

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE EXAMINER OF TRADEMARKS
(MBHB 15-1707)**

In re Application of:

L.G. Harris & Co. Limited

Serial No.: 86/781,798

Filing Date: October 8, 2015

Mark: BLADE

International Class: 016

Law Office: 117

Trademark Attorney: Andrew Leaser

RESPONSE TO OFFICE ACTION OF FEBRUARY 2, 2016

Commissioner for Trademarks
P.O. Box 1451
Alexandria, Virginia 22313-1451

Dear Sir:

In response to the Office Action dated February 2, 2016 (“Office Action”), Applicant responds as set forth below. In accordance with the Trademark Electronic Application System rules, Applicant is responding to the Office Action via electronic form. Per the same rules, this document consists only of Applicant's arguments, and is incorporated fully into Applicant's Response.

I. REMARKS

A. Amendment of Applicant's Goods

As suggested by the Office Action, Applicant hereby amends the description of goods as follows (additions underlined):

- **Class 16:** Paintbrushes for applying paint, polish, stain or varnish; paintbrushes for DIY and decorating purposes.

Applicant asserts that this amendment does not broaden, but instead clarifies and limits the identification of services, and thus complies with 37 C.F.R. § 2.71(a).

B. Likelihood of Confusion

The Examining Attorney has raised a concern regarding an alleged potential likelihood of confusion regarding Applicant's pending application. Applicant respectfully disagrees that there exists any potential likelihood of confusion, and

respectfully requests that the Examining Attorney reconsider the above captioned application in view of the following remarks.

In the Office Action, the Examining Attorney stated that U.S. Registration No. 3466118 for AIR BLADE presents a bar to registration of Applicant's Mark under Trademark Act Section 2(d), because of a perceived likelihood of confusion between the two marks. Applicant respectfully disagrees.

The relevant factors to be considered in evaluating likelihood of confusion were established many years ago. *See In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 U.S.P.Q. 563, 567 (C.C.P.A. 1973). As stated in *E.I. du Pont*, the factors are as follows:

- (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, i.e., "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 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;
- (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, i.e., whether *de minimis* or substantial;
- (13) Any other established fact probative of the effect of use.

The question of likelihood of confusion requires inquiry into the specific facts of each case. *Id.* The factors are not listed in order of importance, and in different cases, different factors may play dominant roles. *Id.* Here, the *DuPont* factors strongly favor Applicant, and Applicant addresses below the most salient of the factors.

1. The Relevant Goods Differ Substantially.

The goods with which Applicant intends to use its mark differ substantially from those with which the Cited Mark is used. Indeed, for there to exist a likelihood of confusion between two marks, the goods and services related to the two marks must be sufficiently similar. *See, e.g., Dynamics Research Corp. v. Langenau Mfg. Co.*, 704 F.2d 1575, 1576, 217 U.S.P.Q. 649, 649-50 (Fed. Cir. 1983) (no likelihood of confusion between two DRC marks both used for goods in the metal fabrication industry). The confusion analysis should not be concerned with “*de minimus*” situations, but rather with the practicalities of the real world in which trademarks exist. *See MTD Prods. Inc. v. Universal Tire Corp.*, 193 U.S.P.Q. 56, 59 (T.T.A.B. 1976). A refusal to register based upon likelihood of confusion should only be made when a “probability,” not merely a “possibility,” of confusion has been established between uses of the marks in connection with the relevant goods/services. *See* 3 J.L. McCarthy, *McCarthy on Trademarks and Unfair Competition* § 23.3 (4th ed., June 2009 update). Here, Applicant submits that, under the appropriate standard, there is no likelihood of confusion.

In *Electronic Design & Sales v. Electronic Data Systems*, for example, the Federal Circuit permitted a trademark registration for the mark E.D.S. to the applicant, who designed power supplies for customers in the medical industry. It did so, even though an opposer used the extremely similar, nearly identical mark EDS, to sell computer services to some of the same customers in the medical industry. *Electronic Design & Sales*, 954 F.2d 713, 717, 21 U.S.P.Q.2d 1388, 1391 (Fed. Cir. 1992). The Trademark Trial and Appeal Board has made similar decisions. *See, e.g., Reynolds & Reynolds Co. v. I.E. Sys., Inc.*, 5 U.S.P.Q.2d 1749, 1752 (T.T.A.B. 1987) (ACCU prefix in both marks used in computer industry insufficient to support likelihood of confusion). Other federal courts have proceeded in the same way. The First Circuit, for example,

found no infringement of a registered mark when one party sold laboratory instrumentation and another sold pharmaceutical products, both selling to large hospitals using the mark ASTRA. *Astra Pharm. Prods. v. Beckman Instruments*, 718 F.2d 1201, 1206, 220 U.S.P.Q. 786, 790 (1st Cir. 1983).

Here a basic understanding of differences between the goods with which Applicant intends to use its mark, and the goods associated with the Cited Mark, establishes without doubt that there is no likely confusion between the two marks.

Applicant's Mark is intended to be used with the following goods, as amended herein:

- Paintbrushes for applying paint, polish, stain or varnish; paintbrushes for DIY and decorating purposes in International Class 016.

The Cited Mark, on the other hand, is associated with the following goods:

- Spraying devices, namely, air brushes and air compressors for applying coatings such as paint in International Class 007.

Examination of the specific terms in Applicant's application and the registration for the Cited Mark readily reveals that the associated goods are substantially different.

As indicated in its goods description, Applicant intends to use the Mark with actual brushes for applying, for example, paint, polish, stain, or varnish. Such brushes can be seen on Applicant's website at <http://www.harrisbrushes.com/brushes>. See Exhibit A. As can be seen on Applicant's website, these are paintbrushes for hand application of paint and the like, having handles of wood, plastics or composite material with bristles connected thereto. Applicant's Mark is classified in International Class 016, which includes such items as hand tools for artists and paint brushes.

In contrast, the goods for the Cited Mark are related to "spraying devices, namely, air brushes and air compressors for applying coatings such as paint." The specimen filed on May 28, 2014 with the Section 8 and 15 declaration for the Cited Mark is described as a "picture of the product." See Exhibit B. As can be seen from the photograph, the product is an air compressor used as part of the apparatus for industrial or automotive spray finishing. It is a large machine, weighing 9.4 pounds (see Exhibit C), and rests upon the floor. In view of the nature of the product, the Cited Mark is

classified in International Class 007, which is defined as machines, machine tools, motors and engines.

Upon comparing the specimen of use of the Cited Mark with the intended use of Applicant’s Mark, it is clear that the goods are completely different and are classified in vastly different international classes. The fields in which the two marks are used are entirely distinct and nobody in either field would confuse the two products (a paintbrush with a compressor for an industrial or automotive spraying machine) or assume they were related or in any way likely to emanate from the same source. The goods are entirely distinct, and therefore, on that basis alone, Applicant’s Mark is not likely to cause confusion.

2. The Number And Nature Of Similar Marks In Use On Similar Goods Narrows the Scope of the Cited Mark.

The co-existence of a number of registrations on the Principal Register with the term BLADE favors a finding of no likelihood of confusion. Specifically, a search on the U.S. Trademark Office website reveals the following marks incorporate the term “BLADE” in connection with “paint”:

Current Search: (blade)[BI] and (paint)[GS] docs: 13 occ: 30

	Serial Number	Reg. Number	Word Mark	Check Status	Live/Dead
1	86781798		BLADE	TSDR	LIVE
2	86665401		BLADE	TSDR	LIVE
3	79152751	4733748	BLADESHIELD	TSDR	LIVE
4	79146745		OPALUS X-BLADE	TSDR	DEAD
5	79096553	4081921	ALEXIT BLADE-REP	TSDR	LIVE
6	79096552	4081920	BLADE-REP	TSDR	LIVE
7	78914301		BABESBLADESBLOODBEAUTY	TSDR	DEAD
8	78609819		COLORBLADE	TSDR	DEAD
9	77864841	3982200	DURABLADE	TSDR	LIVE
10	77251543	3466118	AIR BLADE	TSDR	LIVE
11	77107348	3297107	COLORBLADE	TSDR	DEAD
12	76260765		BLADEBALL	TSDR	DEAD
13	73423374	1291902	BLADE ADE	TSDR	LIVE

See Exhibit D. Of these search results, the following marks are registered to separate entities and have all claimed use in U.S. commerce:

DURABLADE (paints, lacquers, varnishes);

AIR BLADE (spraying devices, namely, air brushes and air compressors for applying coatings such as paint); and

BLADE ADE (paint scrapers).

See Exhibit E.¹ The number of marks incorporating the term BLADE and used with paint-related goods provides evidence that the public is able to distinguish marks using these terms and is capable of viewing the marks in their entirety to distinguish the source of goods or services. Due to the number of similar marks already in the marketplace, consumers would be able to distinguish between another, slightly different mark, especially if used in connection with different goods, as in the present case. Accordingly, the Cited Mark is entitled to a narrow scope of protection due to the number of similar marks in use in U.S. commerce, and the refusal based on this registration should be withdrawn.

3. Applicant's Mark is Unlikely to Be Confused with the Cited Mark Because Applicant's Goods Travel in Highly Specific Channels of Trade.

In applying the pertinent *DuPont* factors to the marks at issue herein, it is important to keep in mind that “the only relevant application of the law to the facts is in the context of the market place, because that is where confusion of prospective purchasers would or would not occur.” *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 1569, 218 U.S.P.Q. 390, 393 (Fed. Cir. 1983). Even when the marks are arbitrary and identical, the registration should be allowed unless there is a reasonable probability of the same customer encountering opposing marks. *In re Fesco, Inc.*, 219 U.S.P.Q. 437, 439 (T.T.A.B. 1984). Likelihood of confusion, not merely possibility of confusion, is the standard. *Id.*

The case of *Electronic Design* is again instructive here. In that case, the opposer's EDS mark for computer services and applicant's E.D.S. mark for component parts of medical equipment were sold not only in the same medical field, but also to different employees of some of the same large corporations. *Elec. Design*, 954 F.2d at 717, 21 U.S.P.Q.2d at 1391 (citing *Astra Pharm. Prods.*, 718 F.2d at 1206, 220 U.S.P.Q. at 790 (1st Cir. 1983)). The court held that, although the marks were identical, it was an

¹ In addition to the above-listed registrations, the Trademark Office also found the following marks as capable of co-existing on the Register: BLADESHIELD (paints, lacquers, varnishes); BLADE-REP (paints, lacquers, varnishes); and COLORBLADE (colorants for paints and stains).

error for the examiner to deny registration just because both parties' goods are marketed and sold to different employees within the same companies. *Id.*; accord *Elec. Data Sys. Corp. v. EDSA Micro Corp.*, 23 U.S.P.Q.2d 1460, 1464-65 (T.T.A.B. 1992) (no likelihood of confusion between EDS for computer programming services including electronic data processing programs and EDSA for computer programs for performing system analysis and design even though parties' software was often purchased by the same large companies, because ultimate consumers occupied different positions in companies and purchasers were highly sophisticated).

Here, the goods associated with Applicant's Mark and the Cited Mark are not "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." TMEP § 1207.01(a)(i); see, e.g., *Shen Manufacturing Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 73 U.S.P.Q.2d 1350, 1356 (Fed. Cir. 2004). As noted above, Applicant markets its goods to contractors and home owners who are interested in painting or home improvement supplies. Such goods are offered for sale through home improvement retailers as well as contractors' specialist websites. In contrast, the goods of the Cited Mark are marketed to sophisticated purchasers, namely specialists in the automotive spraying trade or serious hobbyists in this field, who are seeking industrial equipment for spray painting items. See Exhibit F. Purchasers of such industrial equipment would not consider paintbrushes in any way suitable for accomplishing such a task.

Since these areas of trade are highly specific and would be marketed in in entirely different ways through separate channels of trade, there is no reasonable probability of the same customer encountering the two marks. In light of the above arguments, Applicant respectfully requests that the likelihood of confusion refusal be withdrawn.

5. Applicant's Mark Differs Substantially From the Cited Mark in Appearance, Sound, Connotation, and Commercial Impression.

In testing for likelihood of confusion under Section 2(d), the similarity or dissimilarity of the marks in their entirety must be considered as to appearance, sound, connotation, and commercial impression. *In re E.I. DuPont de Nemours & Co.*, 177 U.S.P.Q. at 567. When determining the likelihood of confusion between marks, it is not

proper to dissect the marks at issue and focus on non-dominant similarities while downplaying or ignoring significant differences that may make a mark registerable. *In re Hearst Corp.*, 982 F.2d 493, 494, 25 U.S.P.Q.2d 1238, 1239 (Fed. Cir. 1992); *Sun-Fun Prods., Inc. v. Suntan Research & Dev., Inc.*, 656 F.2d 186, 189-91, 213 U.S.P.Q. 91, 93-95 (5th Cir. 1981); *Franklin Mint Corp. v. Master Mfg. Co.*, 667 F.2d 1005, 1007, 212 U.S.P.Q. 233, 234-35 (C.C.P.A. 1981). Rather, it is the impression that the mark as a whole creates on the reasonably prudent buyer, and not any individual part thereof, that is important to the analysis, and no element of a mark should be ignored simply because it is less dominant or would not have trademark significance if used alone. *In re Electrolyte Labs., Inc.*, 913 F.2d 930, 932, 16 U.S.P.Q.2d 1239, 1240 (Fed. Cir. 1990); *Little Caesar Enter., Inc. v. Pizza Caesar, Inc.*, 834 F.2d 568, 570-72, 4 U.S.P.Q.2d 1942, 1944-45 (6th Cir. 1987); 3 J.L. McCarthy, *McCarthy on Trademarks and Unfair Competition* § 23.41 (4th ed., June 2009 update).

It is important to note that confusion is not automatically likely, even if a junior user's mark contains the whole of another mark. The public looks at the mark as a whole, and not only a portion of a mark, to determine the source of goods and services. *Conde Nast Pub., Inc. v. Miss Quality, Inc.*, 507 F.2d 1404, 1405-07, 184 U.S.P.Q. 422, 423-25 (C.C.P.A. 1975) (COUNTRY VOGUES not confusingly similar to VOGUE); *In re Merch. Motivations, Inc.*, 184 U.S.P.Q. 364, 365 (T.T.A.B. 1974) (MMI MENSWEAR not confusingly similar to MENSWEAR).

In accordance with the controlling legal principles, it would be improper here to focus only on the similarity of words in the marks at issue. One must consider the overall impression that the marks, ***taken in their entirety***, have on the purchasing customer.

As an initial matter, the Cited Mark and Applicant's Mark are not identical. The Cited Mark differs from Applicant's Mark in that it includes the term "AIR." Even though the term "AIR" has been disclaimed, it cannot be ignored and in fact contributes to a different commercial impression.

Further, one feature of a mark may be recognized as more significant in creating a commercial impression and that dominant feature may be afforded greater weight. In the case of the Cited Mark, the term "AIR" appears first and thus is a dominant feature of

the Cited Mark. Because of its presence, the Cited Mark would make a different commercial impression on a consumer than that of Applicant's Mark.

In addition, the inclusion of the term "AIR" in the Cited Mark further distinguishes the two marks in appearance and sound. The distinct syntax, sound, appearance, and connotation of Applicant's "BLADE" mark, particularly when viewed as a whole, are readily distinguishable mark from that of the Cited Mark. Thus, this factor weighs in favor of Applicant.

6. Other Factors.

In addition to the differences enumerated above, other *DuPont* factors also favor Applicant, such as the conditions under which and buyers to whom sales are made. The goods intended to be sold under Applicant's mark and the goods sold with the Cited Mark are not impulse buys, but rather the result of careful, sophisticated purchasing by individuals who are specialists. The paintbrushes to be sold under Applicant's mark are not an "impulse" buy as they would be purchased only by a contractor or homeowner who needed the tools to paint a house, office, etc. Further, since the goods covered by the Cited Mark cost several hundred dollars, they would *certainly* not be an "impulse" buy, but rather an item bought with great consideration by specialists in the automotive spraying trade or serious hobbyists in this field. Thus, this factor weighs in favor of Applicant.

In view of the above, any potential confusion is, at most, *de minimis*. See *E.I. du Pont*, 177 U.S.P.Q. at 567. When coupled with the other factors discussed herein, however, it is clear that there is no likelihood of confusion.

II. CONCLUSION

In view of the above, Applicant respectfully requests that the Examining Attorney reconsider the office action, and pass the instant application to publication.

Respectfully submitted,

McDONNELL BOEHNEN
HULBERT & BERGHOFF LLP

Date: August 1, 2016

By: /Anthoula Pomrening/
Anthoula Pomrening