

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

MARK:	WIREX
SERIAL NO:	79244709
APPLICANT:	Wirex Limited
FILING DATE:	May 4, 2018
INTERNATIONAL CLASSES:	9, 36, and 42

1. Section 2(d) Refusal - U.S. Trademark Registration Nos. 4,590,633 and 5,503,284

The Examining Attorney (the “**Examiner**”) cites registrations U.S. Trademark Registration No. 4590633 (“**Cited Mark 1**”) for the related goods and services in Class 9 and Class 42 and U.S. Trademark Registration No. 5503284 (“**Cited Mark 2**” and together with Cited Mark 1, the “**Registered Marks**”) for the related goods and services in Class 9 and Class 42. The Examiner has refused registration of Applicant’s Mark for the goods and services to be offered in the United States under Class 9 and Class 42, but not under Class 36, due to likelihood of confusion with the Registered Marks.

The U.S. Patent and Trademark Office recognizes that registration should not be refused in view of all similar marks, but only on the basis of those similar marks whose effect in the marketplace would be to create a likelihood of confusion or mistake on the part of the purchasing public. TMEP § 1207.01.

The controlling standard of determining likelihood of confusion is whether the relevant purchasing public would mistakenly assume that Applicant’s goods or services originate with, are sponsored by, or are in some way associated with the services offered in connection with the Registered Marks. *FBI v. Societe: “M. Bril & Co.”*, 172 USPQ 310 (TTAB 1971). Likelihood of confusion is determined by applying the following factors, among others: 1) the similarity or dissimilarity of the marks, 2) the relatedness of the goods or services offered in connection with the marks, 3) the similarity or dissimilarity of trade channels, and 4) the buyers to whom sales are made and the conditions under which sales are made (i.e. impulse vs. careful, sophisticated purchasing) (the “**du Pont Factors**”). *In re E.I. du Pont de Nemours & Co.*, 177 USPQ 563, 567 (CCPA 1973). Even though factors one and two are the “key considerations,” likelihood of confusion may not exist for similar marks with related goods and services “because these factors [factors one and two] are outweighed by other factors.” TMEP § 1207.01. Here, even though the Applicant’s Mark is similar to Cited Mark 1 and Cited Mark 2, Applicant respectfully disagrees that its Mark is likely to be confused with the Registered Marks because 1) the goods and services offered under the Applicant’s Mark differ in nature and purpose from the goods and services offered under the Registered Marks, 2) the channels of trade are substantially different, and 3) the consumers of Applicant’s goods and services are sophisticated enough to distinguish the goods and services covered by the Registered Marks. Therefore, when considering all of the relevant du Pont Factors, there is not a likelihood of confusion between Applicant’s Mark and the Registered Marks.

In order to clarify the goods and services offered under Applicant's Mark, Applicant proposes the following changes in bold to its descriptions under Class 9, Class 36, and Class 42:

Class 9:

Computer software **for financial and cryptocurrency transactions**; computer software for productivity programmes or end-user programmes, **for financial and cryptocurrency transactions**; computer software, **and computer application software for financial and cryptocurrency transactions available on mobile phones, computers and handheld computers** for the provision of banking, financial and equity trading services; computer software **and computer application software for financial and cryptocurrency transactions available on mobile phones, computers and handheld computers** for electronic financial exchanges; computer software **and computer application software for financial and cryptocurrency transactions available on mobile phones, computers and handheld computers** automated methods of moving money, financial orders and financial instruments; computer software **and computer application software for financial and cryptocurrency transactions available on mobile phones, computers and handheld computers** to facilitate electronic contactless payments; computer software **and computer application software for financial and cryptocurrency transactions available on mobile phones, computers and handheld computers** for processing payments via a mobile device at a point of sale; computer software **and computer application software for financial and cryptocurrency transactions available on mobile phones, computers and handheld computers** for automated banking; computer software **and computer application software for financial and cryptocurrency transactions available on mobile phones, computers and handheld computers** to handle electronic payments via prepaid cards, wireless wallets, mobile wallets, electronic wallets, wireless credit, debit and prepared cards; computer software to run terminals running near field communication (NFC) technology; computer software **and computer application software for financial and cryptocurrency transactions available on mobile phones and handheld computers** for bank account management services, monetary transfer services, payment services, financial analysis, financial reports and financial management services; computer software **and computer application software for financial and cryptocurrency transactions available on mobile phones and handheld computers** for foreign currency exchange services, financial orders or exchanges; computer software for use in displaying and managing financial product portfolios and orders; electronic downloadable publications, namely, newsletters, magazines, periodicals, pamphlets and leaflets in the field of finance, banking and cryptocurrency; magnetic and machine readable cards being encoded or capable of being encoded, namely, magnetically encoded blank bank cards for issuance by financial institutions; cards for obtaining and storing information, namely, magnetically encoded identity cards; authorisation cards, namely, magnetically encoded identity, authentication cards; magnetically encoded credit cards; magnetically encoded debit cards; magnetically encoded cheque cards; magnetically encoded smart cards containing programming for financial transactions; magnetically encoded swipe cards for financial transactions; magnetically encoded loyalty cards, namely, prepaid debit cards; magnetically encoded payment or pre-payment cards namely, credit cards and prepaid debit cards; computer hardware; computer hardware for the provision of banking, financial and equity trading services; computer hardware for electronic financial exchanges; computer hardware to facilitate moving money, financial orders and financial instruments; computer hardware to facilitate electronic contactless payments; computer hardware being a mobile device to

handle electronic payments via prepaid cards, wireless wallets, mobile wallets, electronic wallets, wireless credit, debit and prepared cards; computer hardware to run terminals running near field communication (NFC) technology.

Class 36:

Financial services, **namely, financial brokerage services for cryptocurrency trading;** banking services; payment services, **namely, charge card, crypto-card and credit card payment processing services, bill payment services provided via mobile applications;** provision of electronic contactless payment services, **namely, processing of contactless credit, crypto and debit card payments;** **financial transaction services, namely,** providing secure financial **commercial** transactions and payment options using a mobile device at a point of sale; monetary transfer services; automated banking services; processing electronic payments made through prepaid cards; electronic processing and transmission of credit card transactions, wireless wallets, mobile wallets, electronic wallets, wireless credit, debit and prepared card transactions; processing financial transactions via terminal services using near field communication (NFC) technology; private banking services; home, internet and mobile banking services; securities trading, transactions and exchange services; issuing of credit cards, debit cards, charge cards, payment cards, transaction cards, financial and loan cards; issuing of magnetic data carriers and authentication cards for financial transactions; issuing of authentication cards **for financial purposes;** financial services relating to credit cards, debit cards, charge card, payment cards, pre-payment cards, transaction and loyalty cards, **namely, transaction processing services;** financial underwriting services, **namely, securities underwriting;** private equity **fund** financial investment services; **financial services, namely, the** trading of equities, derivatives, futures, stocks, shares, swaps and options; foreign exchange **transactions** and currency exchange services; foreign exchange brokerage, **namely, foreign exchange transaction services;** provision of stock market information; safe deposit **box** services; bankers' clearing services, **namely, automated clearing house (ACH) transaction processing services;** escrow services, **namely, maintaining escrow accounts for customers;** insurance services **namely, insurance brokerage, insurance consultation and insurance administration services;** financing of loans; **namely, guaranteeing** loans against security; investment management services; capital investment services; trustee services; **financial** services of brokers and agents **for bonds and other securities, namely, broker/dealer services on securities exchanges and over-the-counter markets;** financial analysis, research and reporting services; administration of financial affairs, **namely, financial administration of transactions involving funds drawn from securities, stocks, funds, equities, bonds, cash or other types of financial investments in retirement plans using a credit or debit card over a global data network;** financial advice, consultancy and information services relating to all of the aforesaid services.

Class 42:

Scientific, technological, research and design services, **namely, research and design in the field of computer system architecture for use in the field of banking, finance and cryptocurrency;** computer programming services; design and development of computer software and hardware; design and development of computer software and hardware for productivity programmes or end-user programmes, including application software; design, development and maintenance of proprietary computer software in the field of financial services; rental of computer hardware and software apparatus and equipment; website hosting services; hosting **of web sites** services for others; providing temporary use of non-downloadable software **and computer application software for mobile**

phones and handheld computers for banking and processing financial and cryptocurrency transactions; providing temporary use of non-downloadable computer software for making financial and cryptocurrency payments} and online facilities, namely, hosting online web facilities for others for sharing online content to enable users to access and download computer software; providing online resources for software developers, namely, providing temporary use of online non-downloadable software development tools; maintenance, repair and updating of computer software, computer operating system software, computer utility software including application software; providing information concerning computer software via the Internet and other computer and electronic communication networks, namely, providing information in the field of software development; technical troubleshooting support for computer software; advice, consultancy and information services relating to all of the aforesaid services, namely, computer software consulting and advice, IT consulting and advice, providing information on computer technology and programming via a web site.

a) The Nature of the Goods and Services Covered by Applicant’s Mark are Distinct From the Nature of the Goods and Services Covered by the Registered Marks.

In considering whether a likelihood of confusion exists between Applicant’s Mark and the Registered Marks, it is necessary to consider the differences in the channels of trade, classes of consumers and what each party sells as well as the sophistication of the consumers. *See Elec. Design & Sales, Inc. v. Elec. Data Sys. Corp.*, 21 USPQ2d 1388, 1389 (Fed. Cir. 1992). Confusion is not likely if “the goods or 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 lead persons to incorrectly assume that the goods and services originate from the same source, even if the marks are identical. TMEP § 1207.01(a)(i).

The Examiner claims that the computer software offered by Applicant under Class 9 encompasses the same field as the software “for prevention and detection of computer and intrusion and for network analysis” offered under Cited Mark 2 and that the “computer hardware” offered under Applicant’s Mark encompasses all of the specific computer hardware offered under the Registered Marks. Further, the Examiner claims that the services offered by Applicant in Class 42, relating to “scientific, technological, research and design services” and “computer programming,” encompass the various services offered under Cited Mark 1. However, the essential inquiry is whether there is sufficient overlap between these goods and services to cause a likelihood of confusion as to the source of such goods and services.

Here, as set forth in the revisions to the descriptions under Class 9 and Class 42, Applicant offers computer software and hardware specifically in the financial and cryptocurrency field while the software offered under Class 42 for Cited Mark 2 specifically relates to cybersecurity. Even though the term “computer software” may be broad enough to cause some overlap in the goods and services offered, it is clear that the software offered under Cited Mark 2 and Applicant’s Mark are of a different nature and purpose. In fact, the software offered by Applicant is used specifically for financial transactions relating to both fiat currency and cryptocurrency, and the software offered under Cited Mark 2 is used to “automate securities investigations” and to “automate and accelerate [] incident response.” *See Exhibit A*. Further, the goods offered under Class 9 in connection with Cited Mark 1 are not related to finance and cryptocurrency, but instead, relate to telecommunications, specifically allowing conversion of

“analog equipment from traditional phone lines to cellular 3G/4G networks.” See Exhibit B. The Trademark Trial and Appeal Board previously held that two nearly identical QR marks would not cause confusion to consumers because the goods represented by the marks differed in nature and purpose. *Quartz Radiation Corp. v. Comm/Scope Co.*, 1 USPQ2d 1668, 1669 (TTAB 1986). The applicant’s mark was used in connection with coaxial cable, and the registered mark was used in connection with the manufacturing of certain products for photocopiers and blueprint machines. *Id.* (“Although the marks are virtually the same, the products with which applicant uses its mark are quite different from the products of opposer. They are different in nature; they are used for different purposes; they are promoted differently and are purchased by different discriminating purchasers.”). Similarly, even though Applicant and the owners of the Registered Marks offer computer software and hardware, the purpose and nature of such goods are so distinct that the consuming public would not be confused as to the origin of such goods. Additionally, as set forth in the refined description under Class 42, Applicant offers design and technological services for banking and financial computer systems, which differ from the services offered under the Registered Marks. Therefore, the nature and purpose of the goods and services offered in connection with Applicant’s Mark and the Registered Marks are not confusingly similar where consumers would be mistaken as to the source.

Although the goods and services offered under Applicant’s Mark and the goods and services offered under the Registered Marks are associated with computer software, the goods and services are not automatically related. See *M2 Software, Inc. v. M2 Commc’ns, Inc.*, 78 USPQ2d 1944, 1947-48 (Fed. Cir. 2006) (noting that, in relation to software-related goods, it would be “inappropriate to presume relatedness on the mere basis of goods being delivered in the same media format”); *Elec. Data Sys. Corp. v. Edsa Micro Corp.*, 23 USPQ2d 1460, 1463 (TTAB 1992) (“[T]he fact that both parties provide computer programs does not establish a relationship between the goods or services, such that consumers would believe that all computer software programs emanate from the same source simply because they are sold under similar marks.”).

b) Applicant’s Trade Channels and Classes of Consumers are Distinct from the Trade Channels and Classes of Consumers Covered by the Registered Marks.

One factor that should be considered when determining likelihood of confusion is the similarity or dissimilarity of trade channels for the goods and services offered under Applicant’s Mark and the goods and services offered under the Registered Marks. *In re Thor Tech, Inc.*, 113 USPQ2d 1546, 1551 (TTAB 2015) (holding that identical marks for towable trailers and trucks would not likely cause confusion because of the difference in goods, the difference in the channels of trade, and the high level of consumer care to be exercised when purchasing the goods). The channels of trade and the classes of consumers covered by Applicant’s Mark and covered by the Registered Marks are distinct. Applicant provides software and technological services to consumers seeking to conduct financial transactions on a “borderless payment platform,” allowing consumers to use digital and fiat currencies to effect transactions. See Exhibit C. Applicant’s goods and services are tailored and marketed towards individuals and businesses that can obtain and use digital assets to make cross-border payment transactions, including day-to-day transactions to retail businesses. Whereas, the goods and services under Cited Mark 1 are offered to a different class of consumers, people and businesses that wish to

convert analog lines to cellular services in the healthcare field. Specifically, the goods and services allow “medical devices to migrate from wired to cellular connectivity with a very low regulatory impact.” See Exhibit B. Additionally, the goods covered by Cited Mark 2 are marketed in the field of cybersecurity towards large organizations to conduct security investigations. See Exhibit A. Therefore, the channels of trade and classes of consumers are distinct for the goods and services offered under Applicant’s Mark and the goods and services offered under the Registered Marks.

Even though some organizational users may utilize the goods and services under both the Applicant’s Mark and the Registered Marks, any potential overlap in trade channels does not automatically result in a likelihood of confusion. See *Hewlett-Packard Co. v. Human Performance Measurement, Inc.*, 23 USPQ2d 1390, 1395 (TTAB 1991) (finding no confusion between HPM & design and HP & design, both for medical equipment, stating, “we concur with applicant that the fact that both parties sell their goods to hospitals, and thus share a common channel of trade, does not necessarily mandate a finding that the products are related and that confusion is likely”). Therefore, even though some users may potentially be the same, no sufficient overlap exists, and thus Applicant’s Mark is not likely to cause confusion with the Registered Marks.

c) Purchasers of Applicant’s goods and services are sophisticated enough to distinguish the goods and services covered by Applicant’s Mark and those covered by the Registered Marks.

It is well settled that confusion is unlikely where purchasers and potential purchasers exercise careful consideration in buying the identified goods sold through distinct channels of trade. See, e.g., *In re N.A.D., Inc.*, 224 USPQ 969 (Fed. Cir. 1985); *In re Bay State Brewing Company, Inc.*, 117 USPQ2d 1958 (TTAB 2016) (“When products are relatively low-priced and subject to impulse buying, the risk of likelihood of confusion is increased because purchasers of such products are held to a lesser standard of purchasing care.”) (quoting *Recot Inc. v. M.C. Becton*, 54 USPQ2d 1894, 1899 (Fed. Cir. 2000)); *In re Thor Tech, Inc.*, 113 USPQ2d at 1551.

Here, Applicant’s goods and services are directed towards consumers who will use a great deal of care because of the nature and cost of such goods and services. Consumers interacting with Applicant’s Mark are conducting financial transactions with both fiat and digital assets. Individuals and businesses using a platform to store, send, and receive money, especially cryptocurrency, will take care to ensure that the platform and the operator are secure and reliable. As shown on the Applicant’s website (<https://wirexapp.com/fees-and-limits>) users are charged certain operation and transaction fees. Because Applicant’s goods and services are specifically tailored and could potentially cost users large sums of money, the users of Applicant’s platform will exercise careful consideration when effecting transactions. Therefore, for the several reasons stated above, likelihood of confusion as to the source of Applicant’s goods and services and the source of the goods and services offered under the Registered Marks is highly unlikely, and thus, Applicant’s Mark is registrable.

2. Explanation of Mark's Significance.

Pursuant to the Examiner's request, Applicant respectfully submits that its Mark, WIREX, does not have any meaning or significance in the industry of Applicant's goods or services and is a coined term.

Further, below are Applicant's responses to Examiner's two questions regarding computer security in Applicant's goods and services:

- 1) Do any of applicant's goods/services involve computer security? If so, which ones?

Response: No.

- 2) Do any of applicant's financial services utilize computer security software programs?

Response: No.