


Response to Office Action Issued March 30, 2019

Applicant hereby responds to the Office Action dated March 30, 2019 for the mark GALAXY (Serial No. 88267760) (“Applicant’s Mark”), wherein the Examining Attorney identified Application Serial

No. 88131161 for the mark GALAXY DIGITAL and Design , No. 88131126 for the mark GALAXY DIGITAL, and No. 87768699 for the mark GALAXY INTERNET CAPITAL and Design

 Galaxy Internet Capital

(the “Cited Applications”), as potential blocks to registration of Applicant’s Mark based on a likelihood of confusion under Section 2(d) of the Trademark Act. The Examining Attorney also preliminarily refused registration of Applicant’s Mark based on an alleged likelihood of confusion under Section 2(d) of the Trademark Act with the mark GALAXY in Registration No. 4576146 (the “Cited Registration”) (collectively, the “Cited Marks”).

Applicant respectfully submits that the likelihood of confusion refusal is inappropriate for the following reasons; (i) the parties’ services are sufficiently distinguishable such that consumer confusion among the parties’ respective marks is not likely, (ii) the sophistication of the consumer further reduces the likelihood of confusion; and (iii) Applicant’s Mark creates an overall distinct commercial impression from the Cited Marks such that consumer confusion among the parties’ respective marks is not likely.

Accordingly, and based on the arguments and evidence set forth below, Applicant respectfully requests that the Examining Attorney withdraw the refusal to register Applicant’s Mark and allow the subject application to proceed to publication.

Preliminary Note re Application Serial No. 87768699:

 Galaxy Internet Capital

The prior application for GALAXY INTERNET CAPITAL and Design (Application Serial No. 87768699) should not present an obstacle or potential obstacle to the registration of Applicant’s Mark. The entirety of the Class 36 services were deleted from the subject application *after* the issuance of this office action (March 30, 2019) where the remaining services are limited to “Authenticating works of art; Cloud computing featuring software for use in database management; Computer system design services; Computer technology consultancy; Consultancy in the design

and development of computer hardware; Industrial design; Providing information on computer technology and programming via a web site; Quality control for others; Server hosting; Software as a service (SAAS) services featuring software for accounting” in Class 42. Therefore, there is no relatedness or similarity of the parties’ goods and services and the subject application should be withdrawn as a basis for potential refusal. As such, Applicant has omitted any argument related to Application Serial No. 87768699 in this response but reserves the right to substantively respond accordingly if the Examiner disagrees.

I. A Finding of a Likelihood Of Confusion Between Applicant’s Mark And The Cited Marks Is Improper

A. The Parties’ Respective Services are Distinguishable.

Cited Registration for GALAXY (U.S. Registration No. 4576146):

Here, the services associated with the Cited Registration are neither identical nor overlapping with the services claimed in Applicant’s application. Although the identification of services in the Cited Registration relates to the field of financial services, Registrant’s services offered under the Cited Registration are limited to the field of securities, which are not related nor overlap with Applicant’s claimed offerings. There is no *per se* rule that goods or services sold in the same field or industry are similar or related for purposes of likelihood of confusion. *See, Cooper Industries, Inc. v. Repoparts USA, Inc.*, 218 USPQ 81, 84 (TTAB 1983); *Lloyd’s Food Products, Inc. v. Eli’s, Inc.*, 987 F.2d 766, 25 USPQ2d 2027 (Fed. Cir. 1993) (reversing likelihood of confusion cancellation of LLOYD’S for “barbequed meats” based on LLOYD’S for “restaurant services”).

While the Examining Attorney has presented Internet evidence “that it is common in Applicant’s industry to provide the Applicant’s financial services under the same mark as the Registrant’s financial services” Applicant disagrees that evidence of third party entities offering the same services as Registrant and Applicant under one mark is sufficient to support an argument that Applicant’s services are then so closely related to Registrant’s narrow scope of Class 36 services that a finding of a likelihood of confusion is appropriate. While Applicant understands there may be other providers offering all of these services under one mark, in this case, the Cited Registration is for a narrow scope of services, which is supported by the specimen submitted for the Cited Registration. *See Exhibit A* for Registrant’s specimen filed with

the USPTO. The specimen clearly shows that Registrant offers a unique narrow scope of services consisting of a European bonds trading platform.

The Cited Registration clearly has a restricted description of services and any interpretation otherwise is an erroneous expansion of the scope of protection for this registration that is unsupported by USPTO precedent. The TTAB case, *In re STMicroelectronics NV.*, is instructive here in that the TTAB found no likelihood of confusion between the identical marks, FLEXILOGIC for “computer hardware and software for noise reduction, spatial and strength processing, temporal tracking and gesture recognition of touch input devices” as compared to “computer software design for others”. Ser. No. 77500550 (T.T.A.B. 2010). The TTAB held that there is no *per se* rule that every computer software is related to all computer software design services, just as in this case where there is no *per se* rule that financial offerings are related or overlapping with all other financial related products. *Id.*

Therefore, Registrant should not be afforded the broad scope of protection of services necessary to support this refusal where Applicant is an investment management firm and does not intend to operate a European bond trading platform. Applicant further notes that the Cited Registration may not be in use and, thus, should not be cited as a basis for refusal. The website URL included in the Registrant’s specimen submitted to the USPTO is not active, nor is there any evidence of use of the mark on Registrant’s business website, <https://www.tradingscreen.com/about>. Nevertheless, the services are distinguishable and thus, there is no likelihood of confusion under Trademark Act Section 2(d).

Cited Applications for GALAXY DIGITAL, GALAXY DIGITAL and Design (U.S. Application Nos. 88131161, 88131126):

Here, the services associated with the Cited Applications are neither identical nor overlapping with the services claimed in Applicant’s Application. Although the identification of services in the Cited Applications relate to the field of financial services, the Cited Applicant’s intended offerings are *limited*. As set forth in the Cited Applications, all of ***the services in connection with these marks are in the fields of blockchain and cryptocurrency***, both of which are not included in Applicant’s offerings. See **Exhibit B** for the Cited Applications USPTO records. There is no *per se* rule that goods or services sold in the same field or industry are similar or related for purposes of likelihood of confusion. See, *Cooper Industries, Inc. v. Repoparts USA, Inc.*, 218 USPQ 81, 84 (TTAB 1983); *Lloyd’s Food Products, Inc. v. Eli’s, Inc.*, 987 F.2d 766, 25 USPQ2d 2027 (Fed. Cir. 1993) (reversing likelihood of confusion cancellation of LLOYD’S for “barbequed meats” based on LLOYD’S for “restaurant services”).

Here, the parties services will not intersect. Where services are intended to be used by different groups of prospective purchasers, courts have consistently found no likelihood of confusion, even where the services provided are provided in the same general industry. The case of *Omicron Capital, LLC v. Omicron Capital, LLC*, 443 F. Supp. 2d 382 (S.D.N.Y. 2006) is on point in this instance. In that case, the Court found no likelihood that a commercial lending broker's use of the identical mark OMICRON CAPITAL would result in consumer confusion with the mark OMICRON CAPITAL for a hedge fund manager "since they competed in entirely different markets." *Id.* ***The Court found that such services, although both in the financial industry, were "not in proximity" to each other. Id.***

Similarly, in *Haven Capital Mgmt., Inc. v. Havens Advisors, LLC*, the Court found no likelihood of confusion between the mark HAVEN, used by a company that provided investment advice and managed funds, and the mark HAVENS, used by a company that provided advice and money management services, because the companies were not in competition in that "the services that the parties render to their investors are significantly different." 965 F. Supp. 528, 531 (S.D.N.Y. 1997), *aff'd*, 159 F.3d 1346 (2d Cir. 1998); *See also Beneficial Corp. v. Beneficial Capital Corp.*, 529 F. Supp. 445, 449 (S.D.N.Y. 1982) (no confusion between BENEFICIAL marks used by plaintiff, who advertised and made **small loans to individual consumers**, and defendant, who made **large business loans for business purposes only**; the court found they serviced "entirely different markets").

Here, the Applicant and Cited Applicant's services differ *at least* as much as the services of the parties in the foregoing cases. Certainly if a small lender and a large business lender can coexist on the Register and in the marketplace with similar marks, Applicant's GALAXY services can coexist with the limited scope of the Cited Applicant's blockchain and cryptocurrency services. Therefore, Applicant respectfully submits that due to the differences in the respective services, consumer confusion is not likely.

B. The Parties' Consumers are Sophisticated, thus, Obviating any Likelihood of Confusion.

In establishing the absence of any likelihood of confusion between Applicant's Mark and the Cited Marks, another critical factor to consider is the industry and the nature and characteristics of the parties' respective customers. *See in re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357 (C.C.P.A. 1973). If a buyer is more sophisticated with respect to the purchase of the goods or services at issue, a buyer can be expected to exercise greater care in her purchases. *Homeowners Group, Inc. v. Home Marketing Specialists, Inc.*,

931 F.2d. 1100, 1111 (6th Cir. 1991). When goods or services are provided to sophisticated consumers, confusion is less likely to occur.

Even when the parties use the same mark, if the underlying goods/services are different and sold to sophisticated, discriminating consumers, there is no likelihood of confusion. *See Astra Pharmaceutical Prods. Inc. v. Beckman Instruments, Inc.*, 718 F.2d 1201 (1st Cir. 1983) (ASTRA for an anesthetic preparation no likely to cause confusion with ASTRA for a blood analyzer machine, because goods sold to discriminating medical personnel); *see also Electronic Design & Sales vs. Electronic Data Sys.*, 954 F.2d 713 (Fed. Cir. 1992).

In addition, the likelihood of confusion diminishes where the purchasers are sophisticated because sophisticated consumers may be expected to exercise greater care in choosing the goods or services. *Electronic Design & Sales v. Electronic Data Systems*, 954 F.2d 713, 21 USPQ2d 1388, 1392 (Fed. Cir. 1992) (the Federal Circuit reversed the Board's decision sustaining the opposition even though the goods were in the same field (power supply goods and computer services), because the Board failed to give due weight to the sophistication of purchasers factor, but the factors of similarity of marks and relatedness of goods were given excessive weight in the likelihood of confusion analysis).

Here, ***the parties' respective consumers are sophisticated and discriminating purchasers, making important decisions regarding significant investments and financial decisions¹ to engage the services.*** None of the parties' respective services are the type casually purchased by consumers making quick decisions. Instead, consumers would be well versed about the specific need they are looking to fill and would easily discern that Applicant's services are not interchangeable with those services offered under the Cited Marks. Consequently, Consumers would not confuse Applicant's and the Cited Marks' respective services, nor would these services be perceived by consumers as deriving from the same source. Applicant's target purchasers are seeking important and discrete financial services that will be selected only after

¹ The banking industry is unique with respect to trademark issues because of the history of the industry and the highly regulated nature of the industry. It is common to encounter banks and banking services with the same or very similar names when traveling across the United States. As a result, consumers have become very discriminating in selecting banking and financial services and tend to exercise a high degree of care.

The courts have recognized this fact repeatedly. For example, the Tenth Circuit found no likelihood of confusion between FirstBank and First Bank System where the banks used different logos. *First Savings Bank. F.S.B. v. First Bank System*, 101 F.3d 645 (10th Cir. 1996). In another case, the Fifth Circuit found no likelihood of confusion between Sun Federal Savings and SunBanks. *Sun Banks of Fla., Inc. v. Sun Fed. Sav. & Loan*, 651 F.2d 311 (5th Cir. 1981). In another case, the Eighth Circuit found no likelihood of confusion between First National Bank of Sioux Falls and First National Bank South Dakota, even though Sioux Falls is a city in South Dakota. *First National Bank in Sioux Falls v. First National Bank. South Dakota*, 47 USPQ 2d 1847 (8th Cir. 1998).

considerable care, deliberation and thorough investigation by the purchaser to ensure that they appropriately protect their financial interests. Consequently, confusion between the parties' respective services is not likely to occur among such discriminating and careful consumers.

Therefore, Applicant respectfully submits that because the parties' services in the financial space are clearly distinguishable, and are purchased by sophisticated consumers who are able to discern the difference between the services and the sources of the services, confusion is not likely between Applicant's Mark and the Cited Marks.

C. Applicant's Mark Creates a Distinguishable Commercial Impression from the Cited Applications for GALAXY DIGITAL, GALAXY DIGITAL and Design (U.S. Application Nos. 88131161, 88131126) such that Confusion is Not Likely.

Under the Lanham Act, a refusal to register grounded in a likelihood of confusion requires that such confusion as to the source of the goods or services is 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.*, 222 U.S.P.Q. 367 (T.T.A.B. 1983). Moreover, mere similarity or even identity between two marks can never alone be decisive of likelihood of confusion. In this case, the differences in the marks themselves unquestionably lead to a finding of no likelihood of confusion. In *Jacobs v. Int'l Multifoods Corp.*, the Court stated that "[t]o establish likelihood of confusion a party must show something more than that similar or even identical marks are used..." 212 U.S.P.Q. 641, 642 (C.C.P.A. 1982) (emphasis added) (footnote omitted). *See also Merritt Foods Co. v. Americana Submarine*, 209 U.S.P.Q. 591, 599 (T.T.A.B. 1980). When comparing the marks, "[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." *Recot, Inc. v. M.C. Becton*, 214 F.3d 1322, 1329, 54 USPQ2d 1894, 1899 (Fed. Cir. 2000).

In analyzing the similarity of the marks, it is not proper to dissect the marks of the parties and to discard or ignore all non-similar elements. ***Rather, in conducting an ex parte examination, the examining attorney must assess the similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression.*** Additions to marks, or the absence of elements in marks, may be sufficient to avoid a likelihood of confusion if the marks in their entirety convey significantly different commercial impressions. TMEP 1207.01(b)(iii). Applicant's mark, GALAXY, is visually, phonetically, and conceptually different from the Cited Marks such that the application of the "appearance,

sound, and connotation” analysis makes clear that Applicant’s Mark and the Cited Marks are not likely to be confused by consumers.

First, the parties’ marks are visually distinct from one another. The Cited Marks are composite marks each materially longer than Applicant’s Mark, consisting of thirteen letters as compared to six, and two words as compared to one. *See, e.g., In re Daedalus Media LLC*, 2006 WL 2558015, *4 (T.T.A.B. August 10, 2006) (ATMOSPHERE ENTERTAINMENT MM found not to be confusingly similar to ATMOSPHERES); *In re Taylor Brands, LLC*, 2007 WL 4616263, *2 (T.T.A.B. December 17, 2007) (OLD TIME found not to be confusingly similar to OLDTIMERS’ HOCKEY CHALLENGE (plus design)). Further, unlike the Cited Marks, Applicant’s Mark is a unitary term not broken apart by spacing, which immediately imparts a distinguishable visual impression to consumers. The Cited Marks incorporate additional and different lettering at the end of each mark, the term DIGITAL.

Further, the Cited Mark GALAXY DIGITAL and Design contains stylized lettering and a distinctive design element which creates a different commercial impression from Applicant’s Mark where there is no stylization or design elements. It is well-settled that for purposes of a likelihood of confusion analysis marks “must be compared in their entirety...It follows from that principle that likelihood of confusion cannot be predicated on the dissection of a mark, that is, on only part of a mark.” *In re Nat’l Data Corp.*, 753 F.2d 1056, 1058, 224 USPQ 749, 750-51 (Fed Cir. 1985); *see also* TMEP 1207.01(b)(i). Because of these visual differences, Applicant’s Mark creates a different overall appearance and visual structure from the Cited Mark. Consumers encountering these marks in the marketplace are likely to view and perceive the marks as different and, thus, avoid any consumer confusion as to source.

Second, Application respectfully submits that the Examining Attorney did not give proper weight to the differences in sound between the respective marks. The Cited Marks sound longer because they are comprised of two words and six syllables. In contrast, Applicant’s Mark sounds shorter and is comprised of only one word and three syllables.

It follows that, in addition to the difference in sight and sound, the meanings of the parties’ marks are dissimilar. While the Examiner has dissected the marks such that the term DIGITAL is ignored, that term not only is a key phonetic and visual difference (and half of the Cited Marks), but also conveys an important meaning that speaks directly to the services in the Cited Applications. Indeed, “DIGITAL” (a defined term), signals the specific blockchain and cryptocurrency services proposed in these subject applications, thus, clearly distinguishing the Cited Marks from Applicant’s Mark.

Therefore, Applicant urges the Examining Attorney to consider the impact of the different terms (and other elements such as design), on the parties' marks and evaluate them in their entirety. *Id.* As such, these differences between the marks in appearance, sound and meaning clearly support the conclusion that the Cited Marks and Applicant's Mark create different overall commercial impressions and will not cause consumer confusion.

II. Conclusion

Applicant respectfully submits that a refusal to register Applicant's Mark based on the Cited Marks would be improper. The evidence of record clearly demonstrates that consumer confusion between Applicant's Mark and the Cited Marks is unlikely because (a) the parties' services are sufficiently distinct such that consumer confusion is not likely; (b) the sophistication of the consumer of financial-related offerings such as those at issue here obviates the likelihood of confusion; and (c) Applicant's Mark creates an overall distinct commercial impression from the Cited Marks such that there is no consumer confusion.

Accordingly, Applicant respectfully requests that the Examining Attorney allow Applicant's application be approved for publication.