

Applicant respectfully traverses the rejection of the present application over the cited references at least because (i) assuming *arguendo* that Applicant's services are related to the services in the cited registrations, the coexistence of multiple FORWARD marks in class 39 evidences that consumers of such services are not likely to be confused as to the source of services merely because two marks use the term FORWARD, and (ii) the services in at least two of the cited marks are not related or marketed in such a way that they would be encountered by the same persons in situations that would create the incorrect assumption that they originate from the same source as the services recited in the present application. For at least these reasons, Applicant respectfully requests that the rejection be withdrawn and the present application be permitted to pass to publication.

MULTIPLE COEXISTING FORWARD MARKS:

The mark of the present application includes the word FORWARD in addition to graphical elements, the combination of which creates a distinct commercial impression. As is stated in TMEP s. 1207.01(b)(iii), "[a]dditions or deletions to marks may be sufficient to avoid a likelihood of confusion if: (1) the marks in their entireties convey significantly different commercial impressions; or (2) the matter common to the marks is not likely to be perceived by purchasers as distinguishing source because it is merely descriptive or diluted." In the present rejection, the cited marks each contain additional matter (e.g. the words LUGGAGE, FREIGHT and RELOCATION) over and above the word FORWARD. The present application also includes additional matter over and above the word FORWARD in the nature of a graphical element that is entirely dissimilar to anything included in the cited registrations. That additional matter is entirely distinctive (as opposed to the descriptive or generic additions in the cited references). As such, the inclusion of the distinctive graphical elements combined with the word creates a significantly different commercial impression (element (1) of s. 1207.01(b)(iii)).

In addition, the Office Action has not established that the matter that is common (the word FORWARD alone) is likely to be perceived by purchasers as distinguishing source. Assuming *arguendo* that the services in the cited registrations are related to those of Applicant, Applicant notes that many marks that include FORWARD peacefully coexist in class 39. The three cited registrations are examples—each adds a descriptive word to FORWARD, each is owned by a different registrant, and all three peacefully coexist on the Primary Register for services that the Office Action asserts are related. In the present case, the subject mark does not distinguish itself with addition of merely a descriptive term. Instead, it distinguishes itself with addition of distinctive graphic elements.

Nor are these the only examples in class 39. Exhibit A attached hereto contains 25 registrations for services involving freight, delivery, or transportation services in class 39, all of which include the word FORWARD. Applicant respectfully argues that, where more than twenty prior registrations with the word FORWARD are permitted to coexist on the Primary Register, many distinguishing themselves with only the addition of descriptive or generic matter, it cannot be concluded that a likelihood of confusion exists with respect to the present application, which further distinguishes the word FORWARD with highly distinctive graphical elements.

Applicant further notes that when dealing with composite marks, such as in the present case, the comparison of the composite mark with prior-filed marks must be done on a case-by-case basis, and not based on mechanical rules. *See e.g. Spice Islands, Inc. v. Frank Tea & Spice Co.*, 184 USPQ 35 (C.C.P.A. 1974) (finding no confusion between SPICE TREE with tree design, for garlic powder and minced onion, and SPICE ISLANDS with and without tree design, for seasoning herbs and spices). The present mark, when considered as a whole (and not dissected into component parts) creates a different commercial impression than the cited word marks that share only a single word. Moreover, where the common word is used by multiple coexisting marks in the same class, several of those marks being distinguished from one another by only the addition of a single descriptive or generic term, it cannot be

argued that use of FORWARD alone would create a likelihood of confusion. When considered in that light, Applicant respectfully argues that the additional graphic material combined with the other differences in the present mark is sufficient to overcome any likelihood of confusion with respect to the cited filings.

DISSIMILARITY OF SERVICES:

The foregoing argument assumes, arguendo, that the services in the cited references are related. With respect to at least two of those references, however, that is not the case. In the case of the cited mark FORWARD RELOCATION the services described are clearly directed to moving, relocation and packing services. The services in the present application relate to “[t]ransportation and delivery services by air, road, rail and sea; warehousing; supply chain logistics and reverse logistics services, namely, storage, transportation and delivery of goods for others by air, rail, ship or truck; freight brokerage.” While it is true that moving and relocation involve transportation of goods, that does not mean that the services are related such that consumers would be likely to assume that the services provided by a moving and relocation company are from the same source as the services from a freight company. A “moving and relocation company” is hired by persons and entities wishing to move their furnishings and possessions from one location to another. The services in the present application do not refer to that type of moving, and the office action did not demonstrate that such services are typically marketed to the same consumers. Nor was any evidence provided that companies that provide relocation services also provide freight brokerage, supply chain logistics, and other services typically provided by a freight transportation company, as opposed to a moving company. Applicant respectfully argues, therefore, that the rejection has not properly established the relatedness of the services in this instance. Nor can the relatedness be established where it is self-evident that one set of services is directed to the moving and relocation industry and the other is directed to the freight industry.

Similarly, the class 39 services recited in mark FORWARD LUGGAGE refer to “equipment, baggage, and packages” and the mark itself refers to such items as “luggage.” As is shown in Exhibit B, the Merriam-Webster dictionary defines luggage as “suitcases for a traveler’s belongings.” Consistent with the term luggage, the Merriam-Webster dictionary defines “baggage” used in the description of services as “suitcases, trunks and personal belongings of travelers.” It further defines “package” as a “small or moderate-sized pack [or parcel].” These are consistent with the understanding that the services provided under the cited mark are services provided to consumers or businesses desiring to transport luggage and baggage of a specific traveler from one location to another, as opposed to commercial freight services. The use of the terms “package” and “equipment” should be understood in this context and not considered in isolation. As such, the services in this citation have not properly been established as being similar to the freight and logistic services recited in the present application. Nor could the relatedness be established where it is self-evident that one is directed to a traveler’s baggage, and the other is directed to the freight industry.

CONCLUSION:

For the foregoing reasons, Applicant respectfully argues that the Office Action has not established that consumers would likely assume that the services provided by Applicant and those provided by the owners of the cited registrations come from the same source. See TMEP s. 1207.01 (“The issue is not whether the respective marks themselves, or the goods or services offered under the marks, are likely to be confused but, rather, whether there is a likelihood of confusion as to the source or sponsorship of the goods or services because of the marks used thereon”). Nor could it have done so. As is demonstrated above, the services in at least two of the cited registrations are not related to those in the present application in a manner that would suggest consumers would identify those services as coming from the same source. Furthermore, with respect to all of the cited registrations, the only commonality is

the use of the word FORWARD, which is used in multiple filings in class 39 for transportation-related services. Assuming arguendo that consumers would see all such services as related, then the coexistence of such marks evidences that the addition of even descriptive material to the word FORWARD cures a likelihood of confusion. In the present case, however, the material added is distinctive and should likewise serve to cure any proposed likelihood of confusion even were the services shown to be related. Therefore, Applicant respectfully asks that the rejection be withdrawn and the application be permitted to pass to publication.

Should the Examining Attorney feel that further narrowing of the services in the present application to further emphasize the differences between Applicant's services and those of the cited registrations would facilitate allowance, Applicant invites the Examining Attorney to contact the undersigned to discuss any proposed amendment.