To the Commissioner of the United States Patent and Trademark Office:

In re: Trademark Application Serial No. 88878147

Applicant's Statement

The undersigned Applicant, Lei XU, a national and citizen of China, being duly sworn, hereby state the following in support of the application herein:

RESPONSE TO SECTION 2(d) REFUSAL RAISED IN THE OFFICE ACTION DATED May 13, 2020

This is responsive to Office Action dated May 13, 2020. The Applicant respectfully requests that the application be reconsidered.

BACKGROUND

Applicant Lei XU seeks registration of U.S. Serial No.88878147 for DAMONSWITCH in relation to "Downloadable computer application software for mobile phones, namely, software for use in database management, use in electronic storage of data; Downloadable computer game software; Downloadable computer game software for use on mobile and cellular phones; Downloadable computer software for application and database integration; Downloadable electronic game software for use on mobile and cellular phones, handheld computers; Downloadable emoticons for mobile phones" in Class 9.

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*.

- SWITCH 1 2 (and design) for use with "Computer game programs; computer game software; downloadable electronic game programs; downloadable electronic game software; video game cartridges; video game memory cards; video game programs; video game software" in International Class 9.

- NINTENDO SWITCH (and design) for use with "Cartridges and memory cards containing puzzles, stories, and video games; Computer game programs; Computer game software; Computer programs for parental controls in the field of video games; Downloadable computer game programs; Downloadable computer game software; Downloadable computer programs; Downloadable electronic game programs; Downloadable electronic game software; Downloadable multimedia files including computer games, puzzles, stories and video games; Downloadable video game programs; Downloadable video game software; Electronic game programs; Electronic game software; Electronic video game programs; Electronic video game software; Game programs for hand held video game apparatus; Game programs for video game apparatus; Video game cartridges; Video game memory cards; Video game memory devices including cartridges and memory cards; Video game operating system software programs and utility programs; Video game programs; Video game software; Accessories for electronic video and computer game systems, namely, AC adapters, chargers, earphones, microphones, power adapters; Electronic memory devices for use with electronic video and computer game systems" in International Class 9, among other goods and services.

- NINTENDO SWITCH for use with "Cartridges and memory cards containing puzzles, stories, and video games; Computer game programs; Computer game software; Computer programs for parental controls in the field of video games; Downloadable computer game programs; Downloadable computer game software; Downloadable computer programs; Downloadable electronic game programs; Downloadable electronic game software; Downloadable multimedia files containing computer games, puzzles, stories and video games; Downloadable video game programs; Downloadable video game software; Electronic game programs; Electronic game software; Electronic video game programs; Electronic video game software; Game programs for hand held video game apparatus; Game programs for video game apparatus; Video game cartridges; Video game memory cards; Video game memory devices, including, cartridges and memory cards; Video game operating system software programs and utility programs; Video game programs; Video game software; Accessories for electronic video and computer game systems, namely, AC Adapters, chargers, earphones, microphones, power adapters; Electronic memory devices for use with electronic video and computer game systems" in International

Class 9, among other goods and services.

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 compare the marks for resemblance 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. The marks differ in sight, sound, connotation and commercial impression;

The factors that are relevant to a determination of likelihood of confusion are set forth in *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357 (C.C.P.A. 1973), wherein the two most significant factors relied upon are the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression and the similarity of the goods and channels of trade. The Federal Circuit has held that where the marks at issue are dissimilar, the first Du Pont factor may be dispositive of the likelihood of confusion issue. *In Kellog Co. v. Pack'em Enterprises, Inc.,* -- F.2d -- , 21 U.S.P.Q.2d 1142 (Fed. Cir. 1991) (held: TTAB correctly granted summary judgment that there is no likelihood of confusion between FROOT LOOPS and FROOTEE ICE). *In ex parte examination*, the issue of likelihood of confusion typically revolves around the similarity or dissimilarity of the marks and relatedness of the goods or services. *See, TMEP 1207.01*. The other Du Pont factors may be considered only if relevant evidence is contained in the record. See, *In re National Novice Hockey League, Inc.*, 222 USPQ 638, 640 (TTAB 1984). Accordingly, differences in appearance, sound, connotation and

commercial impression between marks are sufficient to support a finding of no likelihood of confusion.

The basic principle in determining confusion between marks is that marks must be compared in their entireties. It follows from that principle that likelihood of confusion cannot be predicated on dissection of a mark, that is, on only part of a mark. *In Re National Data Corporation*, 753 F.2d 1056, 1058 (Fed. Cir. 1985). Applicant's mark must be considered in the way in which it is perceived by the relevant public, and not considered after hyper-technical dissection. *In Re Shell Oil Company*, 992 F.2d 1204, 1206 (Fed. Cir. 1993) (The marks must be considered in the way in which they are perceived by the relevant public); See, also *In re Best Products, Co., Inc.* 231 USPQ 988 (TTAB 1986) (BEST JEWELRY and design for retail jewelry store services held not likely to be confused with JEWELERS BEST for jewelry). Furthermore, phonetic similarity alone is insufficient to establish likelihood of confusion. See, *Old Tyme Food, Inc. v. Roudy's Inc.*, 961 F.2d 200, 203 (Fed. Cir. 1992).

Only by inappropriately dissecting the "SWITCH" portion of the DAMONSWITCH mark could the Office allege a likelihood of confusion with the "SWITCH 1 2 &design" Mark and "NINTENDO SWITCH" Marks. However, the applicant's trademark DAMONSWITCH is a unitary term and it violates the anti-dissection rule by hyper-technically dissecting it as "DAMON" "SWITCH". If it can be dissect that way, it can be also dissect as "DAMONS WITHC", "DA MONSWITCH" or any other versions with letters combined in a different way. In fact the two share no common words, neither do they have similar sound.

2. *Consumers are generally more inclined to focus on the first part in any trademark or service mark.* See *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee* En 1772, 396 F.3d 1369, 1372, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005) ("VEUVE . . . remains a 'prominent feature' as the first word in the mark and the first word to appear on the label"); *In re Integrated Embedded*, 102 USPQ2d 1504, 1513 (TTAB 2016) ("[T]he dominance of BARR in [a]pplicant's mark BARR GROUP is

reinforced by its location as the first word in the mark."); *Presto Prods., Inc. v. Nice-Pak Prods., Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) ("it is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered" when making purchasing decisions).

Here, applicant's trademark is DAMONSWITCH as a unitary term, while the cited registration contains only the latter part of the applicant's mark as their latter part. Consumers would be more impressed by the first part in each trademark. Therefore, there would be little likelihood of confusion.

Applicant submits that the differences in sight, sound, appearance and connotation of Applicant's DAMONSWITCH Mark is distinct and different enough from Registrant's SWITCH 1 2 (and design) Mark and NINTENDO SWITCH Marks such that there is no likelihood of confusion. In the Office Action, the differences in the marks have not been given proper consideration and weight. It is well established that marks must be compared in their entireties. The office action fails to attribute proper weight to the distinct differences in appearance and sound, as well as the commercial impression and message conveyed to purchasers by Applicant's DAMONSWITCH Mark when compared to the SWITCH 1 2 (and design) Mark and NINTENDO SWITCH Marks. The Applicant's DAMONSWITCH Mark when viewed in its entirety (giving fair weight to the significant contributions of its component parts), are dissimilar in appearance, sight, and commercial impression when compared to the cited two marks.

CONCLUSION

For the reasons listed above, Applicant respectfully requests that the Examining Attorney remove the refusals for the trademark DAMONSWITCH (U.S. Serial No. 88878147) and approve the mark for publication.

I certify that I am the Applicant, AND I understand that Title 18, United States Code, Section 1001 makes it a crime to: 1) knowingly and willfully; 2) make any materially false, fictitious or fraudulent statement or representation; 3) in any matter within the jurisdiction of the executive, legislative or judicial branch of the United States, and I certify that the foregoing statement is all true and accurate to the best of my knowledge.

Dated: May 27, 2020

Beijing, CHINA

Signed: /Lei XU/
Lei XU, *Owner*