

**TRADEMARK**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

<b>Applicant:</b>	<b>Thern, Incorporated</b>
<b>Application No.:</b>	<b>88/493321</b>
<b>Filed:</b>	<b>June 28, 2019</b>
<b>Mark:</b>	<b>CAPTAIN</b>
<b>Examiner:</b>	<b>Edward Payabyab</b>
<b>Law Office :</b>	<b>128</b>

Commissioner for Trademarks  
2900 Crystal Drive  
Arlington, VA 22202-3514

**Docket No.: T99.4C-17521-US01**

**RESPONSE TO OFFICE ACTION**

This paper is filed in response to the Office Action transmitted and/or communicated on September 19, 2019.

**DESCRIPTION OF GOODS**

Please amend the description of goods as follows:

**NEW DESCRIPTION in Class 7:**

Stationary cranes used with manual and electric winches.

**OLD DESCRIPTION in Class 7:**

Cranes.

In the Trademark Office Action dated September 19, 2019 the trademark attorney refused registration under Trademark Act Section 2(d), 15 U.S.C. §1052(d); *see* TMEP §§1207.01 *et seq.* asserting the existence of a likelihood of confusion with the mark CAPTAIN (Registration No. 2010592) in class 7 for goods identified as “machine tools, namely turning machines and lathes”. Applicant respectfully traverses the refusal of registration in view of the mark CAPTAIN (Registration No. 2010592).

### **LIKELIHOOD OF CONFUSION**

#### **Refusal to Register 15 U.S.C. §1052(d) Likelihood of Confusion**

CAPTAIN Reg. No. 2010592 Machine tools, namely turning machines and lathes. Class 7

Applicant respectfully traverses the trademark attorney’s assertion as to the potential for, or existence of, a likelihood of confusion as communicated in the Office Action dated September 19, 2019. Applicant respectfully asserts that an analysis of the dissimilarities of applicant’s mark and the mark identified by US Trademark Registration Number 2010592 supports registration. For the below identified reasons applicant asserts that applicant’s mark CAPTAIN in class 7 is registerable for goods identified as stationary cranes used with manual and electric winches.

1. 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.

The goods identified for the CAPTAIN registration are for machine tools, namely turning machines and lathes. The machine tools, namely turning machines and lathes are

specialized goods, which are marketed to customers which make tools for sale to end users. Machine tools, namely turning machines and lathes may also be sold to a targeted customer which makes components for incorporation into a product or which are sold to a third party. The machine tools, namely turning machines and lathes are sold to specifically targeted customers in the manufacturing industry.

Applicant's goods in class 7 are identified as "stationary cranes used with manual and electric winches". Applicant's targeted customers: are cities and counties operating waste water treatment facilities, where applicant's goods are used to lift pumps, gates and filters as necessary to operate the waste water treatment facility; owners and builders of raised structures having mixing tanks requiring components to be lifted for placement into the mixing tank; and Hydro-electric dams and offshore oil platforms used to raise or lower debris, raise or lower supplies and raise or lower equipment. Applicant offers its cranes to specific targeted customers of specialized goods.

A sophisticated consumer is not likely to be confused that a mark which is used for turning machines and lathes overlaps and is also used on the specific goods of stationary cranes used with manual and electric winches for: cities and counties operating waste water treatment facilities, where applicant's goods are used to lift pumps, gates and filters as necessary to operate the waste water treatment facility; owners and builders of raised structures having mixing tanks requiring components to be lifted for placement into the mixing tank; and Hydro-electric dams and offshore oil platforms used to raise or lower debris, raise or lower supplies and raise or lower equipment. The likelihood of confusion is even less when the customer is sophisticated as applicable with respect to registrant's and applicant's goods.

Applicant therefore respectfully asserts that the difference between turning

machines and lathes for the manufacturing industry and applicant's stationary cranes used with manual and electric winches for the waste water treatment industry and other lifting industries are sufficiently different, especially as related to the specific targeted customers, supporting registration of applicant's mark for CAPTAIN herein.

The nature of registrant's goods is to sell machines to the manufacturing industry which are used to make tools and component parts.

The nature of applicant's goods is to lift items at a desired location.

Applicant therefore respectfully asserts that the Registrant's specialty goods and Applicant's specialty goods are significantly different from each other to remove any likelihood of confusion with respect to the relevant targeted consumers. This factor favors registration of applicant's mark for CAPTAIN herein.

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

An examination of the goods offered from the Registrant indicates that the goods are offered for specialized tool and component parts manufacturing purposes. It is likely that the goods would be advertised on the world wide web and available through specialized turning machines and lathes manufactures or distributors. Advertising for registrant's mark likely occurs on the world wide web.

Applicant's goods are offered for sale through specialty distributorships for the lifting equipment industries, for customers including: cities, counties and municipalities operating waste water treatment facilities; owners and builders of raised structures having mixing tanks requiring components to be lifted for placement into the mixing tank; and Hydro-electric dams and offshore oil platforms used to raise or lower debris, raise or lower supplies and raise or

lower equipment. Advertising for applicant's mark occurs on the world wide web and the goods are available through specialized lifting equipment distributors.

Applicant respectfully asserts that no crossover would be present in the channels of trade, in that, customers for applicant's goods do not visit or search for the specialty goods of stationary cranes used with manual and electric winches from manufacturers or distributors specializing in the sale or turning machines and lathes to make tools and component parts.

Customers for turning machines and lathes to make tools and component parts do not visit specialty distributors in the lifting equipment industries to look for turning machines and lathes. The specialized consumers would also not be confused as to the origin of the goods even if the consumer was somehow exposed to the others mark.

Applicant therefore respectfully asserts that the difference between the channels of trade favors registration of applicant's mark for CAPTAIN herein.

3. The conditions under which and buyers to whom sales are made, i.e. "impulse" vs. careful, sophisticated purchasing.

Applicant respectfully asserts that the customers for the specialized goods offered by registrant for turning machines and lathes as used in the manufacturing industry are extremely sophisticated consumers, especially since a turning machines or lathes may have an expense of tens of thousands of dollars or more.

Applicant respectfully asserts that customers for applicant's specialized goods of stationary cranes used with manual and electric winches are highly sophisticated, and are not likely to be confused as to the source of origin for applicant's products, especially since a single

unit of applicant's goods has an approximate expense of \$14,000 or more.

Neither registrant's nor applicant's goods are impulse items.

Due to the large sale expense of a single unit of registrant's or applicant's specialized goods, both registrant's and applicant's customers are extremely sophisticated and are not likely to be confused as to the source of origin for their respective specialized products. Applicant also respectfully asserts that as the per item sales expense increases, that customers become very sophisticated and discerning eliminating any likelihood of confusion as to the source of the goods. This factor favors registration of applicant's mark for CAPTAIN herein.

4. The fame of the prior mark.

No evidence has been provided that CAPTAIN has acquired fame or is famous. The absence of fame supports registration of applicant's mark herein.

5. The number and nature of similar marks in use on similar goods.

The USPTO TESS database indicates that 12 marks including the term CAPTAIN are either pending, registered, abandoned or cancelled in international class 7. Applicant respectfully asserts that the number of marks in class 7 favors registration of applicant's mark herein for the specialized goods of stationary cranes used with manual and electric winches.

6. The nature and extent of any actual confusion and the length of time during and the conditions under which there has been concurrent use without evidence of actual confusion.

Applicant has been using the mark CAPTAIN in interstate commerce on applicant's specialized goods of stationary cranes used with manual and electric winches since

October 31, 2013. During the last 6 years of concurrent use, applicant is not aware of any instances of actual confusion. The absence of any actual confusion favors registration of applicant's mark CAPTAIN herein for the specialized goods of stationary cranes used with manual and electric winches.

7. The variety of goods on which a mark is or is not used.

Applicant's mark is used on a single specialized product namely stationary cranes used with manual and electric winches. Applicant has no plans or intention to expand the use of CAPTAIN to any other product offered by applicant. Applicant as a specialized manufacturer restricts its product offerings to cranes, winches, controllers for winches and cranes, and cable for winches and cranes.

Registrant's mark is used on specialized products namely turning machines and lathes.

The number of goods being identified by the mark CAPTAIN in class 7 favors registration herein.

8. The market interface between the applicant and the owner of a prior mark.

Applicant is not aware, and does not anticipate, any market interface between applicants specialized goods and registrant's specialized goods identified as turning machines and lathes. The absence of any market interface favors registration of applicant's mark herein.

9. The extent to which applicant has a right to exclude others from use of its mark on its goods.

Based on the last six years of continuous use in interstate commerce, applicant believes that applicant has the right to exclude others from use of the mark CAPTAIN on goods described as cranes.

10. The extent of potential confusion.

Applicant asserts that the extent of potential confusion is very negligible.

A specialized consumer is not likely to be confused that a mark which is used for turning machines or lathes in the manufacturing industry overlaps and is also used on the specific goods of stationary cranes used with manual and electric winches in the waste water treatment as well as other industries.

The registered mark is used in the manufacturing industry as compared to applicant's mark which is used in lifting industry applications. The difference in industries and lack of crossover therebetween eliminates any likelihood of confusion between the marks. The potential for confusion within two different specialized industry products is also negligible because of the different channels of trade.

The expense of one of applicant's stationary cranes used with manual and electric winches is approximately \$14000.00 or more. The expense of one of registrant's turning machines or lathes may be tens of thousands of dollars. This relatively large expense means that significant care is being exercised in the purchase of the products, where the customers will be cautious and sophisticated in the purchasing decision, and not likely to be confused as to the source of origin of the goods.

All of the above factors show that the extent of potential confusion is negligible



favoring registration of applicant's mark herein.

In specialized industries, having sophisticated consumers, searching for specialized goods, a consumer is not likely to be confused as to the source of origin of the applicant's or registrant's specialized products due to the vast distance between the identified industries. No likelihood of confusion is present in this application between applicant's mark and registrant's mark in commerce.

It is not appropriate for the trademark attorney to make a general assumption that an auction business which sells a vast number of diverse products which on occasion will sell a turning machine or lathes and at another time may sell a crane establishes a likelihood of confusion in commerce. The appropriate inquiry is the existence of a likelihood of confusion when a sophisticated consumer encounters the mark in commerce. In specialized industries, having sophisticated consumers, searching for specialized goods, a consumer is not likely to be confused as to the source of origin of the applicant's or registrant's specialized products due to the vast distance between the identified industries. No likelihood of confusion is present in this application between applicant's mark and registrant's mark in commerce.

At a minimum, for the above identified reasons, Applicant respectfully asserts that applicant's mark for CAPTAIN for the specialized goods of stationary cranes used with manual and electric winches is registrable in view of U.S. Trademark Registration 2010592. Applicant requests the allowance and publication of the present application.

In view of the above applicant respectfully asserts the absence of any Likelihood of Confusion herein, and respectfully requests withdrawal of the rejection based on the same.

**Conclusion**

Reconsideration of this application is respectfully requested. Applicant and counsel now contend that this case is in condition for allowance and publication. Should the Trademark Attorney have any questions the Trademark Attorney is earnestly solicited to contact the undersigned by telephone and/or E-mail to expedite prosecution herein. Applicant respectfully requests the enclosed application be allowed and moved to publication. Applicant respectfully asserts that the trademark application herein is in condition for publication and early action to that affect is earnestly solicited.

If an extension of time is required to make this response timely and no separate petition is enclosed, Applicant hereby petitions for an extension of time sufficient to make the response timely. In the event that this response requires the payment of any government fees in order to make this response timely, or any government fees for any other reason, and payment is not enclosed, please charge Deposit Account No. 22-0350.

Respectfully submitted,

VIDAS, ARRETT & STEINKRAUS

Date: March 5, 2020

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