

RESPONSE TO OFFICE ACTION

In response to the Office Action dated March 19, 2019, the Applicant respectfully requests reconsideration of the application. The Office refuses registration of the proposed mark stating that it is likely to cause confusion with U.S. Registration No. 5197566 for SKYLIGHT for providing non-downloadable internet-based software for use in contractor evaluation, bidding, contracting, project management and payments for use by homeowners to help manage their renovation and construction projects. The Applicant respectfully disagrees and traverses the refusal.

The court in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973) set forth various factors to consider when analyzing likelihood of confusion. The most common factors include similarity of the marks, and relatedness of the goods or services. However, the court also listed several other factors, and cautioned that "[t]here is no litmus rule which can provide a ready guide to all cases." *Id.* at 1361, 177 USPQ at 567, TMEP 1207.01. Indeed, the court noted that the significance of a particular factor may differ from case to case. *See du Pont*, 476 F.2d at 1361-62, 177 USPQ at 567-68. Here, the Applicant contends that a combination of several of the factors, including the inherent weakness of the cited mark, as well as third party use of the mark SKYLIGHT for software, weighs in favor of a finding of no likelihood of confusion.

The cited mark is SKYLIGHT. The Applicant's mark significantly differs visually and in fact associates a very different type of service. Applicant's mark is SKYLIGHT & design, the design consisting of three parallel rectangles, ascending in height from the left to right, wherein the first rectangle contains one white square inside, the second rectangle containing two white squares, and the third rectangle containing three white squares. The rectangles being further framed with a left vertical line and an intersecting bottom horizontal line on the bottom left side surrounding the rectangles, and a right top vertical line and an intersecting right horizontal line on the right side surrounding the rectangles. Visually, Applicant's mark presents a different appearance than the cited mark.

The Office argues that the goods and services are related. The Applicant respectfully disagrees. Unlike the cited mark, discussed below, Applicant's mark is inherently distinctive, thus it is difficult to understand a conclusion that the services are highly related. The Office states "[t]he services are closely related, namely both involve downloadable building related

software.” The Applicant respectfully disagrees that these services are closely related. While the services both involve software, they are directed to software with different purposes and different marketplaces, which are included in the identification of the services. The purpose of the services of the cited mark is for use by a consumer, i.e., a homeowner, in the evaluation of a contractor, the bidding, contracting, project management and payments to help manage the homeowner’s renovation and construction projects. Once the project is completed, the services of the cited mark are no longer required. Thus, the services of the cited registration are related to project management software for home renovations and home construction projects.

In vast contrast, the Applicant’s services are directed to software that collects and analyzes building-related data used in the rating and optimization of building performance, efficiency, comfort, safety and financial valuation. Applicant’s software is directed to the management of the actual building based on the current state of the building and optimization of it for safety, efficiency and the like. These services would be used by management personal and would be used continuously, not for a single purpose, as with the services of the cited mark.

Other *Du Pont* factors that Applicant contends are relevant include (1) the similarity or dissimilarity of established, likely-to-continue trade channels; (2) the conditions under which and buyers to whom sales are made, i.e., "impulse" vs. careful, sophisticated purchasing; and (3) the number and nature of similar marks in use on similar goods; and (4) any other established fact probative of the effect of use, such as, in this case, the weakness of the cited mark.

As discussed above, the consumer of the cited mark is a homeowner seeking a remodel or renovation of their home. This owner would be seeking to build or rebuild portions of their home, or upgrade and improve physical aspects of the home, such as the kitchen or bathroom. These consumers might seek the services of the cited mark by asking for information at hardware stores, such as, Lowe’s or DIY, or contractors. The consumer of Applicant’s mark is someone involved in the management of buildings, such as a management company or a commercial property owner with multi-story buildings. The consumer of Applicant’s services is seeking assistance in monitoring the efficiency and safety, for example, of the building. The information is monitored electronically and made available on the software platform for the consumer to utilize. It is an ongoing service that can continue for the life of the building or the ownership by the consumer. Indeed, the consumer seeking Applicant’s services would look to other similarly situated people or trade organizations for management to find Applicant’s services. Due to the

nature of the Applicant's services, the consumer will make a decision to purchase after more careful consideration, and thus, it will not be an impulsive purchase as the service could be relied upon to identify issues in the building for correction before they become major problems. In vast contrast, the services of the cited mark are not as critical to the operation of the home. Rather, it is project management software that allows a homeowner to keep track of whether costs are being exceeded, or whether the completion of an aspect of the project is timely. Thus, the purchase of the service associated with the cited mark will not be made with as much care as much of what is being done by the software could likely be done with an Excel spreadsheet. In any instance however, the consumers of these two services will not overlap as the marketplaces for these services do not overlap, and are distinct marketplaces. One is direct to the homeowner (cited mark), the other is business to business (Applicant's mark).

The Applicant contends that the nature and number of similar SKYLIGHT marks used in association with software weighs in favor of a finding of no likelihood of confusion. A search of the Internet reveals several SKYLIGHT marks used in association with software. Exhibit 1. For instance, the search revealed a SKYLIGHT software by UpSkill that allows workers to interact with a software interface directly in their line of sight and connects workers, such as building or factory workers, to data and equipment of the operations. Sierra Wireless offers SKYLIGHT mobile broadband connection software manager. Of particular interest is SKYLIGHT software, a project management software that is a business management app that integrates billing and accounting and allows organization of tasks, time billing, invoices, and documents. While not directed to home project management for renovations, this SKYLIGHT app is closer in purpose to that of the cited mark than the Applicant's services. Yet, the cited mark and this mark currently coexist in the marketplace. The last pages of Exhibit 1 are from the website of the services of the cited mark, at skylight.com. The SKYLIGHT project management app is found at skylightit.com. These are similar type services, software services for project management, and were found in the same search. If there would be confusion, it would emanate from these two services. Finally, the search revealed a SKYLIGHT software by Silkroute for inventory management. Exhibit 1. Clearly, the marketplace tolerates overlap in software with products bearing similar marks.

In addition to the marketplace, the Trademark Office register demonstrates that SKYLIGHT marks can coexist for software products and services. For instance, the register includes U.S. Registration No. 4711796 for SKYLIGHT for, in part, software to configure network products such as smart home and wearable products; U.S. Registration No. 4958080 for SIERRA WIRELESS SKYLIGHT for telecommunications software for internet connectivity and management and monitoring of wireless connections; U.S. Registration No. 4606068 for SKYLIGHT GLOBAL PRODUCTIONS for, in part, on-line retail store featuring, in part, software in the field of finance, and business and investing; and U.S. Registration No. 4606068 for SKYLIGHT for in part, on-line retail store featuring, in part, software in the field of finance, and business and investing. Exhibit 2. Thus, not only does the marketplace tolerate unrelated SKYLIGHT marks for software, so does the Trademark Office. As the marketplace and Trademark database both support unrelated third-party SKYLIGHT marks related to software or software services, the Applicant contends that its mark can also coexist.

Finally, another factor weighing in favor of no likelihood of confusion is the issue that the cited mark is registered on the Supplemental Register, and is therefore considered a descriptive mark for the identified services. Indeed, during prosecution of this case, the Office stated “Applicant’s goods or services feature internet tools that may be used in the construction and planning for skylights. Therefore, the word “skylight” describes a purpose of the goods or services.” Exhibit 3. The applicant offered no objection to the statement and therefore acquiesced that the mark is descriptive for the services. Although the agreement to amend to the Supplemental Register may not be an admission that the mark has not acquired distinctiveness, it is an admission that the mark is not inherently distinctive, and was considered descriptive at the time of registration. Therefore, without more in the record to show the mark has acquired distinctiveness, the assumption can be made that the mark has not. Accordingly, the mark is only entitled to a narrow scope of protection.

Indeed, the Court of Appeals for the Federal Circuit and Trademark Trial and Appeal Board “have recognized that merely descriptive and weak designations may be entitled to a narrower scope of protection than an entirely arbitrary or coined word. *See Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 1338-39, 115 USPQ2d 1671, 1674 (Fed. Cir. 2015); *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee en 1772*, 396 F.3d 1369, 1373, 73 USPQ2d 1689, 1693 (Fed. Cir. 2005); *Giersch v. Scripps Networks, Inc.*, 90 USPQ2d

1020, 1026 (TTAB 2009) ; *In re Box Solutions Corp.*, 79 USPQ2d 1953, 1957-58 (TTAB 2006); *In re Cent. Soya Co.*, 220 USPQ 914, 916 (TTAB 1984). TMEP 1207.01(b)(ix).

With respect to marks registered on the Supplemental Register, the Board stated the following in *In re Hunke & Jochheim*:

[R]egistration on the Supplemental Register may be considered to establish prima facie that, at least at the time of registration, the registered mark possessed a merely descriptive significance. This is significant because it is well established that the scope of protection afforded a merely descriptive or even a highly suggestive term is less than that accorded an arbitrary or coined mark. That is, terms falling within the former category have been generally categorized as "weak" marks, and the scope of protection extended to these marks has been limited to the substantially identical notation and/or to the subsequent use and registration thereof for substantially similar goods.

185 USPQ 188, 189 (TTAB 1975) (citation omitted). *Id.*

Prior courts have also supported this argument. For instance, in 1958, the Court of Customs and Patent Appeals stated "it seems both logical and obvious to us that where a party chooses a trademark which is inherently weak, he will not enjoy the wide latitude of protection afforded the owners of strong trademarks. Where a party uses a weak mark, his competitors may come closer to his mark than would be the case with a strong mark without violating his rights. *Sure-Fit Prods. Co. v. Saltzson Drapery Co.*, 254 F.2d 158, 160 (C.C.P.A. 1958). Here, the Applicant's inherently distinctive mark is not close to the cited mark, and as discussed above, the identified services are not highly related. For these and the reasons set forth above, Applicant contends that its proposed mark is allowable over the cited mark.

In light of the arguments set forth above, the Applicant contends that no likelihood of confusion would result from the registration of the proposed mark. As such, the Applicant respectfully requests the Office pass the application to allowance.