

This is in response to the Office Action dated February 1, 2019 (the “Office Action”)

In the Office Action, the Examining Attorney initially refused registration of the mark AIRSIDE, U.S. Serial No. 88/247,571 (the “Mark” or “Application”), on the Principal Register on the basis that the Mark creates a likelihood of confusion with the mark AIRSIDE, U.S. Supplemental Register Registration No. 4,797,028 (the “Registered Mark” or “Registration”). The Examining Attorney also required amendments to the goods and services identifications in the Application. Finally, the Examining Attorney required an explanation of the Mark’s significance. On February 27, 2019, the undersigned attorney and the Examining Attorney discussed the office action by phone. The undersigned attorney greatly appreciates the Examining Attorney’s time and assistance. With this present response, Applicant amends the goods and services descriptions for the Application and also submits an explanation of the Mark’s significance. For the reasons set forth below, Applicant respectfully disagrees with the likelihood of confusion refusal and requests that the Examining Attorney withdraw the refusal.

### **Response to 2(d) Refusal – Likelihood of Confusion**

The Examining Attorney has based the likelihood of confusion refusal on (1) the similarity of the marks, and (2) the relatedness of the goods and services (“goods/services”). While the marks at issue are identical on their face, the connotations of the marks differ significantly when considered in connection with the goods/services for which the marks are used. The marks therefore create different overall commercial impressions when viewed from the relevant consumers’ perspectives. Further, the goods/services identified in the Application are sufficiently different from those included in the Registration such that confusion is not likely. As such, Applicant respectfully disagrees that the marks are confusingly similar, and submits that distinctions between the marks’ connotations and the goods/services identified in the Registration and Application will prevent any likelihood of confusion.

**i. The Registered Mark is Entitled to Thin Protection**

The Registered Mark is registered on the Supplemental Register, which indicates that the mark is not inherently distinctive and is weak. As such, smaller differences between Applicant's Mark and the Registered Mark are sufficient to distinguish the marks for likelihood of confusion purposes. See *In Re Hartz Hotel Servs. Inc.*, 102 U.S.P.Q.2d 1150 at \*4 (T.T.A.B. 2012) ("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.").

Applicant submits that the Examining Attorney should apply the stricter likelihood of confusion test utilized by the Trademark Trial and Appeal Board (the "Board") in *In re Texas Instruments Incorporated*, 193 U.S.P.Q. 678, 1976 WL 20856 (T.T.A.B. 1976). In this decision, the Board determined that the mark COPPERCLAD, for "copper coated carbon electrodes for use in electric arc cutting and gouging," was only entitled to a "narrow scope of protection" because it was registered on the Supplemental Register. *Id.* at \*2. The Board found that there was no conflict between the registered mark and the applicant's COPPER CLAD & design mark for "composite metal wire material having an aluminum core clad with copper for use in electrical conductors." *Id.* In a similar decision, the Board acknowledged that it "has given limited protection to descriptive marks registered on the Supplemental Register." *In re Central Soya Company, Inc.*, 220 USPQ 914 at \*4 (T.T.A.B. 1984) (finding that the mark LA POSADA, registered on the Supplemental Register for lodging and restaurant services, should not bar registration of the mark POSADA for frozen Mexican food).

The Board has also observed that "[b]ecause in most cases marks are registered on the Supplemental Register because they are descriptive, 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 Smith and Mehaffey*, 31 U.S.P.Q.2d 1531, 1533 (T.T.A.B. 1994).

Consistent with the Board's decisions in these cases, the Registrant's Mark should only be entitled to a narrow scope of protection due to its status on the Supplemental Register, and the Registrant's Mark should therefore not bar registration of Applicant's Mark.

## ii. The Goods/Services are Sufficiently Different

The goods/services identified in the Registration differ significantly from the goods/services identified in the Application. In the Office Action, the Examining Attorney asserts that the services listed in Classes 9 and 42 of the Application “presumably encompass[ ] all goods and services of the type described, including registrant’s more narrow [goods/services]”. While Applicant disagrees with this assertion, Applicant narrows the identification of goods/services in Classes 9 and 42 of the Application with this present response to further differentiate its goods/services from the goods/services identified in the Registration.

Specifically, the Registered Mark is for goods/services that are used by airport staff on the airside of an airport to track and manage the airport’s assets. Airports are the potential consumers for the Registration owner’s (“Registrant”) goods/services, and travelers and passengers do not utilize these goods/services (as they are not tracking or managing airport assets).

In contrast, Applicant’s Mark is not intended for goods/services that will be used on the airside of an airport. While the pre-security and security passenger-side areas of an airport are among the many locations that Applicant’s goods/services may be used and provided, the goods/services are not utilized in the airside area of an airport and are not used to track or manage airport assets. The fact that the goods/services at issue may all be related to an airport in some way is not adequate by itself to support a finding that they are related. See *In re Gilbert Hospital, LLC*, 2009 WL 4086548 at \*2–3 (T.T.A.B. 2009)(not precedential). Rather, they are used to facilitate the identity verification process (such as the airport check-in and security process, for example) by providing a system for individuals to easily and securely store and manage their personal data and documents and then share that data and documents with an identity-verifying entity (such as the Transportation Security Administration (TSA) during the airport security check, for example). Applicant’s goods/services are not intended to track or manage any data or documents related to airport assets.

The differences between Applicant’s goods/services and the Registrant’s goods/services sufficiently differentiate the Mark from the Registration, especially in light of the Registration’s lack of inherent distinctiveness. The TMEP instructs that:

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.

TMEP § 1207.01(b)(v) (citing *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")). 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. Here, the Examining Attorney must consider the differences between the goods/services listed in the Application (as presently amended) and the goods/services identified in the Registration when comparing the marks at issue during a likelihood of confusion analysis.

As detailed in Section I above, the goods/services for which the Registered Mark is used differ significantly from the goods/services for which Applicant intends to use the applied-for Mark. Specifically, the Registered Mark is for goods/services that are used by airport staff on the airside of an airport to track and manage the airport's assets. The Registered Mark is descriptive of the location in which the goods/services sold under the mark are intended to be used – the “airside” of an airport – which is reflected in the record for the Registration. See **Exhibit A**, copy of an office action for the Registered Mark evidencing the USPTO's position that the Registered Mark is merely descriptive and therefore only eligible for registration on the Supplemental Register.

In contrast, Applicant's Mark is not intended for goods/services that will be used on the airside of an airport. As such, the term “airside” is not descriptive of Applicant's goods/services. Rather, the term is arbitrary and has no specific tie or relationship to the goods/services for which Applicant intends to use the Mark.

Given the distinctions between the goods/service at issue, the connotations of the marks

are also different. As such, the Mark's overall commercial impression is sufficiently distinctive, and the differences discussed herein will obviate any likelihood of consumer confusion between the marks at issue.

**iii. Applicant Owns an Existing Registration for A AIRSIDE & design in Class 9.**

Applicant reminds the Examining Attorney that it owns a live registration for the A AIRSIDE & design mark (U.S. Reg. No. 3,966,159) for computer application software in Class 9 (the Prior Registration). This mark registered on the Principal Register on May 24, 2011, nearly three years before the application for the Registered Mark was filed. The Prior Registration is registered on the Principal Register and does not include any disclaimers, indicating that the mark is distinctive. The Prior Registration is also incontestable. The Examining Attorney should consider Applicant's ownership of the Prior Registration in its likelihood of confusion analysis. The Prior Registration was not cited in a 2(d) refusal against the Registered Mark, and the Registered Mark should similarly not bar the present Application.

**Identification of Goods and Services**

With the present response, Applicant amends the goods and services identifications for Classes 9, 39, 42, and 45 in the Application to clarify the goods and services as follows (additions **bolded**; deletions ~~stricken~~):

- Class 009: Downloadable **computer** software application for secure storage, management, and sharing of **personal** documents, **namely, passports, identification documents, and health records**, and personal information; **downloadable** computer application software for mobile phones, namely, software for secure storage, management, and sharing of government issued identification documents, personal health records, and business records; **downloadable** computer application software for mobile phones, namely, software for assisting travelers with airport and travel services; **downloadable** computer application software for desktop computers, kiosk computers, and mobile devices, namely, software for expediting passport control and customs clearance processing; **downloadable computer software, namely, facial recognition software; downloadable computer software, namely, personal identity verification software; application programming interface software, namely, for secure storage, management, and sharing of personal** documents, namely, passports, identification documents, and health records, and personal information
- Class 39: Consulting services in the field of travel, **namely, providing guidance and information on technology used during the traveler identification verification process**

**to airports, hotels, cruise lines, and government agencies; advisory services in the field of travel, namely, providing advice technology used during the traveler identification verification process to airports, hotels, cruise lines, and government agencies.**

- Class 42: Software as a service (SAAS) services **featuring software** for secure storage, management, and sharing of **personal documents, namely, passports, identification documents, and health records**, and personal information; software as a service (SAAS) services **featuring software** for secure storage, management, and sharing of government issued identification documents, personal health records, and business records; software as a service (SAAS) services **featuring software** for facial recognition; software as a service (SAAS) services **featuring software** for verifying personal identity information; digitization of documents; software design and development; Personal identity verification services provided through digital identification technology **to authenticate user identity; providing non-downloadable computer software, namely, facial recognition software; providing non-downloadable computer software, namely, personal identity verification software; providing non-downloadable computer application software for mobile phones, namely, software for secure storage, management, and sharing of government issued identification documents, personal health records, and business records; providing non-downloadable computer application software for mobile phones, namely, software for assisting travelers with airport and travel services; providing non-downloadable computer application software for desktop computers, kiosk computers, and mobile devices, namely, software for expediting passport control and customs clearance processing; providing a database with verified personal identification information in the nature of verification of personal identity as part of airline check-in process, airport security process, employment verification, building access management, financial service account verification, know your customer (KYC) verification;**
- Class 45: ~~Personal identity verification services provided through digital identification technology; providing a database with verified personal identification information;~~ advocacy in the field of travel, **namely advocating for consistent approaches to traveler identity verification process for the benefit of travelers**

### **Explanation of Mark's Significance**

In response to the Examining Attorney's specific inquiries in the Office Action, please see Applicant's responses below in *italics*.

- (1) Explain whether the wording in the mark "AIRSIDE" has any meaning or significance in the trade or industry in which applicant's goods and services are manufactured or provided, any meaning or significance as applied to applicant's goods and services, or if such wording is a term of art within applicant's industry.  
*The technical meaning of "Airside" in transportation and infrastructure (not travel) is the area of the airport that facilitates the movement of aircraft.*

(2) Respond to the following questions:

- Where will applicant's goods be sold or services be provided?

*The goods and services provided under the Mark are delivered digitally worldwide, and are intended for individual use in a variety of environments including airports, hotels, banks, cruise lines etc.*

- Will these services be provided on the airside of an airport?

*No. The goods and services provided under the Mark involve a consumer-facing application with uses in multiple environments. The application does not have any use within the air operations work area (airside) of the airport.*

- Will these goods be sold on the airside of an airport?

*No. The goods and services provided under the mark are delivered digitally worldwide through major mobile application marketplaces and the internet.*

### **Conclusion**

For all of the above reasons, Applicant respectfully submits that Applicant's Mark is not confusingly similar to the Registered Mark. Having addressed all of the issues raised in the Office Action, Applicant respectfully requests that the refusal to register be withdrawn and that the Application be approved for publication.