

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

**Applicant:** Ford Motor Company

**Serial No.:** 90014301

**Filed:** June 22, 2020



**Mark:**

**Class:** 35, 36, 37, 41, 42, and 43

**Atty. Docket No.:** 842851219

**Examining Attorney:** Mr. Tejbir Singh/ Law Office 106

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**RESPONSE TO OFFICIAL ACTION**

The Applicant, Ford Motor Company, files this document in response to the Examiner's Official Action, dated September 1, 2020. Based upon the Applicant's amendments and the information/arguments set forth below, the Applicant respectfully requests that the Examiner withdraw the objections, and approve the amended application for publication in its entirety.

A. **Request for Amendment of Designation of Services**

Applicant notes the Examiner's acceptance of the designation of services in Classes 36, 37, 43 and 45. In accordance with the Examiner's request, Applicant requests the following amendments to clarify the remaining services to read as follows:

- Class 35: Promoting the goods and services of others; promoting the goods and services of others by providing hypertext links to the web sites of others; marketing services, namely, promoting and advertising the goods and services of others; real estate marketing services in the field of residential homes and office buildings provided via the internet; providing consumer product information via the internet; providing business information, namely, commercial corporate and statistical information provided on-line; retail store services featuring a wide variety of consumer goods of others; arranging and conducting of exhibitions for business purposes; business consultation and development services relating to business management and business operations; retail and online store services for the goods of others in the fields of developing, designing, and testing transportation mobility and connectivity products and services and related businesses; promotional services, namely, promoting the goods of others by providing online gift cards, gift certificates, coupons, restaurant menus; business incubation services, namely, providing work space containing business equipment to emerging, start-up and existing companies; business development services, namely, providing start-up support for businesses of others
- Class 41: Conducting cultural or educational exhibitions and interactive exhibits and displays in the fields of history, architecture and neighborhood growth and development; providing mentoring for businesspeople and entrepreneurs in the field of business development; providing career coaching services
- Class 42: Providing scientific and technological services and research in the fields of transportation and mobility solutions, connectivity, emerging technologies, community development, sustainable communities, ecological resilience business innovation studios, and environmentally-conscious and green innovations; design services for scientific and technological research; industrial analysis and research services for transportation and mobility solutions, connectivity, emerging technologies, community development, sustainable communities, ecological resilience business innovation studios, and environmentally-conscious and green innovations

This is a proper clarification, and not an expansion of the services, in accordance with 37 C.F.R. Sec. 2.7(a) and TMEP Sec. 1402.06.

C. **Request for Withdrawal of Section 2(d) Refusal- No Likelihood of Confusion**

The Examiner has raised a Section 2(d) objection to registration of the mark for the Class 35 services, based upon MC Granite Countertops, LLC’s registration for MC for Class 35 retail services, namely “distributorships and retail store services featuring granite, marble, quartz, quartzite, sinks and faucets.” Applicant respectfully requests withdrawal of the Section 2(d) objection since there is no likelihood of confusion as to the source or origin of Applicant’s clarified



and amended services provided under its mark. Applicant submits that its design mark has a different commercial impression than the cited mark “MC”, and its services are quite different than those provided by MC Granite Countertops, LLC.

1. **Applicant’s Mark Creates a Different and Distinct Commercial Impression**



Applicant’s filed application is for for use in connection with a specified list of services in Class 35, as amended. The list of Class 35 services references a range of services including support to new and developing businesses in connection with Ford’s MC MICHIGAN CENTRAL project, the third party business entities are expected to operate in the fields of transportation, mobility, connectivity, emerging technologies, community development, residential and commercial real estate, sustainable communities, ecological resilience, and business innovation studios. Applicant is also providing cultural and educational exhibitions and exhibits, scientific and technological services and facilities to support related businesses, providing

community centers for social gatherings and meetings, and providing personal concierge services for others.



Applicant's services are committed to establishing a cutting edge business and technical development hub and facilities, for a community steeped in the history of Detroit's oldest neighborhood. Ford Motor Company has made a significant investment in the community, history, and revitalization of Detroit, by purchasing 1.2 million square feet of land in the old "Corktown" neighborhood for development. The centerpiece is the historic Michigan Central Station building, an architectural gem which was the main intercity passenger rail depot in Detroit from 1914 to 1988. The building consists of a three-story train depot and an eighteen-story office tower. This grand station was a temple to transportation, and was added to the National Register of Historic Places in 1975. Ford is committed to restoring and redeveloping the landmark building into a mixed use facility and cornerstone of the company's facilities at the location.

Applicant is investing heavily in the area and buildings to create a dynamic business incubation and innovation center with residential and commercial spaces to provide the extensive services set forth in the designation of services for this trademark application. There is a clear and conscious association with the State of Michigan, a historic landmark in the City of Detroit, and the revitalization of the past history and future impact of the area. The goal is to establish a mobility innovation center in this community to spur research and development of new transportation and mobility solutions, and to provide residential development and commercial space for related enterprises and support businesses. Attached are copies of press releases and excerpts from Applicant's web page at [www.michigancentral.ford.com](http://www.michigancentral.ford.com) with additional information about the




MICHIGAN CENTRAL




mission and services Ford intends to provide under its  and  marks. See Exhibit A, A1, and A2. All of this background and publicity impacts the commercial impression of the marks.

In contrast, the cited mark is registered in Class 35 for “distributorships and retail store services featuring granite, marble, quartz, quartzite, sinks, and faucets,” and for related installation and fabrication services in Classes 37 and 40. No one will confuse the “MC” branded custom countertops, and installation/fabrication services with Ford Motor Company’s use of its stylized



 in connection with its expansive visionary mission to revitalize and redevelop a business center in Detroit, and to further the field of community development, transportation, mobility and connectivity through its designated services in Classes 35, 36, 37, 41, 42, and 43. No one will be



confused and believe that Ford’s  services are associated with the Georgia countertop supplier. These marks create dramatically different commercial impressions in connection with their very different services, and can effectively function as distinct source indicators in the context of the relevant marketplaces.


**2. Applicant’s Service are quite different, and the Purchaser Care is High**

The question for likelihood of confusion is whether the relevant ordinary, reasonably informed consumer is likely to be confused by the parties' marks into somehow associating

Applicant's services with registrant's services in Class 35. As noted above, Ford's services are quite different from those of the cited registration. If likelihood of confusion exists, it must be based on the confusion of some relevant person, i.e., a customer or purchaser. Where the marks the services are very different and not competitive, there is little chance of confusion under the *du Pont* factors.

In addition, there is **less** likelihood of confusion where goods are expensive and purchased after careful consideration. *Astra Pharm. Prods. v. Beckman Instruments, Inc.*, 718 F.2d 1201, 1206 (1st Cir. 1983) citing *Pignons S.A. de Mecanique v. Polaroid Corp.*, 657 F.2d 482 (1st Cir. 1981); and *Fisher Stoves, Inc. v. All Nighter Stove Works, Inc.*, 626 F.2d 193, 194-95 (1st Cir. 1980). In this case, these different marks are used in connection with very different services. The Examiner's objection relates only to the services in Class 35, as amended, and there is absolutely no reference to distribution of granite and quartz countertops and sinks and faucets in Ford's designation of services. The registrant's services relating to its countertops are custom services, which require direct interaction with the customer, and are not low-cost impulse purchases.



Likewise, Ford's services under its  mark relate to cutting edge technology in the transportation, mobility and connectivity fields with a global impact, as well as business development and community and real estate development for a particular neighborhood and the City of Detroit. Ford's mission and services have already received significant publicity and expect to have a large impact on the community and the global transportation and mobility field. These are not low-cost impulse purchases or services. The relevant customers/public would have a high

degree of sophistication in their review of these marks in the relevant marketplace. There would be no confusion as to the source of the entities' respective services.




### **3. The Cited Mark is Weak and Not Entitled to A Broad Scope of Protection**

Furthermore, the cited mark is not entitled to an unlimited monopoly on the two letter mark MC. The Trademark Trial and Appeal Board has recognized that weak marks are entitled to a narrow scope of protection and that such protection has been "limited to the substantially identical notation and/or to the subsequent use and registration thereof for substantially similar goods." TMEP Sec. 1207.01(b)(ix), In *In re Hunke & Jochheim*, 185 USPQ 188, 189 (TTAB 1975). In this case, the cited mark is weak and should not block the Applicant's mark for such different services.


The TMEP provides that evidence of third-party use and registration of similar marks on similar goods is to be considered, since it is one of the factors in determining likelihood of confusion under the *du Pont* factors. TMEP Sec. 1207.01(d)(iii), citing to *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973). The TMEP further provides:

[i]f the evidence establishes that the consuming public is exposed to third-party use of similar marks on similar goods, this evidence 'is relevant to show that a mark is relatively weak and entitled to only a narrow scope of protection.'  
TMEP Sec. 1207.01(d)(iii), citing to *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772*, 396 F.3d 1369, 1373, 73 USPQ2d 1689, 1693 (Fed. Cir. 2005).

The Principal Register is crowded with MC-Component marks. Even for Class 35 services, the Trademark Office has not accorded the cited registrant – or others - exclusive rights in the letters M and C. There are multiple coexisting Registrations incorporating the MC-component in Class 35, including, but not limited to the following:

Trademark	Key Dates	Full Goods/Services	Owner
MC  RN: 5807569	Reg. July 16, 2019 1 <sup>st</sup> Use Dec 5, 2017	Class 35, Administration of a customer loyalty program which provides rewards for movie theater tickets, concessions and services.  Class 41 Movie theaters  (Additional goods in Int'l Class 9)	Cinemark USA, Inc. Corporation Texas 3900 Dallas Parkway Plano Texas 75093
MCS  RN: 6091201	Reg. June 30, 2020 1 <sup>st</sup> Use June 14, 2017	Int'l Class 35 Market research and consulting services relating to measuring effectiveness and nature of customer service solutions; advertising, marketing and promoting services; online marketing services; business advice and information.  Int'l Class 42 providing online non-downloadable software used for customer service solutions, namely, measuring the effectiveness and nature of customer service solutions.  (Additional goods in Int'l Class 9)	LivePerson, Inc. Corporation New York 5th Floor 475 10th Avenue New York New York 10018
MC  RN: 5087830	Reg. Nov 22, 2016 1 <sup>st</sup> Use June 1, 2015	Int'l Class 35, Administration of a customer loyalty program which provides incentives and rewards for coin collectors.	Monnaie royale canadienne / Royal Canadian Mint canadian crown corporation CANADA 320, Prom. Sussex Drive Ottawa, Ontario CANADA K1A0G8
MC  RN: 4600255	Reg. Sep 9, 2014 1 <sup>st</sup> Use April 13, 2013	Int'l Class 35 Data compiling and analyzing in the field of insurance.	Municipal Claims Llc Dba Municlaims California LLC 28562 Silverking Trl Santa Clarita California 91390
MC  RN: 5790196	Reg. July 2, 2019 1 <sup>st</sup> Use	Int'l Class 35, Retail store services, online retail store services, and wholesale store services featuring woven fabrics and beddings; featuring clothing; personal articles; kitchen equipment...  Int'l Class 43, Providing food and beverages  (Additional goods in Int'l Classes 29, 30, 32)	Kabushiki Kaisha Donq (DBA Asdonq Co., Ltd.) Corporation JAPAN 10-19, Sannomiya- cho, 2-chome, Chuo- ku, Kobe-shi Hyogo 650-0021 JAPAN



MCS  RN: 1608463	Reg. July 31, 1990 1 <sup>st</sup> Use Jan 1, 1998	Int'l Class 35, Retrieval and copying of medical records for others.	Mcs Group, Inc., The Corporation Assignee Of Pennsylvania 1601 Market Street, Suite 800 Philadelphia Pennsylvania 19103
MCM SN: 6142047	Reg. Sep 1, 2020 Basis: Section 44e	Int'l Class 35, Retail store services featuring perfumery, diffusers, scented candle articles, cosmetics, sunglasses, cellular phone cases, chronometric instruments, stationery, jewelry products, bags, leather or imitation leather goods, tableware, fabric, footwear, headgear, clothing, toys; Business management of retail outlets; online retail store services featuring perfumery articles, cosmetics, sunglasses, cellular phone cases, chronometric instruments, stationery, jewelry products, bags, leather or imitation leather goods, tableware, fabric, footwear, headgear, clothing, toys; business management assistance in the field of franchising...  (Additional goods in Int'l Class 3, 4, 9, 14, 16,18, 21, 24, 25, 26, 28)	TRIAS Holding AG aktiengesellschaft SWITZERLAND Baarerstrasse 88 Zug SWITZERLAND CH-6300

Copies of the TESS records for these registrations are attached as Exhibit B.

These MC-component registrations have been allowed to coexist – even where the goods and services potentially overlap. In this case, not only are the cited marks weak, but the applied-for mark is different from them all. As such, the cited mark and these marks should not block the Applicant's non-identical mark, especially when used on non-identical Class 35 services. The Applicant submits that it does not manufacture or sell countertops, and that its mark and extensive services are sufficiently different to avoid a likelihood of confusion in the relevant marketplace.

**C. Conclusion**

Applicant respectfully requests entry of the referenced amendments, and requests withdrawal of the Section 2(d) refusal in Class 35. Applicant's mark and different and non-competing services establish a distinctly different and well-publicized commercial impression. It is not likely to be confused with the cited mark and custom countertop retailer in the relevant marketplace. Applicant submits that the mark is in a form suitable for publication for registration on the Principal Register and respectfully requests such action.

Respectfully submitted,

FORD MOTOR COMPANY

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