IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark: FLEXPRO	)	
	)	**Trademark Attorney:**
Serial No.: 88455594	)	**Salima Parmar Oestreicher**
	)	**Law Office: 108**
Filing Date: May 31, 2019	)	
	)	
Applicant: Barta-Schoenewald, Inc.	)	

RESPONSE TO OFFICE ACTION NO. 1

Applicant hereby respectfully responds to the Examining Attorney's Office Action No. 1. Applicant has amended the identification of goods as requested and has paid the fee for an additional class of goods. The remaining issue to be addressed is the Examining Attorney's refusal to register Applicant's mark under Trademark Act §2(d), 15 U.S.C. §1052(d).

NO LIKELIHOOD OF CONFUSION EXISTS

No likelihood of confusion exists between Applicant's mark, FLEXPRO for "Servo-drives for motors, namely, brushed motors, brushless motors, linear motors, stepper motors, vector motors, induction motors and other single or three phase motor systems" in International Class 007, or "servo drives in the nature of electronic controllers, and electronic servo motor controllers" in international Class 009 (both classes of goods hereinafter collectively "Servo-Drives"), and the registrations and pending application cited by the Examining Attorney in her Office Action No. 1. The

cited registrations and application are U.S. Registration Nos. 5011270 and 2258755, and Application No. 87358089. Applicant notes that Registration No. 2258755 is due to be cancelled for failure to file maintenance documents on or before January 6, 2020 and is therefore not addressed herein. The Applicant, hereby respectfully requests the Examining Attorney to consider Applicant's amendment, legal argument and evidence submitted herewith and, withdraw the refusal to register Applicant's mark.

Applicant's Goods Are Not Related to Those in the Cited Records

Applicant's identified goods, Servo-Drives, are not "related" in any manner to the goods in the Registration No. 5011270 (FLEXPRO for "Cellular repeaters; cell phone signal boosters; wireless Internet signal boosters") in International Class 09, or those in Application No. 87358089 (PROFLEX for "audio-visual cables and wires, excluding electrical cables and wires"). The Servo-Drives offered for sale by Applicant under the FLEXPRO trademark are sophisticated electronic subcomponents which are engineered into machinery to drive electrical current into a motor to cause and control motion. See Declaration of René Ymzon, ¶ 3, a true and correct copy of which is submitted electronically as Exhibit 1 herewith.) Servo-Drives are used, by way of example, in machines which precisely control a robot arm or move a load to a position with micrometer accuracy. Exh. 1, ¶3. A Servo-Drive is not capable of doing anything as a stand-alone good. Exh. 1, ¶3. It must be designed, i.e., engineered, into a far more complicated machine by a machine designer, usually an engineer for an original equipment manufacturer ("OEM"). Exh. 1, ¶3. In the industry, we refer to this type of product as requiring an "engineered solution". Exh. 1, ¶3.

Applicant is highly familiar with the Servo-Drive industry and knows of no manufacturer which sells Servo-Drives, on the one hand, as well as cellular repeaters, cell phone signal boosters, wireless Internet signal boosters, or audio-visual cables and wires, on the other hand. Exh. 1, ¶5. Servo-Drives are sold to machine designers and manufacturers and the other items sold above are sold to general consumers. Exh. 1, ¶5. (See also the Examining Attorney's Office Action No. 1 and evidence attached thereto.) Because Servo-Drives and these other items are made by different manufacturers, it is unlikely that a customer of one of these items is likely to mistakenly believe that a single manufacturer makes Servo-Drives and any one of these other items. Exh. 1, ¶5. Servo-Drives, on the one hand, and cellular repeaters, cell phone signal boosters, wireless Internet signal boosters, or audio-visual cables and wires on the other hand, are unrelated goods in that they function completely differently and involve very different technologies, serve different purposes, are sold to different classes of customers, and are manufactured by different entities. Exh. 1, ¶5. Because of the foregoing factors, Applicant's goods and the goods in the cited Registrations and Applicant are not "related" as the respective customers of Applicant's goods and the other referenced goods are not likely to be mistakenly thought to emanate from a single source. Absent some significant relationship or competitive proximity between the goods provided in connection with each mark, even where the marks are identical, a likelihood of confusion will not exist. See, *Shen Mfg. Co. v. Ritz Hotel Ltd*., 393 F.3d 1238, 1244-45, 73 USPQ2d 1350, 1356-57 (Fed. Cir. 2004).

Applicant's Customers Are Sophisticated, Applicant's Goods Are Not Inexpensive, and Applicant's Trade Channels Differ

Additional factors under the du Pont test support a finding of no likelihood of confusion. *In re E. I. du Pont de Nemours & Co.,* 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973). Applicant's Servo-Drives cost at least $565 each and require engineering to be used in the machinery in which they will be incorporated. Exh. 1, ¶¶ 3,6. Applicant's point of contact with its customers is typically with the customers' engineers, and the purchase of Applicant's product typically involves several months of communication and testing to determine which of Applicant's Servo-Drives best serves the need of the customer who will build the Servo-Drive into its machinery. Exh. 1, ¶4. The goods in the cited Registration and Application are consumer products which require little or no understanding of how the goods function. Exh. 1, ¶5. One does not need to have an engineering background to use the goods in the cited Registration and Application. Exh. 1, ¶5. These factors distinguish Applicant's goods from the goods in the cited Registration and Application in a very real, material and substantial way. Because only sophisticated purchasers exercising great care would purchase Applicant's Servo-Drives, there would be no likelihood of confusion merely because of the alleged similarity between the marks. Exh. 1, ¶4. See also, *In re N.A.D., Inc.*, 754 F.2d 996, 999-1000, 224 USPQ 969, 971 (Fed. Cir. 1985) (concluding that, because only sophisticated purchasers exercising great care would purchase the relevant goods, there would be no likelihood of confusion merely because of the similarity between the marks.) While buying a cell signal booster could be an impulse buy while out shopping for other items, many of the Registrant's goods and the other items submitted in the Examining Attorney's evidence cost hundreds of dollars or more. (See evidence

attached to Office Action No. 1.) The Wilson [brand] antenna cited by the Examining Attorney on page 23 of Office Action 1 lists a price of $1099.99. *Id.* @ p. 23. The Wilson [brand] black cable is listed at $599.95. *Id.* at p. 31. Thus, these are also unlikely to be items purchased on impulse. The decision to buy a Servo-Drive component that impacts the function of a highly engineered machine is the opposite of an impulse purchase. Both the nature of the goods and the cost of the goods weigh strongly against any likelihood of any confusion as to source.

"PRO" and "FLEX" are Terms Used in Many Registered Trademarks

The Court of Appeals for the Federal Circuit and the Trademark Trial and Appeal Board have recognized that where terms are commonly used by many parties, the goods and services must be closely related for a finding of likelihood of confusion. *Juice Generation, Inc. v. GS Enterprises. LLC*, 794 F.3d 1334, 115 USPQ2d 1671 (Fed. Cir. 2015). In *Juice Generation*, the CAFC stated where there are multiple parties using similar terms, it is "less likely to generate confusion over source identification". *Id*., at 1342. In this case, there are hundreds of live registrations for goods and services including the terms "FLEX" and "PRO". There are literally many thousands of registered marks using either the term "PRO" or "FLEX". (See the search strategy conducted by the Examining Attorney on August 29, 2019 attached to the Declaration of Angela Small Booth, ¶ XX, Attachment A.) Applicant will submit formal evidence of these registrations if a further refusal to register is issued, as well as additional third party evidence of use of these terms on relevant goods, but Applicant asserts this should be unnecessary. When numerous marks use the same terms,

consumers learn to differentiate between the respective sources of goods and a greater relationship between the goods is required to make a finding of likelihood of confusion. *Juice Generation at 1342;* see also *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee en 1772*, 396 F.3d 1369, 1373, 73 USPQ2d 1689, 1693 (Fed. Cir. 2005); *Giersch v. Scripps Networks, Inc.*, 90 USPQ2d 1020, 1026 (TTAB 2009); *In re Box Solutions Corp.*, 79 USPQ2d 1953, 1957-58 (TTAB 2006); *In re Cent. Soya Co.*, 220 USPQ 914, 916 (TTAB 1984).

The Marks Have Different Connotations

The Examining Attorney has failed to analyze the connotations of the terms "FLEX" and "PRO" in connection with wither Applicant's goods or the goods in the cited Registration or Application. In Applicant's mark, the term "FLEX" suggests flexibility of capacity and use in the context of mechanical and electrical engineering for motion control machinery and "PRO" suggests use of Applicant's goods in the industry rather than home use. In comparison, in Registration No. 5011270 (FLEXPRO for “Cellular repeaters; cell phone signal boosters; wireless Internet signal boosters”) "FLEX" suggests the identified goods will increase the physical area of reception of a cellular provider's signal. (See evidence attached to Office Action No. 1, at pp. 16, 17, 20, 22.) In the case of Application No. 87358089 (PROFLEX for "audio-visual cables and wires, excluding electrical cables and wires"), the term "FLEX" has the connotation of a cable or wire that is bendable, and PROFLEX has the connotation that the goods are really great at being bendable or flexible. *Id.* At p. 14. Thus, the terms "FLEX" and "PRO" have very different connotations. No likelihood of confusion exists where the marks have

different connotations as applied to the respective goods or services even where identical terms are used. *See* In re *Farm Fresh Catfish Co*., 231 USPQ 495, 495-96 (TTAB 1986); *In re Sydel Lingerie Co.*, 197 USPQ 629, 630 (TTAB 1977) (holding **BOTTOMS UP** for ladies' and children's underwear and **BOTTOMS UP** for men's clothing not likely to cause confusion due to different connotations of the marks as applied to the respective goods.). "The basic principle in determining confusion between marks is that marks must be compared in their entireties and must be considered in connection with the particular goods or services for which they are used [. . .]". *In re National Data Corp.*, 753 F.2d 1056, 1058, 224 USPQ 749, 750-51 (Fed. Cir. 1985) (emphasis added.). The Examining Attorney has failed to analyze the meaning of the marks as they are applied to the respective goods.

The Examining Attorney Has Not Met Her Burden Of Proof

In general, the Examining Attorney must always support his or her office action with relevant evidence and ensure that proper citations to the evidence are made in the Office Action. See TMEP § 710.01, 706.01. "The examining attorney must provide evidence showing that the goods and services are related to support a finding of likelihood of confusion." TMEP §1207.01(a)(vi) (emphasis added). The Examining Attorney must also provide evidence to establish the meaning or connotation of a mark *as applied to the goods or services*. TMEP§§ 1203.01, 1203.02(d), 1207.01(b)(vi)(B), 1210.01(a), 1211.02(a), *et al.* The Examining Attorney's evidence in Office Action No. 1 is insufficient. The evidence submitted with Office Action No. 1 consists of internet printouts from Lowes.com and other websites purporting to advertise television antenna

signal boosters, cellular phone signal boosters, and products including "ANTOP [brand] Amplifier High Gain Low Noise Signal Booster for TV antenna with USB cable", "Excel Wireless [brand] Cell Phone Signal Booster", "Excel Wireless [brand] Cable Jumper Assembly" for use in wireless communications, "SureCall [brand]" "cell phone signal booster", Wilson [brand] Pro 70 Plus antenna for cellar devices, Wilson [brand] cellular booster, and Wilson [brand] "CELL PHONE SIGNAL BOOSTER ACCESSORIES" namely cable for use with cell signal boosters. (See evidence attached to Office Action No. 1, at pp. 13-35.) None of these goods are related to Applicant's Servo-Drives. As stated in *In re Princeton Tectonics, Inc*., 95 USPQ2d 1509, 1511 (TTAB 2010), "Turning to the website evidence, we likewise find the evidence not probative of the relatedness of personal headlamps and electric lighting fixtures. Here also, the evidence [. . .] is from sources which sell a broad range of varied and unrelated goods online. " *Id.* Lowes.com sells everything from garden mulch and chicken manure, to glass cleaner, to NFL Team branded cups and coolers, to the proverbial kitchen sink. (See (Declaration of Angela Small Booth, ¶¶ 3-7, and Attachments B-F attached thereto.) In addition, the evidence submitted by the Examining Attorney did not show the purportedly related goods even sold under the same or similar brands. The evidence attached to Office Action No. 1 does not support a likelihood of confusion in the present Application.

Although Lowes.com sells almost anything one can imagine, Lowes.com does not offer "servo controllers" or "servo drives" or "electronic controllers" or "electronic servo motor controllers". (See Declaration of Angela Small Booth, ¶¶ 8-11 and Attachments G-J thereto.) The remaining evidence submitted by the Examining

Attorney relates to goods not relevant to the present refusal to register. Thus, thus Examining Attorney has not made a *prima facie* case supported by evidence.

The Examining Attorney must provide reliable evidence showing that the goods and/or services are related to support a finding of likelihood of confusion. In a case well on point, *Quartz Radiation Corp. v. Comm/Scope Co.*, 1 USPQ2d 1668, 1669 (TTAB 1986) held QR for coaxial cable and QR for various apparatus used in connection with photocopying, drafting, and blueprint machines was not likely to cause confusion because of the differences between the parties' respective goods in terms of their nature and purpose, how they are promoted, and who they are purchased by). *See, e.g., In re White Rock Distilleries Inc.,* 92 USPQ2d 1282, 1285 (TTAB 2009) (finding Office had failed to establish that wine and vodka infused with caffeine are related goods because there was no evidence that vodka and wine emanate from a single source under a single mark or that such goods are complementary products that would be bought and used together). In *In re White Rock Distilleries Inc.,* website evidence showing both wine and vodka sold in the same stores would clearly have been available. However, this alone is not sufficient evidence.

The Refusal to Register Should Be Withdrawn

"[T]here is no mechanical test for determining likelihood of confusion and 'each case must be decided on its own facts'." TMEP Section 1207.01, citing *Du Pont*, 476 F.2d at 1361, 177 USPQ at 567. "In some cases, a determination that there is no likelihood of confusion may be appropriate, even where the marks are similar and the goods/services are related, because these factors are outweighed by other factors,

such as differences in the relevant trade channels of the goods/services [. . . .]" TMEP § 1207.01. Applicant respectfully asserts that the factors herein, including the additional evidence consisting of the Declaration of René Ymzon, and the Declaration of Angela Small Booth and the Exhibits thereto, do not support the Examining Attorney's initial refusal to register under Trademark Act § 2(d). Therefore, The Applicant respectfully requests the refusal to register be withdrawn.

Respectfully,

/Angela Small Booth/

Angela Small Booth
Attorney for Applicant