

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : XNOR.AI, INC.
Serial No. : 88/103,688
Filing Date : September 4, 2018
Trademark : TINY YOLO

RESPONSE TO OFFICE ACTION

Applicant respectfully responds to the United States Patent & Trademark Office (USPTO)'s December 14, 2018 Office Action for TINY YOLO, as follows:

I. IDENTIFICATION OF GOODS

The USPTO has requested that Applicant amend its description of goods for clarification purposes. Applicant respectfully requests that the goods be amended as follows [additions in bold/underline]:

Class 9: Computer software for **use in** real time object detection; computer vision software, **namely software for image and signal processing, object detection, tracking, and recognition, three-dimensional reconstruction and motion analysis.**

II. THE SPECIMEN SUBMITTED IS NOT A MERE ADVERTISEMENT

The USPTO has initially refused the specimen submitted with this application on grounds that it is not an acceptable display associated with the goods and appears to be mere advertising material. Specifically, the USPTO asserts that the specimen is mere advertising material because it does not include a textual description of applicant's goods or software or associate the mark with Applicant's goods or software, and further does not include a means to order the goods. However, Applicant respectfully submits that the specimen submitted is not a mere advertisement, but instead clearly and prominently displays the mark in association with Applicant's goods and provides a link which can be used to download the software. A detailed discussion follows.

According to TMEP § 904.03(e), acceptable specimens for downloadable computer software include specimens showing use of a mark on an Internet website provided that such website, like here, sufficiently displays Applicant's goods, creates an association between the mark and the software and gives enough information that the user will be able to download or purchase the software from the website. See TMEP § 904.03(e); In re Dell Inc., 71 USPQ2d 1725, 1727 (TTAB 2004) (specimen was not mere advertising because the mark was prominently displayed on the webpage, where the goods were the only product on the webpage, the mark would appear largely on a consumer's computer screen, and the mark appeared in a bulleted list of information about the product), but see also In re Azteca Sys., Inc. 102 USPQ2d 1955 (TTAB 2012) (specimen submitted failed to demonstrate an association between the mark and the goods because certain features distracted potential purchasers from associating the mark with applicant's goods, including (1) the mark being distant from the description of the software and separated by over fifteen lines of peripheral text, (2) a multitude of other logos and word marks on the page unrelated to applicant's goods, and (3) other links on the website for articles and news about applicant's business).

In line with the USPTO's requirements, the specimen that Applicant has submitted here is a descriptive webpage that explains the goods offered underneath the mark in relation to TINY YOLO. Applicant's Mark is prominently displayed at the top of the specimen, and the page provides a link where users can navigate in order to download the software. The content and overall impression of the page is dedicated to describing the functionality of Applicant's Mark. In these ways, Applicant's Mark is clearly shown in association with the goods, and not as a mere advertisement, since the entire webpage is dedicated to explaining the mark in connection with the software, and the webpage provides a URL where users can navigate to download/obtain the

software. Thus, unlike in the case of In re Osterberg, 83 USPQ2d 1220, 1224 (TTAB 2007) (where the specimen was a mere advertisement because the mark was not prominently displayed on the webpage, because viewers would have to search through the descriptive text to find the mark on the page, and the webpage gave no means for ordering the goods), the specimen submitted by Applicant in the instant case does not simply advertise the software. In view of the foregoing, Applicant respectfully submits that the specimen submitted in conjunction with its mark TINY YOLO is not a mere advertisement but rather an appropriate specimen, such that Applicant requests withdrawal of the refusal to register.

III. APPLICANT'S MARK IS NOT LIKELY TO CAUSE CONFUSION WITH THE CITED REGISTRATION.

Applicant seeks to register TINY YOLO in connection with “*computer software for use in real time object detection; computer vision software, namely software for image and signal processing, object detection, tracking, and recognition, three-dimensional reconstruction and motion analysis*” in Class 9. The application has been preliminarily refused registration on the grounds that it is likely to cause confusion with the mark in Reg. No. 3,454,313, YOLO, owned by Tradax IP Licensing Company for “*computer software for communications, scheduling, and database management for use for purposes of online dating, social networking and social introductions; computer software for use in locating and reporting the physical location of individuals via handheld electronic devices*” in Class 9 and “*Internet-based social networking, introduction, and dating services; Internet-based location services, namely, services to locate and report the physical location of individuals*” in Class 45 (the “**Cited Registration**”). In response, Applicant submits that its mark is not likely to be confused with the Cited Registration, based, in part, on the following: (1) the differences between the marks in terms of overall appearance, pronunciation and/or commercial impression; (2) the differences between the parties’ goods and

services identified in Applicant's Mark and the Cited Registration; (3) the differing trade channels and markets utilized by Applicant's Mark and the Cited Registration; and (4) the sophisticated nature of the consumers of the products offered by Applicant. In view of the foregoing, Applicant respectfully requests that the USPTO withdraw the refusal to register.

A. Standard for Likelihood of Confusion.

Likelihood of confusion determinations are made in the context of the reality of the marketplace. As such, the Federal Circuit has made clear that courts are "not concerned with mere theoretical possibilities of confusion, deception, or mistake or with de minimus situations but with the practicalities of the commercial world, with which the trademark laws deal." Elec. Design & Sales Inc. v. Elec. Data Sys. Corp., 954 F.2d 713, 21 U.S.P.Q.2d 1388, 1391 (Fed. Cir. 1992) (citations omitted). Likelihood of confusion between two marks is determined on a case-by-case basis, considering thirteen factors enumerated in In re E.I. DuPont DeNemours & Co., 476 F.2d 1357, 1361, 177 U.S.P.Q. 563, 567 (C.C.P.A. 1973). Here, consideration of pertinent DuPont factors, particularly the differences between the marks in terms of overall appearance, pronunciation, and/or commercial impression, the distinct nature of the goods and services offered under each mark, distinct trade channels utilized by each mark, and sophistication of Applicant's consumers demonstrates that there is no likelihood of confusion between Applicant's Mark and the Cited Registration.

B. Applicant's Mark is Visually and Aurally Distinct and Creates a Different Commercial Impression from the Cited Registration.

The Board recognizes, as does the Federal Circuit, that under certain circumstances, the differences in the marks may be so significant that they may be dispositive in determining likelihood of confusion. See Champagne Louis Roederer S.A. v. Delicato Vineyards, 148 F.3d

1373, 1375, 47 U.S.P.Q. 2d 1459 (Fed. Cir. 1998) (“[W]e have previously upheld Board determinations that one DuPont factor may be dispositive in a likelihood of confusion analysis, especially when that single factor is the dissimilarity of the marks.”).

The Cited Registration is for YOLO; conversely, Applicant’s Mark is TINY YOLO. When comparing these marks in their entireties, it is readily apparent that the visual and aural impression imparted by Applicant’s Mark, TINY YOLO, is distinct from that created by the Cited Registration, YOLO. The addition of the term “TINY” to Applicant’s Mark, which is completely absent from the Cited Registration, renders the marks visually distinct. Furthermore, this additional term, “TINY”, adds two additional syllables to Applicant’s Mark such that it is pronounced as TINY YOLO, while the Cited Registration is pronounced as YOLO, rendering the at-issue marks aurally distinguishable as well.

Beyond the apparent visual and aural differences, the marks at issue also create distinct commercial impressions, mitigating any likelihood of confusion. See Coach Servs., Inc. v. Triumph Learning, 668 F.3d 1356, 101 U.S.P.Q.2d 1713 (Fed. Cir. 2012) (difference in commercial impressions outweighed similarity in sight and sounds of both parties’ standard character COACH mark); In re Sears, Roebuck and Co., 2 U.S.P.Q.2d 1312 (T.T.A.B. 1987) (CROSSOVER and CROSS-OVER, were not likely to cause confusion, despite being identical in sound and appearance, because they created distinct commercial impressions). For one thing, Applicant’s Mark begins with the term TINY and is followed by the term YOLO, such that the overall mark appears as “TINY YOLO”. In stark contrast, the Cited Registration comprises the term YOLO, on its own. The addition of the word TINY in Applicant’s Mark, which is completely absent from the Cited Registration makes Applicant’s Mark stand apart from the Cited

Registration, creating a distinct commercial impression and eliminating any likelihood of confusion.

In sum, it is clear from the marks themselves that they differ visually and aurally and exude distinct commercial impressions. These factors alone manifest the absence of confusion between the subject marks and are dispositive of the alleged confusion raised in the Office Action.

C. Applicant’s Mark is Distinguishable from the Cited Registration Based on Differences in Nature of the Goods and Services.

The goods and services identified in the instant application and the Cited Registration are not related or marketed in a manner that would cause consumers to incorrectly assume that they share the same source, and accordingly, confusion is unlikely. See In re I.AM.Symbolic, LLC, 866 F.3d 1315, 1325 (Fed. Cir. 2017) (noting that even identical marks may be unlikely to cause confusion when they have different meanings or commercial impressions, or when they “bring to mind” different things); see also In re Thor Tech, Inc., 113 U.S.P.Q.2d 1546, 1551 (TTAB 2015) (finding no likelihood of confusion between two identical marks used to identify similar goods—towable trailers and trucks—in light of the distinct services offered thereunder). For purposes of a likelihood of confusion analysis, the Trademark Trial and Appeal Board relies on the goods and services as identified by the parties in the applications or registrations at issue. Dupont, 476 F.2d 1357, 1361, 177 U.S.P.Q. 563, 567 (C.C.P.A. 1973). Indeed, Applicant’s or Registrant’s description of the goods and services in its application/registration controls whether there is any likelihood of confusion in the nature of the products and services at issue. Nat’l Football League v. Jasper Alliance Corp., 16 U.S.P.Q.2d 1212, 1216 & n.5 (TTAB 1990).

Here, the identified products and services are narrowly drawn and distinct, mitigating any risk of confusion. The goods identified in Applicant’s Mark, as amended, are as follows: “*computer software for use in real time object detection; computer vision software, namely*

software for image and signal processing, object detection, tracking, and recognition, three-dimensional reconstruction and motion analysis” in Class 9. These goods are narrowly tailored to describe a computer software product for use in imaging and object detection. This software is highly technical and used in the specific context of computer vision, to develop specialized applications such as face detection and recognition. In stark contrast, the Cited Registration’s goods and services are identified as “*computer software for communications, scheduling, and database management for use for purposes of online dating, social networking and social introductions; computer software for use in locating and reporting the physical location of individuals via handheld electronic devices*” in Class 9 and “*Internet-based social networking, introduction, and dating services; Internet-based location services, namely, services to locate and report the physical location of individuals*” in Class 45. On information and belief, the Cited Registration is a social networking tool that enables users to coordinate their locations with each other and meet. See Exhibit 1 at <https://www.zdnet.com/article/mobile-social-network-on-a-vc-shoestring-exclusive-trilibis-ceo-interview/>. Furthermore, a review of the specimen submitted with the renewal application for the Cited Registration reveals that the Cited Registration is centered on being a tool for organizing events including unique activities, food experiences, and camping trips. See Exhibit 2. The specimen also reveals that the Cited Registration can be integrated into Facebook, as there is a link in the specimen that would allow a user to login to the network through Facebook. See Exhibit 2. This association with Facebook underscores the fact that the Cited Registration is focused on social networking, and that on further information and belief, Registrant does not provide goods relating to computer vision or imaging and object detection. Indeed, the goods and services of Applicant’s Mark and the Cited Registration are therefore entirely distinct.

D. Applicant’s Mark Utilizes Different Trade Channels and Targets Distinct Markets.

Because Applicant’s Mark and the Cited Registration target different audiences and travel in different trade channels, a likelihood of confusion is improbable. According to TMEP § 1207.01(a)(i), “if the goods or 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 also, e.g., Coach Servs., Inc. v. Triumph Learning LLC, 668 F.3d 1356, 1371, 101 U.S.P.Q.2d 1713, 1723 (Fed. Cir. 2012) (affirming the Board’s finding of no likelihood of confusion between two COACH marks because an educator purchasing test preparation materials who also purchases a luxury handbag would not think that the goods emanate from the same source). Trade channels are marketing environments where parties advertise their goods or services. Standard Knitting, Ltd. v. Toyota Jidosha Kabushiki Kaisha, 77 U.S.P.Q.2d 1917, 1934 (TTAB 2006). Retail stores, newspapers, fashion magazines, catalogs direct mail, and personal sales representatives are all examples of trade channels and marketing environments. *Coach Servs.* 668 F.3d at 1371. Services that are advertised via the internet are not automatically considered to use identical channels of trade. Parfums de Coeur, Ltd. v. Lory Lazarus, 83 U.S.P.Q.2d 1012, 1021, 2007 WL 683784 (TTAB 2007). Rather, trade channels are related to target markets in that two services targeting distinct audiences oftentimes avoid a likelihood of confusion. See Edwards Lifesciences Corporation v. VigiLanz Corp., 94 U.S.P.Q.2d 1399, 2010 WL 1514315 (TTAB 2010) (finding no likelihood of confusion between VIGILANZ computer monitoring systems and VIGILANCE heart monitor and software used in critical care settings even where both products were purportedly used in hospitals, as the products are marketed to distinct personnel); see also Sunenblick v. Harrell, 895 F. Supp. 616, 629 (S.D.N.Y. 1995), aff’d without op., 1010 F.3d 684

(2d Cir. 1996), cert. denied, 519 U.S. 964, 117 S. Ct. 386 (1996) (finding no likelihood of confusion between two musical artist marks using UPTOWN because each artist targeted a distinct audience; one audience was consumers interested in “lost or forgotten jazz artists” while the other audience was consumers with an interest in rap or hip hop). Here, because the products and services of Applicant’s Mark and the Cited Registration travel in separate trade channels and target distinct markets, confusion is unlikely.

The target audience for the products offered under Applicant’s Mark are software developers of applications that utilize computer vision and object image detection, such as, for instance, facial recognition software. Because this audience consists of those with a specialized skillset, they would encounter Applicant’s Mark through specific forums or websites or by word of mouth from other developers. As such, the trade channels through which Applicant’s Mark flows is specific to this target audience and stands as distinct from the trade channels and target audience of the Cited Registration.

In contrast, the Cited Registration targets people who are interested in connecting with each other through a social networking tool, and potentially interested in meeting up with one another by sharing their locations. See Exhibit 3 at <http://krlsdesign.com/trilibis-jpg/home1.html>. On information and belief, the target audience could therefore be groups of friends wanting to share their locations with each other, or a larger group of people interested in coordinating their locations. As such, the trade channels through which the Cited Registration flows include specific forums or websites that promote the use of the tool, or word of mouth among people interested in social networking. Thus, the trade channels and target audiences of Applicant’s Mark and the Cited Registration are distinct because they are specific enough that the context in which they would be

received by their very distinct consumers would also be separate and distinguishable such that there is no likelihood of confusion between the marks.

E. Consumers of Applicant’s Products are Sophisticated, and Exercise Great Care in their Purchasing Decisions.

Because the goods associated with Applicant’s Mark are for computer software for vision and object imaging, the relevant consumers are likely to be highly sophisticated, discriminating purchasers. The Board must consider "the conditions under which and buyers to whom sales are made, i.e., ‘impulse’ vs. careful sophisticated purchasing" in making likelihood of confusion determinations. DuPont, 476 F.2d 1357, 1361 (C.C.P.A. 1973). The Federal Circuit has made clear that “[purchaser] sophistication is important and often dispositive because sophisticated consumers may be expected to exercise greater care.” Elec. Design & Sales Inc. v. Elec. Data Sys. Corp., 954 F.2d 713, 718, 21 U.S.P.Q.2d 1388, 1392 (Fed. Cir. 1992); In re N.A.D., Inc., 754 F.2d 996, 999-1000, 224 U.S.P.Q. 969, 971 (Fed. Cir. 1985) (finding that the mere similarity of marks did not create a likelihood of confusion because the relevant goods would be purchased by sophisticated buyers exercising great care); In re Ameristar Fence Prods., Inc., 2012 WL 1267941 (T.T.A.B. 2009) (reversing finding of likelihood of confusion between 440 and 440-XH marks in light of consumer sophistication).

Applicant’s goods are sought by computer professionals and only after exercising great care. The products at issue – *computer software for use in real time object detection; computer vision software, namely software for image and signal processing, object detection, tracking, and recognition, three-dimensional reconstruction and motion analysis* – are likely to be purchased by software developers who create applications that use this technology. The Board has “often found that professionals are sophisticated purchasers, or exercise greater care in making their purchases than the general public.” E-Conolight LLC v. Luman Lighting, LTD, 2013 WL 2365032, at *5

(T.T.A.B. 2013). The sophisticated purchasers of Applicant's goods would therefore exercise caution in the selection of software to be used in creating their applications, thus minimizing any likelihood of confusion with the Cited Registration.

IV. CONCLUSION

In view of the foregoing, Applicant respectfully requests withdrawal of the refusal to register.