

RESPONSE TO FINAL OFFICE ACTION NO. 88349288

To the Commissioner for Trademarks:

INTRODUCTION

This Response is in regard to the Final Office Action issued on January 6, 2020 with respect to Trademark Application Serial No. 88349288 for RIVAL (“Applicant’s Mark”). Applicant hereby submits the following remarks below in support of registration.

The Examining Attorney has refused registration on grounds that Registration No. 4511312 (“Registered Mark”), may present a bar to registration under Trademark Act Section 2(d) on the grounds that Applicant’s Mark, when used in connection with Applicant’s goods/services, so resembles the Registered Mark as to cause a likelihood of confusion. Applicant respectfully disagrees with the Examining Attorney and argues the following:

ARGUMENT

I. Confusion Must Be Probable, Not Possible.

It is well established that for confusion to be likely, the confusion must be probable; it is irrelevant that confusion is merely possible. *Electronic Data Sys. Corp. v. EDSA Micro Corp.*, 23 USPQ 2d 1460, 1465 (TTAB 1992) (standard is likelihood of confusion, “not some theoretical possibility built on a series of imagined horrors”); *Rodeo Collection, Ltd. v. West Seventh*, USPQ 2d 1204, 1206 (9 Cir. 1987) (“probable, not simply a possibility”). Trademark law is “not concerned with mere theoretical possibilities of confusion, deception, or mistake or with de minimis situations but with the practicalities of the commercial world, with which the trademark laws deal.” *Electronic Design & Sales, Inc. v. Electronic Data Systems Corp.*, 21 USPQ2d 1388 (Fed Cir. 1992), quoting *Witco Chem. Co. v. Whitfield Chem. Co.*, 164 USPQ 43, 44-45 (1969).

For the reasons outlined below, Applicant respectfully argues that confusion is not probable in this instance and therefore the refusal should be reversed.

II. Confusion Is Unlikely Because the Goods and Services Are Distinct

It is irrelevant that the goods may be tangentially related by their categorization in IC 009. Rather than semantic generalization of the products, it is consumer perception that is significant for determining product relatedness. *See, e.g., Electronic Data Systems Corp. v. EDSA Micro Corp.*, 23 USPQ 2d 1460, 1463 (TTAB 1992) (“[T]he issue of whether or not two products are related does not revolve around the question of whether a term can be used that describes them both, or whether both can be classified under the same general category”); *UMC Industries, Inc. v. UMC Electronics Co.*, 207 USPQ 861, 879 (TTAB 1980) (“the fact that one term, such as ‘electronic,’ may be found which generally describes the goods of both parties is manifestly insufficient to establish that the goods are related in any meaningful way”); *Harvey Hubbell, Inc. v. Tokyo Seimitsu Co.*, 188 USPQ 517, 520 (TTAB 1975) (“In determining whether products are identical or similar, the inquiry should be whether they appeal to the same market, not whether they resemble each other physically or whether a word can be found to describe the goods of the parties”).

Applicant's Mark is used in connection with "*Electric two wheeled mobility scooters intended for commuting and recreational use*" (emphasis added), whereas the Registered Mark is used in connection with "*Electrically powered wheelchairs [and push chairs] for use by handicapped, infirm and disabled persons; repair and replacement parts for such power wheelchairs, [and push chairs,] namely, wheels, axels, motors, seats, bumpers, fenders, tires, handlebar controls for power wheelchairs, [and push chairs,] arm rests and head rests for use with powered wheelchairs [and push chairs]*" (emphasis added).

While, on the face, there does not appear to be any connection between Applicant's goods and the Registrant's goods, the Examining Attorney has attached extrinsic evidence to the Office Action showing that there are some channels of trade in which both Applicant's and Registrant's goods may be found. However, the Examining Attorney misconstrues the issue. Applicant concedes that it is possible both it and the Registrant's goods may be found in some similar retail applications.

Simply showing that two separate goods are sold in the same channels of trade is not dispositive of this matter. Instead, one must also consider the potential consumers of each product. For example, there are millions (if not billions) of products listed on prolific retail websites such as Amazon.com or eBay. This does not mean that there is likely to be confusion among consumers simply because two such products may use similar marks. If there is no overlap in the consumer bases of the two products, there can be no consumer confusion.

Such is the case here. Applicant's goods are "intended for commuting and recreational use". The consumer base for Applicant's goods are those who wish to use its mobility scooters "for commuting and recreational use". In contrast, Registrant's goods are "for use by handicapped, infirm and disabled persons". The consumer base for Registrant's goods are thus, "handicapped, infirm and disabled persons." Such persons cannot, and do not, use mobility scooters that are intended for commuting and recreational use as they are handicapped, infirm, or disabled. Because there is no overlap in the consumer bases of Applicant's and Registrant's goods, there is no likelihood of consumer confusion as to the source of each good.

III. Doubts Must Be Resolved in Applicant's Favor.

For the above-stated reasons, it is unlikely that the co-existence of the Applicant's mark and Registrants' mark will lead to consumer confusion. At a minimum, Applicant has raised clear doubts about whether the marks are confusingly similar. The law states that doubts "should be resolved in Applicant's behalf..." *In re Aid Laboratories Inc.* 221 USPQ 1215, 1216 (TTAB 1993) (PEST PRUF not merely descriptive for animal shampoo with insecticide); *In re American Hospital Supply Corp.*, 219 USPQ 949 (TTAB 1983); *In re Gourmet Bakers. Inc.*, 173 USPQ 565 (TTAB 1972). *See also In re Morton-Norwich Products, Inc.*, 209 USPQ 791 (TTAB 1981); and *In re Grand Metropolitan Foodservice Inc.*, 30 USPQ2d 1974, 1976 (TTAB 1994).

CONCLUSION

In light of the foregoing argument, Applicant respectfully requests that the Examiner withdraw the Section 2(d) refusal of Applicant's application and allow the application to proceed with registration.