

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Gatsby Inc.
Serial No.: 88/330,425
Mark: GATSBY
Filing Date: March 7, 2019
Classes: 9 and 42
To: Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451
Attn: April A. Hesik
Examining Attorney
Law Office 124

RESPONSE TO OFFICE ACTION

Applicant Gatsby, Inc. (“Applicant”), by and through its counsel, hereby responds to the Office Action issued in connection with the above-captioned application (“Application”) for the mark GATSBY (“Applicant’s Mark”).

I. AMENDMENT TO DESCRIPTION OF GOODS AND SERVICES

In response to the Examining Attorney’s request, and to further clarify the nature of Applicant’s goods and services, Applicant amends the identification of goods and services as follows:

original identification of goods:

Class 9: Computer software and software as a service for use in designing, developing, creating and running websites and computer applications.

amended identification of goods and services

Class 9: Downloadable computer software for use by software developers in designing, developing, creating and running websites

Class 42: Software as a service featuring software for use by software developers in designing, developing, creating and running websites

II. THERE IS NO LIKELIHOOD OF CONFUSION BETWEEN APPLICANT’S MARK AND THE CITED MARKS

As an initial matter, and as reflected in the USPTO Application record, Applicant owns a valid prior registration for the mark GATSBY in Class 9 for use in connection with “*computer software for allowing the contents of databases to be viewed and edited over a communications network using a browser*” (Reg. No. 3,993,44) (the “Senior GATSBY Registration”). The Senior GATSBY Registration specifies a first use date of September 17, 1990, a filing date of December 7, 2010, and a registration date of July 12, 2011, which substantially predate the claimed first use, filing, and registration dates in all of the third party filings referenced by the Examining Attorney. The goods covered by Applicant’s Senior GATSBY Registration consist of technical software similar in purpose to that specified more precisely in the instant Application.

Based on the recitation of goods and services originally set forth in the Application, the Examining Attorney has expressed concern that Applicant’s Mark is likely to be confused with the three registrations listed in Table 1 below (“Cited Registrations”), and the three pending applications listed in Table 2 below (“Cited Applications”). The marks in the Cited Registrations and Cited Applications are collectively referred to herein as the “Cited Marks.”

Table 1: Cited Registrations

Reg. No.	Mark	Goods/Services	Owner	Reg. Date
				First Use Date
				Filing Date
4,860,424	GATSBY	Class 9: Computer game software for use on mobile and cellular phones, smartphones, tablets, portable media players, and handheld computer	Gemini Digital Development, Inc.	11/24/2015 06/2015 03/26/2014
5,307,371	GATSBY	Class 9: Computer application software for smartphones, mobile phones, handheld computers, PDA's, and pocket PC's for use in processing, editing, and sharing of photos, digital and graphic images, and videos	Greater Than Gatsby LLC	10/10/2017 11/01/2012 02/12/2016
5,498,257	GREATER THAN GATSBY	Class 9: Computer application software for handheld mobile computerized phones, mobile phones, handheld computers, PDA's, smartphones, and pocket PC's for use in processing, editing, and sharing of photos,		06/19/2018 11/01/2012 02/12/2016

		digital and graphic images, and videos.		
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Table 2: Cited Applications

App. No.	Mark	Goods/Services	Owner
86/232,454	GATSBY	Class 28: Gaming machines; Gaming machines for gambling; Gaming machines, namely, devices which accept a wager Class 41: Entertainment services, namely, providing on-line computer games	Gemini Digital Development, Inc.
88/168,172	GATSBY REAL ESTATE INVESTMENT	Class 9: Downloadable computer software related to real estate information and investment, namely, software for listing real estate investments, software for managing portfolios of real estate investments, and software for analyzing real estate and real estate investments; Downloadable computer software for searching, retrieving, viewing and providing information related to real estate markets, trends, properties, listings, and pricing	Gatsby Enterprises, LLC
88/129,803	GATZBE	Class 42: Providing a website featuring technology that enables event planners and property owners to connect for the rental of property for events	Gatzbe LLC

A. Likelihood of Confusion Factors

Among the factors to be considered in determining whether there is a likelihood of confusion between marks are:

- The similarity or dissimilarity and nature of the goods or services such that one party's goods will be mistaken for those of the other party;
- The channels of distribution of the goods or services;
- The sophistication of the purchasers of the goods or services;
- The number and nature of similar marks in use on similar goods or services; and
- The nature and extent of any actual confusion.

In re E.I. Du Pont De Nemours and Co., 476 F.2d 1357, 1361 (CCPA 1973).

As discussed below, the application of these factors in this case compels the conclusion that there is no likelihood of confusion between Applicant's Mark and the Cited Marks, especially in light of Applicant's amendment to the identification of goods and services in the Application. In addition, consistency of examination by the Trademark Office requires that Applicant's Mark be approved. Applicant's Senior GATSBY Registration predates the Cited Marks on the USPTO registry, and the goods and services offered under the Cited Marks are at least as similar to those covered by Applicant's Senior GATSY Registration as they are to the goods and services listed in the amended Application. The goods offered under the Cited Marks are also closer to each other than they are to the goods and services listed in the amended Application. If the Cited Marks can coexist with confusion on the registry both with Applicant's Senior GATSBY Registration and with one another, than they can certainly coexist with Applicant's Mark.

B. Applicant's Goods Are Not Similar to the Goods Offered Under the Cited Marks, Are Targeted to Different Consumers and/or Are Offered Through Distinct Channels of Trade

There is no likelihood of confusion in this case because the products and services offered under Applicant's Mark and the Cited Marks are not related or complementary to each other and are offered through different channels of trade. For goods to be "related" for purposes of a likelihood of confusion analysis, they must be related in some specific manner or the conditions surrounding their marketing must be such that the goods would be encountered by the same consumer under circumstances that give rise to the mistaken assumption that they originate from the same source. *See In re Total Quality Group, Inc.*, 51 U.S.P.Q.2d 1474, 1476 (T.T.A.B.1999); TMEP § 1207.01(a)(i).

This is true even in cases where two marks are identical. TMEP § 1207.1(a)(i) (citing, *e.g.*, *Local Trademarks, Inc. v. Handy Boys, Inc.*, 16 U.S.P.Q.2d 1156 (T.T.A.B.1990) (LITTLE PLUMBER for drain opener not confusingly similar to LITTLE PLUMBER and Design for advertising services)). Moreover, it is well established that there is no per se rule mandating that likelihood of confusion is to be found in all cases where the goods and services in question involve computer software and/or hardware. *See, e.g., Information Resources, Inc. v. X*PRESS Information Serv.*, 6 U.S.P.Q.2d 1034 (T.T.A.B. 1988) (citing *In re Quadram Corp.*, 228 U.S.P.Q. 863 (T.T.A.B. 1985)). "In order to support a holding of likelihood of confusion, there must be some similarity between the goods and services at issue herein beyond the fact that each involves the use of computers. In view of the fact that computers are useful and/or used in almost every facet of the world of business, commerce, medicine, law, etc., it is obvious that distinctions must be made." *Reynolds & Reynolds Co. v. I.E. Systems, Inc.*, 5 U.S.P.Q.2d 1749, 1751 (T.T.A.B. 1987).

i. Cited Registrations

Here, the three marks in the Cited Registrations are used in connection with software products that are not similar to Applicant's offerings, that are instead designed for their own unique purposes unrelated to Applicant's goods and services, and that travel through distinct channels of trade.

The Cited Mark GATSBY owned by Gemini Digital Development, Inc. is used and registered in connection with computer game software for use on mobile devices. As seen below and in **Exhibit A** to the Declaration of Katherine Green (“Decl. of Katherine Green”) attached hereto, the specimen of use provided in support of the mark shows that GATSBY is very clearly used as the title of a *Great Gatsby* themed, casino style video game downloaded to mobile devices for video gamer players.



Consumers will likely only encounter Gemini Digital Development, Inc.’s GATSBY mark when specifically looking for video games as the product is accessed through a menu of downloadable mobile games. Thus the purpose of the products, the target audience and the channels of trademark are entirely different from those to which Applicant’s Mark is directed. As such, the possibility, let alone the likelihood, that the consumers of either Gemini Digital Development, Inc.’s or the Applicant’s offerings would be confused between these products and services is simply nil.

The Cited Marks GATSBY and GREATER THAN GATSBY, both owned by Greater Than Gatsby LLC, are used in connection with applications for “processing, editing, and sharing of photos, digital and graphic images, and videos.” Simply put, the marks are used on photo editing and sharing tools. As seen below in the screen capture from Greater Than Gatsby LLC’s website which is also attached hereto as **Exhibit B to the Decl. of Katherine Green**, the products offered by Greater Than Gatsby LLC are applications in the nature of photo editing and photo sharing tools specifically intended for use by photographers. For example and as further explained on this registrant’s website, these tools work with Photoshop® to improve or correct lighting or backgrounds in wedding photographs in order to render those photo portraits more attractive. The applications are accessible through Greater Than Gatsby LLC’s website which makes clear to consumers that the nature of their products is related to photography and targeted at photographers.

WELCOME TO GREATER THAN GATSBY



PHOTOSHOP ACTIONS



PHOTOSHOP OVERLAYS



LIGHTROOM PRESETS

CREATED BY PHOTOGRAPHERS FOR PHOTOGRAPHERS

SAVE BIG
WITH OUR BUNDLED COLLECTIONS

BUNDLE & SAVE \$767



THE
COMPLETE ACTIONS BUNDLE
PHOTOSHOP ACTIONS

Includes all 14 Action Collections
1,118 photoshop actions included
Save \$767 with this bundle!

~~\$126.00~~
\$29.00

ADD TO CART

BUNDLE & SAVE \$400



THE
COMPLETE PRESETS BUNDLE
LIGHTROOM PRESETS

Includes all 12 Preset Collections
470 lightroom presets included
Save \$400 with this bundle!

~~\$408.00~~
\$29.00

ADD TO CART

In contrast, and as clarified in Applicant’s amendment to the goods and services description submitted herewith, Applicant is a provider of sophisticated software used “by software developers in designing, developing, creating, and running websites.” Specifically, Applicant provides an open source, modern website framework that allows software developers to use the latest programming technologies to develop and run high performing websites. As seen in the specimen submitted in support of Applicant’s Mark, a portion of which appears below merely accessing Applicant’s goods and services requires specialized technical computer knowledge and a familiarity with coding languages.

Get Up and Running in 5 Minutes

You can get a new Gatsby site up and running on your local dev environment in 5 minutes with these four steps:

1. Install the Gatsby CLI.

```
npm install -g gatsby-cli
```

2. Create a Gatsby site from a Gatsby starter.

Get your Gatsby blog set up in a single command:

```
# create a new Gatsby site using the default starter
gatsby new my-blazing-fast-site
```

3. Start the site in `develop` mode.

Next, move into your new site's directory and start it up:

```
cd my-blazing-fast-site/
gatsby develop
```

4. Open the source code and start editing!

Your site is now running at `http://localhost:8000`. Open the `my-blazing-fast-site` directory in your code editor of choice and edit `src/pages/index.js`. Save your changes, and the browser will update in real time!

At this point, you've got a fully functional Gatsby website. For additional information on how you can customize your Gatsby site, see our [plugins](#) and [the official tutorial](#).

The goods and services offered under Applicant's Mark are not used in connection with video games or photo editing and are intended for, and can only be accessed by, a highly specialized class of consumers. As such, they are completely different from, and do not overlap in any meaningful way with, the goods listed in the Cited Registrations. Other than involving software, which alone is insufficient to support a likelihood of confusion, Applicant's goods and services bear no relation to the goods and services listed in the Cited Registrations.

ii. Cited Applications

Applicant reserves the right, if the Examining Attorney deems it necessary, to present further arguments addressing the Examining Attorney's concern regarding a likelihood of confusion with the marks in Cited Applications; however, even a cursory review of the identification goods and services listed in the Cited Application makes clear that they are entirely unrelated to the goods and services offered under Applicant's Mark and encompassed by the amended Application.

The Cited Applications cover gaming machines and computer games (App. No. 86/232,454), software related to real estate information and investment (App. No. 88/168,172), and technology used to connect event planners and property owners to facilitate property rental for events (App.

No. 88/129,803). The Cited Applications were filed on an intent to use basis and Notices of Allowance have been issued for all three.

Like the goods covered under the Cited Registrations, the goods and services listed in the Cited Application are entirely distinct from the goods and services offered under Applicant's Mark. To the extent that there is *any* meaningful relationship at all between the various trademark owners' offerings, the real estate services and the event planning and property rental services are much more closely related to each other than they are to the website software development and operation services in the instant Application. If the Cited Applications can coexist on the USPTO registry with each other and with the Cited Registrations without risk of confusion and with Applicant's Senior GATSBY Registration, so too can Applicant's Mark as described in this Application.

C. Consumer Sophistication and Specialization Weighs Against a Likelihood of Confusion.

It is well settled that likelihood of confusion is reduced where purchasers and potential purchasers of the products are sophisticated. *Electronic Design & Sales v. E.D.S.*, 954 F.2d 713, 718 (Fed. Cir.1992)). It has also been previously established that when a purchaser has a "reasonably focused need" or "specific purpose" or plan involving the product, the consumer will have a higher degree of ordinary care. See *Haydon Switch & Instrument, Inc. v. Rexnord, Inc.*, 4 USPQ2d 1510, 1517 (D. Conn. 1987) ("It is thus evident that the sophisticated purchasers of the products of plaintiffs or Rexnord enter the marketplace in search of specific products for specific industrial purposes. The sophistication of these purchasers makes the likelihood of confusion remote.")

In this case, Applicant's consumers are highly sophisticated and specialized software developers looking for open source software tools for the focused purpose of "designing, developing, creating and running websites." Software developers, by definition, are particularly well-informed and discerning with respect to software. They exercise a high level of care in making important decisions affecting their choice of technological tools, taking into consideration a myriad of factors, such as overall functionality and performance demands, as well as the specific technology featured in the products. Because they are sophisticated and because they are looking for the particular goods and services that Applicant provides, Applicant's software developer customers are highly *unlikely* to be confused into thinking Applicant's goods and services originate from or are sponsored by the owners of the Cited Registrations, which provide video games and photo editing tools for photographers.

Similarly, the purchasers of the video games and photo editing tools for photographers offered under the Cited Registrations are not likely to be confused in their purchasing decisions based on the existence of Applicant's Mark. Consumers playing or looking to play Gemini Digital Development, Inc.'s *Great Gatsby* themed video game, which is clearly designed to evoke the wealth and excess featured in the novel, are not going to be confused and mistakenly believe that there is any connection between the game and Applicant's website development software, regardless of their level of sophistication.

Likewise, there is virtually no chance that Greater Than Gatsby's customers will be confused between Applicant's use of Applicant's Mark and the Greater Than Gatsby photography software.

Greater Than Gatsby's customers are sophisticated professional photographers with advanced knowledge of photo editing. They enter the marketplace seeking specialized tools to enhance and process images from, for example, professional wedding and newborn photoshoots. As such, they too can be presumed to be sophisticated and careful consumers. Because the nature, purpose, and function of Applicant's website development and operation goods and services are entirely different – and immediately distinguishable as such - from Greater Than Gatsby's product, confusion as to the source of either entity's offerings is highly unlikely.

III. CONCLUSION

Perhaps because of the enduring popularity of F. Scott Fitzgerald's *The Great Gatsby*, the term "Gatsby" is popular in marks used with a wide range of goods and services. In particular, and as discussed above, the USPTO register reflects that the Cited Registrations coexist not only with one another and with the Cited Applications, *and* Applicant's Senior GATSBY Registration. This coexistence demonstrates that consumers are accustomed to differentiating between various GATSBY marks and that confusion is unlikely to occur between Applicant's Mark and the Cited Marks, particularly where the underlying offerings are so highly distinctive, offered for specialized purposes and to different consumers.

For the foregoing reasons, Applicant respectfully submits that it has fully addressed the outstanding Office Action and earnestly requests that the instant Application be approved for publication.