

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Microsoft Corporation

Application
Serial No.: 88319298

Mark: AZURE SENTINEL

Class(es): 9, 42

Office Action Date: April 26, 2019

Examiner: Gabriel Mitchell

**RESPONSE TO OFFICE
ACTION**

This correspondence is filed in response (“Response”) to the Office Action (“Action”) and Application referenced above. In the Action, the Examiner (a) requested clarification of computer software in Class 42 and (b) warned that if pending U.S. Application Serial No. 87758202 for DIGITAL SENTINEL (“cited application”) registers, the Application may be refused registration due to a likelihood of confusion between the marks.

In response, Applicant notes that there are numerous third-party registrations on the Principal Register for marks incorporating “sentinel.” Moreover, the Mark, an inherently distinctive mark, is significantly different from the cited mark when compared in their entireties. Thus, consumers are unlikely to confuse the marks in the relevant crowded field of sentinel-related marks. Applicant also clarifies applied-for services in Class 42.

I. NO LIKELIHOOD OF CONFUSION

1. The Mark is a distinctive unitary phrase, and it is distinguishable from the mark covered by the cited application.

The Mark – AZURE SENTINEL – combines Applicant’s distinctive registered mark AZURE, U.S. Reg. No. 4932997 (“Registration”), with the word “SENTINEL” to form a distinctive unitary phrase. For the purposes of likelihood of confusion analysis, the Examiner is required to compare the applicable marks in their entireties without dissecting portions of either mark. *See In re Nat’l Data Corp.*, 753 F.2d 1056, 1058 (Fed. Cir. 1985) (noting that “[t]he basic principle in determining confusion between marks is that the marks must be compared in their entireties and must be considered in connection with the particular goods and services for which they are used.”); TMEP § 1207.01(b).

Applicant has used its AZURE mark continuously since 2013 in connection with, *inter alia*, computer software for data storage and backup, video streaming solutions, and software-as-a-service offerings as described in the Registration. *See* the TSDR for the Registration attached as Exhibit A. The second element, “sentinel”, is synonymous with “sentry,” which is defined as a guard or watch, especially “a soldier standing guard at a point of passage.” *See* Merriam-Webster definitions of “Sentinel” and “Sentry” attached as Exhibit B. Viewed as a whole, the Mark appears to be an arbitrary term with respect to Applicant’s applied-for goods and services because the mark does not describe the nature or category of such goods or services. *See Nautilus Grp., Inc. v. Icon Health & Fitness, Inc.*,

372 F.3d 1330, 1340, 71 USPQ2d 1173, 1180 (Fed. Cir. 2004) (defining an arbitrary mark as “a known word used in an unexpected or uncommon way”).

Even if arguendo the Mark is not deemed arbitrary, the Mark as a whole suggests security-related goods and services from the same source (Applicant) that provides other AZURE-branded software goods and services. See *In re George Weston Ltd.*, 228 USPQ 57 (TTAB 1985) (SPEEDI BAKE for frozen dough found to fall within the category of suggestive marks because it only vaguely suggests a desirable characteristic of frozen dough, namely, that it quickly and easily may be baked into bread); *In re The Noble Co.*, 225 USPQ 749 (TTAB 1985) (NOBURST for liquid antifreeze and rust inhibitor for hot-water-heating systems found to suggest a desired result of using the product rather than immediately informing the purchasing public of a characteristic, feature, function, or attribute). Thus, the Mark is inherently distinctive because it is an arbitrary or suggestive mark.

With respect to the cited application, the Mark is distinguishable from the DIGITAL SENTINEL mark because they are visually and aurally dissimilar. Specifically, because the cited mark contains more words and syllables than the Mark, the latter appears and is pronounced differently than the former. Thus, compared in their entireties, the marks are significantly distinguishable in the relevant field. See *In re Nat’l Data Corp.*, 753 F.2d 1056, 1058 (Fed. Cir. 1985) (noting that “[t]he basic principle in determining confusion between marks is that the marks must be compared in their entireties and must be considered in connection with the particular goods and services for which they are used.”); TMEP § 1207.01(b).

2. The Mark is entitled to join the crowded field of similar marks in the relevant field.

The number and nature of registered marks on the Principal Register incorporating “sentinel” in Class 9 or 42 is one of the *DuPont* likelihood-of-confusion factors to be given great weight when evidence pertaining thereto is of record. *In re E. I. DuPont de Nemours and Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). The greater the number of similar marks in the market, the more consumers are able to distinguish between and among them. See TMEP 1207.01(d)(iii). It follows that the Examiner is required to assess the relative strength or weakness of the cited registrations in the relevant field in order to define the scope of protection afforded to them. See *id.*

We note that the Principal Register contains several applications and registrations for marks incorporating “sentinel” for goods and services in Class 9 and 42 respectively, including without limitation the following:

Reg. No.	Mark	Relevant Goods / Services
5394543	SENTINEL SOFTWARE	Class 9: “Computer software for use in enterprise resource planning (ERP) software; Software for providing security for data base management, human capital management, supplier relationship management, and customer relationship management”
5374055	SENTINEL WATCH	Class 9: “Downloadable cloud-computing software for video analytics”
5361294	SENTINEL WORLD	Class 9: “Providing online, non-downloadable computer software for simulating urban, suburban, and rural communities and their institutions and homes”

Reg. No.	Mark	Relevant Goods / Services
4310082	DESKTOP SENTINEL	Class 9: “Computer software for controlling and managing access software applications and computer resources”
5338792	BUILDING SENTINEL	Class 42: “Software as a service (SAAS) services featuring software for use in monitoring and analyzing building and HVAC and related control systems”
5439866	SENTINEL TOWN	Class 9: “Computer software for simulating a rural American community for evaluating community health concerns; Computer application software for simulating a rural American community for evaluating community health concerns”

See TSDR reports for the registrations attached as Exhibit C.

The numerous third-party registrations above are relatively weak compared to each other in the crowded field. Further, as discussed above, the Mark is inherently distinctive with respect to its goods and services. As a result, consumers will be able to discriminate between the Mark and the mark in the cited application (to the extent it is approved for registration) on the Principal Register. *See In re Broadway Chicken Inc.*, 38 U.S.P.Q.2d 1559, 1565 (TTAB 1996) (holding that applicant’s evidence of widespread third-party use of marks containing the term BROADWAY for restaurant services and closely related goods and services is sufficient to show that confusion is not likely to result from the contemporaneous use of applicant’s and registrant’s marks incorporating “BROADWAY” in connection with restaurant services). Thus, the Mark should be allowed to join other sentinel-related registrations on the Principal Register.

II. CLARIFICATION OF GOODS IN CLASS 42

As provided in the TEAS form, Applicant clarifies the identified services described in Class 42 as follows:

Software as a service (SaaS) services featuring software for security information and event management (SIEM) employing artificial intelligence and machine learning to enable automated responses in real time to security vulnerabilities, threats and events; **providing temporary use of downloadable** computer software for collection, storage, analysis and presentation of data for forensic analysis of security events and for security compliance

III. CONCLUSION

Based on the foregoing, Applicant respectfully requests that the Examiner approve the Application for publication.