


Response to Office Action Issued February 19, 2019

Applicant hereby responds to the Office Action dated February 19, 2019 for the mark LEGADO.TV (“Applicant’s Mark”), wherein the Examining Attorney refused registration of Applicant’s Mark because of a likelihood of confusion with four marks, LIGADO, LIGADO NETWORKS, LIGADO

NETWORKS and Design , LIGADO NETWORKS MAKING STRONGER CONNECTIONS

and Design  Making Stronger Connections (the “Registrant’s Cited Marks”, U.S. Registration Nos. 5,030,378; 5,030,380; 5,036,082; and 5,036,073), covering telecommunications services in International Class 38. Applicant also addresses the Examining Attorney’s request for the amended identification of services listed in the Application for International Class 41, and the English translation of the foreign wording in the mark, “LEGADO.”

In response, Applicant respectfully submits there is no confusion between Applicant’s Mark and Registrant’s Cited Marks. The differences between the parties’ marks result in substantial differences in the marks’ overall sound, meaning, and commercial impressions, particularly where Applicant’s mark LEGADO means “legacy”, and according to the Registrant, LIGADO means “connected and ready to go”. Further, the parties’ services are not related or marketed in the same channels of trade 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. Therefore, confusion is not likely. As such, Applicant respectfully requests that the Examining Attorney withdraw the refusal to register Applicant’s Mark based on the Cited Marks and allow the subject application to proceed to publication in the *Official Gazette*.

I. There Is No Likelihood Of Confusion Between Applicant’s Mark And Registrant’s Cited Marks

In considering whether a likelihood of confusion exists, a number of factors are relevant, including the similarity of the marks, similarity of the goods or services, the channels of trade, sophistication of target consumers, and other factors.

The Examining Attorney has refused registration of Applicant’s Mark because of the alleged similarities between Applicant’s Mark and Registrant’s Cited Marks, as well as the parties’ services and channels of trade. Applicant respectfully submits there is no likelihood of confusion between Applicant’s Mark and Registrant’s Cited Marks because of the (1) the dissimilarities between the marks in their entirety as to appearance, sound, meaning and commercial impression; (2) the differences between

Applicant and Registrant's claimed services; and (3) the differences in the trade channels of trade and consumers support Applicant's argument that consumer confusion among the parties' respective marks is not likely. Therefore, for the reasons discussed below, Applicant respectfully requests that the Examining Attorney withdraw the refusal, and allow the subject application to proceed to publication.

A. Applicant's Mark and Registrant's Cited Marks Are Dissimilar.

In evaluating whether there is a likelihood of confusion between two marks, the comparison must focus on "the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression." *DuPont*, 476 F.2d at 1361. When comparing the marks, the marks should not be dissected and considered piecemeal, but rather, they must be considered as a whole in determining likelihood of confusion. *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 1340 (Fed. Cir. 2015). "All relevant facts pertaining to appearance, sound, and connotation must be considered before similarity as to one or more of those factors may be sufficient to support a finding that the marks are similar or dissimilar." *Recot, Inc. v. M.C. Becton*, 214 F.3d 1322, 1329, 54 USPQ2d 1894, 1899 (Fed. Cir. 2000).

In the instant case, the Examining Attorney found Applicant's Mark confusingly similar to Registrant's Cited Marks. Specifically, the Examining Attorney found that the term "LEGADO" is the "dominant feature of Applicant's Mark" and declared that this (or similar) feature is shared with all of Registrant's Cited Marks. *Office Action*, p. 3. The Examining Attorney incorrectly found that Applicant's term LEGADO is similar to the term LIGADO in Registrant's Cited Marks and further, discounted the significance the additional terms contained in the parties' marks stating that these additional terms were "insufficient to distinguish the marks". *Id.* Specifically, the Examining Attorney did not apply proper weight to the inclusion of the term "TV" and the punctuation mark "." (pronounced "DOT") in Applicant's Marks, nor the additional wording "NETWORKS, NETWORKS MAKING STRONGER CONNECTIONS" and design elements in Registrant's Cited Marks. The Examining Attorney has incorrectly presumed that potential purchasers could reasonably assume "the LEGADO.TV mark constitutes a new or additional line of services from the same source as the services provided under the previous LIGADO, LIGADO NETWORKS, LIGAD NETWORKS and design, and LIGADO NETWORKS MAKING STRONGER CONNECTIONS and design marks with which they are acquainted or familiar, and that Applicant's Mark is merely a variation of the Registrant's Marks." *Id at 4.*

Thus, the Examining Attorney's analysis is inadequate because it does not take into consideration all of the elements of Applicant's Mark, particularly where those elements create a different commercial impression from Registrant's Cited Marks. Applicant's Mark and Registrant's Cited Marks each contain

additional matter than the first literal terms “LEGADO” and “LIGADO”, i.e. wording and/or designs, that further aid in making the parties’ marks dissimilar as to their appearance, sound, connotation and commercial impression. The fact that this additional matter may not be dominant does not mean it should be completely ignored when comparing the parties’ marks because the marks must be considered in their entirety. *Juice Generation*, 794 F.3d 1334 (“[w]hile the Board may properly afford more or less weight to particular components of a mark for appropriate reasons, it must still view the mark as a whole”; the court found that the Board gave inadequate consideration to the disclaimed word JUICE in the mark PEACE LOVE AND JUICE & Design for juice bar services when compared to PEACE & LOVE for restaurant services,); *Shen Mfg. Co. v. Ritz Hotel, Ltd.*, 393 F.3d 1238, 1243 (Fed. Cir. 2004) (“[t]he disclaimed elements of a mark, however, are relevant to the assessment of similarity. This is so because confusion is evaluated from the perspective of the purchasing public, which is not aware that certain words or phrases have been disclaimed.”). “No element of a mark is ignored simply because it is less dominant, or would not have trademark significance if used alone.” *Hewlett-Packard Co. v. Human Performance Measurement, Inc.*, 23 U.S.P.Q.2d 1390, 1396 (T.T.A.B. 1992) (citations omitted). Rather, “[a]ll relevant facts pertaining to appearance, sound, and connotation must be considered before similarity as to one or more of those factors may be sufficient to support a finding that the marks are similar or dissimilar. *Id.*, citing *DuPont* at 203, *In re National Data Corp.*, 753 F.2d 1056, 1058, 224 USPQ 749, 751 (Fed.Cir.1985)

When Applicant’s Mark and Registrant’s Cited Marks are viewed in their entirety, the marks’ overall commercial impressions are quite dissimilar based on the differences between the marks’ visual appearance, sound and connotation. As a result, there can be no likelihood of consumer confusion under these circumstances.

i. Applicant’s Mark and the Cited Registrations Are Visually Different.

Applicant’s Mark is visually different from Registrant’s Cited Marks as shown in the side-by-side comparison below:

Applicant’s Mark	Cited Registrations
LEGADO.TV	LIGADO
	LIGADO NETWORKS



Applicant’s Mark consists of the wording “LEGADO.TV” without any design elements. Registrant’s Cited Registrations are visually different from Applicant’s Mark for several reasons. First, none of the Registrant’s Cited Marks contain the term “TV” or the punctuation mark “.” (pronounced “DOT”), and Registrant’s Cited Marks, LIGADO NETWORKS, LIGADO NETWORKS and design, and LIGADO NETWORKS MAKING STRONGER CONNECTIONS and design, each include different and additional wording and/or design elements. Further, Applicant’s Mark places focus upon the term “TV” portion, separating it from “LEGADO” with a punctuation mark. Second, the additional wording in Registrant’s Cited Marks, LIGADO NETWORKS and design and LIGADO NETWORKS MAKING STRONGER CONNECTIONS and design, is highly stylized with various design elements creating different commercial impressions from Applicant’s Mark where there is no stylization or design elements. Because of these visual differences, Applicant’s Mark creates a different overall appearance and visual structure from Registrant’s Cited Marks. Consumers encountering these marks in the marketplace are likely to view and perceive the marks as different. Therefore, the marks are visually different.

ii. Applicant’s Mark and the Cited Registrations Are Phonetically Different.

That the marks are phonetically different in this case is clear from the fact that they do not share the same terms. The differences in pronunciation are shown in the chart below:

Applicant’s Mark	Registrant’s Cited Marks
[LE-GAD-O -DOT -T-V]	[LI-GAD-O]

	[LI-GAD-O -NET-WORKS]
	[LI-GAD-O - NET-WORKS]
	[LI-GAD-O -NET-WORKS MAK-ING STRONG-ER CON-NECT-IONS]

As shown above, Applicant’s Mark sounds different than Registrant’s Cited Marks. Read aloud in English, the Registrant’s Cited Marks are “LI-GAD-O, LI-GAD-O -NET-WORKS, LI-GAD-O -NET-WORKS and design, and LI-GAD-O -NET-WORKS MAK-ING STRONG-ER CON-NECT-IONS and design whereas Applicant’s mark read aloud is “LE-GAD-O -DOT –T-V”. Applicant’s Mark consists of six syllables, three of which are different from each of Registrant’s Cited Marks. Specifically, in combination with the term “LIGADO”, two of Registrant’s Cited Marks include the additional literal terms “NETWORKS”, or “NETWORKS MAKING STRONGER CONNECTIONS”, creating distinctly different sounds from Applicant’s Mark. When Applicant’s Mark is pronounced it sounds entirely different from each of Registrant’s Cited Marks particularly because the term “TV” and the punctuation “.” (pronounced “DOT”) share no similarities in sound or spelling with any element of Registrant’s Cited Marks. Additionally, Registrant’s Cited Mark LIGADO NETWORKS MAKING STRONGER CONNECTIONS consists of significantly more syllables than Applicant’s Mark, *i.e.* 12, and therefore entirely different from Applicant’s Mark. Further,

Accordingly, the marks are phonetically different.

iii. Applicant’s Mark and the Registrant’s Cited Marks Have Different Connotation And Create Different Commercial Impressions.

The meaning of Applicant’s Mark is very different from Registrant’s Cited Marks and therefore creates a different commercial impression. As stated in the TMEP, “even marks that are identical in sound and/or appearance may create sufficiently different commercial impressions when applied to the respective parties’ goods or services so that there is no likelihood of confusion.” TMEP § 1207.01(b)(v). Therefore, if the marks convey significantly different meanings and create different commercial impressions there can be no likelihood of confusion.

In this case, Applicant's Mark's connotation is different from the connotation of Registrant's Cited Marks. The first term in Applicant's Mark, "LEGADO", has a different connotation than the first term in Registrant's Cited Marks, "LIGADO". Specifically, the term "LEGADO" in Applicant's Mark, when translated to English, is "legacy", where, according to Registrant, "LEGADO" in Registrant's Cited Marks translates to "connected and ready to go." Therefore, the meaning and commercial impression of Applicant's Mark is wholly different from each of Registrant's Cited Marks.

Where a likelihood of confusion determination involves two non-English language words, the Board has applied the doctrine of foreign equivalents where the wording in both marks being compared is in the same foreign language. *See In re Lar Mor Int'l, Inc.*, 221 USPQ 180, 181-83 (TTAB 1983) (noting that "[i]t seems to us that the fact that both marks may be comprised of foreign words should not mean that we can disregard their meanings" and translating the marks BIEN JOLIE and TRES JOLIE to compare their meanings, but concluding that confusion was not likely, despite their substantially similar meanings, because of, inter alia, the highly laudatory nature of the registered mark, BIEN JOLIE). Applicant's Mark contains the Spanish term "LEGADO" and Registrant's Cited Marks contain the Portuguese term "LIGADO". Spanish is a common, modern language in the United States. *See In re Aquamar, Inc.*, 115 USPQ2d 1122. The USPTO and courts have recognized that languages such as Afrikaans, French, Spanish, Italian, Portuguese, Chinese, Vietnamese and Japanese are not obscure because of the number of people in the United States who speak those languages. *See Abby Software v. Ectaco*, 2011 WL 1399235 (TTAB March 22, 2011). Therefore, the doctrine is applied when "the ordinary American purchaser" would "stop and translate" the foreign term into its English equivalent. *See Palm Bay*, 396 F.3d at 1377, 73 USPQ2d at 1696 (quoting *In re Pan Tex Hotel Corp.*, 190 USPQ 109, 110 (TTAB 1976)); TMEP §1207.01(b)(vi)(A). The ordinary American purchaser includes those proficient in the foreign language. *See In re Spirits Int'l, N.V.*, 563 F.3d 1347, 1352, 90 USPQ2d 1489, 1492 (Fed. Cir. 2009); *see In re Thomas*, 79 USPQ2d at 1024. In this case, the ordinary American purchaser would likely stop and translate the marks because the Spanish and Portuguese languages are common, modern languages spoken by an appreciable number of consumers in the United States. Therefore purchasers would perceive the significantly different meanings and overall commercial impressions so there can be no likelihood of confusion.

Further, the additional terms, as used in Registrant's Cited Marks LIGADO NETWORKS, LIGADO NETWORKS and design, and LIGADO NETWORKS MAKING STRONGER CONNECTIONS and design, are not shared with Applicant's Mark, and help to create different meaning between Registrant's Cited Marks and Applicant's Mark. Specifically, the terms "NETWORKS" and "MAKING STRONGER CONNECTIONS" in Registrants Cited Marks, LIGADO NETWORKS,

LIGADO NETWORKS and design, and LIGADO NETWORKS MAKING STRONGER CONNECTIONS and design, suggests a system of cords or wires, or an interconnected chain, group or system creating an image of several different components. *See* the relevant definitions in **Exhibit A**. None of these meanings are shared by Applicant's Mark because it lacks the terms "NETWORKS" or "MAKING STRONGER CONNECTIONS." Applicant's Mark includes the term "TV" and punctuation "." Both of these terms and the meaning associated with the term "TV" are missing from Registrant's Cited Marks. The prominent inclusion in Applicant's mark of the term "TV" gives the mark a connotation of entertainment and television programs where the Registrant's Cited Marks do not have any connotation of entertainment or television programs.

Therefore, Applicant's Mark and Registrant's Cited Marks have different meaning, which alone is sufficient to avoid confusion. *See also Nabisco.*, 393 F.3d at 1245 (reversing TTAB's holding that contemporaneous use of THE RITZ KIDS for clothing items (including gloves) and RITZ for various kitchen textiles (including barbeque mitts) is likely to cause confusion, because, inter alia, THE RITZ KIDS has a different meaning where "the" operates as an indicator of source of the famous Ritz Hotel and "kids" is used to indicate that the product is geared toward children); *Champagne Louis Roederer, S.A. v. Delicato Vineyards*, 148 F.3d 1373 (Fed. Cir. 1998) (finding no likelihood of confusion between the marks CRISTAL for champagne and CRYSTAL CREEK for wine, because, inter alia, CRISTAL and CRYSTAL CREEK evoke very different images in the minds of relevant consumers: where the former suggests the clarity of the wine within the bottle or the glass of which the bottle itself was made, the latter suggests a very clear (and hence probably remote from civilization) creek or stream).

The differences between the marks appearance, sound and meaning help to create different overall commercial impression between the marks. When finding confusion between Applicant's Mark and Registrant's Cited Marks, the Examining Attorney completely ignored the differences between the marks, when considered in their entirety. The Examining Attorney improperly discarded the value of the non-similar terms in the parties' marks which helps to create significant differences between the respective marks appearance, pronunciation and meaning and result in the parties' marks creating different commercial impressions in the minds of consumers. Further, the Examining Attorney did not consider the differences in meanings of the marks which when considered, results in two distinct words. This *DuPont* factor alone is sufficient to conclude that confusion is not likely in this case.

B. The Differences Between the Parties' Services, Trade Channels and Consumers is Sufficient to Avoid a Finding of Confusion.

i. Dissimilarity of the Services.

Here, the services associated with Registrant's Cited Marks are neither identical nor overlapping with the services claimed in Applicant's application. Applicant's identified "Broadcasting of video and audio programming over the Internet; Internet broadcasting services; video broadcasting services via the Internet; streaming of audio, visual, and audiovisual material via the Internet; video-on-demand transmission services via the Internet" does not overlap with the Registrant's identified services. There is no *per se* rule holding that certain goods or services are related even if provided in the same field or by the same source. TMEP § 1207.01(a)(iv); *see e.g. In re British Bulldog, Ltd.*, 224 USPQ 854, 855-56 (TTAB 1984) (no likelihood of confusion between PLAYERS for men's underwear and PLAYERS for shoes); *In re STMicroelectronics NV.*, Ser. No. 77500550 (T.T.A.B. 2010) (finding no likelihood of confusion between FLEXILOGIC for "computer hardware and software for noise reduction, spatial and strength processing, temporal tracking and gesture recognition of touch input devices" and FLEXILOGIC for "computer software design for others" in part because there is no *per se* rule that every computer software is related to all computer software design services).

In this case, Applicant's Services and Registrant's Services are dissimilar. The services at issue are dissimilar because they are simply different and do not overlap: Applicant's services are related to the entertainment industry where the broadcasting and transmission of Applicant's services will be related to entertainment content, none of which is claimed in Registrant's Cited Marks. In fact, Registrant is a satellite communications company developing a satellite-terrestrial network to support 5G and Internet of Things applications specific to the industrial sector, not the entertainment industry. *See* attached **Exhibit B** screenshots from Registrant's website.

Because it is inappropriate to deny registration merely because the services are in the same general field or maybe provided by the same source, this factor weighs against finding of confusion. Under these circumstances where the parties services are sufficiently distinct, there can be no likelihood of confusion with Registrant's Cited Marks and Applicant's Mark should be allowed for publication.

ii. The Parties' Trade Channels and Consumers Are Distinct.

Any concern about confusion is completely dispelled by the fact that Applicant's and the Registrant's channels of trade and consumers are different. The dissimilarity of established, likely-to-continue trade channels must be considered in determining whether or not there is a likelihood of confusion between the marks. *DuPont*, 476 F.2d at 1362-63, 177 USPQ at 568-69. *See* TMEP § 1207.01. When the

channels of trade and customers are distinct there is “virtually no opportunity for confusion to arise.” *In re HerbalScience Group, LLC*, Ser. No. 77519313 (T.T.A.B 2010).

In this case, the trade channels used by Applicant and the Registrant to distribute their respective services will be very dissimilar. As mentioned previously, Registrant is a satellite communications company developing a satellite-terrestrial network to support 5G and Internet of Things applications specific to the industrial sector. *See* attached **Exhibit B** screenshots from Registrant’s website. Registrant’s services are clearly specialized and tailored to the industrial market where Registrant provides “custom private networks to unlock the power of 5G and critical IoT connectivity for core infrastructure industries like utilities, transportation and manufacturing.” *See* attached **Exhibit C** screenshots from Registrant’s website. The Applicant does not provide any type of services directed to the industrial market. Therefore, the parties’ trade channels and consumers are distinct a few reasons.

First, considering the differences between the nature of the parties’ businesses and their respective services, it is fair to assume that the parties’ trade channels are also not the same. Specifically, Registrant’s services are provided through channels to consumers of the industrial sector, such as consumers in the infrastructure industries like utilities, transportation and manufacturing markets, whereas the Applicant’s services are not. Applicant’s services are targeted to the entertainment market vastly different from the industrial sector. Therefore, these channels are clearly distinct.

Second, considering very specific nature of the Registrant’s services covered by the Cited Marks, it is also fair to assume that the Registrant’s telecommunication services are provided to purchasers in and familiar with the industrial field. Further, neither parties services are the types casually purchased by consumers and therefore the consumers would be well versed about the specific need they are looking to fill and can easily discern that the subject services are not interchangeable. Consumers would not confuse Applicant’s and Registrant’s Cited Mark’s services, nor would these services be perceived by consumers as deriving from the same source. Registrant’s target purchasers are looking to secure telecommunication services tailored to the specific industrial organization need. In this market, the degree of care that can be anticipated by consumers who seek these services on such a large scale can be characterized as extremely high as compared to the everyday, casual purchases. When a consumer exercises a higher degree of care in selecting certain services, it is more likely that consumer will notice differences between the respective goods and the sources of those services. Therefore, there is less of a chance of confusion between two or more competing marks. *See* TMEP §1207.01(d)(vii) (circumstances suggesting care in purchasing may tend to minimize the likelihood of confusion. *See, e.g., In re N.A.D., Inc.*, 754 F.2d 996, 999-1000, 224 USPQ 969, 971 (Fed. Cir. 1985) (concluding that, because only sophisticated purchasers exercising great care

would purchase the relevant goods, there would be no likelihood of confusion merely because of the similarity between the marks NARCO and NARKOMED); *In re Homeland Vinyl Prods., Inc.*, 81 USPQ2d 1378, 1380, 1383 (TTAB 2006)).

Considering the differences between the nature of the parties' businesses and their respective services, it is fair to assume that the parties' trade channels and consumers are also not the same. Therefore, the differences between Applicant's and the Registrant's channels of trade and consumers heavily weigh against finding of likelihood of confusion. The Examining Attorney should give due weight to this factor in the likelihood of confusion analysis.

II. Applicant's Amendment to the Identification of Services in Class 41

In response to the Examining Attorney's request to revise the identification of services in the application, Applicant adopts the following identification of services:

Class 041: Entertainment services, namely, ongoing television programs **in the field of business, entertainment lifestyle and news, medicine, healthcare, psychology, legal, sports, accomplished artists, scholars, philanthropists, and entrepreneurs;** entertainment services, namely, **ongoing entertainment multimedia** programs presented on the Internet in the field of business, **entertainment lifestyle and news, medicine, healthcare, psychology, legal, sports, accomplished artists, scholars, philanthropists, and entrepreneurs;** providing ongoing entertainment **multimedia programs** in the field of business, **entertainment lifestyle and news, medicine, healthcare, psychology, legal, sports, accomplished artists, scholars, philanthropists, and entrepreneurs** accessible by satellite, television, Internet, wireless networks, and through transmission of audio and/or video signals to any type of visual display device; production and distribution of television shows

III. Translation Statement

The Examining Attorney requests Applicant submit an English translations of the Mark. Applicant submits the following:

The English translation of LEGADO in the mark is LEGACY.

IV. Conclusion

In conclusion, Applicant respectfully requests that the Section 2(d) refusal be withdrawn. Applicant's LEGADO.TV mark is not likely to cause confusion with Registrant's Cited Marks,

LIGADO NETWORKS, LIGADO NETWORKS and design, and LIGADO NETWORKS MAKING STRONGER CONNECTIONS and design. First, the marks at issue are different in sight, sound, meaning and commercial impression, particularly where Applicant's Mark means "legacy" and, according to the registrant, LIGADO means "connected and ready to go". Second, Applicant's broadcasting and streaming of entertainment content are not at all related to the Registrant's services which are tailored to the industrial market. Third, the parties' respective services are targeted to different classes of consumers. As such, Applicant requests that the Examining Attorney allow this Application for publication in the *Official Gazette*.