

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: November 5, 2020

December 15, 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 November 5, 2020 (the "Office Action") the Applicant submits the following information:

PRELIMINARY MATTER

As a preliminary matter, the Office Action of November 5, 2020 is deficient because it fails to respond to Applicant's arguments in the previous Response to Office Action submitted on August 12, 2020, instead stating perfunctorily that "The examining attorney has considered applicant's arguments in favor of registration over the cited marks and finds them unpersuasive given the similarity of the marks, the relatedness of the goods, and the presumption of validity to which the registrations are entitled." Section 713.03 of the TMEP requires that "When the applicant submits arguments attempting to overcome a refusal or requirement, the examining attorney must respond to the applicant's arguments." Applicant respectfully requests the courtesy of knowing the Office's analysis and rationale for finding Applicant's previous arguments unpersuasive.

OFFICE ACTION RESPONSE

In an Office Action of May 21, 2020 (the "First Office Action"), 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 filed a Response to the First Office Action on August 12, 2020 (the “First Response”).

In an Office Action of November 5, 2020 (the “Section Office Action”), the Examining Attorney further refused registration of the Applicant’s Mark under §2(d) of the Trademark Act based on a likelihood of confusion with the mark EAST in the U.S., Registration Number 3,198,446, owned by NINGBO EAST TOOLS CO., LTD (the “Third Registrant”), registered in class 7 for “electric shearing machines; lawnmowers” (the “Third Registrant’s Mark”).

Applicant respectfully disagrees that there is a likelihood of confusion between the source of Applicant’s goods and the source of the Third Registrant’s goods because the goods are dissimilar.

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

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 Third Registrant.

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

Applicant is seeking to register its mark for “Glass cutting tools, namely, glass cutters; replacement parts and fittings for the aforesaid goods”, whereas Third Registrant has its mark registered for “electric shearing machines; lawnmowers”. On their face, the goods of Applicant appear to be distinct from the goods of Third 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. Third Registrant’s Mark is not used in connection with hand-held glass cutting tools of any kind. This accords with the specimens included in Third Registrant’s Section 8 renewal. See Exhibit A. The specimen clearly shows the mark displayed on power tools for outdoor use. 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 Third 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 power tools for gardening purposes. They serve different purposes to different consumers seeking a different result. This would be true even if Applicant’s goods were sold through Third 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 Third 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 Third 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 power tools for outdoor garden use.

Third Registrant’s and Applicant’s goods are, therefore, not competitive, overlapping, or related in any way, as Applicant does not manufacture, sell, or market power tools for gardening. In addition, a high degree of care is used in selecting either Applicant’s or Third 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.

In sum, because the distinctions between Applicant’s goods and Third 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 be 'DL', with a long horizontal stroke 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





