

BEFORE THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Alamo Group, Inc.

Mark: TIGER SHARK

Serial No.: 87/559,077

Filing Date: August 7, 2017

Examining Attorney: SOUDERS, Michael J

Law Office: 115

REQUEST FOR RECONSIDERATION AFTER FINAL ACTION

The following amendment and accompanying remarks are filed in response to the Final Office Action dated May 29, 2018 (the “*Final Action*”), in the above-captioned application.

AMENDMENT

Please amend the above-captioned application as follows:

Agricultural machinery replacement sickles and sickle sections for combine harvesters, mowers, windrowers and mower conditioners, all marketed and sold only to machinery manufacturers through wholesale and commercial retail channels of trade.

REMARKS

The Final Action maintains and makes final the refusal to register Applicant’s mark on the ground that it is allegedly confusingly similar, within the meaning of § 2(d) of the Federal Trademark Act, to U.S. Registration No. 5,003,951 of the mark TIGER SHARK (Stylized) (the “*951 Registration*”). For the reasons stated below, Applicant requests reconsideration and withdrawal of the likelihood of confusion objection.

The Final Office Action contends that Registrant’s identification of goods is broad enough in scope to include Applicant’s goods. Specifically, the Final Action states, “[t]he registrant’s goods encompass goods identical to those of the applicant. Specifically, the registrant

manufactures ‘sickles’ and the applicant manufactures ‘sickles’ and ‘sickle sections.’” *Final Office Action dated May 29, 2018*. For easy reference, the table below lists the parties’ goods, and their correlating International Class, as recited in their respective pending application and trademark registration:

	TIGER SHARK (Application Serial No. 87/559,077)	<i>TIGER SHARK</i> (U.S. Registration No. 5,003,951)
International Class	(machines, machine tools, motors and engines) 07	(hand tools) 08
Goods	(as amended) Agricultural machinery replacement sickles and sickle sections for combine harvesters, mowers, windrowers and mower conditioners, <u>all marketed and sold only to machinery manufacturers through wholesale and commercial retail channels of trade.</u>	Bow saws; Digging forks; Forks; Gardening trowels; Hand tools, namely, fruit pickers; Hand tools, namely, picks; Hand tools, namely, rammers; Hand-operated agricultural implements, namely, broadforks; Hatchets; Hoes; Lawn and garden tools, namely, cultivators; Mattocks; Pickaxes; Rakes; Saws; Scythes; Shovels; Sickles; Spades; Weeding forks

CLASS OF 07 SICKLES ARE INHERENTLY DIFFERENT.

The arguments presented in support of a finding of a likelihood of confusion hinge on the misbelief that Applicant’s goods and those recited in the ’951 Registration are so similar the average purchaser would believe they emanate from a single source, stating, “[t]he registration uses broad wording to describe sickles, which presumably encompasses all goods of the type described, including applicant’s more narrow list relevant narrower goods.” *Id.* The Final Action cites *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1369 (quoting *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1724 (TTAB 2007)), to bolster the position that the most oblique

connection between goods is enough to meet the threshold of a likelihood of confusion, particularly stating that “[t]hey need only be ‘related in some manner and/or if the circumstances surrounding their marketing are such that they could give rise to the mistaken belief that [the goods and/or services] emanate from the same source.’”

However, Applicant contends that although *Coach Servs., Inc. v. Triumph Learning LLC* does read as the Examining Attorney recites, that portion of the decision from the United States Court of Appeals for the Federal Circuit is misplaced and certainly is not dispositive in the present case. More appropriately, *Coach Servs.* supports TMEP § 1207.01(a)(i) which says, “...if the goods or services in question are not related or marketed in such a way that they would be encountered by the same persons in situations that would create the incorrect assumption that they originate from the same source, then, even if the marks are identical, confusion is not likely.” Such is the case here.

As *Coach* illustrates, a test for finding the relatedness of goods is the marks’ marketing. In Applicant’s case, the consumer to which they market is a well-informed, sophisticated buyer who uses considerable care in making the purchase. Applicant’s goods are intended to be utilized in agricultural machinery that costs many thousands of dollars, and the user of the type of agricultural machinery described in the applied-for goods understands the differences in marketing to commercial enterprises.

In the same way, the consumer of the goods described in the ’951 Registration will not mistakenly believe the product originates from the same source as their exposure to the marking of Applicant’s goods would have to be intentional – that is, they would have to go looking for Applicant’s products. Concerns of cross exposure of the parties’ goods is mitigated by the specificity of the marketing used to promote the products.

APPLICANT’S AND REGISTRANT’S GOODS ARE INHERENTLY DEFINED

The Final Action claims that because the ’951 Registration contains no such restriction as to nature, type, channels of trade, or classes of purchasers, they are presumed to travel in the same channels of trade and to the same class of purchasers as Applicant’s. Specifically, the Final Action states, “[t]he registration identifies ‘sickles’ broadly and does not restrict the goods to hand tools or agricultural machinery parts. As such, the registration includes the goods of the applicant.” On traversal, the registration *is* restricted to hand tools by the very nature of the International Class in which the goods are registered. The headings for International Class 08 (hand tools) and that for International Class 07 (machinery; and agricultural implements, *other than hand-operated hand tools*) (emphasis added), creates a distinction between where the two sets of goods reside and overcomes the argument that the specific nature of Registrant’s sickle is not identified.

The Nice Classification, established by the Nice Agreement (1957), and the subsequent editions, describe goods identified in International Class 07 as: *Machines, machine tools, power-operated tools; motors and engines, except for land vehicles; machine coupling and transmission components, except for land vehicles; agricultural implements, other than hand-operated hand tools; incubators for eggs; automatic vending machines*. Attached as Exhibit A is a printout from the World Intellectual Property Organization’s (WIPO) website explaining the official criteria for determining which goods belong in Class 7. As previously stated, Applicant’s goods are commercial in nature and built to be utilized in conjunction with heavy, motor-driven machines. Applicant’s goods are made up of a variety of components that are assembled in lengths up to 40 feet and used in mechanical agricultural machines like combines, windrowers, swathers, and

mower conditioners. The mechanically driven sickle on these types of machines is what cuts crops and forage.

REAL-WORLD PRODUCTS ACCENTUATE THE DIFFERENCES

To provide a more definite characterization of Applicant's goods, the first images below are illustrative of Applicant's replacement sickle product that is sold to equipment manufacturers for use in commercial agricultural operations.



The sickle and replacement sickle employed in various types of machinery are found in commercial farming equipment throughout the country. An example of the agricultural application can be seen in the image below.



By way of comparison, the '951 Registration lists a host of tools that are manually powered and not typically used in commercial agriculture. Such implements have their own International Class as directed by the Nice Agreement, entitled "Hand Tools" and described by WIPO as, "[h]and tools and implements, hand-operated; cutlery; side arms, except firearms; razors". Attached hereto as Exhibit B is a printout from the WIPO website explaining the official criteria for determining which goods belong in Class 08. The recited goods and corresponding classification demonstrate the intrinsic differences between the two sets of goods and the resulting distinctions in the minds of the consuming public.

The design and manner of operation of the sickle identified in the '951 Registration is far removed from that of the Applicant's goods. With reference to the illustrations of Applicant's goods, below are two styles of sickles that are demonstrative of the kinds that would be included in International Class 08:



When comparing the goods, the most obvious difference is the physical appearance of each, with Applicant's goods comprising a triangular-shaped toothed blade and the hand tool of the '951 Registration being a handled implement with a curved, "C" shaped blade. Second, because of their physical make-up, each are deployed in distinctive ways with one (Applicant's product) used in

commercial agriculture to cut various crops, and the other for small-scale, personal uses, typically in connection with gardening and tending personal, non-commercial real property.

AMENDMENT EMPHASIZING MARKET DISTINCTIONS

Even though International Class 07 replacement sickles are different than, and inherently marketed through different channels of trade than Class 8 sickles, an amendment to the description of goods is offered to further clarify and emphasize these distinctions. Entry of the amendment is respectfully requested.

CONCLUSION

In conclusion, because the drastically different nature of the hand tool sickle in the '951 Registration is specified by way of the International Class in which it is registered, the goods cannot encompass those of Applicant. Applicant's sickles are agricultural machinery sickles for combine harvesters, mowers, windrowers and mower conditioners, which are marketed and sold only to manufacturers of such machinery through industrial supply channels of trade; whereas, Registrant's sickles are hand tool sickles, which are dramatically different, as clearly shown in the side-by-side comparison below. Thus, there is no likelihood of confusion and no bar to registration. Furthermore, the overall differences in the shape, design and modes of operation – motorized and mechanical versus hand operated – are illustrative of the differences in the goods themselves. Added to that are the differences in industries and by way of extension, the type of consumer, which makes the only commonality between the two products is that they are referred to as a “sickle.”



Therefore, in light of the above remarks, and especially as clarified by the instant amendment, it is believed that the application is in condition for publication and such action is respectfully requested.

EXHIBIT A

[NICE HOME PAGE](#) - [HELP](#) - [GUIDANCE](#) - [DOWNLOAD](#)

EDITION-VERSION
 11-2018

OTHERS

CLASS INDEX

GOODS
[1](#) [2](#) [3](#) [4](#) [5](#) [6](#) [7](#) [8](#) [9](#) [10](#)
[11](#) [12](#) [13](#) [14](#) [15](#) [16](#) [17](#) [18](#) [19](#) [20](#)
[21](#) [22](#) [23](#) [24](#) [25](#) [26](#) [27](#) [28](#) [29](#) [30](#)
[31](#) [32](#) [33](#) [34](#)

SERVICES
[35](#) [36](#) [37](#) [38](#) [39](#) [40](#) [41](#) [42](#) [43](#) [44](#)
[45](#)

Pagination

LANGUAGE
 English
 French
 English/French
 French/English
 Other

LINKS TO TM OFFICES

VIEW MODE
 Flat
 Hierarchical
 Full

SHOW
 Explanatory Notes Basic No.

NCLPUB version: 3.2.9
Last modified: 2018.11.19

- Classes
- Alphabetical
- Class Headings
- General Remarks
- Modifications
- Search

Class 7

Machines, machine tools, power-operated tools; motors and engines, except for land vehicles; machine coupling and transmission components, except for land vehicles; agricultural implements, other than hand-operated hand tools; incubators for eggs; automatic vending machines.

Explanatory Note

Class 7 includes mainly machines and machine tools, motors and engines.

This Class includes, in particular:

- parts of all kinds of motors and engines, for example, starters, mufflers and cylinders for motors and engines;
- electric cleaning and polishing apparatus, for example, electric shoe polishers, electric machines and apparatus for carpet shampooing and vacuum cleaners;
- 3D printers;
- industrial robots;
- certain special vehicles not for transportation purposes, for example, road sweeping machines, road making machines, bulldozers, snow ploughs, as well as rubber tracks as parts of those vehicles' crawlers.

This Class does not include, in particular:

- hand tools and implements, hand-operated (Cl. 8);
- humanoid robots with artificial intelligence, laboratory robots, teaching robots, security surveillance robots (Cl. 9), surgical robots (Cl. 10), robotic cars (Cl. 12), robotic drums (Cl. 15), toy robots (Cl. 28);
- motors and engines for land vehicles (Cl. 12);
- treads for vehicles and tractors (Cl. 12);
- certain special machines, for example, automated teller machines (Cl. 9), respirators for artificial respiration (Cl. 10), refrigerating apparatus and machines (Cl. 11).

- 070555
- 070576
- 070002
- 070004
- 070314
- 070005
- 070056
- 070163
- 070006
- 070386
- 070029
- 070007
- 070008
- 070009
- 070388

- 3D printers
- 3D printing pens
- acetylene cleaning apparatus
- adhesive tape dispensers [machines]
- adhesive bands for pulleys
- aerating pumps for aquaria
- apparatus for aerating beverages
- apparatus for aerating water
- aerocondensers
- aeronautical engines
- aeroplane engines
- agitators
- agricultural machines
- agricultural elevators
- agricultural implements, other than hand-operated
- air condensers
- air cushion devices for moving loads

EXHIBIT B

[NICE HOME PAGE](#) - [HELP](#) - [GUIDANCE](#)
[DOWNLOAD](#)
EDITION-VERSION
 11-2018 ▼

OTHERS
 ---- ▼

CLASS INDEX
GOODS
[1](#) [2](#) [3](#) [4](#) [5](#) [6](#) [7](#) [8](#) [9](#) [10](#)
[11](#) [12](#) [13](#) [14](#) [15](#) [16](#) [17](#) [18](#) [19](#) [20](#)
[21](#) [22](#) [23](#) [24](#) [25](#) [26](#) [27](#) [28](#) [29](#) [30](#)
[31](#) [32](#) [33](#) [34](#)

SERVICES
[35](#) [36](#) [37](#) [38](#) [39](#) [40](#) [41](#) [42](#) [43](#) [44](#)
[45](#)

[Pagination](#)

LANGUAGE
 English
 French
 English/French
 French/English
 Other ▼

[LINKS TO TM OFFICES](#)

VIEW MODE
 Flat
 Hierarchical
 Full

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Last modified: 2018.11.19

[Classes](#) | [Alphabetical](#) | [Class Headings](#) | [General Remarks](#) | [Modifications](#) | [Search](#)

Class 8

Hand tools and implements, hand-operated; cutlery; side arms, except firearms; razors.

Explanatory Note

















Class 8 includes mainly hand-operated tools and implements for performing tasks, such as drilling, shaping, cutting and piercing.

This Class includes, in particular:

- hand-operated agricultural, gardening and landscaping tools;
- hand-operated tools for carpenters, artists and other craftspersons, for example, hammers, chisels and gravers;
- handles for hand-operated hand tools, such as knives and scythes;
- electric and non-electric hand implements for personal grooming and body art, for example, razors, implements for hair curling, tattooing, and for manicure and pedicure;
- hand-operated pumps;
- table cutlery, such as knives, forks and spoons, including those made of precious metals.

This Class does not include, in particular:

- machine tools and implements driven by a motor ([Cl. 7](#));
- surgical cutlery ([Cl. 10](#));
- pumps for bicycle tyres ([Cl. 12](#)), pumps specially adapted for use with balls for games ([Cl. 28](#));
- side arms being firearms ([Cl. 13](#));
- paper knives and paper shredders for office use ([Cl. 16](#));
- handles for objects that are classified in various classes according to their function or purpose, for example, walking stick handles, umbrella handles ([Cl. 18](#)), broom handles ([Cl. 21](#));
- serving utensils, for example, sugar tongs, ice tongs, pie servers and serving ladles, and kitchen utensils, for example, mixing spoons, pestles and mortars, nutcrackers and spatulas ([Cl. 21](#));
- fencing weapons ([Cl. 28](#)).

 080002	abrading instruments [hand instruments]
 080141	adzes [tools]
 080200	agricultural implements, hand-operated
 080220	agricultural forks [hand tools]
 080265	air pumps, hand-operated
 080020	annular screw plates
 080194	augers [hand tools]
 080008	awls
 080069	axes
 080160	metal band stretchers [hand tools]
 080025	bayonets
 080026	beard clippers
 080261	bench vices [hand implements]
 080188	bill-hooks
 080016	bits [parts of hand tools]
 080197	bits [hand tools]

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