

The Examining Attorney has refused registration of Applicant's APOLLO EXPANSION PEX mark on the basis that it will likely be confused with the APOLO stylized mark, U.S. Reg. No. 4,099,556. Applicant submits there is no potential likelihood of confusion between Applicant's mark and the mark listed in the cited registration because of the differences in the marks and the differences in goods. Accordingly, Applicant respectfully requests the Examining Attorney's reconsideration in light of the following remarks.

I. REFUSAL UNDER SECTION 2(d)

Registration of Applicant's APOLLO EXPANSION PEX mark is not likely to result in confusion, mistake or deception amongst consumers in the market place. To determine whether there is a likelihood of confusion under Section 2(d) of the Trademark Act, Courts and the PTO consider the thirteen factors enumerated in *In re E.I. duPont de Nemours & Co.*, 476 F.2d 1357, 177 U.S.P.Q. 563 (C.C.P.A. 1973). No one of the thirteen factors is more important than the others and "Each may from case to case play a dominant role." *Id* at 567. An examination of the following *duPont* factors reveals that no likelihood of confusion exists between the marks in question:

- (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.
- (12) The extent of potential confusion, *i.e.* whether *de minimis* or substantial.

duPont, 177 U.S.P.Q. 567.

A. Applicant's mark is distinct from the mark in the cited registration.

The first relevant *duPont* factor concerns the similarity of the actual marks in question. This factor is determinative in this case. Applicant's mark is APOLLO EXPANSION PEX which the Examining Attorney has concluded will likely be confused with the registered APOLO stylized mark.

The marks do have elements in common; however, similarity of the marks is not dispositive on the issue of likelihood of confusion. Simply because one mark may bring another to mind, it does not necessarily follow that there is a likelihood of confusion as to source. *In re P. Ferro & C.S.P.A.*, 178 U.S.P.Q. 167, 168 (C.C.P.A. 1973); *Jacobs v. International Multifoods Corp.*, 212 U.S.P.Q. 641, 642 (C.C.P.A. 1982). The fact that the marks contain a common element does little to inform on the likelihood of confusion, as *duPont* requires the marks be examined in their entireties rather than piecemeal. *duPont*, 177 U.S.P.Q. 567. When viewed in their entireties, each mark is unique in its appearance, sound, connotation and commercial impression. Applicant's mark is both visually and phonetically distinct from the cited registration, and creates a different commercial impression.

The *P.Ferro* case is very much on point. The applicant in *P.Ferro* sought to register the mark TIC TAC for use in connection with its now very well-known miniature hard mint candies packaged in a little plastic box. The examining attorney refused registration under section 2(d) of the Lanham Act on the grounds that the mark would likely be confused with United States Trademark Registration No. 0,809,357 for the mark TIC TAC TOE which Borden's used in connection with ice cream. *In re P. Ferro*, 178 U.S.P.Q. 167. The Board affirmed the rejection, specifically noting that the applicant's mark consisted of the first two-thirds of the cited registration. The Court of Customs and Patent Appeals reversed:

We feel that the board has made too much of the indisputable fact that TIC TAC is two-thirds of TIC TAC TOE and that TIC TAC would "bring to mind" TIC TAC TOE. Neither fact determines the issue of likelihood of confusion. See our opinion in *In re General Electric Co.*, 49 C.C.P.A. 1186, 304 F.2d 688, 134 U.S.P.Q. 190 (1962) in which we held VULKENE registrable over VULCAN. [3] The fact that one mark may bring another mark to mind does not in itself establish likelihood of confusion as to source. Compare *Lever Brothers Co. v. Producers Chemical Service*, 48 C.C.P.A. 744, 283 F.2d 879, 128 U.S.P.Q. 7 (1960). The very fact of calling to mind may indicate that the mind is distinguishing, rather than being confused by, two marks.

Id. at 168. Thus, merely because one mark may contain all or part of another, there is no *per se* rule that a likelihood of confusion would result. Just as the marks TIC TAC and TIC TAC TOE can peacefully coexist in the market place, so too can the marks APOLLO EXPANSION PEX and APOLO stylized.

Courts have routinely permitted registration of similar, though slightly different, marks. For instance, Clayton Mark & Co was in the business of selling electrical conduit and registered the term "MARK" in association with that activity. *Clayton Mark & Co. v Westinghouse Electric Corp.*, 148 U.S.P.Q. 672 (1966). Clayton filed an objection when Westinghouse sought to register "MARK 75" in connection with its sale of industrial circuit breakers. *Id* at 673. The Court of Customs and Patent Appeals rejected the opposition and stated:

In spite of the obvious similarity, we consider the trademarks to be of different types. Appellant's mark is not simply opposer's mark with the "mere" addition of "75". That addition converts what has every appearance of being a name of some sort into a trademark of the type- or model-designating variety.

Id.

Courts have on many other occasions permitted registration of marks which were almost, but not quite, identical. See *In re Digirad Corp.*, 45 U.S.P.Q.2d 1841 (1998) (Permitting registration of "Digirad" for gamma radiation sensors in spite of previous registration of "Digiray" for digital x-ray systems.); *Jacobs v. International Multifoods Corp.*, 212 U.S.P.Q. 641

(1982) (Permitting registration of “Boston Sea Party” and “Boston Tea Party”); *B.V.D. Licensing v. Body Action Design*, 6 U.S.P.Q.2d 1720 (1988) (Permitting registration of “BAD” for clothing despite previous registration of “B.V.D.” for men’s underwear.).

Applicant’s addition of the terms EXPANSION PEX transforms the mark and gives a completely different commercial impression than the word APOLLO or APOLO. Even though the term EXPANSION PEX may not be considered very significant to the Trademark Office, it is significant to convey information to purchasers of the products and it is significant to the commercial impression of Applicant’s APOLLO EXPANSION PEX mark. Further, the cited mark also is spelled differently and is highly stylized. The commonality of the term APOLLO and APOLO is not enough to cause confusion among consumers. Applicant’s mark APOLLO EXPANSION PEX is visually and phonetically distinct from the cited APOLO stylized mark and creates an entirely different commercial impression. There simply is no likelihood of confusion based on the differences in the marks.

B. Applicant’s goods are distinct from the goods and services in the cited registration.

The second relevant *duPont* factor involves a comparison between the goods as described in the application and the goods and services listed in the prior registration. *duPont*, 177 U.S.P.Q. 567. Here, the plain language of the application and the cited registration reveal that Applicant and Registrant use their respective marks in connection with the sale of different goods. Applicant’s APOLLO EXPANSION PEX mark is used in association with cross-linked polyethylene tubing for plumbing use in International Class 017. On the other hand, the cited APOLO stylized mark is used in connection with everything from “children’s eyeglasses” to “egg timers” in all different classes. The cited APOLO stylized mark is used in connection with so many different goods that it is difficult to imagine consumers confusing it with Applicant’s APOLLO brand that has been used in connection with similar and related goods since 1969. Applicant not only has APOLLO protected by a federal registration No. 0,900,588 but also has several other APOLLO marks including APOLLO INTERNATIONAL 2,530,525, APOLLO-PRESS 3,326,865, APOLLO-PUSH 4,538,032, APOLLOXPRESS 4,259,056 and even more pending applications. If the goods are similar, then it is the cited mark that shouldn’t have been allowed to register in light of Applicant’s long-standing and significant trademark rights in the mark APOLLO. See Applicant’s APOLLO trademark registrations attached hereto as Exhibit 1.

The Board has consistently held that each case must be decided on its own merits and that no particular goods or services are *per se* related simply because they may belong to the same broad category of goods or services. See T.M.E.P. §1207.01(a)(iv).

The matter of *In re Emco, Inc.*, 177 U.S.P.Q. 415 (T.T.A.B. 1973) is analogous and instructive. In that case, the Board permitted registration of EMCO for electrical lighting fixtures in spite of previous registration of EMCO for electrical devices including, *inter alia*, attenuators, filters, couplers and oscillators. The Board found that the sale of the parties’

respective goods under the same mark would not be likely to cause confusion or mistake or to deceive merely because the goods were both electrical in character. *Id.* The Board stated:

In the present case, applicant's goods are electrical fixtures whereas the goods identified in the cited registration are electronic devices which are normally used in the communication field. In the complete absence therefore of any evidence tending to show that these products ... are otherwise related in any material particular, it is our opinion that applicant's mark should be published in accordance with Section 12(a) of the Statute.

Id. at 416-17.

Similarly, in *Sal Iannelli, Inc. v. Wasser*, 411 F.2d 1350, 162 U.S.P.Q. 260 (C.C.P.A. 1969), the opposer sought to prevent the applicant's registration of ANALITE for an "exposure control electronic device for use in printing photographic negatives." *Id.*, 411 F.2d at 1350, 162 U.S.P.Q. at 260. The opposer used ANALYTE on its color comparator units and related equipment sold to all types of industries dealing in color, and it argued that the applicant's use of the same mark would cause confusion. While both parties provided their products to industries dealing in color, the opposer did not specifically market its product to the photographic field. *Id.*, 411 F.2d at 1350-51, 162 U.S.P.Q. at 261. The Court concluded that the products were different precision instruments moving through different trade channels to different classes of purchasers for basically different purposes and permitted registration of the ANALITE mark. *Id.*

The reasoning in *Sal Iannelli, Inc.* and *Emco* is applicable to the present case. Courts have consistently found confusion to be unlikely where the same mark was used for different products in the same International Class. *See, e.g., Atec, Inc. v. Societe Nationale Industrielle Aerospatiale*, 798 F.Supp. 411, 413, 24 U.S.P.Q.2d 1951, 1953-54 (S.D. Tex. 1992) (parties' simultaneous use of ATEC for electronic testing equipment in the aviation industry was not confusing where products were used for different purposes by different customers); *Pep Boys-Manny, Moe & Jack v. Edwin F. Guth Co.*, 197 F.2d 527, 528, 94 U.S.P.Q. 158, 159-60 (C.C.P.A. 1952) (applicant allowed to register CADET for electric lighting fixtures sold to wholesale electrical supply jobbers, despite opposer's registration of CADET for electric storage batteries and other automotive supplies sold in retail stores). *See also In re Planprint Co.*, 229 U.S.P.Q. 621, 623-24 (T.T.A.B. 1986) (CAFÉ for computer engineering services for plants and factories unlikely to be confused with CAFÉ for computer services for analyzing restaurant building costs).

Here, there is even less possibility that registration of Applicant's mark will create a likelihood of confusion in the marketplace than there was in *Emco*, *Sal Iannelli*, *Atec* and *Pep Boys*. In those cases, the parties in question were using identical marks on similar kinds of goods. In this case, Applicant's APOLLO EXPANSION PEX mark is distinguishable from the cited mark visually and phonetically as well and has a different commercial impression.

C. The potential likelihood of confusion is *de minimis*.

When considered in sum, it is evident that the potential likelihood of confusion in this case, if it exists at all, is *de minimis*. First, Applicant's mark is wholly distinct from the mark in the cited registration. Just as the mark TIC TAC and the mark TIC TAC TOE are both registerable for use in connection with similar goods, so too are the marks APOLLO EXPANSION PEX and APOLO stylized.