

## Request for Reconsideration after Final Action

The table below presents the data as entered.

| Input Field                  | Entered   |
|------------------------------|---|
| <b>SERIAL NUMBER</b>         | 86660623  |
| <b>LAW OFFICE ASSIGNED</b>   | LAW OFFICE 110  |
| <b>MARK SECTION</b>          |   |
| <b>MARK</b>                  | <a href="http://tmng-al.uspto.gov/resting2/api/img/86660623/large">http://tmng-al.uspto.gov/resting2/api/img/86660623/large</a> |
| <b>LITERAL ELEMENT</b>       | AXIS  |
| <b>STANDARD CHARACTERS</b>   | YES   |
| <b>USPTO-GENERATED IMAGE</b> | YES   |
| <b>MARK STATEMENT</b>        | The mark consists of standard characters, without claim to any particular font style, size or color.                            |

### ARGUMENT(S)

#### **REQUEST FOR RECONSIDERATION**

Applicant submits this Response of the Final Office Action of April 26, 2016 pursuant to 37 C.F.R. §2.64(b). Applicant respectfully request the Examining Attorney promptly reconsider the refusal, the arguments made herein be made of record, and issue registration for Applicant's Mark.

## **I. ARGUMENT**

### **A. Refusal Section 2(d) – Likelihood of Confusion**

The Office Action refuses the mark on the basis that a likelihood of confusion would occur. There is no evidence in the record, and to Applicant's knowledge, there is no basis for finding that, the registration 3129594 for "knives, namely folding knives and pocket knives and components thereof, namely handles, blades handle liners, hinging mechanisms and mechanisms to secure a blade in the open position" is confusing or even related to hand tools, such as wrenches. The registration 3129594 is related to bladed items whereas the applicant seeks to register "AXIS" for a different, entirely unrelated product which has unrelated essential characteristics, features, uses, and purpose. Similarly, the registration 3714753 is also for "knives, namely folding knives and pocket knives and components thereof, namely handles, blades handle liners, hinging mechanisms and mechanisms to secure a blade in the open position".

Applicant's goods are readily distinguishable from the goods of the Registrants Mark. Applicant's goods are ratchet wrenches used by automotive technicians for servicing and repairing automotive vehicles, such as cars, trucks, motorcycles, RVs, and the like. The registration 3129594 is directed to goods knives and components, such as cutlery, side arms, and razors, sold to culinary professionals, military, law enforcement and first responders. The registration 3714753 is also directed to goods knives and components, such as cutlery, side arms, and razors, sold to culinary professionals, military, law enforcement and first responders.

Even in cases of identical or very similar marks, Courts have repeatedly held that "use in the same broad field is not sufficient to demonstrate that a genuine issue exists concerning likelihood of confusion." *Astra Pharm. Prods. V Beckham Instruments, Inc.*, 718 F.2d 1201 (1st Cir. 1983) (ASTRA for laboratory instruments sold to hospital pharmacies). *Elec. Design & Sales Inc. Homeowners Group, Inc. v. Home Marketing Specialists, Inc.*, 18 U.S.P.Q. 2d 1587 (6th Cir. 1991) (summary judgement for plaintiff reversed as no finding of likelihood of confusion made by trial court as to HMS-roof design mark for products and services sold to real estate brokers and HMS-roof design mark for real estate brokerage services); *Western Publishing Co. Inc. v Rose Art Industries, Inc.*, 910 F.3d 57, 62 (2d Cir. 1990) (holding that although the parties share a common, unsophisticated market for their goods, it is not undisputed that the publisher of children's book services does not currently market a product directly competitive with a children's drawing slate, and therefore this factors weighs in the defendant's favor.)

In the instant case, the facts show that the Applicant's goods and the Registrant's goods may be argued to be loosely related is not sufficient to establish similarity. The marks cover completely different products. As the Court stated in *Homeowner's Group, Inc. , Supra*, services are "related" not because they coexist in the same broad industry, but are "related" if the services are marketed and consumed such that buyers are likely to believe that the services, similarly marked, come from the same source, or are somehow connected with or sponsored by a common company. *Homeowners Group, Inc.*, 18 U.S.P.Q. 2d 1587 at 1594 (quoting *Fleischmann Distilling Corp. v. Maier Brewing Corp.*, 314 F.2d 149, 159, cert. denied, 374 US 830 (1963) (the question is are the services related so that they are likely to be connected in the mind of a prospective purchaser?).

According, since there is no basis for finding that Applicant's goods are "related" related to the goods provided under Registrant's mark and it is shown the marks are directed to different consumer bases, the goods are sufficiently different to avoid confusion. Applicant respectfully requests that the Section 2(d) refusal be withdrawn.

## **B. Comparison of the Marks**

The Office Action refuses the mark on the basis that applicant has not argued the marks are dissimilar. Applicant believes the Office Action cites an overly strict legal standard in evaluating the likelihood of confusion between Applicant's Mark and the Registrant's Mark. On page three of the Final Refusal, the Office Action indicates that all of the marks contain the term AXIS and indicates that the doubt must be resolved on the likelihood of confusion in favor of the registrant and against the applicant who has a legal duty to select a mark which is totally dissimilar to the trademarks being used and cites *Burroughs Welcome Co. v. Warner-Lambert Co.*, 203 USPQ 191 TTAB 1979.

Applicant counters that the overly strict "totally dissimilar" test is not the law and that such language in *Burrough* must be viewed in the context of that case, where there were other factors militating in favor of a finding of confusion.

In comparison, the plain wording of the Trademark Act is clear, and the case law is replete with examples which hold the exact opposite, namely that Applicant's obligation is limited to adopting a mark which is not likely to be confused with a previously registered mark, as opposed to a mark which is "totally dissimilar" to any registered mark. T.M.E.P §1207, citing 15 U.S.C §1052; *See e.g. Bongrain Int'l (American) Co. v. Delice De France, Inc.*, 811 F.2d 14799, 1486 (Fed. Cir. 1987) ("the statute refers to likelihood, not mere possibility of confusion"); *Elect. Design & Sales, Inc. v. Electronic Data Sys. Corp.*, 954 F.2d 713, 717 (Fed. Cir. 1992) ("not concerned with mere theoretical possibilities of confusion").

Applicant states the requirement indicated in the Office Action is unduly restrictive in requiring Applicant to show that its mark is "totally dissimilar" to the Registrant's Mark. There are a large number of marks which are not likely to be confused under the appropriate legal standard and which have therefore been duly registered by the Patent and Trademark Office, yet which are not "totally dissimilar" to the cited Mark. It is respectfully submitted that Applicant's Mark is such one example. According, Applicant's Mark is not likely to be confused under the appropriate standard and Applicant respectfully requests that the refusal be withdrawn.

## **C. Comparison of the Goods and Services**

The Office Action refuses the mark on the basis that the examining attorney does not find Applicant's previous response persuasive. Applicant incorporates the reasons set forth Argument, section A and B detailing Applicant's arguments of "related goods", the reviewing standard and reiterates the same arguments in this section. Furthermore, Applicant's goods and the Registrant's goods are sold through different trade channels. Registrant's goods are online through domains such as [www.knife-depot.com](http://www.knife-depot.com), [www.knifecenter.com](http://www.knifecenter.com), [www.amazon.com](http://www.amazon.com), and [www.us-elitegear.com](http://www.us-elitegear.com). Applicant's **only** sells its ratchet wrenches to automotive service and repair professionals through its mobile (e.g. automobile) distribution system. In this distribution system, the applicant's franchisee drives a "MAC Tools" automobile to a workplace of an automotive professional, such a car repair shop or service center, and sells directly to the automotive professional. Applicant and Registrant have two distinct channels of trade that are visited by different consumer bases. Thus, no general consumer seeking Registrant's accustomed to purchasing registrant's knives are likely to request visitation from a "MAC Tools" franchisee mobile vehicle to buy automotive tools. According, Applicant's Mark is not likely to be confused by potential purchaser and Applicant respectfully requests that the refusal be withdrawn.

## **II. CONCLUSION**

Applicant has established that confusion is not likely between goods sold under Applicant's Mark and goods sold under Registrant's Mark. Therefore, there is no basis for finding that Applicant's goods are "related" to the goods provided under Registrant's mark and given the lack of evidence, the different goods, different end customers, different industries, and different channels of trade and applicant's previous amendment to its goods, Applicant respectfully requests the Examining Attorney withdraw the refusal to register Applicant's Mark and Allow Applicant's Mark to register in due course.

In the event that this Request for Reconsideration is not deemed persuasive, Applicant respectfully requests that the Notice of Appeal submitted herewith be filed and that such fee for such Appeal be charged against Applicant's deposit account as set forth in the Notice of Appeal.

**SIGNATURE SECTION**

|                                |                      |
|--------------------------------|----------------------|
| RESPONSE SIGNATURE             | /Caeden Drayton/     |
| SIGNATORY'S NAME               | Caeden Drayton       |
| SIGNATORY'S POSITION           | Group Patent Counsel |
| SIGNATORY'S PHONE NUMBER       | 4107162419           |
| DATE SIGNED                    | 10/26/2016           |
| AUTHORIZED SIGNATORY           | YES                  |
| CONCURRENT APPEAL NOTICE FILED | YES                  |

**FILING INFORMATION SECTION**

|             |  |
|-------------|--|
| SUBMIT DATE | Wed Oct 26 18:16:14 EDT 2016   |
| TEAS STAMP  | USPTO/RFR-XX.XXX.XXX.XX-2<br>0161026181614354642-86660<br>623-570d5b09f1f93cea64444<br>f697773a85aaff59348caa4c5<br>e6a58b9f746d515c6-N/A-N/A<br>-20161026180509727033 |

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PTO Form 1960 (Rev 10/2011)  
OMB No. 0651-0050 (Exp 07/31/2017)

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**To the Commissioner for Trademarks:**

Application serial no. **86660623** AXIS(Standard Characters, see <http://tmng-al.uspto.gov/resting2/api/img/86660623/large>) has been amended as follows:

**ARGUMENT(S)**

**In response to the substantive refusal(s), please note the following:**

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**SIGNATURE(S)**

**Request for Reconsideration Signature**

Signature: /Caeden Drayton/ Date: 10/26/2016

Signatory's Name: Caeden Drayton

Signatory's Position: Group Patent Counsel

Signatory's Phone Number: 4107162419

The signatory has confirmed that he/she is an attorney who is a member in good standing of the bar of the highest court of a U.S. state, which includes the District of Columbia, Puerto Rico, and other federal territories and possessions; and he/she is currently the owner's/holder's attorney or an associate thereof; and to the best of his/her knowledge, if prior to his/her appointment another U.S. attorney or a Canadian attorney/agent not currently associated with his/her company/firm previously represented the owner/holder in this matter: (1) the owner/holder has filed or is concurrently filing a signed revocation of or substitute power of attorney with the USPTO; (2) the USPTO has granted the request of the prior representative to withdraw; (3) the owner/holder has filed a power of attorney appointing him/her in this matter; or (4) the owner's/holder's appointed U.S. attorney or Canadian attorney/agent has filed a power of attorney appointing him/her as an associate attorney in this matter.

The applicant is filing a Notice of Appeal in conjunction with this Request for Reconsideration.

Serial Number: 86660623

Internet Transmission Date: Wed Oct 26 18:16:14 EDT 2016

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A-N/A-20161026180509727033