

IN THE UNITED STATES PATENT & TRADEMARK OFFICE
WASHINGTON, D.C. 22313

In re application of:

TOYO CO., LTD.

Ser. No. 88/809,338

Filed: February 25, 2020

Mark: TOYO

Trademark Examining Attorney: Molly Segal
Law Office: 105

RESPONSE TO OFFICE ACTION
YOUR MAILING DATE: May 21, 2020

August 12, 2020

Commissioner for Trademarks
P.O. Box 1451
Alexandra, VA 22313-1451

Dear Ms. Segal:

In response to the Trademark Examining Attorney's Office Action dated May 21, 2020 the Applicant submits the following information:

OFFICE ACTION RESPONSE

In an Office Action of May 21, 2020, the Examining Attorney refused registration of the captioned mark (the "Applicant's Mark") under §2(d) of the Trademark Act based on a likelihood of confusion with the mark TOYO in the U.S., Registration Number 3,582,327, owned by Toyo Advanced Technologies Co. Ltd. (the "First Registrant"), registered in class 7 for "Machine tools, namely, grinding machines, wire saws, honing machines, and scroll cutting machines, and their parts" (the "First Registrant's Mark"); and the mark TOYOTERU in the U.S., Registration Number 5,373,502, owned by Hangzhou Shuangdun Trading Co.,Ltd (the "Second Registrant"), registered in class 8 for "Abrading tools; Fertilizer scoops; Frames for handsaws; Gardening shears and scissors; Hand-operated cutting tools; Hand tools, namely, dies; Hand tools, namely, ratchet wrenches; Hand tools, namely, wrenches; Hand saws; Lifting jacks, hand-operated; Pliers; Screwdrivers, non-electric; Gardening tools, namely, trowels, weeding forks, spades and hoes; Hammers; non-electric irons" (the "Second Registrant's Mark").

Applicant respectfully disagrees that there is a likelihood of confusion between the source of Applicant's goods and the sources of the First Registrant's and the Second Registrant's goods because the goods are dissimilar, and, in the case of the Second Registrant's Mark, the marks are distinct.

For the following reasons, Applicant requests that the Examining Attorney withdraw the statutory refusal and allow Applicant's Mark to proceed to publication.

INFORMALITIES

The Applicant adopts the following modified identification of goods:

Class 8: Glass cutting tools, namely, glass cutters; replacement parts and fittings for the aforesaid goods

The arguments that follow reflect this amended identification of goods.

Applicant submits the following information pursuant to the Examining Attorney's request:

(1) The wording "TOYO" in the mark does not have any meaning or significance in the industry in which the goods are manufactured/provided, nor does it have any meaning or significance as applied to applicant's goods, nor is such wording a term of art within Applicant's industry.

(2) The wording "TOYO" means "the East" in Japanese.

(3) The wording "TOYO" means "the East" in Japanese.

ARGUMENT

Likelihood of confusion between marks at the PTO is determined by a review of all of the relevant factors under the *du Pont* test. *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). Under *du Pont*, marks are compared for similarity or dissimilarity in their entireties as to appearance, sound, connotation, and commercial impression. *Id.* There is no *per se* rule that two marks are likely to be confused merely because both marks share common terms. *See Lever Bros. Co. v. Barcolene Co.*, 463 F.2d 1107, 1108, 174 USPQ 392, 393 (CCPA 1972) (finding no likelihood of confusion between the applied-for mark ALL CLEAR! and the prior mark ALL, both for household cleaning products; the commercial impression engendered by ALL CLEAR! was not derived from the component words "ALL" or "CLEAR," but rather from the mark as a whole.) "Marks tend to be perceived in their entireties, and all components thereof must be given appropriate weight." *In re Hearst Corporation*, 982 F.2d 493 (Fed. Cir. 1992). Furthermore, under *du Pont*, marks are compared based upon "the similarity or dissimilarity and nature of the goods. . .described in an application or registration or in connection with which a prior mark is in use." Here, Applicant's goods are dissimilar from the goods of both First Registrant and Second Registrant.

Applicant respectfully disagrees with the Examining Attorney's finding of a likelihood of confusion with First Registrant's Mark and Second Registrant's Mark. Because of the dissimilarities between the goods, and the differences between Applicant's Mark and Second Registrant's Mark, there is no likelihood of confusion between Applicant's Mark and First Registrant's Mark or Second Registrant's Mark, and accordingly the §2(d) refusal should be withdrawn.

A. Applicant's Mark is Entitled to Registration Because It is Sufficiently Distinct from Second Registrant's Mark in Appearance, Sound, Meaning, and Commercial Impression.

The TTAB and courts have found no likelihood of confusion in numerous cases where one mark is comprised of another mark and an additional term, even for marks involving identical or similar goods. See *Time, Inc. v. Petersen Pub. Co. L.L.C.*, 173 F.3d 113, 50 USPQ2d 1782 (TTAB 2002) (no likelihood of confusion between TEEN and TEEN PEOPLE, both for magazines aimed at teenagers); *Jet, Inc. v. Sewage Aeration Systems*, 165 F.3d 419, 49 USPQ2d 1355 (6th Cir. 1999) (no likelihood of confusion between JET and AEROB-A-JET, both for sewage and waste water treatment systems for homes); *Mr. Hero Sandwich Systems, Inc. v. Roman Meal Co.*, 781 F.2d 884, 228 USPQ 364 (Fed. Cir. 1986) (no likelihood of confusion between ROMAN and ROMANBURGER, both for food products); *Plus Products v. General Mills, Inc.*, 188 USPQ 520 (TTAB 1975) (no likelihood of confusion between PLUS for food supplements for breads, rolls, and buns and PROTEIN PLUS for cereal); *In re Ferrero*, 479 F.2d 1395, 178 USPQ 167 (CCPA 1973) (no likelihood of confusion between ALL and ALL CLEAR, both for household cleaning products); and *Colgate-Palmolive Co. v. Carter-Wallace, Inc.*, 432 F.2d 1400, 167 USPQ 529 (CCPA 1970) (no likelihood of confusion between PEAK and PEAK PERIOD, both for personal care products). Here, the marks are more distinct from each other than the marks in the above-cited cases, and, as described below, the goods are dissimilar.

The Board in the past has held that even if identical marks are used for the same goods or goods, there may be no confusion as to source if the meanings and/or commercial impressions of the marks are different. *In re Sydel Lingerie Co., Ltd.*, 197 USPQ 629, 630 (TTAB 1977) (BOTTOMS UP for ladies' and children's underwear is not likely to cause confusion with the identical mark for men's suits, coats and trousers). See also *In re Sears, Roebuck and Co.*, 2 USPQ2d 1312, 1314 (TTAB 1987) (CROSS-OVER was "suggestive of the construction of the brassieres," and hence had a different connotation than CROSSOVER for ladies' sportswear); *In re British Bulldog, Ltd.*, 224 USPQ 854 (TTAB 1984) (PLAYERS for men's underwear held not likely to be confused with PLAYERS for shoes,

the Board finding that the term PLAYERS implies a fit, style, color, and durability adapted to outdoor activities when applied to shoes, but “implies something else, primarily indoors in nature,” when applied to men’s underwear).

It is Applicant’s belief that when the marks are compared *in their entirety*, Applicant’s Mark is dissimilar enough to distinguish it from Second Registrant’s Mark. Applicant concedes that its mark and Second Registrant’s Mark share the word “TOYO.” But that is the *only* similarity between the marks. In terms of appearance and sound, Applicant’s Mark is distinct from Second Registrant’s Mark because (1) in Second Registrant’s Mark the “TERU” appears following the word “TOYO”, whereas Applicant’s Mark comprises only the word “TOYO”, (2) Applicant’s Mark consists solely of a word, whereas Second Registrant’s Mark is comprised of a different word and a prominent design element; (3) Applicant’s Mark consists of two syllables whereas Second Registrant’s Mark has four syllables; and (4) when spoken aloud, the marks sound nothing alike.

The stark differences in the marks and thus their overall commercial impressions obviate any possibility for confusion, much less a likelihood of confusion. *See In re Product Innovations Research LLC* Serial No. 77912065 (January 22, 2014) (“Accordingly, we find that the marks have differences in connotation and are different in overall commercial impression. Moreover, we find this factor to be pivotal in that even considering the other *du Pont* factors, this factor of the dissimilarities of the marks outweighs the other factors”). *See also Kellogg Co. v. Pack’em Enterprises Inc.*, 951 F.2d 330, 21 USPQ2d 1142, 1145 (Fed. Cir. 1991) (“As has often been said, each case must be determined on the particular facts. Under the facts of this case, because of the very different commercial impressions due to the different secondary meanings in each mark resulting, in part, due to the differences in their respective goods, we find that confusion is not likely”).

As noted above, Second Registrant’s Mark is in the nature of a design mark, while Applicant’s filing is for a word mark. As a result, the specific nature of the design found in Second Registrant’s Mark serves to increase the perceptual distance between it and Applicant’s Mark, and to remove any reasonable likelihood of confusion between the marks.

In sum, because the differences in appearance, sound, and connotation between Applicant’s Mark and Second Registrant’s Mark obviate any likelihood of confusion, the §2(d) refusal with respect to Second Registrant’s Mark should be revoked.

B. Applicant’s Mark is Entitled to Registration Because Applicant’s Goods are Sufficiently Distinct from First Registrant’s and Second Registrant’s Goods.

1. Applicant's Goods Compared to First Registrant's Goods

Applicant is seeking to register its mark for “Glass cutting tools, namely, glass cutters; replacement parts and fittings for the aforesaid goods”, whereas First Registrant has its mark registered for “Machine tools, namely, grinding machines, wire saws, honing machines, and scroll cutting machines, and their parts”. The Examining Attorney identifies the relevant language in First Registrant’s registration as follows: “Machine tools, namely...scroll cutting machines, and their parts”. On their face, the goods of Applicant appear to be distinct from the goods of First Registrant in terms of their character and use. Applicant creates small hand-held glass cutting tools and related parts and fittings, as demonstrated by the specimens included in Applicant’s application. First Registrant’s website clearly illustrates that Applicant sells large industrial machines for use in factory settings. See Exhibit A. The website specimen notes that First Registrant’s goods “are widely employed and highly regarded in many key industrial sectors, including automobiles, electric household appliances, and bearings”. There is no mention of glass cutting, and First Registrant’s Mark is not used in connection with hand-held glass cutting tools of any kind. This accords with the specimen included in First Registrant’s most recent Section 8 renewal. See Exhibit B. The specimen clearly shows the mark displayed on a large machine in an industrial setting. In sum, neither party manufactures, sells, or markets the other’s products.

One of the *du Pont* factors is the class of potential purchasers, specifically, the sophistication of potential users of the respective goods is important in determining likelihood of confusion. The standard for likelihood of confusion is a “probability of confusion,” not a possibility of confusion (*See* 3 McCarthy on Trademarks 23:3). When assessing the likelihood of confusion when a product involves a more sophisticated buyer, a higher standard than the typical buyer exercising ordinary care is applied (Homeowners Group, Inc. v. Home Marketing Specialists, Inc., 18 USPQ 1587,1596 (6th Cir. 1991)). Here, the purchasers and users of the goods in the cited registrations and application are highly intelligent, savvy, and educated in their field and would not be easily confused with respect to the goods they shop for and use. The distinction in the type of goods would certainly be enough to avoid confusion as to source for the sophisticated purchasers and users of those goods.

Although both sets of goods are “tools”, this term is enormously broad, so the commonality simply is too tenuous of a connection upon which to find that the goods are commercially related. The goods are non-competitive and clearly have significant differences in utility and essential characteristics. However, even if, for the purpose of argument, we were to assume that the broad category of goods categorized as “tools” fall within the same field, there is no *per se* rule that goods or goods within the same field are related for purposes of a confusion analysis. *Cooper*

Industries, Inc. v. Repcoparts USA, Inc. 218 USPQ 81, 84 (TTAB 1983) (“the mere fact that the products involved in this case (or any products with significant differences in character) are sold in the same industry does not of itself provide an adequate basis to find the required ‘relatedness’”). Goods or goods may fall within the same general category but exist and operate in different niches. When two parties serve distinct sectors of a broad product category, they can be sufficiently unrelated that customers are not likely to assume the products or goods originate from the same source. *See Information Resources Inc. v. X*Press Information Goods*, 6 USPQ2d 1034 (TTAB 1988).

More specifically, the fact that the goods of an applicant and registrant fall into the same broad category is an insufficient basis upon which to find that the goods are related for the purpose of a likelihood of confusion analysis. *Electronic Data Systems Corp. v. EDSA Micro Corp.*, 23 USPQ2d 1460 (TTAB 1992). Even if the goods or goods were deemed to fall broadly in the same category, it would not automatically make the respective goods related. Similarity in one, generalized aspect is not sufficient if otherwise the goods are “plainly different things, different in size, shape, concept, purpose, appearance and price.” *Safeguard Business Sys., Inc. v. New England Business Sys.*, 9 USPQ2d 1051, 1055 (E.D. Pa. 1988); *Electronic Data Sys. Corp.*, at 1463 (computer-related products are not related “simply because each involves the use of computers.”)

Applicant asserts that since First Registrant’s goods do not serve the same needs or perform the same function as Applicant’s goods, any likelihood of confusion is diminished. Again, small hand-held tools are distinct from industrial machines. They serve different purposes to different consumers seeking a different result. This would be true even if Applicant’s goods were sold through First Registrant’s retail channels. The United States Court of Customs and Patent Appeals (“CCPA”) has ruled in certain cases that although the marks were identical and the products were sold through the same retail outlets, any likelihood of confusion was still precluded due to the difference in the goods. “A prospective purchaser of laundry detergent bearing the mark HI-SPOT would not, in our view, be likely to be confused as to the source in the selection of HI-SPORT soft drink. The two products are not only noncompeting, they differ significantly in utility. They share nothing in common with respect to their essential characteristics or sales appeal.” *Canada Dry Corp. v. Am. Home Prods. Corp.*, 468 F2d 207, 208, 1975 USPQ 557 (CCPA 1972). *See also Conwood Corp. v. J.B. Williams Co.*, 475 F2d 643, 644, 177 USPQ 331, 331 (CCPA 1973), in which the Court stated, “considering the differences in the products...we are aware of the opinion that one familiar with HOT SHOT insecticide would not be likely to attribute HOT SHOT shaving cream to the same manufacturer.” In *Schenley Distillers, Inc. v. Gen. Cigar Co.*, 472 F2d 783, 785, 166 USPQ 142, 144 (CCPA 1970), the Court found that “the

ordinary consumer would not be conditioned to expect the same mark [OLE] to be used on such unrelated products as cigars and tequila.” In *G.H. Mumm & Cie v. Desnoes & Geddes Ltd.*, 917 F2d 1292, 1295, 16 USPQ2d 1635, 1638 (Fed. Cir. 1990), the Court found that substantial pricing differences between “upscale” champagne and RED STRIPE beer weighed against likelihood of confusion.

Even if Applicant’s goods and First Registrant’s goods are sold to the same type of customers, the fact that the goods are sold under the parties’ marks in the same general fields, or to different departments within the same group of corporate customers, would not necessarily support a finding that confusion is likely. “The mere purchase of the goods or goods of both parties by the same institution does not, by itself, establish similarity of trade channels or overlap of customers.” *Elec. Design & Sales, Inc. v. Elec. Data Sys. Corp.*, 954 F2d 713, 717, 21 USPQ2d 1388, 1391 (Fed. Cir. 1992).

Moreover, purchasers of both Applicant’s and First Registrant’s goods exercise a high degree of care. Neither party’s goods are candy bars to be purchased on impulse. As such, confusion is highly unlikely. TMEP §1207.01(d)(vii). *See in re Homeland Vinyl Prods.*, at 1380 (comparing impulse purchases with purchases requiring more thought and consideration). The Trademark Trial and Appeal Board (the “Board”) has held that there is no *per se* rule that restaurant goods and food products are related. *See Lloyd's Food Products, Inc. v. Eli's, Inc.*, 25 USPQ2d 2027 (Fed. Cir. 1993). If there is no *per se* rule of likelihood of confusion associated with casual purchases such as commercial food products and restaurant meals, then it stands to reason that there should be no *per se* rule of likelihood of confusion applied to the purchase of sophisticated hand tools or large industrial machines.

First Registrant’s and Applicant’s goods are, therefore, not competitive, overlapping, or related in any way, as Applicant does not manufacture, sell, or market industrial machines. In addition, a high degree of care is used in selecting either Applicant’s or First Registrant’s goods. Accordingly, Applicant’s goods and the cited goods are clearly different and are not similar enough to create a likelihood of confusion in the minds of the consumers.

2. Applicant’s Goods Compared to Second Registrant’s Goods

Applicant is seeking to register its mark for “Glass cutting tools, namely, glass cutters; replacement parts and fittings for the aforesaid goods”, whereas Second Registrant has its mark registered for “Abrading tools; Fertilizer scoops; Frames for handsaws; Gardening shears and scissors; Hand-operated cutting tools; Hand tools, namely, dies; Hand tools, namely, ratchet wrenches; Hand tools, namely, wrenches; Hand saws; Lifting jacks, hand-operated; Pliers; Screwdrivers, non-electric; Gardening tools, namely, trowels, weeding forks, spades and hoes; Hammers; non-electric

irons”. The Examining Attorney identifies the relevant language in Second Registrant’s registration as follows: “Hand-operated cutting tools”. On their face, the goods of Applicant appear to be distinct from the goods of Second Registrant in terms of their character and use. Applicant creates specialized glass cutting tools and related parts and fittings, as demonstrated by the specimens included in Applicant’s application. Second Registrant’s mark is used in connection with common household tools, as demonstrated by the specimens attached to Second Registrant’s Response to Office Action dated August 15, 2017. See Exhibit C. Neither party manufactures, sells, or markets the other’s products.

As further detailed above, one of the *du Pont* factors is the class of potential purchasers, specifically, the sophistication of potential users of the respective goods is important in determining likelihood of confusion. Although both sets of goods are “tools”, this term is enormously broad, so the commonality simply is too tenuous of a connection upon which to find that the goods are commercially related. The goods are non-competitive and clearly have significant differences in utility and essential characteristics. However, even if, for the purpose of argument, we were to assume that the broad category of goods categorized as “tools” fall within the same field, there is no *per se* rule that goods or goods within the same field are related for purposes of a confusion analysis. Goods or goods may fall within the same general category but exist and operate in different niches. When two parties serve distinct sectors of a broad product category, they can be sufficiently unrelated that customers are not likely to assume the products or goods originate from the same source. More specifically, the fact that the goods of an applicant and registrant fall into the same broad category is an insufficient basis upon which to find that the goods are related for the purpose of a likelihood of confusion analysis.

Applicant asserts that since Second Registrant’s goods do not serve the same needs or perform the same function as Applicant’s goods, any likelihood of confusion is diminished. Again, specialized glass cutting tools are distinct from common household tools. They serve different purposes to different consumers seeking a different result. This would be true even if Applicant’s goods were sold through Second Registrant’s retail channels. The United States Court of Customs and Patent Appeals (“CCPA”) has ruled in certain cases that although the marks were identical and the products were sold through the same retail outlets, any likelihood of confusion was still precluded due to the difference in the goods. Even if Applicant’s goods and Second Registrant’s goods are sold to the same type of customers, the fact that the goods are sold under the parties’ marks in the same general fields, or to different departments within the same group of corporate customers, would not necessarily support a finding that confusion is likely.

Moreover, purchasers of Applicant's goods exercise a high degree of care. Applicant's goods are purchased by sophisticated consumers of highly specialized glass cutting products. As noted above, these are not impulse purchases.

Second Registrant's and Applicant's goods are, therefore, not competitive, overlapping, or related in any way, as Applicant does not manufacture or sell common household tools. In addition, a high degree of care is used in selecting Applicant's goods. Accordingly, Applicant's goods and the cited goods are clearly different and are not similar enough to create a likelihood of confusion in the minds of the consumers.

In sum, because the distinctions between Applicant's goods and First Registrant's and Second Registrant's goods obviate any likelihood of confusion, the §2(d) refusal should be revoked.

C. Conclusion

Applicant has responded to all issues raised in the Office Action. If any further information or response is required, please contact Applicant's attorney. The attorney may be reached by telephone at 619-517-2272.

Respectfully Submitted,

A handwritten signature in blue ink, appearing to read 'DL', with a long horizontal flourish extending to the right.

David Lizerbram
Attorney for Applicant
David Lizerbram & Associates
3180 University Avenue, Suite 260
San Diego, California 92104
Phone: 619-517-2272

EXHIBIT A

The screenshot shows a web browser displaying the TOYO Machine Tool Business website. The page features a blue header with the TOYO logo and navigation menus. The main content area includes a banner for Machine Tool Business, a paragraph describing the company's core technology and history, and a 'Product Lineup' section with two columns of CNC internal grinding machines.

TOYO
For the Future of Technology

HOME Machine Tool Business Hard Coating Business Automobile Components Business Corporate Guide

HOME > Machine Tool Business

Machine Tool Business

The core technology in the machine tools from Toyo means the ultimate pursuit of machining. Our machine tools meet expectations from new areas such as semiconductors and power semiconductors.

We manufactured our first machine tool model in 1940, and in the years since then total production has reached over 10,000 units. Our internal grinding machines are used by more than 1,000 companies in Japan and overseas. TOYO brand machine tools are backed by ISO 9001 certification, the international standard in quality assurance. They are widely employed and highly regarded in many key industrial sectors, including automobiles, electric household appliances, and bearings.

Product Lineup

CNC Internal Grinding Machines, Chuck Type	CNC Internal Grinding Machines, Centerless Type
<p>Various models that can meet every work size are lined up. We fill diverse needs in industrial fields, such as automotive and electrical appliance, etc. with wide applicability and ease-of-use.</p> <p>The model lineup is here ></p>	<p>Employs centerless support system that supports OD of work. Various models are lined up to meet work sizes and enable to process high efficiently. These internal grinding machines have been produced by the utilization of processing technology of high-precision bearings.</p> <p>The model lineup is here ></p>

<https://www.toyo-at.co.jp/en/products/kousakuki/index.html>, retrieved on July 29, 2020.

EXHIBIT B



EXHIBIT C



