

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: PocketWatch, Inc. Docket No.: 34955.6013
Mark: P.W GAMES Examining Attorney: George Murray
Serial No.: 88/207,723 Law Office: 121


Response to Office Action

I. INTRODUCTION

Applicant PocketWatch, Inc. (“Applicant”) is responding to the Office Action dated January 29, 2019 concerning its application to register the word mark P.W GAMES, shown at App. Serial No. 88/207,723 (“Applicant’s Mark”) as amended for “Downloadable video and computer game programs; Downloadable computer game software for personal computers and home video game consoles; downloadable software applications and apps, namely, computer application software games; Interactive downloadable video game programs; Downloadable video game programs; Downloadable video game software; video game discs; Downloadable computer programs for video and computer games; Computer game software for use on mobile and cellular phones; Downloadable electronic game software for use on mobile and cellular phones, handheld computers and handheld devices; Downloadable computer game software via a global network and wireless device; computer game software downloadable from a global computer network; downloadable computer game software via a global computer network and for mobile devices, personal computers, consoles, tablets, and other wireless devices” in Class 9.

The Examining Attorney has initially refused registration on the Principal Register pursuant to Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), based on a finding of likelihood of



confusion with the mark , U.S. Registration No. 4,337,237 for “computer game software; computer application software for mobile phones; computer application software for wireless devices, namely, smartphones, handheld computers, handheld tablets, consoles, game consoles, electronic book readers; downloadable ring tones, games, screensavers, graphics, music, photographs, short videos and movies featuring music, action, adventure, drama, comedy, eroticism, interviews, documentaries, news, current affairs, exercise and fitness, health, fiction, sports, leisure, motoring, religion, law, crime, video games, quizzes, cookery, nature, gardening, politics, finance, mobile telecommunications, jokes, culture, travel, natural history, social issues, languages, teaching, mathematics, geography, history, geology, biology, technology, horror, classic movies, western movies, science fiction, decorating, interior design, science, children's programs, and the arts, all via the internet, global computer networks and wireless devices” in Class 9 (“Registrant’s Mark”). Applicant respectfully disagrees with the Examining Attorney’s conclusion that there is a likelihood of consumer confusion as to the source of the goods offered under Registrant’s Mark and those provided under Applicant’s Mark. As set forth more fully below, Registrant’s Mark is not likely to be confused with Applicant’s Mark when each of the different relevant factors is considered.

II. THERE IS NO POTENTIAL LIKELIHOOD OF CONFUSION BETWEEN APPLICANT'S MARK AND REGISTRANT'S MARK.

Registration should only be denied when the applicant's mark "[c]onsists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive." 15 U.S.C. §1052. A determination of likelihood of confusion between marks is determined on a case-by-case basis. *In re Dixie Restaurants Inc.*, 41 USPQ 2d 1531, 1533 (Fed. Cir. 1997). The test for likelihood of confusion is whether a "reasonably prudent consumer" in the marketplace is likely to be confused as to the origin of the good or service bearing one of the marks. *In re E.I. DuPont de Nemours and Co.*, 476 F.2d 1357 (C.C.P.A. 1973). In determining whether a likelihood of confusion exists, some of the factors essential to the analysis include the similarity of the marks in their entireties as to appearance, sound, connotation, and commercial impression, the likely consumers, and the number and nature of similar marks in use on similar goods. *Id.* at 1361; TMEP §1207.01. An application of the relevant *DuPont* factors to the instant case results in no likelihood of confusion between Applicant's Mark and the Registrant's Mark.

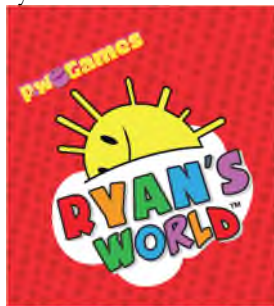
A. Applicant's Mark is Significantly Different in Appearance and Commercial Impression.

The Examining Attorney contends that Applicant's Mark is similar in appearance to Registrant's Mark because both marks begin with the "identical two letters PW." Yet when the marks are actually considered in their entireties, there is no similarity in appearance between the marks.

For purposes of determining whether a likelihood of confusion exists between two marks, the overall visual impression of the marks derived from viewing the marks in their entireties is controlling. See *In re Homeland Vinyl Products, Inc.*, 81 USPQ 2d 1378, (TTAB 2006); *Messey Junior College, Inc. v. Fashion Inst. of Tech.*, 492 F.2d 1399 (C.C.P.A. 1974) ("It is axiomatic that a mark should not be dissected and considered piece meal; rather, it must be considered as a whole in determining likelihood of confusion."). The key analysis is whether the total effect conveyed by the two marks is confusingly similar, not simply whether the marks sound alike or look alike. *First Savings Bank F.S.B. v. First Bank System Inc.*, 101 F.3d at 645, 653, 40 USPQ 2d 1865, 1870 (10th Cir. 1996) (recognizing that while the dominant portion of a mark is given greater weight, each mark still must be considered as a whole). Even the use of identical dominant elements does not automatically mean that two marks are similar. For example, applying this same reasoning, the 10th Circuit in *First Savings Bank F.S.B. v. First Bank System Inc.*, 101 F.3d at 645, 653, 40 USPQ 2d 1865, 1874 (10th Cir. 1996), found the marks "FirstBank" and "First Bank Kansas" not to be confusingly similar. Additionally, in *Luigino's Inc. v. Stouffer Corp.*, 170 F.3d 827, 833 (8th Cir. 1999), the mark "Lean Cuisine" was found not to be confusingly similar to "Michelina's Lean 'N' Tasty" even though both marks included the term "lean" and were in the same class of goods, namely, low-fat frozen food.

Moreover, the requirement to examine a mark in its entirety is preserved even where the mark consists of disclaimed matter. See *In re National Data Corp.*, 753 F.2d 1056 (Fed. Cir. 1985); *Specialty Brands, Inc. v. Coffee Bean Distributors, Inc.*, 748 F.2d 669, 672 (Fed. Cir. 1984); *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 1570 (Fed. Cir. 1983); *Schwarzkopf v. John H. Breck, Inc.*, 340 F.2d 978 (C.C.P.A. 1965); *In re MCI Communications Corp.*, 21 USPQ 2d 1534, 1538-39 (Comm'r Pats. 1991) (“Examining Attorneys will continue to consider the question of likelihood of confusion, under Section 2(d) of the statute, in relation to the marks as a whole, including any voluntarily disclaimed matter.”). This need to afford equal weight to both disclaimed and non-disclaimed matter is rooted in the principal that, “since prospective purchasers will not be aware that a portion of the mark has been disclaimed, the disclaimer is not material in assessing the reaction of the average purchaser.” See *Seigrun D. Kane, Kane on Trademark Law: A Practitioner’s Guide* (2009, 5th Edition) 6-35; see e.g., *Am. Home Prods. Corp. v. B.F. Ascher & Co.*, 473 F.2d 903, 904 (C.C.P.A. 1973). Even though Applicant’s Mark has disclaimed the wording “GAMES,” this wording must still be taken into account when evaluating whether the mark is similar in appearance to Registrant’s Mark.

A comparison of the marks at issue makes clear that Applicant’s Mark is not visually or commercially similar to the Registered Mark. Applicant’s Mark, P.W GAMES, consists of the letters P and W separated by a period, followed by the term GAMES. As shown below, the stylization of the lettering, the yellow and pink font colors and the stylized smiling-face dot in the middle of Applicant’s Mark is unique and creates a distinct commercial impression. Furthermore, the P.W in Applicant’s Mark stands for POCKET.WATCH, which is the main house brand from which Applicant’s Mark originates. See Exhibit A attached hereto. Applicant uses its mark in commerce in a specialized way to reference back to its house brand, as shown by the use in connection with its



products here:

Applicant uses its “P.W” reference and the stylized smiling-face “Dot” character in its overall branding scheme, adding to the distinctiveness between it and Registrant’s Mark. In contrast,



Registrant’s Mark is . This design completely eliminates any obvious word or character elements due to the way the two letters are connected. It is hard to imagine that any consumer would necessarily perceive Registrant’s Mark to contain the letters P and W given its visual impression. Moreover, Registrant’s Mark is also used in connection with its house brand and stands for the completely different term “PhunWare.” See Exhibit B attached hereto. Registrant’s Mark contains a totally distinct visual appearance from Applicant’s Mark and connects the consumer to its

house brand via a designed acronym, for a name that is completely different than Applicant's (Pocket.Watch vs. PhunWare).

Indeed, the Trademark Trial and Appeal Board has recently rejected the propriety of assuming that standard character marks can conceivably be used in connection with similar imagery as that of a logo mark. *See In re Aquitaine Wine USA, LLC*, Serial No. 86928469 (TTAB Apr. 2, 2018). Thus, it is improper to assume that Applicant's Mark will be used in connection with the imagery found in Registrant's Mark (and vice versa), as obvious by the way the marks are actually used in commerce as detailed above.

Consequently, when all of the various aspects of the respective marks are taken into account, Applicant's Mark is not similar in appearance or commercial impression to the Registered Mark and therefore there can be no confusion.

B. Applicant's and Registrant's Goods are Marketed and Sold Through Wholly Distinct Channels of Trade to Different Consumers.

Applicant's goods and those provided under Registrant's Mark are marketed and sold through discrete and separate channels of trade to unique consumers. To the extent goods or services are specifically marketed to selective members of a particular trade who are discriminating with regard to the products they purchase, there may be no likelihood of confusion despite similarity between marks and services. *See Amstar Corp. v. Domino's Pizza, Inc.*, 615 F.2d 252, 262 (5th Cir. 1980), *cert. denied*, 449 U.S. 899 (1980) (explaining that dissimilarities between channels of trade, identity of retail outlets, and the predominant consumers of the parties' products and services lessen the likelihood of confusion, mistake and deception).

Applicant's goods are in the field of entertainment services, namely for children. Applicant is using the mark P.W GAMES in connection with games under its umbrella of existing children's entertainment services which Applicant provides under the mark POCKET.WATCH. *See* Exhibit C. In contrast, the goods associated with Registrant's Mark are all related to a mobile application development platform and related tools that companies and businesses use to monetize their brands. *See* Exhibit D. Registrant offers no computer gaming software for children's entertainment, nor does Applicant offer any of the mobile monetization tools or services provided by Registrant. Unlike the products provided under Applicant's Mark that are marketed through direct-to-consumer advertising channels that promote children's entertainment, Registrant's product is a business-to-business offering for mobile application brand monetization. To that end, individuals are not likely to encounter both Applicant's and Registrant's goods being promoted through the same advertising source or channels of trade, making confusion highly improbable.

C. Consumers of Both Applicant's and Registrant's Goods Are Sophisticated and Knowledgeable.

The more likely a customer is to exercise a high degree of care or sophistication when selecting goods or services, the less chance that confusion, mistake, or deception will occur between two or more competing marks. *See TCPIP Holding Co., Inc. v. Haar Communications, Inc.*, 244 F.3d 88, 102 (2d Cir. 2001) ("The more sophisticated the consumers, the less likely they are to be misled by similarity in marks."); *Cadbury Beverages, Inc. v. Cott Corp.*, 73 F.3d 474, 480 (2d Cir. 1996) ("The sophistication factor recognizes that the likelihood of confusion between the products at issue

depends in part on the sophistication of the relevant purchasers.”). Furthermore, the degree of care factor plays a significant role in minimizing potential confusion where the subject goods or services fail to constitute “impulse” goods. *See Astra Pharm. Prods. Inc. v. Beckman Instruments, Inc.*, 718 F.2d 1201, 1206 (1st Cir. 1983) (finding that blood analyzers require careful consideration likely to result in added consumer scrutiny and examination). Services that are provided to consumers that have a sophisticated knowledge of a given activity are less likely to be confused with services that are provided to a different class of sophisticated buyers. *See Electronic Design & Sales Inc. v. Electronic Data Systems Corp.*, 21 U.S.P.Q. 2d 1388, 1392 (Fed. Cir. 1992).

Here, Applicant’s and Registrant’s respective goods will not be selected or purchased on an impulse. Registrant’s products are likely to be thoroughly reviewed by potential purchasers, as the businesses that utilize Registrant’s goods are going to be spending top dollar on their advertising and branding strategies. Accordingly, Registrant’s products are targeted to knowledgeable adult consumers, or directly to companies and organizations. On the other hand, consumers of Applicant’s children’s entertainment games are likely to be children or their parents who are making the purchase for their children. Parents will be scrutinizing every entertainment product or game software before they buy it for their child. In light of the care that Applicant’s and Registrant’s customers use before selecting the respective goods, it is unlikely that there will be any confusion as to source.

D. The USPTO Has Permitted Registration of “PW” Marks for Similar Goods to Different Owners.

The USPTO has also permitted multiple owners to register marks containing the phrase “PW” in connection with related software goods as well as goods in Class 9. For example, the following registrations containing “PW” are currently coexisting to different owners (copies of the TSDR records for the marks are attached hereto):

Mark	Reg. No.	Class and Identification	Exhibit
PW and Design	4691413	Providing temporary use of online non-downloadable software for managing push notifications	E
PW Pro	4342114	Computer software for supply chain management	F
PW-HAL	87448164 (allowed)	Downloadable and recorded computer software applications for payment processing for point of sales devices	G

AutoPW	4689723	Computer software for encryption; Computer software for use in the encryption and decryption of digital files, including audio, video, text, binary, still images, graphics and multimedia files	H
PW and Design	5670806	Battery chargers for children's ride-on toy vehicles	I

Despite the fact that each of these marks contains a “PW” element like Registrant’s Mark, the USPTO has found the differences in the marks sufficient to preclude confusion. This crowded field of “PW” marks in Class 9 indicates that confusion is not likely between Applicant’s Mark and Registrant’s Mark given that consumers can tell the difference between similar marks owned by different third parties. To wit, to Applicant’s knowledge there have been no instances of confusion as to source between its mark and Registrant’s Mark, nor any of the marks above. Consumers are able to discern between various “PW” marks and therefore there is no potential likelihood of confusion.

III. DISCLAIMER

Applicant responds to the request for disclaimer as follows: No claim is made to the exclusive right to use “GAMES” apart from the mark as shown.

IV. CONCLUSION

For all the foregoing reasons, Applicant requests that its application to register P.W GAMES be approved for publication on the Principal Register.