

REMARKS

In response to the final Office Action dated December 4, 2019, please enter this Amendment and reconsider this application in view of the amendments and the remarks provided herein. The December 4, 2019 final Office Action continued and maintained the following issues, namely: (1) Applicant's identification of the goods for the term "fittings" was deemed indefinite as it allegedly does not describe what the goods are in common commercial language; and (2) an asserted "likelihood of confusion" issue in connection with U.S. Registration Nos. 2630791 and 2630792.

I. Applicant is Amending the Identification of the Goods and Moving Goods from Companion Application No. 88302145.

Applicant expresses appreciation for the guidance in the Office Action regarding Applicant's identification of the goods. Applicant has amended the identification of the goods patterned after the suggestions made in the Office Action to reflect terminology used in the marketplace, to be acceptably definite, and to satisfy the requirements raised in the Office Action. Thus, no further action by Applicant is believed necessary regarding the identification of the goods for this application.

Applicant notes that support for the goods now recited in this application was present in this application or in the original identification of the goods in a companion application, which was filed for the same mark on the same date (see Application No. 88302145). According to TMEP 1402.08 (Moving Goods and Services Between Companion Applications):

If an applicant has filed separate applications to register the same mark, the applicant may, in a limited situation, amend to move items of goods or services from one application to another, if the application from which the item is to be moved was filed on or before the filing date of the application to which it is to be moved. Such an amendment will be permitted only if some of the goods/services in one application should be classified in a different class and the companion application includes that class.

Specifically, in a final office action for Application No. 88302145 (Applicant's companion application), the Office required Applicant to add International Class 11 to include: "Heat pumps for sterilizers, not for medical purposes; Heat pumps for gas burners; Heat pumps for cooking ovens and stoves; Structural and replacement parts for all the aforementioned goods." Thus, Applicant respectfully submits that such an identification is support for Applicant's amendment, including "Heat pumps for sterilizers, not for medical purposes; Heat pumps for gas burners; Heat pumps for cooking ovens and stoves; Structural and replacement parts for all the aforementioned goods." Accordingly, Applicant is moving that specific identification from Application No. 88302145 into this application, such that no further action by Applicant is believed necessary. Should any issue remain regarding Applicant's identification of the goods after entry of this Amendment and consideration of these remarks, the Examining Attorney is invited to initiate a telephone interview with the attorney of record.

II. There is No Likelihood of Confusion Between Applicant's Mark and the Registrant's Mark Because the Goods are Specialty Products.

The final Office Action refused registration due to an asserted likelihood of confusion with the marks in U.S. Registration Nos. 2630791 and 2630792. Applicant respectfully submits that in view of the amendments to the identification of the goods, the facts, and cited case law presented below there is no likelihood of confusion in this case. Accordingly, Applicant respectfully requests the Office to withdraw the 2(d) issue and allow Applicant's mark to publish.

Applicant respectfully submits that the conclusion in the Office Action that the marks *are confusingly similar* is over simplified and incorrect. Simply put, the products sold by Registrant and the products sold by Applicant are specialty products that are purchased by consumers with sophisticated knowledge about the goods in question, such that these sophisticated consumers exercise greater care reducing any likelihood of confusion in the marketplace.

A. Confusion Between the Marks Must Be Probable, Not Just Possible

For confusion to be likely, the confusion must be probable. It is irrelevant that the confusion is merely possible. *Electronic Data Sys. Corp. v. EDSA Micro Corp.*, 23 U.S.P.Q.2d 1460, 1465 (T.T.A.B. 1992) and *Rodeo Collection, Ltd. v. West Seventh*, U.S.P.Q.2d 1204, 1206 (9th Cir. 1987) (“probable, not simply a possibility”).

The Office Action presented no *evidence* that confusion between Applicant's TORNADO mark and the Registrant's TORNADO marks is probable. Additionally, the Office Action did not address or present any evidence relating to the sophistication and knowledge base of the consumers of Applicant's and Registrant's specialty products. The Federal Circuit has made clear that sophistication is important and often dispositive in a likelihood of confusion analysis because sophisticated consumers may be expected to exercise greater care. Applicant is now providing evidence that confusion is not probable and citing precedential case law, and for those reasons Applicant respectfully requests the 2(d) refusal be withdrawn.

B. du Pont Factors

It will be appreciated that the registration of a trademark is determined by whether there is “likelihood of confusion” between the applied for mark and another previously registered trademark in the minds of the consuming public. A determination that there is a likelihood of confusion focuses on whether the purchasing public would mistakenly assume that the junior user's goods or services originate from the same source as, or are associated with, the goods or services of the senior user. That determination is made on a case-by-case basis, aided by the application of the factors set out in *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). Those *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 . . . 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, i.e. “impulse” vs. careful, sophisticated purchasing.
5. The fame of the prior mark.
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.
10. The market interface between the applicant and the owner of a prior mark.
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.
13. Any other established fact probative of the effect of use.

It will be appreciated that not all the *du Pont* factors may be relevant or of equal weight in each case and “any one of the factors may control a particular case.” *In re Dixie Rests., Inc.*, 105 F.3d 1405, 1406-07, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997). While “there is no litmus rule which can provide a ready guide to all cases” of determining likelihood of confusion (177 USPQ at 567), the *du Pont* case provides a list of factors to be considered in an analysis under Section 2(d). Importantly, one or more factors may, from case to case, play a dominant role with no factor always having merit greater than the others. Examination of the pertinent factors from *du Pont* with the applicable facts present in this case lead to a conclusion that there is no likelihood of confusion between the registrations cited in the Office Action and the mark set forth in the present application.

In this case, there is no likelihood of confusion for several reasons, including (1) the differences in the nature of the goods, (2) the differences in the respective channels of trade for the goods described in the current application and the cited registrations, and (3) the high degree of consumer care taken by purchasers.

1. The Similarities or Dissimilarities and Nature of the Goods Described in the Application and Registrations.

It is well known trademark law that a comparison of the goods must be based on the identifications in Applicant’s application and the cited registrations. *See Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014); *Octocom Sys., Inc. v. Houston Comput. Servs., Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). Additionally, a finding of likely confusion must be made with respect to at least one

item in the application to establish likely confusion as to that single-class application. *Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp.*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981).

Applicant's TORNADO mark is for use in connection with: "Accessories for cooling apparatus and installations and accessories for air-conditioning apparatus and installations, namely, air *filters* for air conditioning installations and evaporative coolers, *fittings* in the nature of air conditioning unit fans, shafts, bearings, nuts, bolts, piping, and plumbing fittings, namely valves and couplers; Heat pumps for sterilizers, not for medical purposes; Heat pumps for gas burners; Heat pumps for cooking ovens and stoves; Structural and replacement parts for all the aforementioned goods" in International Class 11.

Conversely, the goods covered by the cited registrations are for use in connection with "rotary piston pumps and their parts" in International Class 07. Applicant submits from the cited registrations do not overlap with the amended identification of the goods in the current application because Applicant deleted "specialty pumps for air-conditioning apparatus" by this response, which appears to be the basis for the 2(d) refusal.

More specifically, the Office Action states: "the attached evidence establishes pumps for cooling as well as rotary piston pumps are found together in the marketplace." Applicant notes that there is no overlap between pumps. Additionally, the evidence presented in the Office Action does not establish that air conditioning and evaporative cooler parts and accessories claimed by Applicant are sold in the same marketplace as "rotary piston pumps." In other words, "air conditioning and evaporative cooler parts and accessories" are not the same as "rotary piston pumps."

The Office Action's evidence states "What's the Purpose of a Vacuum Pump? Vacuum pumps are part of one of the final processes in the repair process. After you've diagnosed and repaired any or other issues in the system it is time to recharge. Before recharging you want to make sure the system is free of any unwanted gasses, air, or water. If these were to remain in the system, it would turn the oil it runs on into sludge and leave behind damaging impurities." (Office Action at page 18, PDF copy). Additional evidence states: "What's the Process of Using a Vacuum Pump - For an HVAC technician you'll primarily need the vacuum pump for AC and refrigerant repairs. Use it for finishing up recovery and repair process. After you've recovered the usable refrigerant and diagnosed your problems, you'll need to refill the unit. Use the vacuum pump to pull out all the air and airborne vapor from the system before refilling. If you don't get the water vapor or other impurities out of the system you'll get a chemical reaction once you add your refrigerant back in. This can cause oil sludge, impurities on piping, and acidic reactions that can damage O rings." (Office Action at page 28, PDF copy). This evidence does not discuss a cooling pump, but is a vacuum pump used for other purposes, namely used to evacuate gases and liquids for repair purposes. Further, because Applicant is not claiming a cooling pump, the evidence supports a conclusion the goods are not related.

Thus, Applicant submits that the goods are not related for purposes of likelihood of confusion.

2. *The Consumers are Sophisticated and Exercise a High Degree of Care Making Purchasing Decisions of Specialty Products.*

Another important *du Pont* factor is the sophistication and degree of care that consumers take in making purchasing decisions. Applicant's consumers are typically HVAC contractors who resell and install HVAC products at the location where it will be used by an end user (i.e., a user's home or office). The customers are not the end users themselves. These HVAC contractors are sophisticated and knowledgeable in their field and are looking for certain products and accessories relating to HVAC systems, such as air conditioning or evaporative cooler parts and accessories as claimed by Applicant. Additionally, customers seeking "rotary piston pumps" are technicians that likewise have a specific use or purpose for the pumps. These technicians are sophisticated and knowledgeable in their field.

Still further, neither a "rotary piston pump" nor Applicant's goods are off-the-shelf products for end users to purchase and buy; rather, these goods are purchased after careful examination and inspection by a sophisticated and knowledgeable purchaser with a specific purpose for the product or to satisfy a specific need. There are a variety of different pumps that are each used for various purposes and needs, as evidenced by the Office Action's evidence as well as Applicant's attached evidence – *see* Exhibit A. These sophisticated and knowledgeable purchasers seek out the specific component or manufacturer whose parts/components they have come to prefer or trust.

According to the Federal Circuit and often cited by the TTAB, the purchasing process plays a significant role in cases where the products at issue are specialty products designed for a specific purpose or use because the test is not simply a side-by-side comparison of the marks, but rather is one of consumer confusion in light of the manner in which consumers purchase these products. *Electronic Design & Sales Inc. v. Electronic Data Systems Corp.*, 954 F.2d 713, 21 USPQ2d 1388, 1391 (Fed. Cir.1992) ("sophistication is important and often dispositive because sophisticated consumers may be expected to exercise greater care;" finding no likelihood of confusion resulting from the contemporaneous use of E.D.S. and EDS despite the fact that "the two parties conduct business not only in the same fields but also with some of the same companies.") and *J. Thomas McCarthy, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION* § 23:101 (4th ed. 2013) ("Where the relevant buyer class is composed solely of professional, or commercial purchasers, it is reasonable to set a higher standard of care than exists for consumers."). Thus, Applicant respectfully submits that the degree of care exercised by consumers for "rotary piston pumps" and/or Applicant's HVAC accessories greatly weighs in favor of Applicant, such that confusion is not likely.

3. *The Similarity of Established Likely-to-Continue Trade Channels.*

Still further, another *du Pont* factor considers the similarity of established likely-to-continue trade channels. In this case, there are no clear trade channels identified in either the cited registrations or Applicant's identification. Thus, the normal trade channels are presumed. In this case, Applicant's trade channels are consistent with HVAC systems, including air conditioning and evaporative coolers. For example, Applicant's accessories and parts for evaporative coolers are sold through HVAC wholesale distributors that typically distribute to

HVAC contractors who resell and install the product at the location where it will be used by an end user. Conversely, the trade channels for “rotary piston pumps” are shown by the Office Action’s evidence, which includes major online retailers, such as Grainger.com and others that sell various goods. Thus, Applicant submits that the trade channels are different from each other, such that sophisticated purchasers seeking a specific specialty good, which are different and used for different specialty purposes, are not likely to be confused under the facts of the present case.

4. *There is an Identical Third Party Owned TORNADO Mark Establishing the Nature of a Similar in Use on Similar Goods.*

Finally, Applicant notes that there is a third party owned trademark registration, namely U.S. Trademark Registration No. 3551651 registered for the TORNADO standard character mark used in connection with “submersible electric water pumps for groundwater testing and sampling, not for pumping drinking water” in International Class 07. *See Exhibit B.* Applicant submits that the goods registered in U.S. Trademark Registration No. 3551651 (namely “submersible electric water pumps for groundwater testing and sampling, not for pumping drinking water”) are much closer to the goods identified in the cited registrations (namely, “rotary piston pumps”) than the goods identified in the current application (namely, “Accessories for cooling apparatus and installations and accessories for air-conditioning apparatus and installations, namely, air filters for air conditioning installations and evaporative coolers, fittings in the nature of air conditioning unit fans, shafts, bearings, nuts, bolts, piping, and plumbing fittings, namely valves and couplers; Heat pumps for sterilizers, not for medical purposes; Heat pumps for gas burners; Heat pumps for cooking ovens and stoves; Structural and replacement parts for all the aforementioned goods”). As noted previously herein, another *du Pont* factor considers the “number and nature of similar marks in use on similar goods.” In this case, since there is at least one coexisting registration for a mark identical to those of the cited registrations, which identifies goods more similar to those of the cited registrations than the present application, this further supports a conclusion that the refusal should be withdrawn.

CONCLUSION

Applicant respectfully submits that because of the high degree of consumer care, the differences in the nature of the goods and their channels of trade, that Applicant’s TORNADO mark for use in connection with “Accessories for cooling apparatus and installations and accessories for air-conditioning apparatus and installations, namely, air filters for air conditioning installations and evaporative coolers, fittings in the nature of air conditioning unit fans, shafts, bearings, nuts, bolts, piping, and plumbing fittings, namely valves and couplers; Heat pumps for sterilizers, not for medical purposes; Heat pumps for gas burners; Heat pumps for cooking ovens and stoves; Structural and replacement parts for all the aforementioned goods” is not likely to cause confusion with the marks TORNADO or TORNADO and design for “rotary piston pumps.”

Applicant respectfully submits that registration on the Principal Register is appropriate. If any impediment to passing this mark onto publication remains after entry of this Amendment and consideration of these remarks, the Examining Attorney is invited to initiate a telephone interview with the attorney of record.