

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Carrier Enterprise, LLC
Serial No.: 85/268,658
Filed: March 16, 2011
Mark: TECHFLEX (Stylized Design)
Int. Class: 006, 019
Examining Attorney: Tina H. Mai
Law Office: 108
Attorney Docket No.: 31915.0042

RESPONSE TO OFFICE ACTION

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

Dear Ms. Mai:

In response to the Office Action mailed June 16, 2011, the Applicant hereby submits the following amendment, remarks and request for reconsideration.

REMARKS

The Applicant responds to the pending Office Action, has amended the pending application and respectfully traverses the Examining Attorney's rejection based on the statements below and seeks reconsideration and allowance.

SECTION 2(d) REFUSAL – LIKELIHOOD OF CONFUSION

In the pending Office Action, the Examining Attorney alleged that there may be a likelihood of confusion between Applicant's mark, Serial No. 85/268,658 (TECHFLEX) (“**Applicant's Mark**”) and prior U.S. Trademark Registration No. 3665791 (“**Cited Mark**”). The Applicant respectfully disagrees with the rejection. Applicant's Mark should proceed to registration because, based on the weakness of the Cited Mark, the distinction in goods sold under the marks, the difference in marketing channels, the sophistication of the likely consumers and the appearance of Applicant's Mark, there is no likelihood of confusion between Applicant's Mark and the Cited Mark.

In determining whether there exists a likelihood of confusion, a test was constructed by the relevant appellate court. *In re E. I. DuPont de Nemours & Co.*, 476 F.2d 1357 (CCPA 1973). The *DuPont* factors are the factors used by the Federal Circuit to determine whether two trademarks are likely to be confused in the relevant market. However, not all of the factors are necessarily relevant or of equal weight and any one factor may be dominant in a given case, depending on the evidence of record. *See In re Majestic Distilling Co.*, 315 F.3d 1311, 1315

(Fed. Cir. 2003). Depending on the case, each of the factors may play a dominant role. *DuPont*, 476 F.2d at 1361. Thus, in a particular case, a single *DuPont* factor may be dispositive. *Kellogg Co. v. Pack'em Enterprises Inc.*, 951 F.2d 330 (Fed. Cir. 1991). The Examining Attorney has noted that, in this case, the most relevant factors are the similarity of the marks and the relatedness of the goods and/or services. Applicant respectfully submits that an analysis of these factors leads to the conclusion that no confusion will result between Applicant's Mark and the Cited Mark.

Crowded Field and Lack of Distinction

The scope of trademark protection given to a mark depends on the strength of the mark; strong marks, which are inherently distinctive, receive greater protection than weak marks, such as a descriptor. *AMF Inc. v. Sleekcraft Boats*, 599 F.2d 341 (9th Cir. 1979). This is so because a strong mark is "inherently distinctive." Distinctiveness is determined both by the relatedness of the mark to the product or service being offered under the mark, as well as by the number of similar marks for similar products. It is well-settled that a mark lacks strength and distinctiveness where there is a crowded field. *Puma-Sportschuhfabriken Rudolf Dassler R.G. v. Super S.P.*, 210 USPQ 316, (TTAB 1980); *In re Broadway Chicken, Inc.*, 38 USPQ2d 1559 (TTAB 1996). In the present case, numerous registrations incorporating only formatives of "TECH" and "FLEX" reveal the weakness of the Cited Mark. The crowded field for the terms in the Applicant's Mark suggests that there is room for another mark in the field as well as in International Classes 006 and 019. Composite *Annex I* provides copies of the relevant registrations and **Table 1** shows examples of such marks:

Table 1:

MARK	REGISTRATION	DESCRIPTION
TECHFLEX (CITED MARK)	3665791	(INT. CL. 09) DUCTING FOR ELECTRIC CABLES; SHEATHS FOR ELECTRIC CABLES
TECHFLEX	3215800	(INT. CL. 07) BELTS FOR CONVEYORS
TEKFLEX	2782200	(INT. CL 019) CEMENTITIOUS WALL AND ROOF COATINGS FOR USE IN THE MINING INDUSTRY
TECH-FLEX	2957105	(INT. CL. 09) SPECTACLES, GLASSES, SUNGLASSES, OPTICAL LENSES, AND SPECTACLE FRAMES
	3184800	(INT. CL. 12) MOLDINGS FOR VEHICLE GLASS
TEK FLEX	3185326	(INT. CL. 25) HEADWEAR, NAMELY, BASEBALL HATS, CAPS, VISORS AND FASHION HATS
TECHFLEX	2434977	(INT. CL. 36) PROPERTY INSURANCE UNDERWRITING SERVICES FOR TECHNOLOGY COMPANIES
TECHNO FLEX	2421471	(INT. CL. 12) SEAT COVERS FOR MOTORCYCLES
TECH-X FLEX	3674159	(INT. CL. 09) ELECTRICAL TESTING EQUIPMENT
FLEX-TECH	3006842	(INT. CL. 17) FLEXIBLE HOSE AND TUBING PRIMARILY MADE FROM PLASTIC, FOR USE IN PRESSURIZED AIR AND GAS SYSTEMS
FLEXTECH	3314141	(INT. CL. 13) GUN STOCKS

FLEXTECH	3197096	(INT. CL. 09) INDUSTRIAL WORK GLOVES
FLEXTECH	2347939	(INT. CL. 09) COMPUTER FURNITURE
FLEX-TEC	3119009	(INT. CL. 001) FLUID CATALYTIC CRACKING CATALYST
FLEXTEC	3654923	(INT. CL. 17) FLEXIBLE IRRIGATION PIPES
	2907112	(INT. CL. 016) DISPOSABLE WIPES NOT IMPREGNATED WITH CHEMICALS OR COMPOUNDS FOR CLEANING PRINTING MACHINES
FLEXTECH	3796940	(INT. CL. 016) PAPER TOWELS
FLEXTEC	3352572	(INT. CL. 01) CHEMICALS

Such a crowded field reveals the weakness of the Cited Mark. Further, the fact that registrations are found in several classes belies any argument that goods having the same mark in different classes may nonetheless be related. Also, transposing “FLEX” and “TECH” does not diminish the crowded field. Where the primary difference between marks is the transposition of the elements that compose the marks there may be a potential for likelihood of confusion. *In re Wine Society of America Inc.*, 12 USPQ2d 1139 (TTAB 1989) (THE WINE SOCIETY OF AMERICA and design, for "wine club membership services including the supplying of printed materials, sale of wines to members, conducting wine tasting sessions and recommending specific restaurants offering wines sold by applicant," held likely to be confused with AMERICAN WINE SOCIETY 1967 and design, for a newsletter, bulletin and journal of interest to members of the registrant); *In re Nationwide Industries Inc.*, 6 USPQ2d 1882 (TTAB 1988) (RUST BUSTER for rust-penetrating spray lubricant held likely to be confused with BUST

RUST for penetrating oil). Thus, the registrations listed above having TECH FLEX elements transposed provide additional evidence of the weakness of the Cited Mark.

Accordingly, the Cited Mark is afforded weak protection and thus even slight differences in the goods associated with the mark should permit registration. Given the differences in the goods, and the differences in the usage of the Marks, the Applicant's Mark should be allowed.

Differences in the Usage of the Marks

The Examining Attorney must analyze each case to determine whether there is a likelihood of confusion. Because the Applicant's Mark and the Cited Mark are identical, the key inquiry as to whether there is a likelihood of confusion involves determining whether the goods are related and whether the public will be confused as to their source. TMEP § 1207.01(a)(i), citing *Safety-Kleen Corp. v. Dresser Indus., Inc.*, 518 F.2d 1399 (C.C.P.A. 1975). The Examining Attorney must compare the goods or services to determine if they are related or if the activities surrounding their marketing are such that confusion as to origin is likely. *In re August Storck KG*, 218 USPQ 823 (TTAB 1983); *In re International Telephone and Telegraph Corp.*, 197 USPQ 910 (TTAB 1978); *Guardian Products Co., v. Scott Paper Co.*, 200 USPQ 738 (TTAB 1978).

Even where two marks are identical, courts hold that there is no likelihood of confusion "if the goods or services in question are not related 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." TMEP § 1207.01(a)(i), citing *Shen Mfg. Co. v. Ritz Hotel Ltd.*, 393 F.3d

1238 (Fed. Cir. 2004) (holding that cooking classes and kitchen textiles not related). To demonstrate that goods are related, it is not sufficient that a particular term may be found which may broadly describe the goods. *In re The W.W. Henry Co., L.P.*, 82 USPQ 2d 1213 (TTAB 2007).

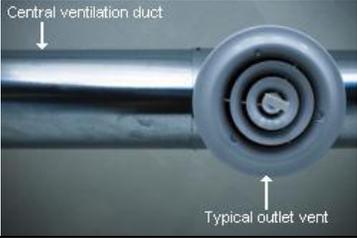
The goods in the present case are different, serve different purposes and are not complementary. Applicant's goods include metal ducts for heating and ventilating installations in International Class 006 and non-metal ventilating ducts in International Class 019. Applicant markets these products for heating, cooling and refrigeration applications. *Annex 2*, <www.carrierenterprise.com/about-ce.aspx>. The goods identified with the Cited Mark include sleeving and ducts for electric cables in International Class 009. The products associated with the Cited Mark are used for the management and protection of wires, cables and hoses. *Annex 3*.

"Ducts" are defined as "a pipe or tubular runway for carrying an electric power line, telephone cables, or other conductors." *Annex 4*, <www.merriam-webster.com/dictionary/duct>. "Ducts are also defined as "a pipe or tube in a building that carries something such as air or protect wires." *Annex 5*, <www.macmillandictionary.com/thesaurus/american/duct#duct_4>. Electrical ducts or conduit used for protection and routing of electrical wiring. Electrical conduit may be made of metal, plastic, fiber, or fired clay. *Annex 6*, <http://en.wikipedia.org/wiki/Electrical_conduit>. Conduit is generally installed by electricians at the site of installation of electrical equipment. The form, and installation details of electrical ducts are often specified by wiring regulations. *Annex 6*.

Conversely, ventilation ducts are used to remove unpleasant smells and excessive moisture, introduce outside air into a structure, to keep interior building air circulating, and to prevent stagnation of the interior air. *Annex 7*, <[http://en.wikipedia.org/wiki/Duct_\(HVAC\)](http://en.wikipedia.org/wiki/Duct_(HVAC))>. Moreover, ducts used for ventilation, heating and air-conditioning are identified with International Class 006 (metal) or International Class 019 (non-metal). *Annex 8*. Electrical ducts are classified in International Class 009. Thus, ducts used for ventilation installations are entirely different than sleeving products used for electrical systems.

As such, the Applicant's Mark and the Cited Mark are set apart by their diverse functions and different International Class, not by the term "duct" used in their identification. Since the goods of the respective parties serve distinct and unrelated functions, consumer confusion is unlikely. Electrical sleeving and ducting is designed to be in close contact with the wiring within. It is intended to protect electrical wiring from corrosion, puncture and other external threats. Conversely, ducts used for ventilation, heating and air-conditioning are designed to facilitate the flow of air within the ducts. Thus, the two types of goods function in very different ways to serve their very different functions. To help illustrate the differences between the products associated with the marks, **Table 2** is provided to show examples of differences between Applicant's ventilation ducts and the ducts identified with the Cited Mark.

Table 2

VENTILATION DUCTS	ELECTRICAL SLEEVING
 <p>UV-Inhibited Black Jacket</p> <p>VIEW DETAILS</p>	
 <p>Agion® Coated Flex</p> <p>VIEW DETAILS</p>	
 <p>Heavy Duty Mobile Home Flex</p> <p>VIEW DETAILS</p>	
HVAC DUCTS	ELECTRICAL CONDUIT
 <p>Central ventilation duct</p> <p>Typical outlet vent</p>	
	

Different Channels of Trade

In addition, the goods associated with the respective marks are marketed to different consumers and travel in different channels of trade. The Applicant distributes top brands of HVAC equipment, as well as a full-line of aftermarket parts, supplies, and accessories through its own website, at its own trade show displays for HVAC professionals and through various HVAC suppliers. *Annex 9*. By contrast, the goods associated with the Cited Mark are specifically marketed on its own website directly to electricians and professionals in the electrical contracting industry through various electrical supply houses. *See Annex 10*, <www.techflex.com/ondlrs.asp>.

As the differences in the respective product offerings would suggest, the Applicant and Registrant market their products to very different marketplaces in distinct channels of trade. Moreover, given these differences, it is highly unlikely that Applicant's and Registrant's respective product would be encountered by the same purchasers or under circumstances that could give rise to the mistaken belief that those goods came from a common source. The availability of information about the parties' goods and services on the Internet does not automatically lead to the conclusion that they use common marketing channels. *Therma-Scan, Inc. v. Thermoscan, Inc.*, 295 F.3d 623 (6th Cir. 2002). Thus, because the respective goods target different groups of purchasers and are marketed through different channels of trade, there is no likelihood of confusion between the marks.

The potential likelihood of confusion is further reduced where consumers of the products offered under each mark are necessarily sophisticated and would not likely be confused. *See*

Electronic Design & Sales, Inc. v. Electronic Data Systems Corp., 954 F.2d 713, 718 (Fed. Cir. 1992) (no confusion between identical marks where, *inter alia*, both parties' goods and services "are usually purchased after careful consideration by persons who are highly knowledgeable about the goods or services and their source."). Where potential purchasers are highly educated and knowledgeable about a particular industry, this factor weighs against a finding of likelihood of confusion. *See, e.g., Evolutions Healthcare Systems, Inc. v. Evolution Benefits, Inc.*, (TTAB Opp. No. 91158602, July 12, 2007) (opposition dismissed where, under *DuPont* factor analysis, potential customers were "highly sophisticated and knowledgeable about the employee benefits industry" and therefore not likely to be confused). In this case, Applicant's likely potential purchasers consist of the sophisticated group of licensed mechanical contractors who are highly knowledgeable about HVAC equipment and installations. **Annex 2**. On the other hand, Registrant engineers and manufactures a wide range of products for wire, hose and cable bundling protection solutions. **Annex II**. Consequently, both the Applicant and the Registrant market their products to very different sophisticated customers, significantly reducing any risk of likelihood of confusion.

Similarity of the Marks

In a likelihood of confusion determination, the marks are compared for similarities in their appearance, sound, meaning or connotation and commercial impression. *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361 (C.C.P.A. 1973); TMEP §1207.01(b). It has long been recognized that marks must be compared in their entirety because likelihood of confusion depends on the overall impression of the marks. "In determining the similarity or dissimilarity of

marks, we must consider the marks in their entireties in terms of sound, appearance, meaning and commercial impression. *See Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin*, 396 F.3d 1369 (Fed. Cir. 2005). The Cited Mark contains the word "TECHFLEX" with no design. The Applicant's Mark consists of the stylized phrase "TECHFLEX" with a dashed line between the letter "T" and "h":

TechFlex

The dashed line is of a height so that the higher letters in the mark (the T, h, F and l) draw the eye of the observer, creating a unique commercial impression that would not be present in a pure word mark. Accordingly, the Cited Mark differs in its commercial impression from Applicant's Mark.

CONCLUSION

For all of the above reasons, the Applicant respectfully submits that the application is presently in condition for allowance, and reconsideration and allowance thereof is respectfully requested. The Trademark Examining Attorney is encouraged to contact the undersigned attorney to discuss any matter that would clarify this submission, and expedite allowance of the application.

INFORMALITIES

Identification of Goods

To further distinguish the Applicant's Mark from the Cited Mark, the Applicant requests that the Examining Attorney substitute the identification of goods as follows:

"Heating ventilation and air conditioning ducts of metal for ventilating installations" in International Class 006.

"Non-metal heating ventilation and air conditioning ducts" in International Class 019.

Respectfully submitted,

/joseph r. englander/

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