

1 **IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

2

3 Applicant: FX Key Card, Inc.)

4 US Trademark Appl. No.: 88127135) USPTO Atty: BURDECKI, ANNA C

5 Filed: September 21, 2018) Law Office: 108

6 Mark: CLAVIS) Ref.: FXKYP001.US09

7

8

9 The Examiner is thanked for the Office Action dated January 8, 2019. Please consider

10 the following amendments and remarks.

11

12 **SECTION 2(D) REFUSAL – LIKELIHOOD OF CONFUSION**

13 The Examining Attorney has refused registration of the proposed mark pursuant to

14 Trademark Act Section 2(d), 15 U.S.C. § 1052(d), on the grounds that the mark is likely to

15 be confused with the mark in Registration No. 4285170 (“the ‘170 Registration”).

16 Applicant respectfully disagrees for the following reasons.

17 First, it should be noted that a Declaration of Use under §8 was not filed by the

18 owner of the ‘170 Registration (“the ‘170 Registrant”) by the February 5, 2019 deadline,

19 and still has not been filed even though we are only 28 days from the end of the six month

20 grace period of August 5, 2019. While Applicant does not believe that its mark and the

21 mark of the ‘170 Registration are confusingly similar, the Examiner may wish to wait

22 until after the cancellation date to make a final decision.

23 Likelihood of confusion between two marks is determined at the PTO by a review

24 of all of the relevant factors under the “*du Pont*” test¹. The two key considerations under

25 the *du Pont* test in *ex parte* likelihood of confusion analysis are the similarity of the marks

26 and the similarity of the goods. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544

27 _____

28 ¹ *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA1973).

1 F.2d 1098, 192 USPQ 24 (CCPA 1976). Applicant believes that there is no likelihood of
2 confusion, *inter alia*, under these two key *du Pont* factors, as set forth below.

3 ***The Marks are Dissimilar in Commercial Impression***

4 The *du Pont* factor regarding the similarities of the marks is more completely
5 described as follows: The similarity or dissimilarity of the marks in their entirety as to
6 appearance, sound, connotation and commercial impression. (emphasis added). Applicant
7 is applying for the registration of a standard character mark as follows:

8
9
10
11
12
13
14
15
16
17
18
19
20
21
22
23
24
25
26
27
28

CLAVIS

The '170 Registration mark, in contrast, is a compound mark including both letters
and symbols, all of which relate to the commercial impression of the mark:



While the letters do spell “clavis” in a stylized manner, just as important to the
meaning of the mark are the design element of the keyhole in the letter “a”, the cloud
above the letters “vis”, and the green color². To those who are in the market for cloud
services, the keyhole implies an encryption key, implying internet security, the cloud
relates to cloud computing and the color green is suggestive of the environmental
soundness of cloud computing where computing resources are efficiently shared by many
users. Therefore, clear commercial impression of the '170 Registration mark is that it

² Note that the color green is claimed as a feature of the mark.

1 applies to virtual or “cloud” computing, and the entirety of the mark must be considered,
2 not just the word portion. Since no evidence is present that “clavis” is a famous mark, or
3 even in use as a trademark by the ‘170 Registrant, the design portions of the mark are
4 actually more distinctive, and memorable, than the word portion itself. That is, an
5 ordinary observer would probably remember the keyhole, cloud and green color better
6 than the word portion of the ‘170 Registration mark. Therefore, taken as a whole, the
7 marks are dissimilar in commercial impression.

8 ***Applicant’s Goods are Unrelated to the ‘170 Registration Services***

9 Applicant’s goods includes software for processing electronic payment to and from
10 others and/or software for effecting foreign exchange transactions to and from others.
11 These goods are analogous to credit card networks, or international money wiring
12 networks. These goods do not permit virtual or cloud computing and, in fact, it would
13 create insecurity in the financial system if it did.

14 The ‘170 Registration services, in contrast, are all about providing a cloud
15 computing platform so that their customers can run virtual computers over the internet.
16 There services have nothing to do with processing electronic payments or facilitating
17 foreign exchange transactions. In fact, the ‘170 Registration services rent virtual servers
18 to customers in the same way that another company might rent or sell physical servers to
19 customers. What the customers do with the virtual servers is up to them.

20 As noted above, the two marks, while have an element of overlap, are dissimilar in
21 commercial impression. There must therefore be a substantial showing that the goods are
22 “related in some manner and/or if the circumstances surrounding their marketing are such
23 that they could give rise to the mistaken believe that [the goods and/or services] emanate
24 from the same source.” *Coach Serv., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1369,
25 101 USPQ2d 1713, 1722 (Fed. Cir. 2012). There is no such showing here. The Examiner
26 cites to a number of famous, high tech companies such as Amazon, Google, Intel and
27 Microsoft, and equates Applicant’s goods with the ‘170 Registration’s services because all
28 of them allegedly provide both electronic payment and/or foreign exchange processing

1 and the cloud computing services. This argument fails in that: 1) none of these companies
2 operate like a credit card or foreign exchange network but, rather, as ecommerce websites
3 and therefore do not provide Applicant's identified goods; 2) there is no nexus or
4 commonality between the disparate services of these high-tech giants which would imply
5 that Applicant's goods and the '170 Registrant's services are related; and 3) all of the
6 companies have famous marks known to millions of people around the world, which is
7 simply not applicable to Applicant and the '170 Registrant. Since none of these factors
8 apply to Applicant's goods and the '170 Registrant's services, their goods and services,
9 respectively, are completely dissimilar.

10 ***Other du Pont Factors***

11 Other *du Pont* factors also apply in this case. For example, established, and likely-
12 to-continue trade channels are entirely dissimilar. Cloud services, including those by the
13 '170 Registrant and the famous high-tech companies cited by the Examiners, are not
14 marketed as financial instruments to individuals. Cloud services are marketed to
15 companies and computing professionals who are technically competent to create and
16 manage virtual server farms over the internet. This also goes to another du Pont factor,
17 the conditions under which the sales are made, *i.e.* "impulse" vs. careful, sophisticated
18 purchasing. Selling cloud services to sophisticated companies is much different than
19 processing electronic payments between two individuals or entities, or implementing
20 foreign exchange transactions, but none of these activities are conducive to impulse
21 buying. These additional du Pont factors further support the proposition that there is no
22 likelihood of confusion between the marks.

23
24 **AMENDMENTS TO THE IDENTIFICATION OF GOODS**

25
26 ***Applicant amends the identification of the goods in Class 9 as follows:***

27 *Computer software for processing electronic payments to and from*
28 *others downloaded from a global computer network; computer software for*

1 *processing electronic payments to and from others that is recorded on*
2 *computer media; computer software for effecting a foreign exchange*
3 *transaction that is downloaded from a global computer network; computer*
4 *software for effecting a foreign exchange transaction that is recorded on*
5 *computer media; magnetically encoded debit cards.*

6
7 ***A marked-up version is as follows:***

8 *Computer software for processing electronic payments to and from*
9 *others ~~and/or for effecting a foreign exchange transaction that may be~~*
10 *downloaded from a global computer network ~~and/or~~; computer software for*
11 *processing electronic payments to and from others that is recorded on*
12 *computer media; computer software for effecting a foreign exchange*
13 *transaction that is downloaded from a global computer network; computer*
14 *software for effecting a foreign exchange transaction that is recorded on*
15 *computer media authentication software that may be downloaded from a*
16 *global computer network and/or recorded on computer media; magnetically*
17 *encoded debit cards*

18
19 Applicant respectfully submits that the foregoing amendments clarify the identification
20 of the goods. Additionally, as shown by the underlined additions and the deletions indicated
21 by strikethrough, the identifications have been amended to list only those goods that are within
22 the scope of the goods set forth in the original application. The “authentication software” has
23 been removed from the identification of the goods without prejudice to being reintroduced in
24 subsequent registration application(s).

25 Applicant respectfully submits that the amended wording of the identification of the
26 goods has been properly clarified to definitely describe the goods to which the mark is applied.
27 Should the Examiner wish to further discuss the identification of the goods, she is invited to
28 call the undersigned at the number set forth below.

1
2
3
4
5
6
7
8
9
10
11
12
13
14
15
16
17
18
19
20
21
22
23
24
25
26
27
28

Conclusion

For at least the reasons set forth above, Applicant submits that Applicant's mark is not confusingly similar to that of the '170 Registration, and that his identification of the goods, as amended, are clear and definite. The Examiner is respectfully requested to reconsider her rejection of the present application and to allow this application to proceed to publication.

Respectfully submitted,



Paul L. Hickman
Reg. 28,516