

RESPONSE

This filing is in response to the Office Action mailed November 19, 2018 in which the Examining Attorney initially refused registration of Application Serial No. 88049459 for the mark SKYLINE (“Applicant’s Mark”) based on Trademark Act Section 2(d), 15 U.S.C. §1052(d); *see* TMEP §§1207.01 *et seq* as more fully described below.

REMARKS

I. APPLICANT’S MARK IS NOT LIKELY TO CAUSE CONFUSION WITH THE CITED MARK

Registration of Applicant’s Mark, SKYLINE, for “Firearm attachments and accessories, namely, mounts for attaching telescopic sights to firearms, scope mount bases being attachments for rifle scope rings and firearm scope rings” in International Class 013 has been refused by the Examining Attorney over the Cited Mark, SKYLINE, for the goods of “Telescope accessories, namely, laser pointers, brackets for laser pointers, collimation systems, namely, a specialized bracket that enables the use of the laser pointer as a telescope collimator” in International Class 9, and “Optical goods, namely, telescopes, and telescope accessories, namely, laser pointers, brackets for laser pointers, collimation systems, namely, a specialized bracket that enables the use of the laser pointer as a telescope collimator” in International Class 9.

The Applicant respectfully submits that there is no likelihood due to the goods being unrelated and other factors below. In determining whether there is a likelihood of confusion, the court in *In re DuPont De Nemours & Co.*, 476 F.2d 1357, 177 U.S.P.Q. 563 (C.C.P.A. 1973) listed a number of factors to consider in making such a determination. The Examiner points out only two of these factors: The similarity of the marks and relatedness of the goods. Applicant

submits that when all of the *DuPont* factors are considered, the goods are sufficiently dissimilar to eliminate a likelihood of confusion.

Specifically, Applicant submits that careful consideration of several *DuPont* factors, such as:

- A. The conditions under which and buyers to whom sales are made, i.e. “impulse” vs. careful, sophisticated purchasing; and
- B. The dissimilarity and nature of likely to continue channels of trade
- C. The dissimilarity of the goods;

weigh toward a finding of no likelihood of confusion between the Applicant’s Mark and the Cited Mark.

A. The Buyers to Whom Sales are Made are Both Careful and Sophisticated with Regard to the Cited Mark

It is well established that, when consumers are sophisticated and the goods are expensive, confusion is less likely. *See, e.g., Astra*, 220 U.S.P.Q. at 790 (“[T]here is always less likelihood of confusion where goods are expensive and purchased after careful consideration.”); *Bristol-Myers Squibb v. McNeil-P.P.C, Inc.*, 24 U.S.P.Q .2d 1161, 1170 (2d Cir. 1992) (“Generally, the more sophisticated and careful the average consumer of a product is, the less likely it is that similarities in trade dress or trade marks will result in confusion concerning the source or sponsorship of the product”). Thus, where the goods provided under a mark are: 1.) expensive and/or purchased only after careful deliberation, *see, e.g., MCCARTHY* § 23:96 (“If the goods are expensive, the reasonably prudent buyer does not buy casually, but only after careful consideration. Thus, confusion is less likely than where goods are cheap and bought casually.”);

or 2.) purchased by professional consumers, *see, e.g.*, MCCARTHY § 23:101; confusion is less likely to result.

The cost associated with the goods of the Registrant is substantial. The primary purchasers of the goods are those who own precision firearms and optical sights. Even if sight mounts were considered low cost, the purpose is to be installed on what would be a high-cost scoped rifle or other firearm. Similarly, accessories for pointing telescopes that may be expensive optical instruments are also likely to involve attentive and careful purchasers making well-researched decisions. It is well settled that confusion is less likely where the goods “are relatively expensive items purchased with a certain amount of care and thought, rather than inexpensive items purchased on impulse.” *Information Res. Inc. v. X*Press Info. Serv.*, 6 U.S.P.Q.2d 1034, 1039 (T.T.A.B. 1988). It goes without saying that these types of goods are not purchased on impulse. The products of the Registrant (and those of the cited registrations owner) are purchased by knowledgeable, experienced, and discerning military buyers after careful consideration. The goods of the Applicant are less specialized (holsters), appealing to consumer hunting and shooting markets.

In the instant case, the expensive goods provided under the Registrant’s Mark are purchased only after careful deliberation by highly sophisticated and professional buyers. Thus, the goods provided by the Registrant, ***by their very nature*** are not usually purchased impulsively. Thus, neither Applicant’s Mark nor the Cited Mark run the likelihood that consumers will confuse the origin of the goods.

Given the sophistication of the purchasers of the goods of the Cited Mark, it is clear that there is no likelihood of confusion present. When these elements are taken together, it is evident

that Applicant's Mark is not confusingly similar to the Cited Mark, and Applicant's Mark is registrable.

B. The Dissimilarity of Trade Channels and the Purchase Process Points to no Likelihood of Confusion

Applicant's trade channels are retailers and distributor of firearms and riflescopes, and the consumers who purchase the Applicant's goods are shooters and hunters. The Applicant's SKYLINE sight mounts are sold online on Applicant's website as well as online retailers and brick and mortar gun stores.

The Registrant's goods of "Telescope accessories, namely, laser pointers, brackets for laser pointers, collimation systems, namely, a specialized bracket that enables the use of the laser pointer as a telescope collimator", and "Optical goods, namely, telescopes, and telescope accessories, namely, laser pointers, brackets for laser pointers, collimation systems, namely, a specialized bracket that enables the use of the laser pointer as a telescope collimator" are specific to an amateur astronomer and telescope owner.

The trade channels in which the Applicant's and Registrant's goods travel do not overlap. The target consumers of the Applicant and Registrant are different consumers, who use the different goods for different applications and who obtain or purchase the goods in different manners. Applicant is unaware of ANY retailer who carried both sight mounts for shooters and laser pointers for astronomers.

C. The Applicant's Goods Are Not Similar To The Goods Of The Cited Mark.

The Examiner cites several cases for the principle that goods need not be identical to find a likelihood of confusion. Applicant acknowledges the principle, but disputes that it applies to

goods as unrelated as marketing services for military gear and consumer handgun holsters. The Office action cites *On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 1086, 56 USPQ2d 1471, 1475 (Fed. Cir. 2000); *Recot, Inc. v. Becton*, 214 F.3d 1322, 1329, 54 USPQ2d 1894, 1898 (Fed. Cir. 2000) for the principle that goods and services of the parties need not be identical or directly competitive to find a likelihood of confusion.

The cited case is distinguishable from the instant situation because the goods and services in *On-line Careline* were, unlike the instant situation, very closely related: One mark was for “providing access to online computer services offering computer industry news, commentary, and product reviews”, and the competing mark was for “services in nature of interactive advice and counseling via computer usage over telephone lines”. These are very similar goods to be used principally, perhaps exclusively, by the same people (internet users in approximately 1993) which enhances the likelihood of confusion in the mind of the consumer. In 1993, the ruling that an online service is similar goods to an internet service provider is sensible; at that time, the internet and its services were not as pervasive as the present and the limited universe of such services would naturally give the consumer a very narrow view of the relationship between the two distinct goods.

In contrast, Applicant's goods are very different from that of the Registrant, and although both involve pointing something at something else with some adjustable accuracy, the similarity ends at this superficial level that does not rise to the level of related goods.

Applicant's goods are mounted for a firearm, while registrant's are mounted to a telescope – unrelated goods having unrelated functions.

Applicant's goods support a facility for transmitting an image to be viewed by the user (i.e. riflescope) while registrant's goods support an illuminator that simply projects a beam.

The cited evidence appears to best support the notion that laser pointers (aiming devices) are used on firearms. Applicant does not dispute this, not even whether scope mounts are related to laser aiming devices, or whether laser aiming devices are related goods to telescope laser aiming devices. But there is no precedent to suggest that two goods are related only if they are related to a common good. The action and the case law do not support such a rejection.

It is believed that nothing in the record supports the expectation that an entity making firearm scope mounts also makes astronomy accessories. It might be argued that telescopes and riflescopes are related because both are optical imaging device that magnify and provide viewing of a distant scene in spite of their very different purposes. However this does not even make laser pointers and rifle scopes related, nor does it make telescopes and mechanical firearm mounts related. Nor, as in the case at hand, does it suggests that astronomical laser pointers and firearm scope mounts are related goods.

For the above reasons, the rejection is traversed and allowance is respectfully requested.

CONCLUSION

Applicant has addressed all outstanding issues raised by the Examining Attorney. Applicant respectfully requests that the application be approved for publication and requests that the Examining Attorney take such action.