

RESPONSE TO OFFICE ACTION No. 1

To Commissioner for Trademarks:

Mark: GAMMA

Serial No.: 88/211,373

Our Ref. No.: 18-20048-US (390976.00003)

BACKGROUND

Applicant has a pending application for the following mark:

- GAMMA (Ser. No. 88/211,373) for “Sailing vessels; sailboats; boats; masts for boats; booms for boats; rudders for boats; sailboats and structural parts therefor, namely, hulls and hull sections; hull fittings, namely, drain plugs, cleats, bailers, coamings, centerboards, keels and daggerboards; beams; booms; masts; rudders; tillers and tiller extensions; sailboat rigging and hardware, namely, rings, pins, halyards, sheets, stays, shrouds, spreaders, pulleys, blocks, lines, gudgeons, pintles, shackles, ratchets, bolts, nuts, screws, washers, bushings, grommets, eyes, hooks, hinges, furlings, bridles, trapezes; fitted and semi-fitted covers for boats, boat cockpits and rudder” in Class 12 and “sails; Sailboat sails; storage bags for boat spars and sailboats” and Class 22, and Arranging, conducting and organizing sporting events and competitions in the sport of sailing; Entertainment in the nature of sailboat races; education in the nature of teaching of yachting, sailing, steering boats, ships or vessels; providing of training for groups and individuals relating to yachting, sailing, steering boats, ships or vessels; sporting and cultural activities, namely, organizing, sanctioning, conducting, regulating and governing amateur athletic programs and activities, namely, in connection with vehicles and apparatus for locomotion by sea; publication of books, magazines, journals, newspapers, periodicals, catalogues, and brochures in the field of sailing in Class 41.

The Examiner issued an Office Action on February 28, 2019, pursuant to Trademark Act Section 29(d), 15 U.S.C. § 1052(d); TMEP §§ 1207.01 et seq., (“Section 2(d) Refusal), asserting a likelihood of confusion and partially refusing Applicant’s Mark for the goods in Class 12 and 22 – based upon a perceived likelihood of confusion with registered mark:

- GAMMA (Ser. No. 5,292,503) for “Boat accessories, namely, boat tops” in Class 12.

Applicant has amended its good to:

Class 12: ~~Sailing vessels; sailboats; boats; masts for boats; booms for boats; rudders for boats;~~ sailboats and structural parts therefor, namely, hulls and hull sections; hull fittings, namely, drain plugs, cleats, bailers, coamings, centerboards, keels and daggerboards; beams **for sailboats**; booms **for sailboats**; masts **for sailboats**; rudders; **sailboat** tillers and **sailboat** tiller extensions; sailboat rigging **structures** and **component** hardware **parts thereof**, namely, rings, pins, halyards, sheets, stays, shrouds, spreaders, pulleys, blocks, lines, gudgeons, pintles, shackles, ratchets, bolts, nuts, screws, washers, bushings, grommets, eyes, hooks, hinges, furlings, bridles, trapezes; fitted and semi-fitted covers for **sailboats**, ~~boat cockpits~~ and rudders, **and excluding boat tops**.

Class 22: sails; Sailboat sails; storage bags for boat spars and sailboats

Applicant respectfully submits that the above goods, as amended, cover only goods for sailboats and that as amended these goods are no longer related to the cited mark, the evidence submitted is no longer relevant, and when considered as a whole a likelihood of confusion no longer exists.

SUMMARY OF ARGUMENTS

Applicant respectfully provides the following summary list of arguments in support of withdrawing the refusal:

- The Applicant's amended identification of goods are limited to use on sailboats, which is different from and unrelated to the goods in the registered mark.
- The Cited Mark covers "Boat accessories, namely, boat tops" and nothing else. Boat tops are not goods that used with or that would apply to sailboats. In fact, boat tops are incompatible with and not closely related to the goods covered by the Cited Mark.
- Consumers of boats are discriminating buyers will not confuse the Cited Mark and Applicant's Mark, and such consumers can distinguish between the marks.
- The Cited Mark GAMMA, as used by registrant is an acronym for Gas Assist Molded Marin Assembly. As such, the cited mark has a specific meaning that makes it distinguishable in connotation and overall commercial impression from Applicant's Mark, which uses GAMMA arbitrarily and as a Greek number.
- The evidence submitted by the Examiner does not establish relatedness of the goods.

Based on the foregoing arguments, which we have elaborated on in more detail below, Applicant respectfully submits that no likelihood of confusion exists and requests that the Examiner withdraw the 2(d) refusal and approve Applicant's Mark for publication.

LEGAL STANDARD

Under the Lanham Act, "no trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it . . . (d) Consists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive..." TMEP §1207.01.

In the case *In re E. I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973), the court provided the factors relevant to a finding likelihood of confusion.¹ In setting forth the factors, the court cautioned that, with respect to determining likelihood of confusion:

¹ The "DuPont Factors" consider: (1) the similarity of the marks in appearance, sound, connotation, and commercial impression; (2) the similarity of the nature of the goods (relatedness); (3) the similarity of the trade channels; (4) the conditions in which the products are purchased; (5) the fame of the prior mark; (6) the nature of similar marks on similar goods; (7) the presence of actual confusion; (8) the length of time without actual confusion; (9) variety of goods on which the mark is used; (10) the market interface between the marks being disputed; (11) the extent to which a trademark holder has the right to exclude others from using the mark; (12) the extent of potential confusion; and (13) any other relevant facts.

- “[T]here is no litmus rule which can provide a ready guide to all cases.” Id. at 1361, 177 USPQ at 567.
- Not all of the factors are relevant and only those relevant factors for which there is evidence in the record must be considered. Id. at 1361-62, 177 USPQ at 567-68; see also: *In re Mighty Leaf Tea*, 601 F.3d 1342, 1346, 94 USPQ2d 1257, 1259 (Fed. Cir. 2010) (“Not all of the DuPont factors are relevant to every case, and only factors of significance to the particular mark need be considered”); *In re Majestic Distilling Co.*, 315 F.3d 1311, 1315, 65 USPQ2d 1201, 1204 (Fed. Cir. 2003) (citing *In re Dixie Rests., Inc.*, 105 F.3d 1405, 1406-07, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997)); *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 946, 55 USPQ2d 1842, 1845 (Fed. Cir. 2000).
- Furthermore, the significance of a particular factor may differ from case to case. See: *DuPont*, 476 F.2d at 1361-62, 177 USPQ at 567-68; *Dixie Rests.*, 105 F.3d at 1406-07, 41 USPQ2d at 1533 (noting that “any one of the factors may control a particular case”). There is no mechanical test for determining likelihood of confusion and “each case must be decided on its own facts.” *DuPont*, 476 F.2d at 1361, 177 USPQ at 567.

ANALYSIS

A. Applicant’s Goods are Distinguishable from the Goods Covered by the Cited Mark

1. The Applicant’s amended identification of goods distinguishes the goods and decreases the potential for consumer confusion

Applicant has amended its identification of goods to sailboats. Applicant’s amended identification limits the reach of Applicant’s Mark to sailboats and accessories “for sailboats.” In addition, Applicant has amended its identification of goods to explicitly exclude “boat tops.” When considering the amendment goods, and the deletion of the broader language from the identification, Applicant’s Goods are sufficiently unrelated from Registrant’s goods to avoid a likelihood of confusion.

2. Applicant’s Goods are not closely related to Registrant’s Goods

The Examiner incorrectly concludes that the goods of the Cited Mark and Applicant’s Mark are related. The Cited Mark covers “Boat accessories, namely, boat tops” and nothing else. Applicant’s listed goods are specifically tailored and limited to sailboats, which are not closely related to the goods covered by the Cited Mark. Despite these goods existing in the boating world, “boat tops” are not accessories to sailboats. In fact, boat tops are incompatible with sailboats. Registrant’s boat tops are designed to fit to center console boats. See Exhibit A - <https://coastalanglermag.com/rt-marine-adda-top-universal-3/>. Center console boats, as the name suggests, have a center-mounted console with a steering station and are commonly used for fishing. See Exhibit B - <https://www.boats.com/explore/boats/center-console/>. Sailboats, on the other hand, are propelled and steered using sails mounted to the boat’s hull, and do not contain center consoles to which Registrant’s Goods are designed. See Exhibit C - <https://en.wikipedia.org/wiki/Sailboat>.

Given the incompatibility of the goods, Applicant submits that the relevant purchasers are unlikely to believe that the goods originate from the same source, and given the nature of the goods and their channels of trade, confusion is unlikely. See TMEP § 1207.01(a)(i) (“[I]f the goods or services in question are not related or marketed in such a way that they would be encountered by the same persons in

situations that would create the incorrect assumption that they originate from the same source, then, even if the marks are identical, confusion is not likely.”); *See also In re Thor Tech, Inc.*, 113 USPQ2d 1546, 1551 (TTAB 2015) (finding use of identical marks for towable trailers and trucks not likely to cause confusion given the difference in the nature of the goods and their channels of trade and the high degree of consumer care likely to be exercised by the relevant consumers); *Local Trademarks, Inc. v. Handy Boys Inc.*, 16 USPQ2d 1156, 1158 (TTAB 1990) (finding liquid drain opener and advertising services in the plumbing field to be such different goods and services that confusion as to their source is unlikely even if they are offered under the same marks); *Quartz Radiation Corp. v. Comm/Scope Co.*, 1 USPQ2d 1668, 1669 (TTAB 1986) (holding QR for coaxial cable and QR for various apparatus used in connection with photocopying, drafting, and blueprint machines not likely to cause confusion because of the differences between the parties’ respective goods in terms of their nature and purpose, how they are promoted, and by whom they are purchased). Based on the cases above, Applicant submits that goods are unrelated.

3. Evidence Provided by Examiner Fails to establish Related Goods

The Examiner provided the following Internet evidence in an attempt to establish the relatedness of the Applicant’s goods and Registrant’s goods; as well as to show that the relevant goods and/or services are sold or provided through the same trade channels and used by the same classes of consumers in the same fields of use. Based on this evidence, the Examiner improperly concluded that the Cited Mark’s goods and Applicant’s Goods are considered related for likelihood of confusion purposes.

- <http://www.taylormadeproducts.com/catalog/>
- <https://www.westmarine.com/rigging>
- <https://www.westmarine.com/sailing>
- <https://www.westmarine.com/boats>
- <https://www.westmarine.com/pontoon-tops-enclosures>
- <https://www.boatstoreusa.com/categories/covers-tops.html>
- <https://www.boatstoreusa.com/categories/sailing.html>
- <https://www.boatstoreusa.com/categories/hardware-hatches.html>
- <http://www.fawcettboat.com/categories/sailing-hardware.asp>
- http://www.fawcettboat.com/pc_combined_results.asp?pc_id=CE51568E6937407EB566F3E181B98E99

The fact that the various products are available for sale from the same websites does not establish related goods, same channel of trade or same purchasing public. The courts have observed that a variety of products from different manufacturers and industries may be sold together in a retail establishment, and mere existence of such an environment should not lead to a presumption of a likelihood of confusion. *See The Nestle Company Inc. v. Nash-Finch Co.*, 4 U.S.P.Q.2d 1085, 1090, 1987 WL 123836 (T.T.A.B. 1987) (opposer’s NESTLE QUIK milk products and applicant’s DELI QUIK delicatessen products were food products available in the same supermarkets and grocery stores, and the Trademark Board found no likelihood of confusion, rejecting the argument that their common appearance in the same stores would necessarily cause confusion).

Applicant submits that the registered goods are unrelated to sailboats and thus Applicant’s goods. Consumers interested in Applicant’s sailboat specific goods are unlikely to confuse Applicant’s product with those of registrant given they are not compatible or related. Thus, the Examiner has failed to

provide sufficient evidence to establish that the Cited Mark's "boat tops" and the Applicant's Goods are related, and the Examiner incorrectly has assumed that the goods are related and that there is a likelihood of confusion. Rather, the Cited Mark's "boat tops" and the Applicant's Goods are not related in a way that would indicate that consumers would understand such goods to emanate from the same source.

B. Consumers of Boats are Discriminating and Not Likely to be Confused by the Cited Mark and the Applicant's Mark

The Examiner does not appear to have properly included or weighed the DuPont factor of the sophistication of the buyer of the good or service. *See In re Mighty Leaf Tea*, 601 F.3d 1342, 1346, 94 USPQ2d 1257, 1259 (Fed. Cir. 2010) ("Not all of the DuPont factors are relevant to every case, and only factors of significance to the particular mark need be considered"); Callmann, *Unfair Competition, Trademarks, and Monopolies* § 81.2(a) ("In determining the likelihood of confusion, the court should consider the general impression of the ordinary purchaser, buying under the normally prevalent conditions of the market and giving the attention such purchasers usually give in buying that class of goods. The ordinary purchaser, however, differs according to the "character of the article, the use to which it is put, the kind of people who ask for it, and the manner in which it was ordered.") This factor must be given substantial weight in the comparison of the Cited Mark and Applicant's Mark, given the sophistication of consumers when it comes to sailboats versus boat accessories for center-console boats, specifically "boat tops," coupled with the price point of the parties' goods.

Applicant's purchasers are not impulse purchasers. Applicant's products, namely sailboats, and Registrant's products, namely "boat tops," have a price point of several thousand dollars. As set forth in TMEP § 1207.01, the fact that Applicant's purchasers are careful purchasers and not impulse buyers may be sufficient for a determination of no likelihood of confusion, even if the marks are similar and the goods and services are related. *See* TMEP § 1207.01(d)(vii) ("[C]ircumstances suggesting care in purchasing may tend to minimize the likelihood of confusion."); *Primrose Ret. Cmty., LLC v. Edward Rose Senior Living, LLC*, 122 USPQ2d 1030, 1039 (TTAB 2016) (finding that, "even in the case of the least sophisticated purchaser, a decision as important as choosing a senior living community will be made with some thought and research, even when made hastily"); *see also In re N.A.D., Inc.*, 754 F.2d 996, 999-1000, 224 USPQ 969, 971 (Fed. Cir. 1985) (concluding that, because only sophisticated purchasers exercising great care would purchase the relevant goods, there would be no likelihood of confusion merely because of the similarity between the marks NARCO and NARKOMED). Here, purchasers of boats and boat accessories are unlikely to make impulse decisions regarding maritime purchases and will understand the difference between the parties' goods. As such, Applicant submits that this factor weighs significantly against finding a likelihood of confusion.

C. The Cited Mark is Distinguishable in Connotation and Overall Commercial Impression from Applicant's Mark

When comparing the marks, "all relevant facts pertaining to appearance, sound, connotation, or commercial impression must be considered before similarity as to one or more of those factors may be sufficient to support a finding that the marks are similar or dissimilar." *Recot, Inc. v. M.C. Becton*, 214 F.3d 1322, 1329, 54 USPQ2d 1894, 1899 (Fed. Cir. 2000); TMEP §1207.01(b). One relevant fact that the Examiner appears not to have properly considered is the meaning and connotation of the Cited Mark in connection with its products.

According to Registrant’s website, the term GAMMA stands for “gas assist molded marine assembly,” the name of the patented construction technology used by Registrant in the course of manufacturing its goods. See Exhibit D - <https://www.rtmarine.net/gamma-tops>. Accordingly, the registrant’s use of “GAMMA” is a descriptive acronym and any trademark rights in such a term must be narrowly construed. By contrast, Applicant’s use of GAMMA is arbitrary and refers to the Greek letter “gamma,” which is fanciful when used on and in connection with sailing-related goods and services. As such, the Cited Mark has a distinct and different meaning and connotation from Applicant’s Mark, resulting in a sufficiently distinguishable commercial impression. See TMEP § 1207.01(b)(v) (“The meaning or connotation of a mark must be determined in relation to the named goods or services. Even marks that are identical in sound and/or appearance may create sufficiently different commercial impressions when applied to the respective parties’ goods or services so that there is no likelihood of confusion.”).

Conclusion

Based on the foregoing, Applicant submits that its GAMMA trademark is not likely to be confused with the registered goods because the goods covered by the parties’ marks are incompatible and easily distinguishable to the relevant sophisticated purchasers. The marks also give distinct and different commercial impressions given that the Cited Mark is descriptive of Registrant’s Goods. Regardless, Applicant’s amended identification of goods obviates any potential consumer confusion by specifically excluding Registrant’s Goods.

For these reasons, Applicant respectfully requests that the Examiner withdraw the current refusal and approve Applicant’s Mark for publication.

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