I. SUSPENSION OF APPLICATION

The Examining Attorney has suspended the application for the mark EDGECOOL ("Applicant's Mark") on the grounds that if application serial no. 87601358 for COOL EDGE (the "Cited Application") registers, that the USPTO may refuse registration of Applicant's mark under Section 2(d) because of a potential likelihood of confusion between the registered mark. However, for the reasons discussed below, Applicant respectfully requests that the Examining Attorney withdraw the suspension and allow the subject Application to proceed to registration.

As set forth in *In re E.I. DuPont de Nemours & Co.*, 177 USPQ 563, 567 (CCPA 1973), there are numerous factors to consider when assessing whether a likelihood of confusion exists. Although there is "no litmus rule which can provide a ready guide to all cases," the realities of use in the marketplace are to be considered. *Id*. at 567, 569. In assessing the likelihood of confusion between Applicant's Mark and that of the Cited Application, the relevant factors to be considered in this case are:

1. The differences between the marks;
2. The similarity or dissimilarity and nature of the goods and services as described in the application or registration; and
3. The conditions under which and buyers to whom sales are made.

Id. at 567.

1. The Visual Differences Between the Marks Renders Any Likelihood of Confusion Remote

i. The Marks Contain Different Elements and Are Distinguishable

Applicant's Mark is substantially different from the Cited Application. A comparison is shown below:

Applicant's Mark	Cited Application
EDGECOOL	COOL EDGE

As seen above, Applicant's Mark is the distinctive, unitary mark EDGECOOL. Applicant's Mark is a unitary mark where "edge" and "cool" are put together and "edge" is the first element that consumers are drawn to, whereas the Cited Application is the composite mark COOL EDGE. The Cited Application's dominant portion appears first in that is "cool" and then there is a space in between the next word "edge". There are significant differences between the Cited Application and Applicant's Mark and we will discuss these differences again below. The differences between the respective marks serve to distinguish the marks from one another and obviate any likelihood of confusion.

Moreover, most consumers viewing the marks can easily distinguish between the respective marks through the differences, including the additional text. In fact, most consumers viewing the respective marks will not assume that the marks are related given their marked differences. The present case is very similar to the issue in *Hearst, supra*. In *Hearst*, the Court of Appeals for the Federal Circuit stated that the Trademark Trial and Appeal Board (the "Board") erred in determining that VARGAS was confusingly similar to VARGA GIRL. The court held that the marks were not confusingly similar and that the Board had inappropriately changed the mark VARGA GIRL by stressing the portion VARGA and diminishing the portion GIRL. In reversing the Board's decision, the Court stated that the term GIRL, although descriptive, should be given fair weight so that confusion becomes less likely.

Applicant notes that the marks are not viewed the same. Rather, the marks have very different visual impressions elements, and therefore are not similar. Given the differences in the respective marks and goods, no likelihood of confusion should be found.

A. The Goods Are Dissimilar

Applicant notes that it has applied for the following goods "Air conditioners", whereas the Cited Application covers the following very specific goods, "A cooling feature for refrigerators and refrigerator doors, namely, cooling vents as parts of refrigerators". As one can plainly see, the goods are very different. The goods are for entirely different things. One is for air conditioners, and the other is for a cooling feature for ***refrigerators***. Air conditioners and refrigerator features are two totally different goods and separate appliances. None of these products would be on the same shelves in stores and none of these products would be compared to one another by consumers. Both are highly specialized goods. Consumers would not be confused and we will discuss that further below.

B. Consumers that Purchase the Goods Would Not Be Confused

Consumers that purchase the goods in the instant Application, namely, "Air conditioners," are sophisticated. These goods are not cheap, there are many different types of air conditioners, from window mounted, central air, etc., which are expensive and require a significant amount of research. Consumers that purchase the goods in the Cited Application are also sophisticated. The goods that they purchase under the Cited Application are part of refrigerators. Such appliance is expensive, very large, and difficult to purchase without doing research. As a result, Consumers do research and review where exactly such goods originate from, who created them, what they are comprised of, amongst other factors. Therefore, consumers in such a demographic will not be confused. *See In re Shipp*, 4 U.S.P.Q. 2d 1174 (T.T.A.B. 1987) (confusion unlikely between PURITAN and Design for dry cleaning services and PURITAN for commercial dry cleaning machine filters and dry cleaning preparations due to the sophistication of dry cleaning professions; *Triumph Machinery Co. v. Kentmaster Mfg. Co.*, U.S.P.Q. 2d 1826 (T.T.A.B. 1987) (confusion unlikely between HYDRO-CLIPPER for power mower attachments for use in agricultural and cattle raising industries and HYDRO-CLIPPER for cattle de-horning shears sold to slaughterhouses and meat-packing plants).

Even where two products or services are used by the same type of consumers in the same general area, the channels of trade can be sufficiently dissimilar. See *Electronic Design & Sales v. Electronic Data Systems*, 954 F.2d 713, 715 (Fed. Cir. 1992) (E.D.S. and EDS not confusingly similar where used with computer programming services and design of power supplies, respectively, even where both parties sold their goods or services to many of the same customers in the automotive, communications, and merchandising industries). Further, in In *Hewlett-Packard Co. V. Human Performance Measurement, Inc*., 23 U.S.P.Q.2d 1390, 1395, the T.T.A.B. held that the fact that both the parties sell their goods to hospitals, and thus share a common channel of trade, does not necessarily mandate a finding that the products are related and that confusion is likely. Therefore, even if the goods may be encountered by the same purchasers, that does not, by itself, establish similarity of trade channel or market overlap resulting in a likelihood of confusion. In this situation, there is no trade channel or market overlap due to the very specialized nature of the goods in both marks.

C. Allegations of Potential Confusion are Theoretical and Not Grounds for Refusal to Register

The possibility, either theoretical or *de minimis* that confusion may occur is not a sufficient basis for refusal to register Applicant's Mark. *Whitco Chem. Co. v. Whitfield Chem. Co.*, 418 F.2d 1403, 164 USPQ 43, 44-45 (CCPA 1969) ("*Whitco*"). Rather, a ***likelihood*** of confusion must exist. *Id.* While Applicant realizes that actual confusion is not necessary, Applicant notes that more than a mere theoretical possibility of confusion must be present. In *Whitco*, the Court stated:

> We are not concerned with the mere theoretical possibilities of confusion, deception or mistake or with the *de minimis* situations but with the practicalities of the commercial word, with which the trademark laws deal.

In the present case, the possibility of confusion as to the source of the respective parties' goods is merely theoretical or at most, *de minimis*. There is no proof that consumers will view Applicant's Mark as being similar to the Cited Application, and there is no proof that consumers will be actually confused by the respective uses of the marks, especially where the goods are so different and travel through separate channels of trade. Under these circumstances, Applicant submits that no confusion as to the source of the goods will occur.

II. CONCLUSION

The Examining Attorney is to act as an impartial judge when evaluating an application and should include facts that not only support his/her conclusion but which also directly contradict his/her conclusion. JAMES E. DAWES AND AMANDA V. DWIGHT, PRACTITIONER'S TRADEMARK MANUAL OF EXAMINING PROCEDURE, § 1209.02 (5th ed. 2009). Here, the Examining Attorney must consider that not all consumers will automatically equate the marks as being the same, nor will consumers view the goods to be the same, nor will consumers believe that the marks hold the same commercial impression. In addition, the Examining Attorney must also consider the differences between the respective goods and the channels of trade for each.

In light of the foregoing comments and information, Applicant respectfully requests that the Examining Attorney withdraw the suspension and promptly pass the subject application to publication.