

United States Patent and Trademark Office (USPTO)
Office Action (Official Letter) About Applicant's Trademark Application

U.S. Application Serial No. 88784645

Mark: EXTREME TOWING

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Reference/Docket No. N/A

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RESPONSE TO OFFICE ACTION

Applicant, by its counsel hereby timely responds to the office action dated below in red as follows, via the Trademark Electronic Application System (TEAS).

Issue date: **April 24, 2020**

Applicant hereby timely and completely responds to the issue(s) raised by examiner below. 15 U.S.C. §1062(b); 37 C.F.R. §§2.62(a), 2.65(a); TMEP §§711, 718.03.

ISSUES ADDRESSED COMPLETELY

- **Section 2(d) Refusal:**
 - **Evidence and Arguments Submitted**
- **Disclaimer Requirement:**
 - **DISCLAIMER ACCEPTED**
 - **No claim is made to the exclusive right to use “TOWING” apart from the mark as shown.**

- **Classification Requirement:**
 - **ELECTION OF IC 039 and IC 035;**
 - **EXPRESS CANCELLATION OF IC 037**
- **Identification Requirement**
 - **EXAMINER’S SUGGESTED LANGUAGE IS PERFECT AND ADOPTED VERBATIM**

REMARKS

Dear Examiner,

In the Office Action herein, Examining Attorney initially refused registration under 15 USC. § 1052(d) because there is purportedly a likelihood of confusion between Applicant’s Mark and Registrant’s Mark. In light the comments set forth below, Applicant respectfully requests that the 2(d) refusal should be removed, and the application proceed to the next step toward registration.

PRELIMINARY STATEMENTS: EXAMINER ERROR

Examiner error caused confusion that should be resolved in Applicant’s favor. Examiner made an affirmative statement that there were NO conflicts. But then proceeded to list two other marks.

Issue date: April 24, 2020

The referenced application has been reviewed by the assigned trademark examining attorney. Applicant must respond timely and completely to the issue(s) below. 15 U.S.C. §1062(b); 37 C.F.R. §§2.62(a), 2.65(a); TMEP §§711, 718.03.

EXAMINER STATES

SEARCH RESULTS. *The trademark examining attorney has searched the Office’s database of registered and pending marks and has found no conflicting marks that would bar registration under Trademark Act Section 2(d). TMEP §704.02; see 15 U.S.C. §1052(d).*

Nevertheless, the issues of confusion are addressed below.

THERE IS NO REASONABLE LIKELIHOOD OF CONFUSION

REFUSAL - SECTION 2(D) – LIKELIHOOD OF CONFUSION: *Registration of the applied-for mark is refused because of a likelihood of confusion with the marks in U.S.*

Registration Nos. 3942818 (XTREME PROTECTION PLAN for “emergency roadside assistance services, namely, responding to calls for roadside assistance, flat tire changing, emergency fuel supplying, and battery jump starting”) and

Registration Nos. 3942819 (XTREME PROTECTION PLAN for “emergency roadside assistance services, namely, responding to calls for...

PROSECUTION HISTORY DEFINES INTENT: REGISTRANT'S SCOPE

Examiner raises US Registration Number: 3942818 for Mark: XTREME PROTECTION PLAN to lead to a likelihood of confusion, to ALL of Applicant's selected international classes. This is improper. There should have been only a partial likelihood of confusion, since not all the categories in Registrants Mark are in conflict with all of Applicant's mark.

The procedural history of US Registration Number: 3942818 shows that Registrant received an office action. In their office action dated 05/19/2010, (attached) the examiner split up their goods and services description into four different categories, and suggested election, or payment of the relevant categories. Namely, IC 036, IC 037, IC 039, IC 045.

By this express cancellation of IC 039, and IC 045 when examiner stated the specimens were satisfactory, that is proof that Registrant severed all claim to those services. Registrant expressly abandons classes IC 039, and IC 045.

On 11/19/2010, Registrant filed a Response to Office Action. (attached). In this response and to obviate the rejection, and by failing to pay for all the classes Registrant Only Elected IC 036, and IC 037 (ROA). The Registrant failed or refused to register the remaining categories even though the other two categories were offered by the examiner, and furthermore, the examiner stated that Registrant had a satisfactory specimen to support all the categories listed including the ones Registrant decided to reject. Clearly then, Registrants intent is undeniable, the examiner says you can have four categories, the specimen allows it, and the Registrant cuts out two categories. On the four corners of this document, Registrant must not be afforded any protection for IC 039, nor 045, because the record clearly shows that it was an intentional rejection of those categories.

REGISTRANT'S '818 OFFICE ACTION RESPONSE **REGISTRANT'S 'EXPRESS CANCELLATION IC 039, and 045**

Therefore Applicant's mark in IC 039, and IC 045 should not be analyzed in the abstract, or in the theoretical way, that they may pose some similarity in commerce. No, the Registrant is afforded the rights inside the application, when the real facts are shown by performance, then that is controlling, the Office Action Response is given more weight than a general unsubstantiated claim that all these categories must all conflict with each other. Not in this case the record should be afforded more weight, the test for likelihood of confusion should be focused on the economic impact of the prior Registrant, by virtue of express cancellation of those classes, they should be afforded no protection in IC 039, AND IC 045.

Registrant's mark has an Express Rejection of IC 039, and IC 045 done by Registrant, this should be resolved. Applicant's favor as the express intent of the Registrant. Applicant's mark in IC 039, and IC 045 should not be analyzed in the abstract, or in the theoretical way, that they may pose some similarity in commerce. No, the Registrant is afforded the rights inside the application, when the real facts are shown by performance, then that is controlling, the Office Action Response is given more weight than a general unsubstantiated claim that all these categories must all conflict with each other. Not in this case the record

should be afforded more weight, the test for likelihood of confusion should be focused on the economic impact of the prior Registrant, by virtue of express cancellation of those classes, they should be afforded no protection in IC 039, AND IC 045.

By the amendment requested herein, Applicant has accepted the suggestions of the Examining Attorney for Classes 36 and 37, and appreciates the assistance of the Examiner in this regard. Applicant has not added Classes 39 and 45 to the application, and in view of the acceptance of the Examiner's suggested recitation, it is respectfully submitted the recitation, as amended, should be acceptable for purposes of publication.

Applicant may adopt the following identification, if accurate.

Class 36: Providing extended warranties on motor vehicles; insurance services, namely, underwriting, issuing and administration of motor vehicle service plans covering mechanical breakdown and repair, emergency roadside assistance and trip interruption insurance.

Class 37: Emergency roadside assistance services, namely, responding to calls for roadside assistance, flat tire changing, emergency fuel supplying, and battery jump starting.

Class 39: Emergency roadside assistance services, namely, towing, winch-out and key delivery services.

Class 45: Emergency roadside assistance services, namely, opening of locks.

APPLICANT'S GOODS AS AMENDED – OBVIATE ALL CONFLICTS

To obviate all issues addressed above, we expressly delete a category 037. Leaving only the categories that Registrant Expressly Carved out and rejected in the office action response. Applicant adopts the following suggested language verbatim..

DELETE:

Emergency roadside assistance services, namely, flat tire changing and battery jump starting; emergency roadside assistance services, namely, responding to calls for roadside assistance, flat tire changing, emergency fuel supplying, battery jump starting, and emergency road side repair services; emergency roadside assistance services, namely, responding to calls for roadside assistance, flat tire changing, emergency fuel supplying, and battery jump starting (Class 037)

Car and heavy truck towing; roadside and recovery, **namely, vehicle towing**; commercial truck towing and recovery, **namely, vehicle towing**; heavy duty and off road recovery, **namely, vehicle towing**; equipment hauling, **namely, transport of equipment**; 24hr emergency **vehicle towing**; exotic car towing and transport; accident **vehicle towing**; remove abandoned and improperly stored vehicles, **namely, vehicle towing**; remove vehicles not in compliance with management lease requirements, **namely, vehicle towing**; police towing, **namely, vehicle towing**; local towing, **namely, vehicle towing**; car loading, **namely, vehicle towing**; donation car towing; flatbed towing, **namely, vehicle towing**; transport towing, **namely, vehicle towing**; wheel lift towing, **namely, vehicle towing**; show car towing and hauling; 24hr towing, **namely, vehicle towing**; motorcycle towing; fuel delivery; water recovery, **namely, boat towing services**; 4x4 off road recovery, **namely, vehicle towing**; **emergency roadside assistance services in the nature**

of winching and up-righting, **namely, winch-out**; off-road recovery, **namely, vehicle towing**; box truck towing; delivery truck towing; utility trucks towing; work truck towing; school bus towing; dump truck towing; construction equipment towing; fire truck towing; straight truck towing; airplane towing; semi-truck recovery, **namely, vehicle towing**; tractor-trailer recovery, **namely, vehicle towing**; mud recovery, **namely, vehicle towing**; beach recovery, **namely, vehicle towing**; construction equipment recovery, **namely, towing of construction equipment**; dump truck recovery; fork lift recovery, **namely, towing**; bus and motor coach recovery, **namely, vehicle towing**; semi-truck uprighting, **namely, emergency roadside assistance services in the nature of winch-out services**; tractor recovery, **namely, towing**; semi-truck accident cleanup, **namely, transport of semi-trucks involved in accidents**; semi-trailer storage; medium duty truck recovery, **namely, vehicle towing**; semi-truck and cargo cleanup, **namely, transport of semi-trucks and cargo involved in accidents**; diesel fuel delivery; trailer storage; cargo hauling, **namely, transport of cargo**; towing of machinery, **namely, boats, scissor lifts, man lifts, fork lifts, pallet jacks, skid steers, bobcat tractors, farm equipment, forklifts, small planes, play houses, sheds, swing sets**; towing services, **namely, vehicle towing**; emergency roadside assistance services, **namely, towing, winch-out and key delivery services**; **vehicle towing, namely, vehicle breakdown towing assistance**; emergency road side repair services; vehicle breakdown towing services (Class 039)

Emergency roadside assistance services, namely, opening of locks (Class 045)

SERVICES NOT COMPETITIVE IT IS ILLEGAL LOCK PICK OR TOW W/O LICENSE & INSURANCE

Here, Registrant is prohibited by law from opening locks, so it is noncompetitive with Applicant's services in IC 045. Without a license, lockpicks are illegal in California. (Web evidence attached). So there is a different stream of commerce, non-competitive commercially. Registrant neither has the license nor the service of lock picking. And they EXPRESSLY REJECTED the addition of Class 45: "Emergency roadside assistance services, namely, opening of locks." In the office action dated ISSUE/MAILING DATE: 5/19/2010. So they rejected protection, they do not provide lock pick services. It is incorrect to state that these services are related, because only licensed lock pickers can do so legally. Furthermore, because Registrant cut out category 045 it is only proper to accept them by course of performance that they affirmatively relinquish all right to 045. It would be wholly improper then to give them any rights in 045, on the basis of a general idea that both the Application and the Registration are somewhat related with Cars.

Examiner is incorrect in making a conclusory statement that the services are related. They are not related. Towing, which is what applicant does, requires a special license which Registrant does not possess. The Registrant is only coming to the car, and putting gas, jump starting, and flat tires. They neither have the license nor capability of towing. That is night and day. They do not have a towed car lot, they cannot pick up a car.

Furthermore the fact that Registrant was given the opportunity to add IC - 039 but affirmatively failed to do so, means that Registrant intentionally relinquished all right to IC 039. It is not a services they provide. So even though it may be sometimes relevant to assume that services are related. In this case we have facts that Towing a Car, and going to Put Gas in a Car are different.

Examiner correctly cites the relevant section, but fails to apply it properly. NOT ONE PENNY belongs to Registrant that is made by Applicant by providing Towing Services in IC 039. Therefore they are not competitive. Also, Registrant cut out 039 from their description, so should be afforded no protection in that Class.

All of Registrants services are expressly limited to providing services on the side of the road. The assumption that the services are related is fiction. A tow truck requires a very expensive pulley system WINCH, TOWING FORK and BOOM SUPPORT. (Image Attached). Registrant has none of these, they require different driver's license to provide these services, safety licenses, safety training, and can NOT be operated by any of Registrant's employees, because they don't have any tow trucks. Registrant's use case is to drive up to a car on the side of a road, with minimal equipment, a 5 Gallon Jug of Gasoline, Jumper Cables, A Car Jack to raise the car, and a wrench to take of a tire. This is usually done in a van or regular pick up truck. Registrant's employees then drive away and leave the motorist to drive home on their own. They do not take the car with them to an impound lot, or to a mechanic.

LIMITING DISCLAIMER IN REGISTRANT'S MARK TO HELP ON THE ROAD SIDE CALLS, FLAT TIRES, FUEL, AND BATTERY, NOT IN A GARAGE OR IMPOUND

The marks are not commercially competitive. You have to look at the applications as the scope. A tow truck can pick up a Car, Registrant does not own a tow truck. They can barely provide any services at all. Furthermore, Registrant's mark is limited to "ROADSIDE" assistance, so by the very nature this would not include moving the car away from the road. So they are logically incompatible.

Registrant cannot legally use their mark in commerce because they fail to have the license to carry heavy machinery like a tow truck. They also lack the license of lock picking, other wise they would have paid for that category. The similarities must be taken from the categories inside the applications, but even if looking at third party website information, Registrant is an insurance company, not a tow truck company. And they travel in different streams of commerce, market differently, they offer completely different services also.

Applicant's mark as amended by this Office Action Response, affirmatively deletes Category 037. Registrant only has 036 for insurance and financial services which are irrelevant. And 037, for limited on the road assistance. By eliminating Applicant's 037, there are no services left that travel in the same channel of trade.

Registrant can NOT provide towing services, they don't have a tow truck, they bring a bucket of Gas and a car Jack. A tow truck requires special licenses, special insurance to provide this service. If registrant would have paid for all those fees and buying a tow truck which is often \$80,000 they would have added the category for \$350. By their course of performance, they have no claim to tow truck services. Thus the differences are distinct, separate, severed, and just because they both have cars, someone picking up and moving your car is a completely different services that someone adding gas to your car and driving away. No reasonable person would be confused.

PRIMACY AS IS STRONGEST INDICATOR OF SOURCE

The first word or letter, or a different spelling of first word causes a striking undeniable different commercial impression.

Consumers are generally more inclined to focus on the first word, prefix, or syllable in any trademark or service mark. See *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 1372, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005) (“VEUVE . . . remains a ‘prominent feature’ as the first word in the mark and the first word to appear on the label”); *In re Integrated Embedded*, 120 USPQ2d 1504, 1513 (TTAB 2016) (“[T]he dominance of BARR in [a]pplicant’s mark BARR GROUP is reinforced by its location as the first word in the mark.”); *Presto Prods., Inc. v. Nice-Pak Prods., Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) (“it is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered” when making purchasing decisions).

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Here, XTREME and EXTREME are already sufficiently different, because one is a fun modern spelling, the other is the basic spelling. Just like primacy where the first word is source identifying, the first letter jumps out at a prospective motorist. If one were to see both, no- reasonable human being would think they are the same company. XTREME has a connotation of the X-GAMES, or youthful extreme sports. The other is an older spelling. This may lead to a different level of sophistication between would be customers. But that’s not all - PROTECTION PLAN does not have a phonetic equivalent with TOWING, they have different letters 4 vs 2 syllables, start with a P and a T respectively. Dissecting the application to it’s component parts, even if disclaimed matter, is improper and the whole marks must be considered. To that effect, there are no words that are shared, even EXTREME vs XTREME is sufficiently different to obviate the conflict. (XTREME SPORTS EVIDENCE INCLUDED)

APPLICANT’S MARK IS DISSIMILAR IN SIGHT SOUND & MEANING

It is well-settled that merely because two marks contain a similar or identical term, this does not establish a likelihood of confusion. E.g., *Republic Steel Corp. v. M.P.H. Mfg. Corp, Inc.*, 136 U.S.P.Q. 447, 449 (C.C.P.A. 1963) (reversing the likelihood of confusion finding of the Trademark Trial and Appeal Board (the “Board”), and holding that TRUSS-SKIN and TRUSCON were “strikingly dissimilar in appearance” and that “normal or casual pronunciation would distinctly emphasize a difference in sound”) (emphasis added); *Sleepmaster Prod. Co. v. Am. Auto-Felt Corp*, 241 F.2d 738 (C.C.P.A. 1957) (finding the mark SURF not confusingly similar to SURGE for detergents); *7—Eleven, Inc. v. Lawrence I. Wechsler*, 83 U.S.P.Q.2d 1715 (T.T.A.B. 2007) (finding the marks GULP for soda beverages not confusingly similar to GULPY for a water dish for pets); *Fuji Jyukogyo Kabushiki Kaisha v. Toyota Jidosha Kabushiki Kaisha*, 228 U.S.P.Q. 672, 674 (T.T.A.B. 1985) (finding no likelihood of confusion between the marks SUPRA and SUBARU); *In re Surf Line Hawaii, Ltd*, 183 U.S.P.Q. 757 (T.T.A.B. 1975) (finding no likelihood of confusion between the mark THE BODYSURFER for men’s swimming suits, and the marks SURFER and SURFERS (owned by the same registrant) for men’s, women’s, and children’s swimming suits); *In re Pelvic Anchor Corp*, 166 U.S.P.Q. 217 (T.T.A.B. 1970), (finding no likelihood of confusion between the marks ANCHOR and PELVIC ANCHOR, both for medical and surgical supplies, appliances and

equipment); *In re Variety Supply Co.*, 143 USPQ. 367, 368 (T.T.A.B. 1964), (no likelihood of confusion between the marks GAY CHARM and CHARM, both for identical types of women's undergarments).

Applicant notes the Board has long recognized that extrinsic evidence is permitted to determine the nature of the mark or the services. See *In re The W. W. Henry Co., L.P.*, 82 U.S.P.Q.2d 1213, 1215, Ser. No. 78/401,595 (T.T.A.B. January 19, 2007); *In re Trackmobile Inc.*, 15 U.S.P.Q.2d 1152 (T.T.A.B. 1990). Thus, based on the meaning of the terms of Applicant's Mark and the Cited Mark consumers would readily distinguish the differences between the marks. Accordingly, Applicant the Office Action should be lifted as these marks are distinguished substantially in their respective meanings. And there is no likelihood of confusion.

DISSIMILAR COMMERCIAL IMPRESSION – “XTREME SPORTS”

Examiner only looks at the first word, and avoids the other words completely, or the spelling of the first word. Thus the commercial impression is not addressed. Specifically, when the marks are compared in their entirety, it is apparent they proffer distinctive commercial impressions.

It is **established in legal precedent** that in making a determination of likelihood of confusion, marks must be compared in their **entireties** and should not be dissected and their parts compared separately. See *Estate of P.D. Beckwith, Inc. v. Comm. of Patents*, 252 U.S. 538 (1920) (the commercial impression of a composite mark is derived from the mark as a whole, not its separate elements). In fact, it has been held that it is a violation of the anti-dissection rule to ignore elements of a mark in deciding whether confusion is likely. *Franklin Mint Corp. v. Master Mfg. Co.*, 667 F.2d 1005, 1007 (C.C.P.A. 1981).

In other words, splitting a mark into its various components and comparing only certain portions of one mark with another mark is not proper. *Massey Junior College, Inc. v. Fashion Institute of Technology*, 492 F.2d 1399, 181 U.S.P.Q. 272 (C.C.P.A. 1974). Thus, a **proper** comparison of Applicant's Mark to the Cited Mark shows that the marks are quite dissimilar in sound, meaning, connotation, overall appearance and commercial impression.

Here, Examiner makes a conclusory statement without fact or justification that the marks are equivalents. Marks are compared in their entirety for similarities in appearance, sound, connotation, and commercial impression. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 1321, 110 USPQ2d 1157, 1160 (Fed. Cir. 2014)

Also Here, Examiner failed to examine the marks in their entirety. EXTREME versus XTREME, the first letter is very telling, is usually given the most weight. It is highly unlikely that a prospective motorist would think they are the same, and it is extremely unlikely that a brand that has already achieved incontestability since 2010, would change the spelling of their company by Omitting the leading E.

Lastly, Herein, Examiner also fails to look at the marks in the entirety. The analysis stops at the first word. Even disclaimed words must be included in a likelihood of confusion analysis. So the words PROTECTION PLAN not only are four syllables, have alliteration, and suggest the primary services Registrant provides, namely INSURANCE in IC 036. PROTECTION PLAN also are 13 ASCII characters long that are different from Applicant's mark. The word TOWING even if disclaimed is relevant to analyzing the marks in their entirety. No one reasonable would confuse the words TOWING two syllables, with PROTECTION PLAN four syllables. They also don't sound the same, they also do not

have the same meaning. Towing is moving, Protection Plan is insurance financial assistance and gasoline delivery.

EXAMINER LOOKS AT ONE ELEMENT THE PHONETICS OF THE FIRST WORD, BUT IGNORES THE SPELLING, THE DIFFERENT FIRST LETTER, THE WORDS AFTER EXTREME, NO ELEMENT OF THE MARK SHOULD BE IGNORED EVEN IF IT WERE TO BE DISCLAIMED THE TOTALITY OF THE MARKS MUST BE ANALYZED

It is held that, “no element of a mark is ignored simply because it is less dominant, or would not have trademark significance if used alone.” *In re Electrolytes Laboratories, Inc.*, 913 F.2d. 930, 16 U.S.P.Q.2d 1239 (Fed. Cir. 1990), corrected 929 F.2d 645 (Fed. Cir. 1990) (holding no likelihood of confusion between the marks K+ (Stylized) and K+EFF (Stylized) both for a dietary potassium supplement). When Applicant’s Mark and the Cited Mark are properly considered in their entireties, they are dissimilar in overall appearance. See *Little Caesar Enters., Inc. v. Pizza Caesar, Inc.*, 834 F.2d 568, 571 (6th Cir. 1987) (holding that, despite prominent component shared by PIZZA CAESAR USA and LITTLE CAESARS, that differences in sound and appearance made them dissimilar).

In fact, as noted above, merely because two marks contain a similar term, this does not establish that there is a likelihood of confusion. For example, in *In re Johnson & Johnson*, 2002 WL 649081 (T.T.A.B. 2002), the Board reversed the Examining Attorney's refusal to register the mark EPIC MICROVISION for a medical device despite the existence of a prior registration for the mark EPIC also for a medical device. In *Fleetwood Co. v. Mende*, 132 U.S.P.Q. 458 (C.C.P.A. 1962), the Court of Customs and Patent Appeals (“CCPA”) affirmed the Board's dismissal of a Petition for Cancellation of the mark TINT ‘N SET for hair care preparations brought by the owner of the registration for the mark TINTZ, also for hair care preparations. *Id.*, at 459. In reaching its conclusion, the CCPA reasoned that merely because both marks contained the term TINT and were used on virtually identical goods, there was no likelihood of confusion. *Id.* In *Pacquin-Lester Co. v. Charmaceuticals, Inc.*, 179 U.S.P.Q. 45 (C.C.P.A. 1973), the CCPA affirmed the Board’s finding of no likelihood of confusion with respect to the marks SILK and SILK ‘N SATIN, despite the fact that the latter mark encompassed the former, for “face cream” and “beauty lotion for hands and skin and bath oil,” respectively. Similarly, in *Standard Brands Inc. v. Peters*, 191 U.S.P.Q. 168 (T.T.A.B. 1975), the Board found no likelihood of confusion between the applicant's mark CORN-ROYAL for “butter and margarine” and the opposer’s mark ROYAL for “liquid frying shortening.”

In addition, in *In re TSI Brands, Inc.*, the Board reversed the Examining Attorney’s refusal to register the mark AK AMERICAN KHAKIS in Application Serial No. 75/615,925 (the “’925 Application”) for “pants, jeans, shorts and shirts” in light of prior registrations for the mark “AK and Design” for “sweaters, jerseys, shirts, tops, undershirts, pants, hosiery, jackets, ski pants, ski jackets, ski suits, tops.” The Board determined that the marks proffered distinguishable commercial impressions. Applicant notes that the ’925 Application proceeded to registration and was assigned Trademark Registration No. 2,802,613. In the case, *Giorgio Beverly Hills Inc. V. Revlon Consumer Products Corp*, 33 U.S.P.Q.2d 1465, 1469 (S.D.N.Y. 1994), the court found that there was no likelihood of confusion between “RED” and “CHARLIE RED,” both for perfume. Likewise, in *Bell Laboratories, Inc. v. Colonial Products, Inc.*, 231 U.S.P.Q. 569, 571-572 (S.D. Fla. 1986), the court found no confusion between “FINAL” and “FINAL FLIP,” both for rodenticides.

In *Republic Steel Corp. v. M.P.H. Mfg. Corp., Inc.*, 136 U.S.P.Q. 447, 449 (C.C.P.A. 1963), the CCPA reversed a Board finding of likelihood of confusion with respect to the marks TRUSS- SKIN and TRUSCON. In reversing the Board's decision, the CCPA stated that the marks were “strikingly dissimilar in appearance” and that “normal or casual pronunciation would distinctly emphasize a difference in sound.” Likewise, in *Fuji Jyukogyo Kabushiki Kaisha v. Toyota Jidosha Kabushiki Kaisha*, 228 U.S.P.Q. 672, 674 (T.T.A.B. 1985), the Board found no likelihood of confusion between the marks “SUPRA” and “SUBARU.” In *In re Surf Line Hawaii, Ltd*, 183 U.S.P.Q. 757 (T.T.A.B. 1975), the Board found no likelihood of confusion between the mark “THE BODYSURFER” for men’s swimming suits, and the marks “SURFER” and “SURFERS” (owned by the same registrant) for men’s, women’s, and children’s swimming suits.

In the recent Board decision, *Syndicat Des Proprietaires Viticulteurs De Chateauneuf-Du-Pape v. Pasquier DesVignes*, 107 U.S.P.Q.2d 1930 (T.T.A.B. 2013), the Board found no likelihood of confusion between the mark CHEMIN DES PAPES and the mark , both for wines. The Board noted that more dominant features will, of course, weigh heavier in the overall impression of a mark, citing *In re Electrolyte Laboratories, Inc.*, 929 F.2d 645, 647, 16 USPS 22d 1239 1240 (Fed. Cir. 1990). The Board went on to say that there is no general rule as to whether letters or design will dominate in composite marks. In light of this, the Board found that the opposer’s registered mark was dominated by the design elements in the mark and that it was likely to be remembered by the design element instead of the literal portion. In fact, the Board held that as “the design is prominently displayed in the center of the mark, is proportionally larger than the wording, and is very distinctive,” there was no likelihood of confusion. The Board also noted that the applicant provided evidence of use of marks containing the term PAPES by third parties and that this evidence supports the conclusion that the common element of both marks was weak.

Here splitting a mark into its various components and comparing only certain portions of one mark with another mark is not proper. *Massey Junior College, Inc. v. Fashion Institute of Technology*, 492 F.2d 1399, 181 U.S.P.Q. 272 (C.C.P.A. 1974). Thus, a proper comparison of Applicant's Mark to the Cited Mark shows that the marks are quite dissimilar in sound, meaning, connotation, overall appearance and commercial impression.

PRAYER FOR RELIEF FROM EXAMINER

Applicant submits that our mark is painfully obvious a double entendre, and has a different appearance, sound and meaning, and overall commercial impression.

There is no reasonable likelihood of confusion here, there is at most merely theoretical, and token likelihoods of confusion, are repugnant to the purpose of a Section 2(D) refusal, to protect the commercial interests of the Registered mark.

Here, as amended none of Applicant's services will affect one penny of Registrant's services because they don't own a \$70-100K tow truck or licenses, nor lock picking license, and insurance. These are NOT competitive; they just have cars. By that token car sales would be the same as car insurance, would be the same as car washes. No, Car insurance, and putting gas in a car or tire or jumper cables, is distinct from what is in the record. The focus must be in the record, and the categories in Applicant's mark are commercially distinct from Registrants.

The Federal Circuit declared in a relevant ruling, "We are not concerned with mere theoretical possibilities of confusion, deception, or mistake or with de minimis situations but with the practicalities of the commercial world, with which the trademark laws deal." *Elec. Design & Sales Inc. V. Elec. Data Sys. Corp*, 954 F.2d 713, 718 (Fed. Cir. 1992) (citing *Witco Chem. Co. v. Whitfield Chem. Co., Inc.*, 418 F.2d 1403, 1405 (C.C.P.A 1969)) (emphasis added). Accordingly, the refusal to register should be withdrawn.

If there are any remaining issues to be resolved, Applicant requests that the Examining Attorney contact the undersigned.

Respectfully submitted,

Very truly yours,
Law Office of Michael O'Brien

/Michael O'Brien /

Michael O'Brien
Registered Patent Attorney
Law License CA, DC, USPTO

Enclosures