

TRADEMARK
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	The Toro Company	Examining Attorney:	Laura Taraban
Serial No.:	88684022	Law Office No.:	127
Filing Date:	November 7, 2019	Docket:	406TM
Mark:	HORIZON		

AMENDMENT AND RESPONSE

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

Dear Commissioner:

This Response is in reply to the Office Action dated January 4, 2020. This Response is being filed prior to the deadline of July 3, 2020.

Please amend the description of goods. The Applicant requests that its HORIZON application cover the following goods in Class 9:

Downloadable computer software for monitoring equipment run times for outdoor power equipment related to landscaping, lawn care, tree care and construction projects, suitable for use by landscape contractors.

Remarks

Reconsideration and withdrawal of the Examining Attorney's rejection is respectfully requested for the reasons set forth below. The Toro Company ("Toro") has used the HORIZON trademark for many years.

I. Confusion between Applicant's HORIZON Mark and the Cited HORIZON Marks Is Unlikely

The Examining Attorney refused registration of Toro's HORIZON trademark application in view of two U.S. registrations, both of which are owned by a Danish company called Nilfisk A/S:

1. HORIZON (word) (U.S. Reg. No. 5,404,382) in association with these Class 9 goods: "Computer software for operating indoor and outdoor floor and surface cleaning, sweeping, polishing, and scrubbing machines, carpet cleaning machines, lawn care machines, leaf removal machines and snow removal machines; Autonomous driving control systems for floor cleaning, sweeping, polishing and scrubbing machines, namely, electrical controlling devices and remote controls for operating said machines; Computer programs for use in autonomous control of floor cleaning, sweeping, polishing and scrubbing machines; Software for use in autonomous control of floor cleaning, sweeping, polishing and scrubbing machines; Tracking and monitoring systems comprising software for tracking and monitoring of floor cleaning, sweeping, polishing and scrubbing machines."
2. HORIZON & Design (U.S. Reg. No. 5,389,282) in association with the same Class 9 description of goods as noted in preceding paragraph for the '382 registration.

The Examiner asserts that the marks are confusingly similar because the applicant's and registrant's goods are identical and "are likely to engender the same connotation and overall commercial impression when considered in connection with applicant's and registrant's respective

goods and/or services.” (The Declaration of Use for the ‘282 registration is due January 30, 2024; and the Declaration of Use for the ‘382 registration is due February 20, 2024.)

A. Differences between the Trademarks

The applied-for HORIZON mark and the cited HORIZON registrations are similar in sound and appearance, although the Applicant’s HORIZON mark appears next to the word “Technology” and the house mark TORO. Applicant nevertheless believes that there is no likelihood of confusion in this situation for the reasons explained below. The crux of the likelihood of confusion issue is whether customers are likely to be confused into believing that one company’s products emanate from, or are sponsored by, another company. In this situation, several circumstances prevent a likelihood of confusion.

B. Differences between the Two Companies’ Products

The Examining Attorney asserted that “Applicant’s goods and services encompass the Registrant’s goods.” The Examining Attorney noted, “the registrant’s relevant goods are identified as ‘Computer software for operating indoor and outdoor floor and surface cleaning, sweeping, polishing and scrubbing machines, carpet cleaning machines, lawn care machines, leaf removal machines and snow removal machines.’” Further, the Examining Attorney stated that Applicant’s description of goods had “no restriction as to nature, type, channel of trade or class of purchasers.”

However, as noted above, Applicant amended its description of goods to add the restriction “suitable for use by landscape contractors.” This is clearly not the trade channel or class of purchasers who would buy carpet and floor cleaning machines. Although the Registrant’s description of goods does not contain express language about the class of purchasers for its floor cleaners, autonomous floor cleaning machines would be purchased by owners of large buildings (hotels, schools, hospitals, etc.), not by landscape contractors. See *In re Trackmobile Inc.*, 15

USPQ2d 1152, 1154 (TTAB 1990) (noting that “when the description of goods for a cited registration is somewhat unclear...it is improper to...attach all possible interpretations to it when the applicant has presented extrinsic evidence showing that the description of goods has a specific meaning to members of the trade.”).

Moreover, customers are unlikely to be confused as to the affiliation between Applicant’s HORIZON mark and the cited HORIZON registrations due to the nature of each company’s software. Applicant’s computer software is used by landscape contractors in order to monitor their fleet of equipment, which allows timely maintenance and service work to be completed. In contrast, Registrant’s HORIZON mark has nothing to do with maintaining and servicing outdoor power equipment. Registrant’s software is used in the operation of commercial cleaning equipment, namely, industrial floor sweeping machinery. Social media coverage of Registrant’s HORIZON goods is enclosed as Exhibit A, which clarifies that Registrant’s software operates robotic indoor floor cleaning machines.

C. Goods Are Purchased Only After Careful Consideration

Landscape contractors (and others) would be able to easily distinguish between Applicant’s HORIZON software for servicing mowers, etc., as compared to Registrant’s floor cleaning systems. The customer base for Applicant’s HORIZON software is familiar with Applicant’s famous house mark, TORO, and its range of outdoor power equipment. Landscape contractors seeking Applicant’s HORIZON software for outdoor power equipment would be unlikely to encounter any promotional materials for Registrant’s HORIZON floor cleaning systems.

In addition, the products sold by Applicant and Registrant cost thousands of dollars. When making such a major investment in a complex, long-lasting machine, prospective purchasers are sophisticated and careful. This also weighs against any likelihood of confusion.

D. Applicant's Use of HORIZON Mark Illustrates Lack of Confusion

In the near future, the Applicant will file a Statement of Use to confirm that it has been using the HORIZON trademark since at least as early as October 2013. The specimen that will accompany the Statement of Use is enclosed as Exhibit B. The specimen is a photograph of the display screen associated with Applicant's software, next to the word "Horizon™."

E. Absence of Actual Confusion

Registrant's marks issued on January 30, 2018, and it is unclear when Registrant began to use its HORIZON trademark in the United States. Applicant's date of first use is at least as early as October 2013. It therefore appears that the Applicant and Registrant have coexisted in the U.S. marketplace for several years. Applicant is aware of no incidents of actual confusion during those years.

F. Third-Party Registrations

As noted in the TMEP, "active third-party registrations may be relevant to show that a mark...[is] so commonly used that the public will look to other elements to distinguish the goods or services. See e.g. *Jack Wolfskin Ausrustong Fur Draussen GmbH & Co.*, TMEP § 1207.01(d)(iii).

Applicant notes that the U.S. Patent and Trademark Office has allowed HORIZON to be registered for a wide variety of Class 9 software, including the following:

<u>Mark</u>	<u>Reg. No.</u>	<u>Goods</u>	<u>Status</u>	<u>First Use</u>
HORIZON	4769638	Electronic controllers for agricultural harvesters, etc.	Declaration of Use due July 7, 2021	August 16, 2013
HORIZON	4309222	Software for remotely controlling environmental conditions, etc.	Renewal due March 28, 2023	July 31, 2012
HORIZON	2769275	Software for controlling times lighting and peripheral control sequences, etc.	Renewal due Sept. 30, 2023	Dec. 1, 1996
HORIZON	5444154	Computer software for administration of computer networks, etc.	Declaration of Use due April 10, 2024	Jan. 25, 2015
HORIZON	5223376	Computer software for protection, control, and automation of electric power generation, etc.	Declaration of Use due June 13, 2023	Jan. 7, 2016

TARR printouts for these five registrations are enclosed as Exhibit C.

It is sometimes helpful and relevant for an Examining Attorney to review extrinsic evidence when analyzing likelihood of confusion. A printout of Nilfisk’s web page for its Horizon floor scrubbing machine is enclosed as Exhibit D. In addition to Toro’s Statement of Use specimen (Exhibit B), enclosed is press coverage for Registrant’s next generation of Horizon software (Exhibit E).

II. Amended Identification and Classification of Goods and Services

As shown above, Applicant amended its description of goods to be more focused than the description in the original trademark application. The amended description of goods is:

Downloadable computer software for monitoring equipment run times for outdoor power equipment related to landscaping, lawn care, tree care and construction projects, all of the foregoing suitable for use by landscape contractors

The amended description of goods emphasizes the differences between the Applicant's and Registrant's goods. The amended description also addresses the Examining Attorney's objection that the original description's wording was "indefinite, too broad, and currently misclassified." For example, the amended description specifies whether the software is downloadable in nature, and notes that the tracking devices are GPS tracking devices.

Applicant requests that this application proceed in only a single class: Class 9. As such, no additional fee is necessary. The amended Class 9 description of goods is consistent with the suggested description on page 6 of the Office Action. As such, it is respectfully requested that the Examining Attorney allow the above, amended Class 9 description of goods.

III. Conclusion

For all of the above reasons, it is respectfully requested that the Examining Attorney approve Applicant's HORIZON application for publication. If there are any questions regarding this matter, or if an Examiner's Amendment is necessary for any reason, please feel free to telephone the undersigned.

Respectfully submitted,

The Toro Company

By its attorney,

/s/ *Linda Byrne*
Linda M. Byrne
Senior Attorney, Intellectual Property
8111 Lyndale Ave. S.
Bloomington, Minnesota 55420
952-887-8854 phone
Linda.byrne@toro.com

- Attachments: Exhibits A Social Media Coverage of Registrant's HORIZON Mark
B Applicant's Photo Specimen for HORIZON
C TARR Information for 5 HORIZON Registrations
D Photo of Nilfisk's HORIZON Machine
E Article about Registrant's HORIZON Product