

## **ARGUMENTS AGAINST LIKELIHOOD OF CONFUSION**

On September 8, 2017, the Examining Attorney issued an Office Action in which registration of the Applicant's mark "MATRIX" was refused based on the assertion that the mark is confusingly similar to U.S. Registrations Nos. 3410506; 4612391; and 5197024 for the marks "MATRIX", "GEOMATRIX", and "HEATMATRIX", respectively (collectively "Cited Marks"). This assertion, however, overlooks the clear difference in the marks themselves, the dissimilarity of the goods associated with the respective marks, the very different channels of trade through which the respective goods are sold, and the sophistication of prospective customers.

The Court in *In re E. I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973) listed the principal factors to be considered in determining whether there is a likelihood of confusion under Section 2(d), any one of which may be dominant, depending upon the evidence of record. The following factors from *DuPont* are relevant:

- The dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.
- The dissimilarity and nature of the goods as described in an application or registration or in connection with which a prior mark is in use.
- The similarity or dissimilarity of established, likely-to-continue trade channels.
- The conditions under which, and buyers to whom, sales are made, i.e., "impulse" vs. careful, sophisticated purchasing.
- The nature and extent of any actual confusion.
- The extent of potential confusion, i.e., whether *de minimis* or substantial.

Applicant respectfully submits there is no likelihood of confusion between Applicant's mark and Registrant's mark for at least the reasons that (1) the marks are different, (2) the goods are different, (3) the channels of trade are different, (4) the purchasers are different, (5) the purchasers are sophisticated, and (6) any confusion would be *de minimis*. In view of these differences, it is respectfully submitted that there is no likelihood of confusion.

### **Differences in the Marks**

As an initial matter, Applicant does not argue the '506 mark is different. The remarks in this section are directed to the '391 and '024 Registrations.

When considering the similarity of the marks, "[a]ll relevant facts pertaining to the appearance and connotation must be considered." *Recot, Inc. v. M.C. Becton*, 214 F.3d 1322, 1329, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000).

For this factor, a very relevant and fundamental difference that distinguishes the Applicant's mark from the '391 and '024 registrations is the absence of a prefix. In both the '391 and '024 registrations, there exists some other term the consumer will encounter first, before they encounter the MATRIX term. See, *In re Shawnee Milling Co.*, 225 USPQ 747, 749 (TTAB 1985) (GOLDEN CRUST for flour held not likely to be confused with ADOLPH'S GOLD'N CRUST and design for coating and seasoning for food items) and, see *contra*, *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 1372-73, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005). In *Veuve*, the Court noted that the two marks, VEUVE CLICQUOT and VEUVE CLICQUOT PONSARDIN, contained the same first word thus rendering the marks similar. This is not the situation here. Instead, the situation is similar to *In*

*re Shawnee*, where the addition of ADOLPH'S was sufficient to distinguish the marks. Here, two of the Cited Marks begin completely differently than Applicant's mark and provide additional terms not included in Applicant's mark. Thus distinguishing Applicant's and the '391 and '024 Marks.

Marks' sharing a common portion does not necessarily compel a conclusion of likelihood of confusion. *General Mills v. Kellogg Co.*, 824 F.2d 622, 627, 3 USPQ2d 1442, 1445 (8<sup>th</sup> Cir. 1987). The proper comparison is between the overall commercial impressions of the marks as consumers view and remember them. *Long John Distilleries, Ltd. v. Sazerac*, 426 F.2d 1406, 166 USPQ 30 (CCPA 1970). In some cases the common portion is combined with other features in such a manner that the identity of the common portion is lost and the marks, when considered in their entirety, are deemed dissimilar. This is the case here.

The '391 and '024 registrations each provide a separate and distinct initial commercial impression that is different than the Applicant's Mark. First, the GEOMATRIX '391 registration's prefix is GEO-, which does not start with the same letter as Applicant's Mark, and the prefix presents a distinct and separate commercial impression to the consumer that the product may be of Earth or ground origin (**see Exhibit A**). Second, the HEATMATRIX '024 registration's prefix is HEAT-, which also does not start with the same letter as Applicant's Mark, and the prefix also presents a distinct and separate commercial impression that suggests to the consumer the nature or installation of the product has something to do with thermal energy. Further, the goods sold under the HEATMATRIX mark have a grid-like (i.e., matrix) property about them (**see Exhibit B**, '024 Registrant's own specimen of use showing the matrix/grid product). As such, both the '391 and '024 registration's marks are suggestive of the goods, while Applicant's mark is instead a stronger, arbitrary mark.

Further, the marks must be considered in their entireties, not dissected into their components. *In re National Data Corp.*, 753 F.2d 1056, 1058, 224 USPQ 749, 750-51 (Fed. Cir. 1985). While it may be true that the marks all use the word "MATRIX," the '391 and '024 marks as a whole are entirely different from Applicant's. Further, the '391 and '024 registrations do not give those Registrants exclusive rights to use the word MATRIX without their respective prefixes. As the '391 and '024 Registrations are not for MATRIX alone, but are instead terms that incorporate their own prefixes and can themselves coexist in the marketplace and on the register, then so too can Applicant's mark.

Just like the following marks were found not confusingly similar, so too should the Cited Marks and Applicant's mark:

Not Confusingly Similar<sup>1</sup> (first mark v. second mark)

CORN-ROYAL v. ROYAL<sup>2</sup> (both for oils and food items) (word v. word)

GOLDEN CRUST v. ADOLPH'S GOLD'N CRUST (food items) (word v. design)

KEYCHECK, KEYBANKER v. KEY<sup>3</sup> (all in the financial industry) (word v. design)

SOLENA v. CASA SOLENA<sup>4</sup> (both for Mexican food) (word v. word & design)

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<sup>1</sup> See § 23:57. Examples of marks similar in part—No likelihood of confusion, 4 McCarthy on Trademarks and Unfair Competition § 23:57 (5th ed.).

<sup>2</sup> *Standard Brands, Inc. v. Peters*, 191 USPQ 168, 172 (TTAB 1975) (where the term ROYAL was found weak).

<sup>3</sup> *In re Hamilton Bank*, 222 USPQ 174 (TTAB) (where KEY was found to be suggestive, thus the marks must be considered as a whole).

<sup>4</sup> *La Mexicana Inc. v. Sysco Corp.*, 1998 WL 929629, \*3-4, 49 USPQ 1204 (W.D. Wash. 1998) (where even though the mark was a fanciful, strong mark, the Court held the marks were not similar when considered as a whole).

PATIO (Mexican-style food) v. TAPATIO<sup>5</sup> (for sauce) (design v. word)  
ALL v. ALL CLEAR<sup>6</sup> (both household products) (word v. design)  
SILK v. SILKSTICK<sup>7</sup> (both beauty products) (word v. word)  
SILK'N'SATIN v. SILK<sup>8</sup> (both beauty products) (word v. design)  
JET AERATION v. AEROB-A-JET<sup>9</sup> (both waste water treatment) (design v. word)  
ROMAN v. ROMANBURGER<sup>10</sup> (both for food) (design v. word)  
VARGAS v. VARGA GIRL<sup>11</sup> (both for calendars) (word v. word)

In view of all these factors, the Applicant's Mark would generate a different overall impression in sight, sound, and meaning than that of the '391 and '024 registrations. See *In re Shawnee Milling Co.*, 225 USPQ 747 (TTAB 1985) (GOLDEN CRUST for flour held not likely to be confused with ADOLPH'S GOLD'N CRUST and design for coating and seasoning for food items).

Thus, consideration of the respective Cited Marks in their entireties clearly demonstrates that the marks are quite different in appearance, sound, connotation, and commercial impression.

### **Differences in the Goods**

The goods associated with Applicant's mark and the Cited Marks are sufficiently different to eliminate any likelihood of confusion. Applicant's goods are typical flooring planks for indoor use in homes and sometimes offices.

On the other hand, the goods of the three Cited Marks are all very distinct from this. First, the '506 registration's goods are specialized for use as temporary/portable dance floors for outdoor use. A consumer who is organizing a special one-time event like an outdoor wedding reception, and thus is looking for a temporary outdoor dance floor, would not mistakenly purchase Applicant's traditional indoor home flooring products. While the Examiner's evidentiary files do show several different materials are used in dance floors, it is clear that all the dance floors are (1) modular, (2) temporary, (3) portable, and (4) not sold with traditional home indoor flooring products. On the other hand, Applicant's goods are sold where traditional flooring products are found (e.g., Home Depot, Floor n' Décor, Lowe's, etc.). Further, Applicant's goods are instead (1) not modular, (2) permanent, (3) not portable, and (4) not sold with dance floors.

Next, the '391 registration's goods are concrete products. The concrete products that the '391 Registrant offers are floor tiles or specialized poured-in-place floors. While it is true

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<sup>5</sup> *ConAgra, Inc. v. Saavedra*, 4 USPQ2d 1245, 1246 (TTAB 1987).

<sup>6</sup> *Lever Bros. Co. v. Barcolene Co.*, 463 F.2d 1107, 1108-09, 174 USPQ 392 (CCPA1972) (where the focus was viewing the marks as a whole, not dissecting the overlapping portion).

<sup>7</sup> *Melaro v. Pfizer, Inc.*, 214 USPQ 645, 648 (TTAB 1982) (where the mark SILK was suggestive, thus the addition of other matter was enough to distinguish the two marks).

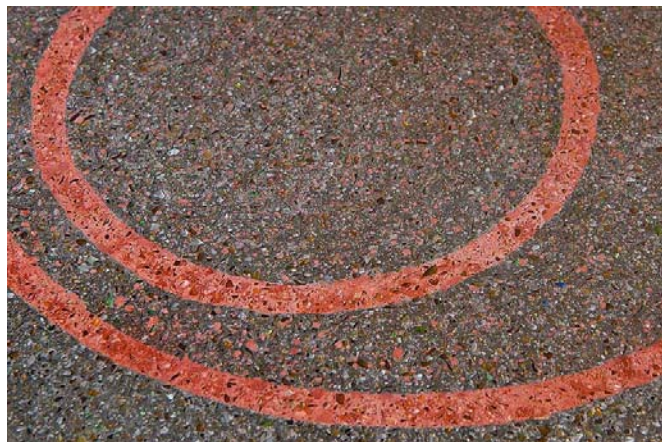
<sup>8</sup> *Pacquin-Lester Co. v. Charmaceuticals, Inc.*, 484 F.2d 1384, 1385, 179 USPQ 45 (CCPA 1973) (where the owner of the mark SILK'N'SATIN' could not prevent the registration of the mark SILK).

<sup>9</sup> *Jet Inc. v. Sewage Aeration Systems*, 165 F.3d 419, 49 USPQ 2d 1355 (6<sup>th</sup> Cir. 1999).

<sup>10</sup> *Mr. Hero Sandwich Systems, Inc. v. Roman Meal Co.*, 781 F.2d 884, 887-88, 228 USPQ 364 (Fed. Cir. 1986) (where ROMAN was a design mark which included a soldier design, the Court held that even though ROMAN was the dominant element in both marks, the marks as a whole were not similar).

<sup>11</sup> *In re Hearst Corp.*, 982 F.2d 493, 494, 25 USPQ 1238 (Fed. Cir. 1992) (where the term VARGA was the dominant element and the additional GIRL was description, however, the marks were not found similar when considered in their entireties).

the '391 Registrant offers smaller concrete floor tiles, concrete tiles are not the same as traditional vinyl flooring planks. Concrete and vinyl are two different materials. As such, an ordinary consumer looking for concrete tiles or a poured-in-place concrete floor would not mistakenly purchase Applicant's traditional vinyl flooring plank products. See below photo of flooring examples from '391 Registrant's own website (<http://www.geomatrixinc.com/GalleryFlooring.html>):



Finally, as for the '024 registration's goods, they are specialized flooring underlayment products. While conceivably the '024 goods might be used under Applicant's goods, the '024 goods and Applicant's goods are not substitutes for each other, nor do they compete. Instead, the '024 goods are used underneath traditional flooring products in order for consumers to heat those traditional flooring products, and the '024 goods are not used as actual floors themselves. Ordinary consumers looking for a heated mat/product that goes under the floor would not mistakenly purchase Applicant's traditional flooring products.

Were the ordinary consumer to encounter Applicant's goods and the Cited Marks' goods, there is little or no possibility of confusion between traditional flooring products (Applicant) on the one hand, and the other products on the other because the Cited Marks' goods are directed either at a specific function (i.e., dance floor or heated floor) or a specialized product (i.e., concrete floor).

### **Channels of Trade**

Even if Applicant's and Registrants' goods were related products, there would still be no likelihood of confusion because the products are offered through very different channels of trade and to very different types of consumers.

While there are several *DuPont* factors to be considered, any one of which can be dominant depending on the record. 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973). One of the most relevant factors is the similarity or dissimilarity of established, likely-to-continue trade channels of the goods. TMEP §§1207.01 et seq. The proposition that related goods may be confused does not depend on the fact that the goods fall within a similar or identical "category,"

but rather the more specific finding that competitive or related goods are offered through the same channels of trade to the same class of purchasers. *In re Rebel, Inc.*, 223 U.S.P.Q. 830, 831 (T.T.A.B. 1984). When the goods of one party are sold to one class of buyers in a different marketing context than the goods of another seller, the likelihood of any confusion is lessened. Thus, even when marks are identical and goods are in the same “category,” sales to different groups of purchasers through different channels of trade “are sufficient to raise a doubt as to likelihood of confusion, mistake or deception.” *In re Radiant Color Co.*, 156 U.S.P.Q. 703, 704 (T.T.A.B. 1968) (RADIANT for coated paper not confusingly similar to RADIANT for loose paper).

With respect to the ‘506 registration, it is clear the channels of trade and consumers are different. The ‘506 goods are portable outdoor dance floors, which are specialized products not sold through the same outlets as traditional home indoor flooring products. This can be seen in the Examiner’s own evidentiary files (see Office Action pages 6-24). As previously discussed, the ‘506 goods are not sold with traditional home indoor flooring products (**see Exhibit C**). On the other hand, Applicant’s goods are sold where traditional flooring products are found (e.g., Home Depot, Floor n’ Décor, Lowe’s, etc.).

Further, consumers looking for portable and/or temporary dance floors are looking for very specific goods and they would not be confused with Applicant’s traditional, permanent flooring products. According to TMEP §1207.01(a)(I), if the goods in question 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, then, *even if the marks are identical*, confusion is not likely. *See, e.g., Local Trademarks, Inc. v. Handy Boys Inc.*, 16 USPQ2d 1156 (TTAB 1990); *Quartz Radiation Corp. v. Comm/Scope Co.*, 1 USPQ2d 1668 (TTAB 1986). As such there is no confusion, in accordance with *In re Rebel*, because although the class number is the same, the ‘506 Registrant’s goods would not be encountered by the same person encountering Applicant’s goods because they are offered through different channels to different consumers.

Turning to the ‘391 registration, the channels of trade and consumers are also different than the Applicant’s. The ‘391 goods are not purchased by your average residential retail consumer, but are instead purchased by a professional contractor and used in the commercial industry. The ‘391 Registrant offers concrete tiles and specialized poured-in-place concrete floors and tiles which appear to be many times custom-made for each commercial customer due to the individualized nature of each person’s home, floor size, design desires, and numerous other variables. Conversely, the Applicant’s goods are found where traditional, residential consumers search for flooring products (e.g., Home Depot, Floor n’ Décor, Lowe’s, etc.).

In addition, consumer’s looking for the ‘391 registration’s goods are looking for unique, custom products and they would not be confused with Applicant’s traditional, luxury vinyl flooring planks. Just like the ‘506 goods above, and in accordance with TMEP §1207.01(a)(I), the ‘391 registration’s goods and Applicant’s goods are not marketed in a way that would be encountered by the same consumer. Therefore, confusion is unlikely. *See, In re Rebel*, 223 U.S.P.Q. at 831.

As for the ‘024 registration, the channels of trade arguably might not be as significantly different, though they need not be because of the greater differences in the marks themselves. Nevertheless, Applicant’s goods are marketed and sold to a very different class of purchaser. Thus, there should be real doubt as to the potential likelihood of confusion. This is because consumers looking for the ‘024 goods are looking for specialized goods. Based on the ‘024

Registrant's website, these too appear to be "custom-built" in nature due to different customer's needs. This is because the '024 goods are custom-made for each customer due to the individualized nature of each person's home and floor size where the heated floor mats are installed. Each customer's needs for the '024 goods are unique.

Thus the transactions with the '024 Registrant is personal and individualized. Applicant's products, by contrast, are mass-merchandised. Thus there is no likelihood of confusion since the goods are not marketed in such a way that they would be encountered by the same person. TMEP §1207.01(a)(l).

The channels of trade through which Applicant's traditional flooring goods and all the Registrants' specialized goods are encountered are also distinct and unrelated. As a result, it is unlikely that there would be any confusion on the consumer's part as to the sources of the parties' respective goods.

### **Discriminating and Sophisticated Purchasers**

Not only are the channels of trade different, the consumers are discriminating and sophisticated purchasers. Another principal factor to be considered in determining whether there is a likelihood of confusion under Section 2(d) is the conditions under which, and buyers to whom, sales are made, i.e., "impulse" versus careful, sophisticated purchasing. As TMEP §1207.01(d)(vii) states, circumstances suggesting care in purchasing may tend to minimize likelihood of confusion. The Cited Marks' customers are sophisticated due to the process and expense involved in obtaining the Registrants' products, as well as, who the purchasing consumer is. "In making purchasing decisions regarding 'expensive' goods, the reasonably prudent person standard is elevated to the standard of the 'discriminating purchaser.'" J. Thomas McCarthy, *McCarthy on Trademarks*, § 23:96, (4<sup>th</sup> ed.1998). See, e.g., *Magniflux Corp. v. Sonoflux Corp.*, 231 F.2d 669, 671, 109 U.S.P.Q. 313, 315 (C.C.P.A. 1956) ("confusion is less likely where goods are expensive and purchased after careful consideration").

The consumers of the '506 Registration's goods are discriminating purchasers, given that modular dance floors tend to be expensive and are specialized products for specific purposes, because they can be presumed to make their purchases only after careful investigation. Therefore, '506 Registrant's prospective consumers are held to a higher standard for determining likelihood of confusion.

The consumers of the '391 Registration's goods are discriminating purchasers, given that concrete floors tend to be expensive because they are poured-in-place (thus creating more costly installation fees due to the need to custom-frame the space to be poured, have a specialized concrete truck go out to the site for the duration of the pouring, etc.), because they can be presumed to make their purchases only after carefully investigating and understanding the product. As such, prospective customers of '391 Registrant's concrete floors are held to a higher standard for determining likelihood of confusion.

The consumers of the '024 Registration's goods are discriminating purchasers as well, given that heated flooring underlayments are likely expensive and are specialized products for specific purposes, because they can be presumed to make their purchases only after careful investigation. Therefore, '024 Registrant's prospective consumers are held to a higher standard for determining likelihood of confusion.

Next the level of sophistication of prospective customers is relevant. See, *Polaroid Corp. v. Plarad Elcs. Corp.*, 287 F.2d 492, 495 (2d Cir.), cert. denied, 368 U.S. 820 (1961); and *Med Data Cent., Inc. v. Toyota Motor Sales, U.S.A., Inc.*, 875 F.2d 1026, 1036-37 (2d Cir.

1989). “Where the [ ] consumers are sophisticated, there is a reduced likelihood that the junior mark will blur the senior mark’s selling power.” *Mead Data*, 875 F.2d at 1036 (where the mark LEXUS for cars was unlikely to cause confusion with LEXIS for legal service because the market for LEXIS was mostly lawyers and accountants who are sophisticated consumers.)

Given that portable and modular dance floors are specialized products for specific purposes, consumers looking for those specific products, such as wedding planners and event organizers. Here, the ‘506 Registrant’s customers and prospective customers are very sophisticated professionals, just like the consumers of LEXIS brand products and services. The consumers of the ‘506 Registrant’s goods are looking for specific goods to fulfill their specific needs. Thus, the ‘506 Registrant’s prospective consumers are sophisticated and held to a higher standard for determining likelihood of confusion.

Finally, the consumers of the ‘391 goods are also sophisticated because they are commercial contractors, not your average consumer. Thus, these sophisticated buyers know what they are looking for when searching for the ‘391 goods and are less likely to be confused by Applicant’s typical flooring products.

As all of the Cited Marks Registrants’ customers should be deemed discriminating and at least the ‘506 Registrant’s customers should be deemed sophisticated, these weigh against likelihood of confusion.

#### **Any Actual Confusion**

Applicant submits it has been using the mark in connection with its goods for approximately 3-6 months in over 100 stores with no known instances of actual confusion. While not a significant amount of time, this should weigh against likelihood of confusion.

#### **De Minimis Potential Confusion**

Considering all the differences demonstrated above, the potential for confusion is *de minimis*, at best. It is highly improbable that any consumer would ever mistakenly purchase one good believing it to be another, assume that there is some sponsorship or affiliation between the parties, or believe that the Applicant’s goods and the Registrant’s goods originate from a common source.

#### **Conclusion**

In view of the above-noted clear and distinct differences in the marks, the Registrants’ goods and the Applicant’s goods, the channels of trade, and the different, sophisticated consumers, consumer confusion would be extremely unlikely. Simply stated, Applicant’s and Registrants’ worlds would never collide.

Having addressed the Examining Attorney’s concerns, Applicant hereby requests favorable reconsideration of this application and approval for publication.