

## RECITATION OF SERVICES

Applicant amends its recitation of services in Class 35 to:

“Business consultancy, business management consulting, business strategic planning services, all in the fields of community engagement, community involvement, public participation, cultural competency, racial equality, climate change, and environmental justice; consulting services in the area of sustainable business solutions, all in the fields of community engagement, community involvement, public participation, cultural competency, racial equality, climate change, and environmental justice; business management consulting, strategic planning and business advisory services provided to business, individuals professionals and corporations, in the fields of community engagement, community involvement, public participation, cultural competency, racial equality, climate change, and environmental justice.”

## BACKGROUND

The Office Action presents only one potential substantive issue with respect to Applicant’s application, namely the conclusion of the Trademark Attorney that HUMMINGBIRD, now covering various business services in the fields of community engagement, community involvement, public participation, cultural competency, racial equality, climate change, and environmental justice, is likely to cause confusion with the registration for HUMMINGBIRD, covering, business services relating to entrepreneurship, innovation, business and product development corroboration.

Applicant respectfully urges the Trademark Attorney to reconsider the Section 2(d) refusals, and to approve its application for publication because the underlying marks are unlikely to be confused based on the fact that the services are intended for different consumers who are likely to be sophisticated and careful purchasers.

Applicant and Registrant are providing business services in different fields. Applicant has amended its recitation of services to make clear that it is advising clients regarding community engagement, racial equality, climate change, and grass roots causes. Conversely, Registrant’s services involve consultation pertaining to entrepreneurship and innovation for start-

up companies. The differences in the ultimate use is significant, as there are other registrations using HUMMINGBIRD for their own business use, such as HUMMINGBIRD PRODUCTIONS for business services in the fields of advertising, film, television, and music, and HUMMINGBIRD LOGISTICS LLC SUPPLY CHAIN MADE EASY for business consulting services for product distribution and logistics. Exhibit A.

Applicant's services are set forth on its website at [www.hummingbirdfirm.com](http://www.hummingbirdfirm.com). Exhibit B. These services involve community outreach, planning, and environmental consultation in cities such as Gulfport, Mississippi, Birmingham, Alabama, and Atlanta, Georgia. Exhibit B. The various case studies from Applicant's website indicate that Applicant has provided services to these and other communities, which include, but are not limited to, negotiating community benefits agreements, providing truck route alternation to reduce vehicle traffic, creating environmental strategic plans in communities to reduce pollution exposure, and procuring funding for outdoor trails and greenways. Exhibit C. These services are specific to those cities and regions, and involve a level of expertise and specialty, particularly since Applicant's clients include the Environmental Protection Agency, along with various government agencies and municipalities. Exhibit D. Additionally, Applicant offers specialized experience in transportation issues, as it is certified by the Georgia Department of Transportation. Exhibit D. This type of work is not simple, and requires professionals to provide these services. Applicant's CEO MaKara Rumley was the Senior Advisor to the Environmental Protection Agency under the Obama administration, and she has used her expertise to provide community engagement plans for federal agencies, and for planning, engineering, architecture, and development firms. Exhibit E.

Conversely, Registrant's business services pertain to providing consultation services for start-up companies. Registrant is an Israeli company named Start-Up Nation Holdings, Ltd. a nod to Israel's reputation as a start-up company hub, as evidenced by investment totals of \$4.8 billion of venture capital investment in the country. Exhibit F. Only the United States and Canada have more Nasdaq-listed companies than Israel, and it is the number one country in start-up eco-system, research and development employee concentration, and high-tech employee concentration.

Notably, sophistication of purchasers is a factor used to test for likelihood of confusion, *In re E.I. du Pont de Nemours & Co.*, 177 USPQ 563 (CCPA 1973). Accordingly, due to the complex and expensive nature of advising start-up companies, and conducting environmental evaluation and community outreach, it is apparent that purchasers of both parties' services will be involved in businesses requiring sophistication as to the services they are using or intending to use. *In re McGladrey & Pullen*, [TTAB, November 20, 1996] ["Business services...would be the subject of careful choices by sophisticated purchasers"].

Furthermore, Registrant Office Action response indicates that Registrant believes that multiple HUMMINGBIRD marks can coexist in connection with services that are broadly identified as business. Exhibit H. This response stated that HUMMINGBIRD is a weak term, and that there is no confusion even when marks are used in the same broad field. *Mejia and Assoc. v. Int'l Business Machines Corp.*, 920 F. Supp. 540 (S.D.N.Y. 1996) [Rejecting a finding of confusion based on similarity as "educational services"]. As Registrant aptly noted, particularly, with regard to business services, "by increasing the level of generality, any products can be made to appear to fall in the same class". *Id.*, at 548.

With regard to the specific nature of Registrant's services, Registrant has indicated that its goods and services "are provided through highly specialized channels and are geared primarily to governmental and non-governmental organizations, academia, the media and investment funds and organizations that are interested in lessons learned in Israel, including the conditions and policies in Israel that support a proliferation of start-ups". Exhibit H, at 11, 12.

Applicant also agrees with Registrant that the consumers at issue are sophisticated. Registrant indicated that its clients include government leaders and other policy makers, who are clearly sophisticated. *American Television & Communications Corp. v. American Communications & Television, Inc.*, 810 F.2d 1546 (11<sup>th</sup> Cir. 1987). Exhibit H.

In addition, Registrant stated that "most of not all of [Registrant's] Goods and Services will be relatively expensive," and "just as importantly, such purchases are very likely to be motivated in large part by precisely who the ["Registrant"] is in this case, namely, an authority on the phenomenon of the relatively small nation of Israel generating outside volumes of investment, innovation and creation of new business ventures." Registrant continued that "consumers are likely to exercise a high degree of care before making a purchase of any of the goods or services under ["Registrant's"] Mark."

Finally, and to a point to which Applicant readily agrees, Registrant stated that it is improper to create broad categories to establish a presumption of product and service relationship. As support for this argument, Registrant cited *Astra Pharmaceutical Products, Inc. v. Beckman Instruments, Inc.*, which stated that broad inferences are not sufficient to demonstrate that there are genuine issues regarding likelihood of confusion. 220 USPQ 786 (1<sup>st</sup> Cir. 1983).

Accordingly, based on the obvious differences in the services and the sophistication of the parties' purchasers, Applicant contends that there is no likelihood of confusion, and requests that its application for HUMMINGBIRD be approved for publication.