

## RESPONSE TO OFFICE ACTION

### I. Introduction

The Examining Attorney has refused Applicant's registration based on the conclusion that there is a likelihood of confusion with U.S. Registration No. 2832907 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 mark 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).

### II. Likelihood of Confusion Factors

The question of likelihood of confusion between marks 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." In re E.I. du Pont de Nemours & Co., 476 F.2d 1357, 1360-61 (C.C.P.A. 1973) (original emphasis). In determining whether there is a likelihood of confusion, courts look to many factors, including as particularly relevant here:

- The similarity or dissimilarity of the marks in their entirety;
- The similarity or dissimilarity and nature of the goods or services such that one party's goods will be mistaken for those of the other party;
- The channels of distribution of the goods or services;
- The conditions under which the goods or services are purchased (i.e. impulse buying versus purchases made after careful consideration);
- The sophistication of the purchasers of the goods or services;
- The number and nature of similar marks in use on similar goods or services; and
- The nature and extent of any actual confusion.

Id. at 1361.

The Examining Attorney has noted that, in this case, the most relevant factors are the similarity of the marks, the similarity of the goods and/or services and the similarity of the trade channels for the goods/services. Applicant addresses each of these factors in the sections below, along with the additional factors listed above.

Applicant respectively submits that an analysis of these factors here leads inevitably to the conclusion that no confusion will result between Applicant's Mark and the Cited Mark. While the marks are utilizing the same term "YUKON" Applicant's Mark is used in connection with a product that is not related to Registrant's goods and Applicant and Registrant offer their products, respectively, to sophisticated consumers in specialized and distinct markets. Accordingly, there is no real potential that the relevant purchasers would be confused as to the source of the parties' respective product and services.

#### **A. Applicant's Goods Are Not Similar to the Goods Offered under the Cited Mark**

There is no likelihood of confusion here because Applicant's product and the goods offered under the Cited Mark are different and offered to entirely disparate marketplaces. Applicant has applied to register YUKON in connection with Light fixtures, namely, bollards. By contrast, the Registrant goods are "battery-operated lamp, with headband, worn by an individual for sporting use". It is obvious that a bollard, which is a sturdy, short, vertical post with lights on it, is not going to be confused with a headlamp worn for hunting and sporting endeavors.

The Examining Attorney has refused to register the Applicant's Mark based on the assumption that the Applicant's goods and the Cited Registrant's goods are "of a kind that may emanate from a single source." Even where two marks are identical, courts and the TTAB routinely hold that there is no likelihood of confusion "if the goods or services in question are not related 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." TMEP § 1207.1(a)(i) (citing Local Trademarks, Inc. v. Handy Boys, Inc., 16 U.S.P.Q.2d 1156 (T.T.A.B. 1990) (LITTLE PLUMBER for drain opener not confusingly similar to LITTLE PLUMBER and Design for advertising services). Moreover, the Board has held that differences in the functions or purpose of products or services may prevent likelihood of confusion. Aries Systems Corp. v. World Book, Inc., 26 U.S.P.Q.2d 1926, \* 21 (T.T.A.B 1993) (KNOWLEDGE FINDER and INFORMATION FINDER are not confusingly similar because, inter alia, "[s]uch products, rather than being... simply computer programs utilized for facilitating research of medical and related scientific topics, are designed to search databases of vastly different levels of content for, concomitantly, significantly different purposes."). See also Reynolds & Reynolds Co. v. I.E. Systems, Inc., 5. U.S.P.Q.2d 1749, \* 12 (T.T.A.B. 1987) (no confusion where "applicant is offering a specific type of software for operational uses while the products and services offered by opposer...are applications software aimed at a very narrow field."). Here, the parties' respective products are wholly distinct.

The realities of the marketplace here compel the conclusion that reasonably prudent purchasers would not believe that bollards would be associated with headlamps. Thus,

Applicant's product cannot be considered "related" to the Cited Mark goods for likelihood of consumer confusion purposes. See Champions Golf Club, Inc. v. The Champions Golf Club, Inc., 78 F.3d 1111, 1118 (6th Cir. 1996) ("Services are 'related' if the services are marketed and consumed such that buyers are likely to believe that the services, similarly marked, come from the same source, or are somehow connected with or sponsored by a common company.") (internal quotes omitted).

**B. The Parties' Goods are Marketed in Different Channels of Trade and are only Purchased by Distinct and Sophisticated Consumers**

As the differences in the respective products offerings would suggest, the parties' market those offerings to very different marketplaces in distinct channels of trade. Applicant's product is marketed to individual consumers and businesses who need bollards to light and protect their businesses and homes.

Registrant's goods, on the other hand, are marketed to individuals who need a headlamp while participating in sporting activities.

Given these differences, it is highly unlikely that Applicant's and Registrant's respective products would be encountered by the same purchasers or under circumstances that could give rise to the mistaken belief that those goods came from a common source.

In addition, 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). Accordingly, where products or services are expensive, confusion is unlikely because the purchase is made after careful consideration in which the purchaser would be likely to become aware of the different sources of the products. See generally 3 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition § 23:96 (4th ed. 1998). On the facts present here, the degree of purchaser care exercised by Registrant's customers eliminates any realistic possibility of confusion.

**III. SECTION 2(d) ADVISORY: PRIOR-FILED APPLICATIONS**

The examining attorney has indicated that the filing dates of pending U.S. Application Serial Nos. 88203178 and 88203200 for YUKON GEAR precede applicant's filing date and if one or more of the marks in the referenced applications register, applicant's mark may be refused registration under Trademark Act Section 2(d) because of a likelihood of confusion with the

registered marks. Since the time of the issuance of the Office Action, the referenced marks have deleted class 11 from their registrations. Further their goods in class 11 were for headlamps, and as discussed above these goods are not similar to Applicants goods, are marketed in different channels and are purchased by very distinct consumers. As such, there is no likelihood of confusion between the marks.

#### IV. SECTION 2(e)(2) REFUSAL – PRIMARILY GEOGRAPHICALLY DESCRIPTIVE

The examining attorney has also refused Applicants registration claiming the applied-for mark is primarily geographically descriptive of the origin of applicant's goods. Trademark Act Section 2(e)(2), 15 U.S.C. §1052(e)(2); see TMEP §§1210, 1210.01(a). A mark is primarily geographically descriptive when the following is demonstrated:

- (1) The primary significance of the mark is a generally known geographic place or location;
- (2) The goods for which applicant seeks registration originate in the geographic place identified in the mark; and
- (3) Purchasers would be likely to make a goods-place association; that is, purchasers would be likely to believe that the goods originate in the geographic place identified in the mark. TMEP §1210.01(a); see In re Societe Generale des Eaux Minerales de Vittel S.A., 824 F.2d 957, 959, 3 USPQ2d 1450, 1452 (Fed. Cir. 1987); In re Hollywood Lawyers Online, 110 USPQ2d 1852, 1853 (TTAB 2014).

The examining attorney claims that the Yukon is known as territory in Canada. While the Applicant questions whether the primary significance of this mark is the fact it is a territory in Canada it really does not matter since the Applicant's goods do not originate in Canada and no purchaser would believe that the goods originate in the Yukon Territory.

The Trademark Act requires that the mark be primarily geographic. As one court has noted, "the wording of the statute makes it plain that not all terms which are geographically suggestive are unregistrable . . . Indeed, the statutory language declares nonregistrable only those words which are 'primarily geographically descriptive.' The word 'primarily' should not be overlooked, for it is not the intent of the federal statute to refuse registration of a mark where the geographic meaning is minor, obscure, remote, or unconnected with the goods." World Carpets, Inc. v. Dick Littrell's New World, 438 F.2d 482, 486 (5th Cir. 1971). Thus, "[t]he name of a geographic location that has no significant relation to commercial activities or the production of the relevant goods or services, such as ALASKA for bananas, is treated as an arbitrary mark because it is unlikely that consumers would believe that the mark identifies the place from which the goods [or services] originate. TMEP § 1210.04(d). As the TMEP further notes, "the names of places devoid of commercial activity are arbitrary usage." *Id.*, quoting In re Nantucket, Inc., 677 F.2d 95, 105, 213 U.S.P.Q. 889, 897 (C.C.P.A. 1982) (Nies, J., concurring). For example, "the names of mountains or rivers," such as "'Colorado River' for candy bars or 'Mount Rushmore' for automobiles," "are arbitrary for goods because no commercial activity is performed there." TMEP § 1210.04(d).

Like the river and mountain marks cited above, the dominant portion of Applicant's mark, YUKON, is not primarily geographically descriptive of its goods and services. Rather, the term YUKON in Applicant's mark is entirely arbitrary. Yukon (also commonly referred to as "The Yukon," and formerly as part of "the Yukon Territory") is the smallest and westernmost of Canada's three federal territories, with the smallest population of any province or territory in Canada, numbering 35,874 people as of the 2016 census. The Yukon's capital, and only city, is Whitehorse, with a population of 25,085, as of the 2016 census. The term "Yukon" does not refer to a single place of commercial activity, and certainly not one known for Light fixtures, namely, bollards; but, rather, refers to a vast, frigid Northwest Canadian territory which forms part of the "Arctic Circle." Moreover, there are many common references to the term "Yukon" in the context of the Klondike Gold Rush or Alaskan Gold Rush of the late 1800's. The term "Yukon," among other things, evokes an image of the early Western pioneers or rugged frontiersman and offers a sense of a historical time, and not of a certain place. "The Yukon" is also used in current speech as a metaphor for, vaguely, an uncharted space in the middle of nowhere, or a lifestyle off the grid.

Further, in assessing whether a geographic location is "generally known," the relevant purchasing public is "the average American consumer, and not the unusually well-traveled tourist." In re Brouwerij Nacional Balashi, 80 U.S.P.Q.2d at 1821. That is, how many people in the United States would know the location of, or the geographical significance of, "Yukon"? Where, as here, the geographic location at issue is not known for the type of goods or services at issue (or for any goods or services other than panned gold perhaps), and, further, the geographic location is remote or obscure, the mark will be viewed by consumers as arbitrary. See TMEP 1210.04(c). "Yukon" is not a "generally known" geographic area and simply would not be recognized as primarily a geographic designation by the relevant consuming public. Again, "Yukon" has multiple connotations, including the vast and remote Northwest Canadian region and its association with the Klondike Gold Rush of 1896-1899.

Furthermore, as the Federal Circuit has noted, to establish the services-place association requires not just evidence that the designation refers to a geographic place, but also that there is some reason for the consumer to associate the services with the geographic location invoked by the mark. See In re Les Halles de Paris J.V., 334 F.3d 1371, 1374 (Fed. Cir. 2003); citing In re Municipal Capital Markets, Corp., 51 U.S.P.Q.2d 1369, 1370-71 (TTAB 1999) ("Examining Attorney must present evidence that does something more than merely establish that services as ubiquitous as restaurant services are offered in the pertinent geographic location."). Contrary to the Examining Attorney's contention, Applicant's goods do not "originate in the geographic place identified in the mark." Rather, as indicated in the application, Applicant is located in California. Accordingly, consumers are not likely to primarily associate the YUKON mark with the geographic location of Applicant's goods. And, again, the term "Yukon" is not simply synonymous with a single town, city or place, but is a general reference to a large, isolated and sparsely populated region in Northwest Canada.

Finally, Applicant notes that a search of Trademark Electronic Search System (TESS) database reveals numerous registrations and applications for marks incorporating the term “YUKON,” for use in connection with a variety of goods and services. Since those marks have not been determined to be primarily geographically descriptive, Applicant contends that its YUKON mark is equally registrable, particularly in view of the fact that “Yukon” refers to a vast and remote Canadian territory with little commercial activity, and that it also evokes a sense of time (not place) in the eyes of the prospective consumer.

V. REQUEST FOR INFORMATION REQUIREMENT

The examining attorney has requested the Applicant to provide a written statement specifying where the goods will come from or will originate.

Neither the goods, or any part of the goods, will be manufactured, packaged, shipped from, sold in or will have any other connection with the geographic location named in the mark .

IV. CONCLUSION

Based on the significant differences between the Cited Mark and Applicant’s Mark in all of the aforementioned aspects, it is unlikely that the respective relevant consumers will confuse the goods offered under the Cited Mark with the product offered under Applicant’s Mark. There is also no geographic significance to the mark. In view of all of the foregoing, it is respectfully submitted that this application is now in condition for prompt publication and such favorable action is therefore requested.