

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Callies Performance Products, Inc.

Trademark Examining Attorney:

Trademark: ENERGY (Stylized)

Ingrid C. Eulin
Law Office 111

Serial No.: 90171796

Attorney Docket: C470-221706

May 25, 2021

Honorable Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

Amendment and Response to Office Action

Honorable Sir:

In response to the Office Action from the Examining Attorney dated December 8, 2020, the applicant provides the following remarks and amendments.

Description of the Mark:

Please amend the application to include the following description of the mark:

The mark consists of the stylized word ENERGY having dark outlines and with an oversized N.

Citation under Trademark Act Section 2(d):

The Examining Attorney initially refused registration under Trademark Act Section 2(d), 15 U.S.C. 1052(d), because the applicant's mark, when used on or in connection with the identified services, is allegedly likely to cause confusion with marks in the following prior registrations:

U.S. Registration No. 4989088 E ENERGYCOIL (Design);

U.S. Registration No. 5929448 ENERGY IFOG (Design); and

U.S. Registration No. 5076937 EVIL ENERGY (Design).

Each mark is individually referred to hereafter as "Cited Mark", or collectively, "Cited Marks".

The test for likelihood of confusion under Section 2(d) of the Trademark Act involves a

weighing of thirteen factors, each of which must be considered when evidence is made of record concerning such factors. *In re E.J. du Pont de Nemours & Co.*, 177 U.S.P.Q. 563, 567 (C.C.P.A. 1973). A careful consideration of relevant *Du Pont* factors demonstrates that no likelihood of confusion exists between the applicant's Mark and the Cited Marks.

For the reasons set forth below, the applicant respectfully requests the Examining Attorney reconsider and withdraw the refusal to register the applicant's mark and allow the mark to pass to publication.

A. Differences in Appearance, Sound, and Commercial Impression Between Applicant's Mark and the Cited Marks Preclude Consumer Confusion.

"Similarity of the marks is one of the most probative and critical elements in the confusion analysis." *W.L. Gore & Assoc. v. Johnson & Johnson*, 882 F. Supp. 1454, 1457-58, (D. Del. 1995). Here, the applicant's mark ENERGY (Design) differs significantly from the Cited Marks E ENERGYCOIL (Design), ENERGY IFOG (Design), EVIL ENERGY (Design) in sight, sound, meaning, connotation, and overall commercial impression. As discussed in greater detail below, the Cited Marks incorporate distinctive wording, colors, and dominant design elements not shared by the applicant's mark.

According to longstanding precedent, the fact that marks "must be considered in their entirety in determining whether there is a likelihood of confusion or mistake is a basic rule in comparison of marks." *Massey Junior College, Inc. v. Fashion Inst. Of Tech.*, 492 F.2d 1399, 1402, 181 U.S. P.Q. 272, 273-74 (C.C.P.A. 1974). As the Supreme Court has noted, "[t]he commercial impression of a trade-mark is derived from it as a whole, not from its elements separated and considered in detail. For this reason, it should be considered in its entirety." *Estate of P.D. Beckwith, Inc. v. Comm'r of Patents*, 252 U.S. 538, 545-46, 40 S. Ct. 414, 417 (1920); *see also In re Hearst Corp.*, 982 F. 2d 493, 494, 25 U.S.P.Q.2d 1238, 1239 (Fed. Cir. 1992)("Marks tend to be perceived in their entirety, and all components thereof must be given

appropriate weight”). The Board has further explained that “it is the entire mark which is perceived by the purchasing public, and, therefore, it is the entire mark that must be compared to any other mark. It is the impression created by the involved marks, each considered as a whole, that is important.” *Genesco Inc. v. Martz*, 66 U.P.Q.2d 1260, 1269 (T.T.A.B. 2003); *accord Franklin Mint Corp. v. Master Mft. Co.*, 667 F.2d 1005, 1007, 212 U.S.P.Q. 233, 234 (C.C.P.A. 1981)(MM design not confusingly similar to FM design); *New England Fish Co. v. Hervin Co.*, 511 F.2d 562, 184 U.S.P.Q. 817 (C.C.P.A. 1975)(BLUE MOUNTAIN KITTY O’s for cat food not confusingly similar to KITTY for same).

1. The Differences in the Words Comprising Applicant’s Mark and the Cited Marks Distinguish the Marks and Preclude a Likelihood of Confusion.

The Examining Attorney claims the applicant’s mark and the Cited Marks create the same commercial impression because of the shared “ENERGY” wording.

However, the anti-dissection rule prevents relying solely on comparisons of individual terms in the mark. Further, it is well established that, even where two marks contain one or more identical terms, slight differences in the appearance, sound, connotation, or commercial impression conveyed by the marks can be sufficient to dispel confusion. *See Freedom Savs. & Loan Ass 'n v. Way*, 757 F.2d 1176, 1186 (11th Cir. 1985) (finding FREEDOM REALTY not confusingly similar to FREEDOM SAVINGS AND LOAN); *see also Time Inc. v. Peterson Publ’g Co.*, 173 F.3d 113, 119, (2nd Cir. 1999 (no likelihood of confusion between TEEN and TEEN PEOPLE, both for magazines); *In re Lancer Orthodontics, Inc.*, 1998 WL 377664, *2 (T.T.A.B. 1998)(no likelihood of confusion between IN ADVANCE and ADVANCE, both for dental products). In fact, a difference as subtle as *one letter* can be sufficient to significantly distinguish two marks. *See Citigroup, Inc. v. City Holding Co.*, 171 F. Supp. 2d 333, 348 (S.D.N.Y. 2001) (“In appearance the [CITI and CITY] marks are significantly different.”).

When viewed in their entireties, it is apparent the applicant’s mark is distinguishable from the Cited Mark. The word portion of the applicant’s mark is ENERGY, but the inquiry

does not end there. The Cited Marks all include terms that are not included in the applicant's mark, each of which are evaluated below:

- Cited Mark E ENERGYCOIL and Design does not include the term ENERGY as a standalone term. It instead includes the leading term E and the compound term ENERGYCOIL – not a standalone term ENERGY. *Importantly, the registration for this mark includes a disclaimer of exclusive rights to the term ENERGYCOIL.*
- Cited Mark ENERGY IFOG and Design includes the term IFOG. *Importantly, the registration for this mark includes a disclaimer of exclusive rights to the term ENERGY.*
- Cited Mark EVIL ENERGY and Design includes the leading, dominant term EVIL.

In all three of the Cited Marks, the term ENERGY is clearly not the dominant term that will make an impression on consumers, as evidenced by the fact that two of the three registrations even include disclaimers of ENERGY. Typically, disclaimed matter will not be regarded as the dominant, or most significant, feature of a mark. *See* TMEP § 1231.10. *See, e.g., In re Dixie Rests., Inc.*, 105 F.3d 1405, 1407, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997) (affirming TTAB's finding that "DELTA," not the disclaimed generic term "CAFE," is the dominant portion of the mark THE DELTA CAFE); *In re Binion*, 93 U.S.P.Q.2d 1531, 1534 (T.T.A.B. 2009) (finding that "BINION'S," not the disclaimed descriptive wording "ROADHOUSE," is the dominant portion of the mark BINION'S ROADHOUSE). Thus, the fact that the applicant's mark and the marks E ENERGYCOIL and ENERGY IFOG all include the term ENERGY is no consequence, since the attention of consumers will be drawn to the unique, dominant terms in the marks E ENERGYCOIL and ENERGY IFOG.

Although the third Cited Mark, EVIL ENERGY, does not include a disclaimer of ENERGY, the first word in that mark is the distinctive term EVIL. In the context of the Class 7 engine and vehicle components offered under the mark, the leading term EVIL is completely arbitrary, whereas the term ENERGY is descriptive. Specifically, the Oxford Dictionary defines





“energy” as meaning “power derived from the utilization of physical or chemical resources, especially to provide light and heat or to work machines”. See Exhibit 1 attached - “energy” Oxford Dictionary. Web. 25 May 2021. <https://www.lexico.com/en/definition/energy> The goods identified in the registration for the Cited Mark EVIL ENERGY are used to power machines. There is a clear descriptive connotation, making ENERGY in the Cited Mark EVIL ENERGY Design is a weak element that is unlikely to make an impression on consumers.

In sum, the common element among the applicant’s mark and all of the Cited Marks is ENERGY, and that element is weak within the Cited Marks. When the common element of marks under comparison is "weak" - in that it is generic, descriptive, or highly suggestive of the named goods - it is unlikely consumers will be confused unless the overall combinations have other commonality. See *In re Bed & Breakfast Registry*, 791 F.2d 157, 159 229 U.S.P.Q. 818, 819 (Fed. Cir. 1986) (reversing TTAB’s holding that contemporaneous use of BED & BREAKFAST REGISTRY for making lodging reservations for others in private homes, and BED & BREAKFAST INTERNATIONAL for room booking agency services, is likely to cause confusion, because, *inter alia*, the descriptive nature of the shared wording weighed against a finding that the marks are confusingly similar); *U.S. Shoe Corp. v. Chapman*, 229 U.S.P.Q. 74 (T.T.A.B. 1985) (holding COBBLER’S OUTLET for shoes, and CALIFORNIA COBBLERS (in typed and stylized forms) for footwear and women’s shoes, not likely to cause confusion).

Last, considering the coexistence of the three distinct parties who own the Cited Marks and all were granted federal registrations on the Principal Register, it is apparent that the term ENERGY is diluted in the context of Class 7 engine and machine parts/components. Small differences among such marks should be sufficient for consumers to distinguish the goods of one party from another. That is the case here. Due to unique terms included in the Cited Marks, the goods of the Cited Marks can be distinguished from one another by consumers, and will likewise be distinguishable by consumers from the applicant’s goods.

2. Applicant’s Mark and the Cited Marks Have Different Connotations and Commercial Impressions Sufficient to Preclude Confusion.

All of the marks under consideration include dominant design elements unique to each mark. Namely, the applicant’s mark and the Cited Marks include distinctive stylization and design elements shown below:

Mark:	Design Image:	Comments:
The applicant’s mark: ENERGY		Only the applicant’s mark includes letters that are in outline form and an oversized “N”.
Cited Mark: E ENERGYCOIL (Design)		This mark includes a large “E” enclosed in a red quadrilateral, which due to its size and bold red color is dominant in this Cited Mark. This mark also includes the colors red, gray and black. The applicant’s mark does not include a quadrilateral design or any color.
Cited Mark: ENERGY IFOG (Design)		This mark depicts the term ENERGY in blue and there is light blue triangle between the terms ENERGY and IFOG in the center of the mark. The applicant’s mark does not include a triangle design or any colors.
Cited Mark: EVIL ENERGY (Design)		In this design, the term EVIL is the largest word element. This mark also includes the outline of a head with horns and the

		letter “I” in the term EVIL is dotted with fire. This mark evokes devil imagery. The applicant’s mark does not include any devil imagery.
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As noted in the comments above, there are clear differences between the design elements depicted in the applicant’s mark and the Cited Marks. These differences are critical, especially because the only shared term, ENERGY, is weak as indicated in the section above.

The Board has noted the importance of a design in the overall commercial impression of a mark:

The spoken or vocalizable element of a design mark, taken without the design, need not of itself serve to distinguish the goods. The nature of stylized letter marks is that they partake of both visual and oral indicia, and both must be weighed in the context in which they occur . . . A design is viewed, not spoken, and a stylized letter design cannot be treated simply as a word mark. *Genesco Inc. v. Martz*, 66 U.S.P.Q.2d 1260, 1269 (T.T.A.B. 2003)

Not only are the design portions of marks properly given weight in the likelihood of confusion analysis, they often are considered determinative. *See e.g., Mr. Hero Sandwich Sys., Inc. v. Roman Meal Co.*, 781 F.2d 884, 888, 228 U.S.P.Q. 364, 367 (Fed. Cir. 1986) (reversing Board and holding that ROMAN and Design not likely to be confused with ROMANBURGER); *Rudolf Wild GMBH v. 1 Uno Espresso, Inc.*, 1998 WL 306486 (T.T.A.B. 1998) (design element of opposer’s mark only “serves to make...[the] opposer’s CAPRI SUN registered marks more dissimilar from [the] applicant’s mark.”); *Hewlett-Packard Co. v. Human Performance Measurement, Inc.*, 23 U.S.P.Q.2d 1390 (T.T.A.B. 1991) (HPM and Design for medical instruments not likely to be confused with HP for medical equipment sold through same channels of trade); *Steve’s Ice Cream v. Steve’s Famous Hot Dogs*, 3 U.S.P.Q.2d 1477 (T.T.A.B. 1987) (STEVE’S and Design, including musical note, not confusingly similar to STEVE’S).

Even if the Examining Attorney discounts the design included in the applicant's mark and treats it as a mere word mark, courts have found that design elements in one mark can avoid a likelihood of confusion with a mere word mark. *See Omaha Nat'l Bank v. Citibank (S.D.), N.A.*, 633 F. Supp. 231, 234, 229 U.S.P.Q. 51, 52 (D. Neb. 1986) (BANK-IN-A-BILLFOLD and design not likely to be confused with BANK-IN-A-WALLET for identical services).

As in the cases noted above, the bold design elements in the applicant's mark and the Cited Marks distinguish the applicant's mark from the Cited Marks, making consumer confusion unlikely.

In conclusion, when comparing the marks in their entireties, there is no likelihood of confusion between the applicant's mark and the Cited Marks because of the substantial differences in the marks' appearances, sounds, and commercial impressions.

3. The Careful Conditions Under Which Goods Sold Under the Applicant's Mark and the Cited Marks Are Purchased, and the Concern and Sophistication of Buyers to Whom Sales Are Made, Make Confusion Unlikely.

The only specific comment made by the Examining Attorney concerning any alleged overlap among the goods offered by the applicant and the owners of the Cited Marks is that "with respect to Registration No. 5076937 [for the mark EVIL ENERGY Design], the goods include identical intake manifolds." For all of the reasons stated above, the applicant's ENERGY (Design) mark and the mark EVIL ENERGY (Design) create entirely distinct commercial impressions. Due to the differences in the marks and the commercial impression of the marks, there is no likelihood of confusion between applicant's ENERGY (Design) mark and the mark EVIL ENERGY (Design), even if intake manifolds are offered under both.

The Examining Attorney also vaguely claimed the goods at issue are related because third parties have registered marks for use with the same or similar goods as those of both applicant and the registrants of the Cited Marks. As proof, the Examining Attorney provided printouts of third-party registrations, many of which have descriptions of goods that very long,

spanning multiple pages. This is weak evidence to support a sweeping assertion and it does not take into account the crowded field of “ENERGY”-formative marks registered on Class 7 engine and machine parts/components goods.

There is no rule certain goods or services are “per se” related. T.M.E.P. § 1207.01(a)(iv). In fact, courts and the Board consistently have held that a finding that the goods or services are merely related in some manner is an insufficient basis to refuse registration. Further, in a myriad of instances, the Board has held that even identical marks – which is not the case here - used in connection with the same type of goods or services may coexist without creating a likelihood of confusion. *See In re Grand Prix Imps. Inc.*, Serial No. 77/405,025, 2010 WL 2113866 (T.T.A.B. June 2, 2010) (SPYN (Stylized) for automobile parts and accessories not confusingly similar to SPYN (Stylized) for audio equipment); *Kiekhaefer Cmp. v. Willy’s Overland Motors, Inc.*, 236 F.2d 423 (C.C.P.A. 1956) (HURRICANE for outboard motors not confusingly similar to HURRICANE for auto engines).

Furthermore, the goods offered under the applicant’s mark and the Cited Marks – engine and machine parts/components - are all type that would be purchased under careful circumstances. This is because engine and machine parts/components are specific to the engine or machine the consumer is servicing, which means the consumer must carefully consider his or her needs, and then specifically seek out that part/component. Such consumers are sophisticated and will exercise greater care when making purchasing decisions than an average consumer. This factor also weighs in the applicant’s favor, as discriminating purchasers could easily discern between the applicant’s ENERGY (Design) goods and the goods offered under the Cited Marks.

Conclusion:

For the above reasons, the applicant respectfully submits that use of the proposed mark for the applicant’s services is not likely to cause confusion with the Cited Marks. The applicant requests that the Examining Attorney withdraw the refusal to register the mark under Section

2(d).

The applicant thanks the Examining Attorney for assisting with the application. The applicant believes that the application is now in condition to be passed to publication. Therefore, a Notice of Publication is earnestly solicited.

May 25, 2021

Respectfully submitted,



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