

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT: Valmont Industries, Inc.

SERIAL NO.: 90/085,504

Examining Attorney: Justin Severson

MARK: ENCOMPASS

Law Office: 111

FILED: July 31, 2020

RESPONSE

Pursuant to an Office Action dated November 17, 2020, the Examining Attorney is refusing registration of Valmont Industries, Inc.'s (the "Applicant") trademark application for registration of ENCOMPASS on the grounds of a likelihood of confusion with the mark ENCOMPASS, U.S. Registration No. 2754326 (hereinafter, the "Cited Registration") under Trademark Act Section 2(d), 15 U.S.C. §1052(d). Applicant respectfully disagrees there is a likelihood of confusion between the applied-for mark and the Cited Registration, and requests that the subject application be approved for publication.

In determining whether there is a likelihood of confusion, the United States Patent and Trademark Office's Trademark Trial and Appeal Board has employed the multi-factor balancing test articulated in In re E.I. du Pont de Nemours & Co., 476 F.2d 1357, 1361 177 U.S.P.Q. 563, 567 (CCPA 1973). The *du Pont* court set forth thirteen factors to consider when determining whether there is or will be a likelihood of confusion:

- (1) the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation, and commercial impression;
- (2) the similarity or dissimilarity and nature of the goods or services as described in an application or registration or in connection with which the prior mark is in use;
- (3) the similarity or dissimilarity of established, likely-to-continue trade channels;
- (4) the conditions under which, and buyers to whom, sales are made, i.e. "impulse" vs. careful, sophisticated purchasing;

- (5) the fame of the prior mark (sales, advertising, length of use);
- (6) The number and nature of similar marks in use on similar goods;
- (7) the nature and extent of any actual confusion;
- (8) the length of time during, and conditions under which, there has been concurrent use without evidence of actual confusion;
- (9) the variety of goods on which a mark is or is not used (house mark, “family” mark, product mark);
- (10) the market interface between applicant and the owner of the prior mark;
- (11) the extent to which applicant has a right to exclude others from use of its mark on its goods;
- (12) the extent of potential confusion, i.e., whether *de minimis* or substantial; and
- (13) any other established fact probative of the effect of use.

The primary considerations are the similarities between the marks and the similarities between the goods. See Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 U.S.P.Q. 24, 29 (CCPA 1976) (“The fundamental inquiry mandated by §2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks”).

A. The number of “ENCOMPASS” marks in the Class 009 is crowded, and, therefore, the Cited Registration is entitled to only a very narrow scope of protection

“Evidence of third-party use of similar marks on similar goods is relevant to show that a mark is relatively weak and entitled to only a narrow scope of protection.” Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772, 396 F.3d 1369, 1373, 73 USPQ2d 1689, 1693 (Fed. Cir. 2005). See also In re Coors Brewing Co., 343 F.3d 1340, 1345 (Fed.Cir.2003) (third-party use can establish that mark is not strong); Fleetwood Co. v. Mende, 49 C.C.P.A. 907, 298 F.2d 797, 799 (1962) (“Where a party uses a weak mark, his competitors may come closer to his mark than would be the case with a strong mark without violating his rights.”). The weaker a mark, the closer an applicant’s mark can come without causing a likelihood of

confusion and thereby invading what amounts to its comparatively narrower range of protection. Palm Bay Imps., Inc. 396 F.3d at 1373, 73 USPQ2d 1693.

Indeed, there is strong evidence that the Cited Registration in this matter is clearly weak, and, therefore, similar or identical marks may come closer without causing a likelihood of confusion. There are currently are 28 active trademark applications/registrations in Class 009 that include the word “ENCOMPASS”. The number of allowed and registered ENCOMPASS marks in this field indicates that consumers are used to deciphering between the numerous ENCOMPASS marks within this field and that these marks are able to coexist on the Principal Register without confusion. Consider the following marks, all in Class 009:

Mark/Number/Status	Registrant/Applicant	Class & Goods/Services
ENCOMPASS Reg. No. 5944621 Registered	General Electric Company	Class 009: A hardware and software platform consisting of sensors, transmitters, receivers, and RFID (Radio Frequency Identification) technology, for use in connection with tracking, locating, and monitoring medical equipment and healthcare assets
ENCOMPASS Reg. No. 4677218 Registered	Phoenix Technologies, LLC	Class 009: Software for fuel management and for use in environmental compliance in the field of fuel dispensing and underground fuel storage; environmental monitoring equipment, namely, optical-based, electronic liquid detectors and ultrasonic-based electronic liquid level monitoring systems with inferred leak detection
ENCOMPASS Reg. No. 1775026 Registered	Worley Group Inc.	Class 009: computer software for the energy and industrial markets featuring management, engineering, construction, and plant operation modules
ENCOMPASS TECHNOLOGIES E8 ERP Reg. No. 6170113 Registered	Encompass Technologies Development, LLC	Class 009: Downloadable mobile applications for enterprise resource planning, customer relationship management, business accounting, and sales management for use in commercial product distribution operations featuring route accounting, warehouse management, voice-pick, sales execution, business intelligence, logistics, mobile delivery, invoice and pricing reconciliation,

Mark/Number/Status	Registrant/Applicant	Class & Goods/Services
		warehouse automation, quality assurance, electronic data interchange, and retailer ordering system features
<p>ENCOMPASS</p> <p>Serial No. 88140281</p> <p>Allowed - Notice of Allowance Issued</p>	<p>TransPerfect Translations International, Inc.</p>	<p>Class 009: Proprietary software that combines a structured content extensible markup language (XML) management system for English and equivalent translated content and an automated translation processing system for centralizing/utilizing linguistic assets in the nature of translation memories and glossaries, for defining translation production workflows, and for providing translation project submission, management, and archiving functionality</p>
<p>ENCOMPASS</p> <p>Reg. No. 5285681</p> <p>Registered</p>	<p>Ocean Reef Club Inc.</p>	<p>Class 009: Computer software for use in management of clubs and hospitality based businesses, namely, software for use in task management, scheduling, budgeting, payroll, billing, financial reconciliation, accounts payable, accounts receivable, project management, contract tracking, key management, utility billing, inventory control and management, procurement, purchasing, point of sale transaction management, accumulating, aggregating and analyzing financial and experiential data, generating communications not including or for call centers, marketing, scanning, records organization, management of payment processing, vacation rental management and billing, rentals reservations, small airport scheduling, small airport fuel sales, small airport takeoff/landing reservations, homeowner association billing, homeowners association member relationship management, front gate check in / check out, gate arm control, camera image capture, logging and organization by event; computer software for use in customer relationship management in clubs and hospitality based businesses, not including or for call centers; computer software for use in membership management, namely, software for use in creating and maintaining membership records; computer software for use in point of sale transaction management, namely,</p>

Mark/Number/Status	Registrant/Applicant	Class & Goods/Services
		operating software for point of sale terminals; computer software for club function management and operational management, namely, software for creating and maintaining employee and inventory records; computer software for use in warehousing and analyzing financial, billing, retail, business records, scheduling, communications and experiential data
ENCOMPASS Reg. No. 4714823 Registered	Toshiba America Business Solutions, Inc.	Class 009: Computer software, namely, software and programs in the field of quantitative and qualitative document management for businesses, specifically, software and programs for analyzing document imaging, document management and output device requirements to improve document management and output and to improve document functionality and reliability
ENCOMPASS Reg. No. 5182356 Registered	Ocean Reef Club Inc.	Class 009: Computer software for use in management of clubs and hospitality based businesses, namely, software for use in task management, scheduling, budgeting, payroll, billing, financial reconciliation, accounts payable, accounts receivable, project management, contract tracking, key management, utility billing, inventory control and management, procurement, purchasing, point of sale transaction management, accumulating, aggregating and analyzing financial and experiential data, generating communications not including or for call centers, marketing, scanning, records organization, management of payment processing, vacation rental management and billing, rentals reservations, small airport scheduling, small airport fuel sales, small airport takeoff/landing reservations, homeowner association billing, homeowners association member relationship management, front gate check in / check out, gate arm control, camera image capture, logging and organization by event; computer software for use in customer relationship management in clubs and hospitality based businesses, not including or for call centers; computer software for use in membership

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		management, namely, software for use in creating and maintaining membership records; computer software for use in point of sale transaction management, namely, operating software for point of sale terminals; computer software for club function management and operational management, namely, software for creating and maintaining employee and inventory records; computer software for use in warehousing and analyzing financial, billing, retail, business records, scheduling, communications and experiential data
360 ENCOMPASS Reg. No. 4305897 Registered	3M Company	Class 009: Computer software for use by hospitals and healthcare organizations for use in coding, calculating, analyzing, grouping and processing patient information for the purpose of healthcare billing and receiving government and insurance reimbursement
ENCOMPASS Reg. No. 4697944 Registered	Encompass Corporation Pty Ltd	Class 009: Computer programs for use as searching directories; downloadable computer programs for use as searching directories; computer software for use in aggregating data sets from internal and external sources; computer software programs for analyzing and displaying connections between people, property and assets; downloadable computer software for analyzing and displaying connections between people, property and assets; computer software for analyzing market information downloaded from the Internet; computer software for analyzing market information; computer software for processing market information; computer software programs for searching, reviewing and managing commercial data; computer software programs for aggregating information from a range of sources to provide users with a full and accurate picture of a company's or person's commercial circumstances; data processing software for graphic representations for corporate, credit, personal and property information; interactive computer software for analyzing and displaying connections between people, property and assets; none of the foregoing goods designed for use by

Mark/Number/Status	Registrant/Applicant	Class & Goods/Services
		hospitals or healthcare organizations or for use in relation to patient information or for billing or insurances purposes including receiving government and insurance reimbursement
<p>ENCOMPASS</p> <p>Reg. No. 4697929</p> <p>Registered</p>	<p>Encompass Corporation Pty Ltd</p>	<p>Class 009: Data compilations recorded on computer media, namely, corporate, person and property information; downloadable electronic data files and networks, databases, namely, corporate, person and property information, for use with computer software; downloadable databases in the field of corporate, personal and property information; electronic databases in the field of corporate, personal and property information recorded on computer media; computer programs for use as searching directories; downloadable software for use as searching directories; computer software for use in aggregating data sets from internal and external sources; computer software for analyzing and displaying connections between people, property and assets; computer software for analyzing market information downloaded from the Internet; computer software for analyzing market information; computer software for processing market information; data processing software for graphic representations for corporate, credit, personal and property information; none of the foregoing goods designed for use by hospitals or healthcare organizations</p>
<p>ENCOMPASS</p> <p>Reg. No. 4524116</p> <p>Registered, but cancelled on 12/11/2020 for failure to file a statement of use.</p>	<p>Ecolab USA Inc.</p>	<p>Class 009: Computer application software for mobile phones, portable media players, handheld computers, namely, software for wireless transfer of data; Computer software for providing an on-line database in the field of medical room transaction processing to upload transactional data, provide statistical analysis, and produce notifications and reports; Dispensers that count or measure output for use with cleaning and disinfecting products</p>
<p>ENCOMPASS</p> <p>Reg. No. 4092774</p> <p>Registered</p>	<p>PriceWaterhouseCoopers LLP</p>	<p>Class 009: Computer software for use in facilitating compliance in the fields of accounting, taxation, financial, legal and regulatory standards and requirements, but in each case excluding any use in the fields</p>

Mark/Number/Status	Registrant/Applicant	Class & Goods/Services
		or origination, compliance, and closing of residential and commercial loans and related services or loan processing and management in the fields of mortgage and commercial banking and real estate lending
ENCOMPASS Reg. No. 3500138 Registered	Krueger International, Inc.	Class 009: Computer software for design, engineering, drafting, and quote and order processing, for use in the office and institutional furniture industries
ENCOMPASS Reg. No. 2890448 Registered	Ellie Mae, Inc.	Class 009: Computer software for use in mortgage and commercial banking and lending in the real estate field
ENCOMPASS Reg. No. 3899171 Registered	Encompass Group, LLC	Class 009: software for laundry and inventory management of linens of healthcare facilities
ENCOMPASS Reg. No. 5477279 Registered	Para Systems, Inc.	Class 009: Electrical power supplies
ENCOMPASS MDX Reg. No. 4674626 Registered	Rheonix, Inc.	Class 009: Laboratory apparatus with electronic components for use in disease, genetic and pharmaceutical diagnostics and research analyzing molecular assays
ENCOMPASS Reg. No. 3382939 Registered	Amtech Systems, LLC	Class 009: MULTI-PROTOCOL RADIO FREQUENCY IDENTIFICATION READERS USED TO CONTROL ACCESS AND TO MONITOR AND MANAGE INFRASTRUCTURES, ASSETS AND PAYMENTS
LED DESTINATOR ENCOMPASS Reg. No. 5550932 Registered	Transign LLC	Class 009: Electronic signs; Electronic LED signs; Electronic transit information signs; Luminous variable/dynamic signs using light emitting diodes and electronic controllers to produce real-time and programmable messages and information displays

Certificates of Registrations and TSDR pages (for the applications) are annexed hereto collectively as Exhibit A. As can be seen above, numerous ENCOMPASS marks are allowed to

co-exist not only within the same class, but also within similar fields, so long as the ultimate function of the products differ (Compare Reg. Nos. 5944621, 4677218, 1775026, 6170113, 88140281, 5285681, 4714823, 5182356, 4305897, 4697944, 4524116, 3500138, and 4092774). Furthermore, with respect to other apparatus or hardware in Class 009, various ENCOMPASS marks are allowed to coexist (See Reg. Nos. 3382939, 4674626, 5477279, 5550932, 5944621). This is because ENCOMPASS is a weak mark, and surely if these marks can coexist within the same international class and field, other ENCOMPASS marks can coexist within the same class and field so long as the goods or services are sufficiently different. In the instance case, Applicant's goods are sufficiently distinct from those identified in the Cited Registration. Furthermore, such products, in addition to not being similar, are not even provided within the same industry (i.e., agricultural industry vs. the microelectronics industry).

It is a faulty analysis to conclude that the above listed registrations/applications identifying software products are distinct enough to permit these marks to co-exist on the Principal Register, but that Applicant's ENCOMPASS mark is regarded as too close to the Cited Registration to be registered even though the industries are in no way similar nor are the products themselves in any way confusingly similar (see Section B below). Applicant understands that "[p]revious decisions by examining attorneys in approving other marks are not binding on the agency or the Board," but the Examining Attorney has an obligation to consider this crowded field." TMEP 1207.01(d)(vi). The Trademark Manual of Examining Procedure clearly states: "If the examining attorney finds registrations that appear to be owned by more than one registrant, he or she should consider the extent to which dilution may indicate that there is no likelihood of confusion." TMEP § 1207.01(d)(x) (emphasis added). The sheer number of third-party registrations and allowed applications for similar marks used in Class 009, including within similar fields (software and hardware) is probative that the word ENCOMPASS is weak. It is in error to find that all the existing registrations for ENCOMPASS in the same field—all owned by

different parties—can coexist on the Principal Register, but that Applicant’s use of ENCOMPASS is somehow an outlier as compared to the large universe of ENCOMPASS registrations.

B. Applicant’s Goods are Unrelated to the Goods Set Forth in the Cited Registration

In support of the finding that the Applicant’s application and the Cited Registration are for similar goods, Examining Attorney notes that “applicant and registrant both identify control goods for use with irrigation and/or fluid dispensing systems.” However, this is not even an accurate comparison or analysis of each product description, and, is in fact an inaccurate statement unsupported by any evidence from Examining Attorney. This sole statement is insufficient to establish that the goods are related. Pursuant to TMEP §710.01, the examining attorney must always support his or her action with relevant evidence and ensure that proper citations to the evidence are made in the Office Action. All evidence that the examining attorney relies on in making a requirement or refusal must be placed in the record and copies must be sent to the applicant.

First, it is important to note that each of the products descriptions are clearly distinct from each other and are not even targeted within the same field/industry by operation of the product descriptions alone. It is erroneous to note that both parties identify goods for use with *irrigation and/or fluid dispensing systems*. The Cited Registration in no way identifies any product for use with irrigation equipment or systems. Applicant’s application in no way identifies any products targeted to the microelectronics industry relating to *pump controllers or fluid dispensing systems*, which is very distinct from *control, navigation, positioning, and communication equipment*. Each are both completely unrelated products that are each targeted at very different and distinct industries. Examining Attorney fails to acknowledge the clear language in each of the product descriptions that identify the narrow field each product is targeted. Compare the following:

- Applicant’s ENCOMPASS Application

- Class 009: Control, navigation, positioning and communication *equipment* relating to water applications systems, namely, *irrigation systems*, and consisting of valves, a control panel, control board, and antenna, *all in relation to the monitoring, operation, and control of irrigation equipment, electrical control panels* and *control boards* for use *with irrigation systems*.
- Cited Registration:
 - Class 009: *Pump controllers* for high viscosity *fluid dispensing systems* for use *in the microelectronics industry*.

Further, courts and the Board have repeatedly refused to find likelihood of confusion merely because both marks are used in the same broad field. See, e.g., Mejia and Assocs. v. Int'l Business Machines Corp., 920 F. Supp. 540, 548 (S.D.N.Y. 1996) (rejecting argument that likelihood of confusion existed because both parties provided " educational" services, explaining that "by increasing the level of generality, any [two] products can be made to appear to fall in the same class."); WWW Pharmaceutical Co., Inc. v. Gillette Co., 984 F.2d 567, 574 (2d Cir. 1993) (no likelihood of confusion between lip balm on the one hand and deodorant and antiperspirant on the other, notwithstanding the fact that all of the goods could be considered personal care products); Thane International Inc. v. Trek Bicycle Corp., 53 U.S.P.Q.2d 1523 (D.D.C. 1999) (no likelihood of confusion between similar marks as applied to defendant's bicycles and bicycle-related equipment and plaintiffs device, designed to simulate walking or jogging, despite the fact that both parties used their marks in connection with exercise equipment). In the instance case, the products identified in each registration are not even in the same field as highlighted above.

"[I]f 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." TMEP § 1207.01(a)(i). See, e.g., 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's services are not for nor do they relate to the microelectronics industry. "The facts in each case vary and the weight to be given each relevant *du Pont* factor may be different in light of the varying circumstances; therefore, there can be no rule that certain goods or services are per se related, such that there must be a likelihood of confusion from the use of similar marks in relation thereto. TMEP § 1207.01(a)(iv). See, e.g., *Info. Res. Inc. v. X*Press Info. Servs.*, 6 USPQ2d 1034, 1038 (TTAB 1988) (regarding computer hardware and software). See also *M2 Software, Inc. v. M2 Commc'ns, Inc.*, 450 F.3d 1378, 1383, 78 USPQ2d 1944, 1947-48 (Fed. Cir. 2006) (noting that relatedness between software-related goods may not be presumed merely because the goods are delivered in the same media format and that, instead, a subject-matter-based mode of analysis is appropriate). See, e.g., *Elec.Data Sys. Corp. v. Edsa Micro Corp.*, 23 USPQ2d 1460, 1463 (TTAB 1992) ("[T]he fact that both parties provide computer programs does not establish a relationship between the goods or services, such that consumers would believe that all computer software programs emanate from the same source simply because they are sold under similar marks.")

The goods as applied for by Applicant are for control, navigation, positioning and communication equipment, including electrical control panels and control boards in the field of irrigation. Contrastingly, the description of goods as set forth in the Cited Registration are designed for use in the microelectronics industry and wholly unrelated to the products identified by Applicant. These are very different industries. Further, a pump controller is in no way similar to hardware that is utilized to move massive pieces of irrigation equipment across acres of agricultural fields. On this evidence alone the Examining Attorney should withdraw the refusal of the applied-for mark on the basis of the Cited Registration potentially being confusingly similar to Applicant's Mark.

C. The Relevant Purchasers of Applicant's Goods, and Those of the Cited Registration, are Different

The purchasers of the Applicant's goods and the registrant's goods would not even remotely be the same. The needs of consumers within the microelectronics industry are starkly different than the needs of individuals and organizations seeking irrigation solutions. Regarding the Cited Registration, persons seeking pump controllers for their fluid dispensing systems for use in the microelectronics industry are typically individuals in advanced industrial and manufacturing environments. On the other hand, Applicant's customers will primarily consist of farmers and ranchers and others who need to sustain crops via irrigation systems, such as irrigation lines. "[T]he identity of the marks alone is not sufficient to establish likelihood of confusion in the absence of probative evidence that the goods are related. If that were the case, then the Registrant would have rights in gross, and that is against the principles of trademark law." *In re Thor Tech, Inc.*, 113 USPQ2d 1546, 1547 (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). "In every case turning on likelihood of confusion, it is the duty of the examiner, the board and this court to find, upon consideration of all the evidence, whether or not confusion appears likely." *In re Thor Tech, Inc.*, 113 USPQ2d at 1547 (citing Electronic Design & Sales Inc. v. Electronic Data Systems Corp., 954 F.2d 713, 21 USPQ2d 1388, 1392 (Fed. Cir. 1992), quoting *In re E. I. du Pont de Nemours & Co.*, 177 USPQ at 568). Here, the goods are not even related.

For all of these reasons, Applicant respectfully requests that the Examining Attorney approve the subject application for publication.