


**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of:	)	
	)	
<b>The Aerospace Corporation</b>	)	Attorney: <b>Jared M. Mason</b>
	)	
Serial No. <b>88/357,655</b>	)	Law Office: <b>119</b>
	)	
Filed: <b>March 27, 2019</b>	)	
	)	
Mark: 	)	
	)	

**AMENDMENT AND RESPONSE TO OFFICE ACTION**


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Commissioner for Trademarks  
P.O. Box 1451  
Alexandria, Virginia 22313-1451

In response to the Final Office action dated December 31, 2019, Applicant respectfully submits the following amendment and arguments in support of the application to register the subject trademark.

**NO LIKELIHOOD OF CONFUSION**


A likelihood of confusion inquiry is made on a case-by-case basis using the *du Pont* factors. *See In re E.I. du Pont de Nemours & Co.*, 177 USPQ 563, 476 F.2d 1357 (CCPA 1983). While not every factor is necessarily relevant or of equal weight, the Trademark Office must consider pertinent evidence regarding any factor entered into the record. *Id.* at 568–69. The most compelling factors, namely the similarity of the goods and similarity of the marks may be outweighed by other factors, especially where there is probative fact evidence. *See* T.M.E.P. § 1207.01.

The Examining Attorney has asserted that Applicant’s mark is likely to cause confusion with U.S. Reg. 4853115 for  in Class 042 (“HLXLAB Mark”). Specifically, the Examining Attorney has asserted that Applicant’s mark is likely to cause confusion with the

HLXLAB Mark because of the perceived similarity of the marks and the perceived similarity of the services. Applicant contends that based upon the totality of the evidence in the record, there is no likelihood of confusion as to the source of the services. For all the reasons discussed below, the marks are not similar in appearance and have different commercial impressions, such that consumers of the sophistication level likely to be consumers of either the registrant or the Applicant's goods or services would not be confused as to the source of the goods or services.

**A. Differences of the Marks in Appearance and Commercial Impression**

**a. "HLX" is the dominant source-indicating feature of the HLXLAB Mark**

Applicant's mark, , is dissimilar from the HLXLAB Mark in appearance and commercial impression, and as such, Applicant's mark is not likely to cause confusion.

"The test of likelihood of confusion is not whether the marks can be distinguished when subjected to a side-by-side comparison, but whether the marks are sufficiently similar that there is a likelihood of confusion as to the source of the goods or services." T.M.E.P. § 1207.01(b) (citing *Midwestern Pet Foods, Inc. v. Societe Des Produits Nestle S.A.*, 103 USPQ2d 1435, 1440, 685 F.3d 1046 (Fed. Cir. 2012)). Marks must be compared in their entirety in terms of appearance, sound, connotation and commercial impression. *In re Vittera Inc.*, 101 USPQ2d 1905, 1908, 671 F.3d 1358 (Fed. Cir. 2012); *Edom Labs., Inc. v. Glenn Lichter*, 102 USPQ2d 1546, 1551 (T.T.A.B. 2012).

If trademarks share a common word or term, the marks may be considered similar in appearance even if one of the marks adds other letters or another word to it, especially if the added material is descriptive or suggestive of the goods or services. Often Examiners will find a likelihood of confusion if the shared portion of the mark is considered to be the dominant element of the trademark. Of course, the inverse is true as well, if two trademarks share a

descriptive word that purchasers *would not perceive as distinguishing source*, then a finding of a likelihood of confusion between the marks is doubtful. Specifically, T.M.E.P 1207.01(b)(vii) states “[w]hen assessing the likelihood of confusion between compound word marks, although each mark must be considered as a whole, it is appropriate to consider *whether a portion of the mark is dominant* in creating the mark’s commercial impression.” (Emphasis added). Although there is no mechanical test to select a “dominant” element of a compound word mark, consumers would be more likely to perceive a fanciful or arbitrary term, *rather than a descriptive or generic term*, as the source-indicating feature of the mark. *See, e.g., In re Dixie Rests., Inc.*, 105 F.3d 1405, 1407, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997) (emphasis added). Moreover, if the common element of two marks is “weak” in that it is generic, descriptive, or highly suggestive of the named goods or services, it is unlikely that consumers will be confused unless the overall combinations have other commonality. *See, e.g., Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 1338-40, 115 USPQ2d 1671, 1674-75 (Fed. Cir. 2015); *see also, In re S.D. Fabrics, Inc.*, 223 USPQ 54, 55-56 (TTAB 1984) (holding DESIGNERS/FABRIC (stylized) for retail fabric store services, and DAN RIVER DESIGNER FABRICS and design for textile fabrics, not likely to cause confusion, noting that, because of the descriptive nature of “DESIGNERS/FABRIC” and “DESIGNER FABRICS,” the addition of “DAN RIVER” is sufficient to avoid a likelihood of confusion).

The Examining Attorney alleges that “the appearance of the registrant’s mark makes the “X LAB” feature the most prominent of the same.” Applicant respectfully disagrees. The term “LAB” (short for “laboratory”) is a merely descriptive term, as evidenced by the use of the term “laboratory(ies)” throughout the identification of International Classes 006, 009, 011, and 042 for the HLXLAB Mark to *describe* its goods and services. Moreover, in the Disclaimer



Required section set forth in the Office action received in the instant application on June 17, 2019, the Examining Attorney required disclaimer of the wording “LAB” because it “is not inherently distinctive,” and “at best [is] merely *descriptive* of a characteristic of applicant’s services.” Thus, in view of “LAB” being merely descriptive and “HLX” notably the only stylized portion of the HLXLAB Mark, consumers would be more likely to perceive “HLX” as the dominant source-indicating feature of the HLXLAB Mark, not “LAB.” This is further supported by the existence of numerous registrations owned by the registrant of the HLXLAB Mark, which all include “HLX” as the dominant source-indicating feature of the respective marks. *See, e.g.*, U.S. Reg. Nos. 4737115 for HLXCOLUMN, 4878982 for HLXPOWER, 4906610 for HLXFUME, 4853113 for HLXLIGHT, 4853114 for HLXVENT, 4792466 for HLXBENCH, 4857195 for HLXOFFICE, 4929540 for HLXPIPE, and 4815270 for HLXGRID. Thus, it is clear that not only would consumers likely perceive “HLX” to be the dominant source-indicating feature of the HLXLAB Mark, but that the registrant of the HLXLAB Mark intended “HLX” to be the dominant source-indicating feature of the HLXLAB Mark. Moreover, the USPTO’s Trademark Electronic Search System indicates that there are 3,688 live applications/registered trademarks with the term “LAB” in the mark, which is further evidence that the term “LAB” is weak. Accordingly, as the common element of the two marks (“LAB”) is “weak” in that it is generic, descriptive, or highly suggestive of the named goods or services, likelihood of confusion is unlikely.

**b. The dominant features of the marks are not visually similar**

When the marks at issue are both design marks, the similarity of the marks must be decided primarily on the basis of visual similarity. *E.g., In re Vienna Sausage Mfg. Co.*, 16 USPQ2d 2044, 2047 (TTAB 1990). Although it is not proper to dissect a mark, if one feature of

a mark is more significant than another feature, *greater weight may be given to the dominant feature* for purposes of determining likelihood of confusion. *See, e.g., In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (emphasis added).

The Examining Attorney alleges that “neither applicant nor registrant’s marks contain design elements.” Applicant respectfully disagrees. Both the Applicant’s applied-for mark and the HLXLAB Mark are design marks (stylized logos), each having a design element, as shown in the table below. In fact, Applicant already owns the registered standard character mark (U.S. Reg. 6014807) for “XLAB” in International Class 042.

Mark	Description of Mark
	<p>The mark consists of the letter "X" in orange color. The right tip of the letter "X" is disconnected from the rest of the letter "X." The tip is in the color grey. Next to the letter "X" is the word "LAB" in blue.</p>
	<p>The mark consists of the wording "HLXLAB" in stylized black font on a white background.</p>

As clearly displayed in the table, Applicant’s mark is distinguishable from the HLXLAB Mark, both in their entireties and when comparing their dominant portions. For example, Applicant’s mark includes an italicized orange “X” with a disconnected tip in grey, and the word “Lab” with lower case “ab” in blue. In sharp contrast, the HLXLAB Mark is a stylized design such that the dominant “HLX” portion includes an “HL” uniquely transfused together and a highly stylized “X”, followed by the word “LAB” in all caps.

Therefore, it is clear that the HLXLAB Mark, particularly the dominant “HLX” portion, is not visually similar and does not give the same commercial impression as the Applicant’s mark.

**B. Sophisticated Purchasers would not be Confused**

The fact that purchasers are sophisticated or knowledgeable in a particular field does not necessarily mean that they are immune to source confusion. *See In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993) (indicating that “even sophisticated purchasers can be confused by very similar marks”). However, circumstances suggesting care in purchasing may tend to minimize the likelihood of confusion. *See, e.g., In re N.A.D., Inc.*, 754 F.2d 996, 999-1000, 224 USPQ 969, 971 (Fed. Cir. 1985) (concluding that, because only sophisticated purchasers exercising great care would purchase the relevant goods, there would be no likelihood of confusion merely because of the similarity between the marks NARCO and NARKOMED); *In re Homeland Vinyl Prods., Inc.*, 81 USPQ2d 1378, 1380, 1383 (TTAB 2006).

As previously described, Applicant offers engineering services in the aerospace field. For example, the Applicant applied-for mark is used in conjunction with Applicant’s prototyping lab for the design and building of complex prototypes such as optical laser communications and cube satellites (See Exhibit A). In contrast, the HLXLAB Mark is used in conjunction with services for designing and engineering flexible, completely integrated, infrastructure solutions for laboratory environments, such as by providing covers ventilation and media supply for laboratories (See Exhibit B). Therefore, any consumer interacting with Applicant’s applied-for mark would have specifically sought or commissioned the specific prototype resulting from the prototyping lab, and would most certainly verify the source prior to completing any transactions. Additionally, any consumer interacting with the registrant’s HLXLAB Mark would potentially be spending hundreds of thousands to millions of dollars as they would be seeking to remodel or build a laboratory environment, and thus would most certainly also verify the source prior to completing any transactions. Accordingly, both potential consumers of the Applicant’s and the

registrant's goods or services would possess a requisite level of sophistication such that neither would be confused as to the source of the goods or services.

**C. Applicant Owns Registration of Standard Character Mark "XLAB"**

Applicant respectfully notes that Applicant is the owner of U.S. Reg. 6014807 for the standard character mark "XLAB" in International Class 042, which registered on March 17, 2020. As Applicant owns the right to use the word mark "XLAB" in relation to engineering services in the aerospace field, Applicant respectfully submits that there would be no likelihood of confusion regarding Applicant's use of the applied-for mark in the relation to the same goods and services.

**AMENDMENT TO DESCRIPTION OF THE MARK**

As requested by the Examining Attorney, Applicant requests amendment of the mark description as suggested in the Office Action. The amendment to the description is requested as follows, with additions in bold):

The mark consists of the letter "X" in orange color. The right tip of the letter "X" is disconnected from the rest of the letter "X." The tip is in the color grey. **Next to the letter "X" is the word "LAB" in blue.**

**DESCRIPTION OF THE MARK**

Applicant agrees that the disclaimer of "LAB" is applicable to International Class 042.

**CONCLUSION**

The foregoing is believed to be a full response to the Office Action. After reviewing arguments set forth herein, Applicant respectfully requests that the Examining Attorney remove the refusal and allow this application to proceed to publication. If the Examining Attorney desires to discuss any of these points by telephone to expedite the processing of this application, he is invited to call the undersigned at the number listed below.

Respectfully submitted,

/Albert K. Heng/

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