

Response to Office Action

This is in response to the Office Action issued May 30, 2019.

Prior Application

The Examining Attorney has raised the issue of a potential refusal based on Application Serial No. 87636547 for “Voltage Modular” (the “Cited Application”). While Applicant disagrees that there would be a likelihood of confusion between the marks, Applicant requests that action on the subject application be suspended pending disposition of the Cited Application.

Section 2(d) - No Likelihood of Confusion

Applicant submits that the refusal to register the subject mark, VOLTAGE and design (“Applicant’s Mark”), based on a likelihood of confusion with Registration Nos. 2113527 for HIGH VOLTAGE, 4501068 for VOLTAGE PICTURES, 4888809 for “Voltage Visuals”, 5562381 for NINJA VOLTAGE and 5579959 for VOLTAGE (the “Cited Marks”), is traversed for the reasons stated below.

There are several independent reasons why the refusal is inappropriate and should be withdrawn, and when they are considered together, the case is even more compelling. The reasons include the following:

1. The Cited Marks are all owned by different registrants and coexist with each other.

With one exception (distinguishable) they all are composite marks and therefore are

- considerably different than Applicant's marks when they are compared in their entireties. There is no reason why Applicant's mark cannot similarly coexist.
2. The one registration for VOLTAGE alone, No. 5579959, covers only computer software and services. Applicant's business is very different, as noted below.
 3. Applicant is an advertising agency. It is not in the software or technology business. To the extent its coverage includes overlapping services in that regard, Applicant *would be willing to delete that coverage.*
 4. In fact, it is noted that each citation only pertains to a single class. Applicant would be willing to work with the Examining Attorney to delete certain services from its coverage in Classes 41 and 42 with the expectation that such a modification would allow for withdrawal of the citations.

Identification of Services

Applicant requests that identification of services be amended to read as follows (changes shown in **bold**):

- Class 35: Advertising, marketing, promotional and public relations services; corporate communications services being public relations services; advertising **and** marketing agency, **namely, promoting the goods and services of others**; public relations agency services; project management services **for others for business purposes** relating to advertising, marketing, promotional and public relations; **conducting** marketing studies; online and internet advertising, promotion and marketing services; internet keyword marketing services; experiential marketing, promotion and advertising services, **namely, the development of advertising** campaigns; immersive and virtual marketing, promotion and advertising services, **namely, the development of advertising** campaigns; viral marketing, promotion and advertising services, **namely, the development of advertising** campaigns; video marketing, promotion and advertising services, **namely, the development of blast campaigns containing video clips; developing** advertising campaigns **for television, print media, and web pages; developing** advertisements; public relations services; field marketing **services in the nature of marketing activities that involve face-to-face contact with the consumer**; business consulting and advisory services; business networking; organization

of exhibitions and trade fairs for commercial and advertising purposes; marketing, advertising and consultancy services in **the field of** brand strategies, brand relationships, customer relationship marketing, loyalty marketing and consumer targeting; **market research analysis for the purpose of** segmentation and profiling of market data; database marketing services in **the nature of marketing the databases of others and marketing services which utilize marketing databases**; analysis of consumer responses to advertising; creation and development of retail **marketing and advertising** strategies; consumer strategy business consulting in **the field of** optimising the utilisation of retail floor space; **conducting marketing** studies, analysis, statistical **evaluation, and creating and compiling** databases relating to business, marketing and marketing information; advertising, marketing and advertising and marketing consultancy services **for** businesses that provide data mining, data manipulation, data cleansing, data transformation, data operations and transmission of data services; providing on-line information in **the field of** advertising and business consultancy services; talent management and talent agency services for entertainers, musicians, artists; marketing research services; retail **marketing** research services, namely, research relating to competition and branding in the retail sector; marketing services in **the nature of** business data analysis of market, business and industry trends; reprographic services, namely, copying of documents for others; advertising services relating to packaging; public relations services, namely, management of news and press coverage and stories; communications services in **the nature of custom writing services** for public relations purposes; public relations services provided through all public communications means; writing of publicity texts, namely, creating press releases; production of video recordings, audiovisual recordings, and digital video and audiovisual recordings for advertising purposes, marketing purposes, publicity purposes, promotional purposes, and public relations purposes; employment staffing consultancy services; **professional staffing and recruiting services, namely**, staff utilisation planning, namely, professional staffing and recruiting services, staff management and management advice relating to staff, namely, professional staffing and employment staffing consultation services; promoting good employment practices **through the use of awareness of benefits marketing campaigns**; promoting the goods and services of others through targeted advertising; conducting, organising, holding, arranging business conferences; conducting, organising, holding, arranging trade conferences, shows and exhibitions in the field of advertising, marketing, and music used for commercial purposes; advertising services, namely, creating corporate and brand identity for others; corporate identity and brand development services for corporate clients; consultancy and advice **services in the field of** brand creation and development; corporate image development consultancy and advice **services**; branding services, namely, consultancy, and advice and information services in **the field of** management and marketing of brands, creating brand identity and brand development for businesses and individuals; **providing educational information in the field of branding; design of point of sale material being advertising material; design of customer information leaflets being advertising material; design consultancy, design and design advice and information services, namely, design of advertising materials relating to brands; consultancy services in the field of data manipulation and data cleansing, both in the nature of data processing**; provision of information, advisory and consultancy services in relation to the aforementioned services

- Class 41: Education and entertainment services **in the nature of organizing, conducting, hosting seminars in the field of marketing; organizing community** sporting and cultural activities; **book, magazine and music** publishing and editing services; publication of printed matter; publication of electronic **matter, namely magazine, books and reviews**; non downloadable electronic publications **in the nature of magazines and journals in the field of design, graphic design, interior, exterior design retail graphics, commercial space, retail design, sustainable design, branding, photo-shoots, website creation, film creation, interactive environment creation** provided via a computer database or from the Internet; publications **in the nature of magazines and journals in the field of design, graphic design, interior, exterior design retail graphics, commercial space, retail design, sustainable design, branding, photo-shoots, website creation, film creation, interactive environment creation** being not downloadable from databases or the Internet; electronic games services provided by means of the Internet; arranging of **educational** conferences, colloquiums, competitions, seminars, symposiums, **and** workshops; **arranging** art shows **in the nature of art exhibitions**; **Educational services, namely, offering** training and **educational** seminars **in the field of** design, graphic design, interior, exterior design retail graphics, commercial space, retail design, sustainable design, branding, photo-shoots, website creation, film creation, interactive environment creation; **providing educational** information **in the field of photography in the nature of** photo-shoots, **and film production; providing online non-downloadable instructional videos in the field of the rental and design of** buildings, shops and commercial/industrial premises; **entertainment services, namely, non-downloadable** ring tones **accessible** from the Internet; provision of online electronic publications **in the nature of magazines and journals in the field of** design, graphic design, interior, exterior design retail graphics, commercial space, retail design, sustainable design, branding, photo-shoots, website creation, film creation, interactive environment creation; news reporting **in the field of current events**; news reporter services; **providing** information about **sporting** events; production of radio and television programs; videotape film production; production of **television** shows; ticket reservation services relating to entertainment **events; entertainment services, namely,** organising, conducting, staging of, judging of and providing facilities for games, competitions and awards **therefor**; arranging award ceremonies **to demonstrate excellence in the field of marketing and advertising; hosting social entertainment events, namely,** gala evenings; arranging and conducting award programs and ceremonies to recognize excellence in the field of brand placement **arranging** competitions, contests, games and quizzes **in the field of** design, graphic design, interior, exterior design retail graphics, commercial space, retail design, sustainable design, branding, photo-shoots, website creation, film creation, interactive environment creation; electronic games services provided by means of the Internet or other communications networks, **namely, global**

communications networks; provision of information, advisory and consultancy services for all the aforesaid

- Class 42: Design services **in the field of graphic design**; implementation of design, **namely, graphic design services**; design and development of downloadable application software design and development of computer hardware and software; design, development, implementation, updating of software and **computer programming**; **interior and graphic design services for business**; **planning and design services for retail premises**; **retail premises exterior design services**; interior design services; **new product design and packaging design services**; graphic design; website design and development; **providing technology consulting in the field of social media design and development**; animation design **for others**; special-effects design **for others**; audio design services **for others**; website design services; **hosting of online websites featuring graphic design, interior design, planning and layout design services for interior space of retail business establishments, sustainable community planning and infrastructure development, and website development**; prototypes and roll-out design services **for others in the nature of graphic design, interior design, planning and layout design services for interior space of retail business establishments, sustainable community planning and infrastructure development, and website development**; design, drawing and **develop webpages, including creation of writing and text on webpages**; creating, testing and maintaining websites **for others**; hosting the websites of others; installing, **namely, implementing websites for others**; design consultancy, design and design advice and information services, **namely, designing websites for advertising purposes relating to brands**; software-as-service services **featuring software for advertising, marketing, promotional, public relations purposes for use in database management, service desk management and accounting**; **providing Internet search engine services**; digital **computer coding services for others in the nature of coding of messages in the nature of graphic design, interior design, planning and layout design services for interior space of retail business establishments, sustainable community planning and infrastructure development, and website development**; consultancy services in the field of data mining; **providing educational information in the field of graphic design, interior design, planning and layout design services for interior space of retail business establishments, sustainable community planning and infrastructure development, and website development**; **providing a web site featuring temporary use of non-downloadable software allowing web site users to edit, post, display, tag, share images, graphics, sound, text or audio-visual information**; information, research, evaluation and consultancy services relating to any of the aforesaid

Significance of Mark

In response to the request for the significance of the mark, Applicant states that the wording in the mark "VOLTAGE" has no meaning or significance in the trade or industry in which Applicant's services are manufactured or provided, nor does/is the term: (1) have any meaning or significance as applied to Applicant's services, and (2) a term of art within Applicant's industry.

Conclusion

Applicant requests that the refusal be withdrawn and that the subject application be accepted.

Respectfully submitted,

DAVIS & GILBERT LLP

By: /Jeffrey C. Katz/

Jeffrey C. Katz
1740 Broadway
New York, NY 10019
Telephone: (212) 468-4800
Facsimile: (212) 468-4888
Attorneys for Applicant
NYS Bar Member