

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Mark: ONE<sub>x</sub> WAN  
Applicant: Hitachi High Technologies America, Inc.  
Serial Number: 88/048,415  
Office Action Date: August 8, 2018  
Examining Attorney: Paula M. Mahoney, Law Office 119

**RESPONSE TO OFFICE ACTION**

On behalf of Hitachi High Technologies America, Inc. (“Applicant”), please consider the following response to the Office Action dated August 8, 2018.

**REMARKS**

**I. No Likelihood Of Confusion Exists Between Applicant’s Mark And The Registered Marks Cited By The Examining Attorney**

The Examining Attorney preliminarily refused registration of Applicant’s mark ONE<sub>x</sub> WAN in Classes 9 and 42 under Trademark Act Section 2(d), 15 U.S.C. § 1052(d). As the basis for the refusal, the Examining Attorney cited prior registrations owned by Avaya Inc. (“Registrant”) for AVAYA ONE-X (Reg. Nos. 3411046, 3411047, and 4726410) covering goods in Class 9.

Applicant respectfully requests reconsideration of the question of likelihood of confusion. All relevant factors, including the differences between the parties’ marks and goods/services, need to be considered in this likelihood of confusion analysis. *In re DuPont de Nemours and Co.*, 177 USPQ 563 (CCPA 1973) (“DuPont”). First, differences exist in the appearance, sound, and overall commercial impression of Applicant’s mark and the cited registered marks. Additionally, the goods/services covered by Applicant’s mark and their uses differ from the goods identified in the registrations. Moreover, the relevant consumers of both Applicant and

Registrant not only differ but also are sophisticated, making confusion even more unlikely in the marketplace. For all of these reasons, no confusion is likely to arise in this case and the Applicant's mark should be approved for publication.

**A. The Marks Are Not Confusingly Similar**

It is well settled that a likelihood of confusion determination turns on a comparison of the marks in their entireties. *See Massey Junior College, Inc. v. Fashion Institute of Technology*, 492 F.2d 1399 (CCPA 1974). The parties' marks must be viewed as a whole, not dissected. *In re National Data Corp.*, 753 F.2d 1056, 1058, 224 USPQ 749, 751 (Fed. Cir. 1985). As discussed below, the mark differs significantly from the registered marks in appearance, sound, and meaning, and the marks convey different overall commercial impressions.

**1. The Parties' Marks Differ In Appearance**

In terms of appearance, Registrant's mark differs from Applicant's mark. The comparison of marks must be made on a case-by-case basis, without reliance on mechanical rules of construction. Indeed, in many cases the TTAB and courts have held that marks as a whole are not confusingly similar even where one contains the entirety of the other. For example, the case of *In re White Rock Distilleries Inc.*, 92 USPQ2d 1282 (TTAB 2009), is particularly instructive here. In that case, the TTAB held that VOLTA for vodka infused with caffeine was not likely to be confused with TERZA VOLTA and Design for wines, since the design feature and the term TERZA in the registered mark made it visually distinguishable from the applicant's mark VOLTA.

Here, Applicant's mark is "ONEx WAN." With respect to appearance, Applicant's mark begins the single word "ONEx" followed by the word "WAN." The dominant portion is "ONEx." However, Registrant's marks emphasize a fanciful or arbitrary term "AVAYA," which is the Registrant's company name at the beginning of the mark followed by a compound word,

“ONE-X,” formed with hyphen. The dominant portion of this mark is “AVAYA.” Furthermore, Registrant’s marks do not include the word “WAN” and differ with the inclusion of the hyphen between ONE and X. Therefore, Registrant’s marks differ from Applicant’s mark as a whole because of different dominant portion of the marks and different wording.

## **2. The Parties’ Marks Differ In Sound**

When the parties’ marks are considered in their entireties, as they must be, Applicant’s mark is separated and comprises a two-syllable single word “ONEx” and another one-syllable word “WAN”. However, Registrant’s marks begin a three-syllable fanciful or arbitrary word “AVAYA” followed by a two-syllable compound word “ONE-X.” Also, when spoken, the phonetic differences between the parties’ marks as a whole serve to avoid a likelihood of confusion.

## **3. The Parties’ Marks Convey Different Commercial Impressions**

Additionally, the significant distinguishing features in Applicant’s mark convey a very different overall commercial impression. Such different overall commercial impressions of the parties’ respective marks should not be overlooked. *See, Shen Mfg. Co. v. Ritz Hotel Ltd.*, 73 USPQ2d 1350 (Fed. Cir. 2004) (RITZ and THE RITZ KIDS create different commercial impressions); TMEP § 1207.01(b)(iii). When assessing the likelihood of confusion between compound word marks, it is appropriate to consider whether a portion of the mark is dominant in creating the mark’s commercial impression. Consumers would be more likely to perceive a fanciful or arbitrary term, rather than a descriptive or generic term, as the source-indicating feature of the mark. *See, e.g., In re Dixie Rests., Inc.*, 105 F.3d 1405, 1407, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997) (affirming TTAB’s finding that “DELTA,” not the disclaimed generic term “CAFE,” is the dominant portion of the mark THE DELTA CAFE); *In re Binion*, 93

USPQ2d 1531, 1534 (TTAB 2009) (finding that "BINION'S," not the disclaimed descriptive wording "ROADHOUSE," is the dominant portion of the mark BINION'S ROADHOUSE).

In this case, the dominant portion of Applicant's mark is "ONEx" placed at the beginning of the mark. *See Presto Products Inc. v. Nice-Pak Products, Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) ("it is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered"). Contrary to Applicant's mark, the dominant portion of Registrant's marks is "AVAYA" because "AVAYA" not only is a fanciful or arbitrary term but also is placed at the beginning of the marks. Further, the registered marks contain a hyphen between ONE and X. Accordingly, Applicant's mark gives different commercial impression over Registrant's marks, and this factor weighs in Applicant's favor.

**B. The Parties' Goods and Services Are Not Closely Related Or Provided In Circumstances Likely To Lead To Confusion**

In assessing the relatedness of the goods/services, if the goods/services in question are not related or marketed in such a way that they would be encountered by the same persons in situations that would 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., In re Thor Tech, Inc.*, 113 USPQ2d 1546, 1551 (TTAB 2015) (holding TERRAIN for towable trailers and TERRAIN for 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 (TTAB 1990) (LITTLE PLUMBER for liquid drain opener held not confusingly similar to LITTLE PLUMBER and design for advertising services, namely the formulation and preparation of advertising copy and literature in the plumbing field); *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 purchases them).

In the immediate case, Applicant's identification of goods reciting, "computer software for computer network control, prioritization, and optimization," and identification of services reciting, "providing temporary use of online non-downloadable software for computer network control, prioritization, and optimization" are unrelated to the Registrant's goods reciting, "software platform for providing communication devices with uniform access to communication applications; software for integrating communication devices with communication applications; software for performing application integration; client software for providing interface between and integration of communication devices to communication applications." Applicant's goods/services sold with Applicant's mark are specially designed to improve network efficiency using (among other methods) control, prioritization, and optimization technologies. Applicant's software enables rapid large-data transfers across TCP/IP-based networks for data distribution and replication/backup. It is designed to improve one-way data transmission over long distances, overcoming latency and poor network conditions. Since the software with Applicant's mark increases the speed of all TCP/IP communication, purchasers of Applicant's goods and services would generally be telecommunications carriers such as Verizon, T-Mobile, and AT&T or network server companies who would like to improve their network efficiency. Already, Applicant has achieved demonstrable use of this software for large global enterprise companies that routinely transmit large files (such as computer-aided design (CAD) files) between multiple locations. Applicant's software can be used either by (i) installation on any server at the

customer's premises, or (ii) through the "cloud," as a virtual server, by a telecommunications carrier authorized by Applicant to distribute the software.

Conversely, the Registrant's goods are for telephone service for consumers and businesses. The specimens submitted with the registered marks show that their software is for individual consumers or businesses to control their desktop telephones. Accordingly, the Registrant's consumers would not have any chance to see Applicant's goods, which are specially designed for improving efficiency at the network level, at the same place where they purchase a desktop telephone for personal or business use or software for the control thereof. The parties' goods and services are noncompetitive, differ completely in utility, have nothing in common with respect to their essential characteristics or sales appeal. In short, the parties' respective goods/services in terms of their trade channels are clearly distinguished from each other.

Indeed, the only true commonality between Applicant's and Registrant's goods is their classification in International Class 9. However, the classification of goods and services is primarily for the convenience of the Office and "has no bearing on the question of likelihood of confusion." TMEP § 1207.01(d)(v). In fact, the statute authorizing the creation of the classification system itself makes clear that it is "for convenience of Patent and Trademark Office administration, but [does] not . . . limit or extend the applicant's or registrant's rights." 15 U.S.C. § 1112; *See also*, 4 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition § 24:66 (4th Ed. 2009), and cases cited therein.

Therefore, Applicant's goods/services are distinguishable from those identified in the cited registrations such that no likelihood of confusion exists, especially in light of the differences between the parties' goods. This factor, thus, weighs against a finding of likelihood of confusion.

**C. Sophistication Of The Parties' Respective Consumers Lessens The Likelihood Of Confusion**

Applicant and Registrant provide their respective goods/services to sophisticated consumers. The more sophisticated the consumers, the less likely they are to be misled by similarity in marks. *See Cadbury Beverages, Inc. v. Cott Corp.*, 37 USPQ2d 1508, 1513 (2d Cir.1996). 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. Cmtys., 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"). This factor, too, heavily favors a finding of no likelihood of confusion.

Applicant's goods/services are provided to sophisticated and knowledgeable companies that either provide network services to enterprises, or seek to improve their local private networks. The goods and services affect their network efficiency and the companies' reputation. Such consumers are savvy and know how Applicant's goods and services can improve their network performance, user experience, and overall data mobility. Applicant's software is capable of improving data download speeds from the customer premises location or via a telecommunications carrier's cloud network to any device (including mobile devices), without the need to install any additional software on the receiving device.

The Registrant's consumers (who are completely different from Applicant's consumers) are also sophisticated. The Registrant's consumers will know how to install the Registrant's

software to their devices or computers to control their desktop telephones. They would not imagine that the Registrant's telephones are related to Applicant's goods/services, applied at the telecommunications carrier level to improve TCP/IP network efficiency. The parties' offerings are not items typical of impulse purchases. The parties' respective consumers will not overlap. As such, source confusion is not likely. Since preventing buyer confusion is the ultimate goal in a likelihood of confusion analysis, this factor weighs against a finding of likelihood of confusion.

## **II. Applicant Submits Information Requested by the Examining Attorney**

The Examining Attorney has requested Applicant to provide all the following information:

**(1) Explain whether the wording in the mark "ONE-X" or "ONEX" have any meaning or significance in the trade or industry in which applicant's goods and/or services are manufactured or provided, or if such wording is a term of art within applicant's industry.**

The terms "ONEx WAN" or "ONEx" have no meaning or significance in the trade or industry, nor are they terms of art. ONEx is Applicant's coined term.

**(2) Respond to the following questions:**

**Does the term refer to software or software platforms?**

ONEx WAN refers to software that is installed, either (i) on the network of a telecommunications carrier, or (ii) on a company's local network server. ONEx WAN is not a software platform.

**Does the term refer to computer or telecommunication networks or a system related to such networks?**

ONEx WAN refers to software that is installed, either (i) on the network of a telecommunications carrier, or (ii) on a company's local network server. ONEx WAN is a unique



overlay, added to the existing software platform, which enhances the movement of all TCP/IP communications. ONEx WAN is not a network or network-related system.

### **III. Conclusion**

To support a refusal on likelihood of confusion grounds, there must be more than a mere possibility of confusion; instead, a demonstrated probability or likelihood of confusion must exist. *See Electronic Design & Sales Inc. v. Electronic Data Systems Corp.*, 21 USPQ2d 1388, 1391 (Fed. Cir. 1992), quoting from *Witco Chemical Company, Inc. v. Whitfield Chemical Company, Inc.*, 164 USPQ 43 (CCPA 1969) as follows: “We are not concerned with mere theoretical possibilities of confusion, deception, or mistake or with *de minimis* situations but with the practicalities of the commercial world, with which the trademark laws deal.” *See also, Triumph Machinery Company v. Kentmaster Manufacturing Company Inc.*, 1 USPQ2d 1826 (TTAB 1987). The Trademark Act does not speak in terms of remote possibilities of confusion, but rather, the likelihood of such confusion occurring in the marketplace. Here, the possibilities for confusion are, if anything, quite remote.

Accordingly, for all the foregoing reasons, Applicant submits that there is no likelihood of confusion between the cited registered marks AVAYA ONE-X on the one hand and Applicant’s mark ONEx WAN on the other. Applicant, therefore, respectfully requests that the Examining Attorney withdraw the Section 2(d) refusal, and approve Applicant’s mark ONEx WAN for publication.