

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Mark: UPVOLT
Serial No.: 88/299683
Docket: TGMB 8902

RESPONSE TO OFFICE ACTION DATED APRIL 2, 2019

This is in response to the office action dated April 2, 2019, wherein the Examining Attorney requested that Applicant amend the Classification of the goods and submit an additional filing fee. The Examiner also indicated that Application No.: 88/299,683, for the mark UPVOLT (the “Applicant’s Mark”) was refused due to a likelihood of confusion with Registration Nos.: 4,824,422 for the mark UPSAVER (the “422 Registration or “Identified Mark”).

I. AMENDMENT TO THE CLASSIFICATION OF GOODS AND MULTI-CLASS APPLICATION

In response to the Examiner’s request that Applicant amend its classification of goods, Applicant requests that it amend its application to add International Class 042 for the following services: design and development of software and hardware for producing, recording and processing digital and analogue signals. Applicant also, hereby submits an additional filing fee.

II. CONFUSION BETWEEN APPLICANT’S MARK AND THE IDENTIFIED MARK IS HIGHLY UNLIKELY

Applicant respectfully disagrees with the Office's assessment that there may be a likelihood of confusion between Applicant's Mark and the Identified Mark. The relevant factors in determining whether a likelihood of confusion exists were set forth in *In re Application of E.I. DuPont de Nemours & Co.*, 177 U.S.P.Q. 563 (C.C.P.A. 1973). Not all of the DuPont factors are, however, relevant to every case, and even one factor may be dispositive on the question of likelihood of confusion. See *Id.* at 567; see also *In re Coors Brewing Co.*, 68 U.S.P.Q. 2d 1059 (Fed. Cir. 2003). Here, the most relevant of the DuPont factors are:

1. The number and nature of similar marks already on the register; and

2. The dissimilarity of the marks in their entireties as to appearance, sound, connotation, and commercial impression.

Both of these factors weigh overwhelmingly against a likelihood of confusion finding.

Marks that share words may coexist when they are not likely to confuse consumers. Even where marks might otherwise be considered similar based on a dominant shared common term, the marks are not likely to confuse consumers where “the marks in their entireties convey significantly different commercial impressions.” MPEP §1207.01(b)(iii) (citing *Citigroup Inc. v. Capital City Bank Group, Inc.*, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011) and *Shen Mfg. Co. v. Ritz Hotel Ltd.*, 73 USPQ2d 1350 (Fed. Cir. 2004)). Further, evidence of third-party use bears on the strength or weakness of a mark, and the weaker an existing mark, the closer an applicant’s mark can come without causing a likelihood of confusion. See *Juice Generation Inc. v. GS Enters. LLC*, 794 F.3d 13334 (Fed. Cir. 2015). In such a case, “the matter common to the marks is not likely to be perceived by purchasers as distinguishing source because it is . . . diluted.” MPEP §1207(b)(iii)(citing *Citigroup Inc.* and *Shen Mfg. Co.*).

Here, the marks are so dissimilar, in terms of both composition and commercial impression, that confusion between the parties' marks is highly unlikely. Further, several third-party marks use the term UP for related goods, and therefore the term is weak and diluted.

A. The Number and Nature of Similar Marks Used on Similar Goods Demonstrates that Confusion is Unlikely Because the Term UP is a Weak Source Identifier When Taken Alone

Confusion is unlikely when the only common elements of two marks is weak due to common use by others. The strength or weakness of existing trademarks is “connected to ‘the number and nature of similar marks in use on similar goods,’” See *Juice Generation Inc.* There are numerous examples of this reasoning in which marks were considered registrable despite containing common terms. See, e.g., *Shen Mfg. Co.* (Finding that RITZ and THE RITZ KIDS create a different commercial impression); *Keebler Co. v. Murray Bakery Prods., Inc.*, USPQ2d 1736 (Fed. Cir. 1989) (PECAN SHORTEES vs. PECAN SANDIES); *Kellogg Co. v. Pack 'Em Enterprises, Inc.*, 21 USPQ2d 1142 (Fed. Cir. 1991) (FROOTEE ICE vs. FROOT LOOPS);

Nutri/Sys., Inc. v. Con-Stan Indus., Inc., 1 USPQ2d 1809 (9th Cir. 1987) (NUTRI/SYSTEM vs. NUTRI-TRIM); *Sears Mortgage Corp. v. Northeast Savings F.A.*, 24 USPQ2d 1227 (TTAB 1992) (APPROVAL PLUS vs. APPROVAL FIRST); *Burns Philp Food, Inc. v. Modern Prods., Inc.*, 24 USPQ2d 1157 (TTAB 1992) (SPICE ISLAND vs. SPICE GARDEN and design); *Stouffer Corp. v. Health Valley Natural Foods Inc.*, 1 USPQ2d 1900 (TTAB 1986) (LEAN CUISINE vs. LEAN LIVING).

Use of a common term by multiple third parties can signify the reduced distinctiveness of similar marks and make confusion unlikely. Consumers recognize this, and distinguish between weak marks on similar goods “on the basis of minute distinctions.” *Standard Brands, Inc. v. RJR Foods, Inc.*, 192 USPQ 383, 385-386 (TTAB 1976). Accordingly, “evidence of third-party use of similar marks on similar goods is relevant to show that a mark is relatively weak and entitled to only a narrow scope of protection.” *Palm Bay Imports v. Veuve Clicquot Ponsardin*, 396 F. 3d 1369 (Fed. Cir. 2005).

A review of the Trademark Register indicates that the term UP occur in a multitude of third-party registrations and applications that have proceeded past examination, which are discussed in more detail below. These third-party registrations relate to IC 009 and 042 in which Applicant’s goods reside.

A search of the register identified other live marks that include the term UP. See the chart below. Most of the marks show below use standard character claims and comprise the term UP combined with one or more secondary terms. Indeed, in those cases, the mark, when taken as a whole, were still considered distinguishable from other marks on the register. Some examples of these marks are as follows:

Serial No.	REG No.	MARK
88317960	5856814	UP GLIDE
88033129	5708541	UPSIGN
87884589	5803218	ZUP
87586254	5754312	AG UP
87829375	5742795	UP & COMING
87007197	5189344	TEXTUP

88283827	5834144	UPZ
88274980	5827492	LEVEL UP
88241132	5806016	UPMELY
88104641	5749708	UP FITNESS
88036238	5690171	UPLEYING
87815526	5865246	UPTAB
87815526	5865246	UPTAB
87786125	5776656	UPTYMA
87655177	5770535	UPUN
87429772	5760227	GO-UP
87729237	5710952	SUP
87193275	5514449	UPTAKE
87488097	5379031	UPEOR
87478884	5390251	UPREV

Accordingly, based on the number of existing registrations formed from the term UP, it is clear that the terms are relatively weak and diluted source identifiers, and are entitled to only a narrow scope of protection.

B. The Differences in the Commercial Impressions of the Marks Make Confusion Highly Unlikely

Among the DuPont factors referenced by the Office are the similarity of the marks. This factor should be evaluated with respect to the “similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.” *Dupont*, 177 U.S.P.Q. 563 (C.C.P.A. 1973). Further, an evaluation with respect to likelihood of confusion “cannot be predicated on dissection of a mark.” *In re National Data Corp.*, 224 U.S.P.Q. 749, 751 (Fed. Cir. 1985); TMEP §1207.01(b). Although one feature of a mark may be more significant in creating a commercial impression, “the ultimate conclusion rests on consideration of the marks in their entireties.” *Id.*

In this case, the commercial impression of Applicant’s Mark is predicated on evaluation of the mark as a whole, while the commercial impression of each earlier mark in the Identified

Registration is similarly predicated on each respective mark as a whole. The Applicant's Mark UPVOLT is significantly different from the term mark cited by the Office. Indeed, the Applicant's mark has a unique commercial impression.

As shown in the above table, when taken as a whole, each mark is clearly distinguishable on its face. Further, none of these marks were rejected because of the close relationship of the goods. Indeed, each mark listed above was reviewed concurrently with the others and none of the marks listed above were rejected on the basis of similarity with earlier registered UP formatives. As discussed above, the extensive variety of existing registrations for UP formatives indicates the weakness of the term UP. The term VOLT allows the mark to be distinguishable when taken as a whole.

In the current case, rather than comparing the marks as a whole, the Office merely compares matter shared by some of the marks i.e. the term UP individually. In doing so, the Office notes that "marks are identical in part and create the same overall commercial impression." The Examiner solely relied on the fact that the term UP was identical. The Examiner's approach strips away the commercial impression of the mark – under the standard applied by the Office, any pair of marks sharing a single word could be considered confusingly similar, and any of marks identified in the previous section of this response would be considered confusingly similar to each and every one of the Identified Registration. The Office never demonstrates that the mere existence of overlapping words in both marks *create[s] a similar overall commercial impression* as required, nor does the Office even attempt to compare the "marks in their entireties." See TMEP §1207.01(b).

It is for this very reason – the potential to strip away the commercial impression of the mark, that the mark UPSAVER, and Applicant's mark UPVOLT are inherently different. The terms SAVER and VOLT not only have phonetic difference, but have no relation in meaning that the marks are sufficiently distinguishable. The consumer, who is used to reviewing many UP marks in commerce, would recognize this distinction.

Further, that the term UP is inherently weak as is demonstrated by the mere fact that there exists a multitude of marks, held by different owners, that would be identical if not for the "something more" provided by the visual and phonetic differences. Accordingly, just as a wide

variety of compound marks incorporating the terms were previously considered registrable, Applicant's unique mark, UPVOLT, should be similarly registrable when taken as a whole.

CONCLUSION

A substantial likelihood that the public will be confused must be shown in order for an application to be rejected on the grounds of likelihood of confusion. In view of the significant differences between the parties' marks, when viewed in light of the inherent weakness of the term UP, confusion is not likely. Accordingly, Applicant requests that the rejection based on likelihood of confusion be withdrawn.