In the United States Patent and Trademark Office

In Re Application of	:	
Serial Number	:	88286831
Mark	:	IRCON
Applicant	:	Argynnis Group AB
Law Office	:	113

Our Ref: 332.257

Response to Office Action

The following is in response to the Office Action issued on April 23, 2019, in connection with above identified trademark application. All issues raised in the office action are addressed herein.

Identification of goods

The Examining Attorney stated that certain items in the identification of goods were indefinite. The applicant has amended the identification of goods to clarify the nature of the goods in question. The identification of goods has also been amended to indicate that applicant's goods are for industrial use and that certain of applicant's good relate to "infrared emitters." The applicant' hereby amends the Class 9 identification of goods to read as follows:

Class 9:

Industrial cooking ovens; Industrial ovens for industrial use; Industrial curing oven for paper industries; Industrial curing oven for metal industries; Gas generating furnaces for industrial use; Industrial curing ovens, not for food or beverages; furnaces not for food or beverages; Heating apparatus for furnaces, namely, furnace boilers; Shaped fittings for ovens, namely. spark igniters for gas ovens; Curing ovens for use in the paper, board, metal and food industries; Curing ovens as a drying solution; Electric cooking ovens for household use; Gas fired water heaters; Thermal treatment furnaces; Gas fired combined furnaces for use in the production of steel; Gas fired combined hearth-type and shaft furnaces for use steel production; Gas fired space heating apparatus; Furnaces for industrial use; Infrared emitter radiation units for drying adhesives for use in automated manufacturing process in the nature of thermal spot curing systems for industrial use; Industrial drying installations, namely, forage drying apparatus; Industrial installations for airing, namely, ventilating fans for industrial purposes; Industrial apparatus for drying, namely, forage drying apparatus; Industrial gas operated devices using air for drying components in the electronics, semiconductor, circuit board, pharmaceutical, medical, and food and beverage industries; Infrared heating panels used for indoor heating purposes for industrial use; Infrared radiators for industrial use; Incinerators; Heat generating apparatus, namely, heat generators; Steam heating apparatus for industrial or commercial purposes; Burners, namely, gas burners, Oxyhydrogen burners; Oil and gas burners for industrial use; Industrial electric heat-treating furnaces; Gas fired furnaces for industrial purposes; Gas operated apparatus for heating water for industrial purposes; Gas fired heating installations; Gas pre-heating apparatus in the nature of igniters for industrial use; Industrial heating installations; Industrial heating apparatus for industrial use in the nature of heating furnaces; Industrial water heaters; Microwave ovens for cooking; Microwave ovens for industrial purposes; Gas fired infrared burners for industrial use, boilers and heaters; Heating units for industrial purposes; Heating apparatus for industrial drying of coatings and lacquers; Electric food dehydrators; Electrically operated apparatus used in drying fodder and forage; Portable electric warm air dryers; Industrial air drying installations for electronics; Drying apparatus and installations for laundry; Industrial furnaces; Gas burners for industrial purposes; Industrial cooking ovens; Industrial cooking installations in the nature of ovens; Industrial heating furnaces; Heating installations for industrial use; Heating installations for use with gaseous fuels; Gas fire radiants, namely, indoor gas radiant heating systems; Electric radiant heaters for household purposes and parts therefor, namely, fans; Electric radiant heaters for household purposes; Gas space heaters; Hot water heaters; Electric cooking ovens; Hot water heating installations; Infrared lamps for industrial use; Industrial air drying apparatus for electronics; Industrial and commercial infrared air drying installations for metal drying purposes; Industrial and commercial infrared air drying apparatus for metal drying purposes in industrial use; Infrared Furnaces for industrial use

Foreign registration

The Examining Attorney stated that the applicant must submit a certified copy of the corresponding foreign registration. The applicant herewith submits a certified copy of the foreign registration.

Refusal to Register

The Examining Attorney has refused registration in view of Registration Numbers 4874380 and 1421788. The applicant is of the opinion that in view of the amended identification of goods there is no likelihood of confusion between the applicant's mark and the cited registrations.

In determining likelihood of confusion under Section 2(d), the Office uses a 13-factor test originally enumerated by the CCPA in 1973. These factors (the "Du Pont" factors) are:

(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, that is, "impulse" vs. careful, sophisticated purchasing;
(5) the fame of the prior mark (sales, advertising, length of use);
(6) the number and nature of similar marks in use on similar goods;
(7) the nature and extent of any actual confusion;

(8) the length of time during, and the conditions under which, there has been concurrent use without evidence of actual confusion;
(9) the variety of goods on which a mark is or is not used (house mark, “family” mark, product mark);
(10) the market interface between applicant and the owner of a prior mark:
    (a) a mere “consent” to register or use,
    (b) agreement provisions designed to preclude confusion, that is, limitations on continued use of the marks by each party,
    (c) assignment of mark, application, registration, and goodwill of the related business,
    (d) laches and estoppel attributable to owner of prior mark and indicative of lack of confusion;
(11) the extent to which applicant has a right to exclude others from use of its mark on its goods;
(12) the extent of potential confusion, that is, whether de minimis or substantial; and
(13) any other established fact probative of the effect of use.

It is the position of the applicant that when applying the above test to the marks at hand there is no confusion between applicant’s and registrant’s marks. Applicant’s amendment to the identification of goods makes it clear that the applicant’s and the registrant’s goods are not related and do not flow in the same channels of trade. The registrant’s goods are in the nature of “infrared radiation thermometers and pyrometers; line scanners; thermal imaging systems for medical use” which are used to measure temperature. While the applicant’s goods are industrial drying ovens and “infrared emitters” which are used to dry out water in large drying installations. The goods of the parties are not the same and one could not be substituted for the other, in that the goods of the applicant and registrant both have different purposes and uses. Therefore, it is submitted that applicant’s goods and registrant’s goods are not related and the refusal to registered should be withdraw.

One of the factors used in determining the issue of likelihood of confusion is the class of purchasers to which the goods are sold. It is submitted that in view of the nature of applicant’s

and registrant’s goods they would not be sold to the ordinary consumer but would rather be sold to and purchased by sophisticated customers which specific and focused purposes.

Sophisticated consumers are generally expected to exercise greater care in their field of expertise and so are less likely to be confused. The same is often true of professional buyers. Various factors increase the care they exercise— training; cost of the goods; volume of the purchase; inspection; testing. See; Racemark Int’l, Inc. v. Specialty Prods., Inc., 217 U.S.P.Q. 772, 780 (N.D.N.Y. 1982) (large-volume purchases by professional buyers); Oreck Corp. v. U.S. Floor Sys., Inc., 803 F. 2d 166, 231 U.S.P.Q. 634, 640 (5th Cir. 1986); Blue Bell Bio-Med. v. Cin-Bad, Inc., 864 F. 2d 1253, 9 U.S.P.Q. 2d 1870, 1876 (5th Cir. 1989) (field testing); Accuride Int’l, Inc. v. Accuride Corp., 871 F. 2d 1531, 10 U.S.P.Q. 2d 1589, 1594 (9th Cir. 1989) (purchasers were technically trained). It is clear from the identification of goods of both the applicant and the registrant that the purchases of the goods of the parties would be professional buyers and would most likely have received specific training in their field of expertise. They would also be conserned with costs. Thus, further eliminating any likelihood of confusion between the marks.

A purchaser will be expected to exercise more care and thus eliminate the issue of likelihood of confusion where the purchaser has a reasonably focused need or a specific purpose of plan involving the product. See; Haydon Switch & Instrument, Inc. v. Rexnord, Inc., 4 U.S.P.Q. 2d 1510, 1517 (D. Conn. 1987) (specific products for specific industrial purpose); G.H. Mumm & Cie v. Desnoes & Geddes, Ltd., 917 F. 2d 1292, 16 U.S.P.Q. 2d 1635, 1638 (Fed. Cir. 1990) (“ focussed need” for champagne); Cliffs Notes, Inc. v. Bantam Doubleday Dell Publ’g Grp., Inc.,

886 F. 2d 490, 496, 12 U.S.P.Q. 2d 1289, 1293 (2d Cir. 1989) (“ A prospective reader of Cliffs Notes probably has a specific book in mind when going to the bookstore for a study guide.”); Munters Corp. v. Matsui Am., Inc., 730 F. Supp. 790, 14 U.S.P.Q. 2d 1993, 2000 (N.D. Ill. 1989) (“ planning”), aff’d, 909 F. 2d 250, 15 U.S.P.Q. 2d 1666 (7th Cir. 1990).

In the case at hand due to the nature of the both parties’ goods and the fact that both the applicant’s goods and the registrant’s goods are directed to industrial purchases, said purchasers would be expected to exercise more care when purchasing the product, thus eliminating any likelihood of confusion. The buyers of applicant’s and registrant’s goods would be sophisticated in nature and thus would exercise more care. As stated above both parties would be expected to have received training. The parties most likely would also be concerned with the cost of the goods. There could also be additional inspection and testing of the goods of respective parties. All of the above factors leading to the conclusion that there is less likelihood of confusion when purchasing the products of the registrant and applicant.

Another factor in determining the extent of care is if the product is essential to the customer’s business needs. See; Checkpoint v. Check Point, 269 F. 3d 270, 60 U.S.P.Q. 2d 1609, 1618 (3d Cir. 2001). In view of the nature of the products, being industrial in nature such items by their very nature would be essential to the customer’s business needs. Thus, the parties would exercise more care when purchasing either applicant’s or registrant’s goods, further eliminating the likelihood of confusion.

Even if the goods were to be purchased by the same institution or class of purchases does not, by itself, establish similarity of trade channels or market overlap resulting in likelihood of confusion. See; Elec. Design & Sales, Inc. v. Elec. Data Sys. Corp., 954 F. 2d 713, 21 U.S.P.Q. 2d 1388, 1391 (Fed. Cir. 1992); Hewlett-Packard Co. v. Human Performance Measurement, Inc., 23 U.S.P.Q. 2d 1390, 1395 (T.T.A.B. 1991) (" the fact that both parties sell their goods to hospitals, and thus share a common channel of trade, does not necessarily mandate a finding that the products are related and that confusion is likely"); NEC Elecs., Inc. v. New England Circuit Sales, Inc., 722 F. Supp. 861, 865, 13 U.S.P.Q. 2d 1058, 1061 (D. Mass. 1989) (" although the parties may each deal with some of the same companies, there is no significant likelihood of confusion among purchasers because each party deals with different departments and individuals"), following Astra Pharm. Prods., Inc. v. Beckman Instruments, Inc., 718 F. 2d 1201, 220 U.S.P.Q. 786 (1st Cir. 1983).

A large institution such as a factory or hospital with diverse requirements buys a myriad of different and unrelated products. The products may be used in physically separate facilities serving different needs and composing separate departments. These in effect are different markets. See; Elec. Data Sys. Corp. v. EDSA Micro Corp., 23 U.S.P.Q. 2d 1460, 1465 (T.T.A.B. 1992); Life Techs., Inc. v. Gibbco Sci., Inc., 826 F. 2d 775, 776, 3 U.S.P.Q. 2d 1795, 1796 (8th Cir. 1987) (" Although they share many common customers, [the parties] supply different products to them and in all but the smallest laboratories these products are used in physically separate facilities.").

As the TTAB stated in dismissing an opposition:

> If all that is necessary to establish a likelihood of confusion . . . is to show that factories and plants purchase the goods of both parties to the proceeding, we would be overlooking the distinctly different character of the goods as well as a well-established fact that commercial and industrial plants purchase a large and diverse number of products, including many unrelated products ranging from products to maintain a restroom up to complicated pieces of machinery, with the result that we would be, in essence, bestowing upon a prior user a right in gross in the mark which is contrary . . . to establish principles of trademark law.

See; Elec. Design & Sales, Inc. v. Elec. Data Sys. Corp., 954 F. 2d 713, 717, 21 U.S.P.Q. 2d 1388, 1391 (Fed. Cir. 1992) ("The likelihood of confusion must be shown to exist not in a purchasing institution, but in 'a customer or purchaser.'") (emphasis in original); Calypso Tech., Inc. v. Calypso Capital Mgmt., LP, 100 U.S.P.Q. 2d 1213, 1221 (T.T.A.B. 2011).

In view of the above it has been established that applicant's and registrant's goods are not related nor are they sold to the same class of purchasers. Applicant's amended identification of goods makes it clear that the products of the parties are not related and do not flow in the same channels of trade.

Even if the goods of the parties were to be sold to the same class of purchases, such purchases would be sophisticated in nature and would exercise a high degree of care thus further eliminating any potential likelihood of confusion. If view of the above the Examining Attorney is requested to withdraw the refusal.

Conclusion

It is the opinion of the applicant that all issues raised in the office action have been addressed. Further it has been established that there is no likelihood of confusion between applicant's and registrant's mark. The Examining Attorney is requested to withdraw the refusal and approve the applicant for publication.

Respectfully submitted,

/Michael J Hynak/

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