

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE COMMISSIONER OF TRADEMARKS

Applicant: Shenzhen Grandsun Electronic Co., Ltd.

Cleer, Inc.

Serial Number: 88480853

Filing Date: June 19, 2019

Mark: **TREK**

Classes: 009

Law Office: 115

Examining Attorney: Maureen Reed

I. INTRODUCTION

Applicant “Shenzhen Grandsun Electronic Co., Ltd. “ and “Cleer, Inc.” (“Applicant”) respond as follows to the September 17, 2019 Office Action (“Office Action”) issued against Application No. 88480853 (the “Application”) for the trademark **TREK** in Class 009.

In the Office Action, the Examining Attorney cited the following U.S. Trademark Registrations against the Application: U.S. Registration No. 5397173 (“Regis. No. 5397173”) for the trademark **PRO TREK** and U.S. Registration No 5649679 (“Regis. No. 5649679”) for the **PRO TREK SMART** mark in Class 009.

For the reasons discussed below, including the fact that the Applicant has deleted a number of goods from the Application, Applicant respectfully contends that there is no likelihood of confusion between Applicant's **TREK** mark and either of the cited marks.

II. THRESHOLD CONSIDERATIONS

As is detailed in the appropriate section of this Response to Office Action, the Applicant has deleted a number of goods from the Application as a result of which only the following goods remain in the Application:

“Humanoid robots with artificial intelligence; Wearable video display monitors; Portable media players; Wearable activity trackers; Personal digital assistants (PDA); Time clocks; Dictating machines; Telecommunication apparatus in the nature of wireless receivers in the form of jewelry; Telephone terminals”

As is discussed further below, Applicant believes that its amendments to the identification of goods in the Application eliminates any likelihood of confusion between the parties' marks.

III. ANALYSIS

Likelihood of confusion between two trademarks under Section 2(d), should be determined by considering the *Du Pont* factors as they apply to the case at hand. These factors include: (i) the similarity or dissimilarity of the marks in their entireties; (ii) the similarity or dissimilarity and nature of the goods or services as described in an application or registration or in connection with which a prior mark is in use, (iii); the nature of the purchasers of the goods and the conditions under which sales occur; (iv) the nature and extent of any actual confusion; and (v) any other established fact that is probative of the effect of use. In re E.I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973).

i. Similarity or Dissimilarity of the Marks in their Entireties

The Court of Appeals for the Federal Circuit has stated "the use of an identical word, even a dominant word, does not automatically mean that two Marks are similar." *See Freedom Savings & Loan Assoc. v. Way*, 757 F. 2d 1176, 1183 (11th Cir. 1985). Marks should be compared for similarities in their appearance, sound, meaning or connotation and commercial impression and must be considered in the way they are used and perceived. *In re National Data Corp.*, 753 F.2d 1056 (Fed. Cir. 1985); *Packard Press Inc. v. Hewlett-Packard Co.*, 56 USPQ2d 1351 (Fed. Cir. 2000) (emphasis added)

While it is not proper to dissect a Mark, if one feature of a Mark is more significant than another feature, greater weight may be given to the dominant feature for purposes of determining likelihood of confusion. *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 1570-71, 218 USPQ 390,395 (Fed. Cir. 1983) The Court of Appeals for the Federal Circuit has cautioned, however, that "[t]here is no general rule as to whether letters or designs will dominate in composite Marks; nor is the dominance of letters or designs dispositive of the issue." *In re Electrolyte Labs. Inc.*, 929 F.2d 645, 64 7, 16 USPQ2d 1239, 1240 (Fed. Cir. 1990). TMEP § 1207.01(c)(ii). While the Examining Attorney may find one portion of a mark the dominant feature, no element of a mark is to be ignored simply because it is less dominant or would not have trademark significance if used alone. *See Spice Islands, Inc. v. Frank Tea & Spice Co.*, 505 F.2d 1293, 184 USPQ 35 (CCPA 1974) (improper to ignore portion of composite mark).

a. Similarities/Dissimilarities between the Parties' Marks

The Applicant's Mark	Regis. No. 5397173
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TREK	PRO TREK
The Applicant's Mark	Regis No. 5649679
TREK	PRO TREK SMART

As can be readily seen from the juxtaposition of the parties' marks above, Applicant's **TREK** mark is different enough from the cited **PRO TREK** mark and **PRO TREK SMART** mark that no likelihood of confusion exists.

TREK vs. PRO TREK. While both marks contain the word "TREK", Applicant's **TREK** mark consists of one four-letter word, while **PRO TREK** consists of two words and seven letters. Furthermore, the literal element "PRO" is placed *in front* of the literal element TREK. Entirely ignoring the literal element "PRO" would be inappropriate given the fact PRO is before TREK. Looking at the mark as a *whole* for PRO TREK, the marks appear different and are pronounced differently. As a result of these *visual and aural differences*, the two marks convey different commercial impressions that are sufficient to make confusion unlikely, especially where, as here, the parties' goods are different and the other factors at work here militate against likelihood of confusion.

TREK vs. PRO TREK SMART. While both marks contain the word "TREK", Applicant's **TREK** mark consists of one four-letter word, while **PRO TREK SMART** consists of three words and twelve letters. The registered mark is four times as long as Applicant's mark in letters, and three times as long in words. Not only is the literal element PRO placed before

TREK, there is also SMART added to the other side. As a result, the marks appear different and are pronounced differently. As a result of these *visual and aural differences*, the two marks convey different commercial impressions sufficient to make confusion unlikely, especially where, as here, the parties' goods are different and the other factors weigh against likelihood of confusion.

ii. Similarities/Dissimilarities of the Goods

The Board and the Federal Circuit have cautioned that “a finding that the goods are similar is not based on whether a general term or overarching relationship can be found to encompass them both.” *In re Mars, Inc.*, 741 F.2d 395, 396 (Fed. Cir. 1984) (no likelihood of confusion between exact mark CANYON for food products, where one party's use was for candy bars and the other's was for fruit); *see also In re Donnay International Société Anonyme*, 31 U.S.P.Q.2d 1953 (T.T.A.B. 1994) (no likelihood of confusion between GHOST and THE GHOST for sporting goods, where one party's use related to racquet sports and the other's related to soccer); *Vitarroz Corp. v. Borden, Inc.*, 644 F.2d 960 (2d Cir. 1981) (no likelihood of confusion between BRAVO'S for crackers and BRAVOS for tortilla chips). Even if the goods are considered related, a “sliding scale” analysis should be applied to determine whether there is a likelihood of confusion. That is, if the goods are only slightly related, the marks need to be identical or nearly identical. For example, in *Cambridge Rubber Co., v. Cluett, Peabody & Co.*, the court found women's boots and men's underwear to be related, but the marks at issue there (“WINTER CARNIVAL”) were identical. *Cambridge Rubber Co. v. Cluett, Peabody & Co.*, 286 F.2d 623, 624, 128 USPQ 549, 550 (C.C.P.A. 1961).

a. The Parties' Respective Goods in this Case

The Class 009 goods covered by the Application, as amended, are:

“Humanoid robots with artificial intelligence; Wearable video display monitors; Portable media players; Wearable activity trackers; Personal digital assistants (PDA); Time clocks; Dictating machines; Telecommunication apparatus in the nature of wireless receivers in the form of jewelry; Telephone terminals” in Class 009.

The goods covered by the registrations are:

Smart watches; batteries; battery chargers; charging cables; electrical adapters; earphones and headphones; downloadable mobile applications and software for processing, reviewing and editing data from smart watches and mobile devices featuring global positioning systems, compasses, barometers, altimeters and thermometers, in Class 009

As can be plainly seen, *none* of the goods covered by Applicant’s **TREK** mark are the same or even “related” to any of the goods covered by the **PRO TREK** mark or the **PRO TREK SMART** mark.

Even if the parties’ goods could occasionally be used together, or were otherwise deemed “complementary”, this does not automatically mean they should be considered “related”, nor does it establish likelihood of confusion. *See In re Thor Tech, Inc.*, 113 USPQ2d 1546, 1551 (TTAB 2015) (finding that trucks and trailers are not likely to cause confusion given the difference in the nature of the goods). Moreover, to the extent any of the parties’ goods are deemed “related”, application of the “sliding scale” analysis mentioned above should compel the conclusion that there is no likelihood of confusion between the Applicant’s **TREK**

mark and either of the cited marks. This is especially the case where, as here, there are a number of active U.S. Trademark Registrations in Class 009 for marks that consist in whole or in part of the element “TREK”. See discussion at point iv below.

iii. **The nature of the purchasers of the goods and the conditions under which sales occur.**

The parties’ goods are not the kind that would typically be ordered in, say, a restaurant or similar setting where goods with similar marks might be confused when customers verbally order them from the seller, or when consumers in grocery store checkout lines buy small, inexpensive items on impulse. Rather, buyers of the parties’ goods would typically encounter them in the electronics section of a department or specialty store, or an online retail platform, in a specialty catalogue or brochure or other venue that would give consumers the opportunity to *perceive the goods visually, inspect them, examine their design, look, specifications, functionality and price, then carefully decide whether to buy them.*

Moreover, one would expect buyers of the parties’ respective goods to possess at least a reasonable amount of sophistication and purchase such goods only after careful, thoughtful consideration. As the Court noted in *Electronic Design & Sales Inc. vs. Electronic Data Systems Corp.*, 21USPQ2d 1388, 1392 (Fed.Cir.1992), “sophisticated consumers may be expected to exercise greater care” Moreover, in *Pignon de Mecanique de Precision v. Polaroid Corp.*, 212 USPQ 245, 252 (1st Cir. 1981), the Court held that “[t]here is always less likelihood of confusion where goods are purchased after careful consideration.” *Astra Pharmaceuticals Prods., Inc. v. Beckman Instruments, Inc.*, 220 USPQ 786, 790 (1st Cir.1993). Such is the case here. Buyers of the parties’ goods would be expected to notice the differences in their respective trademarks and not confuse them.

- iv. *Any other established fact that is probative of the effect of use -The number and nature of similar mark in use on similar goods.*

If there is evidence that “establishes that the consuming public is exposed to third-party use of similar marks on similar goods, it ‘is relevant to show that a mark is relatively weak and entitled to only a narrow scope of protection’.” TMEP §1207.01(d)(iii) citing *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772*, 396 F.3d 1369, 1373-74, 73 USPQ2d 1689, 1693 (Fed. Cir. 2005). As Exhibits A through G attached hereto show, besides the two cited registrations, there are at least 7 other active registrations in Class 009 for marks that consist in whole or in part of the element “TREK”. Although the Class 009 goods covered by these registrations are different, the goods covered by the Applicant’s **TREK** mark are no less different. Therefore, Applicant’s **TREK** mark should also be able to peaceably coexist on the USPTO register with the two cited registrations as well as these 6 other registrations.

III. CONCLUSION

Based on the foregoing, Applicant respectfully submits that there is no likelihood of confusion between Applicant’s **TREK** mark and either the **PRO TREK** mark or the **PRO TREK SMART** mark. Therefore, Applicant requests that the Examining Attorney withdraw the refusal of Application No. 88480843 and allow its **TREK** mark to proceed to publication and registration.

Dated this 10th day of March 2020.

Respectfully Submitted,
/Nazly Aileen Bayramoglu/

Bayramoglu Law Offices LLC
Attorney of Record