

This is Applicant's response to the Office Action dated November 9, 2018.

Remarks

The Examining Attorney has issued a non-final Office Action in the subject application refusing the registration of the Applicant's stylized mark, WARP CHARGE, on the Principal Register due to an alleged likelihood of confusion under Section 2(d) of the Trademark Act between Applicant's mark and the marks of U.S. Reg. Nos. 3200353 for **WARP** in the name of Evertz Microsystems, LTD., and 4233923 for **WARPSPEED** in the name of Warp Speed Incorporated. The Examining Attorney also alleged a potential likelihood of confusion between Applicant's mark and the marks of prior-filed U.S. Application Nos. 87089930 for STARWARP and 87680490 for TRANSWARP, in the name of Transwarp Technology (Shanghai) Co., Ltd.

As an initial matter, Applicant is herein deleting the applied-for services of Class 35 from the subject application. Therefore, Applicant respectfully submits that there can be no likelihood of confusion between the mark of the subject application and the marks of U.S. Registration No. 4233923 and U.S. Application No. 87089930. Accordingly, Applicant respectfully requests that the refusals based on these marks be withdrawn.

For the following reasons, Applicant respectfully submits that the refusals based on U.S. Registration No. 3200353 (the "Cited Registration") and U.S. Application No. 87680490 (the "Cited Application") also be withdrawn, and requests that the applied-for mark be accepted for publication.

There is no mechanical test for determining likelihood of confusion and "each case must be decided on its own facts." *In re E. I. duPont de Nemours & Co.*, 476 F.2d 1357 (C.C.P.A. 1973). In other words, "trademark law must necessarily be flexible responding to particular circumstances disclosed by particular fact situations . . . [E]ach case must be decided on the basis of all relevant facts which include the marks and the goods as well as the marketing environment in which a purchaser normally encounters them" *Interstate Brands Corp. v. Celestial Seasonings, Inc.*, 196 U.S.P.Q. 321, 324 (T.T.A.B. 1997), *aff'd*. 198 U.S.P.Q. 151 (C.C.P.A. 1978).

Here, the relevant factors for determining a likelihood of confusion include, *inter alia*:

- The number and nature of similar marks in use on similar services;
- The dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression; and
- The nature and dissimilarity of the goods as described in the application and registrations.

In re E.I. DuPont de Nemours and Co., 476 F.2d 1357, 177 U.S.P.Q. 563 (C.C.P.A. 1973).

In some cases, a determination that there is no likelihood of confusion may be appropriate, even where the marks are similar, because similarity is outweighed by other factors. When determining whether there is a likelihood of confusion, the Examining Attorney should apply all of the *DuPont* factors relevant to the overall determination. Not all of the factors are relevant and only those relevant factors for which there is evidence in the record must be considered. *DuPont*, 476 F.2d at 1361-62.

Third Party Registrations Demonstrate that Consumers are Conditioned to Distinguish Between the Marks

Determining whether there is a likelihood of confusion requires careful consideration of the nature of the common elements of the marks at issue. Additions or deletions to marks, such as the addition of a house mark, may be sufficient to avoid a likelihood of confusion if: (1) the marks in their entireties convey significantly different commercial impressions; and/or (2) the matter common to the marks is not likely to be perceived by purchasers as distinguishing source. See, e.g., *Citigroup Inc. v. Capital City Bank*

Group, Inc., 637 F.3d 1344, 1356, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011). In this regard, third-party registrations are considered relevant to show that a mark or a portion of a mark is so commonly used and diluted that the public will look to other elements to distinguish the source of the goods or services. If the examining attorney finds registrations that appear to be owned by more than one registrant, he or she should consider the extent to which dilution may indicate that there is no likelihood of confusion. TMEP §1207.01(d)(x).

Active third-party registrations are also relevant to show that a mark or a portion of a mark is descriptive or suggestive, and may also be offered as evidence of a term’s weakness and dilution with respect to a particular field weighing in favor of narrowing the scope of its protection against subsequent applications. See, e.g., *In re i.am.symbolic, llc*, 866 F.3d 1315, 123 USPQ2d 1744 (Fed. Cir. 2017); *Pizza Inn, Inc. v. Russo*, 221 USPQ 281, 283 (TTAB 1983).

Here, the USPTO did not consider the marks of the Cited Registration and the Cited Application (which has been allowed) to be confusingly similar, despite the shared WARP portion, and found the addition the term “STAR” to be sufficient to distinguish the mark of the Cited Application for use in connection with similar/related goods in Class 9. This suggests that the understanding that the public will look to other elements apart from the common component WARP to distinguish the source of the goods or services.


Apart from the Cited Marks, the Trademark Office has also allowed the registration of numerous additional marks containing the WARP term for use in connection with services that are identical and/or highly related to those listed in the Cited Registrations. These include, but are not limited to, the following active U.S. registrations:

Trademark	Reg./ Appl. No.	Status/Key Dates	Goods/Services	Owner Information
WARP	2394590	Renewed October 17, 2010 Int'l Class: 09 First Use: March 1, 1992 Filed: February 25, 1998 Registered: October 17, 2000 Last Renewal: October 17, 2010	(Int'l Class: 09) computer software for creating, designing and/or simulation of programmable integrated circuitry; semi conductor; computer hardware; integrated circuit devices and programmable integrated circuit devices	Cypress Semiconductor Corporation (Delaware Corp.) 3901 N. First Street San Jose California 95134
WARP	4338158	Registered May 21, 2013 Int'l Class: 09 First Use: August 6, 2012 Filed: September 12, 2012 Registered: May 21, 2013	(Int'l Class: 09) graphical user interface software	Wikipad, Inc. (Delaware Corp.) 1801 Century Park East, Suite 2400 Los Angeles California 90067

Trademark	Reg./ Appl. No.	Status/Key Dates	Goods/Services	Owner Information
PHOTOWARP	2707914	Renewed April 15, 2013 Int'l Class: 09 First Use: April 16, 2002 Filed: January 7, 2002 Registered: April 15, 2003 Last Renewal: April 15, 2013	(Int'l Class: 09) software for converting panoramic image data into viewable image data and for manipulating and displaying viewable images	360Fly, Inc. (Delaware Corp.) 1000 Town Center Way, Suite 200 Canonsburg Pennsylvania 15317
VIDEOWARP	2782743	Renewed November 11, 2013 Int'l Class: 09 First Use: July 17, 2003 Filed: January 7, 2002 Registered: November 11, 2003 Last Renewal: November 11, 2013	(Int'l Class: 09) software for converting panoramic image data into viewable image data and for manipulating and displaying viewable images	360Fly, Inc. (Delaware Corp.) 1000 Town Center Way, Suite 200 Canonsburg Pennsylvania 15317
WARPCORE	4533914	Registered May 20, 2014 Int'l Class: 09 First Use: May 11, 2009 Filed: June 16, 2011 Registered: May 20, 2014	(Int'l Class: 09) integrated circuits; semiconductors; computer network hubs, switches and routers; computer hardware for telecommunications; computer networking hardware; ether net transceivers; network routers; broadband routers; computer switches; communication network switches	Avago Technologies International Sales Pte. Limited (Singapore Private Company Limited by Shares) 1 Yishun Avenue 7 Singapore Singapore
TIMEWARP	87952980	Allowed - Intent to Use Notice of Allowance Issued January 1, 2019	(Int'l Class: 09) downloadable computer software for video creation, production and editing; downloadable software tools for image editing and video editing;	Gopro, Inc. (Delaware Corp.) 3000 Clearview Way San Mateo California 94402

Trademark	Reg./ Appl. No.	Status/Key Dates	Goods/Services	Owner Information
		Filed: June 7, 2018	downloadable computer software that enables users to create, produce, edit and share videos using digital images, photos, text, graphics, music, audio, video clips, and multimedia content; downloadable computer software for creating, viewing, sorting, organizing, manipulating, managing, rendering, indexing, storing, transferring, uploading, downloading and sharing videos containing digital images, photos, text, graphics, music, audio, video clips, and multimedia content with others via computer networks, mobile telephones, and other communications	
WARP DRIVE IMAGING Disclaimer: "DRIVE IMAGING"	3633234	Registered 8 & 15 June 22, 2015 Int'l Class: 09 First Use: March 1, 2009 Filed: February 16, 2006 Registered: June 2, 2009	(Int'l Class: 09) microscope imaging system comprised of software and hardware, namely, camera, illumination, image capturing, and control components, used for the purpose of acquiring, processing and analyzing scientific images	Horiba Instruments Incorporated (California Corp.) 9755 Research Drive Irvine California 92618
ICEWARP	3472368	Renewed July 22, 2018 Int'l Class: 09,42 First Use: June 1, 1999 Filed: March 14, 2006 Registered: July 22, 2008 Last Renewal: July 22, 2018	(Int'l Class: 09) computer software and hardware for use in the transmission, access, storage, filtering, analysis and security of digital communication, digital files and other data on a single computer or via multiple computers over a network (Int'l Class: 42) computer hardware services, namely, computer hardware consulting services, computer hardware development services	Icewarp Limited (Cyprus Corp.) Georgiou Gennadiou 43 Limassol Cyprus

Trademark	Reg./ Appl. No.	Status/Key Dates	Goods/Services	Owner Information
			and back-up services for computer hard drive data in the field of transmission, access, storage, filtering, analysis and security of digital communication, digital files and other data on a single computer or via multiple computers over a network	
WARPSTOR	5247077	Registered July 18, 2017 Int'l Class: 09 First Use: January 4, 2017 Filed: October 28, 2015 Registered: July 18, 2017	(Int'l Class: 09) computer hardware and software for storing, caching, deploying, and moving data in order to reduce network bandwidth usage and memory storage usage, sold as a unit	Methodics Inc. (California Corp.) 130 9th Street, Suite 305 San Francisco California 94103
IP-WARP	4733794	Registered May 12, 2015 Filed: September 23, 2014 Registered: May 12, 2015 Int'l Reg Date: June 19, 2013	(Int'l Class: 09) virtual private network vpn hardware; virtual private network vpn operating software (Int'l Class: 37) repair and maintenance of virtual private network vpn hardware (Int'l Class: 38) providing virtual private networks vpn (Int'l Class: 42) design, programming and maintenance of virtual private network vpn operating software	Ntt PC Communications Incorporated (Japan Corp.) 2-14-1 Nishi-Shimbashi Minato-Ku; Tokyo 105-0003 Japan
WARPDRIVE	4139758	Registered 8 & 15 April 10, 2018 Int'l Class: 09 First Use: November 16, 2010 Filed: August 9, 2010	(Int'l Class: 09) computer hardware, namely, storage systems	Seagate Technology LLC (Delaware Limited Liability Company) 10200 South De Anza Blvd Cupertino California 95014

Trademark	Reg./ Appl. No.	Status/Key Dates	Goods/Services	Owner Information
		Registered: May 8, 2012		
<p>GAME WARP and Design</p>  <p>Disclaimer: DESIGN OF A DOCKING STATION FOR A PDA</p>	4382934	Registered August 13, 2013 Int'l Class: 09 First Use: August 6, 2012 Filed: October 17, 2012 Registered: August 13, 2013	(Int'l Class: 09) graphical user interface software	Wikipad, Inc. (Delaware Corp.) Suite 2400 1801 Century Park East Los Angeles California 90067
DATAWARP	5551049	Registered August 28, 2018 Int'l Class: 09 First Use: January 4, 2018 Filed: September 22, 2014 Registered: August 28, 2018	(Int'l Class: 09) computer hardware and software to improve the performance of data storage systems	Cray Inc. (Washington Corp.) 901 Fifth Avenue, Suite 1000 Seattle Washington 98164

Copies of these registrations are attached hereto as Exhibit A.

In addition to the above, a cursory search revealed almost 30 active applications and registrations for marks comprising the term WARP with an additional element(s) in connection with similar and potentially related goods in Class 9. These third-party marks serve as compelling evidence that the shared term WARP is weak and diluted, such that it creates minimal source identifying significance that could contribute to any likelihood of confusion apart from the Cited Marks in their entireties. This wide adoption of WARP in connection with the shared goods also suggests that no one entity possesses the exclusive right to use the term independently from other distinctive elements in connection with similar or related goods.

If the common element of two or more marks is "weak" in that it is generic, descriptive, or **suggestive of the named goods or services**, it is unlikely that consumers will be confused unless the overall combinations have other commonality. *See, e.g., Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334. When properly used in this limited manner, third-party registrations are similar to dictionaries showing how language is generally used. *See, e.g., Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915 (CCPA 1976). Here, based on the above and the marks of the Cited Registration and Cited Application,

all belonging to the technology and electronics industries, the shared term WARP is suggestive of goods which are capable of performing at faster, "warp speeds".

Moreover, the above and similar prior registrations are owned by numerous different entities, evidencing that consumers have learned to recognize that various trademarks containing the WARP term derive from different sources of origin, and consumers are conditioned so as not to associate all uses of WARP with a particular, singular source but to differentiate among them. It has been established that when a component of a mark is widely used, the public can easily distinguish slight differences in other marks. *Telemed Corp. v. Tel-Med, Inc.*, 588 F.2d 213, 219 (7th Cir.1978). Accordingly, minor alterations or dissimilarities weigh heavily against any likelihood of confusion between marks. Applicant respectfully submits that the inclusion/absence of various elements in the Cited Marks help to distinguish them from the stylized WARP SPEED mark of the subject application, having a distinct font as further discussed below.




Additionally, the absence of conflict proceedings between the above owners of the numerous WARP formative marks suggests that the marks are not in fact confusingly similar to consumers, and there have been no instances of actual confusion. By the same standards, Applicant respectfully submits that the stylized WARP CHARGE mark of the subject application is similarly distinguishable from the marks of Cited Registration and Cited Application.

As the Marks are Dissimilar, There Can be No Likelihood of Confusion

A basic principle in determining confusion between marks is that marks must be compared in their entireties as to appearance, sound, connotation and commercial impression. Additions or deletions to marks may be sufficient to avoid a likelihood of confusion if: **(1) the marks in their entireties convey significantly different commercial impressions and/or (2) the matter common to the marks is not likely to be perceived by purchasers as distinguishing source because it is merely descriptive or diluted.** See, e.g., *Citigroup Inc. v. Capital City Bank Group, Inc.*, 637 F.3d 1344, 1356, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011); *In re Shawnee Milling Co.*, 225 USPQ 747, 749 (TTAB 1985) (holding GOLDEN CRUST for flour, and ADOLPH'S GOLD'N CRUST and design (with "GOLD'N CRUST" disclaimed) for coating and seasoning for food items, not likely to cause confusion, noting that, because "GOLDEN CRUST" and "GOLD'N CRUST" are highly suggestive as applied to the respective goods, the addition of "ADOLPH'S" is sufficient to distinguish the marks).

Here, Applicant's mark consists of the words WARP CHARGE, wherein the word "WARP" is presented in stylized letters. The word is positioned directly above the separate word "CHARGE" which is presented in an ordinary and smaller font. The applied-for mark consists of 2 words, appearing on 2 lines. In contrast, both of the Cited Marks consist of a single, unitary word. Any similarity created by the shared WARP term is outweighed by differences in terms of appearance, connotation, and commercial impression created by the addition of various literal terms and/or design elements to the subject mark and the Cited Marks. Therefore, the Examining Attorney's isolation of the shared word MONARCH from the entirety of each of the Cited Marks, and reliance on the same in finding a likelihood of confusion, is improper. Moreover, in view of the above-discussed weakness of the shared literal element, WARP, the visual differences between the marks must be considered carefully when deciding whether likelihood of confusion exists. *E.g., In re Vienna Sausage Mfg. Co.*, 16 USPQ2d 2044, 2047 (TTAB 1990).

A review of the below side by side comparison of the subject mark with each of the Cited Marks readily reveals the visual differences between the marks, due to various distinguishing features:

Applied for Mark	Cited Mark
 <p>The logo features the word "WARP" in a large, bold, stylized font with a curved underline. Below it, the word "CHARGE" is written in a smaller, spaced-out, sans-serif font.</p>	<p>WARP</p>
 <p>The logo features the word "WARP" in a large, bold, stylized font with a curved underline. Below it, the word "CHARGE" is written in a smaller, spaced-out, sans-serif font.</p>	 <p>The logo features the word "STARWARP" in a bold, italicized, sans-serif font with a curved underline.</p>

As evident by the above, the applied-for mark of the subject application readily differs from the marks of the Cited Registration and Cited Application due to crucial visual and phonetic differences, discussed below. Accordingly, Applicant respectfully disagrees with the Examining Attorney's assessment that the marks are confusingly similar. Applicant submits that despite the disclaimer of "CHARGE" apart from Applicant's applied-for mark, this inclusion of the additional term should not be ignored, as indeed they help to distinguish the marks, visually and phonetically, from each other. Even where a word portion is disclaimed, the mark must still be regarded as a whole, including the disclaimed matter, in evaluating similarity to other marks, as the entirety of the mark will be perceived by the public. See *In re Nat'l Data Corp.*, 753 F.2d 1056, 1059 (Fed. Cir. 1985). As evident by the above comparison, Applicant respectfully submits that the applied-for mark as a whole is distinguishable in sight and sound from the marks of the Cited Marks. The various additions to the WARP term further create unique commercial impressions sufficient to avoid consumer confusion in the marketplace.

Therefore, in light of the readily apparent differences in the marks and the crowded field of WARP formative marks for similar and related goods, there is no likelihood that consumers would mistakenly believe that the services provided under Applicant's mark originated from the Cited Registrant or the Cited Applicant.

The Applicant's Goods are Dissimilar and Offered Through Distinct Trade Channels

The analysis of likelihood of confusion also compares the goods/services to determine if they are similar or whether the activities surrounding their marketing are such that confusion as to origin is likely. "If the... services in question are not related or marketed in such a way that they would be encountered by the same persons in situations that would create the incorrect assumption that they originate from the same source, then, even if the marks are identical, confusion is not likely." TMEP §1207.01(a)(i).

As an initial matter, Applicant notes that it has deleted Class 35 and amended the goods of the subject application to specifically recite "~~Data cables; Power adapters~~ **for cell phones**; Cell phone battery chargers; ~~Electrical adapters~~; Batteries, electric; Chargers for electric batteries; Wireless chargers," in Class 9, in order to further separate and distinguish the applied-for goods from those of the Cited Registrant and Cited Applicant. In contrast, the Cited Registrant provides video display converters, and the Cited Applicant provides, *inter alia*, computer peripherals and data processing/storage devices.

While the parties' goods may arguably exist within a common broad industry, the Trademark Trial and Appeal Board has confirmed that goods and/or services within a shared industry can be 'distinctly different activities that move in different channels of trade and to different classes of consumers' such that consumer confusion is unlikely even when the marks are similar. *See, e.g., In re Javelin Capital Markets, LLC*, 2015 WL 4380981 (TTAB 2015). Applicant respectfully submits that due to the different and tailored nature of its products, consumers who seek Applicant's cell phone chargers and associated adapters would not be likely to look toward the video display converters provided under the WARP mark of Cited Reg. No. 3200353, or the data processing and storage devices provided under the STARWARP mark of Cited Application No. 87680490. Further, the consumers who seek the goods of the Cited Registrant and Cited Applicant are unlikely to confuse those with the Applicant's goods, which are specifically dedicated to cell phone charging. Therefore, the parties will not be in competition due to the distinct goods that each provides.

For the reasons above, the Applicant, the Cited Registrant and Cited Applicant also engage in distinct channels of trade, which prevents the parties from competing with each other. The issue is not whether the respective marks themselves, or the goods or services offered under the marks, are likely to be confused but, rather, whether there is a likelihood of confusion as to the source or sponsorship of the goods or services because of the marks used thereon. *See, e.g., Paula Payne Prods. Co. v. Johnson's Pub'g Co.*, 473 F.2d 901, 902 (CCPA 1973). Comparison of the similarity between marks and goods/services must occur in a context that recognizes how consumers encounter the products. *Kemp v. Bumble Bee Seafoods, Inc.*, 398 F.3d 1049 (8th Cir. 2005).

Accordingly, Applicant submits that the goods of the respective parties fall within distinct channels of trade, and there can be no likelihood of confusion.

Conclusion

Applicant respectfully submits that the Examining Attorney's points of objection have been resolved and requests prompt publication. If the Examining Attorney has any questions, or if it would otherwise facilitate registration of the application, she is requested to contact Applicant's attorney.