

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Microtech Knives, Inc.	Examining Attorney:	Leslie Ann Thomas-Riggs
Serial Number:	88386152	Deposit Account:	602160
Filed:	4/15/2019	Customer Number:	153554
Mark:	PROTOCOL	Docket Number:	MTK-50-TM

RESPONSE TO OFFICE ACTION

Commissioner for Trademarks
P. O. Box 1451
Alexandria, VA 22313-1450

Dear Sir:

Please accept the following in response to the office action dated June 6, 2019, for the above-captioned Trademark Application.

Section 2(d) Refusal

The applied-for trademark PROTOCOL for fixed blade knives and folding knives stands rejected as being likely to be confused with U.S. Registration 2,293,072 for the service mark PROTOCOL for import and export agencies and distributorship in the field of gift items, cosmetic accessories, and desk accessories, drinkware, and serveware. Applicant respectfully requests reconsideration of the Section 2(d) rejection.

Applicant agrees that the *du Pont* factors provide the generally accepted framework for evaluating a likelihood of confusion between two marks. *In re E.I. du Pont De Nemours & Co.*, 177 U.S.P.Q. 563, 567 (C.C.P.A. 1973); *In re National Data Corp.*, 753 F.2d 1056, 1058 (Fed. Cir. 1985). When balancing the *du Pont* factors, no single factor should be treated as dispositive;

nor should the inquiry be mechanical by which the party with the greatest number of factors wins. *Nabisco II: Nabisco Inc Nabisco Brands Company v. Warner--Lambert Company*, 220 F.3d 43, 46 (2nd Cir. 2000). Instead, the focus should be on the ultimate question of whether consumers are likely to be confused. *Paddington Corp. v. Attiki Imps & Distribs., Inc.*, 996 F.2d 577, 584 (2d Cir. 1993).

For a trademark application, the two key considerations to a Section 2(d) rejection tend to be the similarity of the marks and the similarities between the goods. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098 (CCPA 1976) (“The fundamental inquiry mandated by §2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks”), *see du Pont*, 177 U.S.P.Q. at 567. Although the applied-for mark and the Registrant’s mark are the same, numerous examples exist of identical marks that create sufficiently different commercial impressions because the marks are used on different goods or services. *See, e.g., In re Sears, Roebuck and Co.*, 2 U.S.P.Q.2d 1312 (TTAB 1987) (CROSS-OVER for bras held not likely to be confused with CROSSOVER for ladies’ sportswear, the Board finding that the term was suggestive of the construction of applicant’s bras); *In re British Bulldog, Ltd.*, 224 U.S.P.Q. 854 (TTAB 1984) (PLAYERS for men’s underwear held not likely to be confused with PLAYERS for shoes); *In re Sydel Lingerie Co., Inc.*, 197 U.S.P.Q. 629 (TTAB 1977) (BOTTOMS UP for ladies’ and children’s underwear held not likely to be confused with BOTTOMS UP for men’s clothing).

In the present case, Applicant’s applied-for mark creates a completely different commercial impression compared to Registrant’s service mark. Specifically, Applicant is a well-known designer and manufacturer of high-end sport and collector’s knives. Applicant’s description of goods is “fixed blade knives and folding knives” in international class 8, which

“includes mainly hand-operated tools and implements for performing tasks, such as drilling, shaping, cutting and piercing.” NICE AGREEMENT ELEVENTH EDITION, 2019 (NCL 11-2019). In contrast, Registrant’s description of services is “import and export agencies and distributorship in the field of gift items” in international class 35, which includes

mainly services rendered by persons or organizations principally with the object of:

1. help in the working or management of a commercial undertaking, or
2. help in the management of the business affairs or commercial functions of an industrial or commercial enterprise,

as well as services rendered by advertising establishments primarily undertaking communications to the public, declarations or announcements by all means of diffusion and concerning all kinds of goods or services.

Id. The cited registration originally listed at least 23 different gift items and currently lists at least 10 different gift items, none of which have any relation to another except that they are all small gift items. Applicant respectfully asserts that Applicant’s trademark and Registrant’s service mark are in completely different international classes, and consumers of Applicant’s high-end sport and collector’s knives are not likely to also be consumers of Registrant’s import and export distribution services. Therefore, consumers are not likely to associate Applicant’s fixed blade knives and folding knives with Registrant’s “import and export agencies and distributorship in the field of gift items.”

Applicant is aware of existing caselaw finding a likelihood of consumer confusion between similar marks used on either goods or services related to those goods. In each case, however, the goods and services were **closely related**. For example, in *In re Detroit Athletic Co.*, 903 F.3d 1297 (Fed. Cir. 2018), consumers could understandably associate the registrant’s trademark for clothing goods with the applicant’s service mark for retail services for sports

apparel because sports apparel is a type of clothing. Similarly, in *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463 (Fed. Cir. 1988), consumers could understandably associate the registrant's trademark for furniture with the applicant's store services for retail grocery and general merchandise because the registrant's furniture is a type of general merchandise. Lastly, in *In re United Serv. Distribs., Inc.*, 229 USPQ 237 (TTAB 1986), consumers could understandably associate the applicant's distributorship services in the field of health and beauty aids with the registrant's moisturizing skin cream because skin cream is a health and beauty aid.

In the present case, the goods described in Applicant's applied-for trademark have no relation to Registrant's services. Although the cited registration lists "pocket knives" as one of many examples of gift items, fixed and folding blade knives are not closely related to Registrant's services for "import and export agencies and distributorship in the field of gift items." To conclude otherwise would improperly extend the scope of Registrant's service mark to virtually every imaginable good. Therefore, Applicant respectfully asserts that consumers are unlikely to associate Applicant's trademark with Registrant's service mark, and the readily observable differences between Applicant's goods and Registrant's services negates a likelihood of confusion between Applicant's mark PROTOCOL and the cited registration. For at least this reason, Applicant respectfully requests reconsideration and withdrawal of the Section 2(d) rejection and allowance of Applicant's mark for publication.

Conclusion

The undersigned believes that all outstanding issues raised by the Examining Attorney have been addressed, and it is respectfully submitted that the present application is in condition for allowance. The undersigned respectfully requests the Examining Attorney to telephone the

