

Applicant here responds to the Examining Attorney's Office Action dated January 24, 2020 in which she refused registration of Applicant's mark, ENSO, incorporating a horizontal line appearing immediately above the letter "O" and which word mark is surrounded by a Zen "Enso" circle, which is intended to be used on "Air conditioning/heating mini split units" on the ground that that mark is likely to be confused with Registrant's mark, ENSO, which as the attached page illustrates, is depicted solely in plain block letters and is used on "Bath tubs; Lavatories; Sinks; Toilets," which mark is the subject of U.S. Trademark Registration #3,894,549.

In refusing registration of Applicant's mark, the Examining Attorney wrote that "In a likelihood of confusion determination, the marks in their entireties are compared for similarities in appearance, sound, connotation, and commercial impression. In re i.am.symbolic, llc, 866 F.3d 1315, 1323, 123 USPQ2d 1744, 1748 (Fed. Cir. 2017); Stone Lion Capital Partners, LP v. Lion Capital LLP, 746 F.3d 1317, 1321, 110 USPQ2d 1157, 1160 (Fed. Cir. 2014) (quoting Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772, 396 F.3d 1369, 1371, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005)); In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973); TMEP sec. 1207.01(b)-(b)(v)" but noted that "When evaluating a composite mark consisting of words and a design, the word portion is normally accorded greater weight because it is likely to make a greater impression upon purchasers, be remembered by them, and be used by them to refer to or request the goods and/or services. In re Aquitaine Wine USA, LLC, 126 USPQ2d 1181, 1184 (TTAB 2018) (citing In re Viterra Inc., 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012)); TMEP sec. 1207.01(c)(ii). Thus, although marks must be compared in their entireties, the word portion is often considered the dominant feature and is accorded greater weight in determining whether marks are confusingly similar, even where the word portion has been disclaimed. In re Viterra Inc., 671 F.3d at 1366-67, 101 USPQ2d at 1911 (citing Giant Food, Inc. v. Nation's Foodservice, Inc., 710 F.2d 1565, 1570-71, 218 USPQ2d 390, 395 (Fed. Cir. 1983))."

Applicant acknowledges that the literal portions of the two marks at issue here are phonetically identical. However, the dominant portion of Applicant's mark in size and commercial impression is its very unique design feature; the word portion of its mark, ENSO, is surrounded by a Japanese Zen Enso circle. "In Zen, enso ("circle") is a circle that is hand-drawn in one or two uninhibited brushstrokes to express a moment when the mind is free to let the body create...The enso symbolizes absolute enlightenment, strength, elegance, the universe, and mu (the void). It is characterized by a minimalism born of Japanese aesthetics. Drawing enso is a disciplined-creative practice of Japanese ink painting. The tools and mechanics of drawing the enso are the same as those used in traditional Japanese calligraphy: One uses a brush to apply ink to a thin Japanese paper. The circle may be open or closed. In the former case, the circle is incomplete, allowing for movement and development as well as the perfection of all things. Zen practitioners relate the idea to wabi-sabi, the beauty of imperfection. When the circle is closed, it represents perfection, akin to Plato's perfect form (Plato), the reason why the circle was used for centuries in the construction of cosmological models, see Ptolemy. Usually, a person draws the enso in one fluid, expressive stroke. When drawn according to the soho style of Japanese calligraphy, the brushstroke is especially swift. Once the enso is drawn, one does not change it. It evidences the character of its creator and the context of its creation in a brief, continuous period of time. Drawing enso is a spiritual practice that one might perform as often as once per day. This spiritual practice of drawing enso or writing Japanese calligraphy for self-realization is called hitsuzendo ("way of the brush"). Enso exemplifies the various dimensions of the Japanese wabi-sabi perspective and aesthetic: Fukinsei (asymmetry, irregularity),kanso (simplicity),koko (basic; weathered), shizen (without pretense; natural), yugen (subtly profound grace), datsuzoku (freedom), and seijaku (tranquility). See <https://en.wikipedia.org/w/index.php?title=Enso&oldid=926664864>

The design feature of Applicant's mark, therefore, is not merely a geometric circle, but is a religious symbol having significant meaning signifying absolute enlightenment, strength, elegance and the universe. It is created by a unique Japanese calligraphic brushstroke which has been drawn in such a way as to allow, symbolically, for movement and development as well as the perfection of all things. The Federal Circuit in *IN RE ELECTROLYTE LABORATORIES, INC.*, 16 USPQ 2d 1239 (1990) wrote, "There is no general rule as to whether letters or design will dominate in composite marks; nor is the dominance of letters or design dispositive of the issue. No element of a mark is ignored simply because it is less dominant or would not have trademark significance if used alone. See *Spice Islands, Inc. v. Frank Tea & Spice Co.*, 505 F.2d 1293, 184 USPQ 35 (CCPA 1974) (improper to ignore portion of composite mark)." Here, where the design portion of the subject trademark not only dominates the composite mark in terms of size but inherently carries such significant symbolic and religious meaning that numerous entities have used that design in their marketing efforts and the shape of Apple's new headquarters is said to have been inspired by that shape (See <https://en.wikipedia.org/w/index.php?title=Enso&oldid=926664864>) that design cannot be ignored and Applicant respectfully submits here that the inclusion of that design in Applicant's trademark is significant enough to distinguish that mark from Registrant's mark, particularly in light of the care that consumers take in purchasing products such as Applicant's "Air Conditioning/Heating Mini-Split Units" which point I will discuss below.

The Examining Attorney writes that because Applicant's latter products may be sold in the same stores, e.g., Home Depot, Lowe's and Ace Hardware as Registrant's bathroom fixtures that that makes confusion more likely when those products are sold under their respective marks. However, "Modern stores sell all sorts of commodities, and a rule that all goods sold in the same stores are to be considered related goods, would have the practical effect of creating universal trademarks independent of the nature of the goods on which they are used." See *CALIFORNIA FRUIT GROWERS EXCHANGE V. SUNKIST BAKING CO.*, 76 USPQ 85 (7th Cir. 1947). Further, what applies to supermarkets should apply to home centers as well, namely, "A wide variety of products, not only from different manufacturers within an industry but also from diverse industries, have been brought together in the modern supermarket for the convenience of the customer. The mere existence of such an environment should not foreclose further inquiry into the likelihood of confusion arising from the use of similar marks on any goods so displayed." See *FEDERATED FOODS, INC. V. FT. HOWARD PAPER CO.*, 192 USPQ 24, 29 (CCPA 1976). Such an inquiry should note the following; that as the attached pages from the U.S. Department of Energy indicate, Applicant's Mini-Split Heat Pumps are not an item that a homeowner would purchase off-the-shelf and install herself; "The installer must correctly size each indoor unit and determine the best location for its installation. Oversized or incorrectly located air handlers can result in short cycling, which wastes energy and does not provide proper temperature or humidity control. Too large a system is more expensive to buy and operate." These units normally would be purchased not in a home center but from a heating and air conditioning contractor who would properly install them. The same is true for heating and air conditioning units in general. As the attached pages from Carrier, Bryant and Lennox and some heating and air conditioning contractors note, heating and air conditioning units are usually purchased from and installed by heating and air conditioning contractors as the Department of Energy recommends. Therefore, contrary to the Examining Attorney's conclusion, Applicant's and Registrant's respective products would not, customarily, be purchased in the same channels of trade. Moreover, companies such as Carrier, Bryant and Lennox do not sell plumbing fixtures and consumers who are familiar with those brands; seeing them on the furnaces and air conditioning units in their homes, would not see those brands on the plumbing fixtures that they use in their day-to-day lives, reinforcing a common understanding among consumers that plumbing fixtures do not originate from the same source as HVAC units.

Finally, in making purchasing decisions regarding expensive goods such as heating and air conditioning units, the reasonably prudent purchaser standard is elevated to the standard of the discriminating purchaser. If the goods are expensive, the reasonably prudent buyer does not buy casually, but only after careful consideration. In such situations involving goods such as Applicant's confusion is less likely. See L.J. MUELLER FURNACE CO. V. UNITED CONDITIONING CORP., 106 USPQ 112 (C.C.P.A. 1955) involving furnaces and SYNCROMATIC AIR CONDITIONING CORPORATION V. WILLIAMS OIL-O-MATIC HEATING CORPORATION, 44 USPQ 598 (C.C.P.A. 1940) involving air conditioning systems.

For all of these reasons and with the amendment of the identification of goods in the instant application to read, "Air Conditioning/Heating Mini Split Units," Applicant respectfully requests that the refusal of registration in the instant application be withdrawn and that that application be approved for publication pursuant to 15 U.S.C. sec. 1062.

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