

The Examining Attorney has initially partially refused registration in Class 35 considering Registration Nos. 5816717 and 5719283, both owned by the same Registrant (“Registrant”).

Applicant amends its services in Class 35 as follows:

*arranging newspaper subscriptions for others, compilation of statistics, systemization of information into computer databases, and business consultancy, accounting services, personnel recruitment, personnel placement, employment agencies, import- export agencies, temporary personnel placement services; auctioneering; the bringing together, for the benefit of others, of a variety of goods, namely, measurement apparatus and equipment including those for scientific, nautical, topographic, meteorologic, industrial and laboratory purposes, thermometers, not for medical purposes, barometers, ammeters, voltmeters, not for medical purposes, hygrometers, testing apparatus not for medical purposes, telescopes, periscopes, directional compasses, speed indicators, laboratory apparatus, microscopes, magnifying glasses, stills, ovens and furnaces for laboratory experiments, apparatus for recording, transmission or reproduction of sound or images, cameras, photographic cameras, television apparatus, video recorders, CD and DVD, players and recorders, MP3 players, computers, desktop computers, tablet computers, microphones, loudspeakers, earphones, telecommunications apparatus, apparatus for the reproduction of sound or images, computer peripheral devices, cell phones, covers for cell phones, telephone apparatus, computer printers, scanners in the nature of data processing equipment, photocopiers, magnetic and optic data carriers and computer software and programmes recorded thereto, downloadable and recordable electronic publications, encoded magnetic and optic cards, antennas, satellite antennas, amplifiers for antennas, parts of the aforementioned goods, electronic components used in the electronic parts of machines and apparatus, semi-conductors, electronic circuits, integrated circuits, integrated circuits chips, diodes, electronic transistors, magnetic heads for electronic apparatus, electronic locks, photocells, remote control apparatus for opening and closing doors, optical sensors, counters and quantity indicators for measuring the quantity of consumption, automatic time switches, clothing for protection against accidents, irradiation and fire, safety vests and life-saving apparatus and equipment, apparatus and instruments for conducting, transforming, accumulating or controlling electricity, electric plugs, electric junction boxes, electric switches, circuit breakers, fuses, lighting ballasts, battery starter cables, electrical circuit boards, electric resistances, electric sockets, electric transformers, electrical adapters, battery chargers, electric door bells, electric and electronic cables, batteries, electric accumulators, alarms and anti- theft alarms, other than for vehicles, electric bells, signalling apparatus and instruments, luminous or mechanical signs for traffic use, fire extinguishing apparatus, fire engines, fire hose and fire hose nozzles, radar apparatus, sonars, night vision apparatus and instruments, motor land*

*vehicles, motorcycles, mopeds, engines and motors for land vehicles, clutches for land vehicles, transmissions, transmission belts and transmission chains for land vehicles, gearing for land vehicles, brakes, brake discs and brake linings for land vehicles, vehicle chassis, automobile bonnets, vehicle suspension springs, shock absorbers for automobiles, gearboxes for land vehicles, steering wheels for vehicles, rims for vehicle wheels, vehicle bodies, tipping bodies for trucks, trailers for tractors, frigorific bodies for land vehicles, trailer hitches for vehicles, vehicle seats, head- rests for vehicle seats, safety seats for children, for vehicles, seat covers for vehicles, shaped vehicle covers, sun- blinds adapted for vehicles, direction signals and arms for direction signals for vehicles, windscreen wipers and wiper arms for vehicles, inner and outer tires for vehicle wheels, tubeless tires, tire-fixing sets comprised of tire patches and tire valves for vehicles, windows for vehicles, safety windows for vehicles, rearview mirrors and wing mirrors for vehicles, anti-skid chains for vehicles, luggage carriers for vehicles, bicycle and ski carriers for cars, saddles for bicycles or motorcycles, air pumps for vehicles, for inflating tires, anti- theft alarms for vehicles, horns for vehicles, safety belts for vehicle seats, air bags in the nature of safety devices for automobiles, enabling customers to conveniently view and purchase those goods, such services provided through retail stores, wholesale store outlets, online retail stores, online wholesale store outlets and mail order catalogues all featuring the aforementioned goods, and such services excluding the transport of those goods*

Applicant has deleted the conflicting services. With this amendment, the pertinent services hugely differ. The non-competitive nature of service is a relevant factor in all cases.

*Curtis-Burns, Inc. v. Northwest Sanitation Products, Inc.*, 189 USPQ 138 (CCPA 1976).

Currently, the services are different, non-compatible and do not travel in the same channels of trade. It is thus highly unlikely that they would be encountered by the same consumers in the marketplace. Thus, there is no probability that confusion, mistake, or deception as to source would arise.

“*Per se*” rules related to likelihood of confusion have been struck down as being too inflexible and contrary to trademark law where each case must be decided based on its own facts and circumstance. *In re Quadram Corporation*, 228 USPQ 863, 865 (TTAB 1995); *Interstate Brands Corporation v. Celestial Seasonings, Inc.*, 198 USPQ 151 (CCPA 1978) and cases cited therein; *In re Sydel Lingerie Co., Inc.*, 197 USPQ 629 (TTAB 1977).

After the amendment of Applicant's services, the parties' respective services are unquestionably not sufficiently related such that they could be encountered by the same consumers under circumstances that could rise to the mistaken belief that the services come from a common source. The respective services are offered in different channels of trade to different types and classes of consumers. The test as to whether trade channels for goods or services are similar is based upon what consumers reasonably might believe when encountering the parties' marks in a commercial environment. *CPG Prods. Corp. v. Perceptual Play, Inc.*, 221 U.S.P.Q. 88, 90 (T.T.A.B. 1983). The issue as to whether the goods or services would be encountered by the same purchasers must be considered in any likelihood of confusion analysis. *In re Fesco, Inc.*, 219 U.S.P.Q. 437, 438-39 (T.T.A.B. 1983). Here, the services are unrelated to each other. Confusion is improbable.

It is well established that "if the goods or services 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) (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). Applicant deletes all the conflicting services. With the deletion, the services are no longer related in any way.

Where the services in question are not identical or competitive and are not related or marketed in such a way that they would be encountered by the same people in situations that could create the incorrect assumption that all the goods come from the same source, the Board has held that even where the marks are identical, confusion is not likely. See *In re Fesco, Inc.*, 219 USPQ 437 (TTAB 1983) [nearly identical marks for distributorship services in the field of farm equipment and machinery and for processing machinery, including fertilizer processing equipment and machinery]; *Chase Brass and Copper Co., Inc. v. Special Springs, Inc.*, 199 USPQ 243 (TTAB 1978) [identical marks for engine distributor springs and for brass rods used in new car manufacturing]; *Autac, Inc. v. Walco Systems, Inc.*, 195 USPQ 11 (TTAB 1977) [identical marks for temperature regulators used in the manufacture of wire and for retractile

electric cords.] In this case, the clear distinction between the fields of the pertinent services must be given enough weight and prevail in finding that confusion is highly unlikely.

As the court in DuPont stressed, “the question of confusion is related not to the nature of the mark but to its effect ‘when applied to the goods of the applicant.’” *In re DuPont De Nemours & Co.*, 476 F.2d 1357, 1360 (Fed. Cir. 1973) (emphasis in original). Therefore, if two marks have different meanings and convey different commercial impressions to the relevant consumer, confusion is unlikely even if the marks are identical in sound and appearance. For example, *in In re Sears, Roebuck & Co.*, 2 U.S.P.Q.2d 1312 (TTAB 1987), the Board reversed an examiner’s refusal to register the mark CROSS-OVER for women’s brassieres due to a prior registration of CROSSOVER in connection with women’s sportswear. The Board found that the different meanings projected by the two marks when applied to the goods were effective to eliminate any confusion in the marketplace. The marks are use in unrelated channels of trade. The services that the parties offered are not compatible with each other. The probability of confusion declines.

Based upon all the foregoing, Applicant respectfully requests that the partial refusal be withdraw, and that the application be approved for Publication.