

From: Lott, Maureen D.

Sent: 8/7/2014 6:41:10 PM

To: TTAB E Filing

CC:

Subject: U.S. TRADEMARK APPLICATION NO. 85849482 - DRIVETEK - 1075.006 - Request for
Reconsideration Denied - Return to TTAB

Attachment Information:

Count: 4

Files: 79092436P001OF003.JPG, 79092436P002OF003.JPG, 79092436P003OF003.JPG, 85849482.doc

**UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)
OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION**

U.S. APPLICATION SERIAL NO. 85849482 MARK: DRIVETEK	
CORRESPONDENT ADDRESS: SUNISHA S. CHOKSI LAW OFFICE OF SUNISHA S. CHOKSI 123 N. POST OAK LANE, SUITE 405 HOUSTON, TX 77024	GENERAL TRADEMARK INFORMATION: http://www.uspto.gov/trademarks/index.jsp VIEW YOUR APPLICATION FILE
APPLICANT: PumpTek Asia Limited	
CORRESPONDENT'S REFERENCE/DOCKET NO: 1075.006 CORRESPONDENT E-MAIL ADDRESS: trademarks@choksilaw.com	

REQUEST FOR RECONSIDERATION DENIED

ISSUE/MAILING DATE: 8/7/2014

The trademark examining attorney has carefully reviewed applicant's request for reconsideration and is denying the request for the reasons stated below. See 37 C.F.R. §2.64(b); TMEP §§715.03(a)(2)(B), (a)(2)(E), 715.04(a). The requirement(s) and/or refusal(s) made final in the Office action dated January 8, 2014 are maintained and continue to be final. See TMEP §§715.03(a)(2)(B), (a)(2)(E), 715.04(a).

In the present case, applicant's request has not resolved all the outstanding issue(s), nor does it raise a new issue or provide any new or compelling evidence with regard to the outstanding issue(s) in the final Office action. In addition, applicant's analysis and arguments are not persuasive nor do they shed new light on the issues. Accordingly, the request is denied.

The filing of a request for reconsideration does not extend the time for filing a proper response to a final Office action or an appeal with the Trademark Trial and Appeal Board (Board), which runs from the date the final Office action was issued/mailed. See 37 C.F.R. §2.64(b); TMEP §715.03, (a)(2)(B), (a)(2)(E), (c).

If time remains in the six-month response period to the final Office action, applicant has the remainder of the response period to comply with and/or overcome any outstanding final requirement(s) and/or refusal(s) and/or to file an appeal with the Board. TMEP §715.03(a)(2)(B), (c). However, if applicant has already filed a timely notice of appeal with the Board, the Board will be notified to resume the appeal. See TMEP §715.04(a).

The final refusals are addressed again below.

Refusal Under Section 2(d) Based on a Likelihood of Confusion

Registration of the applied-for mark is refused because of a likelihood of confusion with the mark(s) in U.S. Registration No(s). 4040389. Trademark Act Section 2(d), 15 U.S.C. §1052(d); see TMEP §§1207.01 *et seq.* See the enclosed registration(s).

Trademark Act Section 2(d) bars registration of an applied-for mark that so resembles a registered mark that it is likely a potential consumer would be confused, mistaken, or deceived as to the source of the goods and/or services of the applicant and registrant. See 15 U.S.C. §1052(d). A determination of likelihood of confusion under Section 2(d) is made on a case-by case basis and the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973) aid in this determination. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d 1344, 1349, 98 USPQ2d 1253, 1256

(Fed. Cir. 2011) (citing *On-Line Careline, Inc. v. Am. Online, Inc.*, 229 F.3d 1080, 1085, 56 USPQ2d 1471, 1474 (Fed. Cir. 2000)). Not all the *du Pont* factors, however, are necessarily relevant or of equal weight, and any one of the factors may control in a given case, depending upon the evidence of record. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d at 1355, 98 USPQ2d at 1260; *In re Majestic Distilling Co.*, 315 F.3d 1311, 1315, 65 USPQ2d 1201, 1204 (Fed. Cir. 2003); see *In re E. I. du Pont de Nemours & Co.*, 476 F.2d at 1361-62, 177 USPQ at 567.

In this case, the following factors are the most relevant: similarity of the marks, similarity and nature of the goods and/or services, and similarity of the trade channels of the goods and/or services. See *In re Viterra Inc.*, 671 F.3d 1358, 1361-62, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *In re Dakin's Miniatures Inc.*, 59 USPQ2d 1593, 1595-96 (TTAB 1999); TMEP §§1207.01 *et seq.*

Marks are Similar

Applicant's mark is "DRIVETEK." Registrant's mark is "VULKAN DRIVE TECH" (stylized). Significantly, "DRIVE TECH" is a large portion of registrant's mark, and "DRIVETEK" is the entirety of applicant's mark. Because "DRIVE" and "TECH" or its misspelling are the entirety of or a large portion of the marks, the marks, as a whole, appear and sound similar. They also create similar commercial impressions with each referring to drive-related equipment/technology (please see the definitions for "drive" and "tech" attached to the final Office action).

Moreover, applicant's mark is in standard characters. A mark in typed or standard characters may be displayed in any lettering style; the rights reside in the wording or other literal element and not in any particular display or rendition. See *In re Viterra Inc.*, 671 F.3d 1358, 1363, 101 USPQ2d 1905, 1909 (Fed. Cir. 2012); *In re Mighty Leaf Tea*, 601 F.3d 1342, 1348, 94 USPQ2d 1257, 1260 (Fed. Cir. 2010); 37 C.F.R. §2.52(a); TMEP §1207.01(c)(iii). Thus, it is presumed that applicant's mark may be displayed in the same font and style as registrant's mark is.

In light of the foregoing, it is likely that consumers would be confused as to the origin of applicant's goods and/or services.

Goods and/or Services are Related

The goods and/or services of the parties need not be identical or even competitive to find a likelihood of confusion. See *On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 1086, 56 USPQ2d 1471, 1475 (Fed. Cir. 2000); *Recot, Inc. v. Becton*, 214 F.3d 1322, 1329, 54 USPQ2d 1894, 1898 (Fed. Cir. 2000) (“[E]ven if the goods in question are different from, and thus not related to, one another in kind, the same goods can be related in the mind of the consuming public as to the origin of the goods.”); TMEP §1207.01(a)(i).

The respective goods and/or services need only be “related in some manner and/or if the circumstances surrounding their marketing [be] such that they could give rise to the mistaken belief that [the goods and/or services] emanate from the same source.” *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1369, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012) (quoting *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1724 (TTAB 2007)); *Gen. Mills Inc. v. Fage Dairy Processing Indus. SA*, 100 USPQ2d 1584, 1597 (TTAB 2011); TMEP §1207.01(a)(i).

Here, applicant’s goods are variable speed drives for use with fluid pumping systems in oil and gas exploration, drilling and production. The goods in Registration No. 4040389 include machine couplings and transmission components except for land vehicles; machine couplings other than for land vehicles; machine couplings, except for land vehicles; clutches for machines and other than for land vehicles; brake parts, other than for land vehicles, namely, brake units and brake pads.

With respect to applicant’s and registrant’s goods and/or services, the question of likelihood of confusion is determined based on the description of the goods and/or services stated in the application and registration at issue, not on extrinsic evidence of actual use. See, e.g., *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1369-70, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012); *Octocom Sys. Inc. v. Hous. Computers Servs. Inc.*, 918 F.2d 937, 942, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990).

Absent restrictions in an application and/or registration, the identified goods and/or services are “presumed to travel in the same channels of trade to the same class of purchasers.” *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (quoting *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1268, 62 USPQ2d 1001, 1005 (Fed. Cir. 2002)). Additionally, unrestricted and broad identifications are presumed to encompass all goods and/or services of the type described. See *In re Jump Designs, LLC*, 80 USPQ2d 1370, 1374 (TTAB 2006) (citing *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981)); *In re Linkvest S.A.*, 24 USPQ2d 1716, 1716 (TTAB 1992).

In this case, the identification set forth in the registration has no restrictions as to nature, type, channels of trade, or classes of purchasers. Therefore, it is presumed that these goods travel in all normal

channels of trade and are available to the same class of purchasers as are applicant's goods. **Further, it is specifically presumed that registrant's goods also are for use with fluid pumping systems and for use in oil and gas exploration, drilling and production.**

The Internet evidence attached to the final Office action establishes that the same entity commonly provide both variable speed drives as well as couplings or clutches for the same machinery. Moreover, it establishes that such goods are commonly provided in the same trade channels and often under the same mark. Therefore, applicant's and registrant's goods and/or services are considered related for likelihood of confusion purposes. *See, e.g., In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1202-04 (TTAB 2009); *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266, 1268-69, 1271-72 (TTAB 2009).

Evidence obtained from the Internet may be used to support a determination under Trademark Act Section 2(d) that goods and/or services are related. *See, e.g., In re G.B.I. Tile & Stone, Inc.*, 92 USPQ2d 1366, 1371 (TTAB 2009); *In re Paper Doll Promotions, Inc.*, 84 USPQ2d 1660, 1668 (TTAB 2007).

The trademark examining attorney also attached to the final Office action evidence from the USPTO's X-Search database consisting of a number of third-party marks registered for use in connection with the same or similar goods and/or services as those of both applicant and registrant in this case. This evidence shows that the goods and/or services listed therein are of a kind that may emanate from a single source under a single mark. *See In re Anderson*, 101 USPQ2d 1912, 1919 (TTAB 2012); *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993); *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988); TMEP §1207.01(d)(iii).

Applicant's Argument

Applicant argues that there is no likelihood of confusion because the coexistence of many "drive" formative marks and the "tek" or "tech" formative marks for a wide variety of goods and services has diluted the Register. Applicant concludes that even small distinctions between such marks are, therefore, sufficient to avoid a likelihood of confusion. Applicant particularly notes the following:

- There are over 2,380 active registrations and applications on the Register containing the term "drive", and over 300 active records in Class 07 containing the term "drive".

- There are over 640 active registrations and applications on the Register containing the term “tek”, and over 35 active records in Class 07 containing the term “tek”.
- There are over 7,351 active registrations and applications on the Register containing the term “tech”, and over 530 active records in Class 07 containing the term “tech”.

Applicant also provided copies of some registration information for registered marks consisting, in part of the term “DRIVE” or the term “TECH” and used in connection with speed drives.

The examining attorney appreciates the argument, but finds it unpersuasive for the following reasons.

1. Applicant has not made of record the registration information for most of the registered marks that it refers to. Only the registrations for which applicant has provided copies of the registration information can be considered. To make registrations of record, copies of the registrations or the complete electronic equivalent (i.e., complete printouts taken from any of the USPTO’s automated systems (X-Search, TESS, TSDR, or TRAM)) must be submitted. *In re Ruffin Gaming LLC*, 66 USPQ2d 1924, 1925 n.3 (TTAB 2002); *In re Volvo Cars of N. Am. Inc.*, 46 USPQ2d 1455, 1456 n.2 (TTAB 1998); *In re Broadway Chicken Inc.*, 38 USPQ2d 1559, 1561 n.6 (TTAB 1996); *In re Smith & Mehaffey*, 31 USPQ2d 1531, 1532 n.3 (TTAB 1994). TMEP §710.03.
2. Even assuming *arguendo* that applicant has provided evidence that “tech” or “tek” and “drive” are weak individually, the marks at issue here have two common words therein – not just one. Both applicant’s mark and registrant’s mark contain “drive” and “tek” or “tech.” Applicant has not provided evidence that marks containing both terms are weak or diluted in connection with goods of the type listed in the application and registration.
3. Even assuming *arguendo* that marks with “drive” or “tech” (or its misspelling) are weak in connection with the relevant goods, the Court of Appeals for the Federal Circuit and the Trademark Trial and Appeal Board have recognized that marks deemed “weak” or merely descriptive are still entitled to protection against the registration by a subsequent user of a similar mark for closely related goods and/or services. *In re Colonial Stores, Inc.*, 216 USPQ 793, 795 (TTAB 1982); TMEP §1207.01(b)(ix); *see King Candy Co. v. Eunice King’s Kitchen, Inc.*, 496 F.2d 1400, 1401, 182 USPQ 108, 109 (C.C.P.A. 1974). This protection extends to marks registered on the Supplemental Register. TMEP §1207.01(b)(ix); *see, e.g., In re Clorox Co.*, 578 F.2d 305, 307-08, 198 USPQ 337, 340 (C.C.P.A. 1978); *In re Hunke & Jochheim*, 185 USPQ 188 (TTAB 1975). The evidence of record in this case establishes that the goods are, in fact, closely related.

Doubt is Resolved in Favor of Registrant

The overriding concern is not only to prevent buyer confusion as to the source of the goods and/or services, but to protect the registrant from adverse commercial impact due to use of a similar mark by a newcomer. See *In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993). Therefore, any doubt regarding a likelihood of confusion determination is resolved in favor of the registrant. TMEP §1207.01(d)(i); see *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1265, 62 USPQ2d 1001, 1003 (Fed. Cir. 2002); *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 464-65, 6 USPQ2d 1025, 1026 (Fed. Cir. 1988).

Based on the foregoing, the final refusal of registration under Trademark Act Section 2(d) is continued.

Refusal under Section 2(e)(1)

It is noted that applicant did not address the refusal under Section 2(e)(1). It is, therefore, continued for the reasons set forth in the final Office action.

Please do not hesitate to contact the undersigned with any questions.

/MaureenDallLott/

Maureen Dall Lott

Trademark Examining Attorney, Law Office 105

United States Patent and Trademark Office

571-272-9714

maureen.lott@uspto.gov