

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:)
)
Applicant:	peterson, andrew l)
)
Serial No.:	88348244)
)
Mark:	FUZE)
)
Filed:	March 20, 2019)
)
Int'l Classes:	*005,024,040)
)
Our File No.	2019-01014)

RESPONSE TO OFFICE ACTION NO. 3

Applicant peterson, andrew l (“Applicant”) responds to the Office Action No. 3 mailed on July 10, 2019 as follows:

I. REFUSAL TO REGISTER BASED ON LIKELIHOOD OF CONFUSION

The Examining Attorney has refused registration of Applicant’s FUZE mark (“Applicant’s Mark”) for “Antimicrobial coatings to treat the growth of mold, mildew, bacteria and fungus on various surfaces, Fabrics for textile use, Chemical treatment of textile fabrics” under International Class 005,024,040, Application Serial No. 88348244 (“Application”) under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the grounds that Applicant’s Mark is likely to be confused with U.S. Trademark Registration No. 5262640 for FUZE, namely for “Backing for commercial carpet tiles, tufted carpets, rugs and synthetic turf” (“Cited Registration”)

For the reasons set below, Applicant respectfully traverses this objection and believes that its mark, and the goods and services thereunder, are distinguishable from the Cited Registration, and its goods, and that there is no likelihood of confusion between the marks of the parties.

Accordingly, Applicant respectfully submits that the Application should be allowed to proceed to publication.

II. THERE IS NO LIKELIHOOD OF CONFUSION

There is no likelihood of confusion because of the distinct nature of the goods, channels of trade, the number of similar marks in use, and the sophistication of potential purchasers when comparing the Applicant's Mark and the Cited Registration. In order for the Examining Attorney to find a likelihood of confusion, the respective goods and services covered by the marks, and not just the marks themselves must be considered. *Hyde Park Footwear Co., Inc. v. Hampshire-Designers, Inc.*, 197 U.S.P.Q. 639, 641 (TTAB 1977). The Examining Attorney must look at the covered goods and services to determine whether a relationship exists which would likely result in confusion about the origin. *In Re August Storck KG*, 218 U.S.P.Q. 823, 825 (TTAB 1983). In determining whether a likelihood of confusion is present the Examiner must consider the factors outlined under the ruling in *In re E.J. du Pont, de Nemours & Co.* 476 F.2d 1357, 1362 (C.C.P.A. 1973). These factors include, the similarity of the marks, the similarity of the nature of goods or services, the similarity of the trade channels in use, the sophistication of purchasers, the fame of the prior mark, the number and nature of similar marks, the nature and extent of actual confusion, the length of time of concurrent use without evidence of actual confusion, the variety of goods on which the mark is on, the market interface between the applicant and the prior mark, the extent of which applicant has a right to exclude other from use of its mark, and the extent of potential confusion. *Id.*

In any likelihood of confusion analysis, however, two key considerations are the similarities between the marks and the similarities between the goods. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). If assuming, arguendo, that the

Cited Registration and the Applicant's mark contain similar components that fact alone is not dispositive as to likelihood of confusion. Both the Applicant's mark and the Cited Registration have been in use concurrently for 2 years with no evidence of actual confusion. In analyzing the remaining factors, we find no likelihood of confusion.

APPLICANT'S PRODUCTS ARE DISTINCT WHEN COMPARED TO THE PRODUCTS OF
THE CITED REGISTRATION

When comparing the Applicant's Mark and the Cited Registration the type of products are unique and wholly distinct. The court will look at whether the marks suggest that different goods and services may emanate from a single source. It has been found that where a product is so related to another as to form an integral relationship, the products cannot be considered distinct. *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993). The mere fact that two products may be found in the same large store is not sufficient to establish that the products are related. *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). **The Board has held products within the same international class can be held as distinct.** *In re Gelati Int'l, Inc.*, S.N. 75/179,289 (October 6, 2000). When comparing the Applicant's product to the products covered by the Cited Registration it is evident that there exists a difference between "Antimicrobial coatings to treat the growth of mold, mildew, bacteria and fungus on various surfaces, Fabrics for textile use, Chemical treatment of textile fabrics", and "Backing for commercial carpet tiles, tufted carpets, rugs and synthetic turf" the products covered by the Cited Registration. The Cited Registration is for carpet backing, although carpets are considered textile products, the Applicant's products and services are not for carpets, they are for textile fabrics which would not include carpets. Although technically it is possible that the

Applicant's products could be applied to carpet, that is not the preferred use of the Applicant's products or services.

With respect to both the number and nature of similar marks, it cannot be said that the Applicant's Mark is the only similar mark to the Cited Registration. For this additional reason, it would be inequitable for the Applicant's registration to be denied.

THE TRADE CHANNELS ARE DIFFERENT

The trade channels for the Applicant's Mark and the Cited Registration are different. In order to determine whether goods share common trade channels it is necessary to look at the suppliers and retailers of the goods. The court has previously held that the mere fact that two products may be found in the same large store is not sufficient to establish that the products are related. *Federated Foods, Inc. v. Fort Howard Paper Co.*, 192 USPQ 24 (CCPA 1976). The Cited Registration is for "Backing for commercial carpet tiles, tufted carpets, rugs and synthetic turf". If, assuming arguendo, that the Applicant's goods and the goods covered by the Cited Registration were sold in the same store, the court has held that to be insufficient reason to hold the goods related. Applicant's products and services are targeted at commercial and industrial purchasers.

PURCHASERS ARE HIGHLY SKILLED AND SPECIALIZED SOPHISTICATED CONSUMERS AND THEREFORE NO LIKELIHOOD OF CONFUSION EXISTS

It has been established that where the purchasers of a product are sophisticated there can be no likelihood of confusion. See, e.g., *In re N.A.D., Inc.*, 754 F.2d 996, 999-1000, 224 USPQ 969, 971 (Fed. Cir. 1985) (concluding that, because only sophisticated purchasers exercising great care would purchase the relevant goods, there would be no likelihood of confusion merely because of the similarity between the marks NARCO and NARKOMED); *In re Homeland Vinyl Prods., Inc.*,

81 USPQ2d 1378, 1380, 1383 (TTAB 2006). The consumers of both the Applicant's products and the Cited Registration's products are highly specialized individuals. The products, in a technical sense, are completely distinct. The potential purchasers of both the Applicant's products and the Cited Registration's products are highly skilled consumers, eliminating any likelihood of confusion. As Applicant's products and services are targeted at commercial and industrial users there exists an increased level of sophistication that would not otherwise be present for general consumer products.

THE CITED REGISTRATION IS NOT FAMOUS

The Cited Registration is not for a famous mark and is therefore not entitled to increased protections. In order for a mark to be considered famous, the mark must be well known so as to indicate the source of the covered goods. The Cited Registration does not appear to be well known. We find that the Cited Registration cannot be considered famous and therefore is not entitled to the protections afforded to famous marks.

III. EXTENT OF POTENTIAL CONFUSION IS DE MINIMIS

Thus, assuming the marks may be similar, the goods and services offered are quite different in nature, are used for different purposes, are promoted differently and are purchased by different, and discriminating purchasers. Accordingly, the potential for confusion is de minimis.

IV. EXAMINER'S INFORMATION REQUIREMENT

In response to the examiner's information requirement, applicant makes the following statements. Applicant's goods could theoretically be applied to carpet, but that is not a preferred use. Applicant's goods are to be used by commercial and industrial users. The textiles referenced in Classes 24 and 40 are for fabrics not for carpet.

V. CONCLUSION

Applicant believes that it has responded to all of the Examining Attorney's inquiries, and, specifically, has addressed the belief that there is a likelihood of confusion as between Applicant's Mark and the Cited Registration identified in the Office Action. As demonstrated above, the goods and services are distinct, purchasers are highly sophisticated, likely to be sold in separate areas, and do not emanate from the same source as those provided under the Cited Registration. Accordingly, there is no likelihood of confusion and Applicant respectfully requests that the Application be allowed to proceed to publication.