

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Neuron Corporation

Serial No: 88531040

Mark: Slide

Class: 012

Filed: 07/2/2019

RESPONSE TO OFFICE ACTION DATED SEPTEMBER 14, 2019

AMENDMENTS

REMARKS

Likelihood of Confusion Refusal Under Section 2(d)

The Examining Attorney's refusal to register Applicant's mark under Section 2(d) of the Trademark Act is made on the basis that Applicant's mark, SLIDE, when used on or in connection with the identified goods, so resembles the mark COOLSLIDE in Registration No. 5061516, as to be likely to cause confusion, to cause mistake or to deceive. A likelihood of confusion may be said to exist only where (1) an applicant's mark is similar to the cited mark in terms of sight, sound, or commercial impression, and (2) the applicant's goods are so related to the goods associated with the cited mark, or the activities surrounding their respective marketing efforts are so similar, that confusion as to the source of the goods is likely. See In re E.I. DuPont de Nemours & Co., 476 F.2d 1357, 177 U.S.P.Q. 563 (C.C.P.A. 1973); In re Aug. Storck KG, 218 U.S.P.Q. 823 (T.T.A.B. 1983); In re Int'l Telephone & Telegraph Co., 197 U.S.P.Q. 910 (T.T.A.B 1978).

Among the factors to be considered in the determination of likelihood of confusion under Section 2(d), the following are particularly pertinent:

1. the similarity or dissimilarity of the marks in their *entireties* as to appearance, sound, connotation and commercial impression;
2. the similarity or dissimilarity of, and nature of the goods or services described in an application or registration or in connection with which a prior mark is in use;
3. the market interface between the Applicant and Registrants;
4. the conditions under which, and the buyers to whom sales are made, i.e., “impulse” vs. careful, sophisticated purchasing;
5. the number and nature of similar marks in use; and
6. the extent of potential confusion.

No one factor is controlling. Each factor may, from case-to-case, play a dominant role. *See In re E.I. DuPont de Nemours & Co.*, 476 F.2d 1357, 1360-62 (C.C.P.A. 1973). Moreover, there is no mechanical test for determining the likelihood of confusion. The question to be determined is not whether the actual goods or services are likely to be confused but, rather, whether there is a likelihood of confusion as to the source of the goods or services because of the marks used in connection therewith. *See In re Rexel Inc.*, 223 U.S.P.Q. 830, 831 (TTAB 1984). Each case must be decided on its own facts.

I. Applicant’s Mark and the Cited Mark are Different

The Court of Appeals for the Federal Circuit has provided the following guidance with regard to determining and articulating the likelihood of confusion:

The basic principle in determining confusion between marks is that marks must be compared in their *entireties* and must be considered in connection with the particular goods and services for which they are used. It follows from that principle that the likelihood of confusion cannot be predicated on dissection of the mark, which is on only part of a mark.

In re National Data Corp., 753 F.2d 1056, 1058 (Fed. Cir. 1985) (citations omitted)

(footnote omitted) (emphasis added). Thus, the determination as to the existence of a likelihood of confusion must consist of a consideration of the marks taken as a whole- as they would be encountered by purchasers. See Taj Mahal Enterprises Ltd. v. Trump, 745 F. Supp. 240, 247 (D.N.J. 1990) (“In making such a comparison, the relevant factor is ‘the overall impression created by the mark as a whole rather than simply comparing individual features of the marks.’”).

The test of likelihood of confusion is not a side-by-side comparison. The issue is whether there is a likelihood of confusion as to the *source* of the goods or services. In the evaluation of similarities between marks, the emphasis must be on the recollection of the average purchaser who normally retains a general rather than a specific impression of the trademarks. Sealed Air Corp. v. Scott Paper Co., 190 U.S.P.A. 106, 109 (TTAB 1976). Thus, even where the marks at issue are identical, there shall be no automatic finding of similarity in appearance and sound. See General Mills, Inc. v. Kellogg Co., 824 F.2d 622, 627 (8th Cir. 1987)(“The use of identical, even dominant, words in common does not mean that two marks are [confusingly] similar.”); In re Lamson Oil Co., 6 U.S.P.Q. 2d 104, 1042 n.4 (TTAB 1987).

Here the respective marks are dissimilar in their entireties. When the marks at issue are compared in accordance with the aforementioned precedent, it becomes clear that the marks are not confusingly similar.

First, the appearance of each mark in its entirety is visually different. There is no automatic finding of similarity in appearance. In re Lamson Oil Co., 6 U.S.P.Q. 2d 104, 1042 n.4 (TTAB 1987). Even slight differences in the appearance of two marks can be enough to negate any likelihood of confusion. For example, **TAPATIO** and **PATIO** are not visually similar. ConAgra Inc. v. Saavedra, 4 U.S.P.Q. 2d 1245, 1247 (TTAB 1987). Likewise **COUNTRY VOGUE** and **VOGUE** do not look alike. The Conde Nast Publications, Inc. v. Quality, Inc., 507 F.2d 1404, 1407 (CCPA). Similarly, the marks **SENSI-RIBBED** and **RIBBED**, both for condoms, are not similar in appearance. In re Schmid Laboratories v. Youngs Drug Products Corp., 482 F. Supp. 14, 17-18 (D.N.J. 1979). Finally, the marks **MERCIREX** and **REX**, both for medications, are not similar in appearance. United Drug Co. v. Mercirex Co., 182 F.2d 222, 224 (CCPA 1950).

Likewise, just as in the foregoing controlling case, **SLIDE**, as compared to **COOLSLIDE**, are not visually similar. The visual differences between the marks are both obvious and numerous. An examination of the marks reveals the following:

1. Applicant's mark consists of one word, while the cited mark combines two words "COOL" and "SLIDE".
2. The cited mark begins with the letter "C" while the Applicant's mark begins with the word "S."

It is clear that upon a casual or careful glance, there are obvious differences between the Registration and the Applicant's mark that a reasonable consumer would not be confused between the two marks. *See In re Vienna Sausage Manufacturing Co.*, 16 U.S.P.Q. 2d 2044, 2047 (TTAB 1990). Based on the differences discussed above, the marks in question are not similar in appearance enough to cause a likelihood of confusion.

The Applicant's Complete Mark Must Be Reviewed to Determine Likelihood of Confusion

In making its rejection as to confusing similarity, the examining attorney points to only a portion of the mark, specifically that both marks in question use the term "SLIDE." However, the register's mark is "COOLSLIDE" as such, the mark must be reviewed for the likelihood of confusion as a whole and should not be broken into component parts to reach a conclusion of confusing similarity. *See In re Hearst Corp.*, 25 U.S.P.Q. 2d 1238, 1239 (Fed Cir. 1992)("marks tend to be perceived in their entireties, and all components thereof must be given appropriate weight.")(“When GIRL is given fair weight, along with VARGA, confusion with VARGAS becomes less likely.).

Secondly, the applicant's mark and the cited registration are not similar in sound. The audible differences between the marks are both obvious and numerous. An examination of the marks reveals the following:

1. The Registration is of two syllables of "Coolslide" as opposed to the Applicant's mark, which contains one syllable of "Slide." Examiner is mistaken as to assume that the general public would choose to identify Register's company and/or products by only using the "Slide" word. In actuality, Applicant's customers normally and typically refer to the Applicant by "Slide" and Applicant typically advertises and promotes its name with the full name of "Slide." *See Recot Inc. v. Becton*, 50 U.S.P.Q. 2d 1439 (TTAB 1999)(no likelihood of confusion found between FRITO LAY for snack foods and FIDO LAY for canine snacks, due to the differences in sound, appearance and meaning.)

II. Applicant's Goods are Extremely Dissimilar to Registrant's Goods

The Registrant in both of the cited registration is the same. As is clear from the cited registration, the Registrant is providers of "Kick-scooters, bicycles." In Wikipedia (https://en.wikipedia.org/wiki/Kick_scooter), a kick scooter (also referred to as a push-scooter or scooter) is a human-powered street vehicle with a handlebar, deck, and wheels propelled by a rider pushing off the ground. The registrant does not appear to offer any goods relating to "electrically-powered motor", "Electric", "Motorized" bicycles or scooters. Applicant's mark has no association with "human-powered street vehicle" and "push-scooter". Given the significant difference between Applicant's and Registrant's respective goods, there is little chance that consumers would confuse the mark and goods of Applicant the marks and goods of Registrant.

CONCLUSION

Applicant respectfully submits that its application is now in condition for publication. The Examining Attorney is invited to contact the undersigned with any questions concerning this matter.

Respectfully submitted,

Dated: 12/30/2019 By: Elizabeth Yang

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