IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE TRADEMARK APPLICATION OF:	Metropolitan Transportation Authority
SERIAL NO.:	88/302127
FILING DATE:	February 14, 2019
MARK:	OMNY (design mark)
CLASS:	INT. 009, 014, 025, 028, 035, 036, 039, 042
EXAMINING ATTY:	Dannean Hetzel Law Office 106

RESPONSE TO OFFICE ACTION

The following is responsive to the Examining Attorney's Office action emailed on May 6, 2019.

I. REGARDING PRIOR PENDING APPLICATION

The trademark Examining Attorney identified a prior pending application which may be the basis for a refusal to register the Applicant's mark under Trademark Act Section 2(d) on grounds that the Applicant's mark, when used on or in connection with the identified goods and services, so resembles the following applied for mark as to be likely to cause confusion, to cause mistake, or to deceive:

OMNY, U.S. App. Ser. No. 87924070, for

- "Videogaming apparatus, hereunder slot machines for gambling, gaming machines, poker machines and other video based casino gaming machines; arcade games; gaming machines, namely, devices that accept a wager; reconfigurable casino and lottery gaming equipment, hereunder gaming machines including computer games and software therefor sold as a unit" in Class 28
  (the "Cited Application")

Without argument or evidence in support, the trademark Examining Attorney argues that the Applicant's mark may be refused registration because of a likelihood of confusion between the two marks in Class 28.

However, all of the following circumstances suggest that consumers will not likely suffer the mistaken belief that the services in the Cited Application and the Applicant's services come from, or are in some way associated with, the same source. The Applicant would request that the Examining Attorney reconsider her determination that there may be a likelihood of confusion between the marks in view of the following. A brief analysis of the following Dupont factors indicates that confusion is improbable with regard to the cited registration:

(1) The similarity or dissimilarity and nature of the goods/services;

(2) The similarity or dissimilarity of established, likely-to-continue trade channels; and

(3) The conditions under which and buyers to whom sales are made, i.e., "impulse" vs. careful, sophisticated purchasing.

See In re E. I. du Pont de Nemours & Co., 177 USPQ 563 (C.C.P.A. 1973). "[A]ny one of the [Dupont] factors may control a particular case.'" In re Dixie Restaurants, Inc., 105 F.3d 1405, 1406-07, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997).

A. THE APPLICANTS' GOODS ARE NOT RELATED AND INVOLVE DISSIMILAR CHANNELS OF TRADE AND CONSUMERS

The Applicant respectfully submits that the Applicant's toy trains, buses, boats and passenger vehicles; stuffed animals; decorations for Christmas trees and other festive events in Class 28 are not similar or otherwise related to the video gaming apparatus and gaming machines of the applicant for the Cited Application noted above (the "Cited Applicant"). "The nature and scope of a party's goods or services must be determined on the basis of the goods or services recited in the application or registration." TMEP § 1207.01(a)(iii).

The Cited Applicant is engaged in the business of video gaming and devices for video gaming. This is very different from being the largest publicly operated transportation agency in North America that happens to sell branded toy and holiday items (e.g., through a gift shop) ancillary to its primary transportation function. The Applicant's Class 28 goods are novelty items geared to the tourist clientele, while the Cited Applicant provides goods and services that are more directed to casinos and online gaming operators.

The goods in the Cited Application and the Applicant's goods are readily distinguishable – a sophisticated casino or online gaming operator is likely to make informed decisions and would not assume that the Applicant is somehow affiliated with a provider of video gaming software and devices. Further, consumers riding the Applicant's subways, buses and commuter rail roads and purchasing gift shop novelty items are not likely to wrongly conclude that the Applicant is affiliated with or sponsored by a gaming developer and operator.

While the video gaming-related apparatus and devices are readily distinguishable from the Applicant's novelty goods, the remaining gaming focused goods and services in the Cited Application are targeted to businesses who desire to build out a casino or online gaming business – this is a different channel of trade than the channel in which the Applicant's novelty goods would be provided. Thus, the sophisticated business consumers who would utilize gaming software, apparatus and services would recognize that the Applicant's goods and services are distinctly different goods than the goods of the Cited Applicant. Similarly, the consumers seeking to buy novelty items related to the Applicant's subways, buses and commuter rail roads would recognize that the Cited Applicant's goods and services are a distinctly different product/service, designed for a distinctly different purpose, and provided by a distinctly different entity. The disparate nature of the Applicant's goods and the goods and services in the Cited Application suggest that confusion as to source within these purchaser classes is highly unlikely.

It is the Applicant's belief that "even if the marks are identical, confusion is not likely" because the goods in connection with which the marks at issue are used "are not related or marketed in such a way that they would be encountered by the same persons in situations that would create the incorrect assumption that they originate from the same source." Trademark Manual of Examining Procedure § 1207.01(a)(i) (citing Coach Servs., Inc. v. Triumph Learning LLC, 668 F.3d 1356, 1371, 101 USPQ2d 1713, 1723 (Fed. Cir. 2012)).

The Applicant respectfully requests that the trademark Examining Attorney reconsider her potential refusal to register the Applicant's mark on grounds of alleged likelihood of confusion with the mark subject to Cited Application and approve the present application for publication accordingly.

II. REGARDING TRADEMARK ACT § 2(d) REFUSAL

The trademark Examining Attorney has refused to register the Applicant's mark under Trademark Act Section 2(d) on grounds that the Applicant's mark, when used on or in connection with the identified services in Class 39, so resembles the following registered mark as to be likely to cause confusion, to cause mistake, or to deceive:

ONMI (US Reg. No. 2106102) for:
arranging travel tours; travel information services; and travel agency services, namely making reservations and bookings for transportation, in class 39.
(the "cited registration")

Noting that the "marks are similar in appearance and meaning because they are comprised of the same first three letters" and that "the marks are identical in sound because they are pronounced the same," the trademark Examining Attorney goes on to argue that the "services are similar in nature in that they are about travel" and that the "services are used together because a consumer would utilize Registrant's travel information to gain knowledge about applicant's transportation services."

However, all of the following circumstances suggest that consumers will not likely suffer the mistaken belief that the Registrant's services and the Applicant's services come from, or are in some way associated with, the same source. The Applicant requests that the Examining Attorney reconsider her determination that there may be a likelihood of confusion between the marks in view of the following. A brief analysis of the following Dupont factors indicates that confusion is improbable with regard to the cited registration:

(1) The similarity or dissimilarity of the marks;

(2) The similarity or dissimilarity and nature of the services; and

(3) The conditions under which and buyers to whom sales are made, i.e., "impulse" vs. careful, sophisticated purchasing.

See In re E. I. du Pont de Nemours & Co., 177 USPQ 563 (C.C.P.A. 1973). "[A]ny one of the [Dupont] factors may control a particular case.'" In re Dixie Restaurants, Inc., 105 F.3d 1405, 1406-07, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997).

A. THE MARKS IMPART A DIFFERENT COMMERCIAL MEANING

"[L]ikelihood of confusion cannot be predicated on dissection of a mark, that is, on only part of a mark." In re Nat'l Data Corp., 224 USPQ 749, 750-51 (Fed. Cir. 1985). "Additions or deletions to marks may be sufficient to avoid a likelihood of confusion if: (1) the marks in their entireties convey significantly different commercial impressions; or (2) the matter common to the marks is not likely to be perceived by purchasers as distinguishing source because it is merely descriptive or diluted." Trademark Manual of Examining Procedure § 1207.01(b)(iii) (citing Citigroup Inc. v. Capital City Bank Group, Inc., 637 F.3d 1344, 1356, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011)).

"Even marks that are identical in sound and/or appearance may create sufficiently different commercial impressions when applied to the respective parties' goods or services so that there is no likelihood of confusion." Trademark Manual of Examining Procedure § 1207.01(b)(v) (citing In re Sears, Roebuck & Co., 2 USPQ2d 1312, 1314 (TTAB 1987)). In the present case, the Applicant's mark and the cited registration both contain the letters "OMN" and would presumably be pronounced the same. However, the Registrant's mark is a word that has a meaning and the Applicant's mark is a coined term that is an acronym. The Registrant's mark is OMNI – this is a word or prefix that is understood in the English

language to mean "all." See Exhibit 1, Definitions of "omni." This conveys the commercial impression that the Registrant's services can assist you in going to all places or that the Registrant is the one stop for all of your travel planning needs. By contrast, the Applicant's mark is OMNY, which is an acronym for ONE METRO NEW YORK – the Applicant operates the public transportation system for the New York City metropolitan area, and the "NY" in the Applicant's mark thus conveys the commercial impression that Applicant's transportation services are connected to New York.

As such, consumers would not look at the Applicant's OMNY mark and mistakenly believe that the Applicant or its public transportation system were somehow affiliated with or otherwise connected to the Registrant's OMNI travel planning services.

B. THE SERVICES ARE DISSIMILAR

Applicant respectfully submits that Applicant's public transportation services and information related thereto are not similar or otherwise related to the travel planning services and information provided by the Registrant. "The nature and scope of a party's goods or services must be determined on the basis of the goods or services recited in the application or registration." TMEP § 1207.01(a)(iii).

Viewing the Registrant's "travel information services" in the context of the other services claimed in the cited registration, it is clear that the Registrant's services in the subject registration are focused in the area of providing travel planning and booking to consumers. By taking the "travel information" portion of the Registrant's services out of context and in a vacuum, the Examining Attorney has imparted a broader scope to the Registrant's services than what consumers and members of the relevant industry would understand the Registrant's services to be.

The Applicant's services are:

> Providing travel information to travelers regarding fares, timetables, train status, and public transport; Public transportation services by means of passenger vehicle, bus, light rail, heavy rail, rapid transit, commuter railroad and boat, in class 39."

Unlike the Registrant's travel planning services where the Registrant will plan and book a trip for a customer so that a customer can go anywhere in the world using any available means of transportation, the Applicant's travel information is directly related to the Applicant's provision of transportation services to its customers – a user can get information from the Applicant so that the user can plan personalized transportation within the New York City metropolitan area using the Applicant's transportation services. This is very different from the travel planning services provided by the Registrant. For this reason, consumers are not likely to be confused that the Registrant is the source of or is otherwise affiliated with the Applicant's services under any circumstances.

C. THE CONDITIONS UNDER WHICH PURCHASES ARE MADE INVOLVE INFORMED DECISIONS

The Registrant's services and the Applicant's services are readily distinguishable and there would be no significant commonalities between the circumstances under which consumers would choose to use the Applicant's services versus the services of the Registrant. Further, consumers seeking the Registrant's services are likely to make informed decisions.

As noted above, the Registrant's travel planning services are targeted to people who want to plan their travel for a trip anywhere in the world. Unlike the Registrant's services, the Applicant's services are directed to people who are planning to use the New York City metropolitan area public transportation system. Consumers do not go to a travel agent for the purpose of booking metropolitan area travel on public

subways, buses and commuter railroads, Thus, the consumers who would utilize the Registrant’s services would recognize that the Applicant's public transportation services are a distinctly different service, designed for a distinctly different purpose, and provided by a distinctly different entity. Similarly, the consumers seeking to utilize the Applicant's services would recognize that the Registrant's travel planning services are a distinctly different service, designed for a distinctly different purpose, and provided by a distinctly different entity. The disparate nature of the Applicant’s services and the Registrant’s services suggest that confusion as to source amongst consumers is unlikely.

It is the Applicant's belief that “even if the marks are identical, confusion is not likely” because the services in connection with which the marks at issue are used “are not related or marketed in such a way that they would be encountered by the same persons in situations that would create the incorrect assumption that they originate from the same source.” Trademark Manual of Examining Procedure § 1207.01(a)(i) (citing Coach Servs., Inc. v. Triumph Learning LLC, 668 F.3d 1356, 1371, 101 USPQ2d 1713, 1723 (Fed. Cir. 2012)).

The Applicant respectfully requests that the trademark Examining Attorney withdraw her refusal to register the Applicant's mark on grounds of alleged likelihood of confusion with the mark subject to cited Registration No. 2106102 accordingly.

III. AMENDMENT OF SERVICES IDENTIFICATION

It is the Applicant’s belief that a more narrow, specific goods identification for Class 25 is needed. Further, the Examining Attorney has required amendment of the Class 9, 28 and 36 IDs. Accordingly, the Applicant provides the following amended identification and classification of goods and services, adding classes where applicable:

Class 09: General purpose reloadable prepaid magnetic cards, **prepaid magnetic contact and contactless cards** for ~~transit~~ **transportation** fare services; prepaid magnetic cards, **prepaid magnetic contact and contactless cards for transportation** ~~**transit**~~ **fare services**; **embedded** software for ~~processing~~ **authenticating** electronic payments;-multi-functional electronic payment computer terminals and computer kiosks; **downloadable** mobile application software for use in electronic payments and transactions for **transportation** ~~transit~~ fare services

Class 16: **Non-magnetically encoded prepaid and reloadable purchase cards for** transportation **fare services; Non-magnetically encoded contact and contactless cards for** transportation **fare services**

Class 25: Clothing, namely, tee-shirts, sweatshirts, tank tops, caps, socks, ties, pants, shorts, skirts, jackets and underwear**, all of the foregoing goods to be used solely as a designator of source of or to promote (i) transportation services, (ii) payment processing services and contactless payment systems, and/or (iii) public services, programs and/or initiatives offered or conducted by government entities**.

Class 28: toy trains; **toy** vehicles; **toy** buses; **toy** boats and **toy** passenger vehicles; **toy** stuffed animals; decorations for Christmas trees

Class 36: Payment processing services, namely, processing electronic payments made through prepaid cards and contact and contactless payment media; issuing prepaid **debit** cards and **prepaid magnetic and non-magnetic contact and contactless cards for transit fare payment services**; Providing a website **featuring fare product purchase services, debt recovery services and bill payment services** for reloadable pre-paid and contact and contactless payment media services;

Payment processing services in the field of transportation services payments; Processing of contactless credit and debit card payments; Processing of credit card payments via near field communication (NFC) technology-enabled devices; Pre-paid purchase card services, namely, processing electronic payments made through prepaid cards; Pre-paid purchase card and contact and contactless payment media services, namely, processing electronic payments through pre-paid cards and contact and contactless payment media; Providing an internet website portal in the field of financial transaction and payment processing services; Stored value prepaid card and contact and contactless payment media services, namely, processing electronic payments made through prepaid cards and contact and contactless payment media

IV. CONCLUSION

In accordance with the foregoing submissions, the Applicant believes that the referenced application is in a condition for approval for publication and respectfully requests that the Examining Attorney approve the application for publication at this time. Should the Examining Attorney believe that a telephone conference will expedite publication of the referenced application, the Examining Attorney is invited to call the undersigned counsel for the Applicant at her convenience.

Respectfully submitted,

METROPOLITAN TRANSPORTATION AUTHORITY

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