

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re United States Application Serial No. 87566001

Filing Date: August 11, 2017

Applied for Mark:



Applicant: NexGen English Online Co.

To the Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

Examining Attorney: Sally Shih, Law Office 106

Request for Reconsideration

Dear Commissioner,

In the Office Action issued on June 5, 2018, the Examining Attorney issued a final action maintaining her refusal to register the Applicant's mark, based on likelihood of confusion with the mark in U.S. Registration No. 3636759 filed December 28, 2004 owned by Nurses Educational Opportunities, Inc. (*Nurses Educational Opportunities*) which, relevantly, covers the following services in Class 41:

Educational services, namely, providing continuing medical education courses for healthcare professionals, doctors, respiratory therapists and nurses and distributing course materials in connection therewith; educational services, namely, conducting classes, seminars, conferences, and workshops for healthcare professionals, doctors, respiratory therapists, and nurses in the field of healthcare and distributing course materials in connection therewith[.]

In particular, registration of the Applicant's mark has been refused as to the following Class 41 services:

Educational services, namely, providing English and foreign language instruction services and educational services in the nature of correspondence and vocational schools, private language schools, and schools specializing in English and foreign languages[.]

The Applicant respectfully requests a reconsideration of the final action. 37 C.F.R. §2.63(b). TMEP §714. To support this request, the Applicant submits the following new issues and evidence which show that it is *not* likely that a consumer would be confused as to the source of the Applicant's language instruction services and Nurses Educational Opportunities' continuing medical education courses because:

1. The Applicant's and Nurses Educational Opportunities' marks are clearly distinguishable
2. Nurses Educational Opportunities' mark is extremely weak in connection with its registered services;
3. The Applicant's and Nurses Educational Opportunities' services are clearly distinguishable, and the Applicant's amendments to its identification of applied for Class 41 services further distinguish them;
4. The Applicant's and Nurses Educational Opportunities services are marketed and sold in entirely dissimilar trade channels to entirely dissimilar classes of consumers; and

5. Arrangements are being made for the Applicant and the Registrant to enter into a valid consent agreement for registration of the Applied-for Mark. TMEP §715.03.

Applicant therefore respectfully submits that the Section 2(d) refusal should be withdrawn, and that no other issues preventing approval of the Application for publication remain. Accordingly, the Applicant respectfully requests that the Examining Attorney withdraw the refusal and approve the Application for publication. 37 C.F.R. §2.63(b). TMEP §§715.02, 715.03(a). The Applicant notes that it has filed this Request for Reconsideration in conjunction with a Notice of Appeal to the Trademark Trial and Appeal Board (the *TTAB*) in order to preserve its right to appeal. 37 C.F.R. §2.63(b). TMEP §§714, 715.01, 715.03, 715.04. The Applicant therefore trusts that the TTAB will acknowledge the appeal, suspend further appeal proceedings including the Applicant's time to file an appeal brief, and remand the Application to the Examining Attorney for review of the Request for Reconsideration. TMEP, §715.04. TBMP §1204.

1. The Applicant's and Nurses Educational Opportunities' marks are clearly distinguishable

The Applicant respectfully maintains that, notwithstanding any similarities between the parties' marks, they are clearly distinguishable because they create distinct commercial impressions - both on their own and when used in relation to the parties' respective services. Nurses Educational Opportunities' mark connotes and is likely to be perceived by consumers of its continuing medical education courses as an acronym for its name ("Nurses Educational Opportunities). Likewise, in addition to the submissions made in the Response to Office Action filed on May 14, 2018, the Applicant submits that NexGen English Online Co's mark connotes and is likely to be perceived by consumers of its language instruction services as an acronym for its name.

The Applicant submits with this Response to Office Action, as evidence for the Examining Attorney's consideration, copies of Internet printouts showing Nurses Educational Opportunities' use of its mark on its website at the domain NURSESED.NET in connection with, and otherwise in a manner that makes clear to consumers that the mark is an acronym for, NURSES EDUCATIONAL OPPORTUNITIES.

2. Nurses Educational Opportunities' mark is extremely weak in connection with its registered services

The Applicant submits that Nurses Educational Opportunities' mark is extremely weak in connection with its continuing medical education courses and other registered Class 41 services. In addition to the submissions made in the Response to Office Action filed on May 14, 2018 regarding the number and nature of similar marks in use in relation to similar services, the Applicant submits that a mere Google search for the string NEO AND "CONTINUING MEDICAL EDUCATION" generates a plethora of results showing use of NEO by multiple third parties in relation to continuing medical education courses, Nurses Educational Opportunities' other registered Class 41 services, and other highly similar services. Further Google searches for the strings NEO AND "MEDICAL EDUCATION" and NEO AND MEDICAL AND EDUCATION generate even more results of this nature. For example, the results generated by just the first search include websites for:

- The NEO conference on neonatology, which has apparently been running for more than 10 years - longer than the claimed use period associated with Nurses Educational Opportunities' registration;
- The NEO continuing medical education course for nuclear physicians;
- The NEOHEART conference on managing neonatal cardiovascular conditions - which is identical to Nurses Educational Opportunities' core services, which appears to be cardiovascular and fetal heart monitoring continuing medical education courses as indicated on their website; and

- The NEOMED college of medicine which provides courses for doctors and other medical professionals.

The Applicant submits with this Response to Office Action, as evidence for the Examining Attorney's consideration, copies of Internet printouts showing a selection of the Google search results referred to above.

In those circumstances, the Applicant further submits that Nurses Educational Opportunities' mark clearly has an extremely limited scope of protection in connection with continuing medical education and its other registered Class 41 services - let alone educational services more broadly. The Applicant respectfully submits that the Examining Attorney's determination of likelihood of confusion is very much at odds with this limited protection.

3. The Applicant's and Nurses Educational Opportunities services are dissimilar

The Examining Attorney has asserted that one of the "*most relevant*" factors for her determination of likelihood of confusion is the "*similarity and nature*" of the Applicant's language instruction services and Nurses Educational Opportunities' continuing medical education courses. In particular, the Examining Attorney contends that the parties' respective services are "*related*" because they are "*both ... educational services*". The Examining Attorney also contends that the parties' "*trade channels are similar, if not identical*" for that same reason.

The Applicant respectfully maintains that, even if the Applicant's language instruction services and Nurses Educational Opportunities' continuing medical education services can both broadly be classified as educational services that fall within Class 41, that is much too broad a classification to provide meaningful evidence of relatedness of services or similarity of trade channels for the purposes of likelihood of confusion.

The Applicant also maintains that the parties' respective services are *not* so related that they would be encountered by the same types of consumers in circumstances that would create the mistaken belief that the Applicant's language instruction services originate from the same source as Nurses Educational Opportunities' continuing medical education courses. The identification of Class 41 services for Nurses Educational Opportunities' registration states explicitly that its medical education courses are provided only to "*healthcare professionals, doctors, respiratory therapists and nurses in the field of healthcare[.]*" This is an entirely different set of services provided to an entirely different consumer group to the Applicant's language instruction services.

Nevertheless, if the Examining Attorney considers it necessary in order for the Applicant's mark to proceed to registration, the Applicant requests that the identification of its applied for Class 41 services be amended to read as follows, to further distinguish its services from those of Nurses Educational Opportunities:

International Class 041

Educational services, namely, providing English-and-foreign language instruction services and educational services in the nature of correspondence and vocational schools, private language schools, and schools specializing in English-and-foreign languages, none of the foregoing including the provision of continuing medical education courses or courses tailored to healthcare professionals[.]

4. The Applicant's and Nurses Educational Opportunities' services are sold in dissimilar trade channels

The Applicant respectfully maintains that the Applicant's and Nurses Educational Opportunities' respective services are marketed and sold in entirely dissimilar trade channels to entirely dissimilar classes of consumers. In particular, Nurses Educational Opportunities' continuing medical education courses, which are provided to

healthcare professionals, doctors, respiratory therapists and nurses, are highly specialized services provided to highly trained professionals in the medical and healthcare fields charged with preserving life.

In addition to the submissions made in the Response to Office Action filed on May 14, 2018, the Applicant submits that Nurses Educational Opportunities puts itself out as an "AHA approved training site" for various certifications including "BLS, ACLS, PALS, NRP, and First-Aid/CPR" as well as "AWHONN Fetal Heart Monitoring, ECG, and 12-lead Interpretation, Maternal, and Critical Care Programs". It also prominently displays the American Heart Association and American Academy of Pediatrics trademarks on its website. This clearly indicates that Nurses Educational Opportunities' healthcare professional consumers are highly discriminating and sophisticated in their selection of such services from appropriately approved and certified providers. In contrast, the Applicant's language instruction services do not require such approvals or certifications.

The Applicant submits with this Response to Office Action, as evidence for the Examining Attorney's consideration, copies of Internet printouts showing the above approval and certification statements made by Nurses Educational Opportunities' on its website.

5. Arrangements for valid consent agreement

The Applicant submits that arrangements are being made for the parties to enter into an agreement under which Nurses Educational Opportunities consents to registration of the Applicant's mark in the event that the Examining Attorney considers such consent to be necessary in order for the Applicant's mark to proceed to registration.

The form of the consent agreement that the Applicant anticipates the parties will enter into shortly is based on a reasoned assessment of the marketplace, contemplates all reasonable circumstances in which the marks may be used by consumers calling for the parties' respective services, sets out the particular reasons why the parties believe no likelihood of confusion exists, and indicates that both parties have agreed to undertake certain actions to avoid confusion. The Applicant respectfully submits that an agreement in this form is typically considered persuasive evidence of substantial weight tending against a likelihood of confusion. *See In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1362, 177 USPQ 563, 568 (C.C.P.A 1973) (noting that "[t]he weight to be given more detailed agreements ... should be substantial"); *In re Donnay Int'l, S.A.*, 31 USPQ2d 1953, 1956 (TTAB 1994) ("[T]he more information that is in the consent agreement as to why the parties believe confusion to be unlikely, and the more evidentiary support for such conclusions in the facts of record or in the way of undertakings by the parties, the more we can assume that the consent is based on a reasoned assessment of the marketplace, and consequently the more weight the consent will be accorded."). TMEP §1207.01(d)(viii).

Conclusion

Based on the above new issues and evidence, the Applicant respectfully requests that the Examining Attorney reconsider the final action, withdraw the refusal, and approve the Application for publication. The Applicant respectfully submits that the issues and evidence it has presented clearly show that a potential consumer would *not* be confused as to the source of the goods of the Applicant and Nurses Educational Opportunities because:

1. The Applicant's and Nurses Educational Opportunities' marks are clearly distinguishable;
2. Nurses Educational Opportunities' mark is extremely weak in connection with its registered services;
3. The Applicant's and Nurses Educational Opportunities' services are clearly distinguishable, and if necessary Applicant's amendments to its identification of Class 41 services further distinguish them;
4. The Applicant's and Nurses Educational Opportunities' services are marketed and sold in entirely dissimilar trade channels to entirely dissimilar classes of consumers; and

5. Arrangements are being made for a valid consent agreement if necessary.

The Applicant therefore respectfully submits that it has overcome the Examining Attorney's refusal, and that no other issues preventing approval of the Application for publication remain.

Respectfully submitted,

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