

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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In re Application of :

Sandivk Hyperion AB :

Serial No. 87/650,833 :

Filed: October 18, 2017 :

For Mark: HYPERION & Design :

RESPONSE TO OFFICE ACTION
DATED: MARCH 1, 2018

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BOX RESPONSES – NO FEE
Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

Attention: Janice L. McMorrow, Esq., Examining Attorney, Law Office 115

RESPONSE

This is a response by Sandivk Hyperion AB (“Applicant”) to the Office Action dated March 1, 2018 in connection with Application Serial No. 87/650,833 (the “Application”) for Applicant’s HYPERION & design mark (“Applicant’s Mark”).

AMENDMENTS

Identification of Services

Please amend the identification of goods and services in the Application as originally filed by substituting the following:

Class 3: Sharpening preparations, namely, abrasive paste; polish powder; abrasives as powders and slurries; flexible abrasives; Grinding preparations, namely, abrasive sand; polishing pastes and compounds; Corundum for use as an abrasive

Class 6: Alloys of common metal; hard alloys of common metal; common metals, unwrought or semi-wrought

Class 7: Power operated metal working machine tools, namely, milling, turning, boring and drilling tools and tool holders and inserts for such tools; parts of machines, namely, tools, sharpening wheels, grindstones; Electrical grinding wheel engines; Stropping machines; Blade sharpening stropping machines; Millstones; Continuous cutting knife tools, rotary cutting knives and tooling systems; Cemented carbide cutting tools; Machine tools, namely aperture knife tools

Class 8: Hand instruments, namely, abrading tools; sharpening wheels for blades; hand tools, namely, augers; sharpening wheels, hand operated scraping tools for mining, construction, agricultural and industrial wear applications; sharpening stones; knife steels; parts of hand tools, namely, bits

Class 9: Computerized electronic controllers for use in monitoring power-operated machine tools in hard and super hard materials applications; computer programs, and computer software all for the calculation of cutting data for machine tools in hard and super hard materials applications; remote control apparatus for power-operated machine tools to monitor cutting data, computer aided manufacturing software for hard and super hard materials applications; sensors; computerized electric integrated control systems for metal working machines and tools in hard and super hard materials applications; computer software for calculation of data collected in connection with machine working machines and tools in hard and super hard materials applications; computer software for increased machine working tool productivity in hard and super hard materials applications

Class 40: Recycling of carbide substrates; material treatment information; regrinding and recoating of tools and machines

Class 42: Design, maintenance and installation of computer software for monitoring all hard and super hard materials applications; consultancy relating to computer software for

monitoring all hard and super hard materials applications; design of machine tools and machines for metal working.

REMARKS

The Examining Attorney has requested that Applicant amend and clarify the identification of goods and services. The Examining Attorney also requested the Applicant address the likelihood of confusion refusal based on Registration No. 4218398 (the “398 Cited Registration” and Registration No. (the “556 Cited Registration”) (together, referred to as the “Cited Registrations”). In response to these issues, Applicant submits the above amendments and the remarks below.

I. Examining Attorney’s Identification Requirements Have Been Satisfied

The Examining Attorney has requested that Applicant amend the original identification of goods and services to further specify the types of goods and services to be offered under Applicant’s Mark. Applicant has now sufficiently addressed this requirement in the Amendments section above as requested by the Examining Attorney. In light of the Applicant’s amendments, it is respectfully submitted that the Examining Attorney’s requirement has been satisfied.

II. The Likelihood of Confusion Refusals Should Be Withdrawn

In the Office Action dated December 18, 2017 the Examining Attorney preliminarily refused to register Applicant’s Mark HYPERION & Design in Class 3 on the ground that it is allegedly confusingly similar to following 398 Registration:

- **HYPERION** – Reg. No. 4218398 (the “398 Registration”) - Class 3: *abrasive preparations for polishing, lapping, sawing, or grinding in the aerospace, power*

*generation, automotive, construction, renovation, electronic, glass, oil and gas,
mineral exploration, mining, tool and die, stone and woodworking industries*

In the Office action dated March 1, 2018, the Examining Attorney preliminarily refused to register Applicant's Mark in Class 42 on the ground that it is allegedly confusingly similar to following 556 Registration:

- **HYPERION** – Reg. No. 1624556 (the “556 Registration”) – Class 9: *Computer programs for use in financial data collection, consolidation and reporting.*

Applicant respectfully submits that the refusal should be withdrawn as the Applicant and the owner of the 398 Cited Registration were wholly-owned subsidiaries of Sandvik AB, the parent company, at the time of filing the application, and as such the refusal in Class 3 based on that registration should be withdrawn. Applicant also submits that the refusal in Class 42 based on the 566 Cited Registration should be withdrawn. The amended goods and services in the Application are vastly different from that in the 566 Registration so that confusion is not likely.

A. Likelihood of Confusion Does not Exist with Respect to the Class 3 Goods.

The Examining Attorney argues the Applicant’s Mark is likely to cause confusion with the 398 Cited Registration in Class 3. The Applicant respectfully avers that confusion is unlikely as at the filing of the application, the Applicant and the owner of the 398 Cited Registration were wholly-owned subsidiaries of Sandvik AB, the parent company. As held by the Court of Appeals for the Federal Circuit, “where the applicant is related in ownership to a company that owns a registered mark that would otherwise give rise to a likelihood of confusion, the examining attorney must consider whether, in view of all the circumstances, use of the mark by the applicant is likely to confuse the public about the source of the applicant's services because of the resemblance of the applicant's mark to the mark of the other

company." TMEP § 1201.07(a); citing In re Wella A.G., 787 F.2d 1549 (Fed. Cir. 1986). As was the case in In re Wella A.G., "in some limited circumstances, the close relationship between related companies will obviate any likelihood of confusion in the public mind because the related companies constitute a single source." *Id.*

Here, as wholly-owned subsidiaries of the same company, unity of control exists between the parties and parent company. See **Exhibit A**.¹ The Examining Attorney, pursuant to TMEP 1201.07(b)(iii), should thus accept that there is no likelihood of confusion. It is respectfully requested that the refusal in regards to the 398 Registration accordingly be withdrawn.

B. Applicant's Goods and Services are Sufficiently Different Coupled with the Sophistication of the Purchasers to Avoid Confusion with the 556 Cited Registration.

Likelihood of confusion is properly evaluated by considering several factors, with each case decided on its own facts. See In re E.I. DuPont DeNemours & Co., 177 U.S.P.Q. 563, 567 (C.C.P.A. 1973). Because application of the DuPont factors is fact-sensitive, some factors will be more dominant than others, while other factors may not apply. Here, the most relevant DuPont factors are: (i) the differences between Applicant's amended goods and services and the goods covered by the 556 Registration and (ii) the sophistication of the relevant consumers. In view of the foregoing, Applicant submits that there is no likelihood of confusion between Applicant's Mark and the mark covered by the 566 Registration. Accordingly, the Section 2(d) refusal should be withdrawn.

¹ The parent company's Annual Report is voluminous, and therefore the Applicant has provided only the relevant pages. The entire report may be viewed at <https://www.home.sandvik/globalassets/all-annual-reports/annual-report-2016/home/sandvik-annual-report-2016.pdf>.

The Examining Attorney has preliminarily refused to register Applicant's Mark in Class 42 on the ground that the applied-for mark is likely to be confused with the mark in the Cited 556 Registration. The Examining Attorney argues that the goods and services of both the Applicant and registrant are related because they are of a kind that emanate from the same source under the same mark. However, as part of a global settlement agreement between the Applicant and Registrant, the Applicant has amended its identification of goods and services in Classes 9 and 42. Accordingly, as discussed below, the subject matter of Applicant's Class 42 services are significantly different and unrelated from the Class 9 computer program goods in the Cited 556 Registration.

Applicant, as part of its comprehensive response, has amended its Class 42 identification of services to the following:

Design, maintenance and installation of computer software for monitoring all hard and super hard materials applications; consultancy relating to computer software for monitoring all hard and super hard materials applications; design of machine tools and machines for metal working.

Hard and super hard materials consist of matter that has a hardness value in excess of 40 gigapascal such as diamonds. See **Exhibit B**. Super hard materials, such as diamonds, are used in a wide range of industrial operations related to turning, cutting, drilling, boring and grinding. See **Exhibit C**. Essentially, the Applicant's computer software services are used in connection with large industrial cutting tools and machines as demonstrated on the Applicant's website. See **Exhibit D**. These services are vastly different from the goods of the registrant.

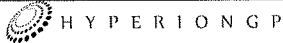
For instance, the software goods in the Cited 556 Registration are specifically for the collection, consolidation, and reporting of financial data. Such software is used for meeting regulatory requirements and ensuring the accuracy of financial data. See Exhibit E. Accordingly, the subject matter of the software in the 556 Registration is unequivocally different from the subject matter of the Applicant's design, maintenance, installation, and consulting services. The subject matter, industry, and use of the respective goods and services all are drastically different and unrelated. There is no connection between computer software used for financial data collection and reporting and services relating to computer software design, maintenance, installation, and consulting in the field of hard and super hard materials for industrial cutting and drilling use. As the respective subject matters and industries are different, consumers will not believe the goods and services of the Applicant and registrant emanate from the same source under the same mark.

This in and of itself is sufficient to dispel any likelihood of confusion because the goods and services must be "so related that they are likely to be encountered by the same persons under circumstances that would give rise to the mistaken belief that they originate from the same source." TMEP § 1207.01(a)(1). Conversely, if the goods or services in question are not related or marketed in such a way that they would be encountered by the same persons in situations that would create the incorrect assumption that they originate from the same source, then even if the marks are identical, confusion is not likely. See, e.g., Shen Mfg. Co. v. Ritz Hotel Ltd., 393 F.3d 1238, 1244-45, 73 USPQ2d 1350, 1356 (Fed. Cir. 2004) (reversing TTAB's holding that contemporaneous use of RITZ for cooking and wine selection classes and RITZ for kitchen textiles is likely to cause confusion, because the relatedness of the respective goods and services was not supported by substantial evidence); In re Thor Tech, Inc., 113 USPQ2d 1546, 1551

(TTAB 2015) (finding use of identical marks for towable trailers and trucks not likely to cause confusion given the difference in the nature of the goods and their channels of trade and the high degree of consumer care likely to be exercised by the relevant consumers).

Further, there is no rule that certain goods or services are per se related, such that there must be a likelihood of confusion from the use of similar marks in relation thereto. See TMEP § 1207.01(a)(iv). The issue is not whether the goods and services touch the same industry, but whether they are related in a manner that would lead consumers to believe that they originate from the same source. TMEP § 1207.01(a)(i). In this regard, to demonstrate the relatedness of goods/services and trade channels, the Trademark Manual of Examining Procedure requires the Examining Attorney to provide evidence such as news articles and/or evidence from computer databases showing that the relevant goods/services are used together or used by the same purchasers, or advertisements showing that the relevant goods/services are advertised together or sold by the same manufacturer or dealer. TMEP § 1207.01(a)(vi). Here, no such evidence has been provided. Thus, it should be presumed that the respective parties' goods and services are not related.

It should also be noted that the Cited 556 Registration currently co-exists with the following marks:

MARK	REG. NO.	GOODS AND/OR SERVICES
	4854986	Class 35: Assistance, advisory services and consultancy with regard to business planning, business analysis, business management, and business organization
HYPERION PILLAR	2073594	Class 9: computer programs for use in business applications, namely, budgeting, forecasting and

		planning
HYPERION	3779470	Class 36: banking services; on-line banking services; financial services, namely, arranging of loans, credit and loan services, financial loan consultation, individual retirement account services

The goods and services in the above registrations are all in the field of business and finance similar to the Cited 556 Registration. Accordingly, these marks are able to coexist despite containing similar wording. Indeed, similar, if not identical marks, may coexist on the register for goods or services even when they fall within the same overall industry, but that such spheres are sufficiently distinct so as not to be confused by consumers. This point was made clear in Reynolds & Reynolds Co. v. I.E. Sys., Inc., 5 U.S.P.Q.2d 1749, 1751 (T.T.A.B. 1987), where the Board found that the fact that both parties' services were computer-related was not sufficient to support a likelihood of confusion. As the Board stated, "in order to support a holding of likelihood of confusion, there must be some similarity between the goods and services at issue herein beyond the fact that each involves the use of computers. In view of the fact that computers are useful and/or are used in almost every facet of the world of business, commerce, medicine, law, etc., it is obvious that distinctions must be made." Id. Thus, because the applicant was offering a specific type of software for operational uses and the opposer was offering applications software aimed at a very narrow field, there was no likelihood of confusion. Id. at 1752. Likewise, the Board in In re Quadram Corp., 228 U.S.P.Q. 863, 865 (T.T.A.B. 1985) rejected a *per se* rule regarding source confusion "vis-a-vis computer hardware and software" as too rigid and restrictive and one that fails to consider the realities of the marketplace.

So, too, here. The specific software provided by the registrant and the specificity of the software services offered by the Applicant must be considered, and, in this case, they are specialized and distinct. The mere fact that Applicant's services are software related is not enough to support a likelihood of confusion with respect to the cited registration. The coexistence of the abovementioned registrations provides evidence that the USPTO did not consider the goods and services to be sufficiently related as to cause confusion in the marketplace. Therefore, Applicant's Mark should be approved for publication because the difference in the subject matter of the Applicant's and Registrant's goods and services is more distinct and unrelated than the goods and services offered by the three other coexisting registrations. If these three marks along with the registrant's mark have been permitted to coexist certainly Applicant's Mark should be accorded the same status especially in view of the significant differences in the subject matter of the goods and services being offered.

Moreover, in light of Applicant's amendment to the identification, there is even less – if any – overlap with the goods in the 556 Registration. See also, DivX, LLC. v. Chance-i USA Corp., Opp. No. 91178576, 2012 TTAB LEXIS 298, at *13 (T.T.A.B. Aug. 1, 2012) (“Opposer's mere assertion that the computer surveillance equipment available through applicant's online ordering services is related to its audio and video software, hardware and services is not sufficient to establish [that the goods and services are related].”); Pointivity v. ChannelVission, Canc. No. 92055731, 2015 TTAB LEXIS 563, *22 (T.T.A.B. Apr. 23, 2015) (the fact that Petitioner's and Respondent's services both involve cloud computing in some manner is not sufficient to find services related); Local Trademarks Inc. v. Handy Boys Inc., 16 U.S.P.Q.2d 1156 (T.T.A.B. 1990) (LITTLE PLUMBER for liquid drain opener not confusingly similar to LITTLE PLUMBER & Design for advertising services in the plumbing field). Applicant

respectfully requests that the Examining Attorney consider the amendment made to Class 42 in the identification of goods and services because it clearly differentiates the purpose, function, and subject matter of the parties' goods and services, and thereby obviates any likelihood of confusion.

C. The Parties' Respective Customers Are Sophisticated and Will Make Careful Purchasing Decisions.

Confusion between Applicant's and Registrant's mark is also unlikely because consumers of the respective goods and services are sophisticated and will make careful purchasing decisions. It is well settled that confusion is less likely where the goods are purchased with a certain amount of care and thought. Highly sophisticated and important goods, which are likely to be purchased only with care and deliberation after investigation to determine suitability for specific needs, are less likely to be confused than if the marks were both used to purchase over the counter items likely, for example, to be orally requested in retail stores. See, e.g., Toro Co. v. ToroHead, Inc., 61 U.S.P.Q.2d 1164, 1169 (T.T.A.B. 2001) (applicant's TOROMR for specialized component for computer disk writing and opposer's TORO for computer-based irrigation systems not likely to be confused where "applicant's customers [equipment manufacturers] would clearly be sophisticated purchasers and opposer's purchasers [professionals and residential homeowners] would often be sophisticated, too" such that "neither party's goods or services would normally be considered an impulse purchase"); Pignons S.A. de Mecanique de Precision v. Polaroid Corp., 657 F.2d 482, 489 (1st Cir. 1981) (sophisticated or discriminating purchasers may be expected to exercise greater care); see Clayton Mark & Co. v. Westinghouse Electric Corp., 148 U.S.P.Q. 672, 673 (C.C.P.A. 1966) (no likelihood of confusion between MARK 75 for circuit breakers as opposed to MARK for electrical conduits in

part because purchase of applicant's goods would be on a very discriminating basis, by individuals who not only know what they are buying and for what particular purpose, but also know the producer of such goods).

The sophistication of consumers has been repeatedly recognized as a factor that dispels confusion in the context of technology and software based goods. This is particularly true where the goods involved are relatively expensive and are purchased with a certain amount of care and thought. Info. Res., Inc. v. X*Press Info. Svcs., 6 U.S.P.Q.2d 1034, 1038 (T.T.A.B. 1988) (noting marked differences between opposer's goods, which are information analysis computer programs that are very specialized in nature, and applicant's news service available through cable television systems); see also In re Software Design, Inc., 220 U.S.P.Q. 662, 663 (TTAB 1983) (DOX for computer programming services and DOC'S for custom manufacture of computer systems held unlikely to be confused even though services are related on ground that services were sophisticated and likely to be purchased after careful investigation and deliberation); Pointivity, 2015 TTAB LEXIS 563 at*28 (notwithstanding that the marks at issue were identical, no confusion in part due to sophistication of consumers).

The Applicant's services are used by highly sophisticated industrial consumers. Specifically, technicians who used diamonds and cemented carbide for drilling, mining, and excavation matters. The consumers of registrant's goods are highly sophisticated financial professionals such as accountants and financial analysts. Therefore, these consumers will inform themselves and exercise care and deliberation in selecting the source of the goods and services as such must specifically address the needs of these consumers. A consumer seeking the goods and services provided by Applicant or the Registrant is not engaging in an impulse buy; rather, such

