

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application Serial No.: 88384546
Mark: ConnectedED
Applicant: The Raechel & Jackie Foundation
Examining Attorney: Jeffrey Sjogren, Law Office 122

MEMORANDUM OF LAW IN SUPPORT OF RESPONSE TO SECTION 2(d) REFUSAL

I. Introduction

The applicant, The Raechel & Jackie Foundation (“Applicant”) applied to register the mark “ConnectedED” (the “Mark”) for charitable fundraising services in International Class 36. In an Office Action dated July 3, 2019 (“Office Action”), registration was refused pursuant to Trademark Act Section 2(d), 15 U.S.C. §1052(d), on the grounds the Mark was likely to be confused with the registered marks “AMERICA CONNECTED” (U.S. Registration No. 5641385) and “CONNECTED BY GOOD” (U.S. Registration Nos. 5386681 and 5517157) (collectively, the “Prior Marks”).

Applicant respectfully disagrees with the conclusion that these marks create a likelihood of confusion and submits that (A) the Prior Marks, considered as a whole, create different commercial impressions; and (B) Applicant’s services and those of the prior registrants would not be expected to emanate from the same source.¹

¹ Concurrently with this Response, Applicant has narrowed its identification of services to “charitable fundraising **for education projects in developing countries**; accepting and administering monetary charitable contributions **to education projects in developing countries**; charitable foundation services, namely, providing financial support to education projects in developing countries” to clarify both the distinctions between its services and the prior registrants’ and the commercial impression conveyed by its mark.

II. Argument

Section 2(d) of the Trademark Act bars the registration of a mark so similar to a registered mark that it is likely that a potential consumer would be confused or mistaken or deceived as to the source of the goods and/or services. The court in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973) listed the principal factors to be considered in assessing likelihood of confusion. Of these factors, the Office Action identified the following as the most relevant in this case: “(1) the similarities between the compared marks and (2) the relatedness of the compared services.” These factors cannot be weighed in isolation or treated in a mechanical, binary fashion. TMEP §1207.01, et seq. Where, as here, the relationship between the services is so tenuous, greater similarity between the marks would be required before confusion is likely. Likewise, where, as here, the marks create such distinct commercial impressions, a stronger relationship between the services would be required before confusion is likely. A mechanical conclusion that there is *some* similarity between the marks and *some* similarity between the services is insufficient.

A. **“ConnectED” creates a different commercial impression than “AMERICA CONNECTED” or “CONNECTED BY GOOD.”**

The sole basis for similarity in the marks raised in the Office Action is that the marks share the word “CONNECTED.”

While certain features of a mark may be given more or less weight in assessing similarity, the marks must be compared in their entirety rather than dissected. *In re National Data Corporation*, 224 USPQ 749, 750-751 (Fed. Cir. 1985); *Massey Junior College, Inc. v. Fashion Institute of Technology*, 181 USPQ 272, 273-274 (CCPA 1974). Here, the marks as a whole have significant dissimilarities in sound, appearance, and meaning. In addition, in connection with

Applicant's services, the word "CONNECTED" conveys a wordplay not present in the Prior Marks.

The marks are substantially different in sound, with the Prior Marks containing at least twice as many syllables. *See ProMark Brands Inc. and H.J. Heinz Company v. GFA Brands, Inc.*, Opposition No. 91194974 (TTAB April 2014) (noting that "[junior mark] 'SMART BALANCE' is composed of more syllables than [senior mark] 'SMART ONES'" and was therefore "noticeably different"). They are even more different in appearance, as Applicant's Mark consists of a single 8-letter word, whereas the Prior Marks are presented as two- and three-word phrases containing 15 and 14 letters respectively.

They also convey very different meanings. The Prior Marks are unitary grammatical phrases, communicating in one case a thing which is connected ("America") and in the other a mechanism of connection ("by good"). Applicant's Mark, in contrast, does not stress any such qualifiers.

Furthermore, Applicant's Mark contains an element of wordplay absent from the Prior Marks. Because Applicant's services are limited to the field of education, the public is likely to understand the "ED" element of the Mark to convey a double meaning. This meaning is unlikely to attach to the Prior Marks due to their additional elements, which render "CONNECTED" in the context of unitary phrases. Furthermore, in the case of "CONNECTED BY GOOD," the services are limited to organizing and promoting community service projects, activities that have no connection to "ed."

B. The relationship between the services is minimal.

The Office Action asserts similarity between Applicant's identified Class 36 services, namely "charitable fundraising for ... [and] providing financial support to educational projects in

developing countries,” and the Class 35 services identified in U.S. Registration Nos. 5386681 and 5517157, namely “organizing and conducting volunteer programs and community service projects” and in U.S. Registration No. 5641385, namely “organizing and developing charitable projects that ... make a community impact.” This assertion is based on website evidence purporting to show that third-party entities UNICEF, Asha for Education, and Smile Foundation engage in fundraising for education projects in developing countries while also organizing volunteer programs and/or community-impact projects.

First, while these websites appear to show that charitable organizations often rely on volunteers, they do not clearly show that the referenced organizations use their respective trademarks specifically in connection with “organizing ... volunteer programs” as a Class 35 business service.² Meanwhile, although “charitable projects that ... make a community impact” might in the broadest sense be interpreted to encompass charitable “educational projects in developing countries” such as those organized by UNICEF, etc., the fact that U.S. Registration No. 5641385 identifies a long list of services, most of which explicitly have nothing to do with either education or developing countries, strongly suggests that “community impact” organizing and “education project” organizing are related only at a very high level of generality if at all.

The relatedness of Applicant’s Class 36 fundraising services and the registrants’ Class 35 volunteer-program/community-impact organizing services is therefore tenuous at best.

III. Conclusion

Even if the registered services were sufficiently related to Applicant’s to cause a likelihood of confusion with respect to identical marks, there is no such likelihood here where

² The mark ASHA FOR EDUCATION is registered in Class 36 for “Charitable services, namely, organizing fundraising services and events to raise funds in the field of education” (U.S. Reg. No. 4204657). Instructively, however, none of the organizations referenced in Examiner’s website evidence appear to own registrations in connection with organizing either volunteer programs or community-impact projects.

the marks are so dissimilar. Applicant therefore respectfully requests that the Section 2(d) refusal be withdrawn.

Dated: July 25, 2019

By: /s/ Chris McElwain

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