

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Mark:	SOLSTICE)	
Filed:	April 11, 2019)	Serial No. 88/381,619
Applicant:	OmniMax International, LLC)	
Attorney Docket No.:	074598.0072)	
Examining Attorney:	D. Beryl Gardner)	
	Law Office 117)	
)	

Commissioner for Trademarks
P.O. Box 1451
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RESPONSE TO OFFICE ACTION

In response to the U.S. Patent and Trademark Office (“USPTO”) Action dated June 21, 2019, Applicant provides the following information and arguments.

I. Background

The Examining Attorney has refused registration of Applicant’s mark SOLSTICE (word mark) based upon a likelihood of confusion with a prior registration, SOSTICE for use in connection with “solar roofing system, namely, non-metal roofing shingles, tiles, panels and membranes containing photovoltaic cells” in Class 019 (U.S. Reg. No. 4411965). For the reasons discussed below, this mark is unlikely to cause a likelihood of confusion with the proposed mark for use in connection with metal roofing, metal louvered roofing, metal prefabricated roofing, metal roof flashing, and metal siding.

The examining attorney also provided an advisory for a prior-filed application, which is separately addressed below.

II. Likelihood of Confusion

Likelihood of confusion between a mark for which registration is sought and a previously registered mark or prior pending mark is determined on a case by case basis, applying the factors set out in *In re E. I. du Pont De Nemours & Co.*, 476 F. 2d 1357, 1361, 177 U.S.P.Q. 563, 567 (C.C.P.A. 1973); and in *Packard Press, Inc. v. Hewlett Packard Company*, 227 F. 3d 1352, 56 U.S.P.Q. 1351 (Fed. Cir. 2000). The *du Pont* factors are (1) the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation, and commercial impression; (2) the similarity or dissimilarity and nature of the goods described in the application or registration of the mark, or in connection with which a prior mark is in use; (3) the similarity or dissimilarity of established, likely-to-continue trade channels; (4) the conditions under which and the buyers to whom sales are made; (5) the fame of the prior mark; (6) the number and nature of similar marks in use on similar goods; (7) the nature and extent of any actual confusion; (8) the length of time

during and the conditions under which there has been concurrent use without evidence of actual confusion; (9) the variety of goods on which a mark is or is not used; (10) the market interface between the applicant and the owner of a prior mark; (11) the extent to which the applicant has a right to exclude others from use of its mark on its goods; (12) the extent of potential confusion; and (13) any other established fact probative of the effect of use. See *In re E. I. du Pont de Nemours & Co.*, 476 F. 2d 1357, 177 U.S.P.Q. 62 (C.C.P.A. 1973); *In re National Data Corp.*, 753 F. 2d 1056, 1058, 224 U.S.P.Q. 749, 750-51 (Fed Cr. 1985); TMEP Section 1207.01; 15 U.S.C.A. § 1052(d).

In *ex parte* examination, the issue of likelihood of confusion typically focuses on the similarity or dissimilarity of the marks and the relatedness of the goods or services. TMEP Section 1207.01. However, other factors listed above may be considered if relevant evidence is contained in the record. See *In re National Novice Hockey League, Inc.*, 222 U.S.P.Q. 638, 640 (TTAB 1984).

A. Applicant's goods are dissimilar from those offered by the cited registrant

One of the most important factors in determining whether likelihood of confusion exists is the difference between the goods or services at issue. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 192 U.S.P.Q. 24, 29 (C.C.P.A. 1976). The goods or services provided under the respective marks must be compared to determine if they are related or if the activities surrounding their marketing are such that confusion of origin is likely. See *In re E. I. du Pont* 177 U.S.P.Q. 562 (C.C.P.A. 1973). It is quite possible for no likelihood of confusion to exist between even identical marks when the goods or services to which the marks are applied are unrelated in such a manner that customers are not likely to assume those goods share a common source.

Applicant's mark is applied to the following goods:

In International Class 006: metal roofing; metal louvered roofing; metal prefabricated roofing; metal roof flashing; metal siding.

Registrant's mark identifies goods in International Class 019: solar roofing system, namely, non-metal roofing shingles, tiles, panels and membranes containing photovoltaic cells.

The Examining Attorney argues that the goods are sufficiently related so as to result in the likelihood of confusion. As a principal matter, the examining attorney has presented no evidence to demonstrate how the goods of the applicant are related to the goods of the registrant. The examining attorney must provide evidence showing that the goods and services are related to support a finding of likelihood of confusion. See, e.g., *In re White Rock Distilleries Inc.*, 92 U.S.P.Q.2d 1282, 1285 (TTAB 2009) (finding Office had failed to establish that wine and vodka infused with caffeine are related goods because there was no evidence that vodka and wine emanate from a single source under a single mark or that such goods are complementary products that would be bought and used together). Here, the examining attorney alleges that the same entity commonly produces solar roofing systems and photovoltaic cells and also sells and produces metal roofing. However, this is not the case, and no evidence has been provided to support this assertion.

The mere fact that the goods in question can be installed on a building does not automatically result in the goods being "related" and traveling through the same channels of trade

so as to result in consumer confusion. See *Edwards Lifesciences Corporation v. VigiLanz Corporation*, 94 U.S.P.Q.2d 1399 (TTAB 2010) (wherein the Board stated that the relatedness of the goods inquiry “is not based on whether a general term or overarching relationship can be found to encompass them both.”); *In re St. Helena Hosp.*, 774 F.3d 747 (Fed. Cir. 2014) (finding that hospital-based weight and lifestyle programs and printed materials dealing with physical activity and fitness were not related).

Another important factor for the analysis of whether a likelihood of confusion exists between marks depends on how the marks are actually used in the marketplace from the purchaser’s point of view. See, e.g. *McCarthy on Trademarks and Unfair Competition* § 23:58. The Trademark Trial and Appeal Board echoed this statement on many occasions, stating that the question of likelihood of confusion must be based “on the reaction of the relevant purchasing public as they encounter the marks of the parties in the actual milieu surrounding the sale of the goods to which they are applied.” *Upjohn Co. v. Universal Wholesale Corp.*, 161 U.S.P.Q. 558, 561 (TTAB 1969). Metal roofing and solar roofing systems and photovoltaic cells are not offered in the same channels of trade or marketed to the same consumers, and customers searching for solar systems are searching for energy solutions as opposed to building products. Because the conditions surrounding the marketing and the channels of trade are so distinct, the solar panel goods and the metal roofing goods are unlikely to be encountered by the same consumers under the same circumstances such that consumers would mistakenly believe that the goods originate from the same source.

The Examining Attorney alleges that both Applicant and Registrant provide roofing. However, this statement is not correct. Customers searching for Registrant’s goods are not searching for roofing needs but are rather searching for energy solutions. Registrant’s customers may be motivated by a desire to be more “green” and environmentally friendly, not roofing to protect any building structure. Customers searching for energy solutions would not be confused by a metal building product that does not offer any power or energy solutions. In fact, prior examining attorneys agreed that these marks are unrelated as evidenced by the fact that Registrant’s mark was not cited in a refusal for the cited application SOLSTIS.

Applicant’s and Registrant’s consumers are sophisticated, indicating that they will further understand the distinctions between the marks and exercise a high degree of care before purchasing. Applicant’s and Registrant’s distinct and unrelated products are both expensive, and consumers will exercise care before purchasing. Use of even identical marks is not likely to cause confusion if the degree of consumer care in choosing the goods is high. See *In re Thor Tech, Inc.*, 113 USPQ2d 1546, 1551 (finding use of identical marks for towable trailers and trucks not likely to cause confusion due to the differences between the goods and their channels of trade, and the high degree of customer care likely to be exercised). The present situation is highly similar to that encountered in *In re Thor Tech*.

As there is no evidence of record to support a finding of likelihood of confusion, the examining attorney has not met the burden to support a refusal to register the mark under Section 2(d), per TMEP 1207.01(a)(vi). Without establishing a *prima facie* case, the registrant’s goods would not be presumed to travel in the same channels of trade, or to the same purchasers as those of the applicant. Applicant’s goods and Registrant’s goods do not travel in the same channels of trade, customers are likely to exercise a high degree of care before purchasing Applicant’s

goods, Applicant's goods descriptions do not cover or encompass those of the registrant, and Applicant's goods and Registrant's goods are in separate classes. Therefore, the applicant respectfully requests that the rejection be withdrawn.

B. Applicant's mark is not similar to the cited registration in connotation and commercial impression.

It is well established that differences among the connotations or commercial impressions made by marks are key factors in determining the existence of likelihood of confusion. See *Revlon, Inc. v. Jerell, Inc.*, 713 F.Supp. 93 (SDNY 1989). When two marks carry different meanings and deliver different commercial impressions, confusion is unlikely. See e.g., *In re Farm Fresh Catfish Co.*, 231 USPQ 495 (TTAB 1986) (holding that CATFISH BOBBER for fish (with CATFISH disclaimed) is not confusingly similar to BOBBER for restaurant services, because BOBBER in CATFISH BOBBER suggests dictionary meaning of fishing bob or float, and BOBER for restaurant services does not carry such meaning); *Nina Ricci, S.A.R.L. v. Gemcraft, Ltd.*, 612 F.Supp. 1520, 226 USPQ 575 (SDNY 1985) (holding Plaintiff's mark L'AIR DU TEMPS for perfume is not confusingly similar to Defendant's mark, L'AIR D'OR, also for perfume, because the two terms suggest different meanings in French and result in different overall impressions).

Determining whether there is a likelihood of confusion requires careful consideration of the meaning and the overall commercial impression created by each mark. TMEP 1207.01(b)(iii). By analyzing these factors in relation to Applicant's mark and the cited registration, one concludes that the marks are dissimilar and therefore unlikely to result in consumer confusion.

Applicant's mark conveys an entirely different meaning and commercial impression when compared to the cited registration in light of Applicant's goods and Registrant's goods. Principally, the purpose of Registrant's goods is to be exposed to the sun and convert light into energy. Registrant's mark, as it is used in connection with Registrant's goods, may call forth a connotation of a sunny day and the summer solstice where the daylight hours are the longest and the solar roof may be exposed to many hours of light and convert the sun's rays into electricity. In contrast, Applicant's mark, when viewed in connection with its goods, provides a connotation of being covered and protected from the sun's rays as opposed to being exposed to the sun.

Consumers would readily interpret these marks to convey entirely different ideas as the marks are used in connection with the different goods. Simply put, consumers who encounter each party's mark with the relevant goods will have no difficulty recognizing that they are dissimilar. Due to these key differences, the marks are not likely to cause consumer confusion.

C. Conclusion

It is well settled that the Trademark Office is "not concerned with mere theoretical possibilities of confusion, deception, or mistake or with de minimus situations but with the practicalities of the commercial world, with which the trademark laws deal." *Elec. Design & Sales, Inc. v. Elec. Data Sys. Corp.*, 954 F.2 713, 715 (1992). The lack of arguments and evidence presented in the Office Action do not support a finding that there is a likelihood of confusion, as opposed to merely a minute theoretical possibility of confusion between the applicant's mark and the cited marks, and the Examining Attorney has not presented evidence that Applicant's goods

are related to Registrant's goods. Accordingly, the refusal to register the applicant's mark should be withdrawn.

III. Prior Pending Application

The examining attorney cited to prior pending Application Serial No. 87/542,109 for the mark SOLSTIS as a potential bar to registration of Applicant's mark. Applicant notes that this mark has issued into Reg. No. 5903720. Applicant notes that its election not to submit substantive arguments at this time in no way limits Applicant's right to address this issue later if a refusal under Section 2(d) issues. However, in light of the arguments above, Applicant respectfully requests that the advisory be withdrawn as the cited application is not confusingly similar to Applicant's mark in appearance, connotation, or commercial impression, and consumers would exercise a high degree of care when purchasing the relevant goods.