

## ARGUMENTS FOR RESPONSE TO OFFICE ACTION

### Likelihood of Confusion Under Trademark Act Section 2(d)

#### I. Introduction

In its May 8, 2019 Office Action (the “Office Action”), the U.S. Patent and Trademark Office (“USPTO”) refused registration of the mark PRISMA (“Applicant’s Mark”) on the ground that it creates a likelihood of confusion under Section 2(d) of the Lanham Act, citing Registration Nos. 4462888 and 4955214 for the mark PRISM (the “Cited Marks”), owned by Richard P. Grassie and Lane T Hauck, respectively (the “Registrants”). Further review of the relevant *DuPont* factors shows that, in fact, there is no likelihood of confusion between Applicant’s Mark and the Cited Marks. In particular, consideration of: 1) the dissimilar commercial impressions created by the marks; 2) the dissimilar nature of the respective goods and services offered under the marks; 3) the dissimilar nature of the established, likely-to-continue trade channels; 4) the sophistication of consumers; and 5) the lack of fame of the Cited Marks, strongly suggests that there is no realistic potential for confusion. *Application of E.I. DuPont DeNemours & Co.*, 476 F.2d 1357 (C.C.P.A. 1973).

#### 1. Dissimilar Marks

The Examining Attorney states that “applicant’s mark PRISMA is highly similar to the registrants’ marks PRISM where the applicant’s applied-for mark is the entirety of registrants’ marks with the addition of an “A” to the end of the term.” Applicant respectfully disagrees. Applicant did not simply add an alphabet letter – Applicant’s mark is a different word altogether and creates an entirely different commercial impression. Not only do Applicant’s Mark and the Cited Marks have dissimilar spellings and pronunciations (/’prizəm/ versus /’priz.ma/), the word “prism” has a

dictionary definition of a geometric figure, whereas Applicant's Mark is an arbitrary term that conveys no such connotation and does not have an English dictionary meaning. Insofar as the Examining Attorney references the Spanish translation of Applicant's Mark, Applicant finds such translation irrelevant, as there is no evidence suggesting that a typical, reasonable purchaser would view Applicant's Mark as a direct translation to the term "prism." *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772*, 396 F.3d 1369, 1376-77 (Fed. Cir. 2005) ("When it is unlikely that an American buyer will translate the foreign mark and will take it as it is, then the doctrine of foreign equivalents will not be applied. . . . Although words from modern languages are generally translated into English, the doctrine of foreign equivalents is not an absolute rule and should be viewed merely as a guideline.").

Notably, the USPTO has already determined that "prism" formative marks can co-exist on the Register in the general computer software and hardware field without confusion, including the following:

1. PRISMA, registered (2008) by Océ-Technologies B.V. for "[s]oftware for document processing" (Registration No. 3381785);
2. PRISMA, registered (2014) by Mediaocean LLC for "[s]oftware as a service (SAAS) services featuring software for digital advertising campaign management for use in the media and advertising industries" (Registration No. 4600456);
3. PRISMA, registered (2002) by Zeppelin Systems USA, Inc. for "[c]omputer software for use in managing recipe production schedules inventory and batch log information for automated bulk handling systems" (Registration No. 2581072);
4. PRISM, registered (2014) by Computer Evidence Specialists, LLC for "providing temporary use of a web-based non-downloadable software application used for conducting investigations by searching, archiving, organizing, analyzing, monitoring, and exporting data for use in cyber investigations . . ." (Registration No. 4955214);
5. PRISM, registered (2017) by Tektronix, Inc. for "hardware and software platform used to monitor and analyze digital video transmitted over a wide range of video networks . . ." (Registration No. 5250375);

6. EPRISM, registered (2012) by Edgewave, Inc. for “[n]on-downloadable computer software, namely, web based data protection software, e-mail data protection software . . . , email spam filters and e-mail encryption software” (Registration No. 4233535);
7. EPRISM, registered (2006) by Health Outcomes Sciences, LLC for “[a]pplication service provider (ASP) featuring software for use in database management, in analyzing data and in projecting risk models that can assist physicians and patients with medical decision-making” (Registration No. 3150755);
8. IPRISM, registered (2001) by Edgewave, Inc. for “computer software for use in controlling and blocking user access to sites on a global computer network based on content” (Registration No. 2488930); and
9. IPRISM, registered (2005) by Curtiss-Wright Flow Control Corp. for “computer software and computer programs for sizing, selecting and evaluating process equipment . . .” (Registration No. 2995879).

The USPTO should apply the same principle here, especially because Applicant’s Mark is a completely different word. If the above cited marks can register and co-exist with the Cited Marks, and with each other, then there is no principled reason that Applicant’s PRISMA mark cannot also be registered and co-exist.


## **2. Dissimilar Goods and Services**

Confusion is not likely just because two somewhat similar (or even identical marks for that matter) are both associated with products or services generally related to computer software. *See, e.g., In re Quadram Corp*, 228 U.S.P.Q. 863 (T.T.A.B. 1985) (“[I]n order to support a holding of likelihood of confusion, there must be some similarity between the goods and services at issue... beyond the fact that each involves the use of computers.”); *see also Reynolds & Reynolds Co. v. I.E. Systems, Inc.*, 5 U.S.P.Q.2d 1749, 1752 (T.T.A.B. 1987) (finding no likelihood of confusion between identical marks used on different kinds of software). For example, in the TTAB decision, *In re Docuview*, Case No. 76348236 (T.T.A.B. June 9, 2004), the TTAB found that two different entities could each register an identical DOCUVIEW mark for software offerings because the parties’

respective software was sufficiently unrelated to avoid confusion between the DOCUVIEW marks. The panel overruled the examiner's refusal based on Section 2(d), disagreeing with the examiner's determination that applicant's DOCUVIEW offerings for "medical system software for controlling and operation of medical systems" were related to the offerings claimed in the cited DOCUVIEW registration for "computer programs for document management and production." *Id.* While the examining attorney argued that both types of software encompassed software related to "documents" in the broadest sense of the word, and were thus related, the panel found that the parties operated in different industries and that applicant's software related to medical systems was "sufficiently limited in terms of function" to avoid any confusion. *Id.*

Here, the Examining Attorney assumes that the goods and services in question are related because the Cited Marks cover goods and services in the general field of computers. This cursory conclusion fails to capture the fundamental differences between the parties' respective goods and services. Specifically, Registration No. 4462888 covers "computer and information security consulting to address physical, computer, and information security" and is in actual use for consulting services for physical security. This is highlighted by the registrant's own specimen submitted on October 21, 2013, showing that the mark is used in connection with "physical and logical security consulting" services. *See* Exhibit A. Registration No. 4955214 covers "computer hardware and computer peripheral devices" and is in use for computer circuit boards, which is also evidenced by the registrant's specimen submitted on August 19, 2015. *See* Exhibit B. These goods and services have little, if anything, to do with Applicant's goods and services under the PRISMA mark, which, as indicated in the identification of goods and recitation of services, relate specifically to cloud-based cybersecurity and network security services. This is consistent with the USPTO's practice of allowing similar marks to register for, on the one hand, computer consulting services,

computer hardware, and computer peripherals, and, on the other hand, network security related goods and services:

Registrations covering computer consulting services, computer hardware, and/or computer peripheral devices	Registrations for network security services
ROOT SERVICES, registered (2014) by Tehmis Information Technologies, Inc. for “ <i>consulting in the field of information technology</i> ” (Reg. No. 4695009).	ROOT LABS, registered (2013) by Root Labs, Inc. for “ <i>network security</i> ” (Reg. No. 4295473).
 , registered (2014) by ARTIS Professionals, LLC for “ <i>computer software consulting</i> ” (Reg. No. 4627806).	ARTIS, registered (2015) by Artis Research & Risk Modeling Corporation for “ <i>monitoring of computer systems for security purposes.</i> ”
SMART DATA DELIVERED, registered (2015) by Numerex Corp. for “ <i>computer software consultation</i> ” (Reg. No. 4680617).	SMART DATA INTEGRATION, registered (2016) by Cambridge Semantics Inc. for “ <i>computer software for the creation of firewalls</i> ” (Reg. No. 4917664).
VICTORY, registered (2019) by TMED INC. for “ <i>computers</i> ” (Reg. No. 5748042).	VICTORY, registered (2019) by Victory CTO LLC for “ <i>design and development of electronic data security systems</i> ” (Reg. No. 5693132).
QUICK CONNERT, registered (2003) by Jo-Dan International, Inc. for “ <i>computer cables</i> ” (Reg. No. 2768440).	QUICK CONNECT, registered (2010) by QC Inc for “ <i>design and development of networks</i> ” (Reg. No. 3753696).
ELEMENT, registered (2018) by Element Brand holding, LLC for “ <i>computers</i> ” (Reg. No. 5434920).	ELEMENT, registered (2016) by Element Inc. for “ <i>software for ensuring the security of electronic communications</i> ” (Reg. No. 5003614).

### 3. Unrelated Trade Channels

Likelihood of confusion is not determined by a side-to-side comparison of marks in the abstract, but by a consideration of the manner in which marks are encountered in the marketplace. TMEP § 1207.1(a)(i). “[T]he test is not that goods and services must be related if used together, but merely that that finding is part of the underlying factual inquiry as to whether the goods and services at issue. . . can be related in the mind of the consuming public as to the origin of the goods.” *Shen Mfg. Co., Inc. v. Ritz Hotel, Ltd.*, 393 F.3d 1238, 1244 (Fed. Cir. 2004).

Here, the trade channels are unrelated. On the one hand, Applicant's goods and services are marketed towards large businesses seeking cybersecurity and network security solutions. On the other hand, the Registrants' goods and services are aimed at professionals looking for "physical and logical security" consultancy services and customers looking to purchase computer circuit boards and peripheral devices. The target purchasers are thus dissimilar from each other.

#### **4. Sophisticated Customers**

The products and services offered respectively by the parties are purchased by sophisticated customers, mitigating against any likelihood of confusion. Significantly, the potential purchasers of Applicant's goods and services are large companies with sensitive and large-scale cybersecurity issues that would exercise great caution in purchasing goods and services to employ and protect their businesses. The potential purchasers of the Registrants' goods and services are sophisticated engineers and IT professionals looking to purchase computer circuit boards or seeking consultancy services for physical security issues. "Where the relevant buyer class is composed only of professionals or commercial buyers familiar with the field, they are usually knowledgeable enough to be less likely to be confused by trademarks that are similar." 4 McCarthy on Trademarks and Unfair Competition § 23:101 (4th ed.). As a result, these purchasers of the parties' respective products and services will not engage in "impulse" purchases but rather practice careful and sophisticated purchasing, calling into doubt any potential likelihood of confusion. *See DuPont*, 476 F.2d at 1361.

#### **5. Cited Marks Are Not Famous**

To the best of Applicant's knowledge, the Cited Marks are not famous and therefore are not entitled to a broader scope of protection. "Famous or strong marks enjoy a wide latitude of legal protection." *Kenner Parker Toys, Inc. v. Rose Art Industries, Inc.*, 22 U.S.P.Q.2d 1894 (Fed. Cir.

1992). For this reason, the fame of a registered mark is a factor to be considered in determining likelihood of confusion. *DuPont*, 476 F.2d at 1361. Nothing in the record suggests that the Cited Marks are famous.

## **II. Conclusion**

Given the reasons above, there is no likelihood of confusion between Applicant's Mark and the Cited Marks. Applicant respectfully requests the Examining Attorney to approve the Application for publication.

### **English Translation Required**

The Examining Attorney has requested Applicant to submit an English translation of Applicant's Mark. This requirement appears to be without basis. Consumers would not perceive Applicant's Mark as a foreign word with an English meaning. This is highlighted by the fact that the USPTO has allowed a number of trademark applications for PRISMA-related marks to register without an English translation requirement. *See* Registration Nos. 4843454, 4783959, 4056179, 4079888, 4342631, 4661082, 5201130, 5113791, 5282669, and 5735179.

# **Exhibit A**



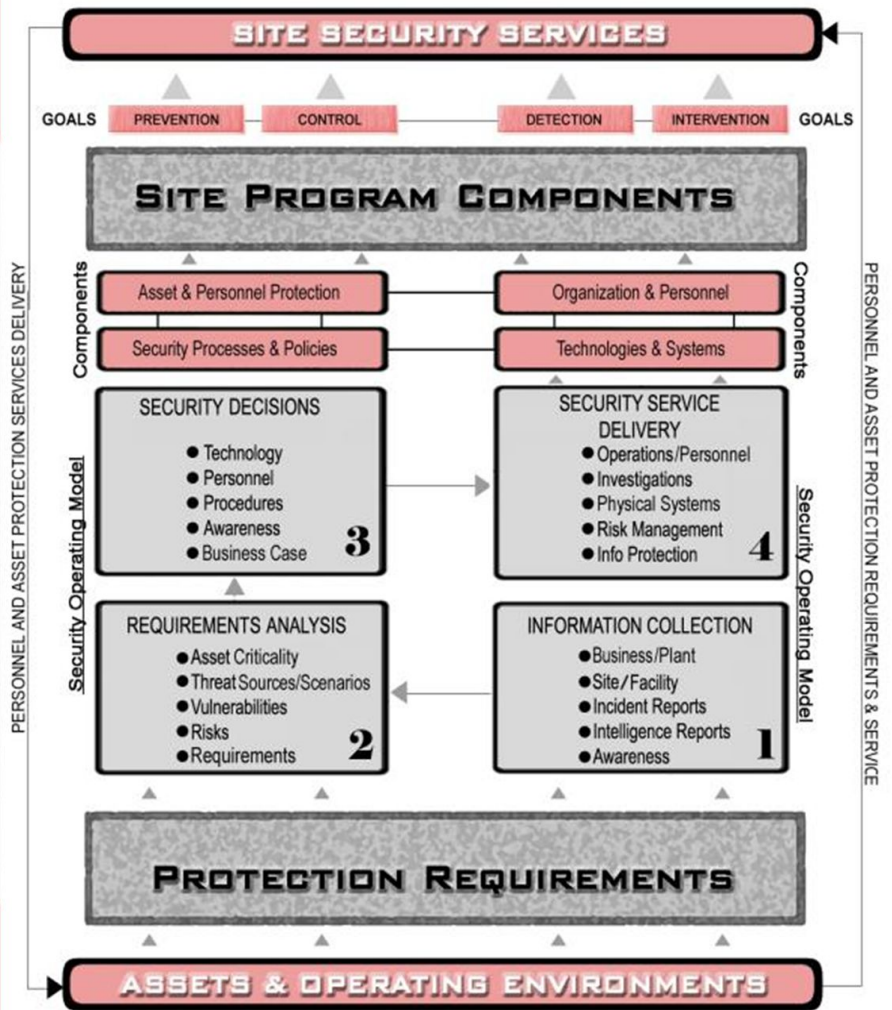
# PRISM

## Four Strategies

- Prevention
- Control
- Detection
- Intervention



### PROACTIVE - INTEGRATED - VALUE BASED

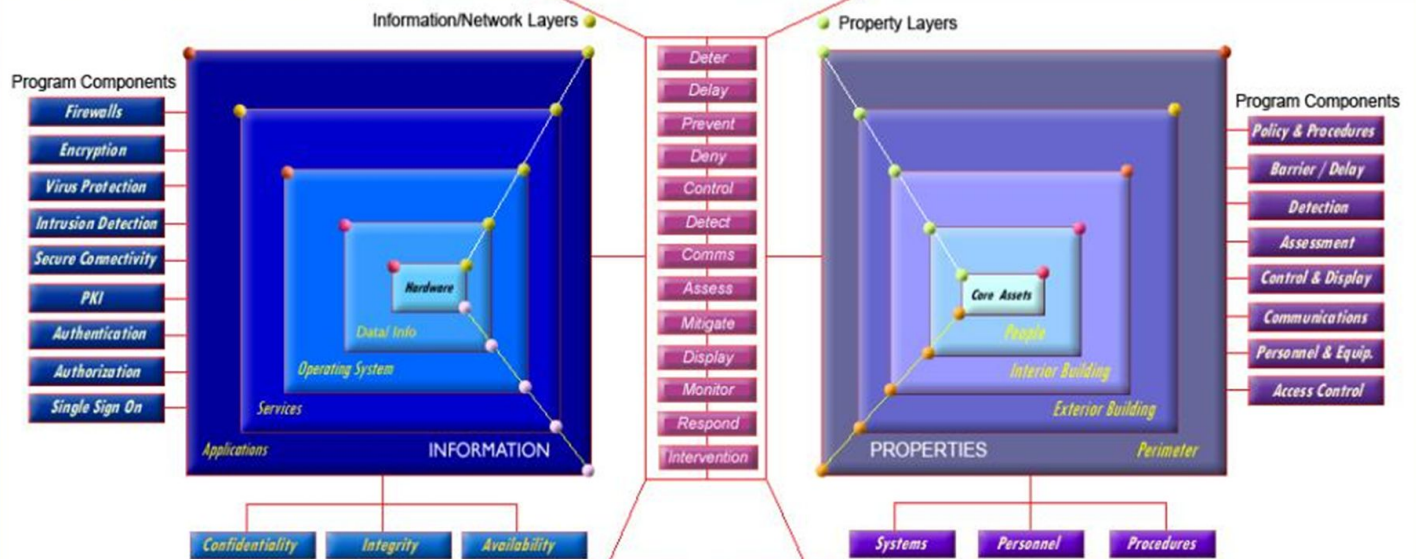


# PRISM MODEL APPROACH

## Physical and Logical Security Consulting

**PREVENT**

**MITIGATE**



- Threats**
- Accidental (man-made unintentional, ie chemical spill)
  - Criminal (man-made intentional)
  - Terrorist/State (man-made intentional)
  - Natural (including climate change, earthquake, etc)

- Risks**
- Injury/Loss
  - Damage
  - Tarnished image
  - Exposure loss
  - Disruption
  - Increased cost
  - Loss of competitive edge

**CONTROL**

**RESPOND**

# **Exhibit B**

