

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

Response to Office Action

Dear Commissioner,

This is in response to the Office Action issued November 15, 2017 in connection with the Application.

Applicant has carefully reviewed the Examining Attorney's comments and submits the following response.

Response

Section 2(d) Refusal - Likelihood of Confusion

The Examining Attorney has refused registration of 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 Applicant's mark has been refused as to the applied for services in Class 41, namely:

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/or schools specializing in English and foreign languages[.]

Specifically, the Examining Attorney has determined that it is likely a consumer would be confused, mistaken, or deceived as to the source of Applicant's and Nurses Educational Opportunities' respective services. The Examining Attorney has asserted that the "most relevant" factors for this determination are:

[S]imilarity of the marks, similarity and nature of the services, and similarity of the trade channels of the services.

Applicant, through its Attorney, respectfully disagrees with Examining Attorney's determination and submits that it is unlikely that a consumer would be confused, mistaken, or deceived as to the source of the parties' services. Specifically, Applicant submits that it is unlikely that the parties' use of their respective marks will confuse people into believing that their respective services emanate from the same source. *See, e.g. Paula Payne Prods. Co. v. Johnson's Publ'g Co.*, 473 F.2d 901, 902, 177 USPQ 76, 77 (C.C.P.A. 1973); *see also* TMEP §1207.01.

Applicant agrees with the Examining Attorney that the USPTO may focus its likelihood of confusion analysis on dispositive factors. The significance of a particular factor may differ from case to case. *See du Pont*, 476 F.2d at 1361-62, 177 USPQ at 567-68; *Dixie Rests.*, 105 F.3d at 1406-07, 41 USPQ2d at 1533 (noting that "any one of the factors may control a particular case"); *see also* TMEP §1207.01.

However, Applicant respectfully submits that, for the following reasons, the most relevant factors in this case are:

1. Differences in sound, connotation, and commercial impression of the marks.
2. Number and nature of similar marks in use in relation to similar services.
3. Lack of relatedness of the parties' services.
4. Dissimilarity of the parties' established, likely-to-continue trade channels.
5. Conditions under which, and buyers to whom, sales of the parties' services are made.

Applicant submits that, in view of these factors, there is no likelihood of confusion as to the source or sponsorship of the parties respective services. *See In re Majestic Distilling Co.*, 315 F.3d 1311, 1316, 65 USPQ2d 1201, 1205 (Fed. Cir. 2003) ("[T]he . . . mistaken belief that [a good] is manufactured or sponsored by the same entity [as another good] . . . is precisely the mistake that §2(d) of the Lanham Act seeks to prevent."); *In re Shell Oil Co.*, 992 F.2d 1204, 1207, 26 USPQ2d 1687, 1689 (Fed. Cir. 1993) ("The degree of 'relatedness' must be viewed in the context of all the factors, in determining whether the services are sufficiently related that a reasonable consumer would be confused as to source or sponsorship."); *In re Binion*, 93 USPQ2d 1531, 1534, 1535 (TTAB 2009); *In re Ass'n of the U.S. Army*, 85 USPQ2d 1264, 1267-68, 1270 (TTAB 2007); *see also* TMEP §1207.01.

Applicant otherwise responds to the Examining Attorney's determination as follows.

1. Differences in sound, connotation, and commercial impression of the marks

As the Examining Attorney points out, likelihood of confusion analysis requires comparison of marks in their entireties to identify similarities, including as to appearance, sound, connotation, and commercial impression. Applicant agrees that the test is whether the marks are sufficiently similar in terms of overall commercial impression that confusion as to the source of the services offered under the respective marks is likely to result.

When comparing marks, "[a]ll relevant facts pertaining to appearance, sound, and connotation must be considered before similarity as to one or more of those factors may be sufficient to support a finding that the marks are similar or dissimilar." *Recot, Inc. v. M.C. Becton*, 214 F.3d 1322, 1329, 54 USPQ2d 1894, 1899 (Fed. Cir. 2000); *see* TMEP §1207.01(b). Similarity in sound is a factor in determining whether marks are confusingly similar. *See In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973); *In re White Swan, Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988); *see also* TMEP §1207.01(b)(iv). Same with similarity in meaning or connotation. *See In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973); *In re Cynosure, Inc.*, 90 USPQ2d 1644, 1645-46 (TTAB 2009); *see also* TMEP §1207.01(b)(v).


The meaning or connotation of a mark must be determined in relation to the named goods or services. Even marks that are identical in sound and/or appearance may create sufficiently different commercial impressions when applied to the respective parties' goods or services so that there is no likelihood of confusion. *See, e.g., In*

re Sears, Roebuck & Co., 2 USPQ2d 1312, 1314 (TTAB 1987) (holding CROSS-OVER for bras and CROSSOVER for ladies' sportswear not likely to cause confusion, noting that the term "CROSS-OVER" was suggestive of the construction of applicant's bras, whereas "CROSSOVER," as applied to registrant's goods, was "likely to be perceived by purchasers either as an entirely arbitrary designation, or as being suggestive of sportswear which "crosses over" the line between informal and more formal wear . . . or the line between two seasons"); *In re British Bulldog, Ltd.*, 224 USPQ 854, 856 (TTAB 1984) (holding PLAYERS for men's underwear and PLAYERS for shoes not likely to cause confusion, agreeing with applicant's argument that the term "PLAYERS" implies a fit, style, color, and durability suitable for outdoor activities when applied to shoes, but "implies something else, primarily indoors in nature" when applied to men's underwear); *In re Sydel Lingerie Co.*, 197 USPQ 629, 630 (TTAB 1977) (holding BOTTOMS UP for ladies' and children's underwear and BOTTOMS UP for men's clothing not likely to cause confusion, noting that the wording connotes the drinking phrase "Drink Up" when applied to men's clothing, but does not have this connotation when applied to ladies' and children's underwear); *see also* TMEP §1207.01(b)(v).

Applicant likewise submits that, in this case, notwithstanding any similarities between the parties' marks, they sound different and 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 services as an acronym for its name ("Nurses Educational Opportunities). This acronym connotation is reflected in the sound of the mark, which reads phonetically "N E O" (ie, *en-ee-oh*).

In contrast, Applicant's mark does not connote and is not likely to be perceived by consumers of its services as an acronym. Rather, Applicant's mark connotes and is likely to be perceived as the non-acronym word "Neo" - being either an arbitrary designation, or (in light of the English meaning of the prefix "neo-") vaguely suggestive of Applicant's services having a "new" or "recent" nature. This non-acronym word connotation creates a different sound to that of the registered mark: "Neo" (ie, *nee-oh*). Applicant submits with this Response to Office Action, as evidence for the Examining Attorney's consideration, a copy of the Dictionary.com definition of "Neo".

Applicant submits with this Response to Office Action, as evidence for the Examining Attorney's consideration, a copy of an Internet printout showing the Dictionary.com definition of "NEO".

The non-acronym word connotation of Applicant's mark is further indicated by its stylized presentation . In particular, the lower case presentation of the letters "n", "e", and "o" and the integration of the letters "e" and "o" into an infinity symbol (as stated in the mark description provided with the Application) make clear that the sound created by the letters is similarly integrated as in the word "Neo" (ie, *nee-oh*) rather than separate as in the acronym "N E O" (ie, *en-ee-oh*). The stylized presentation also serves to distinguish the marks visually.

Applicant further submits that a determination of no likelihood of confusion is appropriate here, notwithstanding any similarities between the parties' marks, because this factor is outweighed by the other factors referred to below. The TMEP indicates that, in cases such as these, a determination of no likelihood of confusion is appropriate, even where the marks are similar and the parties' goods or services are related, because these factors are outweighed by other factors, such as the presence in the marketplace of similar marks in use on similar goods or services, differences in the relevant trade channels of the goods or services, or other established facts that are probative of the effect of use. *See* TMEP §1207.01. Applicant makes further submissions on this point below.

2. Number and nature of similar marks in use in relation to similar services

The number and nature of similar marks in use on or in relation to similar goods or services may be relevant in an *ex parte* likelihood of confusion determination and must be considered if there is pertinent evidence in the record. *See, e.g., du Pont*, 476 F.2d at 1362-63, 177 USPQ at 568-69; *In re Thor Tech, Inc.*, 113 USPQ2d 1546 (TTAB

2015); *In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1203-04 (TTAB 2009); *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266, 1272-74 (TTAB 2009); *Ass'n of the U.S. Army*, 85 USPQ2d at 1271-73; *see also* TMEP §1207.01.

Such evidence falls under the sixth *du Pont* factor. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973). If the evidence establishes that the consuming public is exposed to third party use of similar marks on or in relation to similar goods or services, it "is relevant to show that a mark is relatively weak and entitled to only a narrow scope of protection." *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772*, 396 F.3d 1369, 1373-74, 73 USPQ2d 1689, 1693 (Fed. Cir. 2005); *see also* TMEP §1207.01(d)(iii). Applicant submits that, in this case, third party registration and use of marks that either consist of or substantially comprise "NEO" in connection with educational services, including medical-related educational services that are highly similar to the registered services, show that Nurses Educational Opportunities' mark is weak and entitled to a narrow scope of protection vis-à-vis the registered services.

The USPTO's register of trademarks shows substantial third party registration and use of such marks. In particular, Applicant respectfully draws the Examining Attorney's attention to U.S. Registration No. 5353016 filed May 4, 2016 for the mark NEO FERTILITY owned by Dr. Philip Boyle (*Boyle*) which, relevantly, covers "training and educational services, namely classes and seminars relating to medical and healthcare services relating to fertility ..." in Class 41. Applicant notes from the USPTO's record for Boyle's registration that the mark NEO FERTILITY substantively consists of "NEO" along with the descriptive term "FERTILITY" (which has been disclaimed), and the registration was not blocked by Nurses Educational Opportunities' prior registration.

Applicant submits with this Response to Office Action, as evidence for the Examining Attorney's consideration, a copy of the USPTO record for Boyle's registration.

Applicant also respectfully draws the Examining Attorney's attention to the following registration and allowed applications owned by NeoGenomics Laboratories, Inc. (*NeoGenomics*):

- U.S. Registration No. 5008433 filed September 24, 2013 for the mark NEOLINK which, relevantly, covers "[e]ducational services, namely, providing on-line training courses and seminars in the fields of scientific testing and research services ..." in Class 41.
- U.S. Application No. 86629250 filed May 14, 2015 for the mark NEOUNIVERSITY which has been allowed and, relevantly, covers "[e]ducation services, namely, providing training and on-demand on-line training in the form of courses, seminars and workshops ... [and] providing non-downloadable webinars in the fields of pathology, medical testing, medical tests, diagnostic testing, oncology testing, human disease and human medical conditions" in Class 41.
- U.S. Application No. 87158590 filed September 1, 2016 for the mark NEOINTELLI which has been allowed and, relevantly, covers "[e]ducational services, namely, providing on-line training courses and seminars in the fields of scientific testing and research services ..." in Class 41.
- U.S. Application No. 87158485 filed September 1, 2016 for the mark NEOSMARTFLOW which has been allowed and, relevantly, covers "[e]ducational services, namely, providing on-line training courses and seminars in the field of scientific testing and research services, human disease, human medical conditions, medical diagnostic testing services, medical research services, clinical scientific testing, and medical testing" in Class 41.

Applicant notes that each of NeoGenomics' marks substantively consists of "NEO" along with one or two descriptive, highly suggestive, or suggestive terms, and that Nurses Educational Opportunities' prior registration has not blocked nor otherwise been cited against NeoGenomic's registration and applications.

Applicant submits with this Response to Office Action, as evidence for the Examining Attorney's consideration, a copy of the USPTO records for NeoGenomics' registration and applications.

Applicant further draws the Examining Attorney's attention to the following registrations and applications:

- U.S. Registration No. 4824877 filed May 14, 2014 for the mark NEO TECHNOLOGY owned by Neo4J, Inc. (*Neo*) which, relevantly, covers "[e]ducational services, namely conducting classes, certification training, workshops, tutorial sessions, and online classes in the fields of designing computer databases and updating maintenance of data in computer databases ..." in Class 41. Applicant notes from the USPTO record for Neo's registration that "TECHNOLOGY" has been disclaimed.
- U.S. Registration No. 4311487 filed November 8, 2011 for the mark NEO-HOMESTEADING owned by NeueSystems, Inc. which, relevantly, covers "[e]ducational services, namely, provided an educational blog in the field of sustainable home grown organic foods" in Class 41.
- U.S. Application No. 87225824 filed November 3, 2016 for the mark NEOTRENDS owned by Integrated Management Associates, Inc. which has been allowed and, relevantly, covers "educational services, namely, providing online instruction in the field of self-help, philosophy and politics ..." in Class 41.
- U.S. Registration No. 3603500 filed September 13, 2007 for the mark NEO-SAGE owned by Neo-Sage, Inc. which, relevantly, covers "[e]ducational services, namely, conducting seminars and workshops on effective skills and techniques for personal, sales and customer service communications" in Class 41.
- U.S. Registration No. 4889382 filed June 17, 2015 for the mark THE NEO-FUTURISTS owned by The Neo-Futurists which has been allowed and, relevantly, covers "[e]ducational services, namely, conducting classes, seminars, conferences and workshops in the field of theater" in Class 41.

Applicant notes that each of the above marks substantively consists of "NEO" along with a descriptive, highly suggestive or suggestive term, and that Nurses Educational Opportunities' prior registration has not blocked nor otherwise been cited against any of the above registrations or applications.

Applicant submits with this Response to Office Action, as evidence for the Examining Attorney's consideration, a copy of the USPTO records for the above registrations and applications.

3. Lack of relatedness of the parties' services

Applicant agrees with the Examining Attorney that the relatedness of the goods or services as described in the application and registration is a key consideration in any likelihood of confusion determination. *See, e.g., Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 1103, 192 USPQ 24, 29 (C.C.P.A. 1976) ; *In re Iolo Techs., LLC*, 95 USPQ2d 1498, 1499 (TTAB 2010); *In re Max Capital Grp. Ltd.*, 93 USPQ2d 1243, 1244 (TTAB 2010) ; *In re Thor Tech, Inc.*, 90 USPQ2d 1634, 1635 (TTAB 2009); *see also* TMEP §1207.01.

The question of relatedness is based and ultimately turns on whether consumers are likely to believe that the relevant goods or services emanate from a single source. *See* TMEP §1207.01(a)(vi). In other words, the question is whether the goods or services are related in some manner or that the conditions surrounding their marketing are such that they are likely to be encountered by the same persons under circumstances that, because of the marks used in connection therewith, would lead to the mistaken belief that they originate from the same source. *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1369, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012) (quoting *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1724 (TTAB 2007)); *see also* TMEP §1207.01(a)(i).

If goods or services are not related or marketed in such a way that they would be encountered by the same persons in situations that would create the incorrect assumption that they originate from the same source, then, even if the marks are identical, confusion is not likely. *See, e.g., Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1371, 101 USPQ2d 1713, 1723 (Fed. Cir. 2012); *Shen Mfg. Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 1244-45, 73 USPQ2d 1350, 1356 (Fed. Cir. 2004) (reversing TTAB's holding that use of RITZ for cooking and wine selection classes and RITZ for kitchen textiles is likely to cause confusion, because the relatedness of the respective goods and services was not supported by substantial evidence); *In re Thor Tech, Inc.*, 113 USPQ2d 1546, 1551 (TTAB 2015) (finding use of identical marks for towable trailers and trucks not likely to cause confusion given the difference in the nature of the goods and their channels of trade and the high degree of consumer care likely to be exercised by the relevant consumers); *Local Trademarks, Inc. v. Handy Boys Inc.*, 16 USPQ2d 1156, 1158 (TTAB 1990) (finding liquid drain opener and advertising services in the plumbing field to be such different goods and services that confusion as to their source is unlikely even if they are offered under the same marks); *Quartz Radiation Corp. v. Comm/Scope Co.*, 1 USPQ2d 1668, 1669 (TTAB 1986) (holding QR for coaxial cable and QR for various apparatus used in connection with photocopying, drafting, and blueprint machines not likely to cause confusion because of the differences between the parties' respective goods in terms of their nature and purpose, how they are promoted, and who they are purchased by); *see also* TMEP §1207.01(a)(i).

For the following reasons, Applicant submits that in the present case the parties' services are not so related, nor are the conditions surrounding their marketing otherwise such, that they would be encountered by the same persons in situations that would create the mistaken belief that the services originate from the same source. Accordingly, notwithstanding any similarities between the marks, and even if the Examining Attorney were to take the position that the marks are identical or substantially identical, there is no likelihood of confusion.

The Examining Attorney must provide evidence showing that the goods and services are related to support a finding of likelihood of confusion. *See, e.g., In re White Rock Distilleries Inc.*, 92 USPQ2d 1282, 1285 (TTAB 2009) (finding Office had failed to establish that wine and vodka infused with caffeine are related goods because there was no evidence that vodka and wine emanate from a single source under a single mark or that such goods are complementary products that would be bought and used together). Applicant respectfully notes that, here, the Examining Attorney has provided no such evidence, including any evidence showing that the parties' respective services are used together or by the same purchasers, advertised together, or sold by the same dealers.

The Examining Attorney, in the Office Action, observes that Nurses Educational Opportunities' registration covers certain types of "educational services" (namely, medical education courses for healthcare professionals) and Applicant has sought to register its mark in relation to certain other distinct types of "educational services" (namely, English and foreign language instruction services). Other than this observation that each party's services broadly fall into the category of "educational services", there is nothing on the record to show that consumers would consider that the registrants' medical education courses for healthcare professionals, on one hand, and applicant's foreign language instruction services, on the other, emanate from the same source.

In response to the Examining Attorney's observation that the parties' services broadly fall into the category of "educational services", Applicant respectfully refers to the decision of the U.S. District Court for the Southern District of New York in *Mejia & Assocs. v. IBM Corp.*, 920 F. Supp. 540 (S.D.N.Y. 1996) (*Mejia v IBM*). In *Mejia v IBM*, the Court granted the defendant's motion for summary dismissal of a trademark infringement complaint on the basis that there was no likelihood of confusion. Finding that that the plaintiff failed to provide sufficient evidence of similarity of the parties' services, the Court observed (at 548):

To escape the seemingly obvious conclusion that the bulk of plaintiff's services are not competitive with defendant's, Mejia contends that both are in the same general class of "educational services." ... However, this type of classification is so broad as to be meaningless for purposes of determining that the products are proximate. The Court in W.W.W. Pharmaceutical resisted the conclusion that lip balm and deodorant were competitive or served the same purpose even though "they may both be generally defined as personal care products." 984 F.2d at 573.

Likewise, in Lang, the Court found that defendant's magazine that catered to older adults and plaintiff's publishing house were not rendered proximate products because they were both "in the field of publishing." 949 F.2d at 582. By increasing the level of generality, any products can be made to appear to fall in the same class. Aspirin and easy chairs could be characterized as "comfort products." Jet planes and roller blades could be characterized as transportation products. Such semantic exercises simply are not helpful in assessing likelihood of confusion.

Applicant likewise respectfully submits that, here, a contention that the parties' services are both in the same general class of "educational services" is too broad a classification to provide meaningful evidence of relatedness for the purposes of likelihood of confusion. Even if medical education courses and foreign language instruction can both be generally defined as "educational services", that does not show that they are competitive, serve the same purpose, or that consumers would otherwise consider that they emanate from the same source.

Applicant also respectfully refers the Examining Attorney to the Trademark Trial and Appeal Board (**TTAB**) decision in *In re Bright House Networks LLC*, Serial No. 76663959 (TTAB 2008) (***In re Bright House***). There the Board determined that an application to register BRIGHT KIDS NETWORK for "educational services in the nature of providing after-school programs for children and young adults featuring seminars, workshops and meetings" in Class 41 was not likely to cause confusion with the previously registered mark THE BRIGHT KIDS RESOURCE, INC. for "education services, namely, providing to parents of bright and highly able children intellectually stimulating resources, activities, seminars, and workshops in the field of parenting."

In making its determination, the TTAB found that, notwithstanding the similarities between the parties' respective educational services, "the ultimate recipients... are certainly different" and there was "no evidence to suggest that consumers would believe that the two services would be rendered by the same entity." The Board observed that, while it agreed with the Examining Attorney that there was "some relationship between the services":

[T]he services ..., albeit falling under the umbrella of educational services are ... different in that [applicant's] educational services are for children and registrant's services are aimed at parents of highly able children."

Applicant submits with this Response to Office Action, as evidence for the Examining Attorney's consideration, a copy of *In re Bright House*.

Applicant likewise submits that, in this case, which deals with two sets of services that are highly dissimilar (certainly substantially more dissimilar than the services dealt with in *In re Bright House*), the ultimate recipients of each set of services are different. As Nurses Educational Opportunities' registration provides, its medical education courses, classes, seminars, conferences, and workshops are rendered to "healthcare professionals, doctors, respiratory therapists and nurses" working in the field of healthcare. This is an entirely different consumer group to purchasers and prospective purchasers of Applicant's language instruction services.

Further, Applicant draws the Examining Attorney's attention to the TTAB decision *In re NeoPhotonics Corporation, Inc.*, Serial No. 78331853 (TTAB 2017) (***In re NeoPhotonics***), which dealt with circumstances that are highly analogous to those in the present case. There, the TTAB determined that the applied for mark "NEO" which the applicant sought to register for "optical network components, namely, lasers, detectors, cables, resonators, connectors, filters, phase-shifters, and splitters, all for use in communications networks" in Class 9 was not likely to cause confusion with the previously registered mark "NEO" for the following goods:

television, video and audio signal processing, switching and generating synchronizers, audio delays, audio embedders/deembedders, audio processors, logo generators and inserters, syncgenerators and inserters, time code generators and inserters, video and audio distribution and processing amplifiers, analog to digital converters, digital to analog converters, color encoders and decoders, clock system drivers, clock displays, automation system comprising computer hardware and software for controlling, monitoring, adjusting, optimizing or operating the aforesaid goods, and broadcast facilities; video and audio noise reducers, video and audio compression systems, namely[,] computer software, hardware and multi-rate coder-decoders, codecs, for decreasing audio, video,

television, or data file size or transmission bandwidth and decoding or decompressing compressed content to substantially restore the original audio, video, television or data content; test and reference generators, format converters, converters of standard television and video signals to and from high definition formats, aspect ratio converters, closed caption and other ancillary data processing equipment, namely, computer hardware, software, and electronic equipment for the insertion, deletion, and/or modification of ancillary data associated with video, audio, or television content; multiplexers, embedders, deembedders and demultiplexers, routers, switchers and switching routers, equipment enclosures, remote control panels, and computer software for controlling and monitoring the aforesaid goods, all for industrial use.

The TTAB indicated that, in making its determination, a "key consideration" was "the cumulative effect of differences in the essential characteristics of the goods and differences in the marks." Having observed that the marks were "essentially identical", the Board focused its inquiry on "the similarity or dissimilarity of the respective goods and of the related factors of established, likely-to-continue trade channels and the conditions under which and buyers to whom sales are made." It further observed:

When the marks at issue are identical but the respective goods seem distinctly different, it is incumbent on [the] Examining Attorney ... to present evidence showing that there is at least a viable commercial relationship between the respective goods to establish that contemporaneous use of the marks at issue would be likely to cause confusion. In re Opus One, Inc., 60 USPQ2d 1812, 1815 (TTAB 2001).

Noting the lack of any evidence to the contrary from the Examining Attorney, the TTAB accepted the applicant's arguments that the nature of the parties' products was "distinct" and they did not compete including because the registrants' products were generally used in the production of programming, whereas the applicant's goods were generally used in communications networks. The Board also agreed with the applicant's arguments that "in light of the differences apparent from the goods on their face, and the lack of any evidence to the contrary from the Examining Attorney, the respective goods would be marketed and sold in different channels of trade to different consumers" (namely, "specialty distributors" for their respective markets). Further, the Board agreed that "the actual and prospective purchasers for the respective goods are dissimilar." On those bases, the TTAB held that the Examining Attorney had "misunderstood the nature of the respective goods and their respective uses".

Applicant submits with this Response to Office Action, as evidence for the Examining Attorney's consideration, a copy of *In re NeoPhotonics*.

Applicant respectfully submits that, notwithstanding that *In re NeoPhotonics* is a non-precedential decision, it is so highly analogous to the present case that the Examining Attorney should be guided by the Board's approach there. Moreover, the general principles referred to in the decision are equally applicable in this case - in particular, the requirement that there be "at least a viable commercial relationship" between the respective goods or services where they are distinctly different (which they are here). Applicant respectfully submits that, other than observing that each party's services broadly fall into the category of "educational services", the Examining Attorney has not made any comments or provided any evidence to suggest that there is any commercial relationship between them - let alone a viable commercial relationship. In those circumstances, and in light of the differences between the services on their face, Applicant respectfully submits that there is a distinct lack of relatedness.

4. Dissimilarity of the parties' trade channels

Applicant agrees with the Examining Attorney that the parties' respective trade channels is one of the most relevant factors for the likelihood of confusion determination in this case. The similarity or dissimilarity of established, likely-to-continue trade channels may be relevant in an *ex parte* likelihood of confusion determination and must be considered if there is pertinent evidence in the record. *See, e.g., du Pont*, 476 F.2d at 1362-63, 177 USPQ at 568-69; *In re Thor Tech, Inc.*, 113 USPQ2d 1546 (TTAB 2015); *In re Davey Prods. Pty*

Ltd., 92 USPQ2d 1198, 1203-04 (TTAB 2009) ; *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266, 1272-74 (TTAB 2009) ; *Ass'n of the U.S. Army*, 85 USPQ2d at 1271-73; *see also* TMEP §1207.01.

However, while the Examining Attorney has asserted that "*similarity*" of the parties' trade channels is one of the most important factors for her determination of likelihood of confusion, Applicant respectfully notes that she has not provided any evidence to support her assertion of similarity, nor made any other comments on that point. Applicant respectfully submits that this mirrors the circumstances in *In re NeoPhotonics* where the Examining Attorney did not provide evidence to show that the parties' respective goods were marketed and sold in the same or similar channels to the same or similar consumers. There, in the absence of such evidence, the TTAB accepted the applicant's submissions that the goods were distinct and, in light of the differences between them on their face, they were marketed and sold in different channels to different consumers.

As Applicant argues above, the circumstances of the present case also mirror those in *In re Bright House*, where the TTAB found that, notwithstanding the similarities between the parties' respective educational services - which both involved provision of seminars and workshops relating to children - the ultimate recipients of those services were different in that one set of services was provided to children and the other set was provided to parents. Applicant respectfully submits that, here, the ultimate recipients of the parties' services are also different - and infinitely more so than the child and parent recipients in *In re Bright House*. Nurses Educational Opportunities' registration makes clear that its medical education courses, classes, seminars, conferences, and workshops are rendered to "healthcare professionals, doctors, respiratory therapists and nurses" working in the field of healthcare, which involves entirely different channels and consumers to those for Applicant's language instruction services.

5. *Conditions under which, and buyers to whom, sales are made*

The conditions under which, and buyers to whom, sales are made (ie, "impulse" vs. careful, sophisticated purchasing) may be relevant in an *ex parte* likelihood of confusion determination and must be considered if there is pertinent evidence in the record. *See, e.g., du Pont*, 476 F.2d at 1362-63, 177 USPQ at 568-69; *In re Thor Tech, Inc.*, 113 USPQ2d 1546 (TTAB 2015) ; *In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1203-04 (TTAB 2009) ; *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266, 1272-74 (TTAB 2009) ; *Ass'n of the U.S. Army*, 85 USPQ2d at 1271-73; *see also* TMEP §1207.01.

Circumstances suggesting care in purchasing may tend to minimize the likelihood of confusion. *See, e.g., In re N.A.D., Inc.*, 754 F.2d 996, 999-1000, 224 USPQ 969, 971 (Fed. Cir. 1985) (concluding that, because only sophisticated purchasers exercising great care would purchase the relevant goods, there would be no likelihood of confusion merely because of the similarity between the marks NARCO and NARKOMED); *Primrose Ret. Cmty., LLC v. Edward Rose Senior Living, LLC*, 122 USPQ2d 1030, 1039 (TTAB 2016) (finding that, "even in the case of the least sophisticated purchaser, a decision as important as choosing a senior living community will be made with some thought and research, even when made hastily"); *In re Homeland Vinyl Prods., Inc.*, 81 USPQ2d 1378, 1380, 1383 (TTAB 2006); *see also* TMEP 1207.01(d)(vii).

In a recent decision, *In re Cummings*, Serial No. 86566593 (TTAB 2017) (*In re Cummings*), concerning an application to register a mark for certain "educational services" in Class 41, the TTAB observed (at page 10):

... [W]e can assume that consumers are likely to exercise some degree of care in selecting educational services. We therefore deem this *du Pont* factor as ... weighing against a likelihood of confusion.

Applicant submits with this Response to Office Action, as evidence for the Examining Attorney's consideration, a copy of *In re Cummings*.

Applicant likewise submits that, in this case, consumers are likely to exercise care in selecting the parties' respective educational services, and that this factor should therefore weigh against a likelihood of confusion. Applicant also submits that the particular nature of the parties' respective educational services is such that consumers of those services are likely to exercise even more care in selecting them as compared with other types of educational services. They are not ordinary consumer items that require the exercise only of ordinary care in their procurement, but rather specialized services that are bought by highly knowledgeable, discriminating, and sophisticated purchasers after deliberation rather than on impulse. *Electronic Design & Sales Inc. v. Electronic Data Systems Corp.*, 954 F.2d 713, 21 USPQ2d 1388, 1392 (Fed. Cir. 1992).

Nurses Educational Opportunities' continuing medical education courses in particular, 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. Given the importance of these services for ensuring that such professionals have the knowledge and skills they need to provide human medical care, including knowledge and skills required to preserve human life, they are of a most serious and critical nature. Applicant therefore submits that such professionals are likely to be highly discriminating and sophisticated in their selection of such services. Consumers of Applicant's English and foreign language instruction services are also likely to be discriminating in their selection of such services - though, of course, for different reasons. Among other things, persons wanting to learn a new language, whether for professional, personal, or even academic interest reasons, all have an interest in making sure they will receive accurate language instruction. Like other educational services, language instruction also often involves considerable financial investment, another factor indicating that consumers exercise considerable care and thought in the selection process.

In view of all of the circumstances discussed above, Applicant respectfully requests that the Examining Attorney withdraw her refusal based on likelihood of confusion with the mark in Nurses Educational Opportunities' registration. Applicant submits that use of the parties marks in relation to their respective services is not likely to cause confusion - notwithstanding any similarities between the marks. Rather, the differences between the marks, the registration and use of similar marks by third parties, the lack of relatedness of the parties' services, the dissimilarity of the parties' trade channels, and the conditions under which sales of the services are made, are all such that it is highly *unlikely* that consumers would consider the parties' services to emanate from the same source.

Unsigned Application

The Examining Attorney has required that Applicant submit a signed verification for the Application in the form of an affidavit or signed declaration under 37 C.F.R. §2.20..

Pursuant to the Examining Attorney's requirement, Applicant, through its Attorney, submits with this Response to Office Action, a signed declaration verifying the Application.

Identification of Services

The Examining Attorney has required that Applicant amend the Class 41 identification of services for the Application. Applicant thanks the Examining Attorney for her suggested amendment.

Pursuant to the Examining Attorney's requirement, Applicant, through its Attorney, hereby requests that the identification of services in the Application be amended to read as follows:

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/or~~ schools specializing in English and foreign languages

Conclusion

In view of the foregoing, Applicant, through its Attorney, submits that the Application is in condition for allowance, and requests that it be promptly passed for publication.

Respectfully submitted,

D. Benecke

Date: May 14, 2018

Danielle Benecke

Associate

BAKER & MCKENZIE LLP

(650) 251-5927

danielle.benecke@bakermckenzie.com

A member in good standing of The State Bar of California (#314896)

Associate to David J. Davis, Attorney of Record



Dictionary.com (<http://www.dictionary.com/>)

Thesaurus.com (<http://www.thesaurus.com/>)



(<http://www.dictionary.com/>)

theday/)

definitions

NEO



NEO

Examples Word Origin

- 1. near-earth object.

neo-

- 1. a combining form meaning "new," "recent," "revived," "modified," used in the formation of compound words: *neo-Darwinism; Neolithic; neoorthodoxy; neophyte.*
- 2. *Chemistry.* a combining form used in the names of isomers having a carbon atom attached to four carbon atoms: *neorsphenamine.*

Also, especially before a vowel, **ne-** (<http://www.dictionary.com/browse/ne->).

Origin of neo-

< Greek, combining form of *néos*; akin to new (<http://www.dictionary.com/browse/new>)

Dictionary.com Unabridged
Based on the Random House Dictionary, © Random House, Inc. 2018.
Cite This Source

Examples from the Web for NEO

Contemporary Examples

Now she just wants the *NEO* homeless to get back under a roof before they become acclimated to destitution.

- A Dickensian Christmas For Greece's New Poor (<http://www.thedailybeast.com/articles/2013/12/22/a-dickensian-christmas-for-greece-s-new-poor.html?source=dictionary>)
Barbie Latza Nadeau (<http://www.thedailybeast.com/contributors/barbie-latza-nadeau.html?source=dictionary>)

Others Are Reading

(<http://www.dictionary.com/e/>)



We asked kids about popular idioms...their responses were priceless.

After her husband died, her words changed forever. This is why her words matter.

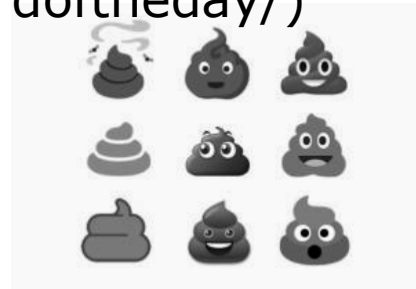
(<http://www.dictionary.com/e/words-vs-first-graders/?param=DcomSERP-RR1>)

(<http://www.dictionary.com/e/words-of-a-widow-video/?param=DcomSERP-RR2>)



Word of the Day

pococurante (<http://www.dictionary.com/wordoftheday/>)



Well, poop. The dictionary has emoji!

(<http://www.dictionary.com/e/emoji/?param=DcomSERP-RR3>)

Extra Cozy Words We Need Right Now (<http://www.dictionary.com/e/s/cozy-words-we-need-right-now>)

December 22, 2013

No word yet if her on-again-off-again boyfriend, Justin Bieber (who is also an *NEO* ambassador) will be at the show as well.

[Anna Wintour's Boyfriend in Hot Water with IRS, Juicy Couture Founders Ink Book Deal](http://www.thedailybeast.com/articles/2013/01/29/anna-wintour-s-boyfriend-in-hot-water-with-irs-juicy-couture-founders-ink-book-deal.html?source=dictionary)

(<http://www.thedailybeast.com/articles/2013/01/29/anna-wintour-s-boyfriend-in-hot-water-with-irs-juicy-couture-founders-ink-book-deal.html?source=dictionary>)

The Fashion Beast Team

(<http://www.thedailybeast.com/contributors/the-fashion-beast->

British Dictionary definitions for NEO

neo-

combining form

1. (**sometimes capital**) new, recent, or a new or modern form or development: *neoclassicism, neocolonialism*
2. (**usually capital**) the most recent subdivision of a geological period: *Neogene*

Word Origin

from Greek *neos* new

Collins English Dictionary - Complete & Unabridged 2012 Digital Edition
 © William Collins Sons & Co. Ltd. 1979, 1986 © HarperCollins Publishers 1998, 2000, 2003, 2005, 2006, 2007, 2009, 2012
 Cite This Source

Contemporary definitions for NEO

noun

See near-Earth object (/browse/near-earth-object)

Dictionary.com's 21st Century Lexicon
 Copyright © 2003-2014 Dictionary.com, LLC
 Cite This Source

Word Origin and History for NEO

neo-



Nearby words for neo

- nemunus (<http://www.dictionary.com/browse/nemunus>)
- nen (<http://www.dictionary.com/browse/nen>)
- nene (<http://www.dictionary.com/browse/nene>)
- nenets (<http://www.dictionary.com/browse/nenets>)
- nenni (<http://www.dictionary.com/browse/nenni>)

neo

(<http://www.dictionary.com/browse/neo>)

- neo- (<http://www.dictionary.com/browse/neo->)
- neo-catholic (<http://www.dictionary.com/browse/neo-catholic>)
- neo-christianity (<http://www.dictionary.com/browse/neo-christianity>)
- neo-classical (<http://www.dictionary.com/browse/neo-classical>)
- neo-communism (<http://www.dictionary.com/browse/neo-communism>)

Difficulty index for NEO

Some English speakers likely know this word

Word Value for NEO

0 0

Scrabble

Words With Friends



Extra Cozy Words We Need Right Now (<http://www.dictionary.com/cozy-words-coid-601>)

word-forming element meaning "new, recent," used in a seemingly endless number of adjectives and nouns, mostly coined since c.1880, from Greek *neo-*, comb. form of *neos* "new, young, youthful; fresh, strange; lately, just now," from PIE root **newo-* (see *new* (/browse/new)).

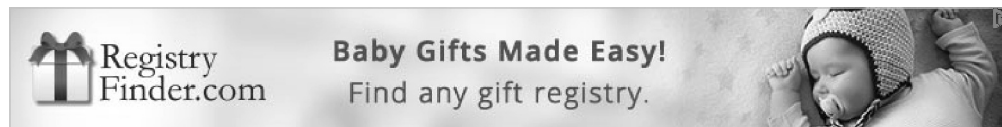
Online Etymology Dictionary, © 2010 Douglas Harper
Cite This Source

NEO in Medicine

neo- *pref.*

1. New; recent: *neonatal*.
2. New and different: *Neo-Freudian*.
3. New and abnormal: *neoplasm*.

The American Heritage® Stedman's Medical Dictionary
Copyright © 2002, 2001, 1995 by Houghton Mifflin Company. Published by
Houghton Mifflin Company.
Cite This Source



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Generated on: This page was generated by TSDR on 2018-05-14 14:33:47 EDT

Mark: NEO FERTILITY



US Serial Number: 87024546

Application Filing Date: May 04, 2016

US Registration Number: 5353016

Registration Date: Dec. 12, 2017

Filed as TEAS RF: Yes

Currently TEAS RF: Yes

Register: Principal

Mark Type: Trademark, Service Mark

Status: Registered. The registration date is used to determine when post-registration maintenance documents are due.

Status Date: Dec. 12, 2017

Publication Date: Jun. 27, 2017

Mark Information

Mark Literal Elements: NEO FERTILITY

Standard Character Claim: No

Mark Drawing Type: 3 - AN ILLUSTRATION DRAWING WHICH INCLUDES WORD(S)/ LETTER(S)/NUMBER(S)

Description of Mark: The mark consists of the word "neo" within an oval that is formed by four arcs separated by gaps and the word "fertility" to the right of the oval, a left arc is red, an upper right arc is blue, a lower arc and an upper left arc are green and the words are in grey.

Color Drawing: Yes

Color(s) Claimed: The color(s) red, green, blue and grey is/are claimed as a feature of the mark.

Disclaimer: "FERTILITY"

Design Search Code(s): 26.01.03 - Circles, incomplete (more than semi-circles); Incomplete circles (more than semi-circles)
26.01.05 - Circles made of broken or dotted lines

Foreign Information

Priority Claimed: Yes

Foreign Application Number: 015394869

Foreign Application Filing Date: Apr. 29, 2016

Foreign Registration Number: 015394869

Foreign Registration Date: Sep. 29, 2016

Foreign Application/Registration Country: EUROPEAN UNION

Foreign Expiration Date: Apr. 29, 2026

Goods and Services

Note: The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis ((.)) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- Asterisks *..* identify additional (new) wording in the goods/services.

For: computer software for use in tracking a patient's fertility cycles; downloadable computer software accessible via the internet and wireless devices enabling the recording and examination of information relating to a patient's fertility and infertility

International Class(es): 009 - Primary Class

U.S Class(es): 021, 023, 026, 036, 038

Class Status: ACTIVE

Basis: 44(e)

For: Printed matter, namely, daily planners and charts for the purposes of recording and examining information relating to personal fertility and infertility; printed instructional and educational material relating to medical services and healthcare services relating to fertility and infertility; printed instructional and educational material relating to fertility, infertility and pregnancy; printed instructional and educational material relating to gynaecology

International Class(es): 016 - Primary Class

U.S Class(es): 002, 005, 022, 023, 029, 037, 038, 050

Class Status: ACTIVE

Basis: 44(e)

For: training and educational services, namely, classes and seminars relating to medical and healthcare services relating to fertility, infertility and pregnancy; training and educational services, namely, classes and seminars relating to gynaecology

International Class(es): 041 - Primary Class

U.S Class(es): 100, 101, 107

Class Status: ACTIVE

Basis: 44(e)

For: providing on-line non-downloadable software for use in tracking a patient's fertility cycles

International Class(es): 042 - Primary Class

U.S Class(es): 100, 101

Class Status: ACTIVE

Basis: 44(e)

For: medical services and healthcare services related to fertility, infertility and pregnancy; medical services and healthcare services for women and couples related to fertility, infertility and pregnancy; gynaecological services for women

International Class(es): 044 - Primary Class

U.S Class(es): 100, 101

Class Status: ACTIVE

Basis: 44(e)

Basis Information (Case Level)

Filed Use: No

Currently Use: No

Amended Use: No

Filed ITU: Yes

Currently ITU: No

Amended ITU: No

Filed 44D: Yes

Currently 44D: No

Amended 44D: No

Filed 44E: No

Currently 44E: Yes

Amended 44E: No

Filed 66A: No

Currently 66A: No

Filed No Basis: No

Currently No Basis: No

Current Owner(s) Information

Owner Name: Boyle, Dr. Philip

Owner Address: Suite 7, Beacon Mall
Sandyford
Dublin 18
IRELAND

Legal Entity Type: INDIVIDUAL

Citizenship: IRELAND

Attorney/Correspondence Information

Attorney of Record

Attorney Name: Carl M Davis II

Docket Number: 2170472-23

Attorney Primary Email Address: trademarks@bakerdonelson.com

Attorney Email Authorized: Yes

Correspondent

Correspondent Name/Address: CARL M DAVIS II
BAKER DONELSON
3414 PEACHTREE ROAD NE STE 1600
ATLANTA, GEORGIA 30326

UNITED STATES

Phone: 404.577.6000

Fax: 404.221.6501

Correspondent e-mail: trademarks@bakerdonelson.com

Correspondent e-mail Authorized: Yes

Domestic Representative

Domestic Representative Name: Carl M. Davis II

Phone: 404.577.6000

Fax: 404.221.6501

Domestic Representative e-mail: trademarks@bakerdonelson.com

Domestic Representative e-mail Authorized: No

Prosecution History

Date	Description	Proceeding Number
Dec. 12, 2017	REGISTERED-PRINCIPAL REGISTER	
Nov. 09, 2017	1(B) BASIS DELETED; PROCEED TO REGISTRATION	74055
Oct. 20, 2017	NOTICE OF ALLOWANCE CANCELLED	74055
Oct. 30, 2017	CASE ASSIGNED TO INTENT TO USE PARALEGAL	74055
Oct. 20, 2017	TEAS DELETE 1(B) BASIS RECEIVED	
Aug. 22, 2017	NOA E-MAILED - SOU REQUIRED FROM APPLICANT	
Jun. 27, 2017	OFFICIAL GAZETTE PUBLICATION CONFIRMATION E-MAILED	
Jun. 27, 2017	PUBLISHED FOR OPPOSITION	
Jun. 07, 2017	NOTIFICATION OF NOTICE OF PUBLICATION E-MAILED	
May 23, 2017	LAW OFFICE PUBLICATION REVIEW COMPLETED	70997
May 10, 2017	APPROVED FOR PUB - PRINCIPAL REGISTER	
May 10, 2017	EXAMINER'S AMENDMENT ENTERED	70997
May 09, 2017	NOTIFICATION OF EXAMINERS AMENDMENT E-MAILED	6328
May 09, 2017	EXAMINERS AMENDMENT E-MAILED	6328
May 09, 2017	EXAMINERS AMENDMENT -WRITTEN	76725
Apr. 13, 2017	TEAS/EMAIL CORRESPONDENCE ENTERED	70997
Apr. 13, 2017	CORRESPONDENCE RECEIVED IN LAW OFFICE	70997
Apr. 10, 2017	ASSIGNED TO LIE	70997
Mar. 27, 2017	TEAS RESPONSE TO SUSPENSION INQUIRY RECEIVED	
Mar. 17, 2017	NOTIFICATION OF LETTER OF SUSPENSION E-MAILED	6332
Mar. 17, 2017	LETTER OF SUSPENSION E-MAILED	6332
Mar. 17, 2017	SUSPENSION LETTER WRITTEN	76725
Feb. 14, 2017	TEAS/EMAIL CORRESPONDENCE ENTERED	88889
Feb. 13, 2017	CORRESPONDENCE RECEIVED IN LAW OFFICE	88889
Feb. 13, 2017	TEAS RESPONSE TO OFFICE ACTION RECEIVED	
Aug. 29, 2016	NOTIFICATION OF NON-FINAL ACTION E-MAILED	6325
Aug. 29, 2016	NON-FINAL ACTION E-MAILED	6325
Aug. 29, 2016	NON-FINAL ACTION WRITTEN	76725
Aug. 19, 2016	ASSIGNED TO EXAMINER	76725
May 10, 2016	NOTICE OF DESIGN SEARCH CODE E-MAILED	
May 09, 2016	NEW APPLICATION OFFICE SUPPLIED DATA ENTERED IN TRAM	
May 07, 2016	NEW APPLICATION ENTERED IN TRAM	

TM Staff and Location Information

TM Staff Information - None

File Location

Current Location: PUBLICATION AND ISSUE SECTION

Date in Location: Dec. 12, 2017

Generated on: This page was generated by TSDR on 2018-05-14 14:34:54 EDT

Mark: NEOLINK

NeoLINK

US Serial Number: 86073550

Application Filing Date: Sep. 24, 2013

US Registration Number: 5008433

Registration Date: Jul. 26, 2016

Register: Principal

Mark Type: Service Mark

Status: Registered. The registration date is used to determine when post-registration maintenance documents are due.

Status Date: Jul. 26, 2016

Publication Date: Oct. 06, 2015

Notice of Allowance Date: Dec. 01, 2015

Mark Information

Mark Literal Elements: NEOLINK

Standard Character Claim: Yes. The mark consists of standard characters without claim to any particular font style, size, or color.

Mark Drawing Type: 4 - STANDARD CHARACTER MARK

Related Properties Information

Claimed Ownership of US Registrations: 3251678, 4177943, 4340040 and others

Goods and Services

Note: The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis (..) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- Asterisks *.* identify additional (new) wording in the goods/services.

For: Educational services, namely, providing on-line training courses and seminars in the fields of scientific testing and research services, human disease, human medical conditions, medical diagnostic testing services, medical research services, clinical scientific testing, and medical testing

International Class(es): 041 - Primary Class

U.S Class(es): 100, 101, 107

Class Status: ACTIVE

Basis: 1(a)

First Use: Aug. 28, 2013

Use in Commerce: Aug. 28, 2013

For: Providing information to others in the field of scientific testing and research services and clinical scientific testing; providing an Internet website portal featuring information in the field of scientific testing and research services, medical research services, and clinical scientific testing; providing cloud-based information to others in the field of scientific testing and research services medical research services, and clinical scientific testing

International Class(es): 042 - Primary Class

U.S Class(es): 100, 101

Class Status: ACTIVE

Basis: 1(a)

First Use: Aug. 28, 2013

Use in Commerce: Aug. 28, 2013

For: Medical diagnostic testing services in the field of human disease and human medical conditions; medical testing for diagnostic or treatment purposes; providing medical information to others in the field of human disease, human medical conditions, medical

diagnostic testing services and medical testing for diagnostic or treatment purposes; providing an Internet website portal featuring medical information in the field of human disease, and human medical conditions, medical diagnostic testing services, medical testing for diagnostic or treatment purposes, and the delivery of scientific and medical test results; providing cloud-based medical information to others in the field of human disease, human medical conditions, medical diagnostic testing services, and medical testing for diagnostic or treatment purposes

International Class(es): 044 - Primary Class

U.S Class(es): 100, 101

Class Status: ACTIVE

Basis: 1(a)

First Use: Aug. 28, 2013

Use in Commerce: Aug. 28, 2013

Basis Information (Case Level)

Filed Use: No

Currently Use: Yes

Amended Use: No

Filed ITU: Yes

Currently ITU: No

Amended ITU: No

Filed 44D: No

Currently 44D: No

Amended 44D: No

Filed 44E: No

Currently 44E: No

Amended 44E: No

Filed 66A: No

Currently 66A: No

Filed No Basis: No

Currently No Basis: No

Current Owner(s) Information

Owner Name: NeoGenomics Laboratories, Inc.

Owner Address: c/o WHITELAW LEGAL GROUP
3838 Tamiami Trail North, Suite 310
Naples, FLORIDA 34103
UNITED STATES

Legal Entity Type: CORPORATION

State or Country Where Organized: FLORIDA

Attorney/Correspondence Information

Attorney of Record

Attorney Name: Jennifer L. Whitelaw

Attorney Primary Email Address: usptomail@whitelawfirm.com

Attorney Email Authorized: Yes

Correspondent

Correspondent Name/Address: JENNIFER L WHITELAW
WHITELAW LEGAL GROUP
3838 TAMIAMMI TRL N STE 310
NAPLES, FLORIDA 34103-3586
UNITED STATES

Phone: 239-262-1001

Fax: 239-261-0057

Correspondent e-mail: usptomail@whitelawfirm.com

Correspondent e-mail Authorized: Yes

Domestic Representative - Not Found

Prosecution History

Date	Description	Proceeding Number
Jan. 11, 2017	ASSIGNMENT OF OWNERSHIP NOT UPDATED AUTOMATICALLY	
Jul. 26, 2016	REGISTERED-PRINCIPAL REGISTER	
Jun. 21, 2016	NOTICE OF ACCEPTANCE OF STATEMENT OF USE E-MAILED	
Jun. 20, 2016	ALLOWED PRINCIPAL REGISTER - SOU ACCEPTED	
Jun. 19, 2016	STATEMENT OF USE PROCESSING COMPLETE	66303
May 26, 2016	USE AMENDMENT FILED	66303
Jun. 19, 2016	CASE ASSIGNED TO INTENT TO USE PARALEGAL	66303
May 26, 2016	TEAS STATEMENT OF USE RECEIVED	
Dec. 01, 2015	NOA E-MAILED - SOU REQUIRED FROM APPLICANT	

Oct. 06, 2015	OFFICIAL GAZETTE PUBLICATION CONFIRMATION E-MAILED	
Oct. 06, 2015	PUBLISHED FOR OPPOSITION	
Sep. 16, 2015	NOTIFICATION OF NOTICE OF PUBLICATION E-MAILED	
Aug. 31, 2015	LAW OFFICE PUBLICATION REVIEW COMPLETED	70884
Aug. 31, 2015	APPROVED FOR PUB - PRINCIPAL REGISTER	
Aug. 31, 2015	TEAS/EMAIL CORRESPONDENCE ENTERED	59554
Aug. 31, 2015	CORRESPONDENCE RECEIVED IN LAW OFFICE	59554
Aug. 25, 2015	TEAS REQUEST FOR RECONSIDERATION RECEIVED	
Aug. 25, 2015	EX PARTE APPEAL-INSTITUTED	73550
Aug. 25, 2015	JURISDICTION RESTORED TO EXAMINING ATTORNEY	73550
Aug. 25, 2015	EXPARTE APPEAL RECEIVED AT TTAB	
Aug. 21, 2015	NOTIFICATION FOR REQ FOR RECON DENIED NO APPEAL FILED	
Aug. 21, 2015	ACTION FOR REQ FOR RECON DENIED NO APPEAL FILED E-MAILED	
Aug. 21, 2015	ACTION REQ FOR RECON DENIED NO APPEAL FILED COUNTED NOT MAILED	80804
Aug. 04, 2015	TEAS/EMAIL CORRESPONDENCE ENTERED	70884
Aug. 04, 2015	CORRESPONDENCE RECEIVED IN LAW OFFICE	70884
Jul. 28, 2015	TEAS REQUEST FOR RECONSIDERATION RECEIVED	
Mar. 02, 2015	NOTIFICATION OF FINAL REFUSAL EMAILED	
Mar. 02, 2015	FINAL REFUSAL E-MAILED	
Mar. 02, 2015	FINAL REFUSAL WRITTEN	80804
Feb. 18, 2015	TEAS/EMAIL CORRESPONDENCE ENTERED	70884
Feb. 18, 2015	CORRESPONDENCE RECEIVED IN LAW OFFICE	70884
Feb. 11, 2015	TEAS RESPONSE TO SUSPENSION INQUIRY RECEIVED	
Nov. 13, 2014	REPORT COMPLETED SUSPENSION CHECK CASE STILL SUSPENDED	
Nov. 12, 2014	LIE CHECKED SUSP - TO ATTY FOR ACTION	70884
Nov. 06, 2014	ASSIGNED TO LIE	70884
Apr. 14, 2014	NOTIFICATION OF LETTER OF SUSPENSION E-MAILED	6332
Apr. 14, 2014	LETTER OF SUSPENSION E-MAILED	6332
Apr. 14, 2014	SUSPENSION LETTER WRITTEN	80804
Apr. 11, 2014	TEAS/EMAIL CORRESPONDENCE ENTERED	88889
Apr. 11, 2014	CORRESPONDENCE RECEIVED IN LAW OFFICE	88889
Apr. 11, 2014	TEAS RESPONSE TO OFFICE ACTION RECEIVED	
Oct. 15, 2013	NOTIFICATION OF NON-FINAL ACTION E-MAILED	6325
Oct. 15, 2013	NON-FINAL ACTION E-MAILED	6325
Oct. 15, 2013	NON-FINAL ACTION WRITTEN	80804
Oct. 15, 2013	ASSIGNED TO EXAMINER	80804
Oct. 03, 2013	NOTICE OF PSEUDO MARK E-MAILED	
Oct. 02, 2013	NEW APPLICATION OFFICE SUPPLIED DATA ENTERED IN TRAM	
Sep. 27, 2013	NEW APPLICATION ENTERED IN TRAM	

TM Staff and Location Information

TM Staff Information - None

File Location

Current Location: PUBLICATION AND ISSUE SECTION

Date in Location: Jun. 20, 2016

Assignment Abstract Of Title Information

Summary

Total Assignments: 5

Registrant: NeoGenomics Laboratories, Inc.

Assignment 1 of 5

Conveyance: SECURITY INTEREST

Reel/Frame: [5699/0501](#)

Pages: 10

Date Recorded: Dec. 30, 2015

Supporting Documents: [assignment-tm-5699-0501.pdf](#)

Assignor

Name: [NEOGENOMICS LABORATORIES, INC.](#) **Execution Date:** Dec. 30, 2015
Legal Entity Type: CORPORATION **State or Country Where Organized:** FLORIDA

Name: [PATH LABS, LLC](#) **Execution Date:** Dec. 30, 2015
Legal Entity Type: LIMITED LIABILITY COMPANY **State or Country Where Organized:** DELAWARE

Assignee

Name: [WELLS FARGO BANK, NATIONAL ASSOCIATION](#)
Legal Entity Type: A NATIONAL BANKING ASSOCIATION **State or Country Where Organized:** UNITED STATES
Address: 2450 COLORADO AVENUE
 SUITE 3000 WEST
 SANTA MONICA, CALIFORNIA 90404

Correspondent

Correspondent Name: LASHANA C. JIMMAR, PARALEGAL
Correspondent Address: GREENBERG TRAURIG, LLP
 3333 PIEDMONT ROAD, NE, SUITE 2500
 ATLANTA, GA 30305

Domestic Representative - Not Found**Assignment 2 of 5**

Conveyance: SECURITY INTEREST
Reel/Frame: [5701/0880](#) **Pages:** 12
Date Recorded: Jan. 05, 2016
Supporting Documents: [assignment-tm-5701-0880.pdf](#)

Assignor

Name: [NEOGENOMICS LABORATORIES, INC.](#) **Execution Date:** Dec. 30, 2015
Legal Entity Type: CORPORATION **State or Country Where Organized:** No Place Where Organized Found

Name: [NEOGENOMICS, INC.](#) **Execution Date:** Dec. 30, 2015
Legal Entity Type: CORPORATION **State or Country Where Organized:** No Place Where Organized Found

Name: [CLARIANT, INC.](#) **Execution Date:** Dec. 30, 2015
Legal Entity Type: CORPORATION **State or Country Where Organized:** No Place Where Organized Found

Name: [CLARIANT DIAGNOSTIC SERVICES, INC.](#) **Execution Date:** Dec. 30, 2015
Legal Entity Type: CORPORATION **State or Country Where Organized:** No Place Where Organized Found

Name: [PATH LABS, LLC](#) **Execution Date:** Dec. 30, 2015
Legal Entity Type: LIMITED LIABILITY COMPANY **State or Country Where Organized:** No Place Where Organized Found

Assignee

Name: [AB PRIVATE CREDIT INVESTORS LLC, AS COLLATERAL AGENT](#)
Legal Entity Type: LIMITED LIABILITY COMPANY **State or Country Where Organized:** DELAWARE
Address: 1345 AVENUE OF THE AMERICAS
 NEW YORK, NEW YORK 10105

Correspondent

Correspondent Name: JOYCE MILLER
Correspondent Address: 1750 TYSONS BLVD.
 TYSONS CORNER, VA 22102

Domestic Representative - Not Found

Assignment 3 of 5

Conveyance: NOTICE OF GRANT OF SECURITY INTEREST IN TRADEMARKS

Reel/Frame: [5950/0749](#)

Pages: 6

Date Recorded: Dec. 23, 2016

Supporting Documents: [assignment-tm-5950-0749.pdf](#)

Assignor

Name: [NEOGENOMICS LABORATORIES, INC.](#)

Execution Date: Dec. 22, 2016

Legal Entity Type: CORPORATION

State or Country Where Organized: FLORIDA

Assignee

Name: [REGIONS BANK, AS COLLATERAL AGENT](#)

Legal Entity Type: CORPORATION

State or Country Where Organized: GEORGIA

Address: 1180 WEST PEACHTREE STREET, NW
SUITE 1400
ATLANTA, GEORGIA 30309

Correspondent

Correspondent Name: MOORE & VAN ALLEN PLLC

Correspondent Address: 3015 CARRINGTON MILL BOULEVARD
SUITE 400
MORRISVILLE, NC 27560

Domestic Representative - Not Found

Assignment 4 of 5

Conveyance: RELEASE BY SECURED PARTY

Reel/Frame: [5951/0216](#)

Pages: 10

Date Recorded: Dec. 22, 2016

Supporting Documents: [assignment-tm-5951-0216.pdf](#)

Assignor

Name: [AB PRIVATE CREDIT INVESTORS LLC, AS COLLATERAL AGENT](#)

Execution Date: Dec. 22, 2016

Legal Entity Type: LIMITED LIABILITY COMPANY

State or Country Where Organized: DELAWARE

Assignee

Name: [NEOGENOMICS LABORATORIES, INC.](#)

Legal Entity Type: CORPORATION

State or Country Where Organized: FLORIDA

Address: 12701 COMMONWEALTH DRIVE
SUITE 9
FORT MYERS, FLORIDA 33913

Name: [NEOGENOMICS, INC.](#)

Legal Entity Type: CORPORATION

State or Country Where Organized: NEVADA

Address: 12701 COMMONWEALTH DRIVE
SUITE 9
FORT MYERS, FLORIDA 33913

Name: [CLARIANT, INC.](#)

Legal Entity Type: CORPORATION

State or Country Where Organized: DELAWARE

Address: 12701 COMMONWEALTH DRIVE
SUITE 9
FORT MYERS, FLORIDA 33913

Name: [CLARIANT DIAGNOSTIC SERVICES, INC.](#)

Legal Entity Type: CORPORATION

State or Country Where Organized: DELAWARE

Address: 12701 COMMONWEALTH DRIVE
SUITE 9
FORT MYERS, FLORIDA 33913

Name: [PATH LABS, LLC](#)

Legal Entity Type: LIMITED LIABILITY COMPANY

State or Country Where Organized: DELAWARE

Address: 12701 COMMONWEALTH DRIVE
SUITE 9
FORT MYERS, FLORIDA 33913

Correspondent

Correspondent Name: K&L GATES LLP

Correspondent Address: P.O. BOX 1135
CHICAGO, IL 60690-1135

Domestic Representative - Not Found

Assignment 5 of 5

Conveyance: RELEASE BY SECURED PARTY

Reel/Frame: [5951/0364](#)

Pages: 8

Date Recorded: Dec. 23, 2016

Supporting Documents: [assignment-tm-5951-0364.pdf](#)

Assignor

Name: [WELLS FARGO BANK, NATIONAL ASSOCIATION](#)

Execution Date: Dec. 22, 2016

Legal Entity Type: A NATIONAL BANKING ASSOCIATION

State or Country Where Organized: UNITED STATES

Assignee

Name: [NEOGENOMICS LABORATORIES, INC.](#)

Legal Entity Type: CORPORATION

State or Country Where Organized: FLORIDA

Address: 12701 COMMONWEALTH DRIVE
FORT MYERS, FLORIDA 33913

Name: [PATH LABS, LLC](#)

Legal Entity Type: LIMITED LIABILITY COMPANY

State or Country Where Organized: DELAWARE

Address: 12701 COMMONWEALTH DRIVE
FORT MYERS, FLORIDA 33913

Correspondent

Correspondent Name: K&L GATES LLP

Correspondent Address: P.O. BOX 1135
CHICAGO, IL 60690-1135

Domestic Representative - Not Found

Proceedings

Summary

Number of Proceedings: 4

Type of Proceeding: Opposition

Proceeding Number: [91234428](#)

Filing Date: May 08, 2017

Status: Pending

Status Date: May 08, 2017

Interlocutory Attorney: MARY B MYLES

Defendant

Name: Michele Angela Patterson

Correspondent MICHELE ANGELA PATTERSON
Address: 11501 NAIRN FARMHOUSE COURT
SILVER SPRING MD , 20902
UNITED STATES

Correspondent e-mail: neoang@aol.com

Associated marks

Mark	Application Status	Serial Number	Registration Number
NEOADVANTAGE	Opposition Pending	87130967	

Plaintiff(s)

Name: NeoGenomics Laboratories, Inc.

Correspondent JENNIFER L WHITELAW
Address: WHITELAW LEGAL GROUP
3838 TAMIAMI TRAIL NORTH STE 310
Naples FL , 34103
UNITED STATES

Correspondent e-mail: ttabmail@whitelawfirm.com

Associated marks

Mark	Application Status	Serial Number	Registration Number
NEOGENOMICS	Renewed	78947056	3251678
NEOGENOMICS	Registered	86315855	4975880
NEOGENOMICS LABORATORIES	Registered	86315917	4857621
NEOGENOMICS LABORATORIES	Registered	86315873	4975881
NEOGENOMICS LABORATORIES	Registered	86315897	4975882
NEOPATH	Registered	86000484	4818409
NEOSITE	Registered	85800853	4502829
NEOARRAY	Registered	85767118	4344271
NEOTYPE	Registered	85685014	4340040
NEOFISH	Registered	85323988	4177943
NEOSCORE	Registered	86000503	4983565
NEOLINK	Registered	86073550	5008433
NEOFLOW	Registered	85324005	4493222
NEOLAB	SU - Non-Final Action - Mailed	86329907	
NEOCONNECT	Abandoned - No Statement Of Use Filed	86267226	
NEOUNIVERSITY	SU - Non-Final Action - Mailed	86629250	

Prosecution History

Entry Number	History Text	Date	Due Date
1	FILED AND FEE	May 08, 2017	
2	NOTICE AND TRIAL DATES SENT; ANSWER DUE:	May 08, 2017	Jun 17, 2017
3	PENDING, INSTITUTED	May 08, 2017	
4	ANSWER	Jun 13, 2017	
5	TRIAL DATES REMAIN AS SET	Jun 27, 2017	
6	NOTICE OF DEFAULT	Jul 24, 2017	
7	ANSWER	Jul 31, 2017	
8	RESPONSE DUE	Aug 04, 2017	
9	TRIAL DATES RESET	Nov 01, 2017	
10	STIP TO SUSP PEND SETTL NEGOTIATIONS	Dec 04, 2017	
11	SUSPENDED	Dec 04, 2017	

Type of Proceeding: Opposition

Proceeding Number: [91233609](#)

Filing Date: Mar 27, 2017

Status: Terminated

Status Date: Feb 01, 2018

Interlocutory Attorney: JENNIFER KRISP

Defendant

Name: Ambry Genetics Corporation

Correspondent Address: KARI L BARNES
BUCHALTER NEMER PLC
18400 VON KARMAN AVE, 8TH FL
IRVINE CA , 92612
UNITED STATES

Correspondent e-mail: kbarnes@buchalter.com , ipdocket@buchalter.com

Associated marks

Mark	Application Status	Serial Number	Registration Number
EPIFIRST-NEONATE	Registered	87101788	5420989

Plaintiff(s)

Name: NeoGenomics Laboratories, Inc.

Correspondent Address: JENNIFER L WHITELAW
WHITELAW LEGAL GROUP
3838 TAMIAMI TRAIL N., SUITE 310
NAPLES FL , 34103
UNITED STATES

Correspondent e-mail: ttabmail@whitelawfirm.com

Associated marks

Mark	Application Status	Serial Number	Registration Number
NEOGENOMICS	Renewed	78947056	3251678
NEOGENOMICS	Registered	86315855	4975880
NEOGENOMICS LABORATORIES	Registered	86315917	4857621
NEOGENOMICS LABORATORIES	Registered	86315873	4975881
NEOGENOMICS LABORATORIES	Registered	86315897	4975882
NEOPATH	Registered	86000484	4818409
NEOSITE	Registered	85800853	4502829
NEOARRAY	Registered	85767118	4344271
NEOTYPE	Registered	85685014	4340040
NEOFISH	Registered	85323988	4177943
NEOSCORE	Registered	86000503	4983565
NEOLINK	Registered	86073550	5008433
NEOFLOW	Registered	85324005	4493222
NEOLAB	SU - Non-Final Action - Mailed	86329907	
NEOCONNECT	Abandoned - No Statement Of Use Filed	86267226	
NEOUNIVERSITY	SU - Non-Final Action - Mailed	86629250	

Prosecution History

Entry Number	History Text	Date	Due Date
1	FILED AND FEE	Mar 27, 2017	
2	NOTICE AND TRIAL DATES SENT; ANSWER DUE:	Mar 27, 2017	May 06, 2017
3	PENDING, INSTITUTED	Mar 27, 2017	
4	STIP FOR EXT	May 05, 2017	
5	EXTENSION OF TIME GRANTED	May 05, 2017	
6	STIP FOR EXT	Jun 02, 2017	
7	EXTENSION OF TIME GRANTED	Jun 02, 2017	
8	STIP FOR EXT	Jul 05, 2017	
9	EXTENSION OF TIME GRANTED	Jul 05, 2017	
10	STIP FOR EXT	Aug 04, 2017	
11	EXTENSION OF TIME GRANTED	Aug 04, 2017	
12	STIP FOR EXT	Sep 01, 2017	
13	EXTENSION OF TIME GRANTED	Sep 01, 2017	
14	STIP FOR EXT	Sep 29, 2017	

15	EXTENSION OF TIME GRANTED	Sep 29, 2017
16	STIP FOR EXT	Oct 31, 2017
17	EXTENSION OF TIME GRANTED	Oct 31, 2017
18	STIP FOR EXT	Dec 04, 2017
19	EXTENSION OF TIME GRANTED	Dec 04, 2017
20	STIP FOR EXT	Jan 03, 2018
21	EXTENSION OF TIME GRANTED	Jan 03, 2018
22	MOT TO AMEND APPLICATION	Jan 18, 2018
23	BD DECISION: DISMISSED W/O PREJ	Feb 01, 2018
24	TERMINATED	Feb 01, 2018

Type of Proceeding: Opposition

Proceeding Number: [91230856](#) **Filing Date:** Oct 18, 2016
Status: Terminated **Status Date:** Feb 02, 2018
Interlocutory Attorney: CHRISTEN M ENGLISH

Defendant

Name: Labsystems Diagnostics
Correspondent Address: DOUGLAS D CHUROVICH
POLSTER LIEDER
12412 POWERSCOURT DRIVE, SUITE 200
ST LOUIS MO , 63131
UNITED STATES
Correspondent e-mail: dchurovich@polsterlieder.com , mlucchesi@polsterlieder.com

Associated marks

Mark	Application Status	Serial Number	Registration Number
NEOMASS	Registered	79180717	5420315

Plaintiff(s)

Name: NeoGenomics Laboratories, Inc.
Correspondent Address: JENNIFER L WHITELAW
WHITELAW LEGAL GROUP
3838 TAMiami TRAIL N, SUITE 310
NAPLES FL , 34103
UNITED STATES
Correspondent e-mail: ttabmail@whitelawfirm.com

Associated marks

Mark	Application Status	Serial Number	Registration Number
NEOGENOMICS	Renewed	78947056	3251678
NEOGENOMICS	Registered	86315855	4975880
NEOGENOMICS LABORATORIES	Registered	86315917	4857621
NEOGENOMICS LABORATORIES	Registered	86315873	4975881
NEOGENOMICS LABORATORIES	Registered	86315897	4975882
NEOPATH	Registered	86000484	4818409
NEOSITE	Registered	85800853	4502829
NEOARRAY	Registered	85767118	4344271
NEOTYPE	Registered	85685014	4340040
NEOFISH	Registered	85323988	4177943
NEOSCORE	Registered	86000503	4983565
NEOLINK	Registered	86073550	5008433
NEOFLOW	Registered	85324005	4493222
NEOLAB	SU - Non-Final Action - Mailed	86329907	
NEOCONNECT	Abandoned - No Statement Of Use Filed	86267226	
NEOUNIVERSITY	SU - Non-Final Action - Mailed	86629250	

Prosecution History

Entry Number	History Text	Date	Due Date
1	FILED AND FEE	Oct 18, 2016	
2	NOTICE AND TRIAL DATES SENT; ANSWER DUE:	Oct 27, 2016	Dec 06, 2016
3	PENDING, INSTITUTED	Oct 27, 2016	
4	D APPEARANCE / POWER OF ATTORNEY	Dec 06, 2016	
5	STIP FOR EXT	Dec 06, 2016	
6	EXTENSION OF TIME GRANTED	Dec 06, 2016	
7	STIP FOR EXT	Jan 05, 2017	
8	EXTENSION OF TIME GRANTED	Jan 06, 2017	
9	STIP FOR EXT	Feb 28, 2017	
10	EXTENSION OF TIME GRANTED	Feb 28, 2017	
11	STIP FOR EXT	Apr 03, 2017	
12	EXTENSION OF TIME GRANTED	Apr 03, 2017	
13	STIP FOR EXT	Apr 27, 2017	
14	EXTENSION OF TIME GRANTED	Apr 27, 2017	
15	STIP FOR EXT	Jun 01, 2017	
16	EXTENSION OF TIME GRANTED	Jun 01, 2017	
17	STIP FOR EXT	Jun 28, 2017	
18	EXTENSION OF TIME GRANTED	Jun 28, 2017	
19	STIP TO SUSP PEND SETTL NEGOTIATIONS	Jul 25, 2017	
20	SUSPENDED	Jul 25, 2017	
21	STIP FOR EXT	Oct 20, 2017	
22	EXTENSION OF TIME GRANTED	Oct 20, 2017	
23	MOT TO AMEND APPLICATION	Dec 28, 2017	
24	MOT TO AMEND APPLICATION	Dec 29, 2017	
25	RESPONSE DUE 30 DAYS (DUE DATE)	Jan 12, 2018	Feb 11, 2018
26	W/DRAW OF OPPOSITION	Jan 31, 2018	
27	BD DECISION: DISMISSED W/ PREJ	Feb 02, 2018	
28	TERMINATED	Feb 02, 2018	

Type of Proceeding: Exparte Appeal

Proceeding Number: [86073550](#)

Filing Date: Aug 25, 2015

Status: Terminated

Status Date: Oct 28, 2015

Interlocutory Attorney:

Plaintiff(s)

Name: NeoGenomics Laboratories, Inc.

Correspondent Address: JENNIFER L WHITELAW
WHITELAW LEGAL GROUP
3838 TAMiami TRL N STE 310
NAPLES FL , 34103-3586
UNITED STATES

Correspondent e-mail: usptomail@whitelawfirm.com

Associated marks

Mark	Application Status	Serial Number	Registration Number
NEOLINK	Registered	86073550	5008433

Prosecution History

Entry Number	History Text	Date	Due Date
1	APPEAL TO BOARD	Aug 25, 2015	
2	APPEAL ACKNOWLEDGED; CASE REMANDED	Aug 25, 2015	
3	INSTITUTED	Aug 25, 2015	
4	REQ FOR RECON	Aug 25, 2015	
5	BD DECISION: DISMISSED TERMINATED	Oct 26, 2015	

Generated on: This page was generated by TSDR on 2018-05-14 14:35:55 EDT

Mark: NEOUNIVERSITY

NeoUniversity

US Serial Number: 86629250

Application Filing Date: May 14, 2015

Filed as TEAS RF: Yes

Currently TEAS RF: Yes

Register: Principal

Mark Type: Trademark, Service Mark

TM5 Common Status Descriptor:



LIVE/APPLICATION/Under Examination

The trademark application has been accepted by the Office (has met the minimum filing requirements) and that this application has been assigned to an examiner.

Status: A non-final Office Action has been sent (issued) to the applicant after review of the Statement of Use. This is a letter from the examining attorney requiring additional information and/or making an initial refusal. The applicant must respond. To view all documents in this file, click on the Trademark Document Retrieval link at the top of this page.

Status Date: Dec. 15, 2017

Publication Date: Oct. 06, 2015

Notice of Allowance Date: Dec. 01, 2015

Mark Information

Mark Literal Elements: NEOUNIVERSITY

Standard Character Claim: Yes. The mark consists of standard characters without claim to any particular font style, size, or color.

Mark Drawing Type: 4 - STANDARD CHARACTER MARK

Related Properties Information

Claimed Ownership of US Registrations: 3251678, 4177943, 4340040

Goods and Services

Note: The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis ((.)) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- Asterisks *..* identify additional (new) wording in the goods/services.

For: Downloadable webinars in the fields of pathology, medical testing, medical tests, diagnostic testing, oncology testing, human disease and human medical conditions; Downloadable electronic publications in the nature of newsletters and abstracts in the fields of pathology, medical testing, medical tests, diagnostic testing, oncology testing, human disease and human medical conditions

International Class(es): 009 - Primary Class

U.S Class(es): 021, 023, 026, 036, 038

Class Status: ACTIVE

Basis: 1(b)

First Use: Jun. 2009

Use in Commerce: Jun. 2009

For: Newsletters, publications and abstracts in the field of pathology, medical testing, medical tests, diagnostic testing, oncology testing, human disease and human medical conditions

International Class(es): 016 - Primary Class

U.S Class(es): 002, 005, 022, 023, 029, 037, 038, 050

Class Status: ACTIVE

Basis: 1(b)

First Use: Jun. 2009

Use in Commerce: Jun. 2009

For: Education services, namely, providing training and on-demand on-line training in the form of courses, seminars and workshops in the fields of pathology, medical testing, medical tests, diagnostic testing, oncology testing, human disease and human medical conditions; Education services, namely, providing non-downloadable webinars in the fields of pathology, medical testing, medical tests, diagnostic testing, oncology testing, human disease and human medical conditions

International Class(es): 041 - Primary Class

U.S Class(es): 100, 101, 107

Class Status: ACTIVE

Basis: 1(b)

First Use: Jun. 2009

Use in Commerce: Jun. 2009

Basis Information (Case Level)

Filed Use: No

Currently Use: No

Amended Use: No

Filed ITU: Yes

Currently ITU: Yes

Amended ITU: No

Filed 44D: No

Currently 44D: No

Amended 44D: No

Filed 44E: No

Currently 44E: No

Amended 44E: No

Filed 66A: No

Currently 66A: No

Filed No Basis: No

Currently No Basis: No

Current Owner(s) Information

Owner Name: NeoGenomics Laboratories, Inc.

Owner Address: c/o WHITELAW LEGAL GROUP
3838 Tamiami Trail North, Suite 310
Naples, FLORIDA UNITED STATES 34103

Legal Entity Type: CORPORATION

State or Country Where Organized: FLORIDA

Attorney/Correspondence Information

Attorney of Record

Attorney Name: Jennifer L. Whitelaw

Attorney Primary Email Address: usptomail@whitelawfirm.com

Attorney Email Authorized: Yes

Correspondent

Correspondent Name/Address: JENNIFER L. WHITELAW
Whitelaw Legal Group
3838 Tamiami Trl N Ste 310
Naples, FLORIDA UNITED STATES 34103-3586

Phone: 239-262-1001

Fax: 239-261-0057

Correspondent e-mail: usptomail@whitelawfirm.com

Correspondent e-mail Authorized: Yes

Domestic Representative - Not Found

Prosecution History

Date	Description	Proceeding Number
Dec. 15, 2017	NOTIFICATION OF NON-FINAL ACTION E-MAILED	
Dec. 15, 2017	NON-FINAL ACTION E-MAILED	
Dec. 15, 2017	SU - NON-FINAL ACTION - WRITTEN	92568
Nov. 28, 2017	NOTICE OF APPROVAL OF EXTENSION REQUEST E-MAILED	
Nov. 27, 2017	STATEMENT OF USE PROCESSING COMPLETE	71034
Nov. 21, 2017	USE AMENDMENT FILED	71034
Nov. 27, 2017	EXTENSION 4 GRANTED	71034
Nov. 21, 2017	EXTENSION 4 FILED	71034
Nov. 21, 2017	TEAS EXTENSION RECEIVED	

Nov. 21, 2017	TEAS STATEMENT OF USE RECEIVED	
Jun. 03, 2017	NOTICE OF APPROVAL OF EXTENSION REQUEST E-MAILED	
Jun. 01, 2017	EXTENSION 3 GRANTED	98765
Jun. 01, 2017	EXTENSION 3 FILED	98765
Jun. 01, 2017	TEAS EXTENSION RECEIVED	
Jan. 11, 2017	ASSIGNMENT OF OWNERSHIP NOT UPDATED AUTOMATICALLY	
Dec. 08, 2016	NOTICE OF APPROVAL OF EXTENSION REQUEST E-MAILED	
Dec. 07, 2016	EXTENSION 2 GRANTED	71034
Nov. 17, 2016	EXTENSION 2 FILED	71034
Dec. 07, 2016	CASE ASSIGNED TO INTENT TO USE PARALEGAL	71034
Nov. 17, 2016	TEAS EXTENSION RECEIVED	
May 21, 2016	NOTICE OF APPROVAL OF EXTENSION REQUEST E-MAILED	
May 19, 2016	EXTENSION 1 GRANTED	98765
May 19, 2016	EXTENSION 1 FILED	98765
May 19, 2016	TEAS EXTENSION RECEIVED	
Dec. 01, 2015	NOA E-MAILED - SOU REQUIRED FROM APPLICANT	
Oct. 06, 2015	OFFICIAL GAZETTE PUBLICATION CONFIRMATION E-MAILED	
Oct. 06, 2015	PUBLISHED FOR OPPOSITION	
Sep. 16, 2015	NOTIFICATION OF NOTICE OF PUBLICATION E-MAILED	
Aug. 28, 2015	APPROVED FOR PUB - PRINCIPAL REGISTER	
Aug. 26, 2015	ASSIGNED TO EXAMINER	92568
May 22, 2015	NOTICE OF PSEUDO MARK E-MAILED	
May 21, 2015	NEW APPLICATION OFFICE SUPPLIED DATA ENTERED IN TRAM	
May 18, 2015	NEW APPLICATION ENTERED IN TRAM	

TM Staff and Location Information

TM Staff Information

TM Attorney: MIRANDA, JOHN SALVADOR

Law Office Assigned: LAW OFFICE 120

File Location

Current Location: TMO LAW OFFICE 120 - EXAMINING ATTORNEY ASSIGNED

Date in Location: Dec. 15, 2017

Assignment Abstract Of Title Information

Summary

Total Assignments: 5

Applicant: NeoGenomics Laboratories, Inc.

Assignment 1 of 5

Conveyance: SECURITY INTEREST

Reel/Frame: [5699/0501](#)

Pages: 10

Date Recorded: Dec. 30, 2015

Supporting Documents: [assignment-tm-5699-0501.pdf](#)

Assignor

Name: [NEOGENOMICS LABORATORIES, INC.](#)

Execution Date: Dec. 30, 2015

Legal Entity Type: CORPORATION

State or Country Where Organized: FLORIDA

Name: [PATH LABS, LLC](#)

Execution Date: Dec. 30, 2015

Legal Entity Type: LIMITED LIABILITY COMPANY

State or Country Where Organized: DELAWARE

Assignee

Name: [WELLS FARGO BANK, NATIONAL ASSOCIATION](#)

Legal Entity Type: A NATIONAL BANKING ASSOCIATION

State or Country Where Organized: UNITED STATES

Address: 2450 COLORADO AVENUE

SUITE 3000 WEST
SANTA MONICA, CALIFORNIA 90404

Correspondent

Correspondent Name: LASHANA C. JIMMAR, PARALEGAL
Correspondent Address: GREENBERG TRAURIG, LLP
3333 PIEDMONT ROAD, NE, SUITE 2500
ATLANTA, GA 30305

Domestic Representative - Not Found

Assignment 2 of 5

Conveyance: SECURITY INTEREST
Reel/Frame: [5701/0880](#) **Pages:** 12
Date Recorded: Jan. 05, 2016
Supporting Documents: [assignment-tm-5701-0880.pdf](#)

Assignor

Name: [NEOGENOMICS LABORATORIES, INC.](#) **Execution Date:** Dec. 30, 2015
Legal Entity Type: CORPORATION **State or Country Where Organized:** No Place Where Organized Found

Name: [NEOGENOMICS, INC.](#) **Execution Date:** Dec. 30, 2015
Legal Entity Type: CORPORATION **State or Country Where Organized:** No Place Where Organized Found

Name: [CLARIANT, INC.](#) **Execution Date:** Dec. 30, 2015
Legal Entity Type: CORPORATION **State or Country Where Organized:** No Place Where Organized Found

Name: [CLARIANT DIAGNOSTIC SERVICES, INC.](#) **Execution Date:** Dec. 30, 2015
Legal Entity Type: CORPORATION **State or Country Where Organized:** No Place Where Organized Found

Name: [PATH LABS, LLC](#) **Execution Date:** Dec. 30, 2015
Legal Entity Type: LIMITED LIABILITY COMPANY **State or Country Where Organized:** No Place Where Organized Found

Assignee

Name: [AB PRIVATE CREDIT INVESTORS LLC, AS COLLATERAL AGENT](#)
Legal Entity Type: LIMITED LIABILITY COMPANY **State or Country Where Organized:** DELAWARE
Address: 1345 AVENUE OF THE AMERICAS
NEW YORK, NEW YORK 10105

Correspondent

Correspondent Name: JOYCE MILLER
Correspondent Address: 1750 TYSONS BLVD.
TYSONS CORNER, VA 22102

Domestic Representative - Not Found

Assignment 3 of 5

Conveyance: NOTICE OF GRANT OF SECURITY INTEREST IN TRADEMARKS
Reel/Frame: [5950/0749](#) **Pages:** 6
Date Recorded: Dec. 23, 2016
Supporting Documents: [assignment-tm-5950-0749.pdf](#)

Assignor

Name: [NEOGENOMICS LABORATORIES, INC.](#) **Execution Date:** Dec. 22, 2016
Legal Entity Type: CORPORATION **State or Country Where Organized:** FLORIDA

Assignee

Name: [REGIONS BANK, AS COLLATERAL AGENT](#)

Legal Entity Type: CORPORATION

State or Country GEORGIA
Where Organized:

Address: 1180 WEST PEACHTREE STREET, NW
SUITE 1400
ATLANTA, GEORGIA 30309

Correspondent

Correspondent Name: MOORE & VAN ALLEN PLLC

Correspondent Address: 3015 CARRINGTON MILL BOULEVARD
SUITE 400
MORRISVILLE, NC 27560

Domestic Representative - Not Found

Assignment 4 of 5

Conveyance: RELEASE BY SECURED PARTY

Reel/Frame: [5951/0216](#)

Pages: 10

Date Recorded: Dec. 22, 2016

Supporting Documents: [assignment-tm-5951-0216.pdf](#)

Assignor

Name: [AB PRIVATE CREDIT INVESTORS LLC, AS COLLATERAL AGENT](#)

Execution Date: Dec. 22, 2016

Legal Entity Type: LIMITED LIABILITY COMPANY

State or Country DELAWARE
Where Organized:

Assignee

Name: [NEOGENOMICS LABORATORIES, INC.](#)

Legal Entity Type: CORPORATION

State or Country FLORIDA
Where Organized:

Address: 12701 COMMONWEALTH DRIVE
SUITE 9
FORT MYERS, FLORIDA 33913

Name: [NEOGENOMICS, INC.](#)

Legal Entity Type: CORPORATION

State or Country NEVADA
Where Organized:

Address: 12701 COMMONWEALTH DRIVE
SUITE 9
FORT MYERS, FLORIDA 33913

Name: [CLARIANT, INC.](#)

Legal Entity Type: CORPORATION

State or Country DELAWARE
Where Organized:

Address: 12701 COMMONWEALTH DRIVE
SUITE 9
FORT MYERS, FLORIDA 33913

Name: [CLARIANT DIAGNOSTIC SERVICES, INC.](#)

Legal Entity Type: CORPORATION

State or Country DELAWARE
Where Organized:

Address: 12701 COMMONWEALTH DRIVE
SUITE 9
FORT MYERS, FLORIDA 33913

Name: [PATH LABS, LLC](#)

Legal Entity Type: LIMITED LIABILITY COMPANY

State or Country DELAWARE
Where Organized:

Address: 12701 COMMONWEALTH DRIVE
SUITE 9
FORT MYERS, FLORIDA 33913

Correspondent

Correspondent Name: K&L GATES LLP

Correspondent Address: P.O. BOX 1135
CHICAGO, IL 60690-1135

Domestic Representative - Not Found

Assignment 5 of 5

Conveyance: RELEASE BY SECURED PARTY

Reel/Frame: [5951/0364](#)

Pages: 8

Date Recorded: Dec. 23, 2016

Supporting Documents: [assignment-tm-5951-0364.pdf](#)

Assignor

Name: [WELLS FARGO BANK, NATIONAL ASSOCIATION](#)

Execution Date: Dec. 22, 2016

Legal Entity Type: A NATIONAL BANKING ASSOCIATION

State or Country Where Organized: UNITED STATES

Assignee

Name: [NEOGENOMICS LABORATORIES, INC.](#)

Legal Entity Type: CORPORATION

State or Country Where Organized: FLORIDA

Address: 12701 COMMONWEALTH DRIVE
FORT MYERS, FLORIDA 33913

Name: [PATH LABS, LLC](#)

Legal Entity Type: LIMITED LIABILITY COMPANY

State or Country Where Organized: DELAWARE

Address: 12701 COMMONWEALTH DRIVE
FORT MYERS, FLORIDA 33913

Correspondent

Correspondent Name: K&L GATES LLP

Correspondent Address: P.O. BOX 1135
CHICAGO, IL 60690-1135

Domestic Representative - Not Found

Proceedings

Summary

Number of Proceedings: 3

Type of Proceeding: Opposition

Proceeding Number: [91234428](#)

Filing Date: May 08, 2017

Status: Pending

Status Date: May 08, 2017

Interlocutory Attorney: MARY B MYLES

Defendant

Name: Michele Angela Patterson

Correspondent Address: MICHELE ANGELA PATTERSON
11501 NAIRN FARMHOUSE COURT
SILVER SPRING MD UNITED STATES , 20902

Correspondent e-mail: neoang@aol.com

Associated marks

Mark	Application Status	Serial Number	Registration Number
NEOADVANTAGE	Opposition Pending	87130967	

Plaintiff(s)

Name: NeoGenomics Laboratories, Inc.

Correspondent Address: JENNIFER L WHITELAW
WHITELAW LEGAL GROUP
3838 TAMiami TRAIL NORTH STE 310

Naples FL UNITED STATES , 34103

Correspondent e-mail: ttabmail@whitelawfirm.com

Associated marks

Mark	Application Status	Serial Number	Registration Number
NEOGENOMICS	Renewed	78947056	3251678
NEOGENOMICS	Registered	86315855	4975880
NEOGENOMICS LABORATORIES	Registered	86315917	4857621
NEOGENOMICS LABORATORIES	Registered	86315873	4975881
NEOGENOMICS LABORATORIES	Registered	86315897	4975882
NEOPATH	Registered	86000484	4818409
NEOSITE	Registered	85800853	4502829
NEOARRAY	Registered	85767118	4344271
NEOTYPE	Registered	85685014	4340040
NEOFISH	Registered	85323988	4177943
NEOSCORE	Registered	86000503	4983565
NEOLINK	Registered	86073550	5008433
NEOFLOW	Registered	85324005	4493222
NEOLAB	SU - Non-Final Action - Mailed	86329907	
NEOCONNECT	Abandoned - No Statement Of Use Filed	86267226	
NEOUNIVERSITY	SU - Non-Final Action - Mailed	86629250	

Prosecution History

Entry Number	History Text	Date	Due Date
1	FILED AND FEE	May 08, 2017	
2	NOTICE AND TRIAL DATES SENT; ANSWER DUE:	May 08, 2017	Jun 17, 2017
3	PENDING, INSTITUTED	May 08, 2017	
4	ANSWER	Jun 13, 2017	
5	TRIAL DATES REMAIN AS SET	Jun 27, 2017	
6	NOTICE OF DEFAULT	Jul 24, 2017	
7	ANSWER	Jul 31, 2017	
8	RESPONSE DUE	Aug 04, 2017	
9	TRIAL DATES RESET	Nov 01, 2017	
10	STIP TO SUSP PEND SETTL NEGOTIATIONS	Dec 04, 2017	
11	SUSPENDED	Dec 04, 2017	

Type of Proceeding: Opposition

Proceeding Number: [91233609](#)

Filing Date: Mar 27, 2017

Status: Terminated

Status Date: Feb 01, 2018

Interlocutory Attorney: JENNIFER KRISP

Defendant

Name: Ambry Genetics Corporation

Correspondent Address: KARI L BARNES
BUCHALTER NEMER PLC
18400 VON KARMAN AVE, 8TH FL
IRVINE CA UNITED STATES , 92612

Correspondent e-mail: kbarnes@buchalter.com , ipdocket@buchalter.com

Associated marks

Mark	Application Status	Serial Number	Registration Number
EPIFIRST-NEONATE	Registered	87101788	5420989

Plaintiff(s)

Name: NeoGenomics Laboratories, Inc.

Correspondent JENNIFER L WHITELAW

Address: WHITELAW LEGAL GROUP
3838 TAMIAMI TRAIL N., SUITE 310
NAPLES FL UNITED STATES , 34103

Correspondent e-mail: ttabmail@whitelawfirm.com

Associated marks			
Mark	Application Status	Serial Number	Registration Number
NEOGENOMICS	Renewed	78947056	3251678
NEOGENOMICS	Registered	86315855	4975880
NEOGENOMICS LABORATORIES	Registered	86315917	4857621
NEOGENOMICS LABORATORIES	Registered	86315873	4975881
NEOGENOMICS LABORATORIES	Registered	86315897	4975882
NEOPATH	Registered	86000484	4818409
NEOSITE	Registered	85800853	4502829
NEOARRAY	Registered	85767118	4344271
NEOTYPE	Registered	85685014	4340040
NEOFISH	Registered	85323988	4177943
NEOSCORE	Registered	86000503	4983565
NEOLINK	Registered	86073550	5008433
NEOFLOW	Registered	85324005	4493222
NEOLAB	SU - Non-Final Action - Mailed	86329907	
NEOCONNECT	Abandoned - No Statement Of Use Filed	86267226	
NEOUNIVERSITY	SU - Non-Final Action - Mailed	86629250	

Prosecution History

Entry Number	History Text	Date	Due Date
1	FILED AND FEE	Mar 27, 2017	
2	NOTICE AND TRIAL DATES SENT; ANSWER DUE:	Mar 27, 2017	May 06, 2017
3	PENDING, INSTITUTED	Mar 27, 2017	
4	STIP FOR EXT	May 05, 2017	
5	EXTENSION OF TIME GRANTED	May 05, 2017	
6	STIP FOR EXT	Jun 02, 2017	
7	EXTENSION OF TIME GRANTED	Jun 02, 2017	
8	STIP FOR EXT	Jul 05, 2017	
9	EXTENSION OF TIME GRANTED	Jul 05, 2017	
10	STIP FOR EXT	Aug 04, 2017	
11	EXTENSION OF TIME GRANTED	Aug 04, 2017	
12	STIP FOR EXT	Sep 01, 2017	
13	EXTENSION OF TIME GRANTED	Sep 01, 2017	
14	STIP FOR EXT	Sep 29, 2017	
15	EXTENSION OF TIME GRANTED	Sep 29, 2017	
16	STIP FOR EXT	Oct 31, 2017	
17	EXTENSION OF TIME GRANTED	Oct 31, 2017	
18	STIP FOR EXT	Dec 04, 2017	
19	EXTENSION OF TIME GRANTED	Dec 04, 2017	
20	STIP FOR EXT	Jan 03, 2018	
21	EXTENSION OF TIME GRANTED	Jan 03, 2018	
22	MOT TO AMEND APPLICATION	Jan 18, 2018	
23	BD DECISION: DISMISSED W/O PREJ	Feb 01, 2018	
24	TERMINATED	Feb 01, 2018	

Type of Proceeding: Opposition

Proceeding Number: [91230856](#)

Filing Date: Oct 18, 2016

Status: Terminated

Status Date: Feb 02, 2018

Interlocutory Attorney: CHRISTEN M ENGLISH

Defendant

Name: Labsystems Diagnostics

Correspondent Address: DOUGLAS D CHUROVICH
POLSTER LIEDER
12412 POWERSCOURT DRIVE, SUITE 200
ST LOUIS MO UNITED STATES , 63131

Correspondent e-mail: dchurovich@polsterlieder.com , mlucchesi@polsterlieder.com

Associated marks

Mark	Application Status	Serial Number	Registration Number
NEOMASS	Registered	79180717	5420315

Plaintiff(s)

Name: NeoGenomics Laboratories, Inc.

Correspondent Address: JENNIFER L WHITELAW
WHITELAW LEGAL GROUP
3838 TAMIAMI TRAIL N, SUITE 310
NAPLES FL UNITED STATES , 34103

Correspondent e-mail: ttabmail@whitelawfirm.com

Associated marks

Mark	Application Status	Serial Number	Registration Number
NEOGENOMICS	Renewed	78947056	3251678
NEOGENOMICS	Registered	86315855	4975880
NEOGENOMICS LABORATORIES	Registered	86315917	4857621
NEOGENOMICS LABORATORIES	Registered	86315873	4975881
NEOGENOMICS LABORATORIES	Registered	86315897	4975882
NEOPATH	Registered	86000484	4818409
NEOSITE	Registered	85800853	4502829
NEOARRAY	Registered	85767118	4344271
NEOTYPE	Registered	85685014	4340040
NEOFISH	Registered	85323988	4177943
NEOSCORE	Registered	86000503	4983565
NEOLINK	Registered	86073550	5008433
NEOFLOW	Registered	85324005	4493222
NEOLAB	SU - Non-Final Action - Mailed	86329907	
NEOCONNECT	Abandoned - No Statement Of Use Filed	86267226	
NEOUNIVERSITY	SU - Non-Final Action - Mailed	86629250	

Prosecution History

Entry Number	History Text	Date	Due Date
1	FILED AND FEE	Oct 18, 2016	
2	NOTICE AND TRIAL DATES SENT; ANSWER DUE:	Oct 27, 2016	Dec 06, 2016
3	PENDING, INSTITUTED	Oct 27, 2016	
4	D APPEARANCE / POWER OF ATTORNEY	Dec 06, 2016	
5	STIP FOR EXT	Dec 06, 2016	
6	EXTENSION OF TIME GRANTED	Dec 06, 2016	
7	STIP FOR EXT	Jan 05, 2017	
8	EXTENSION OF TIME GRANTED	Jan 06, 2017	
9	STIP FOR EXT	Feb 28, 2017	
10	EXTENSION OF TIME GRANTED	Feb 28, 2017	
11	STIP FOR EXT	Apr 03, 2017	
12	EXTENSION OF TIME GRANTED	Apr 03, 2017	
13	STIP FOR EXT	Apr 27, 2017	
14	EXTENSION OF TIME GRANTED	Apr 27, 2017	
15	STIP FOR EXT	Jun 01, 2017	

16	EXTENSION OF TIME GRANTED	Jun 01, 2017	
17	STIP FOR EXT	Jun 28, 2017	
18	EXTENSION OF TIME GRANTED	Jun 28, 2017	
19	STIP TO SUSP PEND SETTL NEGOTIATIONS	Jul 25, 2017	
20	SUSPENDED	Jul 25, 2017	
21	STIP FOR EXT	Oct 20, 2017	
22	EXTENSION OF TIME GRANTED	Oct 20, 2017	
23	MOT TO AMEND APPLICATION	Dec 28, 2017	
24	MOT TO AMEND APPLICATION	Dec 29, 2017	
25	RESPONSE DUE 30 DAYS (DUE DATE)	Jan 12, 2018	Feb 11, 2018
26	W/DRAW OF OPPOSITION	Jan 31, 2018	
27	BD DECISION: DISMISSED W/ PREJ	Feb 02, 2018	
28	TERMINATED	Feb 02, 2018	

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Mark: NEOINTELLI

NeoIntelli

US Serial Number: 87158590

Application Filing Date: Sep. 01, 2016

Filed as TEAS RF: Yes

Currently TEAS RF: Yes

Register: Principal

Mark Type: Trademark, Service Mark

Status: A first request for extension of time to file a Statement of Use has been granted.

Status Date: Jan. 25, 2018

Publication Date: Jun. 06, 2017

Notice of Allowance Date: Aug. 01, 2017

Mark Information

Mark Literal Elements: NEOINTELLI

Standard Character Claim: Yes. The mark consists of standard characters without claim to any particular font style, size, or color.

Mark Drawing Type: 4 - STANDARD CHARACTER MARK

Related Properties Information

Claimed Ownership of US Registrations: 3251678, 4340040, 4344271 and others

Goods and Services

Note: The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis ((...)) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- Asterisks *...* identify additional (new) wording in the goods/services.

For: Computer software to acquire, capture, extract, except, analyze, organize, and manage medical testing, biological information, medical tests, medical test data, and medical test results for the processing of test data and for analysis of medical test results; computer software for enhancing the analysis of research, and review of information pertaining to medical, scientific, genetic, testing and analysis, and information and pertaining to testing and analysis

International Class(es): 009 - Primary Class

U.S Class(es): 021, 023, 026, 036, 038

Class Status: ACTIVE

Basis: 1(b)

For: Educational services, namely, providing on-line training courses and seminars in the fields of scientific testing and research services, human disease, human medical conditions, medical diagnostic testing services, medical research services, clinical scientific testing, and medical testing

International Class(es): 041 - Primary Class

U.S Class(es): 100, 101, 107

Class Status: ACTIVE

Basis: 1(b)

For: Genetic mapping for scientific purposes, namely, gene sequencing, molecular sequencing, cancer study and analysis, cytometry, cytogenetics, cell analysis, cell preservation, clinical study and testing of cells; medical and scientific research information in the field of gene sequencing, molecular sequencing, cancer study and analysis, cytometry, cytogenetics, cell analysis, cell preservation, clinical study and testing of cells; scientific research in the field of gene sequencing, molecular sequencing, cancer study and analysis, cytometry, cytogenetics, cell analysis, cell preservation, clinical study and testing of cells, and cancer; providing information to others in the fields of scientific testing and research services and clinical scientific testing; providing an Internet website portal featuring scientific

and medical research information in the fields of scientific testing and research services, medical research services, and clinical scientific testing; providing cloud-based scientific and medical research information to others in the field of scientific testing and research services, medical research services, and clinical scientific testing; providing temporary use of online non-downloadable software for analysis of medical test results; temporary use of online non-downloadable software for enhancement of analysis, research, and review of information pertaining to medical, scientific, genetic, testing and analysis, and information and pertaining to such testing and analysis; software as a service (SAAS) services featuring software for analysis of medical test results; computer software for enhancement of analysis, research, and review of information pertaining to medical, scientific, genetic, testing and analysis, and information pertaining to testing and analysis

International Class(es): 042 - Primary Class

U.S Class(es): 100, 101

Class Status: ACTIVE

Basis: 1(b)

For: Medical diagnostic testing services in the field of human disease and human medical conditions; medical testing for diagnostic or treatment purposes; providing medical information to others in the field of human disease, human medical conditions, medical diagnostic testing services and medical testing for diagnostic or treatment purposes; providing an Internet website portal featuring medical information in the field of human disease, and human medical conditions, medical diagnostic testing services, medical testing for diagnostic or treatment purposes; providing cloud-based medical information to others in the field of human disease, human medical conditions, medical diagnostic testing services, and medical testing for diagnostic or treatment purposes

International Class(es): 044 - Primary Class

U.S Class(es): 100, 101

Class Status: ACTIVE

Basis: 1(b)

Basis Information (Case Level)

Filed Use: No	Currently Use: No	Amended Use: No
Filed ITU: Yes	Currently ITU: Yes	Amended ITU: No
Filed 44D: No	Currently 44D: No	Amended 44D: No
Filed 44E: No	Currently 44E: No	Amended 44E: No
Filed 66A: No	Currently 66A: No	
Filed No Basis: No	Currently No Basis: No	

Current Owner(s) Information

Owner Name: NeoGenomics Laboratories, Inc.

Owner Address: c/o WHITELAW LEGAL GROUP
3838 Tamiami Trail North, Suite 310
Naples, FLORIDA 34103
UNITED STATES

Legal Entity Type: CORPORATION

State or Country FLORIDA
Where Organized:

Attorney/Correspondence Information

Attorney of Record

Attorney Name: Jennifer L. Whitelaw

Attorney Primary Email Address: usptomail@whitelawfirm.com

Attorney Email Authorized: Yes

Correspondent

Correspondent Name/Address: JENNIFER L. WHITELAW
WHITELAW LEGAL GROUP
3838 TAMAMIAMI TRAIL NORTH, SUITE 310
NAPLES, FLORIDA 34103
UNITED STATES

Phone: 239-262-1001

Fax: 239-261-0057

Correspondent e-mail: usptomail@whitelawfirm.com

Correspondent e-mail Authorized: Yes

Domestic Representative - Not Found

Prosecution History

Proceeding

Date	Description	Number
Jan. 27, 2018	NOTICE OF APPROVAL OF EXTENSION REQUEST E-MAILED	
Jan. 25, 2018	EXTENSION 1 GRANTED	98765
Jan. 25, 2018	EXTENSION 1 FILED	98765
Jan. 25, 2018	TEAS EXTENSION RECEIVED	
Aug. 01, 2017	NOA E-MAILED - SOU REQUIRED FROM APPLICANT	
Jun. 06, 2017	OFFICIAL GAZETTE PUBLICATION CONFIRMATION E-MAILED	
Jun. 06, 2017	PUBLISHED FOR OPPOSITION	
May 17, 2017	NOTIFICATION OF NOTICE OF PUBLICATION E-MAILED	
May 04, 2017	LAW OFFICE PUBLICATION REVIEW COMPLETED	68171
Apr. 20, 2017	APPROVED FOR PUB - PRINCIPAL REGISTER	
Apr. 13, 2017	TEAS/EMAIL CORRESPONDENCE ENTERED	68171
Apr. 13, 2017	CORRESPONDENCE RECEIVED IN LAW OFFICE	68171
Apr. 12, 2017	TEAS REQUEST FOR RECONSIDERATION RECEIVED	
Mar. 02, 2017	NOTIFICATION OF FINAL REFUSAL EMAILED	
Mar. 02, 2017	FINAL REFUSAL E-MAILED	
Mar. 02, 2017	FINAL REFUSAL WRITTEN	74671
Feb. 08, 2017	TEAS/EMAIL CORRESPONDENCE ENTERED	68171
Feb. 08, 2017	CORRESPONDENCE RECEIVED IN LAW OFFICE	68171
Feb. 07, 2017	ASSIGNED TO LIE	68171
Jan. 30, 2017	ASSIGNED TO EXAMINER	74671
Jan. 23, 2017	TEAS RESPONSE TO OFFICE ACTION RECEIVED	
Jan. 11, 2017	ASSIGNMENT OF OWNERSHIP NOT UPDATED AUTOMATICALLY	
Dec. 25, 2016	NOTIFICATION OF NON-FINAL ACTION E-MAILED	6325
Dec. 25, 2016	NON-FINAL ACTION E-MAILED	6325
Dec. 25, 2016	NON-FINAL ACTION WRITTEN	90335
Dec. 10, 2016	ASSIGNED TO EXAMINER	90335
Sep. 09, 2016	NOTICE OF PSEUDO MARK E-MAILED	
Sep. 08, 2016	NEW APPLICATION OFFICE SUPPLIED DATA ENTERED IN TRAM	
Sep. 05, 2016	NEW APPLICATION ENTERED IN TRAM	

TM Staff and Location Information

TM Staff Information

TM Attorney: BROWN, BARBARA TROFFKI

Law Office Assigned: LAW OFFICE 116

File Location

Current Location: INTENT TO USE SECTION

Date in Location: Aug. 01, 2017

Assignment Abstract Of Title Information

Summary

Total Assignments: 1

Applicant: NeoGenomics Laboratories, Inc.

Assignment 1 of 1

Conveyance: NOTICE OF GRANT OF SECURITY INTEREST IN TRADEMARKS

Reel/Frame: [5950/0749](#)

Pages: 6

Date Recorded: Dec. 23, 2016

Supporting Documents: [assignment-tm-5950-0749.pdf](#)

Assignor

Name: [NEOGENOMICS LABORATORIES, INC.](#)

Execution Date: Dec. 22, 2016

Legal Entity Type: CORPORATION

State or Country Where Organized: FLORIDA

Assignee

Name: [REGIONS BANK, AS COLLATERAL AGENT](#)

Legal Entity Type: CORPORATION

State or Country GEORGIA
Where Organized:

Address: 1180 WEST PEACHTREE STREET, NW
SUITE 1400
ATLANTA, GEORGIA 30309

Correspondent

Correspondent Name: MOORE & VAN ALLEN PLLC

Correspondent Address: 3015 CARRINGTON MILL BOULEVARD
SUITE 400
MORRISVILLE, NC 27560

Domestic Representative - Not Found

Generated on: This page was generated by TSDR on 2018-05-14 14:38:02 EDT

Mark: NEOSMARTFLOW

NeoSmartFLOW

US Serial Number: 87158485

Application Filing Date: Sep. 01, 2016

Filed as TEAS RF: Yes

Currently TEAS RF: Yes

Register: Principal

Mark Type: Trademark, Service Mark

Status: A first request for extension of time to file a Statement of Use has been granted.

Status Date: Dec. 14, 2017

Publication Date: May 30, 2017

Notice of Allowance Date: Jul. 25, 2017

Mark Information

Mark Literal Elements: NEOSMARTFLOW

Standard Character Claim: Yes. The mark consists of standard characters without claim to any particular font style, size, or color.

Mark Drawing Type: 4 - STANDARD CHARACTER MARK

Related Properties Information

Claimed Ownership of US Registrations: 3251678, 4340040, 4344271

Goods and Services

Note: The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis ((...)) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- Asterisks *...* identify additional (new) wording in the goods/services.

For: Computer software to acquire, capture, extract, except, analyze, organize, and manage medical testing, biological information, medical tests, medical test data, and medical test results for the processing of test data and for analysis of medical test results; computer software for enhancing the analysis of research, and review of information pertaining to medical, scientific, genetic, testing and analysis, and information and pertaining to testing and analysis

International Class(es): 009 - Primary Class

U.S Class(es): 021, 023, 026, 036, 038

Class Status: ACTIVE

Basis: 1(b)

For: Educational services, namely, providing on-line training courses and seminars in the fields of scientific testing and research services, human disease, human medical conditions, medical diagnostic testing services, medical research services, clinical scientific testing, and medical testing

International Class(es): 041 - Primary Class

U.S Class(es): 100, 101, 107

Class Status: ACTIVE

Basis: 1(b)

For: Genetic mapping for scientific purposes, namely, gene sequencing, molecular sequencing, cancer study and analysis, cytometry, cytogenetics, cell analysis, cell preservation, clinical study and testing of cells; medical and scientific research information in the field of gene sequencing, molecular sequencing, cancer study and analysis, cytometry, cytogenetics, cell analysis, cell preservation, clinical study and testing of cells; scientific research in the field of gene sequencing, molecular sequencing, cancer study and analysis, cytometry, cytogenetics, cell analysis, cell preservation, clinical study and testing of cells, and cancer; providing information to others in the fields of scientific testing and research services and clinical scientific testing; providing an Internet website portal featuring scientific

and medical research information in the fields of scientific testing and research services, medical research services, and clinical scientific testing; providing cloud-based scientific and medical research information to others in the field of scientific testing and research services, medical research services, and clinical scientific testing; providing temporary use of online non-downloadable software for analysis of medical test results; temporary use of online non-downloadable software for enhancement of analysis, research, and review of information pertaining to medical, scientific, genetic, testing and analysis, and information and pertaining to such testing and analysis; software as a service (SAAS) services featuring software for analysis of medical test results; computer software for enhancement of analysis, research, and review of information pertaining to medical, scientific, genetic, testing and analysis, and information pertaining to testing and analysis

International Class(es): 042 - Primary Class

U.S Class(es): 100, 101

Class Status: ACTIVE

Basis: 1(b)

For: Medical diagnostic testing services in the field of human disease and human medical conditions; medical testing for diagnostic or treatment purposes; providing medical information to others in the field of human disease, human medical conditions, medical diagnostic testing services and medical testing for diagnostic or treatment purposes; providing an Internet website portal featuring medical information in the field of human disease, and human medical conditions, medical diagnostic testing services, medical testing for diagnostic or treatment purposes; providing cloud-based medical information to others in the field of human disease, human medical conditions, medical diagnostic testing services, and medical testing for diagnostic or treatment purposes

International Class(es): 044 - Primary Class

U.S Class(es): 100, 101

Class Status: ACTIVE

Basis: 1(b)

Basis Information (Case Level)

Filed Use: No	Currently Use: No	Amended Use: No
Filed ITU: Yes	Currently ITU: Yes	Amended ITU: No
Filed 44D: No	Currently 44D: No	Amended 44D: No
Filed 44E: No	Currently 44E: No	Amended 44E: No
Filed 66A: No	Currently 66A: No	
Filed No Basis: No	Currently No Basis: No	

Current Owner(s) Information

Owner Name: NeoGenomics Laboratories, Inc.

Owner Address: c/o WHITELAW LEGAL GROUP
3838 Tamiami Trail North, Suite 310
Naples, FLORIDA 34103
UNITED STATES

Legal Entity Type: CORPORATION

State or Country FLORIDA
Where Organized:

Attorney/Correspondence Information

Attorney of Record

Attorney Name: Jennifer L. Whitelaw

Attorney Primary Email Address: usptomail@whitelawfirm.com

Attorney Email Authorized: Yes

Correspondent

Correspondent Name/Address: JENNIFER L. WHITELAW
WHITELAW LEGAL GROUP
3838 TAMAMIAMI TRAIL NORTH, SUITE 310
NAPLES, FLORIDA 34103
UNITED STATES

Phone: 239-262-1001

Fax: 239-261-0057

Correspondent e-mail: usptomail@whitelawfirm.com

Correspondent e-mail Authorized: Yes

Domestic Representative - Not Found

Prosecution History

Proceeding

Date	Description	Number
Dec. 16, 2017	NOTICE OF APPROVAL OF EXTENSION REQUEST E-MAILED	
Dec. 14, 2017	EXTENSION 1 GRANTED	98765
Dec. 14, 2017	EXTENSION 1 FILED	98765
Dec. 14, 2017	TEAS EXTENSION RECEIVED	
Jul. 25, 2017	NOA E-MAILED - SOU REQUIRED FROM APPLICANT	
May 30, 2017	OFFICIAL GAZETTE PUBLICATION CONFIRMATION E-MAILED	
May 30, 2017	PUBLISHED FOR OPPOSITION	
May 10, 2017	NOTIFICATION OF NOTICE OF PUBLICATION E-MAILED	
Apr. 26, 2017	LAW OFFICE PUBLICATION REVIEW COMPLETED	70468
Apr. 20, 2017	APPROVED FOR PUB - PRINCIPAL REGISTER	
Apr. 14, 2017	TEAS/EMAIL CORRESPONDENCE ENTERED	70468
Apr. 14, 2017	CORRESPONDENCE RECEIVED IN LAW OFFICE	70468
Apr. 12, 2017	TEAS REQUEST FOR RECONSIDERATION RECEIVED	
Feb. 24, 2017	NOTIFICATION OF FINAL REFUSAL EMAILED	
Feb. 24, 2017	FINAL REFUSAL E-MAILED	
Feb. 24, 2017	FINAL REFUSAL WRITTEN	74671
Jan. 30, 2017	TEAS/EMAIL CORRESPONDENCE ENTERED	70468
Jan. 30, 2017	CORRESPONDENCE RECEIVED IN LAW OFFICE	70468
Jan. 30, 2017	ASSIGNED TO EXAMINER	74671
Jan. 23, 2017	TEAS RESPONSE TO OFFICE ACTION RECEIVED	
Jan. 11, 2017	ASSIGNMENT OF OWNERSHIP NOT UPDATED AUTOMATICALLY	
Dec. 25, 2016	NOTIFICATION OF NON-FINAL ACTION E-MAILED	6325
Dec. 25, 2016	NON-FINAL ACTION E-MAILED	6325
Dec. 25, 2016	NON-FINAL ACTION WRITTEN	90335
Dec. 10, 2016	ASSIGNED TO EXAMINER	90335
Sep. 22, 2016	APPLICANT AMENDMENT PRIOR TO EXAMINATION - ENTERED	70468
Sep. 17, 2016	ASSIGNED TO LIE	70468
Sep. 09, 2016	TEAS VOLUNTARY AMENDMENT RECEIVED	
Sep. 09, 2016	NOTICE OF PSEUDO MARK E-MAILED	
Sep. 08, 2016	NEW APPLICATION OFFICE SUPPLIED DATA ENTERED IN TRAM	
Sep. 05, 2016	NEW APPLICATION ENTERED IN TRAM	

TM Staff and Location Information

TM Staff Information

TM Attorney: BROWN, BARBARA TROFFKI

Law Office Assigned: LAW OFFICE 116

File Location

Current Location: INTENT TO USE SECTION

Date in Location: Jul. 25, 2017

Assignment Abstract Of Title Information

Summary

Total Assignments: 1

Applicant: NeoGenomics Laboratories, Inc.

Assignment 1 of 1

Conveyance: NOTICE OF GRANT OF SECURITY INTEREST IN TRADEMARKS

Reel/Frame: [5950/0749](#)

Pages: 6

Date Recorded: Dec. 23, 2016

Supporting Documents: [assignment-tm-5950-0749.pdf](#)

Assignor

Name: [NEOGENOMICS LABORATORIES, INC.](#)

Execution Date: Dec. 22, 2016

Legal Entity Type: CORPORATION

State or Country Where Organized: FLORIDA

Assignee

Name: [REGIONS BANK, AS COLLATERAL AGENT](#)

Legal Entity Type: CORPORATION

State or Country Where Organized: GEORGIA

Address: 1180 WEST PEACHTREE STREET, NW
SUITE 1400
ATLANTA, GEORGIA 30309

Correspondent

Correspondent Name: MOORE & VAN ALLEN PLLC

Correspondent Address: 3015 CARRINGTON MILL BOULEVARD
SUITE 400
MORRISVILLE, NC 27560

Domestic Representative - Not Found

Generated on: This page was generated by TSDR on 2018-05-14 14:38:58 EDT

Mark: NEO TECHNOLOGY

NEO TECHNOLOGY

US Serial Number: 86281593

Application Filing Date: May 14, 2014

US Registration Number: 4824877

Registration Date: Oct. 06, 2015

Register: Principal

Mark Type: Service Mark

Status: Registered. The registration date is used to determine when post-registration maintenance documents are due.

Status Date: Oct. 06, 2015

Publication Date: Jul. 21, 2015

Mark Information

Mark Literal Elements: NEO TECHNOLOGY

Standard Character Claim: Yes. The mark consists of standard characters without claim to any particular font style, size, or color.

Mark Drawing Type: 4 - STANDARD CHARACTER MARK

Disclaimer: "TECHNOLOGY"

Goods and Services

Note: The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis ((..)) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- Asterisks *.* identify additional (new) wording in the goods/services.

For: Consulting services and advice in the field of updating and maintenance of data in computer databases

International Class(es): 035 - Primary Class

U.S Class(es): 100, 101, 102

Class Status: ACTIVE

Basis: 1(a)

First Use: Dec. 13, 2007

Use in Commerce: Oct. 06, 2008

For: Educational services, namely, conducting training classes, certification training, workshops, tutorial sessions, and online classes in the fields of designing computer databases and updating and maintenance of data in computer databases, and distributing course materials in connection therewith; providing training services in the fields of designing computer databases and updating and maintenance of data in computer databases, and distributing course materials in connection therewith

International Class(es): 041 - Primary Class

U.S Class(es): 100, 101, 107

Class Status: ACTIVE

Basis: 1(a)

First Use: Dec. 13, 2007

Use in Commerce: Oct. 06, 2008

For: Computer services, namely, providing consultation services and advice in the fields of designing computer databases

International Class(es): 042 - Primary Class

U.S Class(es): 100, 101

Class Status: ACTIVE

Basis: 1(a)

First Use: Dec. 13, 2007

Use in Commerce: Oct. 06, 2008

For: Consulting services and advice in the field of maintaining the security and integrity of databases

International Class(es): 045 - Primary Class

U.S Class(es): 100, 101

Class Status: ACTIVE

Basis: 1(a)

First Use: Dec. 13, 2007

Use in Commerce: Oct. 06, 2008

Basis Information (Case Level)

Filed Use: Yes

Currently Use: Yes

Amended Use: No

Filed ITU: No

Currently ITU: No

Amended ITU: No

Filed 44D: No

Currently 44D: No

Amended 44D: No

Filed 44E: No

Currently 44E: No

Amended 44E: No

Filed 66A: No

Currently 66A: No

Filed No Basis: No

Currently No Basis: No

Current Owner(s) Information

Owner Name: NEO4J, INC.

Owner Address: 111 EAST 5TH AVENUE
SAN MATEO, CALIFORNIA 94401
UNITED STATES

Legal Entity Type: CORPORATION

State or Country Where Organized: DELAWARE

Attorney/Correspondence Information

Attorney of Record

Attorney Name: Chiara Portner

Attorney Primary Email Address: chiara@paradigmcounsel.com

Attorney Email Authorized: Yes

Correspondent

Correspondent Name/Address: Chiara Portner
Paradigm Counsel LLP
2625 Middlefield Road 800
Palo Alto, CALIFORNIA 94306
UNITED STATES

Phone: 6504345641

Correspondent e-mail: chiara@paradigmcounsel.com Greg@paradigmco.unsel.com

Correspondent e-mail Authorized: Yes

Domestic Representative - Not Found

Prosecution History

Date	Description	Proceeding Number
Jul. 05, 2017	AUTOMATIC UPDATE OF ASSIGNMENT OF OWNERSHIP	
Jul. 12, 2016	ATTORNEY/DOM.REP.REVOKED AND/OR APPOINTED	
Jul. 12, 2016	TEAS REVOKE/APP/CHANGE ADDR OF ATTY/DOM REP RECEIVED	
Oct. 06, 2015	REGISTERED-PRINCIPAL REGISTER	
Jul. 21, 2015	OFFICIAL GAZETTE PUBLICATION CONFIRMATION E-MAILED	
Jul. 21, 2015	PUBLISHED FOR OPPOSITION	
Jul. 01, 2015	NOTIFICATION OF NOTICE OF PUBLICATION E-MAILED	
Jun. 15, 2015	LAW OFFICE PUBLICATION REVIEW COMPLETED	66213
Jun. 15, 2015	ASSIGNED TO LIE	66213
May 27, 2015	APPROVED FOR PUB - PRINCIPAL REGISTER	
May 27, 2015	EXAMINER'S AMENDMENT ENTERED	88888
May 27, 2015	NOTIFICATION OF EXAMINERS AMENDMENT E-MAILED	6328
May 27, 2015	EXAMINERS AMENDMENT E-MAILED	6328

May 27, 2015	EXAMINERS AMENDMENT -WRITTEN	83698
May 01, 2015	NOTIFICATION OF SUBSEQUENT FINAL EMAILED	
May 01, 2015	CONTINUATION OF FINAL REFUSAL E-MAILED	
May 01, 2015	ACTION CONTINUING A FINAL - COMPLETED	83698
Apr. 13, 2015	TEAS/EMAIL CORRESPONDENCE ENTERED	88889
Apr. 13, 2015	CORRESPONDENCE RECEIVED IN LAW OFFICE	88889
Apr. 13, 2015	TEAS REQUEST FOR RECONSIDERATION RECEIVED	
Feb. 05, 2015	ATTORNEY/DOM.REP.REVOKED AND/OR APPOINTED	
Feb. 05, 2015	TEAS REVOKE/APP/CHANGE ADDR OF ATTY/DOM REP RECEIVED	
Oct. 13, 2014	NOTIFICATION OF FINAL REFUSAL EMAILED	
Oct. 13, 2014	FINAL REFUSAL E-MAILED	
Oct. 13, 2014	FINAL REFUSAL WRITTEN	83698
Sep. 23, 2014	TEAS/EMAIL CORRESPONDENCE ENTERED	88889
Sep. 22, 2014	CORRESPONDENCE RECEIVED IN LAW OFFICE	88889
Sep. 22, 2014	TEAS RESPONSE TO OFFICE ACTION RECEIVED	
Aug. 19, 2014	NOTIFICATION OF NON-FINAL ACTION E-MAILED	6325
Aug. 19, 2014	NON-FINAL ACTION E-MAILED	6325
Aug. 19, 2014	NON-FINAL ACTION WRITTEN	83698
Aug. 14, 2014	ASSIGNED TO EXAMINER	83698
May 28, 2014	NEW APPLICATION OFFICE SUPPLIED DATA ENTERED IN TRAM	
May 17, 2014	NEW APPLICATION ENTERED IN TRAM	

TM Staff and Location Information

TM Staff Information - None

File Location

Current Location: PUBLICATION AND ISSUE SECTION

Date in Location: Oct. 06, 2015

Assignment Abstract Of Title Information

Summary

Total Assignments: 1

Registrant: Neo Technology

Assignment 1 of 1

Conveyance: CHANGE OF NAME

Reel/Frame: [6089/0128](#)

Pages: 3

Date Recorded: Jun. 21, 2017

Supporting Documents: [assignment-tm-6089-0128.pdf](#)

Assignor

Name: [NEO TECHNOLOGY, INC.](#)

Execution Date: Jun. 15, 2017

Legal Entity Type: CORPORATION

State or Country Where Organized: No Place Where Organized Found

Assignee

Name: [NEO4J, INC.](#)

Legal Entity Type: CORPORATION

State or Country Where Organized: DELAWARE

Address: 111 EAST 5TH AVENUE
SAN MATEO, CALIFORNIA 94401

Correspondent

Correspondent Name: CHIARA PORTNER

Correspondent Address: 2625 MIDDLEFIELD ROAD, 800
PALO ALTO, CA 94306

Domestic Representative - Not Found

Generated on: This page was generated by TSDR on 2018-05-14 14:40:13 EDT

Mark: NEO-HOMESTEADING

NEO-HOMESTEADING

US Serial Number: 85466870

Application Filing Date: Nov. 08, 2011

US Registration Number: 4311487

Registration Date: Apr. 02, 2013

Register: Principal

Mark Type: Service Mark

Status: Registered. The registration date is used to determine when post-registration maintenance documents are due.

Status Date: Apr. 02, 2013

Publication Date: Jan. 15, 2013

Mark Information

Mark Literal Elements: NEO-HOMESTEADING

Standard Character Claim: Yes. The mark consists of standard characters without claim to any particular font style, size, or color.

Mark Drawing Type: 4 - STANDARD CHARACTER MARK

Goods and Services

Note: The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis ((.)) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- Asterisks *.* identify additional (new) wording in the goods/services.

For: Educational services, namely, providing an educational blog in the field of sustainable home grown organic foods

International Class(es): 041 - Primary Class

U.S Class(es): 100, 101, 107

Class Status: ACTIVE

Basis: 1(a)

First Use: Jan. 16, 2009

Use in Commerce: Jan. 16, 2009

Basis Information (Case Level)

Filed Use: Yes

Currently Use: Yes

Amended Use: No

Filed ITU: No

Currently ITU: No

Amended ITU: No

Filed 44D: No

Currently 44D: No

Amended 44D: No

Filed 44E: No

Currently 44E: No

Amended 44E: No

Filed 66A: No

Currently 66A: No

Filed No Basis: No

Currently No Basis: No

Current Owner(s) Information

Owner Name: NeueSystems, Inc.

Owner Address: 439 Hollywood Drive
East Stroudsburg, PENNSYLVANIA 18302
UNITED STATES

Legal Entity Type: CORPORATION

State or Country Where Organized: NEVADA

Attorney/Correspondence Information

Attorney of Record

Attorney Name: Bernard Malina **Docket Number:** AS-135
Attorney Primary Email Address: acampbell@malinalaw.com **Attorney Email Authorized:** No

Correspondent

Correspondent Name/Address: BERNARD MALINA
MALINA & ASSOCIATES, PLLC
305 MADISON AVE Suite 1420
NEW YORK, NEW YORK 10165
UNITED STATES
Correspondent e-mail: acampbell@malinalaw.com **Correspondent e-mail Authorized:** Yes

Domestic Representative - Not Found

Prosecution History

Date	Description	Proceeding Number
Apr. 02, 2018	COURTESY REMINDER - SEC. 8 (6-YR) E-MAILED	
Apr. 02, 2013	REGISTERED-PRINCIPAL REGISTER	
Jan. 15, 2013	OFFICIAL GAZETTE PUBLICATION CONFIRMATION E-MAILED	
Jan. 15, 2013	PUBLISHED FOR OPPOSITION	
Dec. 26, 2012	NOTIFICATION OF NOTICE OF PUBLICATION E-MAILED	
Dec. 07, 2012	LAW OFFICE PUBLICATION REVIEW COMPLETED	70633
Dec. 03, 2012	ASSIGNED TO LIE	70633
Nov. 19, 2012	APPROVED FOR PUB - PRINCIPAL REGISTER	
Nov. 19, 2012	EXAMINER'S AMENDMENT ENTERED	88888
Nov. 19, 2012	NOTIFICATION OF EXAMINERS AMENDMENT E-MAILED	6328
Nov. 19, 2012	EXAMINERS AMENDMENT E-MAILED	6328
Nov. 19, 2012	EXAMINERS AMENDMENT -WRITTEN	83171
Sep. 18, 2012	NOTIFICATION OF FINAL REFUSAL EMAILED	
Sep. 18, 2012	FINAL REFUSAL E-MAILED	
Sep. 18, 2012	FINAL REFUSAL WRITTEN	83171
Aug. 23, 2012	TEAS CHANGE OF CORRESPONDENCE RECEIVED	
Aug. 23, 2012	TEAS/EMAIL CORRESPONDENCE ENTERED	88889
Aug. 23, 2012	CORRESPONDENCE RECEIVED IN LAW OFFICE	88889
Aug. 23, 2012	TEAS RESPONSE TO OFFICE ACTION RECEIVED	
Mar. 05, 2012	NOTIFICATION OF NON-FINAL ACTION E-MAILED	6325
Mar. 05, 2012	NON-FINAL ACTION E-MAILED	6325
Mar. 05, 2012	NON-FINAL ACTION WRITTEN	83171
Feb. 25, 2012	ASSIGNED TO EXAMINER	83171
Nov. 14, 2011	NEW APPLICATION OFFICE SUPPLIED DATA ENTERED IN TRAM	

TM Staff and Location Information

TM Staff Information - None

File Location

Current Location: PUBLICATION AND ISSUE SECTION

Date in Location: Apr. 02, 2013

Generated on: This page was generated by TSDR on 2018-05-14 14:41:06 EDT

Mark: NEOTRENDS

NEOTRENDS

US Serial Number: 87225824

Application Filing Date: Nov. 03, 2016

Filed as TEAS RF: Yes

Currently TEAS RF: Yes

Register: Principal

Mark Type: Service Mark

TM5 Common Status Descriptor:



LIVE/APPLICATION/Under Examination

The trademark application has been accepted by the Office (has met the minimum filing requirements) and that this application has been assigned to an examiner.

Status: A first request for extension of time to file a Statement of Use has been granted.

Status Date: Nov. 23, 2017

Publication Date: Mar. 28, 2017

Notice of Allowance Date: May 23, 2017

Mark Information

Mark Literal Elements: NEOTRENDS

Standard Character Claim: Yes. The mark consists of standard characters without claim to any particular font style, size, or color.

Mark Drawing Type: 4 - STANDARD CHARACTER MARK

Goods and Services

Note: The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis (..) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- Asterisks *..* identify additional (new) wording in the goods/services.

For: Providing a website featuring non-downloadable books and articles in the field of self-help, philosophy and politics; Educational services, namely, providing online instruction in the field of self-help, philosophy and politics; educational and entertainment services, namely, programs about personal improvement accessible by computer networks; educational and entertainment services, namely, the presentation of seminars, workshops, panel discussions in the field of personal improvement; educational services, namely, conducting classes and seminars in the field of personal improvement

International Class(es): 041 - Primary Class

U.S Class(es): 100, 101, 107

Class Status: ACTIVE

Basis: 1(b)

Basis Information (Case Level)

Filed Use: No
Filed ITU: Yes
Filed 44D: No
Filed 44E: No
Filed 66A: No
Filed No Basis: No

Currently Use: No
Currently ITU: Yes
Currently 44D: No
Currently 44E: No
Currently 66A: No
Currently No Basis: No

Amended Use: No
Amended ITU: No
Amended 44D: No
Amended 44E: No

Current Owner(s) Information

Owner Name: Integrated Management Associates, Inc.

Owner Address: Suite 503
2505 Anthem Village Dr.
Henderson, NEVADA UNITED STATES 89052

Legal Entity Type: CORPORATION

State or Country NEVADA
Where Organized:

Attorney/Correspondence Information

Attorney of Record

Attorney Name: Lauri S. Thompson

Docket Number: 104858000053

Attorney Primary Email Address: lvpto@gtlaw.com

Attorney Email Authorized: Yes

Correspondent

Correspondent Name/Address: LAURI S. THOMPSON
GREENBERG TRAUIG, LLP
3773 HOWARD HUGHES PARKWAY
SUITE 400N
LAS VEGAS, NEVADA UNITED STATES 89169

Phone: 702-792-3773

Fax: 702-792-9002

Correspondent e-mail: lvpto@gtlaw.com

Correspondent e-mail Authorized: Yes

Domestic Representative - Not Found

Prosecution History

Date	Description	Proceeding Number
Nov. 25, 2017	NOTICE OF APPROVAL OF EXTENSION REQUEST E-MAILED	
Nov. 23, 2017	EXTENSION 1 GRANTED	98765
Nov. 23, 2017	EXTENSION 1 FILED	98765
Nov. 23, 2017	TEAS EXTENSION RECEIVED	
May 23, 2017	NOA E-MAILED - SOU REQUIRED FROM APPLICANT	
Mar. 28, 2017	OFFICIAL GAZETTE PUBLICATION CONFIRMATION E-MAILED	
Mar. 28, 2017	PUBLISHED FOR OPPOSITION	
Mar. 08, 2017	NOTIFICATION OF NOTICE OF PUBLICATION E-MAILED	
Feb. 13, 2017	APPROVED FOR PUB - PRINCIPAL REGISTER	
Feb. 09, 2017	ASSIGNED TO EXAMINER	92577
Nov. 09, 2016	NOTICE OF PSEUDO MARK E-MAILED	
Nov. 08, 2016	NEW APPLICATION OFFICE SUPPLIED DATA ENTERED IN TRAM	
Nov. 07, 2016	NEW APPLICATION ENTERED IN TRAM	

TM Staff and Location Information

TM Staff Information

TM Attorney: YOO, JEANE

Law Office Assigned: LAW OFFICE 120

File Location

Current Location: INTENT TO USE SECTION

Date in Location: May 23, 2017

Generated on: This page was generated by TSDR on 2018-05-14 14:41:56 EDT

Mark: NEO-SAGE

NEO-SAGE

US Serial Number: 77278692

Application Filing Date: Sep. 13, 2007

US Registration Number: 3603500

Registration Date: Apr. 07, 2009

Register: Principal

Mark Type: Trademark, Service Mark

Status: A Sections 8 and 15 combined declaration has been accepted and acknowledged.

Status Date: Nov. 28, 2015

Publication Date: Sep. 09, 2008

Notice of Allowance Date: Dec. 02, 2008

Mark Information

Mark Literal Elements: NEO-SAGE

Standard Character Claim: Yes. The mark consists of standard characters without claim to any particular font style, size, or color.

Mark Drawing Type: 4 - STANDARD CHARACTER MARK

Goods and Services

Note: The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis ((.)) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- Asterisks *.* identify additional (new) wording in the goods/services.

For: Digital media, namely, CDs and DVDs featuring pre-recorded seminars and workshops on effective skills and techniques for personal, sales and customer service communications

International Class(es): 009 - Primary Class

U.S Class(es): 021, 023, 026, 036, 038

Class Status: ACTIVE

Basis: 1(a)

First Use: Nov. 18, 2008

Use in Commerce: Nov. 18, 2008

For: Educational services, namely, conducting seminars and workshops on effective skills and techniques for personal, sales and customer service communications; One on one training on effective skills and techniques for personal, sales and customer service communications

International Class(es): 041 - Primary Class

U.S Class(es): 100, 101, 107

Class Status: ACTIVE

Basis: 1(a)

First Use: Jul. 01, 2004

Use in Commerce: Jul. 01, 2004

Basis Information (Case Level)

Filed Use: Yes

Currently Use: Yes

Amended Use: No

Filed ITU: Yes

Currently ITU: No

Amended ITU: No

Filed 44D: No

Currently 44D: No

Amended 44D: No

Filed 44E: No

Currently 44E: No

Amended 44E: No

Filed 66A: No

Currently 66A: No

Filed No Basis: No

Currently No Basis: No

Current Owner(s) Information

Owner Name: NEO-SAGE, Inc.

Owner Address: 445 PARK AVENUE
10TH FLOOR
New York, NEW YORK 10022
UNITED STATES

Legal Entity Type: CORPORATION

State or Country NEW YORK
Where Organized:

Attorney/Correspondence Information

Attorney of Record

Attorney Name: Alozie N. Etufugh

Docket Number: 0244-4001

Correspondent

Correspondent Name/Address: ALOZIE ETUFUGH
LAW OFFICES OF ALOZIE N. ETUFUGH, PLLC
230 PARK AVENUE
SUITE 1000
NEW YORK, NEW YORK 10169
UNITED STATES

Phone: 212-309-8723

Fax: 917-591-6757

Correspondent e-mail: ane@etufughlaw.com etufughlaw@gmail.com

Correspondent e-mail Authorized: Yes

Domestic Representative - Not Found

Prosecution History

Date	Description	Proceeding Number
May 06, 2018	TEAS CHANGE OF CORRESPONDENCE RECEIVED	
Apr. 07, 2018	COURTESY REMINDER - SEC. 8 (10-YR)/SEC. 9 E-MAILED	
Mar. 18, 2016	PETITION TO DIRECTOR - DISMISSED	78049
Nov. 28, 2015	NOTICE OF ACCEPTANCE OF SEC. 8 & 15 - E-MAILED	
Nov. 28, 2015	REGISTERED - SEC. 8 (6-YR) ACCEPTED & SEC. 15 ACK.	66607
Nov. 28, 2015	CASE ASSIGNED TO POST REGISTRATION PARALEGAL	66607
Nov. 02, 2015	ASSIGNED TO PETITION STAFF	78049
Oct. 07, 2015	TEAS SECTION 8 & 15 RECEIVED	
Oct. 07, 2015	TEAS CHANGE OF CORRESPONDENCE RECEIVED	
Oct. 07, 2015	TEAS PETITION TO DIRECTOR RECEIVED	1111
Nov. 05, 2010	TEAS CHANGE OF CORRESPONDENCE RECEIVED	
Apr. 07, 2009	REGISTERED-PRINCIPAL REGISTER	
Mar. 03, 2009	LAW OFFICE REGISTRATION REVIEW COMPLETED	67287
Mar. 02, 2009	ALLOWED PRINCIPAL REGISTER - SOU ACCEPTED	
Feb. 19, 2009	TEAS CHANGE OF CORRESPONDENCE RECEIVED	
Jan. 15, 2009	STATEMENT OF USE PROCESSING COMPLETE	66230
Dec. 30, 2008	USE AMENDMENT FILED	66230
Jan. 15, 2009	CASE ASSIGNED TO INTENT TO USE PARALEGAL	66230
Dec. 30, 2008	TEAS STATEMENT OF USE RECEIVED	
Dec. 02, 2008	NOA MAILED - SOU REQUIRED FROM APPLICANT	
Sep. 09, 2008	PUBLISHED FOR OPPOSITION	
Aug. 20, 2008	NOTICE OF PUBLICATION	
Aug. 01, 2008	LAW OFFICE PUBLICATION REVIEW COMPLETED	67287
Jul. 28, 2008	APPROVED FOR PUB - PRINCIPAL REGISTER	
Jun. 09, 2008	TEAS/EMAIL CORRESPONDENCE ENTERED	88889
Jun. 08, 2008	CORRESPONDENCE RECEIVED IN LAW OFFICE	88889
Jun. 08, 2008	TEAS RESPONSE TO OFFICE ACTION RECEIVED	

May 19, 2008	PRIORITY ACTION MAILED	
May 16, 2008	PRIORITY ACTION WRITTEN	72506
May 16, 2008	PREVIOUS ALLOWANCE COUNT WITHDRAWN	
Mar. 28, 2008	WITHDRAWN FROM PUB - OG REVIEW QUERY	61844
Mar. 14, 2008	LAW OFFICE PUBLICATION REVIEW COMPLETED	67287
Mar. 12, 2008	ASSIGNED TO LIE	67287
Feb. 20, 2008	APPROVED FOR PUB - PRINCIPAL REGISTER	
Feb. 20, 2008	ASSIGNED TO EXAMINER	72506
Feb. 01, 2008	TEAS/EMAIL CORRESPONDENCE ENTERED	88889
Feb. 01, 2008	CORRESPONDENCE RECEIVED IN LAW OFFICE	88889
Feb. 01, 2008	TEAS RESPONSE TO OFFICE ACTION RECEIVED	
Dec. 17, 2007	NON-FINAL ACTION MAILED	
Dec. 14, 2007	NON-FINAL ACTION WRITTEN	73358
Dec. 07, 2007	ASSIGNED TO EXAMINER	73358
Sep. 18, 2007	NEW APPLICATION ENTERED IN TRAM	

Maintenance Filings or Post Registration Information

Affidavit of Continued Use: Section 8 - Accepted

Affidavit of Incontestability: Section 15 - Accepted

TM Staff and Location Information

TM Staff Information - None

File Location

Current Location: TMO LAW OFFICE 100 - EXAMINING
ATTORNEY ASSIGNED

Date in Location: Mar. 18, 2016

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Mark: THE NEO-FUTURISTS

THE NEO-FUTURISTS

US Serial Number: 86665703

Application Filing Date: Jun. 17, 2015

US Registration Number: 4889382

Registration Date: Jan. 19, 2016

Filed as TEAS RF: Yes

Currently TEAS RF: Yes

Register: Principal

Mark Type: Service Mark

TM5 Common Status Descriptor:



LIVE/REGISTRATION/Issued and Active

The trademark application has been registered with the Office.

Status: Registered. The registration date is used to determine when post-registration maintenance documents are due.

Status Date: Jan. 19, 2016

Publication Date: Nov. 03, 2015

Mark Information

Mark Literal Elements: THE NEO-FUTURISTS

Standard Character Claim: Yes. The mark consists of standard characters without claim to any particular font style, size, or color.

Mark Drawing Type: 4 - STANDARD CHARACTER MARK

Goods and Services

Note: The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis ((..)) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- Asterisks *..* identify additional (new) wording in the goods/services.

For: Provision of facilities for theatrical performances; Entertainment services in the nature of theater productions; Educational services, namely, conducting classes, seminars, conferences and workshops in the field of theater

International Class(es): 041 - Primary Class

U.S Class(es): 100, 101, 107

Class Status: ACTIVE

Basis: 1(a)

First Use: Feb. 14, 1992

Use in Commerce: Feb. 14, 1992

Basis Information (Case Level)

Filed Use: Yes

Currently Use: Yes

Amended Use: No

Filed ITU: No

Currently ITU: No

Amended ITU: No

Filed 44D: No

Currently 44D: No

Amended 44D: No

Filed 44E: No

Currently 44E: No

Amended 44E: No

Filed 66A: No

Currently 66A: No

Filed No Basis: No

Currently No Basis: No

Current Owner(s) Information

Owner Name: The Neo-Futurists
Owner Address: 5153 N ASHLAND AVENUE
CHICAGO, ILLINOIS UNITED STATES 60640
Legal Entity Type: CORPORATION

State or Country ILLINOIS
Where Organized:

Attorney/Correspondence Information

Attorney of Record

Attorney Name: Gary A. Pierson

Attorney Primary gary@piersonwells.com
Email Address:

Attorney Email Yes
Authorized:

Correspondent

Correspondent GARY A. PIERSON
Name/Address: Pierson Wells
3408 Wisconsin Ave
Saint Louis, MISSOURI UNITED STATES 63118-3247

Phone: 314-276-3872

Correspondent e- gary@piersonwells.com loren@piersonwells.com
mail:

Correspondent e- Yes
mail Authorized:

Domestic Representative - Not Found

Prosecution History

Date	Description	Proceeding Number
Jan. 19, 2016	REGISTERED-PRINCIPAL REGISTER	
Nov. 03, 2015	OFFICIAL GAZETTE PUBLICATION CONFIRMATION E-MAILED	
Nov. 03, 2015	PUBLISHED FOR OPPOSITION	
Oct. 14, 2015	NOTIFICATION OF NOTICE OF PUBLICATION E-MAILED	
Sep. 24, 2015	APPROVED FOR PUB - PRINCIPAL REGISTER	
Sep. 24, 2015	ASSIGNED TO EXAMINER	82415
Jun. 23, 2015	NEW APPLICATION OFFICE SUPPLIED DATA ENTERED IN TRAM	
Jun. 20, 2015	NEW APPLICATION ENTERED IN TRAM	

TM Staff and Location Information

TM Staff Information - None

File Location

Current Location: PUBLICATION AND ISSUE SECTION

Date in Location: Jan. 19, 2016

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Mailed: October 20, 2008

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Bright House Networks LLC

Serial No. 76663959

Pamela A. Rask of Sabin, Bermant & Gould for Bright House Networks LLC.

Michael Webster, Trademark Examining Attorney, Law Office 102 (Karen M. Strzyz, Managing Attorney).

Before Hairston, Cataldo and Wellington, Administrative Trademark Judges.

Opinion by Wellington, Administrative Trademark Judge:

On August 1, 2006, Bright House Networks LLC applied to register the mark BRIGHT KIDS NETWORK and design, as reproduced below,



for "educational services in the nature of providing after-school programs for children and young adults

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featuring seminars, workshops and meetings" in International Class 41.¹

The trademark examining attorney has refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), in view of the mark THE BRIGHT KIDS RESOURCE, INC. (in standard character form) for "education services, namely, providing to parents of bright and highly able children intellectually stimulating resources, activities, seminars, and workshops in the field of parenting."² The cited registration is on the Supplemental Register. It is the examining attorney's position that applicant's mark so resembles the registered mark that, as used in connection with the identified services, it is likely to cause confusion, to cause mistake, or to deceive.

In addition, the trademark examining attorney has refused registration in view of applicant's failure to comply with the requirement for a disclaimer of BRIGHT KIDS NETWORK under Section 6(a) of the Trademark Act.

When the refusals were made final, applicant filed this appeal. Applicant and the examining attorney have filed briefs. We affirm the refusal based on a requirement

¹ Serial No. 76639959, based on an allegation of a bona fide intent to use the mark in commerce under Section 1(b).

² Registration No. 3102488 issued June 6, 2006.

for a disclaimer; however, we reverse the refusal based on a likelihood of confusion.

As a preliminary matter, we note the examining attorney argues in his brief that applicant "has not provided any arguments in its brief or request for reconsideration in response to the disclaimer requirement." Brief, (unnumbered, p. 11). He concludes that applicant has "waived its position regarding the requirement." We disagree. In its brief, applicant states that it has "responded with arguments against the disclaimer, noting the overall mark in the context of [applicant's] services is at least suggestive." Brief, p. 5. And, in its concluding paragraph, applicant specifically requests the Board "to reverse the examining attorney's decision...to require a disclaimer of 'BRIGHT KIDS NETWORK'." Brief, p. 6. Based on these statements, we do not find that applicant has conceded the disclaimer requirement.

Disclaimer

As provided in Section 6(a) of the Trademark Act, the Director may require the applicant to disclaim an unregistrable component of a mark otherwise registrable. A component of a mark is unregistrable if, when used in connection with applicant's goods or services, it is merely

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descriptive of the goods or services under Section 2(e)(1) of the Trademark Act.

The examining attorney argues that BRIGHT KIDS NETWORK is merely descriptive of applicant's services. In support of this contention the examining attorney submitted the definition of "bright"; copies of fifteen use-based, third-party registrations for marks used in connection with educational services, each of which includes a disclaimer of "NETWORK" or is on the Supplemental Register; and over a dozen article excerpts containing the phrase "bright kid(s)" used in the context of describing intelligent children.

Based on the evidence of record, we find that the phrase BRIGHT KIDS NETWORK is merely descriptive of applicant's educational services for children and young adults. Specifically, the phrase describes that applicant's services are geared to "bright kids" (or gifted and intelligent children) and involve or comprise a "network" (or interconnected group). As a result, we find that BRIGHT KIDS NETWORK merely describes a feature or characteristic of applicant's services, namely, that they provide an interconnected group of after-school programs for gifted children and young adults. Consumers of applicant's services, upon viewing applicant's mark in

connection with the recited services, would readily perceive the phrase BRIGHT KIDS NETWORK as describing the services.

In view of the above, we find the phrase BRIGHT KIDS NETWORK is merely descriptive of applicant's educational services. Accordingly, the phrase must be disclaimed.

Likelihood of Confusion

Our determination of the issue of likelihood of confusion is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also, *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003).

In this case, we think the *du Pont* factor involving the strength of the cited registration, or rather the lack of strength, plays a significant role in our analysis. The cited registration, as noted above, is on the Supplemental Register. There is no question that a mark registered on the Supplemental Register may be cited as a Section 2(d) bar to the registration of an applicant's mark. See *In re The Clorox Co.*, 578 F.2d 305, 198 USPQ 337 (CCPA 1978); *In re Hunke & Jochheim*, 185 USPQ 188 (TTAB 1975). However, marks registered on the Supplemental Register are presumed

to have been (at least as of the time of registration) merely descriptive at a minimum, and they therefore are deserving of a lesser scope of protection than arbitrary or suggestive marks registered on the Principal Register. *Id.* As the Court explained in *Sure-Fit Products Company v. Saltzson Drapery Company*, 254 F.2d 158, 117 USPQ 295, 297 (CCPA 1958):

It seems both logical and obvious to us that where a party chooses a trademark which is inherently weak, he will not enjoy the wide latitude of protection afforded the owners of strong trademarks. Where a party uses a weak mark, his competitors may come closer to his mark than would be the case with a strong mark without violating his rights. The essence of all we have said is that in the former case there is not the possibility of confusion that exists in the latter case.

Accordingly, the level of descriptiveness of a cited mark on the Supplemental Register may influence the conclusion that confusion is likely or unlikely. Indeed, in such cases, the scope of protection accorded to them has been consequently narrow, so that likelihood of confusion has normally been found only where the marks and goods are substantially similar. *In re Hunke & Jochheim, supra.*; see also, *In re Smith and Mehaffey*, 31 USPQ2d 1531 (TTAB 1994).

Keeping the above in mind, we turn now to the *du Pont* factor involving the level of similarity or dissimilarity of the marks. We must determine whether applicant's mark,

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BRIGHT KIDS NETWORK (in stylized letters and with a design), and registrant's mark, BRIGHT KIDS RESOURCE, INC., when compared in their entireties, are similar or dissimilar in terms of sound, appearance, connotation and commercial impression.

As to appearance and sound of the marks, the obvious similarity between the marks is the common element, BRIGHT KIDS, which appears first in both marks. However, considering the marks in their entireties, we must also take into account the dissimilarities, namely, the addition of RESOURCE, INC. at the end of the registered mark, and applicant's use of NETWORK at the end of its mark, the concentric circles design, and the boxed letters. We agree with the examining attorney that any differences in stylization or lowercase letters is immaterial inasmuch as the cited registration appears in typed letters and thus may be appear, in use, in lowercase letters or the same stylized format as applicant's.

In terms of connotation and commercial impression, we again find the respective marks to be similar to the extent that the common phrase, BRIGHT KIDS, will be understood as meaning intelligent or gifted children. However, we agree with applicant that when the marks are considered in their entireties and in connection with their respective

services, the connotations and commercial impressions are distinguishable. That is, registrant's mark connotes a "resource" or tool for parents in that registrant offers educational workshops and seminars on parenting gifted children; on the other hand, applicant's mark connotes a "network" or system by which it provides its after school educational programs for children and young adults.

On balance, we find that the marks are more dissimilar than similar. Accordingly, the first *du Pont* factor weighs against a finding of likelihood of confusion.

The second *du Pont* factor requires us to determine the similarity or dissimilarity of the services as recited in the application and in the cited registration. Here, we find that the services may be distinguished in that applicant is essentially rendering after school programs for children or young adults whereas registrant is rendering parenting workshops and seminars. The ultimate recipients of the educational services are certainly different. Obviously, the subject matter of the educational services will likewise be different, i.e., applicant's after school programs will not include parenting instruction. In this respect, we note there is no evidence to suggest that consumers would believe that the two services would be rendered by the same entity.

Nonetheless, as the examining attorney pointed out, there is some relationship between the services because they both involve providing educational services and, as the examining attorney pointed out, there is the possibility that parents may send their children to applicant's after-school programs while learning parenting skills for their "bright and highly able children" through registrant's workshops and seminars.

Ultimately, we find that the services of applicant and registrant are related. That factor weighs in favor of a finding of likelihood of confusion.

Under the third *du Pont* factor, we find that applicant's services and registrant's services would be marketed in the same trade channels and to the same classes of purchasers. There are no restrictions or limitations in the respective recitations of services, so we must presume that the services are marketed in all normal trade channels for such services and to all normal classes of purchasers for such services, namely, parents. The third *du Pont* factor weighs in favor of a finding of likelihood of confusion.

Weighing all of the evidence of record as it pertains to the relevant *du Pont* factors, and keeping in mind the narrowed scope of protection to be afforded weak marks

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registered on the Supplemental Register, we conclude that there is no likelihood of confusion. The marks are dissimilar when viewed in their entireties and as applied to the respective services. The services themselves, albeit falling under the umbrella of educational services, are also different in that applicant's educational services are for children and registrant's services are aimed at parents of highly able children. When we consider the narrow scope of protection to be accorded to the cited mark, and the cumulative differences in the marks and services, we find that there is no likelihood of confusion.

Decision: The refusal to register based on a likelihood of confusion with Registration No. 3102488 is reversed.

The requirement for a disclaimer under Trademark Act Section 6(a), and the refusal of registration in the absence of a disclaimer, is affirmed. However, if applicant submits the required disclaimer of BRIGHT KIDS NETWORK to the Board within thirty days, this decision will be set aside as to the affirmance of the disclaimer requirement, and the application then shall proceed to

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publication.³ See Trademark Rule 2.142(g), 37 C.F.R.
§2.142(g).

³ The standardized printing format for the required disclaimer text is as follows: "No exclusive right to use BRIGHT KIDS NETWORK is claimed apart from the mark as shown." TMEP § 1213.08(a) (4th ed. April 2005).

**THIS OPINION IS
NOT A PRECEDENT
OF THE TTAB**

*Decision Mailed:
October 10, 2008
GDH/gdh*

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re NeoPhotonics Corporation

Serial No. 78331853

Irene Eckert and Kyle T. Peterson of Patterson, Thunte, Skaar & Christensen for NeoPhotonics Corporation.

Won T. Oh, Trademark Examining Attorney, Law Office 114 (K. Margaret Le, Managing Attorney).

Before Hohein, Kuhlke and Cataldo, Administrative Trademark Judges.

Opinion by Hohein, Administrative Trademark Judge:

NeoPhotonics Corporation is the owner of an application to register the mark "NEO" on the Principal Register in standard character form for "optical network components, namely, lasers, detectors, cables, resonators, connectors, filters, phase-shifters, and splitters, all for use in communications networks" in International Class 9.¹

Registration has been finally refused under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that

¹ Ser. No. 78331853, filed on November 22, 2003, which is based on an allegation of a bona fide intention to use such mark in commerce.

applicant's mark, when applied to its goods, so resembles the mark "NEO," which is registered on the Principal Register by the same registrant in standard character form² and in the stylized format reproduced below³

NEO

for, in each instance, the following goods in International Class 9, as to be likely to cause confusion, or to cause mistake, or to deceive:

television, video and audio signal processing, switching and generating equipment, namely, frame synchronizers, audio synchronizers, audio delays, audio embedders/deembedders, audio processors, logo generators and inserters, syncgenerators and inserters, time code generators and inserters, video and audio distribution and processing amplifiers, analog to digital converters, digital to analog converters, color encoders and decoders, clock system drivers, clock displays, automation system comprising computer hardware and software for controlling, monitoring, adjusting, optimizing or operating the aforesaid goods, and broadcast facilities; video and audio noise reducers, video and audio compression systems, namely[,] computer software, hardware and multi-rate coder-decoders, codecs, for decreasing audio, video, television, or data file size or transmission bandwidth and decoding or decompressing compressed content to substantially restore the original audio, video, television or data content; test and reference generators, format converters, converters of standard television and video signals to and from high definition formats, aspect ratio converters, closed caption and other ancillary data

² Reg. No. 3,081,094, issued on April 18, 2006, which sets forth a date of first use anywhere and in commerce of April 21, 2001.

³ Reg. No. 3,081,095, issued on April 18, 2006, which sets forth a date of first use anywhere and in commerce of June 26, 1992; renewed.

processing equipment, namely, computer hardware, software, and electronic equipment for the insertion, deletion, and/or modification of ancillary data associated with video, audio, or television content; multiplexers, embedders, deembedders and demultiplexers, routers, switchers and switching routers, equipment enclosures, remote control panels, and computer software for controlling and monitoring the aforesaid goods, all for industrial use.

Applicant has appealed and briefs have been filed.⁴ We reverse the refusal to register.

⁴ Referring, in its initial brief, to the statement in its request for reconsideration of the final refusal that "[l]ists of distributors and outlets ... can be found on the Registrant's and Appellant's web sites," applicant adds in its initial brief that, "[n]evertheless, the lists of distributors and outlets for Registrant's goods (Exhibit A) and Appellant's goods (Exhibit B) are attached hereto." While the Examining Attorney, in denying the request for reconsideration, made no mention of either applicant's reference to lists of distributors and outlets or the websites on which such allegedly could be found, in his brief the Examining Attorney has objected to consideration of applicant's Exhibits A and B on the basis that such evidence is untimely under Trademark Rule 2.142(d) because it was not submitted prior to the filing of the appeal. Although applicant, in its reply brief, contends that such evidence was made of record with its request for reconsideration because it had "directed the Examining Attorney to the web sites of the Registrant and the Appellant with respect to the lists of distributors and outlets, we sustain the Examining Attorney's objection to the printed lists furnished with applicant's initial brief. As stated in *In re Planalytics Inc.*, 70 USPQ2d 1454, 1457 (TTAB 2004), "[a] mere reference to a website does not make the information of record," the Board pointing out, among other things, that:

Regarding website information, it is important that the party actually print out the relevant information and [timely] supply it to the examining attorney for several reasons. First, applicant, by referring the examining attorney to its website, acknowledges that there is relevant information on its website. It is applicant's responsibility to provide the information to the examining attorney. Websites often contain voluminous information and links to other websites. ... [T]he applicant [is] to provide information, not simply to send the examining attorney on a scavenger hunt through a website in search of relevant information.

In addition, ... [i]nformation on websites is transitory and subject to change at any time at the owner's discretion. If applicant intended to put the relevant portions of the website in the record, it is not clear what

Our determination under Section 2(d) is based on an analysis of all of the facts in evidence which are relevant to the factors bearing on the issue of whether there is a likelihood of confusion. In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 568 (CCPA 1973). See also In re Majestic Distilling Co., 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). However, as indicated in Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976), in any likelihood of confusion analysis, two key considerations are the similarity or dissimilarity in the goods at issue and the similarity or dissimilarity of the respective marks in their entireties.⁵ See also In re Dixie Restaurants Inc., 105 F.3d 1405, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997). Here, inasmuch as

is in the record. If applicant's ... [action] were to be considered sufficient, it would raise an issue as to what a reviewing tribunal is allowed to consider. Would we be permitted to consider any information on the website regardless of when it was posted?

Finally, while we cast no aspersions on applicant's intentions in this case, we observe that applicant's ... [action] is fraught with potential for abuse. In effect, an applicant can deflect the examining attorney from information it has in its possession by simply referring the examining attorney to its website. An applicant controls its own website. To the extent that there is information on the website that is harmful to its claim of registrability, applicant has time to remove that information before it responds to the examining attorney's requirement for information. Second, as discussed above, websites are transitory, and it is not clear what information is on the website at any given time.

70 USPQ2d at 1458.

⁵ The court, in particular, pointed out that: "The fundamental inquiry mandated by §2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks." 192 USPQ at 29.

applicant's mark and registrant's mark are identical⁶ in all respects,⁷ the focus of our inquiry is accordingly on the similarity or dissimilarity of the respective goods, along with the related factors of the similarity or dissimilarity of established, likely-to-continue trade channels and the conditions under which and buyers to whom sales are made, i.e. "impulse" versus careful, sophisticated purchasing.

As the Examining Attorney properly notes in his brief, where the marks at issue are identical, as is the case herein, "the relationship between the [respective] goods ... need not be as close to support a finding of likelihood of confusion as might apply where differences exist between the marks," citing *In re Opus One Inc.*, 60 USPQ2d 1812, 1815 (TTAB 2001); *Amcor, Inc. v. Amcor Industries, Inc.*, 210 USPQ 70, 78 (TTAB 1981); and TMEP Section 1207.01(a) (5th ed. 2007). Thus, as the Examining Attorney also accurately observes, while it is well settled that goods need not be identical or even competitive in nature in order to support a finding of likelihood of confusion, it is still the case that the goods must be related in some manner

⁶ Because applicant's mark is in standard character form (which was formerly known as typed form), it includes any reasonable manner of display thereof, including the stylized format utilized by registrant. See, e.g., *Phillips Petroleum Co. v. C. J. Webb, Inc.*, 442 F.2d 1376, 170 USPQ 35, 36 (CCPA 1971) [a mark registered in standard character or typed format is not limited to the depiction thereof in any special form]; and *INB National Bank v. Metrohost Inc.*, 22 USPQ2d 1585, 1588 (TTAB 1992) ["[a]s the *Phillips Petroleum* case makes clear, when [an] applicant seeks a typed or block letter registration of its word mark, then the Board must consider all reasonable manners in which ... [the word mark] could be depicted"].

⁷ Applicant, as the Examining Attorney accurately observes in his brief, "does not contest that its mark is identical to the registered marks."

and/or that the circumstances surrounding their marketing are such that they would be likely to be encountered by the same persons under situations that would give rise, because of the marks employed in connection therewith, to the mistaken belief that they originate from or are in some way associated with the same producer or provider. See, e.g., In re Opus One Inc., 60 USPQ2d 1812, 1815 (TTAB 2001); Monsanto Co. v. Enviro-Chem Corp., 199 USPQ 590, 595-96 (TTAB 1978); and In re International Telephone & Telegraph Corp., 197 USPQ 910, 911 (TTAB 1978).

The Examining Attorney, in this regard, maintains that applicant's goods are "sufficiently related" to registrant's goods because, as evidenced by copies of the excerpts he has made of record from "several websites showing that the same fiber optic networks can be used both for communication services and television broadcast" services, it is the case that "applicant's goods that are used in optic[al] communication[s] networks may also be used for television signal processing." Specifically, the Examining Attorney has introduced pages from the "Verizon" website advertising that its "Verizon FiOS TV" is "[p]owered by the most advanced fiber-optic network straight to your home" and that such network also includes "FiOS Internet" service; that the "Comcast" website offers "BUNDLED PACKAGES" of "DIGITAL CABLE" television services, "HIGH-SPEED INTERNET" services and "DIGITAL VOICE" services; and that the "SureWest" website likewise touts "bundled offerings [which] include an array of advanced digital TV, high-speed Internet, local and long-distance telephone, and wireless services" over its "fiber optic network." Moreover,

absent the evidence attached to applicant's initial brief, the Examining Attorney insists that "there is nothing in the record that supports applicant's contention that its goods are in separate channels of trade from the registrant's goods."

Furthermore, the Examining Attorney contends that even if the respective purchasers of applicant's and registrant's goods were the same or similar and were also considered to be sophisticated purchasers in view of the highly technical nature of the respective goods, the fact that customers for such goods are knowledgeable in a particular field does not necessarily mean that they are sophisticated or discriminating in the field of trademarks or immune from source confusion, citing *In re Decombe*, 9 USPQ2d 1812, 1814-15 (TTAB 1988); and *In re Pellerin Milnor Corp.*, 221 USPQ 558, 560 (TTAB 1983). Finally, the Examining Attorney asserts that he has "provided evidence that the communications industry and ... television broadcasting services are highly related." According to the Examining Attorney:

The evidence [of record] shows that the [respective] goods are in the same channels of trade because it shows the purchasers of applicant's goods are the same purchasers of registrant's goods. These websites shows [sic] the class of purchasers for both applicant's goods and the registrant's goods. Companies such as Comcast[®], Verizon[®] and Surewest[®] will purchase applicant's optical network components to build the infrastructure to provide the broadcast services that ... [they] will provide with the registrant's goods.

It is well established that the issue of likelihood of confusion must be determined on the basis of the goods as they are set forth in the application and the cited registration.

See, e.g., Octocom Systems Inc. v. Houston Computer Services Inc., 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990); Canadian Imperial Bank of Commerce, N.A. v. Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1813, 1815-16 (Fed. Cir. 1987); CBS Inc. v. Morrow, 708 F.2d 1579, 218 USPQ 198, 199 (Fed. Cir. 1983); Squirtco v. Tomy Corp., 697 F.2d 1038, 216 USPQ 937, 940 (Fed. Cir. 1983); and Paula Payne Products Co. v. Johnson Publishing Co., Inc., 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973). However, even though the marks at issue are identical, it is still the case that where, as here, the respective goods on their face are distinctly different, it is incumbent upon the Examining Attorney to present evidence showing that there is at least a viable commercial relationship between the respective goods in order to establish that contemporaneous use of the marks at issue would be likely to cause confusion. See, e.g., In re Opus One Inc., supra, citing In re Shell Oil Co., 992 F.2d 1204, 26 USPQ2d 1687, 1689-91 (Fed. Cir. 1993). We agree with applicant that, in this instance, the Examining Attorney has failed to meet his burden of proof.

Applicant, by way of background, asserts in its initial brief that, as to the respective goods, it is the case that (italics in original):

Registrant's goods (hardware) are used in association with processing, switching and generating television, video and audio signals. The products, as noted in the identification of goods, are electronics that are generally used in the production of television and video programming, such as electronic devices used to synchronize audio with the appropriate video/picture frame (frame synchronizers). The goods associated

with Registrant's mark are not the signals themselves; provision of television and radio programmes [sic] belongs to International Class 041. As noted in Registrant's identification of goods, Registrant's goods can be used to create and insert a logo in the programming (log generators and inserter), to generate time codes and insert the time codes (time code generators and inserters), to convert standard television and video signals to and from high definition formats (format converters) and to convert an aspect ratio picture to another aspect ratio picture (aspect ratio converter).

Registrant's goods are generally used in broadcast production and post production facilities, for example, news control rooms where news programs are created, including inserting pre-recorded video. These facilities require Registrant's analog to digital converters and digital to analog converters to produce their products. These facilities actually make the programming, and are not merely distributors of programming. As noted above, the goods/equipment associated with Registrant's mark is used to synchronize frames of video with audio, to generate and insert logos for placement on programming (e.g. NBC peacock), and includes video and audio compression systems, and closed caption processing equipment, for example. Registrant provides its products to create a fully integrated environment for the streamlined production and processing of content in professional television program production and video program operations. The Registrant's goods are not associated with optical network components.

Appellant's mark is associated with *optical* network components, namely, lasers, detectors, cables, resonators, connectors, filters, phase-shifters, and splitters, all for use in communications networks. ... Appellant's goods are intended for use in fiber optic networks (infrared wavelengths, waveguides, transport of information). It is noteworthy that Appellant's goods are *optical* network components, that is, components associated with *optical* fibers, as indicated in the identification of goods' use of the term "*optical*." Hence, it is understood since the goods are all associated with an

optical network, that the components would all be optically-oriented, for example, the splitter would likely be a beam splitter, because the splitter is associated with an *optical* network.

Applicant's goods are utilized in communications networks, such as computer and communications networking, using optical fibers. Applications include fiber optic connections to homes and buildings linking computers, and high speed Internet connections. Appellant's goods are based upon light technology. Hence, the goods associated with the two marks are very different, are based on different technology, and are used for very different applications and purposes.

In view thereof, applicant persuasively argues in its initial brief that there simply is not a viable commercial relationship between the goods at issue (*italics in original*):

As discussed above, Registrant's goods of television, video and audio signal processing, switching, and generating equipment, as well as the other goods listed in the identification of goods, are distinct as compared to Appellant's goods of *optical network components*, namely, lasers, detectors, cables, resonators, connectors, filters, phase-shifters, and splitters. The products associated with Registrant's mark do not compete with the goods associated with Appellant's mark. The nature of the products is also distinct, with Registrant's good (hardware) generally used in the production of programming, as compared to Appellant's goods (*optical* components) generally used in communications networks. These factors weigh against a finding of a likelihood of confusion.

We also concur with applicant's assertion that, in light of the differences apparent from the goods on their face and the lack of any evidence to the contrary from the Examining Attorney, the respective goods would be marketed and sold in different channels

of trade to different customers. Specifically, as applicant contends in its initial brief:

The channels of trade for the goods associated with Registrant's marks and Appellant's mark are distinct. The channels of trade are distinct, to a large extent, because the goods are distinct. Registrant's goods are sold through specialty outlets. The specialty outlets include professional post resellers, broadcast resellers, videotek [sic] resellers, and system integrators. These specialty outlets may provide an integrated system (e.g. a digital master control panel for a television station) that incorporates the Registrant's products or may make equipment recommendations or sales that include Registrant's products.

Applicant's goods are sold through specialty distributors to the communications market.

The distinct nature of the channels of trade for the goods associated with Registrant's goods, as compared to the channels of trade associated with Appellant's goods, works against finding a likelihood of confusion.

Again, the Examining Attorney has offered no evidence to suggest to the contrary.

Additionally, applicant points out in its initial brief that the actual and prospective purchasers for the respective goods are dissimilar. In particular, applicant maintains that (*italics in original*):

The purchasers of the products associated with the Registrant's marks are distinct from the purchasers of the goods associated with the Appellant's mark. The purchaser's [sic] of the goods associated with the Registrant's mark are, for example, television studios (programming production facilities), professional video facilities involved in post production, editing, and so on, and businesses supplying systems (e.g., system integrators) to facilities such as

corporations (e.g. for a media room) and television stations. Here, the purchasers would exhibit a high degree of care in purchasing the goods because, for example, the goods must be fit for the purpose (e.g. as part of a post-production system for synchronizing audio with the video; converting an aspect ration picture to another aspect ration picture; providing closed captioning), and must be compatible with the equipment already in place. Hence, if the facility does not have the expertise, then a system integrator may be involved in recommending equipment and assisting the television studio, video post-production studio, or other such facility, in the purchase of the proper equipment. In either case, with assistance or not, the purchaser of Registrant's goods is one knowledgeable in the goods and a sophisticated purchaser.

Further, the cost associated with the Registrant's goods would be relatively expensive. It is important to note that the Registrant's goods are directed to industrial use, not the home consumer, and hence the goods are directed to the professional user and not the home amateur. Thus, great care would be taken in making the purchase, at least due to considerations of cost, fitness for use, and compatibility with the other components in a production system.

Purchasers of Appellant's good are generally in the communications industry using the products (e.g. *optical* components), for example, to network computers or create high speed Internet connections with computers. Here, too, the purchasers would exhibit a high degree of care ... to ensure that the product is capable of performing the desired function, as expected. The cost of the product and the network it may be part of may be reasonably expensive, and "down time" may be even more expensive.

As is readily apparent from applicant's arguments, its goods and those of registrant are distinctly different products which would be marketed through specifically different channels of trade to different classes of highly sophisticated purchasers.

In consequence thereof, it is highly unlikely that the respective goods would be encountered by the same purchasers under circumstances which could give rise to the mistaken belief that such goods originate from a common source, notwithstanding the identity of the marks at issue. We agree instead with applicant that the evidence furnished by the Examining Attorney fails to substantiate his contentions that "the communications industry and ... television broadcasting services are highly related" and that, in particular, the respective goods "are in the same channels of trade because ... [such evidence] shows the purchasers of applicant's goods are the same purchasers of registrant's goods" in that "[c]ompanies such as Comcast®, Verizon® and Surewest® will purchase applicant's optical network components to build the infrastructure to provide the broadcast services that ... [they] will provide with the registrant's goods."

Specifically, while applicant concedes in its reply brief that the previously mentioned pages from the "Verizon," "Comcast" and "SureWest" websites "may show use of a fiber optic network for *delivering* television signals and providing access to the Internet, for example," applicant also accurately observes that "the website printouts do not show use of Appellant's products for television signal *processing*" (italics in original). Thus, as applicant notes, "a fiber optic network may carry television signals, for example, to a home, but [it] does not *process* television signals" (italics in original). Applicant's goods, therefore, find applications which "include fiber optic connections to homes and buildings linking computers, and high

speed Internet connections," serving "as a conduit facilitating passage and delivery of these signals." By contrast, registrant's goods, as applicant observes in its reply brief, "focus more on television signal processing" and, as previously mentioned, "are used in professional video facilities involved in post-production, editing, and so on; in newsroom control rooms, and generally in the *production* of television and video programming, not in *distribution* of television programming" (*italics in original*). As a consequence of the fact that applicant's goods pertain to optical components for communications networks while registrant's goods relate to television signal processing, applicant persuasively points out in its reply brief that:

As such, potential purchasers of Appellant's goods would likely be companies in the field of communications who are concerned with communication transmission (i.e. Comcast[®], Verizon[®] and Surewest[®]) whereas potential purchasers of Registrant's goods would likely be involved in television production and editing (NBC, Worldwide Pants Incorporated). Further, the Examining Attorney has not shown that companies such as Comcast[®], Verizon[®] and Surewest[®] use ... or require equipment like registrant's goods to provide television programs Consequently, the Examining Attorney has not shown that the purchasers of Appellant's goods are the same purchasers of Registrant's goods.

Similarly, while the Examining Attorney also made of record pages from the websites of Ram Electronics, NexTag and Communications & Energy Corporation illustrating various products used with audio/video, cable television and satellite television systems such as diplexers, antennas, multiswitches, signal splitters, RF splitters, modulators, amplifiers and filters, and

cables and F-connectors, applicant accurately observes in its initial brief that the goods shown "are made of coaxial cable or are for use with coaxial cable" and that "[n]owhere in the supplied pages are *optical fibers* noted or *optical network components* (italics in original). Thus, "the supplied pages do not address Appellant's goods" and hence fail to demonstrate any relationship thereof to goods like those of registrant.

It accordingly appears, as set forth by applicant in its initial brief, that as to the evidence which is properly of record, the Examining Attorney "has misunderstood the nature of the Registrant's goods and Appellant's goods, and their respective uses." In particular, applicant tellingly notes that (underlining and italics in original):

The Examining Attorney appears to have mistaken the provision of services, such as television program distribution to the home and Internet connection to the home, with Registrant's and Appellant's *goods*. For example, the Comcast® web page ... shows that Comcast® offers cable television services, i.e., is a television program distributor, (which is distinct as compared to creating television programming and requiring Registrant's goods, such as a logo generator and inserter or an audio synchronizer). Further, companies may provide cable television services (that is, distribute television programming to the home), telephone service (to the home), and Internet connection (to the home). However, it is the services that may travel through similar channels of trade (through "the cable guy" and coaxial cable). This provision of services is distinct as compared to Registrant's and Appellant's goods, which each travel through different channels of trade.

Finally, even if the record contained evidence demonstrating that those who create television programming and/or

audio/video content, and hence would be likely to utilize registrant's goods in connection therewith, also maintain their own optical communications network, and thus would be likely to use applicant's goods as components thereof, it would still be the case, as set forth in, for instance, *Astra Pharmaceutical Products, Inc. v. Beckman Instruments, Inc.*, 718 F.2d 1201, 220 USPQ 786, 791 (1st Cir. 1983), that in order for a likelihood of confusion to exist, "it must be based on confusion of some relevant person; i.e., a customer or user, and there is always less likelihood of confusion where goods are ... purchased and used by highly specialized individuals after careful consideration." Here, it is manifest that none of the goods at issue are consumer items which would require the exercise only of ordinary care in their procurement. Instead, the commercial and industrial products at issue on their face are not only distinctly different goods sold for specifically different purposes, but they clearly would be bought only by highly knowledgeable, discriminating and sophisticated purchasers after thorough deliberation rather than on impulse. As our principal reviewing court has pointed out, such "sophistication is important and often dispositive because sophisticated end-users may be expected to exercise greater care." *Electronic Design & Sales Inc. v. Electronic Data Systems Corp.*, 954 F.2d 713, 21 USPQ2d 1388, 1392 (Fed. Cir. 1992).

We accordingly conclude on this record that in the absence of a showing of a viable commercial relationship between applicant's and registrant's goods, the contemporaneous use by

Ser. No. 78331853

applicant of its "NEO" mark in connection with "optical network components, namely, lasers, detectors, cables, resonators, connectors, filters, phase-shifters, and splitters, all for use in communications networks," would not be likely to cause confusion with registrant's use of the identical mark "NEO," in either standard character or stylized form, in connection with various items of "television, video and audio signal processing, switching and generating equipment ... for industrial use."

Decision: The refusal under Section 2(d) is reversed.

This Opinion is not a
Precedent of the TTAB

Mailed: May 8, 2017

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Cummings

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Serial No. 86566593

—
Travis D. Wilson of The Law Office of Travis D. Wilson
for Janet Cummings.

Sara N. Benjamin, Trademark Examining Attorney, Law Office 110,
Chris A. F. Pedersen, Managing Attorney.

—
Before Quinn, Wellington and Lykos,
Administrative Trademark Judges.

Opinion by Lykos, Administrative Trademark Judge:

On March 17, 2015, Janet Cummings (“Applicant”) filed an application to register in standard characters the mark THE CUMMINGS GRADUATE INSTITUTE FOR BEHAVIORAL HEALTH STUDIES, THE ONLY ACCREDITED DOCTOR OF BEHAVIORAL HEALTH PROGRAM on the Principal Register for services ultimately identified as “educational services, namely, providing courses of instruction in the field of behavioral health” in International Class 41.¹

¹ Application Serial No. 86566593, filed under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), alleging a bona fide intent to use the mark in commerce. Applicant has disclaimed the wording “GRADUATE INSTITUTE FOR BEHAVIORAL HEALTH STUDIES, THE

The Trademark Examining Attorney refused registration of Applicant's mark under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that Applicant's mark so resembles the registered marks below that, when used on or in connection with Applicant's identified services, it is likely to cause confusion or mistake or to deceive:²

Registration No. 2671773 for the mark BENJAMIN CUMMINGS on the Principal Register for "providing a website containing information related to teaching science, namely, life science, physical science, chemistry, health and kinesiology, biology, physics, astronomy" in International Class 41;³ and

Registration No. 3985327 for the mark NICHOLAS A. CUMMINGS BEHAVIORAL HEALTH PROGRAM on the Principal Register for "[e]ducational services, namely, providing courses of instruction in the field of behavioral health at the college, graduate and post-graduate level" in International Class 41 with a disclaimer of BEHAVIORAL HEALTH PROGRAM.⁴

When the refusal was made final, Applicant appealed. For the reasons set forth below, we affirm the Section 2(d) refusal as to both cited registrations.

I. Applicable Law

We base our determination under Section 2(d) on an analysis of all of the probative evidence of record bearing on a likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) ("*du Pont*"). *See also In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir.

ONLY ACCREDITED DOCTOR OF BEHAVIORAL HEALTH PROGRAM" apart from the mark as shown.

² Insofar as Applicant has now entered an acceptable disclaimer and identification of services, those requirements have now been withdrawn. 9 TTABVUE.

³ Registered January 7, 2003; renewed.

⁴ Registered June 28, 2011.

2003). In any likelihood of confusion analysis, however, two key considerations are the similarities between the marks and the similarities between the services. *See In re Chatam Int'l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944 (Fed. Cir. 2004); *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). These factors and others are discussed below.

A. The Marks

We commence with the first *du Pont* likelihood of confusion factor which involves an analysis of the similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression. *See Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005) (“*Palm Bay*”) (quoting *du Pont*, 177 USPQ at 567). Our analysis cannot be predicated on dissection of the involved marks. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014) (“*Stone Lion*”). Rather, we are obliged to consider the marks in their entirety. *Id.* *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.”).

Applicant argues that both registered marks are too dissimilar to be confused with her applied-for mark, pointing out that the marks are different in appearance and are “verbalized and heard differently.” Applicant’s Brief, p. 12; 4 TTABVue 16. With regard to connotation and commercial impression, Applicant contends that whereas

both cited marks BENJAMIN CUMMINGS and NICHOLAS A. CUMMINGS BEHAVIORAL HEALTH PROGRAM “create an identity, whether fictional or factual”, by contrast, “there is no evidence to prove that [Applicant’s use of CUMMINGS] in this context is solely associated with a surname, to the exclusion of all other interpretations.” *Id.* at 10-11; 4 TTABVUE 14-15. As Applicant elaborates, when used in connection with Applicant’s identified educational services, CUMMINGS could refer to any person who “is influential or inspired the method of education” or “refer to the geographic location of the school, e.g., Stanford University, Princeton University.” *Id.* In addition, Applicant criticizes the Examining Attorney for improperly focusing on the element which is identical to both cited marks while discounting the importance of the remaining wording. In Applicant’s view, the addition of the phrase GRADUATE INSTITUTE FOR BEHAVIORAL HEALTH STUDIES, THE ONLY ACCREDITED DOCTOR OF BEHAVIORAL HEALTH PROGRAM to her mark projects a distinct connotation and commercial impression from the cited marks.

The Examining Attorney counters by drawing a comparison with *Modern Shoe Co. v. B.B. Walker Shoe Co.*, 170 USPQ 530 (TTAB 1971) where the marks “WALKER” and “JOHNNIE WALKER” were found similar in commercial impression,. In her brief, she highlights the following passage:

We have here a surname “WALKER” and a full name “JOHNNIE WALKER”. The full name would represent an individual. The surname “WALKER” does not per se identify any particular individual but it does identify any and all persons who bear that surname, including “JOHNNIE WALKER”. And, it is not uncommon to identify an individual by a surname without reference to a first ... name, Thus,

“WALKER” and “JOHNNIE WALKER” could be regarded as one and the same individual. These names when used as marks will create the same impression ...

Id. at 531. Continuing, the Examining Attorney submits that the surname “CUMMINGS” presented without a given name could be regarded as referring to “NICHOLAS A. CUMMINGS” or “BENJAMIN CUMMINGS.”

We acknowledge the obvious differences in the marks in terms of sound and appearance. However, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on a consideration of the marks in their entireties. *Stone Lion*, 110 USPQ2d at 1161. Applicant’s and Registrants’ marks are comprised, either in whole or in part, of the surname CUMMINGS.⁵ See *Coca-Cola Bottling Co. of Memphis, Tennessee, Inc. v. Joseph E. Seagram & Sons, Inc.*, 188 USPQ 105, 106 (CCPA 1975) (“When one incorporates the entire arbitrary registered mark of another into a composite mark, inclusion in the composite mark of a significant nonsuggestive element does not necessarily preclude the marks from being so similar as to cause a likelihood of confusion.”). As it appears in Applicant’s mark, CUMMINGS is likely to be accorded more weight by consumers because the remaining wording is, at a minimum, descriptive of Applicant’s services as indicated by the disclaimer and is less likely to make an impact in the minds of consumers. See *In re Dixie Rests., Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997) (disclaimed matter that is

⁵ Given that CUMMINGS in the cited marks is preceded by a given name, we can infer that the meaning of CUMMINGS is that of a surname.

descriptive of or generic for a party's goods is typically less significant or less dominant when comparing marks). *See also In re Nat'l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 753 (Fed. Cir. 1985). Due to the shared common surname, the marks engender similar meanings and commercial impressions. As aptly put by the Examining Attorney:

It is clear that the two cited registrations may coexist because they identify two different, specific individuals. However, when the marks of applicant and the registrants are compared in their entireties, the applicant's mark may be seen as identifying both of those individuals with the surname CUMMINGS found in the registrations.

Examining Attorney's Brief, 6 TTABVue 14. Thus, when comparing the marks overall, we find that the involved marks are similar in connotation and commercial impression. In view of the forgoing, the first *du Pont* factor favors a finding that confusion is likely.

B. The Services

The next step in our analysis is a comparison of the services identified in Applicant's application vis-à-vis the services identified in the cited registrations, the second *du Pont* factor. *See Stone Lion*, 110 USPQ2d at 1161; *Octocom Systems, Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). *See also Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002).

It is well established that unrestricted identifications are presumed to encompass all services of the type described. *See In re Jump Designs, LLC*, 80 USPQ2d 1370, 1374 (TTAB 2006) (citing *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981)); *In re*

Linkvest S.A., 24 USPQ2d 1716, 1716 (TTAB 1992). Applicant’s “educational services, namely, providing courses of instruction in the field of behavioral health” are legally identical to “[e]ducational services, namely, providing courses of instruction in the field of behavioral health at the college, graduate and post-graduate level” as set forth in Registration No. 3985327. This is because Applicant’s courses of instruction in behavioral health could, as identified, be offered at any level.

With regard to Registration No. 2671773, it is settled that it is not necessary that the respective services be identical or even competitive in order to find that they are related for purposes of our likelihood of confusion analysis. The respective services need only be “related in some manner and/or if the circumstances surrounding their marketing [be] such that they could give rise to the mistaken belief that [services] emanate from the same source.” *Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012) (quoting *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1724 (TTAB 2007)). See also *In re Martin’s Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289, 1290 (Fed. Cir. 1984); *In re Melville Corp.*, 18 USPQ2d 1386, 1388 (TTAB 1991). Evidence of relatedness may include news articles and/or evidence from computer databases showing that the relevant services are used together or used by the same purchasers; advertisements showing that the relevant services are advertised together or sold by the same manufacturer or dealer; and/or copies of prior use-based registrations of the same mark for both applicant’s services and the services listed in the cited registrations. See, e.g., *In re Davia*, 110 USPQ2d 1810, 1817 (TTAB 2014) (finding pepper sauce and

agave related where evidence showed both were used for the same purpose in the same recipes and thus consumers were likely to purchase the products at the same time and in the same stores). The issue is not whether purchasers would confuse the services, but rather whether there is a likelihood of confusion as to the source of these services. *L’Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1439 (TTAB 2012); *In re Rexel Inc.*, 223 USPQ 830, 832 (TTAB 1984). The Examining Attorney made of record active third-party, used-based registrations showing that the same entity has registered a single mark identifying both educational courses as well as web content in that particular field. We note the following:

Reg. No. 3898801 for the mark PROJECT 18 and design on the Principal Register for “[e]ducation services, namely, providing classes, workshops, school health programs in the nature of lectures and workshops, public service announcements in the nature of lectures, and seminars in the fields of childhood obesity, behavioral health, healthy lifestyles, exercise and nutrition, and distribution of course materials in connection therewith; ...” in International Class 41, and “...providing a website featuring information on the subject of health, nutrition and childhood obesity ...” in International Class 44;

Reg. No. 4051676 for the standard character mark HEALING SEEKERS on the Principal Register for “[e]ducational services, namely, conducting workshops, seminars, webinars and teaching classes in the subject of traditional medicinal and alternative therapies, and plants and organisms used in and as traditional medicinal and alternative therapies, and conservation and environmental issues as they relate to traditional medicinal and alternative therapies, and medicinal plants and endangered species; ...” in International Class 41 and “[p]roviding a website featuring online nondownloadable videos in the fields of traditional medicinal and alternative therapies, plants and organisms used in and as traditional medicinal and alternative therapies and conservation and environmental issues as they relate to traditional medicinal and alternative therapies and medicinal plants and endangered species” in International Class 44;

Reg. No. 4197611 for the standard character mark SEDONA METHOD on the Principal Register for “educational services, namely, providing on-line e-

learning seminars in the field of emotional and stress relief methods and personal growth methods” in International Class 41 and “providing a website featuring health information regarding stress elimination, health and wellness” in International Class 44;

Reg. No. 4653496 for the standard character mark REFUEL on the Principal Register for “...arranging and conducting classes, seminars, courses, and workshops for entertainment and educational purposes in the fields of food, cooking, nutrition, health, exercise, diet, sleep, stress management, weight management, lifestyle, and medicine ...” in International Class 41 and “[p]roviding a website featuring information in the fields of nutrition, health, diet, sleep, stress management, weight management, and medicine; ...” in International Class 45; and

Reg. No. 4694794 for the standard character mark WHOLYFIT on the Principal Register for “[e]ducational services, namely, developing and conducting classes, seminars, conferences, workshops, retreats, presentations, and workouts in the fields of exercise, fitness, health, nutrition, weight loss, wellness and spirituality ...” in International Class 41 and “Providing information and consultation in the fields of health, nutrition, weight loss, and wellness” in International Class 44.

As a general proposition, although use-based third-party registrations alone are not evidence that the marks shown therein are in use or that the public is familiar with them, they nonetheless may have probative value to the extent they may serve to suggest that the services are of a kind that emanate from a single source. *See In re Infinity Broad. Corp.*, 60 USPQ2d 1214, 1217-18 (TTAB 2001); *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993); *In re Mucky Duck Mustard Co., Inc.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988). In addition, consumers taking courses in a particular field of study are likely to research topics in that field on the Internet, making these services complementary in nature.

In view thereof, we find that the services identified in the application and cited registrations are either legally identical or closely related and complimentary in

nature. Thus, the second *du Pont* factor also weighs in favor of finding a likelihood of confusion.

C. Conditions of Sale

We turn now to the conditions under which the services are likely to be purchased, *e.g.*, whether on impulse or after careful consideration, as well as the degree, if any, of sophistication of the consumers. Purchaser sophistication or degree of care may tend to minimize likelihood of confusion. Conversely, impulse purchases of inexpensive items may tend to have the opposite effect. *Palm Bay*, 73 USPQ2d at 1695.

Applicant argues that prospective consumers will “make well-researched and carefully considered research decisions” because the services involved are “considered assets in one’s personal and/or professional investment.” Applicant’s Brief, p. 15; 4 TTABVUE 19.

With regard to Registration No. 3985327, we can assume that college, graduate, and post-graduate level courses are offered at a relatively higher price point. However, the identifications in the application and cited Registration No. 2671773 include educational and content provision services offered at no specified price point, meaning that we must assume that the services are offered at all price levels. And as is common practice for content providers, consumers can access such services for free. That being said, we can assume that consumers are likely to exercise some degree of care in selecting educational services. We therefore deem this *du Pont* factor as slightly weighing against a likelihood of confusion.

D. Other Considerations

Applicant contends that because “Cummings” is her surname, she has the right to the trademark. To support her position she relies on the following passage from *Brennan’s, Inc. v. Brennan’s Restaurant LLC*, 360 F.3d 125, 69 USPQ2d 1939, 1943 (2d Cir. 2004) (“*Brennan’s*”):

While the law recognizes the unfairness of letting one person trade on the reputation or the name of another, at the same time it also recognizes that one’s surname given at birth creates associations attached to that name which identify the individual. As a consequence, courts generally are hesitant to afford strong protection to proper names, since to do so preempts others with the same name from trading on their own reputation. “To prevent all use of [a man’s personal name] is to take away his identity; without it he cannot make known who he is to those who may wish to deal with him; and that is so grievous an injury that courts will avoid imposing it, if they possibly can.” *Societe Vinicole de Champagne v. Mumm*, 143 F.2d 240, 241 (2d Cir. 1944) (per curiam). Cf. *Taylor Wine Co. v. Bully Hill Vineyards, Inc.*, 569 F.2d 731, 735-36 (2d Cir. 1978); *Conagra, Inc. v. Singleton*, 743 F.2d 1508, 1515 n.9 (11th Cir. 1984).

In that case, Brennan’s New Orleans restaurant sought a preliminary injunction on the grounds that the name Terrance Brennan’s Seafood & Chop House infringed its rights in the name Brennan’s and was likely to cause consumer confusion. After expedited limited discovery and a two-day hearing, the district court denied the motion for a preliminary injunction. On appeal, the U.S. Court of Appeals for the Second Circuit affirmed. In assessing the plaintiff’s infringement claim, the court did not apply the *du Pont* factors but rather the multi-factor test set forth in *Polaroid Corp. v. Polarad Elecs. Corp.*, 287 F.2d 492, 128 USPQ 411 (2d Cir. 1961).⁶ The court

⁶ This test requires an analysis of several non-exclusive factors, including: (1) the strength of the mark, (2) the degree of similarity between the two marks, (3) the competitive proximity of the products, (4) actual confusion, (5) the likelihood the plaintiff will bridge the gap, (6) the

found the geographic remoteness of the restaurants to be “critical.” *Brennan’s*, 69 USPQ2d at 1945. As the court explained,

In the restaurant industry, especially where individual restaurants rather than chains are competing, physical separation seems particularly significant to the inquiry into consumer confusion. Even in this age of rapid communication and travel, plaintiff faces a high hurdle to demonstrate that a single restaurant in New Orleans and a single restaurant in New York City compete for the same customers. That is particularly the case here where the dining services require a customer's physical presence and cannot rely, for instance, on Internet or mail-order sales.

By contrast, in Board *ex parte* appeals, to determine whether there is a likelihood of confusion, we examine the involved marks and goods or services as set forth in the application and cited registration(s) without regard to the manner of use in the marketplace. So, for example, geographic proximity is not a consideration. Due to these differing considerations, we cannot, as Applicant urges, conclude that a *per se* rule exists that surnames are entitled only to a limited scope of protection.⁷

II. Conclusion

We have carefully considered all evidence of record and Applicant’s arguments, even if not specifically discussed herein, as they pertain to the relevant *du Pont* factors.

The fourth *du Pont* factor does not favor a likelihood of confusion because given the personalized nature of educational services, consumers are likely to exercise a

defendant's good faith in adopting its mark, (7) the quality of the defendant's products, and (8) the sophistication of the purchasers. *Polaroid*, 128 USPQ at 413.

⁷ Perhaps on a developed factual record showing third-party use of CUMMINGS for the same or related services as set forth in the cited registrations we may have found otherwise.

relatively higher degree of care. Nonetheless, the first and second factors weigh in favor of finding a likelihood of confusion, and the remaining considerations discussed above is neutral. While there are instances where a single *du Pont* factor is dispositive, we do not think the fourth *du Pont* factor plays such a role here, given the similarity in the marks when compared as a whole as applied to legally identical or related services offered to the same classes of customers. *See HRL Associates, Inc. v. Weiss Associates, Inc.*, 12 USPQ2d 1819, 1823 (TTAB 1989), *aff'd*, 902 F.2d 1546, 14 USPQ2d 1840 (Fed. Cir. 1990) (similarities of goods and marks outweigh sophisticated purchasers, careful purchasing decision, and expensive goods). *See also Stone Lion*, 110 USPQ2d at 1162-63. Accordingly, we find that confusion is likely between Applicant's applied-for mark and the marks in each of the cited registrations in connection with the identified services.

Decision: The Section 2(d) refusal is affirmed.

Opinion by Wellington, Administrative Trademark Judge, concurring in part and dissenting in part:

I concur with the majority's ultimate conclusion that there is a likelihood of confusion between Applicant's mark and the registered mark NICHOLAS A. CUMMINGS BEHAVIORAL HEALTH PROGRAM (Reg. No. 3985327).

However, I am not persuaded that there is a likelihood of confusion between Applicant's mark and the registered mark, for the mark BENJAMIN CUMMINGS (Reg. No. 2671773) and would reverse the refusal with respect to this registration. In essence, I find the marks to be overall dissimilar, the respective services not

sufficiently related, and a certain level of consumer care due to the nature of the services, for there to be a likelihood of confusion.