

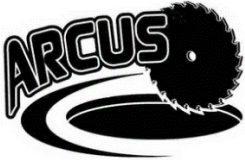
**OFFICE ACTION RESPONSE**

Applicant’s mark is **ARCUS**, U.S. Trademark Application Serial No. 88/322,729, depicted as follows:



for use in connection with, as amended,<sup>1</sup> “Steam cleaning machines; Lawnmowers for household purposes; Snow ploughs; High pressure washers; Electric vacuum cleaners for household purposes; Floor cleaning machines for household purposes” in International Class 7 (“Applicant’s Mark”).

Registration of Applicant’s Mark has been refused under Section 2(d) based on a finding of likelihood of confusion with the following marks:


Mark	Reg. No.	Goods
<b>ARCUS</b>	3308629	Class 7: power saw cutting blades
	3308628	Class 7: power saw cutting blades

<sup>1</sup> Applicant has amended its goods ID in Class 7 as follows:

Steam cleaning machines; ~~Mowing and reaping machines~~; Lawnmowers **for household purposes**; ~~Agricultural machinery, namely, harvesters; engines, other than for land vehicles; Chain saws; Dynamos; Electric pumps; Compressed air machines~~; Snow ploughs; High pressure washers; ~~Blowing machines for the compression, exhaustion and transport of gases; Brushes being parts of machines; Sanding machines, for woodworking; Stone working machines; Electric hammers; Power hammers; Band saws; Circular saws; Electric hand held drills; Glue guns, electric; Power drills; Electric screwdrivers; Power driven wrenches; Electric sanders; Power operated angle grinders; Paint spray guns; Electric arc welding apparatus~~; Electric vacuum cleaners **for household purposes**; Floor cleaning machines **for household purposes**.

The Examining Attorney should consider Applicant’s arguments in light of the amended identification.

In addition, the examiner cited the following pending applications:

<b>Mark</b>	<b>Serial No.</b>	<b>Goods</b>
<b>ARCUS</b>	87091227	<p>Class 7: Industrial robots other than for manufacturing semiconductors; Robotic arms for industrial purposes other than for manufacturing semiconductors; Springs being parts of machines; Ball-bearings for machines, namely, for use with robots, shaft couplings as parts of machines, shaft bearings being parts of machines, Bearing inserts for machines; Plastic processing machines and apparatus; Machines and apparatus for manufacturing rubber goods; Industrial robots for use in assisting with the handling and supporting of workpieces other than for manufacturing semiconductors; Industrial Service Robots other than for manufacturing semiconductors; Industrial robots for collaborative purposes other than for manufacturing semiconductors; Industrial robots for disaster response other than for manufacturing semiconductors</p> <p>Class 9: Piezoelectric switches; Conductive tape for electromagnetic radiation shielding for sensors and industrial robots; Robots for guarding purpose, namely, theft prevention purposes, security surveillance purposes and security guarding for facilities, and not for industrial, medical purposes or for use as a toy; Robots for personal entertainment use and not for industrial, medical purpose or for use as a toy; Robots for hobby use and not for industrial, medical purposes or for use as a toy</p>
	87091275	<p>Class 7: Industrial robots other than for manufacturing semiconductors; Robotic arms for industrial purposes other than for manufacturing semiconductors; Springs being parts of machines; Ball-bearings for machines, namely, for use with robots, shaft couplings as parts of machines, shaft bearings being parts of machines, Bearing inserts for machines; Plastic processing machines and apparatus; Machines and apparatus for manufacturing rubber goods; Industrial robots for use in assisting with the handling and supporting of workpieces other than for manufacturing semiconductors; Industrial Service Robots other than for manufacturing semiconductors; Industrial robots for collaborative purposes other than for manufacturing</p>

	<p>semiconductors; Industrial robots for disaster response other than for manufacturing semiconductors</p> <p>Class 9: Piezoelectric switches; Conductive tape for electromagnetic radiation shielding for sensors and industrial robots; Robots for guarding purpose, namely, theft prevention purposes, security surveillance purposes and security guarding for facilities, and not for industrial, medical purposes or for use as a toy; Robots for personal entertainment use and not for industrial, medical purpose or for use as a toy; Robots for hobby use and not for industrial, medical purposes or for use as a toy</p>
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(collectively, the “Cited Marks”). Applicant respectfully disagrees and submits the following response to the Examining Attorney’s refusal based on the following arguments.

**THE GOODS ARE NOT RELATED**

The Examining Attorney found that “. . . the same entity commonly provides the relevant goods and markets the goods under the same mark.” Applicant respectfully disagrees.

The Examining Attorney must provide evidence showing that the goods and services are related to support a finding of likelihood of confusion. *See, e.g., In re White Rock Distilleries Inc.*, 92 USPQ2d 1282, 1285 (TTAB 2009). The relatedness of goods or services may not be assumed, and the Examining Attorney must show “something more” than that different goods or services are in the same environment or trade channels to demonstrate that the goods are sufficiently related to weigh in favor of a finding of likelihood of confusion. *See In re Coors Brewing Co.*, 343 F.3d 1340, 1345, 68 USPQ2d 1059, 1063 (Fed. Cir. 2003) (quoting *Jacobs v. Int’l Multifoods Corp.*, 668 F.2d 1234, 1236, 212 USPQ 641, 642 (C.C.P.A. 1982)); *see also In re Giovanni Food Co.*, 97 USPQ2d 1990, 1991 (TTAB 2011).

Here, the Examining Attorney provided evidence that some large, multinational corporations such as Ryobi, DeWalt, and Milwaukee provide a wide range of home-improvement equipment, including the registrant’s “power saw cutting blades” and Applicant’s lawnmowers. However, these large companies produce a wide variety of unrelated goods, and the evidence is not representative of the overall marketplace. For example, most companies that produce saw blades do not also produce lawnmowers under the same trademark, and vice versa. Moreover, Applicant’s goods (as amended) are expressly for household purposes, whereas the registrant’s “power saw cutting blades” are machines for use in construction, not for common household use.

Nor are Applicant's goods related to those of the prior-pending ARCUS marks. The prior-pending marks are specifically for industrial robotics and manufacturing equipment, whereas Applicant's goods are common items for household use. The Examining Attorney must rely on the identification of the goods or services as recited in the application or registration when determining the relatedness of the goods for likelihood of confusion purposes. *See* TMEP § 1207.01(a)(iii). Here, the goods (industrial robotics and manufacturing equipment) are completely different from Applicant's common household goods, and there is no overlap in the channels of trade or classes of consumers. Accordingly, the goods are not related for likelihood of confusion purposes, and this factor weighs heavily against a finding of a likelihood of confusion.

### **THE MARKS ARE NOT SIMILAR**

In the first part of the likelihood of confusion analysis, the marks are compared for similarities in their appearance, sound, connotation and commercial impression. TMEP §§1207.01, 1207.01(b). When comparing marks that share a literal element, the addition or deletion of other matter in the marks may be sufficient to avoid a likelihood of confusion if the marks in their entireties convey significantly different commercial impressions. TMEP §1207.01(b)(iii); *see Bass Pro Trademarks, L.L.C. v. Sportsman's Warehouse, Inc.*, 89 USPQ2d 1844, 1857-58 (TTAB 2008) (finding that, although petitioner's and respondent's marks were similar by virtue of the shared descriptive wording "SPORTSMAN'S WAREHOUSE," this similarity was outweighed by differences in terms of sound, appearance, connotation, and commercial impression created by other matter and stylization in the respective marks); *In re Farm Fresh Catfish Co.*, 231 USPQ 495, 495-96 (TTAB 1986) (holding CATFISH BOBBERS (with "CATFISH" disclaimed) for fish, and BOBBER for restaurant services, not likely to cause confusion, because the word "BOBBER" has different connotation when used in connection with the respective goods and services); *See, e.g., Shen Manufacturing Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 73 USPQ2d 1350 (Fed. Cir. 2004) (RITZ and THE RITZ KIDS create different commercial impressions); *In re Shawnee Milling Co.*, 225 USPQ 747 (TTAB 1985) (GOLDEN CRUST for flour held not likely to be confused with ADOLPH'S GOLD'N CRUST and design (with "GOLD'N CRUST" disclaimed) for coating and seasoning for food items); *In re S.D. Fabrics, Inc.*, 223 USPQ 54 (TTAB 1984) (DESIGNERS/FABRIC (stylized) for retail fabric store services held not likely to be confused with DAN RIVER DESIGNER FABRICS and design for textile fabrics).

Often, the examining attorney must determine whether a likelihood of confusion exists between composite marks that consist of a design element as well as words and/or letters. Frequently the marks at issue are similar in only one element. Although it is not proper to dissect a mark, if one feature of a mark is more significant than another feature, greater weight may be given to the dominant feature for purposes of determining likelihood of confusion. *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 218 USPQ 390 (Fed. Cir. 1983). While it is often true that the word portion of a mark is more likely to be impressed upon a purchaser's memory, that is not the case in every situation. The Court of Appeals for the Federal Circuit has cautioned that “[t]here is no general rule as to whether letters or designs will dominate in composite marks; nor is the dominance of letters or design dispositive of the issue.” *In re Electrolyte Laboratories Inc.*, 929 F.2d 645, 647, 16 USPQ2d 1239, 1240 (Fed. Cir. 1990) (K+ and design for dietary potassium supplement held not likely to be confused with K+EFF (stylized) for dietary potassium supplement); *Spice Islands, Inc. v. The Frank Tea & Spice Co.*, 505 F.2d 1293, 184 USPQ 35 (C.C.P.A. 1974) (SPICE TREE and tree design held not confusingly similar to SPICE ISLANDS and tree design, both for spices). Further, the visual impact of the marks on the minds of the prospective purchasers who view them must be considered and the design portion of a mark can be the dominant part of a mark. *Finn v. Cooper's Inc.*, 130 U.S.P.Q. 269, 272 (CCPA 1961). Images create a lasting impression in the minds of consumers. *Id.* (“[We must consider the visual impact of the marks on the minds of the prospective purchasers who view them . . . . Symbolic marks speak a universal language; they lend themselves to effective display in advertising and sales promotional activity and can thus become the dominant part of the mark on labels, packages, and point of purchase displays. They can catch the eye of the customer and create a lasting general impression. Current mass advertising media utilize symbols which are visually projected into millions of homes of prospective purchasers by television and these symbols frequently are associated with pictures of the goods of a particular user”).

Applying these principles, in *In re Fairview Imp. Corp.*, 2013 TTAB LEXIS 447 (TTAB Aug. 16, 2013), the Board reversed a refusal to register the following combined word/design mark:



for, *inter alia*, “sunglasses” in International Class 9 (with the descriptive term “collection” disclaimed) was not likely to cause confusion with the mark HERITAGE 1981, for, *inter alia*, “eyewear, namely, sunglasses” in International Class 9 (with “1981” disclaimed).

Despite the fact that the goods for both marks -- sunglasses -- were *identical*, and the marks shared the first term “Heritage” with the second terms “Collection” and “1981” disclaimed, the Board found that confusion was not likely because the “moose” design was “prominent” and contributed “greatly” to the visual impression of the applicant's mark:

[W]e note that applicant's mark Heritage Collection is similar to the mark HERITAGE 1981 in the cited registration solely to the extent that both contain the word HERITAGE as a prominent element thereof. However, the marks are dissimilar to a significant extent in that applicant's mark contains the prominently sized and arbitrary design of a moose. This design contributes greatly to the visual impression of applicant's mark. This is not a case in which the design portion of applicant's mark is an easily overlooked geometric carrier or an abstract pattern that is much smaller in size than the wording. We observe that in registrant's mark the term HERITAGE is the first and most prominent portion thereof. However, in applicant's mark, the term HERITAGE is located below the prominent moose design, which is equal in size to the wording HERITAGE COLLECTION and appears to be arbitrary as applied to the goods. Even if consumers did not recognize the design as a moose per se, they nonetheless would be likely to recognize it as the design of an animal with a large rack of antlers. Thus, when viewed as a whole, applicant's mark is notably dissimilar from that of registrant in appearance.

*In re Fairview*, TTAB LEXIS 447 at 9-12. The Board further explained that even though the marks shared the first term “Heritage”, which has similar connotations as applied to identical goods, the sole fact that the mark contained a highly distinctive “moose” design was sufficient to obviate a likelihood of confusion:

[T]he wording HERITAGE COLLECTION and HERITAGE 1981 are likely to have similar connotations as applied to identical or otherwise related goods. However, the arbitrary moose design does not appear to have any meaning or connotation as applied thereto, and thus creates an arbitrary and noticeable addition to the connotation engendered by applicant's mark. Taken as a whole, the marks thus are different in connotation and commercial impression.

Based upon the foregoing, we find that the dissimilarities between applicant's mark and the mark in the cited registration outweigh the similarities. Thus, the first *du Pont* factor regarding the dissimilarity of the marks favors applicant. Moreover, we find this factor is determinative and, despite the in-part identity of the goods, we conclude that the marks are sufficiently dissimilar that confusion is not likely between applicant's mark and the mark in the cited registration.

*Id.* at 11-12.

The Board more recently held *again* that **design elements may be dominant and must be considered**. In a precedential decision, the Board reversed a refusal of REDNECK RACEGIRL (& Design) for clothing in class 25, depicted as follows:



finding no likelihood of confusion with the mark RACEGIRL in standard characters for similar clothing in class 25. *In re Covalinski*, 113 USPQ 2d 1166 (TTAB 2014). The Board found “crucial differences” between the marks, including that the graphic elements of the applied-for mark “serve not only to draw attention to the RR letters apart from the wording, but also make the letters that for the 'a-c-e' of the word 'RACEGIRL' difficult to notice.” *Id.* at 5. The Board cited several prior decisions in which the design was deemed dominant.

Applying these principals in the present case, Applicant’s Mark and the Cited Mark must be considered in their **entireties**, including the distinctive “sawblade” design ARCUS (Reg. No. 3308628), the distinctive rainbow design in the ARCUS (Serial No. 87091275), and the “stylized cloud and rising sun” design in Applicant’s Mark. The Examining Attorney must also consider the differences in the stylization of the letters. When the marks are

properly considered in their entirety, the marks are very different in appearance, sound, meaning, and commercial impression.

Specifically, the marks are different in their appearance owing to the inclusion of the “stylized cloud and rising sun” design in Applicant’s Mark, which does not appear in any of the Cited Marks. Similarly, ARCUS (Reg. No. 3308628) includes a “sawblade” design and the ARCUS (Serial No. 87091275) includes a rainbow design, neither of which appear in Applicant’s Mark. Like the “moose” design in Fairview, **the “stylized cloud and rising sun,” “sawblade,” and “rainbow design” are each prominent design features of the Cited Marks. These designs “contribute[] greatly” to the overall visual impressions of the marks.** *Fairview, supra, at 9.* Thus, the marks are completely different owing to the different design elements. Moreover, Applicant’s Mark features unique, smooth, and flowing stylized letters, which do not appear in any of the Cited Marks. Instead, the Cited Mark ARCUS (Reg. No. 3308628) features a bold, forceful typeface, and the Cited Mark ARCUS (Serial No. 87091275) features an angled, futuristic typeface. These stylized letter and design features clearly distinguish the marks in appearance.

Furthermore, the meaning and commercial impression of the marks are completely different. Specifically, the “stylized cloud and rising sun” design in Applicant’s Mark creates the impression of products that are sleek and sophisticated. Further, the term ARCUS is unique and carries no particular meaning. In contrast, the Cited Marks ARCUS (Reg. Nos. 3308628 and 3308629) imply the registrant’s power saw cutting blades are able to cut in various directions, including “arcs”. Similarly, the two pending ARCUS marks connote futuristic industrial robots – an impression that is very different from Applicant’s mark. Accordingly, the marks are not similar in appearance, sound, meaning, or overall commercial impression, thus weighing heavily against a finding of likelihood of confusion

### **CONCLUSION**

Based on the foregoing, Applicant respectfully submits that there is no likelihood of confusion among Applicant's Mark and the Cited Marks. Applicant respectfully requests that the Section 2(d) refusal be withdrawn and that Applicant's Mark be published for opposition.