

RESPONSE TO OFFICE ACTION

An Office Action was issued by the United States Patent and Trademark Office on October 29, 2020, for U.S. Trademark Registration No. 90164898 for the mark “FENIX”, filed September 8, 2020.

In the Office Action, the Examining Attorney indicated that a search of the USPTO database of registered and pending marks did not reveal any conflicting marks that would bar registration of the applied-for-mark under Trademark Act Section 2(d). However, the Examining Attorney refused the applied-for mark under Trademark Act Section 2(d), alleging that prior-filed pending applications may present a bar to registration for the applied-for mark because of a likelihood of confusion between the marks. In addition, the Examining Attorney made a requirement under 37 CFR §2.72 for Applicant to submit a new drawing of the mark. Finally, the Examining Attorney made a requirement under 37 CFR §§ 2.2(o)-(p), 2.11(a), 2.189 for Applicant to provide their domicile address. Based on the arguments and remarks below, Applicant respectfully submits that the Examining Attorney’s refusal has been overcome and requirement met. Thus, Applicant respectfully requests the approval and publication of Applicant’s applied-for mark.

REFUSAL – PRIOR-FILED APPLICATIONS

In the Office Action, the Examining Attorney refused registration of the applied-for mark under Trademark Act Section 2(d) because prior-filed pending App. Ser. Nos. 79293297 (“the ‘297 mark”), 87932449 (“the ‘449 mark”), and 90089946 (“the ‘946 mark”) allegedly present a potential likelihood of confusion between the marks. On November 20, 2020, the attorney for the

owner/holder of the '449 mark filed a Petition to Revive Abandoned Application in which the application was amended to remove Class 007. Thus, Applicant respectfully submits the Examining Attorney's refusal based on the prior-filed application for the '449 mark is now moot. Furthermore, it is respectfully submitted that the Examining Attorney has failed to establish a case of likelihood of confusion between Applicant's applied-for-mark and the '297 and '946 marks.

Likelihood of confusion is analyzed under the relevant factors set out in *In re E.I. Du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See TMEP 1207.01. In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and services. *Id.*; *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

Similarity of the Marks

Determining similarity of the marks requires examination of "the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression." *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361 (C.C.P.A. 1973). Moreover, "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 Nat'l Data Corp.*, 753 F.2d 1056, 1058 (Fed. Cir. 1985). When comparing the marks, "[a]ll relevant facts pertaining to appearance, sound, and connotation must be considered before similarity as to one or more of those factors may be sufficient to support a finding that the marks are similar or dissimilar." *Recot, Inc. v. M.C. Becton*, 214 F.3d 1322, 1329 (Fed. Cir. 2000).

Applicant respectfully submits that the Examining Attorney has failed to make any observation regarding the similarity between Applicant's applied-for mark and the '297 and '946 marks or the respective goods.

The '297 Mark

In regards to the appearance of the '297 mark, Applicant respectfully submits that the differences between Applicant's applied-for mark and the '297 mark negate any likelihood of confusion. Applicant's applied-for mark is a drawing or logo including the word "FENIX". The '297 mark cited by the Examining Attorney was applied for as a compound word and design mark for "PHENIX AGROSYSTEM". Even if, in arguendo, "PHENIX" were to be considered the dominant portion of the '297 mark, the difference in spelling as compared to Applicant's applied-for mark is stark. In particular, the "PH" of "PHENIX" of the '297 mark is different from the "F" of Applicant's applied for mark. More particularly, "PHENIX" is an alternative spelling of the mythological bird (phoenix) and connotes such. However, Applicant's applied-for mark, "FENIX", is better described as a portmanteau that is at the very least suggestive of non-use (NIX) on ferrous (iron-containing; Fe or FE) materials.

Moreover, even if, in arguendo, "PHENIX" were to be considered the dominant portion of the '297 mark, the differences in the stylized or design aspects of the "PHENIX" portion also negates any likelihood of confusion. In particular, the "PHENIX" portion of the '297 mark has each letter in the same size, font, and color over the same light-colored or white background. In contrast, Applicant's applied-for "FENIX" mark is in a wholly different font. The applied-for "FENIX" mark also features a small-sized "E" with larger "F", "N", "I", and "X". In addition, the applied-for mark features a dark-colored "F" and "E" while the letters "N", "I", and "X" have a two-tone color scheme, wherein a portion of the letters "N", "I", and "X" are light-colored and sit atop a dark rectangular field while another portion of those letters extend outside of the rectangular field and are dark-colored.

Furthermore, when considered as a whole, the “AGROSYSTEM” portion of the ‘297 mark has a connotation that is vastly different as it lends itself to be thought of as related to farming. In particular, the prefix “agro” is from Latin “agra” pertaining to land and is the root for “agricola”, or farmer. The “agro-”, or “agra-”, prefix has long been associated with agrarian or farming activities and is no different here. Furthermore, this connotation is further reinforced when the ‘297 mark is considered in light of the respective goods. The ‘297 mark was applied for seeking registration for Class 007 goods listed as

Towed, coupled, semi-mounted, hitched or self-supporting machines, machine tools and mechanical tools for agriculture and viticulture, namely, for the preparation, maintenance and preservation of arable land, including in particular hoeing machines, rotary hoes, field mowers, curry harrows, wine-growing mowers; agricultural instruments other than hand-operated hand tools.

(Emphasis added). Thus the ‘297 mark, in its entirety, clearly gives a commercial impression of association with farming.

In contrast, Applicant’s applied-for mark, “FENIX” lists “band saw blades” in Class 007. When Applicant’s applied-for mark is considered in light of the goods, the applied-for mark clearly has an association or connotation of band saw blades for use on non-ferrous materials.

Therefore, Applicant respectfully submits that Applicant’s applied-for mark and the ‘297 mark are not similar.

The ‘946 Mark

In regards to the appearance of the ‘946 mark, Applicant respectfully submits that the differences between Applicant’s applied-for mark and the ‘946 mark also negate any likelihood of confusion. As discussed above, Applicant’s applied-for mark is a drawing or logo including the

word “FENIX”. In contrast, the ‘946 mark cited by the Examining Attorney was applied for as a standard character mark for “FEENIX PRO PRODUCTS”. Even if, in arguendo, “FEENIX” were to be considered the dominant portion of the ‘946 mark, the difference in spelling as compared to Applicant’s applied-for mark is stark. In particular, the “FEE” of “FEENIX” of the ‘946 mark is different from the “FE” of Applicant’s applied for mark, “FENIX”. More particularly, “FEENIX” has been used by various organizations to connote reduced monetary requirements or frugality. However, as discussed above, Applicant’s applied-for mark, “FENIX”, is better described as a portmanteau connoting non-use on ferrous materials.

Moreover, when considered as a whole, “FEENIX PRO PRODUCTS” of the ‘946 mark has a vastly different character than Applicant’s applied-for mark, “FENIX”.

Therefore, Applicant respectfully submits that Applicant’s applied-for mark and the ‘946 mark are not similar.

Relatedness of the Goods

As to the similarity and nature of the goods, Applicant respectfully submits that the description of the goods in the applied-for mark and the goods listed for the ‘297 and ‘946 marks are sufficiently unrelated as to negate a likelihood of consumer confusion.

The ‘297 Mark

As discussed above, Applicant’s goods include “band saw blades”. In contrast, the ‘297 mark lists goods in connection with the mark including “machine tools and mechanical tools for agriculture and viticulture, namely, for the preparation, maintenance and preservation of arable land”. It is respectfully submitted that none of the goods listed in the ‘297 application are remotely similar to those listed in Applicant’s application for the applied-for mark. In particular, band saw

blades, as listed in the application for Applicant's applied-for mark, are a distinct type of saw blade made for use in band saws. *See* Exhibit A. More particularly, as noted in Exhibit A, band saws, and thus the blades therefor, are used primarily in residential and light industry (such as construction), metal cutting and fabrication, and timber cutting. *See Id.* Thus, neither band saw blades nor band saws include or are likely to be sold or marketed as towed, coupled, semi-mounted, hitched or self-supporting machines, machine tools or mechanical tools for agriculture and viticulture, or machine tools for preparation, maintenance and preservation of arable land, including in particular hoeing machines, rotary hoes, field mowers, curry harrows, wine-growing mowers; agricultural instruments other than hand-operated hand tools.

Furthermore, the goods listed in Applicant's application for the applied-for mark travel in distinct channels of trade that are specific to their industrial and consumer applications. Specifically, Applicant's goods are sold through authorized distributors which specialize in industrial equipment, including for construction and manufacturing. *See e.g.*, Exhibit B; Exhibit C. In contrast, the goods of the '297 mark are not available through such distributors. *See Id.* Moreover, a cursory search for the owner of the '297 mark does not return any similar distributor websites. *See* Exhibit D.

Therefore, Applicant respectfully submits that the goods listed for Applicant's applied-for mark and the '297 mark are distinct and totally unrelated.

The '946 Mark

As discussed above, Applicant's goods are listed in Class 007. In contrast, the '946 mark lists unrelated goods in Classes 008 and 021. In particular, the '946 mark includes goods listed in Class 008 as

Hand-operated cutting tools; Hand-operated riveting tools; Hand-operated tools for removing lug bolt covers; Hand-operated tools for removing lug nut covers; Hand saws; Hand tools, namely, augers; Hand tools, namely, clamps; Hand tools, namely, hatchets; Hand tools, namely, knife sharpeners; Hand tools, namely, pruning saws; Hand tools, namely, putty knives; Hand tools, namely, riveters; Hand tools, namely, saws

In addition, the ‘946 mark includes goods listed in Class 021 as “[g]arden hose sprayers”. It is respectfully submitted that none of the goods listed in the ‘946 application are remotely similar to those listed in Applicant’s application for the applied-for mark. In particular, band saw blades, as discussed above, are a distinct type of saw blade made for use in band saws. *See* Exhibit A. More particularly, band saws are a type of power-operated saw. *Id.* It is respectfully submitted that hand-operated implements in Class 008 are not remotely similar to power-operated implements, let alone accessories therefore, included in Class 007.

Therefore, Applicant respectfully submits that the goods listed for Applicant’s applied-for mark and the ‘946 mark are distinct and totally unrelated.

NEW DRAWING REQUIREMENT

In the Office Action, the Examining Attorney made a requirement to provide a new drawing of Applicant’s applied-for mark without a “TM” symbol depicted. The Representative Attorney has submitted with this response a new drawing lacking any depiction of the “TM” symbol. No additional changes or material alterations were made to the drawing of Applicant’s applied-for mark. Thus, Applicant respectfully submits that the Examining Attorney’s requirement has been satisfied.

DOMICILE ADDRESS REQUIREMENT

In the Office Action, the Examining Attorney made a requirement to provide Applicant's domicile address. The Representative Attorney has submitted a Change Address or Representation Form on November 23, 2020, to distinguish Applicant's Domicile Address and Mailing Address. Thus, Applicant respectfully submits that the Examining Attorney's requirement has been satisfied.

CONCLUSION

In light of the foregoing, it is respectfully submitted that Applicant's applied-for mark is now in condition for acceptance and publication, and the Representative Attorney respectfully requests the same.