

Office Action Response No. 1— U.S. Serial No. 88/403,744 – PURE

GOODS/SERVICES ID MODIFICATIONS AND DELETIONS

Applicant respectfully requests removal of the 2(d) refusal and the prior application citations. As a threshold matter, Applicant has deleted classes 25, 38, and 38 and also amended classes 9, 36, and 42. These deletions and amendments ensure that there is no likelihood of confusion as will be explained further below, but namely that Applicant's goods and services are related to cryptocurrency and digital assets. Applicant's amended goods and services are as follows:

1. Delete Classes 25, 35, and 38
2. Revise remaining classes to read as follows:

Class 9 - Downloadable computer software application for use as a cryptocurrency wallet; **downloadable** computer software for managing cryptocurrency transactions, namely, for making cryptocurrency transfers and payments using blockchain technology; **downloadable** computer application software for smartphones, namely, software for making cryptocurrency transfers using blockchain technology; Cryptocurrency security and management tools, namely, **encoded** labels in the nature of a printed metal foil for use as an offline cryptocurrency wallet, with said labels carrying magnetically or optically encoded information.

Class 36 - ~~financial information services~~; financial trading risk management in the field of electronic financial trading of digitized assets in the nature of digital currency; ~~electronic financial trading services~~; electronic financial trading services in the field of digitized assets in the nature of digital currency; ~~financial information provided by electronic means~~; providing on-demand and real-time financial information about digitized assets in the nature of digital currency; virtual currency exchange services; providing an internet website in the field of digital securities exchange services **being financial information in the nature of digital currency**; financial services, namely, issuing and trading digitized currency; ~~clearing and reconciling financial transactions via electronic communications networks~~; providing monetary exchange services, namely, exchanging digitized assets in the nature of digital currency; financial services, namely, financial management and administration of instruments used to invest in cryptocurrency; Financial information provided by electronic means in the field of virtual currencies and other types of financial transactions using blockchain, smart contract, and distributed systems

Class 42 - Software as a service (SAAS) services featuring software for use as a cryptocurrency Software as a service (SAAS) services featuring software for use as a cryptocurrency wallet; Technological consulting in the field of cryptocurrency; Non-downloadable software, namely, providing temporary use of non-downloadable software for enabling users to securely create, trade, clear, settle and authenticate digital currency transactions; computer software platform for providing cryptographic communications and the encrypted transfer and review of digital currency; Software as a service (SAAS) for enabling cryptographic communications and the encrypted transfer and review of digital currency; ~~Providing temporary use of online, non-downloadable software for interfacing with peer-to-peer networks, for data and digital file~~

~~uploads, for maintaining the security and integrity of digital files and data and for capturing various types of digital files and data, for transferring data and digital files, for use in verifying a chain of custody; Software as a service (SAAS) services featuring software for interfacing with peer-to-peer networks, for data and digital file uploads, for maintaining the security and integrity of digital files and data and for capturing various types of digital files and data, for transferring data and digital files, for use in verifying a chain of custody; Providing temporary use of on-line non-downloadable software for use in accessing, reading, tracking, and using blockchain technology; Providing temporary use of on-line non-downloadable computer software for identity management~~

LIKELIHOOD OF CONFUSION REFUSAL AND PRIOR PENDING APPLICATIONS

REFUSAL ON THE BASIS OF U.S. REGISTRATION NO. 5,061,331

The Office has refused registration of Applicant's mark PURE (the "Subject Mark") which is the subject of U.S. Application Serial No. 88/403,744 (the "Subject Application") under Section 2(d) of the Trademark Act based on a likelihood of confusion in with U.S. Registration No. 5,061,331 for the mark PURE. This refusal applies only to the goods in Class 25. As part of its response to this office action, Applicant has deleted Class 25 from its Identification of Goods and Services. The Subject Application no longer covers clothing in any form, and, as a result, there is no likelihood of confusion between the Subject Mark and the aforementioned PURE mark. Therefore, the Applicant respectfully requests that the Office withdraw the refusal to register on the basis of a likelihood of confusion with U.S. Registration No. 5,061,331.

CITATION OF PRIOR-PENDING APPLCIATION SERIAL NO. 86/429,527

The Office has also cited Application Serial No. 86/429,527 for the mark PURE (Stylized) as a prior-pending application that may serve as a basis for refusing registration of the Subject Application due to a possible likelihood of confusion. Applicant has deleted Classes 25 and 35 from its Identification of Goods and Services, thereby removing any reference to clothing or retail sales of goods. As a result, the Subject Application no longer potentially conflicts with the PURE (Stylized) application and Applicant respectfully requests that the Office withdraw the provisional refusal to register the Subject Application with respect to this prior-pending application.

CITATION OF PRIOR-PENDING APPLCIATION SERIAL NO. 88/195,568 AND REGISTRATION NO. 5,864,694

The Office has also provisionally refused registration of the Subject Mark on the basis of possible likelihood of confusion with U.S. Application Serial No. 88/195,568 for the mark PUR (the "568 Application") and U.S. Application Serial No. 79/240,905 for the mark PURE (which has matured to U.S. Registration No. 5,864,694)(the "694 Registration"). These marks will be collectively referred to as the "Cited Marks" throughout this response. Applicant respectfully disagrees with the Office and contends that confusion is not likely between the Subject Mark and the Cited Marks for the reasons set forth below. However, as of the time of filing the response, the '568 Application is facing a final refusal. If it goes abandoned, it will no longer bar registration.

There are several factors considered when assessing whether a likelihood of confusion exists between two marks. *In re E. I. DuPont DeNemours & Co.*, 476 F.2d 1357, 1361, 177 U.S.P.Q. 563, 567 (CCPA 1973). Collectively, these factors are referred to as the “DuPont Test.” The most relevant factors in this case include:

1. The similarity or dissimilarity and nature of the goods or services as described in an application or registration or in connection with which a prior mark is in use;
2. The conditions under which and buyers to whom sales are made; and
3. The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression (with respect to the ‘568 Application). *Id.*

When evaluating whether a likelihood of confusion exists, all facts and information that are pertinent to the above-referenced categories should be considered and this determination should be made on a case-by-case basis. *Id.*

While the Office has not made any specific assertions regarding a likelihood of confusion between the Subject Mark and Cited Marks, Applicant maintains that when all pertinent facts and information are considered, including the differences in the nature of the goods and services offered by each party including the dissimilarity of trade channels, the care exercised by consumers purchasing Applicant’s goods and services, and the differences in the appearances of the Subject Mark and the Cited Marks (and resulting commercial impressions), it is unlikely consumers would be confused as to the source of the parties’ respective goods and services.

The Goods and Services at Issue Are Sufficiently Different to Avoid a Likelihood of Confusion

When considering whether a likelihood of confusion may exist between two or more marks, it is important to consider the similarity or dissimilarity and nature of the goods or services. *In re E. I. DuPont DeNemours & Co.*, 476 F.2d 1357, 1361, 177 U.S.P.Q. 563, 567 (CCPA 1973). Even where two marks are identical, the goods or services and channels of trade must be sufficiently related so that the use of highly similar marks thereon would be likely to generate confusion, mistake, or deception as to the source of those goods and services. *See, e.g., In re Shipp*, 4 U.S.P.Q.2d 1174, 1176 (T.T.A.B. 1987) (no confusion likely where identical mark “PURITAN” used on laundry and dry cleaning services and on commercial dry cleaning filters); *In re Fesco, Inc.*, 219 U.S.P.Q. 437 (T.T.A.B. 1983) (no likelihood of confusion where identical “FESCO” mark used on distributorship services in the field of farm equipment and on fertilizer, oil mill, crushed stone, clay, coal, concrete block, and foundry processing equipment and machinery); *Chase Brass & Copper Co. v. Special Springs, Inc.*, 199 U.S.P.Q. 243 (T.T.A.B. 1978) (no confusion likely where identical “BLUE DOT” mark used on springs for engine distributors and on brass rods used in auto manufacturing); *Autac, Inc. v. Walco Sys., Inc.*, 195 U.S.P.Q. 11, 15 (T.T.A.B. 1977) (no confusion likely where identical “AUTAC” mark used on temperature regulators and on wire retractile cords in the wire manufacturing industry); *Alliance Mfg. Co. v. Chicago Musical Instrument Co.*, 184 U.S.P.Q. 118, 121 (T.T.A.B. 1974) (no confusion likely where GENIE used on electronic organs and on various small electrical appliances); *Canada Dry Corp. v. American Home Prods. Corp.*, 175 U.S.P.Q. 557 (C.C.P.A. 1972) (no confusion likely where identical HI-SPOT mark used on laundry detergent and on soft drinks). The goods and

services offered by each party in connection with its respective mark are so different that confusion is not likely.

The Subject Application (as amended in conjunction with this response) covers financial goods and services for transactions related to cryptocurrency and blockchain systems, including software. The '568 Application for PUR covers a long list of goods and services in Classes 9 and 42 for software and software related products. The fact that the '568 Application and the Subject Application both cover software or software related goods does not lead to an automatic finding of relatedness between the goods and services, but rather merits an examination of the subject matter and purpose of the software to determine whether there is a likelihood of confusion. *M2 Software, Inc. v. M2 Commc'ns, Inc.*, 450 F.3d 1378, 1383, 78 USPQ2d 1944, 1947–48 (Fed. Cir. 2006). A closer look at the subject matter of the goods and services covered in the '568 Application reveals that the software that is intended to be used with the PUR mark is intended for use in connection with software that performs a variety of functions, including controlling a dishwasher, operating GPS, and downloading video games. This list of goods in Class 9 also includes electronically encoded prepaid payment cards, which presumably prompted the Office to cite this application as a prior-pending application.

However, while both marks are used in connection with software-related goods that fall within the broad category of financial services, this should not automatically lead to a finding that the goods and services offered by each party are related. Furthermore, the mere fact that two products may move in somewhat related channels of trade to the same class of purchasers does not *ipso facto* prove that there is a definite relationship between the goods or services. *Canada Dry Corp. v. American Home Prods. Corp.*, 175 U.S.P.Q. 556 (C.C.P.A. 1972) (no confusion likely where identical HI-SPOT mark used on laundry detergent and on soft drinks), *Alliance Mfg. Co., v. Chicago Musical Instrument Co.*, 184 U.S.P.Q. 118, 121 (T.T.A.B. 1975) (no confusion likely where GENIE used on electronic organs and on various small electrical appliances), *Autac, Inc. v. Walco Sys., Inc.*, 195 U.S.P.Q. 11, 15 (T.T.A.B. 1977) (no confusion likely where identical "AUTAC" mark used on temperature regulators and on wire retractile cords in the wire manufacturing industry). "Electronically encoded prepaid payment cards," which are used by consumers in day-to-day purchasing transactions are distinct from cryptocurrency or blockchain technology which are used by a narrow consumer base. Cryptocurrency is currency that only exists digitally, has no central issuing authority, and is used outside the confines of a traditional banking system. In contrast, electronically encoded prepaid payments cards are just a different form of physical currency that are used in conventional commerce. These are two distinct market segments that do not overlap. The goods and services at issue are non-competitive and differ significantly in utility and purpose. The determinative issue is whether the consumer would likely believe that the goods come from the same source and not whether the goods are in some way remotely related. Thus, confusion between the Subject Mark and the PUR mark is unlikely.

The services covered by the '694 Registration are even more different from the goods and services covered by the Subject Application. Again, while the '694 Registration and the Subject Application cover software in Class 42, Applicant's software has a very narrow and specific purpose: support, transfer, and use of cryptocurrency and blockchain technology. Applicant's revised recitation of services in Class 42 deletes the following wording: "Providing temporary use of online, non-downloadable software for interfacing with peer-to-peer networks, for data and

digital file uploads, for maintaining the security and integrity of digital files and data and for capturing various types of digital files and data, for transferring data and digital files, for use in verifying a chain of custody; Software as a service (SAAS) services featuring software for interfacing with peer-to-peer networks, for data and digital file uploads, for maintaining the security and integrity of digital files and data and for capturing various types of digital files and data, for transferring data and digital files, for use in verifying a chain of custody.” While this may have previously conflicted with the “creating programs for data processing; development, creation and design of software and its implementation in the field of electronic data processing and consultancy relating thereto, services relating to the security of information, namely, selection, configuration of firewall systems and firewall software, maintenance of firewall software; technical project studies in the fields of computer hardware and computer software,” services in Class 42 of the ‘694 Registration, Applicant’s updated recitation of services narrowly focuses on accessing, processing, and transferring cryptocurrency. As the broadly worded services that include data upload, transfer, and security are no longer covered by the Subject Application, the services at issue are no longer related such that confusion between Applicant’s PURE mark and the PURE mark that is the subject of the ‘694 Registration is unlikely.

The Dissimilarity of Established, Likely-to-Continue Trade Channels and the Sophisticated Nature of Applicant’s Goods Weighs Against Any Possible Confusion

Another important consideration in determining whether a likelihood of confusion exists is the similarity or dissimilarity of established, likely-to-continue trade channels. *In re E. I. DuPont DeNemours & Co.*, 476 F.2d 1357, 1361, 177 U.S.P.Q. 563, 567 (CCPA 1973). Additionally, the issue of whether the goods or services in question would be encountered by the same purchasers must also be considered in any likelihood of confusion analysis. *In re Fesco, Inc.*, 219 U.S.P.Q. 437 (T.T.A.B. 1983). Moreover, if the differences in the goods or services result in the products or services being sold through different trade channels, being used for different purposes, or not interfacing in the market, the cumulative dissimilarities are sufficient to outweigh any similarity between the respective marks. *Astra Pharmaceutical Prods. v. Beckman Instruments*, 220 U.S.P.Q. 609 (D. Mass. 1983) (*aff’d*, 718 F.2d 1201 (1st Cir. 1983)).

In this case, the goods and services at issue will be offered to different consumers and used for very different functions. As previously discussed, Applicant’s goods and services relate to cryptocurrency which is marketed to individuals who want to conduct business without a traditional banking account. In contrast, the electronically coded prepayment cards covered by the ‘568 Application are part of traditional banking services and provide users the ability to purchase goods and services through conventional commerce. The trade channels through which the services covered by the ‘694 Registration travel are even further apart from Applicant’s goods and services as the Subject Application no longer covers any services related to data processing or data security. This ensures that each party’s potential consumers will not encounter the marks in question in a way that may cause confusion.

Furthermore, the complex goods and services covered by the Subject Application are marketed to sophisticated purchasers. The consumers who purchase Applicant’s cryptocurrency related goods and services are likely to do so only after careful investigation and consideration. *See Jet Inc. v. Sewage Aeration Systems*, 49 U.S.P.Q.2d 1355, 1358 (6th Cir. 1999) (consumers are generally expected to exercise greater care in the field of expensive and sophisticated products and are less

likely to be confused); *Pignons S.A. de Mecanique v. Polaroid Corp.*, 212 U.S.P.Q.2d 246, 252 (1st Cir. 1981) (there is always less likelihood of confusion where goods are expensive and purchased after careful consideration). These sophisticated purchasers can be expected to be selective about the products and the sources with which they contract and are not likely to be confused about the source of the goods in question. *See McGraw-Hill, Inc. v. Comstock Partners, Inc.*, 17 U.S.P.Q.2d 1599, 1604 (S.D.N.Y. 1990) (when the relevant purchasing public is sophisticated, the likelihood of confusion is minimized).

Cryptocurrency is a relatively new form of digital currency with complicated operating systems. Applicant's prospective consumers are very likely to exercise a high degree of care because these goods and services are complex and provide the consumer with significant value. As a result, the level of care exercised by the relevant consumers further reinforces the notion that confusion between the Subject Mark and the Cited Marks is not likely.

The Subject Mark and the PUR Mark Are Different In Appearance and Convey Different Commercial Impressions

A crucial consideration when performing a likelihood of confusion analysis is the similarity or dissimilarity of the marks in their entireties as to appearance, sound, and meaning. *In re E. I. DuPont DeNemours & Co.*, 476 F.2d 1357, 1361, 177 U.S.P.Q. 563, 567 (CCPA 1973). Applicant maintains that there is no likelihood of confusion between the Subject Mark and the PUR mark covered by the '568 Application because the marks are visually distinct. These differences create different overall commercial impressions that dispel any potential confusion between the Subject Mark and the PUR mark.

When comparing two marks to determine if there is confusing similarity between them, it is well settled that they must be considered in their entireties and not dissected into their constituent parts. *See Massey Junior College v. Fashion Inst. of Tech.*, 181 U.S.P.Q. 399 (C.C.P.A. 1971); and *Food Tech., Inc. v. Sucrest Corp.*, 196 U.S.P.Q. 134 (T.T.A.B. 1977). The question of confusing similarity must be judged on the appearance, sound, connotation and commercial impression of the marks in their entireties. The Subject mark is PURE while the mark covered by the '568 Application is PUR. The deletion of the "E" from the latter mark completely changes the visual impact on consumers. Consumers will recognize PURE as a common word in the English language meaning clear or simple, while PUR is a variation of the term PURR which means to utter a low, continuous murmuring sound like a cat. *See Exhibit A*. In addition to the considerable visual differences of the marks, the cadence of each mark is substantially dissimilar. The Subject Mark is pronounced as *pyoor* while PUR does not include that "yoo" vowel sound. The different spellings of PURE and PUR has multiple effects that further distinguish the marks.

These differences in appearance and pronunciation significantly changes the connotation and overall commercial impression of each mark. As the PUR mark is intended to be used primarily in connection with dish washing machines, the meaning of PUR or PURR evokes the murmuring noise that dish washing machines emit while running. This commercial impression is not applicable to the use of the PURE mark with cryptocurrency. Therefore, when all elements and the meaning of each mark are considered together, the commercial impression conveyed by each mark is distinct and, as a result, any potential confusion is eliminated.

Conclusion

In view of the foregoing, Applicant submits that confusion will not result from registration of the Subject Mark, because it will be used in connection with goods and services that are sold to a limited and specific market and differ greatly than the goods and services offered or are proposed to be offered in connection with the Cited Marks; the prospective customers of Applicant will exercise serious care before purchasing Applicant's goods and services; and the PUR mark is visually distinct and different in pronunciation, and the creates a commercial impression that is wholly unlike the commercial impressions created by the Subject Mark. Therefore, Applicant respectfully requests that the Office withdraw the refusal to register and approve the Subject Mark for publication.