

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of : BEYOND
Serial No. : 88210968
Applicant : Trane International Inc.
Examiner : Jenny Park
Law Office : 104

Response to Office Action

Applicant amends its application to clarify the nature of its goods and services; notably, applicant limits its class 11 goods to commercial furnaces, fluid coolers, water heaters, chillers, and refrigeration machines and parts. In the context of these amendments, Applicant's goods and services are now sufficiently distinguishable from the cited registrant's "air purification units," and there is no likelihood of consumer confusion. Further, when taking into account the specialized nature of Applicant and Registrant's distinguishable goods and the sophistication of their customers, it is clear that consumers will not be confused when confronted with both Applicant's mark and the cited marks.

I. Applicant's Goods and Related Services are Distinguishable

Applicant amends its goods and services to align with its intended use of BEYOND, i.e. in connection with goods and services related to intelligent building systems and building automation and energy management; see attached. Notably, applicant amends its class 11 goods so that they are now completely unrelated to air purification units. Applicant also specifically limits the scope of the class 11 goods to specify that they will be used for commercial purposes.

For there to be a likelihood of consumer confusion, Applicant's goods and the cited registrant's goods need to be at least related. *In re Iolo Technologies, LLC*, 95 USPQ 2d 1498,

1499 (TTAB 2010). The office action refusal specifically identifies the class 11 goods as the source of confusion. Applicant's amended goods and services are now no longer related to the cited registrant's identified goods, and therefore, there is no likelihood of consumer confusion. This application should proceed to registration.

II. Applicant's amended goods and services are specialized, their purchasers are sophisticated, and consumers will unlikely be confused

Another important factor to consider in determining whether there is a likelihood of consumer confusion is the condition of sale; whether purchasers are making an impulse or a sophisticated purchase. *See Calypso Technology Inc. v. Calypso Capital Management, LP*, 100 USPQ2d 1213 (TTAB 2011). Sophisticated consumers are likely aware of the industry in which they are making a purchase and further recognize whether or not the goods and services of that industry emanate from a single source. *Id.*

Applicant's identified goods and services are specialized, i.e. equipment and services related to intelligent building systems. Customers of these products are narrowly defined and highly sophisticated. These customers will take time to investigate the goods and services prior to purchase. Likewise, air purification units are also specialized goods; customers of these products are also likely to thoroughly investigate these products prior to purchase, especially since the product controls ambient air quality. Both Applicant and the cited registrant's customers are not making an impulse purchase.

When taking into account the specialized nature of Applicant and Registrant's goods and the sophistication of their customers, it is clear that these consumers will not be confused when confronted with both Applicant's Mark and the cited marks. This application should therefore proceed to registration.

III. Conclusion

Applicant's amends its application to clarify the nature of its goods and services. In the context of these amendments, Applicant's goods are now sufficiently distinguishable from the cited registrant's "air purification units," and there is no likelihood of consumer confusion. Further, Applicant and Registrant's distinguishable goods are specialized and their customers are sophisticated and unlikely to be confused. Applicant therefore respectfully requests that this application be allowed to proceed to registration.