

ESTTA Tracking number: **ESTTA662365**

Filing date: **03/20/2015**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	85964505
Applicant	Littelfuse, Inc.
Applied for Mark	ENGINEERED TO PERFORM. BUILT TO LAST.
Correspondence Address	Michael E. Hall Kacvinsky Daisak Bluni PLLC 3120 Princeton Pike, Suite 303 Lawrenceville, NJ 08648 UNITED STATES mhall@kdbfirm.com, cseaton@kdbfirm.com, kddocketing@cpaglobal.com
Submission	Appeal Brief
Attachments	Applicant's Appeal Brief.pdf(160593 bytes)
Filer's Name	Michael E. Hall
Filer's e-mail	mhall@kdbfirm.com, cseaton@kdbfirm.com, kddocketing@cpaglobal.com
Signature	/Michael E. Hall/
Date	03/20/2015

relays, ground fault relays, arc flash relays, feeder protection relays, custom key pads, variable frequency drives; portable power cable couplers for use in underground and aboveground mining; electronic controls for motors and custom-built switchgear for use in the mining industry, oil and gas industry, and other industrial applications; electric generator controls and electrical equipment consisting of neutral grounding resistor and electric monitoring relays for use in the mining industry, oil and gas industry, and other industrial applications; electric relays, namely, motor protection relays, ground fault relays, arc flash relays, feeder protection relays, pump protection relays, timers, flashers, power and voltage monitors, pump controllers, liquid level and load sensors, and current transformers, all for use in the mining industry, oil and gas industry, and other industrial applications

The Examining Attorney has issued a final requirement that Applicant amend the **bolded** wording above in Class 9, on the ground that it is indefinite and overly broad.

The Examining Attorney has also issued a final refusal under Section 2(d) with respect to the Class 9 goods only. Thus, there is no refusal or requirement that pertains to the Class 7 goods, and this appeal relates only to the Class 9 goods.

II. Identification of Goods

The Examining Attorney has issued a final requirement that Applicant amend the wording “prefabricated modular buildings and e-houses sold as a housing component of custom-designed, medium- and low-voltage electrical equipment for use in the mining industry, oil and gas industry, and other industrial applications for electrical distribution, protection, and control” in Class 9, on the ground this wording is indefinite and overly broad.

Applicant respectfully submits that the wording is sufficiently definite and properly classified. Indeed, this *exact* wording was suggested to the undersigned by Ms. Jennifer Chicoski, the Office’s Administrator for Trademark Identification, Classification

and Practice, in an email dated September 26, 2014. If the Examining Attorney would like to see that email, he is respectfully requested to make his wishes known in his appeal brief and Applicant will gladly submit the email with its reply brief. Accordingly, Applicant respectfully requests that the Examining Attorney's requirement be reversed.

III. Likelihood-of-Confusion Refusal Under Section 2(d)

The Examining Attorney has also issued a refusal under Section 2(d), on the ground that there is purportedly a likelihood of confusion with the registered mark ENGINEERED TO ORDER. BUILT TO LAST. for the following goods¹:

Class 9

Power cable terminations and joints, namely, pre-molded terminations and joints for use on dielectric cable systems; cable splice boxes; splicing kits primarily comprised of lead sleeve, Novoid compound, dry cotton tape, saturated flax twine, solder, stearine candle, varnished cambric tapes, paper pasters, tinned shielding braid, split tinned solder copper connectors, saturated webbing and compression connectors; SF6 electric circuit switches; solid dielectric switches; vacuum switches, namely, switches and switch gears used in transmission and distribution of electrical power; automatic transfer switches for use in connection with electrical distribution and transmission systems; current limiting protectors; single and three phase reclosers, namely, electric circuit closers to reclose interrupted high voltage electrical circuits; and microprocessor-based power management systems comprised of power distribution switchgear with protective electric relays for controlling automatic switching operations in overhead and underground loop distribution circuits

A. Relevant Prosecution History

On August 28, 2013, the Examining Attorney issued the first Office Action, which noted the existence of a prior-pending application (that would later mature into the cited registration) and required an amendment to the identification.

¹ Registration No. 4,433,118, registered November 12, 2013.

On February 28, 2014, Applicant submitted a response that offered a few remarks regarding the prior-pending application and amended the identification.

On March 17, 2014, the prior-pending application having registered in the interim, the Examining Attorney issued the present refusal under Section 2(d). The Examining Attorney opined that the parties' goods "are related in that they are all electrical goods used in the distribution and controlling of electrical power." Further, he pointed out that certain words, devoid of context, appeared in both Applicant's goods and Registrant's goods. The Examining Attorney did not attach any evidence to the Office Action.

On September 15, 2014, Applicant submitted a response pointing out that the Examining Attorney's explanation of relatedness was flawed because "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 W.W. Henry Co.*, 82 U.S.P.Q.2d 1213, 1215 (T.T.A.B. 2007). Applicant further argued it was pointless to rely on the fact that some of the same words appeared in Applicant's identification and Registrant's identification while ignoring the context in which those words appeared.

On September 23, 2014, the Examining Attorney issued a final Office Action maintaining both the identification requirement and the Section 2(d) refusal. The Examining Attorney reiterated his position that Applicant's goods and Registrant's goods "are related in that they are all electrical goods used in the distribution and controlling of electrical power," and again pointed to the fact that some words, devoid of context, can be found in both Applicant's goods and Registrant's goods. Again the Examining

Attorney did not introduce any evidence to support the refusal. The Examining Attorney's arguments in that final Office Action will be explored further below.

On September 26, 2014, Applicant submitted a request for reconsideration with an amended identification.

Finally, on October 17, 2014, the Examining Attorney issued an Office Action denying Applicant's request for reconsideration. As with his previous Office Actions, the Examining Attorney did not introduce any evidence with this Office Action.

B. No Likelihood of Confusion

Applicant respectfully submits that the Examining Attorney has quite simply failed to show there is a likelihood of confusion. To be more specific, in finding a likelihood of confusion the Examining Attorney has (i) relied on an analysis of "relatedness" that is incorrect as a matter of law, (ii) relied on a dubious approach to "relatedness" that involves cherry-picking words out of the parties' identifications without considering their context, (iii) introduced no evidence to support the refusal, and (iv) improperly dismissed – possibly without reading Applicant's position – the fact that Applicant's purchasers are sophisticated. These points are explored more fully below:

1. The Examining Attorney's Faulty "Relatedness" Analysis

To his credit, the Examining Attorney has been quite candid as to why he believes Applicant's goods are related to Registrant's goods: "The parties' goods are related in that they are all electrical goods used in the distribution and controlling of electrical

power.”² Lest there be any mistake, he insists that “[g]oods that share such a relationship are closely enough related to support a Section 2(d) refusal.”³

This is an astonishing position to take, and one that is directly contrary to precedent. As Applicant pointed out in its response of September 15, 2014, “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 W.W. Henry Co.*, 82 U.S.P.Q.2d 1213, 1215 (T.T.A.B. 2007) (reversing refusal and finding no likelihood of confusion between PATCH & GO and PATCH ‘N GO because although the goods sold under the respective marks could both accurately be defined broadly as “preparations for repairing surfaces,” the goods were used to repair different types of surfaces). As stated recently by the Board in finding no likelihood of confusion between BLACK BELT for “ammunition” and BLACK BELT for “pepper spray”:

The Examining Attorney also contends that the goods are related because they are both used for self-defense and are complementary. However, as we have often said, simply because a term can be found to generally describe both goods does not necessarily make them related.

In re RA Brands, L.L.C., Serial No. 85721641 (T.T.A.B. September 23, 2014 (non-precedential).

Likewise, in this case, the Examining Attorney’s relatedness analysis, namely that Applicant’s goods are related to Registrant’s goods because they could both be described as “electrical goods used in the distribution and controlling of electrical power,” is simply wrong as a matter of law. Under the Examining Attorney’s approach, a device sold to the U.S. Navy and used for controlling electricity in a nuclear reactor on a submarine would be related to a device used to control electricity in an electric guitar. It clearly cannot be

² Examining Attorney’s Final Office Action, unnumbered page 4.

³ *Id.* at unnumbered page 5.

the case, as the Examining Attorney contends, that goods are related simply because one can describe them both as “electrical goods used in the distribution and controlling of electrical power.”

2. The Examining Attorney’s Cherry-Picking of Words

To support the refusal, the Examining Attorney also believes it noteworthy that certain words appear in both Applicant’s identification and Registrant’s identification, or that certain phrases standing alone might sound similar:

[T]he applicant’s goods include “power cable couplers” while the registered goods include “power cable terminations and joints.” The applicant’s goods include “electrical equipment for electrical protection” and three types of “protection relays” while the registered goods include “current limiting protectors” and “protective electric relays.” Both the applicant’s goods and the registrant’s goods also include “switches” and “switchgear.”⁴

What the Examining Attorney conspicuously does not do is place this wording in context within Applicant’s identification and Registrant’s identification. To illustrate the absurdity of this analysis, below are Applicant’s Class 9 goods and the Registrant’s goods, with the words relied upon by the Examining Attorney highlighted in **red**:

Applicant’s Identification

Class 9

Prefabricated modular buildings and e-houses sold as a housing component of custom-designed, medium- and low-voltage **electrical equipment** for use in the mining industry, oil and gas industry, and other industrial applications **for electrical** distribution, **protection**, and control; portable low-to-medium voltage electric power centers for power distribution, monitoring and controlling for use in the mining industry, oil and gas industry, and other industrial applications; skid mounted and aboveground and underground electric substations, namely, skid mounted aboveground and underground portable low-to-medium voltage electric

⁴ *Id.* at unnumbered page 4.

power centers for monitoring and controlling mining operations consisting of medium voltage **switch** or breaker, low-to-medium voltage transformer, electronic motor control centers, namely, control consoles and programmable logic controllers, power take-off and automation panels for monitoring, diagnosing problems and controlling the distribution and flow of electrical power, featuring motor **protection relays**, ground fault relays, arc flash relays, feeder **protection relays**, custom key pads, variable frequency drives; portable **power cable couplers** for use in underground and aboveground mining; electronic controls for motors and custom-built **switchgear** for use in the mining industry, oil and gas industry, and other industrial applications; electric generator controls and electrical equipment consisting of neutral grounding resistor and electric monitoring relays for use in the mining industry, oil and gas industry, and other industrial applications; electric relays, namely, motor **protection relays**, ground fault relays, arc flash relays, feeder protection relays, pump protection relays, timers, flashers, power and voltage monitors, pump controllers, liquid level and load sensors, and current transformers, all for use in the mining industry, oil and gas industry, and other industrial applications

Registrant's Identification

Class 9

Power cable terminations and joints, namely, pre-molded terminations and joints for use on dielectric cable systems; cable splice boxes; splicing kits primarily comprised of lead sleeve, Novoid compound, dry cotton tape, saturated flax twine, solder, stearine candle, varnished cambric tapes, paper pasters, tinned shielding braid, split tinned solder copper connectors, saturated webbing and compression connectors; SF6 electric circuit **switches**; solid dielectric **switches**; vacuum **switches**, namely, **switches** and **switch** gears used in transmission and distribution of electrical power; automatic transfer **switches** for use in connection with electrical distribution and transmission systems; **current limiting protectors**; single and three phase reclosers, namely, electric circuit closers to reclose interrupted high voltage electrical circuits; and microprocessor-based power management systems comprised of power distribution **switchgear** with **protective electric relays** for controlling automatic **switching** operations in overhead and underground loop distribution circuits

Applicant respectfully disagrees with the Examining Attorney's cherry-picking of certain wording found in Applicant's identification and Registrant's identification, devoid of the wording in context, as it does not present a complete or accurate view of the goods. For example, the Examining Attorney states that Applicant's goods include "electrical

equipment for electrical protection.” That statement is highly misleading given that the *complete* clause in which that wording is found is shown below:

Prefabricated modular buildings and e-houses sold as a housing component of custom-designed, medium- and low-voltage **electrical equipment** for use in the mining industry, oil and gas industry, and other industrial applications **for electrical** distribution, **protection**, and control

These goods are actually prefabricated modular buildings and e-houses (!), but if one took the Examining Attorney’s statement at face value one would incorrectly believe the wording “electrical equipment for electrical protection” appears in Applicant’s identification. To take another example, the Examining Attorney states that “the applicant’s goods include ‘power cable couplers’ while the registered goods include ‘power cable terminations and joints.’” Placed in correct context, however, Applicant’s goods include “*portable power cable couplers for use in underground and aboveground mining*” while Registrant’s goods include “power cable terminations and joints, *namely, pre-molded terminations and joints for use on dielectric cable systems.*” Suffice it to say, Applicant believes the Examining Attorney has not presented a fair analysis of the goods.⁵

3. No Evidence Supports the Refusal

Despite issuing the Section 2(d) refusal in a non-final Office Action on March 17, 2014, a final Office Action on September 23, 2014, and a third Office Action denying Applicant’s request for reconsideration on October 17, 2014, at no time did the Examining Attorney introduce any evidence to support his refusal.

⁵ For instance, in a case where the applicant’s goods were identified as “*industrial* electric food processing machines, namely, machines for slicing food products for packing and packaging *in commercial quantities*,” the Board found that “[i]n presenting her arguments the Examining Attorney consistently disregards or discounts the importance of the terms ‘industrial’ and ‘in commercial quantities.’” *In re Formax, Inc.*, Serial Nos. 77298497 and 77298501 (T.T.A.B. October 14, 2009) (non-precedential).

Notwithstanding this, the Examining Attorney did not shy away from making certain assertions. First, the Examining Attorney asserted that “[a]s to electrical goods in particular, different goods in the electrical, electronic, and/or electromechanical fields have been found to be related *where the evidence shows* that the goods would be marketed through the same channels of trade...”⁶ But of course the Examining Attorney introduced no evidence. Likewise, the Examining Attorney took the position that “[p]articularly relevant in this context are the cases involving complementary goods. *Where evidence shows* that the goods at issue have complementary uses...”⁷ But again, the Examining Attorney cited no evidence.

It is well settled that cases must be decided “based on the evidence of record and not on what either the examining attorney or applicant argues the facts are.” *In re Fiesta Palms, LLC*, 85 U.S.P.Q.2d 1360, 1366 (T.T.A.B. 2007). *See also In re BDH Two Inc.*, 26 U.S.P.Q.2d 1556, 1558 (T.T.A.B. 1993) (“The problem with [the examining attorney’s] statement is that it is not supported by any evidence . . .”). While Applicant is mindful of the principle that doubt regarding likelihood of confusion is resolved in favor of the registrant, it must also be remembered that “this ‘tie-breaking rule’ is not a presumption or a substitute for evidence,” *Olde Tyme Foods, Inc. v. Roundy’s, Inc.*, 22 U.S.P.Q.2d 1542, 1547 (Fed. Cir. 1992), and in this case there is none.

4. Sophistication of Purchasers Militates Against Confusion

In its response of September 15, 2014, Applicant pointed out that its goods are expensive goods sold to sophisticated purchasers. Purchaser sophistication is not

⁶ *Id.* at unnumbered page 5 (emphasis added).

⁷ *Id.*

dispositive, of course, and Applicant was careful to clearly articulate that “Applicant does not contend its sophisticated consumers are experts in trademark law or that they are immune from source confusion.”⁸ The Examining Attorney responded with a form paragraph to the effect that “[t]he fact that purchasers are sophisticated or knowledgeable in a particular field does not necessarily mean that they are sophisticated or knowledgeable in the field of trademarks or immune from source confusion.”⁹ This non-responsive response from the Examining Attorney raises the question whether the Examining Attorney even read Applicant’s response, but in any event the fact remains that purchaser sophistication, while not dispositive, is a *factor* weighing against confusion.

C. Conclusion

“[I]t is not applicant’s burden to establish a lack of relationship between the respective goods. Rather, the burden is on the examining attorney to establish that the respective goods are related.” *In re 3-D Belt Co., LP*, Serial No. 76650341 (T.T.A.B. November 7, 2008) (non-precedential). In this case, in order to find Applicant’s goods related to Registrant’s goods, the Examining Attorney has employed an incorrect legal analysis of relatedness and a dubious cherry-picking of terms from Applicant’s goods and Registrant’s goods without taking into consideration their context. Moreover, the Examining Attorney makes certain assertions that are unsupported by the record. For these reasons, Applicant respectfully submits that there is no likelihood of confusion.

⁸ Applicant’s Response, September 15, 2014, page 4.

⁹ Examining Attorney’s Final Office Action, unnumbered page 6.

IV. Conclusion

For the foregoing reasons, Applicant respectfully requests that the Board reverse the requirement for an amendment to the identification and the Section 2(d) refusal.

Respectfully submitted,

Date: March 20, 2015

/Michael E. Hall/

Michael E. Hall
Kacvinsky Daisak Bluni PLLC
3120 Princeton Pike, Suite 303
Lawrenceville, New Jersey 08648
609-270-4918
mhall@kdbfirm.com

Applicant's Attorney