

Response for Trademark Application 88055374

Identification of Goods

Applicant has amended the identification of goods as follows:

~~radios; audio receivers;~~ race scanners to listen to race communication at a racetrack

Section 2(d) Refusal Based on Likelihood of Confusion

The Office Action refused registration because of alleged likelihood of confusion of three registrations 5583157/5567927/5472922 (“Cited Registrations”). Applicant respectfully asserts that, in light of the crowded field of registrations for SWITCH, Applicant’s amendment to the identification of goods distinguishes the present application from the Cited Registrations such that there is no likelihood of confusion.

In *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357 (C.C.P.A. 1973), the U.S. Court of Customs and Patent Appeals set forth factors relevant to a determination of likelihood of confusion. These factors include the appearance, sound, meaning and connotations of the respective marks, the goods of the respective marks, and trade channels and level of sophistication of purchasers of these marks. Under these factors, it is respectfully submitted that there is no likelihood of confusion between the marks as set forth below.

A. The *Du Pont* Factors Do Not Support a Finding of Likelihood of Confusion

Relevant *Du Pont* factors in this case are:

- The similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression;
- The dissimilarity of the goods;
- The dissimilarity of established, likely-to-continue trade channels;
- The conditions under which and buyers to whom sales are made, i.e. “impulse” vs. careful, sophisticated purchasing; and
- Any other established fact probative of the effect of use.

See *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 U.S.P.Q. 563, 567 (C.C.P.A. 1973).

Applying the *Du Pont* factors here shows the Examining Attorney erroneously found a likelihood of confusion where none exists.

1. Applicant's Mark and the Registered Mark are Sufficiently Dissimilar in Appearance, Pronunciation, Connotation and Commercial Impression to Avoid Consumer Confusion

Even where two marks contain one or more identical terms, slight differences in the appearance, sound, connotation, or commercial impression conveyed by the marks can be sufficient to dispel confusion. See *Colgate Palmolive Co. v. Carter-Wallace, Inc.*, 432 F.2d 1400, 1402, 167 U.S.P.Q. 529, 530 (C.C.P.A. 1970) (PEAK PERIOD not confusingly similar to PEAK); *In re August Storck KG*, 218 U.S.P.Q. 823, 825-26 (T.T.A.B. 1983) (JUICY 2 not confusingly similar to JUICY BLEND II); *Gen. Mills, Inc. v. Kellogg Co.*, 824 F.2d 622, 627, 3 U.S.P.Q.2d 1442, 1446 (8th Cir. 1987) (OATMEAL RAISIN CRISP not confusingly similar to APPLE RAISIN CRISP, both for breakfast cereal); *Consol. Cigar Co. v. RJR Tobacco Co.*, 491 F.2d 1265, 1267, 181 USPQ 44, 45 (C.C.P.A. 1974) (DUTCH APPLE for pipe tobacco not confusingly similar to DUTCH MASTERS for cigars); *In re Mars, Inc.*, 741 F.2d 395, 222 U.S.P.Q. 938 (Fed. Cir. 1984) (CANYON and CANYON not confusingly similar).

Here, the parties' marks differ significantly in appearance as Applicant's design is different than the Cited Registrations, with different commercial impressions.

2. Applicant's Goods Are Not Related to the Goods Offered Under the Cited Registrations, Making Confusion Unlikely

Applicant's goods include race scanners to listen to race communication at a racetrack. Race scanners allow fans of automobile racing, who are at the automobile race, to listen to drivers and their teams during the race. This is contrasted with the Cited Registrations (all owned by the same company) that are for connections to the Internet, telephone services, and battery chargers.

Where the goods or services "differ in ways that may be deemed material to consumers," there is no likelihood of confusion. *Buitoni Foods Corp. v. Gio. Buton & C.S.P.A.*, 680 F.2d 290, 292, 216 U.S.P.Q. 558, 559 (2d Cir. 1982) (quoting *Vitarroz Corp. v. Borden, Inc.*, 644 F.2d 960, 967, 209 U.S.P.Q. 969, 973-976 (2d Cir. 1981) (finding no likelihood of confusion between BRAVOS for chips and BRAVO'S for crackers)). In the present case, race scanners differ from connections to the Internet, telephone services, and battery chargers in ways that are deemed material to consumers. For example, race scanners provide different functions than connections to the Internet, telephone services, and battery chargers. Race scanners do not require connections to the Internet, telephone services, and battery chargers. Race scanners are not usually sold with connections to the Internet, telephone services, and battery chargers.

The Examiner attached evidence to the Office Action from the USPTO's X-Search database consisting of a number of third-party marks registered for use in connection with the same or similar goods and/or services as those of the Cited Registrations. However, none of the evidence attached by the Examiner includes race scanners. Therefore, the evidence does not support the refusal to register and actually shows that the race scanners are not typically from the same source as the goods and/or

services as those of the Cited Registrations.

3. The Circumstances Under Which the Parties Offer Their Goods, and the Care Consumers Take When Purchasing These Goods, Prevents Consumer Confusion

Under certain circumstances, the relevant purchaser will be more discriminating, necessitating a greater degree of similarity for there to be a likelihood of confusion. Such a heightened standard is appropriate when consumers evaluate expensive or specialty goods or services. *See Weiss Assoc., Inc. v. HRL Assoc., Inc.*, 902 F.2d 1546, 14 U.S.P.Q.2d 1840 (Fed. Cir. 1990); *see also Recot*, 54 U.S.P.Q.2d at 1899. In such situations, the likelihood of confusion analysis expects the buyer to be discriminating, giving careful consideration to the goods and services. *L.J. Mueller Furnace Co. v. United Conditioning Corp.*, 106 U.S.P.Q. 112 (C.C.P.A. 1955); *Kiekhaefer Corp. v. Willys-Overland Motors, Inc.*, 111 U.S.P.Q. 105 (C.C.P.A. 1956).

Applicant's goods (race scanners) are specialty items sold to race fans at the race. Consumers at a sporting event, such as an automobile race, are focused on the race and goods/services related to the race. The goods and services of the Cited Registrations are unrelated to automobile races and, therefore, would not be considered by consumers of Applicant's goods.

Given that the products offered under Applicant's and Registrant's respective marks are marketed to targeted customers, under circumstances where such consumers would exercise a considerable care in making their purchases and would not be considering Applicant's goods at the same time as the goods/service of the Cited Registrations, it is unlikely consumers will be confused.

B. The PTO Has Repeatedly Found Identical Marks Capable of Coexisting Where the Goods and Services are Different.

Given factors such as those discussed above, the Patent and Trademark Office has regularly granted registrations to two registrants for the same mark where the goods/services are different. Below is a table that identifies 32 trademark registrations for the identical mark SWITCH. These 32 registrations are in addition to the Cited Registrations. Clearly the USPTO is granting multiple registrations for the mark SWITCH, as long as the goods/services are different. As can be seen from the table below, three of the registrations for SWITCH have goods/services much closer to the Cited Registrations than the present application:

- Registration No. 5567930 is for "... providing secure environmentally controlled facilities and technical monitoring of computer and telecommunications equipment for others ...";

- Registration No. 4485729 is for "Computer software for navigational

purposes in the field of telecommunications and global positioning receivers; ...”

- Registration No. 3841556 is for “computer consultation in the fields of evaluation, design, configuration, engineering and implementation of telecommunication, computer and data networks ...”

The fact that the USPTO allowed the cited Registrations in light of the three registrations described above, as well as the 32 registration in the table below, make it clear that multiple registrations can be issued for the same mark, as long as the goods/services are different. In the present case, as explained above, Applicant’s goods are more different from the goods/services of the Cited Registrations than the goods/services of the Cited Registrations are from Registrations 5567930, 4485729 and 3841556.

Mark	Reg. No.	Class	Goods/Services
SWITCH	5744646	11	personal, battery-powered light with mounting bracket for attachment to clothing and to headgear
SWITCH	5491561	9	Computer software and hardware for air quality, air conditioning, energy usage and security access and control monitoring and management systems.
SWITCH	5305349	9	Digital media, namely, downloadable audio and video recordings featuring religious subject matters
SWITCH	5741369	28	Archery bows
SWITCH	5672143	25	Clothing used in the promotion of a youth ministry, namely, t-shirts, shirts, hats, caps, visors, jackets, sweaters, vests, sweatshirts, pants, shorts, socks, footwear and wrist bands sold through religious institutions only.
SWITCH	5423167	35	Club services, namely, promoting the interests of car enthusiasts, car club members; Franchise services, namely, offering business management assistance in the establishment and operation of car club and car club area chapters; Providing a web site featuring on-line registration services for car club membership.
SWITCH	5421837	35	Rental services for fine jewelry, costume jewelry, and fashion jewelry.
SWITCH	5303514	9	Firearm triggers
SWITCH	5241587	16	Pens, pencils, markers, decals, stickers, notebooks, note cards, envelopes, paper tablecloths; and pamphlets, brochures, postcards, study guides, curriculum and newsletters, all in the fields of devotional materials, music, worship, outreach, youth ministry, retreats, youth groups, bible study, inspiration, leadership, spiritual growth, discipleship, evangelism, giving and stewardship, sermons, and baptism.

SWITCH	5595970	44	Managed health care services
SWITCH	5541340	44	Managed health care services.
SWITCH	5139647	42	Design and development of websites for others
SWITCH	5134413	9	safety overflow switches for liquids
SWITCH	5131027	5	Dietary and nutritional supplements in nature of pills and capsules used for weight loss and weight management and no other use, for human consumption
SWITCH	50814529	24	Bed blankets; Bed covers; Bed linen; Bed sheets; Bed sheets, fitted bed sheet covers, bed flat sheets, and pillow cases used in the bedding, health care, home-health care and nursing home industries made of biodegradable film created from renewable bio-polymer resources; Bed skirts; Bed spreads; Bed throws; Comforters; Fitted bed sheets; Flat bed sheets; Futon quilts; Pillow cases; Pillow covers; Pillow shams; Pillowcases; Quilt covers; Quilts; Quilts of towels; Sheet sets; Silk bed blankets; Towel sheet.
SWITCH	5006523	9	Downloadable software for matching job-seekers with employers and job opportunities
SWITCH	4642271	9	Digital media playback and inspection software with video and audio format conversion capabilities for the playback of video and audio files, display of video properties, and conversion of media from one format to another.
SWITCH	5567930	42	Colocation facility development services, namely, designing secure, environmentally controlled facilities and technical monitoring of computers and telecommunication equipment of others; providing secure environmentally controlled facilities and technical monitoring of computer and telecommunications equipment for others for business continuity, disaster avoidance and computer recovery services.
SWITCH	4231538	5	Dietary pet food supplements.
SWITCH	4868958	35	Retail store services featuring lighting and lighting fixtures not including lightbulbs.
SWITCH	4394728	35	Online real time auction bidding services for others; and information, advisory and consultancy regarding online real time auction bidding services for others
SWITCH	4485729	09	Computer software for navigational purposes in the field of telecommunications and global positioning receivers; displays, namely, electronic displays and digital signage displays; calculators; measuring apparatus for physical activity; measuring apparatus for heart rate; speedometers; pedometers; altimeters; barometers; directional compasses; velocimeters;

			measuring apparatus for temperature; distance measuring apparatus; measuring apparatus of cadence; measuring apparatus of calorie; measuring apparatus for health indexes; apparatus for managing indicators of well-being; electronic vibrating alerts; satellite navigational system, namely, a global positioning system GPS; auto-electronic navigational system, namely, a global positioning system and handheld computers; satellite global positioning receivers; navigational system for use in tracking location, calculating GPS-based measurements, and navigating to a location.
SWITCH	3324757	20	Furniture for use with bowling and billiards installations, namely, seating furniture, tables, benches, cocktail tables, chairs, coat hangers, wall units, shoe racks and storage racks.
SWITCH	3841556	16, 42	(016) Magazines, newspapers and other printed matter in the nature of newsletters, bulletins, periodicals and brochures related to domain names, telecommunication networks, computer networks and data networks (042) Providing a web-based information portal for research and teaching, namely, creating an on-line community for registered users to participate in discussions, get feedback from their peers, form virtual communities, and engage in social networking; providing computer consultation and information in the field of design of domain name registration software; computer consultation in the fields of evaluation, design, configuration, engineering and implementation of telecommunication, computer and data networks for the research and education sector; providing information and consulting in the fields of design of telecommunication, computer, and data networks, and engineering of telecommunication, computer, and data networks; rental and maintenance, for others, of memory for use as web sites, namely, hosting the web sites of others, hosting of digital content on the Internet, leasing of computer facilities, and application service provider (ASP) services, namely, hosting computer software applications of others; creation and maintenance of web sites for others; technical infrastructure services in the nature of troubleshooting of computer software problems and design, maintenance and updating of computer software for others, all of which is used in connection with the domain names .ch and .li in the context of the worldwide domain name

			system; none of the foregoing related to network switches
SWITCH	3541866	41	Educational Services, Namely, Seminars and Workshops in the Field of Childhood Fitness and Obesity Prevention
SWITCH	3197701	41	religious instruction services; Providing religious education services, namely providing classes, seminars, conferences, workshops and retreats in the field of religion and ministry and distributing course materials in connection therewith; entertainment services in the nature of organizing and producing live and recorded presentations relating to religious, spiritual and theological topics, namely, lectures, music concerts, theater productions, and musical productions; Entertainment services, namely, providing a television program in the field of religious and religious educational subject matter.
SWITCH	3575570	16	Paper Activity Wheels Used to Allot Television Viewing Time for Children, Posters, Printed Activity Cards Containing Activity Ideas for Children, Activity Books for Use by Children and Parents, Magazines in the Field of Childhood Fitness and Obesity Prevention, Log Books, Printed Recipe Cards, Printed Meal Planners in the Nature of Log Books Containing Meal Ideas and Shopping Lists, Stickers, Brochures and Newsletters in the Field of Childhood Fitness and Obesity Prevention
SWITCH	4077438	9	Interchangeable lenses for eyeglasses, sunglasses, reading glasses, and clip-on sunglasses; specifically designed frames for eyeglasses, sunglasses, reading glasses, and clip-on sunglasses designed to fit interchangeable lenses; cases for aforementioned lenses and frames
SWITCH	2905914	16	DESK ACCESSORIES, namely, STAPLERS AND STAPLES
SWITCH	2507318	5	agricultural fungicides.
SWITCH		21	tableware not of precious metal, namely plates, cups and bowls; porcelain serving dishes, namely casseroles, tureens, serving bowls, pitchers, goblets, egg cups, jugs, cans and vases; candlesticks
SWITCH	1865181	9	computer programs for assignment and management of equipment and facilities.

For all of the reasons discussed above, Applicant asserts that there is no likelihood of confusion and respectfully requests that the refusal of the present application be withdrawn.

Mark on Specimen Differs from Mark on Drawing

Applicant is responding to this refusal by submitting a black and white version of the drawing previously submitted.

Applicant is modifying the description, at the suggestion of the Examiner, to: The mark consists of the word "SWITCH" next to a lightening bolt in a broken circle."

Color Drawing

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Applicant is modifying the description, at the suggestion of the Examiner, to: The mark consists of the word "SWITCH" next to a lightening bolt in a broken circle."

If any issues remain, the Trademark Examining Attorney is invited to contact Applicant's attorney Burt Magen by telephone at (415)489-4103.