

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Trademark Application of	:	
	:	
Evolv, LLC	:	
	:	REQUEST FOR RECONSIDERATION
Appl. Ser. No.: 86/653,053	:	
	:	Examining Attorney
Filed: June 5, 2015	:	Thomas Young
	:	
IC: 034	:	Trademark Law Office 120
	:	
Mark: DNA	:	

REQUEST FOR RECONSIDERATION

Applicant, Evolv, LLC (“Applicant”), by and through its undersigned counsel, hereby responds to the above-captioned Office Action.

I. STATEMENT OF FACTS.

On June 5, 2015, Applicant filed U.S. Application Serial No. 86/653,053 (“Application”) for the above-captioned DNA mark (“Applied-For Mark” or “Applicant’s Mark”). The Application was filed on a 1(b) “intent-to-use” basis pursuant to 15 U.S.C. § 1051(b), and identified the following goods in International Class 034: “Electronic cigarettes; Oral vaporizers for smokers; Oral vaporizers for smoking purposes” (“Applied-For Goods”).

On July 22, 2015, Examining Attorney Thomas Young (“Examining Attorney”) issued an office action alleging a likelihood of confusion pursuant to 15 U.S.C. § 1052(d) with U.S. Registration Nos. 3,845,178 and 4,673,836.¹ This first office action also provisionally cited

¹ US Reg. No. 3,845,178 (now cancelled) identifies a DNA mark for use with “disposable cigarette lighters”, while US Reg. No. 4,673,836 identifies a DNA VAPOR mark for use with “Chemical flavorings in liquid form used to refill electronic cigarette cartridges; Electronic cigarette liquid (e-liquid) comprised of flavorings in liquid form used to refill electronic cigarette cartridges” in Class 030. The refusal based upon US Reg. No. 4,673,836 remains outstanding in the final office action.

three prior pending applications – U.S. Application Serial Nos. 86/170,050, 86/242,597, and 86/222,287,² indicating that if the same proceeded to registration, they could also block Applicant’s Application. Applicant responded to this first office action on January 14, 2016, and a suspension letter was issued thereafter, on January 27, 2016, in light of the prior pending applications.

On August 13, 2018, with the prior pending applications resolved, the Examining Attorney issued a second office action, now citing U.S. Registration Nos. 4,673,836 (identifying the same DNA VAPOR mark originally cited in the first office action), 5,420,810 (identifying the VAPORDNA & LOGO mark originally provisionally cited in the first office action as U.S. Appl. Ser. No. 86/222,287), and 5,420,811 (identifying the VAPORDNA mark originally provisionally cited in the first office action as U.S. Appl. Ser. No. 86/242,597), and alleging that Applicant’s Applied-For Mark created a likelihood of confusion with these marks pursuant to 15 U.S.C. §1052(d) (DNA VAPOR, VAPORDNA, and VAPORDNA & LOGO hereinafter referred to from time to time as “Cited Marks” or “Cited Registrations”, or separately as a “Cited Mark” or a “Cited Registration”, and their identified goods referred to herein as “Cited Goods”). Applicant responded to the second office action on February 13, 2019, and on February 15, 2019, the Examining Attorney issued the current Final Office Action maintaining the Section

² U.S. Application Serial No. 86/170,050 identified a VAPOR SHARK DNA mark for use with “Electronic cigarettes, excluding cigarette lighters” (now abandoned). U.S. Application Serial Nos. 86/242,597 and 86/222,287 identify VAPORDNA and VAPORDNA & LOGO marks, for use with “Electronic cigarettes; Electronic cigarette refill cartridges sold empty; electronic cigarettes for use as an alternative to traditional cigarettes; cartomizers, namely, combination electronic cigarette refill cartridges sold empty and atomizers, sold as a component of electronic cigarettes; electronic cigarette drip tips” and “Computerized on-line retail store services in the field of electronic cigarettes; computerized on-line retail store services in the field of electronic cigarettes and electronic cigarette accessories; on-line retail store services featuring electronic cigarette liquids, electronic cigarettes atomizers; retail electronic cigarette stores; retail electronic cigarette and electronic cigarette accessories store” (now proceeded to registration, with the refusal based upon these VAPORDNA marks continued herein).

2(d) refusal based upon U.S. Reg. Nos. 4,673,836 (for DNA VAPOR), 5,420,810 (for VAPORDNA & LOGO), and 5,420,811 (for VAPORDNA).

Applicant hereby responds and requests reconsideration after the Final Office Action, on the following bases:

- (i) the Applied-For Mark and the Cited Marks differ in appearance, sound, meaning, and commercial impression;
- (ii) the Applied-For Goods and the Cited DNA VAPOR Goods differ;
- (iii) the Applied-For Mark, for use with other, closely similar goods, and the Cited Marks have co-existed on the USPTO Principal Register and in the commercial marketplace for a number of years, and during that time there have been no known instances of actual confusion.
- (iv) the Cited DNA VAPOR Mark and the Cited VAPORDNA Mark – which are more similar to each other than either of them is to the Applied-For Mark – have coexisted on the USPTO Principal Register for 1-1/2 years and in the commercial marketplace for more than six years; if VAPORDNA can coexist with DNA VAPOR, then surely DNA can coexist with both of them as well; and
- (v) Applicant’s good faith intent in selection of its Applied-For Mark.

Accordingly, for the above reasons as further discussed herein, Applicant respectfully requests that the Examining Attorney reconsider and reverse his 2(d) refusal with respect to all Cited Marks, and allow the Application for registration on the USPTO Principal Register.

II. LAW & ARGUMENT: THERE IS NO LIKELIHOOD OF CONFUSION BETWEEN THE APPLIED-FOR MARK AND THE CITED MARKS.

The Trademark Trial and Appeal Board (the “Board”) and the courts look to a number of factors when determining whether there is a likelihood of confusion between allegedly conflicting trademarks. These factors include, without limitation, the following:

- (i) The similarity or dissimilarity of the marks in their entireties as to appearance, sound, meaning, and commercial impression;
- (ii) The similarity or dissimilarity of the goods and/or services as identified in the application or registration;
- (iii) The similarity or dissimilarity of established, likely-to-continue trade channels used to distribute the goods and/or services offered under the two marks;
- (iv) The degree of care that purchasers of the goods and/or services offered under the two marks are likely to exercise, i.e., “impulse” versus careful, sophisticated purchasing;
- (v) The fame or strength of the prior mark;
- (vi) The number and nature of similar marks in use on similar goods and/or services;
- (vii) The intent of the junior user in selecting its mark; and
- (viii) The nature and extent of any actual confusion, or the length of time during which there has been concurrent use without evidence of actual confusion.

See, e.g., In re E.I. Du Pont de Nemours & Co., 476 F.2d 1357 (C.C.P.A. 1973) (cited in numerous Federal Circuit Court and Board decisions to provide the “likelihood of confusion” standard). See also Gibson Guitar Corp. v. Paul Reed Smith Guitars, LP, 423 F.3d 539 (6th Cir. 2005) (citing similar factors); Jet, Inc. v. Sewage Aeration Systems, 165 F.3d 419, 421-22 (6th Cir. 1999) (citing similar factors).

As demonstrated herein, a preponderance of the above-listed factors weighs against a likelihood of confusion. These factors – including without limitation significant differences between the Marks, differences between the Applied-For Goods and the Cited DNA VAPOR

Goods, the lack of fame or strength in the Cited Mark, Applicant's intent in selecting the Applied-For Mark, and the length of time during which there has been concurrent use without evidence of actual confusion – outweigh any minor commonalities and tilt the balance strongly against any likelihood of confusion. For these reasons, Applicant respectfully requests that the Examining Attorney reconsider and reverse his 2(d) refusal and allow the Application for registration.

A. The Applied-For DNA Mark And The Cited Marks Differ In Appearance, Sound, Meaning, And Overall Commercial Impression; As Such, This Factor Weighs Against Any Likelihood Of Confusion Between The Marks.

Potentially conflicting marks must be compared by examining them in their entireties rather than breaking them up into their component parts for comparison. McCarthy on Trademarks, § 23.41 (4th Ed., 2013). See, e.g., China Healthways Institute, Inc. v. Wang, 491 F.3d 1337, 1340 (Fed. Cir. 2007); Recot, Inc. v. Becton, 214 F.3d 1322 (Fed. Cir. 2000). See also, Estate of P.D. Beckwith, Inc. v. Comm'r of Patents, 252 U.S. 538 (1920). Following this well-established anti-dissection rule, the “...standard for infringement does not depend on how closely a fragment of a given use duplicates the trademark, but on whether the use in its entirety creates a likelihood of confusion.” Fuel Clothing Co., Inc. v. Nike, Inc., No. 3:12-00555-MBS, 2014 WL 1155402, *16 (S.D.S.C. Mar. 20, 2014) (referencing Anheuser-Busch, Inc. v. L. & L. Wings, Inc., 962 F.2d 316, 319 (4th Cir. 1992)). See M2 Software, Inc. v. M2 Commc'ns, Inc., 450 F.3d 1378 (Fed. Cir. 2006) (finding no likelihood of confusion even though each of the marks at issue contained an identical dominant term).

See also Miguel Torres v. Bodegas Muga, 176 Fed. Appx. 124 (Fed. Cir. 2006) (holding that the TORRES mark and the TORRE MUGA mark were somewhat dissimilar in their appearance, sound, connotation, and commercial impression, and as such, there was no

likelihood of confusion); Therma-Scan, Inc. v. Thermoscan, Inc., 295 F.3d 623 (6th Cir. 2002) (properly focusing on total effect of two marks, comparing color schemes, lettering styles, and designs, as well as words, to determine that two marks are sufficiently different to avoid confusion); Recot, Inc. v. Becton, 214 F.3d, 1322 (reversing Board for improperly dissecting conflicting marks to determine likelihood of confusion); Dreyfus Fund, Inc. v. Royal Bank of Canada, 525 F. Supp. 1108 (S.D.N.Y. 1981) (considering words, designs, and logos in determination of whether two marks are confusingly similar); Colgate Palmolive Co. v Carter Wallace, Inc., 432 F.2d 1400 (Fed. Cir. 1970); Republic Steel Corp. v. M.P.H. Manufacturing Corp., 312 F.2d 940 (C.C.P.A. 1963) (holding that, because the TRUSS-SKIN and TRUSCON marks differed in appearance and meaning, there was no likelihood of confusion where both marks were used on steel building products); Coca-Cola Co. v. Snow Crest Beverages, 162 F.2d 280 (1st Cir. 1947) (reversing lower court's finding of likelihood of confusion, based on overall inspection of two marks, including type font and color as important considerations); McCarthy on Trademarks, § 23:41 (2008).

Similarity of two marks in one respect – in sight, sound, or meaning – will not automatically result in a finding of a likelihood of confusion, even if the covered goods or services are identical or closely related. TMEP, § 1207(b)(i). Likewise, the fact that two marks share a common component will not necessarily mean that the marks are likely to be confused. See Genesco Inc. and Genesco Brands Inc., 66 U.S.P.Q.2d 1260 (TTAB 2003) (considering the common denominator of the parties' respective marks to hold that an opposition of the applicant's mark was not tenable).

In this case, when the Marks are compared in their entireties, it becomes clear that the Applied-For Mark is significantly different from the Cited Marks in appearance, sound, meaning,

and overall commercial impression. These differences weigh heavily against a likelihood of confusion.

In M2 Software, Inc., the court found that the two marks were not likely to be confused even though each contained an identical dominant term. In that case, the registrant owned the registered mark M2 in standard character form, while the applicant had filed an application to register the mark M2 COMMUNICATIONS, disclaiming the term “COMMUNICATIONS.” M2 Software, Inc., 450 F.3d, at 1379.

The court upheld the Board’s correct finding that the marks, when considered in their entireties, were dissimilar, reasoning that, while a disclaimed term such as “COMMUNICATIONS” may be given little weight, it could not be ignored entirely when comparing the he marks. Id., at 1384. The court also noted that the Board had correctly decided that these marks were not identical, despite the fact that the term “COMMUNICATIONS” did not produce a significant difference in meaning or commercial impression. Id.

The circumstances in the current case are closely similar to those in M2 Software. In that case, the registrant’s mark consisted of a term – M2 – alone, while the applicant’s mark consisted of that same term – M2 – with the addition of the descriptive term – COMMUNICATIONS. Similarly, in this case, the Cited Marks consist of a term – DNA – with the addition of a suggestive term VAPOR, while the Applied-For Mark consists of the same term – DNA – alone.

Just as in M2 Software, where the court found that the applicant’s inclusion of the descriptive term COMMUNICATIONS was sufficient to distinguish two otherwise identical marks, the Examining Attorney here should find that the cited registrants’ inclusion of the suggestive term VAPOR is sufficient to distinguish Applicant’s Mark from the Cited Marks. See also, Packard Press, Inc. v. Hewlett-Packard Co., 227 F.3d 1352 (Fed. Cir. 2000) (holding that

the Board had failed to compare two marks – PACKARD TECHNOLOGIES on the one hand and HEWLETT-PACKARD on the other – in their entireties, and had improperly discounted the term “TECHNOLOGIES”).

Another instructive case is In re Hearst Corp., 982 F.2d 493 (Fed. Cir. 1992). In that case, the court reversed a Board decision that refused registration of a VARGA GIRL mark due to a likelihood of confusion with a previously-registered VARGAS mark. Upon review, the court noted that “[t]he appearance, sound, sight, and commercial impression of VARGA GIRL derive significant contribution from the component ‘GIRL’ . . . we believe that the Board erred in its diminution of the contribution of the word ‘GIRL.’” Id. at 494. Even though the cited VARGAS mark and the applied-for VARGA GIRL mark were used with identical goods (calendars), the court nevertheless held that the weak term “GIRL” was sufficient to differentiate the marks and render them different enough in sound, appearance, connotation, and commercial impression to negate any likelihood of confusion. Id.

The current case is highly analogous to In re Hearst Corp., except, as discussed below in Part II.B, Applicant’s Applied-For Mark and the DNA VAPOR Cited Mark are associated with *dissimilar* goods, thereby making confusion between those Marks *even less likely* here than it was in In re Hearst Corp.

In In re Hearst Corp., the cited VARGAS mark consisted of the distinctive term, VARGAS, while the applicant’s VARGA GIRL mark consisted of that same distinctive term in singular form – VARGA – along with the addition of another descriptive term, “GIRL.” Thus, the two marks in that case were differentiated in appearance, sound, meaning, and commercial impression by the inclusion of a dissimilar descriptive term in one of them. In other words, the court held that the differences in appearance and sound created by the addition of a descriptive,

one-syllable term, was sufficient to eliminate any likelihood of confusion, even where goods were identical.

In the current matter, the Marks are at least as different as the marks were in In re Hearst Corp. Here, as in In re Hearst Corp., the respective Marks are differentiated by the inclusion of a dissimilar albeit suggestive term – VAPOR – in the Cited Marks. This dissimilar suggestive term in the current case, even moreso than the dissimilar descriptive term “GIRL” in In re Hearst Corp., is sufficient to differentiate the Marks, particularly in light of the other factors here (and not present in In re Hearst Corp.) which support a finding of no likelihood of confusion.

In summary, if the differences between the marks in In Re Hearst Corp. were sufficient to avoid a likelihood of confusion even when used with identical goods in identical circumstances, then the analogous (and even greater) differences between the Marks in current case – *in addition to* the differences between the goods – should be sufficient to avoid a likelihood of confusion here.

Given the foregoing differences between the Applied-For Mark and this Cited Marks in their entireties as to appearance, sound, meaning, and overall commercial impression, it becomes clear that this factor weighs heavily against a likelihood of confusion.

B. Applicant’s Applied-For Goods And The Goods Sold Under The Cited VAPOR DNA Mark Are Different; As Such, This Factor Weighs Against Any Likelihood Of Confusion Between The Marks.

Courts consistently state that one cannot justify a finding that goods are similar or related simply because they are sold or used within the same industry. See PC Club v. Primex Techs., Inc., 32 Fed. Appx. 576, 578 (Fed. Cir. 2002) (unpublished) (“Goods are not related because they coexist in the same broad industry”); Kibler v. Hall, 843 F.3d 1068, 1076–77 (6th Cir. 2016)

(“Products belonging to the same industry are not necessarily related”); Recot, Inc. v. Becton, 214 F.3d 1322, 1330, 54 U.S.P.Q.2d 1894 (Fed. Cir. 2000) on remand 56 U.S.P.Q.2d 1859 (TTAB 2000) (“[T]he law is that products should not be deemed related simply because they are sold in the same kind of establishments”).

Here, the Cited Goods identified in the VAPOR DNA registration differ from the Applied-For Goods on their face. The Cited Goods are “chemical flavorings in liquid form used to refill electronic cigarette cartridges; Electronic cigarette liquid (e-liquid) comprised of flavorings in liquid form used to refill electronic cigarette cartridges” in Class 030, while the Applied-For Goods are “electronic cigarettes; Oral vaporizers for smokers; Oral vaporizers for smoking purposes popped popcorn” in Class 34. The mere fact that the Applied-For Goods and the Cited Goods are both used in the e-cigarette and personal vaporizer industry does not necessarily mean that the goods are related in consumers’ minds. Given these facts, confusion as to the source of the Applied-For Goods versus the Cited Goods is unlikely.

Lastly, the Board has recognized that “goods sold through the same channels of trade to the same classes of consumers does not, ipso facto, establish that such products are related.” Ahold Licensing SA v. Premium Nutritional Products, Inc., Opp. No. 91180170, (TTAB Nov. 7, 2011). As such, the Applied-For Goods and the Cited Goods are sufficiently different and unrelated to avoid a likelihood of confusion, particularly in light of the numerous differences between the Marks and the other factors discussed herein.

C. The Applied-For Mark (For Use With Closely Similar Goods) And The Cited Marks Have Co-existed On The USPTO Principal Register And In The Commercial Marketplace For Many Years Without Actual Confusion; As Such, This Fact Weighs Against Any Likelihood Of Confusion.

Another relevant Dupont factor to be considered in analyzing whether a likelihood of confusion exists is the nature and extent of any actual confusion. See In re E.I. DuPont DeNemours & Co., supra, 476 F.2d at 1361. Here, Applicant has used in commerce for more than seven years the term “DNA” in a trademark for use with goods (electronic components in the nature of printed circuit boards (PCBs) for use in electronic devices, including in electronic cigarettes, in Class 009, and printed circuit boards (PCBs) sold as a component of electronic cigarettes, in Class 034) at least as similar to the Cited DNA VAPOR Goods as the Applied-For Goods are, if not more. Likewise, Applicant’s existing DNA goods (PCBs for use with e-cigarettes) and the Cited DNA VAPOR Goods are also closely similar.

Assuming that the Cited DNA VAPOR Mark has been in use in the US since on or around its claimed date of first use of July 15, 2013, these two parties’ Marks containing the common term “DNA” have coexisted in the U.S. market without any evidence of actual confusion for more than six years. Likewise, Applicant owns U.S. Registration No. 4,674,396, for its DNA Mark for use with the above-listed PCB goods for use in and with electronic cigarettes. See Registration Certificate for U.S. TM Reg. No. 4,674,396 attached hereto as Exhibit A. This registration issued on January 20, 2015. The Cited DNA VAPOR Mark coincidentally also registered on that same date – January 20, 2015. Significantly, in the prosecution process, neither of these marks was cited against the other as a prior pending application that could result in a likelihood of confusion refusal. See USPTO TSDR Prosecution History Print-Outs for U.S. Registration No. 4,674,396 (DNA) and U.S. Registration No. 4,673,836 (DNA VAPOR), attached hereto as Exhibit B. Accordingly, in addition to commercial coexistence, the Applied-For Mark and this Cited DNA VAPOR Mark have also

coexisted on the USPTO Principal Register without any confusion – even from the perspective of their examining attorneys – for more than 4-1/2 years.

This absence of actual confusion, in both the commercial marketplace and on the USPTO register, weighs strongly in favor of a finding of no likelihood of confusion between the Applied-For Mark and the Cited DNA VAPOR Mark. See In re General Motors Corp., 23 U.S.P.Q.2d 1465 (TTAB 1992).

Similarly, assuming that the Cited VAPORDNA Marks have been in use in the U.S. since on or around their claimed date of first use of June 5, 2013, these two parties' Marks containing the common term "DNA" have coexisted in the US market without any evidence of actual confusion for more than six years. Likewise, Applicant's U.S. Registration No. 4,674,396, for its DNA Mark for use with the above-listed PCB goods for use in and with electronic cigarettes issued on January 20, 2015. The Cited VAPORDNA Registrations issued on March 13, 2018. Significantly, in the prosecution process, Applicant's Reg. No. 4,674,396 was not cited against either of the VAPORDNA applications in a likelihood of confusion refusal. See USPTO TSDR Prosecution History Print-Outs for U.S. Registration No. 4.674,396 (DNA) and U.S. Registration Nos. 5,420,810 (VAPORDNA & LOGO) and 5,420,811 (VAPORDNA), attached hereto as Exhibit C. Accordingly, in addition to commercial coexistence, the Applied-For Mark and these Cited VAPORDNA Marks have also coexisted on the USPTO Principal Register without any confusion – even from the perspective of their examining attorneys – for almost 1-1/2 years.

This absence of actual confusion, in both the commercial marketplace and on the USPTO register, weighs strongly in favor of a finding of no likelihood of confusion between the Applied-For Mark and the Cited VAPORDNA Marks. See In re General Motors Corp., 23 U.S.P.Q.2d 1465 (TTAB 1992).

D. The Cited DNA VAPOR Mark And The Cited VAPORDNA Marks Are More Similar To Each Other Than Either Of Them Are To The Applied-For Mark; Since These Cited Marks Are Able To Coexist In The Commercial Marketplace And On The USPTO Register Without Confusion, The More Distinguishable Applied-For Mark Should Be Able To Coexist Without Confusion As Well; This Factor Also Weighs Against Any Likelihood Of Confusion.

As discussed in the previous Section, the Cited DNA VAPOR Mark and the Cited VAPORDNA Marks – which are more similar to each other than either of them is to the Applied-For Mark – have coexisted on the USPTO Principal Register for 1-1/2 years and in the commercial marketplace for more than six years. See Exhibits A, B, and C. During that time, there have been no known instances of actual confusion, and the examining attorneys conducting the prosecution of the various applications for these Marks did not cite any likelihood of confusion between them either. See id. If these Cited Marks – more similar to each other than any of them are to the Applied-For Mark – can coexist without confusion, then the Applied-For Mark can do so as well. This fact weighs against any likelihood of confusion.

E. Applicant Had A Good-Faith Intent In Selection Of Its Applied-For Mark; Accordingly, This Factor Weighs Against Any Likelihood Of Confusion.

The last Dupont factor to be considered in analyzing whether a likelihood of confusion exists is the intent of the applicant in registering the mark. See In re E.I. DuPont DeNemours & Co., supra, 476 F.2d at 1361. A finding of bad intent on behalf of an applicant in registering a mark weighs in favor of a finding of likelihood of confusion. See, e.g., M2 Software, Inc. v. M2 Communications, Inc., 450 F.3d 1378, 1385 (Fed. Cir. 2006) (noting that a finding of bad faith intent weighs in favor of the registrant).

Here, there is no dispute that Applicant's selection of the Applied-For Mark was made in good faith, and there are no facts or evidence that indicate otherwise. There is nothing to suggest that Applicant had a bad faith motive in adopting and seeking to register the DNA Mark, or is seeking to trade on either Cited Registrants' goodwill. Accordingly, this Dupont factor also weighs against any likelihood of confusion.

III. CONCLUSION

For the foregoing reasons, it is clear that there will be no likelihood of confusion between Applicant's Applied-For Mark and the Cited Marks. Thus, Applicant respectfully requests that the Examining Attorney reconsider and withdraw his 2(d) objections contained in the above-captioned Office Action and permit U.S. Application Serial No. 86/653,053 for the DNA Mark for registration on the Principal Register.

Respectfully submitted,

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