

Applicant Landon Price seeks registration of the mark **PLUG** for “downloadable computer application software for mobile phones, namely, software for providing a location-based social network to enable contact and social media information sharing of individuals, locations, and venues, which are currently or at one time proximate to the user’s location” (“Applicant’s Mark”). The examining attorney has issued a refusal to register the mark under Section 2(d), 15 U.S.C. §1052(d); see TMEP §§1207.01 et seq., because of likelihood of confusion with a registered trademark and also cited two applications as potential bars under 2(d), as follows:



PLUG.ME.IN (U.S. Reg. No. 5,162,293)

for “Downloadable software in the nature of a mobile application for social networking, communicating, posting and sharing informational updates, uploading pictures, videos, sending and receiving messages via text, video and/or voice, and connecting with other people via their own personal contact ID they can share with others they wish to add to their social network of contacts via and within the app itself for their mobile devices” (“the Plug Me In Mark”); and

PLUGGD (App. Ser. No. 87/167,623)

for “Downloadable mobile communication device software for internet-based

social networking and messaging; downloadable software in the nature of a mobile application operating as a marketplace for music venues and musical artists to interact and connect” (presently in suspension); and

PLUGGED IN (App. Ser. No. 86/705,338)¹

for “computer software for wireless content delivery; wireless communication devices for voice, data or image transmission; wireless routers; wireless transmitters and receivers; wireless adapters used to link computers to a telecommunications network; computer software to organize data in a database, for data warehousing, and use of transactional data and operational data for applications; computer software for creating searchable databases of information and data”.

Applicant respectfully disagrees that it’s mark will cause confusion with the Plug Me In Mark for the reasons discussed herein.

The Goods Are Not Related

"The examining attorney must provide evidence showing that the goods and services are related to support a finding of likelihood of confusion" TMEP § 1207.01(a)(vi). To meet its prima facie burden, the PTO must, at a minimum, set forth "reasonable predicate" for its conclusion, and the Board will look for "substantial evidence" in support of the PTO's prima face case. *In re Pacer*

¹ This application was issued an office action on March 21, 2019 the response deadline for which has passed and therefore it should soon abandon. It happens to be the mark that caused the PLUGGD application to be suspended, so the latter should soon come out of suspension.

Technology, 338 F.3d at 1351-52. The Supreme Court has established that "Substantial evidence is 'more than a mere scintilla' and 'such relevant evidence as a reasonable mind would accept as adequate' to support a conclusion." *Consol. Edison v. NLRB*, 305 U.S. 197, 229 (1938). As the CAFC has stated "We 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, with which the trademark laws deal". *Electronic Design & Sales Inc. v. Electronic Data Systems Corp.*, 954 F.2d 713, 21 USPQ2d 1388, 1391 (Fed. Cir. 1992), citing *Witco Chemical Co. v. Whitfield Chemical Co., Inc.*, 418 F.2d 1403, 1405, 164 USPQ 43, 44-45 (CCPA 1969), aff'g 153 USPQ 412 (TTAB 1967).

The examining attorney stated the following as the sole basis for finding that Applicant's software is related to the Plug Me In software:

Applicant and registrant are both offering downloadable mobile software for social networking. That applicant's is more specifically tied to a user's location is not relevant, as this narrower language would still be included in registrant's broader explanation of their networking software, as a type of informational update and for "connecting with other people." See, e.g., *In re i.am.symbolic, llc*, 127 USPQ2d 1627, 1629 (TTAB 2018) (citing *Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp., Inc.*, 648 F.2d 1335, 1336, 209 USPQ 986, 988 (C.C.P.A. 1981); *Inter IKEA Sys. B.V. v. Akea, LLC*, 110 USPQ2d 1734, 1745 (TTAB 2014); *Baseball Am. Inc. v. Powerplay Sports Ltd.*, 71 USPQ2d 1844, 1847 n.9 (TTAB 2004)). Applicant's goods and registrant's goods would be sought in commerce for the same purpose – social networking with their friends on the platform/software – and thus be likely to be encountered by the same consumers under identical circumstances, making confusion highly likely.

Respectfully, this is an insufficient basis to find the goods to be related because it is overgeneralized (stating that they are both downloadable software for social networking) and fails to take into account all of the limiting wording in the identifications of the software in both Applicant's and registrant's marks. Applicant's software, as it is clearly described in its application, enables its users to gain an understanding of the people physically located around them (using geo location technology) in order to allow them to exchange personal social and business information. The location-specific focus of the app makes it distinctly different from a typical social media app. The Plug Me In software description is specifically limited to social media software for *connecting with other people via their own personal contact ID they can share with others they wish to add*. It is thus a very private version of a social media app where a user must expressly and optionally permit another person to connect by first sharing a personal ID. Thus, these software products are used for very different purposes and for that reason, they are not related goods. See *M2 Software, Inc. v. M2 Commcns, Inc.*, 450 F.3d 1378, 1383, 78 USPQ2d 1944, 1947-48 (Fed. Cir. 2006) (noting that relatedness between software-related goods may not be presumed and that, instead, a subject-matter-based mode of analysis is appropriate); *In re Iolo Techs. LLC*, 95 USPQ2d 1498, 1500 (TTAB 2010) (noting that there is no rule that all computer-related goods and services are related); and *Information Resources Inc. v. X*Press Information Svcs.*, 6 USPQ2d 1034, 1038 (TTAB 1988) ([T]here is no per se rule mandating that likelihood of confusion is to be found in all cases where the goods or services in question involve computer software and/or hardware).

The Marks Are Not Similar

Similarity of trademarks is based on a comparison of their sight, sound, meaning, and overall commercial impression. Each “likelihood of confusion” determination must be reached based upon the relevant facts from the record, including the nature and impact of the marks as well as the marketing environment in which a purchaser normally encounters them. In order to determine whether there is a likelihood of confusion between two marks, they must be viewed in their entireties. *Opryland USA v. Great Am. Music Show*, 970 F.2d 847, 851, 23 U.S.P.Q.2d 1471, 1473 (Fed. Cir. 1992) (“Although it is often helpful to the decision maker to analyze marks by separating them into their component words or design elements in order to ascertain which aspects are more or less dominant, such analysis must not contravene law and reason. When it is the entirety of the marks that is perceived by the public, it is the entirety of the marks that must be compared”). Because marks must be considered as the public views them – namely in their entireties – “likelihood of confusion cannot be predicated on dissection of a mark, that is, on only part of a mark.” *In re Nat’l Data Corp.*, 753 F.2d 1056, 1058, 224 U.S.P.Q. 749, 751 (Fed. Cir. 1985). It is respectfully submitted that the examining attorney improperly dissected the Plug Me In Mark, in order to find it to be similar to Applicant’s Mark. *In re Hearst Corp.*, 25 U.S.P.Q.2d 1238, 1239 (Fed. Cir. 1992) (holding that term “girl” in the mark VARGAS GIRL could not be ignored while examining the mark against another mark VARGAS). “Likelihood of confusion cannot be predicated on dissection of a mark, that is, on only part of a mark.” *In re National Data Corp.* at 1058. Thus,

this rule, deemed the Anti-Dissection Rule, reinforces the idea that marks are to be compared as the consumer perceives them in the marketplace.

“Plug Me In” is a unitary phrase that has a well understood meaning. This meaning is absent in the single word PLUG. The use of the stops (PLUG.ME.IN) and the design feature in the mark gives it additional distinctive qualities that differentiates it from Applicant’s Mark, PLUG. the TTAB and courts have found no likelihood of confusion in numerous cases where one mark is comprised of another mark and an additional term, *even for marks involving identical or similar goods and services*. See, *In re Mike Tonche* Serial No. 77730883 (TTAB June 24, 2011) (addressing the marks STREETLIGHT CLOTHING and STREETLIGHTS, both in Class 25, the Board stated: “*when it comes to the connotations of the marks, there is a significant difference*”); *Time, Inc. v. Petersen Pub. Co. L.L.C.*, 173 F.3d 113, 50 U.S.P.Q. 2d 1782 (T.T.A.B. 2002) (no likelihood of confusion between TEEN and TEEN PEOPLE, both for magazines aimed at teenagers); *Jet, Inc. v. Sewage Aeration Systems*, 165 F.3d 419, 49 U.S.P.Q. 2d 1355 (6th Cir. 1999) (no likelihood of confusion between JET and AEROB-A-JET, both for sewage and waste water treatment systems for homes); *Mr. Hero Sandwich Systems, Inc. v. Roman Meal Co.*, 781 F.2d 884, 228 U.S.P.Q. 364 (Fed. Cir. 1986) (no likelihood of confusion between ROMAN and ROMANBURGER, both for food products); *Plus Products v. General Mills, Inc.*, 188 U.S.P.Q. 520 (T.T.A.B. 1975) (no likelihood of confusion between PLUS for food supplements for breads, rolls, and buns and PROTEIN PLUS for cereal); *In re Ferrero*, 479 F.2d 1395, 178 U.S.P.Q. 167 (C.C.P.A. 1973) (no likelihood of confusion between TIC TAC and TIC TAC TOE, both for

junk food); *Lever Bros. Co. v. Barcolene Co.*, 463 F.2d 1107, 174 U.S.P.Q. 392 (C.C.P.A. 1972) (no likelihood of confusion between ALL and ALL CLEAR, both for household cleaning products); and *Colgate- Palmolive Co. v. Carter-Wallace, Inc.*, 432 F.2d 1400, 167 U.S.P.Q. 529 (C.C.P.A. 1970) (no likelihood of confusion between PEAK and PEAK PERIOD, both for personal care products).

For the reasons stated herein, applicant respectfully requests that the examining attorney withdraw the refusal to register under Section 2(d).