

ARGUMENTS AGAINST LIKELIHOOD OF CONFUSION

On March 28, 2018, the Examining Attorney issued a second Office Action in which registration of the Applicant's mark "MATRIX" was refused based on the maintained assertion that the mark is confusingly similar to U.S. Registration No. 5197024 for the mark HEATMATRIX (the "Cited Mark"). This assertion, however, overlooks the differences in the marks, the commercial impressions, the difference in the goods, the different consumers, the discriminating and sophisticated purchasers, and the fact that there has been no actual confusion.

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

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

Applicant respectfully submits there is no likelihood of confusion between Applicant's mark and Registrant's mark for at least the reasons that the marks are different, the commercial impressions are different, the goods are different, the consumers are different, the purchasers are discriminating and sophisticated, and that there has been no actual confusion. In view of these differences, it is respectfully submitted that there is no likelihood of confusion.

Differences in the Marks

There are three reasons Applicant's mark is different from the Cited Mark. First, the first-encountered terms are different. Second, common term alone cannot create confusion. And finally, each mark provides a different overall commercial impression when considered with the respective goods.

First, the fact that the applied-for mark and the Cited Mark share a common portion should not create a likelihood of confusion. See, *General Mills v. Kellogg Co.*, 824 F.2d 622, 627, 3 USPQ2d 1442, 1445 (8th Cir. 1987). Instead, the proper comparison is between the overall commercial impressions of the marks as consumers view and remember them. *Long John Distilleries, Ltd. v. Sazerac*, 426 F.2d 1406, 166 USPQ 30 (CCPA 1970). Overall, the two marks are different. In particular, it is very relevant that a consumer first encounters a different element with each mark. See, *In re Shawnee Milling Co.*, 225 USPQ 747, 749 (TTAB 1985) (GOLDEN CRUST for flour held not likely to be confused with ADOLPH'S GOLD'N CRUST and design for coating and seasoning for food items) and *contra, Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 1372-73, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005).

Here, the situation is more akin to *In re Shawnee* than in *Veuve*. This is because different terms are encountered first. In *Veuve*, the two marks shared the same first term. That court found confusion. Conversely and similar to the marks at hand, in *In re Shawnee*, the

consumers encountered different first terms, which was significant in finding that there was no confusion. The fact that consumers encounter a different term first in Applicant's mark than in Registrant's mark is persuasive that there is no likelihood of confusion.

Second, marks must be considered in their entireties, not dissected into their components. *In re National Data Corp.*, 753 F.2d 1056, 1058, 224 USPQ 749, 750-51 (Fed. Cir. 1985). Registrant does not own the exclusive right to use the term MATRIX apart from its mark (HEATMATRIX) as a whole. If this were the case, HEATMATRIX should never have been registered, as there are several marks that precede its application that include the term MATRIX in this class, including but not limited to Registration No. 3410506 for MATRIX for dance floors (cited in the first Office Action). However, because the Cited Mark contains a different first term encountered by the consumer and the goods are different (as discussed infra), HEATMATRIX never even received an Office Action and was able to register. Just like the following marks were found not confusingly similar, so too should the Cited Marks and Applicant's mark:

Not Confusingly Similar¹ (first mark v. second mark)

CORN-ROYAL v. ROYAL² (both for oils and food items) (word v. word)

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

KEYCHECK, KEYBANKER v. KEY³ (all in the financial industry) (word v. design)

SOLENA v. CASA SOLENA⁴ (both for Mexican food) (word v. word & design)

PATIO (Mexican-style food) v. TAPATIO⁵ (for sauce) (design v. word)

ALL v. ALL CLEAR⁶ (both household products) (word v. design)

SILK v. SILKSTICK⁷ (both beauty products) (word v. word)

SILK'N'SATIN v. SILK⁸ (both beauty products) (word v. design)

JET AERATION v. AEROB-A-JET⁹ (both waste water treatment) (design v. word)

ROMAN v. ROMANBURGER¹⁰ (both for food) (design v. word)

VARGAS v. VARGA GIRL¹¹ (both for calendars) (word v. word)

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

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

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

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

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

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

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

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

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

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

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

Third, the Applicant's mark and the Registrant's mark each provide separate and distinct overall commercial impressions to the consumer. TMEP §1207.01(b)(v). The goods are relevant in constructing the meaning of the mark (i.e., the commercial impression). See, e.g., *In re Sears, Roebuck & Co.*, 2 USPQ2d 1312, 1314 (TTAB 1987). The Board in *In re Sears* held that upon consideration of the goods sold under each mark, CROSS-OVER for bras was not likely to cause confusion with CROSSOVER for ladies' sportswear because CROSS-OVER was suggestive and CROSSOVER was arbitrary to the respective goods sold under each mark. Applying the same concept here, when considering Registrant's products, an optional product installed underneath traditional flooring that heats the above flooring itself, is actually in a grid-like matrix, requires electrical components and wiring – one can see the HEATMATRIX mark is suggestive of the goods. Applicant's mark, on the contrary, has no suggestive meaning when considering the traditional flooring product as its goods are not and do not include a grid-like matrix pattern. As such, Applicant's mark is arbitrary and should be afforded stronger protection.

Here, when one considers the goods sold under each mark, the Cited Mark is suggestive and the Applicant's mark is arbitrary. While suggestive marks are registerable, they are not afforded the same weight as arbitrary marks. TMEP §1207.01(b)(viii). Thus, just like in *In re Sears*, there is no likelihood of confusion because the suggestive Cited Mark is weak compared to Applicant's arbitrary mark.

Thus, consideration of the Cited Mark in its entirety clearly demonstrates that it is quite different in appearance, sound, connotation, and commercial impression than the Applicant's mark.

Differences in the Goods

The goods associated with Applicant's mark and the Cited Mark are sufficiently different to eliminate any likelihood of confusion. Applicant respectfully submits that Examiner's understanding of "flooring underlayment" goods is not fully informed. While it is true that flooring is composed of many different layers, it is not true that "flooring underlayment" is a type of "flooring."

Instead, it would be accurate to say that "flooring underlayment" products are used with or are optional accessories to flooring. The two types of products are not interchangeable, are separate and discrete, and traditionally not made by the same provider. Further, unlike traditional flooring products, Registrant's products are generally not seen by the ultimate end-users (as discussed *infra*). Instead, the end-users of Registrant's products most likely simply ask their contractor for "heated floors" – regardless of brand – and the discriminating contractor purchaser is the only party exposed to Registrant's brand.

A similar analogy would be clothing. There are several possible layers of clothing, including underwear, shirts, pants, sweaters, coats, etc. Here, "flooring underlayment" goods are akin to underwear. Whereas Applicant's traditional flooring goods are akin to shirts and pants. While Applicant cannot argue that the goods are not broadly related, the respective goods are different enough to reduce, if not eliminate, any likelihood of confusion. A consumer would understand in our analogy that underwear goods are not a replacement for pants and shirts. Further, the Registrant's goods are optional, just like underwear.

Registrant's Goods



Applicant's Goods



One can go out *without* underwear, and one should not go out with *only* underwear. Similarly, one can go *without* flooring underlayment goods, and one should not have *only* flooring underlayment goods.

Further, Registrant's heating grids are specialized products that your average consumer would most likely not encounter. Instead, as discussed *infra*, the Registrant's products are purchased by knowledgeable flooring and construction contractors who know and understand the different layers of products in flooring construction.

Were the ordinary consumer to encounter Applicant's goods and the Cited Mark's goods, there is little or no possibility of confusion between Applicant's traditional flooring products on the one hand, and the specialized, optional under-layer of Registrant's products.

Different, Discriminating, and Sophisticated Purchasers

Another principal factor to be considered in determining whether there is a likelihood of confusion under Section 2(d) is the conditions under which, and buyers to whom, sales are made (i.e., "impulse" versus careful, sophisticated purchasing). Here, the Cited Mark's consumers are different, discriminating, and sophisticated purchasers.

First, Applicant's and Registrant's consumers are different. Consumers wanting to purchase new floors are different than consumers wanting to purchase *heated* floors. The later being an optional upgrade that adds cost, time, and expertise in installation. Not every consumer wants a heated floor or can afford a heated floor. As such, the Cited Mark's consumers are different.

Second, as TMEP §1207.01(d)(vii) states, circumstances suggesting care in purchasing may tend to minimize likelihood of confusion. The Cited Mark's customers are sophisticated due to the specialized nature of the goods, the process, and the expense involved in obtaining the Registrant's products, as well as, who the purchasing consumer is. "In making purchasing decisions regarding 'expensive' goods, the reasonably prudent person standard is elevated to

the standard of the ‘discriminating purchaser.’” J. Thomas McCarthy, *McCarthy on Trademarks*, §23:96, (4th ed.1998). See, e.g., *Magniflux Corp. v. Sonoflux Corp.*, 231 F.2d 669, 671, 109 U.S.P.Q. 313, 315 (C.C.P.A. 1956) (“confusion is less likely where goods are expensive and purchased after careful consideration”).

Here, Registrant’s goods are optional products, not required when installing floors. Not every consumer looking for floors want (or can afford) heated floors – Registrant’s products. Registrant’s optional products add significant expense to getting new floors – an already expensive purchase. Upon review of the costs associated with simply purchasing (not including installing) Registrant’s goods, it is clear they are expensive. One 161 sq. ft. mat of Registrant’s products costs \$360. See https://www.homedepot.com/p/SunTouch-Floor-Warming-HeatMatrix-161-sq-ft-Uncoupling-Membrane-Mat-8006GRY161-ST/300723831?cm_mmc=Shopping%7CG%7CBase%7CAI-Products%7CAI%7CAI%7CPLA%7c71700000014585962%7c58700001236285396%7c92700010802552373&gclid=Cj0KCQjwof3cBRD9ARIsAP8x700TxHzrLH9QgcRqnJcCRPssM8wMB5V2yG0OWFDLgR7yx8N0kr61PGwaAjcdEALw_wcB&gclsrc=aw.ds&dclid=CLX5zpr4wt0CFQ5TwQod3FqFlg. Further, the consumer would need to also purchase the heating wire, which costs \$546 for 140 sq. ft. See <https://www.homedepot.com/p/SunTouch-Floor-Warming-WarmWire-140-sq-ft-240-Volt-Radiant-Heating-Wire-240140WB-RST/303995990>. Finally, a consumer would also need to purchase a thermostat to control Registrant’s product, which costs another \$170. See <https://www.homedepot.com/p/SunTouch-Floor-Warming-SunStat-Command-Programmable-Floor-Heating-Thermostat-500850-SC/206695559>. All these costs are just for the materials and do not include the additional expertise, time, and costs to install the optional heated flooring grid. Due to the high expense, Registrant’s consumers should be held to the ‘higher discriminating purchaser’ standard. They can be presumed to make their purchases only after careful investigation.

Finally, the level of sophistication of prospective customers is relevant. See, *Polaroid Corp. v. Plarad Elcs. Corp.*, 287 F.2d 492, 495 (2d Cir.), *cert. denied*, 368 U.S. 820 (1961); and *Med Data Cent., Inc. v. Toyota Motor Sales, U.S.A., Inc.*, 875 F.2d 1026, 1036-37 (2d Cir. 1989). “Where the [] consumers are sophisticated, there is a reduced likelihood that the junior mark will blur the senior mark’s selling power.” *Mead Data*, 875 F.2d at 1036 (where the mark LEXUS for cars was unlikely to cause confusion with LEXIS for legal service because the market for LEXIS was mostly lawyers and accountants who are sophisticated consumers.)

Registrant’s products are specialized ones that are most likely not installed by your average consumer. Instead, a trained flooring contractor skilled in heated floor elements would most likely be Registrant’s consumer. As such, the ultimate end-user (i.e., the homeowner) does not pick out the pattern, color, material, or brand to accomplish their desire for heated floors. Instead, it is the knowledgeable skilled contractor making the discussion on what heated flooring element(s) to use. This would be similar to a future homeowner working with their contractor on building their brick home, the homeowner does not ask for a specific brand of brick, but they instruct their knowledgeable contractor to build the home with brick. It is the contractor who sees the brick brands and options and makes the ultimate decision to deliver on the homeowner’s request. Here, the Registrant’s customers and prospective customers are very sophisticated professionals, just like the consumers of LEXIS brand products and services. The end-users of Registrant’s goods are interested in accomplishing a goal (i.e., heated flooring), which Registrant’s actual consumers (the contractors) review and choose to fit the end-users specific needs. Thus, the Registrant’s prospective consumers are sophisticated and held to a higher standard for determining likelihood of confusion.

As the Cited Mark's customers should be deemed different, discriminating, and sophisticated, these weigh against likelihood of confusion.

No Actual Confusion

Applicant submits it has been using the mark in connection with its goods for over one year in over 100 direct-to-consumer stores with no known instances of actual confusion. While perhaps not an overly significant amount of time, this nevertheless should weigh against likelihood of confusion.

De Minimis Potential Confusion

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

Conclusion

In view of the above-noted clear and distinct differences in the marks, commercial impressions, the goods, the different consumers, the discriminating and sophisticated purchasers, and no actual confusion, consumer confusion would continue to be extremely unlikely. Simply stated, Applicant's and Registrants' worlds would never collide.

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