

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

**Trademark:** OPTIMA  
**Applicant:** OPTIMA-Maschinenfabrik Dr. Bühler GmbH & Co. KG  
**U.S. Serial No.:** 87/671,325  
**Filed:** November 3, 2017  
**Examining Attorney:** Eugenia K. Martin, Law Office 114

**AMENDMENTS TO THE APPLICATION**

Elsewhere in this Response, Applicant has amended its identification of services in order to improve clarity and specificity. The amended identification of services is as follows:

Class 35: Advertising, marketing and sales promotion; organizational inventory management; all aforementioned services related to machines, equipment and components thereof for packaging, metering, filling, sealing, labelling, freeze-drying, sterilizing and decontaminating, and related to machines, equipment and components thereof for producing medical, medico-technical, pharmaceutical and diagnostic products; trading, also via the Internet, namely, operating a marketplace where others may negotiate transactions for used, overhauled and refurbished packaging, metering, filling, sealing, labelling, freeze-drying, sterilizing and decontaminating machines, equipment and components for producing medical, medico-technical, pharmaceutical and diagnostic products; all aforementioned services not for use in measuring technology.

Class 37: Construction, installation, repair, reconstruction, overhauling, servicing and maintenance of machines, equipment and components, namely packaging, metering, filling, sealing, labelling, freeze-drying, sterilizing and decontaminating machines, equipment and components and machines, equipment and components for producing medical, medico-technical, pharmaceutical and diagnostic products; all aforementioned services not for use in measuring technology.

Class 41: Instruction and further training namely, the planning, arranging and conducting of seminars, workshops, educational symposiums, and educational conferences on the subject of safety, operation, repair of packaging, metering, filling, sealing, labelling, freeze-drying, sterilizing and decontaminating, machines, equipment and components and machines, equipment and components for producing medical, medico-technical, pharmaceutical and diagnostic products; all aforementioned services not for use in measuring technology.

Class 42: IT services, in particular development, programming and implementation of software, development of computer hardware; IT services, in particular research and development and implementation of computers and computer systems, namely, monitoring of computer systems by remote access; providing technical information on packaging, metering, filling, sealing, labelling, freeze-drying, sterilizing and decontaminating machines, equipment and components and machines, equipment and components for producing medical, medico-technical, pharmaceutical and diagnostic products; technical consulting on packaging, metering, filling, sealing, labelling, freeze-drying, sterilizing and decontaminating machines, equipment and components and machines, equipment and components for producing medical, medico-technical, pharmaceutical and diagnostic products; technical monitoring and inspection services, namely, monitoring and inspection of packaging, metering, filling, sealing, labelling, freeze-drying, sterilizing and decontaminating machines, equipment and components and machines, equipment and components for producing medical, medico-technical, pharmaceutical and diagnostic products; monitoring and optimizing of industrial procedures, namely, procedures relating to packaging, metering, filling, sealing, labelling, freeze-drying, sterilizing and decontaminating machines, equipment and components and machines, equipment and components for producing medical, medico-technical, pharmaceutical and diagnostic products; all aforementioned services not for use in measuring technology.

### **ARGUMENTS IN RESPONSE TO FEBRUARY 17, 2018, OFFICE ACTION**

In the Office Action dated February 17, 2018, the Examining Attorney refused registration for Applicant's OPTIMA mark under Trademark Act Section 2(d), 15 U.S.C. § 1052(d), on the grounds that there is a likelihood of confusion between Applicant's mark and several prior registrations for marks also using the term "OPTIMA" listed below:

- OPTIMA SOLUTIONS, Reg. No. 2,783,055, for use with "Technical consultation services for manufacturing operations of others, namely, providing technical consultation services in relation to chemical management; and chemicals management services, namely, monitoring, using and evaluating chemicals for manufacturing operations of others;"
- IOPTIMA, No. 3,308,123, for use with "analyzing market information relating to physicians and pharmaceutical representatives to optimize sales of pharmaceuticals, unrelated to the creation and analysis of brand identities and brand positioning;"
- ENEA OPTIMA, Reg. No. 3,550,490, for use with "Scientific and technological services in the fields of telecommunications, information technology and computer programming, and research and design relating thereto; industrial analysis and research in the fields of telecommunications, information technology and computer programming; design,

development, installation, maintenance and updating of computer software; design and development of computer hardware and computer operating systems; design and development of computer hardware and software for database management, namely, computer hardware and software for embedded, high-speed and real-time applications for database management; recovery of computer data; computer programming; consultancy in the field of computer hardware and software; computer network, hardware and software systems design, computer systems analysis; conversion of data or documents from physical to electronic media; non-physical data conversion of computer programs and data;”

- OPTIMA & Design, Reg. No. 4,263,096, for use with “Installation and maintenance of computer systems” and “Design, development, installation and maintenance of computer software; design and development of computer systems; providing information about the design and development of computer hardware and software;”
- OPTIMA THE RIG COOLING SPECIALISTS, Reg. No. 4,995,626, for use with “Appliances for water distribution, namely, machines in the nature of electric pumps for using water for safety purposes and delivering water for safety purposes, excluding water filters; mechanical high pressure jet water apparatus, namely, pumps and nozzles; mechanical dispensing devices, namely, pumps and nozzles for use with jet water apparatus; water collecting apparatus, namely, electric pumps, excluding water filters; water discharging apparatus, namely, pumps and nozzles for safety use, excluding water filters; water distributing apparatus, namely, machines in the nature of electric pumps for safety purposes excluding water filters; water distribution machines in the nature of electric pumps for safety, excluding water filters; water processing machines in the nature of water treatment equipment, namely, pumps for safety purposes; water pumps for vehicles, excluding water filters; water supply machines, namely, electric pumps for use in oil wells, gas wells, oil platforms and gas platforms, excluding water filters; electric pumps for delivering predetermined quantities of water for use in safety; electric pumps for dispensing substances from containers, namely, pumps used in emergency situations to dispose of oil and gas; hydraulic pumps for use under water; ejectors, namely, electric, hydraulic or pneumatic pumps for safety, engine driven water pumps for use in oil and gas platforms, electric, hydraulic or pneumatic fluid pumps for safety purposes; machines for making pumps; marine pumps, namely, bilge pumps, sludge pumps, salt water pumps; electric motors for use with pumps; combustion engine fuel nozzles; rotary nozzles for use with high pressure water dispensing machines; spray nozzles being parts of machines; parts and fittings for the aforesaid goods,” “Apparatus and instruments, namely, irrigation spray pumps and nozzles for the distribution and supply of water, excluding water filters; air cooling apparatus; apparatus, namely, cold water sprayers for the cooling of objects, namely, oil platforms and gas platforms using cold water, excluding water filters; cooling apparatus for oil platforms and gas platforms; cooling elements, namely, electric fans, evaporators and faucet sprayers; cooling installations for water, excluding water filters; electric cooling apparatus, namely, air conditioners; installations for cooling oil platforms and gas platforms; water cooling apparatus, namely, towers, excluding water filters; water showering devices, namely, shower head sprayers, shower control valves and nozzles; watering apparatus and installations, namely, faucet sprinklers and nozzles

excluding water filters; water supply apparatus, namely, flexible pipes being parts of plumbing installations, rigid pipes being parts of plumbing installations and coupling joints excluding water filters; water supply installations, namely, pipes to cool heat-producing components being parts of safety apparatus, excluding water filters; parts and fittings for the aforesaid goods,” “Provision of engineering services for the offshore and onshore oil and gas industry; onshore and offshore process design, namely, design of safety equipment; design relating to deluge systems for oil and gas flaring applications including FPSO's (floating production storage and offloading vessels), platforms, jackups, semi-submersibles, drilling rigs and land rigs within the oil and gas industries; design and development of water dispensing apparatus and installations, excluding water filters; design and development of cooling apparatus and installations; design and development of fire control apparatus and installations; engineering design and consultancy; engineering research; engineering surveying; engineering testing of oil platforms and gas platforms; preparation and provision of engineering drawings and reports; product design services of oil platforms and gas platforms; research services relating to the oil and gas industry; information, advisory and consultancy services relating to the aforesaid services” and “Technical advice relating to fire prevention;”

- OPTIMA THE RIG COOLING SPECIALISTS & Design, Reg. No. 4,995,627, for use with “Appliances for water distribution, namely, machines in the nature of electric pumps for using water for safety purposes and delivering water for safety purposes, excluding water filters; mechanical high pressure jet water apparatus, namely, pumps and nozzles; mechanical dispensing devices, namely, pumps and nozzles for use with jet water apparatus; water collecting apparatus, namely, electric pumps, excluding water filters; water discharging apparatus, namely, pumps and nozzles for safety use, excluding water filters; water distributing apparatus, namely, machines in the nature of electric pumps for safety purposes excluding water filters; water distribution machines in the nature of electric pumps for safety, excluding water filters; water processing machines in the nature of water treatment equipment, namely, pumps for safety purposes; water pumps for vehicles, excluding water filters; water supply machines, namely, electric pumps for use in oil wells, gas wells, oil platforms and gas platforms, excluding water filters; electric pumps for delivering predetermined quantities of water for use in safety; electric pumps for dispensing substances from containers, namely, pumps used in emergency situations to dispose of oil and gas; hydraulic pumps for use under water; ejectors, namely, electric, hydraulic or pneumatic pumps for safety, engine driven water pumps for use in oil and gas platforms, electric, hydraulic or pneumatic fluid pumps for safety purposes; machines for making pumps; marine pumps, namely, bilge pumps, sludge pumps, salt water pumps; electric motors for use with pumps; combustion engine fuel nozzles; rotary nozzles for use with high pressure water dispensing machines; spray nozzles being parts of machines; parts and fittings for the aforesaid goods,” “Apparatus and instruments, namely, irrigation spray pumps and nozzles for the distribution and supply of water, excluding water filters; air cooling apparatus; apparatus, namely, cold water sprayers for the cooling of objects, namely, oil platforms and gas platforms using cold water, excluding water filters; cooling apparatus for oil platforms and gas platforms; cooling elements, namely, electric fans, evaporators and faucet sprayers; cooling installations for water, excluding water filters; electric cooling apparatus, namely, air conditioners; installations for cooling oil platforms

and gas platforms; water cooling apparatus, namely, towers, excluding water filters; water showering devices, namely, shower head sprayers, shower control valves and nozzles; watering apparatus and installations, namely, faucet sprinklers and nozzles excluding water filters; water supply apparatus, namely, flexible pipes being parts of plumbing installations, rigid pipes being parts of plumbing installations and coupling joints excluding water filters; water supply installations, namely, pipes to cool heat-producing components being parts of safety apparatus, excluding water filters; parts and fittings for the aforesaid goods,” “Provision of engineering services for the offshore and onshore oil and gas industry; onshore and offshore process design, namely, design of safety equipment; design relating to deluge systems for oil and gas flaring applications including FPSO's (floating production storage and offloading vessels), platforms, jackups, semi-submersibles, drilling rigs and land rigs within the oil and gas industries; design and development of water dispensing apparatus and installations, excluding water filters; design and development of cooling apparatus and installations; design and development of fire control apparatus and installations; engineering design and consultancy; engineering research; engineering surveying; engineering testing of oil platforms and gas platforms; preparation and provision of engineering drawings and reports; product design services of oil platforms and gas platforms; research services relating to the oil and gas industry; information, advisory and consultancy services relating to the aforesaid services” and “Technical advice relating to fire prevention;”

- OPTIMA, Reg. No. 4,110,008, for use with “business services, namely, sales promotion and inventory management services in the field of bearings, seals, bearing housings and bearing accessories by planning, implementing and coordinating the business process from manufacturing through shipping, thereby reducing lead times in shipping products to others;”
- OPTIMA, Reg. No. 5,263,225 for us with “Cabinets for liquid and gas fuel dispensers, namely, dispenser cabinets for automatic temperature compensation so that the appropriate amount of liquid or gas fuel is metered, not used for underwater and offshore oil rigs;” “Wholesale reseller services, namely, distributorship services in the field of cabinets for liquid and gas fuel dispensers, not used for underwater and offshore oil rigs; providing a website featuring consumer product information in the field of cabinets for liquid and gas fuel dispensers, not used for underwater and offshore oil rigs,” “Installation, maintenance, and repair of cabinets for liquid and gas fuel dispensers, not used for underwater and offshore oil rigs; technical support services, namely, technical advice related to the installation and repair of cabinets for liquid and gas fuel dispensers, not used for underwater and offshore oil rigs,” and “Computer services, namely, hosting and maintaining an online website for others featuring information relating to cabinets for liquid and gas fuel dispensers, and for the purpose of providing a repository of technical information and manuals for customers, not used for underwater and offshore oil rigs;”
- PHARMOPTIMA, No. 5,358,005, for use with “pharmaceutical research and development;” and

- PHARMOPTIMA and design, Reg. No. 5,342,732, for use with “pharmaceutical research and development;”

Applicant respectfully disagrees with the Examining Attorney’s refusal. As an initial matter, the registration for IOPTIMA was cancelled on May 11, 2018 and therefore cannot be a basis for refusal.

Applicant asserts that when its mark and the remaining cited registrations are considered in light of the *Du Pont* factors, confusion is unlikely between Applicant’s mark and the cited registrations because (1) Applicant’s services are different from the Registrants’ goods and services, and the respective marks travel in different channels of trade; (2) the goods and services are expensive and the relevant purchasers are sophisticated buyers; (3) the commercial impression of the marks are different; and (4) Applicant’s OPTIMA mark can coexist on the Trademark Register just as the cited registrations have also coexisted.

**I. There Is No Likelihood of Confusion between the OPTIMA Mark and the Cited Registrations**

With respect to the remaining registrations, a multi-factor test is used to assess whether a likelihood of confusion exists between marks. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 U.S.P.Q. 563, 567 (C.C.P.A. 1973) (determining likelihood of confusion by thirteen factors, including: similarity of the marks, similarity and nature of the goods or services, similarity of trade channels, whether relevant purchasers are impulsive or sophisticated, the number and nature of similar marks on similar goods and services, and any other probative facts). Some of the factors may not be relevant in a particular case. *In re Majestic Distilling Co.*, 315 F.3d 1311, 1315, 65 U.S.P.Q.2d 1201, 1204 (Fed. Cir. 2003). Additionally, a single *DuPont* factor should not outweigh all the rest. *Kellogg Co. v. Pack ‘Em Enters. Inc.*, 951 F.2d 330, 333, 21 U.S.P.Q.2d 1142, 1145 (Fed. Cir. 1991).

**A. Confusion with OPTIMA SOLUTIONS (Reg. No. 2,783,055) Is Unlikely**

The OPTIMA SOLUTIONS registration’s services are limited to “chemical management,” which the registration further elaborates as “monitoring, using and evaluating chemicals for manufacturing operations of others.” The registrant’s latest specimen of use, from 2013, shows the “chemical management” services applied in the context of automobile manufacturing, particularly painting. *See* specimen of use for U.S. Reg. No. 2,783,055 (submitted March 11, 2013), **Exhibit A**. This registration’s services differ from Applicant’s services, which are limited for use in connection with machines for producing medical or pharmaceutical goods or for packaging goods. The services in these registrations are neither identical nor interchangeable with Applicant’s services, and the fact that both Applicant’s and registrant’s services may have some common nexus with either machine processes or manufacturing assembly lines does not make them related per se—particularly in the context of both Applicant’s and the registrant’s other limitations in their respective identifications of services. *See M2 Software, Inc. v. M2 Commc’ns, Inc.*, 450 F.3d 1378, 1383, 78 USPQ2d 1944, 1947–48 (Fed. Cir. 2006) (noting that relatedness between software-related goods may not be presumed merely because the goods are delivered in the same media format and that, instead, a subject-matter-based mode of analysis is appropriate; finding that the marks were used in different channels of trade and with respect to different purchasers); *see also, e.g., MTD Products, Inc. v. Universal Tire Corp.*, 193 U.S.P.Q. 56, 59-60 (TTAB 1976) (confusion unlikely between COLUMBIA for automobile tires and COLUMBIA for wheeled products bearing rubber tires including bicycles, tricycles, road-hauling tractors, motorized all-terrain vehicles, motorcycles, agricultural tractors, motorized snow throwers, motorized riding mowers, and motorized walking mowers, and motorized walking motors). Therefore confusion is unlikely.

Further, the marks are dissimilar. Under the likelihood of confusion analysis, the Examining Attorney must examine the marks in their entirety. *Colgate-Palmolive Co. v. Carter-Wallace, Inc.*, 432 F.2d 1400 (CCPA 1970). When viewed in their entirety, the marks are not similar. The registrant's mark contains the "SOLUTIONS" suffix. The addition of the term "SOLUTIONS" suggests to consumers that the registrant provides services related to liquid chemicals (*i.e.* "solutions"). See *Ty, Inc. v. The Jones Group, Inc.*, 237 F.3d 891, 898 (7th Cir. 2001) ("if one word or feature of a composite mark is the salient mark, it may be given greater weight than the surrounding elements."). Here, the SOLUTIONS portion of the mark is absent in Applicant's mark and thus confusion is unlikely. *Industrial Adhesive Co. v. Borden, Inc.*, 218 U.S.P.Q. 945 (TTAB 1983) (WONDER BOND PLUS not likely to be confused with BOND-PLUS for adhesive and glue-products). Given the differences in the services and the differences in the marks, confusion is unlikely.

**B. Confusion with ENEA OPTIMA (Reg. No. 3,550,490) Is Unlikely**

Confusion with the ENEA OPTIMA registration is unlikely for several reasons. First, the services are dissimilar. Here, the registrant provides computer and telecommunications related services. The registrant does not provide services in the pharmaceutical packaging and manufacturing field. Applicant asserts that its services are differentiable from the services in the cited registration because they are largely limited to services in relation to machines, equipment, and components for the purposes of (a) packaging, metering, filling, sealing, labelling, freeze-drying, sterilizing, and decontaminating, and (b) producing medical, medico-technical, pharmaceutical and diagnostic products. Applicant's services and the cited registration's services are distinguishable because the respective identifications clearly indicate that the parties' goods and services are applied in different contexts and for different purposes.



These services are also contained to a specific channel of trade: Applicant and its subsidiaries “design and build packaging equipment for pharmaceutical, consumer, nonwovens [i.e., diapers, cotton swabs, tissues, etc.] and life science products – from single standard machines to complete complex turnkey systems.” Homepage, Optima (accessed Aug. 15, 2018), <https://www.optima-packaging.com/en-us>, **Exhibit B**. These machines are used to fill and package pharmaceutical products; package other consumer retail products like food, chemicals, cosmetics, diapers, and more; or otherwise prepare materials for packaging and shipment through processes like freeze-drying, sterilizing, weighing, and labeling. *See generally id.* Applicant’s mark is not used on the goods that are packaged or produced by these machines. *See, e.g.,* Machine Solutions: Packaging Machines, Optima (accessed Aug. 15, 2018) <https://www.optima-packaging.com/en-us/machine-solutions/packaging-machines> (explaining the industries in which Applicant’s machine are used and showing various machine models tailored for those purposes), **Exhibit C**. Therefore, Applicant’s mark is confined to a specific channel of trade: the manufacturers, packagers, and shippers who purchase machines such as those produced and serviced by Applicant.

Further, the marks are dissimilar. *See, e.g., Colgate-Palmolive Co.*, 432 F.2d 1400. When viewed in their entirety, the marks are not similar. The registrant’s mark contains the “ENE” prefix. This prefix is the dominant portion of the registrant’s mark as it is the first term encountered by consumers. *See Ty, Inc.*, 237 F.3d at 898 (“if one word or feature of a composite mark is the salient mark, it may be given greater weight than the surrounding elements.”). Here, the ENE portion of the mark is absent in Applicant’s mark and thus confusion is unlikely. *Industrial Adhesive Co.*, 218 U.S.P.Q. 945 (WONDER BOND PLUS not likely to be confused with BOND-PLUS for adhesive and glue-products).

Finally, the sophistication of Applicant's purchasers and the price of Applicant's services obviates confusion. Where services are expensive and consumers carefully consider a purchase, confusion is not likely. *See Magnaflux Corp. v. Sonoflux Corp.*, 109 U.S.P.Q. 313 (CCPA 1956) ("confusion is less likely where goods are expensive and are purchased after careful consideration than where they are inexpensive and are purchased casually"). Applicant's services are expensive installation, repair and training services for niche pharmaceutical and diagnostic equipment and are purchased after careful consideration. Similarly, registrant's services telecommunications services are not purchased by the casual consumer. Purchasers carefully consider the purchase prior to buying these types of services. Thus confusion is unlikely.

**C. Confusion with OPTIMA & Design (Reg. No. 4,263,096) Is Unlikely**

Confusion with the OPTIMA & Design registration is unlikely for several reasons. First, the services are dissimilar. Here, the registrant provides computer related services. The registrant does not provide services in Applicant's pharmaceutical packaging and manufacturing field. Applicant asserts that its services are differentiable from the services in the cited registration because they are largely limited to services in relation to machines, equipment, and components for the purposes of (a) packaging, metering, filling, sealing, labelling, freeze-drying, sterilizing, and decontaminating, and (b) producing medical, medico-technical, pharmaceutical and diagnostic products. Applicant's services and the cited registration's services are distinguishable because the respective identifications clearly indicate that the parties' services are applied in different contexts and for different purposes.

Further, the marks are dissimilar. Under the likelihood of confusion analysis, the Examining Attorney must examine the marks in their entirety. *Colgate-Palmolive Co.*, 432 F.2d

1400. When viewed in their entirety, the marks are not similar. The registrant's mark contains a circular design element which is not present in Applicant's mark. *See Ty, Inc.*, 237 F.3d at 898 (“if one word or feature of a composite mark is the salient mark, it may be given greater weight than the surrounding elements.”).

Finally, the sophistication of Applicant's purchasers and the price of Applicant's services obviates confusion. Where services are expensive and consumers carefully consider a purchase, confusion is not likely. *See Magnaflux Corp.*, 109 U.S.P.Q. 313 (“confusion is less likely where goods are expensive and are purchased after careful consideration than where they are inexpensive and are purchased casually”). Applicant's services are expensive installation, repair and training services for niche pharmaceutical equipment and are purchased after careful consideration. Similarly, registrant's telecommunications services are not purchased by the casual consumer. The relevant purchasers of Applicant's services and the registrant's services are clearly capable of distinguishing between the respective marks. *See Raytheon Co. v. Litton Business Systems, Inc.* 169 U.S.P.Q. 438 (TTAB 1971) (highly experienced and informed business personnel not likely to confuse ROYTRON data processing tape punches and RAYTHEON data processing equipment). *See also, Electronic Design & Sales, Inc. v. Electronic Data Systems, Corp.*, 954 F.2d 713, 717, 21 U.S.P.Q.2d 1388, 1391 (Fed. Cir. 1992) (reversing the Board's finding of likelihood of confusion between opposer's registered mark EDS for computer programming services and Applicant's mark E.D.S. for power supplies and battery chargers); *Triumph Machines Company v. Kentmaster Manufacturing Company, Inc.*, 1 U.S.P.Q.2d 1826, 1829 (TTAB 1987) (finding no likelihood of confusion between HYDRO-CLIPPER for power operated cattle de-horning shears and HYDRO-CLIPPER (and design) for

power mower attachments). Purchasers carefully consider the purchase prior to buying these types of services. Thus confusion is unlikely.

**D. Confusion with OPTIMA THE RIG COOLING SPECIALISTS (Reg. No. 4,995,626) and OPTIMA THE RIG COOLING SPECIALISTS & Design (Reg. No. 4,995,627) Is Unlikely**

Here, the registrant's goods and services are focused in the oil and gas industry or for use with water distribution, and thus do not present a likelihood of confusion with Applicant's services. Even these registrations' unlimited descriptions of "engineering design and consultancy," "engineering research," "engineering surveying," and "preparation and provision of engineering drawings and reports," are distinguishable from and do not encompass Applicant's services, such as technical support and maintenance for its machines.

As discussed above, the goods and services in these registrations are neither identical nor interchangeable with Applicant's services, and the mere fact that both Applicant's and Registrants' services may have some common nexus with either machine processes or manufacturing assembly lines does not make them related per se—particularly in the context of both Applicant's and these registrants' other limitations in their respective identifications of services. *See M2 Software, Inc.*, 450 F.3d at 1383, 78 USPQ2d at 1947–48 (Fed. Cir. 2006) (noting that relatedness between software-related goods may not be presumed merely because the goods are delivered in the same media format and that, instead, a subject-matter-based mode of analysis is appropriate; finding that the marks were used in different channels of trade and with respect to different purchasers); *see also, e.g., MTD Products, Inc.*, 193 U.S.P.Q. at 59-60 (confusion unlikely between COLUMBIA for automobile tires and COLUMBIA for wheeled products bearing rubber tires including bicycles, tricycles, road-hauling tractors, motorized all-

terrain vehicles, motorcycles, agricultural tractors, motorized snow throwers, motorized riding mowers, and motorized walking mowers, and motorized walking motors).

Further, the commercial impression of the marks are different. The addition of the terms “RIG COOLING SPECIALISTS” and the design element in the second cited registration lessen any likelihood of confusion. *See Ty, Inc.*, 237 F.3d at 898 (“if one word or feature of a composite mark is the salient mark, it may be given greater weight than the surrounding elements.”). Here, the “RIG COOLING SPECIALISTS” portion of the mark changes the commercial impression of the mark and provides consumers with additional information regarding the goods and services, thus lessening any potential confusion. *Industrial Adhesive Co.*, 218 U.S.P.Q. 945 (WONDER BOND PLUS not likely to be confused with BOND-PLUS for adhesive and glue-products).

Finally, the sophistication of the purchasers and the price of the goods and services obviates confusion. Where services are expensive and consumers carefully consider a purchase, confusion is not likely. *See Magnaflux Corp.*, 109 U.S.P.Q. 313 (“confusion is less likely where goods are expensive and are purchased after careful consideration than where they are inexpensive and are purchased casually”). As discussed above, Applicant’s services are expensive installation, repair and training services for niche pharmaceutical equipment and are purchased after careful consideration. Similarly, registrant’s oil and gas focused goods and services are not purchased by the casual consumer. The relevant purchasers of Applicant’s services and the registrant’s services are capable of distinguishing between the respective marks. *See Raytheon Co.*, 169 U.S.P.Q. 438 (highly experienced and informed business personnel not likely to confuse ROYTRON data processing tape punches and RAYTHEON data processing equipment). *See also, Electronic Design & Sales, Inc.*, 954 F.2d at 717, 21 U.S.P.Q.2d at 1391

(reversing the Board’s finding of likelihood of confusion between opposer’s registered mark EDS for computer programming services and Applicant’s mark E.D.S. for power supplies and battery chargers).

Indeed, the TTAB and Federal Circuit have consistently held that when the relevant consumers are specialized professionals, such as the manufacturers and packagers that purchase Applicant’s machines and then seek Applicant’s services, these consumers are less likely to be confused even in the face of similarities between the marks. *See Dynamics Research Corp. v. Langenau Mfg. Co.*, 704 F.2d 1575, 1576, 217 U.S.P.Q. 649, 650 (Fed. Cir. 1983) (finding no likelihood of confusion where the goods are sold to different, discriminating customers, namely that large corporate purchasing agents are not likely to confuse DRC sheet metal fabric and DRC encorders and back gauges for press brakes). Purchasers carefully consider the purchase prior to buying these types of services. Thus confusion is unlikely.

**E. Confusion with OPTIMA (Reg. No. 4,110,008) Is Unlikely**

Here, confusion is unlikely because the services are provided in distinct fields. The OPTIMA registration’s services are limited to “the field of bearings, seals, bearing housings, and bearing accessories.” Applicant’s services, while they are for use with machines that may contain bearings, are not directed toward bearings as a distinct good. Further, the “seals” mentioned in this registration’s services are likely seals specifically for bearings. *See, e.g.*, EP Editorial Staff, “Selecting the Correct Bearing Seal,” *Efficient Plant Magazine* (February 25, 2014), available at <https://www.efficientplantmag.com/2014/02/selecting-the-correct-bearing-seal/> (“[T]he primary functions of a bearing seal are to keep lubricant in the bearing and bearing chamber contaminants out.”), **Exhibit D**. Applicant’s “sealing” services are in the context of sealing packages or containers, as can be inferred from the other actions listed in the identification: “packaging,

metering, filling, sealing, labelling, freeze-drying, sterilizing, and decontaminating.” *See also* Machine Solutions: Packaging Machines, Optima (accessed Aug. 15, 2018) <https://www.optima-packaging.com/en-us/machine-solutions/packaging-machines> (“The range of packaging equipment and machines from Optima includes automation for cartoning, bagging, sealing, wrapping, weighing and vacuum processes.”), **Exhibit C. Astra Pharm. Prod., Inc. v. Beckman Instruments, Inc.**, 718 F.2d 1201, 220 U.S.P.Q. 786, 790 (1st Cir. 1983) (in analyzing likelihood of confusion of two ASTRA marks used with, respectively, an anesthetic drug and a blood analyzer machine, “there is always less likelihood of confusion were goods are expensive and purchased after careful consideration”).

In addition, these types of services are purchased by sophisticated purchasers. As discussed above, when the relevant consumers are specialized professionals, such as the manufacturers and packagers that purchase Applicant’s and registrant’s services, these consumers are less likely to be confused even in the face of similarities between the marks. *See Dynamics Research Corp.*, 704 F.2d at 1576, 217 U.S.P.Q. at 650 (finding no likelihood of confusion where the goods are sold to different, discriminating customers, namely that large corporate purchasing agents are not likely to confuse DRC sheet metal fabric and DRC encoders and back gauges for press brakes). Because the types of services are distinct, and because the purchasers are sophisticated, confusion is unlikely.

#### **F. Confusion with OPTIMA (Reg. No. 5,263,225) Is Unlikely**

Here, confusion is unlikely due to the differences in goods and services. This registration’s services used in connection with “cabinets for liquid and gas fuel dispensers,” that is, the housing for fuel pumps at gas stations. *See, e.g.*, CNG KRAUS OPTIMA™ SERIES, Kraus Global (accessed Aug. 15, 2018) <http://krausglobal.com/products/cng/dispensers/optima/introduction/>,

**Exhibit E.** Such cabinets, and gas station structures more generally, are not similar to or related to the machines that are the subject of Applicant’s services, nor are those machines used to create such cabinets. As registrant acknowledged in during the prosecution of the registration, registrant’s goods and services are related to fuel pumps for the alternative fuels industry. *See* Response to Office Action, U.S. Trademark Reg. No. 5,263,225 (submitted Dec. 18, 2015), **Exhibit F.** They do not relate to Applicant’s services. Therefore, consumers are unlikely to assume that Applicant is also the source behind this registrant’s cabinets and related services.

Further, given that the purchasers of both Applicant’s and registrant’s goods and service are sophisticated companies, confusion is also unlikely. Registrant acknowledged in the prosecution of its application that its services are expensive and purchased after careful consideration. *See id.* Similarly, Applicant’s customers purchase the machines because of their high volume capability and their efficiency and reliability. The machines can cost thousands of dollars, and the services Applicant provides in relation to these machines are likewise not nominal purchases. Applicant’s machines and their attendant services are not purchased by individuals on a whim; rather, they are purchased pursuant to a business’s need for commercial-level manufacturing and packaging processes. *See, e.g., Magnaflux Corp.*, 231 F.2d 669, 109 U.S.P.Q. 313 (“confusion is less likely where goods are expensive and purchased after careful consideration than were they are purchased casually”).

**G. Confusion with PHARMOPTIMA (Reg. No. 5,358,005), and PHARMOPTIMA & Design (Reg. No. 5,342,732) Is Unlikely**

There is no likelihood of confusion between Applicant’s mark and the cited PHARMOPTIMA marks for several reasons. First, the marks differ in overall sound, appearance, and commercial impression. Under the likelihood of confusion analysis, the Examining Attorney must examine the marks in their entirety. *Colgate-Palmolive Co.*, 432 F.2d



1400. When viewed in their entirety, the marks are not similar. Both of registrant's marks contains the "PHARMA" prefix and the design mark contains a distinctive "eye" element. The PHARMA prefix is the dominant portion of the registrant's mark as it is the first term encountered by consumers. *See Ty, Inc.*, 237 F.3d at 898 ("if one word or feature of a composite mark is the salient mark, it may be given greater weight than the surrounding elements."). Here, the PHARMA portion of the mark is the key portion of the mark viewed by consumers and thus confusion is unlikely. *Industrial Adhesive Co.*, 218 U.S.P.Q. 945 (WONDER BOND PLUS not likely to be confused with BOND-PLUS for adhesive and glue-products).

Second, these cited marks travel in channels of trade different from Applicant's mark because the respective services are in different levels of a supply chain: Applicant's services are at work in the manufacturing, packaging, and wholesale shipment stage, but these registrations' services are limited to the research and development stage at the beginning of a product's life.

Customers for pharmaceutical research and development are likely scientists, researchers, and the drug companies who make the high-level decisions to sell and market the pharmaceuticals; customers for analysis of market information can be the drug companies wishing to improve their sales, salespersons, or marketing firms. In contrast, Applicant's services are used by on-the-ground manufacturers and packagers operating the machines that physically create or package a product. These customers are concerned with the process and efficiency of packaging or manufacturing a good, not necessarily its development or its eventual sales numbers. The marks thus travel in different channels of trade and are seen by different types of customers with different purposes in mind, making confusion unlikely. *See In Re Shipp*, 4 U.S.P.Q.2d 1174, 1176 (TTAB 1987) (no confusion between PURITAN for laundry and dry-cleaning services, PURITAN for commercial dry cleaning machine filters, or PURITAN for

cleaning preparations, because the goods and services were not likely to come to the attention of the same kinds of purchasers).

To the extent that Applicant's customers and these registrants' customers may be the same business establishment (e.g., a pharmaceutical company overseeing all stages of a product's life, from research to manufacturing to sales), the differences between the respective services and the channels of trade in which the services are obtained would obviate any possibility of confusion, and the consumer would not assume that the respective services originate from the same source. *See Shen Mfg. Co., Inc. v. Ritz Hotel, Ltd.*, 393 F.3d 1238 (Fed. Cir. 2004) (stating that if the goods 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).

## **II. Because Multiple Marks Using the Term "OPTIMA" Already Coexist on the Register, Applicant's Mark Can Likewise Coexist**

Confusion between Applicant's mark and the cited registrations is unlikely because Applicant's OPTIMA mark would be able coexist with the other marks using "OPTIMA" just as several of the cited registrations already coexist. The sixth *DuPont* factor concerns "[t]he number and nature of similar marks in use on similar goods." *In re Application of E. I. DuPont de Nemours & Co.*, 476 F.2d at 1361. Notably, the cited registrations have been allowed to coexist, in some cases despite covering goods and/or services more closely related to each other than they are to Applicant's services. This is persuasive evidence that the Register reflects the reality of the marketplace, where consumers have learned how to differentiate similar marks. *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 1373, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005) (finding that evidence of third parties using a similar mark on

similar goods and services can demonstrate that consumers exposed to such a “plethora” of similar marks have learned how to distinguish the marks based on small details).

The OPTIMA & Design registration (Reg. No. 4,263,096) has coexisted with the prior ENEA OPTIMA registration (Reg. No. 3,550,490), despite the fact that both registrations cover use with essentially identical services (namely, design and development of computer software and computer operating systems), and that the later registration for OPTIMA & Design contains a literal element already wholly contained in ENEA OPTIMA. Applicant’s mark OPTIMA, also covering development of computer software, hardware, and systems, can and should likewise coexist.

In addition, the PHARMOPTIMA registrations (Reg. Nos. 5,358,005 and 5,342,732) covering pharmaceutical research and development were allowed to coexist with the prior IOPTIMA registration (Reg. No. 3,308,123) covering services related to marketing and sales of pharmaceuticals, despite the fact that the marks could be encountered by the same customers (drug companies concerned with development and sales of pharmaceuticals). Applicant’s services related to machines that produces or packages pharmaceutical products can likewise coexist with these marks, since Applicant’s mark itself covers yet another, different level of the pharmaceuticals supply chain, which is currently unoccupied by the cited registrations.

More broadly, the other cited registrations coexist on the Register because they cover different goods in different channels of trade, such that consumers are unlikely to assume that the disparate goods and services come from the same source. As evidenced by these many coexisting uses of “OPTIMA” by many different uses across a wide spectrum of goods and services, the term is not so strong or distinguishable that consumers will assume the term is associated with only one source. As explained above, Applicant’s goods and services are sufficiently

distinguishable from these cited registrations, and sophisticated consumers of the respective goods and services, with money and specific needs on the line, know how to differentiate between marks.

The coexistence on the Register of the various registrants' OPTIMA marks, despite some covering similar or related services, is persuasive evidence that Applicant's mark would likewise be able to coexist with Registrants' marks. This widespread use and registration of marks that incorporate OPTIMA by multiple parties show that consumers have had ample opportunity to learn how to distinguish similar marks based on context—such as differentiable services or entirely different channels of trade—to determine the source of the services. Therefore, Applicant's OPTIMA mark can and should coexist on the Register alongside the cited registrations.

## CONCLUSION

In view of the foregoing, Applicant's OPTIMA mark is distinguishable from the cited registrations. Therefore, confusion is unlikely. Applicant respectfully requests that the refusal to register under Section 2(d) of the Lanham Act be withdrawn and the amended identification of services be accepted. In view of the above arguments, Applicant believes that its application is in condition for allowance, and requests that the application be approved for publication.

Respectfully Submitted,

Dated: August 17, 2018

/Nicole M. Murray/

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United States Attorney for Applicant  
Quarles & Brady LLP  
300 North LaSalle Street Suite 4000  
Chicago, Illinois 60654  
(312) 715-5277

QB\145047.00027\53660734.2

# **EXHIBIT A**

Chemical Management - Services - Automotive OEM Coatings - Windows Internet Explorer


http://www.ppg.com/coatings/autooem/services/Pages/01\_Ch... lasalle steel

File Edit View Favorites Tools Help

★ Favorites ★ Customs and Border Protect... XE - The World's Favorite C... United States Patent and Tr...

United St... Chem... Home Feeds (3) Read Mail Print Page Safety Tools Help

**PPG** PPG Automotive Coatings  
OEM Products



**Products** ▶ [Automotive OEM Coatings - Services - Chemical Management](#)

**Services** ▶ **Chemical Management**

Chemical Management  
Process Management  
Industrial Services  
Custom Services  
Application Development

**Color** ▶

**News and Events** ▶

**About PPG Automotive Coatings** ▶

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PPG's Optima Solutions® Chemical Management program uses a "systems" approach through services of a single, first tier, on-site manager that focuses on:

- Cost Reduction
- Safety
- Material Management
- Tier II Management
- Environmental Reporting Requirements
- Problem Resolution
- Continuous Improvement
- Project Management

PPG's Optima Solutions® Chemical Management program lays a solid foundation for effective management of Tier II suppliers, inventories, projects, new product evaluations and improved process techniques for our customers.

Customers benefit from having a single point of contact for all chemical needs within their facility, while allowing them to concentrate on their core business.

Internet 90%

Registrant: PPG INDUSTRIES OHIO, INC.  
Reg. No: 2783055  
Reg. Date: November 11, 2003

8 & 9 – Page 2

The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. §1001, and that such willful false statements and the like may jeopardize the validity of this document, declares that he/she is properly authorized to executed this document on behalf of the Owner; and all statements made of his/her own knowledge are true and all statements made on information and belief are believed to be true.

### Section 9: Application for Renewal

The registrant requests that the registration be renewed for the goods and/or services identified above.

### POWER OF ATTORNEY

Registrant hereby revokes any and all previous Powers of Attorney and appoints jointly and severally, with full power of substitution, the power of appointment of an associate attorney and the power of revocation:

ALLAN S. PILSON  
DANIEL F. ZENDEL  
LANNING G. BRYER  
DENNIS S. PRAHL  
SCOTT LEBSON

BHARATI BAKSHANI  
RALPH CATHCART  
MICHAEL A. CORNMAN  
JAY A. BONDELL

### LADAS & PARRY LLP

1040 Avenue of the Americas, New York, New York 10018, U.S.A.

to maintain this registration and to transact all business in the Patent and Trademark Office in connection therewith, and to receive all Certificates.



Signature

Rita Bergstrom

Name (Print)

Assistant Secretary

Title

03-07-2013

Date



# **EXHIBIT B**



### Newsroom & Press

Here you will find current news, case studies as well as press releases and videos from Optima.

[More Information](#)

## OPTIMA at a glance

Technologies that Inspire: From Packaging Machines to Software Solutions



#### > pharma

Machine solutions for filling and packaging of pharmaceutical products.

- > Sterile Filling
- > Isolator / RABS
- > Freeze drying / Lyophilization
- > Diagnostics
- > Nonsterile filling



#### > consumer

More efficiency and more effective processes with powerful packaging machines.

- > Food
- > Chemicals
- > Cosmetics
- > Single Serve
- > Filtration
- > Packaging solutions



#### > nonwovens

World leader in performance and highspeed packaging machines for hygienic paper products.

- > Home Care
- > Infant Care
- > Personal Care
- > End of line automation



#### > life science

Customized solutions for the diagnostic, medical and pharmaceutical industry.

- > Wound dressings
- > Transdermal patches
- > ELISA Test Kits
- > OP gloves
- > Line Management System

OPTIMA at a glance

## Shows

OPTIMA is present for you - worldwide

Year:   
 all  Pharma  Nonwovens  Consumer  Life Science

Trade Show / Event

Date

Country / City



Tissue World Istanbul 2018

Amotek Nonwovens

Istanbul,

9/4/18 - 9/6/18

Add to Calendar



Turkey  
Istanbul

[Website](#)

	Istanbul Congress Center (ICC), Booth C117	<a href="#">Make an Appointment</a>	
	<b>Maghreb Pharma 2018</b> Pharma Algiers	9/17/18 - 9/19/18 <a href="#">Add to Calendar</a> <a href="#">Make an Appointment</a>	 Algeria Algiers <a href="#">Website</a>
	<b>FachPack 2018</b> Pharma Nonwovens Consumer Nürnberg, Messezentrum Nürnberg, Booth 2/2-213	9/25/18 - 9/27/18 <a href="#">Add to Calendar</a> <a href="#">Make an Appointment</a>	 Germany Nürnberg <a href="#">Website</a>
	<b>A3P Single Use 2018</b> Pharma Lyon	10/1/18 - 10/2/18 <a href="#">Add to Calendar</a> <a href="#">Make an Appointment</a>	 France Lyon <a href="#">Website</a>
	<b>PDA Prefilled Syringes 2018</b> Pharma Orlando	10/8/18 - 10/10/18 <a href="#">Add to Calendar</a> <a href="#">Make an Appointment</a>	 United States Orlando <a href="#">Website</a>

[Add all dates to calendar.](#)

[Overview of all trade shows & events](#)



## Digitalization at OPTIMA: Industry 4.0

The pilot system made by Optima in cooperation with Festo and Siemens can produce an individualized perfume flacon in batch size 1 at the push of a button.

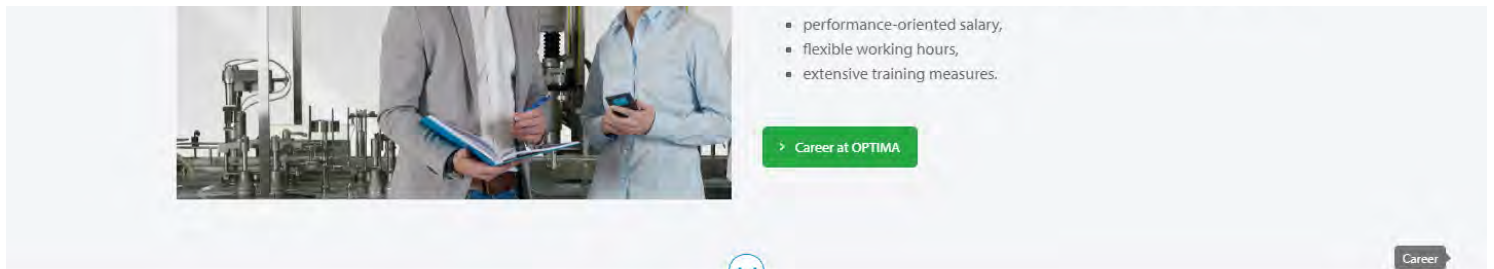


## Vacancies

Secure future with perspective

At Optima, one of the largest employers in Schwaebisch Hall, you benefit from:





- performance-oriented salary,
- flexible working hours,
- extensive training measures.

> Career at OPTIMA

Career

## OPTIMA

Manufacturer and technology leader

### Industry and customer specific

OPTIMA packaging group GmbH with headquarters in Schwaebisch Hall, Germany, teams with its subsidiaries to design and build packaging equipment for [pharmaceutical](#), [consumer](#), [nonwovens](#) and [life science](#) products – from single standard machines to complete complex turnkey systems. Whether custom solutions or modular machines, functions are systematically tailored to the specific needs of the customers and their industries. Optima packaging technologies are considered leading-edge in many fields worldwide, including filling and packaging of coffee capsules, freeze drying for sterile pharmaceutical liquids and packaging of paper hygiene products. The company's broad expertise also extends into production lines for manufacturing and packaging advanced wound care products.

### Global responsibility

Customers appreciate the personal, cooperative and flexible working relationship with Optima's [subsidiaries](#). Optima as a parent company in turn provides the infrastructure and resources needed in the globalized economy. The company is committed to environmental and social sustainability through positive action. Optima provides various levels of support to a wide range of social and societal projects.

### Employees as central success factor

Optima is considered to be a "hidden champion", a status due in no small part to its highly qualified workforce. All employees have access to an extensive continuing education program to continuously hone their skills and develop professionally. Training the next generation of employees has been a long-standing tradition at the company. More than 170 young people are employed as apprentices at Optima every year.

### Machines in use worldwide

Founded in 1922, the family owned and operated business is in its third generation and employs a workforce of 2,250 at its [sites in Germany and 14 locations abroad](#). In addition to its base in Germany, the company maintains branch offices in Italy, France, the UK, the USA, Brazil, Mexico, Japan, South Korea, China, India and Malaysia. An export share of more than 85% is indicative of the company's international standing.

OPTIMA

#### About Optima

Optima designs and realizes packaging solutions from single machines to complex turnkey systems for pharma, consumer, nonwovens and life science products.

#### Divisions

- > Pharma
- > Consumer
- > Nonwovens
- > Life Science
- > Total Care

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✉ info-usa@optima-packaging.com

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# **EXHIBIT C**

# Packaging machines from OPTIMA

Specialists for your production. Efficient. One-of-a-kind. Brilliant.

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[The digitalization of packaging machines](#)
[Home](#) / [Machine Solutions](#) / [Packaging Machines](#)

## Powerful, compact and automatic packaging machines

The perfect packaging machine! It increases efficiency, raises productivity and reduces costs

Packaging is an economic factor for the sales, durability and handling of a product. When a product becomes more sophisticated, packaging requirements increase in complexity. The involvement of automated packaging increases these challenges even further. For manufacturers, getting the right packaging equipment is often a problem.

[Technologies](#)

### OPTIMA – an international manufacturer of packaging machines

A leading manufacturer of high-performance solutions, equipment and packaging machinery for industry. OPTIMA packaging group GmbH (Schwäbisch Hall, Germany) engineers and implements packaging equipment. These are custom, turnkey solutions for customers, manufacturers and companies in the pharmaceutical, life science, consumer (food, cosmetics, chemical) and nonwoven (paper hygiene) sectors. Our 90 years of experience allow us to tailor our customer's packaging machines and packaging equipment to their exact needs. Optima's packaging equipment and systems can be seen around the globe. The engineering innovations in Optima's machinery drive the packaging industry and are well known in the trade show circuits.



### Companies trust Optima for packaging process expertise in the following areas:

- **Consumer:** The packing and processing of powdered, granulated, pasty and liquid substances and other products. Packaging machinery for the entire consumer product lifecycle, including piston filler machines, carton sealers and label applicators.
- **Pharmaceutical:** Flexible packaging and filling solutions and machines for the pharma industry. Sterile and non-sterile liquids and powdered products are no challenge for Optima's high speed packaging machinery.
- **Nonwoven:** Packaging equipment, wrapping machines and end-of-line automation for paper hygiene products. The packaging of diapers or sanitary napkins in film bags with the help of reliable bagging machines and systems.
- **Life Science:** Machines, equipment and vacuum packaging machines for the production and processing of horizontal and vertical forms, medical and pharmaceutical products. Optima's innovations include systems for coating immunoassays (ELISA kits) and modular machinery.

[Technologies](#)





### The right solution for every product

Our product portfolio includes specialized, semi-automatic, automatic and continuous packaging equipment, packaging machines, packaging solutions and vertical packaging machines. These solutions are for filling, packaging and production. In addition, we manufacture complete packaging lines and turn-key equipment.

In the field of secondary packaging, our extensive machine program wraps everything up. Compact and automatic Packaging equipment, cartoners and batch making machines complete Optima's high quality portfolio. Vertical forms, Challenging labeling and complex pack requirements are just some of the challenges Optima can solve. Due to a high degree of specialization, Optima's packaging machinery is configurable to customer requirements. Machines and packaging equipment from Optima always impress with quality, innovation and modular capabilities.

The range of packaging equipment and machines from Optima includes automation for cartoning, bagging, sealing, wrapping, weighing and vacuum processes. Virtually all packaging types can take advantage of Optima's precise and fast packaging equipment and packaging machines. Products can be processed with horizontal or vertical packaging machines. Product packaging is able to be processed across the range of packing types, from cartons to trays to other product types. Additionally, Optima's continuous innovations and know-how are well known in most verticals and in the trade show and packaging industry circuits.

High-performance packaging solutions from Optima take care of your entire production and packaging process. From dosing needs, to labelling and sealing. Your manufacturing process is in good hands.

With Optima's knowledge, your packaging machine and equipment requirements are solved. Automate your packaging with Optima and lower labor costs and other production area expenses.



Technologies



Operating worldwide



Customized



Made in Germany



High-tech machines



## A range of packaging machines from OPTIMA

Expertise on many levels and applications combined – a unique offer on the market



### > OPTIMA pharma GmbH

Innovative packing machine, tray former and equipment product range for the pharma industry. Pharmaceutical filling systems, packaging machinery, isolators/RABS, freeze-dry equipment and seal machines. For pharmaceutical materials and diagnostic agents. Package and fill bottles, carpules, syringes and vials with ease.

#### Fields of application

- > Aseptic / Sterile filling
- > Isolator / RABS
- > Freeze-drying systems / Lyophilization Technology
- > Diagnostics
- > Non-sterile filling



### > OPTIMA consumer GmbH

Increase efficiency and reduce labor costs with packaging systems and equipment for consumer applications. Dose, weigh and fill products in a quick, straightforward, flexible process with an Optima packaging machine. Labelling is also taken care of with label applicators giving you a complete solution with high flexibility. No matter your packing material, from cartons to glass, to pouch and metal forms, to capsules and cans, Optima has your solution.

#### Fields of application

- > Food (sweets, drinks, food)
- > Cosmetics
- > Chemicals
- > Portion packages

Portfolio

- > Filtration
- > Packaging Types



#### > OPTIMA nonwovens GmbH

A producer of production equipment and special machinery for packing. Creating customized solutions, equipment and packaging machinery for the diagnostic, medical and pharmaceutical industries. Flexible packaging solutions made possible with Optima's extensive project experience. Optima solves your entire packing life cycle, from intake of products to pallets ready to be shipped.

#### Fields of application

- > Home Care
- > Infant Care
- > Personal Care
- > End of Line Automation



#### > OPTIMA life science GmbH

Offers a wide range of innovative high speed and modular production systems, sealers and packaging equipment combined with extensive project experience and expertise. Solutions for the automation of weighing, sealing and labeling. Flexibility, speed and efficiency define OPTIMA life science GmbH.

#### Fields of application

- > Wound dressings
- > Transdermal therapeutic systems
- > ELISA Kits
- > Surgical gloves
- > Line management system OPAL

Portfolio

"There may be mechanical engineering companies that are significantly larger, but there are very few that offer a comparable diversity of technologies."

Hans Bühler, CEO



## OPTIMA Total Care

Our system for your safety



OPTIMA Total Care

Be supported throughout all stages of your work with the **OPTIMA Total Care** portfolio. Flexible, comprehensive and adaptable to your needs. Combined with a worldwide service network for the wide range of Optima's packaging equipment and machinery, your needs are adapted to with the uttermost care. An individual consultant will support you through the life cycle of your turnkey system. Through planning, commissioning, production and beyond. Your needs, goals, and success is our focus.

With OPTIMA Total Care, you can be sure that your packaging machines, seal machines and equipment are implemented, serviced and cared for by the leading experts. From the start of your packaging project, through scaling of your equipment and your processes throughout your manufacturing lifecycle. With the OPTIMA Total Care program, you are also covered for any new Optima innovations in the packaging machinery field. Not only are your packaging operations set up quickly and smoothly, but they will continue to impress time and time again.

You can rely on our expertise, know-how, market knowledge and optimized adapted service for your system. At any time and in every phase of your work with Optima.



### Project Phase

- **Installation & Start up** – We guide you from the planning to the commissioning of your system and equipment.
- **Qualification Support** – We match your machine perfectly to your quality assurance specifications requirements.
- **Instruction & Training** – Before commissioning, we offer you





comprehensive and qualified training.



### Ramp-up Phase

- **Ramp-up support** – An Optima expert will assist you during start-up and production.
- **Remote Support & Hotline** - The OPTIMA Remote Service is available to you for fast and reliable remote support for your machine.

OPTIMA Total Care



### Production Phase

- **Spare Part Service** – The right spare parts are always at hand.
- **Calibration Service** – Regular calibration for perfect results.
- **Formats** – We use the most current formats and often do not require any tools for the exchange of parts.
- **Personal On-Site Support** – Our experts at your location.
- **Maintenance Service** – Customized maintenance concepts to fit your unique needs.
- **Process & Efficiency Optimization** – Analyze, plan and increase performance.
- **Retrofit & Upgrades** - Upgrade existing equipment instead of buying new.



## The digitalization of packaging machines

OPTIMA Total Care

The successful collaboration of high tech and the art of engineering: Industry 4.0.



State-of-the-art semi-automatic or automatic packaging machines for the food, pharmaceutical, beverage industry, non-woven and life science sectors. Reliable equipment and solutions for almost every task in modern product packaging. Designed and perfected by Optima. Made in Germany. Always state of the art. Trained

and motivated experts, global support and comprehensive services. We are your trusted manufacturer and supplier for now and the future.

Digitalization

### About Optima

Optima designs and realizes packaging solutions from single machines to complex turnkey systems for pharma, consumer, nonwovens and life science products.

### Divisions

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- > Nonwovens
- > Life Science
- > Total Care

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### Headquarters

Optima Machinery Corporation  
1330 Contract Drive  
Green Bay, WI 54304, USA  
☎ +1 920 339-2222  
✉ +1 920 339-2233  
✉ info-usa@optima-packaging.com

Member of Packaging Valley



Visit us on

# **EXHIBIT D**



# EFFICIENT PLANT

FORMERLY MAINTENANCE TECHNOLOGY

New and Improved Neptune®  
Corrosion-Resistant Chain  
 [www.ustsubaki.com](http://www.ustsubaki.com)



- RELIABILITY
- ELECTRICAL
- ANALYSIS
- AUTOMATION
- EQUIPMENT
- LUBRICATION
- SAFETY
- SERVICES
- WORKFORCE

BEARINGS | FEBRUARY | MAINTENANCE



## Selecting the Correct Bearing Seal

EP Editorial Staff | February 25, 2014



*This expert advice will help simplify your application-specific decisions about external seal types.*

The primary functions of a bearing seal are to keep lubricant in the bearing and bearing chamber contaminants out.

ADVERTISEMENT



Some seals are integral to the bearing; others aren't. The focus here is on what to consider when selecting external bearing seals. Key factors in making the right choice for an application typically include:

- Bearing type (rolling or sleeve)
- Lubricant (oil or grease)
- Seal friction and consequent heating
- Shaft surface speed and finish
- Physical space available

To select the appropriate seal for an application, match the relevant factors from the above list with the characteristics of the following external seal types.

### Common types of external seals

The types of seals most commonly used with rolling (ball and roller) bearings are contact or lip seals; non-contact seals; and, to a lesser degree, various types of bearing isolators that combine the functions of contact and non-contact seals in different ways. The labyrinth seal is a non-contacting type normally used with sleeve bearings.



### POPULAR CATEGORIES

- 1 Products
- 2 News
- 3 Management
- 4 Automation
- 5 Reliability
- 6 Maintenance
- 7 Uncategorized

### FEATURED VIDEO

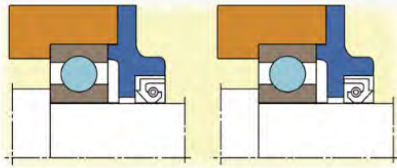


Fig. 1. The contact-grease-seal arrangement on the left is better for protecting against dust and liquids entering bearing chamber; the arrangement on the right is better for retaining lubricant in the bearing chamber.

**Contact seals:** A contact seal (Fig. 1) forms an effective sealed interface by applying continuous pressure to the surface with a resilient material. These seals make it difficult for fluids or solids particles to penetrate the sealed area, but direct contact with the shaft creates friction and heat that can degrade the seal and damage the shaft's surface finish. If a less effective sealing method is acceptable, an alternative is a non-contact seal.

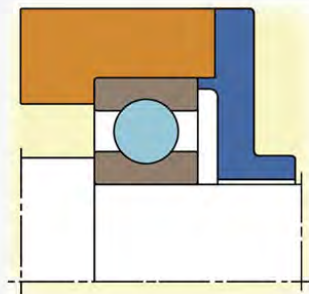


Fig. 2. Example of a non-contact seal used for a ball bearing

**Non-contact seals:** A non-contact seal (Fig. 2) produces much less friction (if any) and heating than a contact type. Unfortunately, non-contact seals also allow lubricant to leak out of the bearing chamber and liquid, and permit physically small contaminants to enter.

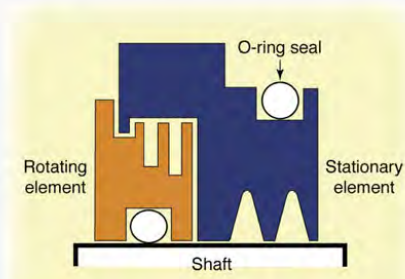
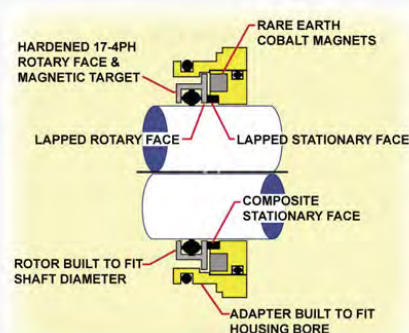


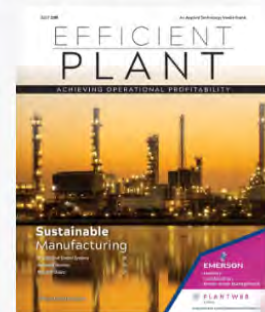
Fig. 3. Example of a combination contact and non-contact bearing isolator seal

**Bearing isolator seals:** Bearing isolators combine the characteristics of contact and non-contact seals in a single unit (Fig. 3), but use the contact features to "drive" part of the seal at the shaft's rotating speed. Such seals afford more protection than individual contact or non-contact seals. They also can be used with either grease or oil lubrication, and with sleeve or rolling bearings. Although bearing isolators are more costly and require more physical space than contact or non-contact seals, they deliver more effective sealing.



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Fig. 4. Contacting-type bearing isolator (courtesy of Isomag)

**Contacting isolators:** The first bearing isolators were non-contact labyrinth seals that greatly reduced contamination ingress but didn't stop moisture or other vapors. A newer version called a contacting isolator (Fig. 4) uses rare-earth magnets to apply tension to lapped contacting faces, just like a mechanical pump seal. Although contacting isolators stop all solid and vapor contamination, they have surface-speed limitations—a maximum of about a 4" (100 mm) shaft at 3600 rpm.

**Labyrinth-design isolators:** Another variation of the bearing isolator has a labyrinth design and an O-ring or other elastomer element that keeps the labyrinth channel closed when the shaft is stopped and expands by centrifugal force to open the channel when the shaft is rotating. This prevents vapor ingress while the machine is off and eliminates friction/heat when it's running. Special long-relief isolators are used in sleeve-bearing applications to accommodate the bearing's axial end float.

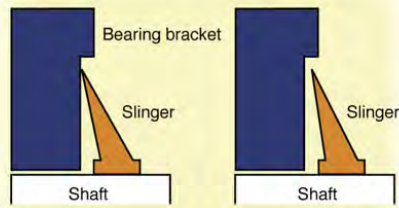


Fig. 5. Example of a shaft-slinger seal that combines contact (1) and non-contact seal types

**Shaft slingers.** These seals combine elements of contact and non-contact seals (see Fig. 5). Shaft slingers make contact with the end bracket while the machine is idle and move away from it (by centrifugal force) when the shaft is rotating.

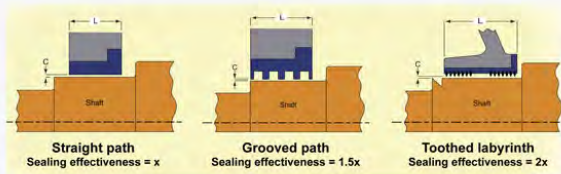


Fig. 6. Non-contact labyrinth seal examples arranged in order of sealing effectiveness. (Clearance [C] and length [L] values are the same for each example).

**Labyrinth seals:** Another commonly used non-contact seal is the labyrinth type (Fig. 6), which can be used with rolling or sleeve bearings, and with oil or grease lubrication. Suggested clearances for labyrinth seals with oil-lubricated sleeve bearings are provided in Table I:

Table I. Labyrinth Seal Diametral Clearance Guide					
DIMENSIONS IN INCHES					
Shaft diameter* 3000 to 3600 rpm			Shaft diameter* 1800 rpm or lower		
From	Up to		From	Up to	
3.000	3.500	0.009	3.000	3.500	0.012
3.500	4.000	0.010	3.500	4.000	0.014
4.000	4.500	0.012	4.000	4.500	0.016
4.500	5.000	0.014	4.500	5.000	0.018
5.000	5.500	0.015	5.000	5.500	0.020
5.500	6.000	0.017	5.500	6.000	0.022
6.000	6.500	0.018	6.000	6.500	0.024
6.500	7.000	0.020	6.500	7.000	0.026
7.000	7.500	0.021	7.000	7.500	0.028
DIMENSIONS IN MILLIMETERS					
Shaft diameter* 3000 to 3600 rpm			Shaft diameter* 1800 rpm or lower		
From	Up to		From	Up to	
76	89	0.230	76	89	0.305
89	102	0.255	89	102	0.355
102	114	0.305	102	114	0.405
114	127	0.355	114	127	0.455
127	140	0.380	127	140	0.510
140	152	0.430	140	152	0.560
152	165	0.455	152	165	0.610
165	178	0.510	165	178	0.660
178	191	0.535	178	191	0.710

Speeds given are synchronous speeds corresponding to the applicable line frequency and winding poles. Dimensions shown in millimeters are rounded off. The table at left is to be used for horizontal machines with bronze/brass labyrinth seals, absent specific clearance recommendations from the manufacturer. Galling materials, such as cast iron, may require greater clearance. Vertical machines may require less clearance. Labyrinth

may require greater clearance. Vertical machines may require less clearance. Labyrinth seal clearance must always be greater than the bearing clearance. A general rule of thumb suggests that labyrinth seal clearance should be 0.002" – 0.004" (.050 – .100 mm) greater than the sleeve bearing clearance.

\* The shaft diameter is the diameter at the seal fit; and "up to" means "up to but not including."

\*\* The diametral clearance is the clearance for the applicable range of shaft diameter.

Reference: ANSI/EASA Standard AR100-2010: Recommended Practice for the Repair of Rotating Electrical Apparatus, Table 2-7.

Suggested diametral clearances for labyrinth seals with grease-lubricated rolling bearings are 4-8 mils per inch (0.04-0.08 mm/cm) for shaft diameters below 2" (50 mm), and 5-10 mils per inch (0.05- 0.10 mm/ cm) for shafts 2" (50 mm) and larger.

#### Seal selection

Contact seals or bearing isolators are good choices for most oil-lubricated bearings—with the major exception of sleeve bearings, for which labyrinth seals are commonly used. Non-contact seals aren't acceptable in most oil-lubricated applications because they allow leakage.

The options for grease-lubricated bearings run the gamut, from non-contact and contact seals to various kinds of bearing isolators and labyrinth seals. (Note that virtually all sleeve bearings are oil-lubricated, whereas most rolling element bearings are grease-lubricated.)

Table II. Limiting Surface Contact Speeds for Seal Materials

Seal material/type	Limiting speed/f/sec (m/sec)
Felt	13 (4)
Grease seal	20 (6)
Oil seal, nitrile rubber	49 (15)
Oil seal, fluorinated rubber	105 (32)
V-ring	130 (40)

Table II. Limiting Surface Contact Speeds for Seal Materials

#### Shaft surface speed and finish

Shaft surface speed is always a consideration for contact seals. If it's excessive, overheating from friction will degrade the seal material and possibly damage the shaft surface. Table II provides limiting speeds for some common contact seal materials.

Table III. Shaft Surface Finish Tolerances

Circumferential speed/f/sec (m/sec)		
Over	Up to and including	Surface roughness Ra $\mu$ m ( $\mu$ m)
0	16.5 (5)	32 (0.8)
16.5 (5)	33 (10)	16 (0.4)
3 (10)	—	8 (0.2)

Table III. Shaft Surface Finish Tolerances

Contact seal friction and wear are also affected by shaft's surface finish. Suggested shaft surface finish tolerances are given in Table III. **LM&T**

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<p><b>Workforce</b></p> <ul style="list-style-type: none"> <li>Training</li> <li>Work Processes</li> </ul>				
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# **EXHIBIT E**



# CNG KRAUS OPTIMA™ SERIES

The most advanced CNG fueling dispenser on the market today.

## INTRODUCTION

KRAUS GLOBAL > PRODUCTS > CNG > DISPENSERS > OPTIMA™ SERIES > INTRODUCTION

Optima™ is the result of three decades of CNG focused experience and feedback from the field. A newly designed MICON NEXTGEN 1.0® aids station operators with additional communication capabilities, including remote access to gather data, download error code reporting, and complete software updates. Optima™ offers a new level of fuel dispensing performance while maintaining the reputation for high standards Kraus Global is known for.

With an array of standard customizable options, Optima™ can easily adapt to your standard or unique station design requirements. Because each dispenser is made to order this level of customization is possible at a cost comparable to an out of the box dispenser.

Station Operators will appreciate more control over operating parameters through superior data acquisition capabilities, analysis tools, and the expanded set of configurable variables. Enhanced diagnostics identify dispenser performance enabling faster trouble shooting and root cause analysis on site or remotely minimizing down time.

Grow your fleet base by providing Fleet Managers historical and real time filling data they will come to rely on. Save valuable Technical Support time while servicing the dispenser using enhanced diagnostics and the purpose built cabinet providing easier accessibility to internal components.

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# **EXHIBIT F**

## Response to Office Action

**The table below presents the data as entered.**

Input Field	Entered
<b>SERIAL NUMBER</b>	86557974
<b>LAW OFFICE ASSIGNED</b>	LAW OFFICE 116
<b>MARK SECTION</b>	
<b>MARK</b>	<a href="http://tmng-al.uspto.gov/resting2/api/img/86557974/large">http://tmng-al.uspto.gov/resting2/api/img/86557974/large</a>
<b>LITERAL ELEMENT</b>	OPTIMA
<b>STANDARD CHARACTERS</b>	YES
<b>USPTO-GENERATED IMAGE</b>	YES
<b>MARK STATEMENT</b>	The mark consists of standard characters, without claim to any particular font style, size or color.
<b>ARGUMENT(S)</b>	
<b>EVIDENCE SECTION</b>	
<b>EVIDENCE FILE NAME(S)</b>	
<b>ORIGINAL PDF FILE</b>	<a href="#">evi_10848137240-20151218150124336919_.nt_in_Response_to_Likelihood_of_Confusion_Refusal_for_OPTIMA.pdf</a>
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DESCRIPTION OF EVIDENCE FILE	A PDF containing Applicant's arguments against the likelihood-of-confusion finding and three supporting exhibits.
<b>GOODS AND/OR SERVICES SECTION (009)(class deleted)</b>	
<b>GOODS AND/OR SERVICES SECTION (011)(class added)Original Class (009)</b>	
INTERNATIONAL CLASS	011
DESCRIPTION	
cabinets for liquid and gas fuel dispensers, namely, dispenser cabinets for automatic temperature compensation so that the appropriate amount of liquid or gas fuel is metered	
FILING BASIS	Section 1(b)
FILING BASIS	Section 44(d)
FOREIGN APPLICATION NUMBER	1713786
FOREIGN APPLICATION COUNTRY	Canada
FOREIGN FILING DATE	02/04/2015
INTENT TO PERFECT 44(d)	At this time, the applicant intends to rely on Section 44(e) as a basis for registration. If ultimately the applicant does not rely on Section 44(e) as a basis for registration, a valid claim of priority may be retained.
<b>GOODS AND/OR SERVICES SECTION (037)(current)</b>	
INTERNATIONAL CLASS	037
DESCRIPTION	
service, installation, repair, maintenance, and support services for cabinets for liquid and gas fuel dispensers; manufacturing and distribution of cabinets for liquid and gas fuel dispensers; wholesale services of cabinets for liquid and gas fuel dispensers; operation and maintenance of an internet website containing information relating to cabinets for liquid and gas fuel dispensers	
FILING BASIS	Section 1(b)
FILING BASIS	Section 44(d)
<b>GOODS AND/OR SERVICES SECTION (037)(proposed)</b>	
INTERNATIONAL CLASS	037
TRACKED TEXT DESCRIPTION	
<del>service, installation, repair, maintenance, and support services for cabinets for liquid and gas fuel dispensers; installation, maintenance, and repair of cabinets for liquid and gas fuel dispensers; manufacturing and distribution of cabinets for liquid and gas fuel dispensers; technical support services, namely, technical advice related to the installation and repair of cabinets for liquid and gas fuel dispensers; wholesale services of cabinets for liquid and gas fuel dispensers; operation and maintenance of an internet website containing information relating to cabinets for liquid and gas fuel dispensers</del>	
FINAL DESCRIPTION	
installation, maintenance, and repair of cabinets for liquid and gas fuel dispensers; technical support services, namely, technical advice related to the installation and repair of cabinets for liquid and gas fuel dispensers	
FILING BASIS	Section 1(b)
FILING BASIS	Section 44(d)
FOREIGN APPLICATION	1713786

<b>NUMBER</b>	
<b>FOREIGN APPLICATION COUNTRY</b>	Canada
<b>FOREIGN FILING DATE</b>	02/04/2015
<b>INTENT TO PERFECT 44(d)</b>	At this time, the applicant intends to rely on Section 44(e) as a basis for registration. If ultimately the applicant does not rely on Section 44(e) as a basis for registration, a valid claim of priority may be retained.
<b>GOODS AND/OR SERVICES SECTION (035)(class added)</b>	
<b>INTERNATIONAL CLASS</b>	035
<b>DESCRIPTION</b>	
Wholesale reseller services featuring cabinets for liquid and gas fuel dispensers; providing a website featuring consumer product information in the field of cabinets for liquid and gas fuel dispensers	
<b>FILING BASIS</b>	Section 1(b)
<b>FILING BASIS</b>	Section 44(d)
<b>FOREIGN APPLICATION NUMBER</b>	1713786
<b>FOREIGN APPLICATION COUNTRY</b>	Canada
<b>FOREIGN FILING DATE</b>	02/04/2015
<b>INTENT TO PERFECT 44(d)</b>	At this time, the applicant intends to rely on Section 44(e) as a basis for registration. If ultimately the applicant does not rely on Section 44(e) as a basis for registration, a valid claim of priority may be retained.
<b>GOODS AND/OR SERVICES SECTION (039)(class added)</b>	
<b>INTERNATIONAL CLASS</b>	039
<b>DESCRIPTION</b>	
Distribution services, namely, delivery of cabinets for liquid and gas fuel dispensers	
<b>FILING BASIS</b>	Section 1(b)
<b>FILING BASIS</b>	Section 44(d)
<b>FOREIGN APPLICATION NUMBER</b>	1713786
<b>FOREIGN APPLICATION COUNTRY</b>	Canada
<b>FOREIGN FILING DATE</b>	02/04/2015
<b>INTENT TO PERFECT 44(d)</b>	At this time, the applicant intends to rely on Section 44(e) as a basis for registration. If ultimately the applicant does not rely on Section 44(e) as a basis for registration, a valid claim of priority may be retained.
<b>GOODS AND/OR SERVICES SECTION (040)(class added)</b>	
<b>INTERNATIONAL CLASS</b>	040
<b>DESCRIPTION</b>	
Manufacture of cabinets for liquid and gas fuel dispensers to order and/or specification of others	

<b>FILING BASIS</b>	Section 1(b)
<b>FILING BASIS</b>	Section 44(d)
<b>FOREIGN APPLICATION NUMBER</b>	1713786
<b>FOREIGN APPLICATION COUNTRY</b>	Canada
<b>FOREIGN FILING DATE</b>	02/04/2015
<b>INTENT TO PERFECT 44(d)</b>	At this time, the applicant intends to rely on Section 44(e) as a basis for registration. If ultimately the applicant does not rely on Section 44(e) as a basis for registration, a valid claim of priority may be retained.
<b>GOODS AND/OR SERVICES SECTION (042)(class added)</b>	
<b>INTERNATIONAL CLASS</b>	042
<b>DESCRIPTION</b>	
Computer services, namely, hosting and maintaining an online website for others featuring information relating to cabinets for liquid and gas fuel dispensers, and for the purpose of providing a repository of technical information and manuals for customers	
<b>FILING BASIS</b>	Section 1(b)
<b>FILING BASIS</b>	Section 44(d)
<b>FOREIGN APPLICATION NUMBER</b>	1713786
<b>FOREIGN APPLICATION COUNTRY</b>	Canada
<b>FOREIGN FILING DATE</b>	02/04/2015
<b>INTENT TO PERFECT 44(d)</b>	At this time, the applicant intends to rely on Section 44(e) as a basis for registration. If ultimately the applicant does not rely on Section 44(e) as a basis for registration, a valid claim of priority may be retained.
<b>ADDITIONAL STATEMENTS SECTION</b>	
<b>MISCELLANEOUS STATEMENT</b>	Applicant notes that the foreign application relied upon has not yet issued as a foreign registration. Accordingly, Applicant requests that the U.S. application be suspended as necessary until a copy of the foreign registration is available.
<b>PAYMENT SECTION</b>	
<b>NUMBER OF CLASSES</b>	4
<b>APPLICATION FOR REGISTRATION PER CLASS</b>	275
<b>TOTAL FEES DUE</b>	1100
<b>SIGNATURE SECTION</b>	
<b>DECLARATION SIGNATURE</b>	/Adam Sikich/
<b>SIGNATORY'S NAME</b>	Adam Sikich
<b>SIGNATORY'S POSITION</b>	Attorney of Record, Washington, DC Bar Member
<b>SIGNATORY'S PHONE NUMBER</b>	(202) 298-6322



<b>DATE SIGNED</b>	12/18/2015
<b>RESPONSE SIGNATURE</b>	/Adam Sikich/
<b>SIGNATORY'S NAME</b>	Adam Sikich
<b>SIGNATORY'S POSITION</b>	Attorney of Record, Washington, DC Bar Member
<b>SIGNATORY'S PHONE NUMBER</b>	(202) 298-6322
<b>DATE SIGNED</b>	12/18/2015
<b>AUTHORIZED SIGNATORY</b>	YES
<b>FILING INFORMATION SECTION</b>	
<b>SUBMIT DATE</b>	Fri Dec 18 15:51:58 EST 2015
<b>TEAS STAMP</b>	USPTO/ROA-XXX.XX.XXX.XXX- 20151218155158806155-8655 7974-55044a04dcad450ce324 9532e25daed68b7ab1617a4b8 91f23e92f4effb87fb9c-CC-2 638-20151218150124336919

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## Response to Office Action

### To the Commissioner for Trademarks:

Application serial no. **86557974** OPTIMA(Standard Characters, see <http://tmng-al.uspto.gov/resting2/api/img/86557974/large>) has been amended as follows:

#### ARGUMENT(S)

**In response to the substantive refusal(s), please note the following:**

#### EVIDENCE

Evidence in the nature of A PDF containing Applicant's arguments against the likelihood-of-confusion finding and three supporting exhibits. has been attached.

#### Original PDF file:

[evi\\_10848137240-20151218150124336919\\_.nt\\_in\\_Response\\_to\\_Likelihood\\_of\\_Confusion\\_Refusal\\_for\\_OPTIMA.pdf](#)

Converted PDF file(s) ( 6 pages)

[Evidence-1](#)

[Evidence-2](#)

[Evidence-3](#)

[Evidence-4](#)

[Evidence-5](#)

[Evidence-6](#)

#### Original PDF file:

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[Evidence-1](#)



**Original PDF file:**

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[Evidence-1](#)

**Original PDF file:**

[evi\\_10848137240-20151218150124336919 . Exhibit C.pdf](#)

**Converted PDF file(s)** ( 1 page)

[Evidence-1](#)

**CLASSIFICATION AND LISTING OF GOODS/SERVICES**

**Applicant hereby deletes the following class of goods/services from the application.**

Class 009 for cabinets for liquid and gas fuel dispensers

**Applicant proposes to amend the following class of goods/services in the application:**

**Current:** Class 037 for service, installation, repair, maintenance, and support services for cabinets for liquid and gas fuel dispensers; manufacturing and distribution of cabinets for liquid and gas fuel dispensers; wholesale services of cabinets for liquid and gas fuel dispensers; operation and maintenance of an internet website containing information relating to cabinets for liquid and gas fuel dispensers

Original Filing Basis:

**Filing Basis: Section 1(b), Intent to Use: For a trademark or service mark application:** As of the application filing date, the applicant had a bona fide intention, and was entitled, to use the mark in commerce on or in connection with the identified goods/services in the application. **For a collective trademark, collective service mark, or collective membership mark application:** As of the application filing date, the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce by members on or in connection with the identified goods/services/collective membership organization. **For a certification mark application:** As of the application filing date, the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce by authorized users in connection with the identified goods/services, and the applicant will not engage in the production or marketing of the goods/services to which the mark is applied, except to advertise or promote recognition of the certification program or of the goods/services that meet the certification standards of the applicant.

Based on Foreign Application: Applicant has had a bona fide intention to use the mark in commerce on or in connection with the identified goods and/or services, and will submit a copy of a foreign registration, and translation thereof, if appropriate. 15 U. S.C. Section 1126(d), as amended.

**Proposed:**

**Tracked Text Description:** ~~service, installation, repair, maintenance, and support services for cabinets for liquid and gas fuel dispensers; installation, maintenance, and repair of cabinets for liquid and gas fuel dispensers; manufacturing and distribution of cabinets for liquid and gas fuel dispensers; technical support services, namely, technical advice related to the installation and repair of cabinets for liquid and gas fuel dispensers; wholesale services of cabinets for liquid and gas fuel dispensers; operation and maintenance of an internet website containing information relating to cabinets for liquid and gas fuel dispensers~~

Class 037 for installation, maintenance, and repair of cabinets for liquid and gas fuel dispensers; technical support services, namely, technical advice related to the installation and repair of cabinets for liquid and gas fuel dispensers

**Filing Basis: Section 1(b), Intent to Use: For a trademark or service mark application:** As of the application filing date, the applicant had a bona fide intention, and was entitled, to use the mark in commerce on or in connection with the identified goods/services in the application. **For a collective trademark, collective service mark, or collective membership mark application:** As of the application filing date, the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce by members on or in connection with the identified goods/services/collective membership organization. **For a certification mark application:** As of the application filing date, the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce by authorized users in connection with the identified goods/services, and the applicant will not engage in the production or marketing of the goods/services to which the mark is applied, except to advertise or promote recognition of the certification program or of the goods/services that meet the certification standards of the applicant.

**Filing Basis: Section 44(d), Priority based on foreign filing:For a trademark or service mark application:** As of the application filing date, the applicant had a bona fide intention, and was entitled, to use the mark in commerce on or in connection with the identified goods/services, and asserts a claim of priority based upon a foreign application. **For a collective trademark, collective service mark, or collective membership mark application:** As of the application filing date, the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce by members on or in connection with the identified goods/services/collective membership organization, and asserts a claim of priority based upon a foreign application. **For a certification mark application:** As of the application filing date, the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce by authorized users in connection with the identified goods/services, the applicant will not engage in the production or marketing of the goods/services to which the mark is applied, except to advertise or promote recognition of the certification program or of the goods or services that meet the certification standards of the applicant, and the applicant asserts a claim of priority based upon a foreign application. Claim of priority is based on [ Canada application number 1713786 filed 02/04/2015]. 15 U.S.C.Section 1126(d), as amended.

INTENT TO PERFECT 44(d) : At this time, the applicant intends to rely on Section 44(e) as a basis for registration. If ultimately the applicant does not rely on Section 44(e) as a basis for registration, a valid claim of priority may be retained.

**Applicant hereby adds the following class of goods/services to the application:**

**New:** Class 011 (Original Class: 009 ) for cabinets for liquid and gas fuel dispensers, namely, dispenser cabinets for automatic temperature compensation so that the appropriate amount of liquid or gas fuel is metered

**Filing Basis: Section 1(b), Intent to Use: For a trademark or service mark application:** As of the application filing date, the applicant had a bona fide intention, and was entitled, to use the mark in commerce on or in connection with the identified goods/services in the application. **For a collective trademark, collective service mark, or collective membership mark application:** As of the application filing date, the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce by members on or in connection with the identified goods/services/collective membership organization. **For a certification mark application:** As of the application filing date, the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce by authorized users in connection with the identified goods/services, and the applicant will not engage in the production or marketing of the goods/services to which the mark is applied, except to advertise or promote recognition of the certification program or of the goods/services that meet the certification standards of the applicant.

**Filing Basis: Section 44(d), Priority based on foreign filing:For a trademark or service mark application:** As of the application filing date, the applicant had a bona fide intention, and was entitled, to use the mark in commerce on or in connection with the identified goods/services, and asserts a claim of priority based upon a foreign application. **For a collective trademark, collective service mark, or collective membership mark application:** As of the application filing date, the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce by members on or in connection with the identified goods/services/collective membership organization, and asserts a claim of priority based upon a foreign application. **For a certification mark application:** As of the application filing date, the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce by authorized users in connection with the identified goods/services, the applicant will not engage in the production or marketing of the goods/services to which the mark is applied, except to advertise or promote recognition of the certification program or of the goods or services that meet the certification standards of the applicant, and the applicant asserts a claim of priority based upon a foreign application. Claim of priority is based on [ Canada application number 1713786 filed 02/04/2015]. 15 U.S.C.Section 1126(d), as amended.

INTENT TO PERFECT 44(d) : At this time, the applicant intends to rely on Section 44(e) as a basis for registration. If ultimately the applicant does not rely on Section 44(e) as a basis for registration, a valid claim of priority may be retained.

**Applicant hereby adds the following class of goods/services to the application:**

**New:** Class 035 for Wholesale reseller services featuring cabinets for liquid and gas fuel dispensers; providing a website featuring consumer product information in the field of cabinets for liquid and gas fuel dispensers

**Filing Basis: Section 1(b), Intent to Use: For a trademark or service mark application:** As of the application filing date, the applicant had a bona fide intention, and was entitled, to use the mark in commerce on or in connection with the identified goods/services in the application. **For a collective trademark, collective service mark, or collective membership mark application:** As of the application filing date, the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce by members on or in connection with the identified goods/services/collective membership organization. **For a certification mark application:** As of the application filing date, the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce by authorized users in connection with the identified goods/services, and the applicant will not engage in the production or marketing of the goods/services to which the mark is applied, except to advertise or promote recognition of the certification program or of the goods/services that meet the certification standards of the applicant.

**Filing Basis: Section 44(d), Priority based on foreign filing:For a trademark or service mark application:** As of the application filing date, the applicant had a bona fide intention, and was entitled, to use the mark in commerce on or in connection with the identified goods/services, and asserts a claim of priority based upon a foreign application. **For a collective trademark, collective service mark, or collective membership mark application:** As of the application filing date, the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce by members on or in connection with the identified goods/services/collective membership organization, and asserts a claim of priority based upon a foreign application. **For a certification mark application:** As of the application filing date, the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce by authorized users in connection with the identified goods/services, the applicant will not engage in the production or marketing of the goods/services to which the mark is applied, except to advertise or promote recognition of the certification program or of the goods or services that meet the certification standards of the applicant, and the applicant asserts a claim of priority based upon a foreign application. Claim of priority is based on [ Canada application number 1713786 filed 02/04/2015]. 15 U.S.C.Section 1126(d), as amended.

INTENT TO PERFECT 44(d) : At this time, the applicant intends to rely on Section 44(e) as a basis for registration. If ultimately the applicant does not rely on Section 44(e) as a basis for registration, a valid claim of priority may be retained.

**Applicant hereby adds the following class of goods/services to the application:**

**New:** Class 039 for Distribution services, namely, delivery of cabinets for liquid and gas fuel dispensers

**Filing Basis: Section 1(b), Intent to Use: For a trademark or service mark application:** As of the application filing date, the applicant had a bona fide intention, and was entitled, to use the mark in commerce on or in connection with the identified goods/services in the application. **For a**

**collective trademark, collective service mark, or collective membership mark application:** As of the application filing date, the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce by members on or in connection with the identified goods/services/collective membership organization. **For a certification mark application:** As of the application filing date, the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce by authorized users in connection with the identified goods/services, and the applicant will not engage in the production or marketing of the goods/services to which the mark is applied, except to advertise or promote recognition of the certification program or of the goods/services that meet the certification standards of the applicant.

**Filing Basis: Section 44(d), Priority based on foreign filing:****For a trademark or service mark application:** As of the application filing date, the applicant had a bona fide intention, and was entitled, to use the mark in commerce on or in connection with the identified goods/services, and asserts a claim of priority based upon a foreign application. **For a collective trademark, collective service mark, or collective membership mark application:** As of the application filing date, the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce by members on or in connection with the identified goods/services/collective membership organization, and asserts a claim of priority based upon a foreign application. **For a certification mark application:** As of the application filing date, the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce by authorized users in connection with the identified goods/services, the applicant will not engage in the production or marketing of the goods/services to which the mark is applied, except to advertise or promote recognition of the certification program or of the goods or services that meet the certification standards of the applicant, and the applicant asserts a claim of priority based upon a foreign application. Claim of priority is based on [ Canada application number 1713786 filed 02/04/2015]. 15 U.S.C. Section 1126(d), as amended.  
INTENT TO PERFECT 44(d) : At this time, the applicant intends to rely on Section 44(e) as a basis for registration. If ultimately the applicant does not rely on Section 44(e) as a basis for registration, a valid claim of priority may be retained.

**Applicant hereby adds the following class of goods/services to the application:**

**New:** Class 040 for Manufacture of cabinets for liquid and gas fuel dispensers to order and/or specification of others

**Filing Basis: Section 1(b), Intent to Use:** **For a trademark or service mark application:** As of the application filing date, the applicant had a bona fide intention, and was entitled, to use the mark in commerce on or in connection with the identified goods/services in the application. **For a collective trademark, collective service mark, or collective membership mark application:** As of the application filing date, the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce by members on or in connection with the identified goods/services/collective membership organization. **For a certification mark application:** As of the application filing date, the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce by authorized users in connection with the identified goods/services, and the applicant will not engage in the production or marketing of the goods/services to which the mark is applied, except to advertise or promote recognition of the certification program or of the goods/services that meet the certification standards of the applicant.

**Filing Basis: Section 44(d), Priority based on foreign filing:****For a trademark or service mark application:** As of the application filing date, the applicant had a bona fide intention, and was entitled, to use the mark in commerce on or in connection with the identified goods/services, and asserts a claim of priority based upon a foreign application. **For a collective trademark, collective service mark, or collective membership mark application:** As of the application filing date, the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce by members on or in connection with the identified goods/services/collective membership organization, and asserts a claim of priority based upon a foreign application. **For a certification mark application:** As of the application filing date, the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce by authorized users in connection with the identified goods/services, the applicant will not engage in the production or marketing of the goods/services to which the mark is applied, except to advertise or promote recognition of the certification program or of the goods or services that meet the certification standards of the applicant, and the applicant asserts a claim of priority based upon a foreign application. Claim of priority is based on [ Canada application number 1713786 filed 02/04/2015]. 15 U.S.C. Section 1126(d), as amended.  
INTENT TO PERFECT 44(d) : At this time, the applicant intends to rely on Section 44(e) as a basis for registration. If ultimately the applicant does not rely on Section 44(e) as a basis for registration, a valid claim of priority may be retained.

**Applicant hereby adds the following class of goods/services to the application:**

**New:** Class 042 for Computer services, namely, hosting and maintaining an online website for others featuring information relating to cabinets for liquid and gas fuel dispensers, and for the purpose of providing a repository of technical information and manuals for customers

**Filing Basis: Section 1(b), Intent to Use:** **For a trademark or service mark application:** As of the application filing date, the applicant had a bona fide intention, and was entitled, to use the mark in commerce on or in connection with the identified goods/services in the application. **For a collective trademark, collective service mark, or collective membership mark application:** As of the application filing date, the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce by members on or in connection with the identified goods/services/collective membership organization. **For a certification mark application:** As of the application filing date, the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce by authorized users in connection with the identified goods/services, and the applicant will not engage in the production or marketing of the goods/services to which the mark is applied, except to advertise or promote recognition of the certification program or of the goods/services that meet the certification standards of the applicant.

**Filing Basis: Section 44(d), Priority based on foreign filing:***For a trademark or service mark application:* As of the application filing date, the applicant had a bona fide intention, and was entitled, to use the mark in commerce on or in connection with the identified goods/services, and asserts a claim of priority based upon a foreign application. *For a collective trademark, collective service mark, or collective membership mark application:* As of the application filing date, the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce by members on or in connection with the identified goods/services/collective membership organization, and asserts a claim of priority based upon a foreign application. *For a certification mark application:* As of the application filing date, the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce by authorized users in connection with the identified goods/services, the applicant will not engage in the production or marketing of the goods/services to which the mark is applied, except to advertise or promote recognition of the certification program or of the goods or services that meet the certification standards of the applicant, and the applicant asserts a claim of priority based upon a foreign application. Claim of priority is based on [ Canada application number 1713786 filed 02/04/2015]. 15 U.S.C. Section 1126(d), as amended.  
INTENT TO PERFECT 44(d) : At this time, the applicant intends to rely on Section 44(e) as a basis for registration. If ultimately the applicant does not rely on Section 44(e) as a basis for registration, a valid claim of priority may be retained.

## **ADDITIONAL STATEMENTS**

### **Miscellaneous Statement**

Applicant notes that the foreign application relied upon has not yet issued as a foreign registration. Accordingly, Applicant requests that the U.S. application be suspended as necessary until a copy of the foreign registration is available.

### **FEE(S)**

Fee(s) in the amount of \$1100 is being submitted.

### **SIGNATURE(S)**

#### **Declaration Signature**

**DECLARATION:** The signatory being warned that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. § 1001, and that such willful false statements and the like may jeopardize the validity of the application or submission or any registration resulting therefrom, declares that, if the applicant submitted the application or allegation of use (AOU) unsigned, all statements in the application or AOU and this submission based on the signatory's own knowledge are true, and all statements in the application or AOU and this submission made on information and belief are believed to be true.

**STATEMENTS FOR UNSIGNED SECTION 1(a) APPLICATION/AOU:** If the applicant filed an unsigned application under 15 U.S.C. §1051(a) or AOU under 15 U.S.C. §1051(c), the signatory additionally believes that: the applicant is the owner of the mark sought to be registered; the mark is in use in commerce and was in use in commerce as of the filing date of the application or AOU on or in connection with the goods/services/collective membership organization in the application or AOU; the original specimen(s), if applicable, shows the mark in use in commerce as of the filing date of the application or AOU on or in connection with the goods/services/collective membership organization in the application or AOU; *for a collective trademark, collective service mark, collective membership mark application, or certification mark application*, the applicant is exercising legitimate control over the use of the mark in commerce and was exercising legitimate control over the use of the mark in commerce as of the filing date of the application or AOU; *for a certification mark application*, the applicant is not engaged in the production or marketing of the goods/services to which the mark is applied, except to advertise or promote recognition of the certification program or of the goods/services that meet the certification standards of the applicant. **To the best of the signatory's knowledge and belief, no other persons, except, if applicable, authorized users, members, and/or concurrent users, have the right to use the mark in commerce, either in the identical form or in such near resemblance as to be likely, when used on or in connection with the goods/services/collective membership organization of such other persons, to cause confusion or mistake, or to deceive.**

### **STATEMENTS FOR UNSIGNED SECTION 1(b)/SECTION 44 APPLICATION AND FOR SECTION 66(a)**

**COLLECTIVE/CERTIFICATION MARK APPLICATION:** If the applicant filed an unsigned application under 15 U.S.C. §§ 1051(b), 1126(d), and/or 1126(e), or filed a collective/certification mark application under 15 U.S.C. §1141f(a), the signatory additionally believes that: *for a trademark or service mark application*, the applicant is entitled to use the mark in commerce on or in connection with the goods/services specified in the application; the applicant has a bona fide intention to use the mark in commerce and had a bona fide intention to use the mark in commerce as of the application filing date; *for a collective trademark, collective service mark, collective membership mark, or certification mark application*, the applicant has a bona fide intention, and is entitled, to exercise legitimate control over the use of the mark in commerce and had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce as of the application filing date; the signatory is properly authorized to execute the declaration on behalf of the applicant; *for a certification mark application*, the applicant will not engage in the production or marketing of the goods/services to which the mark is applied, except to advertise or promote recognition of the certification program or of the goods/services that meet the certification standards of the applicant. **To the best of the signatory's knowledge and belief, no other persons, except, if applicable, authorized users, members, and/or concurrent users, have the right to use the mark in commerce, either in the identical form or in such near resemblance as to be likely, when used on or in connection with the goods/services/collective membership organization of such other persons, to cause confusion or mistake, or to deceive.**

Signature: /Adam Sikich/ Date: 12/18/2015  
Signatory's Name: Adam Sikich  
Signatory's Position: Attorney of Record, Washington, DC Bar Member  
Signatory's Phone Number: (202) 298-6322

**Response Signature**

Signature: /Adam Sikich/ Date: 12/18/2015  
Signatory's Name: Adam Sikich  
Signatory's Position: Attorney of Record, Washington, DC Bar Member

Signatory's Phone Number: (202) 298-6322

The signatory has confirmed that he/she is an attorney who is a member in good standing of the bar of the highest court of a U.S. state, which includes the District of Columbia, Puerto Rico, and other federal territories and possessions; and he/she is currently the owner's/holder's attorney or an associate thereof; and to the best of his/her knowledge, if prior to his/her appointment another U.S. attorney or a Canadian attorney/agent not currently associated with his/her company/firm previously represented the owner/holder in this matter: (1) the owner/holder has filed or is concurrently filing a signed revocation of or substitute power of attorney with the USPTO; (2) the USPTO has granted the request of the prior representative to withdraw; (3) the owner/holder has filed a power of attorney appointing him/her in this matter; or (4) the owner's/holder's appointed U.S. attorney or Canadian attorney/agent has filed a power of attorney appointing him/her as an associate attorney in this matter.

RAM Sale Number: 86557974  
RAM Accounting Date: 12/21/2015

Serial Number: 86557974  
Internet Transmission Date: Fri Dec 18 15:51:58 EST 2015  
TEAS Stamp: USPTO/ROA-XXX.XX.XXX.XXX-201512181551588  
06155-86557974-55044a04dcad450ce3249532e  
25daed68b7ab1617a4b891f23e92f4effb87fb9c  
-CC-2638-20151218150124336919

Attorney Docket No: KRAU-005  
Mark: OPTIMA  
Serial No.: 86/557,974

This is a Response to the Office Action mailed June 19, 2015.

#### REMARKS

The Examining Attorney initially refuses registration of Applicant's OPTIMA Mark ("Applicant's Mark"), on the grounds of a likelihood of confusion with the following registration:

Mark: OPTIMA ("Registrant's Mark")  
Registration No: 3,837,991  
Owner: Optima Solutions UK Limited

The Examining Attorney identifies the following relevant services covered by Registrant's Mark:

Class 37: installation, maintenance and repair services relating to deluge systems for oil and gas flaring applications including Floating Production Storage and Off loading vessels, platforms, jackups, semi-submersibles, drilling rigs and land rigs; installation, maintenance and repair of offshore structures

Class 37: maintenance and repair services relating to engineering products, namely, fluid dispensing nozzles, hose systems, pipe work, filtration devices and deluge systems; construction supervision of the engineering of structures for the oil and gas industry

Class 42: design relating to deluge systems for oil and gas flaring applications including floating production storage and offloading vessels, platforms, jackups, semi-submersible, drilling rigs and land rigs within the oil and gas industries

Applicant respectfully requests reconsideration and withdrawal of the refusal for the reasons set forth below.

#### **I. There Is No Likelihood of Confusion**

A likelihood-of-confusion determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the thirteen factors set forth in *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361-62, 177 U.S.P.Q. 563, 567 (C.C.P.A. 1973). The Examining Attorney need not consider all factors, but may consider those factors that are most relevant to the case at hand.

See *In re Dixie Rests., Inc.*, 105 F.3d 1405, 1406, 41 U.S.P.Q.2d 1531, 1533 (Fed. Cir. 1997); *Kimberly-Clark Corp. v. H. Douglas Enters., Ltd.*, 774 F.2d 1144, 1146, 227 U.S.P.Q. 541, 542 (Fed. Cir. 1985).

While the marks at issue are identical, the similarity of the marks is only one factor to be considered. See *In re E.I. du Pont de Nemours & Co.*, 476 F.2d at 1361-62, 177 U.S.P.Q. at 567 (“There is no litmus rule which can provide a ready guide to all cases.”). Indeed, confusion may be unlikely even for identical marks when used on different products. *Id.* (citing *McKesson & Robbins, Inc. v. Lorillard Co.*, 120 U.S.P.Q. 306 (T.T.A.B. 1959)).

Here, three other *du Pont* factors play a dominant role: 1) the dissimilarity of the goods and services, 2) the dissimilarity of the trade channels, and 3) the conditions under which and buyers to whom sales are made. See *id.* When all of the relevant *du Pont* factors are considered in relation to Applicant’s Mark and Registrant’s Mark, the factors weigh against a likelihood-of-confusion finding and in favor of allowing Applicant’s Mark to continue to publication.

**a. The Goods and Services Listed for the Marks Are Dissimilar**

In determining whether a likelihood of confusion exists, the Examining Attorney must consider the differences between the goods and services at issue. *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 U.S.P.Q. 24, 29 (C.C.P.A 1976). While the determination of similarity or relationship between the goods and services must be made on the basis of the identification of goods and services set forth in the involved application and registration, see *In re Cont’l Graphics Corp.*, 52 U.S.P.Q.2d 1374, 1377 (T.T.A.B. 1999), the Examining Attorney must provide evidence showing that the goods and services are related to support a finding of likelihood of confusion. See, e.g., *In re White Rock Distilleries, Inc.*, 92 U.S.P.Q.2d 1282, 1285 (T.T.A.B. 2009).

Here, the Examining Attorney identifies the following relevant services covered by Applicant’s Mark:

Class 37: service, installation, repair, maintenance, and support services for cabinets for liquid and gas fuel dispensers; manufacturing and distribution of cabinets for liquid and gas fuel dispensers

Applicant is submitting a revised description of goods and services as part of this Response to Office Action. Accordingly, the services that the Examining Attorney has identified as relevant to this 2(d) refusal now read as follows:

Class 37: installation, maintenance, and repair of cabinets for liquid and gas fuel dispensers; technical support services, namely, technical advice related to the installation and repair of cabinets for liquid and gas fuel dispensers

Class 39: Distribution services, namely, delivery of cabinets for liquid and gas fuel dispensers

Class 40: Manufacture of cabinets for liquid and gas fuel dispensers to order and/or specification of others

As identified above, the Examining Attorney focuses on a select portion of Registrant's and Applicant's goods and services, concluding that Applicant's services "could include" Registrant's services. The Examining Attorney, however, fails to provide or identify any evidence showing that these services are related.

Respectfully, the Examining Attorney misinterprets the services at issue. Applicant offers services relating to fuel dispensers—more specifically in connection with Applicant's Mark, the cabinets that house fuel dispensers. At their core, these cabinets and dispensers are comparable to the fuel dispensers you would find at a typical gas station, except that the dispensers are generally used to dispense alternate fuels such as compressed natural gas, liquid petroleum gas, liquid natural gas, and hydrogen. See *CNG Dispensers*, Kraus Global Dispensing Solutions, <http://krausglobal.com/products/cng/dispensers/> (last visited December 18, 2015) (*Exhibit A*).

Registrant offers, by contrast, "deluge systems for oil and gas flaring applications." In other words, Registrant offers "[a] sprinkler system employing open sprinklers attached to a piping system



connected to a water supply.” *Deluge System*, International Association of Drilling Contractors Drilling Lexicon, (last updated Sept. 2015), <http://www.iadclexicon.org/deluge-system/> (*Exhibit B*). Relatedly, Registrant offers “design relating to deluge systems” and “maintenance and repair services” relating to deluge systems.

A specialization in deluge systems for use on oil rigs does not in any way make those deluge systems similar to Applicant’s fuel-dispenser cabinets. To the contrary, the goods and services are diametrically opposed: Registrant’s goods and services are used to put out fires and cool oil rigs, whereas Applicant’s goods and services are used to provide the fuel for chemical reactions and energy generation. Thus, rather than possibly including Registrant’s services, Applicant’s services are generally incompatible with Registrant’s services.

That Registrant’s list of services may include component parts of deluge systems, such as “fluid dispensing nozzles, hose systems, pipe work, [and] filtration devices,” does not render Applicant’s and Registrant’s goods and services any more related. Such component parts are basic plumbing equipment, and should not be read to unduly expand Registrant’s rights. Registrant’s rights, for example, would certainly not extend to the services of a local plumber who carries out “pipe work” or a local car wash that uses and maintains “fluid dispensing nozzles.” Rather, under the interpretive canon of *noscitur a sociis*, these terms should be defined in connection with the rest of the wording, namely, deluge systems. *See, e.g., Gustafson v. Alloyd Co.*, 513 U.S. 561, 575 (1995) (explaining the principle that “a word is known by the company it keeps”). Accordingly, these terms should be read in light of Registrant’s cooling and deluge systems, and no connection should be made to Applicant’s unrelated goods and services.

As such, the goods and services, as listed in the application and in the registration, are directed to entirely different industries. There has been no showing that fuel dispensers and deluge systems are

in any way related, much less closely related. Accordingly, this *du Pont* factor weighs heavily against a likelihood-of-confusion finding.

**b. The Listed Goods' Distinct Trade Channels, Careful Buying Conditions, and Non-Overlapping Buyers Weigh Heavily Against Possible Confusion**

Closely related to the similarity of the listed goods and services are two other essential *du Pont* factors, namely, 1) the similarity of established, likely-to-continue trade channels and 2) the conditions under which and buyers to whom sales are made. *In re E.I. du Pont de Nemours & Co.*, 476 F.2d at 1361, 177 U.S.P.Q. at 567. Considerations such as the unrelated nature of the parties' goods and services, their different purchasers, or their different channels of trade may weigh heavily against a likelihood-of-confusion finding. *See M2 Software, Inc. v. M2 Commc'ns, Inc.*, 450 F.3d 1378, 1384, 78 U.S.P.Q.2d 1944, 1947-48 (Fed. Cir. 2006). While an applicant's and a registrant's goods and services should be read in light of their application and registration, respectively, incidental overlap of product or service features do not bring disparate goods and services into the same field. *See id.* at 1382-83, 78 U.S.P.Q.2d at 1947-48.

Here, Applicant's and Registrant's goods and services are plainly distinct. As explained above, Applicant offers goods and services related to fuel pumps for the alternate fuels industry while Registrant offers goods and services related to deluge and cooling systems for oil rigs. Indeed, there is no reason to believe that Registrant's services, which are targeted to the operators of oil rigs, would share any channels of trade or customers in common with Applicant's goods and services, which are targeted to alternate fuel dispensaries. That both parties, for example, might use basic plumbing equipment or operate websites is insufficient to show an overlap in trade channels. *See id.* at 1383, 78 U.S.P.Q.2d at 1947-48.

Relatedly, the purchasers of each party's goods and services are plainly not casual consumers susceptible to purchasing the wrong company's product on impulse. Both Applicant's and Registrant's goods and services are far from inexpensive, and they are generally purchased by corporations rather than individuals. See *About Us*, Optima the Rig Cooling Specialists, <http://www.optimauk.com/about-us.html> (last visited December 18, 2015) (emphasizing experience serving "major oil and gas companies") (*Exhibit C*). As such, purchasing either alternate fuel pumps or cooling and deluge systems specially engineered for oil rigs requires the kind of "careful, sophisticated purchasing" necessary to keep a business afloat. See *In re E.I. du Pont de Nemours & Co.*, 476 F.2d at 1361, 177 U.S.P.Q. at 567. Given the specialized nature of these products and the importance of these purchases to the purchasing businesses, confusion between these two marks is highly unlikely. In sum, the unrelated nature of the parties' goods, their different channels of trade, their different purchasers, and their sophisticated goods and services weigh heavily against a likelihood-of-confusion finding.

## **II. Conclusion**

Taken together, the *du Pont* factors weigh heavily against a likelihood of confusion between these two marks. The relevant goods and services—alternate fuel dispensing systems and deluge systems specially engineered for oil rigs—are entirely distinct, sold in different channels of trade, and purchased by different sets of purchasers exercising careful, sophisticated decision making. Accordingly, the *du Pont* factors weigh heavily against a likelihood-of-confusion finding, and Applicant respectfully requests withdrawal of the refusal and approval of the mark for publication.



## CNG DISPENSERS

With over 6,000 dispensers deployed globally, Kraus Global compressed natural gas products are leaders in the alternative fuel market.

KRAUS GLOBAL > PRODUCTS > CNG > DISPENSERS

Kraus Global Fleet and Retail Series dispensers set the industry standard for reliability, durability and safety. With over 6,000 dispensers deployed around the world, Kraus is the preferred choice for both fleet and retail CNG fueling stations. Our expertise lies in our ability to create customized and innovative solutions to meet and exceed your station goals and our commitment to providing exceptional customer service ensures maximum uptime for your CNG equipment.



### The Kraus Retail Series dispenser

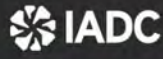
The Kraus Retail Series dispenser is one of the most widely used for CNG dispensing solutions in the North American market today. Combining the industry leading MICON™ 500 CNG controller with the Gilbarco Encore® 5 or the Gilbarco Encore® 700 S cabinet, Kraus delivers CNG solutions that are configured to meet your fueling station needs. With a range of flexible options in delivered flow rates and inlet configurations and an optional CRIND™ configuration, the Kraus Retail Series is the perfect solution for any forecourt design.



### The Kraus Fleet Series dispenser

By providing a cost effective dispenser that does not compromise on performance and safety, Kraus continues to raise the bar. Featuring the industry leading MICON™ 500 CNG controller at the heart of its system, the Kraus Fleet Series dispenser is the ideal choice for both commercial and retail CNG fueling applications.

Encore® is a registered trademark of Gilbarco Veeder-Root. CRIND™ is a trademark of Gilbarco Veeder-Root. MICON™ is a trademark of Kraus Global Ltd.



# Drilling Lexicon

Oil & Gas Drilling Glossary

## EXHIBIT B

### Deluge System

Last Updated 3 months ago

#### Definition(s)

##### Deluge System

A sprinkler system employing open sprinklers attached to a piping system connected to a water supply through a valve that is opened by the operation of a detection system installed in the same areas as the sprinklers. When this valve opens, water flows into the piping system and discharges from all sprinklers attached thereto.

Source: Resolution A 900(19), Revised Guidelines for Approval of Sprinkler Systems Equivalent to that Referred to in SOLAS Regulation 11-2/12, 23 November 1995, International Maritime Organization Regulatory Guidelines

##### Deluge System

System to apply fire-water through an array of open spray nozzles by operation of a valve on the inlet to the system.

Source: ISO 13702 2015, Petroleum and natural gas industries — Control and mitigation of fires and explosions on offshore production installations — Requirements and guidelines, Second Edition, August 2015 Global Standards

#### See Also

• Preaction System

#### Lexicon Categories

- Legislation
- Regulations
- Regulatory Guidance
- Global Standards
- IADC Guidelines
- Well Control Institute

#### Recently Added Terms

- Training and Qualifications Committee
- "What If?" Analyses
- "C" Class Divisions
- "D" Circle
- (FES) Fire and Explosion Strategy

#### A-Z Index

## ABOUT US

### About Us

#### OPTIMA® Overview

OPTIMA® the innovator of the RigCooling® concept has built on its pioneering status in developing patented technology and advanced pumping services for the oil and gas E&P global market.

[Read more...](#)

#### What makes us better?

OPTIMA® Solutions is the first choice for major oil and gas companies requiring state of the art RigCooling® solutions.

[Read more...](#)

#### Who we work for

OPTIMA® works, in a variety of contractual relationships, with all the major oil & gas exploration, drilling and testing companies around the world. We are proud to have built up an enviable reputation for delivering best in class RigCooling® systems in this highly specialised and demanding industry.

[Read more...](#)

#### Our team

The OPTIMA® team is made up of a wide range of experienced individuals, all with a common goal - to contribute to the process of delivering our customers with best in class RigCooling® systems.

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- [What makes us better?](#)
- [Who we work for](#)
- [Our Team](#)
- [News](#)

RAM SALE NUMBER: 86557974  
RAM ACCOUNTING DATE: 20151221

INTERNET TRANSMISSION DATE:  
2015/12/18

SERIAL NUMBER:  
86/557974

Description	Fee Code	Transaction Date	Fee	Number Of Classes	Total Fees Paid
	7009	2015/12/18	275	4	1100