

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**  
**Trademark Examining Operation**

IN RE: Application No. 88/231,528  
Mark: GENIUSDIVIDENDS  
Applicant: Radian Group Inc.  
Law Office: 120  
Examining Attorney: Jeanine Gagliardi  
Attorney Docket No.

**RESPONSE TO OFFICE ACTION**

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

Dear Sir or Madam:

The Applicant, Radian Group Inc., by and through its undersigned counsel, responds to the Office Action dated March 6, 2019, as follows:

**AMENDMENTS**

Kindly enter the following amendments:

**1. Amend the services of the application as follows:**

“An incentive reward program to encourage real estate sales associates to adopt company technology, follow company best practices and promote products and services provided by company affiliates in conjunction with the sale of real estate” in International Class 35.

**REMARKS**

**I. Likelihood of Confusion Refusal**

The Examining Attorney has refused to register Applicant's mark on the grounds that it is likely to be confused with U.S. Registration No. 4,478,749 for GENIUS for "incentives for sale and usage of transaction cards, electronic accounts, wireless communication devices and other payment devices or loyalty programs" ("the '749 mark"). Applicant respectfully traverses the refusal.

#### **A. Differences in the Appearance of the Mark**

When the sound and appearance of two marks are compared, the marks must be viewed in their entirety and in context. *Comerica, Inc. v. Fifth Third Bankcorp*, 282 F.Supp. 2d 557, 570 (E.D. Mich. 2003) (citing *Homeowners Group, Inc. v. Home Marketing Specialists, Inc.*, 931 F.2d 1100, 1109 (6<sup>th</sup> Cir. 1991)). Marks that contain some identical formatives, when viewed in their entirety, have been found not to be confusingly similar, even when used for related or identical goods. *Keebler Co. v. Murray Bakery Products*, 866 F.2d 1386, 9 U.S.P.Q. 2d 1736 (Fed. Cir. 1989) (PECAN SANDIES and PECAN SHORTEES, both for pecan cookies, summary judgment of dismissal granted). *Nutri/System, Inc. v. Con-Stan Industries, Inc.*, 809 F. 2d 601, 1 U.S.P.Q.2d 1809 (9th Cir. 1987) (NUTRI/SYSTEM and NUTRI-TRIM both for weight loss services). More particularly, the addition of words can be sufficient to distinguish marks. *Comerica, Inc. v. Fifth Third Bankcorp*, 282 F.Supp. 2d at 570 (citing *In re Hearst Corp.*, 982 F.2d 493 (1992) (addition of GIRL in VARGA GIRL is sufficient to distinguish it from VARGAS for identical goods)).

Although the '749 mark and Applicant's mark each contain the word "genius", the additional element in Applicant's mark results in two marks that differ in both appearance and sound. Whereas "genius" is the sole element in the '749 mark, the same cannot be said for Applicant's mark, in which the formative is inseparable with the word "dividends", thus forming a unitary expression with a very different commercial impression. Consumers most likely would

view the “genius” portion of Applicant’s mark as a modifier of “dividends,” such that, considered in its entirety, the GENIUSDIVIDENDS mark creates a commercial impression of a type of benefit or pay-off. This differs significantly from the impression created by GENIUS alone which engenders no connotation or commercial impression as to a beneficial outcome.

The marks also sufficiently differ in sound so as not to cause confusion. The ‘749 mark is single word comprising two syllables. Applicant’s mark, on the other hand, is a longer word consisting of five syllables. This factor also weighs against a finding of likelihood of confusion.

**B. The differences between GENIUSDIVIDENDS and the ‘749 mark, especially in type of services offered, ensure that there will not be confusion in the marketplace.**

Applicant has amended the identification of services to clarify that the GENIUSDIVIDENDS mark is used in connection with an incentive reward program to encourage real estate sales associates to adopt company technology, follow company best practices and promote products and services provided by company affiliates in conjunction with the sale of real estate. In contrast, the ‘749 mark is used in connection with incentives for sales in the field of transaction cards, electronic accounts, wireless communication devices and other payments devices or payment loyalty programs.

As clarified by the amended identification of services, Applicant’s services are sufficiently distinguishable from the services of the ‘749 mark as the services are offered through different channels to different purchasers. While the Registrant’s services are offered to the general consumer for personal payment and financial offerings, Applicant’s services are exclusive to the real estate industry, and offered only to real estate sales associates to promote Applicant’s products and services in connection with the sale of real estate. As such, Applicant’s

services are restricted to a limited and narrow channel of trade offered to a very different class of purchasers, and thus is clearly different than Registrant's services.

### **C. Coexisting Third Party Registration**

Finally, Applicant points to U.S. Registration No. 5,597,147 for GENIUS KARMA for providing incentive award programs through issuance and processing of loyalty points for purchase of a company's goods. That the '147 registration is capable of co-existing with the '749 registration with only minor variations in fields of use further supports the argument that Applicant's mark can similarly co-exist. Applicant's GENIUSDIVIDENDS mark is at least as distinguishable from the '749 registration in terms of appearance, sound and commercial impression as is the registration from GENIUS KARMA, and Applicant's services are further removed from the '749 Registrant's services than are the services of the '147 Registrant.

### **III. Conclusion**

For the above reasons, including the amendment to the identification of services and the arguments presented, Applicant respectfully suggests that the section 2(d) refusal to register should be withdrawn. As all outstanding issued in the March 6, 2019 Office Action have been addressed, Applicant respectfully requests favorable consideration and requests publication of the application.

Respectfully submitted,

SCHNADER HARRISON SEGAL & LEWIS LLP

Dated: September 6, 2019

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