

Note To The File

Serial Number: 90049472
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Created by: Bayliss, Hunter



Contacted Applicant/Atty

- via E-Mail

Spoke with Jordan Lavine, applicant's attorney, by email on October 27, 2020. The email communication is included below.

From: LaVine, Jordan <Jordan.LaVine@flastergreenberg.com>
Sent: Tuesday, October 27, 2020 6:19 PM
To: Bayliss, Hunter <Hunter.Bayliss@USPTO.GOV>; tmdock <tmdock@flastergreenberg.com>
Subject: RE: US TRADEMARK APPLICATION SERIAL NOS. 90049472 ("NEAT") and 90049140 ("NEAT") - Issues with Applications that may be resolved by examiner's amendment.

Hunter: we accept the proposed amendments to clarify the identification of services and to obviate the partial 2(d) refusal.

Please issue an appropriate EA.

Thank you.

/jordan lavine/

Jordan A. LaVine

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From: Bayliss, Hunter [<mailto:Hunter.Bayliss@USPTO.GOV>]

Sent: Tuesday, October 27, 2020 5:21 PM

To: LaVine, Jordan < Jordan.LaVine@flastergreenberg.com >; tmdock < tmdock@flastergreenberg.com >

Subject: US TRADEMARK APPLICATION SERIAL NOS. 90049472 ("NEAT") and 90049140 ("NEAT") - Issues with Applications that may be resolved by examiner's amendment.

Dear Mr. Lavine,

My name is Hunter Bayliss and I am the trademark examining attorney assigned to review your applications Serial Nos. 90049472 and 90049140. There are issues with the applications that I hope can be resolved by examiner's amendment. Specifically, applicant's identification is partly indefinite and requires clarification, and there is a partial likelihood of confusion between applicant's mark and U.S. Registration No. 5528380 ("CCI NEAT").

Partial Likelihood of Confusion

The issue at hand is that applicant's services include a number of technical support, computer synchronization, and general data management services that are closely related to registrant's software as a service. Specifically, software development tool software is commonly offered alongside other general data synchronization, software troubleshooting, and data hosting services.

When viewed in connection with the marks (which are virtually identical but for the addition of registrant's house mark), consumers would be confused regarding those services. The addition or deletion of a house mark to an otherwise confusingly similar mark does not obviate the likelihood of confusion. *See In re Fiesta Palms LLC*, 85 USPQ2d 1360, 1366-67 (TTAB 2007) (finding CLUB PALMS MVP and MVP confusingly similar); *In re Christian Dior, S.A.*, 225 USPQ 533, 534 (TTAB 1985) (finding LE CACHET DE DIOR and CACHET confusingly similar); TMEP §1207.01(b)(iii). It is likely, instead, that services sold under such marks would be attributed to the same source. *See In re Chica, Inc.*, 84 USPQ2d 1845, 1848-49 (TTAB 2007).

Because the likelihood of confusion does not apply to *all* of applicant's identification, applicant can resolve this issue by limiting its identification to eliminate the more general computer and data services.

Identification Overbroad and Indefinite

Most of applicant's identification is acceptable, however certain identifications are overbroad (such as "*data hosting services*") and others are indefinite (such as "*Providing temporary use of online non-downloadable software for accounting, bookkeeping, online financial and business transaction processing management, financial and business transaction management, tax preparation and tax planning, business process management, and financial planning*"). The main issue is that the identification lists the fields of the software and not the particular use.

Given that certain goods in the application create a likelihood of confusion with Registration No. 5528380, the following suggested amended language would resolve both the identification and Section 2(d) issues (amended language in bold):

Class 42: *Providing temporary use of online non-downloadable software for **use in** accounting, bookkeeping, **managing** online financial and business transaction processing, **managing** financial and business transaction s , **preparing and planning** tax es , and **managing** business process es ;*

*providing temporary use of online non-downloadable software for creating, customizing, and managing invoices, recording payments, and issuing receipts; providing temporary use of online non-downloadable software for use in organizing, servicing and tracking sales, collections and receivables data; providing temporary use of online non-downloadable software for tracking income, expenses, sales, and profitability by business location, department, type of business, or other user set field; providing temporary use of online non-downloadable software for customer relationship management; providing temporary use of online non-downloadable software to calculate and charge sales tax and to create reports to pay sales tax to appropriate tax agencies; providing temporary use of online non-downloadable software for credit card invoicing and credit card payment processing; providing temporary use of online non-downloadable software for managing online bank accounts; providing temporary use of online non-downloadable software for controlling access to financial information via electronic permission settings; providing temporary use of online non-downloadable software to automate creation of invoices; providing temporary use of online non-downloadable software to create, customize, print, export, and e-mail financial reports, business reports, balance sheets, profit and loss statements, cash flow statements, and taxable sales reports; providing temporary use of online non-downloadable software to track sales, expenses, and payments; providing temporary use of online non-downloadable software to analyze the financial status of businesses and industries; providing temporary use of online non-downloadable software to import contacts and financial data from other electronic services and software; providing temporary use of online non-downloadable software for use in transaction processing, accounting, receipt printing, **and** customer relationship management*

This amended language clarifies the use of the software, and removes those identifications that trigger the likelihood of confusion partial refusal.

Please let me know if you agree to these proposed amendments. With your approval, I can issue an examiner's amendment amending the identifications and putting the applications in position to move forward.

If you have any questions or concerns, please reach out to me. I can be reached by phone at (571) 272-6526 or by email.

If I do not hear from you by the end of the day on Thursday, Oct. 29, 2020, I shall assume you do not wish to discuss these issues and I shall take appropriate action.

Thank you kindly for your time. I look forward to hearing from you and hope you have a wonderful day!

Sincerely,

Hunter Bayliss

Hunter Amadeus Bayliss

Examining Attorney

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