

## REMARKS

In the Office Action, the examining attorney refused registration of the applied-for mark under 15 U.S.C. §1052(d) based on a likelihood of confusion with the marks in U.S. Registration Nos. 3173268 and 4794443 (hereinafter “the ‘268 mark” and “the ‘443 mark,” respectively). The applicant respectfully traverses this refusal.

### ***The proposed mark will not create a likelihood of confusion with the above referenced registered mark.***

In response to the above refusal, the applicant submits that the proposed mark will not create a likelihood of confusion. The Office Action states that “Trademark Act Section 2(d) bars registration of an applied-for mark that so resembles a registered mark that it 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.” Office Action, citing 15 U.S.C. § 1052(d). *In re E.I. du Pont de Numours & Co.*, 476 F.2d 1357 (C.C.P.A. 1973). The applicant submits that that a number of the 13 factors laid out by the court in *In re E.I. du Pont de Numours & Co.*, 476 F.2d 1357 (C.C.P.A. 1973) are relevant to the to the instant case. Specifically, the applicant submits that the proposed mark will not create a likelihood of confusion, because, among other things, 1.) the proposed mark is used for different goods from those of the registered marks, 2.) the proposed mark is used in different trade channels than those of the registered marks, and 3.) the customers in the field of the registered trademarks listed above and the field of the proposed mark are sophisticated. In other words, each of the foregoing distinctions are relevant *du Pont* factors.

### ***1 - Relatedness of Goods.***

The first factor relevant to this case is the relatedness of the goods and/or services that the proposed mark represents when compared with the ‘268 and ‘443 marks cited by the examining attorney.

The ‘268 mark

The identification of goods for the proposed mark specifies that the proposed mark is intended to represent spray guns for electrostatic paint, and, more specifically, “electrostatic coating machines and parts thereof and attachments and accessories for use therewith, namely, spray coating guns.” In contrast, the ‘268 mark cited by the examining attorney is owned by National Foam and covers a “pumping system for fighting fires comprised of suction pumps and electrical water pumps.” The ‘268 mark identifies goods and services related to firefighting concerning goods for use in the context of fire safety. While the base word “pump” is used in the description for both marks to identify the type of goods that the marks represent, a pump for spray guns (as the proposed mark is intended to represent) may be described as “a device for pumping a fluid that is electrostatic paint.” This definition clearly indicates that the applicant intends a usage of the mark that represents goods or services not related to firefighting.

Clarifying Amendment

Further distinguishing “pump” from a device related to the firefighting industry is the amendment to the identification of goods indicating that the pump is an electric pump “for use in

industrial applications, namely applying coating materials, namely paints.” This amendment indicates that the applicant does not intend to use the proposed mark in the field of firefighting. The ‘268 mark cited by the examining attorney generally represents goods and services related to firefighting. As such, this present amendment further reduces the possibility of customer confusion, because the applicant is indicating that the mark will be used for industrial applications related to applying coating materials.

The ‘443 mark

The ‘443 mark cited by the examining attorney is owned by Kop-Coat, Inc. and covers “marine paint.” The ‘443 mark identifies goods and services related to marine paint concerning paint for use in the context of oil based paints that are used to paint boats that are exposed to water for extended periods of time. While the base word “paint” is used in the description for both marks to identify the type of goods that the marks represent, an amendment to the proposed description of goods for a paint for spray guns (as the proposed mark is intended to represent) describes the paint as “electrostatic paint.” Electrostatic paint is generally understood to mean paint in the form of either powdered particles or atomized liquid, which is initially projected towards a conductive workpiece using normal spraying methods, and is then accelerated toward the work piece by a powerful electrostatic charge. This definition, and ordinary meaning, of the word “electrostatic paint” clearly indicates that the applicant intends a usage of the mark that represents goods or services not related to marine paint.

Therefore, because the device is related to equipment associated with spraying paints (e.g., spray guns for electrostatic paint), the likelihood of customer confusion under Section 2(d) is extremely low due to the goods represented by the marks being unrelated.

## **2 - Similarity of Trade Channels.**

The second *du Pont* factor relevant to this case involves a determination of whether or not the products represented by the proposed mark and the registered marks cited by the examining attorney are sold in the same trade channels. The applicant points out that the TMEP states that “if 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.” TMEP § 1207.01(a)(i), citing *Shen Manufacturing Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 73 USPQ2d 1350 (Fed. Cir. 2004). For this determination, the marketing channels and the class of customers should be analyzed. The marketing channels of the goods and services surrounding the ‘268 mark cited by the examining attorney is likely geared toward firefighting safety. For example, the goods and services represented by the ‘268 mark cited by the examining attorney may be marketed in the firefighting industry or tradeshows. In sharp contrast, the goods represented by the proposed mark may be marketed in paint shops, in trade publications for electrostatic painting, or in hardware stores in specific areas for electrostatic painting applications. The products are marketed in completely separate channels, and, thus, the proposed mark is unlikely to cause confusion as to the source of goods.

The marketing channels of the goods and services surrounding the ‘443 mark cited by the examining attorney is likely geared toward boat painters. For example, the goods and services represented by the ‘443 mark cited by the examining attorney may be marketed in the industry or tradeshows. In sharp contrast, the goods represented by the proposed mark may be marketed in paint shops, in trade publications for electrostatic painting, or in hardware stores in specific areas for electrostatic painting applications. The products are marketed in completely separate channels, and, thus, the proposed mark is unlikely to cause confusion as to the source of goods.

Further, the products represented by the proposed mark and the '268 and the '443 marks cited by the examining attorney are sold to different classes of customers. An electrostatic spray gun represented by the proposed mark is sold to people working with tools that may paint specific workpieces that are conductive that yield themselves to electrostatic spraying applications. On the other hand, the goods and services represented by the '268 and '443 marks cited by the examining attorney are sold or provided for customers with firefighting backgrounds and paint jobs for articles that will be exposed to water for long periods of time. The clear distinction between customer classes makes it unlikely that the customers will be confused as to the source of the goods or services by the proposed mark.

### ***3 - Sophistication of the Customers.***

The final *du Pont* factor relevant to this case involves a determination of the sophistication of the customers. In particular, the conditions under which sales are made and the buyers to whom sales are made should be analyzed (i.e., impulse vs. careful, sophisticated purchasing). See TMEP § 1207.01. It is clear from the determinations above that neither the purchaser of an electrostatic spray gun branded under the proposed mark nor the purchaser of a pumping system for firefighting branded under the '268 mark cited by the examining attorney or the purchaser of marine paint branded under the '443 mark would be an impulse purchaser. While the devices represented by the marks at issue are not related to each other, a consumer purchasing a device in any of the aforementioned fields is likely to take considerable time in evaluating the product's comfort, effectiveness, and performance (among many other considerations) prior to making a purchase. As such, it is unlikely that a consumer would simply purchase the first item that they come across on a whim. There is likely a well thought out process involved prior to making a purchase in the aforementioned fields. Therefore, because the consumers are likely to be sophisticated purchasers, it is further unlikely that the consumer would be confused as to the source of the goods or services by the proposed mark.

When weighing the factors above, it is clear that a consumer would not be confused about the source of the goods and/or services represented by the proposed mark. As such, the products are significantly different, the trade channels are entirely different, and the customers purchasing the goods or services are sophisticated. For at least these reasons, the applicant respectfully submits that the proposed mark would not cause a likelihood of confusion with the '268 mark and the '443 under the Trademark Act Section 2(d). As such, the applicant respectfully requests that the examining attorney withdraw the refusal to register the applied-for mark and also register the same.

### **CONCLUSION**

Based on the above Remarks, the applicant respectfully requests withdrawal of the Section 2(d) Refusal and further requests publication of the instant application. Should the Office have any questions, please contact the attorney of record.