

To: Jon E Shackelford(jshack@endurancelaw.com)
Subject: U.S. Trademark Application Serial No. 97120679 - CASTERSHOX - CASTERSHX-T1
Sent: August 24, 2022 05:28:08 PM EDT
Sent As: tmng.notices@uspto.gov

Attachments

[4418177](#)

**United States Patent and Trademark Office (USPTO)
Office Action (Official Letter) About Applicant's Trademark Application**

U.S. Application Serial No. 97120679

Mark: CASTERSHOX

Correspondence Address:

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Applicant: CasterShoX, LLC

Reference/Docket No. CASTERSHX-T1

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NONFINAL OFFICE ACTION

The USPTO must receive applicant's response to this letter within six months of the issue date below or the application will be [abandoned](#). Respond using the Trademark Electronic Application System (TEAS). A link to the appropriate TEAS response form appears at the end of this Office action.

Issue date: August 24, 2022

The referenced application has been reviewed by the assigned trademark examining attorney. Applicant must respond timely and completely to the issue below. 15 U.S.C. §1062(b); 37 C.F.R. §§2.62(a), 2.65(a); TMEP §§711, 718.03.

Summary of Issues

- Section 2(d) Refusal – Likelihood of Confusion
- Unity of Control Asserted – More Information/Evidence Needed
- Advisory: Ownership of Cited Registration
- Advisory: USPTO Will Not Issue Duplicate Registrations/Express Abandonment by TEAS

Section 2(d) Refusal – Likelihood of Confusion

Registration of the applied-for mark is refused because of a likelihood of confusion with the mark in U.S. Registration No. 4418177. Trademark Act Section 2(d), 15 U.S.C. §1052(d); *see* TMEP §§1207.01 *et seq.* See the attached registration.

Trademark Act Section 2(d) bars registration of an applied-for mark that is so similar to a registered mark that it is likely consumers would be confused, mistaken, or deceived as to the commercial source of the goods of the parties. *See* 15 U.S.C. §1052(d). Likelihood of confusion is determined on a case-by-case basis by applying the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973) (called the “*du Pont* factors”). *In re i.am.symbolic, llc*, 866 F.3d 1315, 1322, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017). Any evidence of record related to those factors need be considered; however, “not all of the *DuPont* factors are relevant or of similar weight in every case.” *In re Guild Mortg. Co.*, 912 F.3d 1376, 1379, 129 USPQ2d 1160, 1162 (Fed. Cir. 2019) (quoting *In re Dixie Rests., Inc.*, 105 F.3d 1405, 1406, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997)).

Although not all *du Pont* factors may be relevant, there are generally two key considerations in any likelihood of confusion analysis: (1) the similarities between the compared marks and (2) the relatedness of the compared goods. *See In re i.am.symbolic, llc*, 866 F.3d at 1322, 123 USPQ2d at 1747 (quoting *Herbko Int’l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1164-65, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002)); *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 1103, 192 USPQ 24, 29 (C.C.P.A. 1976) (“The fundamental inquiry mandated by [Section] 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.”); TMEP §1207.01.

Applicant’s applied-for mark is CASTERSHOX in standard characters for “[m]etal casters” in International Class 6.

Registrant’s mark is CASTERSHOX in standard characters for “[m]etal casters” in International Class 6.

For the purposes of the Section 2(d) Likelihood of Confusion Refusal, applicant’s mark and the mark in U.S. Reg. No. 4418177 are owned by different entities. If applicant owns the registration, applicant should reference the ownership of cited registration advisory below. However, applicant is also advised that **the USPTO does not issue duplicate registrations.**

In addition, although applicant notes the cited registration is owned by a “sister company,” applicant’s statement is insufficient to establish unity of control. Please see the “unity of control” section below for further information.

Similarity of the Marks

Marks are compared in their entireties for similarities in appearance, sound, connotation, and commercial impression. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 1321, 110 USPQ2d 1157, 1160 (Fed. Cir. 2014) (quoting *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 1371, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005)); TMEP §1207.01(b)-(b)(v). “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *In re Inn at St. John’s, LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018) (citing *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014)), *aff’d per curiam*, 777 F. App’x 516, 2019 BL 343921 (Fed. Cir. 2019); TMEP §1207.01(b).

In a likelihood of confusion determination, the marks in their entireties are compared for similarities in appearance, sound, connotation, and commercial impression. *In re i.am.symbolic, llc*, 866 F.3d 1315, 1323, 123 USPQ2d 1744, 1748 (Fed. Cir. 2017); *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 1321, 110 USPQ2d 1157, 1160 (Fed. Cir. 2014) (quoting *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 1371, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005)); *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973); TMEP §1207.01(b)-(b)(v).

In the present case, applicant’s mark is CASTERSHOX in standard characters and registrant’s mark is CASTERSHOX in standard characters. These marks are identical in appearance, sound, and meaning, “and have the potential to be used . . . in exactly the same manner.” *In re i.am.symbolic, llc*, 116 USPQ2d 1406, 1411 (TTAB 2015), *aff’d*, 866 F.3d 1315, 123 USPQ2d 1744 (Fed. Cir. 2017). Additionally, because they are identical, these marks are likely to engender the same connotation and overall commercial impression when considered in connection with applicant’s and registrant’s respective goods. *Id.*

Based on the foregoing, the applicant’s applied-for and registrant’s marks are sufficiently similar to find a likelihood of confusion.

Relatedness of the Goods

The goods are compared to determine whether they are similar, commercially related, or travel in the same trade channels. *See Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1369-71, 101 USPQ2d 1713, 1722-23 (Fed. Cir. 2012); *Herbko Int’l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1165, 64 USPQ2d 1375, 1381 (Fed. Cir. 2002); TMEP §§1207.01, 1207.01(a)(vi).

The compared goods 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); TMEP §1207.01(a)(i). They need only be “related in some manner and/or if the circumstances surrounding their marketing are such that they could give rise to the mistaken belief that [the goods] 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)); TMEP §1207.01(a)(i).

When analyzing an applicant’s and registrant’s goods for similarity and relatedness, that determination is based on the description of the goods services in the application and registration at issue, not on extrinsic evidence of actual use. *See Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 1323, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014) (quoting *Octocom Sys. Inc. v. Hous. Computers Servs. Inc.*, 918 F.2d 937, 942, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990)).

In this case, the goods in the application and registration are identical. Specifically, applicant and registrant provide "[m]etal casters." Therefore, it is presumed that the channels of trade and classes of purchasers are the same for these goods. *See Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 1372, 127 USPQ2d 1797, 1801 (Fed. Cir. 2018) (quoting *In re Vitterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012)).

Based on the analysis above, applicant's and registrant's goods are related.

Because applicant's and registrant's marks are similar and the goods are related, there is a likelihood of confusion and applicant's applied-for mark must be refused under Section 2(d) of the Lanham Act.

Although applicant's mark has been refused registration, applicant may respond to the refusal by submitting evidence and arguments in support of registration.

Unity of Control Asserted – More Information/Evidence Needed

Applicant indicates that it has a legal relationship with the registrant in the cited registration. However, a legal relationship between the parties is insufficient to overcome a likelihood of confusion unless the parties constitute a "single source." That is, the legal relationship between the parties must exhibit a "unity of control" over the nature and quality of the goods in connection with which the trademarks are used, and a "unity of control" over the use of the trademarks. *See In re Wella A.G.*, 5 USPQ2d 1359, 1361 (TTAB 1987); *see also* TMEP §1201.07.

Unity of control is presumed in instances where, absent contradictory evidence, one party owns (1) all of another entity, or (2) substantially all of another entity and asserts control over the activities of that other entity. *See* TMEP §1201.07(b)(i)-(ii). Such ownership is established, for example, when one party owns all or substantially all of the stock of another or when one party is a wholly owned subsidiary of another. *See In re Wella A.G.*, 5 USPQ2d at 1361; TMEP §1201.07(b)(i)-(ii). It is additionally presumed when, absent contradictory evidence, applicant is shown in USPTO records as a joint owner of the cited registration, or the owner of the registration is listed as a joint owner of the application, and applicant submits a written statement asserting control over the use of the mark by virtue of joint ownership. TMEP §1201.07(b)(ii).

However, in most other situations, additional evidence is required to show unity of control. For example, if the parties are sister corporations or if the parties share certain stockholders, directors or officers in common, additional evidence must be provided to show how the parties constitute a single source. *See In re Pharmacia, Inc.*, 2 USPQ2d 1883, 1884 (TTAB 1987); TMEP §1201.07(b)(iii).

Therefore, applicant must provide a written statement explaining the nature of the legal relationship between the parties. In addition, if neither party owns all or substantially all of the other party, and USPTO records do not show their joint ownership of the application or cited registration, applicant must provide a detailed written explanation and documentary evidence showing the parties' "unity of control" over the nature and quality of the goods in connection with which the trademarks are used, and the parties' "unity of control" over the use of the trademarks. *See* TMEP §1201.07(b)(i)-(iii). This statement and, if necessary, explanation must be verified with an affidavit or signed declaration under 37 C.F.R. §2.20. TMEP §1201.07(b)(ii)-(iii); *see* 37 C.F.R. §2.193(e)(1). However, if one party owns all of the other entity, and there is no contradictory evidence of record, the written statement need not be verified. TMEP §1201.07(b)(i).

Advisory: Ownership of Cited Registration

If the mark in the cited registration is owned by applicant, applicant may provide evidence of ownership of the mark by satisfying one of the following:

- (1) Record the assignment with the USPTO's Assignment Recordation Branch (ownership transfer documents such as assignments can be filed online at <http://etas.uspto.gov>) and promptly notify the trademark examining attorney that the assignment has been duly recorded;
- (2) Submit copies of documents evidencing the chain of title; or
- (3) Submit the following statement, verified with an affidavit or signed declaration under 37 C.F.R. §2.20: **"Applicant is the owner of U.S. Registration No. 4418177."** To provide this statement using the Trademark Electronic Application System (TEAS), use the ["Response to Office Action"](#) form; answer "yes" to wizard questions #3 and #9; then, continuing on to the next portion of the form, in the "Additional Statement(s)" section, find "Active Prior Registration(s)" and insert the U.S. registration numbers in the data fields; and follow the instructions within the form for signing. The form must be signed twice; a signature is required both in the "Declaration Signature" section and in the "Response Signature" section.

TMEP §812.01; *see* 15 U.S.C. §1060; 37 C.F.R. §§2.193(e)(1), 3.25, 3.73(a)-(b); TMEP §502.02(a).

Recording a document with the Assignment Recordation Branch does not constitute a response to an Office action. TMEP §503.01(d).

Although applicant may provide evidence of ownership, applicant is advised that **the USPTO will not issue a duplicate registration**. As such, please note the advisory below.

Advisory: USPTO Will Not Issue Duplicate Registrations/Express Abandonment by TEAS

In the application, applicant states that U.S. Registration No. 4418177 "shall be Expressly Abandoned in favor of th[e] present application." However, applicant's miscellaneous statement filed with the application does not expressly abandon the registration.

In addition, applicant is advised that if applicant establishes ownership of the cited registration, the present application will be an exact duplicate of U.S. Registration No. 4418177. 37 C.F.R. §2.48; TMEP §703. **The USPTO will not issue duplicate registrations.** 37 C.F.R. §2.48; TMEP §703.

In that event, applicant may [abandon the application](#) or [surrender the registration](#) (use form #6).

Express Abandonment by TEAS

Applicant can [file a request to expressly abandon the application](#). *See* 37 C.F.R. §2.68(a). This will end the application process; and the applied-for mark will not register. The request must be properly signed by applicant's attorney, if applicant is represented by an authorized attorney, or by the individual applicant, all joint applicants, or someone authorized to sign on behalf of a juristic applicant (e.g., a corporate officer or general partner). *See* 37 C.F.R. §2.193(e)(2); TMEP §§611.03(b), 718.01. Once filed, the request may not be withdrawn. 37 C.F.R. §2.68(a).

Assistance

Please call or email the assigned trademark examining attorney with questions about this Office action. Although an examining attorney cannot provide legal advice, the examining attorney can provide additional explanation about the refusal in this Office action. *See* TMEP §§705.02, 709.06.

The USPTO does not accept emails as responses to Office actions; however, emails can be used for informal communications and are included in the application record. *See* 37 C.F.R. §§2.62(c), 2.191; TMEP §§304.01-.02, 709.04-.05.

How to respond. [Click to file a response to this nonfinal Office action.](#)

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RESPONSE GUIDANCE

- **Missing the response deadline to this letter will cause the application to [abandon](#).** The response must be received by the USPTO before midnight **Eastern Time** of the last day of the response period. TEAS maintenance or [unforeseen circumstances](#) could affect an applicant's ability to timely respond.
- **[Responses signed by an unauthorized party](#)** are not accepted and can **cause the application to [abandon](#)**. If applicant does not have an attorney, the response must be signed by the individual applicant, all joint applicants, or someone with [legal authority to bind a juristic applicant](#). If applicant has an attorney, the response must be signed by the attorney.
- If needed, **find [contact information for the supervisor](#)** of the office or unit listed in the signature block.

Print: Wed Aug 24 2022

85868208

(4) STANDARD CHARACTER MARK

CasterShoX

Mark Punctuated
CASTERSHOX

Translation

Goods/Services

- IC 006. US 002 012 013 014 023 025 050.G & S: Metal casters. FIRST USE: 20050601. FIRST USE IN COMMERCE: 20050601

Mark Drawing Code
(4) STANDARD CHARACTER MARK

Design Code

Serial Number
85868208

Filing Date
20130306

Current Filing Basis
1A

Original Filing Basis
1A

Publication for Opposition Date
20130730

Registration Number
4418177

Date Registered
20131015

Owner
(REGISTRANT) Caster Concepts, Inc. CORPORATION MICHIGAN 16000 E. Michigan Ave. Albion MICHIGAN 49224

Priority Date

Disclaimer Statement

Description of Mark

Type of Mark
TRADEMARK

Register
PRINCIPAL

Live Dead Indicator

LIVE

Attorney of Record

Bradley L. Smith

United States Patent and Trademark Office (USPTO)

USPTO OFFICIAL NOTICE

Office Action (Official Letter) has issued
on August 24, 2022 for
U.S. Trademark Application Serial No. 97120679

A USPTO examining attorney has reviewed your trademark application and issued an Office action. You must respond to this Office action in order to avoid your application abandoning. Follow the steps below.

- (1) **[Read the Office action](#)**. This email is NOT the Office action.
- (2) **Respond to the Office action by the deadline** using the Trademark Electronic Application System (TEAS). Your response must be received by the USPTO on or before 11:59 p.m. **Eastern Time** of the last day of the response period. Otherwise, your application will be **[abandoned](#)**. See the Office action itself regarding how to respond.
- (3) **Direct general questions** about using USPTO electronic forms, the USPTO **[website](#)**, the application process, the status of your application, and whether there are outstanding deadlines to the **[Trademark Assistance Center \(TAC\)](#)**.

After reading the Office action, address any question(s) regarding the specific content to the USPTO examining attorney identified in the Office action.

GENERAL GUIDANCE

- **[Check the status](#) of your application periodically** in the **[Trademark Status & Document Retrieval \(TSDR\)](#)** database to avoid missing critical deadlines.
- **[Update your correspondence email address](#)** to ensure you receive important USPTO notices about your application.
- **[Beware of trademark-related scams](#)**. Protect yourself from people and companies that may try to take financial advantage of you. Private companies may call you and pretend to be the USPTO or may send you communications that resemble official USPTO documents to trick you. We will never request your credit card number or social security number over the phone. And all official USPTO correspondence will only be emailed from the domain “@uspto.gov.” Verify the correspondence originated from us by using your Serial Number in our database, **[TSDR](#)**, to confirm that it appears under the “Documents” tab, or contact the **[Trademark Assistance Center](#)**.

- **Hiring a U.S.-licensed attorney.** If you do not have an attorney and are not required to have one under the trademark rules, we encourage you to hire a U.S.-licensed attorney specializing in trademark law to help guide you through the registration process. The USPTO examining attorney is not your attorney and cannot give you legal advice, but rather works for and represents the USPTO in trademark matters.