

Applicant Sphere Knowledge Limited (“Applicant”) hereby submits its response (“Response”) to the U.S. Patent and Trademark Office’s Office Action mailed on September 13, 2018, with regard to the trademark application for **SPHERE and Design** (Serial No. 79239709).

REMARKS

The Examining Attorney has refused registration of Applicant’s **SPHERE** mark on the grounds that it resembles (i) U.S. Registration No. 4265436 (**SPHERE**) in Class 36, (ii) U.S. Registration Nos. 2445398 (**SPHERE and design**) and 2403087 (**SPHERE COMMUNICATIONS**) in Class 38, (iii) U.S. Registration Nos. 4485913 (**PROJECT DATA SPHERE**), 5474863 (**LIFESPHERE**), and 4277114 (**LEARNINGSPIHERE**) in Class 42 (together, the “Cited Marks”) to the extent that makes confusion likely. Trademark Act, Section 2(d), 15 U.S.C. § 1052(d); *see* TMEP §§ 1207.01 *et seq.* Applicant respectfully disagrees with these conclusions and requests that the Examining Attorney reconsider his decision for the reasons that follow.

Further, although Applicant disagrees that confusion is likely based on the differences between the services, Applicant notes that in connection with this Response, it is further narrowing its Class 36, 38, and 42 services descriptions as follows:

Class 36: “~~Tax advice [not accounting]; financial advice~~ **Financial advice in the nature of financial information services, but not including any financial information relating to the provision of credit cards**”;

Class 38: “Providing access to chat rooms; chatroom services for social networking; providing online chatroom services; **all the aforesaid services in the field of general interest**”; and

Class 42: “~~Chemistry consultancy; biology consultancy; consulting services in the field of medical physics~~ **Provision of chemistry, biology and medical physics information**; cloud computing **being** web hosting services **relating to the provision of a cloud-backed human knowledge search engine.**”

The Examining Attorney also requested that the description of services in Class 41 be amended to clarify or limit the services. 37 C.F.R. § 2.71(a); *see* TMEP § 1904.02(c)(iv). Applicant notes that in connection with its response, it is further narrowing its Class 41 services as follows:

Class 41: “**Information on** ~~E~~education, entertainment and sports **information**~~s~~services; language tuition **and training in the nature of language instruction**; ~~language training~~; career counselling, **namely, providing information concerning education options to pursue career opportunities**; cooking instruction; training in philosophy; religious **instruction**~~education~~ services.”

Accordingly, this Response addresses the similarity of the Cited Marks’ services based on these amended descriptions.

I. APPLICANT’S USE OF ITS SPHERE MARK IS UNLIKELY TO CAUSE CONFUSION

In the Office Action, registration was refused because the Examining Attorney concluded that Applicant’s **SPHERE** mark, when used in connection with the Class 36, 38, and 42 services currently identified in its application, so resembles the Cited Marks as to be likely to cause confusion.

However, as the following discussion establishes, the Cited Marks should not pose a barrier to the registration of Applicant’s **SPHERE** mark. “[I]n every case turning on likelihood of confusion, it is the duty of the examiner...to find, upon consideration of all the evidence, whether or not confusion appears likely.” *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1362, 177 U.S.P.Q. 563, 568 (C.C.P.A. 1973). Although there are similarities between the marks at issue, the distinct services compel the conclusion that Applicant’s mark is unlikely to cause any confusion. Accordingly, Applicant submits that its **SPHERE** mark is entitled to registration on the Principal Register.

A. Applicant's Class 36 Services Are Readily Distinguishable.

The Examining Attorney concluded that the Class 36 services of “tax advice [not accounting]; financial advice” offered under Applicant’s mark, and the Class 36 services of “credit card services” offered under Registration No. 4265436 (the “Class 36 Cited Mark”), are “considered related for likelihood of confusion purposes.” The Examiner found that the “attached Internet evidence, consisting of screen shots from Chase, Bank of America, and Citi, establishes that companies that provide financial advice also commonly provide credit card services.”

As noted above, however, Applicant has amended its Class 36 services description to the following: “Financial advice in the nature of financial information services, but not including any financial information relating to the provision of credit cards.” By contrast, the Class 36 Cited Mark is registered in connection with “credit card services.” Applicant’s amended services specifically exclude “financial information relating to the provision of credit cards.” In sum, Applicant’s financial services are not related to the credit card services offered under the Class 36 Cited Mark.

B. Applicant's Class 38 Services Are Readily Distinguishable.

The Examining Attorney also appears to have concluded that Applicant’s services in Class 38 are closely related to those offered under Registration Nos. 2445398 and 2403087 (the “Class 38 Cited Marks”) because the “attached Internet evidence, consisting of screen shots from Xfinity, AT&T, and CenturyLink, establishes that companies offer telephone services and chat room services under the same mark to the same consumers.”

As noted above, Applicant has further amended its Class 38 services description to the following: “Providing access to chat rooms; chatroom services for social networking; providing online chatroom services; all the aforesaid services in the field of general interest.” By contrast, the Class 38 Cited Marks are registered in connection with “telephony communications services.”

The Examining Attorney cites to several telecommunications companies’ websites (Xfinity, AT&T, and CenturyLink) and concludes that the chat features on these company’s

websites are conclusive that chat services are related to telephone services. Applicant respectfully disagrees. It is common knowledge that numerous companies provide chat features on their websites so that their consumers can visit the website and ask specific questions relating to a specific product or service being offered by that company. The “chatroom services” that the Examining Attorney points to that are offered under Xfinity, AT&T, and CenturyLink are merely customer service hotlines that these companies offer to support the questions of their customers – these are not general chatroom services. For example, if an AT&T customer had a question relating to their phone bill from AT&T, that customer could go to AT&T’s website, and use the chat feature to talk with an AT&T customer support representative. Similarly, a CenturyLink customer would utilize the chat feature on CenturyLink’s website.

“Telephony communications services” are distinguishable from “chatroom services,” but by Examining Attorney’s logic, all of these services would be considered related, even if they serve distinguishable functions and distinguishable classes of consumers, which is the case here. Applicant’s services relate exclusively to chatroom services in the field of general interest, whereas the Class 38 Cited Marks relate exclusively to telephony communications services. Given the differences in the services, and the consumer class for such services, the respective consumers of these services are unlikely to believe they emanate from the same source, and therefore confusion is unlikely.

Furthermore, it is important to remember that the Federal Circuit and the Trademark Trial and Appeal Board have rejected rules deeming products or services per se “related” merely because they fall into the same general class. *In re Mars, Inc.*, 741 F.2d 395, 222 U.S.P.Q. 938 (Fed. Cir. 1984); *In re British Bulldog*, 224 U.S.P.Q. 854, 856 (T.T.A.B. 1984). The Trademark Manual of Examining Procedure clearly provides that “there can be no rule that certain goods or services are per se related, such that there must be a likelihood of confusion from the use of similar marks in relation thereto.” TMEP § 1207.01(a)(iv). The fact that goods or services in the same broad category are identified by marks which incorporate common terms does not necessarily mean

consumers expect a single source to be responsible for both. *Steve's Ice Cream, Inc. v. Steve's Famous Hot Dogs*, 3 U.S.P.Q. 2d 1477, 1478 (T.T.A.B. 1987).

One test for determining whether goods or services are related is to consider whether they are competitive, that is, whether they are “reasonably interchangeable by buyers for the same purposes.” 4 J. Thomas McCarthy, *Trademarks and Unfair Competition* § 24:23 at 24-71 (4th ed. 2015). *See also, Beneficial Corp. v. Beneficial Capital Corp.*, 529 F. Supp. 445, 449-50, 213 U.S.P.Q. 1091, 1094-95 (S.D.N.Y. 1982).

Here, Applicant's services are not interchangeable or competitive with those of the Class 38 Cited Marks. Consumers purchasing or utilizing Applicant's general chatroom services would not alternatively purchase or use the Class 38 Cited Mark's telephony communications services. The Applicant's services cover completely different functions and would be marketed to completely different sets of customers than those offered under the Class 38 Cited Marks.

Based on the foregoing, the Class 38 Cited Marks should not prevent registration of Applicant's mark in Class 38.

C. Applicant's Class 42 Services are Readily Distinguishable

The Examining Attorney found that the Class 42 services offered under Applicant's mark were confusingly similar with Registration Nos. 4485913, 5474863, and 4277114 (the “Class 42 Cited Marks”). As noted above, Applicant has amended its Class 42 services to the following: “Provision of chemistry, biology and medical physics information; cloud computing being web hosting services relating to the provision of a cloud-backed human knowledge search engine.” Accordingly, the Class 42 Cited Marks should not prevent registration of Applicant's mark, particularly given Applicant's amended Class 42 identification.

II. CONCLUSION

Taking into consideration all of the factors discussed above, Applicant submits that there is no likelihood that any confusion will result from the use and registration of Applicant's

SPHERE and Design mark and that the other issues raised in the Examining Attorney's Office Action have been adequately addressed. Accordingly, Applicant respectfully asks for the prompt passage of its trademark application to publication.

However, should there be any question or other matter which can be handled by an Examining Attorney's Interview or Amendment, Applicant respectfully requests that the Examining Attorney contact the undersigned directly.