

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

HYMARK LTD CO

US Serial Number: 88320627

Filed: February 28<sup>th</sup>, 2019

Examining Attorney: Miranda, John Salvador

For: The logo for MOTЕК features the word "MOTЕК" in a bold, sans-serif font. The letter "E" is replaced by a stylized graphic consisting of two parallel horizontal lines with arrowheads pointing to the right, suggesting motion or a double arrow.


**RESPONSE TO OFFICE ACTION 88320627**

To the Commissioner for Trademarks:

**Introduction**

In response to the Office Action dated May 16<sup>th</sup>, 2019, Applicant respectfully requests that the following arguments be considered in support of registration.


The Examining Attorney has refused registration of Applicant's mark MOTЕК under (A) Trademark Act Section 2(d) on the basis of likelihood of confusion with the registered mark Moutec (Reg. No. 5,669,164).

Applicant's mark in its entirety  is for use in connection with "instruments for measuring lengths, electronic slide calipers" in International Class 009. The cited mark MOUТЕC is for use in connection with "Binoculars; Close-up lenses; Cover glass for microscope slides; Diffusers for use in photography; Filters for ultraviolet rays, for photography; Infrared detectors; Lenses for astrophotography; Magnifying glasses; Measuring apparatus, namely, laser distance meters; Microscopes; Monopods used to take photographs by positioning a smartphone or camera beyond the normal range of the arm; Optical lens sights; Optical cables; Optical character recognition (OCR) apparatus; Optical couplers; Optical fibers; Optical lamps; Optical lanterns; Optical lenses; Optical

reflectors; Optical shutters; Range finders for cameras; Sighting telescopes for firearms; Stands for photographic apparatus; Stereoscopes; Telemeters; Telescopes; Telescopic sights for artillery; Thermal imaging cameras; Tripods for cameras; Distance measuring apparatus; Lens filters.” in International Class 009.

The Examining Attorney had determined there is a likelihood of confusion between Applicant’s mark and Registrant’s mark. Applicant respectfully disagrees with the Examining Attorney and argues the following:

### **Rejection Based On Trademark Act Section 2(d) Argument**

Generally, the term MOUTEC, as used by Registrant, is used in connection with optical lenses such as binoculars and range finders for measuring the distance from the user to an object. (See Attachment A); whereas Applicant utilizes its trademark  with reference to a niche market relating instruments for measuring precision lengths of objects otherwise known as digital calipers (See Attachment B).

#### **I. Confusion Must Be Probable, Not Possible to Deny Registration of a Word Mark**

For confusion to be likely, the confusion must be probable; it is irrelevant that confusion is merely possible. *Rodeo Collection, Ltd. v. West Seventh*, USPQ 2d 1204, 1206 (9 Cir. 1987) (“probable, not simply a possibility”). Trademark law is “not concerned with mere theoretical possibilities of confusion, deception, or mistake or with de minimis situations but with the practicalities of the commercial world, with which the trademark laws deal.” *Electronic Design & Sales, Inc. v. Electronic Data Systems Corp.*, 21 USPQ2d 1388 (Fed Cir. 1992), quoting *Witco Chem. Co. v. Whitfield Chem. Co.*, 164 USPQ 43, 44-45 (1969). For the reasons outlined below, Applicant respectfully argues that confusion is not probable in this instance and therefore registration of the Applicant’s mark should be allowed.

## **II. There Is No Likelihood of Confusion Because Applicant's Mark Is Distinct From Registrant's Mark In Appearance, Connotation, Meaning, And Commercial Impression**

The question of whether a likelihood of confusion exists between a registered mark and a mark for which a registration application has been filed depends on “whether the purchasing public would mistakenly assume that the Applicant's goods originate from the same source as, or are associated with, the goods in the cited registrations.” *In re Majestic Distilling Co.*, 315 F.3d 1311, 1315, 65 U.S.P.Q.2d 1201 (Fed. Cir. 2003). This determination must be based on the specific facts of each case, *Jacobs v. Int'l Multifoods Corp.*, 668 F.2d 1234, 212 U.S.P.Q. 641 (C.C.P.A. 1981), according to the factors set forth in *In re E.I. duPont DeNemours & Co.*, 476 F.2d 1357, 1361 (C.C.P.A. 1973). In a likelihood of confusion determination, the marks in their entireties are compared for similarities in appearance, sound, connotation, and commercial impression. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, (C.C.P.A. 1973); TMEP §1207.01(b)-(b)(v).

Several factors in this case substantially diminish any likelihood that consumers will be confused as to the source of Applicant's or Registrant's goods, or will mistakenly assume that they are associated. Applicant contends that the marks are sufficiently different in sight, sound, connotation, meaning, and commercial impression, such that the likelihood of confusion of the source of the goods is not probable.

### **A. Applicant's Mark is Different in Appearance from Registrant's Mark**

The Applicant's mark in its entirety is **MOITEK»»** whereas the Registrant's mark in its entirety reads MOUTEC. This difference in appearance is significant for two reasons: (1) it further bolsters the argument that the respective marks are not likely to result in confusion when compared in their entireties and (2) it drastically alters the differences in meaning and connotation between the respective marks. Put simply, Applicant's applied-for mark **MOITEK»»** is visually and phonetically distinctly different than Registrant's use of MOUTEC. Registrant utilizes the additional letter U phonetically changing the sound of the first syllable from MO to a MOO sound. Moreover, Applicant's mark includes the letter K as opposed to the letter C and also combines the literal element with the

embedded distinctive design which utilizes arrows to highlight the term ‘TEK’ between the abbreviated terms. Applicant’s mark provides a distinctive immediate impressionable difference in appearance in comparison to Registrant’s mark.

**B. Applicant’s Mark Has a Different Connotation and Meaning Than Registrant’s Mark**

Applicant’s mark **MOTEK»»** has a different connotation and meaning than Registrant’s mark MOUTEC. Applicant’s products, namely, electronic slide calipers and instruments for measuring length are often utilized to provide real time feedback while measuring distances relating to moving objects. Thus, the first portion of the mark MO is an abbreviation of the term MOTION and the second portion TEK creatively refers to the term TECHNOLOGY relating to MOTION. Thus, the mark **MOTEK»»** is suggestive of motion related technology products as viewed in the marketplace.

Thus, by comparing the marks in their entirety involving their appearance, sound, connotation and commercial impression, the marks are sufficiently different, and confusion is not likely.

**III. Goods Related To Each Mark Are Not Sufficiently Alike Or Related To Find a Likelihood Of Confusion**

The issue is not whether the goods and/or services will be confused with each other, but rather whether the public will be confused as to their source. *See Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 1329, 54 USPQ2d 1894, 1898 (Fed. Cir. 2000). If 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. *See, e.g., Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1371, 101 USPQ2d 1713, 1723 (Fed. Cir. 2012).

Applicant’s goods and Registrant’s goods are not closely related and are not frequently offered in the same channels of trade, nor would they be encountered by the same purchaser. It is well-settled that

goods and services are considered “related” under Section 2(d) “not because they coexist in the same broad industry, but [only] if the services are marketed and consumed such that buyers are likely to believe that the services, similarly marked, come from the same source, or are somehow connected with or sponsored by a common company.” *Homeowners Group, Inc. v. Home Mktg. Specialists, Inc.*, 931 F.2d 1100, 1109 (6th Cir. 1991) (emphasis added).

Most importantly, Applicant contends that the goods related to each mark are not sufficiently alike or related to find a likelihood of confusion. The Examiner has concluded that “applicant’s and registrant’s goods related” simply on the basis that Registrant’s goods listed may be utilized in a broadly defined “measuring devices, motion control and industrial products.”

Applicant’s amended goods include a unique type of goods, namely, instruments for measuring object lengths, or electronic slide calipers. Registrant’s mark MOUtec is for use in connection with optical range finders for measuring the distance from the user to an object viewed through an optical lens, such as a range finder and laser distance meters measuring apparatus. Under a reasonable interpretation, these goods are sufficiently unrelated and are not sold through the same channels of trade. Put simply, slide calipers would fall in a specific category of measuring objects and precision lengths - and range measuring devices would fall in the unrelated category of optics and range finders for measuring distance from a viewer to an object, a fundamentally different application of measuring lengths/distances.

Applicant’s electronic slide calipers and Registrant’s binoculars and distance to object measuring devices are not sold in the same outlet, not similarly marketed in the same channels of trade, and are not marketed towards the same group of consumers. Thus, not likely to be encountered by the same persons under circumstances that, because of the marks used in connection therewith, would lead to the mistaken belief that they originate from the same source.

#### **IV. There Is Absence of Actual Confusion**

The parties' marks have been coexisting in the marketplace with ample opportunity for such confusion to occur. Due to the above stated reasons, Applicant contends that no actual confusion has occurred.

#### **Examiner's Request for Information Response**

- (1) Explain whether the wording in the mark "MOTЕК" has any meaning or significance in the industry in which the goods are manufactured/provided, any meaning or significance as applied to applicant's goods, or if such wording is a term of art within applicant's industry.

**APPLICANT ANSWER:** The term MOTЕК is not a term of art in the industry. MOTЕК is the combined abbreviated words MOTION (MO) and TECHNOLOGY (TEK).

- (2) Explain whether this wording identifies a geographic place or has any meaning in a foreign language.

**APPLICANT ANSWER:** The wording MOTЕК does not identify a geographical place or have any meaning in a foreign language.

- (3) Submit an English translation of all foreign wording in a mark and a transliteration (the phonetic spelling of the pronunciation, in Latin characters) of all non-Latin characters in a mark. If the wording does not have meaning in a foreign language, applicant should so specify.

**APPLICANT ANSWER:** The wording MOTЕК does not have any meaning in a foreign language.

- (4) What does this wording mean?

**APPLICANT ANSWER:** MOTЕК is the combined abbreviated words MOTION (MO) and TECHNOLOGY (TEK) and has no particular meaning.

## **Final Conclusion**

Collectively in light of these considerations, Applicant submits to the Examiner that by comparing the marks in their entirety involving their appearance, connotation, meaning, commercial impression, different class of purchaser, and differences in channels of trade, the marks are sufficiently different in that there is not a likelihood of confusion as to the goods originating from the same source.

Applicant respectfully requests that the Examining Attorney consider the preceding arguments and that the Section 2(d) Refusal be withdrawn.

In light of the above, Applicant believes that it has responded to all issues raised in the Office Action and respectfully requests that the application be passed to publication. However, should any questions arise with respect to the application or the issues addressed herein, please contact the undersigned.

Respectfully Submitted,

/Bryce D. Miracle/

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