UNITED STATES DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

In Re the Application of:		
Applicant:	Space Exploration Technologies Corp.	Examining Atty: Leslie L. Richards
Mark:	LOOP	Law Office: 106
Serial No.:	88/017,793	
Class:	42	
Filed:	June 27, 2018	

RESPONSE TO OFFICE ACTION

In response to the Office Action issued October 25, 2018 in connection with the above-captioned application (the "Application") for the trademark LOOP ("Applicant's Mark"), Space Exploration Technologies Corp. ("Applicant"), by and through counsel, submits the following.

I. LIKELIHOOD OF CONFUSION

Pursuant to Section 2(d) of the Lanham Act, the Examining Attorney cited U.S. Reg. No. 4,953,361 for the mark LOOP (the "Cited Mark"), registered by Frontiers Media SA ("Frontiers") as a bar to registration of Applicant's Mark. The Examining Attorney has concluded that Applicant's Mark and the Cited Mark are likely to cause confusion with one another. Applicant respectfully disagrees and submits the following arguments in support of registration.

The question of whether there is a likelihood of confusion between marks is "related not to the *nature* of the mark but to its *effect* 'when applied to the goods of the applicant.' The only *relevant* application is made in the marketplace. The words 'when applied' do not refer to a mental exercise, but to all of the known circumstances surrounding use of the mark." *In re E.I.*

du Pont de Nemours & Co., 476 F.2d 1357, 1360-61 (C.C.P.A. 1973) (original emphasis). In determining whether there is a likelihood of confusion, the United States Patent & Trademark Office ("PTO") analyzes many factors, including as particularly relevant here:

- The similarity or dissimilarity and nature of the goods or services such that one party's goods will be mistaken for those of the other party; and
- The sophistication of the purchasers of the goods or services.

Id. at 1361.

An assessment of these factors reveals that there is no likelihood of confusion between Applicant's Mark and the Cited Mark. The parties' distinct, sophisticated commercial consumers exercise a high degree of care when making decisions about purchasing, respectively, Applicant's transportation related technology development and consulting, and Frontiers' academic research related offerings. The parties' consumers are therefore highly unlikely to be confused about the relationship between Applicant's Mark and the Cited Mark, or the parties' distinct offerings. Furthermore, while the parties' marks are similar, the differences between the marks should not be dismissed, especially given the relevant consumer sophistication and degree of care.

A. The Marks are Associated with Distinguishable Services.

Even where two marks are identical, courts and the TTAB routinely 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 § 1207.1(a)(i). *See, e.g., Calypso Tech. Inc. v. Calypso Capital Mgmt., LP*, 100 U.S.P.Q.2d 1213, 1221 (TTAB 2011) (finding that CALYPSO computer software for use by financial institutions is not sufficiently similar to

CALYPSO PARTNERS investment management and fund services even though the goods and services are offered in the financial field); *In re W.W. Henry Co.*, 82 U.S.P.Q.2d 1213, 1215 (TTAB 2007) (finding that products offered under PATCH & GO and PATCH 'N GO marks can be distinguished even though both products are used to repair surfaces); *Aries Systems Corp. v. World Book, Inc.*, 26 U.S.P.Q.2d 1926, * 21 (TTAB 1993) (KNOWLEDGE FINDER and INFORMATION FINDER are not confusingly similar because, *inter alia*, "[s]uch products, rather than being…simply computer programs utilized for facilitating research of medical and related scientific topics, are designed to search databases of vastly different levels of content for, concomitantly, significantly different purposes.").

For example, in *McGraw-Hill Inc. v. Comstock Partners Inc.*, the District Court for the Southern District of New York held that even though the parties used the same mark, COMSTOCK, the defendant's investment services and plaintiff's financial information services were not sufficiently related to support a finding of a likelihood of confusion. 743 F. Supp. 1029, 1034 (S.D.N.Y. 1990). The court concluded that it was simply inconceivable that the parties' sophisticated clientele would believe such services emanate from the same source. *Id.*

Here, the Cited Mark is registered in connection with, in relevant part, "Providing scientific information in the field of academic, scientific and industrial research; providing online searchable databases featuring information, text, and electronic documents in the field of science and technology and scholarly research, the sharing of and collaboration on scientific and scholarly research, and featuring people involved with scientific and scholarly research." Each clause in the foregoing description includes significant qualifiers which differentiate Frontiers' offerings. Specifically, the first clause specifies that Frontier's offering is limited to the field (singular) of "academic, scientific and industrial research." Frontier's offering is targeted to

academics. It is also limited to "scientific information." The second clause describes a searchable database for "scholarly research." Frontiers' offering is exactly what it sounds like from the registration: a web based platform for academics to connect, share, and obtain academic and scholarly research. A true and correct screenshot of Frontiers' website is included herewith.

In contrast, Applicant is in the business of developing a cutting-edge high speed transportation system. Applicant's offerings concern R&D and consulting services in the field of transportation. Such offerings are unrelated to academia, scholarly research, or the provision of scientific information and searchable research databases. Accordingly, there is no basis to infer that consumers would assume that the parties' offerings originate from the same source.

In view of the foregoing, consumers are unlikely to believe that Applicant's services and Frontiers' services are related and originate from the same source.

B. The Parties Offerings are Targeted Toward Distinct, Sophisticated Consumers Who Exercise a High Degree of Care.

It is well settled that likelihood of confusion is reduced where purchasers and potential purchasers of the products are sophisticated. *Electronic Design & Sales v. E.D.S.*, 954 F.2d 713, 718 (Fed. Cir.1992)). It has also been established that when a purchaser has a "reasonably focused need" or "specific purpose" or plan involving the product, the consumer will have a higher degree of ordinary care. *See Haydon Switch & Instrument, Inc. v. Rexnord, Inc.*, 4 USPQ2d 1510, 1517 (D. Conn. 1987) ("It is thus evident that the sophisticated purchasers of the products of plaintiffs or Rexnord enter the marketplace in search of specific products for specific industrial purposes. The sophistication of these purchasers makes the likelihood of confusion remote."). The greater degree of consumer sophistication and care in purchasing minimizes the likelihood of confusion between marks in the marketplace. *See* TMEP § 1207.01(d)(vii).

As an initial matter, based on the descriptions of the parties' respective offerings, the goods offered under the Cited Mark and Applicant's Mark are targeted toward different consumers. Frontiers' scholarly research platform is directed toward those in the "field of academic, scientific and industrial research" and consumers of "scholarly research" (i.e., scholars). Applicant's offering is targeted toward governments and businesses in the fields of "high speed transportation," "transportation engineering and transportation technology." The parties' consumers are therefore sophisticated and have very focused needs such that they would necessarily exercise a higher degree of care and not be confused.

In light of all of the foregoing, Applicant respectfully requests that the citation to Registration No. 4,953,361 be withdrawn.

II. ADDITIONAL INFORMATION REQUIRED

The Examining Attorney has advised that, in order to permit proper examination of Applicant's Mark, Applicant must explain whether the wording "LOOP" has any significance in the transportation trade or industry or as applied to applicant's goods and/or services, or if such wording is a "term of art" within applicant's industry. Applicant represents that the wording "LOOP" does not have any meaning as applied to Applicant's goods and services other than as a trademark. Likewise, the wording "LOOP" is not a term of art within Applicant's industry.

In response to the Examining Attorney's other requests for information, Applicant responds as follows:

- Relevant screenshots from Applicant's website are attached hereto as advertising and marketing materials reflecting Applicant's planned offerings under Applicant's mark.

- Applicant's transportation services do not comprise, incorporate or otherwise consist of a loop, e.g., a shape produced by a curve that bends around and crosses itself.
- Applicant's transportation services do not travel in the shape of a loop, e.g., a shape produced by a curve that bends around and crosses itself.
- Applicant's competitors do not use "loop" to advertise similar goods and/or services.
- The typical customers of Applicant's goods and services under the LOOP mark are local governments and commuters.
- Once Applicant's transportation services are completed, riders will be able to reserve times and purchase tickets in advance similar to booking seats at a movie theater via a mobile app, over the phone, or in person.

III. CITED APPLICATIONS

The Examining Attorney has cited Application Serial Nos. 87/913,970; 87/276,630; 86/589,154; 86/617,512 for the trademark HYPERLOOP, and variations thereof, as potential bars to registration of Applicant's LOOP mark. Applicant notes that Application Serial No. 86/617,512 is owned by Applicant, and therefore citation to that application should be withdrawn. As to the remaining applications referenced by the Examining Attorney, Applicant respectfully requests that any further action on this Application be suspended pending final disposition of those filings.

IV. CONCLUSION

Applicant has addressed the issues raised by the Examining Attorney in the Office Action issued October 25, 2018. In view of the foregoing, Applicant respectfully requests that the Application be suspended.

Respectfully submitted,

Date: April 25, 2019

/Judd D. Lauter /

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