

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the application of: TEPSI, LLC Serial No.: 88/288045 Filed: February 4, 2019 For: OCTOPUS in international class 007	Law Office 111 Examining Attorney: Meredith Debus RESPONSE TO OFFICE ACTION DATED April 26, 2019
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This is a response to the Office Action dated April 26, 2019.

INTRODUCTION

Applicant Tepsi, LLC respectfully responds to the Examining Attorney’s refusal to register Applicant’s mark for “OCTOPUS” (“the Mark”). The refusal is based on the following grounds: (1) the Examining Attorney has required partial amendment to the identification of goods; (2) multiple-class application requirements; (3) likelihood of confusion; and (4) a prior-filed conflicting application. Applicant respectfully traverses this refusal and submits the following arguments and statements in support of Applicant’s registration.

I. AMENDMENT OF GOODS

The Applicant has reviewed the Examining Attorney’s remarks and respectfully submits amendments to the classification of its goods for the mark “OCTOPUS”. Applicant amends the listing as follows:

IC 007: Machine parts, namely, ball bearings, deep-groove ball bearings, angular contact ball bearings, self-aligning ball bearings, needle roller bearings, roller bearings, thrust ball bearings, thrust roller bearings, tapered roller bearings, magnetic bearings, linear bearings, anti-friction bearings, mounted bearings, rotary bearings, telescopic bearings, linear ball bearings, flanged roller bearings, metric ball bearings, anti-friction roller bearings, radial roller bearings, differential bearings, insert bearings, swing bearings, pinion bearings, and shock bearings;

Vehicle engine components, namely, ball bearings, deep-groove ball bearings, angular contact ball bearings, self-aligning ball bearings, needle roller bearings, roller bearings, thrust ball bearings, thrust roller bearings, tapered roller bearings, magnetic bearings, linear bearings, anti-friction bearings, mounted bearings, rotary bearings, telescopic bearings, linear ball bearings, flanged roller bearings, metric ball bearings, anti-friction roller bearings, radial roller bearings, differential bearings, insert bearings, swing bearings, pinion bearings, and shock bearings;

Bearings as parts of agricultural machinery, namely, tractors, backhoes, mowers, cultivators, seeders, tillers, harvesters, sprayers, plows, planters, and combines;

Belts, namely, belts for engines and belts for conveyors;

Appliance parts for washing machines, dishwashers, electric food blenders, electric food processors, and vacuum cleaners, namely, couplings, springs, pumps, clutches, valves, motors, handles, fuses, filters, pipes, sockets, control knobs, and seals such as door boot seals and tub seals;

Roller chains being parts of industrial machines, combine harvesters, and power-operated lifting and moving equipment;

Sprockets as parts of industrial machines, combine harvesters, and power-operated lifting and moving equipment;

Engine seals for use in land vehicle engines, namely, engines of power sport vehicles, go-karts, tractors and bicycles, namely, mechanical seals and oil seals; and

Seals as parts for industrial machines, combine harvesters, and power-operated lifting and moving equipment, namely, mechanical seals and oil seals.

IC 011: Appliance parts for clothes dryers, refrigerators, cooking ovens, microwave ovens, air conditioners, freezers, range hoods, and ice machines, namely, handles, fuses, gas valve solenoids, heating elements, ignition elements, bake elements, filters, pipes, igniters, sockets, control knobs, thermistors, couplings, springs, pumps, clutches, valves, motors, and seals.

IC 012: Land vehicle parts for power sport vehicles, go-karts, tractors and bicycles, excluding engine parts, namely, ball bearings, deep-groove ball bearings, angular contact ball bearings, self-aligning ball bearings, needle roller bearings, roller bearings, thrust ball bearings, thrust roller bearings, tapered roller bearings, magnetic bearings, linear bearings, anti-friction bearings, mounted bearings, rotary bearings, telescopic bearings, linear ball bearings, flanged roller bearings, metric ball bearings, anti-friction roller

bearings, radial roller bearings, differential bearings, insert bearings, swing bearings, pinion bearings, and shock bearings for wheels, wheel hubs, axles, and brakes;

Belts as parts for land vehicles, namely, power sport vehicles, go-karts, tractors and bicycles, namely, belts for land vehicle transmissions and drive belts;

Land vehicle components for power sport vehicles, go-karts, tractors and bicycles, namely, engines, body parts, namely, body panels and structural parts of land vehicles;

Axles, brakes, radiator, tires, wheels, and transmissions;

Wheel bearings as parts for land vehicles, namely, power sport vehicles, go-karts, bicycles, and tractors, excluding engine parts;

Roller chains as parts for land vehicles, namely, power sport vehicles, go-karts, bicycles, and tractors, excluding engine parts;

Sprockets as parts for land vehicle wheels, namely, power sport vehicles, go-karts, tractors, and bicycles;

Bicycle parts, namely, sprockets;

Seals as parts for land vehicles, namely, power sport vehicles, go-karts, bicycles, and tractors, namely, transmission seals.

IC 028: Ball bearings for skateboards.

Applicant respectfully submits that this is a proper classification of the goods. Please note these claimed goods for Applicant's mark with respect to the arguments below.

II. MULTIPLE CLASS APPLICATION REQUIREMENTS

The Examining Attorney previously remarked that the application's identified goods belonged in more than one international class.

Applicant submits the amended goods as above with additional international classes 011, 012, and 028 in addition to 007.

III. NO LIKELIHOOD OF CONFUSION

The Examining Attorney considered the following *du Pont* factors most relevant in issuing the refusal: similarity of the marks and similarity of the goods. *See In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973). Applicant respectfully submits that there is no likelihood of confusion between Applicant's and Registrants' marks based on similarity of the goods for the following reasons.

The Lanham Act provides that no trademark which distinguishes the goods of the Applicant from the goods of others shall be refused registration on the principal register on account of its nature unless it so resembles a mark registered in the Patent Office or previously used in the United States by another mark not abandoned, "as to be likely when applied to the goods of the Applicant to cause confusion, or to cause mistake or to deceive."¹ 15 U.S.C. §1052.

While there is admittedly no "litmus rule" for determining likelihood of confusion of a pending mark with a previously registered mark, the Court of Customs and Patent Appeals has listed 13 elements which, when relevant, should be considered. *DuPont DeNemours & Co.*, 476 F.2d at 1361. The *DuPont* factors include: (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 a

¹ Legislative history of the above portion of the Lanham Act, as declared by the 79th Congress, indicates that the objective of the Act is to make registration more liberal, to dispense with "mere technical prohibitions and arbitrary provisions" and modernize the trademark statutes to conform with legitimate, modern business practice. *See Application of E. I. DuPont DeNemours & Co.*, 476 F.2d 1357, 1360, 177 U.S.P.Q. 563 (C.C.P.A. 1973) *citing* S. Rep.No. 1333, 79th Cong., Sess. (1946) in U.S. Code Cong.Service, 79th Cong., 2d Sess. at 1274-1278 (1946). Thus, the intent of the drafters of the Act wanted trademarks to be more freely registered, not disallowed on technicalities. In this case, Applicant's mark should be allowed to register as it is not likely to be confused with the cited registration, Registration No. 2,689,503, as explained in detail below.

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. When applying the *DuPont* factors, each factor must be shown to be material or relevant to the particular case before evidence on that factor is considered. Therefore, there is no need to discuss all 13 factors. *See Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 U.S.P.Q.2d 1842 (Fed. Cir. 2000) (The Board satisfied the *DuPont* test by considering each factor for which there was evidence in the record). Consequently, in this analysis, only the relevant factors will be discussed. The applicable *DuPont* factors are as follows:

A. The Applicant’s Mark “OCTOPUS” is dissimilar in nature of the goods or services as described in the registration of Registrants’ Marks

The nature and scope of a party’s goods or services must be determined on the basis of the goods or services recited in the application or registration. TMEP 1207.01(a)(iii); *see also, e.g., Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002); *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1690 n.4 (Fed. Cir. 1993); *J & J Snack Foods Corp. v. McDonald’s Corp.*, 932 F.2d 1460, 18 USPQ2d 1889 (Fed. Cir. 1991); *Octocom Systems Inc. v. Houston Computer Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990); *Canadian Imperial Bank of Commerce, N.A. v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987); *Paula Payne Products Co. v. Johnson Publishing Co.*, 473 F.2d 901, 177 USPQ 76 (C.C.P.A. 1973).

1. The Goods of Registrant’s Mark are Not Similar to the Goods of Registration No. 2954022 “OKTOPUS”

Applicant’s goods are for machine parts (ball bearings, belts, roller chains, seals, and various parts), appliance parts, non-engine vehicle parts, and ball bearings for skateboards.

International Classes 007, 011, 012, and 028. The first registration provided, Reg. No. 2954022 for word mark “OKTOPUS”, narrowly defines its International Class 012 goods as “Floor conveyor vehicles, namely, conveyors and lifters for use in the construction industry; Forklift trucks, fork stacker vehicles and cranes and structural parts therefor, namely, attachments for lifting, manipulating, adjustment, and arresting large plane aerials and loads such as boards, walls and ceiling panels, glass panels, profile panels, all by vacuum suction means.” Because the manner in which the prior Registrant and Applicant have identified their goods is controlling, the prior Registrant’s goods must be presumed limited to the goods described, floor conveyor vehicles. TMEP 1207.01(d)(5); *Jean Patou Inc. v. Theon Inc.*, 9 F.3d 971, 29 USPQ2d 1771 (Fed. Cir. 1993); *National Football League v. Jasper Alliance Corp.*, 16 USPQ2d 1212, 1216 n.5 (TTAB 1990).

Thus, “OKTOPUS” cannot be presumed to encompass Applicant’s goods, cannot be presumed to move in the same channels of trade as the Applicant’s services, and cannot be presumed to be available to the same classes of purchasers as Applicant’s services, and vice-versa. Because “OKTOPUS” is not probative to the relatedness of the prior registrant’s floor conveyor vehicles and Applicant’s ball bearings and machine parts, “OKTOPUS” cannot be used as evidence to show that the goods are related and move in the same channels of trade. TMEP 1207.01(a)(vi).

Applicant’s goods are also distinct from the “OKTOPUS” floor conveyor vehicles. Ball bearings, machine parts, and appliance parts are highly distinctive from floor conveyor vehicles and are not in the same International Class. Moreover, Applicant’s non-engine vehicles parts for power sport vehicles, go-karts, bicycles, and tractors are also highly distinctive from floor conveyor vehicles, and a consumer would not confuse parts for power sport vehicles, go-karts, or

bicycles with conveyors, lifters, or forklift trucks. One group of goods is non-engine vehicle parts for ordinary consumer vehicles and farming equipment while the other pertains to highly specialized industrial lifting vehicles such as forklifts. Applicant's goods are entirely different than the goods of Reg. No. 2954022 "OKTOPUS".

Where allegedly similar marks are involved in unrelated goods, the risk with which Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d) was specifically intended to deal – namely, the likelihood that registration of the mark being sought would be likely to cause confusion, to cause mistake, or to deceive – is *de minimis*. The recited descriptions of the goods restrict their respective markets in such a way as to avoid confusion.

2. The Goods of Registrant's Mark are Not Similar to the Goods of in Registration No. 5191321 "OCTOPUS"

The second registration provided. Reg. 5191321 for word mark "OCTOPUS", narrowly defines its goods as "Buckles of common metal; Busts of common metal; Clothes hooks of metal; Crampons for climbing; Eye bolts; Figures of common metal; Hardware, namely, metal brackets for general use; Hooks of metal for clothes rails; Hooks of metal for roofing slates; Metal eye bolts; Metal hooks; Plugs of metal; Pot hooks of metal; Screws of metal; Works of art of common metal; Clothes hooks of metal; Pot hooks of metal." As stated above, the prior Registrant's goods can only be presumed to encompass the goods described, in this case metal buckles and metal hooks.

Thus, "OCTOPUS" also cannot be presumed to encompass Applicant's goods, cannot be presumed to move in the same channels of trade as the Applicant's services, and cannot be presumed to be available to the same classes of purchasers as Applicant's services, and vice-versa. Because "OCTOPUS" is not probative to the relatedness of the prior registrant's buckles of common metals and Applicant's ball bearings and machine parts, "OCTOPUS" cannot be used as

evidence to show that the goods are related and move in the same channels of trade. TMEP 1207.01(a)(vi).

Applicant's goods are also distinct from the "OCTOPUS" buckles of common metal and hooks of metal. The International Class 006 goods of "OCTOPUS" are limited to uncomplicated metal buckles and hooks. These are not comparable to Applicant's much more sophisticated ball bearings, machine parts, appliance parts, and non-engine vehicle parts. The fact that metal may be involved in both does not make the goods comparable. Applicant's goods are entirely different than the goods of Reg. No. 5191321 "OCTOPUS."

As previously stated, the risk of confusion is *de minimis* because the allegedly similar marks are involved in unrelated goods. The recited descriptions of the goods restrict their respective markets in such a way as to avoid confusion.

Consequently, after careful analysis using the relevant *DuPont* factors, Applicant's good and registrants' goods are distinct. Thus, it is clear there is no likelihood of confusion between Applicant's mark and the cited registrations.

IV. THERE IS NO CONFLICT WITH PRIOR-FILED APPLICATIONS

The Examining Attorney has cited U.S. Application Serial No. 87867725 ("TAKO") as an application that precedes (April 8, 2017) applicant's filing date (February 4, 2019). The "TAKO" application is only for goods "Vacuum pumps" under International Class 007.

Applicant's mark, as the identification of goods has been amended, does not include any goods that are similar to "Vacuum pumps." Vacuum cleaners using fan blades is distinct from a vacuum pump device that removes gas molecules from a sealed volume. Because vacuum pumps and vacuum cleaners are distinct, there is no potential likelihood of confusion between Applicant's mark and U.S. Application Serial No. 87867725 "TAKO".

CONCLUSION

Based on the foregoing analysis of the du Pont and Sleekcraft factors, the facts here weigh in favor of the argument that there is no likelihood of confusion between the Applicant's applied-for mark and the prior Registrant's mark. Applicant respectfully requests the Examining Attorney to withdraw the refusal and forward Applicant's application to publication.

Respectfully submitted,

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