

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Neuron Corporation

Serial No: 88205368

Mark: Neuron EV

Class: 012

Filed: Nov. 26, 2018

RESPONSE TO SUSPENSION INQUIRY DATED FEBRUARY 12, 2019

Please replace the current International Class 12 identification of goods in the application with the following identification in the same class:

~~Electric vehicles, namely, commercial, passenger, and performance electric trucks, buses, freight semi tractor trailers, waste management trucks, SUVs and automobiles~~ Electric cars

REMARKS

Likelihood of Confusion Refusal Under Section 2(d)

The Examining Attorney's refusal to register Applicant's mark under Section 2(d) of the Trademark Act is made on the basis that Applicant's mark, Neuron EV, when used on or in connection with the identified goods, so resembles the mark Neuron in Application Serial No. 79233215, as to be likely to cause confusion, to cause mistake or to deceive. A likelihood of confusion may be said to exist only where (1) an applicant's mark is similar to the cited mark in terms of sight, sound, or commercial impression, and (2) the applicant's goods are so related to the goods associated with the cited mark, or the activities surrounding their respective marketing efforts are so similar, that confusion as to

the source of the goods is likely. *See In re E.I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 U.S.P.Q. 563 (C.C.P.A. 1973); *In re Aug. Storck KG*, 218 U.S.P.Q. 823 (T.T.A.B. 1983); *In re Int'l Telephone & Telegraph Co.*, 197 U.S.P.Q. 910 (T.T.A.B 1978).

Among the factors to be considered in the determination of likelihood of confusion under Section 2(d), the following are particularly pertinent:

1. the similarity or dissimilarity of the marks in their *entireties* as to appearance, sound, connotation and commercial impression;
2. the similarity or dissimilarity of, and nature of the goods or services described in an application or registration or in connection with which a prior mark is in use;
3. the market interface between the Applicant and Registrants;
4. the conditions under which, and the buyers to whom sales are made, i.e., “impulse” vs. careful, sophisticated purchasing;
5. the number and nature of similar marks in use; and
6. the extent of potential confusion.

No one factor is controlling. Each factor may, from case-to-case, play a dominant role. *See In re E.I. DuPont de Nemours & Co.*, 476 F.2d 1357, 1360-62 (C.C.P.A. 1973).

Moreover, there is no mechanical test for determining the likelihood of confusion. The question to be determined is not whether the actual goods or services are likely to be confused but, rather, whether there is a likelihood of confusion as to the source of the goods or services because of the marks used in connection therewith. *See In re Rexel Inc.*, 223 U.S.P.Q. 830, 831 (TTAB 1984). Each case must be decided on its own facts.

I. Applicant's Mark and the Cited Mark are Different

The Court of Appeals for the Federal Circuit has provided the following guidance with regard to determining and articulating the likelihood of confusion:

The basic principle in determining confusion between marks is that marks must be compared in their *entireties* and must be considered in connection with the particular goods and services for which they are used. It follows from that principle that likelihood of confusion cannot be predicated on dissection of the mark, that is on only part of a mark.

In re National Data Corp., 753 F.2d 1056, 1058 (Fed. Cir. 1985). Thus, the determination as to the existence of a likelihood of confusion must consist of a consideration of the marks taken as a whole- as they would be encountered by purchasers. *See Taj Mahal Enterprises Ltd. v. Trump*, 745 F. Supp. 240, 247 (D.N.J. 1900) (“In making such a comparison, the relevant factor is ‘the overall impression created by the mark as a whole rather than simply comparing individual features of the marks.’”).

The test of likelihood of confusion is not a side-by-side comparison. The issue is whether there is a likelihood of confusion as to the *source* of the goods or services. In the evaluation of similarities between marks, the emphasis must be on the recollection of the average purchaser who normally retains a general rather than specific impression of the trademarks. Sealed Air Corp. v. Scott Paper Co., 190 U.S.P.A. 106, 109 (TTAB 1976). Thus, even where the marks at issue are identical, there shall be no automatic finding of similarity in appearance and sound. *See General Mills, Inc. v. Kellogg Co.*, 824 F.2d 622, 627 (8th Cir. 1987)(“The use of identical, even dominant, words in common does not mean that two marks are [confusingly] similar.”); In re Lamson Oil Co., 6 U.S.P.Q. 2d 104, 1042 n.4 (TTAB 1987).

Here the respective marks are dissimilar in their entireties. When the marks at issue are compared in accordance with the aforementioned precedent it becomes clear that the marks are not confusingly similar.

First, the appearance of each mark in its entirety is visually different. There is no automatic finding of similarity in appearance. In re Lamson Oil Co., 6 U.S.P.Q. 2d 104, 1042 n.4 (TTAB 1987). Even slight differences in the appearance of two marks can be enough to negate any likelihood of confusion. For example, **TAPATIO** and **PATIO** are not visually similar. ConAgra Inc. v. Saavedra, 4 U.S.P.Q. 2d 1245, 1247 (TTAB 1987). Likewise **COUNTRY VOGUE** and **VOGUE** do not look alike. The Conde Nast Publications, Inc. v. Quality, Inc., 507 F.2d 1404, 1407 (CCPA). Similarly, the marks **SENSI-RIBBED** and **RIBBED**, both for condoms, are not similar in appearance. In re Schmid Laboratories v. Youngs Drug Products Corp., 482 F. Supp. 14, 17-18 (D.N.J. 1979). Finally, the marks **MERCIREX** and **REX**, both for medications, are not similar in appearance. United Drug Co. v. Mercirex Co., 182 F.2d 222, 224 (CCPA 1950).

Likewise, just as in the foregoing controlling case, Neuron EV as compared to Neuron is not visually similar. The visual differences between the marks are both obvious and numerous. An examination of the marks reveals the following:

1. Applicant's mark consists of two words, while the cited marks consist of only one word.
2. Applicant's mark ends with the word "EV," whereas the cited marks end with the word "Neuron."

It is clear that upon a casual or careful glance, there are obvious differences between the Registration and the Applicant's mark that a reasonable consumer would not

be confused between the two marks. Since the marks at issue are both design marks, the question of the similarity of the marks must be determined primarily on the basis of their visual similarity. *See In re Vienna Sausage Manufacturing Co.*, 16 U.S.P.Q. 2d 2044, 2047 (TTAB 1990). Based on the differences discussed above, the marks in question are not similar in appearance enough to cause a likelihood of confusion.

The Applicant's Complete Mark Must Be Reviewed to Determine the Likelihood of Confusion

In making its rejection as to confusing similarity, the examining attorney points to only a portion of the mark, specifically that both marks in question use the term "Neuron." However, applicant's mark is "Neuron EV," as such the mark must be reviewed for the likelihood of confusion as a whole and should not be broken into component parts to reach a conclusion of confusing similarity. *See In re Hearst Corp.*, 25 U.S.P.Q. 2d 1238, 1239 (Fed Cir. 1992)("marks tend to be perceived in their entireties, and all components thereof must be given appropriate weight.")("When GIRL is given fair weight, along with VARGA, confusion with VARGAS becomes less likely.). Here, the overall impression is different because of the fact that the Applicant uses a completely distinct and different design for the word "Neuron" in conjunction with the word "EV." Just because both marks are within the same classification of goods does not lead to the conclusion that a likelihood of confusion will result between the two marks. *See In re Dayco Products-Eagle Motive Inc.*, 9 U.S.P.Q. 2d 1910 (TTAB 1988)(no likelihood of confusion found for IMPERIAL for automobiles and structural parts and IMPERIAL for automotive products).

Secondly, the applicant's mark and the cited registration are not similar in sound. The audible differences between the marks are both obvious and numerous. An examination of the marks reveals the following:

1. The Registration is of two syllables of "Neuron" as opposed to the Applicant's mark, which contains three syllables of "Neuron EV." Examiner is mistaken as to assume that the general public would choose to identify Applicant's company and/or products by only using the "Neuron" word. *See Recot Inc. v. Becton*, 50 U.S.P.Q. 2d 1439 (TTAB 1999)(no likelihood of confusion found between FRITO LAY for snack foods and FIDO LAY for canine snacks, due to the differences in sound, appearance, and meaning.)

II. Applicant's Goods are Extremely Dissimilar to Registrant's Goods

As is clear from the cited registration, Registrant is providers of "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." Registrant does not appear to offer any goods relating to "electric cars". Applicant offers goods relating to electric cars which means four-wheeled motor cars. As is evident from the amended identification of goods provided above, Applicants offers goods relating to the electric cars in the retail environment. Unlike Registrant's marks, the Applicant's mark has no association with bicycles, bicycle parts, rack trunk bags and

water bottle holders adapted for bicycles, and transporting bags adapted for bicycles and bicycle wheels.

Given the fact that Applicant's mark is associated with, electric cars will be vastly different from those of the Registrant. From its identification of goods, it is presumed that Registrant's goods are intended for bicycles, bicycle frames, and bicycle parts. There is nothing in Registrant's registration indicating that the goods identified therein are intended for use in "electric cars." The fact that Registrant's good identification refers to "bicycles," rather than electric cars described in the Applicant's mark. Applicant's displays will undoubtedly be smaller than those of Registrant since the goods displayed will be electric cars, which means four-wheeled motor cars, while Registrant's bicycles and bicycle frames and parts to be in larger categories, including two wheels and four wheels bicycles, and further Registrant's goods include human powered or motor powered bicycles. Applicant's goods are only "electric" "cars."

III. The Market Interface Between the Applicant and Registrant is Minimal at Best

As mentioned above, Registrant is a provider of bicycles and components for the bicycles. The applicants will provide electric cars. Since the good offered under the respective marks are vastly different, it is highly unlikely that interface between Registrant and Applicant in the marketplace will occur. Applicant's mark and goods are directed at those seeking to purchase cars. Meanwhile, Registrant's mark and goods are directed at those seeking to "Bicycles" and "Bicycles parts and accessories." There is very little if any overlap between these two market segments. It is highly unlikely that an establishment that bicycle buyer will also have a need to purchase cars. These two types of

retail stores are mutually exclusive. There is virtually no risk that the same consumers would ever encounter both the Applicant's mark and Registrant's mark in the marketplace. Overall, the interface between Applicant and Registrant in the marketplace will be extremely low. This low probability of interface greatly reduces any likelihood of confusion between the marks, or the sources of their respective goods.

The Applicant's Mark is Used in a Different Channel of Trade

Applicant has amended its identification of good to clarify and limit its channels of trade. In particular, the Applicant has adopted the classification of electric cars because the Applicant's mark is intended to be strictly limited to the manufacturing and sale of electric four-wheeled cars. The referenced mark's channels of trade are "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."

Though the registrant lists "Bicycles" as its classes of goods, a quick search on Google does not reveal any information registrant's business, let alone any "electric cars" manufactured or sold by the registrant. The registrant's business sells bicycles and bicycle accessories. No motor-driven bicycles and cars are sold by the registrant's business.(See Registrant's website <https://www.canyon.com/en-us/>).

IV. The Extent of Potential Confusion

All of the foregoing factors prove that the potential for confusion between the Applicant's mark and the cited marks is really non-existent. The goods to be offered under the Applicant's mark are tailored to target a specific type of retail product, namely, electric cars. On the other hand, Registrant's goods may not even be intended for motor-driven four-wheeled cars, and are designed for use with two-wheeled bicycle products.

These goods are vastly different from those of the Applicant. The market interface between Applicant's mark and goods and those of the cited registration appears to be extremely minimal, if not non-existent, further diminishing any likelihood of confusion. Applicant's mark is not identical to the cited marks in any respect.

The numerous factors examined above all indicate that it is extremely unlikely that consumers will be confused as to the source of Applicant's goods and the source of the goods sold under the cited marks, that is if consumers ever even encounter both marks in the marketplace which seems improbable. Therefore, Applicant respectfully requests that the Examining Attorney withdraw the Section 2(d) refusal to register the mark Neuron EV.

Based on the foregoing, there is no likelihood of confusion between the Applicant's mark and the mark contained in the cited registration. Therefore, Applicant respectfully requests that its application proceed to publication in the *Official Gazette*. The Examining Attorney is invited to contact the undersigned with any questions concerning this matter.

CONCLUSION

Applicant respectfully submits that its application is now in condition for publication. The Examining Attorney is invited to contact the undersigned with any questions concerning this matter.

Respectfully submitted,

Date: March 6, 2019

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CERTIFICATE OF ELECTRONIC FILING

I hereby certify that this correspondence is being filed electronically with the U.S.
Patent & Trademark Office via EFS on March 6, 2019.

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