

### **Likelihood of Confusion**

In the Second Official Action dated October 17, 2017, the Examining Attorney maintained the refusal of the subject application 87329235 under Section 2(d) based on U.S. Registration 4816102 and 4507610. We incorporate by reference all previous arguments made in the first response dated September 25, 2017. The refusal should be withdrawn because there is no likelihood of confusion based on (1) the overall differences in the parties' respective services as amended and (2) the overall differences in the parties' marks.

### **There is No Likelihood of Confusion Because the Services Are Not Similar**

It is well settled that when considering likelihood of confusion among marks, the goods or services are to be compared on the basis of the descriptions contained in the registration or application. *See, e.g., Commerce Drug Co., Inc. v. Kirkman Laboratories, Inc.*, 174 U.S.P.Q. 265, 267 (CCPA 1972).

The present application covers:

Class 35: Providing business consultation and administrative support services in the field of tuition assistance programs

Class 36: Providing tuition assistance services in the nature of educational scholarships to those with financial need; providing financial information relating to tuition and tuition assistance.

The refusal is focused on a perceived overlap in services related to employment and recruitment. In the Official Action, the Examining Attorney states that "Applicant's services are related to those of the registrants because they all feature career information, guidance, and consulting that are often provided by similar types of entities and organizations." Furthermore, the Examining Attorney takes the position that the Applicant's services for "employment,

recruitment, and resources to assist with employment, jobs, and skills are commonly provided by entities that also provide personal branding services and employment opportunity information.”

However, as amended, the current application does not include class 41 and does not claim any services involving employment, recruitment, career information, career guidance, job skills or consulting in these fields. Instead, the application is limited to financial services. There is no overlap in services with the cited registrations as a result.

#### **Cited Registration 4816102**

The cited registration 4816102 covers a narrow range of services, namely “providing information to students and young professionals about career opportunities within the insurance industry” in class 35.

These services would be provided to a specific audience that is focused on careers in the insurance industry. Such consumers have already expressed an interest in and sought out information about careers specific to the insurance industry. They are not looking to begin education and therefore are not looking for tuition and financial assistance for that education. Rather, they have likely already completed their education. At the very least they are now at the next stage of starting a career. They may even already be in the insurance industry and looking for advancement in the insurance industry. Either way, these consumers already have a very specific plan and profession in mind.

In contrast, the customers of Applicant’s services are at an entirely different point. They are beginning the process of further education. They will encounter the Applicant’s services when seeking information and assistance required to meet tuition obligations. Applicant’s

services are not career advice and information. They are a financial aid service. They are not offering placement, recruitment or career advising services

The services covered in the cited registration 4816102 and those claimed in the present application are not offered to the same consumers. A person seeking assistance with tuition payment or financial aid would seek a financial institution or an organization that is specializing in scholarships. They would not encounter a career advising service that is focused on the insurance industry, which is likely to be an insurance trade organization or an insurance company itself. As a result, the parties' respective consumers are not likely to encounter the services of the other, and mistakenly believe that they emanate from the same source.

#### **Cited registration 4507610**

The services claimed by the cited registration 4507610 include "Identity development and personal branding and reputation management services" as well as "Career planning and marketing services for high school and college students".

The services are offered to those looking to create a particular persona and reputation in their online and social media profiles. It is common for those beginning the college application process or the employment search to review and "scrape" their online persona and social media of any content that may be viewed in an unfavorable light. This is done largely to manage one's prospects for admissions and employment by presenting oneself as an ideal applicant.

In comparison, Applicant's services are financial services. They do not involve reputation management, they do not involve social media, branding, or career advising. Instead, they are strictly for the purposes of obtaining the necessary assistance with tuition in order to further one's education.

Following the revision to Applicant's services, it is clear that there is no similarity or likelihood of confusion between the services covered in the cited registration 4507610 and those claimed in the present application. One who is looking for assistance with controlling an online persona would not expect the same party to offer financial aid or even information on tuition assistance. Even where the respective services are needed by the same consumer beginning a college or higher education process, they serve such disparate purposes that one would not mistakenly believe that they emanate from the same source. Each is a niche field in which a provider is expected to specialize.

With respect to both of the cited registrations, even where marks are similar or contain similar elements, confusion is not likely to occur if the services in question are not related or marketed in such a way that they would be encountered by the same persons in situations that would create an incorrect assumption that they originate from the same source. *See, e.g., Shen Manufacturing Co. v. Ritz Hotel Ltd.*, 73 USPQ2d 1350 (Fed. Cir. 2004) (cooking classes and kitchen textiles not related); *Local Trademarks, Inc. v. Handy Boys Inc.*, 16 USPQ2d 1156 (TTAB 1990) (LITTLE PLUMBER for liquid drain opener held not confusingly similar to LITTLE PLUMBER and design for advertising services, namely the formulation and preparation of advertising copy and literature in the plumbing field); *Quartz Radiation Corp. v. Comm/Scope Co.*, 1 USPQ2d 1668 (TTAB 1986) (QR for coaxial cable held not confusingly similar to QR for various products (*e.g.*, lamps, tubes) related to the photocopying field). *See generally* TMEP § 1207.01(a)(i).

The true standard for relatedness of marks is whether the circumstances surrounding their marketing are such that they are likely to be seen by the same consumer, under circumstances which would lead one to believe that they emanate from the same source. Even if trademarks are

identical, if the respective services are not sufficiently related, or the relevant consumers would not believe that the services emanate from the same source; confusion is not likely to occur.

*Nautilus Group Inc. v. ICON Health and Fitness Inc.*, 71USPQ2d 1173 (Fed Cir. 2004); *In re Unilever Limited*, 222 USPQ 981 (TTAB 1984); *In re Fesco, Inc.*, 219 USPQ 437 (TTAB 1993).

The circumstances do not exist in the present matter. It is now clear that the parties' respective services are not related. Neither of the cited registrations include any financial services. The Applicant's services do not include career advice or personal branding advice. The Applicant's services are not likely to be encountered by the same persons as those offered by the cited registrants, or in situations that would create an incorrect assumption that they originate from the same source as the services offered by registrants.

#### **There is No Likelihood of Confusion Because the Marks Are Not Similar**

A comparison of marks for a likelihood of confusion also requires consideration of the visual and phonetic impact, along with any meaning or commercial impression.

When determining the similarity between two marks, the decision must be based on the entire marks, not just part of the marks. *In re Nat'l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985); *see also Franklin Mint Corp. v. Master Mfg. Co.*, 667 F.2d 1005, 212 USPQ 233, 234 (CCPA 1981) ("It is axiomatic that a mark should not be dissected and considered piecemeal; rather, it must be considered as a whole in determining likelihood of confusion.").

In the present case, the examining attorney has placed undue emphasis on the MYPATH element. A full comparison requires a consideration of all elements in MYPATH101 and MYPATH INSURANCE. IT'S LIMITLESS. & design, not just the shared element MYPATH.

When viewed in the entirety, it is clear that there is no likelihood of confusion because the marks are not only different visually and phonetically, but also convey a distinct meaning.

### **Cited Registration 4816102**

The cited registration 4816102 is for the mark MYPATH INSURANCE. IT'S LIMITLESS., with a prominent design on the left comprised of four curved arrows that has the appearance of a rounded "X" or flower. This additional literal element along with the design gives the Registrant's mark a different visual and phonetic impact. It is a four word slogan. But, more importantly, it gives the cited mark a different meaning. It clearly defines the industry – insurance. The phrase "it's limitless" conveys the idea of multiple possibilities in insurance.

In contrast, Applicant's Mark MYPATH does not include a design element, nor does it include the wording "INSURANCE. IT'S LIMITLESS". Applicant's mark is only the term "MYPATH". It conveys the idea of determining, and then following, one's own singular path and pursuing one's own goals. There is an individualism present in MYPATH on its own that is at the forefront of the meaning. This is very different from the Registrants' mark, which leaves a consumer largely with the idea of the multiple, limitless possibilities in the insurance industry.

These two marks are visually and phonetically different, and have a significant difference in commercial impression. There is no likelihood of confusion.

### **Cited registration 4507610**

The cited registration 4507610 is for the mark MYPATH101. It, too, has a different visual and phonetic impact compared to the Applicant's mark, due to the latter element "101". MYPATH101 is two words and five syllables. More importantly, the number "101" also gives a very different commercial impression. "101" is the number commonly used as a shorthand for

an introductory, or a basic level. It is perhaps most commonly used in the educational context, but can be used in any context to imply that something is basic knowledge. Thus, in the context of the Registrant's branding and advising services, it convey the idea that Applicant's services are intended to be introductory in nature, and a beginning course.

This meaning is not present in the Applicant's mark. MYPATH on its own conveys the idea of determining, and then following, one's own singular path and pursuing one's own goals

The two marks are visually and phonetically different and have a significant differences in commercial impression. There is no likelihood of confusion.

**The Co-Existence of the Applicant's Older Registration No. 3702498 With The Cited Registrations Is Further Evidence That The Marks Are Not Similar.**

The 13<sup>th</sup> *du Pont* factor asks the question of whether there are any other facts that are relevant to the issue of likelihood of confusion. This factor permits the consideration of a likelihood of confusion to be flexible, rather than a set of rigid rules. Here, the relevant information is the co-existence of the cited registrations with the Applicant's older registration, as evidence that there is no likelihood of confusion.

Compared to the cited registrations, Applicant holds the oldest rights for MYPATH. The co-existence of the parties' various rights is firm evidence that there is no likelihood of confusion here, either. In the previous response, Applicant pointed to the precedent set in *In re Strategic Partners, Inc.* 102 USPQ2d 1397 (TTAB 2012). Regardless of the length of time of co-existence, and whether the precedent of *In re Strategic Partners* is applicable, Applicant's oldest registration is pertinent because of its similarity to the cited marks. It demonstrates that there is room for the newest MYPATH. If the cited registrations can co-exist with the Applicant's oldest

registration, and all for services involving employment, jobs, and job skills, then there is certainly room for Applicant's current MYPATH on unrelated tuition assistance and financial aid services.

When each of the cited registrations were examined, a decision was made that it did not conflict with the Applicant's older registration. First, "MYPATH101" on personal branding, career planning and marketing services for high school and college students in class 35 was allowed despite Applicant's earlier MYPATH also on services involving career planning, employment, and job related information.

A second time, the decision was made that "MYPATH INSURANCE. IT'S LIMITLESS." for "providing information to students and young professionals about career opportunities within the insurance industry" did not have a likelihood of confusion with the Applicant's MYPATH for services involving information about employment, careers and job related information. Furthermore, in this matter, the Applicant's older registration 3702498 was cited as an obstacle. The USPTO accepted the arguments asserting that there is no likelihood of confusion based on the differences in the marks. In this case, it was not even a situation where a citation was not made. The application was refused, arguments in response were considered, and then the refusal was affirmatively withdrawn.

Thus, the existence of all three earlier registrations is evidence that in totality, there is no likelihood of confusion amongst the marks MYPATH, MYPATH101 and MYPATH INSURANCE. IT'S LIMITLESS. The Applicant acknowledges that the Examining Attorney is not bound by the decisions of other Examining Attorneys in earlier cases. But this is not a case where the USPTO would be bound by a single poor examination decision. The USPTO has demonstrated not once, but repeatedly, that multiple rights for MYPATH can co-exist on similar



or conflicting services. And, as a result, there is no likelihood of confusion between MYPATH, or MYPATH101 or MYPATH INSURANCE. IT'S LIMITLESS. on different services for tuition assistance. To find otherwise in the present case is wholly inconsistent with the USPTO's own established pattern and position to date.

### **Conclusion**

In light of the different services and the differences in the marks, there is no likelihood of confusion. Applicant requests that the refusal based on a likelihood of confusion be withdrawn.