

IN THE UNITED STATES
PATENT AND TRADEMARK OFFICE

Applicant: Ontel Products Corporation

U.S. Serial No.: 88/351,739


Mark: GOPHER PRO & Design



Filed: March 22, 2019

Attention: Ashley Ojeyemi
Examining Attorney, USPTO
Law Office 128
(571) 270-3399
ashley.ojeyemi@uspto.gov

RESPONSE TO OFFICE ACTION DATED JUNE 13, 2019

The Trademark Examining Attorney issued an Office Action on June 13, 2019 concerning the above-referenced application for registration of GOPHER PRO & Design  in connection with “[h]and held tool for grabbing and picking up objects” in Class 8 (the “Applicant’s Mark”) owned by Ontel Products Corporation (the “Applicant” or “Ontel”). Specifically, the Examining Attorney has refused registration under Trademark Act Section 2(d) on the basis that the Mark is confusingly similar to U.S. Registration for GOPHER PRO (Reg. 3837608) for “manually operated hand tool, namely, pole used in wire installation” in Class 8 owned by SECO Manufacturing Company, Inc. (the “Cited Mark”).

The Examining Attorney has required Applicant to amend the identification of goods. An amendment has been made as indicated below and herein submitted with this response.

Based on the foregoing reason, Applicant respectfully requests the Examining Attorney to withdraw the 2(d) refusal and allow registration of Applicant’s Mark in International Class 8:

I. THE LIKELIHOOD OF CONFUSION CLAIM SHOULD BE DROPPED

A. Applicant's Registration for GOPHER Pre-Dates the Cited Mark

As an initial matter, Ontel maintains a registration for GOPHER (Reg. 2826979) in connection with "hand-held tool consisting of an extendable rod and a suction gripper at one end used to reach objects in high places and for picking up objects" in Class 8. A copy of the USPTO record for this mark is included in Exhibit 1. This mark was applied for May 17, 2002 and was registered on March 30, 2004. Contrastingly, the Cited Mark was applied for on January 21, 2010, more than 8 years after Ontel's GOPHER registration, and registered on August 24, 2010. Applicant's own registration for GOPHER predates the Cited Mark.

Applicant's Mark is a legal equivalent to Applicant's GOPHER registration. Its application for GOPHER PRO is nearly identical to the literal elements of Applicant's GOPHER registration. Applicant's Mark should therefore gain priority over the Cited Mark by tacking onto the registration date of Applicant's prior GOPHER registration. For the purposes of tacking, the marks must create "the same, continuing commercial impression." See TMEP §1212.04(b). See *Van Dyne-Crotty Inc. v. Wear-Guard Corp.*, 926 F.2d 1156, 17 USPQ2d 1866 (Fed. Cir. 1991); *Ilco v. Ideal Security Hardware Corp.*, 527 F.2d 1221, 188 USPQ 485 (CCPA 1976) ("The law permits a user who changes the form of its mark to retain the benefit of its use of the earlier form, without abandonment, if the new and old forms create the same, continuing commercial impression"); *Baroid Drilling Fluids Inc. v. Sun Drilling Products*, 24 USPQ2d 1048 (TTAB 1992).

The goods in both Applicant's Mark and Applicant's GOPHER registration cover the same goods and services in Classes 8 and as such consumers would not differentiate the two marks as they apply to the same class of goods and are used in the fashion that consumers would recognize. Indeed, the GOPHER PRO product is an enhancement over Applicant's prior GOPHER product, yet is still the same grabbing/reaching tool to enable users to reach an item typically out of grasp:

Applicant's GOPHER PRO Product:

Applicant's GOPHER Product:



**GOPHER
PRO**



A minor difference in the marks such as mere pluralization or an **inconsequential modification** of a later mark will not preclude application of the rule. See *In re Loew's Theatres, Inc.*, 223 USPQ513 (TTAB 1984) aff'd, 769 F.2d 764, 226 USPQ 865 (Fed. Cir. 1985); *Laura Scudder's v. Pacific Gamble Robinson Co.*, 136 USPQ 418, 419-20 (TTAB 1962) (Board permitted tacking of the mark "BLUE BIRD" to the use of "BLUE ROBIN" because both marks "create substantially the same general impression, namely, that of a blue-colored bird") (emphasis added).

The overall general commercial impression created by each of Applicant's GOPHER marks is the same. Further, they have the same visual and aural impression and share the same meaning in the mind of the consumer. An inconsequential modification such as adding the term "PRO" onto the dominant element "GOPHER" still retains the same trademark impact and symbolizes a single and continuing commercial impression upon the minds of the consumers, as "Pro" indicates an enhancement on the prior GOPHER product. *See Ilco v. Ideal Security Hardware Corp.*, 527 F.2d 1221, 188 USPQ 485 (CCPA 1976).

Based on the foregoing, Applicant's marks pre-date the Cited Mark based on its other GOPHER registration. Applicant respectfully requests the Examining Attorney to withdraw the 2(d) refusal and the citation to the prior filed application.

B. There Is No Likelihood of Confusion with the Cited Registration

Further, the Cited Mark is registered for "a manually operated hand tool, namely, **pole used in wire installation**" (emphasis added). In fact, the product itself includes the words "wire installation tool" directly underneath GOPHER POLE:



<https://www.surveying.com/en/gopher-pole-wire-installation-tool.html>

The Cited Mark's website also establishes that the goods are used in a narrow capacity: as a tool used to help with wire installation for "interior construction applications like suspended ceilings, sub-floors, crawl spaces, and attics" See Exhibit 2. Images of the product in use to "telescope" a wire through a ceiling by a worker are included directly next to images and the description of the product. See below and also Exhibit 2.



The company’s website states that its reputation is known “for being on the cutting edge of **designing and manufacturing tools and accessories for surveying, construction, utilities** and other industries that use GPS/GNSS technology” (emphasis added) in the About Us section. See Exhibit 2. This product is clearly marketed to a highly specialized, technical consumer, as the use is for construction purposes and those trained for electrical wiring.¹

In sharp contrast, Applicant’s Mark **GOPHER PRO**, is used for a product entirely unrelated to the goods of the Cited Mark and is a device with a suction gripper at one end used to reach objects in high places for grabbing and picking up objects by the average, every day consumer. It is not for use in the highly specialized construction industry. This is also demonstrated by the images on Applicant’s website and on the **GOPHER PRO** packaging itself:



¹ If the Trademark Office continues to maintain that the goods are related, it is unclear how **GOPHER POLE** was able to register in view of Applicant’s prior **GOPHER** registration. Applicant requests consistency with the examination of its marks.

Grips, Locks, & Won't Shake Loose!

Great For All This & More!

Order Now!



Top Shelf



Bottom Shelf



Behind the Couch

<https://www.buygopherpro.com/>

Hence, the Cited Mark is used and registered in connection with a very narrow capacity in mind which is clearly indicated not only on the packaging of the product but also on the product's website as noted above. The goods description is very narrow, limited only to “**wire installation**” and targeted to an entirely unrelated consumer than that of the Applicant: tools for surveying and construction utilities for the purpose of installing wires. The Applicant's Mark is used for none of these things. Therefore, the likelihood of Applicant's products being sold directly alongside this Cited Mark's product to the same consumers is highly unlikely and should diminish any concern for confusion.

II. IDENTIFICATION OF GOODS AND SERVICES

The Examining Attorney has requested the Applicant to amend the identification of goods in the application because “hand held tool” is indefinite and must be clarified. Applicant has amended the identification as suggested, which is consistent with Applicant's similar GOPHER registration cited above:

Class 8: Hand held tool, namely, a reaching device for grabbing and picking up objects

This amendment has been submitted herein.

III. CONCLUSION

Based on the foregoing response, Applicant herein requests the Examining Attorney remove the 2(d) refusal issued against the Mark, accept the proposed amendment, and allow the Mark to proceed to publication.

December 13, 2019

Respectfully submitted,

 /Carly Fraker/

Jenny T. Slocum
Carly D. Fraker
Dickinson Wright PLLC
1825 Eye Street, NW, Suite 900
Washington, DC 20006
Phone: (202) 659-6927
Email: JSlocum@dickinsonwright.com
CFraker@dickinsonwright.com