

Mark: MOVE
Applicant: ITT Manufacturing Enterprises LLC
S/N: 88029883

Response to Office Action

Applicant responds to the Office Action that issued on October 29, 2018. The Office Action refused registration of Applicant's mark based on an alleged likelihood of confusion with Reg. No. 5075691 for Z-MOVE (the "Cited Registration"), owned by Iriso Electronics Co., LTD. For the reasons set forth below, Applicant respectfully requests that the likelihood of confusion refusal be withdrawn.

The Office Action asserts that the marks are confusingly similar because the commercial impression of Z-MOVE is "the move," and that the addition of the phonetic equivalent of the word "the" does not distinguish the marks. However, the evidence that consumers would interpret the letter "Z" as the equivalent of the article "the" is not probative and fails to prove that confusion is likely.

The Office Action includes three exhibits intended to prove that it is common for consumer to substitute the letter "Z" for the word "the," but the evidence is not persuasive. The first citation is a comment from yelp that includes the phrase "ok i wanna let everyone know that she is z best sushi chef in the valley." However, it is impossible to conclude that the author intended to replace the word "the" with the letter "Z." The post is full of typos, including "demo nor" rather than "demeanor," and lacks punctuation and capitalization. It is equally likely that the addition of the letter "Z" resulted from the slip of a finger on a smart phone. Moreover, the reference is over eight years old and not contemporary.

The second reference is a quote from a 2010 blog. Likewise, the age of the article reduces its probative value. In addition, the use of the letter "Z" in this instance is a clear reference to the subject of the post, Queen Zenyatta. The blog post does not establish that consumers are likely to use the letter "Z" in place of the word "the" when the letter "Z" does not have some other significance in context.

The third reference is from a seven-year-old post on an Indian entertainment forum based in Mumbai. Given that the content is from India, it is not evidence of how U.S. consumers would perceive the letter "Z" in this context.

Moreover, while the refusal is based on the theory that the meanings of the marks is nearly identical ("MOVE" versus "THE MOVE"), the Office Action fails to consider the meaning in the context of the goods. Even identical marks can be distinguishable if they have different meanings in context of the goods or services. See In re Sears, Roebuck & Co., 2 U.S.P.Q.2d 1312, 1314 (T.T.A.B. 1987) (holding CROSS-OVER for bras and CROSSOVER for ladies' sportswear not likely to cause confusion where the terms have different meanings as applied to the particular goods); In re British Bulldog, Ltd., 224 U.S.P.Q. 854, 856 (T.T.A.B. 1984) (holding PLAYERS for men's underwear and PLAYERS for shoes not confusingly similar because the marks imply different things in the context of the different goods); and In re Sydel Lingerie Co., 197 U.S.P.Q. 629, 630 (T.T.A.B. 1977) (holding BOTTOMS UP for ladies' and children's underwear and BOTTOMS UP for men's clothing not likely to cause confusion because they have different connotations).

In this case, it is clear from Iriso Electronics' goods that consumers would not associate the letter "Z" with the word "the." According to the company's website, "The Z-Move connector has the structure that allows the connector to move in Z-axis with a fixed contact point, while allowing it to float in the X

and Y direction as well.” See Exhibit A - <https://www.irisconnectors.com/z-move>. Therefore, consumers will recognize that the letter “Z” suggests the “Z-axis,” and that the word “MOVE” suggests the flexible circuit boards.

Applicant’s mark has a significantly different meaning. Applicant’s connectors are for making electrical and telecommunication connections between locomotive cars, and the like - <https://www.itt.com/newsroom/news-releases/2018/itt-veam-previews-new-move-modular-connector-series-at-innotrans-2018>. In this context, “MOVE” refers to the transportation industry, which is a significantly different meaning from that of Z-MOVE. Consumers will readily recognize these different meanings in the context of the goods and will not be confused as to source.

The Office Action also improperly dissects the marks, and fails to consider the commercial impression of the marks on the whole. As a general matter, “[t]he basic principle in determining confusion between marks is that marks must be compared in their entirety. . . . It follows from that principle that likelihood of confusion cannot be predicated on dissection of a mark, that is, on only part of a mark.” TMEP § 1207.01(b) (quoting *In re Nat’l Data Corp.*, 224 U.S.P.Q. 749, 750-51 (Fed. Cir. 1985)). Marketplace consumers will encounter the parties’ respective marks in their entirety, and the impressions that are created will be derived from the marks’ overall presentations. See e.g., *Keebler Co. v. Murray Bakery Products*, 9 U.S.P.Q.2d 1736 (Fed. Cir. 1989) (holding no likelihood of confusion between PECAN SANDIES and PECAN SHORTIES both for cookies). The Court of Appeals for the Federal Circuit has repeatedly admonished that (a) trademarks should be viewed in their entirety as they are perceived by consumers, and (b) trademarks should not be dissected into fragments, with entire elements disregarded.

A case that is particularly instructive is *In re Hearst Corp.*, 25 U.S.P.Q.2d 1238 (Fed. Cir. 1992), in which the Federal Circuit held that there was no likelihood of confusion between VARGA GIRL and VARGAS both for calendars. In reversing the Trademark Trial and Appeal Board, the Federal Circuit stated:

The Board erred in its analytic approach. Although undoubtedly “varga” and “vargas” are similar, the marks must be considered in the way they are used and perceived. Marks tend to be perceived in their entirety, and all components thereof must be given appropriate weight.

The appearance, sound, sight, and commercial impression of VARGA GIRL derive significant contribution from the component “girl”. By stressing the portion “varga” and diminishing the portion “girl”, the Board inappropriately changed the mark. . . . When GIRL is given fair weight, along with VARGA, confusion with VARGAS becomes less likely.

Id. at 1239 (citations omitted). In this case, the addition of the distinguishing element “Z” is sufficient to distinguish the marks, particularly when the different meanings of the marks are taken into account.

Finally, both parties’ goods are complicated technological products that are likely to be purchased with care by sophisticated consumers. See *Standard Knitting Ltd. v. Toyota Jidosha Kabushiki Kaisha*, 77 U.S.P.Q.2d 1917, 1932 (T.T.A.B. 2006) (“it is clear that automobiles are expensive and would only be purchased after careful consideration, thereby reducing the risk of confusion.”); See also Restatement (Third) of Unfair Competition § 21 cmt. h (1995); *Checkpoint Sys., Inc. v. Check Point Software Techs., Inc.*, 60 U.S.P.Q.2d 1609 (3d Cir. 2001) (“When consumers exercise heightened care in evaluating the relevant products before making purchasing decisions, courts have found there is not a strong likelihood of

confusion.”). In this case, both sets of goods are highly technical and are incorporated into complicated systems, such as circuit boards and locomotive cars. The parties’ respective consumers, businesses in the computer and locomotive industries, will likely evaluate the goods with great care before making a purchase, which further reduces the likelihood of confusion.

Accordingly, when considering the full context of the marks and the respective goods, confusion in the marketplace is very unlikely. Applicant respectfully requests that the refusal to register be withdrawn.