

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

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**In re Application of:** Ositech Communications Inc.

<b>Serial No.:</b> 88/235,701	<b>Trademark Law Office:</b> 110
<b>Filing Date:</b> December 19, 2018	<b>Examining Attorney:</b> Eliana Torres
<b>Mark:</b> GUARDIAN ANGELS	<b>Our File No.:</b> 5595.002

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**RESPONSE TO OFFICE ACTION**

This paper is filed in response to Office Action dated March 18, 2019, in connection with the above-identified U.S. trademark application. The six-month period for response expires on September 18, 2019. Accordingly, this response is timely filed.

**I. AMENDMENT**

Applicant requests that its identification of goods and services be amended to delete classes 041 and 044, and as follows:

**Class 9**

Downloadable Computer software featuring mathematical algorithms for use in identifying and notifying persons trained in paramedic services or first aid regarding a cardiac arrest or drug overdose event; Downloadable Computer software featuring mathematical algorithms for use in evaluating skill level of persons trained in paramedic services or first aid; Downloadable computer software featuring mathematical algorithms for use in providing to a person trained in paramedic services or first aid directional guidance to a cardiac arrest or drug overdose event.

**II. REMARKS**

**A. Applicant's Request for Amendment**

Applicant has made certain amendments to further clarify and specify the goods associated with the above-referenced mark. Applicant has not amended the identification of goods to add or broaden the scope of goods.

Applicant requests the below arguments addressing the Office Action's Section 2(d) refusal be considered in view of the amended identification of goods.

**B. No Likelihood of Confusion Between Applicant's Mark and the Cited Registration**

The Office Action refuses registration of Applicant's mark GUARDIAN AGNELS ("Applicant's Mark") under Trademark Act Section 2(d), 15 U.S.C. § 1052(d), because the Trademark Examining Attorney considered Applicant's Mark, when used on or in connection with the identified goods to so resemble US Trademark Reg. No. 4845576 for the mark GUARDIAN ANGEL in class 041 ("Cited Registration").

Applicant respectfully requests that refusal to register on the basis of likelihood of confusion be withdrawn on grounds the differences in the marks, differences in the goods and services, and their trade channels, as well as the sophistication of prospective customers, obviate the finding of likelihood of confusion between the Cited Registration and Applicant's mark.

In testing for likelihood of confusion under Section 2(d), the following factors must be considered:

- (1) The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.
- (2) The similarity or dissimilarity and nature of the goods or services as described in an application or registration or in connection with which a prior mark is in use.
- (3) The similarity or dissimilarity of established, likely-to-continue trade channels.
- (4) The conditions under which and buyers to whom sales are made, i.e. "impulse" vs. careful, sophisticated purchasing.
- (5) The fame of the prior mark (sales, advertising, length of use).
- (6) The number and nature of similar marks in use on similar goods.
- (7) The nature and extent of any actual confusion.
- (8) The length of time during and conditions under which there has been concurrent use without evidence of actual confusion.
- (9) The variety of goods on which a mark is or is not used (house mark, "family" mark, product mark).
- (10) The market interface between applicant and the owner of a prior mark.
- (11) The extent to which applicant has a right to exclude others from use of its mark on its goods.

- (12) The extent of potential confusion, i.e., whether *de minimis* or substantial.
- (13) Any other established fact probative of the effect of use.

*In re E. I. DU Pont de Nemours & Co.*, 476 F.2d 1357, 1361 (C.C.P.A. 1973). One or more of the *DuPont* factors may be more dominant than others in a particular case. See *In re Inspired Technologies, Inc.*, 2011 WL 526096 (T.T.A.B. January 19, 2011) (in certain situations, differences in the goods and the sophistication of the purchasers outweigh the purported similarities of appearance in the compared marks).

In considering each of the above factors, the Office must keep in mind that “[t]he fundamental inquiry mandated by Section 2(d) goes to the **cumulative effect** of differences in the essential characteristics of the goods and differences in the marks.” *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) (emphasis added); see also *In re Azteca Restaurant Enterprises, Inc.*, 50 USPQ2d 1209 (TTAB 1999) and the cases cited therein. As described in more detail below, Applicant respectfully asserts that, given the cumulative effect of the above factors, there is no likelihood of confusion and Applicant’s Mark should proceed to registration.

1. Difference in Goods/Services Precludes a Likelihood of Confusion

Applicant has amended its identification in the present response to obviate any potential confusion with the Cited Registration. As amended, the striking differences in the goods of the respective parties alone preclude a likelihood of confusion, particularly in combination with the relevant channels of trade and sophistication of relevant consumers. Accordingly, Applicant asks the Examining Attorney to withdraw the § 2(d) refusal and permit Applicant’s Mark to proceed to allowance.

The services covered by the Cited Registration relied on in the Office Action versus Applicant’s goods (as amended) are as follows:

US Reg./ Serial Number	MARK	GOODS/SERVICES
4845576	GUARDIAN ANGEL	<u>Class 041</u> : Educational services, namely, clinical education and training in the insertion, care and maintenance of vascular access devices
88235701	GUARDIAN ANGELS	<u>Class 009</u> : Downloadable Computer software featuring mathematical algorithms for use in identifying and notifying persons trained in paramedic services or first aid regarding a cardiac arrest or drug overdose event; Downloadable Computer software featuring mathematical algorithms for use in evaluating skill level of persons trained in paramedic services or first aid; Downloadable computer software featuring mathematical algorithms for use in providing to a person trained in paramedic services or first aid directional guidance to a cardiac arrest or drug overdose event

It is well established that differences in the parties’ goods and services alone are sufficient to prevent a likelihood of confusion. In determining whether a likelihood of confusion exists under § 2(d), “confusion is related not to the nature of the mark but to its effect when applied to the goods [and services] of the Applicant. [Therefore] the only relevant application is made in the marketplace.” *In re E.I. duPont de Nemours & Co.*, 476 F.2d 1357, 1360 (CCPA 1973). In fact, when determining whether a likelihood of confusion exists under § 2(d), if the goods in question “are not related ... in 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, then, even if the marks are identical, confusion is not likely.” TMEP §§ 1207.01(a)(i), *e.g., Shen Mfg. Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 1244-45 (Fed. Cir. 2004) (emphasis added) (reversing the Boards’ holding that RITZ for cooking and wine classes was likely to cause confusion with RITZ for kitchen textiles, reasoning in part that the Examining Attorney had not established the respective goods and services were related).

Here, the Office Action does not assert or submit any evidence to establish that Applicant’s goods in Class 009 are related to the services recited in the Cited Registration. As amended, the remaining computer software goods are sufficiently distinct from the educational services recited in the Cited Registration to eliminate any likelihood of confusion. The Cited Registration is directed to “educational services, namely, clinical education and training”

specifically for vascular access devices. Conversely, in the present application the mark is used in association with computer software used during a medical emergency to identify and notify nearby people trained in first aid or paramedical services and to guide them to the emergency location. There is no reason to conclude and/or evidence relied upon to show that an education institution providing clinical training in the field of vascular access would be involved in creating and providing computer software and/or a mobile application for real-time notification and guidance of first responders or community volunteers during a medical emergency.

Applicant has amended its identification to further clarify and narrow the underlying goods, and to obviate any potential overlap with the services in the Cited Registration. Specifically, Applicant has also added the following limitation to its description of goods in class 009:

*...for use in providing to a person trained in paramedic services or first aid directional guidance to a cardiac arrest or drug overdose event.*

As amended, there is simply no overlap or relation between Applicant's computer software/mobile application, on the one hand, and the educational services in the field of vascular access devices in the Cited Registration, on the other. Thus, in view of Applicant's amended identification and the differences in the goods and services, a § 2(d) refusal is improper.

## 2. Sophistication of Consumers/Difference in Trade Channels Precludes Confusion

The sophistication of consumers is "important and often dispositive because sophisticated consumers may be expected to exercise greater care." *Electronic Design & Sales Inc. v. Electronic Data Systems Corp.*, 954 F.2d 713, 21 USPQ2d 1388 (Fed. Cir. 1992). Here, the sophistication of relevant consumers further prevents a likelihood of confusion. Likewise, the channels of trade are vastly different. *See du Pont*, 476 F.2d at 1361; *Electronic Data Systems*,

23 USPQ2d at 1460, 1462-63 (no likelihood of confusion where products reside in different trade channels).

Applicant's software is directed toward highly sophisticated, differentiating entities that exercise a high degree of care and deliberation when making purchasing decisions for software to aid paramedics in emergency situations. Such software must be carefully selected to meet highly detailed specifications for very specific functions. To these discerning consumers, clinical training institutions would not be considered a likely source of a real-time software product for location-based notification of emergency or medical personnel. Likewise, purchasers of educational services for vascular access devices in the Cited Registration would be discerning when selecting services for such a highly specific and separate purpose.

Finally, the owners of the Cited Registration and Applicant's Mark are not competitors because they conduct business in completely different industries and to different consumers. Because the goods and services in question are not related or marketed in 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, confusion is not likely. *See* TMEP 1207.01(a)(i); *Quartz Radiation Corp. v. Comm/Scope Co.*, 1 USPQ2d 1668, 1669-70 (TTAB 1986)(QR for coaxial cable held not confusingly similar to QR for various products, e.g. lamps, tubes, related to the photocopying field).

In view of the above arguments and evidence, it is highly unlikely that any confusion as to the source of origin would exist because the Cited Registration and Applicant's goods travel in very different channels of trade and further, would never be sold side by side or to the same audience. Analyzed as a whole, in the context of its trade channels, sophistication of the consumer, and use in the marketplace, Applicant's Mark is entitled to registration.

3. The Marks Are Different and Have a Different Commercial Connotation

Applicant's Mark is GUARDIAN ANGELS, with an "s"; while the Cited Registration is in the singular form, GUARDIAN ANGEL. While the addition of an "s" to render a word in its plural form *by itself* may not impart a difference in commercial impression or connotation sufficient to avoid a likelihood of confusion, Applicant asserts that, in this case, this difference between the marks, combined with the other factors outlined above, weighs in favor of no confusion.

**III. FOREIGN REGISTRATION**

Examiner asserts that Applicant must provide a foreign registration certificate. Applicant has not yet obtained a foreign registration certificate to submit. Applicant, however, intends to submit the Certificate once it does and respectfully requests suspension until then.

**IV. CONCLUSION**

Under the Lanham Act, a refusal to register under likelihood of confusion requires that such confusion as to the source of the goods must be not merely possible, but likely. A mere possibility of confusion is an insufficient basis for rejection under Section 2(d). *In re Massey-Ferguson, Inc.*, 22 U.S.P.Q. 367 (T.T.A.B. 1983). In view of the foregoing remarks, Applicant respectfully requests that the Examining Attorney refrain from refusing this application on the basis of the Cited Registration as to be likely to cause confusion, to cause mistake or to deceive.

Respectfully submitted,



Date: September 18, 2019

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