

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Kaliburn, Inc.
Serial No.: 85/805,437
Mark: ENDURA
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Examining Attorney: Lee-Anne Berns
Law Office: 105
Attorney Docket: 201990.06090

**Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451**

RESPONSE TO THE SUPPLEMENTAL OFFICE ACTION

The Applicant has reviewed the Supplemental Office Action indicating a refusal based on a likelihood of confusion with US Registration No. 3,894,808. The Applicant respectfully disagrees for the following reasons.

In the seminal case involving §2(d), *In re E. I. du Pont de Nemours & Co.*, the U.S. Court of Customs and Patent Appeals discussed the factors relevant to a determination of likelihood of confusion. 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973). Furthermore, the significance of a particular factor may differ from case to case. See *du Pont*, 476 F.2d at 1361-62, 177 USPQ at 567-68; *Dixie Rests.*, 105 F.3d at 1406-07, 41 USPQ2d at 1533 (noting that “any one of the factors may control a particular case”). TMEP 1207.01. While the similarity of the marks and the goods described in the application and registration are given key consideration, additional factors must be considered if there is pertinent evidence of record. In this case, in addition to the differences in the marks and the goods, the Applicant submits that the coexistence of the two marks for several years without any instances of actual confusion is a relevant factor for consideration in this application. *See*, MPEP 1207.01(d)(ii).

A. DIFFERENCES IN THE MARKS AND THE GOODS TO WHICH THEY ARE APPLIED

The applied for ENDURA trademark is different from the registered mark ENDURANCE in terms of its appearance, sound, and meaning. In terms of appearance, the registered mark is a complete word that is readily recognizable. In contrast, ENDURA is not an actual word and has no readily recognizable meaning. ENDURA is shorter than ENDURANCE and lacks the letters “nce” giving it a different appearance. Likewise, in terms of sound, the last three letters of the ENDURANCE mark give it a significantly different pronunciation. These letters provide a sibilant sound as opposed to the vowel sound created by the letter “A” at the end of ENDURA. Finally, the meaning of the marks is different. The definition of ENDURANCE is the ability to do something difficult for a long period of time or a quality of continuing for a long time period. www.merriam-webster.com. ENDURA, on the other hand, has no recognizable meaning. These differences would provide distinctions in the eyes, ears and minds of a consumer considering the goods associated with each mark.

In that regard, they also provide a basis for distinction. The goods’ descriptions of the ENDURA and ENDURANCE marks indicate that the electrodes are used for distinct purposes. In the case of ENDURANCE, the electrodes are used for welding while in the applied for mark, the electrodes are used for plasma cutting.

B. COEXISTENCE OF THE MARKS FOR SEVERAL YEARS

The coexistence of marks in the marketplace for a number of years without any instances of actual confusion is relevant evidence supporting a lack of a likelihood of confusion. *Pignons S.A. de Mecanique de Precision v. Polaroid Corp.*, 657 F.2d 482, 490 (1st Cir. 1981)(“absent evidence of actual confusion, when the marks have been in the market, side-byside, for a substantial period of time, there is a presumption that there is little likelihood of confusion.”). In *Pignons*, the court recognized that four years was a substantial period of time. *Id.*

Here, Select-Arc registered its ENDURANCE mark in 2010 and indicated a date of first use on August 31, 2009 in its registration. The Applicant and its predecessor have been using the ENDURA mark for plasma cutting electrodes well before Select-Arc began using its mark. Decl. J. Winn. The Applicant has used the mark on sales sheets (Decl. J. Winn, Ex. A) and on

product labels (Decl. J. Winn, Ex. B). Based on Select-Arc’s registration, the marks have coexisted in the market place for over four years. Customers purchasing Select-Arc or the Applicant’s products exercise considerable care in purchasing the respective products. A copy of Select-Arc’s catalog is attached. As can be seen, Select-Arc offers over 100 different welding electrodes based on the type of weld process, the materials being joined and the desired weld characteristics. The entry for the ENDURANCE electrode states:

Endurance

CLASSIFICATION: E70C-6M-H4 per AWS A5.18, ASME SFA 5.18

A specially manufactured carbon steel, composite metal cored electrode for gas-shielded arc welding, Endurance provides unsurpassed feedability and arc starting capability, low residual slag and excellent operating characteristics. Endurance is intended for the single and multiple pass welding of carbon and certain low alloy steels, where a minimum tensile strength of 70,000 psi is required in the deposited weld metal.

APPLICATIONS: Endurance is ideally suited for robotic and other automated applications where consistency of feeding, arc starting and bead appearance are of primary importance. This electrode is utilized for general purpose welding but excels in higher demand situations such as in heavier sheet metal fabrication, automotive applications, structural work, pipe welding and the welding of water heaters.

DIAMETERS: .045", .052", 1/16"

SHIELDING GAS: 75-95% Ar/ balance CO₂, 40-55 cfh

WELDING POSITIONS: All positions



CHARACTERISTICS:

- Continuous, uninterrupted feeding and consistent arc starts under difficult conditions.
- Low slag formulation.
- Smooth, well washed beads with even edges and minimal silicon islands.
- Faster travel speeds and increased productivity over solid wires.
- Better sidewall fusion on heavy plate.
- Greater tolerance of rust and millscale.

CARBON STEEL

LOW ALLOY

STAINLESS STEEL

NICKEL ALLOYS

Select-Arc Catalog, p. 15. Likewise, as can be seen in Ex. A, the Applicant’s electrodes take into consideration the welding process and amperage to be used during cutting. Given the specialized purpose of each electrode and the factors that go into a purchase decision, a

consumer would exercise greater than ordinary care in purchasing the respective goods associated with each mark.

Considering this level of care, the differences in the goods, the differences in the marks and the coexistence of the two marks in the marketplace for over four years without confusion, the relevant *du Pont* factors weigh against a likelihood of confusion. In view of this, the Applicant respectfully requests withdrawal of the Section 2(d) refusal based on a likelihood of confusion. The Applicant submits that the application is in condition for publication and respectfully requests notice of the same.

Respectfully submitted

Shannon V. McCue
Attorney for the Applicant
USPTO Registration No. 42,859