RESPONSE TO OFFICE ACTION

The Examining Attorney has refused Applicant's registration of RIO for light fixtures, namely, parabolic floodlight based on the conclusion that there is a likelihood of confusion with U.S. Registration No. 2755654. Applicant respectfully disagrees with this conclusion and maintains that the goods and services are not similar and are marketed to different members of the public.

I. Likelihood of Confusion

The Examining Attorney has refused Applicant's registration for light fixtures, namely, parabolic floodlight under the Trademark Act Section 2(d), 15 U.S.C. Section 1052(d), stating that the Applicant's mark, when used on or in connection with the identified goods, so resembles the mark in the above listed registered marks as to be likely to cause confusion, to cause mistake, or to deceive. Applicant disagrees and believes that there is no likelihood that purchasers of the Applicant's goods and the Registrant's goods would believe that the goods emanate from a common source.

The facts in each case vary and the weight to be given each factor may be different in light of the varying circumstances; therefore, there can be no rule that certain goods or services are per se related, such that there must be a likelihood of confusion from the use of similar marks in relation thereto. See, e.g., Information Resources Inc. v. X*Press Information Services, 6 USPQ2d 1034, 1038 (TTAB 1988) (regarding computer hardware and software); Hi-Country Foods Corp. v. Hi Country Beef Jerky, 4 USPQ2d 1169, 1171 (TTAB 1987) (regarding food products); In re Quadram Corp. , 228 USPQ 863, 865 (TTAB 1985) (regarding computer hardware and software); In re British Bulldog, Ltd. , 224 USPQ 854, 855-56 (TTAB 1984) and cases cited therein (regarding clothing).

A. Confusion Must Be Probable, Not Possible

For confusion to be likely the confusion must be probable; it is irrelevant that confusion is merely possible. Electronic Data Sys. Corp. v. EDSA Micro Corp., 23 U.S.P.Q.2d 1460, 1465 (TTAB 1992) (standard is likelihood of confusion, "not some theoretical possibility built on a series of imagined horrors"); Rodeo Collection, Ltd. v. West Seventh, U.S.P.Q.2d 1204, 1206 (9th Cir. 1987) ("probable, not simply a possibility"). Trademark law is "not concerned with mere theoretical possibilities of confusion, deception, or mistake or with *de*

minimis situations but with the practicalities of the commercial world, with which the trademark laws deal." Electronic Design & Sales Inc. v. Electronic Data Systems Corp., 21 U.S.P.Q.2d 1388 (Fed Cir. 1992), quoting Witco Chem. Co. v. Whitfield Chem. Co., 164 U.S.P.Q. 43, 44-45 (CCPA 1969), aff'g, 153 U.S.P.Q. 412 (TTAB 1967). Likelihood of confusion "is synonymous with 'probable confusion' it is not sufficient if confusion is merely possible." 2 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition § 23:3 (4th ed. 2007). Here, Applicant respectfully submits that there is no probability of confusion with the registered mark due to the fact that applicant's light fixtures, namely, parabolic floodlight and the cited registration's lighting tracks, downlighters, spotlights, floodlights, and fluorescent lamps are very different in nature and sold to different consumers.

If 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 source, then, even if the marks are identical, confusion is not likely. Quartz Radiation Corp. v. Comm/Scope Co., 1 USPQ2d 1668 (TTAB 1986) (QR for coaxial cable not confusingly similar to QR for various products (e.g. lamps, tubes) related to photocopying field. Since the goods here are being purchased by different consumers for unrelated purposes there is no probable likelihood of confusion.

B. Applicant's Goods and the Goods Listed in the Applications Are Distinct

When considering whether a likelihood of confusion exists, the Examiner is limited to determining relatedness in respect to the goods/services as identified in the registration. See United Drug v. Rectanus, 248 U.S. 90, 97 (Sup. Ct. 1918); University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., 217 U.S.P.Q. 505, 507 (Fed. Cir. 1983) (holding that "rights in gross . . . is contrary to principles of Trademark law"). Thus, this general trademark principle grants a trademark owner protection only in relation to the identified goods.

Rather than semantic generalization of the products, it is consumer perception that is significant for determining product relatedness. See, e.g., Electronic Data Systems Corp. v. EDSA Micro Corp., 23 U.S.P.Q.2d 1460, 1463 (TTAB 1992) ("the issue of whether or not two products are related does not revolve around the question of whether a term can be used that describes them both, or whether both can be classified under the same general category"); UMC Industries, Inc. v. UMC Electronics Co., 207 U.S.P.Q. 861, 879 (TTAB 1980) ("the fact that one term, such as 'electronic,' may be found which generally describes the goods of both parties is manifestly insufficient to establish that the goods are related in any meaningful way"); Harvey

Hubbell, Inc. v. Tokyo Seimitsu Co., 188 U.S.P.Q. 517, 520 (TTAB 1975) ("in determining whether products are identical or similar, the inquiry should be whether they appeal to the same market, not whether they resemble each other physically or whether a word can be found to describe the goods of the parties").

The fact that the goods and services at issue can be categorized in the same broad "field" does not, of itself, provide a basis for regarding the goods and services as "related." See In re Digirad Corp., 45 U.S.P.Q.2d 1841 (ComrPats 1998) (holding that despite some industry "overlap," DIGIRAY and DIGIRAD not confusingly similar for high-tech medical diagnostic used to different ends); Cooper Industries, Inc. v. Repcoparts USA, Inc., 218 U.S.P.Q. 81, 84 (TTAB 1983) ("the mere fact that the products involved in this case (or any products with significant differences in character) are sold in the same industry does not of itself provide an adequate basis to find the required 'relatedness'").

Even where the marks are identical and the products can be marketed to the same customers, sufficient differences between the products negate a likelihood of confusion. TMEP § 1207.01(a)(i); *see also* Local Trademarks Inc. v. The Handy Boys Inc., 16 U.S.P.Q.2d 1156 (TTAB 1990) (holding no confusion between LITTLE PLUMBER for liquid drain opener and identical mark LITTLE PLUMBER for advertising services though both products were marketed to plumbing contractors). In re Sears, Roebuck and Co., 2 USPQ2d 1312, 1314 (TTAB 1987) (CROSS-OVER for bras held not likely to be confused with CROSS-OVER for ladies' sportswear); Electronic Design & Sales, Inc. v. Electronic Data Systems Corp., 954 F.2d 713, 21 USPQ2d 1388 (Fed. Cir. 1992) (no confusion between E.D.S. data processing services sold to medical insurers and EDS batteries and power supplies sold to makers of medical equipment). Likewise, Applicant submits that the unrelated nature of the parties' goods and services is more than sufficient to avoid a likelihood of confusion.

The goods and services listed for the cited application are for "Lighting tracks, downlighters, spotlights, floodlights, and fluorescent lamps". The identification of goods should be as complete and specific as possible and protection afforded by the cited registration is limited to only the identified goods and nothing broader. United Drug, 248 U.S. at 97; University of Notre Dame du Lac, 217 U.S.P.Q. at 507. In contrast, Applicant's proposed goods are: "light fixtures, namely, parabolic floodlight" Parabolic floodlights are different than regular floodlights and as such there is no likelihood of confusion.

C. There Is No Likelihood of Confusion Because the Goods Are Directed to Different Sophisticated Purchasers

It is well-settled that the likelihood of confusion is reduced where purchasers and potential purchasers of the products or services are sophisticated. See Electronic Design & Sales, Inc. v. Electronic Data Systems Corp., 954 F.2d 713, 718 (Fed. Cir. 1992) (no confusion between identical marks where, inter alia, both parties' goods and services "are usually purchased after careful consideration by persons who are highly knowledgeable about the goods or services and their source."). See also TMEP § 1207.01(d)(vii) (care in purchasing tends to minimize the likelihood of confusion). "In making purchasing decisions regarding expensive goods, the reasonably prudent purchaser standard [that is normally applied in determining likelihood of confusion] is elevated to the standard of the 'discriminating purchaser.'" Weiss Associates v. HTL Associates Inc., 14 U.S.P.Q.2d 1840, 1841-42 (Fed. Cir. 1990). See also Chase Brass & Copper Co., Inc. v. Special Springs, Inc., 199 U.S.P.Q. 243, 245 (T.T.A.B. 1978) (finding no likelihood of confusion between the identical marks BLUE DOT, one for automotive springs and the other for brass rod, because "while it is clear from the record of the present case that the goods of both parties are sold in a common industry, even to the same automotive manufacturers, nevertheless, there is no evidence of record to show that the marks identifying the respective products of applicant and opposer would ever be encountered by the same persons in an environment where a likelihood of confusion could occur."); T.M.E.P. § 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.")

The goods and services listed for the cited mark: Lighting tracks, downlighters, spotlights, floodlights, and fluorescent lamps . Applicant's goods and services include only light fixtures, namely, parabolic floodlights. The cited application's goods are directed to a completely different consumer market. The respective consumers would find the two goods entirely distinct and used in such separate markets that consumers would not believe the sources to be related. Applicant's goods are different, serve different purposes and are purchased by different customers. Accordingly, this factor weighs against a likelihood of confusion.

Since likelihood of confusion is not probable, the respective goods are distinct, and the marks and respective goods are directed to different target markets, Applicant respectfully requests that there are no potential 2(d) rejections with respect to the current application.

II. Section 2(d) Advisory: Prior-filed Applications

The Examining Attorney has cited two prior-filed applications. However both of these applications have been abandoned.

III. English Translation Requirement

The examining attorney has requested the Applicant to submit an English translation of the foreign wording in the mark "RIO". The following English translation is submitted:

The English translation of "RIO" in the mark is "RIVER".

IV. Conclusion

Passage of the application to publication is respectfully requested.