RESPONSE AND AMENDMENT

Re: VENN, Serial No. 79/249,603

This Amendment and Response is being filed in response to the Office Action transmitted to the International Bureau on February 5, 2019. In the Office Action, the Examining Attorney has refused to register the Applicant's mark on the grounds that:

(1) the mark, when used on or in connection with the identified goods, so resembles a registered mark as to be likely to cause confusion, to cause mistake, or to deceive, under Section 2(d) of the Trademark Act with regard to **"computer software" only**;

(2) the identification of goods requires clarification and amendment;

(3) the Applicant must provide information on the significance of the mark (whether the mark has any meaning or significance in the industry in which the goods and/or services are manufactured/provided, any meaning or significance as applied to applicant's goods and/or services, or if such wording is a term of art within applicant's industry, whether the wording identifies a geographic place or has any meaning in a foreign language); and

(4) the Applicant must clarify its entity status.

I. AMENDMENT

Applicant requests that the following amendment of the goods in Classes 9, 36, and 41 be entered:

"Computer software for database management of real estate assets and services provided to user community, enable members to advertise hosted events, request the company to coordinate tradesmen service providers, onboarding of new members, and to provide personal assistance functions available in the application; computer software applications for mobile phones, portable media players, handheld computers, namely, software for database management of real estate assets and services provided to user community, enable members to advertise hosted events, request the company to coordinate tradesmen

service providers, onboarding of new members, and to provide personal assistance functions available in the application in the field of communal housing" in Class 9

"Financial management; financial consultancy; providing financial information via a web site; real estate management; apartment house management; management of residential complexes, namely, management of buildings, apartments, open spaces, real-estate properties, art and cultural spaces, co-working spaces; providing operational services for residential complexes, namely, coordinate tradesmen service providers, manage member utility and internet service payments and taxes, providing members with recreational services, namely, community events and gym classes, partnering with landlords and local vendors in the member community; real estate agency services; rental of real estate; rental of apartments; accommodation bureau services, namely, manage member utility and internet service payments and taxes; rental of offices; providing facilities or space for exhibitions, educational classes, seminars, workshops, cultural events, restaurants, offices, and co-working spaces**.** In Class 36

"Conducting workshops, conferences and lectures in the fields of lifestyle, health, nutrition, wellness, business development, and finance and distribution of educational materials in connection therewith; organizing exhibitions in the fields of lifestyle, health, nutrition, wellness, business development, and finance for educational and cultural purposes; organizing and conducting personal educational sessions namely education services, namely, providing tutoring in the field of lifestyle, health, nutrition, wellness, business development, and finance." In Class 41

II. OWNER NAME AND ENTITY STATUS

The Applicant respectfully requests that the following entity information be entered into the record:

"The Applicant is a Limited Liability Company organized as a Private Company in the State of Israel."

III. SIGNIFICANCE OF THE MARK

The Applicant states that the term "venn" is used in mathematics, mainly in the field of logic and probability, as in a Venn diagram. The common use of this definition is mainly in order to express relations between groups and a finite collection of different sets. It has no known meaning or significance in the industry in which the goods and/or services are manufactured/provided, is not a term of art within applicant's industry and does not identify a geographic place or

has any meaning in a foreign language. It is a creative and perhaps suggestive use of the word related to assisting members to integrate diverse aspects of a person's life.

IV. RESPONSE

A. APPLICANT'S MARK IS NOT LIKELY TO CAUSE CONFUSION WITH THE CITED REFERENCE DUE TO VAST DIFFERENCES IN THE GOODS APPLICANT'S GOODS, AS AMENDED, FROM THOSE OF THE CITED MARK, DIFFERENCES IN THE CHANNELS OF TRADE FOR THOSE GOODS, AND CIRCUMSTANCES SURROUNDING THE MARKETING OF THOSE GOODS.

In the Office Action, the Examining Attorney has refused registration of the Applicant's mark for VENN as likely to cause confusion with regard to a registration for the mark VENN, as shown in U.S. Registration No. 4913450 as the Applicant's mark relates to computer software.

Applicant has amended the goods and services listed in the application to the following identification:

> "Computer software for database management of real estate assets and services provided to user community, enable members to advertise hosted events, request the company to coordinate tradesmen service providers, onboarding of new members, and to provide personal assistance functions available in the application; computer software applications for mobile phones, portable media players, handheld computers, namely, software for database management of real estate assets and services provided to user community, enable members to advertise hosted events, request the company to coordinate tradesmen service providers, onboarding of new members, and to provide personal assistance functions available in the application."

The cited registration protects "computer application software containing and for playing puzzles." Applicant respectfully suggests that the Applicant's now amended identification of goods makes it abundantly clear that the goods of the two companies are completely unrelated and that there is no likelihood of confusion possible.

Certainly, the purchaser of game software would not likely be confused into believing that software for database management of real estate assets, or enabling persons to advertise hosted events, request a company to coordinate tradesmen service providers, allows for onboarding of new members, and to provide personal assistance functions would be the same seller as the producer of computer games. Nor would a game enthusiast seek to purchase computer games in the same or similar channels of trade that consumers desiring to find providers of group services related to real estate, wellness, community services, tradesmen, etc.

"A variety of factors may be material in assessing the likelihood of confusion and no one of these factors by itself is dispositive of the likelihood of confusion question." *McGraw-Edison Co. v. Walt Disney Productions*, 787 F.2d 1163, 1167 (7th Cir. 1986). The analysis of the likelihood of confusion involves consideration of several factors.

The relevant factors in analyzing the likelihood of confusion are as follows:

1. The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.
2. The similarity or dissimilarity, and nature, of the goods or services as described in an application or registration or in connection with which a prior mark is in use.
3. The similarity or dissimilarity of established, likely to continue trade channels.
4. The conditions under which, and buyers to whom, sales are made, i.e., "impulse" vs. careful, sophisticated purchasing.
5. The fame of the prior mark (sales, advertising, length of use).
6. The number and nature of similar marks in use on similar goods.
7. The nature and extent of any actual confusion.
8. The length of time during and conditions under which there has been concurrent use without evidence of actual confusion.
9. The variety of goods on which the mark is or is not used (house mark, "family" mark, product mark).
10. The market interface between applicant and the owner of a prior mark.
11. The extent to which applicant has a right to exclude others from use of its mark on its goods.
12. The extent of potential confusion.
13. Any other established fact probative of the effect of use.

In re E.I. DuPont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). Application of the above factors to the instant case shows that Applicant's mark is not likely to cause confusion with the cited references.

In order to find that a likelihood of confusion exists, the conditions surrounding the marketing of the services at issue must be such that they would be encountered by the same purchasers under circumstances that would give rise to the mistaken belief that they come from a common source. *On-Line Careline Inc. v. America Online Inc.*, 229 F.3d 1080, 56 USPQ2d 1471 (Fed. Cir. 2000); *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984); *In re Corning Glass Works*, 229 USPQ 65 (TTAB 1985); *In re Jeep Corp.*, 222 USPQ 333 (TTAB 1984).

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, e.g., Shen Manufacturing Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 73 USPQ2d 1350 (Fed. Cir. 2004) (cooking classes and kitchen textiles not related); *Local Trademarks, Inc. v. Handy Boys Inc.*, 16 USPQ2d 1156 (TTAB 1990) (LITTLE PLUMBER for liquid drain opener held not confusingly similar to LITTLE PLUMBER and design for advertising services, namely the formulation and preparation of advertising copy and literature in the plumbing field); *Quartz Radiation Corp. v. Comm/Scope Co.*, 1 USPQ2d 1668 (TTAB 1986) (QR for coaxial cable held not confusingly similar to QR for various products (*e.g.*, lamps, tubes) related to the photocopying field).

The channels of trade and relevant consuming class must be considered in determining whether a likelihood of confusion exists. *See, Pep Boys-Manny, Moe & Jack v. Edwin F. Guth*

Co., 197 F.2d 527, 94 USPQ 158 (C.C.P.A. 1952) (lighting fixtures and storage batteries sold in different channels of trade); *Fred W. Amend Co. v. American Character Doll Co.*, 223 F.2d 277, 106 USPQ 187 (C.C.P.A. 1955) (candy-dolls); *Kiekhaefer Corp. v. Willys-Overland Motors, Inc.*, 236 F.2d 423, 111 USPQ 105 (C.C.P.A. 1956); *Du Barry of Hollywood, Inc. v. Richard Hudnut (Corp.)*, 323 F.2d 986, 139 USPQ 112 (9th Cir. 1963) (cosmetics-women's clothing); *Clayton Mark & Co. v. Westinghouse Electric Corp.*, 356 F.2d 943, 148 USPQ 672 (C.C.P.A. 1966) (electrical conduit and industrial circuit breakers sold in different channels for different uses); *Sweetarts v. Sunline, Inc.*, 380 F.2d 923, 154 USPQ 459 (8th Cir. 1967), on remand, 299 F. Supp. 572, 162 USPQ 179 (E.D. Mo. 1969), aff'd in part and rev'd in part, 436 F.2d 705, 168 USPQ 483 (8th Cir. 1971) (children's candy and "adult" chocolates); *Blazon, Inc. v. Blazon Mobile Homes Corp.*, 416 F.2d 598, 163 USPQ 156 (7th Cir. 1969) (different channels of distribution for trailers and children's toys and sports equipment); *Communications Satellite Corp. v. Comcet, Inc.*, 429 F.2d 1245, 166 USPQ 353 (4th Cir. 1970), cert. denied, 400 U.S. 942, 91 S. Ct. 240, 167 USPQ 705 (1970); *In re Yazaki Corp.*, 437 F.2d 1406, 168 USPQ 772 (C.C.P.A. 1971); *Habitat Design Holdings, Ltd. v. Habitat, Inc.*, 436 F. Supp. 327, 196 USPQ 425 (S.D.N.Y. 1977), modified, 200 USPQ 10 (2d Cir. 1978) (sales through professional interior designer and consumer fields do not prevent common exposure to consumers); *Information Clearing House, Inc. v. Find Magazine*, 492 F. Supp. 147, 209 USPQ 936 (S.D.N.Y. 1980) (similar titles on magazines directed to specialized business clients and on consumer family magazine held not likely to cause confusion).

If the goods or services of one party are marketed and sold to one class of buyers in a different marketing context than the goods of another seller, the likelihood that a single group of buyers will be confused by similar trademarks is less than if both parties sold their goods or

services through the same channel of trade. *See McCormick & Co. v. B. Manischewitz Co.*, 206 F.2d 744, 98 USPQ 367 (6th Cir. 1953); *Applebaum v. Senior*, 154 Cal. App. 2d 371, 316 P.2d 410, 115 USPQ 243 (1st Dist. 1957); *Dynacolor Corp. v. Beckman & Whitley, Inc.*, 134 USPQ 410 (TTAB 1962); *Paul Sachs Originals Co. v. Sachs*, 325 F.2d 212, 139 USPQ 414 (9th Cir. 1963); *Field Enterprises Educational Corp. v. Cove Industries, Inc.*, 297 F. Supp. 989, 161 USPQ 243 (E.D.N.Y. 1969); *Telex Corp. v. Sound Ear, Inc.*, 169 USPQ 255 (TTAB 1971); *Dynamics Research Corp. v. Langenau Mfg. Co.*, 704 F.2d 1575, 217 USPQ 649 (Fed. Cir. 1983); *Oxford Industries, Inc. v. JBJ Fabrics, Inc.*, 6 USPQ.2d 1756 (S.D.N.Y. 1988); *Paco Sport, Ltd. v. Paco Rabanne Parfums*, 86 F. Supp. 2d 305, 54 USPQ.2d 1205 (S.D.N.Y. 2000), judgment aff'd without op, 234 F.3d 1262 (2d Cir. 2000).

In this matter, the computer game software of the cited Registrant's mark is so vastly different than the computer software sold by the Applicant that it is certainly evident that the parties' goods are not related in such a manner that consumer confusion as to the source of those goods is likely. *See On-Line Careline Inc.* 56 USPQ2d 1471; *In re Martin's Famous Pastry Shoppe, Inc.*, 223 USPQ 1289; *In re Corning Glass Works*, 229 USPQ 65; *In re Jeep Corp.*, 222 USPQ 333. *See also Shen Manufacturing Co. v. Ritz Hotel Ltd.*, 73 USPQ2d 1350; *Local Trademarks, Inc.*, 16 USPQ2d 1156; *Quartz Radiation Corp.*, 1 USPQ2d 1668.

V. CONCLUSION

By this response, Applicant has addressed the issues raised by the Examining Attorney and respectfully requests that the application be approved for publication at an early date.
If the Examining Attorney has any questions or comments, Applicant respectfully requests that the Examining Attorney contact the undersigned Attorney of record.