

Dear Examiner Lee,

We write in response to the Office Action dated February 12, 2014, for Applicant's U.S. Trademark Application No. 86/114,180, for TRACER (hereinafter referred to as "Applicant's Mark"). Applicant hereby responds to the issues raised in the Office Action as follows:

SECTION 2(d) REFUSAL – LIKELIHOOD OF CONFUSION

The February 12, 2014 Office Action refused registration of Applicant's Mark under Trademark Act Section 2(d), 15 U.S.C. § 1052(d), because it is claimed that Applicant's Mark, when used in connection with the identified goods, so resembles the marks in U.S. Registration Nos. 3,443,802 (hereinafter referred to as "the ALERT Mark"); 3,753,775 (hereinafter referred to as "the PRO Mark"); 4,087,634 and 4,087,635 (hereinafter collectively referred to as "the INFO Marks"); and 4,101,037 (hereinafter referred to as "the TRACER I Mark") and 4,101,038 (hereinafter referred to as "the TRACER II Mark") (collectively referred to as the "Cited Marks"), as to be likely to cause confusion, mistake, or deception as to the source of the services of the of Applicant and Registrant. Applicant respectfully disagrees with this assertion because Applicant's Mark, is not likely to cause confusion with the Cited Marks for five reasons: (1) Applicant's Mark is different in appearance from the Cited Marks; (2) the goods and services provided in connection with the Cited Marks and Applicant's Mark, respectively, are very

different; (3) the channels of trade and marketing are very different; and (4) previous Trademark Applications have been granted Registration over prior Registered Trademarks where the mark and/or the applied for goods/services were much more similar to each other than what is found between Applicant's Mark and the Cited Marks.

In order to demonstrate a likelihood of confusion, a multifactor test is employed: (1) strength of the mark; (2) proximity of the goods; (3) similarity of the marks; (4) evidence of actual confusion; (5) similarity of marketing channels used; (6) degree of caution exercised by the typical purchaser for the type of goods; (7) defendant's intent in selecting the mark; and (8) the likelihood of expansion of the product lines. *AMF, Inc. v. Sleekcraft Boats*, 599 F.2d 341 (9th Cir. 1979). From this multi-factor test, no one factor is determinative in and of itself. The importance of one factor over another is case specific, because it is usually necessary to prove that a hypothetical "reasonably prudent" consumer would likely be confused by the use of the same or a similar Trademark on potentially competing products.

APPLICANT'S MARK AND THE CITED MARKS ARE NOT SO SIMILAR AS TO

BE LIKELY TO CAUSE CONSUMER CONFUSION

The determination of whether a second trademark is likely to cause confusion with a prior trademark is based on an overall impression of the Marks, as

opposed to a side-by-side comparison of the Marks. When an inappropriate side-by-side comparison of the Marks is performed, Applicant's Mark may appear somewhat similar to the "ALERT," "PRO," and "INFO" Marks because of the commonly shared word "TRACER". However, when the overall impression of the Marks is taken into consideration, this similarity does not give rise to a finding that Applicant's Mark is likely to cause confusion with the "ALERT," "PRO," and "INFO" Marks.

When looking at the overall impression of Applicant's Mark and the "ALERT," "PRO," and "INFO" Marks, a reasonably prudent consumer would immediately notice the absence of the additional words "ALERT", "PRO", and "INFO" in the Applicant's Mark. The addition of the words "ALERT", "PRO", and "INFO" in the Cited Marks provides a different meaning and look to the Cited Marks as compared to the Applicant's Marks. Specifically, the word tracer, which means a person or thing that traces (see Exhibit A), has a different meaning from the words "ALERT," "PRO," and "INFO," which causes the consumer to use their imagination to reconcile the three words. The word "alert" has a tendency to invoke feelings of urgency in an observer. The word "pro" has a tendency to invoke reserved feelings of formality. The word "info" has a tendency to invoke feelings of inquisitiveness. However, the word "tracer" standing alone, as in Applicant's Mark, invokes feelings of casual familiarity.

Additionally, despite the commonly shared word “TRACER”, a reasonably prudent consumer may assign a very different meaning to the Cited Marks. As shown in Exhibit B, ALERT means fully aware and attentive. As shown in Exhibit C, PRO is a shortened version of professional which means undertaken or engaged in as a means of livelihood or for gain. As shown in Exhibit D, INFO is a shortened version of information which means knowledge communicated or received concerning a particular fact or circumstance. Accordingly, the inclusion of letters “A,” “L,” “E,” “R,” and “T” in the ALERT Mark, the addition of “P,” “R,” and “O,” in the PRO Mark and the addition of “I,” “N,” “F,” and “O” in the INFO Mark, provide a very different overall impression of Applicant’s Mark.

Accordingly, Applicant’s mark looks very different, and has a different meaning, than the ALERT, PRO, and INFO Marks. Thus, when the overall impression of the Marks is taken into consideration, rather than a simple side-by-side comparison that shows that they share a common word, the Marks are different, have a different meaning, and provide the consumer with a very different impression. Therefore, Applicant’s Mark is not so similar to the ALERT, PRO, and INFO Marks such that a reasonably prudent consumer is not likely to be confused between the Marks.

When looking at the overall impression of Applicant’s Mark and the ALERT and INFO Marks, a reasonably prudent consumer would immediately notice the

prominently featured and distinctive additional word ALERT and INFO in the Cited Marks, which is located at the beginning of the respective Marks. Pursuant to *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 1372-73, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005), a reasonably prudent consumer pays particular attention to the first word of a Trademark. Thus, when the first word of two similar marks is not the same, then the two Trademarks are unlikely to cause consumer confusion. The same is true in this case.

Because the ALERT, PRO, and INFO Marks and Applicant's Mark do not have the same letters and word, and because the Marks have very different meanings, the overall impression of Applicant's Mark is different enough from the overall impression of the ALERT, PRO, and INFO Marks, such that a reasonably prudent consumer is not likely to be confused between the three Marks. Accordingly, this factor weighs in favor of finding that Applicant's Mark is not likely to cause consumer confusion with the ALERT, PRO, and INFO Marks.

*THE GOODS AND SERVICES PROVIDED IN CONNECTION WITH THE
CITED MARKS ARE RADICALLY DIFFERENT FROM THE GOODS AND
SERVICES PROVIDED IN CONNECTION WITH APPLICANT'S MARK*

Part of the legal analysis in determining whether two marks are similar is a comparison of the goods and/or services of the two marks. Although the services do not have to be identical, they must be related in some manner, or they must be

marketed such that a consumer that may encounter them in commerce would believe that the goods have a common source. TMEP §1207.01(a)(i).

In this case, the ALERT Mark is directed to “[a] feature of message delivery notification services, namely, real-time reporting of detailed alert delivery status information and statistics, including details as to when a message was delivered and to whom, all done via text and voice messaging” in Class 038, whereas Applicant’s Mark is associated with “[t]elecommunication services, namely, connectivity services for electronic transmission and reception of audio, video, multimedia, text and data via the Internet, computers and other communications networks; delivery of messages by electronic transmission” in Class 038.

Although there are some similarities in the listing of services, the ALERT services are directed primarily to inform users as to information concerning delivery of a message, whereas Applicant’s services connecting and transmitting data through the internet and other communications networks. Therefore, a reasonably prudent consumer would not be confused by services being offered with the ALERT Mark on them, and the products of others being sold under Applicant’s Mark.

Regarding the PRO Mark, the PRO Mark is directed to “[c]omputer software for remote data capture” in Class 009. Applicant’s Mark, on the other hand, is associated with “[c]omputer software in the field of text and image transmission

and display; computer software for transmitting, sharing, receiving, downloading, displaying and transferring content, text, visual works, audio works, audiovisual works, literary works, data, files, documents and electronic works via computers and handheld mobile digital electronic devices, namely, tablet computers; computer software for formatting and converting content, text, visual works, audio works, audiovisual works, literary works, data, files, documents and electronic works into a format compatible with computers and handheld mobile digital electronic devices, namely, tablet computers; computer software enabling content, text, visual works, audio works, audiovisual works, literary works, data, files, documents and electronic works to be downloaded to and accessed on computers and handheld mobile digital electronic devices, namely, tablet computers; electronic pens; Downloadable films, television programs and television shows featuring children's entertainment provided via a video-on-demand service; Digital media, namely, downloadable audio and video recordings featuring children's entertainment; Computer application software for personal and handheld computers, namely, software for data communication and translating and transmitting data sold therewith; Computer software programs enabling receipt, download, playing, viewing and purchasing of audio and video programming in the nature of children's entertainment via a global computer network; Computer

software, namely, software for streaming audio-visual media content in the nature of children's entertainment via the internet” in Class 009.

Although there are some similarities in the listing of services in that both services the use of computers, the PRO services are directed primarily to capturing data, whereas Applicant’s goods are directed to computer software used primarily for entertainment purposes, such as audio visual transmission. Therefore, a reasonably prudent consumer would not be confused by services being sold with the PRO Mark on them, and the products of others being sold under Applicant’s Mark.

Regarding the INFO Marks, these Marks are directed to “[c]omputer services, namely, providing search engines for obtaining data for business and consumer purposes on a global computer network; Computer services, namely, providing online nondownloadable software for search and retrieval of information; Computer services, namely, providing online nondownloadable software for search and retrieval of information relating to people, properties, businesses, events, identity verification, telephone numbers, addresses, email addresses, and criminal, court and other public records; Computer services, namely, providing online nondownloadable software for reverse telephone number and email address searches in Class 042. Whereas, Applicant’s Mark is associated with “[p]roviding temporary use of online non-downloadable software to enable

users to create, share, access and use software, audio, video, text multimedia and data; Document data transfer from one computer format to another; hosting of digital content on global computer networks, wireless networks, and electronic communications networks; providing an online network that enables users to access and share content, text, visual works, audio works, audiovisual works, literary works, data, files, documents and electronic works; providing a web site that gives computer users the ability to transmit, cache, receive, download, stream, broadcast, display, format, transfer and share content, text, visual works, audio works, audiovisual works, literary works, data, files, documents and electronic works” in Class 042.

Although there are some similarities in the listing of goods in that both services include computers, the INFO services are directed primarily to finding information on the internet and networks, whereas Applicant’s services are directed to sharing and sending data, which may include visual, audio, audiovisual works and various other forms of entertainment. Therefore, a reasonably prudent consumer would not be confused by services being sold with the INFO Mark on them, and the products of others being sold under Applicant’s Mark.

Regarding the TRACER Marks, these Marks are directed to “[p]rinted materials, namely, posters, paper signs, window displays in the nature of printed signs, gift cards, greeting cards, business cards, post cards, event tickets, printed

visuals in the nature of promotional material, all featuring lenticular images” in Class 016. Whereas, Applicant’s Mark is associated with “[p]rinted matter for use in connection with handheld mobile digital electronic devices, namely, paper, notebooks, and notepads, all for use with computers and handheld mobile digital electronic devices, namely, tablet computers, and all of the aforementioned in the field of a wide variety of topics and subjects; Pens; Figures made of paper; Writing Paper; Printing Paper; Paper stock; Paper stationary; Craft paper; Children's arts and crafts paper kits” in Class 016.

Although there are some similarities in the listing of goods in that both goods include paper materials, the TRACER goods are directed primarily to printed signs, gift cards, and greeting cards, whereas Applicant’s goods are directed to different printed matter such as paper and notepads for electronic devices. Therefore, a reasonably prudent consumer would not be confused by products being sold with the TRACER Mark on them, and the products of others being sold under Applicant’s Mark.

THE CHANNELS OF TRADE ARE VERY DIFFERENT

As detailed above, Applicant’s goods and services are in connection with handheld mobile digital electronic devices. See Exhibit E. On the other hand, the printed material, informational searching services, data capture, and message information and statistics associated with the Cited Marks are not directed to the

same fields as Applicant's Mark. See Exhibit F. Thus, Applicant's goods and services are simply not sold, provided, or advertised in the same channels of trade as Registrants' goods. Therefore, a reasonably prudent consumer, looking for Registrants' goods, is absolutely not going to come across Applicant's goods. Accordingly, this factor weighs in favor of finding that Applicant's Mark is not likely to cause consumer confusion with the Cited Marks.

EXTRINSIC EVIDENCE SUPPORTS THE FACT THAT APPLICANT'S MARK IS NOT LIKELY TO CAUSE CONFUSION WITH THE CITED MARKS

Previous Trademark Applications have been granted Registration over prior Registered Trademarks where the mark and/or the applied for services or goods were much more similar to each other than what is found between Applicant's Mark and the Registered Trademarks. For example, the well-known Registered U.S. Trademark No. 3,417,110 for LUCKY (standard character mark), submitted as Exhibit G, and Registered as U.S. Trademark No. 3,207,294 for LUCKY 13 (standard character mark), submitted as Exhibit H, are such two marks. These two marks are hereinafter referred to as "the LUCKY Marks." Although the LUCKY 13 Mark listed identical goods in the same international class as the LUCKY Mark and the Marks only differed by the addition of "13", these two Marks were allowed to co-exist and Register. Thus, the USPTO made the decision that these two jeans related Trademarks were not likely to cause confusion. In this case, Applicant's

goods and mark are both more different than Registrant's goods and mark. Thus, just as the two Lucky Marks are not likely to cause consumer confusion, neither is Applicant's Mark likely to cause consumer confusion with the Cited Marks.

Another example, Registered U.S. Trademark No. 4,363,153 for GROOVE CO (standard character mark), submitted as Exhibit I, and Registered U.S. Trademark No. 3,139,529 for GROOVE (standard character mark), submitted as Exhibit J, are such two marks. These two marks are hereinafter referred to as "the GROOVE Marks." Although the GROOVE CO Mark listed identical goods in the same international class as the GROOVE Mark and the Marks only differed by the addition of CO, these two Marks were allowed to co-exist. Thus, just as these two registered U.S. Trademarks are not likely to cause consumer confusion, neither is Applicant's Mark likely to cause consumer confusion with the Cited Marks.

A third example includes Registered U.S. Trademark No. 2,829,783 for THE HOME DEPOT EXPRESS (design plus words, letters and/or numbers), submitted as Exhibit K, and Registered U.S. Trademark No. 3,046,079 for DEPOT EXPRESS (standard character mark), submitted as Exhibit L. These two marks are hereinafter referred to as "the DEPOT Marks." The DEPOT EXPRESS Mark is listed in the same International Class as THE HOME DEPOT EXPRESS Mark, and the Marks only differed by the addition of THE and HOME. Trademark Office concluded that these two marks were not likely to cause consumer

confusion. Thus, just as these two registered U.S. Trademarks are not likely to cause consumer confusion, neither is Applicant's Mark likely to cause consumer confusion with the Cited Trademarks.

Additional examples include the following four Registered U.S. Trademark Nos. 3,113,039 for "VEX", submitted as Exhibit M, 2,951,926 for "INVEX", submitted as Exhibit N, 3,581,344 for "HI-VEX", submitted as Exhibit O, and 1,240,921 for "SOL-VEX", submitted as Exhibit P, each of which includes goods in International Class 009, all include the characters "V-E-X." Because all four of these Trademarks co-exist, the Trademark Office concluded that they are not likely to cause consumer confusion. In other words, "VEX" was found to be not likely to cause consumer confusion with "SOL-VEX" or "INVEX" and "HI-VEX" was found to be not likely to cause consumer confusion with "SOL-VEX", "INVEX", or "VEX". If there is no consumer confusion between "VEX" and "INVEX", between "HI-VEX" and "INVEX", or between "VEX" and "HI-VEX", all of which are much more similar to each other than "ALERT," "INFO," "PRO," and "TRACER," there is simply no way that there is or would be any consumer confusion between Applicant's Mark and the Cited Trademarks.

The above is additional evidence that weighs in favor of finding that Applicant's Mark and the Cited Trademarks are not likely to cause consumer confusion.

POTENTIAL SECTION 2(d) REFUSAL – LIKELIHOOD OF CONFUSION

ADVISORY

Additionally, the February 12, 2014 Office Action indicated that U.S. Application Serial No. 85/538,178 (hereinafter the “HI” Mark) may be used to refuse registration of the applied for Mark if HI were to register. On June 24, 2014 the HI Mark registered. Should Examiner decide to issue a Section 2(d) refusal based on the HI Mark, Applicant offers the following arguments. (1) Applicant’s Mark is different in appearance from the Cited Marks; (2) the goods and services provided in connection with the Cited Marks and Applicant’s Mark, respectively, are very different; (3) the channels of trade and marketing are very different; and (4) previous Trademark Applications have been granted Registration over prior Registered Trademarks where the mark and/or the applied for goods/services were much more similar to each other than what is found between Applicant’s Mark and the Cited Marks. In the interest of brevity and readability, the above referenced introductory statements, rules, and case law will not be repeated below.

APPLICANT’S MARK AND THE CITED MARKS ARE NOT SO SIMILAR AS TO BE LIKELY TO CAUSE CONSUMER CONFUSION

When an inappropriate side-by-side comparison of the Marks is performed, Applicant’s Mark may appear somewhat similar to the “HI” Mark because of the commonly shared word “TRACER”. However, when the overall impression of the

Marks is taken into consideration, this similarity does not give rise to a finding that Applicant's Mark is likely to cause confusion with the "HI" Mark.

When looking at the overall impression of Applicant's Mark and the "HI" Mark, a reasonably prudent consumer would immediately notice the absence of the additional word hi in the Applicant's Mark, which is located at the beginning of the HI. The addition of the words "hi" to the Cited Mark provides a different meaning and look to the Cited Mark as compared to the Applicant's Mark.

Additionally, a reasonably prudent consumer would also notice the addition of the letters "H," and "I" in the HI Mark. Despite the commonly shared word "TRACER", a reasonably prudent consumer may assign a very different meaning to the words. As shown in Exhibit Q, accordingly, the inclusion of letters "H," and "I" in the HI Mark, provide a very different overall impression of Applicant's Mark.

Accordingly, Applicant's mark looks very different, and has a different meaning, than the HI Mark. Thus, when the overall impression of the Marks is taken into consideration, rather than a simple side-by-side comparison that shows that they share a common word, the Marks are different, have a different meaning, and provide the consumer with a very different impression. Therefore, Applicant's Mark is not so similar to the HI Mark such that a reasonably prudent consumer is not likely to be confused between the Marks.

*THE GOODS AND SERVICES PROVIDED IN CONNECTION WITH THE
CITED MARKS ARE RADICALLY DIFFERENT FROM THE GOODS AND
SERVICES PROVIDED IN CONNECTION WITH APPLICANT'S MARK'*

In this case, the HI Mark is directed to “Computer programs for use in the operation of Scanning Electron Microscopes (SEM) in the field of SEM metrology; computer programs for the manipulation, analysis, storage and management of SEM data and images; computer software platform for the management and integration of SEM (Scanning Electron Microscope) metrology applications software; data and image storage software; database management software; networking software for administration of computer networks” in Class 009, whereas Applicant’s Mark is associated with “Computer software in the field of text and image transmission and display; computer software for transmitting, sharing, receiving, downloading, displaying and transferring content, text, visual works, audio works, audiovisual works, literary works, data, files, documents and electronic works via computers and handheld mobile digital electronic devices, namely, tablet computers; computer software for formatting and converting content, text, visual works, audio works, audiovisual works, literary works, data, files, documents and electronic works into a format compatible with computers and handheld mobile digital electronic devices, namely, tablet computers; computer software enabling content, text, visual works, audio works, audiovisual works,

literary works, data, files, documents and electronic works to be downloaded to and accessed on computers and handheld mobile digital electronic devices, namely, tablet computers; electronic pens; Downloadable films, television programs and television shows featuring children's entertainment provided via a video-on-demand service; Digital media, namely, downloadable audio and video recordings featuring children's entertainment; Computer application software for personal and handheld computers, namely, software for data communication and translating and transmitting data sold therewith; Computer software programs enabling receipt, download, playing, viewing and purchasing of audio and video programming in the nature of children's entertainment via a global computer network; Computer software, namely, software for streaming audio-visual media content in the nature of children's entertainment via the internet” in Class 009.

Although there are some similarities in the listing of goods, the HI Mark is directed towards the extremely specialized fields of scanning electron microscopy (SEM). This Mark would be directed towards engineers in extremely specific fields for extremely specific purposes. The Applicant’s Mark, however, would be directed towards entertainment services which are in no way directed towards only scanning electron microscopists.

THE CHANNELS OF TRADE ARE VERY DIFFERENT

Because the HI Mark is offered to a very selective group, it cannot be

advertised by casting a wide net, but instead is likely to be specifically targeted and often used at seminars or academic papers.

Thus, Applicant's goods and services are simply not sold, provided, or advertised in the same channels of trade as Registrant's goods. Therefore, a reasonably prudent consumer, looking for Registrant's goods, is absolutely not going to come across Applicant's goods. Accordingly, this factor weighs in favor of finding that Applicant's Mark is not likely to cause consumer confusion with the Cited Marks.

EXTRINSIC EVIDENCE SUPPORTS THE FACT THAT APPLICANT'S MARK IS NOT LIKELY TO CAUSE CONFUSION WITH THE CITED MARKS

The same extrinsic evidence provided above applies to the HI Mark, and is therefore additional evidence that weighs in favor of finding that Applicant's Mark and the Cited Trademarks are not likely to cause consumer confusion.

SECTION 2(e) REFUSAL – MERELY DESCRIPTIVE

Additionally, the February 12, 2014 Office Action refused registration of Applicant's Mark in Class 016 under Trademark Act Section 2(e)(1), 15 U.S.C. § 1052(e)(1), because it is allegedly merely descriptive of the goods "pens."

While Applicant respectfully disagrees with Examiner's determination that the word "tracer" is merely descriptive of "pens," Applicant is willing to remove "pens" from the descriptors in Class 016.

IDENTIFICATION OF GOODS AND SERVICES

We will be using the Examiner's suggested identifications.

CONCLUSION

Applicant respectfully requests reconsideration of the registration of the mark and requests that it be allowed to pass for publication in the Official Gazette in light of the foregoing. The Examiner is invited to contact Applicant's undersigned counsel by e-mail at Marc@HankinPatentLaw.com or by telephone at (310) 979-3600 to expedite the prosecution of this case should there be any unresolved matters remaining.

Respectfully submitted,

Law Office of Michael Isaac Shokrian

Dated: August 12, 2014

/Michael I. Shokrian/

Michael I. Shokrian

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Attorney for Applicant