ACCUTEMP
SN 88291633
October 23, 2019

Office Action Response

The Examining Attorney has refused to register Applicant's mark ACCUTEMP, under Trademark Act Section 2(d), 15 U.S.C. §1052(d) on the grounds that it is likely to be confused with Registration No. 5378397 for the mark ACCU-TEMP SLIDE. Applicant respectfully disagrees with the Examining Attorney's refusal and requests withdrawal of the refusal based upon the following arguments.

Applicant also respectfully disagrees with the Examining Attorney's assessment of the identical appearance of the marks. Simply because the marks share the word ACCUTEMP or ACCU-TEMP does not mean that they are likely to be confused. There is much more to both marks that serve to distinguish them.

When in determining a likelihood of confusion, one must look to the principal factors listed in *In re E.I. DuPont de Nemours Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). *DuPont* has long been held to be the precedent for determining issues of likelihood of confusion. In *DuPont*, the court emphatically held: "[T]he the question of confusion is related not to the *nature* of the mark but to its *effect* 'when applied to the goods of the applicant.' The only *relevant* application is made in the marketplace. The words 'when applied' do not refer to a mental exercise, but to all of the known circumstances surrounding use of the mark." *Id.* at 567 (emphasis original). It is clear that the Court held that *all* of the circumstances must be examined. The Court went on to hold "we find no warrant, in the statute or elsewhere, for discarding *any* evidence bearing on the question of likelihood of confusion...In every case turning on likelihood of confusion, it is the duty of the examiner, the board and this court to find, upon consideration of *all* the evidence, whether or not confusion is likely." *Id.* at 568 (emphasis original). While one person will give greater weight to one factor than another person might, it is the Examiner's duty to look at all the relevant evidence.

Marks must be evaluated as they are perceived, in their entirety. *In re Hearst Corp*., 982 F.2d 492, 494, 25 USPQ2d 1238, 1239 (Fed. Cir. 1992) (stating that marks are perceived in their entireties and, therefore, all components thereof must be given appropriate weight). As noted by the Examining Attorney, the test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression that confusion as to the source of the good or services offered under the respective marks is likely to result. *Miss Universe v. Community Marketing*, 82 USPQ2d 1562, 1570 (TTAB 2007). Additionally, when determining the degree of similarity, rather than dissecting a mark by minute comparison of its elements, courts look to the marks as a whole. *M2 Software Inc. v. M2 Communications Inc.*, 78 USPQ2d 1994, 1946 (Fed. Cir. 2006).

Applicant's mark is the simple mark ACCUTEMP. The cited mark is a hyphenated compound mark ACCU-TEMP SLIDE. Taken as a whole the marks are indeed visually and aurally different. Applicant asserts that rather than examining the marks as a whole, the Examining Attorney improperly dissected the marks and focused solely on a portion of each of the marks. Applicant maintains that this is precisely the sort of piecemeal comparison the courts reject. *See China Healthways Inst., Inc. v. Wang*, 491 F.3d 1337, 1340 (Fed. Cir. 2007) ("The marks must be compared in their entirety, at least when the overall commercial impression is reasonably based on the entirety of the marks"). When comparing the visual similarity of mark, an Examining Attorney must ask whether the overall appearance of the mark, when compared in its entirety, resembles that of the registrant's.

The Examining Attorney appears to ignore the presence of the term SLIDE in the cited mark. This word, and the hyphenated form of ACCU-TEMP, indeed create a difference in appearance, sound, connotation, and commercial impression between the marks. The Examining Attorney contends that the marks are similar because WELLINGTON comes first in the word sequence and therefore the term SLIDE can be discounted. Applicant notes that the first-word position rule is not hard and fast. *See* 4 McCarthy on Trademarks and Unfair Competition §23:45 (5th Ed. 2019). Rather, Applicant contends that the addition of the word SLIDE clearly differentiates the marks not only because it creates a different visual and aural impression but because it creates a different commercial impression pointing decidedly to Registrant and the commercial activities associate with the mark.

The word SLIDE forms a part of the cited mark *as a whole*. The Examining Attorney's analysis assumes that people reading or pronouncing the marks ACCUTEMP and ACCU-TEMP SLIDE somehow will ignore the word SLIDE. There is simply no factual support for that conclusion, nor is there any reason to believe that will happen.

Applicant does not dispute the fact that the marks both contain the word ACCUTEMP or ACCU-TEMP. However, just because marks contain identical words does not mean that they are automatically likely to be confused. As noted by the Examining Attorney, the goods need not be identical. "They need only be related in some manner, or the conditions surrounding their marketing be such, that they could be encountered by the same purchasers under circumstances that could give rise to the mistaken belief that the goods/services come from a common source. *In re Martin's Famous Pastry Shoppe, Inc.,* 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984); *In re CorningGlass Works*, 229 USPQ 65 (TTAB 1985); *In re Rexel Inc*., 223 USPQ 830 (TTAB 1984); *Guardian Products Co., Inc. v. Scott Paper Co.,* 200 USPQ 738 (TTAB 1978); *In re International Telephone & Telegraph Corp*., 197 USPQ 910 (TTAB 1978). TMEP §1207.01(a)(i)." Applicant maintains that the goods are not sufficiently related or marketed in such a way that they would be "encountered by the same purchasers under circumstances that could give rise to the mistaken belief that the goods/services come from a common source."

The goods associated with the cited mark include *temperature indicators.* Applicant's goods are *mechanical and digital cooking thermometers; Mechanical and digital weather thermometers, mechanical and digital humidity meters, mechanical and digital barometers, mechanical and digital rain gauges, and wind sensors.* The Examining Attorney contends that the goods are commercially related and

Use of identical, even dominant words in common does not automatically mean that two marks are confusingly similar. Applicant directs the Examiner's attention to those cases which hold that in the overall impression analysis there is absolutely no rule that likelihood of confusion is automatically found if a junior user seeks to register a mark that contains the whole of another's mark. *See, Colgate Palmolive Co. v. Carter Wallace, Inc*., 432 F.2d 1400, 167 USPQ 529 (CCPA 1970), *Conde Nast Publications, Inc. v. Miss Quality, Inc*., 507 F.2d 1404, 184 USPQ 422 (CCPA 1975) and *Plus Products v. General Mills, Inc.,* 188 USPQ 520 (TTAB 1975). Even if Applicant's mark is similar to the cited mark, this does not automatically render it likely to be confused with the cited mark. In this instance, the goods associated with the cited mark and the goods associated with Applicant's mark are not sufficiently related to raise any issue of likelihood of confusion.

First, Applicant and Registrant are in very different lines of business. Registrant is a medical technology company. The goods associated with the ACCU-TEMP SLIDE application are microscope slides and temperature indicators. The inclusion of the goods - *laboratory equipment, namely, microscope slides* – clearly indicates the focus of the ACCU-TEMP SLIDE goods. Indeed, the goods as identified on Applicant's website are actually temperature indicating slides. The ACCU-TEMP SLIDE application was filed as a TEASPlus application which required the registrant to pick from prescribed goods identifications that best fit the products. These products are designed to be used with automated immunodiagnostic and special staining machines to ensure that the slide-pad heating mechanism of these machines is functioning properly so that critical patient tissue slides stain optimally. These products are used in pathology laboratories. Attached are instructions for use of the Accu-Temp Slide which can readily be found on Registrant's website. T

Second, Applicant's goods are *mechanical and digital cooking thermometers; Mechanical and digital weather thermometers, mechanical and digital humidity meters, mechanical and digital barometers, mechanical and digital rain gauges, and wind sensors.* To lump these retail household products in with goods clearly directed to laboratory use is overreaching.

The Examining Attorney states that case law and evidence from third-party websites (3M, DeltaTrak, Omega, Spot See, Telatemp, and TIP Temp) attached to the office action establish that the same entity commonly manufactures, produces, and provides the relevant goods and markets the goods under the same mark, that the relevant goods are sold or provided through the same trade channels and used by the same classes of consumers in the same fields of use, and that the goods are similar or complementary in terms of purpose or function." Application believes that the Examining Attorney has overstated the evidence.

3M

3M is the company name and a house mark for a variety of goods and services. To be accurate, the thermometers that #M markets that are similar to Applicant's are branded NexCare and are distributed through the conglomerate's consumer products division. The time temperature indicators that the Examining Attorney refers to are branded MonitorMark and marketed through the conglomerate's Food Safety & Microbiology division. 3M is such a large entity that has so many business segments that to use them as an example of similarity of channels of trade is misleading.

DeltaTrak

Again, DeltaTrak is the company name, not the product brand. The thermometer that DeltaTrak markets is under the brand name FlashCheck and is for commercial use. The time-temperature indicator that DeltaTrak markets for indicting exposure of food and drugs to excessive temperature during transport are branded.

Omega

The humidity meters sold by Omega are for industrial use while the OMEGALABEL temperature labels are for commercial use to monitor when electronics are exposed to excessive temperatures.

Spot See

The SpotBot BLE product is for attachment to products shipments and "measures and records temperature, humidity, tilt, and shock, with the data visualized through a mobile application." Again, a sophisticated commercial product marketed for use with commercial shipments of sensitive products.

The WarmMark DUO product is another time temperature monitor for use in the shipping and storage industry for monitoring temperature sensitive products.

TelaTemp

The Min/Max Memory Thermometer found on this website is "ideal for laboratory, field, and process measurements" not "mechanical and digital cooking thermometers." The Model 110 Irreversible Temperature Labels are like all of the above temperature indicators – for monitoring temperature sensitive products during shipment.

TIP Temp

The TIP Temp products are for commercial application "to accurately monitor, record and alert key personnel of unfavorable environmental conditions" and are "used in many industries." The Barometer & Temperature product is marketed as "ideal for recording ambient changes in the lab, monitoring conditions affecting sample analysis, and assisting in the prediction of weather changes." Again, commercial use. Similarly, just like all of the time temperature indicators reference on the other websites, the Reversible Temperature Label (also known as a Thermochromic Thermometer – not a mechanical or digital thermometer cooking thermometer) is for use with monitoring temperature sensitive products during shipping or storage.

Other than the Nexcare thermometer (which is no longer available) none of the products noted above are the same or even closely related to Applicant's goods. These are not Applicant's goods. Applicant's goods are retail household products used to in cooking and to monitor the weather. The goods associated with the cited mark and all of those referenced above are commercial products and are for very specific purposes unrelated to household use. Using the websites above as evidence that Applicant's digital and mechanical cooking thermometers and weather gauges are the same as the Registrants temperature indicators is like comparing apples and oranges. The websites attached to the office action are for competitors of the Registrant, not Applicant.

Thus, Applicant's and Registrant's goods are not considered related for likelihood of confusion purposes. Registrant's temperature indicators and Applicant's mechanical and digital cooking and weather thermometers are for very different purposes and intended consumers and travel in entirely different channels of trade. Contrary to the Examining Attorney's assertion, the respective marks with their associated goods are not likely to be confused by the relevant consumers. The products associated with the marks are not even remotely used for the same purposes or encountered by the same consumers.

In *Elvis Presley Enterprises v. Capece*, 141 F.3d 188, 46 U.S.P.Q.2d1737 (5th Cir. 1998), the court held that "likelihood of confusion is . . . more than mere possibility of confusion." Registrant's customers are pathology laboratories. According to Registrant's website, the ACCU-TEMP SLIDE is a slide with temperature rating areas to indicate slide pad heating functionality for staining machines when testing human tissue. Applicant's thermometers are identified as for use with cooking and reading weather conditions. No matter what the mark and goods, there is always a possibility of confusion. This, however, is not sufficient to prohibit registration. Are Applicant's goods and the goods associated with the cited mark "likely" to be confused? The answer is "no." Again, the consumers are entirely different, searching for different products for different purposes and these products are, in fact, very different products.

Finally, purchasers and potential purchasers of the goods associated with the cited marks and Applicant's goods presumably exercise a relatively high degree of care when choosing the relevant products. The buyers of the goods associated with the cited mark are seeking technically sophisticated goods for temperature sensitive applications in the medical industry. Applicant's goods are retail consumer products. The consumers of Registrant's goods will not be searching on Amazon in the cooking utensil and household product categories for time-temperature indicators for use in pathology labs. Such care would tend to negate any possibility of a likelihood of confusion caused when individuals view the marks. The sophisticated nature of the consumer coupled with the fact that they are searching for entirely different things in entirely different markets belies any contention that the marks are confusingly similar.

Applicant remains convinced that its ACCUTEMP mark is entitled to registration on the Principal Register. Simply because the marks are the somewhat similar does not mean that the consumer will be likely to be confused as to the source of the goods. The ordinary buyer may be guided by general impressions; however, the courts have held that there has to be a "lower limit on the carelessness or indifference of the reasonable buyer." *J. McCarthy, McCarthy on Trademarks and Unfair Competition,* §23.94 (4th Ed.). As the court in *Pocket Books, Inc. v. Dell Publishing Co.,* 49 Misc. 2d 596, 268 N.Y.S. 2d 46, 149 USPQ 466 (1966) held, "there simply must be some limits to the claimed asininity of the buying public." Again, the test is likelihood of confusion, not a "mere possibility of confusion" (*Elvis Presley,* 141 F.3d 188, 46 USPQ2d 1737(5th Cir. 1998)).

In view of the foregoing arguments, Applicant maintains that there really is no likelihood of confusion issue present. To maintain otherwise unfairly provides the mark of the cited registration with a far greater breadth and scope of protection than that to which it is entitled. Accordingly, Applicant respectfully requests that the Examining Attorney reconsider the refusal to register under Section 2(d) with a view toward withdrawal. The underlying Canadian application is still undergoing examination. Thus, Applicant requests suspension of further prosecution pending submission of the resulting Canadian registration.