

Applicant has filed for registration of the mark EMERGE as applied to “Software as a service (SAAS) services featuring cloud-based software solutions that enable customers and their channel partners to configure, price, quote and place orders in the field of doors and building materials” in International Class 42.

The Examining Attorney has refused registration under Section 2(d) on the ground of likelihood of confusion with the mark of U.S. Registration No. 4560285 for EMERGE (“the Cited Registration”) as applied to, the following services:

“Providing non-downloadable software on a global computer network for obtaining data for business and consumer purposes; providing temporary use of non-downloadable software allowing customers to order, search, and retrieve reports containing information relating to people, properties, businesses, events, and identity verification,” in International Class 042, and

“Providing pre-employment and other background checking services to businesses and individuals,” in International Class 045.

Applicant respectfully submits that the Section 2(d) refusal is misplaced, and respectfully requests reconsideration and withdrawal of the same based on the following arguments and accompanying evidence.

Likelihood of confusion under the Lanham Act, 15 U.S.C. §1052(d), is found where a mark is so similar to a registered mark “as to be likely, *when used on or in connection with the goods of the applicant*, to cause confusion, or to cause mistake, or to deceive.” (Emphasis added.) It is a “legal determination based upon factual underpinnings.” *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 1371, 73 USPQ2d 1689 (Fed. Cir. 2005) (citing *On-Line Careline, Inc. v. Am. Online, Inc.*, 229 F.3d 1080, 1084 (Fed. Cir. 2000)). Such a finding should be evaluated on a “case-by-case basis, aided by the application of the factors set out in *In re E.I. DuPont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (CCPA 1973).” *On-Line Careline* 229 F.3d at 1084. Only those factors that are relevant need be considered. *M2 Software, Inc. v. M2 Commc’ns, Inc.*, 450 F.3d 1378, 1382, 78 USPQ2d 1944 (Fed. Cir. 2006).

Applicant seeks registration of its EMERGE mark in association with, as indicated above, “software as a service (SAAS) ... *in the field of doors and building materials.*” The entire identification of goods is characterized as being associated with and pertaining to the field of doors and building materials, which are used consistent with their ordinary meanings. A door denotes, among other things set forth by dictionary.com/browse/doors?s=t (Exhibit 1), a movable, usually solid, barrier for opening and closing an entranceway, cupboard, cabinet, or the like. The same site denotes a building “as a relatively permanent enclosed construction over a plot of land, having a roof” *See* dictionary.com/browse/building?s=ts (Exhibit 2).

In contrast, the Cited Registration applies to obtaining data for people and businesses pertaining to background check information and identity verification. The Cited Registration has nothing to do with and is in no way related to doors or building materials. A consumer would not think that background check information and information about doors and building materials were related or from the same source.

In the Office Action, the Examining Attorney asserts that the Cited Registration “uses broad wording to describe the relevant services which *presumably* encompasses all services of the type described, including the applicant’s more narrowly defined services.” (Emphasis added). Applicant respectfully disagrees for at least the following reasons.

First, TMEP § 1207.01(a)(iv) cites *M2 Software, Inc. v. M2 Commc'ns, Inc.*, 450 F.3d 1378, 1383, 78 USPQ2d 1944, 1947–48 (Fed. Cir. 2006) for the finding “that relatedness between software-related goods may not be *presumed* merely because the goods are delivered in the same media format and that, instead, a subject-matter-based mode of analysis is appropriate.” (Emphasis added). Here, the subject matter of the present application, *i.e.*, doors and building materials, is not subject-matter related to data for consumer and business purposes of conducting background checks and identity verification. Any similarities between the media format of the goods and services of the present application and the Cited Registration are not relevant to the likelihood of confusion analysis.

Second, Applicant respectfully submit that in construing the wording of the Cited Registration’s services “broad[ly],” the Office Action has given the identified services such a broad construction as to prevent all future applicants from obtaining a registration for any mark

similar to EMERGE in association with goods or services that are offered on the Internet. That cannot be intended scope of coverage of the Cited Registration.

Third, TMEP § 1207.01(a)(vi) provides that “[t]he examining attorney must provide evidence showing that the goods and services are related to support a finding of likelihood of confusion.” (Citations omitted). Here, the identification of goods/services of the Cited Registration does not in itself, *ipso facto*, establish relatedness of Applicant’s goods with the Cited Registration’s services. The Cited Registration’s identification of services, when taken as a whole, makes clear that the data for business and consumer purposes is data that business and consumers use to conduct background checks and identity verification. Applicant respectfully submits that there is no evidence of record showing the data and building material subject matter of the present application is related to background checks and identity verification so as to support a finding of likelihood of confusion.

Applicant acknowledges that TMEP § 12078.01(a)(iii) provides that “[t]he nature and scope of a party’s goods or services must be determined on the basis of the goods or services recited in the application or registration.” However, the same section of the TMEP further provides that “[i]n cases where the terminology in an identification is unclear or undefined, the Trademark Trial and Appeal Board has permitted an applicant to provide extrinsic evidence to show that the registrant’s identification has a specific meaning to members of the trade.” (Citations omitted). Here, the phrase “for obtaining data for business and consumer purposes” in the Cited Registration’s identification of services is undefined as to what the data is and what those purposes are. In such cases, it is appropriate, if not necessary, to consult extrinsic evidence to determine the meaning of the identification of goods and services of the Cited Registration.

Attached hereto as Exhibit 3 are printouts from the website, intelifi.com, of the current owner of the Cited Registration. The printouts make clear and unambiguous that the “data” provided by and the “purposes” of Intelifi’s services are for background checks and identity verification in the form of searches of people, criminal records, DMV records, verifications, and credit reporting, as well as providing drug testing. The website identifies Intelifi’s “Mission” as “to provide high quality background checks to recruiters and human resource professionals for all businesses nationwide.” See <https://intelifi.com/why-intelifi/vision/> (pages 40-43 of Exhibit 3).

The “data” identified in the Cited Registration is data regarding the identity and backgrounds of business and consumers, not their products, and certainly not door and building material products. The “purpose” of providing the data is to allow people and business to “hire with confidence.” Those services are not related to Applicant’s goods. The goods relating to the present application and the services of the Cited Registration would not reasonably be thought by the buying public to come from the same source.

Marks, even when identical to one another, can co-exist where the goods are sufficiently unrelated. *See* J. Thomas McCarthy, 4 McCarthy on Trademarks and Unfair Competition, § 24:11 (well-known examples of marks that co-exist include UNITED airlines and UNITED van lines; EAGLE shirts, EAGLE pencils, EAGLE pretzels, and EAGLE brand condensed milk; CHAMPION spark plugs and CHAMPION sportswear; DELTA airlines, DELTA dental insurance, and DELTA faucets, ACE retail hardware stores and ACE bandages; TROPICANA Las Vegas hotel and TROPICANA orange juice; DOW stock market index and DOW chemical company; and DELL computers and DELL magazines).

For the above reasons, Applicant respectfully submits that a Section 2(d) refusal over the Cited Registration is misplaced. Applicant respectfully requests allowance of the present application.