. Master Mfg. Co.*, 667 F.2d 1005, 212 U.S.P.Q. 233 (C.C.P.A. 1981); *Massey Junior College, Inc. v. Fashion Institute of Technology*, 492 F.2d 1399, 1402, 181 USPQ 272, 273 (C.C.P.A. 1974) (“It is axiomatic that a mark should not be dissected and considered piecemeal; rather, it must be considered as a whole in determining likelihood of confusion.”). The cited registration for GARAGE MAHAUL SELF STORAGE contains a very distinct and



dominant design element , which helps convey the commercial impression that this mark is used in connection with rental storage units due to the incorporation of the bright orange doors on storage units in the center of the mark. Indeed, the misspelling of “Mahal” is necessary to this commercial impression as it is spelled MAHAUL in order to convey to consumers that this mark is associated with moving and storage (and “hauling”). Although disclaimed, the “self storage” portion of this mark likewise conveys to consumers that the services offered are self-storage services. These are dominant features that should not be overlooked when considering the marks.

There is no such commercial impression conveyed by Applicant’s Mark. Instead, the incorporation of the distinctive terms “At Circa” conveys that this parking garage is affiliated with the Circa casino, and provided for consumers visiting this location. These features should not be discarded just because there is a similar sounding term of “Mahal” in both marks (garage has been disclaimed from both marks). A mark must be considered in its entirety when determining a likelihood of confusion. *See J. THOMAS MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION* § 23:41 (4<sup>th</sup> ed. 2013) (“It is incorrect to compare marks by eliminating portions thereof and then simply comparing the residue.”)(*internal citations omitted*). There are very clear visual differences and commercial impressions conveyed by each mark.

Moreover, there are differences in the services offered under each mark. The cited registration is for self-storage services. The specimen submitted in support of the renewal of the cited mark demonstrates that the mark is used in connection with “self storage” and “mini storage;”, in the form of a rentable and contained storage unit, that are present in a row of drive-up units:



The screenshot shows the website for garagemahaul.com. At the top, the URL is displayed in a grey bar with a refresh icon on the right. Below the URL is a navigation menu with links: HOME PAGE, ABOUT US, RENTAL SIZES, SUPPLIES, DISCOUNTS, STORAGE TIPS, LOCATION, PARTNERS, SECURITY, AERIAL VIEWS, and CONTACT US. The main content area features a logo on the left that says "garage mahaul self storage" with a stylized illustration of a building. To the right of the logo is an aerial photograph of the storage facility. Below the images, the text reads: "Garage Mahaul Self Storage" in orange, "Serving Iowa City and Surrounding Areas" in black, and "Locally owned and operated, Garage Mahaul is your source for Iowa City Self Storage and Mini Storage." in black. A list of services follows: "24/7 Surveillance", "Supplies", "Temperature Controlled", "Gate Access", "Local Giving", "LED Lighting" (with an eco leaf icon), "Near Campus", "Drive-up Access", "Locally Owned", and "Solar Power" (with an eco leaf icon). The contact information is "Call 319-358-1864 or email info@garagemahaul.com to reserve your space today". At the bottom, three orange bullet points state: "\*No Administration Fee", "\*No Deposit", and "\*Two Month Minimum".

Users rent an individual storage unit for storage of boxes, furniture, etc. It is not a parking garage.



In contrast, Applicant's services are not for providing such storage units, but a public parking garage, that users can conveniently park in for events and later exit. It is not a storage garage, nor are there any units for storage, and mere overlap as a "garage" is not sufficient. *See Calypso Tech., Inc. v. Calypso Cap. Mgm't, LP*, 100 U.S.P.Q.2d 1213, 1222 (T.T.A.B. 2011) ("However, in order to find that goods and services are related, there must be more of a connection than that a single term . . . may be used to generally describe them.") (citing *In re W.W. Henry Co.*, 82 U.S.P.Q.2d 1213, 1215 (T.T.A.B. 2007) (it is not sufficient that a particular term may be found which may broadly describe the goods); *Gen. Elec. Co. v. Graham Magnetics Inc.*, 197 U.S.P.Q. 690, 694 (T.T.A.B. 1977) (it is, however, not enough to find one term that may generically describe the goods)); *In re Force Tech.*, 2009 WL 1896058, at \*5 (T.T.A.B. 2009) (not precedential).

The categorization as a "garage" service is not sufficient to conclude that the services are such that consumers would mistakenly believe that they emanate from the same source. Consumers are not likely to associate a rentable storage unit (where a contract, deposit and monthly payments are likely required) with a public automobile parking garage, where users may come and go at will (and without monthly payment obligations or a written contract). As the Federal Circuit made clear in *Electronic Design & Sales Inc. v. Electronic Data Systems Corp.*, it is error to deny registration simply because an applicant markets and sells its goods in one (or more) of the same generalized fields as those in which a registrant markets and sells its goods without also determining who are the relevant purchasers in instances of common institutional customers. 954 F.2d 713, 21 U.S.P.Q.2d 1388, 1391. Due to the very different nature of the services, Applicant respectfully requests that this refusal be withdrawn.

**1. Conclusion**

Based on the foregoing, Applicant respectfully requests that the Trademark Examining Attorney withdraw the refusal and allow the mark to publish in the Official Gazette of the U.S. Trademark Office.

Respectfully Submitted,

/Jenny Slocum/

---

Jenny T. Slocum  
**DICKINSON WRIGHT PLLC**  
1825 Eye St. N.W.; Suite 900  
Washington, D.C. 20006  
Counsel for Applicant

DC 51808-157 477575v1