

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

**Mark:** VICTUS  
**International Classes:** 007 & 039  
**Serial No.:** 88/371629  
**Applicant:** Weatherford Technology Holdings, LLC  
**Filing Date:** April 4, 2019  
**Docket No.:** AWEAT.0537  
**Examiner:** Lyal Fox

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

**RESPONSE TO OFFICE ACTION**

In response to the Priority Office Action dated June 17, 2019, Applicant hereby presents the following amendments and arguments with regard to the above-identified application as follows:

**I. Introduction**

The Examiner has refused registration of Applicant's "VICTUS" ("Applicant's Mark") based on the assertion that there is a likelihood of confusion between Applicant's Mark and U.S. Trademark Reg. No. 5024428 for "VECTUS" ("Cited Mark"). Additionally, the Examiner has issued an identification/clarification requirement, as well as a clarification of the number of classes to be registered.

**II. Likelihood of Confusion**

Regarding the likelihood of confusion between Applicant's Mark and the Cited Mark, the Examiner asserts that Applicant's Mark and the Cited Mark are similar to such a degree that a

professional sophisticated consumer may experience confusion as to the source of goods/services offered under Applicant's Mark and the Cited Mark. Applicant disagrees and offers the following response.

The question of likelihood of confusion between marks is "related not to the nature of the mark but to its effect 'when applied to the goods of the applicant.' The only relevant application is made in the marketplace. The words 'when applied' do not refer to a mental exercise, but to all of the known circumstances surrounding use of the mark." *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1360–61 (C.C.P.A. 1973). Courts will consider many factors when determining likelihood of confusion; the relevant factors are listed below:

- Sophistication of the Buyer;
- Dissimilarity of the goods/services;
- Dissimilarity of the Marks
- Dissimilarity of established, likely-to-continue trade channels.

*Id.* at 1361.

#### **A. Buyers are Professional**

Products identified by Applicant's Mark and the Cited Mark are going to be exclusively sold to "professional" consumers because of the extraordinary cost associated with oil production and the extremely high degree of technical knowledge and effort required to complete a transaction for a system offered under Applicant's Mark and the Cited Mark. *See Dynamics Research Corp. v. Langenau Mfg. Co.* 704 F.2d 1575, 1576 (Fed. Cir. 1983) (stating that the purchasing agents were sophisticated enough to distinguish between sources of goods); *Hewlett-Packard Col. v. Human Performance Measurement Inc.*, 23 U.S.P.Q. 2d 1390, 1394–95 (T.T.A.B. 1991); *see also John Crane Production Solutions, Inc. v. R2R and D, LLC*, 861 F.

Supp. 2d 792 (N.D. Tex. 2012) (denying preliminary injunction because purchasers of oil rig equipment are “*highly sophisticated*” buyers).

In *John Crane Prod. Solutions, Inc. v. R2R & D, LLC*, the court determined that the potential buyers were “*highly sophisticated*” buyers of oil rig equipment—i.e. fiberglass sucker rods—and that fact cut against the likelihood of confusion between the “FIBEROD” mark and “FINALROD” mark. See *John Crane*, 861 F. Supp. 2d at 801. Looking at the facts in *John Crane*, the court considered the fact that a potential purchaser would have to analyze and digest a large amount of technical data about each well and custom tailor the purchase to meet each well’s unique specifications when it came to its determination that the potential purchasers were *professionals*. See *id.*

Similarly, in the present case, the potential purchasers qualify as highly sophisticated and *professional*. For example, negotiations between the Applicant and a potential buyer can take a year or more to complete. (Declaration of James Kurka, Ex. A, ¶ 3). The system has to be specifically customized for each rig, as well as conform to the buyer’s preferences. (Ex. A, ¶ 4). This customization process can require fifty (50) weeks of lead time and up to six months to organize depending on the actions and choices of the potential buyer. (Ex. A, ¶ 4). Thus, potential purchasers of the system (goods/services) offered under Applicant’s Mark have to analyze and digest a vast amount of technical data and custom tailor the purchase to meet unique specifications. Furthermore, the total cost of the system can be anywhere from \$10 Million and \$20 Million or more, depending on the specific needs of the buyer. The daily operating cost to run the system can range from \$10,000/day to \$30,000/day depending on the entity that the purchaser utilizes to operate the system.

While it is not out of the realm of possibilities that a *professional* buyer may, from time to time, momentarily get confused, the question is whether an appreciable number of *professional* buyers would get confused. See *7-Eleven, Inc., v. Lawrence I. Wechsler*, 83 U.S.P.Q. 2d 1715, 1725 (T.T.A.B. 2007); see also 4 MCCARTHY ON TRADEMARKS § 23:91, p. 23–415, 416 (2018). In this case, given the amount of money, time, effort, and expertise is required to complete a transaction for a system offered under Applicant’s Mark, the potential purchasers are exclusively *professionals*, and that fact weighs against a determination of likelihood of confusion between Applicant’s Mark and the Cited Mark.

**B. Dissimilarity of the Goods/Services**

While both Applicant’s Mark and the Cited Mark are related to oil and gas production on a high conceptual level, the offered goods and services are distinctively different because each focus on primarily different aspects of the mineral extraction process. Specifically, the good/services offered under Applicant’s mark concern **managing** the annular pressure during drilling operations. The Examiner is correct by stating that the annular pressure is the pressure in the void between an outer piping and an inner pipe in an oil well. The key item to focus on in Applicant’s description of the goods/services is the **managing** aspect.

To emphasize, the goods/services offered under Applicant’s Mark **manage** the annular pressure for the professional consumer. This involves advanced hydraulics modeling, a unique intelligent control system, and sophisticated infrastructure in order to provide increased level of automation to the production process. (VICTUS Webpage Ex. B, pg. 2; Weatherford Press Release, Ex. C, pgs. 1–2). Furthermore, the goods/services offered under Applicant’s Mark are offered to land-based oil extractors, as well as subsea based oil extractors. By contrast, the

offered goods/services under the Cited Mark appear to be only intended for subsea production operation. (VECTUS Webpage, Ex. D, pgs. 1–2; VECTUS Registration, Ex. E, pg. 1) (describing the associated goods/services as intended for subsea for both international classes 007 and 009).

The goods/services offered under the Cited Mark are also directed at Subsea Electronic Modules (“SEM”). While SEMs offered under the Cited Mark are concerned with **monitoring** the pressure in an oil well, in this context, **monitoring** is a passive term. Whereas, Applicant’s use of the **managing** term has an active connotation. The goods/services required to **manage** annular pressure are going to be distinctively different than the goods/services only required to **monitor** pressure in an oil well. Therefore, the goods/services offered under Applicant’s Mark are sufficiently dissimilar from the goods/services offered under the Cited Mark to weigh against a finding of likelihood of confusion.

### C. Dissimilarity of the Marks

Applicant’s Mark is sufficiently dissimilar from the Cited Mark because each mark is a unique Latin word that is suggestive regarding each mark’s related offered goods/services such that each has a distinct commercial impression capable of functioning as an indicator of source without the likelihood of confusion. For example, Applicant’s Mark is Latin for “nourishment”, “provisions”, or “that which sustains life”, etc. (Victus Definition, Ex. F, pg. 1). And the Cited Mark is Latin for “bear, carry, convey” or “pas, ride, sail.” (Vectus Definition, Ex. G, pg. 1). Latin and words derived from Latin are prevalent to such a degree in the English language that even though a professional purchaser may not be able to speak Latin, a professional purchaser is going to recognize that both marks are connected to the Latin language and presume that each

has a distinct meaning. As a result, each mark is going to convey a unique commercial impression. Accordingly, the fact that Applicant's Mark and the Cited Mark are composed exclusively of a single Latin word with a unique commercial impression weighs against a finding of likelihood of confusion between the marks.

#### **D. Channels of Trade are Dissimilar**

As stated previously, goods/services offered under Applicant's Mark are marketed to oil producers that extract oil from land-based oil wells and subsea wells. The goods/services offered under the Cited Mark however appear to be offered only to subsea oil producers. While there is going to be some crossover when it comes to the channels of trade for subsea oil production, the goods/services offered under the Cited Mark are never going to enter the channels of trade that exclusively cater to land-based oil production. Thus, the channels of trade factor leans against a finding of likelihood of confusion between Applicant's Mark and the Cited Mark.

#### **E. Weighing the Factors**

To summarize the likelihood of confusion analysis, all of the relevant factors weigh against a finding of likelihood of confusion because (1) the intended buyers of goods/services under both Applicant's Mark and the Cited Mark are *professionals*, (2) the offered goods/services are dissimilar because Applicant's goods/services relate to **managing** annular pressure and the goods under the Cited Mark only **monitor** pressure, (3) the marks themselves are dissimilar because each is a different Latin word with a distinct commercial impression, and (4) the offered goods/services under the Cited Mark are exclusively marketed toward subsea oil procedures and will never enter into the same channels of trade that the land-based oil extraction goods/services offered under Applicant's Mark travel through. Therefore, based on the weight of

all of the relevant factors combined, there is not a likelihood of confusion between Applicant's Mark and the Cited Mark. As such, Applicant respectfully requests that the Examiner remove the likelihood of confusion analysis from Applicant's application.

### **III. Identification/Classification of Goods /Services Requirement**

The Examiner has asserted that the identified classes for Applicant's goods/services is in need of clarification because Applicant's identified goods/services could potentially fall under other international classes such as class 042. Applicant appreciates the Examiner pointing out Applicant's need to clarify the goods/services offered under Applicant's mark. Therefore, Applicant hereby amends the identification of goods as referenced below:

Class 007: Oilfield system for managing annulus pressure during drilling operations **comprised of integrated rig equipment designed to detect, control, and circulate out influxes.**

Class 037: Oilfield drilling services, namely, **rig equipment integration, real-time analysis, and facilitate rapid automated responses** to manage annulus pressure during drilling operations.

These amendments should satisfy the Examiner's requirement that Applicant clarify the identification/classification of goods/services and should indicate that the inclusion of additional classes is not required. At this point, Applicant feels the need to point out that the Trademark Manual of Examining Procedure ("TMEP") explicitly excludes mining and oil extraction from the type of goods/services that should be identified under international class 042. TMEP § 1401.02(a) (2018). Thus, Applicant respectfully requests that the Examiner remove the identification/classification of goods/services requirement.

**IV. Conclusion**

If any issues remain, the Examiner is invited to call the undersigned attorney at 972.367.2001.

December 17, 2019  
Date: \_\_\_\_\_

Respectfully submitted,

/David W. Carstens/  
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