

issued a refusal under Section 2(d) of the Trademark Act in view of U.S. Registration No. 2,787,311 for the mark PROXIMITY (the “Cited Registration”); and issued an advisory that the subject application may be suspended and registration of Applicant’s Mark may be refused under Section 2(d) in view of Application Nos. 88/097,511 for the mark PROXIMITY, 87/659,432 for the mark PROXIMITY PARKS, 88/101,884 for the mark PROXIMITY NOMAD, 87/271,830 for the mark PROXIMITY MX, and 79/258,388 for the mark PROXIMITY DMP (collectively, the “Referenced Applications”). In this Response, Applicant amends the identification. However, Applicant respectfully submits, and establishes herein, that there is no likelihood of confusion with respect to Applicant’s Mark and the Cited Registration. Applicant further submits that the application should not be suspended on the grounds that a likelihood of confusion may arise with respect to Applicant’s Mark and the Referenced Applications. The Cited Registration and Referenced Applications cover products and services unrelated to the services claimed in the subject application. Accordingly, Applicant’s Mark is entitled to registration.

AMENDMENT

The Examining Attorney requests that Applicant specify the exact nature of the applied-for services. Applicant now amends the identification of services as set forth below, and concurrently submits this amendment via the electronic response form.

Class 35: ~~Data management services, namely, data center services in the nature of management and processing of data; business management of data centers for others;~~ **Consultation in the field of energy efficiency of modular and hyper-scale data centers; Consultation in the field of energy efficiency of green data centers in the nature of developing and operating data centers for others**

Class 37: **Construction services, namely, planning, laying out and construction of construction and placement of modular data centers for use in delivering data services to customers and partners; Consulting services for the construction of modular data centers;** ~~consultation services in connection with the construction,~~

~~optimization and energy consumption efficiency of modular data centers; installation services in the field of data center equipment and critical infrastructure~~ **equipment** used for airflow and temperature management, power distribution, and monitoring of alarm systems; Construction of green data centers for others; Construction planning of commercial buildings, namely, **planning of** green data centers; Land development services, namely, planning and laying out of commercial buildings, namely, **in the nature of** green data centers; **Consulting services for the construction of green data centers** ~~consultation services in connection with the construction, optimization and energy consumption efficiency of green data centers; installation services in the field of data center equipment and critical infrastructure used for airflow and temperature management, power distribution, and monitoring of alarm systems~~

ARGUMENT

I. There Is No Likelihood of Confusion with Respect To Applicant's Mark and the Cited Registration.

In order to refuse registration of a mark under Section 2(d), the Examining Attorney must establish that the subject mark so resembles a registered mark as to cause confusion as to the source or sponsorship of the goods or services offered under the respective marks. TMEP § 1207.01. The Examining Attorney must consider the factors articulated in *In re du Pont de Nemours & Co.*, 476 F.2d 1357 (C.C.P.A. 1973). Only the factors relevant to the mark at issue should be considered and each case should be decided on its own particular facts. *In re Mighty Leaf Tea*, 601 F.3d 1342 (Fed. Cir. 2010). The key factors to consider in the present matter are the relatedness of the services covered by the Cited Registration and the Referenced Applications and the number and nature of similar marks registered for use with similar goods and services. Confusion is not likely if Applicant's services and those covered by the Cited Registration "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." TMEP § 1207.01(a)(i).

The Cited Registration, owned by BBDO Worldwide Inc. (the "Registrant"), recites the

following services:

Class 35: Advertising, marketing and publicity services, direct marketing services, conducting market surveys and market research, market analysis services, database marketing, consulting services related to advertising, customer relationship marketing services, advertising and marketing services targeted at specific individuals or groups, telemarketing, public relations, business advisory services, media planning and media buying, event marketing, and sales promotional services

Class 42: Graphic design services, web design services, interactive communication design services, creative design services in relation to advertising, marketing and publicity, and organization of business conventions and trade shows

The Examining Attorney contends that the Registrant's "business advisory services" encompass the data management and construction services recited in the subject application. Applicant respectfully disagrees and, especially in light of the amendment set forth above, contends that consumers are not likely to be confused or mistakenly believe that the Registrant's services and Applicant's services originate from a common source.

Business advisory services do not encompass and are not related to Applicant's services. The term "business" refers to "an organization or enterprising entity engaged in commercial, industrial, or professional activities" or "the organized efforts and activities of individuals to produce and sell goods and services for profit." Exhibit A. "Business advisory services" constitute strategic planning to financially grow businesses and enhance profitability. *See* Exhibit B. Examples of business advisory services include financial reporting, business valuations, accounting, budgeting, marketing and advertising consultancy, and market analysis. *Id.* As these examples demonstrate, business advisory services are rendered directly for the financial benefit of commercial entities. Business advisory services do not include every possible aspect of every possible organization. *See, e.g., In re Joekel*, Serial No. 85/204,813 (T.T.A.B. 2013) (not precedential) (noting registrant's and applicant's identifications of services were in part identical because both included "administration of business payroll for others," but not because

applicant's business advisory services included registrant's business payroll administration services).

Business advisory services are not overlapping or competitive with Applicant's data center services. The term "data center" refers to a physical "facility that centralizes an organization's IT operations and equipment" and where the organization "stores, manages, and disseminates its data." Exhibit C. Data centers do not directly affect the profitability of organizations. Moreover, Applicant's consultation services regarding energy efficiency and Applicant's construction services for data centers do not fall within the gamut of business advisory services, because Applicant's services are not "producing goods and services for profit" or "selling goods and services for profit." Rather, Applicant's services focus on environmental sustainability, energy-efficiency, and the construction of facilities. The purpose of Applicant's services is to enhance physical data centers, not to improve the profitability of commercial entities. In other words, the return consumers receive when investing in business advisory services is higher profit and financial management. The return consumers receive when investing in Applicant's services is energy-efficient processes, as well as well-constructed and well-organized facilities, for storing, managing, and disseminating data. These differences in services confirm that confusion between the two marks is highly unlikely.

Confusion is also unlikely given the weakness of the mark of the Cited Registration. The use of similar trademarks by third parties for similar goods and services indicates that a mark is relatively weak and entitled to only a narrow scope of protection. *General Mills, Inc. v. Kellogg Co.*, 824 F.2d 622, 626–27 (8th Cir. 1987); *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 1373 (Fed. Cir. 2005); *see also* TMEP § 1207.01(d)(iii) ("Evidence of third-party use falls under the sixth du Pont factor – the 'number and nature of

similar marks in use on similar goods.’ If the evidence establishes that the consuming public is exposed to third-party use of similar marks on similar goods, it ‘is relevant to show that a mark is relatively weak and entitled to only a narrow scope of protection.’” (citations omitted)). As the Examining Attorney has highlighted, there are numerous other PROXIMITY marks used with services in Class 35 and with other services closely related to the Registrant’s business advisory services. As a result of the substantial third-party use of PROXIMITY marks, PROXIMITY is weak when used with the Registrant’s services and the Registrant is only entitled to a narrow scope of protection.

For the foregoing reasons, no likelihood of confusion exists with respect to Applicant’s Mark and the Cited Registration.

II. Applicant’s Mark Is Not Likely to Be Confused with the Marks in the Referenced Applications.

Applicant respectfully submits that there is no reasonable likelihood of confusion with respect to Applicant’s Mark and the marks of the Referenced Applications. Below is a comparison of the respective services in each application, with a focus on services in Classes 35 and 37 where applicable. As demonstrated below, there is no likelihood of confusion because the marks only share the term PROXIMITY, which is a weak term when used for services in Classes 35 and 37. Additionally, the marks’ respective services are not related to Applicant’s services.

Consumers are highly unlikely to believe Applicant’s services and the services recited in Application No. 88/097,511 for the mark PROXIMITY, owned by Proximity Space, emanate from the same source. Unlike the subject application, the Proximity Space application does not cover services in Classes 35 or 37. Instead, Proximity Space claims to use the PROXIMITY

mark in connection with computer programs and software, the provision of an online portal for financial transactions and payment processing services, and the provision of a website for party and entertainment events. These services do not fall within the data center industry and do not overlap with Applicant's services. Because the services are unrelated, no likelihood of consumer confusion will exist.

Consumers are similarly unlikely to mistakenly believe Applicant's services and the services recited in Application No. 87/659,432 for the mark PROXIMITY PARKS, owned by Mario Berlanga Villarreal, emanate from the same source. The Villarreal application covers "real estate development" services in Class 37. These services are completely unrelated to Applicant's services. Villarreal's services are specifically narrowed to the real estate industry. Applicant's services are narrowed to the field of data centers. There is no overlap between the real estate and data center industries. Furthermore, the additional term PARKS in the PROXIMITY PARKS mark creates a commercial impression distinct from that of the proposed mark.

Likewise, Applicant's Mark will also not be confused with the PROXIMITY mark in Application No. 87/271,830 for PROXIMITY MX, owned by July Systems Inc. PROXIMITY MX and PROXIMITY differ in overall appearance, sound, and meaning. The marks also differ in terms of their respective services. The July System application recites the following:

Class 35: Advertising, marketing and promotion services; Business advice and information; Collection and systematisation of information into computer databases; Compilation and systemization of information into computer databases; Electronic commerce services, namely, providing information about products via telecommunication networks for advertising and sales purposes; Information services relating to business matters; Inventory control; Providing commercial information in the field of business information and research services; Provision of information and advice to consumers regarding the selection of products and items to be purchased

The services recited in the July System application pertain to the commercial aspect of

businesses and have nothing to do with consultation in the field of energy efficiency of data centers or construction services for data centers. Applicant's efficiency-related consultation and construction services cannot be construed as advertising services, providing business advice, databasing services, electronic commerce services, providing business information and research, or aiding consumers in purchase decisions. Because Applicant's and July System's respective services are wholly unrelated, there is no likelihood of consumer confusion.

Lastly, Application No. 79/258,388 for the mark PROXIMITY DMP, owned by Beaconside GmbH, recites various services for businesses, such as business management, business administration, business consultancy services, and market research. Specifically, the Beaconside application recites the following:

Class 35: Business management; business administration; business consultancy services; office functions; business services, namely, computer-assisted database and file administration namely, computerized file and database management; administrative data processing; advertising agency services; advertising, marketing and sales promotion; advertising and marketing consultancy; promotion of sales; the bringing together, for the benefit of others, of a variety of goods, namely, computers, home electronics devices, telecommunication devices, cellular phones, digital electronic pocket devices, computer software and accessories, peripheral devices and carrying containers for such products, [excluding the transport thereof] enabling customers to conveniently view and purchase those goods and services; sales promotion for goods and services of third parties; market research; market research and analyses; drafting, design, creation, production and dissemination of advertisements and advertising materials for third parties; planning of advertising measures and marketing strategies; administration of customer loyalty programmes which provide free or discounted goods or services if customers repeatedly purchase goods at a certain store; planning and implementation of incentive premium programmes for sales promotion for goods and services; provision of economic, consumer and trade information via computer networks and worldwide communication networks in the field of consumer product information; business services, namely, collection, updating and maintenance of data in databases; online retail services via the internet and other electronic and communication networks in the field of books, magazines, periodicals, newsletters, journals and other publications on a wide range of topics of general interest; online retail store services via the internet and other electronic and communication networks featuring, electronic games, computer software applications, musical works and sound and audiovisual works; online retail store services via the internet and other electronic

and communication networks featuring computers, home electronics devices, telecommunication devices, cellular phones, digital electronic pocket devices, computer software and accessories, peripheral devices and carrying containers for such products; retail store services in the field of books, magazines, periodicals, newsletters, journals and other publications on a wide range of topics of general interest; retail store services featuring electronic games, computer software applications, musical works and sound and audiovisual works; retail store services featuring computers, home electronics devices, telecommunication devices, cellular phones, digital electronic pocket devices, computer software and accessories, peripheral devices and carrying containers for such products; presentation and demonstration of goods, namely, providing television home shopping services in the field of general consumer merchandise; subscription to information media packages including texts, data, graphics, images, sound contents, video contents, electronic publications, computer software applications, electronic games and other multimedia contents, provided via newspapers via the internet and other electronic and communication networks; planning and conducting of conferences, shows and exhibitions for commercial, trading and business purposes; information and advice with respect to all services stated above

Applicant notes that these services are more clearly related to the services in the Cited Registration than to Applicant's services, yet the examining attorney for the Beaconside application stated that she found no conflicting marks that would bar registration. For reasons similar to those conveyed regarding the Cited Registration, no likelihood of confusion will arise between the Beaconside mark and Applicant's Mark. None of the services identified in the Beaconside application are broad enough to encompass consultation services in the field of energy efficiency or construction services for data centers. Confusion is further unlikely because the composite mark PROXIMITY DMP and Applicant's Mark, which only consists of the weak term PROXIMITY, differ in terms of overall sight, sound, and meaning.

CONCLUSION

Applicant has established in this Response that likelihood of confusion between Applicant's Mark and the cited references is exceptionally low, and requests that the Examining Attorney withdraw her Section 2(d) refusal and approve the application for publication.

Dated: November 29, 2019

Respectfully submitted,

/s/ Lynn E. Rzonca

Lynn E. Rzonca

Dacia A. Green

1735 Market Street, 51st Floor

Philadelphia, PA 19103-7599

215.864.8109 direct

215.864.8999 fax

Attorneys for Applicant