



PRAIRIEVIEW LAW
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January 8, 2020

ONLINE VIA TSDR

Jonathan Schlegelmilch
Law Office 108
U.S. Patent & Trademark Office

RE: Office Action Dated September 17, 2019
U.S. Application Serial No. 88486372
Mark: CLEAR WATER HOME GOODS (standard)

Dear Examiner Schlegelmilch:

Please allow this letter to serve as a formal response to the above-referenced office action regarding the CLEAR WATER HOME GOODS mark.

Section 2(d) Refusal – Likelihood of Confusion

Under the standard articulated in *In re: E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973), four factors are used to determine whether a likelihood of confusion exists between a registered mark (or prior-filed application) and a new, proposed trademark:

1. The similarity of the marks in their entirety, including commercial impression, appearance and sound;
2. The similarity of the goods and/or services between the registered mark and the applicant;
3. Trade channel similarity; and
4. The number and nature of similar marks in use on similar products in commerce.

The U.S. Registration No. 4451109 (“CLEARWATER”) is clearly distinguishable from the above-requested mark.

Further, in ex parte likelihood-of-confusion circumstances, the following factors may be relevant:

The similarity or dissimilarity of established, likely-to-continue trade channels.

The conditions under which and buyers to whom sales are made, i.e., “impulse” vs. careful, sophisticated purchasing¹...

As is noted in the Office Action, 4451109 is registered in International Class 8 for “fish slicing kitchen knives; Fishing knives; Fixed blade knives; hunting knives; Knives.” In contrast, Applicant has requested registration in IC21 for “Cutting boards; flasks; drinking glasses, namely, tumblers”.

Applicant’s market is primarily home goods and services where, in contrast, Registrant’s trade channel focuses on sporting goods and services (see attached). It is unlikely that sportspeople seeking out specialized fishing knives are likely to be confused as to the origin and source of the knives, particularly given the frequent use of the phrase “clear water” as pertains to items of this nature (suggestive of fishing and sporting)². In addition, at least one other company is using the phrase “CLEARWATER” in direct reference to consumer and sporting knives³. “Clearwater” is the name of a type of knife by the Registrant (Buck) (“Buck Clearwater Series Fillet Knife”), whereas Applicant’s mark designates a larger scope of consumer products; namely, home goods in general and as a brand source. Therefore, the overall commercial use is very different and unlikely to cause confusion.

Applicant’s use of “CLEAR WATER” is a nod to his place of business, Eau Claire, Wisconsin (“Eau Claire” in French means “Clear Water”⁴).

In sum, the *du Pont* factors weigh heavily - given the relevant trade channels and consumer sophistication in this area⁵, the marks’ utilization and registration in different international classes, as well as relatively frequent use of similar marks on similar goods and services - in a finding of no likelihood of confusion.

Agreement to Amend Goods/Services Description

Applicant is willing to remove the request to trademark “CLEAR WATER HOME GOODS” as pertains to cutting boards if it would assist in registration of the mark and eliminate the element of confusion.

¹ TMEP 1207.01(d)(vii), referencing *du Pont*, 476 F.2d at 1362-63, 177 USPQ at 568-69.

² *Citigroup Inc. v. Capital City Bank Group, Inc.*, 637 F.3d 1344, 1356, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011), TMEP 1207.01(b)(iii); see also: Google search results; see also: *In re FabFitFun, Inc.*, 127 USPQ2d 1670, 1675 (TTAB 2018) (holding I’M SMOKING HOT for cosmetics and related non-medical personal care items and SMOKIN’ HOT SHOW TIME for cosmetics not likely to cause confusion based on a totality of the evidence showing that the shared wording is somewhat weak in view of its suggestiveness and that the marks overall convey different commercial impressions); TMEP 1207.01(b)(viii)

³ See: Kershaw.kaiusaltd.com (attached)

⁴ <https://www.linguee.com/english-french/translation/clear+water.html>

⁵ *In re Thor Tech, Inc.*, 113 USPQ2d 1546, 1551 (TTAB 2015) “(finding use of identical marks for towable trailers and trucks not likely to cause confusion given the difference in the nature of the goods and their channels of trade and the high degree of consumer care likely to be exercised by the relevant consumers)” TMEP 1207.01(a)(i)

Summary

Given the totality of the circumstances in light of the *Du Pont* factors, Applicant respectfully requests reconsideration of the denial.

Please contact me at: (715) 895-8910 or jen@prairieviewlaw.com if you have any additional questions. Thank you.

Sincerely,

/Jennifer Rust Anderson/

Jennifer Rust Anderson