Docket No. 51DA-289862

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Eturi Corp. Serial No: 88/201,436 Filed: November 20, 2018 Classes: 009, 042 Mark: VEW	Office Action Examining Attorney: William T. Verhosek Law Office: 114 **RESPONSE TO OFFICE ACTION**

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

RESPONSE TO OFFICE ACTION

Applicant submits the following remarks in response to the Office Action mailed on February 25, 2019 (the "Action"). The Action refuses registration of the mark VEW ("Applicant's Mark") for both Identification of Goods in Class 9 and potentially under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d) based on a possible alleged likelihood of confusion with two identified prior-filed applications. Applicant respectfully traverses these refusals as follows.

I. Identification of Goods

The Action alleges that Applicant's identification of goods is indefinite in Class 9. In order to put the Application in condition for allowance, and in accordance with the Examiner's suggestion, Applicant respectfully submits herewith the following amended identification of goods:

> Downloadable computer application software and downloadable mobile applications all for use in controlling, monitoring, managing and reporting use of devices, namely, mobile phones, portable media players, handheld computers, laptop computers, notebook computers, and computers; downloadable computer application software and downloadable mobile applications all for use in controlling, monitoring, managing and reporting use of and access to mobile and computer applications; downloadable computer application software and downloadable mobile applications all for use in controlling, monitoring, managing and reporting use of and access to the Internet; downloadable computer application software and downloadable mobile applications all for use in restricting access to Internet content.

II. Prior Pending Applications:

The Action identifies prior pending U.S. trademark application serial No. 87/781,791 (the "'791 Application") and the U.S. trademark application serial No. 87/781,802 (the "'802 Application") as potentially barring registration of Applicant's trademark because of a likelihood of confusion under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d). This response will address each prior application independently.

The Action's refusal in view of the two prior marks fails to sufficiently show that consumers would be confused between the marks because: (1) there is little similarity between Applicant's description of services and the services provided by the owner of the '791 and '802 marks; (2) the Action's analysis improperly dissects the Applicant's Mark and the cited marks to find them highly similar when, in fact, the marks are substantially distinct with respect to sound, appearance, and commercial impression, lack of fame, and no evidence of actual confusion which weigh heavily against finding a likelihood of confusion. *See In re E.I. DuPont de Nemours & Co.*, 476 F.2d 1357, 1361 (C.C.P.A. 1973).

The Office bears the burden of showing that a mark falls within the statutory bars of Section 2(d). J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* (Fourth Ed.) § 19:75 at 19-230. To refuse registration under Section 2(d), the Action "must present

sufficient evidence and argument that the mark is barred from registration." *Id*. § 19-128 at 19-383. For the reasons discussed below, the Action, respectfully, has not met its burden.

A. '791 Prior Application

The Action alleges that Applicant's Mark is potentially confusingly similar to VEWD on account of the marks allegedly being confusingly similar in appearance and representing similar services. Applicant respectfully traverses this refusal as follows.

As amended, Applicant's Mark identifies:

> Downloadable computer application software and downloadable mobile applications all for use in **controlling, monitoring, managing and reporting use** of devices, namely, mobile phones, portable media players, handheld computers, laptop computers, notebook computers, and computers; downloadable computer application software and downloadable mobile applications all for use in controlling, monitoring, managing and reporting use of and access to mobile and computer applications; downloadable computer application software and downloadable mobile applications all for use in controlling, monitoring, managing and reporting use of and access to the Internet; downloadable computer application software and downloadable mobile applications all for use in restricting access to Internet content.

(Present Application (Emphasis added).) In contrast, the '791 Application identifies:

> Computer software featuring application programming interface software as a component all **for display and operation of applications, content creation, program guides, streaming media and video, playing live broadcasts and browsing the internet**; computer software for the **integration of text, audio, graphics, still images and moving pictures** into an interactive delivery for multimedia applications used with computing, communications, mobile and entertainment devices, namely, mobile telephones, personal digital assistants, tablets, smart phones, smart tvs, set-top boxes, optical disk players, streaming media devices, portable media players, desktop and laptop computers, virtual reality devices, augmented reality devices, in-flight infotainment and entertainment systems, automotive infotainment and entertainment systems, internet of things (IoT) devices, game and entertainment consoles; computer software for use in **transmitting and receiving data over computer networks and global communication networks**; web browser software for accessing the internet and the worldwide web; software for enabling web browsing on the internet and worldwide web;

> computer software for **managing communications and data exchange** among and between handheld mobile digital electronic devices and desktop computers; computer middleware, namely, software that **mediates between the operating system** of a handheld mobile digital electronic device and the application software of a mobile device; all of the foregoing being software for the purpose of enabling over-the-top (OTT) delivery of multimedia content, provided to original equipment manufacturers, silicon vendors, pay TV operators, and multimedia content owners and content service providers/publishers.

('791 Application (Emphasis added).)

Although both marks identify types of software, it is clear from the respective descriptions of goods that the respective software identified for use in connection with each mark is quite different. Specifically, Applicant intends to use Applicant's Mark in connection with **controlling and monitoring** the use of electronic devices (e.g., parental control and monitoring of a child's use of social media, etc.), whereas the '791 Application is computer software designed as an **interface for content creation, program guides, and streaming media and video**. Furthermore, the '791 Application will be used for playing live broadcasts, while Applicant's software is designed to collect usage information from the device, not create or broadcast content. Indeed, such uses are intended for entirely different consumer bases. Accordingly, the application for the respective software programs is completely different.

Similarly, the Applicant's mark when compared to the '791 Application does not carry the same sound, appearance, nor commercial impression. The Applicant's mark is "VEW", while the '791 is "VEWD" and a unique design. Although the difference in text is one letter, the impact of one letter in a four letter word is significant. Applicant's mark has twenty-five percent less characters that the '791 mark. Additionally, the '791 mark has a design in addition to their text, ultimately creating an entirely different impression than Applicant's Mark. This dramatic

difference between the totality of the marks is enough to create a unique sound, appearance, and commercial impression that is not likely to cause confusion.

Furthermore, the ’791 mark is not famous. This is not a well-known mark that benefits from vast exposure and goodwill previously established in the marketplace. Finally, there is zero evidence of actual confusion in the marketplace. Lack of established actual confusion from consumers is strong evidence to support there will be no confusion moving forward. There is likely no actual confusion because the customers for each products are different. One customer is in the market for a media consumption operating system while another is trying to find an application to track their family members’ device usage. Different products with different audiences are the main reason for lack of actual confusion.

Because the Office has not provided sufficient evidence to overcome their burden, the Office must conclude there is no likelihood of confusion.

B. ’802 Prior Application

The Action alleges that Applicant’s Mark is potentially confusingly similar to VEWD on account of the marks allegedly being confusingly similar in appearance and representing similar services. Applicant respectfully traverses this refusal as follows.

The ’802 Application identifies “Financial administration of subscription fees and services and one-time transaction fees and services” and “Licensing of technology in the nature of computer software for enabling over-the-top delivery of multimedia content, provided to pay to TV operators and multimedia content owners and service providers.” Accordingly, the ’802 Application identifies services that are completely different from the present Application. Specifically, Applicant’s Mark is intended for use in connection with computer and mobile applications to control, monitor, manage, and report use of devices, whereas the ’802

Application identifies uses for financial administration of subscription fees and software for enabling delivery of multimedia content, or a platform to pay TV operators and content owners. Applicant's Mark has nothing to do with the payment for multimedia and content creators. Indeed, such uses are intended for entirely different consumer bases. Because these applications are not similar and have no similar use, there is no likelihood of confusion in the marketplace between the two marks.

Furthermore, because the '801 and the '791 text and design are the exact same, the sound, appearance, and commercial impression are identical to the points made above. The difference in text, and lack of unique design sufficiently create two different marks and will likely not cause confusion. The '801 design similarly is not famous and enjoys no significant goodwill in the marketplace as a result of this mark.

Finally, the '801 marks presents no evidence of actual confusion in the marketplace. This is likely from the same reason the '791 mark produced no actual evidence of confusion, because the customers are looking for two different products. The '801 product is founded on the financial administration of media while the Applicant's mark is design for families and parents concerned with how often their children are using their device. For the reasons above, the '801 mark causes no likelihood of confusion in the marketplace with the Applicant's Mark.

Applicant's Mark is neither confusingly similar with the '791 nor the '802 because the use of the Applicant's Mark compared to both previously filed applications present no conflicting uses, are totality different in appearance, sound, and commercial impression. In addition, neither the '791 nor the '802 are famous and there is no evidence of actual confusion.

III. CONCLUSION

In view of the analysis discussed above, Applicant respectfully accepts the Action's proposed wording change for the identification of goods in International Class 9. In addition, the

Applicant respectfully distinguishes both previously filed applications as they present no likelihood of confusion in the marketplace with Applicant's Mark and identification of goods.

The Examining Attorney is invited to contact Applicant's attorney at the number listed below with any questions or requests for additional documentation.

Date: August 26, 2019

Respectfully submitted,

By: /Jesse A. Salen/
Jesse A. Salen, Attorney for Applicant
SHEPPARD MULLIN RICHTER & HAMPTON LLP
12275 El Camino Real, Suite 200
San Diego, CA 92130
Telephone: (858) 720-8900
Facsimile: (858) 509-3691