

RESPONSE TO OFFICE ACTION

Dear Examiner,

This is in response to the Office Action mailed on July 07, 2020, objecting to the subject PICC AUTO mark based on one prior registration, unacceptable drawing amendment, and specimen refusal by the subject application.

DRAWING AMENDMENT

Applicant is withdrawing the request to amend the drawing.

SPECIMEN

Specimen consists of a photograph of Applicant's packaging bearing the applied-for mark, thus demonstrating use of the mark in commerce. Examiner claims "the mark appears on packaging, but the mark appears to be floating above the goods rather than appearing directly on the packaging", applicant respectfully provides additional information regarding thus "floating mark".

The applicant's mark, since 2009, has had this "floating" appearance. It is part of the design element. For reference, see the applicant's previous registered mark (4110206).

Substitute Specimen: The substitute (or new, or originally submitted, if appropriate) specimen(s) was/were in use in commerce prior to expiration of the filing deadline for a Statement of Use.

Likelihood of Confusion

Similarity of the marks

Sound

Applicant acknowledges examiners argument "The only difference is a single identical "C" missing from the registered mark but in either case the sound of the mark is the same, and the meaning does not change as an intentional misspelling of "pick"". On the contrary, PICC is pronounced as an acronym, purchasers/sellers of the applicant's good(s) are aware of the correct pronunciation due to the good(s) being sold in a wholesale environment.

Commercial impression

The marks do not include the same design element, they do not create a similar overall commercial impression, even though they both contain the letters "P" "I" "C" and the word "AUTO".

Appearance of the mark

PIC= standard 3-character mark **VS** PICC=standard 4-character mark

PIC=108-182 Acronyms **VS** PICC=22-38 Acronyms (Appendix A-U)

No alike acronyms (URL and date accessed are included)

Relatedness of the goods

Appearance of the good(s)

The applicant's goods are made from metal, rubber, and oil. The applicant has no general good(s), that applies to all vehicle types. While PIC AUTO goods are made from various cloths and plastics, applying to all vehicles types due to having a general good(s).

PIC AUTOs good(s) and the applicant's good(s) have no alike features. Besides color of some good(s), only black.

Applicant respectfully submits that the registrations cited by the Examiner, namely PIC AUTO, will not cause confusion with the subject's mark for the following reasons.

PIC AUTO good(s) are not promoted/sold in the same retail section as the subject's good(s). Consumers will not expect that one producer made both goods.

The subject's good(s) are stored behind the register, commonly in the warehouse area. A consumer cannot access the good(s) without an employee. While PIC AUTO good(s) are stored in the retail space, easily accessible to the consumer, hence their good(s) are an accessory.

The subject's good(s) are a part for under the vehicle, while PIC AUTO good(s) are accessories for inside of the vehicle.

The subject's good(s) are considered a NEED, to maintain a vehicle. While PIC AUTO goods are considered a WANT, to accessorize a vehicle, does not improve the vehicles performance.

A consumer purchasing the subject's good(s) are careful. While consumers purchasing PIC AUTO good(s) are impulsive.

While purchasing the subject's good(s), a service is required to install such good(s) to provide better performance to one's vehicle. Also, the consumer must purchase 2-4 of the subject's good(s) to fully repair one's vehicle. Which furthers my case, that consumers purchasing the subject's good(s) are careful.

The subject's and PIC AUTO boxing and labeling look completely different. The applicant has stayed true to its mark, with the same box and label since 2011.

Both marks have dissimilar goods, a reasonable consumer would not be confused as to the origin of such goods.

Conclusion

For the foregoing reasons, applicant requests that the objections of the Examiner be withdrawn, that Likelihood of Confusion be amended as outlined above, and the subject application be allowed to proceed.