

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: MKM Global Pty Ltd
Serial Number: 88407923
Filing Date: July 10, 2019
Mark: PIIQ

Examining Atty: Tarah Hardy Ludlow, Esq.
Law Office: 110

Commissioner of Trademarks
P.O. Box 1451
Alexandria, Virginia 22313-1451

RESPONSE TO OFFICE ACTION

Applicant submits the following amendments and remarks in response to the Office

Action dated July 10, 2019.

AMENDMENTS

Applicant submits the following description of goods and services for Class 9:

Downloadable computer software for use in capturing, manipulating and viewing multimedia files, still files, video, graphics, audio, and text in the field of virtual reality and augmented reality visualization; computer hardware; downloadable firmware for use in capturing, manipulating and viewing multimedia files, still files, video, graphics, audio, and text in the field of virtual reality and augmented reality visualization; downloadable application software including application software for use in finding, booking, providing, and sharing beauty and/or hair salon services; downloadable electronic publications, namely, books, magazines, manuals, e-books, newsletters, periodicals, blog entries, and articles, in the field of beauty, fashion, wellness, business, business management, health, special events, haircare, salon and beauty products, and in the lifestyle industry; downloadable computer software that enables users to make reservations and bookings for personal services; downloadable computer software for customers and potential customers to interact with and to compare personal service providers; downloadable software for appointment management, notification, commercial evaluation, payment transactions, client management, rewards management, and for locating, geo-locating and comparing personal services providers including beauty and/or hair salons; downloadable computer software for the collection, editing, organizing, modifying, transmission, storage and sharing of data and information; on-line downloadable computer software in the nature of an application programming interface (API) for computer software which facilitates online services for allowing data retrieval, upload, download, access and management; downloadable computer

software to enable uploading, downloading, accessing, posting, displaying, tagging, blogging, streaming, linking, sharing or otherwise providing electronic media or information via computer and communication networks; downloadable computer software for streaming audio-visual media content via a global computer network and to mobile and digital electronic devices; downloadable appointment and booking tracking software; electronic point of sale (EPOS) terminals; electronic point of sale (EPOS) systems comprising computer hardware and downloadable software for system management, telecommunications apparatus and instruments in the nature of mobile phones, handheld mobile digital electronic devices, handheld computers, tablet computers, digital audio and video players and recorders, electronic notepads, electronic organizers, and personal digital assistants; downloadable computer software to allow users to perform electronic business transactions via a global computer network; downloadable computer software to allow users to receive and process orders via a global computer network; downloadable computer software applications to allow users to search, order, browse personal services, including beauty and hair salon services and/or rate and/or comment on those services; downloadable computer software applications relating to the sale, order and booking of beauty and hair salon services; downloadable computer software for use in navigation for and location identification of beauty and/or hair salon services; **none of the foregoing in the field of measuring employee performance, employee productivity, employee training, or employee goals, or providing or tracking employee training programs or progress.**

Applicant submits the following description of goods and services for Class 41:

Creating, editing, producing, publishing, and distributing motion picture film, sound, and video recordings for the lifestyle industry; publishing of printed matter in the nature of books, magazines, manuals, e-books, newsletters, periodicals, blog entries, and articles; creating and publishing training materials for the beauty, salon, and haircare industry; **none of the foregoing in the field of measuring employee performance, employee productivity, employee training, or employee goals, or providing or tracking employee training programs or progress.**

Applicant submits the following description of goods and services for Class 42:

Computer services, namely, hosting an interactive web site featuring technology that allows users to manage their appointments for beauty and hair salons; computer programming services in the nature of capturing, manipulating and displaying multimedia files, still files, video, graphics, audio, and text in the field of virtual reality and augmented reality visualization; computer consultancy services, not in the field of measuring employee performance, employee productivity, or employee goals; computer software design services, not in the field of measuring employee performance, employee productivity, or employee goals; research and development of technology, namely, product research and development in relation to telecommunications goods and on-line computer services; mapping services, namely, electronic, on-line and digital mapping services; hosting of websites for others; designing of websites; computer design and implementation of IT systems; maintenance of computer software; data security services, namely, data encryption services for providing security and anonymity for electronically transmitted data; provision of internet search engine services; software as a service (SAAS) services, namely, hosting software for use by others for use in website building and publishing; computer services, namely, providing on-line non-downloadable software for content management of websites; computer services, namely, software for management of website

tracking information; hosting websites for others featuring landing pages; computerized electronic data storage of business information; hosting an online website for others including a website featuring technology, not in the field of measuring employee performance, employee productivity, or employee goals; hosting an online website for the management, booking, notification, location and payment of beauty and/or hair salon services; file sharing services, namely, hosting a web site featuring technology enabling users to upload and download electronic files; hosting on-line web facilities for others for managing and sharing on-line content; hosting computer software applications of others; application service provider (ASP), namely, hosting computer software applications of others featuring publication of information in electronic form; computerized electronic data storage services; electronic data storage other than physical storage; electronic data storage; storage services other than physical storage for electronic media and data; information, advisory and consultancy services in relation to the aforementioned application service provider (ASP) and software as a service (SaaS) services featuring software for electronic point of sale systems; application service provider (ASP) and software as a service (SaaS) services featuring software that allows users to perform electronic business transactions via a global computer network; providing on-line non-downloadable software and software platforms to facilitate electronic business transactions via a global computer network and/or to allow users to receive and process reservations, bookings and appointments online; providing temporary use online of non-downloadable software to facilitate communication between beauty and/or hair salon and customer; providing temporary use online of non-downloadable software for use in navigation and location identification of a beauty and/or hair salon; computer consultancy services related to electronic point of sale (EPOS) systems and computer hardware and software, featuring telephonic and on-line support; computer consultancy services related to the setting up and operation of websites and internet portals; creating, maintaining and hosting websites and internet portals; installation, maintenance and repair of computer software; web site security services for the protection of personal and financial data, namely, monitoring of computer systems for security purposes; advisory services relating to computer security; rental and leasing of computer hardware and computer peripheral equipment for use in electronic point of sale (EPOS) systems; creating and maintaining blogs for beauty and/or hair salons; hosting a website featuring web journals (blogs) for beauty and/or hair salons; Computer services, namely, hosting an interactive web site featuring technology that allows users to manage their appointments for beauty and hair salons; computer programming services in the nature of capturing, manipulating and displaying multimedia files, still files, video, graphics, audio, and text in the field of virtual reality and augmented reality visualization; computer consultancy services, not in the field of measuring employee performance, employee productivity, or employee goals; computer software design services, not in the field of measuring employee performance, employee productivity, or employee goals; research and development of technology, namely, product research and development in relation to telecommunications goods and on-line computer services; mapping services, namely, electronic, on-line and digital mapping services; hosting of websites for others; designing of websites; computer design and implementation of IT systems; maintenance of computer software; data security services, namely, data encryption services for providing security and anonymity for electronically transmitted data; provision of internet search engine services; software as a service (SAAS) services, namely, hosting software for use by others for use in website building and publishing; computer services, namely, providing on-line non-downloadable software for content management of websites; computer services, namely, software for management of website

tracking information; hosting websites for others featuring landing pages; computerized electronic data storage of business information; hosting an online website for others including a website featuring technology, not in the field of measuring employee performance, employee productivity, or employee goals; hosting an online website for the management, booking, notification, location and payment of beauty and/or hair salon services; file sharing services, namely, hosting a web site featuring technology enabling users to upload and download electronic files; hosting on-line web facilities for others for managing and sharing on-line content; hosting computer software applications of others; application service provider (ASP), namely, hosting computer software applications of others featuring publication of information in electronic form; computerized electronic data storage services; electronic data storage other than physical storage; electronic data storage; storage services other than physical storage for electronic media and data; information, advisory and consultancy services in relation to the aforementioned application service provider (ASP) and software as a service (SaaS) services featuring software for electronic point of sale systems; application service provider (ASP) and software as a service (SaaS) services featuring software that allows users to perform electronic business transactions via a global computer network; providing on-line non-downloadable software and software platforms to facilitate electronic business transactions via a global computer network and/or to allow users to receive and process reservations, bookings and appointments online; providing temporary use online of non-downloadable software to facilitate communication between beauty and/or hair salon and customer; providing temporary use online of non-downloadable software for use in navigation and location identification of a beauty and/or hair salon; computer consultancy services related to electronic point of sale (EPOS) systems and computer hardware and software, featuring telephonic and on-line support; computer consultancy services related to the setting up and operation of websites and internet portals; creating, maintaining and hosting websites and internet portals; installation, maintenance and repair of computer software; web site security services for the protection of personal and financial data, namely, monitoring of computer systems for security purposes; advisory services relating to computer security; rental and leasing of computer hardware and computer peripheral equipment for use in electronic point of sale (EPOS) systems; creating and maintaining blogs for beauty and/or hair salons; hosting a website featuring web journals (blogs) for beauty and/or hair salons; information and advisory services relating to the aforesaid; **none of the foregoing in the field of measuring employee performance, employee productivity, employee training, or employee goals, or providing or tracking employee training programs or progress.**

REMARKS

I. Identification of Goods and Services

With the above clarifying and limiting amendments to the goods and services, Applicant believes that its identification should satisfy the examiner's comments.

II. Likelihood of Confusion

The Examining Attorney refused to register Applicant's mark PIIQ for the services in Classes 9, 41, and 42 on the grounds that it is confusingly similar to Registration No. 5795193

for the mark PIIQ, owned by Cornerstone OnDemand, Inc. (“Registrant”), registered for the following services in Class 42: “Providing software as a service (SAAS) services featuring software to measure employee performance and productivity and set and analyze employee goals, and for employee training, and personal effectiveness; Providing technology information relating to measuring employee performance and productivity, setting and analyzing employee goals; Providing a website featuring technology to create, assign, and take educational courses and training programs and to track employee training progress.”

The Examining Attorney contends that confusion between Applicant’s mark and Registrant’s mark is likely because the goods and services are commercially related and there are no restrictions on Applicant’s goods and services. Applicant’s amendments detailed above further distinguish Applicant’s goods and services from Registrant’s limited services such that consumer confusion is unlikely. Applicant respectfully suggests that the Examining Attorney’s concerns have been addressed and that the refusal should be withdrawn. Under the Federal Circuit’s guiding factors set forth in *In re Du Pont de Nemours & Co.*, 476 F.2d 1357 (CCPA 1973), confusion among the marks is unlikely because Applicant’s services differ in form, function, consumer base, and trade channels from the services offered by Registrant.

Applicant’s goods and services, as amended, are sufficiently different from those of the cited mark. Specifically, the cited registration is for software and technology to measure employee performance and productivity and set employee goals. In stark contrast, Applicant’s amended goods and services are directed to the field of beauty, salon, and lifestyle industries as well as virtual reality and augmented reality visualizations. As evidenced by the added limitation, Applicant’s amended goods and services, are not related or directed to measuring employee performance and productivity or setting employee goals.

Although the parties' goods and services both cover computer software, this fact alone is insufficient to support a finding of a likelihood of confusion. Indeed, both the Court of Appeals for the Federal Circuit and the Board have cautioned that there is no "per se" rule that confusion will always be found as between any and all software-related goods and services. *See Electronic Design and Sales Inc. v. Electronic Data Systems*, 954 F.2d 713 (Fed. Cir. 1992) ("[T]he fact that both parties provide computer programs does not establish a relationship between the goods or services."); *see also In re Reproductive Medicine Assocs. of New Jersey, LLC*, 2019 TTAB LEXIS 9 (TTAB 2019) (finding goods of respective ARTEMIS and ARTEMIS HEALTH marks were not related where applicant's patient medical record software and registrant's employee benefits software were "fundamentally different"); *Reynolds & Reynolds Co. v. I.E. Sys.*, 1987 TTAB LEXIS 6, 5 U.S.P.Q.2D (BNA) 1749 (TTAB 1987) (finding ACCULINK for software for operational uses not confusingly similar to ACCU marks for applications software aimed at the accounting field, noting that because computers permeate almost every aspect of commerce, "it is obvious that distinctions must be made."); *In re Quadram Corp.*, 228 USPQ 863, 865 (TTAB 1985) ("[A] per se rule relating to source confusion vis-à-vis computer hardware and software is simply too rigid and restrictive an approach and fails to consider the realities of the marketplace[.]"); TMEP § 1402.03(d) ("The purpose of requiring specificity in identifying computer programs is to avoid the issuance of unnecessary refusals of registration under 15 U.S.C. § 1052(d) where the actual goods of the parties are not related and there is no conflict in the marketplace.").

Applicant's and Registrant's goods/services are neither competitive nor complementary. Indeed, Applicant's software and website technology used in connection with salons and haircare as well as for augmented reality and virtual reality visualizations have markedly different

functions and purpose than Registrant's software for monitoring employee performance. *See, e.g., Oculu, LLC v. Oculus VR, Inc.*, No. SACV 14-0196 DOC(JPRx), 2015 U.S. Dist. LEXIS 74666 (C.D. Cal. June 8, 2015) (finding OCULU mark for video streaming software and related services not confusingly similar to OCULUS mark for virtual reality hardware, noting that the goods and services were neither related nor complementary).

Confusion is unlikely where there is no overlap in consumers and trade channels in which the marks are used. The TTAB has allowed the registration of identical marks when ultimate purchasers will not be faced with both marks in the same context. *E.g., In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993) (PHOENIX for leather sold in bulk to manufacturers not confusingly similar to PHOENIX for finished leather products sold to the public); *In re Shipp*, 4 USPQ2d 1174 (TTAB 1987) (PURITAN for dry cleaning services offered to the public not confusingly similar to PURITAN for commercial dry cleaning filters sold to proprietors of dry cleaning businesses).

Here, Registrant's and Applicant's goods and services are marketed to different consumers in different contexts. Registrant's employee and performance management technology and software is unlikely to be marketed to consumers in the beauty and lifestyle industries or to those using augmented and virtual reality visualizations. To the extent that there is any overlap, the shared consumers are unlikely to believe that the goods/services are related given the differences in their functions and purpose. As such, given this context, consumers of these goods and services will be different.

CONCLUSION

For the reasons discussed above, Applicant respectfully requests that (1) the request for clarification of certain goods and services be withdrawn, and (2) the refusal based on the likelihood of confusion be withdrawn.

Respectfully submitted,

MKM Global Pty Ltd.

Dated: January 10, 2020

By /Robert G. Kramer/
Robert G. Kramer
Attorney for Applicant

Finnegan, Henderson, Farabow,
Garrett & Dunner, LLP
901 New York Avenue, N.W.
Washington, D.C. 20001-4413
Telephone: 202-408-4000
Facsimile: 202-408-4400