

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Examining Attorney: Nicholas Atree
Law Office 107

September 12, 2018

In re Application of : Beijing Sogou Technology Development Co., Ltd.

Serial No. : 87/679,726

Filed : November 10, 2017

Mark : SOGO

Commissioner of Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

AMENDMENT AND RESPONSE TO OFFICE ACTION UNDER 37 C.F.R. § 2.62

Beijing Sogou Technology Development Co., Ltd. (“Applicant”) hereby responds to the Office Action dated March 12, 2018 with respect to its application to register the mark SOGO, Serial No. 87/679,726 (the “Mark”), as follows.

Response to Examiner’s Proposed Amendments to the Description of Goods and Services

Applicant provides the following response to the Examining Attorney’s proposed amendments to the description of goods and services. For the most part, the amendments and requests for more definite language proposed by the Examining Attorney are, unless otherwise noted, accepted and the proposed amendments in each Class description are shown below.

Class 9.

With respect to Class 9, Applicant agrees, for the most part, with the amendments and clarifications proposed by the Examining Attorney. With regard to “Alarm” in the original description, Applicant has amended the description to read “Sound alarms” (TM Manual Term ID 009-2792). Applicant does not intend to offer “Anti-theft alarms for vehicles” under the Mark, therefore, the addition of Class 12 is not necessary. Consequently, Applicant proposes the following amendments to the description of goods in Class 9, which are consistent with the proposed amendments and clarifications by the Examining Attorney:

Computer hardware and computer peripherals; Wearable ~~action~~ activity trackers; Magnetic encoded identification bracelet; Intelligent Smart watches (~~data processing~~); Network communication equipment, namely, devices for transporting and aggregating voice, data, and video communications across multiple network infrastructures and communications protocols; ~~Monitor~~Computer, touchscreen, television and video monitors; Electronic monitoring device, namely, energy meters for monitoring energy usage; Photographic camera (~~photography~~); Apparatus for speech recording and replaying; mobile phones; portable media players; On-line length measuring instrument for use with bracelets (~~measuring instrument~~); Electronic data recorder; ~~E-book~~ Electronic book reader; telecontroller equipment, namely, remote controls for electronic terminals, namely, computers, computer peripherals, mobile devices, mobile telephones, robots, smart watches, wearable devices, earphones, headphones, set top boxes, audio and video players and recorders, home theater systems, and entertainment systems; Computer software (~~recorded~~) recorded on data media for use in accessing, transmitting, storing, processing, and sharing data and information; Downloadable software for use in programming, organizing, and accessing audio, video, text, multimedia content and third-party computer software programs; Downloadable ~~E~~electronic publications (~~downloadable~~), namely, books, magazines, brochures, journals, periodicals in the field of banking, finance, investment, stock market, securities market, insurance and real estate; Computer application software for handheld computers, namely, software for voice, speech and command recognition, conversion; Computer game software for use on computer, mobile and cellular phones; Computer search engine software; Computer software for the collection, editing, organizing, modifying, book marking, transmission, storage and sharing of data and information; Data processing apparatus; Downloadable software for accessing, browsing and searching online databases; Global positioning system (GPS) and ~~equipment~~parts therefore; Sound alarms~~Alarm~~; Batteries~~Battery~~; Protective cases, namely, shells ~~Shell~~ for mobile phone; Robots for personal, educational and hobby use and structural parts therefor

Class 35.

With respect to Class 35, Applicant agrees with the amendments and clarifications proposed by the Examining Attorney, except that Applicant respectfully disagrees with the proposal to move “Layout services other than for advertising purposes” from Class 41 to 35 (as explained below in connection with Class 41). Consequently, Applicant proposes the following amendment to the description of services in Class 35:

Advertising services; Advisory services relating to business management and business operations; Business appraisals; Business investigations; Compiling and analyzing statistics, data and other sources of information for business purposes; Demonstration of goods and services by electronic means, also for the benefit of the so-called teleshopping and home shopping services; Search engine optimization for sales promotion; On-line advertising on a computer network; Personnel recruitment; Professional business consultancy; Providing business information via a web site; Sales promotion for others; Sponsorship search; Systemization of information into computer databases

Class 38.

With respect to Class 38, Applicant agrees with the amendment proposed by the Examining Attorney and amends its description of services as follows:

Broadcast of cable television programs; Electronic message sending; Communications by computer terminals; Electronic, electric, and digital transmission of voice, data, images, signals, and messages; Electronic ~~mail services~~ transmission of e-mail; Providing on-line chat rooms and electronic bulletin boards for transmission of messages among users in the field of general interest; Providing telecommunications connections to a global computer network; Providing multiple-user access to a global computer information network; Providing internet chat rooms; Voice mail services

Class 41.

With respect to Class 41, Applicant agrees with the amendments and clarifications proposed by the Examining Attorney, with the exception that the Applicant respectfully disagrees that its description of services in connection with “Layout services other than for advertising purposes” should be moved to Class 35. Layout services *for* advertising purposes

fall under Class 35 (TM Manual Term ID 035-1192), while layout services that are *not* for advertising purposes fall under Class 41 (TM Manual Term ID 041-761 (“Layout services other than for advertising services”)). Here, Applicant’s “layout services” are not for advertising purposes and therefore belong in Class 41. Consequently, Applicant proposes the following amendments to the description of services in Class 41:

Arranging and conducting business seminars in the field of banking, finance, investment, stock/securities market, insurance, real estate; Arranging and conducting educational conferences in the field of banking, finance, investment, stock market, securities market, insurance, real estate and sports; Arranging, organizing, conducting, and hosting social entertainment events; Bookmobile services; Arranging and conducting business training in the field of banking, finance, investment, stock market, securities market, insurance, real estate and sports; Education services, namely, providing on-line classes, seminars, workshops in the fields of sports and current events, ~~general interest~~; Health club services, namely, providing instruction and equipment in the field of physical exercise; Layout services other than for advertising purposes; Production of radio and television programs; Providing on-line publications in the nature of books, magazines, brochures, journals, periodicals in the field of banking, finance, investment, stock market, securities market, insurance and real estate; Providing on-line music and entertainment information

Class 42.

With respect to Class 42, Applicant agrees with the amendments and clarifications proposed by the Examiner and amends its description of services as follows:

Technical research in the field of the Internet; Research, development, design and upgrading of computer software; Computer services, namely, providing search engines for obtaining data on a global computer network; Computer programming; Computer software design for others; Maintenance of computer software; Computer systems analysis; Design and development of on-line computer software systems; Duplication of computer programs; Conversion of data or documents from physical to electronic media; Creating or maintaining web sites for others; Web site hosting services

No Additional Fees Required

As explained with respect to Class 9, *supra*, Applicant's goods include "sound alarms" in Class 9, but do not include "anti-theft alarms for vehicles" in Class 12. Therefore, the addition of Class 12 is not necessary and Applicant previously paid the filing fee for the requisite number of classes. Consequently, no additional fees are required.

Response to Section 2(d) Refusal

The Examining Attorney has partially refused registration of the Mark pursuant to Section 2(d) with respect to some of the Applicant's services in Classes 41 and 42, citing U.S. Registration Nos. 4,490,614 for SOGOSURVEY and 5,247,008 for SOGO. The Examining Attorney has also refused registration of the Mark pursuant to Section 2(d) with respect to some of the Applicant's goods in Class 9, citing pending Serial No. 87/780,790 for SOOGO, should that application register. As set forth more fully below, Applicant respectfully disagrees that there is any likelihood of confusion between Applicant's Mark and the cited registrations and application. *See In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357 (C.C.P.A. 1973); TMEP § 1207.01.

A. Pending Application Serial No. 87/780,790.

The Examining Attorney cited Serial No. 87/780,790 for SOOGO for mouse pads as a "prior pending application" (the "Cited Application"). The Cited Application has a filing date of February 1, 2018. Applicant's Mark, however, has a filing date of November 10, 2017—approximately three months *before* the Cited Application. Noteworthy is that the Cited Application has Published for Opposition and Applicant's Mark, despite preceding the Cited Application, was not cited as a basis for refusal of the Cited Application pursuant to Section 2(d). It is believed the Cited Application was cited in error. Consequently, Applicant respectfully

requests that the Examining Attorney's Section 2(d) refusal on the basis of the Cited Application be withdrawn.

B. Registration No. 5,247,008 (the "'008 Registration")

The Examining Attorney cited the '008 Registration for "Education services, namely, providing annual medical conferences, lectures, poster sessions, interactive panel discussions, hands-on workshops and broadcast symposia for oncologists and surgeons in the field of oncology; educational services, namely, providing on-line activities in the nature of courses, lectures, workshops and interactive discussions in the field of oncology" in Class 41. The Examining Attorney has based his initial Section 2(d) refusal on the following services appearing in Class 41 of Applicant's Mark: "Educational services, namely providing on-line classes, seminars, workshops in the field of general interest." Specifically, the Examining Attorney has taken the position, without citation to any evidence, that "there can be little doubt that applicant's educational services in the field of 'general interest' are related to registrant's educational services in the field of oncology."

Applicant respectfully submits that the Examining Attorney's presumption, without evidentiary support, is an insufficient basis for concluding that the services are related. The Examining Attorney bears the burden of establishing relatedness. *In re Coty US LLC*, 2012 WL 1267919 (T.T.A.B. 2012)). Moreover, the '008 Registration is limited to the field of oncology, a highly specialized "branch of medicine concerned with the prevention, diagnosis, treatment, and study of cancer." *Merriam-Webster Dictionary* (available at <https://www.merriam-webster.com/dictionary/oncology> (updated Sep. 4, 2018)). Oncology is a specialized medical field, not a field that would be considered of "general interest." The registrant's services are thus directed to sophisticated purchasers (i.e. physicians specializing in oncology) of specialized

educational services in a highly specialized field. Such highly sophisticated consumers in a highly sophisticated field are not likely to be confused. *See Jet, Inc. v. Sewage Aeration Systems*, 165 F.2d 419, 423, 49 U.S.P.Q.2d 1355 (6th Cir. 1999).

Without waiving the foregoing arguments, Applicant has amended its description of services in Class 41 to clarify that “general interest” refers to “current events.” Such amendment is permitted because it merely clarifies or limits its services that are encompassed within the field of “general interest,” rather than expanding the services. TMEP § 1402.06.

In light of the foregoing, Applicant respectfully requests that the Section 2(d) refusal be withdrawn.

C. Registration No. 4,490,614 (the “’614 Registration”)

The Examining Attorney has cited the ’614 Registration for SOGOSURVEY in Class 41 for educational services and Class 42 for computer software as a service, limited to the field of developing, taking and administering surveys. Applicant respectfully disagrees that there is any likelihood of confusion between Applicant’s Mark and the ’614 Registration. *See In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357 (C.C.P.A. 1973); TMEP § 1207.01.

One of the most relevant *DuPont* factors to consider when assessing whether there is a likelihood of confusion is “[t]he similarity of the marks *in their entirety* as to appearance, sound, connotation and commercial impression.” TMEP 1207.01. It is well-established that the existence of the same or similar wording within marks does not *per se* establish a likelihood of confusion, even when the marks are used in connection with the same class of goods or services. *See Application of Ferrero*, 479 F.2d 1395 (C.C.P.A. 1973) (no likelihood of confusion between TIC TAC and TIC TAC TOE for impulse foods); *In re White Rock Distilleries, Inc.*, 92 U.S.P.Q.2d 12982 (T.T.A.B. 2009) (Board reversed Examining Attorney and found no

likelihood of confusion between VOLTA for vodka and TERZA VOLTA for wine). This is because the anti-dissection rule prohibits dissecting a mark into its elements rather than evaluating it as a whole when considering likelihood of confusion. See *Colgate-Palmolive Co. v. Carter-Wallace, Inc.*, 432 F.2d 1400 (C.C.P.A. 1970) (affirming Board’s decision of no likelihood of confusion between PEAK and PEAK PERIOD for personal care products); *In re Johnson & Johnson*, 2002 WL 649081 (T.T.A.B. 2002) (reversing Examining Attorney’s refusal to register EPIC MICROVISION for medical devices in light of prior registration of EPIC for medical devices). It is well-established, however, that “arguments to the effect that one portion of a mark possess no trademark significance leading to direct comparison between only what remains is an erroneous approach.” *Spice Islands, Inc. v. The Frank Tea and Spice Co.*, 184 U.S.P.Q. 35, 37 (C.C.P.A. 1974); *Scherling Corp. v. Alza Corp.*, 207 U.S.P.Q. 504 (T.T.A.B. 1980); *Jet, Inc. v. Sewage Aeration Sys.*, 165 F.3d 419 (6th Cir. 1999) (“the ‘anti-dissection rule’ ... serves to remind courts not to focus only on the prominent features of the mark, or only on those features that are prominent for purposes of the litigation, but on the mark in its totality.”). Respectfully, the Examining Attorney’s dissection of the marks without proper consideration of the appearance, sound, connotation and commercial impression of the marks *in their entirety* violates the anti-dissection rule.

Moreover, the ’614 Registration is related to specialized services in the field of conducting and administering surveys. The purchasers of such services are trained professionals in a highly specialized field, thus reducing any likelihood of confusion. As the U.S. Court of Appeals for the Sixth Circuit explained:

Generally, in assessing the likelihood of confusion to the public, the standard used by the courts is the typical buyer exercising ordinary caution. However, when a buyer has expertise or is otherwise more sophisticated with respect to the purchase of the services at issue, a higher standard is proper. Similarly, when

