

Response to Office Action/Likelihood of Confusion Refusal

Registration of Applicant's mark **J-QUAD DYNAMICS** has been refused initially on the basis of a likelihood of confusion with the mark JQuad for "*On-line retail store services featuring tools and automotive parts*" under U.S. Registration No. 5485224.

Applicant respectfully disagrees with the Examiner's preliminary finding of a likelihood of confusion with the above cited mark. Applicant believes that after the Examiner reviews the Response herein, the Examining Attorney will agree that concurrent use of the respective marks is not likely to cause confusion.

Amendment

As a preliminary matter, Applicant has amended the goods and services in a manner thought to comply with Office requirements. If the Examiner requires further amendments, please do not hesitate to contact the undersigned.

With respect to the Foreign Registration Certificate, the Examiner is advised the corresponding Japanese application has not yet issued.

As for the Examiner's requirement for additional information about certain non-downloadable software services, the Examiner is advised the Applicant provides the relevant software embodied within the electronic control unit for automobile engines. Updates are expected to occur through cloud services or OTA (On-the-Air) updates. If additional amendments to the goods/services are required in light of this information, Applicant respectfully solicits the Examiner's recommendations.

Discussion

Confusion Unlikely

In ex parte examinations, the issue of likelihood of confusion is generally centered on the 1) *similarity or dissimilarity of the marks* and 2) the *relatedness of the goods or services*. *In re National Novice Hockey League, Inc.*, 222 USPQ 638, 640 (TTAB 1984). There is, however, no mechanical test for determining likelihood of confusion. Each case must be decided on its own facts. The mere possibility that there might be confusion is not a basis for a section 2(d) refusal under the statute, which refers to a likelihood of confusion. *Bongrain Int'l. (American) Corp. v. Delice de France, Inc.*, 1 USPQ 2d 1775, 1779 (Fed. Cir. 1987). "Likelihood of confusion is synonymous with a probability of confusion, which is more than a mere possibility of confusion." *Elvis Presley Enterprises Inc. v. Capece*, 141 F.3d 188, 46 U.S.P.Q.2d 1737 (5th Cir. 1998).

In short, the Marks at issue are sufficiently different, the Goods/Services are sufficiently different and will not be encountered under circumstances that will create confusion, buttressed by the fact that consumers are already distinguishing among other QUAD marks.

While Applicant's mark and the cited marks may appear superficially similar, the mere sharing of the letter "J" and the term "QUAD" is not sufficient to conclude confusion is likely, especially considering marks are to be compared in their entirety and Applicant's mark includes DYNAMIC (as well as a hyphen after the letter "J"). These differences are meaningful and result in marks that create separate commercial impressions – moreover and importantly, consumers are already distinguishing between other QUAD marks, namely, QUAD and QUAD-RING (see attached) for goods with an automotive application. Moreover, Applicant's mark is short for **Jordan Quade**, the signatory of the JQuad application. Applicant's use of "J", meanwhile, suggests "Japan", the country of origin of Applicant. Neutral factors perhaps, but tending to show the overall commercial impressions of the respective marks can reasonably be viewed as dissimilar.

In addition, concerning the relatedness of the goods or services factor noted above, the Trademark Office has the burden of establishing that the respective goods are related or marketed in such a way that confusion is likely. In other words, if the goods in question are not related or marketed in such a manner 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., *Local Trademarks, Inc. v. Handy Boys Inc.*, 16 USPQ2d 1156 (TTAB 1990); *Quartz Radiation Corp. v. Comm/Scope Co.*, 1 USPQ2d 1668 (TTAB 1986).

The differences in the goods/services and their purpose coupled with consumer/buyer sophistication ensures a likelihood of confusion with respect to the cited marks will, at most, be de minimis. While there is no per se rule that consumer sophistication obviates a likelihood of confusion finding, the level of purchaser sophistication is nonetheless "important and **often dispositive** in a likelihood of confusion analysis because sophisticated consumers may be expected to exercise greater care." *Tricia Guild Associates Ltd. V. Crystal Clear Industries Inc.*, 38 USPQ2d 1313, 1315 (TTAB 1990)(emphasis added), quoting *Electronic Design & Sales v. Electronic Data Systems*, 21 USPQ2d 1388, 1392 (Fed. Cir. 1992). No less an authority than David D. Krugman, a former member of the Trademark Trial and Appeal Board, agrees:

If the goods are low-cost items ordinarily purchased by consumers on impulse or otherwise without great care, greater opportunity for confusion between two marks exists. On the other hand, where the goods are expensive or **technical products** carefully purchased only by discriminating purchasers, even minor differences between the marks can avoid confusion. This factor, called purchaser sophistication, can make the difference in an otherwise close ex parte case before the Examiner and the Board. Trademark Trial and Appeal Board Practice and Procedure, 2001 Edition, Gary D. Krugman (emphasis added).

Applicant's goods/services are not 'over the counter' goods/services purchased on impulse by the retail public at large. In point of fact, they are **technical software electronics** purchased by sophisticated, discriminating and educated purchasers. In this regard, Applicant requests the Examiner consider Gary Krugman's discussion of the trademark "PURITAN" in *In re Shipp*, 14 USPQ2d 1170 (TTAB 1987):

[I]n one case, the Examining Attorney refused to register PURITAN for laundry and dry-cleaning services because of the prior registration of PURITAN for dry-cleaning preparations. In reversing the Examiner's Section 2(d) refusal, the Board found that while the dry-cleaning services of the applicant were offered to members of the general public, the dry-cleaning preparations covered by the cited registration would be sold only to owners and operators of dry cleaners and laundries. The Board recognized that owners and operators of dry cleaners and laundries were also, of course, members of the general public and that, therefore, the goods and services overlapped at least with that segment of the public. Nevertheless, the Board found that this limited segment of the public would be sophisticated and discriminating with respect to the products and services involved and that they would be familiar with trade practices in the industry. **The Board found that these sophisticated customers would be confused as to the source or sponsorship of the goods and services involved only if it was customary for dry cleaners or laundries to offer dry-cleaning preparations to the dry-cleaning and laundry industries. The Board held that it would be the Examiner's burden to show such customary trade practices and that, since no such showing was made, the refusal was reversed.** Trademark Trial and Appeal Board Practice and Procedure, 2001 Edition, Gary D. Krugman (emphasis added)

Turning back to the case at hand, the cited mark owner operates an online retail store. Applicant's goods in contrast are not sold in an online retail environment. The respective goods/services will simply not be confronted under circumstances leading to confusion. The sophisticated and non-impulse customers of Applicant are simply not the target for Registrant's online retail store services. And if there is overlap in consumers, sophisticated customers will differentiate between the marks based on the differences in the goods and services (see again the attached real world evidence of use), **especially considering the differences in the marks and the fact that consumers are already distinguishing among the attached QUAD and QUAD-RING marks.**

Please also refer to the attached evidence showing the nature and limited extent of automotive related goods offered by Registrant in its online store.

It is also important to remember that establishing a "likelihood of confusion" means more than simply foreseeing that purchasers may "call to mind" another's mark:

The very fact of calling to mind may indicate that the mind is distinguishing, rather than being confused by, the two marks....Seeing a yellow traffic light immediately "calls to mind" the green that has gone and the red that is to come, or vice versa; **that does not mean that confusion is being caused. As we are conditioned, it means exactly the opposite.**

In re Ferrero, 479 F.2d 1395, 178 U.S.P.Q. 167 (C.C.P.A. 1973)(emphasis added). Any "calling to mind" of the respective marks at issue here will serve to reinforce the meaningful differences between the marks and the respective goods/services they identify. Thus, like in PURITAN,

marketing practices and consumer sophistication counsel in favor of finding no likelihood of confusion.

The Cited Mark Is Not Entitled to Broad Protection—numerous “similar” marks already

After considering the coexisting QUAD marks and the real world evidence attached, the fair conclusion to be drawn is that consumers are capable of distinguishing among and between marks for different goods/services despite the simple sharing of limited common elements. See *Miles Laboratories v. Naturally Vitamin Supplements*, 1 USPQ2d 1445, 1463 (TTAB 1987) (the presence of common elements in marks extensively used by firms and persons unrelated as to source, may cause purchasers to not rely upon such elements as source indicators but to look to other elements as a means of distinguishing the source of the goods). See also *In re Dayco Prods.-Eagle Motors, Inc.*, 9 USPQ2d 1910 (TTAB 1988)(IMPERIAL for automotive products not likely to cause confusion with IMPERIAL for other automotive products where third-party use of IMPERIAL showed ordinary, laudatory connotation of the term) and *In re General Motors Corp.*, 23 USPQ2d 1465 (TTAB 1992)(GRAND PRIX for automobiles not confusingly similar to GRAND PRIX for wheels and other automotive goods where GRAND PRIX is laudatory and highly suggestive).

Conclusion

In conclusion, it bears noting that the TTAB has stated that "[w]e are 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". *MTD Products Inc. v. Universal Tire Corporation* 193 USPQ 56 (TTAB 1976), quoting *Witco Chemical Company, Inc. v. Whitfield Chemical Company, Inc.*, 164 USPQ 43 (CCPA, 1969).

If light of the above argument, the Examiner is respectfully requested to withdraw the refusal and approve the instant application for publication. If the Examiner has any remaining questions, the Examiner is respectfully invited to contact the undersigned.

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