

ASAP

U.S. Application Serial No. 86239782
0043603.00699
Amazon Ref. TMKM3396

OFFICE ACTION RESPONSE

(1) Remarks

Applicant, Amazon Technologies, Inc., respectfully submits this Response to the non-final Office Action that issued on July 10, 2014 with respect to U.S. Trademark Application Serial No. 86/239,782.

A. Likelihood of Confusion under section 2(d)

1. Section 2(d) Refusal regarding International Classes 9 and 42, in part

The Examining Attorney has initially refused registration of the applied-for mark ASAP (“Applicant’s Mark”) in International Class 9 for the goods “Software tool and feature for downloading, uploading and streaming of multimedia content” and in International Class 42 for the services “Computer services, namely providing non-downloadable software tool for streaming and delivery of multimedia” under section 2(d) of the Lanham Act on the ground that there is a likelihood of confusion between Applicant’s Mark and the marks in U.S. Reg. No. 1,603,556 (for ASAP) and U.S. Reg. No. 3,382,672 (for MEETASAP).

Initially, Applicant notes that U.S. Reg. No. 3,382,672 was canceled as of September 19, 2014 and can no longer serve as a bar to the registration of Applicant’s Mark.

Turning to U.S. Reg. No. 1,603,556, Applicant respectfully submits that no likelihood of confusion in the instant case exists, especially in light of the amendments to the Application’s identification of goods and services, submitted herewith. The cited registration covers “computer programs and accompanying manuals sold as a unit for use as an electronic mail system” in International Class 9. The Examining Attorney noted in the Office Action that the Application’s identification of goods and services—and, in particular, the wording “multimedia”—was so broad as to encompass the registrant’s goods. Applicant herein submits amendments narrowing the Application’s description of goods and services in International Classes 9 and 42 and making clear that Applicant’s software tools relate to the downloading, uploading, and streaming of multimedia entertainment content. The Application’s identifications as amended, therefore, do not overlap with, encompass, or otherwise relate to the registrant’s electronic mail system software.

As such, Applicant submits that there is no likelihood of confusion as between Applicant’s Mark and the mark in U.S. Reg. No. 1,603,556 and respectfully requests that the Examiner lift the refusal with respect to Classes 9 and 42.

2. Section 2(d) Refusal regarding International Class 38, in part

The Examining Attorney has initially refused registration of Applicant's Mark in International Class 38 for the services "providing an internet forum, online chat rooms and online communities for the transmission of messages among computer users concerning reviews, ratings and recommendations related to voice, audio, visual images, data, books, photos, videos, text, documents, content, audiovisual works, multimedia works, literary works, files, and other electronic works" and "providing online chat rooms, internet forums and online communities for the transmission of photos, videos, text, and electronic works, namely, books, data, images, documents, content, visual works, audio works, audiovisual works, multimedia works, literary works, files, and other electronic works" under section 2(d) of the Lanham Act on the ground that there is a likelihood of confusion between Applicant's Mark and two prior, registered marks. Applicant respectfully submits that no likelihood of confusion exists as between Applicant's Mark and the cited marks, especially in light of the amendments to the Application's identification of goods and services, submitted herewith.

The first prior registration cited is U.S. Reg. No. 3,267,870 for the mark ASAP, covering "providing on-line chat rooms and electronic bulletin boards for transmission of messages among users related to syringomyelia, chiari malformations and related conditions and disorders" in International Class 38. The second prior registration cited is U.S. Reg. No. 4,231,343 for the mark ASAP AUTOMATED SECURE ALARM PROTOCOL, covering "Providing on-line forums in the field of central station alarm monitoring" in International Class 38 (among others).

The Examining Attorney noted in the Office Action that the Application's identification in International Class 38 was so broad as to encompass the registrants' respective services. Applicant herein submits amendments narrowing the Application's identification of services in International Class 38 and making clear that the subject matter of Applicant's internet forums and online chat rooms relates specifically to entertainment content. The Application's identification as amended, therefore, does not overlap with, encompass, or otherwise relate to online forums or chat rooms relating to "syringomyelia, chiari malformations and related conditions and disorders" or in the field of "central station alarm monitoring."

As such, Applicant submits that there is no likelihood of confusion as between Applicant's Mark and the marks in U.S. Reg. Nos. 3,267,870 and 4,231,343 and respectfully requests that the Examiner lift the refusal with respect to International Class 38.

3. Section 2(d) Refusal regarding International Class 41

The Examining Attorney has initially refused registration of Applicant's Mark in International Class 41 for the services "Entertainment services, namely providing non-downloadable playback of multimedia content and audio and video recordings via global communications network" under section 2(d) of the Lanham Act on the ground that there is a likelihood of confusion between Applicant's Mark and the marks in U.S. Reg. Nos. 4,471,422 for the mark A\$AP ROCKY and 4,564,607 for the mark A\$AP WORLDWIDE, both covering "Providing a website featuring musical performance videos, musical multi-media materials, and information on a musical performer" in International Class 41. Applicant respectfully submits that no likelihood of confusion in the instant case exists. The differences in the respective marks preclude a likelihood of confusion in this case. *See In re E.I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 U.S.P.Q. 563 (C.C.P.A. 1973).

Applicant respectfully submits that its mark is dissimilar from the cited marks in terms of sight, sound, meaning, and commercial impression. In finding that Applicant's mark is confusingly similar to the cited marks, the Examining Attorney focused on the phonetic similarity among Applicant's Mark and the first

term in the cited marks. That marks share a phonetically similar element, does not, in and of itself, make confusion likely where the marks are otherwise dissimilar. *See, e.g., La Mexicana, Inc. v. Sysco Corp.*, 1998 U.S. Dist. LEXIS 21158, at *14, 49 U.S.P.Q.2d 1204 (W.D. Wash. 1998) (CASA SOLANA not confusingly similar to SOLENA, both for tortillas and tortilla chips); *Jet, Inc. v. Sewage Aeration Sys.*, 165 F.3d 419, 424 (6th Cir. 1999) (AEROB-A-JET not confusingly similar to JET, both for sewage and waste-water treatment devices for homes); *In re Hearst Corp.*, 982 F.2d 493, 494, 25 U.S.P.Q.2d 1238 (Fed. Cir. 1992) (VARGA GIRL not confusingly similar to VARGAS, both used in connection with similar printed artwork, based on the finding that the unique ending of VARGA GIRL sufficiently distinguished the marks). Rather, marks are to be considered in their entirety in determining whether a likelihood of confusion exists. *See In re Loew's Theaters, Inc.*, 218 U.S.P.Q. 956 (TTAB 1983). In the case at hand, more than just a slight difference exists. The scope of inquiry must encompass all aspects of the marks' presentation, sound, and connotation, particularly the unique portions of the respective marks.

Here, Applicant's Mark and the cited marks share no common elements, and a striking difference exists between the only element of the cited marks bearing any similarity to Applicant's Mark. The first term in each cited mark features a conspicuous, visually-distinct element not found in Applicant's Mark—the use of the dollar sign (“\$”) in the place of the letter “s” to form the term A\$AP—which imbues the cited marks with meaning and connotation not shared by Applicant's Mark. Before even deciding upon a pronunciation, consumers encountering the cited marks are required to interpret the dollar symbol within the context of the adjacent lettering in order to determine that it should be pronounced as the letter “s.” Only then would consumers pronounce the first term in each mark in a manner phonetically similar to Applicant's Mark. The use of the dollar symbol in the cited marks, moreover, evokes the notion of currency and presumably monetary value and wealth, whereas Applicant's Mark evokes no such meaning. Under these circumstances, consumers will certainly focus on the dollar sign when recalling the cited marks.

The differences do not end there. The cited marks each feature unique wording that further distinguish the cited marks from Applicant's Mark. The wording “worldwide” (in the mark A\$AP WORLDWIDE) and the wording “rocky” (in the mark A\$AP ROCKY) imparts the cited marks with additional meaning not found in Applicant's Mark. This additional wording, coupled with the visually- and connotatively-distinct “A\$AP” element, results in the cited marks' creating an overall commercial impression that is entirely dissimilar to that of Applicant's Mark.

In light of the dissimilarities in sight, sound, and commercial impression between the marks, a likelihood of confusion in this case is foreclosed, and Applicant respectfully requests that the Examining Attorney lift the refusal with respect to International Class 41 and pass the present Application to publication.

B. Identifications of Goods and Services

Applicant herein submits several amendments to the Application's identifications of goods and services per the Examining Attorney's request but respectfully submits that certain objected-to wording is properly identified.

Regarding the phrase “software tool,” the Examining Attorney took issue with this wording as used in the identifications in International Classes 9 and 42. Applicant respectfully submits that “software tool” is the common commercial or generic name for the identified services and refers the Examining Attorney to U.S. Reg. Nos. 4,488,866; 4,658,797; and 4,627,589, and to U.S. Serials Nos. 85/433,986 (allowed) and 85/602,464 (allowed), which confirm that the wording “software tool” or “software tools” is acceptable.

Applicant respectfully submits that the wording “providing access to online directories, databases, current events websites and blogs and on-line reference materials in the entertainment and literary fields” in International Class 38 is properly identified and classified. The Examining Attorney objected to the classification of this wording in International Class 38. In response, Applicant notes that the introductory wording “providing access” necessarily implicates telecommunications services in International Class 38. The Examining Attorney who examined Applicant’s pending U.S. Serial No. 86/073,839 for the mark FIRETUBE made this very point in an Office Action that issued on September 10, 2014, stating: “[T]he ‘providing access to online directories, databases...’ refers to telecommunications access services generally classified in International Class 38. If providing content, and not the underlying transmission/communications services, the wording, ‘providing access’ should be deleted from the identification.”

Nevertheless, to further clarify the International Class 38 nature of the identified services, Applicant herein amends the wording to read: “telecommunications services, namely, providing access to online directories, databases, current events websites and blogs, and on-line reference materials in the entertainment and literary fields.”