

**UNITED STATES PATENT AND TRADEMARK OFFICE**

**SERIAL NO:** [REDACTED]

**APPLICANT:** [REDACTED]

**\* [REDACTED] \***

**RETURN ADDRESS:**  
Commissioner for Trademarks  
P.O. Box 1451  
Alexandria, Virginia 22313-1451

**CORRESPONDENT ADDRESS:**

[REDACTED]

**MARK:** [REDACTED]

**CORRESPONDENT'S REFERENCE/DOCKET NO:** [REDACTED]

**CORRESPONDENT E-MAIL ADDRESS:**

[REDACTED]

**Filing Date:** [REDACTED], 2005  
**Date of Office Action:** [REDACTED], 2005  
**Examining Attorney's Name and Law Office Number:**  
[REDACTED], Esq.  
Trademark Attorney  
Law Office [REDACTED]  
(540) [REDACTED]

**APPLICANT'S RESPONSE TO OFFICE ACTION**

**Response to Primary Basis for Refusal of Registration  
Under Trademark Act Section 2(d), 15 U.S.C. §1052(d)**

In the Office Action of [REDACTED], 2005, the examining attorney refused registration under Trademark Act Section 2(d), 15 U.S.C. §1052(d), on the ground that "...the applicant's mark, when used on or in connection with the identified services, so resembles the marks in U.S. Registration Nos. [REDACTED], and [REDACTED] as to be likely to cause confusion, to cause mistake, or to deceive." Applicant does not agree with this conclusion, and in further support of its original application ("Application"), hereby submits this Response and requests that the examining attorney reconsider his prior determination concluding that the Application should be refused.

A. The Nature of the Applicant's Mark.

The mark for which the Application seeks registration is the numeric-alphabetic phrase "[REDACTED]". One drawing and one specimen were submitted concurrently with the Application. The drawing consisted simply of the typeset characters "[REDACTED]"; the specimen consisted of the first page of Applicant's website at www.[REDACTED].com. Since the time of the original Application, the content of the website has changed substantially. Among other things, the first page of the site now contains a disclaimer that reads as follows: "\* [REDACTED] is not affiliated with [REDACTED] [sic], Inc." Also since the time of the original Application, it has been brought to Applicant's attention that certain previously existing advertising and promotional materials not submitted with the Application had been developed and in use by Applicant. The following supplemental specimens are attached to this Response and incorporated herein by this reference:

- (1) Brochure consisting of five (5) pages describing the nature of Applicant's business and the services it provides (Supplemental Attachment #1);
- (2) Color print-out of Applicant's website pages as the site is presently constituted, also describing the nature of Applicant's business and the services it provides (Supplemental Attachment #2).

No International Class has yet been formally assigned to the registration being sought by Applicant, since the Application has not yet been approved. Upon such registration, if issued, Applicant would fall into International Class No. 035, "Advertising and business."

B. The Nature of the Marks the Examining Attorney Concluded Could Lead to Confusion, Mistake, or Deception Under 15 U.S.C. §1052(d).

- (1) U.S. Registration No. [REDACTED].

The mark covered by this registration number is a graphic depiction containing the words "[REDACTED]". The graphic is styled as follows:



This registration was issued on [REDACTED], 19[REDACTED], to an [REDACTED] corporation named [REDACTED], Inc. The registration fits into International Class 037, "Building construction; repair; installation services," and is more particularly described in the issued trademark as "[REDACTED]".

(2) U.S. Registration No. [REDACTED].

The mark covered by this registration number is also a graphic depiction, containing the words “[REDACTED]” styled as follows:



The words covered by the registration are “[REDACTED].” The registrant is the same [REDACTED] corporation named in Registration No. [REDACTED], and Registration No. [REDACTED] is classified as an addition to design search codes for the prior registration. The latter registration was issued on [REDACTED], 19[REDACTED]. This registration also fits into International Class 037, “Building construction; repair; installation services,” and is more particularly described in the issued trademark as “[REDACTED].”

C. A Comparison of the Nature of Applicant’s Business and Operations With the Business and Operations of the Holder of the Two Previously-Issued Competing Marks.

(1) Description of the Nature of Applicant’s Business and Operations.

Applicant is not itself engaged in either the ownership or operation of [REDACTED]. It fits into International Class 035, “Advertising and business.” It operates purely as an advertising, marketing, and promotional firm. The company website at www.[REDACTED].com prominently displays the service being offered to [REDACTED] owners as a “Referral and Affiliate Program.” As further explained on the same company website:

“Why should your company use [REDACTED]? Simple, because we do the marketing to get customers to you! With advertising through the power of the internet and the obviously easy to remember phone number, we have found the perfect formula for getting those customers [REDACTED] exposure to your [REDACTED] business. This is target marketing for your business on your area.”

The target market for Applicant’s services are [REDACTED] themselves, as the company website also explains:

“[REDACTED] is currently looking for certified [REDACTED] and [REDACTED] business owners that are interested in maximizing their advertising dollars.”

Using that same website, Applicant points out to its prospective customers that the benefits to be derived by them through Applicant's advertising program include:

- Name recognition
- Performance Based Advertising
- Increase you [sic] [REDACTED] Status
- Create a New Profit Center
- Pre-Qualified Customers

Applicant does not operate any kind of a franchising program nor does it charge the customers at whom its marketing is targeted – those with [REDACTED] – any amount for its services. All revenues are derived purely from independent, non-owned and non-affiliated [REDACTED] for whom sales leads are generated by Applicant's marketing program.

(2) Description of the Nature of the Competing Marks Holder's Business and Operations.

Unlike Applicant's business, the operations being carried out by the holder of the two competing marks is limited to actual [REDACTED], owned either by the company itself or by one or more franchisees.

In the local Yellow Pages advertising section for [REDACTED] (the company's headquarters city), the company's locations are listed under the categories of "[REDACTED], [REDACTED]," and "[REDACTED]."

The company's website at www.[REDACTED].com makes it clear that the actual [REDACTED] [REDACTED] is the company's principal and only business. According to the site:

"[REDACTED] pioneered a new industry by introducing [REDACTED] to the marketplace in 19[REDACTED]. [REDACTED] has successfully [REDACTED]. [REDACTED] are so superior we guarantee your satisfaction or you owe nothing. Call now for the [REDACTED] in your area or information on how you can own a [REDACTED] franchise [REDACTED]."

By way of contrast to the business being carried on by the holder of the two competing marks, Applicant's website explains to prospective [REDACTED] customers that:

"The [REDACTED] program is a beneficial way to create new profit areas and customers, plus gives you a great way to track your advertising dollars. For our [REDACTED] associates this program creates a new added service of [REDACTED] to existing customers. The unique [REDACTED] system of [REDACTED] marketing

has great appeal to [REDACTED] companies. This will increase the [REDACTED] status by qualifying all [REDACTED] before a conventional [REDACTED] giving the customers the best and most economical options of [REDACTED]. By the numbers shown above we know this is a great opportunity for your business.”

In short, the holder of the two competing marks actually [REDACTED] and provides no marketing services to outside third parties. Applicant, by contrast, does not engage in the making of any [REDACTED] and its activities are strictly limited to the provision of advertising and promotional services for the benefit of independent, third-party [REDACTED].

D. There is No Likelihood That the Registration of Applicant’s Requested Mark Will Result in Confusion, Mistake, or Deception Because Applicant is an Entirely Different Business Than the Business in Which the Holder of the Two Competing Marks Engages.

As noted above, the nature of Applicant’s business places it in International Class 035, “Advertising and business.” The official *Trademark Manual of Examination Procedures* (TMPEP) -- 4th Edition, the currently PTO-prescribed handbook for examining attorneys, contains the following description of this category:

**(Advertising and business)**

Advertising; business management; business administration; office functions.

*Explanatory Note*

This class includes mainly services rendered by persons or organizations principally with the object of:

- (1) help in the working or management of a commercial undertaking,  
or
- (2) help in the management of the business affairs or commercial functions of an industrial or commercial enterprise, as well as services rendered by advertising establishments primarily undertaking communications to the public, declarations or announcements by all means of diffusion and concerning all kinds of goods or services.

*Includes, in particular:*

- services consisting of the registration, transcription, composition, compilation, or systematization of written

communications and registrations, and also the exploitation or compilation of mathematical or statistical data;

- services of advertising agencies and services such as the distribution of prospectuses, directly or through the post, or the distribution of samples. This class may refer to advertising in connection with other services, such as those concerning bank loans or advertising by radio;
- the bringing together, for the benefit of others, of a variety of goods (excluding the transport thereof), enabling customers to conveniently view and purchase those goods.

*Does not include, in particular:*

- activity of an enterprise the primary function of which is the sale of goods, i.e., of a so-called commercial enterprise;
- services such as evaluations and reports of engineers which do not directly refer to the working or management of affairs in a commercial or industrial enterprise (consult the Alphabetical List of Services).

[Underlined portions indicate emphasis added from the original text.]

By comparison, as also noted above, the nature of the business being conducted by the holder of the two competing registered marks places it in International Class 037, “Building construction and repair.” The previously-referenced *Trademark Manual of Examination Procedures* (TMPEP) -- 4th Edition, contains the following description of this category:

**(Building construction and repair)**

Building construction; repair; installation services.

*Explanatory Note*

This class includes mainly services rendered by contractors or subcontractors in the construction or making of permanent buildings, as well as services rendered by persons or organizations engaged in the restoration of objects to their original condition or in their preservation without altering their physical or chemical properties.

*Includes, in particular:*

- services relating to the construction of buildings, roads, bridges, dams or transmission lines and services of undertakings specializing in the field of construction such as those of painters, plumbers, heating installers or roofers;
- services auxiliary to construction services like inspections of construction plans;
- services of shipbuilding;
- services consisting of hiring of tools or building materials;
- repair services, i.e., services which undertake to put any object into good condition after wear, damage, deterioration or partial destruction (restoration of an existing building or another object that has become imperfect and is to be restored to its original condition);
- various repair services such as those in the fields of electricity, furniture, instruments, tools, etc.;
- services of maintenance for preserving an object in its original condition without changing any of its properties (for the difference between this class and Class 40 see the explanatory note of Class 40).

*Does not include, in particular:*

- services consisting of storage of goods such as clothes or vehicles (Cl. 39);
- services connected with dyeing of cloth or clothes (Cl. 40).

[Underlined portions indicate emphasis added from the original text.]

It thus seems clear that the PTO's own internal guidelines for examining attorneys make plain the distinctions between the business being operated by Applicant on the one hand, versus the operations of the holder of the two competing registered marks on the other.

E. Explanation of the Eight-Pronged Test Recognized by the Courts for the Purpose of Determining Whether Confusion, Mistake, or Deception is Likely.

“The test for likelihood of confusion is whether a ‘reasonably prudent consumer’ in the marketplace is likely to be confused as to the origin of the good or service bearing one of the

marks.” *Dreamwerks Production Group, Inc. v. SKG Studio*, 142 F.3d 1127, 1129 (9th Cir. 1998).

Where, as here, similarly-named organizations are involved in entirely unrelated types of business operations, the risk with which Section 2(d) of the *Trademark Act*, 15 U.S.C. §1052(d), was specifically intended to deal – namely, the likelihood that registration of the mark being sought would be likely to cause confusion, to cause mistake, or to deceive – is *de minimis*. The courts have developed an eight-prong test for the purpose of deciding this question on a case-by-case basis, known commonly as the “Sleekcraft factors.”

The Sleekcraft factors were summarized in *Brookfield Communications, Inc. v. West Coast Entertainment Corporation*, 174 F.3d 1036, 50 U.S.P.Q.2d 1545 (9th Cir. 1999), as follows:

"The core element of trademark infringement is the likelihood of confusion, i.e., whether the similarity of the marks is likely to confuse customers about the source of the products." *Official Airline Guides*, 6 F.3d at 1391 (quoting *E. & J. Gallo Winery v. Gallo Cattle Co.*, 967 F.2d 1280, 1290 (9th Cir.1992)) (quotation marks omitted); accord *International Jensen, Inc. v. Metrosound U.S.A., Inc.*, 4 F.3d 819, 825 (9th Cir.1993); *Metro Publishing, Ltd. v. San Jose Mercury News*, 987 F.2d 637, 640 (9th Cir.1993). We look to the following factors for guidance in determining the likelihood of confusion: similarity of the conflicting designations; relatedness or proximity of the two companies' products or services; strength of Brookfield's mark; marketing channels used; degree of care likely to be exercised by purchasers in selecting goods; West Coast's intent in selecting its mark; evidence of actual confusion; and likelihood of expansion in product lines. See *Dr. Seuss Enters. v. Penguin Books USA, Inc.*, 109 F.3d 1394, 1404 (9th Cir.1997), petition for cert. dismissed by, 521 U.S. 1146, 118 S.Ct. 27, 138 L.Ed.2d 1057 (1997); *Sleekcraft*, 599 F.2d at 348-49; see also *Restatement (Third) of Unfair Competition* §§ 20-23 (1995). These eight factors are often referred to as the Sleekcraft factors.”<sup>1</sup>

The use of the “Sleekcraft factors” is not unique to the Ninth Circuit. Other courts have ratified the application of the same eight tests originally articulated in *Sleekcraft, supra*. See, e.g., *Wynn Oil Co. v. American Way Service Corp.*, 943 F.2d 595 (6th Cir. 1991); *Frisch's Restaurants, Inc. v. Elby's Big Boy of Steubenville, Inc.*, 670 F.2d 642 (6th Cir.) cert. denied, 459 U.S. 916, 103 S.Ct. 231, 74 L.Ed.2d 182 (1982).

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<sup>1</sup> The “Sleekcraft tests” were first derived from the holding in *AMF Inc. v. Sleekcraft Boats*, 599 F.2d 341, 348 (9th Cir. 1979).

F. Application of the “Sleekcraft factors” to the Pending Application.

(1) Similarity of the Conflicting Designations.

Registrations Nos. [REDACTED] and [REDACTED] not only fall into different International Classes from the International Class into which the registration sought by Applicant would fall; they also fall into particularized Design Search Codes. No. [REDACTED] is covered by Design Search Codes [REDACTED] and [REDACTED]. No. [REDACTED] is covered by [REDACTED]. These specifically stylized logo-type marks derive their distinctiveness not from their words alone, but more particularly from their configuration:



By comparison, Applicant’s mark does not seek to fit within any particular style or Design Search Code – it consists merely of the phrase “[REDACTED].” Besides being different in terms of stylization, Applicant’s mark is also distinctive in that:

- It does not use the full word “[REDACTED],” as do the two competing marks.
- It does not incorporate the familiar [REDACTED] symbol.
- The “1-800-“ prefix mark obviously identifies Applicant’s mark as being a toll-free telephone number. It could not possibly be anything else in the mind of almost any observer. Nothing in the two competing registered marks could conceivably be confused with Applicant’s mark, since neither contain any direct or indirect reference to a telephone number.

(2) Relatedness or Proximity of the Two Companies' Products or Services.

As explained at length above, and by the reckoning of no less an authority than PTO’s own internal *Trademark Manual of Examination Procedures* (TMEP) -- 4th Edition, Applicant is in an entirely different business than is the holder of the two competing marks. Applicant fits into International Class 035 as an organization being in “advertising or business.” The holder of the competing marks fits into International Class 037 as being in “Building construction and repair.” Applicant seeks out customer referrals for [REDACTED]; the holder of the competing marks actually [REDACTED].

That the difference between the two companies’ respective businesses is substantial is illustrated by the fact that:

- Applicant might well, hypothetically, [REDACTED]. Were this to occur, Applicant would be without resources to [REDACTED]; it would

need to seek out the services offered by the holder of the two competing marks, or another company in the same line of work. The holder of the two competing marks could, by comparison, [REDACTED].

- As illustrated in Supplemental Attachment #1 submitted concurrently herewith, the advertising and marketing program offered by Applicant is entirely results-based. Users of Applicant’s services pay referral fees only to the extent that new business is actually generated from leads that Applicant supplies. Were the holder of the two competing marks to ask if Applicant would be willing to add them to its list of approved providers, the answer would, of course, be yes. Applicant would have nothing to lose and potential revenue to be gained. The holder of the two competing marks would likewise have nothing to lose and potential revenue to be gained.

It is thus evident that Applicant and the holder of the two prior registered marks are not in competition with one another; rather, they are each seeking out ways to maximize revenues ultimately derived from consumers whose vehicles have sustained damage. Any “relatedness or proximity” of the two companies’ businesses under the “Sleekcraft factors” test is simply not present here.

(3) The Relative Strength of the Marks.

“Relative strength” is the third of the “Sleekcraft factors” identified by the court in *Brookfield Communications, Inc., supra*. “Relative strength” is generally understood to mean the degree to which a particular mark is likely to be remembered and associated in the public mind with the owner of the mark. *Kenner Parker Toys Inc. v. Rose Art Indus., Inc.*, 963 F.2d 350, 353 (Fed.Cir. 1992). *See also, Nutri/System, Inc. v. Con-Stan Indus., Inc.*, 809 F.2d 601, 605 (9th Cir. 1987).

Currently the holder of the two competing marks boasts franchised [REDACTED] in [REDACTED].<sup>2</sup> It has no operations in [REDACTED]. By contrast, Applicant’s business consists of maintaining an Internet website and advertising through other means in [REDACTED] and [REDACTED] Counties – two of [REDACTED]’s total of [REDACTED] counties.<sup>3</sup>

It has been held in cases that even where two separate companies are using identical marks, there may be no consumer confusion if the companies operate in different geographic areas and/or are in wholly different industries. *See, e.g., Weiner King, Inc. v. Weiner King Corp.*, 615 F.2d 512, 515-16, 521-22 (C.C.P.A. 1980), in which the simultaneous use of the term “Weiner King” as a mark for restaurants dedicated mainly to hotdogs operated in New Jersey by one company, and in North Carolina by the other company, was held permissible; and

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<sup>2</sup> Source: www.[REDACTED].com.

<sup>3</sup> See Supplemental Attachment #2 submitted concurrently herewith, at p. 2.

*Pinocchio's Pizza Inc. v. Sandra Inc.*, 11 U.S.P.Q.2d 1227, 1228 (T.T.A.B. 1989), in which the concurrent use of "PINOCCHIO'S" as a service mark for restaurants in Maryland and "PINOCCHIOS" as a service mark for restaurants elsewhere in the country was held permissible. Both of these holdings were expressly cited with approval by the court in *Brookfield Communications, Inc.*, *supra*.

Thus, the present Application presents a scenario in which two companies are both engaged in entirely separate types of businesses, and are carrying out those businesses in geographic areas that do not overlap. The "relative strength" of Applicant's mark as well as the "relative strength" of the two competing marks -- the degree to which a particular mark is likely to be remembered and associated in the public mind with the owner of the mark -- is at this time probably almost non-existent. That may change if the Application is approved, in that a "1-800" toll-free number with the corresponding *nom de plume* that describes the service being offered is to some degree inherently memorable. But when and if that occurs, there will be no danger that the public will be confused or misled that the true owner of the mark is anyone other than Applicant -- and even if there were, so what? If Applicant were named "[REDACTED]" and used "[REDACTED]" in its advertising, the only thing that a consumer would likely associate with the mark would be the service offered -- not the party offering it.

A finding of the "relative strength" of the competing marks involved in this Application would at worst leave a finder of fact in equipois, but there is nothing here to suggest that anyone will likely become confused, mistaken, or deceived regarding the mark sought by Applicant versus the two marks already previously registered by [REDACTED], Inc.

(4) The Marketing Channels Used.

As mentioned above, presently Applicant's marketing activities are confined to its website, and to other advertising media disseminated in [REDACTED] and [REDACTED] Counties, [REDACTED].

No advertising of any kind on behalf of the holder of the two competing marks has come to the attention of Applicant, other than that holder's company website.

Internet website advertising is dealt with in PTO's own previously-referenced *Trademark Manual of Examination Procedures* (TMEP) -- 4th Edition. Under the title of "Services Classified in Classes 35, 36, 37, 39, 40, 41, 44 and 45," the *Manual* provides:

"Any activity consisting of a service that ordinarily falls in these classes (*e.g.*, real estate agency services, banking services, dating services), and that happens to be provided over the Internet, is classified in the class where the underlying service is classified. For example, banking services are in Class 36 whether provided in a bank or online."

The *Manual* goes on to state that “Some acceptable identifications” include “Promoting the goods and services of others by preparing and placing advertisements on websites accessed through the Internet, in Class 35.” This is *precisely* the business in which Applicant is engaged; it is *not* the type of business that the holder of the two competing marks conducts.

A Google® search for websites containing the exact phrase “██████████” returns approximately 22,900 separate references. A similar search for websites containing the exact phrase “██████████” returns approximately 9,450 references. With this plethora of publicly searchable and easily found information, it would be difficult for either party to argue in favor of the absolute uniqueness of its respective marks. And it must be remembered that with respect to each reference returned by an Internet search engine, the searcher is ultimately led to a website that almost always does, in fact, identify the true owner of the mark. There is thus very little if any chance for confusion, mistake, or deception through this manner of advertising.

With respect to advertising media other than the Internet, the fact that the companies operate in distinct, different, non-overlapping territories likewise minimizes, if not eliminates, the chance for confusion, mistake, or deception.

(5) The Degree of Care Likely to be Exercised by Purchasers in Selecting Goods.

The degree of care that can be anticipated when a ██████████ seeks out a ██████████ to ██████████ to his or her ██████████ can fairly be characterized as relatively high when compared with more casual, everyday purchases such as, e.g., soda pop. It is common knowledge that over the years, the ██████████ business has enjoyed less than a stellar reputation for being scrupulous when compared with, say, the Gideons. Hence the common practice of “██████████,” even when most ██████████ no longer impose this requirement.

Whether a consumer is referred to a particular ██████████ by Applicant through its toll-free hotline, or is in some other fashion of advertising attracted to one of the franchisees of the owner of the two competing marks, it is unlikely that the customer will be content to rely merely on advertising alone. A much more probable scenario involves the physical inspection by the customer of the ██████████, and the interaction between the customer and staff ██████████ to see if the customer is comfortable with the “chemistry” between the two. If the customer’s experience turns out to be a positive one, he or she will likely remember the source from which the ██████████ name was procured – particularly if that source is an easily remembered, descriptive telephone number such as ██████████. If the customer’s experience is a negative one, such an event would also be likely to trigger a recollection of just how the ██████████ in question had been located in the first place. People in general tend to take ██████████ fairly seriously.

The conclusion of how this issue was analyzed in *Brookfield Communications, Inc.*, *supra*, as well as the original decision in *Sleekcraft Boats*, *supra* is this: To the extent that a customer is likely to exercise a high degree of care when selecting goods or services, the less chance that confusion, mistake, or deception will occur between two or more competing marks. In this instance, the marketplace can be fairly characterized as one in which customers can be

expected to exercise a higher degree of care than would be true of most other goods; thus, the likelihood of confusion, mistake, or deception will be minimized.

(6) Intent in the Selection of the Mark.

This prong of the “Sleekcraft tests” is directed at whether a newcomer to the marketplace is actively attempting to “piggyback,” or “ride on the coat-tails,” of an established trademark’s owner.

The “intent” question was explained as follows in *Cosmetic Dermatology and Vein Centers of Downriver, P.C. v. New Faces Skin Care Centers, Ltd.*, 91 F.Supp.2d 1045 (U.S.D.C. E.D. Mich. 2000):

“Another factor relevant to the likelihood of confusion is whether there is any evidence that Defendants selected the mark knowing that it had already been used. This factor is relevant ‘because purposeful copying indicates that the alleged infringer, who has at least as much knowledge as the trier of fact regarding the likelihood of confusion, believes that his copying may divert some business from the senior user.’ *Daddy’s Junky Music*, 109 F.3d at 286.” [Emphasis added]

The first that Applicant had ever heard of the existence of [REDACTED]’s registration of the two prior marks was when it received the PTO’s [REDACTED], 2005 Office Action. This fact is immaterial in any event because, as the *Cosmetic Dermatology, etc., supra* court explained, the purpose of the alleged copier must be to divert some business from the senior user. That is not the case here. The two parties are in entirely separate businesses. One is an advertising agency under International Class 035; the other is in “Building construction and repair” under International Class 037. If anything, the two businesses are complimentary to one another as opposed to being competitors (see #F(2) above). In addition, they operate in geographic areas that do not overlap.

Under these circumstances, no adverse intent on the part of Applicant can be either established or implied.

(7) Evidence of Actual Confusion.

Inasmuch as this is a proceeding before the PTO in which Applicant is seeking approval of its Application, as opposed to an adversary proceeding between two or more opposing litigants, there has been no opportunity to establish whether or not there have ever been any instances of actual confusion among consumers. Certainly none have ever come to the attention of Applicant.

In any event, the “Sleekcraft tests” represent “...factors [that] should not be rigidly weighed” (*Dreamwerks, supra*, 142 F.3d at 1129), but rather “are intended to guide the court in assessing the basic question of likelihood of confusion” (*E. & J. Gallo Winery, supra*, 967 F.2d

at 1290). For all of the other reasons set forth above, Applicant contends that there is no likelihood of confusion, mistake, or deception in the marketplace.

(8) Likelihood of Expansion of Product Lines.

The eighth and final “Sleekcraft test” involves the likelihood that the future expansion of the product lines of the two competing parties could bring about a change in circumstances; i.e., that such an expansion could render the probability of confusion, mistake, or deception greater than it was at the time of original consideration.

The court in *Daddy's Junky Music Stores, Inc. v. Big Daddy's Family Music Center*, 109 F.3d 275, 281 (6th Cir. 1997), quoting *Homeowners Group, Inc. v. Home Marketing Specialists, Inc.*, 931 F.2d 1100, 1107 (6th Cir. 1991), stated:

"[A] `strong possibility' that either party will expand his business to compete with the other or be marketed to the same consumers will weigh in favor of finding that the present use is infringing."  
[Emphasis added]

For all of the reasons hereinabove stated, this is extremely unlikely to happen. While it is possible that the parties' businesses may naturally expand so that at some future point, they will be doing business within one or more of the same geographic areas, the fact remains that they are not in the same business; are not in competition with one another; and, if anything, should turn out to be complimentary to one another by addressing entirely different segments of the marketplace.

**Response to Secondary Basis for Refusal of Registration  
Under Trademark Act Section 2(d), 15 U.S.C. §1052(d)**

The Office Action indicates that “If the applicant chooses to respond to the refusal to register, the applicant must also respond to the following informalities.”

(1) Ownership of Cited Registrations.

There has been no assignment of any registered mark to the Applicant that relates directly or indirectly to the Application.

(2) Specimens of Use.

Attached hereto as Supplemental Attachment #1 is a 5-page advertising brochure produced by the Applicant which constitutes a specimen showing the use of the mark for the services identified in the Application, submitted hereby pursuant to 37 C.F.R. §2.56; TMEP §904. The Applicant hereby represents that Supplemental Attachment #1 attached hereto was “in use in commerce at least as early as the filing date of the Application,” i.e., [REDACTED], 20[REDACTED], within the meaning of 37 C.F.R. §2.59(a); TMEP §904.09.

FOR THE APPLICANT:

\_\_\_\_\_  
[REDACTED]  
\_\_\_\_\_  
Attorney for Applicant  
\_\_\_\_\_  
[REDACTED], 2006  
\_\_\_\_\_

DECLARATION UNDER 37 C.F.R. §2.20

The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. §1001, and that such willful false statements may jeopardize the validity of the application or any resulting registration, declares that the facts set forth in this Applicant's Response to Office Action are true; all statements made of his/her own knowledge are true; and all statements made on information and belief are believed to be true.

\_\_\_\_\_  
[REDACTED]  
\_\_\_\_\_  
Attorney for Applicant  
\_\_\_\_\_  
[REDACTED], 2006  
\_\_\_\_\_