


**BODY OF RESPONSE TO LIKELIHOOD OF CONFUSION REFUSAL**

In the initial Office Action, dated September 29, 2018, the Examining Attorney refused registration of the subject application for Applicant’s RENEGADE & Design mark:

**RENEGADE**

, Serial No. 88/037,251 (the “Application”), under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the grounds that it is likely to cause confusion with the following three United States Trademark Registrations:

	<b>Reg. No.</b>	<b>Mark</b>	<b>Goods/Services</b>
1	2,737,027		<u>Class 011</u> . Lights and light accessories, all for motorcycles, namely, passing lights, brackets for passing lights, rear lights, indicator lights, protection grills for lights, and visors for lights. <u>Class 012</u> . Accessories, spare parts and hard parts, all for motorcycles, each made of chrome plated steel or stainless steel, namely, protection parts, trim parts, luggage racks, foot rests, wheel covers, brake covers, fender trim, sissybars, engine covers, and engine guards.
2	4,443,350	RENEGADE	<u>Class 007</u> . Riding and walk-behind floor scraper, polisher, scarifier, and shot blaster.
3	4,298,302	RENEGADE	<u>Class 011</u> . Ceiling fans.

(each a “Cited Mark” or “Cited Registration,” and collectively, the “Cited Registrations”).

Further, the Examining Attorney indicated that the description of goods contained goods that are overbroad and can exist in multiple classes, and therefore must be clarified and reclassified. In response, Applicant herewith amends the goods identification and reclassifies the requested goods, as well as traverses each of the initial § 2(d) refusals. Applicant submits that this Response resolves the issues identified in the Office Action, and respectfully requests reconsideration.

Applicant is making significant changes to the identification of goods in the Application in connection with this Response. Therefore, if and to the extent that there may still be a

likelihood of confusion issue, Applicant requests clarification of the goods with which the Examining Attorney believes that confusion is still likely after review of this Response and in light of the amendments made herewith.

**I. Classification of Goods**

As a preliminary matter, the Application was filed under § 44(d) based on a Canadian application. The Canadian Trademark Office currently does not separate goods and services into classifications based on the Nice Classification system. Applicant herewith amends the Application to conform to United States practices and the Nice Classification system, as required by the Examining Attorney. After amendment, the full description of goods in the Application will read:

Class	Goods
006	<b><u>Metal chests</u></b> ; jobsite boxes <b><u>namely metal storage container for tools</u></b> ; bolt bins, <b><u>namely, general purpose metal storage bins</u></b> ; <b><u>metal ladders</u></b> ; <b><u>metal step stools</u></b> ; <b><u>tool boxes of metal, empty</u></b> ; Work supports, namely, <b><u>metal</u></b> casters; <b><u>metal</u></b> fencing panels, safes.
007	<del>Snow throwers; Work supports; work platforms, sump pumps</del>
008	<b><u>Tool holders, namely, magnetic socket set holders</u></b> ; snow roof rakes.
011	Lighting, namely, <del>electric light bulbs</del> , portable or stand work lights, <b><u>namely, LED flood lights and LED work lights for construction settings</u></b> ; flood lights, flash lights, fire rings <b><u>in the nature of outdoor fire pits</u></b> .
012	Mechanics' creepers and car creepers; <b><u>dollies</u></b> ; <b><u>automotive aftermarket parts, namely, truck storage box</u></b> ; <b><u>racks and stands specifically designed to hold tires</u></b> .
016	<b><u>Magnetic decals, namely, magnetic tool storage labels</u></b> .
019	<b><u>Non-metal fencing panels</u></b> ; laminate flooring; hardwood flooring; engineered <b><u>hardwood</u></b> flooring; <b><u>engineered flooring, namely, interlocking plastic flooring tiles</u></b> ; vinyl flooring; slate flooring; <del>flooring installation accessories; flooring installation kits; flooring installation tools</del> ; flooring underlayment, <b><u>namely, underlay for laminate flooring</u></b> , rubber garage flooring, rubber stair treads.
020	Tool storage and garage storage, namely, <b><u>metal</u></b> mechanics tool storage cabinets; <b><u>metal storage cabinets</u></b> ; <b><u>non-metal ladders</u></b> ; <b><u>non-metal step stools</u></b> ; <b><u>shelves</u></b> ; <b><u>storage racks</u></b> ; <b><u>storage drawers and chambers as furniture parts</u></b> ; <b><u>lockers</u></b> ; <b><u>filing cabinets</u></b> ; garage storage <b><u>namely, storage cabinets, job boxes, and tool chests</u></b> ; <b><u>work benches</u></b> ; <b><u>tool boxes, not of metal, empty</u></b> ; <b><u>non-metal casters</u></b> .

(the "Amended Goods").

## II. Likelihood of Confusion

Before beginning an analysis of the factors used in a likelihood of confusion case, it should be clearly understood exactly what level of confusion the Lanham Act proscribes. The Lanham Act is not concerned with a mere chance or possibility of confusion. *Estee Lauder, Inc. v. Gap, Inc.*, 42 USPQ2d 1228, 1233 (2d Cir. 1997) (“[I]t is not sufficient if confusion is merely ‘possible.’”) (citing 3 J. McCarthy, *McCarthy on Trademarks and Unfair Competition* § 23:2, at 23-10,11 (1996)). The risk of confusion must be probable before a likelihood of confusion can exist. *See Electronic Design & Sales, Inc. v. Electronic Data Systems Corp.*, 21 USPQ2d 1388, 1391 (Fed. Cir. 1992) (“We are not concerned with mere theoretical possibilities of confusion...”). Some courts have even stated that the Lanham Act requires a “substantial likelihood” of confusion before the statute is violated. *See, e.g., Fisher Stoves, Inc. v. All Nighter Stove Works, Inc.*, 206 USPQ 961, 962 (1st Cir. 1980); *WSM, Inc. v. Hilton*, 221 USPQ 410, 417 (8th Cir. 1984). Accordingly, a rejection based only on a mere possibility of confusion is not appropriate. There must be a real, genuine, and probable likelihood of confusion for the rejection to be proper. Applicant respectfully submits that such is not the case with respect to any of the Cited Registrations.

Turning now to the alleged likelihood of confusion between Applicant’s Mark and the Cited Marks, the Examining Attorney set forth two of the most important factors out of the thirteen plus factors provided by the seminal case, *In re E. I. du Pont de Nemours & Co.*, 177 USPQ 563 (CCPA 1973). Specifically, the Examining Attorney discussed the similarity of the marks and the similarity of the services. Applicant submits that the relevant *du Pont* factors weigh against a finding of a likelihood of confusion in each case and respectfully requests withdrawal of the § 2(d) refusals.

**a. Similarity of the Marks**

Applicant does not dispute that the applied-for mark and the marks within the cited Registrations are identical in their literal elements. Applicant's mark is RENEGADE in stylized form. Two of the Cited Marks are "RENEGADE," in standard character form. The '027 Registration is a composite mark consisting of the word RENEGADE appearing beneath the head of a horse wearing sunglasses.

The likelihood of confusion analysis, however, does not end with the similarity of the marks, and "identity of the marks alone is insufficient to establish a likelihood of confusion in the absence of probative evidence that the goods are related." *In re Thor Tech, Inc.*, 113 USPQ2d 1546, 1547 (TTAB 2015). A likelihood of confusion analysis must consider the trademark in connection with the goods and services offered. *See* 15 U.S.C. § 1052(d). The "fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks." *In re W.W. Henry Co., L.P.*, 82 USPQ2d 1213, 1214 (TTAB 2007) (quoting *Federated Foods, Inc. v. Fort Howard Paper Co.*, 192 USPQ24, 29 (CCPA 1976)). Here, Applicant's Amended Goods are sufficiently dissimilar and distinguishable from the goods in each of the Cited Registrations that consumer confusion is unlikely in any of the three analyses.

**b. Similarity of the Goods**

To be considered similar for likelihood of confusion purposes, the goods must be "related in a way that gives rise to the mistaken belief that the goods and/or services emanate from a common source." *In re International Telephone & Telegraph Corp.*, 197 USPQ 910 (TTAB 1978). For a likelihood of confusion to exist, even when two marks are identical, the goods/services and channels of trade must be sufficiently related such that the use of similar

marks thereon would be likely to generate confusion, mistake, or deception. *See, e.g., In re Fesco, Inc.*, 219 USPQ 437 (TTAB 1983) (no confusion likely where identical FESCO mark used on distributorship services in the field of farm equipment and machinery, and in the field of fertilizer processing equipment and machinery); *In re Shipp*, 4 USPQ2d 1174, 1176 (TTAB 1987) (no confusion likely where identical mark of PURITAN used on laundry and dry cleaning services and on commercial dry cleaning machine filters); *Chase Brass and Copper Co., Inc. v. Special Springs, Inc.*, 199 USPQ 243 (TTAB 1987) (no confusion likely where identical BLUE DOT mark used on springs for engine distributors and on brass rods used on auto manufacturing). In the case at hand, Applicant's Amended Goods and the goods listed in each of the Cited Registrations are not sufficiently related such that it would be likely to generate confusion, mistake, or deception.

As amended, Applicant seeks registration of the mark RENEGADE & Design for use in connection with various goods in seven classes. Applicant submits that the amendments made to the identification of goods moots the refusals with respect to a majority of the goods in the Application. The Office Action specifically mentions *lighting, namely, light bulbs, portable or stand work lights, flood lights, flash lights, laminate flooring, hardwood flooring, engineered flooring, vinyl flooring, slate flooring, flooring installation accessories, namely, flooring installation kits, flooring installation tools, flooring underlayment*. For those goods that are not mentioned in the Office Action, Applicant assumes the Examining Attorney concedes there is no likelihood of confusion with any of the Cited Registrations, as there is no case made that confusion is likely for any of those goods. Accordingly, the Application appears to be entitled to registration for all goods but those listed above. Applicant responds below to each likelihood of

confusion refusal on the merits, but specifically requests approval of the Application for at least those goods not mentioned in the Office Action.

**i. RENEGADE and Design – The ‘027 Registration**

The goods in the ‘027 Registration are “*Lights and light accessories, all for motorcycles, namely, passing lights, brackets for passing lights, rear lights, indicator lights, protection grills for lights, and visors for lights*” in Class 007 and “*Accessories, spare parts and hard parts, all for motorcycles, each made of chrome plated steel or stainless steel, namely, protection parts, trim parts, luggage racks, foot rests, wheel covers, brake covers, fender trim, sissybars, engine covers, and engine guards*” in Class 012. The Office Action does not state that the Class 012 goods are related to any goods in the Application; nevertheless, Applicant asserts that confusion is unlikely with all the goods in the ‘027 Registration.

The goods in the ‘027 Registration are all qualified and limited to “motorcycles.” The lighting goods listed in the Application after amendment are “*lighting, namely, portable or stand work lights, namely, LED flood lights and LED work lights for construction settings; flood lights, flash lights.*” Applicant has deleted the unqualified term “*light bulbs*” from the Application. Applicant submits that there is no reading of “portable or stand work lights, namely, LED flood lights and LED work lights for construction settings; flood lights, flash lights,” that is broad enough to encompass the registered goods or lights for use with motorcycles generally. Applicant does not sell goods in the automotive industry, nor do any of the Amended Goods listed in the Application apply to motorcycles. As “portable or stand work lights, namely, LED flood lights and LED work lights for construction settings; flood lights, flash lights,” are not used on motorcycles, are not related to motorcycle lights, and are not confusingly similar to lighting used on motorcycles, there are no conflicting goods in the Application.

The goods in the '027 Registration do not overlap with the Amended Goods. The registered goods are limited to use in connection with motorcycles, and the Amended Goods are not related to motorcycle lights or accessories. The goods travel in different channels of trade, are limited to mutually exclusive industries, and are marketed to dissimilar consumers. Thus, the goods are not related for likelihood of confusion purposes, and Applicant respectfully requests that the § 2(d) refusal be withdrawn.

ii. **RENEGADE – The '350 Registration**

The goods in the '350 Registration are "*Riding and walk-behind floor scraper, polisher, scarifier, and shot blaster*" in Class 007. Applicant's goods referenced in the Office Action apparently related to these goods are "*laminated flooring, hardwood flooring, engineered flooring, vinyl flooring, slate flooring, flooring installation accessories, namely, flooring installation kits, flooring installation tools, flooring underlayment.*" Again here, the Office Action does not address any goods in the Application other than these and, therefore, no likelihood of confusion case has been made with respect to any of the unmentioned remaining goods in the Application.

Here, the registered goods are a riding or walk-behind multipurpose machine whose function is to scrape, polish, scarify, and blast floors. Applicant's Amended Goods are various types of flooring and flooring underlayment. It is noteworthy that Applicant's Amended Goods no longer contain any flooring installation tools, kits, or accessories. Despite the apparent similarities caused by both descriptions containing the word "floor," the goods are wholly dissimilar. First, there is no evidence that various types of flooring and riding floor-scraping machines are commonly manufactured and sold by the same entity. Second, a riding floor-scraping machine is not sold in retail outlets, and is not marketed to the general public. Third, a machine big enough for a person to ride on or walk behind and for performing floor maintenance

is not purchased by the average individual consumer. Further, such an expensive and specialized machine is not purchased on a whim or without significant deliberation.

Applicant's Amended Goods, on the other hand, are types of flooring available and accessible to the average individual consumer. Despite being less expensive than a floor-scraping machine, the average consumer exercises considerable deliberation regarding their flooring purchases. Specifically, the consumer will shop for aesthetically pleasing flooring. The consumer must make a decision about the color, the material, the budget, and the installation of flooring. All of these considerations naturally invite deliberation, comparison and scrutiny among the various brands and types of flooring available. These facts indicate that consumers are unlikely to be easily confused between "flooring" and "floor-scraping machines."

The goods in the '350 Registration differ significantly from Applicant's Amended Goods. The price points, intended consumer, the level of care exercised in purchasing the goods, the conditions of purchase, and level of sophistication of the consumers are all drastically different. Where the goods differ in these important dimensions, there is scant likelihood that consumers will be confused. Accordingly, Applicant submits that there is no likelihood of confusion with the '350 Registration, and Applicant requests withdrawal of the rejection.

**iii. RENEGADE – The '302 Registration**

The third and final Cited Registration covers the mark RENEGADE for use in connection with "ceiling fans," in Class 011. The Amended Goods must be compared to "ceiling fans," and there are simply no goods in the Application that can remotely be considered confusingly similar to "ceiling fans." Further, the Office Action does not set forth a *prima facie* case for confusion with "ceiling fans" by making a proper comparison to any of the goods listed in the Application.



Applicant has deleted “light bulbs” from the Application, which may have been the goods with which the Examining Attorney believed that a likelihood of confusion existed. As amended, there do not appear to be any goods in the Application that are so related to “ceiling fans” that consumers are likely to be confused as to the source of the two products, even where identical marks are used. In addition to the lack of apparent relatedness, the Office Action does not present any argument or evidence that “ceiling fans” are related to any of the Amended Goods. Applicant therefore respectfully submits that the Office Action does not make a *prima facie* case that confusion is likely with the ‘302 Registration. Accordingly, Applicant requests that the § 2(d) refusal with respect to the ‘302 Registration be withdrawn.

### **III. Conclusion**

For all the foregoing reasons, Applicant submits that the evidence presented clearly shows that Applicant’s RENEGADE & Design mark is not likely to cause confusion, mistake or deception with the marks in the Cited Registrations, and therefore, the likelihood of confusion refusals have been overcome. Applicant herewith amends the goods to conform to the Nice Classification system, as outlined above and submitted in connection herewith. If necessary, Applicant specifically requests clarification as to what goods, if any, the Examining Attorney believes there may still be a likelihood of confusion issue. Applicant submits that the Application is now in condition for formal allowance and passage to publication. Such action is respectfully requested. If any issues arise which the Examining Attorney believes may be best resolved over the telephone, the Examining Attorney is invited to contact Applicant’s undersigned attorney at (800) 821-7962 or via email at [cgntmdocket@shb.com](mailto:cgntmdocket@shb.com).