

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

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**Trademark:** EVOLUTION

**Examining Attorney:** Charles Hiser

**Serial No.:** 88/518,062

**Law Office:** 112

**Applicant:** SpeedKore Performance Group, LLC

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**OFFICE ACTION RESPONSE**

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Applicant hereby responds to the office action issued October 14, 2019, wherein the Examining Attorney refused to register trademark application Serial No. 88518062 for EVOLUTION ("Applicant's Mark") for "licensing high performance cars for use in motion pictures, television programming and other media; entertainment services featuring high performance cars" ("Applicant's Services").

As part of the office action, the Examining Attorney issued a refusal under Section 2(d) of the Trademark Act, on the grounds that Applicant's Mark is likely to cause confusion with the following two trademark Registrations:

- Registration No. 5492415 for EVOLUTION LAW for "Legal document preparation services" (the "'415 Services") (the "'415 Registration") and;
- Registration No. 5308093 for EVOLUTION C for "Museum services; museum services, namely, exhibiting automobiles to the public; classic car museum services; organizing entertainment clubs for owners of automobiles, namely, arranging, organizing, and hosting social events, get-togethers and parties for club members; organization of automobile shows; organization of automobile shows of late model and vintage automobiles and automobile memorabilia; organization of competitions of sport and vintage cars; organization of meetings of enthusiasts of automobiles, automobile racing, and automobile competitions; entertainment in the nature of automobile shows and automobile races; conducting and organizing recreational events, meetings, and automobile shows for sport and vintage cars for amateurs and collectors; development and dissemination of printed educational materials in the field of automobiles, namely, late model and vintage automobiles" (the "'093 Services") (the "'093 Registration).

The Examining Attorney also advised of two prior pending applications that, if they proceeded to registration, may be cited as a grounds for refusing the Application under Section 2(d).

## **Likelihood of Confusion – Standard of Law**

A trademark application may be refused registration under Section 2(d) of the Trademark Act if the applied-for mark so resembles another's trademark as to be likely to cause confusion, mistake, or deception as to the source of the respective goods or services. 15 U.S.C. § 1052(d). In re E. I. du Pont de Nemours & Co., 476 F.2d 1357 (C.C.P.A. 1973), sets forth the factors relevant to a likelihood of confusion determination. No single factor is determinative, and the du Pont factors must be analyzed on a case-by-case basis and consider all evidence relevant to the likelihood of confusion inquiry. Juice Generation, Inc. v. GS Enterprises LLC, 794 F.3d 1334 (Fed. Cir. 2015); see also Electronic Design & Sales Inc. v. Electronic Data Systems Corp., 954 F.2d 713, 21 U.S.P.Q.2d 1388, 1392 (Fed. Cir. 1992), quoting In re E. I. du Pont de Nemours & Co., 177 U.S.P.Q. at 568.

The standard for likelihood of confusion is not whether confusion is possible, but rather, whether confusion is probable among ordinary, relevant consumers. See Estée Lauder v. The Gap, Inc., 42 U.S.P.Q.2d 1228, 1234 (2d Cir. 1997). The mere possibility that relevant consumers might relate the two different marks does not meet the statutorily established test of likelihood of confusion. E.g., In re Hughes Aircraft Company, 222 U.S.P.Q. 263, 264 (T.T.A.B. 1984) ("the Trademark Act does not preclude registration of a mark where there is a possibility of confusion as to source or origin, only where such confusion is likely"). Additionally, the Examining Attorney must review the marks to determine whether a purchaser can resolve any confusion with "minimum effort and average intelligence (for the particular market)." See Church of the Larger Fellowships of Unitarian Universalist v. Conservation Law Foundation, Inc., 221 U.S.P.Q. 869 (D. Mass. 1983).

### **Applicant's Mark is Not Likely to Cause Confusion with the Cited Marks**

In the instant matter, the most important du Pont factors are the similarity or dissimilarity of the respective marks; the similarity or dissimilarity of the respective services; the respective channels of trade; the respective target consumers; and relative strength or weakness of the respective marks. Consideration of these factors, among the other du Pont factors, demonstrates that Applicant's Mark is not likely to cause confusion with the Cited Registrations.




### **The Application is Not Likely to Cause Confusion with Cited Registration No. 5492415 for "EVOLUTION C"**

In the appropriate portion of the office action response form, Applicant has deleted "entertainment services featuring high performance cars" from the services description. Accordingly, Applicant respectfully that with amended description Applicant's Mark will not be likely to cause confusion with the '415 Registration.

### **The Application is Not Likely to Cause Confusion with Cited Registration No. 5308093 for "EVOLUTION LAW"**

The Examining Attorney argues that the Applicant's Mark is likely to cause confusion with the '093 Registration because "legal licensing services and legal document preparation services, are of a kind that may emanate from a single source under a single mark". The Examining Attorney also provided records for a number of third party registrations in support this position.

However, Applicant respectfully submits that the registrations provided by the Examining Attorney do not, in fact, establish that the Applicant's Services and the '093 Services are likely to emanate from the same source, or that consumers are likely to believe that the respective services emanate from the same source. As the chart below shows, the registrations cited by the Examining Attorney cover licensing services specifically related to intellectual property and computer software. Not one of the registration in the table below cover licensing related to cars or high performance cars, as identified in the Applicant's Services. Therefore, while the cited registrations may show that legal document preparation services and intellectual property licensing services are related, these registrations do not establish that Applicant's services and the '093 Services are likely to emanate from the same source.

<b><u>Trademark</u></b>	<b><u>Reg. No.</u></b>	<b><u>Identified Licensing Services</u></b>
BIBO NETWORK	5788024	Licensing of intellectual property; licensing of computer software
FAIRSKY	5248764	Licensing of intellectual property being legal services; licensing of computer software being legal services
MYBRANDMARK.COM	5133048	Licensing of intellectual property
	5165334	Patent licensing; licensing of intellectual property; licensing of intellectual property in the field of patents, copyrights, and trademarks
	5327977	Licensing of intellectual property in the field of trademarks, copyrights, patents, trade secrets, and literary property; licensing of trademarks
THE WILL STORE	5468212	Licensing of intellectual property; licensing of trademarks
RDO	5513507	Patent licensing
	5599341	Licensing of intellectual property
CODEX.LEGAL	5605787	Technology licensing
JACKSONVILLE LEGAL TEAM	5766195	Licensing of advertising slogan and cartoon characters; licensing of computer software;

		licensing of intellectual property; licensing of patent applications; licensing of registered designs; licensing of trademarks
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In addition, there are notable differences between the marks. The mark EVOLUTION LAW is comprised of two words, including the word "LAW". The inclusion of the word "LAW" indicates to consumers that legal services are offered in connection with the EVOLUTION LAW trademark. Further, the combination of "EVOLUTION" and "LAW" suggests that the services are somehow changing or evolving the field of legal services. By contrast, Applicant's Mark is a single word mark, which in no way suggests that Applicant or the Applicant's Services are connected to the legal field. Therefore, Applicant's Mark is unique in that it is a single word mark (as compared to the multi-word mark in the '093) Registration, is shorter in pronunciation than the mark in the '093 Registration, and completely different in meaning. When considered together, these differences demonstrate that Applicant's Mark is distinguishable in overall impression from the mark in the '093 Registration.

**The Application is Not Likely to Cause Confusion with Prior Filed Application No. 88144268**

As noted above, Applicant has amended the services description to delete entertainment services that would potentially belong in Class 41. Applicant's Mark, when used in connection with the amended services is not likely to cause confusion with application Serial No. 88144268 (the "'268 Application").

Applicant also notes that the Trademark Office has already issued a Notice of Allowance for the '268 Application. The allowed '268 Application for TUNER EVOLUTION for "organizing, arranging, and conducting car shows and drag racing events" already coexists with the '415 Registration for services that include "organization of automobile shows; organization of automobile shows of late model and vintage automobiles and automobile memorabilia; organization of competitions of sport and vintage cars". Accordingly, the allowed '268 Application and the '415 Registration cover identical and highly similar entertainment services in Class 41. If the '268 Application has been allowed in light of the '415 Registration for identical and highly similar services, then certainly the Applicant's Mark for distinguishable services can also coexist without creating a likelihood of consumer confusion.

**Conclusion**

For the foregoing reasons, namely, the differences between the respective marks and the difference in goods and target customers, Applicant submits that Applicant's Mark, when used in connection with the Applicant's Goods, is not likely to cause confusion with the Cited Registrations and Prior Filed Applications. Applicant respectfully requests that the 2(d) refusal be withdrawn and the Application approved for publication.