

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of Dinan Corp.

Serial No.: 88/369,893

Filed: April 3, 2019

Mark: The logo for Dinan Shockware, featuring a stylized 'D' in a circle followed by the words 'DINAN' and 'SHOCKWARE' stacked vertically.

Examining Attorney
Megan K. Hartnett
Law Office 123

RESPONSE TO OFFICE ACTION


Applicant, Dinan Corp. (“Applicant”), acknowledges receipt of the Office Action dated June 20, 2019 (“Office Action”). Please consider the following response to the Office Action.

I. AMENDMENT

Applicant requests the identification of goods and services be amended as follows:

- International Class 9: Electronic motor vehicle suspension tuning kits comprised of an electronic control unit that monitors suspension performances and delivers re-calculated sensor values to the original suspension control unit to increase suspension performance; **downloadable** computer software that monitors suspension performance and delivers re-calculated sensor values to the original suspension control unit to increase suspension performance

II. RESPONSE

The Examining Attorney has refused registration of Applicant’s  mark (“Applicant’s Mark”) in connection with “electronic motor vehicle suspension tuning kits comprised of an electronic control unit that monitors suspension performances and delivers re-calculated sensor values to the original suspension control unit to increase suspension performance; downloadable computer software that monitors suspension performance and delivers re-calculated sensor values to the original suspension control unit to increase suspension performance” in class 9 (“Applicant’s Goods,” as amended above) on the ground that, under

Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d), it is likely to be confused with a cited registration for the mark SHOCKWEARS (Reg. No. 1,942,827) (the “Cited Registration”) owned by Outwears, Inc. (“Registrant”) for use in connection with “covers fitted to protect shock absorbers for motor land vehicles” in class 12 (“Registrant’s Goods”).

Applicant respectfully submits that Applicant’s Mark is distinguishable from the Cited Registration and that there is no likelihood of confusion under the test set forth in *In re E.I. DuPont de Nemours & Co.*, 476 F.2d 1357, 1361 (C.C.P.A. 1973) and other cases evaluating the likelihood of confusion test under Section 2(d) of the Lanham Act. As set forth in more detail below, Applicant’s Mark is not confusingly similar to the Cited Registration because Applicant’s electronic tuning kits and software for vehicle suspension systems are distinguishable from the covers for shock absorbers identified in the Cited Registration. *See In Re Northside Imports, Inc.*, SERIAL 77440023, 2012 WL 2588558, at *7 (T.T.A.B. 2012) (non-precedential) (finding no likelihood of confusion and observing, “[w]e cannot conclude, simply because the term ‘automotive parts’ can be used to broadly describe both applicant’s [goods] and the registrant’s goods, that the goods are related.”). Confusion is also unlikely because Applicant’s Goods are and will be purchased by sophisticated, highly-discriminating consumers who use them for entirely different applications than Registrant’s Goods.¹ *See, e.g., In Re the Boler Co.*, SERIAL 77059048, 2009 WL 625567, at *6 (Feb. 17, 2009) (non-precedential) (finding no likelihood of confusion between applicant’s suspension systems and registrant’s tires sold under virtually identical marks in part because the relevant consumers were sophisticated). Moreover, the

¹ The Application was filed on an intent-to-use basis because Applicant is currently selling “computer software that monitors suspension performance and delivers re-calculated sensor values to the original suspension control unit to increase suspension performance” but is not yet selling “electronic motor vehicle suspension tuning kits comprised of an electronic control unit that monitors suspension performances and delivers re-calculated sensor values to the original suspension control unit to increase suspension performance.” Any references to Applicant’s current sales in this Response refer to Applicant’s software.

differences between Applicant's Mark and Registrant's mark when considered in their entirety, including that Applicant's Mark incorporates its proprietary logo and corporate name, mitigate potential confusion. *See In Re Avnet, Inc.*, 195 U.S.P.Q. (BNA) ¶ 185 (T.T.A.B. 1977) (addition of applicant's house mark, CHANNEL MASTER, sufficient to distinguish applicant's mark CHANNEL MASTER CHROMA-KING from registered mark, COLOR KING). The risk of Applicant's Mark being confused with the Cited Registration is further reduced because Registrant's shock absorber covers are marked with Registrant's corporate name. *See In Re Hyundai Motor Am.*, SERIAL 78889340, 2009 WL 4086577, at *6 (Sept. 14, 2009) (non-precedential) (finding no likelihood of confusion between applicant's automobiles and registrant's tires sold under the identical mark in part because registrant's goods were marked with its corporate name).

A. Shock Absorber Covers are Not Closely Related to Electronic Tuning Kits and Software for Vehicle Suspension Systems.

Applicant's Goods and Registrant's Goods can both be broadly classified as "automotive goods" but that is where the similarities end. In *In Re Bayco Products, Ltd.*, SERIAL 78565383, 2007 TTAB LEXIS 387, at *1 (T.T.A.B. 2007) (non-precedential), the applicant sought registration of BAYCO for "battery booster cables for automotive and truck use" in class 9. The application was refused based on prior registration for the identical mark BAYCO for "metal automatic valves - namely, flanged swing check valves, and spring-actuated check valves and air relief valves; spring actuated pressure fill and vent caps for fuel tanks" in class 9. *Id.* at *1. Reversing the refusal, the Board wrote, "[t]he fact that the involved goods are both in the general auto parts and accessories field is not sufficient to establish the relatedness of the goods." *Id.* at *10. Moreover, the Board "explicitly eschew[ed] any *per se* rule that everything sold in an auto

parts outlet – whether found online or located in a traditional bricks-and-mortar location – is related.” *Id.* at *11.

Similarly, *In re Hyundai*, the Examining Attorney refused to register the mark ECHELON for “automobiles” in class 12 based on a purported likelihood of confusion with a prior registration for the identical mark for “automotive tires” in class 12. 2009 WL 4086577, at *1. The Board reversed, noting “[w]hen it comes to likelihood of confusion, trademark practitioners and jurists know that there are no *per se* rules as to the relatedness of goods.” *Id.* at *6. “[M]erely because two products are attached or used together does not necessarily mean they are closely related.” *Id.* at *3. And in *In re The Boler Company*, the Board reversed the Examiner’s refusal to register the mark QUAANTUM for “trailer suspension systems, incorporating wheel end systems” in class 12 based on alleged likelihood of confusion with a prior registration for QUANTUM for “tires” in class 12, noting that consumers were not likely to believe that the two automotive products came from the same source. 2009 WL 625567, at *1, *5.

As in *In re Bayco Products*, *In re Hyundai* and *In re The Boler Company*, Applicant’s application has been refused based on a prior registration for a similar mark used in connection with distinguishable automotive goods. Yet as the Board determined in those cases, the mere fact that Applicant’s Goods and Registrant’s Goods are used in connection with automobiles does not mean that they are closely related, such that confusion is likely. *See also In Re Northside Imports, Inc.*, 2012 WL 2588558, at *7 (“We cannot conclude, simply because the term ‘automotive parts’ can be used to broadly describe both applicant’s [goods] and the registrant’s goods, that the goods are related.”). That Applicant’s Goods and Registrant’s Goods are both broadly related to a vehicle’s suspension system does not change this conclusion. A

vehicle's suspension system consists of many disparate parts, including tires, springs, sway bars and shock absorbers, among numerous other parts. Indeed, each party's goods in *In re The Boler Company* were related to suspension systems as well but were nonetheless held to be distinguishable.

Even more than in the cases discussed above, consumers simply are not likely to believe that high-tech electronic tuning kits and software for suspension systems are sold by the same company that sells polyester covers for shock absorbers. A useful analogy can be made to the fitness market. In recent years, wrist-wearable smart devices that monitor an individual's fitness across a variety of measures have become popular. The Apple Watch is an example of such a device. Consumers who come into contact with the Apple Watch and also weightlifting gloves sold under the mark Apple are not likely to believe that both products emanate from the same source, even though both are broadly related to personal fitness. Rather, consumers think it unlikely that a manufacturer of high tech fitness-tracking watches would also sell a low-tech, non-electronic fitness product, weightlifting gloves. Similarly, consumers are unlikely to believe that the maker of electronic tuning kits and software for suspension systems also sells shock absorber covers or vice versa.

Evidence submitted by the Examining Attorney strengthens, rather than undermines, this conclusion because it demonstrates that the same company is unlikely to sell both Applicant's Goods and Registrant's Goods. In *In re The Boler Company*, the Board reversed the Examiner's refusal despite evidence consisting of website screenshots showing that the same retailers sold both tires and suspension systems, noting "the Examining Attorney [has not] met her burden of proving that purchasers encountering trailer suspension systems and tires under the same or similar marks would conclude they originate from the same source." *Id.* at *5. In reaching that

conclusion, the Board noted that, although both products were sold on the same website, they were not sold under the same mark. *Id.* at *4. That is precisely the case here—the Examining Attorney has put forth evidence that the same online retailers sell both shock absorber covers and electronic tuning kits and software for suspension systems but in each case, these products are sold under different marks by different companies. Specifically, in the Office Action, the Examining Attorney attached evidence that online retailer Auto Parts Warehouse sells suspension control modules under the marks Bilstein®, aFe®, Firestone® and GenuineXL® and sells shock absorber covers under the mark Daystar®; online retailer Auto Zone sells suspension control modules under the mark Bilstein® and shock absorber covers under the mark Nolathane®; online retailer CarID sells suspension control modules under the marks Bilstein®, Icon® and KW Suspensions® as well as suspension software under the mark AFCO® and also sells Registrant’s Outerwears® Shockwear® shock absorber covers; and online retailer Napa offers suspension control modules under the Napa® mark, software under the Bosch® mark and shock absorber covers under the Altrom® mark. The Examining Attorney’s evidence demonstrates that, while electronic tuning kits and software for suspension systems and shock absorber covers may be sold by the same retailer, the two classes of products do not typically emanate from the same source such that consumers would expect similarly-branded products to come from the same company. *See In re Bayco Products*, 2007 TTAB LEXIS 387, at *10 (noting that the Examining Attorney’s evidence failed to show that the parties’ products “emanate from the same entities under a single mark.”). Rather, consumers understand that these distinct products are sold by different companies.

As in *In re Bayco Products*, *In re Hyundai* and *In re Boler*, Applicant’s Goods and Registrant’s Goods are not closely related, weighing against a likelihood of confusion.

B. Relevant Purchasers are Sophisticated.

Applicant's customers are careful and highly discriminating, further reducing the likelihood of confusion between Applicant's Mark and the Registered Mark. *See, e.g., Pignons S.A. de Mecanique de Precision v. Polaroid Corp.*, 657 F.2d 482, 489 (1st Cir. 1981) ("Sophisticated consumers may be expected to exercise greater care."). Applicant's electronic tuning kits and software for vehicle suspension systems are not purchased by the average consumer. Rather, Applicant's Goods are purchased by knowledgeable automotive enthusiasts who wish to enhance the suspension performance of their vehicles. *See In re Keith Huber, Inc.*, SERIAL 74674575, 1999 TTAB LEXIS 32 (T.T.A.B. 1999) (non-precedential) (reversing refusal to register DOMINATOR for "industrial trucks equipped for transporting and handling of liquid, solid and semi-solid materials" in class 12 due to prior registrations for PRO DOMINATOR and STREET DOMINATOR, both registered in connection with "intake manifolds for internal combustion engines for land vehicles" in class 12, in part because purchasers of registrant's specialized automotive goods were sophisticated); *In re Bayco Products*, 2007 TTAB LEXIS 387, at *15 (determining that consumers of registrant's specialized automotive goods were "more sophisticated than the average purchasers and hence, would be expected, relatively, to exercise a higher degree of care in making this purchase.").

In addition, Applicant's Goods are relatively expensive, especially when compared to Registrant's Goods. For example, Applicant's Shockware software for BMW electronic damper control suspension tuning retails for \$308.50. *See Exhibit A*. Consumers making expensive purchases will be discriminating and understand that the source of the product they are buying is Applicant. *See Weiss Assoc., Inc. v. HRL Assoc., Inc.*, 902 F.2d 1546, 1548 (Fed Cir. 1990) ("In making purchasing decisions regarding 'expensive' goods, the reasonably prudent person

standard is elevated to the standard of the ‘discriminating purchaser.’”). Moreover, consumers in the market to purchase Applicant’s relatively expensive electronic tuning kits and software for vehicle suspension systems are very unlikely to believe they are somehow affiliated with Registrant’s inexpensive shock absorber covers, which retail for approximately \$30-\$45 (or vice versa).

Because the goods provided by Applicant are not of the type or nature of an inexpensive, off-the-shelf product, consumers make careful purchase decisions, and thus confusion is less likely. *See* 4 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 23:96 (2015).

C. **Because Applicant’s Mark has a Different Spelling, Pluralization and Meaning as Compared to Registrant’s Mark, Incorporation of Applicant’s Corporate Name and Logo Sufficiently Distinguishes the Parties’ Marks.**

In determining whether Applicant’s Mark varies sufficiently from the Cited Registration, the marks should be considered in their entirety. *See* 4 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 23:41 (2015) (“[A]llegedly conflicting marks should be compared by looking at them as a whole, rather than breaking the marks up into their component parts for comparison.”); *see also In re National Data Corp.*, 753 F.2d 1056, 1058 (Fed. Cir. 1985) (“[L]ikelihood of confusion cannot be predicated on dissection of a mark, that is, on only part of a mark.”); *Recot, Inc. v. Becton*, 214 F.3d 1322, 1330 (Fed. Cir. 2000) (reversing Board in part for improperly dissecting conflicting marks to determine if the commercial impressions were confusing). Although inclusion of a junior user’s trade name does not always obviate confusion with an otherwise confusingly similar mark, there is an exception in cases where there are other, recognizable differences between the marks. *See In Re Times Mirror*, 2000 WL 1125574, at *2 (T.T.A.B. 2000) (non-precedential) (“While it is a general rule

that the addition of a trade name or house mark to one of two otherwise confusingly similar marks will not serve to avoid a likelihood of confusion, an exception has been made in those cases where there are some recognizable differences between the assertedly conflicting product marks, so that the addition to one of a trade name or house mark or other such matter may be sufficient to render the marks as a whole distinguishable and thus to avoid confusion.”); *see also In Re Avnet, Inc.*, 195 U.S.P.Q. (BNA) ¶ 185 (T.T.A.B. 1977) (addition of applicant’s house mark, CHANNEL MASTER, sufficient to distinguish applicant’s mark CHANNEL MASTER CHROMA-KING from registered mark, COLOR KING).

When both marks are properly considered in their entireties, Applicant’s Mark,



, is readily distinguishable from Registrant’s mark, SHOCKWEARS.

Applicant’s Mark is spelled differently (“SHOCKWARE” vs. “SHOCKWEARS”) and features a different pluralization (singular vs. plural) as compared to Registrant’s mark. In addition, the parties’ marks have different meanings. As a suffix, “-WARE” generally “occur[s] as the final element in words that refer to a specified kind or class of software,” as it does in Applicant’s Mark. *See Exhibit B.* Conversely, “-WEAR” typically “combines with nouns and adjectives to form nouns that refer to a particular type of clothing.” *See Exhibit C.* This is similar to the way Registrant uses “WEARS” to signify a protective, outer material that “clothes” shock absorbers.

When considered in the context of these differences, Applicant’s use of its “D” logo and trade name, DINAN, distinguishes Applicant’s Mark from Registrant’s mark. *See In Re Times Mirror*, 2000 WL 1125574, at *2 (holding applicant’s mark, THE SPORTING NEWS FANTASY BASKETBALL CHALLENGE, was distinguishable from registrant’s mark, FANTASY BASKETBALL, due to inclusion of Applicant’s trade name in addition to inclusion of term “CHALLENGE” in applicant’s mark). Upon seeing the prominent “D” logo and

DINAN trade name in addition to the differences between the SHOCKWARE and SHOCKWEARS elements, consumers will have no doubt that Applicant is the source of Applicant's Goods.

Because Applicant's Mark incorporates Applicant's corporate name and proprietary logo and because the marks have different appearances, spellings, pluralization and meanings and create different commercial impressions when considered in their entirety, Applicant's Mark can co-exist with the Cited Registration on the Principal Register without any likelihood of confusion.

D. The Marking of Registrant's Goods Further Reduces Any Potential Confusion.

The conditions under which sales are made is relevant to the *du Pont* analysis. In determining whether there is a likelihood of confusion, the Board is "not concerned with mere theoretical possibilities of confusion, deception, or mistake or with *de minimus* situations, but with the practicalities of the commercial world, with which trademark laws deal." *Witco Chemical Co. v. Whiffield Chemical Co.*, 418 F.2d 1403, 1405 (CCPA 1969).

In *In re Hyundai*, the Board recognized tire manufacturers' practice of marking their corporate names on tire sidewalls. 2009 WL 4086577, at *6. The Board acknowledged that "this reality reduces even further any chance of inadvertent confusion, i.e., with both the manufacturer's name and the product/tire name appearing prominently on the tire sidewall." *Id.*




Similarly, Registrant clearly marks its shock absorber covers with its corporate name, "Outerwears":



And as can be seen by the screenshot attached as evidence by the Examining Attorney, Registrant's corporate name is also prominently displayed on online retailers' websites in connection with the sale of Registrant's Goods, further reducing the possibility of confusion:

Order Now, Pay Later with [affirm](#) Fixed monthly payments. How it works?

Outerwears



Outerwears® 30-2616-01 - Shockwear Shock Covers

★★★★★ 0 reviews | Item # mpn4497258075

[View Similar Products](#)

\$43.95

• In Stock (8) - Ships within 24 hrs
Deliver to: 22204 - Arlington, VA [change](#)

! Custom Built / Racing

Fitment Notes:

- Not Vehicle Specific. May require professional installation. Typically used with custom built or racing vehicles

Notes:

- Fits 5" diameter coil eliminator on dirt modified
- Fits Circle Track Late Model/Modified Racing Vehicles

- 1 + [ADD TO CART](#)

♥ Add to Wishlist

Consumers who encounter Registrant's shock absorber covers are therefore certain to understand that Registrant is the source. Thus, this factor, too, weighs against the possibility of source confusion.

III. CONCLUSION

Through the foregoing Response, Applicant believes that it has addressed the issues raised by the Examining Attorney in the Office Action dated June 20, 2019. Applicant respectfully requests that the Examining Attorney withdraw the refusal and approve Applicant's Mark for publication.

Date: August 26, 2019

Respectfully submitted,

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