IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of :		SYNTH RIDERS
Serial No.	:	88465148
For	:	remarkable.legal
Examiner	:	Natalie M. Polzer
Law Office	:	108

RESPONSE TO OFFICE ACTION DATED 09/03/2019

This is responsive to Office Action dated 09/03/2019. The Applicant respectfully requests that the application be reconsidered.

BACKGROUND

Applicant Kluge Strategic, Inc. seeks registration of U.S. Serial No.88465148 for SYNTH RIDERS in relation to "downloadable video game software; Downloadable virtual reality game software; all the foregoing excluding downloadable media not as video game software" in International Class 9. The Examining Attorney has refused registration of the mark.

The Examining Attorney alleges that the applied for mark is likely to be confused with the mark(s) listed below. Trademark Act Section 2(d), 15 U.S.C. § 1052(d); see TMEP § § 1207.01 et seq.

•U.S. Registration No. 5447807 for SYNTH RYDER covering "audio and video recordings featuring music and artistic performances; compact discs featuring music; digital music downloadable from the internet; downloadable music files; downloadable musical sound recordings; downloadable ring tones, graphics and music via a global computer network and wireless devices; musical recordings; musical sound recordings; musical video recordings; phonograph records featuring music" in International class 9 and “entertainment services in the nature of presenting live musical performances; entertainment services, namely, non-downloadable ringtones, pre-recorded music, and graphics presented to mobile communications devices via a global computer network and wireless networks; entertainment services, namely, personal appearances by a musical artist; entertainment services, namely, providing a web site featuring photographic, audio, video and prose presentations featuring a musical artist; entertainment in the nature of live performances by a musical artist; fan clubs; music publishing services; production of musical videos; production of sound recordings,” in International Class 41.

APPLICANT'S ARGUMENT THAT THE MARK PRESENTS NO LIKELIHOOD OF CONFUSION

Applicant respectfully disagrees with the Examining Attorney's decision for the reasons discussed below.

The Standard for Determining Likelihood of Confusion

A determination of likelihood of confusion between two marks is determined on a case by case basis. *In re Dixie Restaurants Inc.*, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997). The Examining Attorney is to apply each of the applicable thirteen factors set out in *In re E.I. DuPont DeNemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (CCPA 1973). The relevant DuPont factors as they relate to likelihood of confusion in this case are reviewed below.

The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation, and commercial impression;

In comparing two trademarks for confusing similarity, the Examining Attorney must compare the marks for resemblances in sound, appearance and meaning or connotation. *In re E.I. DuPont de Nemours & Co.,* 476 F.2d 1357, 177 U.S.P.Q. 563 (C.C.P.A. 1973). Similarity in one respect - sight, sound, or meaning - does not support a finding of likelihood of confusion, even where the goods or services are identical or closely related. TMEP §1207.01(b)(i).

It has long been established under the "anti-dissection rule" that "the commercial impression of a trademark is derived from it as a whole, not from its elements separated and considered in detail. For this reason it should be considered in its entirety." *Estate of P. D. Beckwith, Inc. v. Commissioner of Patents*, 252 U.S. 538, 545-46, 64 L. Ed. 705, 40 S. Ct. 414 (1920). It violates the anti-dissection rule to focus on the "prominent" feature of a mark, ignoring other elements of the mark, in finding likelihood of confusion. *Massey Junior College, Inc. v. Fashion Institute of Technology*, 492 F.2d 1399, 181 U.S.P.Q. 272 (C.C.P.A. 1974). See *Franklin Mint Corp. v. Master Mfg. Co.*, 667 F.2d 1005, 212 U.S.P.Q. 233 (C.C.P.A. 1981) ("It is axiomatic that a mark should not be dissected and considered piecemeal; rather,

it must be considered as a whole in determining likelihood of confusion."); *Sun-Fun Products, Inc. v. Suntan Research & Development, Inc.*, 656 F.2d 186, 213 U.S.P.Q. 91 (5th Cir. 1981) (the test is "overall impression," not a "dissection of individual features").

1. No Explicit Rule that Likelihood of Confusion Applies Where Junior User's Mark Contains the Whole of Another Mark.

There is no explicit rule that likelihood of confusion automatically applies where a junior user's mark contains in part the whole of another mark. See*, e.g., Colgate-Palmolive Co. v. Carter-Wallace, Inc*., 432 F.2d 1400, 167 U.S.P.Q. 529 (C.C.P.A. 1970) (PEAK PERIOD not confusingly similar to PEAK); *Lever Bros. Co. v. Barcolene Co.*, 463 F.2d 1107, 174 U.S.P.Q. 392 (C.C.P.A. 1972) (ALL CLEAR not confusingly similar to ALL); *In re Ferrero*, 479 F.2d 1395, 178 U.S.P.Q. 167 (C.C.P.A. 1973) (TIC TAC not confusingly similar to TIC TAC TOE); *Conde Nast Publications, Inc. v. Miss Quality, Inc.*, 507 F.2d 1404, 184 U.S.P.Q. 422 (C.C.P.A. 1975) (COUNTRY VOGUES not confusingly similar to VOGUE); *In re Merchandising Motivation, Inc*., 184 U.S.P.Q. 364 (T.T.A.B. 1974) (there is no absolute rule that no one has the right to in-corporate the total mark of another as a part of one's own mark: MMI MENSWEAR not confusingly similar to MEN'S WEAR); *Plus Products v. General Mills, Inc.*, 188 U.S.P.Q. 520 (T.T.A.B. 1975) (PROTEIN PLUS and PLUS not confusingly similar*).* See *Monsanto Co. v. CI-BA-GEIGY Corp.*, 191 U.S.P.Q. 173 (T.T.A.B. 1976) (use of portion of another's mark to indicate that defendant's product contains plaintiff's product held not likely to cause confusion). Even the use of identical dominant words or terms does not automatically mean that two marks are similar. *Luigino's Inc. v. Stouffer Corp*., 50 USPQ2d 1047, the mark LEAN CUISINE was not

confusingly similar to MICHELINA'S LEAN 'N TASTY though both products were similar low-fat frozen food items and both shared the dominant term "lean." Finally, "marks tend to be perceived in their entireties, and all components thereof must be given appropriate weight." *In re Hearst*, 982 F.2d 493, 494 (Fed.Cir. 1992). In *Hearst*, Applicant registered VARGA GIRL for calendars and was refused registration by the Trademark Trial and Appeal Board because of earlier registration of VARGAS for posters, calendars, and greeting cards. The Federal Circuit reversed the refusal on appeal. The higher court found that the Board inappropriately changed the mark by diminishing the portion of "girl." When the mark was reviewed in its entirety, there was no likelihood of confusion. Here, the marks share the term SYNTH and the allegedly similar terms RIDER and RYDER in common. But these shared and allegedly similar terms are not enough to support a finding of likelihood of confusion, particularly where there are a number of differentiating factors.

2. Marks Differ in Sight, Sound, and Commercial Impression

a. Marks Differ in Sight

A visual examination of the literal elements of the conflicting marks supports a finding that they are different. Applicant's mark consists of SYNTH RIDERS. In contrast, Registrant's mark consists of SYNTH RYDER. Given the significantly different literal elements discussed above, there is little likelihood of confusion.

b. Marks Differ in Sound

Here, the marks vary substantially in sound. Applicant's mark ends with the elongated sound of the consonant "s." Registrant's mark, on the other hand, ends with the clipped sound of the consonant "r." The marks therefore have distinct final phonemes. As such, these marks sound little alike and have an entirely different phonetic profile.

However, even where two marks are phonetically similar, no likelihood of confusion exists if other differentiating factors can be established. See *National Distillers & Chemical Corporation v. William Grant and Sons, Inc.*, 505 F.2d 719 (finding that DUVET and DUET did not raise likelihood of confusion where other differentiating factors existed such as the term "duet" was a common word whereas "duvet" was not). As stated above, the visual differences between Applicant's mark and the Registrant's mark provide one of many differentiating factors that do not support a claim of likelihood of confusion.

c. Marks Differ in Commercial Impression

The marks in this case vary substantially in commercial impression. Applicant's mark, SYNTH RIDERS, used in connection with "downloadable video game software; downloadable virtual reality game software" brings to mind a virtual reality game where users keep pace with or "ride" the beat of a synthesizer by pressing buttons on a controller to remain alive in the game and score points. Indeed, in Applicant's game, "player[s] must hit different colored notes and note streams that fly by on either side

of them. Each note is a 3D sphere that zooms by on the beat of the pulsating retro synthesizer music" (see Exhibit A). Players of Applicant's game are "synth riders."

In contrast, Registrant's mark, SYNTH RYDER, forges no association with the goals or rules of a video game or with the nickname of players of a video game. Rather, applied to audio and video recordings and entertainment services featuring music, SYNTH RYDER refers to the name of a musician. All of Registrant's advertising materials in fact show use of Registrant's mark in connection with the musical albums and live performances of a musician (see Exhibit B). Neither Registrant's mark nor his advertising materials relate in any way to video games.

Moreover, unlike the term RIDERS in Applicant's mark, the term RYDER in Registrant's mark may be perceived as the given name of a particular individual (see Exhibit C); and the spelling of RYDER with the letter "y" to parallel the letter "y" in synth suffuses the mark with an overall look and feel that is unique from Applicant's. As such, the marks present entirely distinct commercial impressions. Given the significant differences in the commercial impressions of the marks, there is little likelihood of confusion.

The similarity or dissimilarity and nature of the goods as described in an application or registration or in connection with which a prior mark is in use;

Goods and services fall into three categories: (1) competitive, (2) non-competitive but related, and (3) non-competitive and non-related. *Homeowners Group, Inc. v. Home Mktg. Specialists Inc.*, 931 F.2d 1100, 18 USPQ2d 1587,1593 (6th Cir. 1991). Services in the last category are un-likely to be confused. *Murray v. Cable National Broadcasting Co*., 86 F.3d 858,861 39 USPQ2d 1214 (9th Cir. 1996). Moreover, "the presence of goods in the same store does not necessarily lead to the conclusion

that confusion would arise under such conditions." *7-Eleven, Inc. v. HEB Grocery Company, LP*, 83 U.S.P.Q.2d 1257 at *22 (TTAB 2007)(citations omitted).

Here, Applicant's and Registrant's goods and services are non-competitive and non-related. Applicant's goods are virtual reality video game software. Registrant's goods and services are audio and video recordings and live entertainment in the nature of musical performances. The mere fact that video games contain recorded audio and visual elements, and even complete songs, does not support that Applicant's and Registrant's goods are related.

Most video games that contain the music of a particular musician contain licensed music and do not maintain a primary advertising connection with the artist. Those video games advertised as having some connection with an artist nonetheless retain a distinct name. Consumers therefore have no basis to assume that a video game emanates from the same source as the music of a particular artist. Furthermore, the purpose of video games, particularly immersive virtual reality games such as Applicant's, is to actually play a game, not to listen to the music. Conversely, the purpose of listening to recorded or live music is to listen to music, not to play a game. Accordingly, the goods and services are non-competitive and non-related. Given the dissimilar nature of the goods of both parties, there is little likelihood of confusion.

The similarity or dissimilarity of established, likely-to-continue trade channels;

Relevant to the issue of likelihood of confusion is consideration of how and to whom the respective goods of the parties are sold - that is, if both products are sold in the same channels of trade. If the goods of one party are sold to one class of buyers in a different marketing context than the goods of another seller, the likelihood that a single group of buyers will be confused by similar trademarks is

less than if both parties sold their goods through the same channel of distribution. *McCarthy on Trademarks and Unfair Competition* § 24:51 (4th ed.). Notwithstanding any similarity between the goods themselves, pronounced differences in trade channels and the manner of marketing "weighs heavily" against a finding of likelihood of confusion. *Big Dog Motorcycles, L.L.C. v. Big Dog Holdings, Inc.*, 402 F. Supp. 2d 1312 (D. Kan. 2005) (no likelihood of confusion between two different users of BIG DOG mark due to significant differences in manner of marketing and classes of consumers of apparel goods). Differences between classes of buyers, relevant industries, the manner of distribution (retail vs. wholesale), and the target audience of advertisements are all relevant considerations when determining how closely the products are related and how likely consumer confusion would be. See *McCarthy* §24:51 (4th ed.).

In this case, Applicant's and Registrant's goods and services travel in distinct trade channels. Applicant's goods target hardcore gamers who are willing to invest in the incredibly expensive virtual reality gaming hardware required to play Applicant's game (see Exhibit D). Registrant's goods and services, on the other hand, target music fans. To the extent that Applicant's video game software and Registrant's musical recordings and live musical performances target fans of electronic music, the equipment required to run Applicant's game software practically forecloses that electronic music fans who are not gamers or who are merely casual gamers will purchase Applicant's game. As such, Applicant's and Registrant's goods and services travel is distinct channels of trade. Given the differences in the relevant trade channels, consumer confusion is unlikely.

The conditions under which and buyers to whom sales are made, i.e. "impulse" vs. careful, sophisticated purchasing;

"The sophistication of a buyer certainly bears on the possibility that he or she will become confused by similar marks." *Freedom Sav. and Loan Ass'n v. Way*, 757 F.2d 1176, 1185 (11th Cir. 1985). The more sophisticated a consumer, the more likely that consumer will use great care in selecting and discerning goods. The greater the care used, the less the likelihood of consumer confusion. "Sophisticated purchasers involved in purchasing decisions would be aware of the practices of the industry, and recognize that such goods and services do not emanate from a single source." *Calypso Tech., Inc*., 100 U.S.P.Q.2d 1213 (T.T.A.B. 2011).

If the relevant goods are expensive, the reasonably prudent buyer does not buy casually, but only after careful consideration. Thus, confusion is less likely than where the goods are cheap and bought casually. *McCarthy on Trademarks and Unfair Competition* § 23:96 (4th ed.); *Kiekhaefer Corp. v. Willys-Overland Motors, Inc*., 236 F.2d 423, 428 (C.C.P.A. 1956). "It has been repeatedly held, and we think properly so, that, other things being equal, confusion is less likely where goods are expensive and are purchased after careful consideration than where they are inexpensive and are purchased casually." *Magnaflux Corp. v. Sonoflux Corp*., 231 F.2d 669, 671 (C.C.P.A. 1956).

Regardless of the price of the relevant goods/services, the sophistication of the relevant consumers can be determined based on assumptions about the nature of certain buyers. See, e.g. *Luigino's, Inc. v. Stouffer Corp*., 170 F.3d 827, 50 U.S.P.Q.2d 1047 (8th Cir. 1999) (diet-conscious consumers tend to examine food packages more carefully to determine source and caloric content); *Barbecue Marx, Inc. v. 551 Ogden, Inc*., 235 F.3d 1041, 57 U.S.P.Q.2d 1307 (7th Cir. 2000) ("We can expect that customers will exercise a reasonable degree of care when planning to dine at a restaurant of [a certain] caliber"). Buyers of goods in specialized, niche markets may be very sophisticated as to differences between brands and discerning in their purchases. Consumers of banking services, alcoholic

beverages, insurance, and specialty or artisan goods have all been found to be sophisticated purchasers to a relevant degree. *McCarthy on Trademarks and Unfair Competition* § 23:99 (4th ed.).

In this case, consumers of Applicant's and Registrant's goods and services are sophisticated. Applicant's video game software runs on expensive virtual reality hardware that consumers do not purchase on impulse; and consumers who own that expensive hardware necessary to run virtual reality game software such as Applicant's are diehard gamers who are discerning when purchasing video games.

Consumers of Registrant's musical recordings and live musical performances are similarly discerning. Music speaks to the visceral self and has unique emotive force in consumers' lives. The decision of consumers to purchase musical recordings or tickets to live musical performances is frequently a culmination of prior aesthetic exploration and experienced emotional resonance. And fans of electronic music such as Registrant's are "actively engaged" in electronic music culture and "are much more passionate about the music" than even the average music fan (see Exhibit E). As such, consumers of Applicant's and Registrant's goods and services exercise a high degree of thought and care. Given the sophistication of the relevant consumers, there is little likelihood of confusion.

The length of time during and the conditions under which there has been concurrent use without evidence of actual confusion;

The Applicant's and Registrant's marks have coexisted for more than one year without any known instances of consumer confusion. Accordingly, this factor supports that for the relevant market there is little likelihood of confusion.

CONCLUSION

For the reasons listed above, Applicant respectfully requests that the Examining Attorney should remove all refusals for the trademark SYNTH RIDERS (U.S. Serial No. 88465148) and approve the mark for publication.

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