

RESPONSE TO NON-FINAL OFFICE ACTION

Application Serial No. 88660424

Applicant has applied for the mark “FROSTBITE” in special form for use in connection with the following:

International Class 007 Brushes being parts of or for use with ice scrapers; ice and snow brushes for use with removing ice and snow from vehicles

On January 16, 2020 the examiner in the present case issued an office action requiring the Applicant to respond issues:

1. SPECIMEN REFUSAL AND REQUEST FOR INFORMATION
2. IDENTIFICATION OF GOODS AND/OR SERVICES
3. MULTIPLE-CLASS APPLICATION REQUIREMENTS
4. REFUSAL UNDER SECTION 2(d)- LIKELIHOOD OF CONFUSION

Thereafter, Applicant attorney conducted a teleconference with the examiner on February 20, 2020 to discuss the basis for the various rejections and determine the potential for withdrawal of the rejections. Accordingly, Applicant now responds and requests amendment of the present application and withdrawal of the rejection.

1. SPECIMEN REFUSAL AND REQUEST FOR INFORMATION

Applicant responds to this rejection by submitting additional information in support of the original specimen submitted, included herein as Exhibits A and B, which Applicant can confirm were in use prior to the filing of the present application. During the teleconference with the examiner, the examiner confirmed that the additional information included herein was satisfactory. Accordingly, Applicant requests the rejection to Applicant’s specimen be withdrawn.

2. IDENTIFICATION OF GOODS AND/OR SERVICES

Applicant amends the description as previously filed:

International Class 007 Brushes being parts of or for use with ice scrapers; ice and snow brushes for use with removing ice and snow from vehicles to: **International Class 008 Brushes being parts of and for use with hand-operated ice scrapers; Hand-operated ice and snow brushes for use with removing ice and snow from vehicles** as suggested by the examiner. Accordingly, Applicant requests the rejection to Applicant’s identification of goods be withdrawn.

3. MULTIPLE-CLASS APPLICATION REQUIREMENTS

Applicant’s amendment of its description from class 007 to 008 as offered by the examiner makes this issue moot. Accordingly, Applicant requests the multiple class requirement be withdrawn.

4. SECTION 2(d) REFUSAL – LIKELIHOOD OF CONFUSION

In response to the rejection, Applicant includes illustrative examples of Applicant’s word & logo design (Exhibit C) and the use of same on a product and display (Exhibits A and B, also submitted herein as substitute specimens).

The examiner has rejected the application for registration of the applied-for mark (FROSTBITE & design) because of a likelihood of confusion with the marks #5290947, #5205482, #5074552 and #2057878 as listed in Table 1 (the cited Marks).

Reg. #	Mark	Owner	Class	Product Description	Additional information (provided by Applicant) Identification of Goods
5290947	“FROSTBITE”	Windy Ridge Corporation	007	Replacement parts for chain saws, namely, bars and chains; tractor-towed agricultural instrument grab attachments, namely, buckets, grapples, and forks; tractor-towed agricultural instruments, namely grapples	Machine good; Non-hand operated good; non-seasonal product
5205482	“FROSTBITE PERFORMANCE COOLING” (with design)	Holley Performance Products	007	Radiators and motors for engines	Machine good; Non-hand operated good; non-seasonal product
5074552	FROSTBITE PERFORMANCE COOLING”	Holley Performance Products	007	Radiators and motors for engines	Machine good; Non-hand operated good; non-seasonal product
2057878	“FROSTBITE”	Shelby Group International	009	Safety glass and impact resistance spectacles	Wearable product; non-seasonal product

Table 1: Comparative Listing of Cited Registrations

The examiner’s primary argument is that the applicant’s and registrant’s goods are related and could give rise to the mistaken belief that they emanate from the same source. Applicant believes it appropriate for the examiner to withdraw the rejection in view of the amended product description and addresses the examiner’s arguments as to the relatedness of the various products to applicant’s herein

The examiner has argued that the goods and/or services are to be compared to determine whether they are similar, commercially related, or travel in the same trade channels. *See Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1369-71, 101 USPQ2d 1713, 1722-23 (Fed. Cir. 2012); *Herbko Int’l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1165, 64 USPQ2d 1375, 1381 (Fed. Cir. 2002); TMEP §§1207.01, 1207.01(a)(vi). Further, the compared

goods and/or services need not be identical or even competitive to find a likelihood of confusion. *See On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 1086, 56 USPQ2d 1471, 1475 (Fed. Cir. 2000); *Recot, Inc. v. Becton*, 214 F.3d 1322, 1329, 54 USPQ2d 1894, 1898 (Fed. Cir. 2000); TMEP §1207.01(a)(i).

The examiner then goes on to state that:

[t]hey need only be “related in some manner and/or if the circumstances surrounding their marketing are such that they could give rise to the mistaken belief that [the goods and/or services] emanate from the same source.” (Citation omitted) Generally, the greater degree of similarity between the applied-for mark and the registered mark, as is the case here, the lesser the degree of similarity between the goods and/or services of the parties is required to support a finding of likelihood of confusion. In re C.H. Hanson Co., 116 USPQ2d 1351, 1353 (TTAB 2015) (citing *In re Opus One Inc.*, 60 USPQ2d 1812, 1815 (TTAB 2001)); *In re Thor Tech, Inc.*, 90 USPQ2d 1634, 1636 (TTAB 2009).

The examiner’s arguments, however, fail to fully appreciate the products covered by the cited registrations and Applicant’s product. The examiner’s argument that applicant’s and registrant’s goods have complementary uses are now incorrect. The examiner argues

that [s]pecifically, applicant’s and registrant’s goods are in the field of tools and equipment. The respective ice and snow brushes and scrapers, radiators, safety glasses, and grapples enhance the qualities of each other by allowing consumers to fix, repair, treat, and utilize automotive parts and accessories. As a result, the goods are often used together or otherwise purchased by consumers of tools and equipment for the same or related purposes. See the attached evidence showing that ice and snow brushes and scrapers, radiators, safety glasses, and grapples are provided through the same trade channels:

<https://shop.advanceautoparts.com>

<https://www.oreilyauto.com/>

Leading the examiner to conclude that:

“[A]pplicant’s and registrant’s goods are considered related for likelihood of confusion purposes. See, e.g., In re Davey Prods. Pty Ltd., 92 USPQ2d 1198, 1202-04 (TTAB 2009); *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266, 1268-69, 1271-72 (TTAB 2009). Upon encountering “FROSTBITE” used on applicant’s goods and “FROSTBITE” and/or “FROSTBITE PERFORMANCE COOLING” used on registrant’s goods, consumers are likely to be confused and mistakenly believe that the respective goods emanate from a common source. Because the marks are similar and the goods are related, there is a likelihood of confusion as to the source of applicant’s goods. Therefore, applicant’s mark is not entitled to registration under Section 2(d) of Trademark Act.

Applicant strongly disagrees with this position and believes this conclusion is either now moot, in view of the now amended identification (as previously discussed at 2) or, was reached in error. It is Applicant’s position that the examiner erred in the present case by applying only two of the relevant *du Pont* factors, and particularly: (1) the similarities between the compared marks and (2) the relatedness of the compared goods and/or services. *See In re i.am.symbolic, llc*, 866 F.3d at 1322, 123 USPQ2d at 1747 (quoting *Herbko Int’l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1164-65, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002)); *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 1103, 192 USPQ 24, 29 (C.C.P.A. 1976) (“The fundamental inquiry mandated by [Section] 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods [or services] and differences in the

marks.”); TMEP §1207.01. But see *In re Dixie Rests. Inc.*, 41 U.S.P.Q.2d 1531, 1534 (Fed. Cir. 1997) (“*Indeed, the second Du Pont factor expressly mandates consideration of the similarity or dissimilarity of the services ‘as described in an application or registration.’*”) (**Emphasis by Applicant**)

Firstly, as now amended, it is Applicant’s position that the examiner in the present case has failed to make a prima facie case finding a likelihood of confusion between Applicant’s mark and the various cited registrations. A review of the various links and screenshots referenced by the examiner **do not, and cannot**, provide support for the conclusion that the Windy Ridge registration (#5290947 listed in Table 1) for “Frostbite” for [r]eplacement parts for chain saws, namely, bars and chains; tractor-towed agricultural instrument grab attachments, namely, buckets, grapples, and forks; tractor-towed agricultural instruments, namely grapples, can be found in any of these channels:

<https://shop.advanceautoparts.com>

<https://www.oreilyauto.com/>

Further support for this argument is found by reviewing the Windy Ridge website. As shown at Exhibits 1 and 2 the product is very large (**359 lbs.**) and typically mounted to a loader tractor or skid-steer loader tractor. There is no evidence that the product may be mounted to truck or automobile. Applicant products, as shown at Exhibits A1, A2 and B are relatively small and usually weigh less than three to four ounces (**3-4 oz**) and sell for less than \$10.00 as shown at Exhibit D. It is therefore Applicant’s position that the Windy Ridge Frostbite Grapple is not sold through the channels as cited as evidenced by 1) the product not found in the various website searches and 2) Exhibit 2 soliciting “Dealers Wanted”. Finally, the examiner was mistaken in putting the Windy Ridge Frostbite Grapple into this statement:

[t]he respective ice and snow brushes and scrapers, radiators, safety glasses, and grapples enhance the qualities of each other by allowing consumers to fix, repair, treat, and utilize automotive parts and accessories.

as there is no evidence or support for categorizing the Windy Ridge Frostbite Grapple as an automotive part or accessory as it is to be mounted to a tractor loader or skid-steer loader, as supported by the trademark registration description and the evidence included herein.

A similar problem exists with the cited registrations for “Frostbite Performance Cooling” as a word (#5074552) and with a logo (#5205482) as found in Table 1. As shown in Exhibits 4 and 5, the logos are significantly different from Applicants (Exhibit C compared to Exhibit 4) and although clearly an automotive product, it is meant to be connected to and used with an automotive engine. Further, the radiator offered for sale by the registrant Holley is also a large product and a significant investment as demonstrated by retail price of **\$321.95** in comparison to Applicant’s as evidenced by Exhibit D.

Secondly, a detailed review of assembled Table 1 provides significant support for this argument and provides **significant evidence as to the dissimilarity of** the products of the cited registrations. The Dupont factors allow applicant to submit any other established fact probative of the effect of the use. *In re Martin's Famous Pastry Shoppe, Inc.*, 223 U.S.P.Q. 1289, 1289 (Fed. Cir. 1984) (“Likelihood of confusion under section 2(d) is determined from the probative facts in evidence.”). Applicant would note that none of the cited registrations are for hand-operated products as will be discussed herein. Applicant’s amended description of the goods is only the one in class 008 and includes a reference to “hand-operated”.

Thirdly, Applicant’s snow brushes are for **removing ice and snow from vehicles. Accordingly, they are typically sold in late fall and through-out the winter. Applicant’s products are therefore seasonal, unlike all the other products for the various cited registrations which are not seasonal and do not have a seasonal component.**

Under the Dupont factors, the conditions under which, and buyers to whom, sales are made, that is, “impulse” vs. careful, sophisticated purchasing, is to be considered. There is no evidence that any of the cited registrations would

be categorized as “seasonal” providing significant evidence as to the differences between Applicant’s identified products and the cited registrations.

Finally, likelihood of confusion exists when consumers viewing the mark probably would assume that the product the mark represents is associated with the source of a different product identified by a similar mark. *Ford Motor Co. v. Summit Motor Prods., Inc.*, 930 F.2d 277, 292 (3d Cir.) (quoting *Scott Paper Co. v. Scott's Liquid Gold, Inc.*, 589 F.2d 1225, 1229 (3d Cir. 1978)), cert. denied, 112 S. Ct. 373 (1991). **Likelihood of confusion should be determined by viewing the two marks from the perspective of an ordinary consumer of the goods.** See *Ford Motor Co. v. Summit Motor Prods., Inc.*, 930 F.2d 277, 293 (3d Cir. 1991) (quoting *Dominion Bankshares Corp. v. Devon Holding Co.*, 690 F. Supp. 338, 345 (E.D. Pa. 1988)); see 2 J. Thomas McCarthy, *Trademarks and Unfair Competition* § 23.27-29 (1992) (**Emphasis by Applicant**). In this case, the examiner should conclude that the ordinary consumer of the relevant products exercises care and attention in their purchases and are unlikely to confuse safety glasses to be worn by a user, a grapple hook for use with a tractor or skid-steer load, and an automotive radiator for attachment to an automotive when purchasing a snow brush/ice scraper for clearing snow and ice from the exterior surfaces of an automobile during winter snow and ice season, or preparing for same. It is therefore Applicant’s position that the seasonality of Applicant’s products, and the lack thereof for the cited registrations should be considered as well. Applicant submits a screenshot from Advanced Auto Parts evidencing that de-icers and scrapers are categorized as seasonal. See Exhibit 6.

5. CONCLUSION

Applicant has addressed all of the issues raised by the examiner in this office action. Applicant has amended their description and requests the application be amended to class 008. An ordinary consumer of the subject products is able to distinguish between the distinct products of the cited registrations. An ordinary consumer seeking to purchase ice and snow brushes is unlikely to be confused by similar marks on the cited products which include safety glasses to be worn by a user, radiators for attachment to and use with car engines, and tractor mounted grapples, as demonstrated by the probative evidence submitted by Applicant herein. Applicant does not believe there is a likelihood of confusion present with the cited registrations because of the significant differences and the lack of relatedness of the compared goods. Applicant requests all rejections to the application now be withdrawn and it be allowed to publish prior to issuance of a certificate of registration.

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