

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE EXAMINATION DIVISION**

In re: Trademark Application of)	
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IMAGEKEEPER, LLC)	
)	
Serial No.: 88/298,190)	RESPONSE TO OFFICE ACTION
)	DATED May 7, 2019
Filed: February 12, 2019)	
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Mark: "DIGITAL MEDIA BANK)	
)	

RESPONSE TO OFFICE ACTION

Applicant hereby responds to the Office Action issued by the United States Patent and Trademark Office ("USPTO") on May 7, 2019, relating to the above-identified Application, wherein the Office issued: (1) a refusal on the basis of a likelihood of confusion; (2) a refusal for registration on the basis of mere descriptiveness; and (3) a requirement for clarification of the identification in Class 42. Applicant responds to the foregoing refusals for registration as set forth below.

**REFUSAL FOR REGISTRATION UNDER SECTION 2(d), 15 U.S. § 1051(d) ON THE
BASIS OF A LIKELIHOOD OF CONFUSION**

Likelihood of confusion between two marks at the USPTO is determined by a review of the relevant factors under the du Pont test. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177USPQ 5653, (C.C.P.A. 1973). No single factor controls as "[t]here is no mechanical test for determining likelihood of confusion and 'each case must be decided on its fact.'" TMEP §1207.01 (citing *du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ at 567). *See* TMEP §1207.01. In some cases, a determination that there is no likelihood of confusion may be appropriate, even where the marks share common terms, as respective additions or deletions to the marks may be sufficient to avoid a likelihood of confusion if the marks in their entireties convey significantly different commercial impressions, are used in connection with different goods and services, or are used in connection with goods/services purchased by a sophisticated consumer. *See* TMEP §1207.01(b)(iii) With respect to the present case, *duPont* factors One, Two, Three, and Four are the relevant to the analysis of likelihood of confusion.

I. duPont Factor One: The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation, and commercial impression.

There is no explicit rule that likelihood of confusion automatically applies where one mark contains in part the whole of another mark. *See, e.g., Colgate-Palmolive Co. v. Carter-Wallace, Inc.*, 432 F.2d 1400, 167 U.S.P.Q. 529 (C.C.P.A. 1970) (PEAK PERIOD not confusingly similar

to PEAK); *Lever Bros. Co. v. Barcolene Co.*, 463 F.2d 1107, 174 U.S.P.Q. 392 (C.C.P.A. 1972) (ALL CLEAR not confusingly similar to ALL); *In re Ferrero*, 479 F.2d 1395, 178 U.S.P.Q. 167 (C.C.P.A. 1973) (TIC TAC not confusingly similar to TIC TAC TOE); *Conde Nast Publications, Inc. v. Miss Quality, Inc.*, 507 F.2d 1404, 184 U.S.P.Q. 422 (C.C.P.A. 1975) (COUNTRY VOGUES not confusingly similar to VOGUE); *In re Merchandising Motivation, Inc.*, 184 U.S.P.Q. 364 (T.T.A.B. 1974). In addition, courts have found (in many cases) that even where two marks share common terms combined with other dissimilar elements, the dissimilar element sufficiently distinguishes the two marks in their entirety to avoid a likelihood of confusion. **To that end, numerous marks that have common or similar elements have avoided a finding of likelihood of confusion.** See, e.g., *Marshall Field & Co. v. Mrs. Fields Cookies*, 25 U.S.P.Q.2d 1321 (TTAB 1992) (“MARSHALL FIELD’S” and “FIELD’S,” both for department store services including baked goods, created no likelihood of confusion with “MRS. FIELDS,” for cookies and brownies); *Mr. Hero Sandwich Systems, Inc. v. Roman Meal Co.*, 228 U.S.P.Q. 364 (Fed. Cir. 1986) (“ROMAN” and “ROMANBURGER” were not confusingly similar); *Bell Laboratories Inc. v. Colonial Products Inc.*, 231 U.S.P.Q. 569 (S.D. Fla. 1986) (both “FINAL FLIP” and “FINAL,” for pesticides were not confusingly similar); *Interstate Brands v. Celestial Seasonings*, 198 U.S.P.Q. 151, 153 (CCPA 1978) (“The presence of the word “RED” in Applicant’s mark cannot be dismissed as an identification factor. Thus whether we consider Applicant’s mark to be ‘THE RED ZINGER’ or ‘RED ZINGER,’ it is distinguishable from ‘ZINGER’ per se”); *Plus Products v. General Mills, Inc.*, 188 U.S.P.Q. 520 (TTAB 1975), *aff’d* without opinion, 534 F.2d 336 (CCPA 1975) (“PROTEIN PLUS” not confusingly similar to “PLUS”); *Lever Bros. Co. v. Barcolene Co.*, 174 U.S.P.Q. 392 (CCPA 1972) (“ALL” and “ALL CLEAR,” for household cleaners were not confusingly similar); *Colgate-Palmolive Co. v. Carter-Wallace, Inc.*, 167 U.S.P.Q. 529 (CCPA 1970) (“PEAK PERIOD” not confusingly similar to “PEAK”); *Long John Distilleries, Ltd. v. Sazerac Co.*, 420 F.2d 1403, 166 U.S.P.Q. 30 (CCPA 1970) (no likelihood of confusion between “FRIAR JOHN” and “LONG JOHN” for scotch whiskey - despite near identity in the goods).

“When comparing the marks, ‘all 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 consideration of all the relevant facts, the applied-for mark (the “Applied-for Mark”) is markedly dissimilar from of the mark in the cited registration (the “Cited Mark”). Furthermore, it is not appropriate for the Office to compare the Applied-for Mark and the Cited Mark by discriminately selecting portions of either for comparison while ignoring the aggregate effect created by each of the marks. *Franklin Mint Corp. v. Master Mfg. Co.*, 212 U.S.P.Q. 233 (CCPA 1981). The Office must focus on the entire mark as a whole, based on its overall sight, sound, connotation, and commercial impression, instead of just its component parts. *In re National Data Corp.*, 753 F.2d 1056, 224 U.S.P.Q. 749, 751 (Fed. Cir. 1985); *Massey Junior College, Inc. v. Fashion Institute of Technology*, 492 F.2d 1399, 1402, 181 U.S.P.Q. 272, 273-74 (CCPA 1974); 2 J. Thomas McCarthy, MCCARTHY ON TRADEMARKS §23.15[1][a] (3rd Ed. 1992). **While each mark may contain common or similar roots, the marks should be considered in their entirety.** See *Opryland USA, Inc. v. Great American Music Show, Inc.*, 970 F.2d 847, (Fed. Cir. 1992); *In re National Data Corn.*, 753 F.2d 1056, (Fed. Cir. 1985) (individual components or features should not be dissected and analyzed piecemeal).

With regard to Cited Mark and the Applied-for Mark, there are material dissimilarities when accounting for the sight, sound, connotation, and commercial impression of the marks *as a whole*. The presence of a separate word that conveys trademark significance creates important and divergent implications for the visual, aural, and connotative properties of the marks at issue. Visually, the marks are dissimilar and they are pronounced different as well. Moreover, the commercial impression must be different as the Cited Mark has another indicator of source incorporated into the claimed mark, which the Applied-for Mark lacks altogether.

Granted, the Cited Mark may share some similarity with the Applied-for Mark, however, this similarity alone is not enough to create a likelihood of confusion according to the precedent detailed above. In this case, there are key differences due to the presence of distinguishing textual material to the Applied-for Mark and these differences should not be discounted as they account for material dissimilarity in appearance, pronunciation and meaning. In this case, *duPont Factor One* should not weigh in favor of refusal.

II. duPont Factor Two: The similarity or dissimilarity of the services.

For a determination of likelihood of confusion, the question to be determined is not whether the *actual goods and services* are likely to be confused, but rather whether there is a likelihood of *confusion as to the source of the goods and services* because of the marks used thereon. *In re Rexel Inc.*, 223 USPQ 830, 831 (TTAB 1984) (emphasis added), and cases cited therein. Even in cases featuring closely related services, the TTAB has mandated that a closer inspection of the goods and/or services must be undertaken before a finding of a likelihood of confusion would be appropriate. In fact, the TTAB has repeatedly rejected overbroad generalizations that services are related simply because they are in the same general field or space. The TMEP states “there can be no rule that certain goods or services are *per se* related, such that there must be a likelihood of confusion from the use of similar marks in relation thereto.” TMEP § 1207.01(a)(IV), citing *M2 Software, Inc. v. M2 Comm'ns, 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 merely because the goods are delivered in the same media format and that, instead, a subject-matter-based mode of analysis is appropriate).

Applicant’s services feature a software program that provides users with media certified with 3D geographic location information, date and time, title, and group identifiers in Class 42. In contrast, Registrant’s mark covers goods, which are classified in a different class altogether, namely, Class 9. Whereas Applicant’s services concern information attached to a specific geographic location, Registrant’s goods concern digital media asset management. Certified information tied to geographic locations and other group identifiers are quite unique from digital media asset management: they serve a different purpose and they function differently as well. While Applicant’s services are focused verifying and certifying information tied to specific places in order to provide secure, verified, and untampered information, Registrant’s goods are focused on providing software that helps archive and track images for use in marketing, publishing and production management. Therefore, the respective goods and services are, on their face quite different. To apply the reasoning of *M2 Software, Inc. v. M2 Comm'ns, Inc.*, a likelihood of confusion is unlikely here because the goods and services at issue concern entirely different industries (information security v. marketing, publishing, and production management). Therefore, *duPont Factor Two* must weigh favor of registration of the Applied-for Mark.

II. duPont Factor Threes and Four: The similarity or dissimilarity of established, likely-to-continue trade channels; and The conditions under which and buyers to whom sales are made.

When goods and/or services “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.” *Perfect Foods, Inc.*, 2006 WL 867931, at *6 (Mar. 21, 2006) (citing *Shen Mfg Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 73 USPQ2d 1350 (Fed. Cir. 2004)). The test as to whether trade channels for services are similar is based upon what consumers reasonably might believe when encountering the parties’ marks in a commercial environment. *CPG Prods. Corp. v. Perceptual Play, Inc.*, 221 USPQ 88, 90 (TTAB 1983); McCarthy § 24:51. If the differences in the services result in the services being sold through different trade channels, being used for different purposes, or not interfacing in the market, the cumulative dissimilarities are sufficient to outweigh any similarity between the respective marks. See *Astra Pharmaceutical Prods. V. Beckman Instruments*, 220 USPQ 609 (D. Mass. 1983)(aff’d, 718 F.2d 1201 (1st Cir. 1983)). Moreover, in determining whether a likelihood of confusion exists, it must be kept in mind that the likelihood of confusion or mistake must exist as to the purchasing public for the services on which the marks are used – not confusion of the purchasing public at large or confusion merely as an intellectual concept. See McCarthy §23:5.

In the present case, the Registrant’s goods and Applicant’s services will be marketed to different persons, who will use the respective goods and services for very distinct purposes. To begin with, the Applied-for Mark is marketed towards customers who require certified data in order to avoid computer image manipulation, fraud, and cyber-crime. In contrast, the Registered Mark is marketed towards companies that want an easily accessible central repository’s for their valued information. Given the foregoing evidence, Applicant’s customers are an entirely different type of consumer in an entirely different industry as compared to Registrant’s consumers. While Applicant’s services will be marketed towards companies and agencies such as insurance companies and government agencies that will need certified media, Registrant’s goods are marketed towards companies that need one cohesive solution for integrating the people, process and technology of their team. Given these disparate functions and purposes, each of the services at issue would be marketed to a different type of specialist, who (in each case) would have a particular type of education and accreditation.

It is well established that sophisticated consumers mitigate the likelihood of consumer confusion. *U.S. Polo Ass’n, Inc. v. PRL USA Holdings, Inc.*, 800 F. Supp. 2d 515, 537 (SDNY 2011) aff’d, 511 F. App’x 81 (2d Cir. 2013)(“Generally, the more sophisticated and careful the average consumer of a product is, the less likely it is that similarities in trademarks will result in confusion concerning the source or sponsorship of the product.”); *Bristol Myers Squibb Co. v. McNeil-P.P.C., Inc.* 973 F.2d 1033, 1046 (2d Cir. 19912); McCarthy § 23:99. None of the goods or services at issue are items that would be available through common or wide-spread methods of distribution, such as retail stores. In contrast, Applicant’s services will be supplied to, and purchased by, very distinct and selective entities or purchasers, highly educated agencies and companies. In terms of sophistication, the consumers for the services at issue are among the most informed and selective because of the demands of their profession. They must carefully select the systems and technology they incorporate into their company policies.

Due to the nature of the services for the Applied-for Mark, Applicant's consumers would clearly be among some of the most sophisticated and discerning purchasers. As the services at issue would be selected for its specific function, over any other characteristic, the consumers for these services are more likely to pay attention to the actual performance and purpose of the services rather than any mark that may be used in association therewith. Because Applicant is marketing and selling to separate and unique sets of consumers who are likely to be much more sophisticated, discerning and careful than the average consumer *because of the very nature of Applicant's services*, the less likely it is that any similarities between the marks or the services at issue will result in confusion concerning the source or sponsorship of the services.

REFUSAL FOR REGISTRATION UNDER SECTION 2(e)(1), FOR MERELY DESCRIPTIVE

In categorizing a trademark, it is not sufficient to ask whether a term is descriptive. The statutory test is whether the term at issue is merely descriptive. 15 U.S.C. § 1052(e)(1). In this context, the term "merely" is to be taken in its ordinary meaning of 'only' or 'solely' -- that is, when considered in relation to the particular goods or services, the mark, because of its meaning, does nothing but describe them. T.M.E.P. §1209.01. Additionally, the "word 'merely' in the [Trademark] Act means that if the mark clearly does not tell the potential customer only what the goods are, their function, characteristics, use or ingredients, then the mark is not 'merely descriptive.'" See McCarthy's 11§51, citing *In re Colonial Stores Inc.*, 394 F.2d 549 (C.C.P.A. 1968). (SUGAR & SPICE for bakery products "descriptive" as opposed to being "merely descriptive"; being "merely descriptive" would make the mark unregistrable, but a mark that is "descriptive" could still fulfill a trademark function). **Terms which may describe the characteristics or function of the applied-for goods and/or services are nonetheless entitled to registration, and the determination of whether a term is merely descriptive must be made solely on the basis of the goods or services specified in the application.** McCarthy's § 11:51.

If information about the product or service given by the term used as a mark is indirect or **vague**, then this indicates that the term is being used in a suggestive, not descriptive, manner. See McCarthy's §§11:62-11:65. A suggestive term or mark suggests or alludes to a characteristic or function of the services and is registrable on the Principal Register. *In re Aid Laboratories, Inc.*, 223 U.S.P.Q. 357 (T.T.A.B. 1984); TMEP § 1209.01(a). Applicant respectfully submits that the term "DIGITAL MEDIA BANK" is not merely descriptive of Applicant's services. Instead, the phrase "DIGITAL MEDIA BANK" is vague and could convey a number of different connotations. Consumers could view the phrase "DIGITAL MEDIA BANK" to indicate a service to purchase or borrow digital media. Given the vague nature of the Applied-for Mark, consumers would not immediately understand the sophisticated service associated with Applicant's trademark.

Even if the USPTO determines that the phrase "DIGITAL MEDIA BANK" is descriptive *as a whole*, though Applicant advocates that it is not, "DIGITAL MEDIA BANK" is not *merely* descriptive. Applicant respectfully submits that any suggested use of Applicant's mark in connection with Applicant's services support a finding of suggestiveness rather than mere descriptiveness. See *In re Reynolds Metals Company*, 178 U.S.P.Q. 296 (C.C.P.A. 1973)

(“BROWN-IN-BAG” for a “bag” which is placed in the oven and holds food in order to “brown” the food is suggestive, not merely descriptive; the word “bag” is descriptive of the product and the word “brown” is descriptive of what can happen to the food when the bag is used; however, the informational nature of the words does not make them merely descriptive). “[O]ne may be informed by suggestion as well as by description.” *Id.*, 178 U.S.P.Q. at 297.

Similarly, the phrase “DIGITAL MEDIA BANK” does not merely describe a feature of the services, but rather suggests or alludes to the overall mission behind the services, which is certified media with 3D geographic location information. While this phrase may suggest some information to the consuming public regarding the services, the term does not merely describe the particular nature of Applicant’s services. Accordingly, the term is not merely descriptive.

Upon encountering the goods or services under the mark, should a multistage reasoning process or resort to imagination be required in order to determine the attributes or characteristics of the product or services, the mark is suggestive rather than merely descriptive. *Plyboo America Inc. v. Smith & Fong Co.*, 51 USPQ2d 1633 (TTAB 1999); and *In re Atavio*, 25 USPQ2d 1361, 1362 (TTAB 1992). Even a mark that requires only a small amount of imagination is registrable. To be refused registration, a mark must have more than a descriptive interpretation, the mark must be merely descriptive. The phrase “DIGITAL MEDIA BANK” contains no verbiage, in and of itself, to certified media: Therefore, consumers must use their imagination to get from the literal meaning of the words “DIGITAL”, “MEDIA” and “BANK” to the actual services rendered by Applicant.

Based on the preceding arguments, Applicant asserts it is incorrect to conclude “DIGITAL MEDIA BANK” immediately describes a feature or characteristic of the services. In support of Applicant’s position, in addition to the cases cited herein, Applicant notes that the TTAB has overturned several Section 2(e)(1) rejections in similar situations: BUDGET DIRECTOR for “computer software for use in accounting, financial management and planning, and budget forecast and analysis” (*In re Best Software, Inc.*, 2001 TTAB LEXIS 172) (holding the term “budget director” had multiple meanings including a person or the process of setting the direction of an organization’s budget) and THE RESIDENCE COMPANY for use in “financial, design, construction and property management services for residences” (*In re EquityRG, LLC*, 2008 TTAB LEXIS 298).

In *EquityRG*, the TTAB reversed the refusal issued by the Trademark Examining Attorney on the basis the mark THE RESIDENCE COMPANY does not “convey an immediate and unambiguous meaning. As used in connection with applicant’s financial, design, construction and property management services, we agree with applicant that the Trademark Examining Attorney has failed to demonstrate that the term “The Residence Company” is merely descriptive.” *Id.* In similar fashion, Applicant respectfully submits that “DIGITAL MEDIA BANK” does not immediately and unambiguously convey information about Applicant’s services. Because the phrase “DIGITAL MEDIA BANK” does not draw an immediate connection in the mind of the consumer to the exact nature or type of goods or services being offered by Applicant it cannot be merely descriptive.

Finally, it is well settled that when there is doubt as to whether a particular term is suggestive or merely descriptive, the doubt is to be resolved on Applicant’s behalf, *i.e.*, in favor of a finding of

suggestiveness and registrability. *In re: Atavio Inc.*, 25 U.S.P.Q. § 1361 (T.T.A.B. 1992); *see also In re Conductive Systems, Inc.*, 220 U.S.P.Q. 84, 86 (T.T.A.B. 1983). Accordingly, because the term “DIGITAL MEDIA BANK” does not immediately describe Applicant’s particular services, this vague phrase is suggestive in that some imagination, thought and perception is required to reach a conclusion regarding some of the properties of the services. Given the foregoing, Applicant respectfully requests the withdrawal of the refusal for registration on the basis of descriptiveness.

AMENDMENT TO THE SERVICES OF CLASS 42

The Office also requires an amendment to the identification of the services. Applicant amends as follows:

Class 42: Platform as a service (PaaS) featuring computer software platforms for securely integrating Internet portal access and datacenters in order to provide users certified media with 3D geographic location information, date and time, title, and group identifiers; Platform as a Service (PaaS) featuring technology for processing, securely transmitting, and certifying images, videos, sound recordings, and other visual media; Computer services, namely, **providing online non-downloadable** computer software platforms for securely integrating internet portal access and datacenters in order to provide users certified media with 3D geographic location information, data, and time, title, and group identifiers; Computer services, namely **providing online non-downloadable** computer software technology for processing, securely transmitting, and certifying images, videos, sound recordings, and other visual media.

The Application is now believed to be in a state for publication and Applicant respectfully requests the same. If the Office has any further concerns or queries, the Office is encouraged to contact the undersigned. Thank you!

Rachel A. Rice