

REMARKS

In a June 17, 2020 Office Action, the Examining Attorney has initially refused registration of Application Serial Number 88/866,361 under Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d), on the grounds that Applicant's mark ENFORCER is likely to cause confusion with the previously registered ENFORCER (U.S. Reg. No. 3,909,652) for "Electronic components, namely,... timers, programmable timers..." and "times switches, namely, electronic timers" (the "Cited Mark"). The Examining Attorney has deemed Applicant's mark and the Cited Mark confusingly similar based on an alleged similarity between the marks and the alleged relatedness between the goods and services. Applicant respectfully submits that consumer confusion is unlikely because the goods at issue are not, in fact, related and that, as a result, they travel through different channels of trade and are goods sold to discerning consumers after careful consideration.

"Likelihood of confusion must be analyzed on a case-by-case basis, considering all evidence actually relevant to that inquiry." *Juice Generation, Inc. v. GS Enterprises LLC*, 794 F.3d 1334, 1338 (Fed. Cir. 2015) (citing *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 U.S.P.Q. 563, 567 (C.C.P.A. 1973)). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) ("The fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks").

Similarity of the Marks

The marks at issue share the component ENFORCER. "However, the identity of the marks alone is not sufficient to establish likelihood of confusion in the absence of probative evidence that the goods are related." *In re Thor Tech, Inc.*, 113 USPQ2d 1546, 2015 WL 496133, at *1 (TTAB 2015). "If that were the case, then the Registrant would have rights in gross, and that is against the

principles of trademark law.” *Id.* “In every case turning on likelihood of confusion, it is the duty of the examiner, the board and this court to find, upon consideration of all the evidence, whether or not confusion appears likely.” *Electronic Design & Sales Inc. v. Electronic Data Systems Corp.*, 954 F.2d 713, 21 USPQ2d 1388, 1392 (Fed. Cir. 1992) (quoting *In re E. I. du Pont de Nemours & Co.*, 177 USPQ at 568). Despite the alleged identity of the marks, the remaining relevant *DuPont* factors negate any risk of consumer confusion.

Dissimilarity of the Goods and Their Lack of Relatedness

In determining the similarity of the goods, the issue is not whether the goods and/or services will be confused with each other, but rather whether the public will be confused as to their source. *See Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 1329, 54 USPQ2d 1894, 1898 (Fed. Cir. 2000).

It is sufficient that the goods and/or services of the applicant and the registrant are related in some manner or that the conditions surrounding their marketing are such that they are likely to be encountered by the same persons under circumstances that, because of the marks used in connection therewith, would lead to the mistaken belief that they originate from the same source. *See, e.g., On-line Careline Inc. v. America Online Inc.*, 229 F.3d 1080, 56 USPQ2d 1471 (Fed. Cir. 2000) (holding ON-LINE TODAY for Internet connection services and ONLINE TODAY for an electronic publication likely to cause confusion).

Conversely, if the goods or services in questions are not related or marketed in such a way that they would be encountered by the same person 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) (affirming the Board’s dismissal of opposer’s likelihood-of-confusion claim, noting “there is nothing in the record to suggest that a purchaser of

test preparation materials who also purchases a luxury handbag would consider the goods to emanate from the same source” though both were offered under the COACH mark); *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); *In re Thor Tech, Inc.*, 113 USPQ2d 1546, 1551 (TTAB 2015) (finding use of identical marks for towable trailers and trucks not likely to cause confusion given the difference in the nature of the goods and their channels of trade and the high degree of consumer care likely to be exercised by the relevant consumers); *Local Trademarks, Inc. v. Handy Boys Inc.*, 16 USPQ2d 1156, 1158 (TTAB 1990) (finding liquid drain opener and advertising services in the plumbing field to be such different goods and services that confusion as to their source is unlikely even if they are offered under the same marks); *Quartz Radiation Corp. v. Comm/Scope Co.*, 1 USPQ2d 1668, 1669 (TTAB 1986) (holding QR for coaxial cable and QR for various apparatus used in connection with photocopying, drafting, and blueprint machines 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).

Here, the Examining Attorney argues that Applicant’s and Registrant’s goods travel in the same channels of trade and are thus related. In support of this argument, the Examining Attorney proffers six websites for companies purporting to sell watches and timers and seven registrations covering watches and timers. However, the timers sold by Registrant are do not function in the same way and do not serve the same purpose as any of the third-party products cited by the Examining Attorney. And while Applicant recognizes that extrinsic evidence concerning a

registrant's goods is generally not considered at this stage, but when the goods descriptions are so broad as to potentially be vague, such extrinsic evidence may be helpful to determine how consumers would perceive such goods. *See In re Trackmobile Inc.*, 15 USPQ2d 1152, 1154 (TTAB 1990) (“when the description of goods for a cited registration is somewhat unclear . . . it is improper to simply consider that description in a vacuum and attach all possible interpretations to it when the applicant has presented extrinsic evidence showing that the description of goods has a specific meaning to members of the trade.”).

The products sold by Registrant are security devices, namely programmable timer modules, “designed for delayed egress or controlling other devices.” *See* Exhibit A. For instance, one of Registrant's timers, the SA-027HQ 365-Day Annual Timer “can be programmed to operate two relays 24 hours a day, over the course of an entire year. These relays can be used to control devices in many applications such as security, access control, lighting, and environmental control.” *See* Exhibit B. These timers are designed to operate in tandem with other devices, letting the user program them to operate at specific times. While Registrant's devices do operate on a timed basis, they do not function as timekeepers. In fact, most of devices listed under “Timers” on Registrant's website lack even a display to show or measure time. *See* Exhibit C. In contrast, all of the products cited by the Examining Attorney consist of either timepieces or timers. Timepieces or watches reflect the time of day while timers measure the time that has passed between one press of the button and another. Not only are these security timers covered by the Cited Mark completely removed from Applicant's timepieces and thus are not likely to cause confusion, but they are also completely different than the timers cited by the Examining Attorney for the proposition that timers and watches travel in the same channels of trade. *See Quartz Radiation Corp. v. Comm/Scope Co.*, 1 USPQ2d 1668 at *2. As a result, there is no evidence in the record that the

goods covered by the Cited Mark are related to Applicant's goods, and the rejection should be withdrawn for this reason alone.

Further, when purchasing security devices for a business, home, or automobile, such as the products sold by Registrant, a consumer would expend a high-than-average level of care—carefully choosing a device that will best suit their needs and secure their most prized assets. *See Primrose Ret. Cmtys.*, 122 USPQ2d at 1039 (finding that, “even in the case of the least sophisticated purchaser, a decision as important as choosing a senior living community will be made with some thought and research, even when made hastily”). Such a level of care weighs against a likelihood of confusion. The rejection should be withdrawn for this additional reason.

Next, even if Registrant were selling timers of the same type as those shown in the evidence cited by the Examining Attorney, the evidence still does not support the proposition that watches and timers are related goods. The Examining Attorney proffers six websites for companies purporting to sell watches and timers and seven registrations covering watches and timers as evidence that timepieces and timers travel in the same channels of trade and are thus related. Applicant respectfully disagrees. First, the amazon.com website does not offer for sale timepieces and instead only shows one example of a digital timer that may be worn around the wrist. *See Exhibit D.* Similarly, though POTTY TIME (U.S. Reg. No. 3,579,077) is registered for “Timers...Clocks, and watches,” the recently submitted specimens for both its Class 9 goods (timers) and Class 14 goods (clocks and watches) accompanying its Application for Renewal under Sections 8 & 9 are identical and consist not of a timepiece or watch but instead of digital timers to be worn on the wrist. *See Exhibit E.* In fact, the same timer to be worn on the wrist was submitted as the specimen for both the Class 9 and 14 goods in connection with the Section 8 & 15 renewal papers and the original application. *Id.* The POTTY TIME product does keep time as a watch does

and instead operates a timer worn on the wrist. Given the small font on the product packaging shown in the specimen, Applicant is attaching the product webpage for ease of reference. *See* Exhibit F. These pages is therefore not probative. *See In re Thor Tech*, 113 USPQ2d at 1551. Next, any watches and timers shown in the remaining websites are separate and distinct from the “timed switches, namely, electronic timers” in the Cited Registration. According to Registrant’s website, Registrant is a “leading supplier of both automotive and commercial/residential security products.” *See* Exhibit G. A review of Registrant’s website shows that these security products include “programmable timers for delayed egress or controlling other devices.” *See* Exhibit A. Such is not the case for the remaining websites and registrations cited by the Examining Attorney, which include personal digital timers (such as stopwatches or kitchen timers) or include timers only as a feature of the watches sold, not separate products. Further, the CASIO registration (U.S. Reg. No. 3,614,858) cited by the Examining Attorney covers broad range of electronic goods, including calculators, printers, musical instruments, and batteries. This registration is not probative of the likelihood of confusion in this case, as it merely demonstrates Casio’s pervasive presence in the electronic device category. *See In Re Donnay Int’l, Societe Anonyme*, 31 U.S.P.Q.2d 1953 (T.T.A.B. 1994) (finding soccer balls and sports rackets to be unrelated where the Examining Attorney’s evidence of third-party registrations consisted of house marks used to identify a broad range of products).

Moreover, the timers sold on the websites cited by the Examining Attorney are low-cost products with prices ranging from \$7.00 to \$35.00. The programmable timers sold by Registrant are also relatively inexpensive. *See, e.g.*, Exhibit H (third party sellers; accessed 11/16/2020). Applicant’s goods are contrastingly expensive. For instance, Applicant’s watches can sell for \$2,000 or more. *See* Exhibit I. Likewise, the watches sold on the websites cited by the Examining

Attorney have prices starting at \$100 ranging all the way to \$723.00. Given the price of these goods, they are typically selected by consumers who have carefully investigated the product. Circumstances suggesting care in purchasing minimize the likelihood of confusion. *See, e.g., In re N.A.D., Inc.*, 754 F.2d 996, 999-1000, 224 USPQ 969, 971 (Fed. Cir. 1985); *Primrose Ret. Cmty., LLC v. Edward Rose Senior Living, LLC*, 122 USPQ2d 1030, 1039 (TTAB 2016); *In re Homeland Vinyl Prods., Inc.*, 81 USPQ2d 1378, 1380, 1383 (TTAB 2006).

Given the above, the goods at issue are not everyday purchases. They are special, considered purchases. A consumer can be expected to pay particular attention to such purchases, and indeed would likely make a careful, personal examination of the item before purchasing. These types of products are not the kinds of products that reasonably prudent purchasers would buy without researching the product to some degree. Rather, these items will be purchased with care and deliberation. *See Tiffany & Co. v. Classic Motor Carriages Inc.*, 10 USPQ2d 1835, 1841 (TTAB 1989) (automobiles would be purchased only upon careful consideration). In making purchasing decisions regarding expensive products such as these, “the reasonably prudent person standard is elevated to the standard of the ‘discriminating purchaser.’” *Weiss Associates, Inc. v. HRL Associates, Inc.*, 902 F.2d 1546, 14 USPQ2d 1840, 1841 (Fed. Cir. 1990). This weighs against the risk of consumer confusion.

In sum, Applicant’s Mark and the Cited Mark are used on unrelated, carefully purchased goods that travel in different channels of trade and that are only purchased after careful consideration. The goods therefore are not sufficiently related to create a likelihood of confusion. Through the remarks submitted with this response, Applicant has fully complied with the Office’s request and has presented evidence to overcome the Office’s refusal to register the ENFORCER mark.

Applicant therefore respectfully requests that the Office withdraw the § 2(d) grounds for refusal and allow the application to proceed to publication.