

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

Application No.: 88105272  
Applicant: Contour Hardening, Inc.  
Filing Date: September 5, 2018  
Law Office: 111  
Examiner: Douglas M. Lee  
Attorney Docket No.: 8022-238  
Mark: CONTOUR

**RESPONSE TO OFFICE ACTION**

BOX RESPONSE NO FEE  
Commissioner for Trademarks  
P.O. Box 1451  
Arlington, VA 22313-1451

Dear Sir:

In response to the Office Action emailed December 18, 2018, reconsideration is respectfully requested in view of the following amendments and remarks.

**AMENDMENT**

Please amend Applicant's description of services in Class 40 to the following:

“treatment of materials, namely processing forged or machined metal parts for the automotive, aerospace, heavy truck and agricultural industries to increase surface hardness.”

**REMARKS**

The Office Action preliminarily rejects the present application under §2(d) alleging that there is a likelihood of confusion between Applicant's mark and Registration No. 4,491,460 for CONTOUR PRECISION with a ribbon design as shown:



citing the services of “treatment of materials for the manufacture of machine tool goods.”

Applicant respectfully submits that the differences between the marks, the difference between the respective services, and the sophistication and high degree of respective consumer care support that there is no reasonable likelihood of confusion. Applicant requests that the refusal to register be withdrawn.



### **The Commercial Impressions Are Different**

As acknowledged in the Office Action, the cited registration is a design based mark which differs from Applicant’s mark by the inclusion of the word PRECISION and the stylized ribbon design. The Office Action discounts the differences, arguing that CONTOUR is the dominant portion of the cited registration. Applicant respectfully submits that discounting the differences so much as to effectively ignore them is incorrect. The differences should be given more weight, and the cited registration should be interpreted more narrowly than as interpreted in the Office Action.

By filing for a design based mark, the registrant chose to emphasize the visual aspects which need to be considered as significant in evaluating the overall commercial impression of the CONTOUR PRECISION and design mark. For instance, the ribbon graphic is larger than the word CONTOUR, making it also a distinctive feature. Similarly, the slanted angle and font of the word CONTOUR and the proportional size and placement of the word PRECISION contribute to the overall impression.

Further, the word “Contour” is relatively common, indicating that it should be interpreted more narrowly. There are multiple “Contour” based marks in class 40 in the USPTO database.

Of particular note is the coexistence of CONTOUR PRECISION & DESIGN and CONTOUR CUT & DESIGN, both for “treatment of materials”<sup>1</sup>:

TM/AN/RN/Disclaimer	Status/Key Dates	Full Goods/Services	Owner Information
<p><a href="#">CONTOUR CUT and Design</a></p>  <p>RN: 4378089 SN: 79109850 Disclaimer: "CONTOUR CUT"</p>	<p>Registered August 6, 2013 Filed: October 31, 2011 Registered: August 6, 2013 Int'l Reg Date: October 31, 2011</p>	<p>(Int'l Class: 07) [Omitted] (Int'l Class: 09) [Omitted] (Int'l Class: 37) [Omitted] (Int'l Class: 40) treatment of materials, namely, welding, cutting, joining, aligning, coating spraying, marking, inscribing and thermal heat treatment; cutting of materials suitable for cutting by plasma and laser cutting technique; soldering; consultancy in the field of treatment of materials, namely, plasma cutting, welding, joining, aligning, coating, spraying, marking, inscribing of materials and thermal heat treatment</p>	<p>Kjellberg Stiftung, Rechtsfähige Stiftung Des Bürgerlichen Rechts (No Country Provided) Schloßstraße 6 C 03238 Finsterwalde Federal Republic of Germany</p>
<p><a href="#">CONTOUR PRECISION and Design</a></p>  <p>RN: 4491460 SN: 85303427 Disclaimer: "PRECISION"</p>	<p>Registered March 4, 2014 Int'l Class: 40,42 First Use: July 22, 2013 Filed: April 25, 2011 Registered: March 4, 2014</p>	<p>(Int'l Class: 40) custom manufacturing and production services for others in the field of machine tools; treatment of materials for the manufacture of machine tool goods (Int'l Class: 42) engineering services for others in the field of machine tools</p>	<p>Contour Precision Group, LLC (North Carolina Limited Liability Company) 1050 Huffman Way Clover South Carolina 29710</p>

The USPTO’s approval of both registrations (and other CONTOUR based registrations) supports that there is no likelihood of confusion even if these marks coexist. *See, In re Hartz Hotel Services, Inc.*, 102 USPQ2d 1150, 1153-54 (TTAB 2012) (precedential) (finding GRAND HOTELS NYC not likely to cause confusion with the mark GRAND HOTEL for the same services in light of numerous uses of the wording "grand hotel," inferring that the Trademark Office has historically registered "grand hotel" marks "to different parties so long as there has been some difference, not necessarily created by a distinctive word, between the marks as a

<sup>1</sup> The Certificate for Reg. No. 4,378,089 is submitted herewith.  
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whole.”) The cited registration should be interpreted more narrowly than is asserted in the present Office Action. Specifically greater weight should be given to the differences between Applicant’s mark and the cited registration when comparing the marks in their entireties.

### **The Services Are Different**

“[T]he burden is on the Trademark Examining Attorney to prove that there in fact is an overlap or similarity in purchasers and trade channels.” *In re Band-it-IDEX, Inc.* 2009 TTAB LEXIS 659 \*16 (TTAB Oct. 20, 2009). The Office must show, “that circumstances surrounding the marketing of the respective goods would result in relevant purchasers mistakenly believing that the goods originate from the same source when the same mark is used on both types of goods.” *In re Princeton Tectonics*, 2010 TTAB LEXIS 224 \*3 (TTAB June 10, 2010).

The Office Action asserts that applicant’s and registrant’s services are related. The Office Action bases its premise solely on the rationale that:

In the present case, applicant’s services are closely related to registrant’s services because they are both treatment of material services and registrant’s broadly worded services are not limited as to the type of materials treated or how it is treated. As such, registrant’s services would encompass applicant’s services. While registrant’s services are for the manufacture of machine tool goods, it is noted that applicant’s services are not limited to any particular field.

No evidence is cited. Addressing this argument, Applicant has amended its services to a particular field, specifically, “treatment of materials, namely processing forged or machined metal parts for the automotive, aerospace, heavy truck and agricultural industries to increase surface hardness.”

Applicant submits that services for the manufacture of machine tools and materials for machine tools are significantly different than processing forged or machined metal parts for the automotive, aerospace, heavy truck and agricultural industries to increase surface hardness. The

respective channels of trade are different and the market for each of the respective services involves sophisticated consumers.

The cited registration is for producing machine tools or materials/components for machine tools. Machine tools are used in manufacturing. Thus, the customers and the natural channels of trade for the services in the cited registration are manufacturing companies. Specifically, services related to machine tools and components for machine tools are provided to manufacturing companies who then use the tools in the production of further goods.

In contrast, Applicant's services are for processing forged or machined metal parts to increase surface hardness. Specifically, Applicant processes metal parts which are finished goods, which are used in the automotive, aerospace, heavy truck and agricultural industries. The channels of trade are to customers who may use the hardened product as an end product or as a component of an end product.

Still further neither Registrant's nor Applicant's services are purchased impulsively. Machine tools are often expensive mechanical components which must function correctly or there is a risk of ruining the manufacturing process and/or manufactured goods. Correspondingly, great care must be exercised by trained and skilled individuals to ensure the proper selection and use of the machine tools.

Comparably yet separately, the automotive, aerospace, heavy truck and agricultural industries are complex highly technical industries. Metal parts used in those industries often must meet precise technical specifications. Selecting and using such parts requires care to ensure proper size, type and compatibility, and often requires the assistance of expert, trained personnel to ensure proper selection and use. Hence, consumers are forced to exercise a high degree of care. *See, In re Hyundai*, 2009 TTAB LEXIS 598 \*13 (TTAB 2009).

For both Registrant and Applicant, it can be safely assumed that the relevant purchasers, “are knowledgeable and careful consumers who exercise a high degree of care” when purchasing such goods. *In re RAM Oil, Ltd., LLP*, 2009 TTAB LEXIS 586 \*14 (TTAB 2009) (“safely assuming” that potential purchasers of goods and services which “by their very nature are unusual, complex and expensive,” “are knowledgeable and careful consumers who exercise a high degree of care”.)

### **Conclusion**

Applicant respectfully submits that the differences in the overall commercial impressions coupled with the differences in the respective services and the sophistication and high degree of respective consumer care supports that there is no reasonable likelihood of confusion between Applicant’s mark and the cited mark. Applicant respectfully requests withdrawal of the rejection. Applicant accordingly submits that the mark is in condition for publication and allowance, and action towards such is respectfully requested. If there are any questions with regard to the application or this response, the Examining Attorney is invited to telephone the undersigned to expedite this application.

Respectfully submitted

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