

**UNITED STATES DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE**

In Re the Application of:)	
)	
Applicant: Space Exploration Technologies Corp.)	
)	Examining Atty: Joanna E. H. Fiorelli
Mark: STARSHIP)	
)	Law Office: 105
Serial No.: 88/201,852)	
)	
Class: 39)	
)	
Filed: November 20, 2018)	
_____)

RESPONSE TO FINAL OFFICE ACTION

In response to the Final Office Action issued May 5, 2020 (the “Office Action”) in connection with the above-captioned application (the “Application”) to register the mark STARSHIP (“Applicant’s Mark”), Space Exploration Technologies Corp. (“Applicant”), by and through counsel, submits the following.

I. THERE IS NO LIKELIHOOD OF CONFUSION BETWEEN APPLICANT’S MARK AND THE CITED MARK

The Examiner has concluded that Applicant’s Mark is likely to cause confusion with the subjects of U.S. Registration Nos. 5,751,529, 5,784,018, and 5,790,086 (the “Cited Registrations”) for the trademark STARSHIP (the “Cited Mark”) in the name of Starship Technologies OÜ (“Registrant”).

Among the relevant factors to be considered in determining whether there is a likelihood of confusion between marks are:

- The similarity of the compared marks

- 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;
- The channels of distribution of the goods or services;
- The sophistication of the purchasers of the goods or services; and
- The nature and extent of any actual confusion.

In re E.I. Du Pont De Nemours and Co., 476 F.2d 1357, 1361 (CCPA 1973).

As discussed in further detail below, the application of these factors in this case compels the conclusion that there is no likelihood of confusion between Applicant's Mark and the Cited Mark. In particular, the respective services offered under the marks do not compete with each other, are not meaningfully related, are for very different targeted purposes, are sold to sophisticated, discerning consumers, and the marks as applied to the respective services have drastically different connotations.

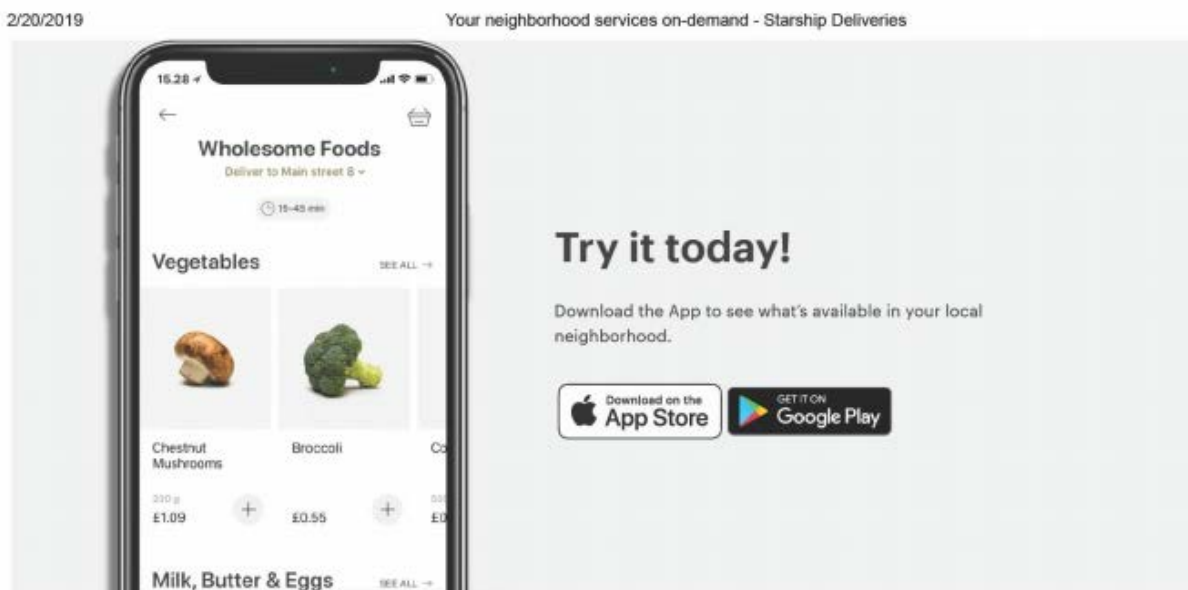
A. Applicant's Services Are Not Related to the Services Offered Under the Cited Mark.

There is no likelihood of confusion here because the services offered under the parties' marks are not competitive, related or complementary to each other, and are offered through different channels of trade. The relatedness inquiry focuses on whether goods or services with comparable marks are similarly marketed and appeal to common customers. TMEP § 1207.01(a)(i). Even goods or services that "coexist in the same broad industry," are not necessarily related. *Therma-Scan Inc. v. Thermoscan Inc.*, 63 USPQ2d 1659, 1663 (6th Cir. 2002) (holding that although the marks at issue coexist in a very broad industry of medical applications of

thermology and infrared identification of heat, parties' goods are not so related that any confusion is likely to occur.)

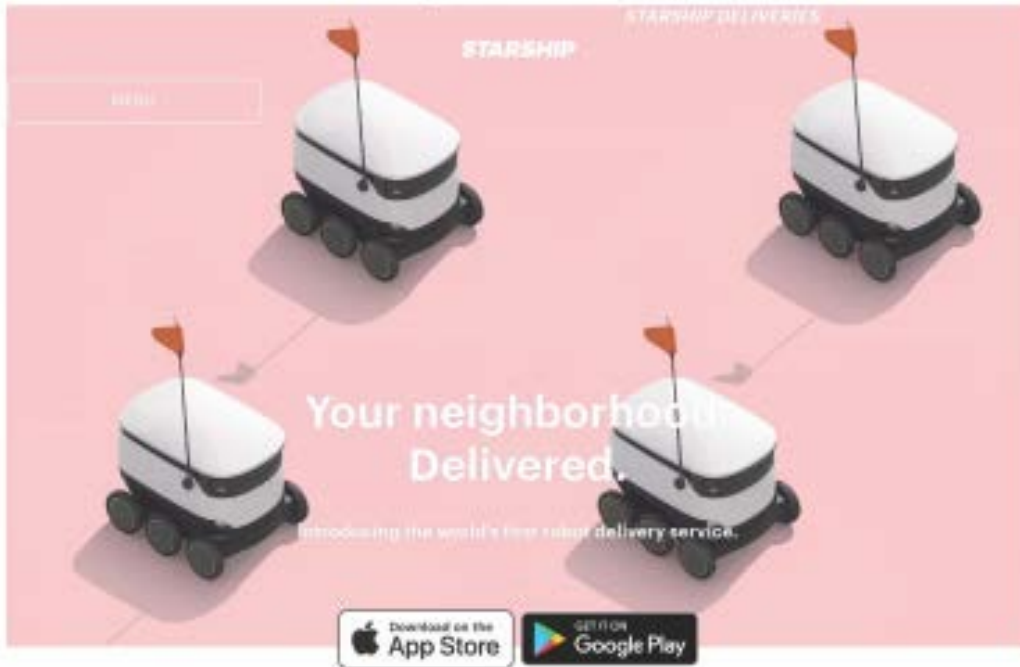
If goods and services are not related or marketed in such a way that they would be encountered by the same persons in situations that would create the incorrect assumption that they originate from the same source, then, *even if the marks are identical*, confusion is not likely. T.M.E.P. § 1207.01(a)(i). *See, e.g., Shen Mfg. Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 1244-45, 73 USPQ2d 1350, 1356 (Fed. Cir. 2004) (reversing TTAB's holding that contemporaneous use of RITZ for cooking and wine selection classes and RITZ for kitchen textiles is likely to cause confusion, because the relatedness of the respective goods and services was not supported by substantial evidence).

The Cited Registrations cover, in relevant part, “[t]ransport, delivery and shipping of goods” and [t]ransport, delivery and shipping of goods except for passenger travel purposes” in Class 39. As seen below and in Exhibit A to the Declaration of Katherine Green (“Green Decl.”), Registrant’s specimen of use shows the Cited Mark is used in connection with an on demand, app-based robot delivery service.



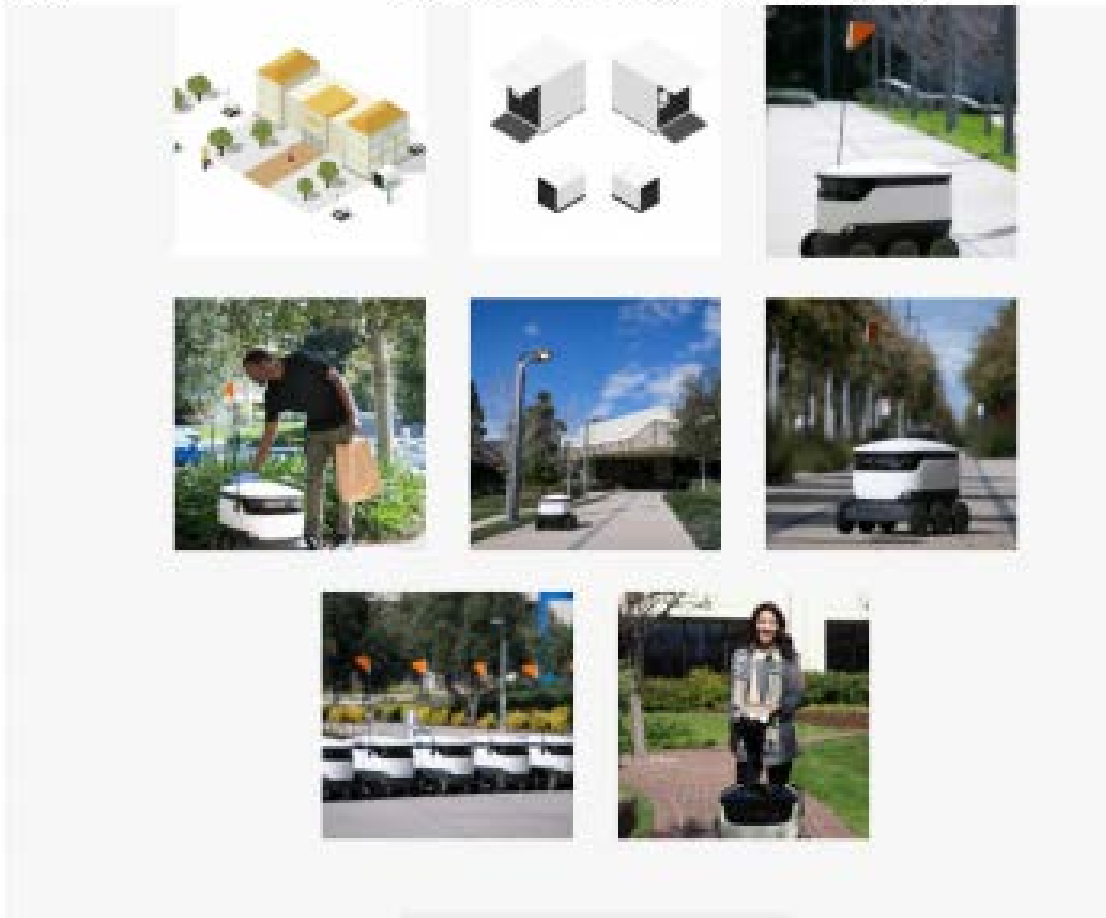
2/20/2019

Your neighborhood services on-demand - Starship Deliveries



2/20/2019

World's first robot delivery service for corporate and academic campuses



As seen in the specimen, customers access Registrant’s shipping services by downloading a mobile app. Green Decl., Ex. A at pg. 1. Customers use the app to order food, drink and snack items to be delivered by small, autonomous robots. In addition to grocery items, the robots may also be used to deliver small packages. *Id.* at pg. 7.

Registrant’s transport and delivery services necessarily involve highly localized ground delivery as the small, unmanned robots Registrant uses clearly do meet legal requirements for travel on roads and highways. Moreover, the size of the robots limits the items that can be transported using Registrant’s services to items that would fit into a standard sized ice chest. As seen in the specimen of use, these characteristics make Registrant’s shipping services ideal for use by individuals living and working on academic and corporate campuses and for quick neighborhood deliveries. Green Decl., Ex. A pg. 8.

In sharp contrast, Applicant’s Mark covers “[l]aunch services, namely, launching of rockets carrying the payloads of others into space.” Unlike Registrant’s services providing transportation and delivery of goods, which are conventional services marketed through ordinary marketing channels, Applicant’s services require the launching of rockets carrying payloads into space—a fact which cannot be over-emphasized. Applicant’s launch services are among the most highly specialized services in the world, and are intended for, and can be used by, only a very small pool of potential customers comprised of companies and governments with specific needs to launch objects into outer space, and the budget to do so.

Despite these differences, which are facially sufficient to preclude consumer confusion, the Examiner has expressed concern that Applicant’s launch services may be considered a subset of Registrant’s “transport, delivery, and shipping of goods.” As a factual matter, only the most strained interpretation, completely divorced from how that phrase is commonly used and

understood, could Applicant's services constitute "transport, delivery and shipping of goods." FedEx provides transport, delivery and shipping of goods. See Green Decl., Ex. B, federal trademark registration owned by Federal Express Corporation. The United States Postal Service provides transport, delivery and shipping of goods. See Green Decl., Ex. C, printout of website at USPS.com. Postmates provides transport, delivery and shipping of goods. See Green Decl., Ex. D, federal trademark registration owned by Postmates Inc. None of them offer launch services, and no consumer would reasonably assume that they do.

As a legal matter, Applicant respectfully submits that Registrant's description of services would be impermissibly broad if it encompassed both Registrant's app-based, highly localized ground delivery services and the launch of rockets carrying payloads into space. It is not reasonable "from a commercial viewpoint" that the Cited Mark would be used in connection with both. See TMEP § 1402.03; *In re Port Huron Sulphite & Paper Co.*, 120 USPQ 343 (TTAB 1959) (identification of "paper other than board papers" approved because of evidence of actual use on various types of paper). The broad interpretation of the Registrant's description of services endorsed by the Examiner would unduly expand the scope of protection granted to Registrant. Trademark rights are limited to actual use in the U.S. marketplace. To allow the Cited Mark to block Applicant's registration of Applicant's Mark for services that Registrant does not offer and that no one could reasonably assume it would offer goes beyond the rights granted by the Registrant's federal registration.

To show "that the same entity commonly provides launching of payloads as well as the transport and delivery of goods," the Examiner cites the websites for Northrup Grumman, SNC, Spaceflight, Inc., and Boeing. This purported evidence shows nothing of the sort and, in fact, supports registration of Applicant's Mark. The companies all specialize in aerospace and defense

technologies, but the Examiner has not introduced any evidence into the record that these companies provide both launch services and “transport, delivery and shipping of goods.”

As to Northrop Grumman , SNC, and Boeing, the evidence identified shows only that these companies, like Applicant, provide space launch services and develop spacecraft used in the connection with the same. The Examiner provides no evidence that these companies offer transport, delivery, and shipment of goods. As to Spaceflight, Inc., the Examiner’s evidence shows that the company provides logistical support related to launch services, namely, booking services for space launches and transport of certain specialized physical objects, such as satellites, to the launch locations. To the extent that these logistical support services are more fairly encompassed by Registrant’s services, there is no evidence that Spaceflight, Inc. also provides launch services. In short, there is no evidence in the record that companies that provide launch services, also provide “transport, delivery, and shipment of goods.”

B. CONSUMER SOPHISTICATION RENDERS CONFUSION HIGHLY UNLIKELY

As the Examiner points out, sophisticated or knowledgeable purchasers are not necessarily immune from source confusion. However, “circumstances suggesting care in purchasing may tend to minimize the likelihood of confusion.” TMEP §1207.01(d)(vii); *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 this case, multiple factors reduce the likelihood of consumer confusion. Applicant’s target consumers are government entities and companies engaged in space-related activities. The decision makers at these entities are highly educated and knowledgeable in their field, and are thus

likely to exercise a high degree of care when making purchasing decisions. Applicant's consumers are also looking to purchase an incredibly niche service. Declaration of Rachel Lovejoy ("Lovejoy Decl.") ¶¶ 3-4. It is well-established that when a purchaser has a "reasonably focused need" or "specific purpose" or plan involving a 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.").

Applicant's target consumers will also be discriminating due to the expensive nature of Applicant's services. The greater the value of a product, "the more careful the typical consumer can be expected to be." *McGregor-Doniger, Inc. v. Drizzle, Inc.*, 599 F.2d 1126, 1137, 202 U.S.P.Q. 81, 92 (2d Cir. 1979) (purchasers of women's overcoats and raincoats priced from \$100-\$900). Here, not only are Applicant's launch services very expensive, the payloads being launched into space are worth many millions of dollars. Lovejoy Decl. ¶ 5. A decision to purchase Applicant's services will not be taken lightly. *Id.*

Because they are sophisticated and because they are looking for the particular, extremely expensive services that Applicant provides, Applicant's space industry customers are highly unlikely to be confused into thinking Applicant's services originate from or are sponsored by Registrant, which provides transport, delivery and shipping services (specifically local grocery and package delivery services through an app).

Similarly, the purchasers of Registrant's services are not likely to be confused in their purchasing decisions based on the existence of Applicant's Mark. Consumers looking to have a

package delivered are not going to be confused and mistakenly believe that there is any connection between those services and Applicant's launch services, regardless of their level of sophistication.

C. APPLICANT'S MARK AND THE CITED MARK HAVE DIFFERENT CONNOTATIONS

Even marks that share similarities in sight and sound can be unlikely to cause confusion if they convey different meanings. *See, e.g., Champagne Louis Roederer, S.A. v. Delicato Vineyards*, 148 F.3d 1373, 1374-75 (Fed. Cir. 1998) (CRISTAL and CRYSTAL CREEK, both used for wine, were not confusingly similar because CRISTAL suggested the clarity of the wine or bottle while CRYSTAL CREEK suggested a clear creek or stream); *Lever Brothers Company v. The Barcolene Company*, 174 USPQ 392 (C.C.P.A. 1972) (ALL CLEAR for household cleaner not likely to cause confusion with ALL for same goods); *Jacobs v. International Multifoods Corp.*, 212 USPQ 641 (C.C.P.A. 1982) (BOSTON SEA PARTY for restaurant services would not be confused with BOSTON TEA PARTY for food products despite similarities in appearance.)

Applicant's STARSHIP mark is suggestive of aircraft that travels into outerspace. The Cited Mark has no such connotation. Given the terrestrial limitations of Registrant's services, its use of STARSHIP is, on its face, ironic. Applicant's Mark has no such connotation. The different meanings that Applicant's Mark and the Cited Mark convey, in light of the vastly different services offered under each, are sufficient to distinguish the marks for purposes of use and registration and avoid confusion.

II. CONCLUSION

In short, the Cited Mark and Applicant's Mark are readily distinguishable because of the significantly different services, which are different in kind and in purpose and would be viewed in distinguishable market contexts, as well as differences in the marks themselves. Additionally, consumer sophistication and the specialized and expensive nature of Applicant's make confusion

between the marks high unlikely. For the reasons set forth above, Applicant respectfully requests that the Examiner withdraw the citation and approve this application for publication.

Respectfully submitted,

Date: November 5, 2020

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