IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Jaguar Land Rover Limited

Application No.: 79158508

Mark: DISCOVERY

Class: 28

Atty. Docket No.: LAND7944TIX

Examining Attorney: Timothy Schimpf / Law Office 113

RESPONSE TO OFFICE ACTION

Dear Sir:

This document is filed in response to the Examining Attorney's Office Action sent to WIPO on January 1, 2015. Applicant respectfully requests that the Examining Attorney reconsider his refusal to register the mark. Applicant submits that the mark is properly registrable in accordance with the Trademark Act.

A. Section 2(d) Likelihood of Confusion Refusal

The Examining Attorney has refused registration of Applicant's Mark based on a perceived likelihood of confusion under Section 2(d) with the following mark:

> DISCOVERY CHANNEL (U.S. Registration No. 3204240) for, in relevant part, "toy action figures and accessories therefor; play figures" in Class 28.

For the reasons discussed below, Applicant respectfully requests withdrawal of the refusal to register Applicant's Mark.

1. The Standard for Determination of Likelihood of Confusion

Likelihood of confusion between marks is determined on a case-by-case basis. *In re*

Dixie Restaurants Inc., 41 USPQ2d 1531, 1533 (Fed. Cir. 1997). The examining attorney is to apply each of the applicable factors set out in *In re E.I. DuPont DeNemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (CCPA 1973). The relevant DuPont factors are:

> (1) the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression;
>
> (2) the similarity or dissimilarity and nature of the goods or services as described in an application or registration or in connection with which a prior mark is in use;
>
> (3) the similarity or dissimilarity of established, likely-to-continue trade channels;
>
> (4) the conditions under which and buyers to whom sales are made, i.e., impulse vs. careful, sophisticated purchasing;
>
> (5) the number and nature of similar marks in use on similar goods; and
>
> (6) the absence of actual confusion as between the marks and the length of time in which the marks have co-existed without actual confusion occurring.
>
> *Id.*

Whether a likelihood of confusion exists involves a two-part analysis, while considering the relevant *Du Pont* factors. First, the marks are compared for similarities in appearance, sound, connotation, and commercial impression. *In re E. I. du Pont de Nemours & Co.,* 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973). Second, the goods or services are compared to determine whether they are similar or related or whether confusion as to origin is likely based on the activities surrounding their marketing, including considering the channels of trade and the conditions under which the respective marks are encountered in the marketplace. *See Du Pont,* 177 USPQ 563, 567 (C.C.P.A. 1973); *In re National Novice Hockey League, Inc.,* 222 USPQ 638 (TTAB 1984); *In re August Storck KG,* 218 USPQ 823 (TTAB 1983); *In re Int'l Tel. and*

Tel. Corp., 197 USPQ 910 (TTAB 1978); *Guardian Prods. Co., v. Scott Paper Co.,* 200 USPQ 738 (TTAB 1978); TMEP § 1207.01 *et seq.*

Applying the legal standards as enumerated above, it is clear that confusion is not likely to exist and Applicant's Mark is entitled to registration.

2. Marks Differ in Sound, Appearance, Connotation and Commercial Impression

Admittedly, Applicant's Mark and the Cited Mark share the common word "Discovery", however, the marks are not identical in terms of appearance and sound. Additionally, they are not identical in connotation and commercial impression, and thus cannot be said to be identical. *See* J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition*, § 23.21 ("[S]imilarity as to one aspect of the sight, sound and meaning trilogy will not *automatically* result in a finding of a likelihood of confusion when the goods are identical or closely related."). DISCOVERY in Applicant's Mark has a specific meaning and connotation that will be recognized by consumers. Specifically, DISCOVERY refers to Applicant's DISCOVERY vehicle, a well-known vehicle model that is the subject of United States Registration Nos. 1898830 and 1301508. As noted in this registration, Applicant's DISCOVERY vehicle was first used in 1983, over 30 years ago. The DISCOVERY vehicle is a classic, popular, well-recognized, and highly prized and sought-after vehicle. The description of goods for Applicant's Mark is "scale model and toy model motor land vehicles and kits thereof". As such, in the context of Applicant's applied-for-mark, consumers will recognize the meaning and connotation of Applicant's Mark, will know that Applicant is the source of the goods offered under the mark, will not be confused as to the cited mark, and will understand the goods offered under Applicant's mark are model replicas of the well-known DISCOVERY vehicle.

By contrast, according to a Wikipedia entry attached as Exhibit A, the cited DISCOVERY CHANNEL mark is a cable and satellite channel that provides programming primarily related to popular science, technology and history. Registrant sells merchandise related to its programming as shown on its webpage attached as Exhibit B. The relevant consumers – viewers of the DISCOVERY CHANNEL- will recognize the cited goods as being associated with Registrant and will not be confused by Applicant's Mark. The addition of the word "Channel" in the Cited Mark distinguishes it from the Applicant's mark in appearance, sound, connotation and makes certain that consumers will associate goods sold under the CITED MARK only the Registrant – a well-known cable and satellite television channel.

A likelihood of confusion inquiry goes to the cumulative effect of the differences in the marks and the goods or services at issue. *Federated Foods, Inc. v. Fort Howard Paper Co.*, 192 USPQ 24, 29 (C.C.P.A. 1976). Even with respect to marks that may appear similar in the abstract, there may be a finding of no likelihood of confusion where consumers are not likely to assume that the goods or services to which the marks are applied share a common source. In this case, Applicant's Mark is distinguishable in connotation and commercial impression from the Cited Mark and confusion, therefore, is not likely.

3. Applicant's Goods are Distinguishable from the Goods in the Cited Mark

It is well settled that, "there can be no rule that certain goods or services are *per se* related, such that there must be a likelihood of confusion from the use of similar marks in relation thereto." TMEP § 1207.01(a)(iv), *citing to, Information Resources Inc. v. X*Press Information Services*, 6 USPQ2d 1034, 1038 (TTAB 1988) (regarding computer hardware and software); *Hi-Country Foods Corp. v. Hi Country Beef Jerky*, 4 USPQ2d 1169, 1171 (TTAB 1987) (regarding food products); *In re Quadram Corp.*, 228 USPQ 863, 865 (TTAB 1985)

(regarding computer hardware and software); *In re British Bulldog, Ltd.*, 224 USPQ 854, 855-56 (TTAB 1984) and cases cited therein (regarding clothing). *See also M2 Software, Inc. v. M2 Communications, Inc.,* 450 F.3d 1378, 78 USPQ2d 1944, 1948 (Fed. Cir. 2006) (regarding software-related goods).

Applicant's Mark is not likely to cause confusion with the Cited Mark because the goods are not related and are not similar in function or customer base. The model and toy vehicles based off of Applicant's well-known vehicle model could not be confused with the types of merchandise sold by Registrant because they are used for different purposes and are purchased by different customers. The purchasers of Applicant's goods are enthusiasts of Applicant's high-end luxury vehicle. The purchasers of the cited goods are generally fans and viewers of the Registrant's cable and satellite television channel. The respective consumers will not be confused as to source.

The Examining Attorney does not provide any evidence showing or suggesting that the parties' respective goods are of a kind that emanate from a single source. While certain goods in the broad field of games and playthings could be considered similar in certain contexts, such is not the case here. The facts and circumstances of this case show that Applicant's goods are not related to the goods of the Cited Mark based on the differences in the form, function, and purpose of the goods. Here, consumers would not be likely to be confused as to source.

4. Goods are Marketed Differently and Travel in Different Channels of Trade

Applicant's Mark is not likely to be confused with the Cited Mark because the goods are not marketed to the same target consumer, nor do they travel in the same channels of trade. When conducting a likelihood of confusion analysis, courts have held, "[i]f the goods or services in question 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. TMEP § 1207.01(a)(i), (bold emphasis added), *citing to, Shen Manufacturing Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 73 USPQ2d 1350 (Fed. Cir. 2004) (cooking classes and kitchen textiles not related); *Local Trademarks, Inc. v. Handy Boys Inc.*, 16 USPQ2d 1156 (TTAB 1990) (LITTLE PLUMBER for liquid drain opener held not confusingly similar to LITTLE PLUMBER and design for advertising services, namely the formulation and preparation of advertising copy and literature in the plumbing field); *Quartz Radiation Corp. v. Comm/Scope Co.*, 1 USPQ2d 1668 (TTAB 1986) (QR for coaxial cable held not confusingly similar to QR for various products (*e.g.*, lamps, tubes) related to the photocopying field).

Here, purchasers or users of goods under the Cited Mark are fans and viewers of Registrant's cable and satellite television channel. By contrast, purchasers of Applicant's goods are owners or fans of Applicant's DISCOVERY vehicle and seek to own goods associated with those vehicles, such as toy or scale model replicas of the vehicle. Given these differences, there is no likelihood of confusion between these marks.

5. <u>Summary</u>

In light of the above, Applicant submits that its Mark is different in meaning and commercial impression from the cited registration. The conditions in the relevant marketplace would not give rise to a mistaken belief that the goods of Applicant and the goods of the cited registrant emanate from the same source. Applicant's Mark is clearly distinguishable as a source indicator for Applicant's goods and is not likely to be confused with the Cited Mark under the factors set forth in *In re E.I. DuPont De Nemours & Co.,* 476 F.2d 1356, 177 USPQ 563 (CCPA

1973). As such, Applicant's Mark is entitled to registration under 15 U.S.C. § 1052.

D. Conclusion

In light of the above, Applicant respectfully requests that the Examining Attorney approve the application for publication and allow registration of the DISCOVERY mark.

Respectfully submitted,

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Date: July 14, 2015

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