

## UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 79/045569

MARK: NEW BUSINESS GENERAT

**\*79045569\***

## CORRESPONDENT ADDRESS:

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## RESPOND TO THIS ACTION:

<http://www.uspto.gov/teas/eTEASpageD.htm>

## GENERAL TRADEMARK INFORMATION:

<http://www.uspto.gov/main/trademarks.htm>

APPLICANT: ALCATEL LUCENT

## CORRESPONDENT'S

REFERENCE/DOCKET NO:

N/A

CORRESPONDENT E-MAIL ADDRESS:

## OFFICE ACTION

TO AVOID ABANDONMENT, THE OFFICE MUST RECEIVE A PROPER RESPONSE TO THIS OFFICE ACTION WITHIN 6 MONTHS OF THE ISSUE/MAILING DATE.

ISSUE/MAILING DATE:

INTERNATIONAL REGISTRATION NO. 0942007.

This is a **PROVISIONAL FULL REFUSAL** of the trademark and/or service mark in the above-referenced U.S. application. *See* 15 U.S.C. §1141h(c).

## WHO IS PERMITTED TO RESPOND TO THIS PROVISIONAL FULL REFUSAL:

Applicant may respond directly to this provisional refusal Office action, or applicant's attorney may respond on applicant's behalf. However, **the only attorneys who can practice before the United States Patent and Trademark Office (USPTO)** in trademark matters are as follows:

- (1) **Attorneys in good standing with a bar of the highest court of any U.S. state, the District of Columbia, Puerto Rico, and other federal territories and possessions of the U.S.; and**
- (2) **Canadian attorneys who represent applicants residing in Canada and who have applied for and received reciprocal recognition by the USPTO under 37 C.F.R. §10.14(c).**

37 C.F.R. §10.14; TMEP §602.

Other than duly authorized Canadian attorneys, foreign attorneys cannot sign responses or otherwise represent applicants before the USPTO. *See* TMEP §602.06(b). Preparing a paper, authorizing an amendment to an application, or submitting legal arguments in response to a requirement or refusal constitutes representation of a party in a trademark matter. *A response signed by an unauthorized foreign attorney is considered an incomplete response.* TMEP §§602, 602.03, 603.04, 605.05(a).

## THE APPLICATION HAS BEEN PROVISIONALLY REFUSED AS FOLLOWS:

The assigned trademark examining attorney has reviewed the referenced application, and has determined the following.

### Section 2(d) - Likelihood of Confusion Refusal

Registration of the proposed mark is refused because of a likelihood of confusion with the mark in U.S. Registration No. 2065615. Trademark Act Section 2(d), 15 U.S.C. §1052(d); TMEP §§1207.01 *et seq.* See the enclosed registration.

#### I. Determination of Likelihood of Confusion

Trademark Act Section 2(d) bars registration where an applied-for mark so resembles a registered mark that it is likely, when applied to the goods and/or services, to cause confusion, mistake or to deceive the potential consumer as to the source of the goods and/or services. TMEP §1207.01. The Court in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973), listed the principal factors to consider in determining whether there is a likelihood of confusion. Among these factors are the similarity of the marks as to appearance, sound, meaning and commercial impression, and the relatedness of the goods and/or services. The overriding concern is to prevent buyer confusion as to the source of the goods and/or services. *In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993). Therefore, any doubt as to the existence of a likelihood of confusion must be resolved in favor of the registrant. *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988); *Lone Star Mfg. Co. v. Bill Beasley, Inc.*, 498 F.2d 906, 182 USPQ 368 (C.C.P.A. 1974).

#### II. Comparison of the Marks

When applicant's mark is compared to a registered mark, "the points of similarity are of greater importance than the points of difference." *Esso Standard Oil Co. v. Sun Oil Co.*, 229 F.2d 37, 40, 108 USPQ 161 (D.C. Cir. 1956) (internal citation omitted). The applicant's mark NEW BUSINESS GENERATION is similar in sound, meaning and appearance to the registered mark NEW GENERATION because the marks contain similar wording. Marks may be confusingly similar in appearance where there are similar terms or phrases or similar parts of terms or phrases appearing in both applicant's and registrant's mark. See e.g., *Crocker Nat'l Bank v. Canadian Imperial Bank of Commerce*, 228 USPQ 689 (TTAB 1986), *aff'd* 1 USPQ2d 1813 (Fed. Cir. 1987) (COMMCASH and COMMUNICASH); *In re Phillips-Van Heusen Corp.*, 228 USPQ 949 (TTAB 1986) (21 CLUB and "21" CLUB (stylized)); *In re Corning Glass Works*, 229 USPQ 65 (TTAB 1985) (CONFIRM and CONFIRMCELLS); *In re Collegian Sportswear Inc.*, 224 USPQ 174 (TTAB 1984) (COLLEGIAN OF CALIFORNIA and COLLEGIENNE); *In re Pellerin Milnor Corp.*, 221 USPQ 558 (TTAB 1983) (MILTRON and MILLTRONICS); *In re BASF A.G.*, 189 USPQ 424 (TTAB 1975) (LUTEXAL and LUTEX); TMEP §§1207.01(b)(ii) and (b)(iii).

#### III. Comparison of the Goods

Applicant's goods, namely, "apparatus, equipment, installations and software associated with telecommunications," are identical to registrant's goods, namely, "signal transmission cables," because signal transmission cables are a type of telecommunications apparatus and/or equipment. It is well settled that the issue of likelihood of confusion between marks must be determined on the basis of the goods or services as they are identified in the application and the registration. *Canadian Imperial Bank of Commerce v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987); *Paula Payne Products Co. v. Johnson Publishing Co.*, 473 F.2d 901, 177 USPQ 76 (C.C.P.A. 1973). Since the identification of the applicant's goods/services is very broad, it is presumed that the application encompasses all goods/services of the type described, including those in the registrant's more specific identification, that they move in all normal channels of trade and that they are available for all potential customers. TMEP §1207.01(a)(iii).

Any doubt regarding a likelihood of confusion is resolved in favor of the prior registrant. *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002); *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988); TMEP §§1207.01(d) (i).

In light of the similarities in sound, meaning and appearance of applicant's mark and registrant's mark, combined with the closely related or identical nature of the goods, it appears that the applicant's mark is confusingly similar to the registrant's mark.

Although the trademark examining attorney has refused registration, applicant may respond to the refusal to register by submitting evidence and arguments in support of registration.

If applicant chooses to respond to the refusal(s) to register, then applicant must also respond to the following requirement(s).

### **Identification of Goods and Services**

The wording "*Apparatus, equipment, installations and software associated with telecommunications*" in the identification of goods needs clarification because it is broad. TMEP §1402.01. The identification of goods must be specific and all-inclusive. Applicant should amend the identification to replace this wording with "namely." Please note that applicant may amend the identification to list only those items that are within the scope of the goods set forth in the application. 37 C.F.R. §2.71(a); TMEP §§1402.01 and 1402.03(a).

Applicant may adopt the following identification of goods, if accurate:

Apparatus, equipment, and installations associated with telecommunications, namely, {*specify goods e.g. fuses, electric capacitors, etc.*}; *Telecommunications software, namely, {specify purpose of software, e.g. computer telephony software, electric game software for cellular telephones, etc.}*, in Class 009.

TMEP §1402.01.

The international classification of goods and/or services in applications filed under Trademark Act Section 66(a) cannot be changed from the classification given to the goods and/or services by the International Bureau of the World Intellectual Property Organization in the corresponding international registration. TMEP §§1401.03(d), 1401.04 and 1904.02(b).

For assistance with identifying and classifying goods and/or services in trademark applications, please see the online searchable *Manual of Acceptable Identifications of Goods and Services* at <http://tess2.uspto.gov/netahtml/tidm.html>.

Please note that, while the identification of goods may be amended to clarify or limit the goods, adding to the goods or broadening the scope of the goods is not permitted. 37 C.F.R. §2.71(a); TMEP §1402.06. Therefore, applicant may not amend the identification to include goods that are not within the scope of the goods set forth in the present identification.

### **Significance of Wording**

Applicant must specify whether the wording "NEW BUSINESS GENERATION" has any significance in the applicant's trade or industry or as applied to the goods/services described in the application. 37 C.F.R. §2.61(b). Specifically, applicant must specify whether the goods in Class 009 or the software will be used to generate business.

If applicant has questions about its application or needs assistance in responding to this Office action, please telephone the assigned trademark examining attorney directly at the number below.

/Saima Makhdoom/  
Attorney  
Law Office 101  
U.S. Patent and Trademark Office  
Telephone: (571) 272-8802  
Facsimile: (571) 273-8802

**RESPOND TO THIS ACTION:** If there are any questions about the Office action, please contact the assigned examining attorney. A response to this Office action should be filed using the form available at <http://www.uspto.gov/teas/eTEASpageD.htm>. If notification of this Office action was received via e-mail, no response using this form may be filed for 72 hours after receipt of the

notification. **Do not attempt to respond by e-mail as the USPTO does not accept e-mailed responses.**

If responding by paper mail, please include the following information: the application serial number, the mark, the filing date and the name, title/position, telephone number and e-mail address of the person signing the response. Please use the following address: Commissioner for Trademarks, P.O. Box 1451, Alexandria, VA 22313-1451.

**STATUS CHECK:** Check the status of the application at least once every six months from the initial filing date using the USPTO Trademark Applications and Registrations Retrieval (TARR) online system at <http://tarr.uspto.gov>. When conducting an online status check, print and maintain a copy of the complete TARR screen. If the status of your application has not changed for more than six months, please contact the assigned examining attorney.

Print: Jan 10, 2008

74662505

**TYPED DRAWING**

**Serial Number**  
74662505

**Status**  
REGISTERED AND RENEWED

**Word Mark**  
NEW GENERATION

**Standard Character Mark**  
No

**Registration Number**  
2065615

**Date Registered**  
1997/05/27

**Type of Mark**  
TRADEMARK

**Register**  
PRINCIPAL

**Mark Drawing Code**  
(1) TYPED DRAWING

**Owner**  
BELDEN TECHNOLOGIES, INC. CORPORATION DELAWARE 7701 FORSYTH BLVD.  
SUITE 800 ST. LOUIS MISSOURI 63105

**Goods/Services**  
Class Status -- ACTIVE. IC 009. US 021 023 026 036 038. G & S:  
signal transmission cables sold to industrial users in bulk  
quantities. First Use: 1995/08/00. First Use In Commerce:  
1995/08/00.

**Filing Date**  
1995/04/18

**Examining Attorney**  
SCHULMAN, LORI