

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): Crosscut Enterprises LLC	
Serial No.: 88441486	Law Office 117
Filed: 5/22/2019	
Mark: GORILLA SUPPORT	Examining Attorney: S. VENGURLEKAR
Attorney Docket No.: 025804.0001	

FIRST AMENDMENT

Box RESPONSES NO FEE
Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

Dear Sir:

In response to an Office Action from the Trademark Examining Attorney dated August 15, 2019, please amend the Trademark Registration Application identified above as follows:

REMARKS

PROPOSED AMENDMENTS:

In response to the Office Action, Applicant respectfully requests that the above-captioned application be amended as follows:

DESCRIPTION OF GOODS AND SERVICES

Amend the Description of Goods and Services to add the words " having metal cladding" and delete the words " and civil engineering" as follows:

Structural load bearing roof supports having metal cladding for underground mining ~~and civil engineering~~ applications.

DISCLAIMER

No claim is made to the exclusive right to use “SUPPORT” apart from the mark as shown.

SECTION 2(d) REFUSAL – LIKELIHOOD OF CONFUSION

The Trademark Office has refused registration of the application under Section 2(d), because of a likelihood of confusion with the mark in U.S. Registration No. 3312377 “GORILLA” for the following goods “Non-metallic building materials, namely, polyvinyl chloride (PVC) planks, rails, pickets, mounts and posts for fencing and floor decking” in Class 19.

The present application is for the mark "GORILLA SUPPORT" for use with "Structural load bearing supports for underground mining and civil engineering applications” in Class 19.

The Office Action states that the overall commercial impression of the applicant’s mark “GORILLA SUPPORT” is extremely similar to the cited registered mark “GORILLA”, and likely to cause confusion as to the source of the goods. Given the identical dominant term GORILLA, the two marks create a highly similar commercial impression, and consumers that encounter “GORILLA SUPPORT” and “GORILLA” are likely to believe that the goods emanate from the same source. Therefore, the marks are confusingly similar. given the identical dominant terms, the two marks create a highly similar commercial impression, and consumers that encounter “GORILLA SUPPORT” and “GORILLA” are likely to believe that the goods emanate from the same source. Therefore, the Trademark Office indicated that the marks are confusingly similar.

Further, the Office Action compared the goods and determined that they are similar, commercially related, or travel in the same trade channels. While the goods are not identical, the Office Action stated that evidence shows that purchasers are accustomed to encountering the building materials provided by applicant and registrant offered under the same mark, as well as sold or provided through the same trade channels. Therefore, purchasers are likely to believe the building materials of applicant and registrant emanate from the same source. Accordingly, the goods of applicant and the registrant are considered related for purposes of the likelihood of confusion analysis. The conclusion stated that the marks are confusingly similar and the goods

are closely related, and there is a likelihood of purchaser confusion as to the source of the goods. Therefore, registration was refused under Section 2(d) of the Trademark Act..

PRIOR-FILED APPLICATION

The Office Action conditionally refused or may suspend the present application based on pending U.S. Application Serial No. 88356695, with a filing date that precedes applicant's filing date. The referenced application is for "GORILLA WALL BRACES" in International Class 006 for "Construction elements made of metal, namely, braces". If the mark in the referenced application registers, applicant's mark may be refused registration under Trademark Act Section 2(d) because of a likelihood of confusion between the two marks. Upon receipt of applicant's response to this Office action, action on this application may be suspended pending final disposition of the earlier-filed referenced application.

RESPONSE TO 2(d) REFERENCES

Applicant respectfully submits that the proposed amendments to the description of goods and services is sufficient to distinguish the goods and services and respective consumers and trade channels, such that there is no likelihood of confusion by the respective consumers. Specifically, neither the non-metallic building materials, i.e., polyvinyl chloride (PVC) planks, rails, pickets, mounts and posts for fencing and floor decking associated with the GORILLA trademark, nor the construction elements made of metal, namely, braces for GORILLA WALL BRACES, would be related to underground mining applications. Both are marketed in residential and commercial trade channels for above-ground structures. As evidence, applicant submits samples of the products from the trademark owners' respective websites, showing PVC clad porch columns and railings for GORILLA (Exhibit A), and wall braces for GORILLA WALL BRACES (Exhibit B).

GORILLA Reg. No. 3312377

As indicated in Exhibit A, the registered mark GORILLA is used in association with polyvinyl chloride (PVC) planks, rails, pickets, mounts and posts for fencing and floor decking. Residential columns, posts and railings are wrapped in decorative and protective PVC outer layers to resist oxidation and weathering from sunlight. There are no metal clad products sold under the GORILLA mark, and the products would not be used for underground mine roof supports. Thus there is no likelihood of purchaser confusion as to the source of the goods.

Application S/N 88356695 for GORILLA WALL BRACES

As indicated in Exhibit B, the pending trademark application for GORILLA WALL BRACES applies to construction elements made of metal, namely, braces, and not to mine roof supports. The GORILLA WALL BRACE is used to stabilize bowing or buckling foundation walls of a residential basement. Galvanized steel beams brace foundation walls against outside soil forces pushing against it. The beams are attached to the concrete basement floor and the wooden joists overhead to stop a wall from buckling and moving inward. Thus, consumers of the wall brace system are not likely to be confused by registration of Applicant's trademark for GORILLA SUPPORT.

DISCLAIMER REQUIREMENT

Applicant is providing a disclaimer of the descriptive portion of the applied-for mark, to the wording "SUPPORT", as required in the Office Action, as follows:

No claim is made to the exclusive right to use "SUPPORT" apart from the mark as shown.

IDENTIFICATION/CLASSIFICATION OF GOODS

Applicant has amended the Identification of the Goods to specify the nature of the goods for proper classification, to include the words "having metal cladding", in International Class 006.

Applicant submits that the amended description of goods does not broaden or expand the goods beyond those in the original application.

MULTIPLE-CLASS APPLICATION REQUIREMENTS

The proposed amendment to the description of goods and services places the present application in a single International Class (006), therefore no additional filing fees are required.

ATTORNEY BAR INFORMATION AND ATTESTATION REQUIREMENT

Applicant’s attorney has provided the following bar information: (1) Pennsylvania Bar attorney identification number 50352; and (2) the name of the U.S. commonwealth, - Pennsylvania and (3) the year of admission to the bar. 1987, as required for all U.S.-licensed attorneys who are representing trademark applicants at the USPTO.

“I attest that I am an attorney who is an active member in good standing of the bar of the highest court of a U.S. state (including the District of Columbia and any U.S. Commonwealth or territory).”

Further consideration of the Application, as amended, is respectfully requested.

For the foregoing reasons, it is submitted that the present application is in condition for publication and registration, and such action is respectfully requested. Should any questions arise, the Examining Attorney is requested to contact Applicant's Attorney at the telephone number shown below.

Respectfully Submitted,

Spilman Thomas & Battle, PLLC

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