

OFFICE ACTION RESPONSE
U.S. Serial No. 88240747 for PASTPORT

In the Office Action mailed March 25, 2019, the examiner rejected Application Serial No. 88240747 for the mark PASTPORT, citing likelihood of confusion with U.S. Registration Nos. 3793628 and 5582119. In addition, the examiner objected to the identification of goods, asserting that the wording directed to the device is indefinite and must be clarified. Each of these issues is discussed in turn below.

I. Identification of Goods

The examiner alleges that the wording “[p]ortable archiving equipment, namely, devices for capturing and archiving physical items, documents and artwork in digital format” and “[a]rchiving equipment, namely, devices for capturing and archiving physical items, documents and artwork in digital format” in the identification of goods is indefinite and must be clarified. Specifically, the examiner has requested that the applicant indicate the common commercial name for the “device.”

As indicated in the form section of this response, applicant has amended the identification of identified goods to indicate that the archiving equipment comprises a photographic light box for use with a digital camera.

In addition, applicant has amended the description with respect to the recitation of “items, documents and artwork.” Specifically, applicant has replaced the word “physical” with “tangible” so that the phrase now reads, “tangible items, documents and artwork.” For the sake of clarity, it is applicant’s intent that the term “tangible” modifies each of the listed terms, such that the items, documents and artwork are all tangible (as opposed to digital).

Following applicant’s amendments, the description reads as follows:

Computer application software for mobile phones, namely, software for capturing and archiving tangible items, documents and artwork in digital format; Downloadable software in the nature of a mobile application for capturing and archiving tangible items, documents and artwork in digital format; Downloadable mobile applications for capturing and archiving tangible items, documents and artwork in digital format; Portable archiving equipment, namely, devices comprising a photographic light box for use with a digital camera for capturing and archiving tangible items, documents and artwork in digital format; Archiving equipment, namely, devices comprising a photographic light box for use with a digital camera for capturing and archiving tangible items, documents and artwork in digital format; Downloadable mobile applications for processing digital images of tangible items, documents and artwork into a digital archival preservation format.

II. Section 2(d) – Likelihood of Confusion

The examiner has refused registration of the applied-for mark due to likelihood of confusion with U.S. Registration No. 3793628 for the mark MY PASSPORT in connection with “Computer products, namely, disk drives, computer storage units, namely, computer hardware for storage of digital data, and computer peripherals, excluding mouse pads” in class 009 and U.S. Registration No. 5582119 for the mark PASSPORT DOCUMENT CLOUD in connection with “Software as a service (saas) services featuring software for collecting, storing, retrieving, archiving, analyzing, managing, and sharing patient medical data and documents, patient admissions information, patient financial data, patient demographic data, information received from or sent to medical facilities, patients and physician offices, and digital archiving, storage and retrieval of paper, electronic and other forms of medical records; Software as a service (saas) services featuring software for creating, editing, updating and distribution of medical records by physicians, nurses and allied health professionals and medical clerical staff” in class 042. The examiner also cited pending U.S. Application Serial Nos. 87855332, 79235473, 88022451, and 88058581 because if one or more of the marks in the referenced applications register, applicant’s mark may be refused because of a likelihood of confusion. Applicant respectfully disagrees with the examiner’s finding that the cited registrations and pending applications are likely to be confused with the applied-for mark.

Applicant submits that there are a significant number of “passport” registrations in classes 9 and 42. *See Exhibit A* (87 registrations in class 009 for marks containing “passport”); *Exhibit B* (56 registrations in class 042 for marks containing “passport”). There are no active entries for marks containing the term “pastport” in either class 9 or class 42.

Traditionally, when there are a large number of marks with similar elements in the same classes, a field of use limitation is sufficient to narrow the identification of goods to circumvent the registrations on the record. Indeed, the examiner acknowledges that “physical items” and “artwork” presuppose a different field of use.

As detailed above, applicant has amended the description of goods to clarify that the items, documents and artwork recited in the description are all tangible in nature. In addition, the amended description also clarifies that the recited downloadable mobile applications process “digital images of tangible items, documents and artwork into a digital archival preservation format.” As such, the amended description recites goods directed to a field of use that is separate and distinct from the goods and services recited in the registrations and applications cited by the examiner.

In light of applicant’s amendments to the identification of goods, including the field of use clarifications, applicant asserts that there is no likelihood of confusion between the applied-for mark, the cited registrations or the pending applications.

III. Conclusion

Because there is no likelihood of confusion between the applied-for mark, the cited registrations and the pending applications, applicant submits that the application is in condition for allowance and respectfully requests that the examiner approve the application for publication.