

The Examining Attorney refused registration of Applicant's Trademark Application 79/216,954 under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), based on a likelihood of confusion with the marks in U.S. Registrations No. 4,372,158; 4,372,156; 2,417,725 and 1,228,094. Applicant respectfully disagrees with this position of the Examining Attorney.

With respect to the mark "MICRON MOLY" of U.S. Reg. No. 1,228,094 for "Motor Oil", in the Response all goods in Int. Class 4 were deleted from the Application.

As to U.S. Registrations No. 4,372,158; 4,372,156 and 2,417,725, these three cited registrations for "MICRON" and "PIGMA MICRON" cover goods in International Class 16. More specifically, these Registrations cover "WRITING INSTRUMENTS" only.

In the Response, by amending the description of goods in International Class 16, Applicant has made the best faith effort to differentiate such goods from the goods related to "WRITING INSTRUMENTS" of the cited registrations. In the opinion of the Applicant, the remaining goods in Class 16 are not sold or provided through the same channels and used by the same classes of consumers in the same field of use. Furthermore, Applicant respectfully considers it is unlikely that the entity which provides the "WRITING INSTRUMENTS" and markets such instruments under the marks of the cited registrations and the goods currently of record in International Class 16 of the application are sold or provided through the same channels and used by the same classes of consumers in the same field of use.

However, Applicant requests guidance from the Examining Attorney to indicate if further amendment to the goods in International Class 16 is needed.

## **SUBSTANTIVE REMARKS AND ARGUMENTS**

### **Section 2(d) Refusal – Likelihood of Confusion**

In the Office Action the Examining Attorney argues that registration of the applied-for mark is refused because of a likelihood of confusion with the marks in U.S. Registrations No. 4,372,158; 4,372,156 and 2,417,725, Trademark Act Section 2(d), 15 U.S.C. §1052(d); *see* TMEP §§1207.01 *et seq.*

In the Office Action, the Examining Attorney indicates that Trademark Act Section 2(d) bars registration of an applied-for mark that so resembles a registered mark that is likely that a potential consumer would be confused or mistaken or deceived as to the source of the goods and/or services of the applicant and registrant. *See* 15 U.S.C. §1052(d). The court in *In re E. I. du Pont de Nemours & Co.*, 476 F. 2d 1357, 177 USPQ 563 (C.C.P.A. 1973) listed the principal factors to be considered when determining whether there is a likelihood of confusion under Section 2(d). *See* TMEP §1207.01.

Applicant respectfully disagrees with the position of the Examiner discussed in the Office Action.

## Channels of Trade and Likelihood Of Confusion

An essential factor in determining confusion is that the channels of trade and manners of distribution of goods in the Applicant's mark and in the cited marks are different.

Appliques in the form of decalcomanias; Aquarelles; Bags of paper or plastics, for packaging; Canvas for paintings; Cardboard articles, namely, cardboard boxes, cardboard containers, cardboard packaging, cardboard carries for food and beverages; Figurines, statuettes, of papier mâché; Labels, not of textile, namely, adhesive labels, blank or partially printed paper labels, labels of paper or cardboard, plastic labels; Modelling clay; Modeling materials, namely, polymer modeling clay, modeling paste, modeling dough, modeling wax not for dental purposes, modeling compounds for use by children; Packaging material made of starches, namely, packaging and containers comprised of starch-based materials in the nature of a paper substitute for food, beverages and consumer products; Printed patterns for making clothes; Bookends; Photograph stands; Modeling compounds, namely, plastics for modelling; Painting sets for artists; Stencil plates; Stickers; Table napkins of paper

and other goods currently of record in Class 16 of the Application sold under Applicant's mark are distributed primarily through specialized on-line and regular stores, where they can be found in specialized sections. These types of goods attract "niche" shoppers interested primarily in these very specific goods and not in "WRITING INSTRUMENTS" of the cited registrations.

In Bentley Motors Serial No. 85325994 (December 3, 2013), the Board, reversed a refusal to register the mark BENTLEY for perfume, cosmetics, and glassware "sold only in authorized vehicle dealers and authorized vehicle service outlets," finding the mark not

likely to cause confusion with the marks BENTLEY, BENTLEY UNIVERSITY, and BENTLEY ORGANIC for similar or identical goods.

The applicant Bentley Motors successfully argued that, because its goods are sold only through the “very tightly-knit” Bentley circle of dealers and service outlets to a “niche, affluent clientele,” confusion is unlikely. The Board agreed.

In this case the Examining Attorney argued that since the cited registrations are unrestricted as to channels of trade, the goods are presumed to travel in all normal channels of trade. The Board observed, however, that there was no evidence that the ordinary channels of trade for registrants’ goods include Bentley’s authorized dealers and service outlets.

Put another way, Bentley’s goods are marketed solely and exclusively through dealers and service outlets for Bentley and Rolls Royce automobiles. The Board held that the Examining Attorney failed to support the proposition that the goods identified in the cited registrations normally move in those exclusive channels of trade, notwithstanding the fact that the cited registration do not recite any trade channel limitations. The Board held that the burden is on the Examining Attorney to prove that the ordinary trade channels for the registrants’ goods overlap with the applicant’s very limited trade channel.

The Board found this factor to be dispositive, and it therefore reversed the refusal. In fact, the Board found this factor to be so pivotal that it did not even discuss the other six confusion factors, instead resting its entire opinion on the limitation of trade channels.

Applicant has amended the Description of Goods in International Class 16 of the present Trademark Application to emphasize that the goods are very different from “WRITING INSTRUMENTS”. The goods as currently amended in Class 16 are typically sold to specific “niche” purchases. Therefore, in the Applicant’s opinion, it is unlikely that purchasers of “WRITING INSTRUMENTS” (of the Cited mark) will look for such instruments in the specialized sections of stores serving the above-discussed “niche” community. Thus, confusion is unlikely. Furthermore, Applicant respectfully considers it is unlikely that the entity which provides the “WRITING INSTRUMENTS” and markets such instruments under the marks of the cited registrations and the goods currently of record in International Class 16 of the application are sold or provided through the same channels and used by the same classes of consumers in the same field of use.

By amending description of goods as discussed above, Applicant respectfully argues that it has minimized the possibility of confusion with the Cited Registration.

### **CONCLUSION**

Applicant respectfully submits that the Applicant’s mark is entitled to registration to all applicable classes, including the currently amended goods of International Classes 16 presented in the Response, and respectfully requests that the Examining Attorney will pass said mark to issue.

Applicant also respectfully requests that in the event the Examining Attorney does not agree with Applicant's Response, a final refusal will not be issued, so that Applicant may have the opportunity to respond further to the Examining Attorney's concerns.

PTOResponse01\_1782