Trademark: HORIZON (Stylized)
Serial No.: 88-523,466

December 19, 2019

The Examining Attorney has refused registration of the applied-for mark in Class 9 only under Section 2(d) of the Trademark Act because of alleged likelihood of confusion with the mark in U.S. Registration No. 5444154. Applicant respectfully requests that this refusal of registration be reconsidered and withdrawn.

The Goods of the Parties are Unrelated

The goods identified in the cited registration and in the present application (as now amended) are as follows:

Class 9 Goods in Reg. No. 5444154	Class 9 Goods in the Present Application
Computer software for administration of computer networks; Computer software for monitoring and controlling computer hardware and software over a network; Computer software for monitoring and controlling computer hardware and software over a network that may be downloaded from a global computer network; Downloadable computer software for monitoring and controlling computer hardware and software over a network; Downloadable software for monitoring and controlling computer hardware and software over a network; Downloadable cloud-computing software for monitoring and controlling computer hardware and software over a network	Downloadable computer software applications used for communications between computers and automated machine systems for evaluating the workflow systems, barcode verification systems and inspection systems of stitching and folding machines, spine taping machines, paper counters, paper joggers, bookbinding machines and bookbinding machines for office use, mimeographs, perforating machines, paper binding machines, paper collators and paper collators for office use, paper cutters and paper cutters for office use, paper folding machines and paper folding machines for office use, paper hole punches, paper trimmers for office use and staplers for office use

Other than the fact that both parties use their respective marks in connection with the general category of software, there is no similarity or relatedness between applicant's downloadable software used for communication between computers and automated systems for evaluating the workflow, bar code verification and inspection systems of specific types of machinery (stitching and folding machines, spine taping machines, bookbinding machines, etc.), and the prior registrant's computer software for administration of computer networks and monitoring and controlling computer hardware and software over networks. Applicant's downloadable software mediates between computers and specified categories of computer-controlled machinery used in an office or printshop environment for producing bound, folded and collated paper materials such as books, booklets and catalogs. The software of the cited registrant administers and controls network hardware and software and cloud computing software but does not relate to the control

or evaluation of any automated machinery, much less the specialized binding, cutting, stitching and other types of machinery which applicant's software controls and monitors.

The differences between the goods of the registrant and those of the applicant and the situations in which they would be encountered by potential purchasers are so great that a likelihood of confusion does not exist despite the substantial identity of the parties' trademarks. Indeed, the respective goods of the parties are entirely different in their nature, function, intended purposes and ultimate uses as well as the channels of commerce through which they travel and the customers to whom they are offered.

As the Trademark Manual of Examining Procedure states in Section 1207.01(a)(i):

> "Conversely, if the goods or services in question are not related or marketed in such a way that they would be encountered by the same persons in situations that would create the incorrect assumption that they originate from the same source, then, even if the marks are identical, confusion is not likely. See, e.g., *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1371, 101 USPQ2d 1713, 1723 (Fed. Cir. 2012) (affirming the Board's dismissal of opposer's likelihood-of-confusion claim, noting "there is nothing in the record to suggest that a purchaser of test preparation materials who also purchases a luxury handbag would consider the goods to emanate from the same source" though both were offered under the COACH mark); *Shen Mfg. Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 1244-45, 73 USPQ2d 1350, 1356 (Fed. Cir. 2004) (reversing TTAB's holding that contemporaneous use of RITZ for cooking and wine selection classes and RITZ for kitchen textiles is likely to cause confusion, because the relatedness of the respective goods and services was not supported by substantial evidence); *Local Trademarks, Inc. v. Handy Boys Inc.*, 16 USPQ2d 1156, 1158 (TTAB 1990) (finding liquid drain opener and advertising services in the plumbing field to be such different goods and services that confusion as to their source is unlikely even if they are offered under the same marks); *Quartz Radiation Corp. v. Comm/Scope Co.*, 1 USPQ2d 1668, 1669 (TTAB 1986) (holding QR for coaxial cable and QR for various apparatus used in connection with photocopying, drafting, and blueprint machines not likely to cause confusion because of the differences between the parties' respective goods in terms of their nature and purpose, how they are promoted, and who they are purchased by)."

(emphasis added).

All of the factors listed in the above TMEP excerpt which were held to be sufficient to distinguish the goods sold by respective trademark owners and to avoid a likelihood of confusion between their marks are present in this case. In the real world, the potential purchasers of applicant's goods and the customers for the goods of the prior registrant are a different class of business entities and the goods themselves are so unrelated that no misleading association of applicant's goods or trademark with the goods or mark of the prior registrant is likely to occur.

Moreover, there is no real-world interface between the goods sold by the prior registrant under its HORIZON mark and applicant's HORIZON goods. The goods are wholly non-competitive. The parties would not serve or solicit the same customers or potential customers with respect to the goods sold under their marks, would not appear at the same trade shows or exhibitions and would not advertise through the same type of print or online media.

It should be further noted that the categories of software set forth in both the cited registration and those in the present application are specialized and complex and would normally be purchased by information technology specialists, systems engineers or persons highly knowledgeable in network technology or in the use and operation of automated paper cutting, collating, binding and punching machines, all of whom are sophisticated and make careful decisions as to the nature and characteristics of the software products they buy. These facts militate against a likelihood of confusion. As Professor McCarthy states:

> "Where the relevant buyer class is composed solely of professional or commercial purchasers, it is reasonable to set a higher standard of care than exists for consumers. Where the relevant buyer class is composed only of professionals or commercial buyers familiar with the field, they are usually knowledgeable enough to be less likely to be confused by trademarks that are similar. Such professional buyers are less likely to be confused that the ordinary consumer."

McCarthy on Trademarks, §23:101.

There is no likelihood that any of the prospective purchasers of applicant's HORIZON software would be confused into associating such goods or the source thereof with the prior registrant's network controlling and monitoring software, which has no relevance to any of the applications or features for which applicant's goods will be purchased.

The Mark HORIZON is Widely Used and Diluted in the Software Field

Another factor tending to negate any likelihood of confusion between applicant's mark HORIZON and the cited mark HORIZON as applied to the respective goods of the parties is that "Horizon" is the subject of many co-existing active registrations in the USPTO for computer software products in Class 9, including software for monitoring and/or controlling various types of systems. For example, attached hereto as Exhibit A are copies of the following certificates of registration. All of these pertain to the mark HORIZON in standard character format; all are owned by different parties; and all pertain to computer software, including in some instances software for controlling and monitoring various devices or systems:

Mark	Reg. No.	Reg. Dt.
HORIZON	2769275	September 30, 2003
HORIZON	3922649	February 22, 2011
HORIZON	4309222	March 26, 2013
HORIZON	4769638	July 7, 2015
HORIZON	5223376	June 13, 2017
HORIZON	5404382	February 20, 2018
HORIZON	5425941	March 20, 2018

All of the registrations shown in Exhibit A issued prior to Reg. No. 5444154 cited herein, and yet the cited registration was issued by the USPTO in the face of these registrations. This was obviously because of the differences in the nature of the cited registrant's computer software and the software described in the prior registrations of HORIZON.

Moreover, there have been numerous registrations issued by the USPTO for the mark HORIZON in connection with various types of computer software after and in the face of cited Registration No. 5444154 for HORIZON. Certificates of the following illustrative registrations are shown in Exhibit B attached hereto:

Mark	Reg. No.	Reg. Dt.
HORIZON	5461625	May 8, 2018
HORIZON	5492534	June 12, 2018
HORIZON	5553009	September 4, 2018

In view of the state of the Register it is clear that HORIZON is a widely diluted term in the computer software field used by many different parties. These trademarks coexist without conflict because of the differences in the nature and function of the goods and the fact that the purchasing decisions for such products are made by sophisticated persons knowledgeable in their specialized fields who make careful buying decisions and are not likely to be confused.

Conclusion

It is respectfully requested that the refusal of registration under Section 2(d) be withdrawn and the application accepted for publication.