

This is in response to the Office Action dated September 30, 2019 regarding the X SERIES mark, Serial No. 88/504,108. The Examining Attorney has refused registration of Applicant's X SERIES mark for use in association with "routers" (as amended in this Office Action) on the basis of the Examiner's belief that it will likely be confused with five marks:

- 1) X-SERIES, U.S. Reg. No. 4,331,714 for use in association with "electric power washers";
- 2) X-SERIES, U.S. Reg. No. 4,611,037 for use in association with "snow throwers";
- 3) X, U.S. Reg. No. 4,229,115 for use in connection with "outdoor power equipment, namely mowers";
- 4) X, U.S. Reg. No. 4,229,116 for use in connection with "outdoor power equipment, namely, mowers"; and
- 5) X DRIVER, U.S. Reg. No. 4, 341,375 for use in connection with "hydraulic wrenches".

Applicant respectfully submits that there is no potential likelihood of confusion between its mark and the marks listed in the cited registrations because the goods are not related. In addition, all of the goods of the cited marks are more similar to each other than to Applicant's goods and are yet peacefully coexisting. Further, Applicant's goods are large and expensive machines purchased by sophisticated manufacturing companies in completely separate trade channels. Accordingly, Applicant respectfully requests the Examining Attorney's reconsideration in light of the following remarks.

#### **I. REFUSAL UNDER SECTION 2(d)**

Application submits that registration of its X SERIES mark is not likely to result in confusion, mistake or deception amongst consumers in the market place. To determine whether there is a likelihood of confusion under Section 2(d) of the Trademark Act, Courts and the PTO

consider the thirteen factors enumerated in *In re E.I. duPont de Nemours & Co.*, 476 F.2d 1357, 177 U.S.P.Q. 563 (C.C.P.A. 1973). No one of the thirteen factors is more important than the others and “Each may from case to case play a dominant role.” *Id* at 567. The Applicant submits an examination of the following *duPont* factors reveals that no likelihood of confusion exists between the marks in question:

(2) The similarity or dissimilarity and nature of the goods described in an application or registration or in connection with which a prior mark is in use.

(3) The similarity of the trade channels.

(4) The conditions under which and buyers to whom sales are made, i.e. “impulse” vs. careful, sophisticated purchasing; . . .

(6) The number and nature of similar marks on similar goods.

(12) The extent of potential confusion, i.e. whether de minimis or substantial.

*duPont*, 177 U.S.P.Q. 567.

**A. Applicant’s goods are distinct from the goods in the cited registration.**

In this case, the most relevant *duPont* factor involves a comparison between the goods and services as described in the application and the goods and services listed in the cited registration. *duPont*, 177 U.S.P.Q. 567. Here, this factor is dispositive. The plain language of the application and the cited registration reveal that Applicant and Registrant use their respective marks in connection with sale of different goods. Applicant’s X SERIES is used in connection with routers. On the other hand, the cited marks are used in connection with electric power washers, snow throwers, mowers, and hydraulic wrenches. The Office Action states that the goods are related because some companies sell both routers and the goods of the cited application.

However, Applicant’s goods are not similar to any of the goods of the cited marks or the evidence provided by the Examining Attorney. Applicant has amended the identification to

read simply “routers” instead of the previous “power tools, namely, routers” to clarify and more accurately describe its goods. Applicant’s routers are huge, expensive routers. They are machines that start at 18 feet wide and go up to 70 feet wide. The routers also start at a price of about \$500,000 and go to well over \$1M. The size can be seen in the substitute specimen filed with this Response. These are not tools that you can just pick up the local home improvement or hardware stores. They are commercial machines for complex extrusions. See Exhibit 1, Applicant’s website page for the X SERIES products.

On the other hand, all of the goods of the cited marks could be sold at a home improvement store. The goods of the cited marks are far closer to each other than to Applicant’s goods. If the cited marks can all register and peacefully coexist than Applicant’s mark for use in association with million dollar commercial routers certainly can too.

The Board has consistently held that each case must be decided on its own merits and that no particular goods or services are *per se* related simply because they may belong to the same broad category of goods or services. See T.M.E.P. §1207.01(a)(iv) (*citing, Information Resources Inc. v. X\*Press Information Services*, 6 U.S.P.Q.2d 1034, 1038 (T.T.A.B. 1988); *Hi-Country Foods Corp. v. Hi Country Beef Jerky*, 4 U.S.P.Q.2d 1169, 1171 (T.T.A.B. 1987); *In re Quadram Corp.*, 228 U.S.P.Q. 863, 865 (T.T.A.B. 1985); *In re British Bulldog, Ltd.*, 224 U.S.P.Q. 854, 855-56 (T.T.A.B. 1984).

The matter of *In re Emco, Inc.*, 177 U.S.P.Q. 415 (T.T.A.B. 1973) is analogous and instructive. In that case, the Board permitted registration of EMCO for electrical lighting fixtures in spite of previous registration of EMCO for electrical devices including, *inter alia*, attenuators, filters, couplers and oscillators. The Board found that the sale of the parties’ respective goods

under the same mark would not be likely to cause confusion or mistake or to deceive merely because the goods were both electrical in character. *Id.* The Board stated:

In the present case, applicant's goods are electrical fixtures whereas the goods identified in the cited registration are electronic devices which are normally used in the communication field. In the complete absence therefore of any evidence tending to show that these products ... are otherwise related in any material particular, it is our opinion that applicant's mark should be published in accordance with Section 12(a) of the Statute.

*Id.* at 416-17.

Similarly, in *Sal Iannelli, Inc. v. Wasser*, 411 F.2d 1350, 162 U.S.P.Q. 260 (C.C.P.A. 1969), the opposer sought to prevent the applicant's registration of ANALITE for an "exposure control electronic device for use in printing photographic negatives." *Id.*, 411 F.2d at 1350, 162 U.S.P.Q. at 260. The opposer used ANALYTE on its color comparator units and related equipment sold to all types of industries dealing in color, and it argued that the applicant's use of the same mark would cause confusion. While both parties provided their products to industries dealing in color, the opposer did not specifically market its product to the photographic field. *Id.*, 411 F.2d at 1350-51, 162 U.S.P.Q. at 261. The Court concluded that the products were different precision instruments moving through different trade channels to different classes of purchasers for basically different purposes and permitted registration of the ANALITE mark. *Id.*

The reasoning in *Sal Iannelli, Inc.* and *Emco* is applicable to the present case. Indeed, courts have consistently found confusion to be unlikely where the same mark was used for different products in the same International Class. *See, e.g., Atec, Inc. v. Societe Nationale Industrielle Aerospatiale*, 798 F.Supp. 411, 413, 24 U.S.P.Q.2d 1951, 1953-54

(S.D. Tex. 1992) (parties' simultaneous use of ATEC for electronic testing equipment in the aviation industry was not confusing where products were used for different purposes by different customers); *Pep Boys-Manny, Moe & Jack v. Edwin F. Guth Co.*, 197 F.2d 527, 528, 94 U.S.P.Q. 158, 159-60 (C.C.P.A. 1952) (applicant allowed to register CADET for electric lighting fixtures sold to wholesale electrical supply jobbers, despite opposer's registration of CADET for electric storage batteries and other automotive supplies sold in retail stores, because respective goods differed so widely in use and characteristics which governs choice by purchaser). See also *In re Planprint Co.*, 229 U.S.P.Q. 621, 623-24 (T.T.A.B. 1986) (CAFÉ for computer engineering services for plants and factories unlikely to be confused with CAFÉ for computer services for analyzing restaurant building costs, because services are unrelated and marketed to different users).

Here, there is even less possibility that registration of Applicant's mark will create a likelihood of confusion in the marketplace than there was in *Emco*, *Sal Iannelli*, *Atec* and *Pep Boys*. Here, Applicant's mark and the marks listed in the cited registrations are used in connection with different products intended for use by different types of consumers.

**B. Applicant's goods and the goods of the cited registrations are offered in completely separate channels of trade to discriminating consumers who are unlikely to be confused.**

The next relevant *duPont* factors concerns the channels in which and the conditions under which and the buyers to whom sales are made. *duPont*, 177 U.S.P.Q. 567. At heart, this is an inquiry into the sophisticated nature of the purchase. It is well-established that confusion is considered unlikely, *even where the marks are identical*, when specialized goods or services are marketed to sophisticated consumers. *Dynamics Research Corp. v. Langenau Mfg. Co.*, 704 F.2d 1575, 217 U.S.P.Q. 649 (Fed. Cir. 1983).

Dynamics Research Corp. (Dynamics) opposed Langenau's application to register the trademark DRC for its sheet metal fabric sold primarily to state highway departments and airport authorities. *Id* at 650. Dynamics had previously registered the mark DRC for products sold to manufacturers of press brakes and sheet metal fabrication shops. *Id*. The Board determined Langenau's goods were "quite distinct" from those of Dynamics and were offered to consumers who would be able to distinguish between the sources of the goods. *Id*. Consequently, the Board dismissed Dynamics' opposition. *Id* at 649. Dynamics appealed and the Federal Circuit Court of Appeals affirmed. *Id*. The appellate court quoted a passage from the Board's decision which is applicable to the present Office Action:

[In] those instances where the same customers might be exposed to both Thompson's and opposer's goods sold under the identical mark, there would not be any likelihood of confusion as to the source of the goods in view of the nature of the goods involved *and the nature of the purchasers who would be responsible for acquisition of the products.*

*Id* at 650 (emphasis added).

Thus, the sophisticated nature of the purchaser is probative for purposes of determining whether confusion is likely in a given case. The Court of Appeals for the Federal Circuit has stated "[T]here is always less likelihood of confusion where the goods are expensive and purchased after careful consideration." *Electronic Design & Sales v. Electronic Data Systems*, 21 U.S.P.Q.2d 1388, 1392 (Fed. Cir. 1992) (quoting *Astra Pharm. Prod. Inc. v. Beckman Instruments, Inc.*, 220 U.S.P.Q. 787, 790 (1<sup>st</sup> Cir. 1983).

The Federal Circuit's opinion in *Electronic Design* is particularly instructive. In that case, the applicant was using the mark EDS in connection with the sale of battery chargers and power supply units. *Electronic Design*, 21 U.S.P.Q.2d 1389. The opposer was also using the mark

EDS, but in connection with the implementation of data processing programs and telecommunications systems. *Id.* Most of the opposer's sales were made to large corporations in the medical, automotive, merchandising, and communications fields. *Id.* Most, though not all, of the applicant's sales were made to manufacturers who incorporated the applicant's products into their own electronic devices. *Id.* During the course of the opposition proceeding, evidence was presented that there was at least some overlap between the applicant's market and the opposer's market. *Id.* Specifically, both the applicant and the opposer sold their respective products to General Motors and Sears. *Id.* "The Board concluded that applicant's power supply goods and opposer's computer services [were] sufficiently related and would likely be encountered by the same persons so that confusion [would be] likely...." *Id.* at 1390.

The Court of Appeals for the Federal Circuit disagreed. *Id.* The court took particular exception to the emphasis that the Board placed on the relatedness of the goods of the parties. *Id.* That emphasis, the court determined, was "incorrect as a matter of law." *Id.* The court noted that "If a likelihood of confusion exists, it must be based on the confusion of some relevant person, *i.e.*, a consumer or purchaser." *Id.* (quoting *Astra Pharmaceutical Prods. v. Beckman Instruments*, 718 F.2d 1201, 1206, 220 U.S.P.Q. 786, 790 (1<sup>st</sup> Cir. 1983)). The relevant inquiry then, is "whether there is likely to be sufficient overlap of the respective purchasers of the parties' goods and services to confuse actual and potential purchasers." *Id.* at 1390. It was on this question that the Federal Circuit parted ways with the Board. Specifically, the court found:

[A]lthough the two parties conduct business not only in the same fields but also with the same companies, the mere purchase of the goods and services of both parties by the same institution does not, by itself, establish similarity of trade channels or overlap of consumers. The likelihood of confusion must be shown to exist not in a purchasing *institution*, but in a customer or purchaser. "... We are not concerned with mere theoretical possibilities of confusion, deception or mistake or with *de minimis* situations but with the practicalities of the commercial world, with which the trademark laws deal."

*Electronic Design*, 21 U.S.P.Q.2d 1391 (internal citations omitted)(emphasis in original).

The Federal Circuit determined the Board had erred when it determined the opposer's customers "who came in contact with applicant's goods may well believe that applicant's goods are produced or sponsored by opposer." *Id.* at 1392. The Court found this conclusion unfounded, as "it would involve at most only a *de minimis* number of sophisticated purchasers. In other words, any overlap in customers is too small to be significant, much less dispositive." *Id.* It was ultimately the sophisticated nature of the consumers that tipped the balance in favor of the applicant. The court found, regardless of whether or not the goods in question were related, that "the relevant persons - potential or actual purchasers - are nevertheless mostly different **and in any event are sophisticated enough that the likelihood of confusion remains remote.**" *Id.* (emphasis added).

The same is true here with regard to the cited marks and Applicant's mark. The goods associated with Applicant's mark and the goods associated with the cited marks are sold to different consumers in completely separate fields. Applicant sells its machines to very sophisticated commercial customers for use in manufacturing facilities around the world. Nobody is going to think that Applicant's 50 foot wide, million dollar router machine is associated with the mowers and wrenches of the cited marks. The goods are too disparate given the broad field and the sophisticated and discriminating nature of the consumers.

**C. The term X SERIES or X is in common use by other sellers in the marketplace.**

The next relevant *duPont* factor involves an examination of the number and nature of similar marks on similar goods. *duPont*, 177 U.S.P.Q. 567. It is well settled that a portion of a mark may be "weak" in the sense that such portion *is in common use by other sellers in the market*. *Colgate-Palmolive Co.*, 432 F.2d 1400, 167 U.S.P.Q. 529, 530 (C.C.P.A. 1970). A



prime example of the application of these well-established principals is clearly demonstrated when looking at the current status of the Federal Register.

If the common element of conflicting marks is a word that is in common use by other sellers in the market, there is reduced likelihood confusion would result from registration of the mark. *Nestle's Milk Products, Inc. v. Baker Importing Co.*, 182 F.2d 193, 86 U.S.P.Q. 80 (C.C.P.A. 1950); *Long John Distilling, Ltd. v. Sazerac Co.*, 426 F.2d 1406, 166 U.S.P.Q. 30 (C.C.P.A. 1970). This is because the consuming public has already become accustomed to distinguishing between marks that incorporate the popular term. As even just the cited marks themselves demonstrate, the term X SERIES is popular for use as a trademark. As the Court of Customs and Patent Appeals has pointed out:

“It seems both logical and obvious to us that where a party chooses a trademark which is inherently weak, he will not enjoy the wide latitude of protection afforded the owner of strong trademarks. Where a party uses a weak mark, his competitors may come closer to his mark than would be the case with a strong mark without violating his rights.”

*Sure-Fit Products Co. v. Saltzson Drapery Co.*, 254 F.2d 158, 117 U.S.P.Q. 295 (C.C.P.A. 1958). Therefore, a refusal of registration of Applicant's X SERIES mark is not only inconsistent with past treatment of the word X SERIES or X by the Trademark Office, but is also inconsistent with case precedent regarding the scope of protection afforded weak marks. Accordingly, Applicant should be allowed to register its X SERIES mark.

**D. The potential likelihood of confusion is de minimis.**

When considered in sum, it is evident that the potential likelihood of confusion in this case, if it exists at all, is *de minimis*. Applicant's mark and cited marks are used in connection with wholly distinct goods. The goods associated with Applicant's mark are sold to highly sophisticated consumers who are unlikely to be confused. It is highly unlikely that registration of Applicant's mark would result in consumer confusion in the marketplace.