

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: New Flyer Industries Canada ULC
Mark: OPTIMA
Serial No.: 87657585
Law Office: 104
Examining Attorney: O'ROURKE, Jonathan

VIA ELECTRONIC FILING

Commissioner for Trademarks
P.O. Box 1451
Alexandria, V.A. 22313-1451

RESPONSE TO OFFICE ACTION

This paper is filed in response to the Office Action issued in this Application 4 May 2020.

The Examining Attorney has identified the following concerns as grounds for provisional refusal:

- Likelihood of Confusion (Section 2(d))
 - US Reg. 5407874
 - US Regs. 2646948, 2997153, 5261549, 5261560
- Ownership of claimed registration
- Specimen refusal pertaining to classes 39 and 41

Applicant responds as follows to each of the issues.

AMENDMENT

Please delete the goods in classes 39 and 41 from the application.

LIKELIHOOD OF CONFUSION (Section 2(d)), in view of US Reg. No. 5407874

The Examining Attorney has raised a concern for likelihood of confusion under Lanham Act Section 2(d), in view of US Reg. No. 5407874 for Optimas Solutions, with respect to Class 39 only. Applicant respectfully disagrees that the marks are confusingly similar – it is clear that the mark ‘Optimas Solutions,’ taken as a whole in connection with nuts, bolts, and screw, is not likely to be confused with OPTIMA, which looks and sounds different, when used in connection with vehicle parts.

In the interest of advancing the application, however, Applicant has deleted the class 39 claim from the application, without prejudice.

LIKELIHOOD OF CONFUSION (Section 2(d)), in view of US Regs. 2646948, 2997153, 5261549, 5261560

The Examining Attorney has continued a rejection for likelihood of confusion under Lanham Act Section 2(d), in view of US Regs. 2646948, 2997153, 5261549, 5261560 for Optimas Solutions, again with respect to Class 39 only. Applicant respectfully disagrees that the marks are confusingly similar. In the interest of advancing the application, however, Applicant has deleted the class 39 claim from the application, without prejudice. Applicant believes that this obviates the Examining Attorney’s concern and places the application in condition for Registration.

OWNERSHIP OF CLAIMED REGISTRATION

Applicant’s undersigned attorney of record hereby certifies that Applicant is owner of US Registration 2997153. Applicant thanks the Examining Attorney for his very clear explanation of the parallel online process of making this certification.

SPECIMENS

The Examining Attorney has raised concerns regarding the specimens in Classes 39 and 41. By this paper Applicant has deleted classes 39 and 41 from the application. Applicant believes that this obviates the Examining Attorney's concern and places the application in condition for Registration.

CONCLUSION

Applicant believes that it has responded to all grounds of concern raised by the Examining Attorney, and that the Application is in condition for registration.

Applicant believes that no fee is due in connection with the response. If the Office determines that any such fee is due, the Office is requested to charge such fee to its Attorney's Deposit Account No. 041061, and to provide notice to its Attorney of such charge.

Applicant thanks the Examining Attorney for her very diligent efforts in advancing this Application, and requests that any questions concerning this matter be directed to the undersigned at 416-708-9806.

Respectfully submitted,

Dated: __30 October 2020__

_____/Matthew J. MARQUARDT/
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