

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK EXAMINING DIVISION

APPLICANT : FCA US LLC
TRADEMARK : MAGNETO
SERIAL NO : 90,513,733

David Taylor
Examining Attorney
Law Office 112

RESPONSE TO FIRST OFFICE ACTION

Applicant, FCA US LLC, f/k/a Chrysler Group LLC (“FCA US” or “Applicant”), submits the following Response to the June 13, 2021 First Office Action issued by Examining Attorney David Taylor, Law Office 112, regarding the above-referenced application.

Concurrently with this Response, Applicant has also filed an amendment to the goods description for its mark, MAGNETO, U.S. Serial No. 90,513,733. In light this amendment, and for the additional reasons set forth below, Applicant respectfully submits that Applicant’s mark is not likely to cause confusion with Registration No. 5,677,945 cited by the Examining Attorney and requests that Applicant’s mark be approved for registration.

I. AMENDMENT

The identification of goods is hereby amended to read as follows:

“Motor vehicles, namely, concept passenger automobiles.”

II. ARGUMENT

A. Introduction

The Examining Attorney has refused registration under Section 2(d) of the Lanham Act, 15 U.S.C. §1052(d), because of a purported likelihood of confusion between Applicant’s mark, MAGNETO, in International Class 12 for “motor vehicles, namely, concept passenger

automobiles”¹, and U.S. Registration No. 5,677,945 owned by Magneto Sports, LLC (“Registrant” or “Magneto Sports”) for MAGNETO, in International Class 12 for “vehicles, namely, electronically motorized skateboards.”

In support of the likelihood of confusion refusal, the Examining Attorney has argued that Applicant’s goods description of “motor vehicles, namely, concept motor vehicles” “presumably encompasses all goods of the type” described by Registrant’s more narrow description of “vehicles, namely, electronically motorized skateboards.” The Examining Attorney attached printouts from USPTO database of seven registered marks which contain both motor vehicles and motorized skateboards in the description of goods in Class 12 to support his conclusion that Applicant’s and Registrant’s goods “are of a type that commonly emanate from a single source.”

The Examining Attorney’s conclusions are misplaced. The attached registrations do not support his finding that motor vehicles, particularly concept passenger automobiles, and motorized skateboards are closely related. The mere fact that concept passenger automobiles and motorized skateboards are both classified in International Class 12 and are types of “motorized vehicles” does not mean that the goods are related or that consumers are likely to be confused. To the contrary, the evidence of record supports that concept passenger automobiles and motorized skateboards are not related. This is particularly true here, where full consideration of the relevant *DuPont* factors clearly demonstrates that confusion is not likely.

B. No Likelihood of Confusion

In determining the issue of likelihood of confusion, the Trademark Office must consider the thirteen evidentiary factors listed in *In re E. I. DuPont De Nemours & Co.*, 476 F.2d 1357, 1361 (C.C.P.A. 1973). The similarity of the marks in their entirety as to appearance, sound,

¹ This Response addresses the description of goods in Application Serial No. 90/513,733, as amended.

connotation and commercial impression is just one factor for consideration in a likelihood of confusion analysis. See *In re SL&E Training Stable, Inc.*, 88 U.S.P.Q.2d 1216, 2008 WL 4107225 (T.T.A.B. 2008). The TTAB has held that the likelihood of confusion analysis must be based upon consideration of all relevant *DuPont* factors (i.e., all the known circumstances surrounding the use of the mark), not only on the “sound, sight and meaning” trilogy. *In re E. I. DuPont De Nemours & Co, supra; Specialty Brands, Inc. v. Coffee Bean Distributors, Inc.*, 223 U.S.P.Q. 1281 (Fed. Cir. 1984). An equally important factor is a comparison of the goods at issue and a review of all of the known circumstances surrounding use of the marks in the relevant marketplace, because if the goods are not related in a manner that would cause consumer confusion, there is no likelihood of confusion. Moreover, when products are not in head-on competition in the same market, any likelihood of confusion is substantially reduced. See *Vitarroz Corporation v. Borden, Inc.*, 209 USPQ 969 (2d Cir. 1981).

Here, Applicant’s and Registrant’s marks are both MAGNETO. However, it is well established that, even identical marks for similar goods or services may not create a likelihood of confusion. See, e.g., *In re Mars, Inc.*, 741 F.2d 395 (Fed. Cir. 1984) (finding CANYON for fruit not likely to be confused with CANYON for candy bars); *Kiekhaefer Corp. v. Willys-Overland Motors, Inc.*, 236 F.2d 423 (C.C.P.A. 1956) (holding HURRICANE for outboard motors not likely to be confused with same mark for auto engines); *IDV North Am., Inc. v. S & M Brands, Inc.*, 26 F. Supp. 2d 815 (E.D. Va. 1998) (holding BAILEY’S for liqueurs not likely to be confused with BAILEY’S for cigarettes); *Modular Cinemas of Am., Inc. v. Mini Cinemas Corp.*, 348 F. Supp. 578 (S.D.N.Y. 1972) (holding MINI CINEMA for family movie theaters not confusingly similar to MINI CINEMA for an erotic movie theater); *In re British Bulldog, Ltd.*, 224 U.S.P.Q. 854 (T.T.A.B. 1984) (finding PLAYERS for shoes not confusingly similar to same

mark for men's underwear). *See also Freedom Sas. & Loan Ass'n v. Way*, 757 F.2d 1176, 1183 (11th Cir. 1985) (FREEDOM REALTY not confusingly similar to FREEDOM SAVINGS AND LOAN); see also *In re Bed & Breakfast Registry*, 791 F.2d 157 (Fed. Cir. 1986) (BED & BREAKFAST REGISTRY for making lodging reservations for others not likely to be confused with BED & BREAKFAST INTERNATIONAL for room booking services).

Moreover, when all of the known circumstances surrounding the use of Applicant's and Registrant's respective MAGNETO marks in the relevant marketplace are considered, it is clear that confusion is not likely. Indeed, because Applicant's concept passenger automobiles and Registrant's motorized skateboards are not similar goods, are not in head-on competition in the same market, and are expensive goods sold in different channels of trade to careful and sophisticated purchasers, Applicant's mark and Registrant's mark are not likely to be confused.

1. The Goods Are Dissimilar and Unrelated.

The Examining Attorney found that the goods offered under Applicant's mark "presumably encompass" the goods offered under Registrant's marks. Applicant respectfully disagrees. The Examining Attorney submits no evidence that motorized skateboards would fall under and within concept passenger automobiles². At most, concept passenger automobiles and motorized skateboards fall within the same broad category of motorized vehicles in Class 12. It is well established that "use in the same broad field is not sufficient to demonstrate that a genuine issue exists concerning likelihood of confusion." *Elec. Design & Sales, Inc. v. Elec. Data Sys. Co.*, 954 F.2d 713, 716, 21 U.S.P.Q.2d 1388, 1391 (Fed. Cir. 1992). Further, *per se* rules for categories of supposedly related goods or services are "improper and inconsistent with §

² The Examining Attorney attaches website screenshots from www.electrichybridvehicletechnology.com, which lists articles about concept cars and nothing about motorized skateboards; a Wikipedia page on concept cars, which lists notable concept cars from Original Equipment Manufacturers (OEMs), but nothing about motorized skateboards; and website screenshots from OEM Infiniti on concept cars, none of which are motorized skateboards.

2(d) of the Lanham Act.” *Interstate Brands Corp. v. Celestial Seasonings, Inc.*, 576 F.2d 926, 928, 198 U.S.P.Q. 151, 153 (C.C.P.A. 1978) (no likelihood of confusion between ZINGERS for cakes and RED ZINGER for herb tea); *see also In re British Bulldog, Ltd.*, 224 U.S.P.Q. 854 (no likelihood of confusion between PLAYERS for shoes and PLAYERS for men’s underwear).

In the present case, the Examining Attorney has improperly applied a *per se* rule that use of the same mark on goods in the broad category of “motorized vehicles” will cause confusion. However, merely because both Applicant’s and Registrant’s goods are some type of motorized vehicle does not mean that confusion must result. Applicant’s and Registrant’s goods used in connection with their respective MAGNETO marks inhabit different parts of the motorized vehicle market and do not compete or overlap with each other. Simply put, no consumer seeing Applicant’s use of MAGNETO for concept passenger automobiles will think of Registrant’s motorized skateboards.

Motor vehicles, namely concept passenger automobiles, are not likely to be compared to, or confused with, motorized skateboards. Further, the reality of the motorized vehicle market is that consumers are accustomed to seeing the same mark used for different types of goods that fall under the broad “motorized vehicle” category and they are not confused as to the source of such goods. This is exemplified by the fact that the USPTO has consistently allowed the coexistence of identical and similar marks for concept passenger automobiles and other types of motorized vehicles as shown in the chart below:

Mark	Goods	Owner	Ser./Reg. No.
HURRICANE	Non-racing trucks, namely, concept vehicles sold through authorized JEEP automobile dealerships.	FCA US LLC	3878176
HURRICANE	Land motor vehicles, namely, motorcycles and structural parts therefor.	Honda Motor Co., LTD	3445627
SLINGSHOT	Motor vehicles, namely concept motor vehicles	FCA US LLC	3197223

SLINGSHOT	Recreational vehicles, namely, three-wheeled motor vehicles for on road use	Polaris Industries Inc.	4610154
SPORTSMAN	Concept motor vehicles, namely pickup trucks	FCA US LLC	3908097
SPORTSMAN	All-terrain vehicles	Polaris Industries Inc.	2820439

The USPTO has also consistently allowed the registration and coexistence of numerous different types of non-concept motorized vehicles, such as passenger automobiles, motorcycles and all-terrain vehicles, in International Class 12 when owned by different entities as outlined in the chart below. For example, the marks AERO, LEGEND, MAGNUM, MUSTANG, RAIDER, SILVERADO, THUNDERBIRD, TITAN and VIPER are all owned by different registrants for both passenger automobiles and motorcycles, and the marks BREEZE, OUTLAW, PREDATOR, RANGER, TRAILBLAZER and TRX are all owned by different entities in connection with automobiles and other types of motorized vehicles, such as all-terrain vehicles:

Mark	Goods	Owner	Ser./Reg. No.
AERO	Motorcycles and structural parts therefor	Honda Motor Co., LTD	2932931
DART AERO	Automobiles; badges for automobiles	FCA US LLC	4293403
BREEZE	Automobiles and structural parts therefor	FCA US LLC	3842593
BREEZE	Electric low-speed and recreational vehicles, namely, golf carts, golf cars, and 4-wheeled land vehicles for use in primarily closed communities	Polaris Industries Inc.	2057877

LEGEND	[Automobiles and structural parts thereof]* Structural parts for automobile*	Honda Motor Co., LTD	1574715
LEGEND MOTORSPORTS	Motorcycles	Legends Motorsports, LLC.	3516203
MAGNUM	Recreational vehicles, namely, fifth wheel trailers and truck campers	Magnum Custom Trailer Manufacturing Company	2158428
MAGNUM	Motor vehicles, and structural parts therefor	FCA US LLC	2917994
MAGNUM	Motorcycles and structural parts therefor	Polaris Industries Inc.	4740741
MUSTANG	Automobiles and their structural parts	Ford Motor Co.	1467208
MUSTANG	Motorcycles and parts therefor	Mustang Motorcycle Products, LLC	2162359
MUSTANG	Motorcycles and parts therefor	Mustang Motorcycle Products	4649647
OUTLAW	All-terrain vehicles and structural parts therefore.	Polaris Industries Inc.	3118202
OUTLAW	Recreational vehicles, namely, motor homes	Thor Tech Inc.	3306995
OUTLAW	Snowmobiles, skis, snowmobile ski mounting kits and snowmobile ski running bars	C&A Pro, LLC	3118202
PREDATOR	Industrial use land motor vehicles, namely trucks equipped for vacuum loading, transporting and dumping.	Guzzler Manufacturing, Inc.	1996827
PREDATOR	Monster trucks	Predator Racing	1927280
RAIDER	[Automobiles and] structural parts[therefor]* for automobiles	Mitsubishi Motors North America, Inc.	3104416
RAIDER	Motorcycles	Yamaha Hatsudoki Kabushiki Kaisha	3599086
RANGER	Dual wheel drive heavy duty motorcycle	Rokon International Inc.	3201277
RANGER	All-terrain utility vehicles and structural parts therefor	Polaris Industries Inc.	3413940
RANGER	Motor trucks for highway use	Ford Motor Company	0836232
SILVERADO	Motor vehicles, namely, trucks	General Motors Corporation	1039220
SILVERADO	Motorcycles and structural parts therefor	Yamaha Hatsudoki Kabushiki Kaisha	2373509
THUNDERBIRD	Automobiles	Ford Motor Company	0618942
THUNDERBIRD	Motorcycles and structural parts therefore	Triumph Designs LTD	1939115
TITAN	Motor vehicles, namely, on-road passenger trucks and structural parts therefor	Nissan Motor Co. Ltd.	3007624
TITAN MOTORCYCLE CO. OF AMERICA	Motorcycles and structural parts therefor	2161187 Arizona, Inc.	2047068
TRAIL BLAZER	All-terrain vehicles for off-road use only and structural parts therefor	Polaris Industries Inc.	3255601

TRAILBLAZER	Motor vehicles, namely, sport utility vehicles, engines thereof and structural parts therefor	General Motors Corporation	2257873
TRX	Motor vehicles, namely, trucks, excluding all-terrain vehicles.	FCA US LLC	3641164
TRX	All-terrain vehicles and structural parts therefor.	Honda Motor Co. LTD	3199168
VIPER	Automobiles and structural parts therefor	FCA US LLC	1800654
VIPER MOTORCYCLE COMPANY	Motorcycles; Motorcycles and structural parts therefor	Viper Motorcycle Company	3694594

The USPTO has also consistently allowed the registration and coexistence of numerous different types of vehicles and vehicle-related products in International Class 12 when owned by different entities as outlined in the following chart:

Mark	Goods	Owner	Ser./Reg. No.
BLACKHAWK	Tires excluding semi-truck tires and trailer tires	The Hercules Tire & Rubber Company	3946628
BLACKHAWK & DESIGN	Trailers	E.D. Etnyre & Co.	2951805
BLACKHAWK AUTOMOTIVE	Automobile and truck tools	Snap-On Incorporated	3946681

FUZION	Non-motorized scooters	Nextsport, Inc.	4436506 and 3239644
FUZION	Trailers	Thor Tech, Inc.	
FUZION	Vehicle tires	Bridgestone Brands LLC	2882553
FUSION	Motor vehicles, namely, automobiles	Ford Motor Company	3109881
FUSION	Bicycles	Industries Rad Inc.	1890990
FUSION	Vehicle lights	Fusion Electronics Limited	2892240
GLACIER	Motor vehicles, namely, passenger automobiles, their structural parts, trim and badges	FCA US LLC	4269692
GLACIER	Snow plow blades for all-terrain vehicles	Polaris Industries Inc.	2968437
FREEDOM	Motorcycle engines	Polaris Industries Inc.	2978162
FREEDOM DRIVE II	4x4 Transmission sold as a component part of a sport utility vehicles	FCA US LLC	3345843
MAGANUM	Internal combustion engines for motor vehicles used primarily for transportation and having multiple cylinders with a combined displacement of over two liters.	FCA US LLC	2419240
MAGNUM	Parts, fittings, and accessories for land vehicles	Northwood Games LLC	4124065
MAGNUM	Tires and tubes for automotive vehicles	Magnum Tire Corporation	1226584
MAGNUM	Auto theft alarms for motor vehicles	Mitek Corporation	2560896
OUTLAW	Automobile structural parts for racing purposes, namely, fuel storage cells	Aircraft Rubber Manufacturing, Inc.	3695448
OUTLAW RACING PRODCUTS	After-market parts for motorcycles, namely, handle bars, levers, grips, shift levers, gas caps, brake rotors and hand guards	Posse Products, Inc.	3665394
OUTLAW CONVERTERS	Automotive parts, namely, high performance torque converters and transmissions, all for land vehicles	ATI Performance Products Inc.	3660899
PREDATOR	Motorcycle engines	Sabertooth Motorcycles, LLC	4157858
PREDATOR	Motor vehicle tires	Yokohama Tire Corporation	1505752
PREDATOR	Bicycles	Schwinn Acquisition LLC	1193139
SPORTSMAN PRO	Tires	Max-Trac Tire Co., Inc.	2008576
SPORTSMAN RACING PRODUCTS	High performance automotive engine parts, namely pistons and piston rings	Delaware Capital Formation Inc.	1985999
SPORTSMAN	Automobile structural parts for racing purposes, namely, fuel storage cells	Aircraft Rubber Manufacturing, Inc	3695446
SPORTSMAN	Pickup truck caps and pickup truck bed covers	Custom Fiberglass Manufacturing company	1621086

SPORTSMAN'S PARADISE	Recreational vehicles, namely, towable travel trailers and motor homes for use in hunting, fishing and camping	Margolis Group Inc.	4358363
TRAILBLAZER	Travel trailers, fifth wheel trailers	Thor Tech Inc.	2629101
TRAILBLAZER	Bicycles	Pacific Cycle, LLC	2036101
TRAILHAWK	Motor vehicles, namely, passenger automobiles, their structural parts, trim and badges.	FCA US LLC	4280729
TRAIL HAWK	All-terrain vehicle tires.	Carlisle Intangible Co Corp	1885964

The above-referenced registrations displaying the same or similar marks owned and used by different companies on different types of motorized vehicles in Class 12, including concept motor vehicles, demonstrate that consumers are used to seeing the same or similar marks for various motorized vehicles and are not confused as to source. In other words, while the Examining Attorney's refusal is based upon a purported likelihood of confusion caused by the use of similar marks for motorized vehicles, the market for these goods indicates that they are wholly unrelated. Therefore, it follows that consumers would not confuse the sources of Applicant's MAGNETO concept passenger automobiles and Registrant's MAGNETO motorized skateboard.

The coexistence of all of these marks in use and on the Principal Register further indicates that the *owners* of these marks do not believe that there is a likelihood of confusion between various motor vehicle related goods, including concept passenger automobiles and motorized skateboards, and that the same or similar marks can coexist for various motor vehicle related goods without necessarily causing confusion or mistake in the marketplace. Indeed, if all these identical or similar marks have coexisted on the Principal Register in Class 12, then it is both incongruous and inconsistent to hold that Applicant's MAGNETO mark cannot coexist with the Registrant's MAGNETO mark without confusion as well.

In addition, there are a number of characteristics specific to passenger automobiles, including concept vehicles like Applicant's, and motorized skateboards that further evidence that they are not related or complementary goods. While both passenger automobiles and motorized skateboards are used for transportation purposes, the similarity ends there. In fact, automobiles generally serve as a primary mode of daily transportation, while motorized skateboards are typically used for recreational purposes. Additional differences between automobiles and skateboards include, but are not limited to, the following:

- automobiles, even concept passenger automobiles, and skateboards look entirely different (one has four large tires, is large and enclosed and suitable for transporting several people and cargo, while the other is a small board with four small wheels, is open and typically only capable of carrying one passenger) (*Exhibit 1*);
- operators of automobiles use a steering wheel and gas and brake pedals to control the vehicle, while operators of motorized skateboards use their feet to control the skateboard (*Exhibit 2*);
- automobiles and skateboards have a weight differential of one ton or more (*Exhibit 3*);
- automobiles and skateboards have a cost differential of tens of thousands of dollars (*Exhibits 1, 3 and 4*);
- automobiles and skateboards are typically offered in different trade channels; automobiles through authorized automotive dealerships and skateboards typically through recreational sports stores (*Exhibits 5 and 6*); and
- automobiles are licensed, registered, operated on roads in accordance with specific regulations and laws, and you must have a driver's license to operate one; motorized skateboards are recreational vehicles which cannot be driven on roads and can be operated by anyone (*Exhibit 7*).

In sum, the evidence of record clearly supports that concept automobiles and motorized skateboards are not similar or related goods.

2. Purchasers of Goods Under Applicant's Mark Use Great Care and Take Great Time in Their Purchasing Decisions, Thus Minimizing Any Risk of Confusion.

In determining a likelihood of confusion, courts must examine "[t]he conditions under which, and buyers to whom, sales are made, i.e. 'impulse' vs. careful, sophisticated purchasing."

In re E.I. Du Pont Nemours, 476 F.2d at 1361. Where consumers are likely to exercise attention

and care in selecting the provider of the goods or services sought, there is less likelihood of confusion. *See Checkpoint Sys., Inc. v. Check Point Software Tech., Inc.*, 269 F.3d 270 (3d Cir. 2001) (noting that purchasers who “take care in making purchasing decisions and are not likely to be confused by the parties’ similar marks”); *Homeowners Grp. v. Home Mktg.*, 931 F.2d 1100, 1111 (6th Cir. 1991) (no likelihood of confusion between HMS & Design for marketing and advertising services for real estate brokers and HMS & Design for real estate broker services because “selling one’s property is likely the most significant commercial transaction ever undertaken for most people, [Defendant’s] customers are likely to carefully select the provider of sales services”).

Additionally, where a product is provided at a significant cost, the purchasers of that product are more likely to be sophisticated, discriminating purchasers who are less likely to be confused. *See Checkpoint Sys., Inc.*, 269 F.3d at 276 (finding no likely confusion between plaintiff’s CHECKPOINT electronic surveillance and theft detection systems and defendant’s CHECK POINT for corporate computer firewall security programs); *Arrow Fastener Co. v. Stanley Works*, 59 F.3d 384 (2d Cir. 1995) (finding that purchasers of defendant’s T50 series \$400 pneumatic stapler gun are sophisticated and unlikely to be confused by lower-priced stapler guns sold by plaintiff under the T-50 mark); see also *Astra Pharm. Prods., Inc. v. Beckman Instruments, Inc.*, 718 F.2d 1201 (1st Cir. 1983) (less likelihood of confusion where goods are expensive).

Indeed, when the goods are relatively expensive, it follows that potential purchasers exercise more care in their decision-making process and are less likely to be confused about the source or the affiliation of a product bearing a particular mark than instances where the goods are inexpensive. The Court of Appeals for the Second Circuit propounded this conclusion in the

McGregor-Doniger, Inc., v. Drizzle Inc., supra, stating, “The greater the value of an article, the more careful the typical consumer can be expected to be; the average purchaser of an automobile will no doubt devote more attention to examining different products and determining their manufacturer than will the average purchaser of a ball of twine.” *Id.* at 92 [emphasis added].

As McCarthy notes, “If the goods are expensive, the reasonably prudent buyer does not buy casually, but only after careful consideration. Thus, confusion is less likely than where the goods are cheap and bought casually.... Thus, the reasonably prudent buyer is assumed to take more care in purchasing “expensive” items which he buys infrequently, than in buying everyday, relatively inexpensive items.” *J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition*, Vol. 4 (2006), § 23.96, p. 23-311. “Expensive goods” include motor vehicles and motorized skateboards. *Standard Knitting, Ltd. v. Toyota Jidosha Kabushiki Kaisha*, 77 USPQ2d 1917, 1932 (TTAB 2006)(“it is clear that automobiles are expensive and would only be purchased after careful consideration, thereby reducing the risk of confusion”).

The conditions under which the purchase of Applicant’s goods occurs ensures that confusion is not likely. First, Applicant manufactures and sells its famous branded automobiles through its authorized dealers, who ensure that the consumers are educated about the brand and products they are purchasing. Second, purchasers of automobiles do not undertake the purchase lightly or without adequate consideration and careful evaluation of the type and brand of vehicle they desire to purchase. Indeed, the starting manufacturer's suggested retail price (“MSRP”) for one of Applicant’s vehicles can vary anywhere from \$30,665 to \$84,730.00. See *Exhibit 4*. Given the price involved, for most consumers, a vehicle is either the most expensive or second most expensive item that they purchase in their lives, causing them to take great care in the purchase process.

In addition to the price of the goods, other circumstances that have been found to increase the degree of care and reduce the likelihood of consumer confusion include personal examination and testing of the goods by the consumer³; if the mark is considered a status symbol⁴; the sale of the goods by knowledgeable salespersons⁵; a focused need or specific purpose or plan by the consumer involving the product⁶; the nature of the product being unusual in size and complexity⁷; if the purchaser has a higher duty of care with respect to the product⁸; if the purchaser is an enthusiast⁹; and if the purchaser seeks to satisfy personal tastes.

All of the above circumstances are present with respect to Applicant's automobiles. Automobile purchasers test drive the product, inspecting the models of the various manufacturers and comparing features such as performance, looks, safety, price, and warranty. Purchasers research the various models they are considering in references such as Consumer Reports, Road and Track Magazine, Car and Driver Magazine and other similar publications. In addition, consumers research passenger automobiles on the Internet using such websites as www.kbb.com and www.edmunds.com. Part of the consumer research and inspection is focused on the source of the product and reputation of the manufacturer. In fact, the manufacturer/brand, rather than the model, is often the primary focus of the consumer when shopping for a passenger automobile.

³ *Edison Bros. Stores, Inc. v. Cosmair, Inc.*, 651 F.Supp. 1547, 2 U.S.P.Q.2d 1013, 1024 (S.D.N.Y. 1987)(fragrances).

⁴ *E.S. Original, Inc. v. Stride Rite Corp.*, 656 F.Supp. 484, 2 U.S.P.Q.2d 1934, 1941 (S.D.N.Y. 1987) (athletic shoes).

⁵ *Astra Pharmaceutical Products, Inc. v. Beckman Instruments, Inc.*, 718 F.2d 1201, 220 U.S.P.Q. 786, 790-91 (1st Cir. 1983).

⁶ *Haydon Switch & Instrument v. Rexnord, Inc.*, 4 U.S.P.Q.2d 1510, 1517 (D.Conn. 1987).

⁷ *Astra Pharmaceutical Products, Inc. v. Beckman Instruments, Inc.*, 718 F.2d 1201, 220 U.S.P.Q. 786, 790-91 (1st Cir. 1983).

⁸ *Barre-National, Inc. v. Barr Labs., Inc.*, 773 F.Supp. 735, 221 U.S.P.Q. 1755, 1761 (D.N.J. 1991)(pharmacist ordering pharmaceuticals).

⁹ *Turtle Wax, Inc. v. First Brands Corporation*, 781 F.Supp. 1314, 22 U.S.P.Q.2d 1013, 1024 and n. 18 (N.D. Ill. 1991)(car buffs who purchase car polish exercise a high degree of care in making a selection).

In addition, the brand name or trademark associated with a passenger automobile often has a certain cache or value as a status symbol. Many people take a great deal of pride in their automobiles. Automobiles are also large and extremely complex machines, further increasing the care exercised by purchasers in making choices regarding Applicant's and Registrant's respective products. Passenger automobile sales people are also knowledgeable in their field. When purchasing a passenger automobile, consumers have the opportunity to ask questions as well as personally inspect and take a test-drive. Because consumers are able to question experts prior to making a purchasing decision, there is a greater likelihood that the source of the product will be properly emphasized and identified during the sales process. In fact, automobiles cannot be purchased without the presence of a knowledgeable sales person. A consumer cannot simply select the product off the shelf without assistance and immediately go to a cashier, as they can with a motorized skateboard. Rather, the consumer must interact with a sales person, which further decreases any likelihood of confusion.

Moreover, automobiles are typically purchased for a specific purpose – transportation of passengers and cargo. Thus, the average purchaser is shopping for a passenger automobile with the purpose of acquiring a mode of passenger transportation or towing capacity. The fact that the purchasing decision is dictated by a specific need leads to greater care in making the purchasing decision.

Many passenger automobile purchasers are also enthusiasts. Enthusiasts are likely to read car magazines and to know about the subject of their passion. In fact, purchasing a new passenger automobile is exciting for most purchasers, further increasing the attention paid to the purchasing decision.

Purchasing a passenger automobile is also a personal decision. Purchasers are making decisions, in part, based on personal tastes – some like to draw attention to themselves through their choice of an automobile that is well-known for being expensive, reliable and well-appointed. Others might choose to purchase an automobile because it is functional, affordable, and dependable.

In short, given the nature and cost of Applicant's respective goods and the careful, sophisticated purchase process for those goods, confusion is unlikely.

3. Automobiles and Skateboards Are Sold in Separate and Distinct Channels of Trade.

Automobiles and skateboards typically do not travel in the same channels of trade. Applicant has submitted evidence demonstrating that skateboards and passenger automobiles typically emanate from different sources. See *Exhibits 5 and 6*. Only one of the owners of the seven U.S. trademark registrations for both motor vehicles and motorized skateboards attached to the Office Action by the Examining Attorney is an OEM, China Jialing Industrial Co., and it does not sell motor vehicles in the U.S. The six other registrations identified by the Examining Attorney are owned by companies that do not, in fact, actually sell motor vehicles. All of the specimens filed in support of those registrations are for motorized scooters or skateboards. Thus, consumers typically do not encounter entities selling both automobiles and motorized skateboards and the Examining Attorney has presented no credible evidence to the contrary.

Regardless, passenger automobiles and motorized skateboards are sold through different channels; automobiles through authorized automotive dealerships and skateboards through recreational sporting retail stores. Motorized skateboards are sold in channels of trade and to consumers looking to purchase recreational vehicles, while automobiles are sold in channels of

trade and to consumers looking to purchase vehicles primarily for basic transportation purposes. See *Exhibits 5 and 6*.

Thus, Applicant's and Registrant's respective goods do not travel in the same channels nor will they be encountered by the same consumers such that confusion as to source is likely.

C. The Record Does Not Contain Persuasive Evidence that the Goods Are So Related Such That Confusion of Source Is Likely.

As mentioned above, in refusing registration of Applicant's mark, MAGNETO, it appears that the Examining Attorney has improperly adopted a "per se" rule that the use of the same or similar marks for two different types of motorized vehicles will likely cause confusion. This is not the law. The law requires the likelihood of confusion decision to be firmly based on evidence. "In every case turning on likelihood of confusion, it is the duty of the examiner, the board and this court to find, upon consideration of all the evidence, whether or not confusion appears likely. That determination ends the decisional process." *In re E. I. DuPont De Nemours & Co.*, 476 F.2d 1357, 1362, 177 U.S.P.Q. 563, 568 (C.C.P.A. 1973) (emphasis in original); *In re General Motors Corp.*, 23 U.S.P.Q.2d 1465, 1468 (T.T.A.B. 1992).

Simply put, there can be no *per se* rule in determining likelihood of confusion between two marks. *Interstate Brands Corporation v. Celestial Seasonings, Inc.*, 196 U.S.P.Q. 321, 324 (T.T.A.B. 1977), *aff'd*. 198 U.S.P.Q. 151 (C.C.P.A 1978). The Trademark Manual of Examining Procedure specifically states:

The facts in each case vary and the weight to be given each factor may be different in the light of the varying circumstances; therefore, there can be no rule that certain goods or services are *per se* related, such that there must be likelihood of confusion from the use of similar marks in relation thereto.

TMEP §1207.01(a)(iv).

The party asserting likelihood of confusion (i.e., the Examining Attorney) bears the burden of showing something more than a mere relationship between the goods by providing

evidence that the relationship between the goods is sufficient to support a finding of likelihood of confusion. *TMEP §1207.01(a)(vi)*. Here, the Examining Attorney has submitted very little evidence to demonstrate the relationship between passenger automobiles and motorized skateboards, relying solely on seven registrations for both motor vehicles and motorized skateboards and not evidence of actual use of the same marks on both sets of goods to demonstrate relatedness. He has essentially argued that merely because the description of goods in seven trademark registrations contain both motor vehicles and motorized skateboards, the use of the same mark for a motorized skateboard and any type of passenger automobile vehicle, including a concept vehicle, will necessarily cause a likelihood of confusion. The evidence submitted by Applicant shows that this conclusion is illogical, especially considering the realities of the markets for motorized skateboards and motor vehicles and full consideration of the *DuPont* factors.

II. CONCLUSION

“A showing of mere possibility of confusion is not enough; a **substantial likelihood** that the public will be confused must be shown.” *Omaha Nat’l Bank v. Citibank (S.D.), N.A.*, 633 F. Supp. 231, 234 (D. Neb. 1986) (emphasis added). The facts and the evidence in this record establish that there is no likelihood of confusion, let alone a substantial one. Indeed, Applicant has established that: (1) numerous third-party registrations of the same or similar marks by different companies for different types of motorized vehicles evidence that consumers have become accustomed to encountering the same or similar marks by different companies for Applicant’s and Registrant’s respective goods without confusion; (2) passenger automobiles and motorized skateboards are not similar and the parts therefor are not compatible; (3) passenger

automobiles and motorized skateboards move in different channels of trade; and (4) consumers exercise a high degree of care in selecting passenger automobiles.

In view of the foregoing, Applicant respectfully requests that the refusal to register under Section 2(d) of the Lanham Act be withdrawn and the above-captioned application be approved for publication.

Respectfully submitted,

/s/Kristen Spano

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