

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Examining Attorney:	William Breckenfeld
Law Office:	116
Serial No.:	88248514
Filing Date:	January 3, 2019
Applicant:	Rhythm Group LLC
Trademark:	STACK (and Design)

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

AMENDMENT AND RESPONSE TO OFFICE ACTION

Dear Madam:

In response to the Office action issued on March 27, 2019, Applicant submits the following amendments and remarks.

AMENDMENT

Identification of Goods

Please amend the identification of goods as follows:

---Software as a service (SAAS) services featuring software for document retrieval and storage in the fields of healthcare, pharmacy and education---

Description of the Mark

Please replace the original description of the mark with the following:

The marks consists of a continuous line bent at right angles to resemble a stack of papers adjacent to the word “STACK”. The entire mark is blue.

REMARKS

In the Office Action, it was indicated that there is an alleged likelihood of confusion between the instant application and two registered trademarks (“The Cited Registrations”) that are owned by two different entities. It was further indicated that there is a potential conflict between the instant application and six pending trademark applications (the “Pending Applications”)¹ that are owned by six additional entities. Informalities relating to the description of services and the description of the mark were also identified.

In response to Office Action, Applicant has amended its description of services to clarify the scope of services that are associated with the mark-at-issue. The description of the mark has been amended in the manner that was suggested by the Examining Attorney.

On the merits, Applicant respectfully traverses the Examining Attorney’s refusal to register Applicant’s mark based on The Cited Registrations. It is evident from U.S. Patent and Trademark Office (“USPTO”) records and from well-established principles of trademark law that the above-identified registrations should not prevent registration of Applicant’s distinct mark.

In summary, Applicant’s mark should be allowed registration over the above-identified registrations in view of: (1) the fact that Applicant’s mark and the marks associated with The Cited

¹ It should be noted that five of the six Pending Applications were published for opposition prior to the filing date of this response. This suggests that the U.S. Patent and Trademark Office has determined that at least seven different entities could be using trademarks that include the term “Stack” in International Class 042 (or in a related class) with no likelihood of confusion.

Registrations are applied to distinct products and services; and (2) the fact that the term “stack” is not only inherently weak in distinguishing source because of its common meaning and meaning in connection with goods and services that are found in the relevant classes of goods and services.

The services associated with the instant application, as amended, are substantially different from the services associated with The Cited Registrations to the extent that Applicant is entitled to registration for the instant application over The Cited Registrations.

The reasoning set forth in *Calypso Tech., Inc. v. Calypso Capital Mgmt., LP*, 100 USPQ2d 1213 (TTAB 2011), as well as the cases cited therein, is instructive. Specifically, the *Calypso* Board found that there was no likelihood of confusion between various marks that included the term CALYPSO after noting:

[a]lthough we have found that the parties’ marks are similar, that does not end the inquiry. ***Even if marks are identical***, the goods and services must also be sufficiently related and/or the circumstances surrounding their marketing be such that purchasers encountering them would mistakenly believe that they emanate from the same source for us to find that confusion is likely to occur. *Standard Knitting Ltd. v. Toyota Jidosha Kabushiki Kaisha*, 186 Fed. Appx. 1005, 77 USPQ2d 1917, 1930 (TTAB 2006). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and/or services. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). *See also, In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

Id. at 1220 (emphasis added).

Regarding U.S. Trademark Registration No. 5,059,311, the services associated with that registration are various computer-related services within the insurance industry relating to the processing of insurance claims. In contrast, the services associated with Applicant’s mark relate to document retrieval and storage in the fields of healthcare, pharmacy and education. Consequently, the two sets of services are not related to one another.

Regarding U.S. Trademark Registration No. 3,785,426, the services relating to that registration are set forth, as follows:

[p]roviding on-line non-downloadable software for project management and collaboration, namely, the assignment, visualization and reporting of specific tasks filtered by categories and/or individuals.

The description of services does not include “document retrieval” or “storage”. Similarly, the description of services does not indicate that the software is intended for use in the fields of

healthcare, pharmacy, or education. Consequently, the two sets of services are not related to one another.

The fact that the Examining Attorney was able to identify eight different records for marks that include some various of the term “stack” within International Class 042 or a related class establishes that the term “stack” is not only inherently weak, but weak in terms of coexisting trademarks. The Trademark Manual of Examining Procedure (“TMEP”) states as follows:

[d]uring the examination of an application, the Examining Attorney should consider separately each registration found in a search of the marks registered in the USPTO that may bar registration. If the Examining Attorney finds registrations that appear to be owned by more than one registrant, he or she should consider the extent to which dilution may indicate that there is no likelihood of confusion.

TMEP § 1207.01(d)(x). The TMEP also states that “[i]f the evidence establishes that the consuming public is exposed to third-party use of similar marks on similar goods, it ‘is relevant to show that a mark is relatively weak and entitled to only a narrow scope of protection.’” TMEP §1207.01 (d)(iii)(citing *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)(additional citation omitted)).

The TMEP further illustrates the relevance of third party registrations in establishing that the marks-at-issue are weak, as follows:

[t]hird-party registrations may be relevant to show that the mark or a portion of the mark is descriptive, suggestive, or so commonly used that the public will look to other elements to distinguish the source of the goods or services. *See, e.g., AMF Inc. v. American Leisure Products, Inc.*, 474 F.2d 1403, 1406, 177 USPQ 268, 269-70 (CCPA 1973); *Plus Products v. Star-Kist Foods, Inc.*, 220 USPQ 541, 544 (TTAB 1983). Properly used in this limited manner, third-party registrations are similar to dictionaries showing how language is generally used. *See, e.g., Specialty Brands, Inc. v. Coffee Bean Distributors, Inc.*, 748 F.2d 669, 675, 223 USPQ 1281, 1285-86 (Fed. Cir. 1984); *Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 917, 189 USPQ 693, 694-95 (CCPA 1976); *In re Melville Corp.*, 18 USPQ2d 1386, 1388 (TTAB 1991); *In re Dayco Products-Eagle Motive Inc.*, 9 USPQ2d 1910, 1911 (TTAB 1988); *In re J.M. Originals Inc.*, 6 USPQ2d 1393, 1394 (TTAB 1987); *United Foods Inc. v. J.R. Simplot Co.*, 4 USPQ2d 1172, 1174 (TTAB 1987)... Evidence of third-party use falls under the sixth du Pont factor - the “number and nature of similar marks in use on similar goods.” *In re E. I. duPont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (CCPA 1973).

TMEP § 1207.01(d)(iii).

Further, the law is well-settled that not all marks are entitled to equal protection. *See In re*

Coors Brewing Co., 68 USPQ2d 1059, 1063 (Fed. Cir. 2003). The stronger the mark, the greater the scope of protection afforded it. The weaker the mark, the less trademark protection it receives. See TMEP 1207.01(b)(ix); *see also Frehling Enterprises, Inc. v. Int'l Select Group*, 52 USPQ2d 1447, 1450 (11th Cir. 1999); *In re Essex Serv. Co.*, 7 USPQ2d 1748 (TTAB 1988). A portion of a mark may be shown to be “weak” either by demonstrating that the portion is highly suggestive or is in common use by many other sellers in the relevant market. When a party chooses a trademark that is inherently weak, he will not enjoy the wide latitude of protection afforded the owners of strong trademarks. *See Sure-Fit Products, Co. v. Saltzon Drapery Company*, 117 USPQ 295 (CCPA 1958).

As indicated by Footnote No. 1 above, the term “stack” is inherently weak within International Class 042 because at least seven entities are using (or are planning to use) a variation of the term as a mark within the class or within an allegedly related class simultaneously. Accordingly, this factor, when coupled with the above-described differences in the services-at-issue, indicates that there is no likelihood of confusion in the instant case.

In view of the above amendments, explanations, and remarks, Applicant believe that application is now in a condition for publication. Accordingly, reconsideration of the refusal of registration is respectfully requested.

Respectfully submitted,

April 12, 2019

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