

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

U.S. Application Serial No. 88305417

Mark : DESIGN2CUT

Applicant : Westcott Plasma Inc.

Filed : February 18, 2019

Re: Response to Non-Final Office Action sent May 08, 2019

Dear Sir or Madam,

This letter is written in response to the Non-Final Office Action sent May 08, 2019. Applicant respectfully requests that the following responses and arguments be considered:

Section 2(d) Refusal – Likelihood of Confusion

As to the marks in U.S. Registration No. 5525592 Applicant acknowledges that Section 2(d) bars registration of an applied-for mark that is so similar to a registered mark that it is likely consumers would be confused, mistaken, or deceived as to the commercial source of the goods and/or services of the applicant and registrant, though notes that, while the analysis may begin with apparent similarities between the marks, the analysis further considers the similarity of the nature of services provided under the mark, the similarity of established trade channels associated with the mark, and the conditions under which consumers may encounter or engage with the mark. Applicant further notes that while “unrestricted and broad identifications are presumed to encompass all services of the type described,” such identifications are still subject to the restrictions identified in an application or registration.

Applicant first acknowledges that the various marks are similar in appearance, sound, connotation, and commercial impression since they are all for, generally, “DESIGN” and “CUT.” Applicant thus focuses on the nature of the services claimed in the various marks.

Applicant next narrows the services claimed in the present application to read: “Downloadable CAD/CAM software for operating electronic plasma cutting machines for industrial applications; Downloadable computer-aided design (CAD) software for operating electronic plasma cutting machines for industrial applications; ~~Downloadable computer-aided manufacturing (CAM) software for general use;~~ Recorded CAD/CAM software for operating electronic plasma cutting machines for industrial applications; Recorded computer-aided design (CAD) software for operating electronic plasma cutting machines for industrial applications.”

In summary Applicant has cancelled the most generic claim to specifically identify that Applicant operates solely in the “plasma cutting machines for industrial applications” field.

Applicant then notes that the registration at issue claims, as relevant, “downloadable computer programs in the field of crafts; recorded computer programs in the field of crafts; computer software for use in operating electronic cutting machines and electronic cutters in the field of crafts.” The applied-for mark, now, claims, as relevant, “Downloadable CAD/CAM software for operating electronic plasma cutting machines for industrial applications; Recorded CAD/CAM software for operating electronic plasma cutting machines for industrial applications.” Applicant proposes that the nature of services provided under the applied-for mark and the registered marks is now sufficiently distinct.

In the same vein, Applicant notes that the nature of established trade channels associated with the various marks is distinct. Applicant proposes that the average consumer to be considered in the present matter is either a person having authority to bind an industrial company having needs for plasma cutting equipment or an individual having need of craft-level cutting

machines. In either case the average consumer of the services provided by the applied-for and registered marks is likely to be a savvy consumer not easily confused by similarity between the marks, if any.

The registered mark, in view of its claims and its specimen of record operates solely in the personal use field. The specimen itself shows the mark used to advertise equipment within what appears to be a “big box” store. The applied-for mark, in view of the present claims and the specimen of record, on the other hand, operates solely in trade channels related to the industrial cutting industry. A buyer of Applicant’s equipment is not going to find it available for purchase at a Walmart, for example, and a buyer of Registrant’s equipment is not going to accidentally custom order or purchase an industrial-scale plasma cutting machine that could cost anywhere between \$15,000 and \$300,000. As such, Applicant proposes that the conditions under which consumers may encounter or engage with the applied-for mark and the registered marks are distinct, and that the intended consumers targeted by the two marks are savvy enough that they would not be confused.

For these reasons, Applicant respectfully requests that the Section 2(d) rejection be withdrawn as to the mark in U.S. Registration No. 5525592, and that a timely Notice of Allowance be issued in the present application.

Respectfully Submitted,

/Andrew Pharar, #75770/
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