

In the Office Action dated May 13, 2019, the Examining Attorney referenced five (5) prior pending applications and indicated that if any of these applications mature to registration, the Examining Attorney might refuse registration. The specifics of these five (5) marks are as follows:

1. U.S. Application No. 877469307 for the mark CENTURA for Advertising agencies; Business consultant services for direct marketing programs of others; Business consulting services, namely, providing business consultation regarding customer loyalty and promotion programs; Business management and consultation in the field of artificial intelligence; Business marketing consulting services; Business marketing data analysis and modeling services for advertising or sales promotion; Creative design and copy services for others, namely, creating and designing forms, logos, publications and marketing collateral for use in business operations, marketing and advertising; Direct marketing advertising services for others; Marketing agency services, namely, marketing plan audit and analysis, marketing plan development, and marketing plan execution and reporting services; Marketing campaign management services; Marketing consultation and development services for the management of marketing systems; Market research services, namely, market analysis and research of information regarding consumers' purchasing preferences and related data; Marketing response analysis services, namely, measurement, analysis and assessment of the responses and effectiveness of marketing, sales and advertising campaigns, and providing reports and recommendations regarding such campaigns; Preparing and analyzing mailing lists for others for marketing purposes; Providing a database featuring marketing information for the financial industry; Response management services, namely, analysis of advertising response; Web site traffic optimization and analytic services, namely, assessing and analyzing web sites and web site usage for effectiveness in attracting and retaining customers; Database management services; Marketing services, namely, designing customized direct marketing programs for others utilizing computer-generated information in Class 35 and Computer services, namely, designing and implementing web sites for others; Computer services, namely, providing search platforms to allow users to collect, store and analyze data and perform searches in the field of artificial intelligence and modeling of human behavior and responses across all industries; Data mining services to gather data in the field of consumers' purchasing preferences and related data; Database development services in Class 42. This application is owned by Epsilon Data Management, LLC ("Epsilon") and has been allowed.
2. U.S. Application Nos. 87772910 for the mark CENTAUR for Data automation and collection service using proprietary software to evaluate, analyze and collect service data; Electronic monitoring and reporting of the storage environment of harvested crops using computers or sensors; Electronic monitoring of the storage environment of harvested crops using computers and sensors; Computer services, namely, acting as an application service provider in the field of information management to host computer application software for the purpose of monitoring the status of harvested crops and predicting the timing and quality of the effects of environmental conditions and pest-treatment on the crops; Monitoring the status of harvested crops for quality control purposes; Software as a service (SAAS) services featuring software for use in monitoring current post-harvest crop quality and estimating future post-harvest crop quality, for predicting safe storage time in silos and other storage volumes, and for designing and monitoring effective fumigation and heat-treatment protocols; Software as a service (SAAS) services, namely, hosting software for use by others for use in monitoring current post-harvest crop quality and estimating future post-harvest crop quality, for predicting safe storage time in silos and other storage volumes, and for designing and monitoring effective fumigation and heat-treatment protocols. This application is owned by Centaur Analytics, Inc. ("CAI").
3. U.S. Application No. 87772899 for the mark CENTAUR and Design for Data automation and collection service using proprietary software to evaluate, analyze and collect service data; Electronic monitoring and reporting of the storage environment of harvested crops using computers or sensors; Electronic monitoring of the storage environment of harvested crops using computers and sensors; Computer services, namely, acting as an application service provider in the field of information management to host computer application software for the purpose of monitoring the status of harvested crops and predicting the timing and quality of the effects of environmental conditions and pest-treatment on the crops; Monitoring the status of harvested crops for quality control purposes; Software as a service (SAAS) services featuring software for use in monitoring current post-harvest crop quality and

estimating future post-harvest crop quality, for predicting safe storage time in silos and other storage volumes, and for designing and monitoring effective fumigation and heat-treatment protocols; Software as a service (SAAS) services, namely, hosting software for use by others for use in monitoring current post-harvest crop quality and estimating future post-harvest crop quality, for predicting safe storage time in silos and other storage volumes, and for designing and monitoring effective fumigation and heat-treatment protocols. This application is owned by CAI.

4. U.S. Application No. 87772874 for the mark CENTAUR and Design for Data automation and collection service using proprietary software to evaluate, analyze and collect service data; Electronic monitoring and reporting of the storage environment of harvested crops using computers or sensors; Electronic monitoring of the storage environment of harvested crops using computers and sensors; Computer services, namely, acting as an application service provider in the field of information management to host computer application software for the purpose of monitoring the status of harvested crops and predicting the timing and quality of the effects of environmental conditions and pest-treatment on the crops; Monitoring the status of harvested crops for quality control purposes; Software as a service (SAAS) services featuring software for use in monitoring current post-harvest crop quality and estimating future post-harvest crop quality, for predicting safe storage time in silos and other storage volumes, and for designing and monitoring effective fumigation and heat-treatment protocols; Software as a service (SAAS) services, namely, hosting software for use by others for use in monitoring current post-harvest crop quality and estimating future post-harvest crop quality, for predicting safe storage time in silos and other storage volumes, and for designing and monitoring effective fumigation and heat-treatment protocols. This application is owned by CAI.
5. U.S. Application No. 88088376 for the mark CENTAURI for Electric and electronic measuring apparatus, namely, energy meters for tracking and monitoring energy usage; electrical hardware and equipment, namely, electric control devices for energy management used for monitoring, analyzing, and storing energy and operational data; data processors for electronic data recording, data input, data processing, data storage, data output, data display; batteries; energy storage modules, namely, accumulators, electric storage batteries, supercapacitors, capacitors and condensers; electric monitoring apparatus, namely, multi-function panel front displays; switching, regulating and electrical control and distribution devices, namely, electrical switchboards; enclosures, namely, housing for electric switches or distribution boards for electrical energy; electric control panel units, switching and control apparatus for electrical switchboards; converters, rectifiers and rectifier modules; structural and replacement parts of the aforementioned goods in Class 9 and Design and development of **electric power batteries, supercapacitors, and energy meters for tracking and monitoring energy usage** in Class 42. This application is owned by KiloWatt Labs, Inc. ("KiloWatt").

The Examining Attorney also requested amendments to the services in Class 42. Accordingly, Applicant has amended its services as suggested by the Examining Attorney and in accordance with the Acceptable Identification of Service Manual issued by the U.S. Patent and Trademark Office ("PTO"). Moreover, Applicant submits that the amendments to Class 42 not only resolves the indefiniteness issue but also resolves the potential Section 2(d) refusals as Applicant's amended services are distinguishable from the services in the referenced applications.

In light of the amendments, the differences in the marks, the coexistence of referenced marks with each other and many other marks as well as the comments set forth below; Applicant respectfully requests that the Examining Attorney remove the potential Section 2(d).

**THERE IS NO LIKELIHOOD OF CONFUSION BETWEEN THE
REFERENCED MARKS AND APPLICANT'S MARK**

Likelihood of Confusion Standard

The PTO recognizes that a mark should not be refused registration in view of all similar registered marks, but only on the basis of those similar marks whose effect *in the marketplace* would be to create a likelihood of confusion or mistake on the part of the purchasing public. T.M.E.P. §1207.01.

The controlling standard for determining likelihood of confusion is whether the relevant purchasing public would mistakenly assume that the applicant's services originate with, are sponsored by, or are in some way associated with the services offered in connection with the referenced applications or referenced applications. FBI v. Societe: "M. Bril & Co.", 172 U.S.P.Q. 310 (T.T.A.B. 1971).

Further, Applicant notes that the Examining Attorney "bears the burden of making out a persuasive case for finding that confusion among consumers or users of products or services is not merely a theoretical possibility but is likely." In re Medical Central Online, Inc., Serial No. 76/138,824 (T.T.A.B. Oct. 22, 2003) (non-precedential). Argument and conclusive assertions do not suffice to establish a likelihood of confusion. In re Consulting Services International Inc., Serial No. 76/376,622 (T.T.A.B. Oct. 3, 2003).

More importantly, it is well-recognized that "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).

A number of factors set forth in In re DuPont de Nemours & Co., 476 F.2d 1357, 177 U.S.P.Q. 563 (C.C.P.A. 1973) ("DuPont"), are considered relevant in making a determination of likelihood of confusion, including: (1) the differences in the marks; (2) the differences in functions and purposes of the services; (2) whether the services at issue are engaged after careful consideration as to the source of the services; (3) whether intended consumers and consumers are sophisticated and knowledgeable and (4) the co-existence of third-party registrations and uses for similar marks for similar services. These factors are to be addressed with respect to "the known circumstances surrounding use of the mark." Id. at 567. Applying these factors to the case at hand, it is apparent that there is no likelihood of confusion between Applicant's mark and the five referenced marks.

APPLICANT'S SERVICES AS AMENDED ARE DISTINGUISHABLE FROM THE SERVICES IN THE REFERENCED APPLICATIONS

As noted above, the PTO recognizes that a registration should not be refused in view of all similar registered marks, but only on the basis of those similar marks **whose effect in the marketplace** would be to create a likelihood of confusion or mistake on the part of the purchasing public. Given the amendments to Applicant's services, Applicant submits that its **amended** services are clearly distinguishable from the services in the referenced applications. As such, it is apparent that Applicant's services and the services in the referenced applications are not "related in some manner" or sufficiently related that "the conditions surrounding their marketing be such, that they could be encountered by the same purchasers under circumstances that could give rise to the mistaken belief that the [services] come from a common source." Accordingly, the likelihood of confusion and potential likelihood of confusion objections should be removed. This is especially true as the five referenced marks already coexist with each other and many other CENTAUR/CENTAURI containing or consisting marks.

Applicant's Services

Applicant notes that its amended services are engineering and information technology **consulting** services in the field of national defense, missile defense, space-based systems, surveillance, reconnaissance, intelligence gathering, and infrastructure protection. As noted in these services and is shown in **Exhibit A**, which is printout from the Applicant's website, Applicant provides high-end, creative engineering solutions to **critical national security missions across space, cyber, ISR, missile defense and intelligence domains**. Thus, Applicant's services are highly specialized and the consumer and potential consumers for such services are sophisticated.

U.S. Application No. 87469307

Applicant notes that during the prosecution of this application, Epsilon explained, "Applicant Epsilon Data Management, LLC is a global marketing company that helps businesses manage and increase the effectiveness of their marketing programs. See Exhibit 1 (website excerpts from <https://us.epsilon.com>). This includes providing marketing software that enables its clients to send direct mail advertisements to their customers and potential customers and that performs customer data mining and other intelligence gathering services." A copy of the applicant's "Exhibit 1" is attached hereto as **Exhibit 1**. Applicant also argued that, "Applicant's website targets businesses seeking services relating to marketing."

It is apparent that Applicant's services (Engineering and information technology **consulting** services in the field of **national defense, missile defense, space-based systems, surveillance, reconnaissance, intelligence gathering, and infrastructure protection**) are highly specific and technical service which would not be confused with Epsilon's marketing services. These differences have been recognized by the PTO in requiring Epsilon to identify its business marketing services in Class 35 while Applicant's services are classified in Class 42.

U.S. Application No. 88088376

During the prosecution of this mark, KiloWatt argued that the mark CENTURA is diluted in that numerous applications and registrations coexist in the PTO and numerous marks/uses coexist in the marketplace. KiloWatt also argued that its goods were "'a single source for power management specifically including an energy saver. The energy server "replaces integrated systems comprised of multiple components (PV inverter + charge controller + battery inverter + communication software and hardware + safety devices, etc.) in all use cases. The energy management product can accept power for multiple sources and can then distribute the power to multiple loads (i.e., powering a house or factory) or store the power in a battery bank for later use." KiloWatt also provided the attached information website (attached hereto as **Exhibit 2**).

U.S. Application Nos. 87772910; 87772874; and 87772899

Applicant notes that these applications are all owned by CAI and are all limited to services related to crops. A copy of CAI's specimen of use submitted to the PTO is attached hereto as **Exhibit 3**. Conversely, as shown in Applicant's application and as discussed in **Exhibit 1**, Applicant's services are related to **national defense, missile defense, space-based systems, surveillance, reconnaissance, intelligence gathering, and infrastructure protection**. The limitations in each party's application alone should be sufficient for the Examining Attorney to remove this refusal.

In In re The W.W. Henry Co., L.P., 82 U.S.P.Q.2d 1213, 1215, Ser. No. 78/401,595 (T.T.A.B. January 19, 2007) ("Henry"), an examining attorney refused registration of the mark PATCH & GO, used in connection with "portland cement based patch for use in patching, repairing or smoothing wall and floor surfaces, namely, wood, drywall, plaster, concrete, block wall, tile and wood paneling prior to painting or wallpapering," in view of the nearly identical registered mark PATCH 'N GO used in connection with "chemical filler preparations for use in the cosmetic repair of polyolefin surfaces." The examining attorney argued that in the absence of any restrictions in applicant's or registrant's identification of goods, it must be assumed that applicant's and registrant's goods may be used to repair surfaces inside or outside the home, and that such goods are offered in the same channels of trade to the same class of purchasers. The Board, in reversing the Examining Attorney, held that although the goods sold under the respective marks could both accurately be defined broadly as "preparations for repairing surfaces," the goods were used to repair different types of surfaces.

In fact, in Henry, the Board cited In re Trackmobile Inc., 15 U.S.P.Q.2d 1152 (T.T.A.B. 1990), and noted that when it "is somewhat uncertain as to what the goods identified in the registration are," extrinsic evidence is permitted to determine the nature of the goods. The Board therefore permitted the applicant to introduce printouts from the registrant's website to demonstrate that the registrant's goods were used by plastic manufacturers.

As with Henry, and as discussed above and as shown by the exhibits), Applicant's amended services have nothing to do with the services in the referenced applications. In fact, to support a conclusion that these five referenced applications are confusingly similar, the services specified in the Applicant's amended application must be so related to the services listed in the referenced applications, such that consumers would be confused about the source of origin. T.M.E.P. §1207.01(a)(i). Here, Applicant's amended services are not related or marketed in such a way that they would be encountered by the same people in situations that would create the incorrect assumption that they originate from the same source, then there is no likelihood of confusion, **even if the marks are identical**. See Coach Servs., Inc. v. Triumph Learning LLC, 668 F.3d 1356, 1371, 101 U.S.P.Q. 2d 1713 (Fed. Cir. 2012). Similarly, there is no likelihood of confusion between Applicant's mark and the referenced marks.

In fact, the only similarity between the services in referenced applications and Applicant's application is their classification. It is well recognized that this is not a sufficient basis for finding a likelihood of confusion. In support of this position, Applicant directs the Examining Attorney's attention to Groveton Papers Co. v. The Anaconda Co., 197 U.S.P.Q. 576 (T.T.A.B. 1977), where the opposer maintained that its products were related to the applicant's because both products were within the same class. In dismissing the opposition, the Trademark Trial and Appeal Board (the "Board") indicated that:

[T]he Patent and Trademark Office classification of services was established for the Office's convenience rather than for the purpose of showing that the services falling within a single class are related, and thus Office classification of particular services is immaterial to the determination of any issue of likelihood of confusion concerning those services.

Id. at 579.

In the case at hand, it is apparent that Applicant's amended services are not "related in some manner" or sufficiently related to the services in the referenced applications so that "the conditions surrounding their marketing be such that they could be encountered under circumstances that could give rise to the mistaken belief that the services come from a common source. Accordingly, the likelihood of confusion objections should be removed. This is particularly true given the specific and highly distinguishable functions and purposes of the services identified in the referenced applications, as is discussed in more detail below.

CONFUSION IS UNLIKELY BECAUSE THE PURPOSES AND FUNCTIONS OF THE SERVICES ARE DISTINGUISHABLE

As is explained above, a finding of no likelihood of confusion is mandated by the highly specialized nature of each party's services and the differences in the functions and purposes of the respective services. In fact, the case at hand presents itself as one in which there will be no competitive proximity between the parties' respective services.

The realities of the marketplace mandate consumer orientation to the specific **utility or function** of the services necessary to fulfill the consumer's specific needs. While it may not be necessary for the services of the parties to be identical or directly competitive to find a likelihood of confusion, Applicant directs the Examining Attorney's attention to In re Unilever Ltd., 222 U.S.P.Q. 981 (T.T.A.B. 1984), in which the Board stated that: "where the services in question are not identical or competitive, and are not related or marketed in such a way that they would be encountered by the same people in situations that could create the incorrect assumption that all the services come from the same source . . . confusion is not likely." Id. at 982-83.

As explained in more detail below, Applicant's services have very specific functions, purposes and fields of use. Likewise, the five referenced applications identify services with very specific functions, purposes and fields of use that are unrelated to Applicant's amended services. Thus, the services at issue are not identical or competitive. Moreover, a consumer interested in the services being provided by the owners of the referenced applications would be unable to use Applicant's amended services to perform the same functions and purposes. As all the services have **mutually-exclusive purposes**, a finding of likelihood of confusion is even more tenuous.

The Board's decision in Borg-Warner supra, 225 U.S.P.Q. at 224 is instructive in this regard. In Borg-Warner, the mark BLENDX for use in connection with "stabilizing chemical composition for fertilizers and pesticides" was opposed based upon an asserted likelihood of confusion with opposer's identical mark BLENDX for use in connection with "synthetic resinous compositions for use in the industrial arts."

In Chase Brass & Copper Co., Inc. v. Special Springs, Inc., 199 U.S.P.Q. 243, 245 (T.T.A.B. 1978), the Board found no likelihood of confusion between the identical marks BLUE DOT, one for automotive springs and the other for brass rod, because "while it is clear from the record of the present case that the goods of both parties are sold in a common industry, even to the same automotive manufacturers, nevertheless, there is no evidence of record to show that the marks identifying the respective products of applicant and opposer would ever be encountered by the same persons in an environment where a likelihood of confusion could occur."

Moreover, in reversing the Board's decision sustaining a Section 2(d) opposition with respect to the marks "E.D.S." versus "EDS," the Federal Circuit explained that "[w]here both applicant's goods and opposer's services are marketed and sold in the medical and certain other fields, it is error to deny registration simply because applicant sells some of its goods in some of the same fields in which opposer provides its services." Elec. Design & Sales, supra, 21 U.S.P.Q.2d 139. The Federal Circuit further emphasized that "[w]e 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." Id. (quoting Witco Chem. Co. v. Whitfield Chem. Co., 164 U.S.P.Q. 43, 44-45 (C.C.P.A. 1969)). See also Cooper Indus., Inc. v. Repcoparts USA, Inc., 218 U.S.P.Q. 81, 84 (T.T.A.B. 1983) ("the mere fact that the products involved in this case (or any products with significant differences in character) are sold in the same industry does not of itself provide an adequate basis to find the required 'relatedness'").

Indeed, noting that a likelihood-of-confusion analysis may focus on "dispositive factors," the Federal Circuit reversed another Board decision sustaining a Section 2(d) opposition where the marks were identical and the goods and services superficially related. Shen Mfg. Co. v. Ritz Hotel Ltd., 73 U.S.P.Q.2d 1350, 1353 (Fed. Cir. 2004). This opposition involved RITZ applied to cooking classes versus the identical mark RITZ applied to various kitchen textiles. The Federal Circuit disapproved of the Board's rationale that "the services of applicant clearly require the use of certain of opposer's goods," and clarified that simply because "two goods are used together . . . does not, in itself, justify a finding of relatedness," Id. at 1355, and that "aside from the fact that these goods are used together, there is no indication that the consuming public would perceive them as originating from the same source," Id. at 1356.

Furthermore, in Reynolds & Reynolds Company v. I.E. Systems, Inc. ("Reynolds"), 5 U.S.P.Q.2d 1749 (T.T.A.B. 1987), both the applicant and registrant marketed computer software. Nonetheless, the Board concluded that there was no likelihood of confusion because the applicant marketed its products to an entirely different set of consumers than the opposer. Id. at 1752. After analyzing the channels of trade through which applicant's and opposer's goods flowed, as well as the customers who purchased those goods, the Board concluded that the "goods sold under applicant's mark are sufficiently different from those goods and services for which opposer uses its . . . mark." Id. at 1757.

Likewise, the source of Applicant's services is not likely to be confused with the source of the services in the referenced applications, just as the source of the applicant's computer software in Reynolds was not likely to be confused with the source of the opposer's computer software.

As shown by the same types of evidence provided herewith, the limited and specific description and services in the referenced applications and Applicant's amended and limited description of services are all distinctive from one another.

THE NATURE OF THE SERVICES AND THE CONDITIONS OF PURCHASE

The nature of the services at issue must be considered in a likelihood of confusion analysis. Accuride Int'l Inv. V. Acuride Corp., 10 U.S.P.Q. 1589, 1595 (9th. Cir. 1989). The more careful and sophisticated the

consumer, the less likely he or she will be confused. In re Inspired Technologies, Inc., Serial No. 77/272,899 (T.T.A.B. 2011) (non-precedential); see also In re N.A.D., 224 U.S.P.Q. 969, 971 (Fed. Cir. 1985); Pfizer Inc. v. Astra Pharmaceutical Products Inc., 33 U.S.P.Q.2d 1545, 1562 (S.D.N.Y. 1994) (“[t]he consumers here are doctors, as sophisticated a group as one could imagine”).

A consumer would not impulsively engage Applicant’s services or the services identified in the referenced applications but would contemplate such a purchase because of the nature of the services and the fact that the services must perform the desired functions and be compatible with the consumers existing business and platforms. Thus, when consumers are engaging such services, they carefully consider their selection and purchase, as well as the source of the services. Thus, the nature of the services at issue, as well as the conditions of purchase, support the conclusion that there is no likelihood of confusion between the marks.

In In re Bridger Management, LLC (T.T.A.B 2007), regarding Serial No 785163469, the Board reversed the Examining Attorney’s refusal to register the mark BRIDGER CAPITAL for "hedge fund services for high-net-worth investors" [CAPITAL disclaimed] based on the mark BRIDGER COMMERCIAL FUNDING for commercial lending services for the commercial mortgage and financial asset management industries" [COMMERCIAL FUNDING disclaimed]. In reaching this conclusion, the Board held that “The nature of the services clearly requires that any of the involved financial transactions are made only with care and deliberation after investigation. . . In any event, the customers are sophisticated and certainly will know with whom they are dealing.” Similarly, in the case at hand, Applicant’s services are brokers and dealers. Thus, customers and potential customers only engage the services in the referenced applications or Applicant’s application after careful and thorough consideration of the sources and quality of the services. Moreover, Applicant’s customers and potential customers are highly sophisticated brokers and dealers. These types of customers and potential customers would clearly investigate the source of the services before engaging such services.

Likewise, in In re Barkely International Incorporated (T.T.A.B. 2011), regarding Serial No. 77311059, the Board reversed the Examining Attorney’s refusal to register the mark HOMER for financial engineering software and services for institutions, accredited investors, governments, hedge funds, and bankers, finding it not likely to cause confusion with the same mark registered for "savings and loan financial services." The Board noted that a key factor is the “condition under which and buyers to whom sales of the goods and services at issue are made.” The Board held that “it is clear that the applicant’s goods and services are directed toward highly sophisticated consumers. The fact that sophisticated purchasers are the only connection between the goods and services of the applicant and the services of registrant weighs against a finding of likelihood of confusion.”

Further, in In re American Olean Tile Co. Inc., 1 U.S.P.Q.2d 1823 (T.T.A.B. 1986), the Board found no likelihood of confusion between MILANO for “ceramic tile” and the identical mark MILANO for “wood doors for exterior and interior use.” In reversing the refusal, the Board made the point that certain goods are by their very nature sold to sophisticated professionals:

It is, of course, correct that in evaluating the likelihood of confusion we must consider the description of goods set forth in the application and registration regardless of what the record may reveal as to the nature of the goods, their actual channels of trade, and the class of purchasers to which their sale is directed. . . . Nevertheless, the doubt we have in the case before us is not with the applicable law, but whether it is fair to infer that ‘ceramic tile,’ considering its very nature, would appropriately be sold directly to ordinary homeowners for do-it-yourself installation.

Id. at 1825. The Board went on to hold, further, that “[a]s to sophisticated purchasers of tile such as professional home-builders and tile contractors, we are not persuaded that such persons are likely to be confused. As appellant has stated, these purchasers are far too familiar with the separate manufacturing sources of those products to be confused even where the marks applied to them are identical.” Id. at 1826 (emphasis added).

In In re Planprint Co., 229 U.S.P.Q. 621 (T.T.A.B. 1986), registration of the mark CAFE for “engineering services – namely, computer-aided surveys of customers’ existing buildings, machinery, equipment, furnishings and utilities, incorporation of the information generated by the surveys into computer database form and recordation of the database information on memory media for subsequent use by the customer in performing on-going plant layout planning functions” was refused in view of the registered mark CAFE CAFE CAFE & Design applied to “services which estimate and analyze business construction costs for restaurants, cafeterias and fast-food outlets.”

The Board rejected the examining attorney’s contention that these services were related because his contention was “based more on speculation than fact” and was a “largely hypothetical scenario” unsupported by any evidence. Id. at 624. See also Libman Co. v. Vining Indus. Inc., 36 U.S.P.Q.2d 1751 (7th Cir. 1995).

As the functions/activities/purpose/fields identified in the referenced applications (owed by three different entities) are all distinguishable and as many of the functions, purposes and fields have been excluded from Applicant’s application, Applicant submits that the potential Section 2(d) refusals should be removed.

Moreover, as mentioned above, the realities of the marketplace mandate consumer orientation to the specific utility or function of the product or service necessary to fulfill the consumer’s specific needs. A perusal of the identification of the services in the referenced applications and Applicant’s amended services show that the services are not interchangeable.

APPLICANT’S MARK IS DIFFERENT FROM THE MARKS IN THE REFERENCED APPLICATION IN APPEARANCE, COMMERCIAL IMPRESSION AND MEANING

In the case at hand, Applicant’s mark is CENTAURI. On the other hand, the marks in U.S. Application Nos. 87469307; 87772910; 87772874; and 87772899 are CENTAUR. As such, Applicant submits that the marks in these applications are different in overall appearance, sound and commercial impression. Specifically, the term “Centaur” is a word referring to the Greek mythological half-human, half-horse creature, whereas Applicant’s mark (Centauri) refers to Alpha Centauri, the closest star system to our solar system. See Exhibit 4 hereto.

It is well founded that in deciding likelihood of confusion, marks must be compared in their entireties and should not be dissected, and their parts compared separately. See Estate of P.D. Beckwith, Inc. v. Comm. of Patents, 252 U.S. 538 (1920) (the commercial impression of a composite mark is derived from the mark, not its separate elements). In fact, it has been held that it is a violation of the anti-dissection rule to ignore elements of a mark in deciding whether confusion is likely. Franklin Mint Corp. v. Master Mfg. Co., 667 F.2d 1005, 1007 (C.C.P.A. 1981). In other words, splitting a mark into its various components and comparing only certain portions of one mark with another mark is not proper. Massey Junior College, Inc. v. Fashion Institute of Technology, 492 F.2d 1399, 181 U.S.P.Q. 272 (C.C.P.A. 1974). Thus, a proper comparison of Applicant’s mark to the marks in the referenced applications shows that the marks are quite dissimilar in sound, meaning, connotation, overall appearance and commercial impression. See also In re Electrolyte Laboratories Inc., 913 F.2d 930, 16 U.S.P.Q.2d 1239, 1240 (Fed. Cir. 1990) (“no element of a mark is ignored simply because it is less dominant, or would not have trademark significance if used alone”); and Spice Islands, Inc. v. Frank Tea & Spice Co., 505 F.2d 1293, 184 U.S.P.Q. 35 (C.C.P.A. 1974) (improper to ignore portion of composite mark).

In fact, “no element of a mark is ignored simply because it is less dominant or would not have trademark significance if used alone.” In re Electrolytes Laboratories, Inc., 913 F.2d. 930, 16 U.S.P.Q.2d 1239 (Fed. Cir. 1990), corrected 929 F.2d 645 (Fed. Cir. 1990) (“Electrolytes”) (holding no likelihood of confusion between the marks K+ (Stylized) and K+EFF (Stylized) both for a dietary potassium supplement).

Applicant respectfully submits that when the marks are properly considered in their entireties, they are dissimilar in overall appearance. See Little Caesar Enters., Inc. v. Pizza Caesar, Inc., 834 F.2d 568, 571 (6th Cir. 1987) (holding that, despite a prominent component shared by PIZZA CAESAR USA and LITTLE CAESARS, that differences in sound and appearance made them dissimilar).

It is also well established that merely because two marks contain a similar or identical term, this does not

establish that there is a likelihood of confusion. In fact, time and time again, the Board and the courts have found that even where the marks at issue are identical or nearly identical; there is no likelihood of confusion.

In Oakville Hills Cellar, Inc. dba Dalla Valle Vineyards v. Vina Casa Tamaya S.A., Opposition No. 91189443 (April 15, 2013), the Board held that the dissimilarity of the marks TAMAYA and MAYA and the difference in commercial impressions resulted in no likelihood of confusion between the marks despite the fact that both marks were for wine.

Further, in ConAgra Inc. v. Saavedra, 4 U.S.P.Q.2d 1245 (T.T.A.B. 1987), the Board found that the mark "PATIO" for Mexican food has a different connotation than the mark "TAPATIO" for Mexican food and in Taj Mahal Enterprises Ltd. v. Trump, 745 F.Supp. 240, 16 U.S.P.Q.2d 1577 (D.N.J. 1990), the court found that the mark "TAJ MAHAL" for an Indian restaurant has a different connotation than the mark "TAJ MAHAL" for an Atlantic City hotel/casino.

Similarly, in Fleetwood Co. v. Mende, 132 U.S.P.Q. 458 (C.C.P.A. 1962), the Court of Customs and Patent Appeals ("CCPA") affirmed the Board's dismissal of a Petition for Cancellation of the mark "TINT 'N SET" for hair care preparations brought by the owner of the registration for the mark "TINTZ," also for hair care preparations. *Id.* at 459. In reaching its conclusion, the CCPA reasoned that merely because both marks contained the term "TINT" and were used on virtually identical goods, there was no likelihood of confusion. *Id.*

In the case, Giorgio Beverly Hills Inc. v. Revlon Consumer Products Corp., 33 U.S.P.Q.2d 1465 (S.D.N.Y. 1994), the court found that there was no likelihood of confusion between "RED" and "CHARLIE RED," both for perfume. *Id.* at 1467. Likewise, in Bell Laboratories, Inc. v. Colonial Products, Inc., 231 U.S.P.Q. 569 (S.D. Fla. 1986), the court found no confusion between "FINAL" and "FINAL FLIP," both for rodenticides. *Id.* at 571-572.

In fact, the Federal Circuit has made it clear that "one DuPont factor may be dispositive in a likelihood of confusion analysis, especially when that single factor is the dissimilarity of the marks." Champagne Louis Roederer S.A. v. Delicato Vineyards, 47 U.S.P.Q.2d 1459, 1460 (Fed. Cir. 1998) ("Roederer"). In Roederer, the Federal Circuit affirmed the Board's finding of no likelihood of confusion between the marks CRISTAL and CRYSTAL CREEK, both for beverages due to the differences in overall appearance and sound of the marks.

In Nutri/System, Inc. v. Con Stan Industries, Inc., 809 F.2d 601 (9th Cir. 1987), the court found no confusion between the marks NUTRI/SYSTEM and NUTRI TRIM, both for weight loss services.

In Lever Bros. Co. v. Barcolene Co., 463 F.2d 1107 (C.C.P.A. 1972), the court found no confusion between the mark ALL CLEAR! and the mark ALL, both for household cleaning products.

Moreover, in In re Johnson & Johnson, Serial No. 75/252,479 (T.T.A.B. 2002), which can be found at <http://ttabvue.uspto.gov/ttabvue/v?pno=75252479&pty=EXA&eno=11>, the Board reversed the Examining Attorney's refusal to register the mark EPIC MICROVISION for a medical device despite the existence of a prior registration for the mark EPIC also for a medical device.

This is especially true given the design elements shown in U.S. Application Nos. 87772899 and 87772874. Thus, Applicant's mark and the referenced marks are quite dissimilar in sound, meaning, connotation, overall appearance and commercial impression.


In support of this position, Applicant directs the Board's attention to Omaha National Bank v. Citibank (South Dakota), N.A., 633 F. Supp. 231 (D.C. Neb. 1986). In Omaha, the court determined that because the plaintiff's




composite mark consisted of words and a design element, it was not infringed by the defendant's use of the mark "BANK IN A WALLET." *Id.* at 233-34.

Further, Applicant directs the Examining Attorney's attention to Electrolytes, supra, where the Federal Circuit determined that due to the existence of the design portion of the K+ and Design mark, there was no likelihood of confusion between the marks "K+ and Design" and "K+EFF (stylized)" both for a dietary potassium supplement. In reaching this conclusion, the Federal Circuit stated, "[t]here is no general rule as to whether letters or designs will dominate in composite marks; nor is the dominance of letters or design dispositive of the issue."

In addition, in In re TSI Brands, Inc., the Board reversed the Examining Attorney's refusal to register the

mark  in Application Serial No. 75/615,925 (the "'925 Application") for "pants, jeans,

shorts and shirts" in light of prior registrations for the mark  for "sweaters, jerseys, shirts, tops, undershirts, pants, hosiery, jackets, ski pants, ski jackets, ski suits, tops." The Board determined that the marks proffered distinguishable commercial impressions. Applicant notes that the '925 Application proceeded to registration and was assigned Trademark Registration No. 2,802,613.

Applicant further directs attention to In re Merchandising Motivation, Inc., 184 U.S.P.Q. 364 (T.T.A.B. 1974), where the Board determined that the mark "MEN'S WEAR and MMI (STYLIZED)" for men's fashion consulting services did not resemble the mark "MEN'S WEAR" for a men's fashion magazine. See also Diamond Alkali Co. v. Dundee Cement Co., 145 U.S.P.Q. 211, 212 (C.C.P.A. 1965). See also Tektronics, Inc. v. Daktronics, Inc., 189 USPQ 693 (C.C.P.A. 1976) (the prominent letter "D" must be given weight); Menzies v. International Playtex, Inc., 204 USPQ 297 (T.T.A.B. 1979) (no confusion between the marks "SUPER LOOK" and "SUPER LOOK +") and Medical Modalities Associates Inc. v. ARA Corporation, 203 USPQ 295 1979) (no confusion between the marks "MG-PLUS" and "MG+C").

Indeed, "differences in designs may outweigh similarity of words." Richard L. Kirkpatrick, Likelihood of Confusion In Trademark Law, § 4:9.2 (2006).

In fact, different designs, lettering, or typeface play a significant role in distinguishing two marks and may even prevent confusion between identical words. See, e.g., Packman v. Chicago Tribune Co., 60 U.S.P.Q.2d 1245, 1255 (7th Cir. 2001) ("Packman") ("Although the words . . . are the same, the words' appearances do not resemble each other and are not likely to cause confusion").

Likewise, in Private Eyes Sunglass Corp. v. Private Eye Vision Center of New Milford, 25 U.S.P.Q.2d 1709, 1715 (D. Conn. 1992), the court found no likelihood of confusion notwithstanding the near identical marks PRIVATE EYE and PRIVATE EYES because "the print design and the logotype reduce the potential for confusion that would otherwise be inherent given the similar wordings."

For instance, in Hard Rock Cafe Licensing Corp. v. Elsea, 48 U.S.P.Q.2d 1400 (T.T.A.B. 1998), the Board dismissed a Section 2(d) opposition because it found no likelihood of confusion between the marks COUNTRY ROCK CAFE SALOON DANCE HALL & Design and HARD ROCK CAFE & Design for identical goods and services, e.g., clothing and restaurant services. With regard to the applicant's mark, the Board found that the design element was "a significant factor in the overall commercial impression of the mark" because all of the wording in the applicant's mark was either highly suggestive or merely descriptive as applied to its services. Id. at 1409. Concluding, the Board found that the two marks engendered different commercial impressions, "particularly in view of the highly suggestive nature of both parties' marks in connection with their respective goods and services." Id. at 1410.

Likewise, in Ass'n of Coop. Members, Inc. v. Farmland Indus., Inc., 216 U.S.P.Q. 361, 367 (5th Cir. 1982), the Court of Appeals for the Fifth Circuit explained that "when a composite [mark] includes both words and a design, the design element is likely to dominate if it is more conspicuous" and "[a] word that may be

subject to lessened trademark protection because of its popularity and lack of distinctiveness is not likely, when included in a composite, to be the element that attracts the public's attention."

In fact, the Board and the courts have held that different designs, lettering, or typeface play a significant role in distinguishing two marks and often prevent confusion between identical words. For example, in Packman, supra, the court stated, "Although the words . . . are the same, the words' appearances do not resemble each other and are not likely to cause confusion."

Further, in D & H Distributing Co. v. Designhouse International, Inc., 211 U.S.P.Q. 662 (T.T.A.B. 1981), the Board determined that a likelihood of confusion determination involving a mark with a design element must be primarily based on the mark's overall visual appearance.

Applicant notes that the Board and the Courts have consistently found, even if a mark incorporates the entire trademark of another, the marks often proffer different commercial impressions. See e.g., Redken Labs, Inc. v. Clairol Inc., 183 U.S.P.Q. 85, 86 (9th Cir. 1974) (no likelihood of confusion between the marks "CURL & CONDITION" and "CONDITION," both for hair care products); Colgate-Palmolive Co. v. Carter-Wallace, Inc., 167 U.S.P.Q. 529 (C.C.P.A. 1970) ("Colgate") (no likelihood of confusion between "PEAK" and "PEAK PERIOD" for personal care products); Del Labs, Inc. v. Allegheny Pharmacal Corp., 215 U.S.P.Q. 422 (S.D.N.Y. 1981) (no likelihood of confusion between the mark "REJUVIA" for skin care products and the mark "REJUVNA-NAIL" for nail products.); In re Pelvic Anchor Corp., 166 U.S.P.Q. 217 (T.T.A.B. 1970), (no confusion between the marks ANCHOR and PELVIC ANCHOR for medical and surgical supplies, appliances and equipment); In re Surf Line Hawaii, Ltd., 183 U.S.P.Q. 757 (T.T.A.B. 1975) (no confusion between the mark "THE BODY SURFER" for men's swimming suits and the marks SURFER and SURFERS for men's, women's and children's swimming suits); Murray Corp. of America v. Red Spot Paint Co. 126 U.S.P.Q. 391 (C.C.P.A. 1960) (no confusion between the marks "EASY" and "EASYTINT," both for paints); Toro Manufacturing Corp. v. The Gleason Works, 177 U.S.P.Q. 330 (C.C.P.A. 1973) (no likelihood of confusion between the mark "TORO" for grass cutting machinery, self-propelled power plants, hand mowers, power mowers, turf tractors, golf carts, utility cars and motorized golf carts, and the mark "TOROID" for gears, gear cutters and blades); Electronic Realty Associates, Inc. v. Kayser-Roth Corp., 216 U.S.P.Q. 61 (T.T.A.B. 1982) (no likelihood of confusion between the marks "GOLDEN ERA" and "ERA" both for clothing); Industrial Adhesive Co. v. Borden, Inc., 218 U.S.P.Q. 945 (T.T.A.B. 1983) (no likelihood of confusion between the mark "WONDER BOND PLUS" and the mark "BOND-PLUS" both for adhesives); In re Norfolk Wallpaper, Inc., 216 U.S.P.Q. 903 (T.T.A.B. 1983) (no likelihood of confusion between the mark "THE NORFOLK PLAN" for retail store selling wallpaper and installation services and the mark "NORFOLK," both for interior and exterior paints); Lever Brothers Co. v. American Bakeries Co., Inc., 215 U.S.P.Q. 647 (E.D.N.Y. 1982) (no likelihood of confusion between the mark "AUTUMN GRAIN" and the mark "AUTUMN" both for food products); Beneficial Corp. v. Beneficial Capital Corp., 213 U.S.P.Q. 1091 (S.D.N.Y. 1982) (no likelihood of confusion between the mark "BENEFICIAL FINANCE SYSTEM" and the mark "BENEFICIAL" both for money lending services); Johnson Publishing Co., Inc. v. Etched-In-Ebony, Inc., 213 U.S.P.Q. 995 (D.C.D.C. 1981) (no likelihood of confusion between the mark "EBONY" for magazine relating to Afro-American culture, history and achievement, and the mark "ETCHED-IN-EBONY" for appointment/planning guides with photographs of Afro-American females); and International Brands v. Celestial Seasonings, Inc., 198 U.S.P.Q. 151 (C.C.P.A. 1978) (no likelihood of confusion between the mark "RED ZINGER" and the mark "ZINGERS," both for food).

Likewise, the referenced marks proffer different connotations and meanings and distinguishable commercial impressions from Applicant's mark. Thus, consumers will recognize the differences in sight, sound and meaning between the marks, which negates any likelihood of confusion.

THE WEAK NATURE OF THE REFERENCED MARKS AND THE CO-EXISTENCE OF THE REFERENCED MARKS AND MANY THIRD-PARTY MARKS AND USES SUPPORTS A FINDING OF NO LIKELIHOOD OF CONSUMER CONFUSION

It is well established that merely because two marks contain a similar or identical term, this does not establish that there is a likelihood of confusion. This is true, even if one mark incorporates the entire mark of another and is even more so where, as here, the referenced marks are weak.

In In re Hartz Hotel Services, Inc., 102 U.S.P.Q.2d 1150 (T.T.A.B. 2012) (“Hartz Hotel”). In Hartz Hotel, the Board reversed the Examining Attorney’s refusal to register the mark GRAND HOTELS NYC (with a disclaimer of HOTELS NYC) for hotel services based on a prior registration for the mark GRAND HOTEL (with HOTEL disclaimed) for hotel and restaurant services.

In reaching its decision that there was no likelihood of confusion, the Board noted that there were several other registrations for GRAND marks for hotel services that coexisted with the cited mark. Further, the Board also noted that there were several parties using the term GRAND for hotels. Thus, the Board stated:

It is clear from the third-party registrations that the addition of a geographic location to the word GRAND HOTEL has been sufficient for the Patent and Trademark Office to view these marks as being sufficiently different from the cited registrant’s mark, and from each other, such as not to cause confusion.

In In re Broadway Chicken, Inc., 38 U.S.P.Q.2d 1559, 1566 (T.T.A.B. 1996), the Board determined there was no confusion between BROADWAY CHICKEN and BROADWAY PIZZA and BROADWAY BAR & PIZZA). In the Board reached this conclusion based on the geographic significance of the term BROADWAY and the number of third-party BROADWAY marks.

Similarly, in the case at hand, the registrant did not invent the terms centaur or centauri. Instead, they are common English terms. Thus, each mark owner is only entitled to a narrow scope of protection.

In support of this position, Applicant directs the Examining Attorney to Sure-Fit Products Company v. Saltzson Drapery Company, 254 F.2d 158, 117 U.S.P.Q. 295, 297 (C.C.P.A. 1958), where the court stated:

It seems both logical and obvious to us that where a party chooses a trademark which is inherently weak, he will not enjoy the wide latitude of protection afforded the owners of strong trademarks. Where a party uses a weak mark, his competitors may come closer to his mark than would be the case with a strong mark without violating his rights. The essence of all we have said is that in the former case there is not the possibility of confusion that exists in the latter case.

See also Colgate, supra, 167 U.S.P.Q. 529 (C.C.P.A. 1970), the (CCPA affirmed the Board’s decision that there was no likelihood of confusion between “PEAK” and “PEAK PERIOD” for personal care products because PEAK was suggestive); Knapp-Monarch Company v. Polorano Products, Inc., 134 U.S.P.Q. 412 (T.T.A.B. 1962) (THERM is highly suggestive of heat insulated products).

In In re Fesco Inc., 219 U.S.P.Q. 437, 438 (T.T.A.B. 1983), the applicant’s mark FESCO and Design for use in connection with “distributorship services in the field of farm equipment and machinery” was refused registration in view of the registered mark FESCO for, inter alia, “fertilizer” and “fertilizer coolers and dryers.”

Although the Board deemed the marks “virtually identical” and observed that the cited mark FESCO was arbitrary and therefore a “relatively strong designation,” the Board nonetheless found no likelihood of confusion:

[E]ven identical marks would have little opportunity, in our view, other than through accidental or chance confrontation, to create any confusion among customers or potential customers of either applicant or registrant. In this regard, the TTAB has not hesitated to find an absence of likelihood of confusion, even in the face of identical marks applied to goods used in a common industry, where such goods are clearly different from each other and there is insufficient evidence to establish a reasonable basis for assuming that the respective products and/or services, as identified by their marks, would be encountered by the same purchasers or parties.

Fesco, 219 U.S.P.Q. at 438 (emphasis added).

Further, Applicant notes that Section 1207.01(d)(iii) of the T.M.E.P. explains that “[t]hird-party registrations may be relevant to show that the mark or a portion of the mark is . . . so commonly used that the public will look to other elements to distinguish the source of the goods or services.” In a similar vein, T.M.E.P. § 1207.01(d)(x) provides that “[i]f 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.” In the case at hand, the fact that the Examining Attorney referenced five (5) marks owned by three different entities. The fact that all of the marks are owned by different entities supports the conclusion that Applicant’s mark can also coexist.

In In re Hamilton Bank, 222 U.S.P.Q 174, 177 (T.T.A.B. 1984), the Board reversed the refusal to register under Section 2(d) based on the fact that the federal register showed numerous registrations for banking services incorporating the word “key.” In reversing the refusal, the Board held that “the applicant’s mark is no more likely to cause confusion with the cited mark than cited mark was likely to cause confusion with the other registered marks which contain the term ‘KEY.’” Id.

In In Plus Products v. Natural Organics, Inc., 204 U.S.P.Q. 773 (T.T.A.B. 1979), the Board found no likelihood of confusion between the marks NATURE’S PLUS and PLUS both for vitamins. In reaching this conclusion, the Board noted that the PTO has “historically registered PLUS marks for vitamins to different parties so long as there has been some difference, not necessarily create by a distinctive word, between the marks as a whole.

In Jerrold Electronics Corp. v. The Magnavox Company, 1999 U.S.P.Q.2d 751, 758 (T.T.A.B. 1978), the Board concluded that third-party registrations reflect a belief, at least by the registrants, who would be most concerned about avoiding confusion and mistake, that various ‘STAR’ marks can co-exist.

In re Sien Equipment Co., 189 U.S.P.Q. 586, 588 (T.T.A.B. 1975), the Board stated that the suggestive meaning of the word “BRUTE” explains the numerous third-party registrations incorporating the word with other wordings or material no matter how little additional significance this may add to the word “BRUTE” per se.

The Examining Attorney’s referencing of five marks owned by three different entities supports the cases listed above. Moreover, a quick search of the PTO’s records revealed over 100 live applications and registrations for CENTAUR/CENTAURI containing and consisting marks. Printouts of these registrations downloaded from the PTO’s online database are attached hereto as **Exhibit 5** and made of record.

In particular, Applicant notes the following marks for Class 42 services already coexist in the PTO:

Mark	Reg. No.	Identification of Services in Class 42
THE RESEARCH CENTAUR	4685576	Computer software research and development; Computer game research and development; Video game research and development
CENTAURUS TECHNOLOGY	4352018	Research and design in the fields of solar cells and solar cell manufacturing; industrial analysis and research services in the fields of solar cells and solar cell manufacturing; design and development of computer hardware and software in the fields of solar cells and solar cell manufacturing; research in the field of photovoltaics, particularly in the field of production of solar cells; mechanical and technical research in the fields of solar cells and solar cell manufacturing; construction drafting in the fields of solar cells and solar cell manufacturing; technical project studies for projects of the solar cell industry; technical studies concerning commissioning of machines and installations consisting thereof for the production of solar cells; development of machines,

		installations and processes for the solar cell industry, particularly for the production of solar cells; technical consultancy in the field of photovoltaics, particularly in the field of the production of solar cells; services of physicists in the fields of solar cells and solar cell manufacturing; services of chemists in the fields of solar cells and solar cell manufacturing
CENTAURUS CONSULTING GROUP	4474606	Consulting services in the fields of biotechnology, pharmaceutical research and development, laboratory testing, diagnostics, and pharmacogenetics
CENTAUR SCULPTURE GALLERIES	1560242	Art gallery services
CENTAURI ADVANCE	5068154	Cloud computing featuring software for use to provide data collection, analytics, risk stratification and reporting in the management of risk adjustment and quality-based revenue programs for health plans and at-risk providers
CENTAURUS CONSULTING GROUP	5871953	Technical consulting in the field of pharmaceutical studies

Printouts of these registrations and applications downloaded from the PTO's online database are attached hereto as **Exhibit 6** and made of record.

It is well recognized that the very existence of multiple registrations negates the likelihood of confusion between marks. Thus, due to the coexistence of all of the cited and referenced marks and all these other marks, the potential 2(d) refusals should be removed. See Loctite Corp. v. Tubbs Cordage Co., 175 U.S.P.Q. 663, (T.T.A.B. 1972); and In re Shoe Corp. of American v. The Juvenile Shoe Corp. of America, 121 U.S.P.Q. 510, 512-13.

Given the common registration, Applicant's mark should also be registered. In fact, in light of the previous stance of the PTO, it seems difficult to reconcile the Examining Attorney's position in this matter. As the Board has stated that the PTO should avoid inconsistent practices, Applicant submits that it should not be singled out and subjected to inconsistent treatment in this case. See, e.g., In re Women's Publishing Co., Inc., 23 U.S.P.Q.2d 1876, 1878 (T.T.A.B. 1992). Accordingly, the potential Section 2(d) refusal should be removed.

CONCLUSION

In performing any likelihood-of-confusion analysis, it is essential to remember that likelihood of confusion "is synonymous with 'probable' confusion - it is not sufficient if confusion is merely 'possible.'" 2 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition § 23:3 (4th ed. 2006). Or, as the Court of Appeals for the Federal Circuit has put it, "[w]e 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." Elec. Design & Sales, supra. See also Phoenix Closures Inc. Yen Shaing Corp. Ltd., 9 U.S.P.Q.2d 1891, 1894 (T.T.A.B. 1988) ("While it is theoretically possible for opposer's mark PHOENIX to be affixed to [its goods] in [a] manner such that it would be visible to an ultimate purchaser of [applicant's goods], this Board will not base a finding of likelihood of confusion upon such theoretical possibilities."); Restatement (Third) of Unfair Competition § 20 cmt. g (1995) ("[A] few particularly undiscerning persons may make purchasing decisions under a wide range of misconceptions. An actor is subject to liability for infringement only if the actor's use of another's designation is likely to confuse a significant number of prospective purchasers").

Given the fact that Applicant's services are vastly different in purpose and function from the services in the referenced application, the specialized and sophisticated nature of Applicant's services (and the services

in the referenced applications), it cannot be said that confusion with respect to a significant number of prospective purchasers is probable, as opposed to a theoretical possibility with respect to some de minimis number of undiscerning purchasers. Accordingly, Applicant respectfully requests the Examining Attorney withdraw the potential Section 2(d) refusals.

Applicant submits it has responded to all outstanding issues raised in the Office Action. The Examining Attorney is encouraged to contact the undersigned if the Examining Attorney has any questions or requires any additional information.

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