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795 000 000 334

January 17, 1995

Florida Secretary of State
Florida Department of State
Division of Corporations
Post Office Box 6327
Tallahassee, Florida 32314

FILED
95 JAN 17 1995
TAMPA
SECRETARY OF STATE
DIVISION OF CORPORATIONS
000001386500
-01729795-01035-003
****87.50 ****87.50

Attn: Service Mark Application

Re: Transmittal of Application for Registration of a Services Mark

Mark: Specialist and Design of Stylized Letters, With Letters "LIST" Slanted, Above Diagonal Mosaic Pattern Resembling Tire Treads that is comprised of Silhouetted Automobiles

Class: 35

FILED
95 JAN 23 1995
TALLAHASSEE, FLORIDA
SECRETARY OF STATE
DIVISION OF CORPORATIONS

Dear Madam or Sir:

Enclosed for filing is an original and one copy of an Application for Registration of a Service Mark for the above referenced mark in Class 35. Also enclosed are three specimens of the mark and a check in the amount of \$87.50 for the filing fee.

Respectfully submitted,

789/751/708/672
Andrew C. Greenberg

ACG/ar
Enclosures

cc: Mr. Ronald P. Chenoweth
Mr. Kenneth Baker

1,127,081
11/27/79

Name Availability	up) NYC
Document Examiner	NJC
Updater	NJC
Updater Verifier	NJC
Acknowledgement	NJC
W. P. Verifier	NJC

795-334
795-2047



FLORIDA DEPARTMENT OF STATE
Sandra B. Mortham
Secretary of State

January 30, 1995

Andrew C. Greenberg, Esquire
Carlton, Fields, et al.
P.O. Box 3239
Tampa, FL 33601

SUBJECT: SPECIALIST AND DESIGN
Ref. Number: W95000002047

We have received your document for SPECIALIST AND DESIGN and your check(s) totaling \$87.50. However, the enclosed document has not been filed and is being returned for the following correction(s):

We must deny registration; there is a federal registration on file with the U.S. Patent and Trademark Office for THE SPECIALIST, Registration Number 1,127,081, for the same or similar name and class(es).

Enclosed is an application for refund.

If you have any questions concerning the filing of your document, please call (904) 487-6918.

Nanette Causseaux
Corporate Specialist Supervisor

Letter Number: 195A00003758

AFFIDAVIT

STATE OF FLORIDA
COUNTY OF HILLSBOROUGH

BEFORE ME, the undersigned authority duly authorized to administer oaths, personally appeared Ronald P. Chenoweth, Sr. ("Affiant"), who being first duly sworn, on oath deposes and says that:

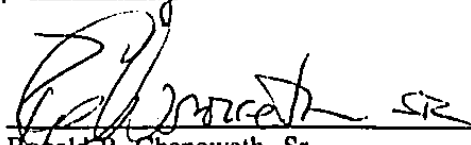
1. I am the President of Specialist Automotive Marketing, Inc., a Florida corporation.

2. The market for direct mail and advertising agency services is of an entirely different kind and nature from the market for employment agency services. In particular, the services provided are essentially different, as are the established and likely-to-continue trade channels, conditions under which sales are made, and buyers to whom sales are made.

3. I have no knowledge or information of any evidence of actual confusion whatsoever arising from the use by the registrant of **THE SPECIALIST** for employment agency services with the use by Specialist Automotive Marketing, Inc. and its predecessors in interest of **SPECIALIST**, since February 1, 1993, and **SPECIALIST and Design**, **SPECIALIST AUTOMOTIVE MARKETING**, and **SPECIALIST AUTOMOTIVE MARKETING and Design**, since August 2, 1994, for direct mail and advertising services.

Further Affiant saith not.

Dated the 20 day of February, 1995.



Ronald P. Chenoweth, Sr.
777 S. Harbour Island Blvd., Suite 950
Tampa, Florida 33602

THE FOREGOING INSTRUMENT was sworn to, subscribed and acknowledged before me this 20 day of February, 1995, by Ronald P. Chenoweth, Sr., as President(ite) of Specialist Automotive Marketing, Inc., a Florida(state) corporation, on behalf of the corporation. He/She [please check as applicable] / He / is personally known to me, or ~~has~~ produced / / his/her (state) driver's license, or / / his/her (type of identification) as identification, and did take an oath.

Karen H Schmidt

(Signature)

Karen H Schmidt

(Printed name)

(NOTARIAL SEAL)

NOTARY PUBLIC, STATE OF FLORIDA

MY COMMISSION EXPIRES: May 23, 1995.

(Commission Expiration Date)

(Serial Number, if Any)

FLORIDA DEPARTMENT OF STATE
DIVISION OF CORPORATIONS

In re Application of:

Specialist Automotive Marketing, Inc.

Serial No.: W95000002947
Filed: January 23, 1995
Mark: SPECIALIST and Design

Response to Office Action
Letter Number: 195A00003758

Examiner: Nanette Causseaux
Corporate Specialist Supervisor

Dear Ms. Causseaux:

We represent Specialist Automotive Marketing, Inc. (the "Applicant") in the above-captioned application for registration of **SPECIALIST and Design** (the "Mark") as a service mark, pursuant to Chapter 495, Florida Statutes. In letter number 195A00003758, the Examiner denied registration on the ground that **SPECIALIST and Design** is similar to a federally registered service mark, **THE SPECIALIST** (the "Cited Mark"), Registration Number 1,127,081. The Applicant greatly appreciates the courtesies extended during a telephone conference with Applicant's attorney. In light of that discussion, Applicant hereby and respectfully requests in writing that the examiner reconsider and register the requested service mark, on the following ground:

SPECIALIST and Design is registerable under section 495.021, Florida Statutes, because the uses of that mark for advertising agency services are not likely to cause confusion, mistake or to deceive with respect to the uses of **THE SPECIALIST** for employment agency services.

In the following discussion, substantial reliance will be made upon authority interpreting the Trademark Act of 1946, as amended, 15 U.S.C. §§ 1051-1127 (the "Trademark Act") Although this application is made under Chapter 495, Florida Statutes, and not under the Lanham Act, Chapter 495 provides that:

Construction of chapter.--It is the intent of the Legislature that, in construing this chapter [495], due consideration and great weight be given to the interpretation of the federal courts relating to comparable provisions of the Trademark Act. . . .

§ 495.181, Fla. Stat. (1993).

ANALYSIS

SPECIALIST and Design IS REGISTERABLE UNDER SECTION 495.021, FLORIDA STATUTES, BECAUSE THE USES OF THAT MARK FOR ADVERTISING AGENCY SERVICES ARE NOT LIKELY TO CAUSE CONFUSION, MISTAKE OR TO DECEIVE WITH RESPECT TO THE USES OF THE SPECIALIST FOR EMPLOYMENT AGENCY SERVICES.

Applicant respectfully submits that the **SPECIALIST and Design** should be registered Under Section 495.021, Florida Statutes (1993). The examiner denied registration because "there is a federal registration on file with the U.S. Patent and Trademark Office for **THE SPECIALIST**, Registration Number 1,127,081, for the same or similar name and class(es)." Of course, the Examiner's initial impression that the two marks are similar was entirely accurate: **SPECIALIST and Design** comprises in whole the word "specialist", which word is part of the composite Cited Mark, **THE SPECIALIST**.

However, Section 495.021 does not state any ground upon which a registration may be rejected merely for being the "same or similar" to another mark or name.^{1/} The statute clearly states that the appropriate standard to determine registrability of a new mark based upon an existing mark is to determine if the new mark

Consists or comprise[s] a mark which so resembles a mark . . . previously used in this state by another and not abandoned, as to be likely, when applied to the goods or services of the applicant, to cause confusion or mistake or to deceive.

§ 495.021(f), Fla. Stat. (1993) (emphasis added).

The appropriate test, therefore, is not whether there is mere similarity of names or classes, but whether the two marks, when used with their services, respectively, are likely to create confusion as to the source or origin of those services.

Standard for Registrability --

Likelihood of confusion arising from similarity of two marks requires consideration of the factors enumerated in In re E.I. DuPont DeNemours & Co., 476 F.2d 1357 (CCPA 1973). There, the Court of Customs and Patent Appeals discussed likelihood of confusion, and listed

^{1/} The only reference to the phrase "same or similar" with regard to registrability can be found in Section 495.021, which provides that

Registration shall not be denied solely on the basis of reservation or registration by another of a corporate name or fictitious name that is the same or similar to the mark for which registration is sought.

§ 495.021(f), Fla. Stat. (1993) (emphasis added).

thirteen factors to be considered in determining likelihood of confusion, which factors include the following:

- (1) The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression;
- (2) The similarity or dissimilarity and nature of the goods or services as described in an application or registration or in connection with which a prior mark is in use;
- (3) The similarity or dissimilarity of established, likely-to-continue trade channels;
- (4) The conditions under which and buyers to whom sales are made;
- (5) The fame of the prior mark (sales, advertising, length of use);
- (6) The number and nature of similar marks in use on similar good; and
- (7) The length of time during and the conditions under which there has been concurrent use without evidence of actual confusion.

See DuPont, 476 F.2d at 1360-62; § 495.181, Fla. Stat. (1993); see also Rules of the Department of State Division of Corporations: Trademark Examining Procedures § 305.01 (1994 draft ed.) [hereinafter Fla. T.E.P. Draft].

Dissimilar Services and Dissimilar Markets --

Under DuPont, even marks that are identical in sound or appearance often create sufficiently different impressions when applied to the respective parties goods or services. See e.g., In re Sears, Roebuck and Co., 2 U.S.P.Q.2d 1312 (TTAB 1987) (CROSS-OVER for bras not likely to be confused with CROSSOVER for ladies' sportswear); In re British Bulldog, Ltd., 224 U.S.P.Q. 854 (TTAB 1984) (PLAYERS for men's underwear not likely to be confused with PLAYERS for shoes); In re Sydel Lingerie Co., Inc., 197 U.S.P.Q. 629 (TTAB 1977)

(BOTTOMS UP for ladies' and children's underwear not likely to be confused with BOTTOMS UP for men's clothing). Indeed, the United States Patent and Trademark Office has granted federal registrations for THE SPECIALIST, cited by the examiner and THE SPECIALISTS, LTD., REG. NO. 1,522,870, Jan. 31, 1989 in Class 35, notwithstanding the nearly identical appearance of those marks. Further examples of other similar or identical marks federally registered in Class 35 appear below and in Appendix B.

In the case of SPECIALIST and Design and THE SPECIALIST, the nature of the services and their respective trade channels are entirely different. Although, at first glance, the services for the two marks appear similar to the extent they both appear in the same class, it must be noted that Class 35 is remarkably broad in scope, and encompasses vastly differing markets for services, including those from "account auditing" to "xerography services." See International Trademark Association, U.S. Patent and Trademark Office Acceptable Identification of Goods and Services Manual 503, 513 (1991). Upon more careful examination, it can be seen from the service descriptions alone, that the marks are directed to services that are by their nature dissimilar, which services are in turn directed to dissimilar markets and channels of distribution. Indeed, the very name of the Class 35 category, "advertising and business", suggests that advertising services and business services are two separate services. In this case, the Mark is used for advertising services while THE SPECIALIST is used for very different business services.

In particular, the application for the Mark states that SPECIALIST and Design has been used for

Direct mail and advertising agency services,

while the Westlaw listing, attached hereto as Appendix A, of the registration for 'THE SPECIALIST' shows that 'THE SPECIALIST' is instead used for

Employment agency services.

The Applicant suggests that these services are entirely different in nature: direct mail and advertising agencies entail preparation of advertising materials and their distribution to targeted customers through appropriate advertising channels for their client businesses; employment agency services presumably entail the location and placement of employees. The services are directed to entirely different marketplaces: the Applicant will seek out companies that would benefit from direct mail advertising of such company's goods and services; the employment agency presumably seeks out companies that would benefit from employee identification and placement services. Any commonality between the respective customer bases would be entirely incidental. These facts are attested to in the Affidavit attached hereto as Exhibit C.

The likelihood of confusion or mistake must exist as to the purchasers, or the purchasing public, for the particular goods or services on which the marks are used. Section 495.181, Fla. Stat. (1993); 15 U.S.C. § 1052(d); see also Fla. T.E.P. Draft § 305.01. In the present case, the conditions under which and buyers to whom sales are made are entirely different. As noted before, there is no reasonable basis to conclude that a customer who is likely to want to hire an employee will be more or less likely to be desirous of acquiring advertising or direct mail services.

Moreover, these marks are different in meaning and appearance, however similar in spelling they might appear. While 'THE SPECIALIST' appears to appeal to the notion of a "specialist," that is, an expert in providing employment agency services, the Applicant's mark

is designed to refer to its "special list", a particularly effective mailing list of names that it uses with its direct mail and advertising agency services. This distinction is evidenced in the presentation of the design of the Applicant's mark, which uses a stylized and slanted "LIST" to separate the use of the two words.

The Cited Mark is Weak, Given the Multiplicity of Registered Marks and Applications Using the Word "Specialist" --

The DuPont factors include the number and nature of similar marks in use on similar goods, and the strength of the mark. See DuPont, 476 F.2d at 1360-62. Applicant suggests that this factor also militates allowance of registration in this case. A unitary mark is not likely to be confused with a composite mark incorporating the unitary mark when there exists a number of composite marks also sharing that unitary feature, even where both marks are used in the same market. See Giorgio Beverly Hills, Inc. v. Revlon Consumer Prods. Corp., 869 F. Supp. 176 (S.D.N.Y. 1994) (holding RED not likely to be confused with CHARLIE RED, both used for perfumes, in light of the multiplicity of marks using the word "red"). As seen in Appendix B, attached hereto, many federal registrations and applications for registrations in Class 35 incorporate or have incorporated the word "specialist." These include some marks that are nearly identical to **THE SPECIALIST**, such as:

THE SPECIALISTS LTD.	Reg. No. 1,522,870	JAN. 31, 1989
THE SPECIALIST'S SPECIALIST	Ser. No. 74-420,801	-not registered-
TECH SPECIALISTS	Reg. No. 1,498,884	AUG. 2, 1988
THE LOCAL SPECIALIST	Reg. No. 1,265,940	JAN 31, 1984
SPECIALISTS ON CALL	Reg. No. 1,678,763	Mar. 10, 1992
MACSPECIALISTS	Reg. No. 1,640,752	Apr. 9, 1991

These marks and registrations are just a few of the registrations and applicants using the word "specialist" in section 35.^{2/} Many more examples exist in other classes. The Applicant submits that if **THE SPECIALISTS LTD.** is not considered so inherently likely to cause confusion because of similarity with **THE SPECIALIST**, then it cannot reasonably be said that the Applicant's application for registration for use with entirely different services in an entirely different marketplace could create such likelihood of confusion.

To the extent that similar marks in Class 35 affords protection against these marks regardless of their uses, the failure of the owner of **THE SPECIALIST** to oppose or cancel those other registrations abandons or weakens the scope of that mark's protection. Even if protection for **THE SPECIALIST** was not abandoned by inaction in light of those subsequent registrations, the protection afforded to a mark with so many "clones" would be so weak as to preclude denial of registration of non-identical marks in non-identical markets. In light of the extent to which the Applicant's mark is used in an entirely different market, with an entirely different meaning, and is not identical to **THE SPECIALIST**, application should not have been refused on likelihood of confusion grounds.

Indeed, even if the Examiner were to take the view that the marketplaces for the respective services used with the Mark and the Cited Mark were similar merely because both services are categorized in Class 35 as "advertising and business services," a view that the

^{2/} Although **THE SPECIALIST'S SPECIALIST** has not yet matured to registration, its publication and registration review have been completed. **THE LOCAL SPECIALIST**, though it was at one time fully registered during the period following registration of **THE SPECIALIST** was later cancelled because the registrant failed to file a Section 8 affidavit during the sixth year following registration, and not because of substantive issues related to the mark **THE SPECIALIST** itself.

Applicant respectfully suggests is inconsistent with commercial reality, the DuPont test would still permit registration in this case. Another of the DuPont factors cited above is the number and nature of similar marks in use on similar services. 476 F.2d at 1360-62. Here, the multiplicity of similar marks in Class 35 (to the extent that co-existence in a class can be considered to render services similar), taken in combination with the other facts and factors discussed above further points to a finding that there is no likelihood of confusion, and that the application is in condition for allowance.

No Evidence of Actual Confusion --

Still another DuPont factor is the length of time and conditions under which there has been concurrent use without evidence of actual confusion. As attested to in the Affidavit attached hereto as Exhibit C, The Applicant has no knowledge or information of any actual confusion between **THE SPECIALIST**, used for employment agency services, and the Mark and similar marks used by the Applicant and its predecessors in interest to the Mark since February, 1993, used for direct mail and advertising agency services.

CONCLUSION

The Applicant submits that because **SPECIALIST** and Design is applied for use with entirely different services in an entirely different marketplace than those services and marketplaces set forth in the registration of **THE SPECIALIST**; and because there is an abundance of registrations in Class 35 incorporating the word "specialist", including marks nearly identical to **THE SPECIALIST**, the latter mark should not be cited against the present application for registration on likelihood of confusion grounds under DuPont. In light of this, Applicant's application is in condition for allowance. Therefore, the Applicant respectfully requests that the Examiner and Department of State reconsider the Examiner's rejection of the present application, and that the application be permitted at this time to mature to registration.

Respectfully Submitted,

CARLTON, FIELDS, WARD, EMMANUEL,
SMITH & CUTLER, P.A.

By: Andrew C. Greenberg



Florida Department of State, Jim Smith, Secretary of State

APPLICATION FOR THE REGISTRATION OF A TRADEMARK OR SERVICE MARK

PURSUANT TO CHAPTER 495, FLORIDA STATUTES

TO: Division of Corporations
Post Office Box 6327
Tallahassee, FL 32314

Name & address to whom
acknowledgement should be sent:

Andrew C. Greenberg, Esq.
Carlton, Fields, Ward, et al.
PO Box 3239

Tampa, FL 33601

(813) 223-7000
Daytime Telephone number

PART I

1. (a) Applicant's name: Specialist Automotive Marketing, Inc.
- (b) Applicant's business address: 777 S. Harbour Island Blvd., Suite 950
Tampa, Florida Zip: 33602
- (c) Applicant's telephone number: (813) 228-0080

- Individual Corporation Joint Venture Other: _____
 General Partnership Limited Partnership Union

If other than an individual,

- (1) Florida registration number: P94000062931
- (2) Federal Employer Identification Number: 59-3263006
- (3) Domicile state: Florida

2. (a) If the mark to be registered is a service mark, the services in connection with which the mark is used: (i.e., furniture moving services, diaper services, house painting services, etc.)
Direct mail and advertising agency services.

(b) If the mark to be registered is a trademark, the goods in connection with which the mark is used: (i.e., ladies sportswear, cat food, barbeque grills, shoe laces, etc.)

(c) The mode or manner in which the mark is used: (i.e., labels, decals, newspaper advertisements, brochures, etc.)
By imprinting the mark on advertising materials, stationery, business cards,
brochures and other means customary in the trade.

(Continued)

(d) The class(es) in which goods or services fall:
35

PART II

1. Date first used by the applicant, predecessor, or a related company (month, day and year):
- (a) Date first used anywhere: August 2, 1994
- (b) Date first used in Florida: August 2, 1994

FILED
MAR 1 1995
TALLAHASSEE, FLORIDA
SECRETARY OF STATE

PART III

1. The mark to be registered is: (If logo/design is included, please give brief written description which must be 25 words or less.)
- SPECIALIST and DESIGN OF STYLIZED LETTERS, WITH LETTERS "LIST" SLANTED, ABOVE DIAGONAL
- MOSAIC PATTERN RESEMBLING TIRE TREADS THAT IS COMPRISED OF SILHOUETTED AUTOMOBILES

2. DISCLAIMER (if applicable)

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE THE TERM " _____ " APART FROM THE MARK AS SHOWN.

I, _____, being sworn, depose and say that I am the owner and the applicant herein, or that I am authorized to sign on behalf of the owner and applicant herein, and no other person except a related company has the right to use such mark in Florida either in the identical form or in such near resemblance as to be likely to deceive or confuse or to be mistaken therefor. I make this affidavit and verification on my/the applicant's behalf. I further acknowledge that I have read the application and know the contents thereof and that the facts stated herein are true and correct.

Ronald P. Chenoweth
Typed or printed name of applicant

[Signature]
Applicant's signature or authorized person's signature
(List name and title)

STATE OF FLORIDA
COUNTY OF HILLSBOROUGH

On this 17 day of JANUARY, 19 95, RONALD P. CHENOWETH personally appeared before me,

- who is personally known to me
- whose identity I proved on the basis of _____

FILED
95 JAN 18 1995
TALLAHASSEE, FLORIDA
SECRETARY OF STATE
26

[Signature]
Notary Public Signature
KAREN H SCHMIDT
Notary's Printed Name

Seal

My Commission Expires: _____

FEE: \$87.50 per class

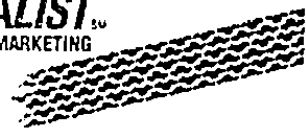
NOTARY PUBLIC, STATE OF FLORIDA,
MY COMMISSION EXPIRES MAY 22, 1995.
BOOK 1188 NOTARY PUBLIC UNDERWRITERS.

TARGET MARKETING AT IT'S BEST...



**SPECIALIST DIRECT MAIL &
TELEMARKETING SERVICES**

SPECIALISTSM
AUTOMOTIVE MARKETING



CONTENTS

SECTION A

DIRECT MAIL CAMPAIGN

- Program Overview
- List Specifics
- Sample Database
- Sample Mail Pieces
- Event Preparation Check List

SECTION B

TELEMARKETING PROGRAM

- Telemarketing is a Numbers Game
- Telemarketing Instructions
- Telemarketing Script
- Telemarketing Tips
- Common Objections
- Telemarketing Call Record
- Telemarketing Appointments Schedule

SECTION C

SERVICE DEPARTMENT DIRECT MAIL PROGRAM

SECTION D

VARIOUS "TURN KEY" PROGRAMS