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Re: Office Action Response- U.S. Application Ser. No. 88296576- 47Z Performance

Dear Ms. Mahmoudi:

The following is 47Z Performance's response to Office Action dated April 30, 2019.

I. Preliminary Refusal Under Section 2(d)

The Examining Attorney has preliminarily refused registration, citing Trademark Section 2(d), 15 U.S.C. § 1052(d), suggesting that the Applicant's mark, a logo, resembles the mark in U.S. Registration No. 4765399 ("Registrant Mark") as to create a likelihood of confusion.

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ARGUMENT AND EVIDENCE

The Trademark Examining Attorney refused registration based on the similarity of the marks and the similarity and nature of the goods and services. Based on the *Du Pont* factors of similarity of the marks, similarity and nature of the goods and services, and similarity of the trade channels of the goods and services[1], Applicant respectfully disagrees with the Trademark Examining Attorney's refusal to register 47Z Performance and presents its response below.

A. There Is No Confusion, Mistake or Deception Between the Applicant's Mark and the Registrant's Mark.

The two relevant factors cited by the Trademark Examining Attorney are (1) similarity of the marks and (2) similarity and nature of the goods and services. Each of these factors will be addressed below. In evaluating the *Du Pont* factors for determining a likelihood of confusion, the marks "must be compared in their entireties and must be considered in connection with the particular goods …" *In re National Data Corp*., 753.2d 1056, 1058 (Fed. Cir. 1985); In *In re E.I. Du Pont de Nemours & Co*., 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973).

As explained herein, 47Z Performance logo is not confusingly similar to Registrant's Mark.

1) <u>In Sound and Commercial Impression, There is No Likelihood of Confusion, Mistake or Deception</u>

The Examining Attorney writes: "Applicant has applied to register the mark **47 Z PERFORMANCE with design** . . . the marks are identical in part in that they both contain the element 47… the first portion of applicant's mark. Consumers are generally more inclined to focus on the first word, prefix, or syllable in any trademark or service mark"

[1] In *In re E.I. Du Pont de Nemours & Co*., 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973)

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These propositions are incorrect in several respects. In its entirety, 47Z Performance has an overall commercial impression that is greatly different from that of the Registrant's Mark. As stated in *In re Nat'l Data Corp.,* 753 F. 2d 1056, 1060 (Fed. Cir. 1985), "the marks must be considered as the public views them, that is, in their entireties." The use of identical words does not automatically make the marks confusingly similar, even if the goods or services are closely related. *First Savings Bank F.S.B. v. First Bank System, Inc.*, 101 F. 3d 645, 653 (10th Cir. 1996) (holding "FIRSTBANK" and "FIRST BANK KANSAS" were not confusingly similar); General Mills, Inc. v. Kellogg Co., 824 F. 2d 622, 687 (8th Cir. 1987) (holding "OATMEAL RAISIN CRISP" did not infringe on "APPLE RAISIN CRISP").

Applicant's mark has a completely different visual and sound appearance and commercial impression than the registrant's logo, it is actually in fact **47Z** as one word and not 47 as the first word.

The logo used by Applicant is 47Z Performance. In the literal sense, it is "47Z" as one word without a space and then "Performance." The numbers 47 and the letters Z are clearly written together and cannot be interpreted as any other number or letter when observed. Additionally, the mark is more stylized than the registered mark and includes small dot/dash patterns on the 47 numbers with a bigger dash on top of 47 and a shadowed box Z next to it with performance written underneath it with a half circle.

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Applicant's mark is stylistically different from the registered mark which could be interpreted to be the letters "LN" or the number "47" inside a black circle.

2) Disclaimer Concedes Descriptiveness.

Registered mark has been disclaimed by the Registrant in Registration No. 4765399. The numbers 47 has been disclaimed because it is descriptive. Specifically, the Registered Mark owner was asked by the Examining Attorney to disclaim 47 because of the following:

> "The Applicant's website states, in part: Limited to a production run of 47 Ronin motorcycles, each hand-built bike will be issued a name - in lieu of a serial number - that corresponds with each of the 47 Ronin of ancient Japanese lore. An initial release of 10 bikes in the original silver and black trim will start at $38,000. There will be multiple incarnations in the line at price points corresponding with their finish and features. Release of the Ronin models will begin in mid-2013 and will occur in stages until the 47th Ronin leaves the workshop, at which time production will cease. The underlining of "47" is by the Examining Attorney for emphasis. Therefore, the wording merely describes of a feature of the Applicant's goods." [2]

By disclaiming a word(s), an applicant impliedly admits descriptiveness, justifying giving less weight to the word(s) in determining likelihood of confusion. *SMS, Inc. v. Byn-Mar, Inc.*, 228 U.S.P.Q. 219 (T.T.A.B. 1985). The fact of a disclaimer is evidence that the disclaimed portion was descriptive, weak, and the dominant part of the composite mark is its remainder. McCarthy on Trademarks, § 19:72 (4th Ed. 1999). Since a disclaimer concedes that the term is

[2] Office Action Dated May 23, 2014 for Registered Trademark #4765399 and Serial Number 86195526.

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merely descriptive, arguments to the contrary will not be considered by the TTAB. *In re Pollio Dairy Products Corp.*, 8 U.S.P.Q.2d 2012, n.4 (Bd. Pat. App. & Interferences 1988). When the word(s) of a composite mark have been disclaimed, the disclaimed segment is "not usually regarded as the dominant part of a mark." *County Floors, Inc. v. Gepner*, 930 F.2d 1056, 18 U.S.P.Q.2d 1577 (3d Cir. 1991).

Under traditional disclaimer practice, an applicant whose composite mark is dominated by non-registrable matter cannot obtain registration by disclaimer. *Dena Corp. v. Belvedere International, Inc.*, 950 F.2d 1555, 21 U.S.P.Q. 1047, 1051 (Fed. Cir. 1991). A disclaimed segment of a composite mark is regarded as a weaker and less dominant portion which makes a lesser impact on the consuming public. A disclaimed segment of a composite registration is not the "dominant" part. McCarthy on Trademarks, § 23:45 (4^{rh} Ed. 1999); Bank of America National Trust & Savings Association v. American National Bank, 201, U.S.P.Q. 842 (T.T.A.B. 1978).

In the present case, the registrant's disclaimer is deemed to be a concession that "47" is descriptive. Absent contrary proof of descriptiveness in the registrant's USPTO file, the TTAB would not consider contrary arguments at this time. "47" is to be accorded lesser weight, if no weight. Accordingly, the Examining Attorney must give these words a minimal degree of weight in light of the entire mark when determining likelihood of confusion, mistake or deception.

3) Dissimilarity in Nature of Goods and Services

If the goods and 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), citing *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1371 (*emphasis added*); (noting "there is nothing in the record to suggest that a purchaser of test preparation materials who also purchases a luxury handbag would consider the goods to emanate from the same source when both goods were sold" under the mark, "COACH").

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Here, and as admitted by Registrant *supra,* Registrant is in the business of making motorcycles and specifically in making a series of 47 motorcycles which will have the logo 47 on it. However, even though the registrants have registered the mark as "Structural parts of a motorcycle" their actual production is the motorcycle itself. Whereas, Applicants mark 47Z Performance are for accessories for motorcycles and supermoto bikes and not for an actual motorcycle or the structure of the motor (Please see Exhibit 1 and 2)

This is fundamentally different, as are the essential natures of their respective goods and services and as such are not "related in the mind of the consuming public as to the origin of the goods." See *In re Shell Oil Co.,* 992 F.2d 1204, 2017 (Fed. Cir. 1993).

Applicant respectfully submits that the distinctions between Applicant's and Registrant's business are clearly evident in their respective descriptions of goods and services in the USPTO record, and as evidenced by Exhibit 1 and 2 .

4) Dissimilarity of Established, Likely-To-Continue Trade Channels

In *In re Thor Tech, Inc*., the Trademark Trial and Appeal Board found the use of "TERRAIN" for towable trailers and for trucks was not likely to cause confusion because, although towable trailers and trucks are similar goods, their respective natures differ and their channels of commerce differ. 113 U.S.P.Q. 2d 1546, 1551 (TTAB 2015).

Following the findings in *In re Thor Tech. Inc.,* the Channels of trade associated with Applicant and Registrant's Mark's respective business are quite distinct from one another.

As stated earlier, above, the goal was to create 47 Ronin ***motorcycles***, (emphasis added) each hand-built bike would be issued a name in lieu of a serial number that corresponds with each of the 47 Ronin of ancient Japanese lore and the brand would discontinue once the 47 bikes

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have been released. Currently and as attached in Exhibit 3, their website states that production has been completed and states the following:

> "with the final bikes rolling off the assembly line last December, Ronin production has now ceased. We have closed the workshop and design studio and have put spare parts in storage. It has always been the intent of Ronin to shutter the doors once the 47 bikes were complete. A moment in time."

Registrant and Applicant's goods and services do not travel in the same channels of trade, nor are consumers of each party's respective services and products likely to encounter the other's mark. The "nature" of their respective marketing endeavors, businesses, products and services are entirely distinct from one another. In addition to the differences in trade channels, the Registrant's purpose of obtaining a Trademark originally has come to an end. 47Z Performance goods do not and would not be encountered by the same persons who encounter the Registrant's Mark's goods because a person who is looking for Registrant's good would be looking for a limited edition Japanese Motorcycle, while the person looking for Applicant's good would be looking to purchase an accessory to add on to their supermoto bike or motorcycle.

II. Specimen Illegible and Differs on Drawing and Specimen

Applicant hereby amends and attaches a legible specimen as requested.

III. Disclaimer

The Applicant submits a disclaimer stating the following:

> "No claim is made to the exclusive right to use "PERFORMANCE" apart from the mark as shown."

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Conclusion

For all of the reasons stated herein, 47Z Performance is not likely to cause confusion with the Registered Mark. Applicant's logo, goods are different in nature and will not be in the same trade channels as those of the Registered Mark. Applicant submits this application and respectfully requests that the Trademark Examining Attorney approve 47Z Performance for publication in the Official Gazette and to proceed to registration on the Principal Register.

Thank you for your consideration.

Sincerely
The Chidolue Law Firm

By:

/s/Ayesha Chidolue
Ayesha Chidolue, Esq.

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Exhibit 1-From Registrants "47" motorcycle series

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Exhibit 2- Applicant's motorcycle accessories

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Exhibit 3-From Registrants website under “present”

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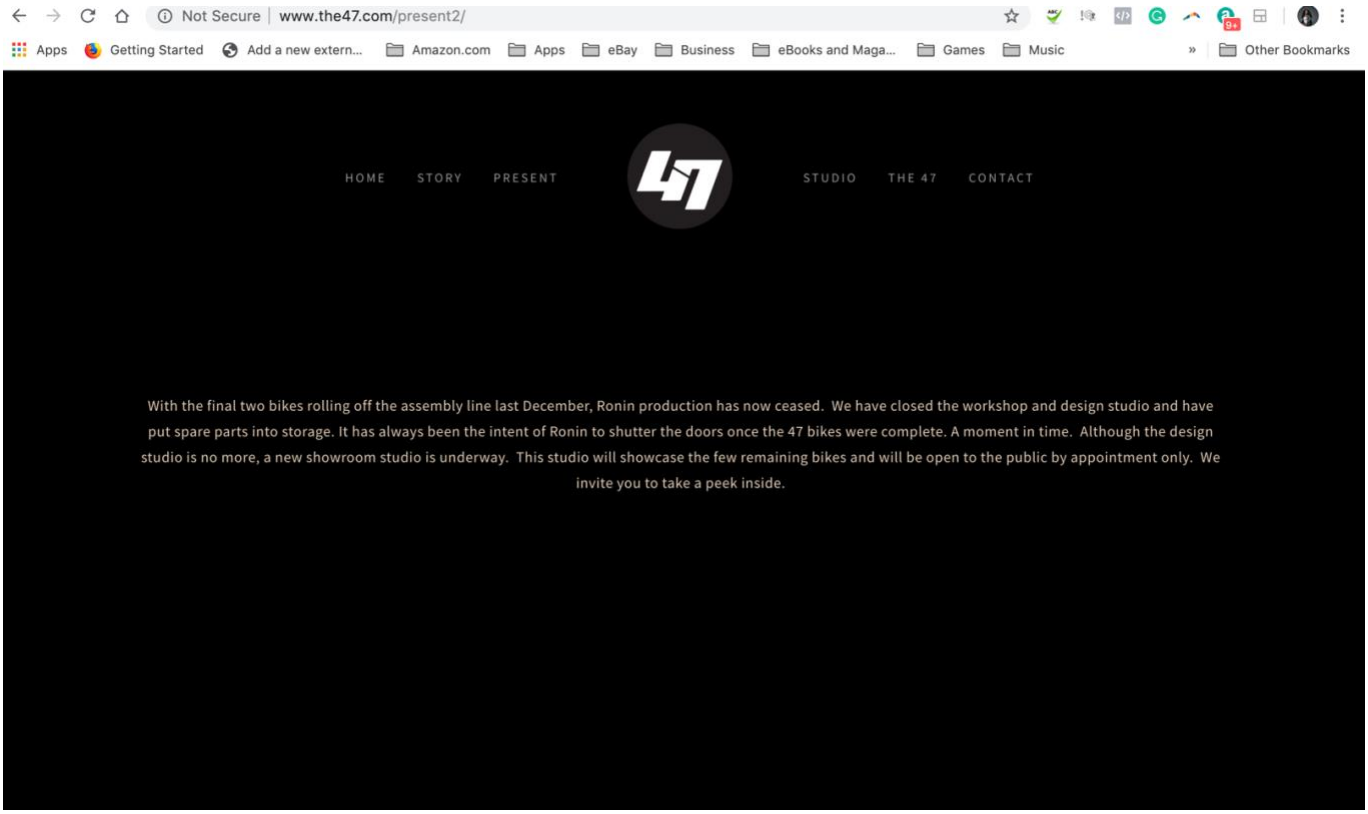
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CONTACT
With the final two bikes rolling off the assembly line last December, Ronin production has now ceased. We have closed the workshop and design studio and have put spare parts into storage. It has always been the intent of Ronin to shutter the doors once the 47 bikes were complete. A moment in time. Although the design studio is no more, a new showroom studio is underway. This studio will showcase the few remaining bikes and will be open to the public by appointment only. We invite you to take a peek inside.