IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of OSF Healthcare System	Trademark Law Office 128 (571) 272-6848
For: "RUBE-E"	
Serial No.: 88/274,541	Examining Attorney: Olivia S. Lee
Filed: January 24, 2019	

RESPONSE TO OFFICE ACTION

TO COMMISSIONER FOR TRADEMARKS:

OSF Healthcare System ("Applicant"), by and through its undersigned counsel, hereby responds to the Office Action, emailed April 16, 2019, on the above-captioned trademark application.

1. Likelihood of Confusion Refusal and Prior-Filed Application

The Examiner has refused registration of Applicant's RUBE-E mark in connection with "downloadable software for education and development in the fields of science, technology, art, engineering and math; educational materials in the fields of science, technology, art, engineering and math" in Class 9, based upon a perceived likelihood of confusion with the Registration No. 4,654,843 for the mark RUBI and Gem Design in connection with "training services in the fields of information technology and the use of computer software and loan processing computer software" in Class 41, owned by Paradigm Quest, Inc. ("Paradigm") (hereinafter referred to as the "Cited Registration").

The Examiner also has preliminarily refused registration of Applicant's RUBE-E mark based on U.S. Application Serial No. 88/318,009 for the mark RUBY in connection with "scientific instruments for measuring fluids; rheometers; downloadable computer software for

use in controlling a scientific instrument for measuring properties of fluids; downloadable computer software for use in controlling a rheometer for measuring properties of fluids" in Class 9, owned by Cannon Instrument Company ("Cannon") (hereinafter referred to as the "Cited Application")(together with the Cited Registration, referred to as the "Cited Marks").

Applicant respectfully disagrees with the Examiner's conclusion and requests withdrawal of the 2(d) refusal for the reasons set forth below.

A. Introduction

When evaluating a possible likelihood of confusion, the marks involved must be considered in their entireties. In re Hearst Corp., 25 U.S.P.Q.2d 1238, 1239 (Fed. Cir. 1992). "Marks tend to be perceived in their entireties, and all components thereof must be given appropriate weight." In this instance, a comparison of the marks in their entireties, as well as distinct differences between the relevant services, target markets, and channels of trade, all demonstrate that confusion is not likely.

B. Confusion is Not Likely with the Cited Registration or Cited Application

1. The Marks are Not Confusingly Similar When Considered in Their Entireties.

As a primary matter, it is essential to consider the sound, appearance and commercial impression of the marks as a whole. Packard Pres., Inc. v. Hewlett-Packard Co., 227 F.3d 1352, 1357 (Fed. Cir. 2000) (holding that "[a]ll relevant facts pertaining to appearance, sound, and connotation must be considered before similarity as to one or more of those factors may be sufficient to support a finding that the marks are similar or dissimilar"). See also Casa Vinicola Gerardo Cesari S.R.L. v. Miguel Torres S.A., 1999 U.S. App. LEXIS 32023 (vacating the Board's decision denying registration of applicant's mark because the Board failed to consider the difference in appearance between the applicant's mark and the opponent's mark).

Here, Applicant's RUBE-E mark differs in basic, sound, appearance and meaning from the Cited Registration and the Cited Application. Although Applicant's mark and the Cited Marks all contain the term RUB*, that is where the similarities end. The remaining elements of each mark are noticeably different in appearance, pronunciation and connotation.

First, Applicant's mark contains the made up term RUBE with the initial "-E". Paradigm's mark contains the made up term RUBI following a distinct Gem design. The letter "I" instead of an "E", in addition to a distinct Gem design, creates a mark that is sufficiently distinct in appearance, pronunciation and commercial impression. Additionally, Cannon's mark contains the word RUBY and does not contain any design element. Similarly, these differences render confusion unlikely.

The Examiner notes that the terms RUBE-E and RUBI "are novel spellings or intentional misspellings that are phonetic equivalents of the word "RUBY". Applicant respectfully disagrees. The Examiner has not put forth any evidence that demonstrates that consumers will pronounce the marks RUBE-E and RUBI the same at all, or similar to RUBI. It takes a series of mental steps to understand how Applicant's mark and Registrant's mark are each pronounced.

In determining whether marks are confusingly similar in sound, appearance and overall commercial impression, a sole point of similarity may be outweighed by points of dissimilarity. See, e.g., In re Sleepyheads.com Inc., 2005 TTAB LEXIS 450. (SLEEPYHEADS.COM and SLEEP-HEAD HOUSE were sufficiently different) See also, e.g., In re Hearst Corp., 25 U.S.P.Q.2d at 1239 (marks VARGA GIRL and VARGAS sufficiently different in sound, appearance, and commercial impression for closely related goods); Pacquin-Lester Co. v. Pharmaceuticals, Inc., 179 U.S.P.Q. 45, 46 (C.C.P.A. 1973) (no likelihood of confusion between

SILK for face cream and SILK 'N SATIN for beauty lotion and bath oil for hands and skin). The points of dissimilarity here outweigh the sole point of similarity, namely the term RUB*.

Further, the TTAB has held that it is inappropriate to dissect marks to analyze a likelihood of confusion. See, e.g., In re Produits de Beatue – Parfums Jean D'Aveze, 225 USPQ 283, 284 (T.T.A.B. 1984) (Applicant's mark CRÈME DE JOUVENECE & Bird Design not confusingly similar to mark JUVENANCE for identical toiletry products and criticizing the registration refusal as "a classic example of improper dissection of marks.") Therefore, it is similarly inappropriate to dissect Applicant's RUBE-E mark to find a likelihood of confusion with the Cited Marks.

Finally, it is well established that courts are "not concerned with mere theoretical possibilities of confusion, deception or mistake or with de minimis situations, but with the practicalities of the commercial world which trademark laws deal." Witco Chem. Co. v. Whitfield Chem. Co., Inc., 418 F.2d 1403, 1405 (C.C.P.A. 1969). Because Applicant's mark contains the distinctive "-E" and does not contain the letter I nor the distinct Gem Design, nor does it contain the term RUBY, consumers are not likely to be confused.

The foregoing cases clearly establish that two marks may be found not confusingly similar, even when they have a word in common, even if it is the first word of the marks, and are associated with identical or related goods. Since the Trademark Office has, for example, permitted the co-existence of marks such as SLEEPYHEADS.COM and SLEEP-HEAD, and VARGA GIRL and VARGAS, for nearly identical goods, the differences between Applicant's RUBE-E and the Cited Marks are likewise sufficient to preclude a likelihood of confusion. Any similarities do not outweigh the stark differences in the marks' overall sounds and appearances, and do not create an overall commercial impression that is confusingly similar.

2. There are Significant Differences Between the Respective Goods/Services and the Target Markets.

Applicant's mark and the Cited Marks are used in connection with entirely different goods and services. Paradigm's RUBI and Gem Design mark is registered for "training services in the field of information technology and the use of computer software and loan processing computer software." According to its website, Paradigm offers process outsourcing services in the financial services sector. Its RUBI services are tied to a program that performs lender underwriting and servicing that benefits both the original community and the mortgage borrower. See Exhibit A. It appears that Paradigm's RUBI training services are, as indicated in the identification, related to loan processing.

Cannon's RUBY mark covers "scientific instruments for measuring fluids; rheometers; downloadable computer software for use in controlling a scientific instrument for measuring properties of fluids; downloadable computer software for use in controlling a rheometer for measuring properties of fluids". According to its website, Cannon provides instruments, services and reference materials for the characterization of viscosity, rheology and other physical properties. See Exhibit B. Although Cannon's RUBY application is pending and based upon an intent-to-use, it appears that Cannon's RUBY products will be used to measure properties of fluids.

In contrast, Applicant is a not-for-profit Catholic health care corporation that operates a medical group, hospital system and other health care facilities in Illinois and Michigan. See Exhibit C. Applicant's application covers "downloadable software for education via augmented reality interaction with durable learning objects on content in the fields of science, technology, art, engineering and math; downloadable educational scouse materials in the field of science,

technology, art, engineering and math" in Class 9 and "printed educational materials in the field of science, technology, art, engineering and math" in Class 16 (as amended). Applicant highlights that it has dropped its Class 41 applications altogether and added Class 16, further distinguishing Applicant's goods from those associated with the goods and services of the Cited Registrations.

Applicant's RUBE-E software is really a mobile application that is intended for children to learn more about science, technology, art, engineering and math. See Exhibit D. Applicant provides none of the services covered by the Cited Registration or the Cited Application, and Applicant's RUBE-E software does not have anything to do with the financial services sector, nor does it relate in any way to controlling scientific instruments. Therefore, the distinct differences between the underlying goods and services render confusion unlikely.

Although Applicant's mark and the Cited Registration both contain the term "technology" as part of their identification, closer examination reveals that the parties' specified goods and services are sufficiently distinct. The fact that Applicant's mark and the Cited Registrations are used in connection with services in the broad category of technology certainly does not automatically render confusion likely. Additionally, although Applicant's mark and the Cited Application both contain the term "software" as part of their identification, closer examination reveals that the parties' specified software uses are sufficiently distinct as well.

With regard to the Cited Registration, the Examiner attaches Internet evidence to demonstrate "that the same entity commonly provides both the relevant software goods and related training services and markets the goods and services under the same mark." Applicant does not disagree with this proposition. However, in an instance such as this case, where Registrant's services are so clearly focused on the financial services sector and Applicant's

services are so clearly focused on education in the fields of science, technology, art, engineering and math, confusion is highly unlikely. The examples put forth by the Examiner show that the same entity could offer training services and software both related to same subject. For example, Teach Safe provides services and web-based software that help organizations educational and training courses in a variety of areas. Similarly, Texas Educational Solutions provides research-based services and related training to help educators. Registrant's services are clearly focused on financial services and are not educational services in the way that Teach Safe, Texas Educational Solutions or even Applicant's services are. Further, Applicant is not involved in the financial services sector. It is therefore incorrect to conclude that Applicant's software and those services covered by the Cited Registration are identical, or even related, based on the mere fact that both involve technology.

Applicant further notes that the Federal Circuit and TTAB specifically have rejected the analogous premise that all computer goods and services must be considered related simply because the goods and/or services are used in connection with computers. See e.g., Electronic Design & Sales, Inc. v. Electronic Data Systems Corporation, 954 F.2d 713 (Fed. Cir. 1992) (confusion not likely between nearly identical marks for power supplies and computer services); Viacom International, Inc. v. Kermit Komm, et. al., 46 U.S.P.Q.2d 1233 (TTAB 1998) (computer accessories and computer toys and games are not related to computer software for enabling typing with a mouse, by the mere fact that they are all used with computers). See also In Re Intelistaf Healthcare Management, L.P., 2006 TTAB LEXIS 119 (March 29, 2006) (mere presence of the term "debit card" in each description insufficient to draw a conclusion that the services were substantially similar).

Additionally, the goods or services associated with each mark possess material differences. See, e.g., In re Emissive Energy Corporation, 2006 TTAB LEXIS 203, where the TTAB was comparing SLIQUE T2, a registered mark relating to "flashlights," with Applicant's mark T2, for "electric lighting fixtures." The TTAB found that, while flashlights and electronic lighting fixtures were clearly related, they were not identical and the specific goods provided under each mark contained significant differences. See also Perfect Foods, Inc. v. John D. Gullahorn, 2006 TTAB LEXIS 103 (COOL CAT PRODUCTS for "cat collars and cat clothes" not confusingly similar to COOL CAT for "fresh vegetables to be used as a pet treat" even though both products are intended for cats); In re Lac Du Flambeau Band of Lake Superior Chippewa Indians, 2006 TTAB LEXIS 127 (PLAYER PRIVILEGES for "casino services" is not likely to be confused with PLAYER PRIVILEGES for "arranging and planning travel tour packages", despite the fact that tour planning services may relate to casino services).

Moreover, the target markets and channels of trade differ considerably. Paradigm targets its RUBI and Gem Design training services to mortgage brokers, lenders and consumers looking for a mortgage operation solution. Cannon targets its RUBY instruments and software to researchers interested in measuring properties of fluids. In contrast, Applicant targets its RUBE-E software to those interested in downloading a mobile application to learn about science, technology, art, engineering and math. These differences further erode any likelihood of confusion between Applicant's RUBE-E mark and the Cited Marks, because the channels of trade and distribution do not overlap at all.

3. Applicant's Use Predates the Constructive First Use of the Cited Application.

Applicant notes that the Examiner erred in citing the Cited Application as a bar to registration of Applicant's RUBE-E mark because Applicant's first use predates the constructive

first use date of Cannon's RUBY mark. Under 15 U.S. C. §§1507(c) and 1141f(b), "filing any application for registration on the Principal Register . . . constitutes constructive use of the mark. . . . Upon registration, filing affords the applicant nationwide priority over others, except (1) parties who used the mark before the applicant's filing date. . . ." In this case, Cannon filed its application on February 27, 2019. However, Applicant's first use date as noted in its application is July 31, 2018. Therefore, as this date predates Cannon's filing date, Cannon is not entitled to priority.

4. Applicant Has Amended its Recitation of Goods and Services.

Finally, Applicant emphasizes to Examiner that its amended recitation of goods and services includes Class 16. Additionally, Applicant has dropped its Class 41 applications altogether. These changes further distinguish Applicant's goods from those associated with the goods and services of the Cited Registrations.

For these reasons, Applicant respectfully requests that these citations be removed and Applicant's mark be entitled to registration.

2. Identification of Goods

Applicant has considered the Examiner's suggestions and proposes the following identifications:

- ***Class 9:*** Downloadable software for education via augmented reality interaction with durable learning objects on content in the fields of science, technology, art, engineering and math; downloadable educational scouse materials in the field of science, technology, art, engineering and math.
- ***Class 16:*** Printed educational materials in the field of science, technology, art, engineering and math.