

Applicant Apache Corporation (“Applicant”) responds to the Office Action issued on January 24, 2018 regarding Application Serial No. 87619318 for APACHE (the “Mark”). The Mark was preliminarily refused based on the alleged likelihood of confusion with Registration Nos. 1141230 for APACHE (the “’230 Registration”) and 2247006 for APACHE DC CUP (the “’006 Registration”) (collectively, the “Cited Marks”).


Applicant respectfully submits that confusion is not likely to occur and submits the following response in favor of registration.

I. Confusion With The ‘230 Registration For APACHE For Mobile Drills Is Unlikely To Occur Since The Marks Have Co-Existed Without Confusion Since The 1970s (With The Cited Registrant As The Junior User)

Several *du Pont* factors show that consumer confusion is not likely to occur between Applicant’s Mark and the ‘230 Registration, particularly since the marks have co-existed for nearly 40 years without any confusion.

Applicant already owns two U.S. registrations for its APACHE mark covering nearly identical services as the Mark, as shown below. A copy of the TSDR records are attached as Exhibit 1.

Mark	Class and Goods/Services	App. Date	App. No.	Reg. Date	Reg. No.	Date of First Use
APACHE	<p>[37] Oil and gas drilling and pumping; Installation, maintenance and repair of liquid and compressed natural gas fueling systems; Maintenance of facilities for operating fleets of compressed natural gas vehicles; Vehicle refueling services; Vehicle repair services</p> <p>[40] Natural gas liquefaction services; Oil and gas well treatment; Oil and gas production services; Oil and gas well treatment</p> <p>[42] Analysis of oil and gas fields; Exploration and searching of oil and gas; Geophysical exploration for the oil industry; Geophysical exploration for the gas industry; Oil and gas field surveying; Oil and gas prospecting; Oil and gas well testing; Surveying of oil and gas beds and fields</p>	Aug 16 2012	85706000	Aug 27 2013	4390865	May 03, 1973

APACHE (Stylized) 	[40] Oil and gas production services [42] Oil and gas exploration, oil and gas development, namely, searching for oil and gas; oil and gas geological prospecting analysis, oil fields and gas analysis, and testing of oil and gas wells	Aug 22 2008	77553819	Apr 6 2010	3769833	May 03, 1973
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The oil and gas production and distribution goods and services covered by the Mark are very closely related to the services for which Applicant has already registered its APACHE marks.

Moreover, both marks have been used in the oil and gas industry for nearly 40 years without any confusion. See *In re Strategic Partners, Inc.*, 102 USPQ2d 1397, 2012 WL 1267930, at *2, *4 (TTAB 2012) (stating that the prior co-existence of five years between applicant’s prior registration and the cited registration was strong evidence that confusion was unlikely under the thirteenth *du Pont* factor, which admits evidence for “any other established fact probative of the effect of use” (emphasis added)); see also *In Re Lg Elecs. Inc.*, 2018 WL 2999771, at *4 (May 15, 2018) (noting that “the five-year milestone [for co-existence] carries added weight because of its legal significance under the Lanham Act”). “If the parties have co-existed for some years without any credible evidence of confusion, this is evidence that there will not be a likelihood of confusion in [the] future.” 3 McCarthy on Trademarks and Unfair Competition § 20:85 (4th ed.) (hereinafter “McCarthy”); see e.g. *Boi Na Braza, LLC v. Terra Sul Corp.*, 110 U.S.P.Q.2d 1386, 1393 (T.T.A.B. 2014) (finding that confusion was unlikely when parties co-existed for 15 years without evidence of actual confusion); *G.H. Mumm & Cie v. Desnoes & Geddes, Ltd.*, 917 F.2d 1292, 1295 (Fed. Cir. 1990) (stating that confusion was unlikely when parties co-existed for over a decade without evidence of actual confusion).

Here, the Mark, which is Applicant’s house mark, was first used in commerce on May 3, 1973, and the owner of the ‘230 Registration (the “‘230 Registrant”) claims to have used its mark since September 8, 1978. Applicant is not aware of any consumer confusion. As in *Strategic Partners*, the fact that Applicant already owns two registrations for an identical mark (Reg. No. 4390865) and a nearly identical stylized mark (Reg. No. 3769833) that cover essentially identical services and the fact that the Mark has co-existed with the ‘230 Registration for nearly 40 years without consumer confusion strongly indicates that consumer confusion is unlikely to result from registration of the Mark.

II. Confusion With The ‘006 Registration For APACHE DC CUP For Pipeline Pigs Is Unlikely To Occur Since The Marks Have Co-Existed Without Confusion Since The 1990s (With The Cited Registrant As The Junior User)

Several *du Pont* factors also show that consumer confusion is not likely to occur between Applicant’s Mark and the ‘006 Registration.

As discussed above, Applicant owns two U.S. registrations for its APACHE house mark covering nearly identical services as the Mark and has used the Mark in commerce since 1973. See Exhibit 1. Comparatively, the owner of the ‘006 Registration (the “‘006 Registrant”) claims a date of first use in March 1992. Therefore, Applicant’s Mark pre-dates the ‘006 Registration and has co-existed with the ‘006 Registration for over 26 years. See e.g., *In re Strategic Partners, Inc.*, 2012 WL 1267930, at *2, *4 (finding co-existence of five years to be strong evidence that confusion was unlikely to occur); *Boi Na Braza, LLC*,

110 U.S.P.Q.2d at 1393 (finding co-existence of 15 years to be evidence that confusion was unlikely to occur).

As in *Strategic Partners* and *Boi Na Braza*, the fact that Applicant already owns two registrations for its APACHE mark (Reg. Nos. 4390865 and 3769833) and that Applicant's Mark has co-existed with the '006 Registration for over 26 years without consumer confusion strongly indicates that consumer confusion is unlikely to result from registration of the Mark.

III. Confusion With The '006 Registration is Unlikely Because The Mark Is Visually And Aurally Distinguishable

Applicant's Mark is distinguishable from the '006 Registration in appearance, sound, and commercial impression, such that confusion is unlikely to occur. See TBMP § 309.03(C) ("[T]o determine whether the marks are similar for purposes of assessing the likelihood of confusion, the Board will consider the appearance, sound, connotation and commercial impression of each mark." (citation omitted)).

Applicant submits that the respective marks, when properly evaluated as a whole, are sufficiently distinct in appearance and sound. See McCarthy § 23:41 ("Conflicting composite marks are to be compared by looking at them as a whole, rather than breaking the marks up into their component parts for comparison").

First, Applicant's Mark is visually distinguishable from the '006 Registration because the Mark, APACHE, consists of one unitary word, consisting of six letters. Comparatively, the '006 Registration for APACHE DC CUP consists of three words—the first consisting of six letters, the second consisting of two letters, and the third consisting of three letters. Additionally, the Mark begins with an "A" and ends with an "E;" whereas, the '006 Registration begins with an "A" and ends with a "P." See *In Re Roberto Rivera*, 2007 WL 3320314, at *2–3 (Oct. 29, 2007) (finding that JUICY MUSIC for audio and video tapes was distinguishable from JEWICY for video tapes and entertainment services and stating that "[e]ven assuming that the [shared term 'JUICY'] is the dominant portion of the Applicant's mark, . . . the addition of the word 'music' cannot be ignored in determining the question of likelihood of confusion"); *Miguel Torres, S.A. v. Advantage Wine Grp.*, 2000 WL 506303, at *2 (T.T.A.B. 2000) (determining VIÑA SOL and DONA SOL are visually dissimilar). These differences in appearance distinguish the marks and prevent confusion in the marketplace.

Second, the visual distinctions between the Mark and the '006 Registration also serve to distinguish the marks in sound. The Mark is distinguishable because it consists of three syllables and ends with an E-sound. On the other hand, the '006 Registration consists of six syllables and ends with a P-sound. See *Ferrotec (Usa) Corp. & Ferrotec Corp. v. Ferro Labs, Inc.*, 2009 WL 273256, at *8 (T.T.A.B. 2009) (finding FERRO LABS aurally dissimilar from FERRO TEC when considering the marks in their entirety). Thus, the marks are distinct in sound as well.

These differences in appearance and sound further serve to distinguish the Mark from the '006 Registration and create a distinguishable commercial impression, such that there can be no likelihood of confusion between the marks.

IV. Applicant's Mark has no Connection with JICARILLA APACHE

Applicant respectfully submits that the Mark, including the goods and services covered by the Mark, has no present connection with JICARILLA APACHE.

CONCLUSION

For the reasons noted above, Applicant respectfully submits that confusion is unlikely to occur and requests that the application be moved forward to publication.