

THE MARK SHOULD BE PASSED TO PUBLICATION

I. There is No Likelihood of Confusion with the Cited Registration

Applicant hereby responds to the Office Action of October 11, 2013. In the Office Action, the Examining Attorney refused to register the mark SCAT PACK for “motor vehicles, namely, passenger automobiles, their structural parts, trim and badges,” in International Class 12 under Section 2(d) of the Trademark Act on the grounds of a likelihood of confusion with the following trademarks, owned by Registrant Scat Enterprises, Inc. :

- SCAT (stylized), as shown in Reg. No. 3,981,319 and registered for “vehicle seats; custom vehicle seats; vehicle bucket seats; vehicle racing seats; vehicle sport seats; automotive aftermarket parts, namely, seats; vehicle seat accessories and structural parts therefor, namely, seat covers, seat harnesses, seat padding, and seat armrests; automotive seat kits, namely, front seat, rear seat, consoles, seat covers, map pockets and cassette compartments; land vehicle internal combustion engines; land vehicle components, namely, cross bars, flex plates, headlight housings, interior and exterior decorative trim, moldings and insignias, sedan stringers, shock absorbing springs for motor cars, differentials and gears, cross drive shafts, shift rod couplers, lock nuts, axle boots, bus rear motor mounts, hubcaps, gear shifters, steering wheels, pedal covers, pedals, gear shifters and shifter boots, door and window handles, window locks, brake handles, vent window fasteners, bumpers and bumper brackets, torsion bars, hoods, hood handles, engine lid stay springs, engine covers, horns, floor panels, off-road suspension systems, running boards, rubber window molding, body seals, body jackets, cages, tow bars, pulley and belt guards, air intake screens, steering brakes,

spoilers, seats, seat mounting units, seat controls, seat tracks, seat frames, foam as a component part of a vehicle seat, seat tilt mechanisms, gear shifter consoles, under dash utility trays, speaker shelves, seat covers, knobs for vehicle radios and heaters, radiator fan shrouds; and fuel lines - all of the aforementioned goods only for the performance aftermarket for cars, trucks, and aircrafts, specifically excluding the aftermarket for boats, construction and mining machinery” in International Class 12;

- SCAT (stylized), as shown in Reg. No. 3,944,367 and registered for “vehicle seats; custom vehicle seats; vehicle bucket seats; vehicle racing seats; vehicle sport seats; automotive aftermarket parts, namely, seats; vehicle seat accessories and structural parts therefor, namely, seat covers, seat harnesses, seat padding, and seat armrests; automotive seat kits, namely, front seat, rear seat, consoles, seat covers, map pockets and cassette compartments; land vehicle internal combustion engines; land vehicle components, namely, cross bars, flex plates, headlight housings, interior and exterior decorative trim, moldings and insignias, sedan stringers, shock absorbing springs for motor cars, differentials and gears, cross drive shafts, shift rod couplers, lock nuts, axle boots, bus rear motor mounts, hubcaps, gear shifters, steering wheels, pedal covers, pedals, gear shifters and shifter boots, door and window handles, window locks, brake handles, vent window fasteners, bumpers and bumper brackets, torsion bars, hoods, hood handles, engine lid stay springs, engine covers, horns, floor panels, off-road suspension systems, running boards, rubber window molding, body seals, body jackets, cages, tow bars, pulley and belt guards, air intake screens, steering brakes,

spoilers, seats, seat mounting units, seat controls, seat tracks, seat frames, foam as a component part of a vehicle seat, seat tilt mechanisms, gear shifter consoles, under dash utility trays, speaker shelves, seat covers, knobs for vehicle radios and heaters, radiator fan shrouds; and fuel lines - all of the aforementioned goods only for the performance aftermarket for cars, trucks, and aircrafts, specifically excluding the aftermarket for boats, construction and mining machinery” in International Class 12;

- PROCAR BY SCAT, as shown in Reg. No. 3,965,092 and registered for “vehicle seats; custom vehicle seats; vehicle bucket seats; vehicle racing seats; vehicle sport seats; automotive aftermarket parts, namely, seats; vehicle seat accessories and structural parts therefor, namely, seat covers, seat harnesses, seat padding, and seat armrests; automotive seat kits, namely, front seat, rear seat, consoles, seat covers, map pockets and cassette compartments; land vehicle components, namely, seat mounting units, seat controls, seat tracks, seat frames, foam as a component part of a vehicle seat, seat tilt mechanisms, interior and exterior decorative trim, moldings and insignias, steering wheels, gear shifters, gear shifter boots, gear shifter consoles, under dash utility trays, speaker shelves - all of the aforementioned goods only for the performance aftermarket for cars, trucks, and aircrafts, specifically excluding the aftermarket for boats, construction and mining machinery” in International Class 12;
- SCAT CRANKSHAFTS & Design, as shown in Reg. No. 3,944,367 and registered for “vehicle seats; custom vehicle seats; vehicle bucket seats; vehicle racing seats; vehicle sport seats; automotive aftermarket parts, namely, seats;

vehicle seat accessories and structural parts therefor, namely, seat covers, seat harnesses, seat padding, and seat armrests; automotive seat kits, namely, front seat, rear seat, consoles, seat covers, map pockets and cassette compartments; land vehicle internal combustion engines; land vehicle components, namely, cross bars, flex plates, headlight housings, interior and exterior decorative trim, moldings and insignias, sedan stringers, shock absorbing springs for motor cars, differentials and gears, cross drive shafts, shift rod couplers, lock nuts, axle boots, bus rear motor mounts, hubcaps, gear shifters, steering wheels, pedal covers, pedals, gear shifters and shifter boots, door and window handles, window locks, brake handles, vent window fasteners, bumpers and bumper brackets, torsion bars, hoods, hood handles, engine lid stay springs, engine covers, horns, floor panels, off-road suspension systems, running boards, rubber window molding, body seals, body jackets, cages, tow bars, pulley and belt guards, air intake screens, steering brakes, spoilers, seats, seat mounting units, seat controls, seat tracks, seat frames, foam as a component part of a vehicle seat, seat tilt mechanisms, gear shifter consoles, under dash utility trays, speaker shelves, seat covers, knobs for vehicle radios and heaters, radiator fan shrouds; and fuel lines - all of the aforementioned goods only for the performance aftermarket for cars, trucks, and aircrafts, specifically excluding the aftermarket for boats, construction and mining machinery” in International Class 12; and

- SCAT, as shown in Reg. No. 3,217,216 and registered for “Carburetors; power operated boring tools for use on land vehicles; throttles as parts of carburetors; distributors for vehicles; distributor drive pulleys for land vehicles; alternators for

land vehicles; land vehicle internal combustion engine parts, namely, valve covers, radiator fan shrouds, cylinder covers, radiator fan housings, cooling fans, air cleaners, fuel lines, automotive intake manifolds, carburetor linkages, connecting rods, distributor clamps, coil covers, electric generator covers, oil coolers, oil pumps, oil breathers, breather caps, oil galley plugs, windage trays, oil pumps, filter pumps, oil filter brackets, oil cooler bypass adaptors, heat risers, exhaust gas recirculation units, exhaust extensions, heater hoses, heat riser block-offs, flywheels, starter bushings, gland nut and washer, front end adjusters, sway bars; crank shafts and pulleys for land vehicles; pulley belts; automobile oil pans; electric generator and alternator pulleys for land vehicles; electric generator and alternator trim sets for land vehicles; mufflers for motors and engines; mounts for mufflers for motors and engines; land vehicle parts, namely, exhaust pipes, tail pipes, cross-over pipes; all of the aforementioned goods only for the performance aftermarket for cars, trucks, and aircrafts, specifically excluding the aftermarket for boats, construction and mining machinery” in International Class 7 and “Land vehicle internal combustion engines; land vehicle components, namely, cross bars, cable extenders, flex plates, headlight housings, rear tin, pulley tin, interior and exterior decorative trim, moldings and insignias, dip sticks, sedan stringers, dune buggy dual valve springs, shock absorbing springs for motor cars, differentials and gears, gear sets, cross drive shafts, shift rod couplers, syncro gear rings and hubs, shift forks, lock nuts, axle boots, bus rear motor mounts, wheel adaptors, hubcaps, gear shifters, steering wheels, pedal covers, pedals, gear shifters and shifter boots, door and window handles, window locks, brake

handles, vent window fasteners, bumpers and bumper brackets, torsion bars, hoods, hood handles, engine lid stay springs, engine covers, aprons, horns, floor panels, off-road suspension systems, baffles, running boards, rubber window molding, body seals, body jackets, cages, tow bars, pulley and belt guards, air intake screens, steering brakes, spoilers, seats, seat mounting units, seat controls, seat tracks, seat frames, foam as a component part of a vehicle seat, seat tilt mechanisms, gear shifter consoles, under dash utility trays, speaker shelves, seat covers, knobs for vehicle radios and heaters;*all of the aforementioned goods only for the performance aftermarket for cars, trucks, and aircrafts, specifically excluding the aftermarket for boats, construction and mining machinery” in International Class 12 (collectively, the “Cited Marks”).

The Examining Attorney states that Applicant’s mark and the Cited Marks are similar in appearance, sound, meaning, connotation and commercial impression such that potential purchasers are likely to erroneously believe that Applicant’s goods and Registrant’s goods emanate from a common source. Applicant respectfully disagrees and requests withdrawal of the refusal to register in light of the foregoing remarks and evidence.

The Examining Attorney has cited *In re E.I. DuPont de Nemours & Co.*, 476 F.2d 1357 (CCPA 1973) in support of his position. However, the Examining Attorney has based his conclusion upon only a portion of the test applied in *DuPont*. In view of the significant dissimilarities in appearance, sound, connotation and commercial impression between Applicant’s mark and the Cited Marks, Applicant’s long-term association with the term SCAT PACK and the sophistication of the consumers, it cannot be reasonably concluded that a likelihood of confusion exists. Application of all key elements of the *DuPont* test dictates the

conclusion that granting Applicant's application for federal registration of SCAT PACK is not likely to cause confusion.

Section 1207.01 of the TRADEMARK MANUAL OF EXAMINING PROCEDURE sets forth the factors from *DuPont*, which should be considered in deciding whether a likelihood of confusion exists. A discussion of the application of the relevant factors to the marks in question follows.

A. Applicant's Mark and the Cited Marks Are Distinguishable in Appearance, Sound, Connotation and Commercial Impression

The first inquiry in testing for likelihood of confusion is the similarity or dissimilarity of the marks in their entireties. *See DuPont*, 476 F.2d at 1361. The Examining Attorney has erroneously concluded that Applicant's mark and the Cited Marks are identical because the Examining Attorney has not only failed to properly appreciate the visual and phonetic differences between the marks but also the unique connotation and commercial impression that imbue Applicant's Mark.

The Examining Attorney has stated that Applicant's mark and the Cited Marks are similar simply because they share the word SCAT. It is not enough, however, to simply note that Applicant's mark shares a component with the Cited Marks. *See Murray Corp. of America v. Red Spot Paint & Varnish Co.*, 280 F.2d 158, 161 (C.C.P.A. 1960) ("[A]lthough appellee's mark embodies appellant's entire mark, when considering those marks in their entireties, as we must . . . we are of the opinion that the likelihood of confusion, mistake or deception contemplated by Section 2(d) of the Lanham Act does not exist."); *see also General Mills, Inc. v. Kellogg Co.*, 824 F.2d 622, 627 (8th Cir. 1987) ("The use of identical, even dominant, words in common does not automatically mean that two marks are similar."). Indeed, such a rule would violate the anti-dissection rule. *See Estate of P.D. Beckwith, Inc. v. Commissioner of Patents*, 252 U.S. 538, 545-46 (1920) ("The

commercial impression of a trademark is derived from it as a whole, not from its elements separated and considered in detail.”).

Applicant submits that the Examining Attorney has improperly dissected Applicant’s mark by concentrating just on the word SCAT. The individual words SCAT and PACK, as well as Applicant’s composite mark SCAT PACK, are all arbitrary as applied to Applicant’s goods. Thus, according less weight to PACK is improper because the addition of that word serves to distinguish Applicant’s mark from Registrant’s marks. *See Rite Aid Corp. v. Rite-Way Discount Corp.*, 184 USPQ 351, 353 (CCPA 1978) (RITE WAY & Design not confusingly similar to RITE AID, both for retail drug store services because WAY and AID are dissimilar in appearance, sound and meaning); *Studio Girl-Hollywood, Inc. v. H/P Consultants, Ltd.*, 172 USPQ 364 (CCPA 1972) (STUDIO ONE for men’s hair spray not confusingly similar to STUDIO GIRL for women’s cosmetics and beauty products because marks in their entireties have different commercial impressions); *Jack Poust & Co. v. John Gross & Co.*, 173 USPQ 31, 32 (CCPA 1972) (CHERRY JUBILEE and CHERRY JULEP, both for wine, not confusingly similar because JUBILEE and JULEP have different meaning, significance and sound); and *Safeway Stores, Inc. v. Dunkirk Ice Cream Co.*, 173 USPQ 10, 11 (CCPA 1972) (PARTY PARADE and PARTY PRIDE, both for ice cream products, not confusingly similar).

When compared in their entireties, Applicant’s mark SCAT PACK and the Cited Marks are visually dissimilar because none of the Cited Marks contains the word PACK.

Applicant’s mark and the Cited Marks are also phonetically dissimilar because none of the Cited Marks contains the word PACK.

More importantly, however, “[t]he meaning or connotation of a mark must be determined in relation to the named goods or services. Even marks that are identical in sound and/or

appearance may create sufficiently different commercial impressions when applied to the respective parties' goods or services so that there is no likelihood of confusion. TRADEMARK MANUAL OF EXAMINING PROCEDURE §1207.01(b)(v), citing *In re Sears, Roebuck & Co.*, 2 USPQ.2d 1312, 1314 (TTAB 1987) (holding CROSS-OVER for bras and CROSSOVER for ladies' sportswear not likely to cause confusion, noting that the term "CROSS-OVER" was suggestive of the construction of applicant's bras, whereas "CROSSOVER," as applied to registrant's goods, was "likely to be perceived by purchasers either as an entirely arbitrary designation, or as being suggestive of sportswear which "crosses over" the line between informal and more formal wear . . . or the line between two seasons"); *In re British Bulldog, Ltd.*, 224 USPQ 854, 856 (TTAB 1984) (holding PLAYERS for men's underwear and PLAYERS for shoes not likely to cause confusion, agreeing with applicant's argument that the term "PLAYERS" implies a fit, style, color, and durability suitable for outdoor activities when applied to shoes, but "implies something else, primarily indoors in nature" when applied to men's underwear); *In re Sydel Lingerie Co.*, 197 USPQ 629, 630 (TTAB 1977) (holding BOTTOMS UP for ladies' and children's underwear and BOTTOMS UP for men's clothing not likely to cause confusion, noting that the wording connotes the drinking phrase "Drink Up" when applied to men's clothing, but does not have this connotation when applied to ladies' and children's underwear).

The term SCAT PACK is not merely Applicant's mark for its proposed motor vehicles, structural parts, trim and badges, but also refers uniquely to Applicant Chrysler. Muscle car and hot rod culture exploded in the 1960s. Various car manufacturers attempted to capitalize on that interest by offering high-performance, redesigned versions of their vehicles. Applicant Chrysler took that effort to a new level when it launched its legendary SCAT PACK in 1968—a play on

the popular Hollywood "Rat Pack" from the mid-60s. Chrysler re-envisioned its DODGE CHARGER R/T, CORONET R/T, and DART GTS vehicles with new body looks and performance upgrades designed to appeal to the muscle car aficionado. Marketplace interest was immediate and enthusiastic, making the DODGE brand SCAT PACK performance vehicles hugely successful from 1968 to 1971. The vehicles, as well as accessories, were heavily marketed as SCAT PACK and press coverage was extensive. Applicant Chrysler, as well as collectors, fans, bloggers and history buffs have consistently ensured that SCAT PACK has remained in the public consciousness and uniquely linked to Applicant Chrysler through the past 45 years.

Registrant and its Cited Marks, when used in connection with Registrant's goods lacks this unique connotation and commercial impression, and thus the respective connotations and commercial impressions are quite different.

B. The Relevant Consumers Will Not be Confused When Purchasing the Offered Goods and Services

The *DuPont* test also considers the conditions under which and the buyers to whom sales are made, *i.e.* "impulse" buys vs. careful, sophisticated purchasing. *See DuPont*, 476 F.2d at 1361. The threshold for confusion is much higher for careful, sophisticated, discriminating purchasers than for impulse purchasers, and there is always less likelihood of confusion if the purchase concerns an expensive product or is made after careful examination of the product. *See In re Digirad Corp.*, 45 USPQ2d 1841, 1843 (TTAB 1998).

Registrant's goods are products that require a significant investment of money. Applicant performed a recent Internet search for price information in order to ascertain Registrant's product prices, and to Applicant's best knowledge, Registrant's goods cost

anywhere from approximately \$200 to over \$1,900. Registrant's products are not "impulse" buys and this fact consequently decreases the likelihood of confusion.

The consumers of Registrant's goods comprise a narrow niche market, namely, car mechanics and enthusiasts and also qualify as sophisticated, careful purchasers. Such consumers are likely "do their homework" before investing hundreds or thousands of dollars into Registrant's goods, which in turn are incorporated into cars that may cost tens of thousands of dollars. Similarly, Applicant has applied to register its SCAT PACK mark for, *inter alia*, motor vehicles, which are expensive durable goods that cost tens of thousands of dollars.

These purchasing conditions weigh in favor of a finding that there is no likelihood of confusion between Applicant's mark and the Cited Marks. In summary, given the differences in appearance, sound, connotation and commercial impression between Applicant's mark and the Cited Marks, Applicant's long-term association with the term SCAT PACK, the sophistication of the consumers as well as the purchasing conditions, it cannot be reasonably concluded that a likelihood of confusion exists.

I. CONCLUSION

Having fully responded to the Office Action, Applicant respectfully requests that the Examining Attorney's refusal to register under Section 2(d) be withdrawn, and that the application be approved for publication.

Respectfully Submitted By:

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