

U.S. Trademark Application No. 88/163,001
Mark: LIFE MODE
Applicant: Palm Ventures Group, Inc.
Attorney Ref.: 10409-00502-00002 US

RESPONSE TO OFFICE ACTION

Applicant, Palm Ventures Group, Inc. (“Applicant”), hereby responds to the Office Action issued January 29, 2019, for the above-referenced application, and submits that it is timely. In the Office Action, the Examining Attorney required Applicant to amend its identification of goods to clarify “computer software.” Additionally, the Examining Attorney refused to register Applicant’s mark based on a likelihood of confusion with U.S. Registration No. 3,265,115 for LIFE and also noted prior-pending Application Nos. 87072731, 87871110 and 87377449, indicating that, if one or more of the marks in the referenced applications register, Applicant’s mark may be refused registration under Trademark Act Section 2(d) because of a likelihood of confusion with the registered mark(s). Applicant respectfully requests that the Examining Attorney reconsider the likelihood of confusion and potential likelihood of confusion refusals based on its amended identification of goods and the discussion below.


Amended Identification of Goods

The Examining Attorney required Applicant to amend its identification of goods to clarify “computer software.” In this regard, Applicant has amended its identification of goods to delete this broad claim to “computer software” so the application now covers only “computer software to view, control, and manage usage and activity on mobile phones, tablets, and other electronic devices; computer software to view, control and manage calls, notifications, and alerts on mobile phones, tablets and other electronic devices.” Applicant respectfully submits that this amended identification is clear and meets all other Office requirements. Accordingly, Applicant requests that the Examining Attorney use this amended identification in re-assessing the likelihood of confusion and potential likelihood of confusion refusals.

There Is No Likelihood of Confusion Between Applicant’s Mark and the Registered and Prior-Pending Marks

The Examining Attorney refused to register Applicant’s mark based on a likelihood of confusion and potential likelihood of confusion with the below marks:

Reg./Appln. No.	Mark	Goods and/or Services
Reg. No. 3,265,115	LIFE	Class 9: Computer software, namely, fatigue evaluation software for valve actuators
Appln. No. 87072731	LIFE	Class 9: Software application for mobile devices for social networking, for recognizing users based on location, for connecting

Reg./Appln. No.	Mark	Goods and/or Services
		users, for allowing users to share contact information, for organizing contact information, for suggesting new contacts to users, and for intelligently recruiting new users
Appln. No. 87871110		<p>Class 9: Apparatus for monitoring of personnel; Fatigue monitoring equipment; Scientific apparatus and instruments for monitoring fatigue; Body function monitoring apparatus other than for medical purposes; Physiological monitoring apparatus, other than for medical use; Mounting devices for electrodes; Computer software for monitoring and reporting on alertness and fatigue; Computer hardware for monitoring and reporting on alertness and fatigue.; Apparatus for monitoring of personnel; Body function monitoring apparatus (other than for medical purposes); Physiological monitoring apparatus, other than for medical use; Mounting devices for electrodes</p> <p>Class 25: Headwear, namely, headbands; Headbands for use in fatigue monitoring</p>
Appln. No. 87377449	LIFE	<p>Class 7: Machines for manufacturing metal parts, namely, lathes, multi-spindle machines, drilling machines, trueing machines for metalworking, turning machines in the nature of turning machine for making metal parts...</p> <p>Class 9: Recorded content, namely, sound recordings, audio recordings, video recordings, DVD featuring operation and performance of machine tools for metal parts; Electronic database in the field of machine tools for metal parts recorded on computer media; downloadable software for operation, maintenance and control of machine tools for making metal parts , data storage; Apparatus for recording, transmission or reproduction of sound or images; Information technology and audiovisual equipment, namely, audiovisual receivers, computers data processors; Calculators; data processing apparatus; electrical and mechanical data processing equipment; electrical and mechanical data processing accessories, namely, couplers; computers; Control instruments, namely, operational and monitoring machine tools for metal parts; measuring instruments, namely, particular measuring instruments rulers, tool measuring instruments, instruments for measuring length, rotation, angular velocity and displacement; detecting instruments, namely, motion detectors, power consumption detectors, ware detectors; monitoring instruments, namely, electronic carbon dioxide monitors, other than for medical use, Electric, electronic, or electrochemical oxygen monitors and sensors for environmental use; supervision</p>

Reg./Appln. No.	Mark	Goods and/or Services
		<p>instruments, namely, operational machine tool monitors for making metal parts; Measuring apparatus based on mechanical, hydraulic and electrical principles; Control and regulating apparatus based on electrical principles, namely, electronic controllers for monitoring machine tools for making metal parts; Inspection machines for the physical inspection of metal parts manufactured by machine tools; Computer programs for monitoring the operation, ware and production of machine tools for making metal parts; control programs, namely, computer programs for enabling of access or entrance control of machine tools for making metal parts; All the aforesaid goods solely for use with machines and machine tools for the treatment of materials and production, and parts therefor; All aforesaid goods for use with machines and machine tools for material processing and production as well as parts thereof; All aforesaid goods only as industrial goods and only related to machines and machine tools for material processing and production</p> <p>Class 35: Advertising, marketing and promotional services; business management...</p> <p>Class 37: Installation, cleaning, repair and maintenance, of machines and machine tools for the treatment of materials and production, and the component parts therefor; all aforesaid goods except honing machines, honing tools and related accessories...</p> <p>Class 40: Custom manufacturing of machine tools for metal parts; Machines and services which involve cutting, shaping, polishing by abrasion or metal coating and multi-spindles, all aforesaid goods except honing machines, honing tools and related accessories</p> <p>Class 41: Education services, namely training in the form of classes, seminars, meetings telephone and video conferencing in the field of machine tools for making metal parts, the latter not for travel and sightseeing education services...</p> <p>Class 42: Scientific and technological services, namely, consultancy in the field of the use and configuration of machines and machine tools for the treatment of materials and production, and parts therefor...</p>

If one or more of the marks in the prior-pending applications register, the Examining Attorney indicated that Applicant's mark may be refused registration.

For the reasons discussed below, Applicant respectfully disagrees with the Examining Attorney's assessment and requests that she withdraw the likelihood of confusion and potential likelihood of confusion refusals because confusion between the marks is not likely.

Section 2(d) of the Trademark Act precludes registration of an applicant's mark "which so resembles a mark registered in the Patent and Trademark Office...as to be likely, when used on or in connection with the goods [and/or services] of the applicant, to cause confusion." 15 U.S.C. §1052(d). A determination of likelihood of confusion under Section 2(d) is made on a case-by-case analysis, using the factors set out in *In re E.I. Du Pont de Nemours & Co.*, 177 U.S.P.Q. 563 (C.C.P.A. 1973).

When considering whether there is a likelihood of confusion, marks must be compared in their entireties. *General Mills, Inc. v. Kellogg Co.*, 3 U.S.P.Q.2d 1442 (8th Cir. 1987) ("[A] court must look to the overall impression created by the marks and not merely compare individual features"). See also *In re Electrolyte Laboratories Inc.*, 16 U.S.P.Q.2d 1239 (Fed. Cir. 1990) (stating that no element of a mark is ignored in a likelihood of confusion analysis); *In re 1776, Inc.*, 223 U.S.P.Q. 186 (T.T.A.B. 1984) (it is improper to dissect a mark as "[i]t is axiomatic that marks must be considered in their entireties in resolving the issue of confusing similarity"); J. Thomas McCarthy, *Trademarks and Unfair Competition*, §23:41 (a mark "should not be split into its component parts and each part then compared with the corresponding parts of the conflicting mark to determine the likelihood of confusion. It is the impression that the mark as a whole creates on the average reasonably prudent buyer and not the parts thereof, that is important").

Differences in the parties' goods and services also serve to distinguish the marks. Simply because the marks at issue cover goods that are broadly grouped as computer software does not support a finding of likelihood of confusion per se. It has long been recognized that use in the same broad field is not sufficient to demonstrate that a genuine issue concerning likelihood of confusion exists. See TMEP §1402.03 (requiring that any identification of goods for computer programs must be sufficiently specific to permit determinations with respect to likelihood of confusion); *Electronic Data Systems Corp. v. EDSA Micro Corp.*, 23 U.S.P.Q.2d 1460 (T.T.A.B. 1992) ("[T]he fact that both parties provide computer programs does not establish a relationship between the goods or services, such that consumers would believe that all computer software programs emanate from the same source simply because they are sold under similar marks"); *Information Resources, Inc. v. X*Press Information Services*, 6 U.S.P.Q.2d 1034 (T.T.A.B. 1988) (quoting *In re Quadram Corp.*, 228 U.S.P.Q. 863 (T.T.A.B. 1985)) ("As a result of the veritable explosion of technology in the computer field over the past several years and the almost limitless number of specialized products and specialized uses in this industry, we think that a per se rule relating to source confusion vis-à-vis computer hardware and software is simply too rigid and restrictive an approach and fails to consider the realities of the marketplace").

Goods that may seem related at first blush, even if they are in the same class, may not cause confusion as to source if their functions are quite different. *In re Princeton*, 95 U.S.P.Q.2d 1509 (T.T.A.B. 2010). Even computer software that exists in the same industry or is ambiguous as to industry is not likely to cause confusion if the function of the software differs. See *M2 Software Inc. v. M2 Communications Inc.*, 2005 WL 1822550, at *5 (T.T.A.B. 2005). An

analysis of the parties' respective computer software and services must take into account any specifics of the software claimed. When the identification of goods contains limitations, those limitations must be considered in a likelihood of confusion analysis. *See M2 Software Inc.*, 2005 WL 1822550, at 4. Once an identification specifies a function of the computer software, other functions are excluded by omission. *In re Microsoft Corp.*, 2012 WL 1881488, at *7 (T.T.A.B. 2012). Therefore, in comparing the marks in their entireties, including the parties' relevant goods and services, Applicant respectfully submits that there is no likelihood of confusion between its mark and the marks in the cited registration and prior-pending applications and requests withdrawal of same. Below are the detailed analyses of the differences between Applicant's mark and the cited marks.

There Is No Likelihood of Confusion Between Applicant's Mark LIFE MODE and LIFE Under Registration No. 3,265,115

There is no likelihood of confusion between Applicant's mark LIFE MODE and the mark LIFE under Registration No. 3,265,115 because of differences between the marks and goods. The mere fact that Applicant's mark contains the cited mark does not automatically mean that confusion is likely. *See, e.g., Colgate-Palmolive Co. v. Carter-Wallace, Inc.*, 167 U.S.P.Q. 529 (C.C.P.A. 1970) (finding PEAK PERIOD not confusingly similar to PEAK); *Bell Laboratories Inc. v. Colonial Products Inc.*, 231 U.S.P.Q. 569 (S.D. Fla. 1986) (denying preliminary injunction and finding no likelihood of confusion between the marks FLIP and FINAL FLIP for competing rodenticide products). When viewed in their entireties, the parties' marks are not confusingly similar because Applicant's mark includes the additional wording "mode," which creates aural, visual, and meaningful differences compared to the cited mark.

With regard to the parties' goods, Applicant has deleted the broad claim to "computer software" so its identification of goods now covers only software for use in connection with viewing, controlling, and managing usage and activity on a person's mobile phone, tablet, and other electronic devices. The purpose of the software is to allow users to silence incoming calls and notifications so they can retreat from the digital world. Attached as Exhibit A are screenshots of Applicant's website at <https://www.palm.com/lifemode> which provides more information about Applicant's software. In contrast, the cited registration covers computer software, namely, fatigue evaluation software for valve actuators. Consequently, the parties' software is used for different purposes such that there is no potential for consumer confusion between LIFE MODE and LIFE, i.e., consumers will not mistakenly assume that both types of software emanate from the same source. Accordingly, Applicant requests that the Examining Attorney withdraw the likelihood of confusion refusal.


There is No Likelihood of Confusion between Applicant's Mark LIFE MODE and LIFE Under Application No. 87072731

Similarly, there is no likelihood of confusion between Applicant's mark LIFE MODE and the prior-pending mark LIFE under Application No. 87072731. Applicant's mark includes the additional term "mode" and, when viewed in their entireties, the marks are indeed different in terms of sight, sound and meaning.

Additionally, differences in the parties' goods and services support a finding of no confusion. The prior-pending mark covers software for social networking, for recognizing users based on location, for connecting users, for allowing users to share contact information, for organizing contact information, for suggesting new contacts to users, and for intelligently recruiting new users. This is a completely different purpose than Applicant's software which is used to disconnect people from their mobile phones and the digital world. Given these differences in the parties' goods, consumers would not be confused that the goods emanate from a single source despite their sharing of the term "life." Consequently, Applicant respectfully submits that there is no potential for confusion between the marks and requests that the Examining Attorney withdraw the potential likelihood of confusion refusal.

There is No Likelihood of Confusion between Applicant's mark LIFE MODE and
Under Application No. 87871110



There is no likelihood of confusion between Applicant's mark LIFE MODE and the prior-pending mark for  under Application No. 87871110. Applicant's mark includes the additional term "mode" and the prior-pending mark includes the additional design element of a series of connected dots. Therefore, when the marks are viewed in their entirety, they are different in terms of sight, sound and meaning.

Differences in the parties' goods also support a finding of no confusion. The prior-pending mark covers software for monitoring and reporting an individual's alertness and fatigue. The purpose of this software is different from Applicant's software that is used to disconnect people from their mobile phones and the digital world. Given these differences in the parties' marks and goods, Applicant respectfully submits that there is no potential for consumer confusion and requests that the Examining Attorney withdraw the potential likelihood of confusion refusal.

There is No Likelihood of Confusion Between Applicant's Mark LIFE MODE and LIFE under
Application No. 87377449

There is no likelihood of confusion between Applicant's mark LIFE MODE and the prior-pending mark for LIFE under Application No. 87377449. Applicant's mark includes the additional term "mode" and, when viewed in their entirety, the marks are different in terms of sight, sound and meaning.

Differences in the parties' goods also support a finding of no confusion. The prior-pending mark covers software for operating, maintaining and controlling of machine tools for making metal parts and related products and services. Therefore, the purpose of the prior-pending software is different from Applicant's software that is used to disconnect people from their mobile phones. As a result of these differences in the parties' marks and goods, Applicant respectfully submits that there is no potential for confusion and requests that the Examining Attorney withdraw the potential likelihood of confusion refusal.

There Is No Likelihood of Confusion as the Parties' Goods and Services are Sold/Provided and Marketed in Different Trade Channels

Applicant also submits that there is no likelihood of confusion because the parties' goods and services are sold/provided and marketed through different channels. Where the parties' goods and services are not identical, the presumption that their goods and services travel in the same channels of trade to the same class of purchasers are tenuous. *See In re Milan Votava*, Serial No. 85/913,856 (T.T.A.B. 2015) (where the goods are not identical, the Board rejected the presumption that, absent restrictions in an application and/or registration, the identified goods and/or services are presumed to travel in the same channels of trade to the same class of purchasers).

Applicant's LIFE MODE software is available only on its mobile devices and marketed through its own website or through authorized retailers, such as Verizon Wireless. *See Exhibit B* attached hereto. By contrast, the marks in the cited registration and prior-pending applications, if they are in use at all, are marketed through their own channels and not through Applicant, so there is no overlap of trade channels which eliminates any potential consumer confusion.

The fact that the parties' software and related services may be marketed online is not sufficient to find confusion because the mere offering of goods and services via the Internet is not sufficient to conclude that the respective offerings are made through the same channels of trade. In *Network Automation, Inc. v. Advanced Sys. Concepts, Inc.*, the Ninth Circuit noted that "[t]oday, it would be the rare commercial retailer that did not advertise online, and the shared use of a ubiquitous marketing channel does not shed much light on the likelihood of consumer confusion." 638 F.3d 1137, 1152 (9th Cir. 2011). *See also Parfums de Coeur, Ltd. v. Lory Lazarus*, 83 U.S.P.Q.2d 1012, 1021 (T.T.A.B. 2007) ("The Internet is such a pervasive medium that virtually everything is advertised and sold through the Internet. We therefore need something more than this general fact . . . merely because the medium of the Internet is involved is not a sufficient basis to show that the conditions and activities surrounding the marketing of the goods and services are such as to lead to confusion"); *In-N-Out Burgers v. Peak Harvest Foods, LLC*, Opp'n 91161044, 2008 WL 4674604, *10 (T.T.A.B. 2008) ("[G]iven the vast array of goods and services available online, the mere fact that two products or services can be found in cyberspace is no more meaningful than saying that both products are sold in "brick-and-mortar" stores."); *Realnetworks, Inc. v. QSA Toolworks, LLC*, 92 U.S.P.Q.2d 1720, 1725 (W.D. Wash. 2009) (both parties utilizing "web-focused channels of trade" is insufficient; "the fact that both products are available *somewhere* on the internet does not represent an overlap of marketing channels for purposes of the [likelihood of confusion] analysis.")

For instance, in *Playboy Enterprises Inc. v. Netscape Communications Corp.*, where the parties used the Internet to market their goods, the court noted that "[g]iven the broad use of the Internet today, the same could be said for countless companies[, therefore,] this factor merits little weight." 354 F.3d 1020, 1028 (9th Cir. 2004). Similarly, here, the possible marketing and distribution of the parties' software and related services on the Internet, without more, is insufficient to establish overlapping channels because the vast majority of companies market and distribute software online so little weight can be given to that factor in a likelihood of confusion analysis. The key consideration should be that Applicant's software is sold only by Applicant or

authorized retailers and the functionality of the software is distinguishable from the other parties' goods and services so there is no potential confusion between them.

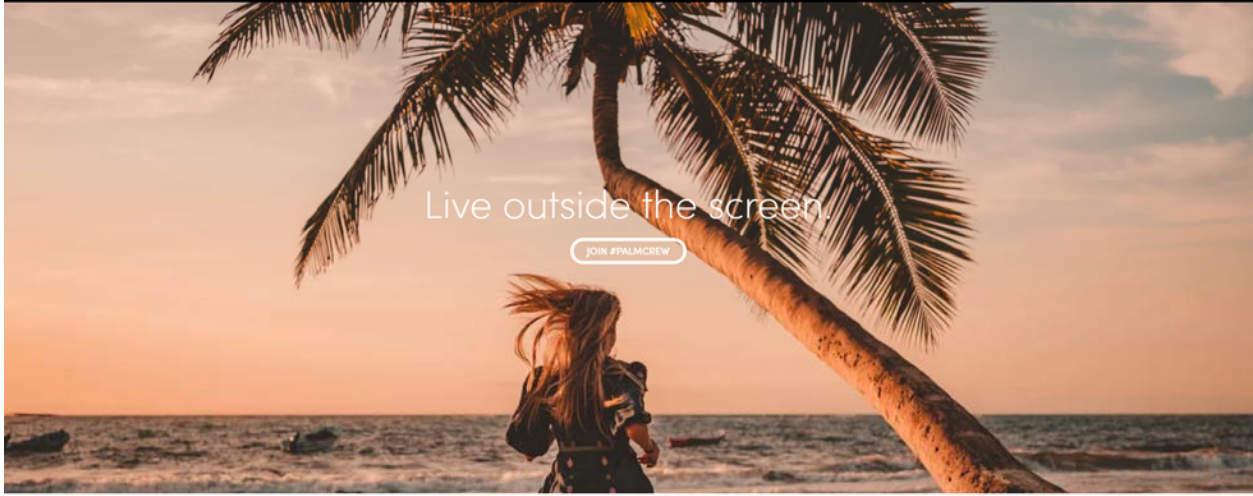
CONCLUSION

In conclusion, given the above, Applicant submits that there are sufficient differences between its mark LIFE MODE and the LIFE marks in the cited registration and prior-pending applications such that they can coexist without any potential for consumer confusion. As a result, Applicant respectfully requests that the Examining Attorney withdraw the potential and likelihood of confusion refusals and approve Applicant's application for publication.

Please contact the undersigned attorney if you have any questions.

Exhibit A

Screenshots of Applicant's Website at <https://www.palm.com/lifemode>



Live outside the screen.

[JOIN #PALMCREW](#)

There's a time to lean into our devices and a time to lean into the world. Palm is for those moments when you are more

There's a time to lean into our devices and a time to lean into the world. Palm is for those moments when you are more engaged in real life than your device.

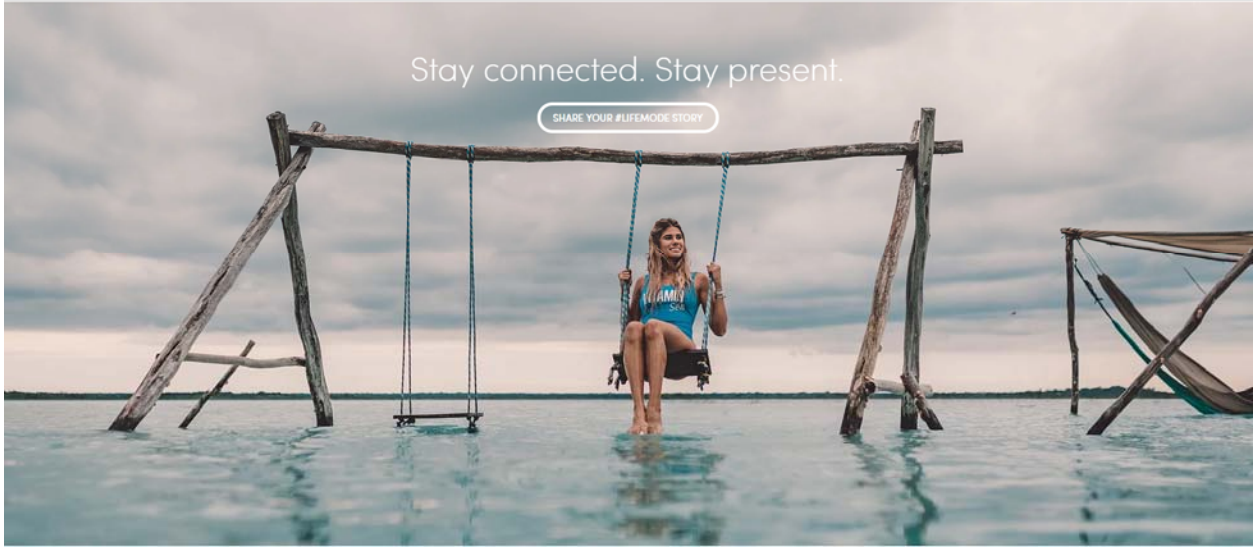
Silence the noise.

Life Mode silences incoming calls and notifications every time the screen is off, unless you're on a call, streaming music or using GPS. When you wake the screen, your Palm becomes fully connected again.



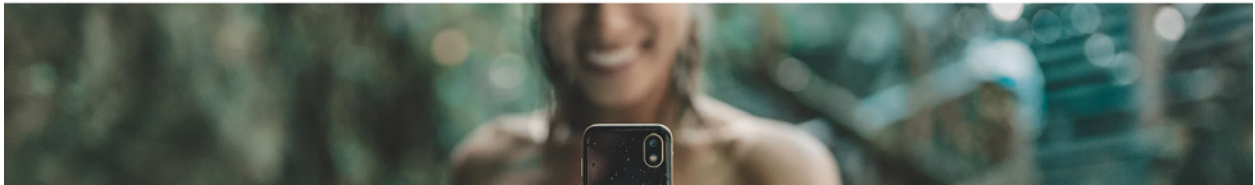
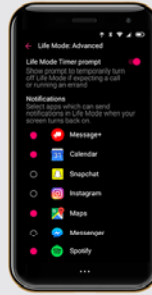
Stay connected. Stay present.

[SHARE YOUR #LIFEMODE STORY](#)



Take control of your digital life.

You can customize your Life Mode settings to control which notifications come through. Whether it's text messages, phone calls, or Instagram DMs, you can choose which apps can get your attention, and what can wait.





Join #PalmCrew and never miss out

Exhibit B

Screenshots Verizon Wireless' Website Marketing Applicant's LIFE MODE Software

Choose free 2-day shipping or in-store pickup.

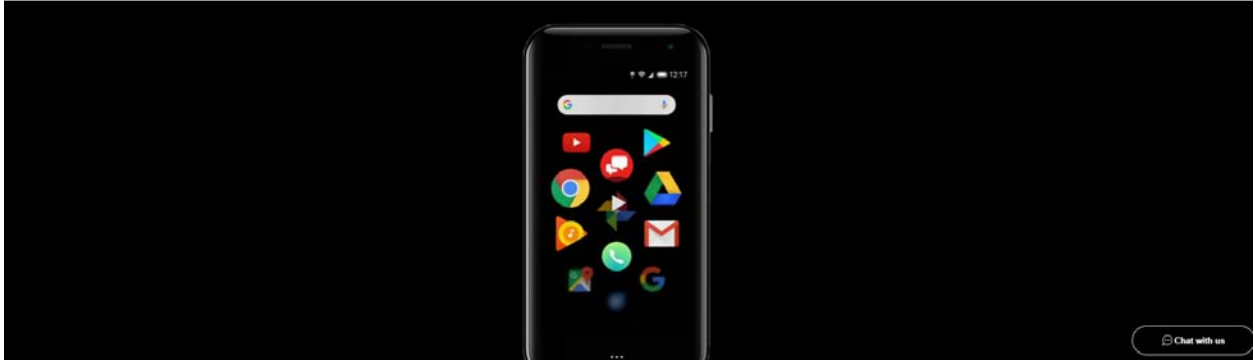


Wireless In Home Business
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Español Sign In

Home > Support > Palm > Palm > Palm Life Mode

Palm Life Mode



(Video Length - 2:21)

Life mode allows you to minimize distraction from the various apps on your device as well as save battery life. You won't be bothered by calls text or notifications when your screen is off. Watch this video to see how it works and how to set it up.

[Video Transcript](#)

Palm Life Mode (2:21)



Life Mode is a way for you to stay connected but do it on your own terms. It allows you to minimize distraction from the various apps on your device as well as save battery life. With Life Mode you won't be bothered by calls, texts, or notifications when your screen is off. You can catch up on your notifications when you wake the screen. When the screen is turned back on your Palm becomes fully connected again and your essential notifications will sync. Life Mode will never interrupt your connectivity while recording a run streaming music or navigation. You can turn on Life Mode through the device's Quick Settings. From any screen, pull the status bar down to display the device's Quick Settings. Tap the palm tree to enable Life Mode. Just a reminder: you will not be bothered by calls, texts and notifications while your screen is off. You can also turn Life Mode on through the settings menu. Drag the status bar down and tap Settings. Then tap Life Mode. On the following screen tap the ON switch to enable Life Mode. From here, you can also pick which apps are able to notify you when the screen is on. To further customize life mode tap advanced options.

Chat with us



To further customize life mode tap advanced options.

Here you can enable or disable apps from notifying you when your screen is on.

For example, if you want to receive text message notifications when your screen turns on, simply tap Message plus.

Keep in mind that with Life Mode on you're still able to stream your music, record your runs, and receive directions from your navigation app even when the screen is off.

Lastly, if you are expecting a call or need to stay connected for something, you can temporarily disable Life Mode using its timer function. When you turn Life Mode off, you are given the option to place the timer for how long you want Life Mode to be disabled.

Once the time runs out you'll be notified that your Palm has resumed Life Mode.

Thanks for tuning in. We hope you enjoy your Life Mode experience and start to experience life uninterrupted.

For more information, visit palm.com/support.

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