

SECTION 2(d) REFUSAL – LIKELIHOOD OF CONFUSION

Registration of the applied-for mark stands refused because of a likelihood of confusion with the mark in U.S. Registration Nos. 3928224 (herein the “’224 registration”).

The cited ‘224 registration covers:

Mark: HORIZON TECHNOLOGY (design)

Goods/Services: class 009 “Analytical laboratory instruments, namely, automated concentrators used for drying, evaporation, and concentration of organic extracts; electronic controllers used with extraction systems; solid phase extraction disks for removing chemical compounds from water for analysis and testing; vacuum extractor for removing liquids from solvents for analysis and testing; membrane for extracting organic compounds and oil and grease from aqueous solutions for use in environmental laboratories; micro-processor based software used to monitor and control analytical testing instruments in the field of environmental testing and related computer hardware”

Applicant by way of the clarifying amendment submitted herewith has applied for (amendment markups shown):

Mark: HORIZON

Goods/Services: class 009 “Laboratory imaging instruments for analyzing particulates in fluid samples; Laboratory imaging instruments for counting and characterizing particulates in biopharmaceutical samples; Laboratory imaging instruments for analyzing biopharmaceutical samples; Robotic imaging apparatus for scientific analysis”

Applicant notes that the goods and services relevant to the instant HORIZON application are imaging instruments for capturing and analyzing particulates in fluid samples via imaging. As understood in the industry, this type of imaging technology at a minimum typically requires a platform or container for holding a sample to be analyzed, a camera for image acquisition, a computer module for processing the images, and a robotic component for manipulating the position of the camera and/or the sample. In contrast, the ‘224 registration is not reciting an imaging technology. Instead, as recited in the registration and further explained by the Evidence provided by the Examiner in the Office Action, the ‘224 registration is merely aimed towards technology that performs solid phase extraction or solid-state concentration. Solid-phase extraction is a sample preparation process by which compounds are separated from other compounds in the mixture according to their physical and chemical properties. As shown in the Examiner’s evidence and recited in the registration itself, this merely involves subjecting a sample to drying, evaporation, concentration, etc. (in other words, reorganizing or reconcentrating solids in the mixture, separating organics vs. inorganics, etc.).

According to TMEP 1207.01(a)(i), “[i]f 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”, citing *Quartz Radiation Corp. v. Comm/Scope Co.*,

1 USPQ2d 1668, 1669 (TTAB 1986) (holding QR for coaxial cable and QR for various apparatus used in connection with photocopying, drafting, and blueprint machines not likely to cause confusion because of the differences between the parties' respective goods in terms of their nature and purpose, how they are promoted, and who they are purchased by). As explained in TMEP 1207.01(a)(i) and the court in *Quartz*, goods that are not marketed in the same way or encountered by the same persons are not likely to give rise to a likelihood of confusion. As shown by the Examiner's evidence, the '224 is a system for reorganizing the concentration of solid state materials. This is a far different task both in execution, purpose and outcome when compared to imaging technology of Applicants, which images particulates in fluid. The instant application recites an imaging system, while the cited registration does not. The instant application recites fluidic samples, while the cited registration is specific to solid state mediums. The goods recited in the instant application would be purchased by pharmaceutical research, development and manufacturing labs, whereas the goods in the cited registration are most commonly purchased by environmental specialists who extract oil from soil/the earth. On the surface, there would be no default overlap between customers shopping for solid-state concentrators and customers shopping for a particulate imaging and analysis device for fluids because the devices fundamentally perform different tasks, and are neither compatible nor interchangeable.

TMEP 1207.01(d)(vii) further states that "circumstances suggesting care in purchasing may tend to minimize the likelihood of confusion", citing *In re N.A.D., Inc.*, 754 F.2d 996, 999-1000, 224 USPQ 969, 971 (Fed. Cir. 1985) (concluding that, because only sophisticated purchasers exercising great care would purchase the relevant goods, there would be no likelihood of confusion merely because of the similarity between the marks NARCO and NARKOMED); *In re Homeland Vinyl Prods., Inc.*, 81 USPQ2d 1378, 1380, 1383 (TTAB 2006). As evidenced by the Examiners evidence of Applicant's goods the customer base of such goods is highly sophisticated, and a particulate imaging technology is clearly not an impulse purchase (see for example HORIZON website screenshots, explaining the advantages of the technology in highly sophisticated scientific terms and data). Customers of solid state concentrators can also be presumed to be sophisticated (see for example Horizon Technology screen shots, explaining the advantages of the technology in highly sophisticated scientific terms and data). So even though there is no reason to assume that customers of particulate imaging technology are also customers for solid-state concentrators, as stated by the court in *In re N.A.D., Inc.*, because only sophisticated purchasers exercising great care would purchase the relevant goods, there would be no likelihood of confusion merely because of the similarity between the marks HORIZON and HORIZON TECHNOLOGY (or in that case of *In re N.A.D., Inc.*, NARCO and NARKOMED).

For at least the reasons stated above, and in light of the clarifying amendment to the goods and services submitted herewith, Applicant submits that there would be no likelihood of confusion between the cited '224 registration and Applicant's mark HORIZON.