

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Alloy Software, Inc.
Serial No. : 88365982
Filed : April 1, 2019
For : ALLOY
Examining Attorney : Shavell McPherson-Rayburn
Law Office: : 106
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STATEMENT OF FILING

This correspondence is being filed on December 9, 2019 via the Electronic Filing System.

Dated: December 9, 2019

Sir/Madam:

RESPONSE TO OFFICE ACTION

This is a full and complete response to the non-final Office Action dated June 12, 2019. In the Office Action, the Examining Attorney has noted the following issues: (i) Section 2(d) – Likelihood of Confusion; and (ii) Potential Section 2(d) Refusal – Prior Pending Application. For the reasons set forth below, Applicant respectfully requests reconsideration and publication of the application.

I. Section 2(d) – Likelihood of Confusion

The Examining Attorney has refused registration of the applied-for-mark ALLOY because of a likelihood of confusion with the mark ALLOY registered in U.S. Reg. No. 5311788. Applicant respectfully disagrees.

The present application for **ALLOY (“Applicant’s Mark”)** is for:

Computer software for use in business management, customer management, asset inventory management, help desk service management, information technology management and network management in Class 9;

Auditing services, namely, detecting, collecting, analyzing and reporting software, hardware and devices on a computer network in Class 35; and

Software as a service (SAAS) services featuring software for use in business management, customer management, asset inventory management, help desk service management, information technology management and network management in Class 42.

The Examining Attorney has cited **ALLOY in U.S. Reg. No. 5311788 (“Cited Registration”)** for:

Data management services in the nature of data collection and data compilation relating to business management for use in monitoring business activity and providing visibility into Business-to-Business and Application-to-Application integration activities; data management services in the nature of electronic business data analysis for data harmonization and cleansing purposes in the nature of aggregating data, comparing data, removing extraneous data, and making data consistent between disparate business data sets for use in monitoring business activity and providing visibility into Business-to-Business and Application-to-Application integration activities in Class 35; and

Data management services in the nature of electronic data storage for use in monitoring business activity and providing visibility into Business-to-Business and Application-to-Application integration activities in Class 42.

TMEP 1207.01(a)(1) provides 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.” The TMEP cites several cases to support this principle:

- *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1371, 101 USPQ2d 1713, 1723 (Fed. Cir. 2012) (affirming the Board’s dismissal of opposer’s likelihood-of-confusion claim, noting "there is nothing in the record to suggest that a purchaser of test

preparation materials who also purchases a luxury handbag would consider the goods to emanate from the same source" though both were offered under the COACH mark);

- *Shen Mfg. Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 1244-45, 73 USPQ2d 1350, 1356 (Fed. Cir. 2004) (reversing TTAB's holding that contemporaneous use of RITZ for cooking and wine selection classes and RITZ for kitchen textiles is likely to cause confusion, because the relatedness of the respective goods and services was not supported by substantial evidence);

- *In re Thor Tech, Inc.*, 113 USPQ2d 1546, 1551 (TTAB 2015) (finding use of identical marks for towable trailers and trucks not likely to cause confusion given the difference in the nature of the goods and their channels of trade and the high degree of consumer care likely to be exercised by the relevant consumers);

- *Local Trademarks, Inc. v. Handy Boys Inc.*, 16 USPQ2d 1156, 1158 (TTAB 1990) (finding liquid drain opener and advertising services in the plumbing field to be such different goods and services that confusion as to their source is unlikely even if they are offered under the same marks); and

- *Quartz Radiation Corp. v. Comm/Scope Co.*, 1 USPQ2d 1668, 1669 (TTAB 1986) (holding QR for coaxial cable and QR for various apparatus used in connection with photocopying, drafting, and blueprint machines not likely to cause confusion because of the differences between the parties' respective goods in terms of their nature and purpose, how they are promoted, and who they are purchased by).

Similar to the cases cited above, even though the marks at issue are the same, the parties' respective goods and services are quite different in terms of their nature and purpose. Here, Applicant's goods and services are clearly distinguishable from Registrant's services.¹

Contrary to the Examining Attorney's argument, each and every one of the services identified in the Cited Registration is limited to "data management services." More specifically, in Registrant's services, data is collected and analyzed to facilitate data integration. As described by Registrant, its services enable data exchange between applications and uses business logic and workflows to support business processes and also provides the user to view movement of data during data integration.²

Applicant's goods and services, however, are quite different from the services identified in the Cited Registration.

In Class 35, Applicant's services are for auditing a computer network for software, hardware and devices therein. That is, software, hardware and devices within a computer network are tracked and inventoried. Applicant's auditing services are not data management services nor is the purpose for monitoring and aiding in data integration.

In Classes 9 and 42, Applicant's goods and services are for software for managing business, customers, asset inventory, help desk service, information technology and computer networks. See screenshot of Applicant's software, attached **Exhibit 2**. As identified in the present application, and shown in the Class 9 specimen and **Exhibit 2**, Applicant's software is a tool to manage various aspects of a business. On the contrary, the Cited Registration is for

¹ Applicant notes that the Examining Attorney has not addressed whether the refusal applies to Applicant's goods in Class 9. Applicant states that the Cited Registration does not include computer software. Furthermore, the purpose and/or use of Applicant's computer software are far removed from the Cited Registration as set forth in more detail below. Therefore, Applicant states that there is no likelihood of confusion with respect to Applicant's Class 9 goods as well.

² See **Exhibit 1** – screenshot of <https://businessnetwork.opentext.com/enterprise-application-integration/>.

collecting, compiling and analyzing data for data integration. Applicant's software is not for managing data for purposes of integrating data from one source to another.

Furthermore, consumers for the goods and services offered by Applicant and Registrant are sophisticated and would not be confused. As provided in TMEP 1207.01(d)(vii), "circumstances suggesting care in purchasing may tend to minimize the likelihood of confusion." *See, e.g., In re N.A.D., Inc.*, 754 F.2d 996, 999-1000, 224 USPQ 969, 971 (Fed. Cir. 1985) (concluding that, because only sophisticated purchasers exercising great care would purchase the relevant goods, there would be no likelihood of confusion merely because of the similarity between the marks NARCO and NARKOMED); *Primrose Ret. Cmtys., LLC v. Edward Rose Senior Living, LLC*, 122 USPQ2d 1030, 1039 (TTAB 2016) (finding that, "even in the case of the least sophisticated purchaser, a decision as important as choosing a senior living community will be made with some thought and research, even when made hastily"); *In re Homeland Vinyl Prods., Inc.*, 81 USPQ2d 1378, 1380, 1383 (TTAB 2006).

Consumers in the data management space as well as the computer network auditing services and business software space are businesses that are well-versed in the products and services offered in those fields. Therefore, those consumers would recognize and have the ability to distinguish one company's products and services from another company's products and services. Here, data management services for data integration offered by Registrant Liaison Technologies, Inc. d/b/a opentext, called "OpenText Alloy" would not be confused with Applicant Alloy Software's computer network auditing services and software for managing various aspects of a business. See **Exhibit 1**. Indeed, the goods and services offered by Applicant and Registrant are not off the shelf items and therefore, consumers would purchase the same after much thought and research.

As shown above, the parties' respective goods and services are quite different in terms of their nature and purpose. As well, consumers for the goods and services at issue are sophisticated and would not be confused. Therefore, there is no likelihood of confusion between the marks at issue.

II. Potential Section 2(d) Refusal – Prior Pending Application

The Examining Attorney has cited U.S. Ser. No. 87047021 for ALLOY as potential for refusal for likelihood of confusion. Applicant states that the record shows that the cited application has been abandoned. Therefore, Applicant states that the issue is now moot.

III. CONCLUSION

In view of the discussion presented above, Applicant submits that this responds to all of the issues raised in the Office Action. Thus, it is submitted that the applied-for-mark is registrable under all of the designated classes of goods and services. Accordingly, both favorable reconsideration of the application and prompt publication of registration are earnestly solicited.

Respectfully submitted,

/John H. Choi/
John H. Choi (Member of the NJ Bar)
John H. Choi & Associates LLC
65 Challenger Road, Suite 100
Ridgefield Park, NJ 07660
201.580.6600
jchoi@jchoilaw.com

Counsel for Applicant

EXHIBIT 1

The screenshot shows a web browser displaying the OpenText Alloy overview page. The browser's address bar shows the URL businessnetwork.opentext.com/enterprise-application-integration/. The page header includes the OpenText logo and the text "Business Network". A navigation menu contains "Products and Solutions", "About", and "CONTACT". The main content area features a dark blue background with the heading "OpenText Alloy overview". Below the heading is a paragraph: "OpenText Alloy integrates cloud and on-premises applications and data sources across the increasingly diverse enterprise system landscape. The platform enables data exchange between applications and uses business logic and workflows to support both simple and complex business processes. OpenText Alloy provides full visibility into the data movement between connected applications and helps improve the quality of the data that is being integrated." To the right of this text is a video player with a play button and a title "Overcoming the shortcomings of legacy integ...". Below the video are three circular icons: a document, a play button, and a group of people. At the bottom of the page, there are social media icons for LinkedIn, Twitter, and Facebook. A footer at the bottom of the page states: "This website uses cookies to ensure you get the best experience on our website. [Read our cookie policy.](#)"

EXHIBIT 2

The screenshot displays a service desk application interface. At the top left is the 'FALLOY' logo. A navigation menu on the left includes options like 'My Work', 'Service Desk', 'Incidents', 'Service Requests', 'Problems', 'Change Requests', 'Change Calendar', 'Walk Orders', 'Approval Requests', 'Knowledge Base', 'Announcements', and 'All Tickets'. The main area shows a list of tickets with columns for 'Ticket', 'Subject Date', 'Responsible', 'Status', and 'Assignee'. A modal window is open over the ticket with ID 1000027, showing its details and a 'Long delays in receiving email' notification. The notification states: 'Maxwell Newcomb maxnewcomb@example.com 800-800-0000 x8726. Last Activity: New Technical Issue was created @ 9/1/2019 8:23:51 PM. Sometimes it takes me up to 1 hour to receive email.'

Ticket	Subject Date	Responsible	Status	Assignee
1000027	9/1/2019 8:23:51 PM	Maxwell Newcomb	Assigned	Lynch Stenms
1000028	9/1/2019 8:40:00 PM	Joseph Moon	Assigned	Lynch Stenms
1000029	9/1/2019 8:50:00 PM	Joseph Moon	In Progress	Maxwell Newcomb
1000030	9/1/2019 9:00:00 PM	Joseph Moon	In Progress	Maxwell Newcomb
1000031	9/1/2019 9:10:00 PM	Joseph Moon	Assigned	Joseph Moon