

To: EXPRESS COMMUNICATIONS (ExpressCommunications@RocketMail.com)
Subject: U.S. TRADEMARK APPLICATION NO. 85480792 - EXPRESS - N/A
Sent: 12/12/2013 2:59:09 PM
Sent As: ECOM111@USPTO.GOV
Attachments:

**UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)
OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION**

U.S. APPLICATION SERIAL NO. 85480792

MARK: EXPRESS

85480792

CORRESPONDENT ADDRESS:

JEFF VOLK
JEFF VOLK
PO BOX 828
PISMO BEACH CA 93448-0828

CLICK HERE TO RESPOND TO THIS LETTER:
http://www.uspto.gov/trademarks/teas/response_forms.jsp

APPLICANT: EXPRESS COMMUNICATIONS

CORRESPONDENT'S REFERENCE/DOCKET NO :

N/A

CORRESPONDENT E-MAIL ADDRESS:

ExpressCommunications@RocketMail.com

OFFICE ACTION

STRICT DEADLINE TO RESPOND TO THIS LETTER

TO AVOID ABANDONMENT OF APPLICANT'S TRADEMARK APPLICATION, THE USPTO MUST RECEIVE APPLICANT'S COMPLETE RESPONSE TO THIS LETTER **WITHIN 6 MONTHS** OF THE ISSUE/MAILING DATE BELOW.

ISSUE/MAILING DATE: 12/12/2013

THIS IS A FINAL ACTION.

This action addresses the applicant's 09/21/12 response to the 03/17/12 office action. The office action included several 2d likelihood of confusion refusals, a prior pending mark, and a requirement to amend the identification of goods. The applicant has provided an acceptable amended identification and the prior pending mark has since abandoned. While, the applicant has provided a preliminary response, many of the issues of likelihood of confusion have not been vetted or discussed. Additionally, while the applicant has filed letters of protests for two mark, which were granted, the marks subsequently have been approved for registration. Upon careful review of the applicant's response, the undersigned finds the arguments unpersuasive. As a result, the 2d refusal is maintained and is now made **FINAL**.

SECTION 2(d) REFUSAL – LIKELIHOOD OF CONFUSIONS- FINAL

Registration of the applied-for mark- "Express" for "Devices capable of storing/producing/computing, transmitting, receiving, data/signals including sound, images/video, and text, namely: **transceivers**, personal computers, lap-tops, tablet computers, tablet mobile phones, telephones, cellular/mobile telephones, sold as integrated components and separate components. Accessories for the aforementioned goods, namely, internal and external components, namely, antennas, battery chargers, batteries, hands-free headsets, vehicle mountings, housings/face plates, carrying

cases/pouches/holsters

is refused because of a likelihood of confusion with the mark in U.S. Registration Nos. 3922364 “Channel Express” for “transceivers” [owned by Ranger Electronic Communications], 3950050 “ExpressMaps” for the relevant goods, computers [owned by Spot Image], 3916159 “Xpressradio” for the relevant goods, namely mobile telephones and accessories for mobile telephones, namely batteries, battery chargers, headsets [owned by Nokia], 79048130 “Rittal Express” plus a design for the relevant goods, namely “adapted housings for the accommodation of electrical installations, in the fields of computers for [putting] up electrical installations [owned by Rittal GmbH], 3524420 “Nasuba Express” and design for the relevant goods, namely “computer terminals, laptops, telephone terminals [owned by LCS Media], 2931609 “Express Fast Charger” and 3430696 “Express” for battery chargers and batteries [owned by ESRMCO Corp.], 3681466 “Think Express” and 3681462 “Express” for the relevant goods, namely “computers and computer accessories” [both owned by International Business Machines], 3476179 “Express Gate” for the relevant goods, namely “personal computers and notebook computers” [owned by Asustek Computer Inc.], 2496915 “Neax Express” for the relevant goods “computers” [owned by NEC Infrontia Corp], 2289968 “Micro Express” for the relevant goods “computers” [owned by ASA Engineering], 1529489 “Bowler Express” with a design for the relevant goods, namely computers [Computer Sports Systems, Inc.], 1606164 “Callxpress” for the relevant goods, computers [Applied Voice & Speech]. Trademark Act Section 2(d), 15 U.S.C. §1052(d); see TMEP §§1207.01 *et seq.* See the enclosed registrations.

Comparison of Marks

The goods and/or services of the parties need not be identical or directly competitive to find a likelihood of confusion. See *Safety-Kleen Corp. v. Dresser Indus., Inc.*, 518 F.2d 1399, 1404, 186 USPQ 476, 480 (C.C.P.A. 1975); TMEP §1207.01(a)(i). Rather, it is sufficient to show that because of the conditions surrounding their marketing, or because they are otherwise related in some manner, the goods and/or services would be encountered by the same consumers under circumstances such that offering the goods and/or services under confusingly similar marks would lead to the mistaken belief that they come from, or are in some way associated with, the same source. *In re Iolo Techs., LLC*, 95 USPQ2d 1498, 1499 (TTAB 2010); see *In re Martin’s Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 1566-68, 223 USPQ 1289, 1290 (Fed. Cir. 1984); TMEP §1207.01(a)(i).

Here, the proposed mark is “Express” and the registrants’ marks are “Express”, “Channel Express”, “ExpressMaps”, “Xpressradio”, “Rittal Express” plus a design, “Nasuba Express” and design, “Express Fast Charger”, “Express”, “Think Express”, “Express”, “Express Gate”, “Neax Express”, “Micro Express”, “Bowler Express”, “Callxpress”. The marks share the wording “Express”. The mere addition of a term to a registered mark generally does not obviate the similarity between the marks nor does it overcome a likelihood of confusion under Trademark Act Section 2(d). See *In re Chatam Int’l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944 (Fed. Cir. 2004) (GASPAR’S ALE and JOSE GASPAR GOLD); *Coca-Cola Bottling Co. v. Jos. E. Seagram & Sons, Inc.*, 526 F.2d 556, 188 USPQ 105 (C.C.P.A. 1975) (BENGAL and BENGAL LANCER); *Lilly Pulitzer, Inc. v. Lilli Ann Corp.*, 376 F.2d 324, 153 USPQ 406 (C.C.P.A. 1967) (THE LILLY and LILLI ANN); *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266 (TTAB 2009) (TITAN and VANTAGE TITAN); *In re El Torito Rests., Inc.*, 9 USPQ2d 2002 (TTAB 1988) (MACHO and MACHO COMBOS); *In re Corning Glass Works*, 229 USPQ 65 (TTAB 1985) (CONFIRM and CONFIRMCELLS); *In re U.S. Shoe Corp.*, 229 USPQ 707 (TTAB 1985) (CAREER IMAGE and CREST CAREER IMAGES); *In re Riddle*, 225 USPQ 630 (TTAB 1985) (ACCUTUNE and RICHARD PETTY’S ACCU TUNE); TMEP §1207.01(b)(iii).

In addition, some of the registrant’s marks include the phonetic equivalent for the wording “express.” The marks are essentially phonetic equivalents and thus sound similar. Similarity in sound alone may be sufficient to support a finding that the marks are confusingly similar. *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988); see *In re 1st USA Realty Prof’ls, Inc.*, 84 USPQ2d 1581, 1586 (TTAB 2007); TMEP §1207.01(b)(iv).

Finally, as to the addition of the design for some of the registrant’s marks, For a composite mark containing both words and a design, the word portion may be more likely to be impressed upon a purchaser’s memory and to be used when requesting the goods and/or services. *Joel Gott Wines, LLC v. Rehoboth Von Gott, Inc.*, 107 USPQ2d 1424, 1431 (TTAB 2013) (citing *In re Dakin’s Miniatures, Inc.*, 59 USPQ2d 1593, 1596 (TTAB 1999)); TMEP §1207.01(c)(ii); see *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1911 (Fed. Cir. 2012) (citing *CBS Inc. v. Morrow*, 708 F. 2d 1579, 1581-82, 218 USPQ 198, 200 (Fed. Cir 1983)). Thus, although such marks must be compared in their entirety, the word portion is often considered the dominant feature and is accorded greater weight in determining whether marks are confusingly similar, even where the word portion has been disclaimed. *In re Viterra Inc.*, 671 F.3d at 1366, 101 USPQ2d at 1911 (Fed. Cir. 2012) (citing *Giant Food, Inc. v. Nation’s Foodservice, Inc.*, 710 F.2d 1565, 1570-71, 218 USPQ2d 390, 395 (Fed. Cir. 1983)).

The applicant argues that certain elements “stand out” more than the wording “Express”, but as indicated above design elements routinely are not recalled as readily as word elements, such as the wording “express.”

Comparison of Goods

The goods and/or services of the parties need not be identical or directly competitive to find a likelihood of confusion. See *Safety-Kleen Corp. v. Dresser Indus., Inc.*, 518 F.2d 1399, 1404, 186 USPQ 476, 480 (C.C.P.A. 1975); TMEP §1207.01(a)(i). Rather, it is sufficient to show that because of the conditions surrounding their marketing, or because they are otherwise related in some manner, the goods and/or services would be encountered by the same consumers under circumstances such that offering the goods and/or services under confusingly similar marks would

lead to the mistaken belief that they come from, or are in some way associated with, the same source. *In re Iolo Techs., LLC*, 95 USPQ2d 1498, 1499 (TTAB 2010); see *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 1566-68, 223 USPQ 1289, 1290 (Fed. Cir. 1984); TMEP §1207.01(a)(i).

Here, the proposed mark is "Express" for "Devices capable of storing/producing/computing, transmitting, receiving, data/signals including sound, images/video, and text, namely: **transceivers**, personal computers, lap-tops, tablet computers, tablet mobile phones, telephones, cellular/mobile telephones, sold as integrated components and separate components. Accessories for the aforementioned goods, namely, internal and external components, namely, antennas, battery chargers, batteries, hands-free headsets, vehicle mountings, housings/face plates, carrying cases/pouches/holsters.

Related To Transceivers

U.S. Registration No. 3922364 "Channel Express" for "transceivers"[owned by Ranger Electronic Communications],

In a likelihood of confusion analysis, the comparison of the parties' goods and/or services is based on the goods and/or services as they are identified in the application and registration, without limitations or restrictions that are not reflected therein. *In re Dakin's Miniatures, Inc.*, 59 USPQ2d 1593, 1595 (TTAB 1999); see *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 1267-68, 62 USPQ2d 1001, 1004-05 (Fed. Cir. 2002); *In re Thor Tech, Inc.*, 90 USPQ2d 1634, 1638-39 (TTAB 2009); TMEP §1207.01(a)(iii).

In the present case, applicant's goods and/or services are transceivers and registrant's goods and/or services are transceivers. Thus, the goods and/or services are identical, and it is presumed that they move in all normal channels of trade and are available to all potential customers. See *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d 1344, 1356, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011); *In re La Peregrina Ltd.*, 86 USPQ2d 1645, 1646 (TTAB 2008); TMEP §1207.01(a)(iii).

While the letter of protest was accepted, the examining attorney in the respective application ultimately approved the mark for publication and the application has since registered.

Accordingly, the goods and/or services are considered related for purposes of the likelihood of confusion analysis.

Related To Computers

U.S. Registration No. 3950050 "ExpressMaps" for the relevant goods, computers [owned by Spot Image],

The application argues that the goods are for a satellite maps, however, the relevant goods at issue are computers.

U.S. Registration No. 3524420 "Nasuba Express" and design for the relevant goods, namely "computer terminals, laptops, telephone terminals[owned by LCS Media],

U.S. Registration No. 3681462 "Express" for the relevant goods, namely "computers and computer accessories"[both owned by International Business Machines],

The applicant does not argue that the goods are not related.

U.S. Registration No. 2496915 "Neax Express" for the relevant goods "computers" [owned by NEC Infrontia Corp] This mark has since cancelled and is no longer a bar to registration.

U.S. Registration No. 3476179 "Express Gate" for the relevant goods, namely "personal computers and notebook computers" [owned by Asustek Computer Inc.],

U.S. Registration No. 3681466 "Think Express" for the relevant goods, namely "computers and computer accessories"

U.S. Registration No. 2289968 "Micro Express" for the relevant goods "computers" [owned by ASA Engineering],

U.S. Registration No. 1529489 "Bowler Express" with a design for the relevant goods, namely "computers" [Computer Sports Systems, Inc.],

The applicant argues that the mark is for bowling alley systems and not the goods listed here, however, this is incorrect.

U.S. Registration No. 1606164 "Callxpress" for the relevant goods, "computers" [Applied Voice & Speech].

In a likelihood of confusion analysis, the comparison of the parties' goods and/or services is based on the goods and/or services as they are identified in the application and registration, without limitations or restrictions that are not reflected therein. *In re Dakin's Miniatures, Inc.*, 59 USPQ2d 1593, 1595 (TTAB 1999); see *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 1267-68, 62 USPQ2d 1001, 1004-05 (Fed. Cir. 2002); *In re Thor Tech, Inc.*, 90 USPQ2d 1634, 1638-39 (TTAB 2009); TMEP §1207.01(a)(iii).

In the present case, applicant's goods and/or services are personal computers. Thus, the goods and/or services are identical, and it is presumed that they move in all normal channels of trade and are available to all potential customers. See *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d 1344, 1356, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011); *In re La Peregrina Ltd.*, 86 USPQ2d 1645, 1646 (TTAB 2008); TMEP §1207.01(a)(iii).

In a likelihood of confusion analysis, the comparison of the parties' goods and/or services is based on the goods and/or services as they are identified in the application and registration, without limitations or restrictions that are not reflected therein. *In re Dakin's Miniatures, Inc.*, 59 USPQ2d 1593, 1595 (TTAB 1999); see *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 1267-68, 62 USPQ2d 1001, 1004-05 (Fed. Cir. 2002); *In re Thor Tech, Inc.*, 90 USPQ2d 1634, 1638-39 (TTAB 2009); TMEP §1207.01(a)(iii). In the instant case, the applicant's relevant

goods are as follows: personal computers, lap-tops, tablet computers and registrant's goods and/or services are computers and computer peripherals and the registrant's goods are computers.

In this case, the identification set forth in the cited registration uses broad wording to describe registrant's goods and/or services and does not contain any limitations as to nature, type, channels of trade or classes of purchasers. Therefore, it is presumed that the registration encompasses all goods and/or services of the type described, including those in applicant's more specific identification, that the goods and/or services move in all normal channels of trade, and that they are available to all potential customers. *See Citigroup Inc. v. Capital City Bank Grp., Inc.*, ___ F.3d ___, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011); *In re Jump Designs LLC*, 80 USPQ2d 1370, 1374 (TTAB 2006); *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981); TMEP §1207.01(a)(iii).

Accordingly, the goods and/or services are considered related for purposes of the likelihood of confusion analysis.

Mobile telephones, batteries, battery chargers, and headsets for related purposes

U.S. Registration No. 3916159 "Xpressradio" for the relevant goods, namely mobile telephones and accessories for mobile telephones, namely batteries, battery chargers, headsets [owned by Nokia],

While the letter of protest was accepted, the examining attorney in the respective application ultimately approved the mark for publication and the application has since registered.

U.S. Registration No. 2931609 "Express Fast Charger" and U.S. Registration No. 3430696 "Express" for battery chargers and batteries [owned by ESRMCO Corp.],

In a likelihood of confusion analysis, the comparison of the parties' goods and/or services is based on the goods and/or services as they are identified in the application and registration, without limitations or restrictions that are not reflected therein. *In re Dakin's Miniatures, Inc.*, 59 USPQ2d 1593, 1595 (TTAB 1999); *see Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 1267-68, 62 USPQ2d 1001, 1004-05 (Fed. Cir. 2002); *In re Thor Tech, Inc.*, 90 USPQ2d 1634, 1638-39 (TTAB 2009); TMEP §1207.01(a)(iii).

In the present case, applicant's goods and/or services are mobile telephones, batteries, battery chargers, and headsets and registrant's goods and/or services are mobile telephones, batteries, battery charger, and headsets. Thus, the goods and/or services are identical, and it is presumed that they move in all normal channels of trade and are available to all potential customers. *See Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d 1344, 1356, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011); *In re La Peregrina Ltd.*, 86 USPQ2d 1645, 1646 (TTAB 2008); TMEP §1207.01(a)(iii).

Accordingly, the goods and/or services are considered related for purposes of the likelihood of confusion analysis.

Housings for related purposes

U.S. Registration No. 79048130 "Rittal Express" plus a design for the relevant goods, namely "adapted housings for the accommodation of electrical installations, in the fields of computers for [putting] up electrical installations[owned by Rittal GmbH],

In a likelihood of confusion analysis, the comparison of the parties' goods and/or services is based on the goods and/or services as they are identified in the application and registration, without limitations or restrictions that are not reflected therein. *In re Dakin's Miniatures, Inc.*, 59 USPQ2d 1593, 1595 (TTAB 1999); *see Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 1267-68, 62 USPQ2d 1001, 1004-05 (Fed. Cir. 2002); *In re Thor Tech, Inc.*, 90 USPQ2d 1634, 1638-39 (TTAB 2009); TMEP §1207.01(a)(iii).

In this case, applicant's goods and/or services are identified broadly. Therefore, it is presumed that the application encompasses all goods and/or services of the type described, including those in the registrant's more specific identification, that the goods and/or services move in all normal channels of trade, and that they are available to all potential customers. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, ___ F.3d ___, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011); *In re La Peregrina Ltd.*, 86 USPQ2d 1645, 1646 (TTAB 2008); *In re Jump Designs LLC*, 80 USPQ2d 1370, 1374 (TTAB 2006); TMEP §1207.01(a)(iii).

Although applicant's mark has been refused registration, applicant may respond to the refusal(s) by submitting evidence and arguments in support of registration.

Proper Response

If applicant does not respond within six months of the mailing date of this final Office action, the application will be abandoned. 15 U.S.C. §1062(b); 37 C.F.R. §2.65(a). Applicant may respond to this final Office action by:

- (1) Submitting a response that fully satisfies all outstanding requirements, if feasible; and/or
- (2) Filing an appeal to the Trademark Trial and Appeal Board, with an appeal fee of \$100 per class.

37 C.F.R. §§2.6(a)(18), 2.64(a); TBMP ch. 1200; TMEP §714.04.

In certain rare circumstances, a petition to the Director may be filed pursuant to 37 C.F.R. §2.63(b)(2) to review a final Office action that is limited to procedural issues. 37 C.F.R. §2.64(a); TMEP §714.04; *see* 37 C.F.R. §2.146(b); TBMP §1201.05; TMEP §1704 (explaining petitionable matters). The petition fee is \$100. 37 C.F.R. §2.6(a)(15).

If applicant has questions regarding this Office action, please telephone the assigned trademark examining attorney. If the applicant chooses to e-mail, please note that all relevant e-mail communications will be placed in the official application record; however, an e-mail communication **will not** be accepted as a response to this Office action and will not extend the deadline for filing a proper response. *See* 37 C.F.R. §2.191; TMEP §§709.04-.05. Further, although the trademark examining attorney may provide additional explanation pertaining to the refusal(s) and/or requirement(s) in this Office action, the trademark examining attorney may not provide legal advice or statements about applicant's rights. *See* TMEP §§705.02, 709.06.

/Nakia D. Henry/
Trademark Attorney (Law Office 111)
Phone: (571) 272-7208
Fax: (571) 273-7208
E-mail: nakia.henry@uspto.gov

TO RESPOND TO THIS LETTER: Go to http://www.uspto.gov/trademarks/teas/response_forms.jsp. Please wait 48-72 hours from the issue/mailling date before using the Trademark Electronic Application System (TEAS), to allow for necessary system updates of the application. For *technical* assistance with online forms, e-mail TEAS@uspto.gov. For questions about the Office action itself, please contact the assigned trademark examining attorney. **E-mail communications will not be accepted as responses to Office actions; therefore, do not respond to this Office action by e-mail.**

All informal e-mail communications relevant to this application will be placed in the official application record.

WHO MUST SIGN THE RESPONSE: It must be personally signed by an individual applicant or someone with legal authority to bind an applicant (i.e., a corporate officer, a general partner, all joint applicants). If an applicant is represented by an attorney, the attorney must sign the response.

PERIODICALLY CHECK THE STATUS OF THE APPLICATION: To ensure that applicant does not miss crucial deadlines or official notices, check the status of the application every three to four months using the Trademark Status and Document Retrieval (TSDR) system at <http://tsdr.uspto.gov/>. Please keep a copy of the TSDR status screen. If the status shows no change for more than six months, contact the Trademark Assistance Center by e-mail at TrademarkAssistanceCenter@uspto.gov or call 1-800-786-9199. For more information on checking status, see <http://www.uspto.gov/trademarks/process/status/>.

TO UPDATE CORRESPONDENCE/E-MAIL ADDRESS: Use the TEAS form at <http://www.uspto.gov/trademarks/teas/correspondence.jsp>.

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.