

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

MARK: EASY CONNECT
SERIAL NO.: 88478754
APPLICANT: Jason Ingram
FILING DATE: June 18, 2019
INTERNATIONAL CLASS: 011
TO: Commissioner for Trademarks
ATT'N: Jeffrey S. Molinoff
Trademark Attorney
Law Office 122

RESPONSE TO OFFICE ACTION DATED SEPTEMBER 10, 2020

This is in response to the Office Action dated September 10, 2020, wherein the Examining Attorney made final the refusal to register the mark EASY CONNECT under Section 2(d) of the Lanham Act, 15 U.S.C.A. § 1052(d), on the ground that it gives rise to a likelihood of confusion with EASY CONNECT (1735844) for cooling towers featuring an inlet piping arrangement, in Class 011 and EZ-CONNECT (1912236) for plumbing adapters, namely couplings and joints, made of metal, for pipes, in Class 006. Applicant respectfully requests that the Examining Attorney reconsider and withdraw the refusal to register on this ground.

AMENDMENT TO IDENTIFICATION OF GOODS

To overcome the objection to likelihood of confusion, the Applicant can amend its description to exclude connections to water cooling towers and plumbing and/or specify it is for residential HVAC units.

ARGUMENT

The Examiner has refused registration of Applicant's mark EASY CONNECT for HVAC UNITS on the ground that it gives rise to a likelihood of confusion with the following registrations (collectively, the "Cited Marks"):

CITED MARK	COVERED GOODS	OWNER
EASY CONNECT Reg No. 1735844	cooling towers featuring an inlet piping arrangement, in Class 011	Baltimore Aircoil Company, Inc.
EZ-CONNECT Rg. No. 1912236	plumbing adapters, namely couplings and joints, made of metal, for pipes, in Class 006	MUELLER INDUSTRIES, INC.

Applicant respectfully disagrees and submits that the refusal should be withdrawn on the ground that there is no likelihood of confusion as to the source of the respective services because: (1) the Applicant's goods are different in nature and purpose from the goods covered by the Cited Marks; (2) the conditions under which sales are made are distinct and the relevant buyers are sophisticated and thus likely to exercise a high degree of care; and (3) the Cited Marks are weak and therefore only entitled to a limited scope of protection.

I. Likelihood of Confusion Standard

Likelihood of confusion is determined on a case-by-case basis, with application of the factors identified in Application of E.I. DuPont DeNemours & Co., 476 F.2d 1357 (C.C.P.A. 1973).

The likelihood standard means that it must be probable that confusion as to source will result from the simultaneous registration of two marks; it is not sufficient that confusion is merely possible. Trademark law is “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 & Sales, Inc. v. Electronic Data Systems Corp.*, 954 F.2d 713 (Fed. Cir. 1992), quoting *Witco Chemical Co. v. Whitfield Chemical Co.*, 418 F.2d 1403 (C.C.P.A. 1969).

As such, no per se rule exists that confusion is automatically likely between marks merely because they share similar wording, as demonstrated in numerous federal cases and Board proceedings. See, e.g., *IN RE HARTZ HOTEL SERVICES, INC.*, 2012 WL 1267900 (T.T.A.B. 2012) (no likelihood of confusion between GRAND HOTELS NYC and GRAND HOTEL for hotel services); *IN RE INTELISTAF HEALTHCARE MANAGEMENT, L.P.*, 2006 WL 936990 (T.T.A.B. 2006) (no likelihood of confusion between INTELLICASH for consumer debit card services and INTELECASH for business services involving debit cards); *Jacobs v. International Multifoods Corp.*, 668 F.2d 1234 (C.C.P.A. 1982) (no likelihood of confusion between BOSTON TEA PARTY for tea and BOSTON SEA PARTY for restaurant services); *Omaha Nat. Bank v. Citibank (South Dakota), N.A.*, 633 F. Supp. 231 (D. Neb. 1986) (no likelihood of confusion between BANK IN A BILLFOLD and BANK IN A WALLET for banking credit card services); *Citigroup Inc. v. Capital City Bank Group, Inc.*, 637 F.3d 1344 (Fed. Cir. 2011) (no likelihood of confusion between CAPITAL CITY BANK and CITIGROUP for banking and financial services); *Franklin Resources, Inc. v. Franklin Credit Management Corp.*, 988 F. Supp. 322 (S.D. N.Y. 1997) (no likelihood of confusion between FRANKLIN for investment services and same mark for debt collection services); *McGraw-Hill, Inc. v. Comstock Partners, Inc.*, 743 F. Supp. 1029 (S.D. N.Y. 1990) (no likelihood of confusion between COMSTOCK for stock and commodity trade information services and same mark for money management services); *Allstate Ins. Co. v. Allstate Inv. Corp.*, 210 F. Supp. 25 (W.D. La. 1962), judgment aff'd, 328 F.2d 608 (5th Cir. 1964) (no likelihood of confusion between ALLSTATE for insurance services and same mark for mortgage brokerage services).

Indeed, as the Board has frequently held, registrations for identical marks for closely related goods and services may coexist when the totality of the circumstances indicates there is no likelihood of confusion. See, e.g., *In re Itec Manufacturing, Ltd.*, 2008 WL 885926, *4–5 (T.T.A.B. 2008) (PAL for a patient-lifting medical device and PAL for lithotomy medical devices and patient support mattress pumps); *In re Hyundai Motor America*, 2009 WL 4086577 (T.T.A.B. 2009) (ECHELON for automobiles and ECHELON for automotive tires); *In re Kaemark, Inc.*, 2008 WL 5256390 (T.T.A.B. 2008) (LUXE for salon furniture and LUXE for furniture); *IN RE HAGEMEYER NORTH AMERICA, INC.*, 2007 WL 2698300 (T.T.A.B. 2007) (VERSAPRO for weed killer and VERSAPRO for garden tools); *IN RE APOLLO COLORS, INC.*, 2005 WL 1787221 (T.T.A.B. 2005) (APOLLO for color pigments in the graphic arts industry and APOLLO for dye and pigments used in the leather and textile industry).

Not all of the DuPont factors are relevant to every case and the significance of a particular factor may differ from case to case. *In re Mighty Leaf Tea*, 601 F.3d 1342, 1346 (Fed. Cir. 2010); *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 1315 (Fed. Cir. 2003); *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 946 (Fed. Cir. 2000); *In re Dixie Restaurants, Inc.*, 105 F.3d 1405, 1406–07 (Fed. Cir. 1997).

The Examining Attorney is correct that the similarity of the marks should be considered, but it is just one of many relevant factors. Equally significant here are the dissimilarity and nature of the goods, the dissimilarity of the trade channels used to target the respective customers, the degree of care used by the consuming public, and the relative weakness of the Cited Marks. *Application of E. I. DuPont DeNemours & Co.*, 476 F.2d 1357 (C.C.P.A. 1973). Applicant respectfully submits that, here, a proper comparison of the DuPont factors reveals that consumer confusion is unlikely.

II. The Respective Goods Are Distinguishable.

The goods offered under the respective marks are dissimilar. There is no per se rule that goods or services which fall into the same broad, general field are “related” for Section 2(d) purposes. See *Umc Industries, Inc. v. Umc Electronics Co.*, 207 U.S.P.Q. 861, 879, 1980 WL 30155 (T.T.A.B. 1980) (“[T]he fact that one term, such as ‘electronic’, may be found which generically describes the goods of both parties is manifestly insufficient to establish that the goods are related in any meaningful way.”).

Applicant offers HVAC Units online and in stores. In contrast, the goods covered under the Cited Marks are, essentially, for cooling towers and plumbing adapters, respectively. This is completely unrelated to Applicant's goods which are designed for home use for climate control.

The Examining Attorney states that the parties' goods “Here, applicant’s goods and registrants’ goods are related because they are commonly offered by the same companies under the same mark and sold through the same trade channels to the same consumers. Therefore, consumers are accustomed to these goods/services emanating from the same source.” This is not the case. Most of Applicant’s customers buy the product online for their home and install the product themselves. The cited marks are being used in industrial applications.

It is not enough to prove relatedness under Section 2(d) by showing that one general category or term can be found that encompasses each of the respective identified goods or services. As the courts have consistently recognized, more is required.

The Applicant's goods are sold in the residential market not the commercial market like the cited marks. Very little pipes or plumbing is used on HVAC Home units. There is a drain line and possibly a hose connecting an indoor unit with an outdoor unit but often the hoses enclose wires. The Examining Attorney has not provided sufficient evidence to support his position that such items are sold in the same commercial context.

There are fundamental differences in the goods offered by the Applicant and those covered under the Cited Marks. The parties do not compete with one another. The differences between the goods covered by the Applicant's Mark, as proposed to be amended, and the goods covered by the Cited Marks obviate any likelihood of confusion.

IV. Conditions Under Which Sales Are Made and The Buyers To Whom They Are Made Renders Confusion Unlikely

Conditions under which purchases of a particular kind of good or service are made are to be considered in determining likelihood of confusion. TMEP § 1207.01, citing *In re E.I. DuPont de Nemours & Co.*, at 1360-62. When the relevant buyer class is composed of professional purchasers such as real estate brokers, consulting engineers, or contractors, the likelihood of confusion will be lower. See *Jet, Inc. v. Sewage Aeration Systems*, 165 F.3d 419, 423, 43 Fed. R. Serv. 3d 231, 1999 FED App. 0003P (6th Cir. 1999) (citing *Homeowners Group, Inc. v. Home Marketing Specialists, Inc.*, 931 F.2d 1100, 1111 (6th Cir. 1991)); See also, *In re American Olean Tile Company Inc.*, 1 U.S.P.Q.2d 1823, 1986 WL 83338 (T.T.A.B. 1986) (no confusion between MILANO for ceramic tile sold to trade and MILANO for wooden doors sold to the public); *In re Shipp*, 4 U.S.P.Q.2d 1174, 1987 WL 123841 (T.T.A.B. 1987) (PURITAN for professional dry cleaning machine filters not likely to cause confusion with PURITAN for dry cleaning services sold to public).

The Applicant's goods consist of residential HVAC Units often purchased on the internet and delivered to the customer's home so the customer can install the unit themselves. The cited marks are sold in a commercial context. Accordingly, the cited marks cannot be purchased

without sales contact and often accompanying installation. Moreover, consumers of the cited goods would likely be professional purchasers knowledgeable in their industry. Thus, it is reasonable to conclude that consumers of the the cited mark's goods are likely to exercise a high degree of care in their purchasing decisions and that purchase of the cited mark's goods would likely be the result of forethought and analysis. Moreover, the Applicant's goods are relatively expensive, which increases the likelihood that such purchases would be made with care and mitigates any alleged confusion. See e.g., *Alpharma Inc.* 2009 WL 273252 at (T.T.A.B. 2009) (holding that the substantial amount of money consumers paid for defendant's staplers supported the finding against consumer confusion); *Full Speed Ahead, Inc. v. SRAM Corp.*, 2008 WL 5256412 at *4–8 (T.T.A.B. 2008) (finding that the fact that bicycle parts—which “range in cost and quality from the basic and less expensive to the high-tech/high-end and more expensive”—are “relatively expensive, and not impulse items,” supported the finding of no confusion).

In sum, “the goods at issue on their face are not only distinctly different, but they clearly are very expensive and would be bought ... only by highly knowledgeable, discriminating and sophisticated purchasers after thorough deliberation rather than on impulse.” In re *Nexgen*, 2006 WL 2557987 at *13. As the Board has noted, such “sophistication is important and often dispositive.” In re *Nexgen*,, quoting *Electronic Design & Sales, Inc. v. Electronic Data Systems Corp.*, 954 F.2d 713, 722 (Fed. Cir. 1992); See also *IN RE CROSSWALK, INC.*, 2007 WL 2344684, *8 (T.T.A.B. 2007) (reversing refusal of registration where marketing targets were professionals who were not likely to be confused as to source). When combined with differing goods, as here, it outweighs any similarities between marks. In re *Itec*, 2008 WL 885926 at *5 (no confusion despite identical marks because hospital purchasers are sophisticated).

III. The Cited Marks Are Weak and Entitled to Only Limited Scopes of Protection

The relative strength (or lack thereof) of a prior mark is relevant to the likelihood of confusion analysis. Here, the Cited Marks are relatively weak and therefore only entitled to a narrow scope of protection.

A. The Cited marks Are Weak Because They Coexist with Each Other and With Nearly Identical Marks for Closely Related Goods and Services

As the Trademark Trial and Appeal Board stated in *Pizza Inn, Inc. v. Russo*, 221 U.S.P.Q. 281, 283, 1983 WL 51842 (T.T.A.B. 1983), it is well recognized that third party registrations are of

value to the extent they indicate that a particular word, feature or design has been adopted and registered by others in a particular field. Such registrations indicate that the word, feature or design is more suggestive than arbitrary in a particular field, and, therefore, such a registration for goods or services in the same or related field should be given a more restricted scope of protection. 254 F.2d at 160. Accord *In re Dayco Products- Eagle Motive Inc.*, 9 U.S.P.Q.2d 1910, 1911, 1988 WL 252342 (T.T.A.B. 1988); *Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 917 (C.C.P.A. 1976).

Further, evidence of third-party use of similar marks on similar goods is relevant to show that a mark is relatively weak and entitled to only a narrow scope of protection.” *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 1372 (Fed. Cir. 2005); *Miles Laboratories Inc. v. Naturally Vitamin Supplements Inc.*, 1 U.S.P.Q.2d 1445, 1463, 1986 WL 83319 (T.T.A.B. 1986) (the presence of common elements unrelated as to source that are used extensively by firms and persons, may cause purchasers to not rely upon such elements as source indicators but to look to other elements as a means of distinguishing the source of the goods). See also *Continental Grain Co. v. Central Soya Co., Inc.*, 69 F.3d 555 (Fed. Cir. 1995) (“Where the common element of conflicting marks is ‘weak’ in the sense that such portion ... is in common use by many sellers in the market, then this reduces the likelihood of confusion.”); *In re Bed & Breakfast Registry*, 791 F.2d 157 (Fed. Cir. 1986) (no likelihood of confusion between BED AND BREAKFAST REGISTRY and BED AND BREAKFAST INTERNATIONAL, because the common part was the weak and descriptive phrase “bed and breakfast”).

The scope of protection afforded to such marks is limited because, by virtue of its frequent usage, the common term in the mark does little to distinguish the products or services from those of others. See, e.g., *King Candy Co. v. Eunice King's Kitchen, Inc.*, 182 U.S.P.Q. 108, 109–10, 496 F.2d 1400 (C.C.P.A. 1974). Accord *Puma-Sportschuhfabriken Rudolf Dassler K.G. v. Superga S.P.A.*, 210 U.S.P.Q. 316, 317, 1980 WL 30117 (T.T.A.B. 1980) (where plaintiff adopts a commonly used mark, “his competitors may come closer to his mark without violating his rights than would be the case with a strong mark”).

The Cited Marks coexist with numerous similar third-party marks for closely related goods. Specifically, “Easy Connect” is commonly used in trademarks owned by many unaffiliated

third parties for goods in Classes 009 and 011. Over the years, the Office has consistently permitted these close formatives to coexist on the Register, perceiving no risk of confusion. For this reason as well, the Cited Marks are weak and entitled to a limited scope of protection.

A representative list of similar registrations includes the following:

TRADEMARK/REG. NO.	LAST LISTED OWNER	RELEVANT GOODS/SERVICES
EZ CONNECT (logo) RN: 2743911	Ruud Lighting, Inc.	Int'l Class 009: modular wiring products, namely, electric wiring for installing multiple lighting fixtures.
EZCONNECT RN: 3786592	Liquid Controls LLC	Int'l Class 009: Apparatus for transmission of communication in the nature of vehicle identification communicators for refueling fleet vehicles, namely, a vehicle carried identity source, a portable communicator temporarily connectable to the identity source and having electronics and programming for reading the identity of the vehicle from the identity source and wirelessly communicating that information to a fuel management center for use in refueling vehicles.
EZKONNECT RN: 3839123	BCI Burke Company	Int'l Class 006: Deck mounting system comprised of metal connectors for connecting decks to outdoor play equipment.
EZ CONNECT RN:4633013	POLYGROUP MACAU LIMITED CORPORATION BR.VIRGIN ISLANDS OFFSHORE INCORPORATIO NS	Int'l Class 028: Pre-lit artificial Christmas trees.
Easy Connect RN: 4548970	Brunson Instrument Company	Int'l Class 009: connectors for installation on stands with thread-enabled mounting means to permit rapid coupling and decoupling of electric, electronic, and other scientific precision measuring tools and equipment to and from such stands.
EZ CONNECT EYEWEAR RN: 4561140	Clic Goggles, Inc.	Int'l Class 009: Eyewear.

EZCONNECT RN: 4791244	Dollamur, LP Dollamur Holding, LLC	Int'l Class 027: Sporting mats, namely, martial arts mats, grappling mats, wrestling mats, gymnastic mats, cheerleading mats and gymnastic tumbling mats.
EZ CONNECT RN: 5076557	FasTest, Inc.	Int'l Class 006: Temporary metal connectors for use in conjunction with compressed gas and liquid systems and used for quick temporary attachment to pass compressed gasses and liquids, for use with in-process leak testing and processing of products in the fields of refrigeration, medical, manufacturing, compressed gas, calibration and industrial processing.
EZ-CONNECT RN: 5335810	IMADA Co., Ltd.	Int'l Class 009: Force measurement products, namely, digital force gauges, digital torque gauges and manual and motorized test stands used therewith sold as a unit with the gauges; instruments for detecting and measuring two-dimensional distribution of force and pressure.
EZCONNEX RN:5116068	S. J. ELECTRO SYSTEMS, INC	Int'l Class 009: Electrical wiring module in the nature of an electrical connector used to link liquid level control floats with a control panel in the water and wastewater industries
EZ-CONNECT RN: 5186096	North American Power Products, Inc. DBA Global Power Products	Int'l Class 009: Automatic transfer switches (ATS).
EZ CONNECT RN: 5379108	Casite Intraco, LLC	Int'l Class 001: Automobile tire inflator sealers. Int'l Class 012: Tire inflators.
EZ-CONNECT COMPACT RN: 5217569	ENVIRO WATER SOLUTIONS LLC DBA PELICAN WATER SYSTEMS	Int'l Class 011: Water softening units; Water treatment equipment, namely, water filtration units.

The USPTO has consistently taken the position that such marks can coexist with a narrow scope of protection to each and without risk of confusion, because other elements of the marks sufficiently distinguish them from each other.

The coexistence of such similar marks for closely related goods with the Cited Marks supports the conclusion that Applicant's mark is also capable of coexisting with the Cited Marks without any likelihood of confusion.

V. Supplemental v. Principal Register

Most of the above mentioned registrations are on the principal not the supplemental register. Even one of the two cited marks are on the principal: Supplemental: EASY CONNECT (1735844) for cooling towers featuring an inlet piping arrangement, in Class 011 and Principal: EZ-CONNECT (1912236) for plumbing adapters, namely couplings and joints, made of metal, for pipes, in Class 006.

There is no evidence that the supplemental is more appropriate than the principal.

VI. Specimen

The specimen shows use as a branding for HVAC Unit connections: “easy connect” connections. Therefore, it should be accepted.

VII. Conclusion

Given (1) the distinctions in the nature and purpose of the respective goods, (2) the differing conditions under which sales are made and the sophistication of the relevant purchasers, and (3) the relative weakness of the Cited Marks, consumer confusion is unlikely. Therefore, Applicant respectfully requests that the Section 2(d) refusal be withdrawn. Applicant believes it has responded to all of the issues raised in the Office Action and submits that its application is ready for publication.

Respectfully submitted,

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I hereby certify that this Response was filed on March 10, 2020 through TEAS.

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