

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application

Mark: NEURON
Appln. No.: 79283825
Filed: January 15, 2020
Applicant: NEURON MOBILITY PTE. LTD.

TRADEMARK APPLICATION

Examiner: Marc J. Leipzig
Docket No.: TM1248US00

RESPONSE TO OFFICE ACTION

Dear Examiner:

In response to the Office Action of August 3, 2020, the Applicant presents the following remarks:

LIKELIHOOD OF CONFUSION REFUSAL AND PRIOR PENDING APPLICATIONS

The Examiner has refused registration of the proposed mark pursuant to Trademark Act Section 2(d), 15 U.S.C. § 1052(d), on the ground that the mark is likely to be confused with the cited marks, Registration Nos. 1393859, 1540303, 2767143, 4912274, 5206337, 5630378, 5677314, and 6017617, and cited pending marks, Serial Nos. 79247794, 88200850, 88200868, 88205368, 88205382, 88281089, 88502604, and 88814689. The Applicant appreciates this finding, and proposes to amend the goods and services that will be claimed by the mark. The proposed changes are detailed in Table 1 below.

Table 1: Comparison of Relevant Marks and Goods/Services with Selected Citations

Applied-for Mark Serial No. 88327180	Cited Mark Registration No. 5677314
NEURON & device	Neuron
Proposed amended Identified Goods/Services: Class 9: [deleted] Class 12: motorized scooters; self-balancing scooters; electrically operated scooters; self balancing electric scooters; electrically-powered motor scooters; electrically powered scooters [vehicles]: self-balancing one-wheeled electric scooters; self-balancing two-wheeled electric scooters	Class 12: Bicycles; bicycle frames; brake levers for bicycles; handlebars for bicycles; handle grips for bicycles; bicycle seat posts; seat clamps for bicycles; bicycle forks; headsets, namely, a bicycle part which provides a rotatable interface between the bicycle fork and the bicycle frame; bicycle parts, namely, handle bar stems; panniers adapted for bicycles; rack trunk bags and water bottle holders adapted for bicycles; transporting bags adapted for bicycles and bicycle wheels

Class 18: [unchanged]	
Class 25: [deleted]	Cited Pending Mark Serial No. 88205368
Class 28: [deleted]	NEURON EV
Class 35: [deleted]	Class 12: Electric cars
Class 38: [deleted]	Cited Pending Mark Serial No. 88205382
Class 39: [unchanged]	Neuron EV & device
Class 42: [deleted]	Class 12: Electric vehicles, namely, commercial, passenger, and performance electric trucks, buses, freight semi-tractor trailers, waste management trucks, SUVs and automobiles
Class 45: [unchanged]	

In view of the revised set of goods and services, the Applicant respectfully requests that the Examiner reconsider the statutory refusal and allow registration of the applied-for mark.

In determining whether there is a likelihood of confusion between two marks, the USPTO must consider whether the two marks will give rise to the mistaken belief that the goods in question emanated from the same source. *In re Majestic Distilling Co.*, 315 F.3d 1311, 1316, 65 USPQ2d 1201, 1205 (Fed. Cir. 2003). Such consideration is made through a thorough evaluation of all pertinent factors under the *du Pont* test. *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). While all factors enumerated in *du Pont* may be considered, the relatedness of the goods or services ought to be assigned due weight in any likelihood of confusion determination. *See, e.g., In re Max Capital Grp. Ltd.*, 93 USPQ2d 1243, 1244 (TTAB 2010); *In re Thor Tech, Inc.*, 90 USPQ2d 1634, 1635 (TTAB 2009). In some instances, even when the marks in question are similar, no determination of likelihood of confusion is made because other factors are deemed to take precedence. “[E]ach case must be decided on its own facts. There is no litmus rule which can provide a ready guide to all cases.” *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973).

It is the Applicant's belief that the revised claimed goods and services are sufficiently narrow, to an extent that the previously held partial refusals on cited marks, Registration Nos. 1393859, 1540303, 2767143, 4912274, 5206337, 5630378, and 6017617; and cited pending marks Serial Nos. 79247794, 88200850, 88200868, 88281089, 88502604, and 88814689, based on likelihood of confusion in Classes 9, 25, 28, 35, 38, and 42 should be withdrawn. Considering the revised goods in Class 12 particularly, as referred to in Table 1, the Applicant now seeks to register the mark NEURON & device predominantly for use in connection with motor cars and miscellaneous components in vehicles. The Applicant henceforth respectfully submits that there is no likelihood of confusion between the revised mark with the remaining cited mark, Registration No. 5677314, and remaining cited pending marks, Serial Nos. 88205368, and 88205382, for the reasons as follows. The amended applied-for mark is sufficiently different and distinct to the extent that they do not overlap with those of the cited, and cited pending marks, and as a result, consumers will not be confused as to whether the claimed goods have emanated from the same source. The applied-for goods also travel in different channels of trade to that of the Prior Registrant's and Prior Applicants', where the level of care exercised by consumers in the procurement process ought to also be considered.

Given this revision, the Examiner's previous refusal of the registration based on a likelihood of confusion in view of the cited mark listed above should be rescinded.

Applicant's and Cited Marks' Goods Do Not Overlap

The proposed and amended applied-for Class 12 goods predominantly relate to motorized and electric scooters; whereas the goods of the cited mark and cited pending marks are different, being more relevant to bicycles and electric cars respectively. Therefore, the applied-for goods should be viewed as distinct from those sold under the cited marks, such that a consumer will not be confused between the two.

In the case that the Examiner maintains there is any degree of doubt as to the similar nature between the two sets of goods, the Applicant respectfully submits that there is not a rule *per se* that certain goods or services in the same broad classification are necessarily related, nor will similar marks for such goods or services cause consumers confusion. *See In re Thor Tech, Inc.*, 90 USPQ2d 1634, 1635 (TTAB 2009) (finding no likelihood of confusion in the registration of the identical mark TERRAIN for both land motor vehicles and towable recreational vehicle trailers). Even if both sets of goods may be said to share the same vehicular nature, several distinctions can be drawn: firstly, motorized and electric scooters are fundamentally non-interchangeable with bicycles and electric cars; secondly, in considering the broad nature of the personal mobility transportation device market, motorized and electric scooters, bicycles, and electric cars ought to be considered as belonging to sufficiently

separate sub-categories. Based on these distinctions, it can be said that each set of goods belong to non-overlapping circles.

Applicant's and Cited Marks' Goods Do Not Travel in the Same Trade Channels

Further to the foregoing argument, the likelihood of confusion as to the source of the goods is effectively diminished when considering the nature of the purchases of these goods. "Circumstances suggesting care in purchasing may tend to minimize the likelihood of confusion," TMEP §1207.01(d)(vii) (October 2018). It therefore should be noted accordingly, that vehicles, such as motorized and electric scooters, bicycles, and electric cars are not inexpensive everyday items, and consumers are regarded to be making these special or one-time purchases with an elevated standard in the care that they exercise. *See In re Thor Tech, Inc.*, 90 USPQ2d 1634, 1635 (TTAB 2009); *Tiffany & Co. v. Classic Motor Carriages Inc.*, 10 USPQ2d 1835, 1841 (TTAB 1989). Therefore, when consumers encounter the applied-for mark's motorized and electric scooters and cited marks' bicycles and electric vehicles in their respective outlet channels, they should be construed as displaying a high degree of care in the procurement process. This heightened standard means that they will be more prudential in their assessment of the marks, further lessening the likelihood of consumers confusing the sources between the goods.

Given the significant differences in the marks' claimed goods, channels of trade, and the level of care exercised by consumers as elaborated upon above, the risk of likelihood of confusion among consumers will be minimal to non-existent. As such, the Applicant respectfully requests that the refusal be withdrawn.

IDENTIFICATION OF GOODS AND RECITATION OF SERVICES

In view of the class deletions and proposed amendments to the applied-for goods, the Applicant submits that the objection is now mooted.

CONCLUSION

In consideration of the proposed amended list of goods and services, the Applicant submits that the revised list is sufficiently narrow to have overcome the cited marks, Registration Nos. 1393859, 1540303, 2767143, 4912274, 5206337, 5630378, and 6017617; and cited pending marks Serial Nos. 79247794, 88200850, 88200868, 88281089, 88502604, and 88814689, as related to the partial refusals applied to Classes 9, 25, 28, 35, 38, and 42.

Regarding Class 12 in particular, and issues specifically pertaining to the cited mark, Registration No. 5677314, and cited pending marks, Serial Nos. 88205368, and 88205382, the

Applicant argues that the proposed amended list of goods belong to non-overlapping circles, and that the applied-for mark travels in different channels of trade. Where there is any doubt to the arguments submitted, the established elevated level of care exercised by consumers ought to be accounted for. As a result, following the adoption of the proposed and amended list, there will no longer be any likelihood of confusion between the applied-for mark and the cited mark, and cited pending marks, and the applied-for mark should be allowed to proceed to publication.

The Applicant has responded to all issues raised in the Office Action and respectfully requests that the citation be withdrawn. If any further information or response is required for overcoming the refusal, please contact the attorney of record, and the attorney is best reached by email at syip@ideaintellectual.com.

Respectfully submitted,

Date: February 1, 2021

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