

**UNITED STATES DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE**

In Re the Application of:)	
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Applicant: Solve HQ, Inc.)	
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Mark: SOLVE)	
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Serial No.: 88307782)	Trademark Law Office: 126
)	
Class: 9)	Examiner: Carl A. Korschak, Esq.
)	
Filed: February 19, 2019)	
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RESPONSE TO OFFICE ACTION

On May 3, 2019, the Examining Attorney refused registration for SOLVE, in connection with “Downloadable computer game software via a global computer network and wireless devices; Downloadable computer software applications via a global computer network and wireless devices featuring videos and films in the fields of drama, live action, and comedy entertainment; Computer software, namely, computer software for streaming audio-visual media content via the Internet to mobile digital electronic devices and to downloadable players for viewing audio-visual media content in the fields of drama, live action, and comedy entertainment,” in Class 9, on the grounds that it is likely to cause confusion with four pre-existing registrations:

- Reg. No. 3513787 for SOLV in connection with “computer software for managing and scheduling appointments; computer software for providing users with reminders about appointments; computer software for allowing users to check in for appointments; computer software for verifying insurance eligibility status; computer software for allowing users to create, view and update medical profiles; computer software for allowing users to communicate regarding medical care and medical advice”

- Reg. No. 4722879 and 4722881 for ISOLVE and ISOLVE (& Design), respectively, in connection with “computer software for use in connection with the management and monitoring of the operations of business in the produce industry relating to inventories, sales, grower accounting, quality control, crop costs, traceability of orders and shipments, general accounting, receivables, payables, relationships with banks and lenders and the production of financial reports” in Class 9
- Reg. No. 5710645 for ESOLVE in connection with “computer software for a web-based crisis investigation, major case, and serious crime management software program” in Class 9.

The Examining Attorney also identified the following prior-filed applications:

- Ser. No. 88292152 for SOLV= and Ser. No. 88292148 for SOLVE, both in connection with “Downloadable computer software to automate data warehousing; Downloadable software for use in managing data infrastructure and security of data access; Downloadable software for enabling access to and collaboration on business data and managing data security and performance; Downloadable software for configuring and maintaining data in multi-cloud or on-premise environments for businesses; Downloadable software for data analytics and software development” in Class 9
- Ser. No. 88169270 for SOLVE in connection with “Software as a service (SAAS) services featuring software for use by others to generate life insurance quotations; Providing a website featuring on-line non-downloadable software that enables users to expedite and facilitate the marketing, selling and processing of insurance and financial products for the insurance industry” in Class 42

- Ser. No. 88154865 for PICSOLVE in connection with (as amended September 23, 2019) “Apparatus for recording, transmission or reproduction of sound or images; blank magnetic data carriers, recording discs and memory cards; compact discs, DVDs and other digital recording media in the nature of USB flash drives and memory cards featuring pre-recorded content in the nature of photographs and videos; mechanisms for coin-operated apparatus; cash registers, calculating machines, data processing equipment, computers; downloadable computer software for creating, transmitting, modifying and displaying images and videos; photography equipment, namely, cameras, video cameras, memory cards, lenses for cameras, lights in the nature of electrical lights for use in professional quality photography, camera stands and mounting devices, tripods and portable light reflectors; video apparatus, namely, cameras, video cameras, memory cards, lenses for cameras, lights for use on video cameras, camera stands and mounting devices for monitors, tripods and microphones; exposed film, namely, exposed camera film, exposed slide film, exposed photographic film and exposed cinematographic film; photographic developing apparatus and instruments, namely, photography dark room lamps and photography drying racks; downloadable computer software for creating, transmitting, modifying and displaying images and videos; downloadable computer software for the collection, editing, organizing, modifying, transmission, storage and sharing of data and information; downloadable computer software for use as an application programming interface (API) for creating, transmitting, modifying and displaying images and videos; downloadable computer software and hardware for creating, transmitting, modifying and displaying images and videos; downloadable computer software that allows users

to view and purchase photographs and videos and share such photographs and videos via the Internet; downloadable digital images, namely, images and videos of people, places, pets, social, cultural and sporting events; recorded data storage media, namely, CDs, DVDs and USB flash drives featuring recorded images and videos of people, places, pets, social, cultural and sporting events; downloadable electronic publications in the nature of images and videos of people, places, pets, social, cultural and sporting events; cases especially made for photographic apparatus and instruments, namely, camera cases, lighting cases and tripod cases; cinematographic cameras; cinematographic film, exposed; close-up lenses; computer memory devices; computer programs, recorded for the collection, editing, organising, modifying, transmission, storage and sharing of data and information; downloadable computer programs for the collection, editing, organising, modifying, transmission, storage and sharing of data and information; computer software applications, downloadable for mobile phones, portable media players and handheld computers namely, for the collection, editing, organising, modifying, transmission, storage and sharing of data and information; downloadable computer game software; computer software platforms, recorded or downloadable for the collection, editing, organising, modifying, transmission, storage and sharing of data and information; computer screen saver software, recorded or downloadable; data processing apparatus; downloadable image files containing images of people, places, pets, social, cultural and sporting events; downloadable music files; downloadable graphics for mobile phones; apparatus for editing cinematographic film and photographs, namely, editing machines for films and photographs; downloadable electronic publications in the nature of photo books of

people, places, pets, social, cultural and sporting events; enlarging apparatus for photography namely, photography projectors, green screens being projection screens, grey screens being projection screens and experience walls being projection screens; film cutting apparatus, namely, film splicers and downloadable digital photography editing software; filters for photography, namely, photographic filters, digital overlays specially adapted for touchscreen display; flash-bulbs for photography; flashlights for photography; frames for photographic transparencies; projection screens for photograph and video projection; remote control apparatus, namely, remote controls for projectors, green screens, grey screens and experience walls; screens for photography, namely, green screens being Projection screens, grey screens being Projection screens and experience walls being Projection screens; screens for photoengraving, namely, projection screens for photoengraving; selfie sticks being hand-held monopods for cameras and video cameras; selfie lenses, namely, lenses for cameras; shutter releases for photography; mobile phones; sound transmitting apparatus; sound recording apparatus; sound reproduction apparatus; stands for photographic apparatus; television apparatus, namely, televisions; thermal imaging cameras; video recorders; viewfinders, photographic; sunglasses, eyeglasses; smart glasses; optical apparatus, namely, optical character recognition apparatus; parts and fittings relating to the aforesaid goods” in Class 9

- Ser. No. 88111074 for SOLVE in connection with “Providing temporary use of on-line non-downloadable cloud computing software used to monitor, analyze, maintain, and control wind energy based power plant sites and data collected from such sites” in Class 42

- Ser. No. 87869632 for SOLVE IT in connection with “Board games; Card games” in Class 28

All of the above are herein referred to as the “Cited Marks.”

The Examining Attorney also requires amendment to the Identification of Goods and addition of Class 42 services.

I. Amendment and Limitations to Identification of Services

Applicant hereby amends and limits its Identification of Services to read as follows:

~~Downloadable~~ Computer game software **downloadable via from** a global computer network ~~and to~~ wireless devices; Downloadable computer software applications **for transmitting videos and films in the fields of drama, live action, and comedy entertainment to wireless devices** via a global computer network ~~and wireless devices featuring videos and films in the fields of drama, live action, and comedy entertainment~~; Computer software, namely, **downloadable** computer software for streaming audio-visual media content via the Internet to mobile digital electronic devices and to downloadable **media** players for viewing audio-visual media content in the fields of drama, live action, and comedy entertainment” in International Class 9.

“Providing temporary use of non-downloadable computer software for streaming audio-visual media content via the Internet to mobile digital electronic devices and to downloadable media players for viewing audio-visual media content in the fields of drama, live action, and comedy entertainment” in International Class 42.

II. Applicant’s Mark is Not Liked to Be Confused with the Cited Marks

In determining whether there is a likelihood of confusion, courts and the Trademark Trial and Appeal Board (“the TTAB” or “the Board”) look to many factors, including the following, which are most relevant in the present analysis:

- the relatedness of the goods or services as described in the application and registration(s);
- the similarity of the trade channels of goods and services; and

- the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation, and commercial impression;
- the number and nature of similar marks in use on similar goods.

See In re E.I. DuPont De Nemours & Co., 476 F.2d 1357, 1361 (C.C.P.A. 1973); T.M.E.P. § 1207.01. There is no mechanical test for determining likelihood of confusion and "each case must be decided on its own facts." *Id.* The application of these factors in this case leads inevitably to the conclusion that no confusion is likely between Applicant's Mark and the Cited Marks.

1. *The Goods and Services of the Parties Are Not Related*

If the goods or services in question 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, then, even if the marks are identical, confusion is not likely. T.M.E.P. § 1207.01(a)(i).

There is no likelihood of confusion between Applicant's SOLVE trademark, as clarified and amended, and any of the Cited Marks, all of which are used for distinct goods and services that do not overlap and are not otherwise related with Applicant's goods.

A majority of the Cited Marks are used in connection with various software applications that are unrelated to Applicant's computer game software or software for transmitting or streaming videos and films in the fields of drama, live action, or comedy entertainment. Applicant's software is unrelated to software for scheduling appointments, obtaining insurance eligibility, or managing a medical office; managing the operations of a business in the agricultural produce industry; conducting internet crisis investigations; data management or warehousing; creating life insurance quotes; monitoring wind-energy-based power plants; or editing digital photographs. Respectfully, Applicant disagrees with the Examining Attorney that its recitation of goods includes "broad language" that

“does not specify the *function* of the software,” and thus “presumably encompasses all software of this type, irrespective of its claimed function...” Applicant’s recitation, as amended, specifies the software function as computer games, transmitting entertainment products, and streaming entertainment products. It does not broadly encompass all software.

Applicant’s software is also not related to apparatus of taking or editing digital photography (as the September 23 response to office action for the PICSOLVE application makes clear its goods “clearly...relate to photography”), nor is it related to physical board or card games, since each has its own unique uses, and is not used in connection with or a replacement for the other.

Given the coexistence of all of the above marks in connection with their various goods and services (described more fully below), Applicant’s mark should be permitted to coexist as well given the differences in goods and services.

2. *The Appearances, Sounds, and Commercial Impressions of the Applicant’s Mark and the Cited Marks Are Different.*

Applicant’s Mark SOLVE is not likely to be confused with any of the Cited Marks because, when viewed in their entirety, the marks convey completely different appearances, sounds, and commercial impressions. *See DuPont*, 476 F.2d at 1361.

While Applicant’s mark bears some similarities with the Cited Marks in terms of the “solve” letter chain, all of those marks coexist. Accordingly, and taking into account the different goods and services, there is no likelihood of confusion, as consumers will differentiate between the marks, and will focus on the differences between them to identify source. ESOLVE and ISOLVE, for example, connote solving internet or electronic related problems. SOLVE IT connotes a puzzle game that the players must solve. These offer different commercial impressions than SOLVE in connection with Applicant’s goods.

3. *The Nature and Number of Similar Marks in Use on Similar Goods Mitigates the Likelihood of Confusion.*

Evidence of third-party use falls under the sixth *DuPont* factor – the "number and nature of similar marks in use on similar goods." *DuPont*, 476 F.2d at 1361. If the evidence establishes that the consuming public is exposed to third-party use of similar marks on similar goods, it "is relevant to show that a mark is relatively weak and entitled to only a narrow scope of protection." *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772*, 396 F.3d 1369, 1373-74, 73 USPQ2d 1689, 1693 (Fed. Cir. 2005); *see also Mini Melts, Inc. v. Reckitt Benckiser LLC*, 118 USPQ2d 1464, 1470 (TTAB 2016) (noting that evidence that third parties had adopted marks that were the same as or similar to opposer's mark for use in connection with food products "may show that a term carries a highly suggestive connotation in the industry and, therefore, may be considered weak ").

“During the examination of an application, the examining attorney should consider separately each registration found in a search of the marks registered in the USPTO that may bar registration of the applicant's mark under §2(d). If the examining attorney finds registrations that appear to be owned by more than one registrant, he or she should consider the extent to which dilution may indicate that there is no likelihood of confusion.” T.M.E.P. § 1207.01(d)(x).

The Examining Attorney's citation to multiple registrations owned by more than one registrant indicates a level of dilution that mitigates the likelihood of confusion in this case. Indeed, given that all of the Cited Marks coexist, even in the broad category of software, there is no reason to conclude that consumers of Applicant's goods would be unable to distinguish its SOLVE goods from those offered under the Cited Marks.

III. Conclusion

Applicant's Mark is not likely to be confused with the Cited Marks due to differences in the marks, differences in the respective goods and services, and dilution of the term "SOLVE." Accordingly, Applicant requests that the Examining Attorney withdraw the refusal and that Applicant's Mark be approved for publication. To the extent the Examining Attorney believes a likelihood of confusion continues to exist with respect to any of the cited applications, Applicant respectfully requests suspension of its Application pending resolution of any cited application that remains in issue.