

The Office Action has initially refused registration of Applicant's Mark under Section 2(d) on grounds of an alleged likely confusion with the mark in U.S. Registration No. 3,690,711 for AXIS ("the Cited Mark").

For the reasons noted below, this potential refusal should be withdrawn.

I. THERE IS NO LIKELIHOOD OF CONFUSION

There is no "per se" rule regarding a finding of likely confusion. Rather, the facts in each case vary and the weight to be given to each relevant *du Pont* factor may be different in light of varying circumstances. *See, e.g., In re White Rock Distilleries, Inc.*, 92 USPQ.2d 1282, 1285 (TTAB 2009). For the reasons noted below, this refusal should be withdrawn.

If the services in question 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, then, even if the marks are identical, confusion is not likely. *See, e.g., Coach Servs., Inc. v. Triumphs Learning LLC*, 668 F.3d 1356, 1371, 101 USPQ.2d 1713, 1723 (Fed. Cir 2012). Thus, for example, in *Shen Mfg., Co. v. Ritz Hotel Ltd.*, 393 F. 3d 1238, 1244-45, 73 USPQ.2d 1350, 1356 (Fed. Cir. 2004), the Federal Circuit held that the contemporaneous use of RITZ for cooking and wine selection classes and the identical mark RITZ for kitchen textiles was not likely to cause confusion because the relatedness of the respective goods and services was not supported by substantial evidence. That both marks were used in the context of goods and services involved with kitchens, food, and cooking was not enough to support a finding of likely confusion. The same is true here.

A. The Marks Are Dissimilar.

The cited mark is AXIS (word). Applicant's mark is a particular design shown below:



As an initial matter, the marks look nothing alike. Applicant's mark includes a very distinctive design with the figure of a bridge and the word "AXIS" in stylized form below it. The Cited Mark is a plain word mark for "AXIS" - the two do not appear similar.

When comparing marks, the marks are to be considered in their entirety when being analyzed for likely confusion, and all relevant facts pertaining to sound, appearance and connotation must be considered. *Recot, Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ.2d 1894 (Fed. Cir. 2000). Similarity of marks in one respect -- sight, sound, or meaning -- will not automatically result in a determination that confusion is likely even if the goods are identical or closely related. *See In re Thor Tech., Inc.* 90 USPQ.2d 1634, 1635 (TTAB 2009).

B. The Goods / Services and Target Customers are Dissimilar

First, Applicant's services and the Cited Mark's services are different. Applicant's services are in Class 36 for:

- "Real estate services, namely, management of rental apartments to college students in buildings located in close proximity to a college campus; Housing property management services, namely, management of apartments; Real estate services, namely, rental property management; Real estate services, namely, property management services for renting apartments to students"

The Cited Mark's specific services are for:

- Class 35 for "Marketing services relating to commercial real estate, namely, on-line services featuring virtual tours and interactive brochures";
- Class 36 for "Providing interactive website featuring information via the internet in the field of building management and leasing; Providing a website featuring financial reports, growth and future analytics for real estate investment management; providing an interactive website for sharing information among brokers, tenants, managers and visitors regarding building data relating to real estate building management" and
- Class 39 for "Web-based computer services for providing secure storage of documents regarding real estate sales and leasing and building management, namely, electronic storage of files and documents; Electronic document

management system relating to real estate transactions, namely, electronic storage of files and documents”.

Applicant’s services are for “rental and management of property to **students**” and not related to “marketing ... in the field of building management and leasing” or “financial reports or computer services for providing secure storage of documents regarding real estate sales and leasing and building management.”

Applicant is oriented towards student living services in the field of housing. Applicant’s services are specialized to college students looking for spaces to live. Based on the above, Applicant respectfully requests the rejection be withdrawn.

C. The Markets and Channels of Trade are Dissimilar

Applicant’s marketing and customer acquisition channels are different from those of the Cited Mark as well. If the services in question 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, then even if they are identical, confusion is not likely. *See Shen Mfg. Co. v. Ritz Hotel Ltd.*, 393 F.3d 1244-45, 73 USPQ.2d 1350, 1356 (Fed. Cir. 2004) (emphasis added).

Here, the evidence demonstrates that Applicant’s and the Cited Mark’s respective services, are not marketed in a manner where they will be likely encountered by the same customers who would assume that they emanate from the same source. The price range of the services, the channels of trade for the services, the target customers for the services, and their functionality and purpose are different such that confusion is not likely to occur between them.

D. There has been No Actual Confusion Between the Marks

Applicant is not aware of any instances of actual confusion between its services and the Cited Mark’s services.

E. Other Third-Party Marks Help Show There is No Likelihood of Confusion

In a likelihood of confusion analysis, “[t]here is no question that third party use of similar marks is relevant.” *Chips ‘N Twigs, Inc. v. Chip-Chip, Ltd.*, 414 F. Supp. 1003, 1017 (E.D. Penn. 1976).

The TMEP states:


“During the examination of an application, the examining attorney should consider separately each registration found in a search of the marks registered in the Office that may bar registration of the applicant's mark under § 2(d). *If the examining attorney finds registrations that appear to be owned by more than one registrant, he or she should consider the extent to which dilution may indicate that there is no likelihood of confusion.*”

TMEP § 1207.01(d)(x) (emphasis added).

As recognized by the TTAB, TMEP, and the courts, when multiple trademark registrations exist for the same terms, owned by different parties, the registered terms do not enjoy as broad of protection. *See, e.g., Western Publishing. Co., Inc. v. Rose Art Industries, Inc.*, 910 F.2d 57 (2d Cir. 1990); *Time, Inc. v. Petersen Pub. Co. LLC*, 173 F.3d 113, 118 (2d Cir. 1999); McCarthy, Thomas J., MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION, Sections 11:85-86 (2009).

Even if the above was not enough, numerous third-party registrations further supports a finding of no likelihood of confusion.

As per the evidence attached shows (USPTO Records – Exhibits 1-5), the USPTO has allowed similar marks for related goods and services to co-exist and obtain Federal Registrations because the goods or services were considered to be distinguishable from one another. Other third-party AXIS (and variations) marks include:

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 - Reg. No. 4,145,241
 - Class 37 “Building construction and repair.”

- AXIS CONSTRUCTION
 - “CONSTRUCTION” disclaimed
 - Reg. No. 3,892,003
 - Class 37 “Building construction and repair.”

- **AXIS PARTS**
 - “PARTS” disclaimed
 - Reg. No. 5,502,128
 - Class 35 “On-line retail store services featuring replacement parts for vehicles and machinery use in **construction**, road building, mining and earth moving; On-line wholesale store services featuring replacement parts for vehicles and machinery use in **construction**, road building, mining and earth moving.” (Emphasis added)

- **AXIS DIMENSIONAL STONE**
 - “DIMENSIONAL STONE” disclaimed
 - Reg. No. 5,115,410
 - Class 19 “Natural stone; Non-precious stones for garden or ornamental use; Stone for **building and construction**.” (Emphasis added)

- **AXIS**
 - Reg. No. 4,896,161
 - Class 19 “Decorative glass for doors for **building** purposes.” (Emphasis added).

Based on the above, Applicant’s Mark and Applicant’s services are different enough to be distinguishable from the services of the Cited Mark. *See, e.g., In re Broadway Chicken Inc.*, 38 USPQ.2d 1559, 1565–66 (TTAB 1996) (“Evidence of widespread third-party use, in a particular field, of marks containing a certain shared term is competent to suggest that purchasers have been conditioned to look to the other elements of the marks as a means of distinguishing the source of goods or services in the field.”) Thus, there is no likelihood of confusion between Applicant’s Mark and the Cited Mark.

It is the Examiner’s burden to demonstrate with sufficient and credible evidence that Applicant’s Mark is likely to be confused with the Cited Mark, which has not occurred. Accordingly, for all of these reasons, it is respectfully requested that the prior registration citation be withdrawn.