

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of
Trademark : BEYOND
Serial No. : 88210968
Applicant : Trane International Inc.
Examiner : Jenny Park
Law Office : 104

Response to Office Action

Applicant amends its application to clarify the nature of its goods and services; notably, applicant specifies that its goods in classes 7 and 11 will be used in connection with intelligent building systems for commercial use. In the context of these amendments, Applicant’s goods and services are now sufficiently distinguishable from the cited registrant’s “air purification units,” and there is no likelihood of consumer confusion. Further, when taking into account the specialized nature of Applicant and the cited registrant’s distinguishable goods and the sophistication of their customers, it is clear that consumers will not be confused when confronted with both Applicant’s mark and the cited marks. At minimum, this application should be allowed to proceed to registration in connection with the goods and services in classes 09, 37 and 42.

I. Applicant’s Goods and Related Services are Distinguishable

Applicant amends its goods to align with its intended use of BEYOND, i.e. in connection with intelligent building systems and building automation and energy management. Notably, applicant amends its goods so that they are now completely unrelated to air purification units. Applicant also specifically limits the scope of its goods to specify that they will be used for commercial purposes.

For there to be a likelihood of consumer confusion, Applicant’s goods and the cited registrant’s goods need to be at least related. *In re Iolo Technologies, LLC*, 95 USPQ 2d 1498, 1499 (TTAB 2010). Applicant’s amended goods are not related to the cited registrant’s identified

goods, and therefore, there is no likelihood of consumer confusion. This application should proceed to registration.

II. Applicant's amended goods and services are specialized, their purchasers are sophisticated, and consumers will unlikely be confused

Another important factor to consider in determining whether there is a likelihood of consumer confusion is the condition of sale: whether purchasers are making an impulse or a sophisticated purchase. *See Calypso Technology Inc. v. Calypso Capital Management, LP*, 100 USPQ2d 1213 (TTAB 2011). Sophisticated consumers are likely aware of the industry in which they are making a purchase and further recognize whether or not the goods and services of that industry emanate from a single source. *Id.*

Applicant's identified goods and services are specialized, i.e. equipment and services related to intelligent building systems. Customers of these products are narrowly defined and highly sophisticated. These customers will take time to investigate the goods and services prior to purchase. Likewise, air purification units are also specialized goods; customers of these products are also likely to thoroughly investigate these products prior to purchase, especially since this product concerns ambient air quality. Both Applicant and the cited registrant's customers are not making an impulse purchase; rather, these customers are sophisticated.

When taking into account the specialized nature of Applicant and Registrant's goods and the sophistication of their customers, it is clear that these consumers will not be confused when confronted with both Applicant's Mark and the cited marks. This application should therefore proceed to registration.

III. Conclusion

Applicant's amends its application to clarify the nature of its goods. In the context of these amendments, Applicant's goods are now sufficiently distinguishable from the cited registrant's

“air purification units,” and there is no likelihood of consumer confusion. Further, Applicant and the cited registrant’s distinguishable goods are specialized, and their customers are sophisticated and unlikely to be confused. Applicant therefore respectfully requests that this application be allowed to proceed to registration. At minimum, this application should be allowed to proceed to registration in connection with the goods and services in classes 09, 37 and 42.