

This is in response to the Office Action issued on March 28, 2020 related to Application No. 88/750916 in the name of Pylon Manufacturing Corp. for the mark X-FLEX, for amended goods as follows: “Windshield wiper blade technology system comprised of primary, secondary and tertiary flexors sold as an integral component of windshield wiper blades for vehicles; windshield wiper blade system comprised of primary, secondary and tertiary flexors to control movement, contact and connection for the wiper blade sold as an integral component of windshield wiper blades for vehicles,” in Class 12 (“Applicant’s Mark”). The Examining Attorney has issued a Section 2(d) Likelihood of Confusion related to the following mark (the “Cited Mark”):

- Reg. No. 2688807 for the mark X-FLEX owned by Tramec Sloan, L.L.C. for “vehicle fender mounting kits composed primarily of isolators, mounting hardware and mounting brackets,” in Class 12.

For the following reasons, Applicant respectfully disagrees that there is a likelihood of confusion between Applicant’s Mark and the Cited Mark, and requests that the refusal be withdrawn.

### **I. THERE IS NO LIKELIHOOD OF CONFUSION BETWEEN APPLICANT’S MARK AND THE CITED MARK**

A likelihood of confusion determination under Section 2(d) is based on an analysis of all the probative facts in evidence that are relevant to the thirteen factors set forth in *In re E.I. Du Pont DeNemours & Co.*, 476 F.2d 1357, 1361, 177 U.S.P.Q.563, 567 (C.C.P.A. 1973). Trademark Act Section 2(d) requires that confusion, mistake, or deception be “likely, not merely possible.” *Sears, Roebuck & Co. v. All States Life Ins. Co.*, 246 F.2d 161 (5th Cir. 1957), *cert. denied*, 355 U.S. 894 (1957). Whether confusion, mistake, or deception are likely is determined by the standard set forth in *In re E.I. Du Pont DeNemours & Co.*, 476 F.2d 1357, 177 U.S.P.Q.563 (C.C.P.A. 1973).

The following analysis of the most relevant *DuPont* factors establishes why there is no likelihood of confusion, mistake, or deception between Applicant’s Mark and the Cited Mark.

#### **I. Automotive Products Are Not Per Se Related**

The TTAB has recognized that automotive products are not *per se* related. “It must be noted at the outset that there is no *per se* rule governing likelihood of confusion cases involving all types of automotive products.” *In re A-Fab, LLC*, Serial No. 77639815 (TTAB July 11, 2011). Instead, in all cases, including those related to automotive goods and services, “the likelihood of confusion analysis is governed by the record before the Board.” *Id.* In *In re A-Fab, LLC*, the Board reversed the Examining Attorney’s finding of confusion between the marks DYNATECH for “engine exhaust system components, namely, pipes, collectors and mufflers ordered through specialty racing product ordering services” and DYNATEK for “ignition systems for motor vehicles comprising, ignition coils and fuel injection controllers for motor vehicles; [and] crank sensor ignition triggers for motor vehicles,” noting the underlying differences between the goods.

For exactly the same reasons, it is improper for the Examining Attorney in the present case to presume without sufficient factual evidence that the goods at issue would be viewed as emanating from the same source simply because they are automotive goods.

## 2. The Goods Are Not Similar and Marketed to Different Markets.

Applicant's Goods are different from the goods offered under the Cited Mark, and the mere fact that Applicant's Mark and the Cited Mark fall under the same classification is not sufficient to support a likelihood of confusion.

Specifically, Applicant's Goods are windshield wiper blades marketed and sold in the automotive aftermarket. *See attached Exhibit A*. Applicant has been developing and engineering innovative designs in the wiper blade market for over fifty years. *Id.* The owner of the Cited Mark, Tramec Sloan, on the other hand, is a supplier to the heavy-duty commercial market. *See attached Exhibit B*. The goods are not sold to the same consumers and given the differences in the target markets presumably are not sold through the same trade channels.

Applicant's goods, namely, windshield wipers, are inexpensive automotive accessories. They are small and lightweight, and consumers can hold them using their fingertips. Most consumers purchase and install windshield wiper blades themselves, and they are available at multiple locations, including general retail stores. Replacing windshield wiper blades is a relatively easy endeavor, and one can consult their owner's manual to determine proper size and fit. The goods sold under the Cited Mark are for heavy duty commercial vehicles. They are not purchased by do-it-yourself consumers, but rather are likely installed by authorized installers.

As discussed further below, there are a number of marks comprised of FLEX for vehicle related goods in Class 12. This supports the argument that windshield wipers and other automotive products are not automatically considered "related." "When it comes to likelihood of confusion, trademark practitioners and jurists know that there are no *per se* rules as to the relatedness of goods." *In re Hyundai Motor America*, Serial No. 78/889,340, TTAB 2009 (not precedential).

Further, if the goods in question are not related or marketed in such a way that they would be encountered by the same persons in situations that would create the incorrect assumption that they originate from the same source, then, even if the marks are identical, confusion is not likely. *See, e.g., Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1371, 101 USPQ2d 1713, 1723 (Fed. Cir. 2012); *Shen Mfg. Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 1244-45, 73 USPQ2d 1350, 1356 (Fed. Cir. 2004) (reversing TTAB's holding that contemporaneous use of RITZ for cooking and wine selection classes and RITZ for kitchen textiles is likely to cause confusion, because the relatedness of the respective goods and services was not supported by substantial evidence).

The differences in the specific nature of the parties' respective goods are an important factor in the likelihood of confusion analysis, and must be given due consideration. In *Interstate Brands Corp. v. Celestial Seasonings, Inc.*, 198 U.S.P.Q. 151 (C.C.P.A. 1978), the Court held that RED ZINGER for herbal tea was not confusingly similar to ZINGERS for snack cakes, because an analysis of the actual relationship of the goods/services based on their individual characteristics is always required, and **it is not proper to lump different goods/services into a broad category** (such as vehicle fender mounting kits and windshield wiper blades) and then hold the different goods/services to be "related" automatically as a result. Accordingly, in *Astra Pharmaceutical Products Inc. v. Beckman Instruments, Inc.*, 220 U.S.P.Q. 786, 790 (1st Cir. 1983), the court affirmed a grant of summary judgment and found that the marks ASTRA, for the plaintiff's

pharmaceuticals and syringes and ASTRA for the defendant's computerized blood analyzer machines, were not likely to be confused. In so doing, the court stated:

The most favorable inference that may be drawn from the evidence regarding the similarity of goods is that both parties' products are used in the medical or health care field. However, such a **broad inference is not sufficient** to demonstrate that a genuine issue exists concerning likelihood of confusion as to the source of the products identified in the present suit.

Given the fundamental differences in the goods covered by the marks, consumers are able to distinguish between Applicant's Mark and the Cited Mark.

### **3. Strength Of The Mark/The Number And Nature Of Similar Marks For Similar Goods**

Even if the Examiner could establish that vehicle fender mounting kits for the heavy duty market and windshield wipers for the automotive aftermarket are "related," this must be considered in the context of the strength of the Cited Mark. Where a trademark is weak, the goods may have to be more closely related to create a likelihood of confusion. *In re Shell Oil Co.*, 992 F.2d 1204, 1207, 26 USPQ2d 1687, 1689 (Fed. Cir. 1993) ("The degree of 'relatedness' must be viewed in the context of all the factors, in determining whether the services are sufficiently related that a reasonable consumer would be confused as to source or sponsorship.").

In this case, the Cited Mark is weak and should be afforded a sufficiently narrow scope of protection such that Applicant's Mark can coexist. A *large* number of other marks comprised of or featuring the word FLEX coexist in the vehicle space. This is likely because the word "flex" means "to bend". *See attached Exhibit C*. In the context of a fender, the word is used to connote the idea that the fender will bend and absorb the force of a collision. With respect to windshield wipers, the word "flex" suggests that the wiper will hug the contour of the window and provide a more thorough wiping of the window. The word "flex" is commonly used in connection with a variety of goods and services because of it suggests a certain characteristic of the goods.

The Court of Appeals for the Federal Circuit and the Trademark Trial and Appeal Board have recognized that merely descriptive and weak designations may be entitled to a narrower scope of protection than an entirely arbitrary or coined word. *See Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée 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).

When determining the strength of a particular mark, one looks at the extent of use of the components of the mark. "Determining that a mark is weak means that consumer confusion has been found unlikely because the mark's components are so widely used that the public can easily distinguish slight differences in the marks, even if the goods are related." *General Mills, Inc. v. Kellogg Co.*, 824 F.2d 622, 3 U.S.P.Q.2d 1442 (8<sup>th</sup> Cir. 1987). If a word mark is relatively weak, a significantly different display of the same word can avoid a likelihood of confusion. *First Sav. Bank, F.S.B. v. First Bank System, Inc.*, 101 F.3d 645, 40 U.S.P.Q.2d 1865 (10<sup>th</sup> Cir. 1996). When

determining the strength of a particular mark, one looks at how widely used are the components of the mark.

The Cited Mark should be afforded a sufficiently narrow scope of protection that Applicant's Mark can coexist, because other marks comprised of or featuring the word FLEX and variations thereof coexist in the automotive field. TMEP § 1207.01(d)(iii) states in part:

If the evidence establishes that the consuming public is exposed to third-party use of similar marks on similar goods, this evidence "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, 1373, 73 USPQ2d 1689, 1693 (Fed. Cir. 2005).

In addition, TMEP § 1207.01(d)(iii) states in part:

. . . Third-party registrations may be relevant to show that the mark or a portion of the mark is descriptive, suggestive, or so commonly used that the public will look to other elements to distinguish the source of the goods or services. See, e.g., *AMF Inc. v. American Leisure Products, Inc.*, 474 F.2d 1403, 1406, 177 USPQ 268, 269-70 (C.C.P.A. 1973); *Plus Products v. Star-Kist Foods, Inc.*, 220 USPQ 541, 544 (TTAB 1983) ...

In particular, as shown in Table 1 below, other third parties have registered FLEX-formative marks for automotive-related goods and services. If these marks can co-exist with the Cited Mark, this means the Cited Mark is not entitled to a broad scope of protection in the automotive space.

Table 1 (Exhibit C): Examples Of FLEX-Formative Marks Used With Automotive-Related Goods:

<b>Mark/Name</b>	<b>Registration No.</b>	<b>Status</b>	<b>Full Goods/Services</b>	<b>Owner Information</b>
EZ FLEX	4277153	Registered 8 & 15, February 19, 2019	(Int'l Class: 12) motor vehicle seating and parts and accessories therefor, all sold as an integral part of a motor vehicle	Nissan North America, Inc. (California Corp.) P.O. Box 685001 Franklin Tennessee 370685001
E-Z FLEX	3709942	Renewed, November 10, 2019	(Int'l Class: 12) rubber equalizer suspension systems for trailers	Dexter Axle Company (Delaware Corp.) 2900 Industrial Parkway Elkhart Indiana 46516
FLEX	4010108	Registered 8 & 15, September 6, 2017	(Int'l Class: 12) trailers, namely, cargo and utility trailers	Trailer Brands, Inc. (Delaware Corp.) 436 N. Silver Street Lexington North Carolina 27292
FLEX	3500311	Renewed, September 9, 2018	(Int'l Class: 12) automobiles	Ford Motor Company (Delaware Corp.) One American Road Dearborn Michigan 48126
J-FLEX		Pending - Non- Final Action Mailed, March 12, 2020	(Int'l Class: 12) Suspension components for vehicles, namely, adjustable control arms	Fox Factory, Inc. (California Corp.) 6634 Highway 53 Braselton Georgia 30517
K-FLEX (Stylized)  <i>K-Flex</i>	4486850	Registered, February 25, 2014	(Int'l Class: 12) suspension springs for automobiles; vehicle suspension springs; shock absorbing springs for vehicles; suspension shock absorbers for vehicles	Kyb Corporation (No Country Provided) World Trade Center Bldg., 4-1, Hamamatsu-Cho 2- Chome, Minato-Ku Japan

O-FLEX	2285948	Renewed, October 12, 2009	(Int'l Class: 12) structural support system and energy-absorption system, namely, tube-shaped metal surrounded by a covering which is placed between metal panels for internal structural support, specifically for use in automobiles	Ohtsuka Co., LTD. (Japan Corp.) 1531 Sarah Court Murfreesboro Tennessee 37129
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TESS records of the aforementioned applications and registrations are attached as *Exhibit D*.

Based on these co-existing marks alone, it would appear that the Cited Mark is sufficiently weak that there is room on the register for Applicant's Mark.

The ultimate test of relative strength is the distinctiveness of a mark in the mind and perception of the relevant customer group. But a mark that is hemmed in on all sides by similar marks on similar goods **cannot be very "distinctive."** It is merely one of a crowd of marks. In such a crowd, customers will not likely be confused between any two of the crowd and may have learned to carefully pick out one from the other. *McCarthy on Trademarks and Unfair Competition*, 4<sup>th</sup> ed. §11:85.

Clearly, with the other marks that are comprised of or feature the term FLEX that coexist in the same field as the Cited Mark on the register, Applicant's Mark should be able to coexist, as well.

### Conclusion

Under the Lanham Act, a refusal to register based on an allegation of likelihood of confusion requires that such confusion as to the source of the goods/services must not be merely possible, but likely. A mere possibility of confusion is an insufficient basis for refusal under Section 2(d). See *In re Massey-Ferguson, Inc.*, 222 U.S.P.Q. 367, 368 (TTAB 1983). In the case at hand, there is no evidence to support a finding that confusion is likely. Further, the TTAB specifically stated in *In re Massey-Ferguson*: "We are not concerned with mere theoretical possibilities of confusion, deception or mistake or with de minimis situations but with practicalities of the commercial world, with which trademark deals." *Id.* at 368, quoting *Witco Chemical Co. v. Whitfield Chemical Co., Inc.*, 164 U.S.P.Q. 43, 44 (C.C.P.A. 1969).

In the current case, the differences in the goods, as well as the target markets suggests that Applicant's Mark is readily distinguishable and not similar to the Cited Mark. Furthermore, the Cited Mark is weak and warrants only narrow protection. In total, the *DuPont* factors weigh against a finding of likelihood of confusion between Applicant's Mark and the Cited Mark. Therefore, the Section 2(d) Likelihood of Confusion Refusal related to the Cited Mark should be withdrawn, and the mark should be allowed to proceed to publication.