RESPONSE TO OFFICE ACTION

This correspondence is being sent in response to the Suspension Letter dated August 23, 2019 (the "Suspension Letter") in which the Examining Attorney suspended registration on the Principal Register of Applicant's mark LEONTOOL (Applicant's Mark) in Class 8 for

"IC 008. US 023 028 044. G & S: Pliers; Center punches being hand tools; Hand tools, namely, pincers; Hand tools, namely, pliers sets; Hand tools, namely, tile cutters; Hand tools, namely, wrenches; Hand-operated automotive repair tools, namely, brake cylinder hones; Hand-operated automotive repair tools, namely, brake pad spreaders; Hand-operated automotive repair tools, namely, brake spring removers; Hand-operated automotive repair tools, namely, disc brake piston cubes; Hand-operated automotive repair tools, namely, drum brake adjusting tools; Hand-operated automotive repair tools, namely, engine cylinder hones; Hand-operated automotive repair tools, namely, ring compressors; Hand-operated cutting tools; Manually operated shop tools for work on motorcycles, namely, chain breaker tool, chain riveting tool, chain press tool, chain alignment tool, carburetor tuning tool, carburetor tuning gauge set, tire irons, tappet adjustment tools, valve shim tools, tappet feeler gauge, carburetor jet wrenches, clutch holding tool, piston pin removing tool, spring removing tool, timing cover wrench, oil filter wrench, shock absorber wrench, axle wrench, fly wheel puller tool, clutch puller tool and magneto flywheel puller tool; Wire strippers."

citing likelihood of confusion with LEONPART OTOMOTIV DIS TIC LTD STI ("Earlier applicant") mark LEONPART (No. 88105448) (Cited Mark) for

"IC 012. US 019 021 023 031 035 044. G & S: Shock absorbers for automobiles; Shock absorbing springs for vehicles; Vehicle parts, namely, power steering hoses; Vehicle parts, namely, rearview mirrors; Vehicle parts, namely, shock absorbers; Vehicle parts, namely, steering wheels; Vehicle parts, namely, suspension struts; Vehicle parts, namely, windshield wipers; Air turbines for land vehicles; Armoured land vehicles; Automatic gearboxes for land vehicles; Axle bearings for land vehicles; Axles for air suspension systems in vehicles; Band brakes for land vehicles; Belt pulleys for land vehicles; Block brakes for land vehicles; Brake blocks for land vehicles; Brake calipers for land vehicles; Brake drums for land vehicles; Brake linings for land vehicles; Brake linings for vehicles; Brake pads for land vehicles; Brake pads for automobiles; Brake rotors for land vehicles; Brake shoes for land vehicles; Brake shoes for vehicles; Brakes for land vehicles; Clutch linings for land vehicles; Clutch mechanisms for land vehicles; Clutches for land vehicles; Connecting rods for land vehicles, other than parts of motors and engines; Couplings for land vehicles; Diesel engines for land vehicles; Diesel motors for land vehicles; Door panels for land vehicles; Doors for vehicles; Drive shafts for land vehicles; Driving chains for land vehicles; Driving motors for land vehicles; Engine mounts for land vehicles; Engines for land vehicles; Gas caps for land vehicles; Gas tanks for land vehicles; Gas turbines for land vehicles; Gear boxes for land vehicles; Gear wheels for land vehicles; Gearboxes for land vehicles; Gearing for land vehicles; Hydraulic turbines for land vehicles; Idling pulleys for land vehicles; Jet engines for land vehicles; Joysticks for land vehicles; Land vehicle parts, namely, axles; Land vehicle parts, namely, differentials; Land vehicle parts, namely, drive belts; Land vehicle parts, namely, drive gears; Land vehicle parts, namely, fenders; Land vehicle parts, namely, transmissions; Land vehicle parts, namely, wheels; Land vehicle parts, namely, windshields; Land vehicle suspension parts, namely, torsion/sway bars; Land vehicle transmissions and replacement parts thereof; Motors for land vehicles; Motors, electric, for land vehicles; Reduction gears for land vehicles; Reversing gears; Rims for vehicle wheels; Rocket engines for land vehicles; Roller chains for land vehicles; Roof panels for land vehicles; Shaft couplings for land vehicles; Spindles for land vehicles; Steam turbines for land vehicles; Tires for land vehicles; Toothed wheels for land vehicles; Torque converters for land vehicles;

Transmission belts for land vehicles; Transmission cases for land vehicles; Transmission chains for land vehicles; Transmission mechanisms, for land vehicles; Transmission shafts for land vehicles; Transmissions for land vehicles; Transmissions, for land vehicles; Turbines for land vehicles; Universal joints for land vehicles; Vehicle suspension springs; Wheel bearings for land vehicles.", "Retail on-line ordering services featuring auto and truck parts also accessible by telephone, facsimile and mail order".

Applicant respectfully responds as follows.

RESPONSE

I. There is No Likelihood of Confusion.

There is no likelihood of confusion between Applicant's Mark and the Cited Mark because the marks are significantly different in appearance, sound and commercial impression, the goods are different and consumers are sophisticated. Further, Applicant's Mark and the Cited Mark have coexisted in the marketplace without any confusion since the inception of the Cited Mark. As such, Applicant requests that the Examining Attorney remove this ground of refusal and allow the application to proceed to publication.

A. Legal Standard for 2(d) Determinations

The determination of likelihood of confusion requires a two-part analysis. First, the similarity or dissimilarity of the marks is analyzed in terms of their "appearance, sound, connotation and commercial impression." *In re E. I. Du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563 (CCPA 1973). Second, the relatedness of the goods or services is analyzed for similarity or differences. *Id.*

In assessing the likelihood of confusion, "it is the duty of the examiner . . . to find, upon consideration of all the evidence, whether or not confusion appears likely." *Id.* at 1362 (emphasis omitted). The weight given to any one factor may vary in light of the circumstances, but the crucial issue is always whether an appreciable number of ordinarily prudent purchasers of the associated goods or services are likely to be misled or confused as to the source of goods or services in question. *Plus Prods. v. Plus Discount Foods, Inc.*, 722 F.2d 999, 222 USPQ 373 (2d Cir. 1983); *Lever Bros. Co. v. Am. Bakeries Co.*, 693 F.2d 251, 253, 216 USPQ 177 (2d Cir. 1982) (AUTUMN for margarine not likely to be confused with AUTUMN GRAIN for bread).

A mere possibility of confusion is not enough. *Gruner + Jahr USA Publ'g v. Meredith Corp.*, 991 F.2d 1072, 1077 (2d Cir. 1993) (mark PARENTS not confusingly similar to mark PARENT'S DIGEST for child-rearing magazines). **Likelihood means probability**. When only a possibility, rather than a probability, of confusion exists, registration of Applicant's Mark should be allowed. 3 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 23:3 (4th ed. 2006).

To determine likelihood of confusion, the marks in question must be compared in their entireties. *See Ross Bicycles, Inc. v. Cycles USA, Inc.*, 765 F.2d 1502, 1507 (11th Cir. 1985) ("[T]he marks ultimately must be considered as a whole . . . ."). To decide likelihood of confusion solely on the basis of one feature violates the antidissection rule. *See Jet, Inc. v. Sewage Aeration Sys.*, 165 F.3d 419, 423 (6th Cir. 1999). Two marks that share "identical, even dominant, words in common does not automatically mean that" such marks are similar. *Gen. Mills, Inc. v. Kellogg Co.*, 824 F.2d 622, 627, 3 USPQ2d 1442 (8th Cir. 1987). When Applicant's Mark is reviewed as a whole and consistent with the above case law, it is clear that it is different in appearance, sound and commercial impression from the Cited Mark. Further, the goods are

different and consumers are sophisticated. Accordingly, Applicant's Mark should not be found confusingly similar to the Cited Mark.

i. The Marks Differ in Overall Commercial Impression

For the purpose of likelihood of confusion analysis, the marks must be compared as a whole and not as separate parts, *i.e.*, even if some part of the mark involved is disclaimed, the disclaimed part still constitutes solid and inseparable part in determining the likelihood of confusion, and would not be accorded a lesser weight simply because it is disclaimed. After all, an average purchaser would neither know nor care about the disclaimer status of a trademark.

As a result, even if "Part" is disclaimed in the Cited Mark, it still is an important part of consideration for determining the likelihood of confusion.

The differences in the appearance and sound and of the two marks, i.e., the "~~PART and "~~TOOL". create two separate and distinct overall commercial impressions of Applicant's Mark and the Cited Mark. An average consumer in the related market is particularly sensitive to the difference between a "part" and a "tool". An average consumer inherently separate and instinctively distinguish a "part", which a raw material to be worked on, with a "tool", which is aid to work on the raw material. From the perspective of human psychology, the demarcation of "part' versus "tool" is simply strong and sharp, making the commercial impressions of the two marks starkly differ.

Applicant's Mark, is a standardized font. In contrast, the Cited Mark is design of the head and neck of a red leopard above the stylized wording that looks like a person riding on a car. Encountering these two marks will give consumers a completely different business impression. Thus, the Marks create different commercial impressions such that the Marks are not likely to be confused by the relevant public.

More importantly, the fact that a portion of Applicant's Mark is the same as the Cited Mark does not, by itself, make the marks confusingly similar. The likelihood of confusion between marks must be determined by comparing the marks as a whole, and even the presence of identical dominant terms does not mean that two marks are confusingly similar. *E.g., Duluth News Tribune v. Mesabi Publ'g Co.* , 84 F.3d 1093, 1097, 38 USPQ2d 1937 (8th Cir. 1996). It is the overall commercial impression that governs the comparison rather than just individual elements. "No element of a mark is ignored simply because it is less dominant . . . ." *In re Electrolyte Labs., Inc.*, 929 F.2d 645, 647, 16 USPQ2d 1239 (Fed. Cir. 1990).

ii. The Marks Differ in Appearance

The differences between Applicant's Mark and the Cited Mark far outweigh any common visual elements between the marks. The test for determining whether two marks appear similar is a "subjective 'eye ball' reaction" to the total commercial appearance of each mark. *Gen. Foods Corp. v. Ito Yokado Co.*, 219 USPQ 822, 828 (TTAB 1983).

Applicant's Mark, LEONTOOL, is a standardized font. In contrast, the Cited Mark consists of the design of the head and neck of a red leopard above the stylized wording "LEONPART", with "LEON" appearing in the color gray and "PART" appearing in the color red. The appearances between the two are diametrically opposite. Thus, Applicant's Mark produces a visually distinct appearance from the Cited Mark.

Marks much closer to each other in appearance than Applicant's Mark and the Cited Mark, even with closely related goods or services, have been found to be distinctive and sufficiently dissimilar. *See, e.g.*, *Wooster Brush Co. v. Prager Brush Co.*, 231 USPQ 316 (TTAB 1986) (no likelihood of confusion

between **POLY PRO and POLY FLO** for paintbrushes); *Vitarroz Corp. v. Borden, Inc.*, 644 F.2d 960, 209 USPQ 969 (2d Cir. 1981) (**BRAVO'S** for crackers not likely to be confused with **BRAVOS** for tortilla chips); *Affiliated Hosp. Prods., Inc. v. Merdel Game Mfg. Co.*, 513 F.2d 1183, 185 USPQ 321 (2d Cir. 1975) (**KICK'ER** not likely to be confused with **KICK-IT**, both for tabletop soccer games). The differences between Applicant's Mark and the Cited Mark are conspicuous in comparison to the differences between the marks found distinctive in these cases. These facts support a finding that there is no likelihood of confusion between the marks when the marks are compared as a whole.

iii. The Marks Differ in Sound

In addition to the conspicuous differences between the appearance of the marks, the sound of Applicant's Mark is distinct from that of the Cited Mark. Although it is the same part "LEON" in front, it is followed by 2 completely different words "TOOL" and "PART", which are completely different when read together. Thus, Applicant's Mark and Cited Mark are not phonetically identical and not phonetically similar.

Furthermore, "phonetic similarity is not dispositive in creating a likelihood of confusion" where the marks are different in appearance as is the case here. *Katz v. Modiri*, 283 F. Supp. 2d 883, 895 (S.D.N.Y. 2003) (finding that JUVA and JUVANEX were not confusingly similar). These significant differences in pronunciation and emphasis of each mark create distinct commercial impressions for the respective marks such that no likelihood of confusion exists.

B. The Goods of Applicant and Registrant Are Not Competitive

When goods are not competitive, there is no likelihood of confusion even from identical marks. *Therma-Scan, Inc. v. Thermoscan, Inc.*, 295 F.3d 623, 632, 63 USPQ2d 1659 (6th Cir. 2002).

Applicant sell her products exclusively through a third-party online platform, whereas the Earlier Applicant does not sell his products through the third-party online platform, which segregates Cited products and Applicant's products into separate and non-overlapping channels, because of the third-party online platform's merchandise organization and search algorithm. Specifically, Applicant sells exclusively in Amazon.com and have no plan for expanding into other platforms, whereas Cited LEONPART plus design cannot be found in Amazon.com or any other online platforms such as ebay and whish.com.

When selling in a third-party online platform, sales comes from key-word search by customers. A customer would normally type in the name of merchandise (e.g., hand tools) she/he wants. A list of suggestions of would pop up, and the customer would choose from the list. A repeat customer may also type in the brand she/he knows, and merchandise associated with the brand would appear. The Amazon's search algorithm is such that when customer searches for "LEONTOOL", she/he will not get another brand that differs by even one letter, let alone differs by four letters (i.e., "tool" and "part"), and vice versa. More specifically, according to search in Amazon, it was not found that the Earlier Applicant sold any listed products under "LEONPART" mark on Amazon, and the applicant's products are only sold on Amazon.com. Thus, the Cited orders and Applicant's orders are generated through different channels and there are no competition or confusion between merchandises, and no confusion for the respective customers.

Moreover, the main products of the applicant are hand tools of various styles. Although it is possible that hand-operated automotive repair tools and vehicle parts are sold on the same sales channel , hand tools generally are not sold on the same counter as vehicle parts. That is to say, consumers who have a hand tool demand are generally focused on buying a hand tool, instead of thinking about buying an vehicle part while buying the hand tools, and vice versa.

The differences between goods are a fundamental consideration in determining likelihood of confusion. *Polaroid Corp. v. Polarad Elecs. Corp.*, 287 F.2d 492 (2d Cir. 1961). Even identical marks are often distinguished by the fact that they are used with different goods or services. *E.g., Worthington Foods, Inc. v. Kellogg Co.*, 732 F. Supp. 1417 (S.D. Ohio 1990) (HEARTWISE for breakfast meat analogs not likely to be confused with HEARTWISE for breakfast cereal); *In re R.C. Bigelow Inc*., 199 USPQ 38 (TTAB 1978) (ROSE GARDEN for tea not likely to be confused with ROSE GARDEN for fresh vegetables).

Because the Applicant's and Cited goods are neither competitive nor related, similar marks can coexist in the marketplace without any likelihood of confusion.

C. The Relevant Consumers Are Sophisticated

The law presumes that consumers are prudent and sophisticated enough to distinguish material differences. *Buitoni Foods Corp. v. Gio. Buton & C. S.p.A.*, 680 F.2d 290 (2d Cir. 1982) (consumers unlikely to confuse "BUITONI" for table wine with "BUTON" for apertif wine).

When goods are "purchased with a certain amount of care and thought, rather than … on impulse," confusion is less likely to be found. *Info. Res. Inc. v. X*Press Info. Servs.*, 6 USPQ2d 1034, 1039 (TTAB 1988). "[T]he more sophisticated the consumer the less likely he will be confused" when encountering different goods or services with similar marks. *Moore Bus. Forms, Inc. v. Rite Aid Corp.*, 21 USPQ2d 2024, 2029 (W.D.N.Y. 1991). Also, when goods or services are expensive, there is less likelihood of confusion because prospective purchasers exercise greater care in making such purchases. *Elec. Design & Sales, Inc. v. Elec. Data Sys. Corp.*, 953 F.2d 713, 718 (Fed. Cir. 1992).

Purchasers of Applicant's and Cited goods are sophisticated and discerning. Most importantly, Applicant's Mark and the Cited Mark have coexisted in the marketplace ever since the inception of the Brand with no confusion for years. Accordingly, these purchasers are sufficiently sophisticated and are unlikely to be confused as to the source of goods merely because there is some surface similarity in the marks.

REMARKS

In view of the foregoing, and in light of the amendments submitted herewith, Applicant believes it has addressed all outstanding issues relating to the present Application, and respectfully requests that the Examining Attorney enter its amendments to the Application's identification of goods and services, withdraw the refusals under Section 2(d) of the Lanham Act, and approve Applicant's Application. Should the Examining Attorney have any questions or require any additional information, the undersigned is readily available.

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