

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Toolbox TVE, LLC

Date: January 20, 2020

International Class: 42

Filing Date: May 1, 2019

Mark: CLOUD EXPERIENCE

Serial No.: 88/411,504

Examining Attorney: Michael FitzSimons

Law Office: 103

RESPONSE

In the Office Action dated July 23, 2019, regarding Application No. 88/411,504, the Examining Attorney refused to register Applicant's mark citing likelihood of confusion as grounds for refusal, requested clarification of the identification services, and required a disclaimer. Applicant responds as set forth below.

I. PRIOR-FILED APPLICATIONS

At this time Applicant elects not to submit arguments regarding the prior-filed applications.

II. LIKELIHOOD OF CONFUSION

The Examining Attorney has refused registration of the CLOUD EXPERIENCE trademark application pursuant to Trademark Act Section 2(d), 15 U.S.C. § 1052(d), on the grounds that the mark is likely to be confused with the mark in Registration No. 5692345. For the following reasons, Applicant respectfully disagrees with this finding and requests the Office to reconsider the statutory refusal and allow Applicant's mark to be registered on the Principal Register.

Likelihood of confusion between two marks is determined by reviewing the relevant factors under the *du Pont* test. *In re E. I. du Pont de Nemours & Co.*, 476 F. 2d 1357, 177 USPQ 563 (CCPA 1973). Contrary to the Office's assertion that "[a]lthough not all *du Pont* factors may be relevant," the Federal Circuit in a recent decision held that all DuPont factors must be considered in a likelihood of confusion analysis:

In every case turning on likelihood of confusion, it is the duty of the examiner, the board and this court to find, upon consideration of *all* the evidence, whether or not confusion appears likely.” *DuPont*, 476 F.2d at 1362 (emphasis in original). “In discharging this duty, the thirteen *DuPont* factors ‘must be considered’ ‘when [they] are of record.’ ” *In re Dixie Rests., Inc.*, 105 F.3d 1405, 1406 (Fed. Cir. 1997) (quoting *DuPont*, 476 F.2d at 1361).

In re Guild Mortgage Co., 912 F.3d 1376, 1379 (Fed. Cir. 2019).

Those factors are: (1) the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression; (2) 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; (3) the similarity or dissimilarity of established, likely-to-continue trade channels; (4) the conditions under which and buyers to whom sales are made, i.e. “impulse” vs. careful, sophisticated purchasing; (5) the fame of the prior mark (sales, advertising, length of use); (6) the number and nature of similar marks in use on similar goods; (7) the nature and extent of any actual confusion; (8) the length of time during and conditions under which there has been concurrent use without evidence of actual confusion; (9) the variety of goods on which a mark is or is not used (house mark, “family” mark, product mark); (10) the market interface between applicant and the owner of a prior mark; (11) the extent to which applicant has a right to exclude others from use of its mark on its goods; (12) the extent of potential confusion, i.e., whether de minimis or substantial; (13) any other established fact probative of the effect of use. *Id.*

A determination that there is no likelihood of confusion may be appropriate, even where the marks share common terms and the goods/services relate to a common industry, because these factors can be outweighed by other factors, such as the length of time during which there has been concurrent use without evidence of actual confusion, the variety of goods on which a mark is or is not used, or any other evidence probative of concurrent use’s effects on consumers. *See* TMEP § 1207.01.

The determinative inquiry is whether the marks' concurrent use "will confuse people into believing that the goods they identify emanate from the same source." *Paula Payne Prods. Co. v. Johnson's Publ'g Co.*, 473 F. 2d 901, 902 (C.C.P.A. 1973). The Examining Attorney suggests that the following factors are the most relevant in the likelihood of confusion analysis applicable to the subject trademark application: (1) similarities between the compared marks; and (2) relatedness of the compared goods and/or services. However, Applicant submits that consideration of those two factors and the following additional DuPont factors weighs against a finding of likelihood of confusion: the nature and extent of any actual confusion (seventh DuPont factor); the length of time during and conditions under which there has been concurrent use without evidence of actual confusion; (eighth DuPont factor); the variety of goods on which a mark is or is not used (house mark, "family" mark, product mark) (ninth DuPont factor); and the extent of potential confusion, i.e., whether de minimis or substantial (twelfth DuPont factor). The analysis for each of these factors is set forth below.

**Similarity Or Dissimilarity Of The Marks In Their Entireties
As To Appearance, Sound, Connotation And Commercial Impression**

Applicant seeks registration of the standard character mark CLOUD EXPERIENCE for "Software as a Service (SaS) for the creation of Internet applications and client interfaces; Software as a Service (SaS) to design and manage content of websites and applications; Software as a Service (SaS) to access backend services, namely, syncing data, data storage, data control, data transmission, push notifications, user management, application performance reporting, mobile messaging, social media platforms, video player, mobile payment services" in International Class 042. Applicant's mark has been refused registration based on an alleged likelihood of confusion with the standard character mark ADOBE EXPERIENCE CLOUD for "Application service provider (ASP) services featuring computer software for use in creating, designing, building,

publishing, and managing websites; application service provider (ASP) services featuring computer software for creating, designing, publishing and managing content for web sites; application service provider (ASP) services featuring computer software for creating, editing and managing images, graphics, data and text on web sites and for the customization and layout of text, images and graphics for web sites; application service provider (ASP) services featuring e-commerce application software; computer services, namely, providing technical information and consulting services in the fields of computer software and cloud computing; providing technical support services in the nature of troubleshooting in the fields of computer software and cloud computing; software leasing services” in International Class 042.

In the Office Action, the Examining Attorney asserted that in a likelihood of confusion determination, the “[m]arks are compared in their entireties for similarities in appearance, sound, connotation, and commercial impression. . . [s]imilarity in any one of these elements may be sufficient to find the marks confusingly similar.” The Examining Attorney also asserted that “[c]onfusion is likely between the two marks consisting of reverse combinations of the same elements if they convey the same meaning or create substantially similar commercial impressions.” However, the Office Action only provides an analysis of one of those factors: commercial impression. With respect to the “commercial impression” factor, the Examining Attorney concluded that “the common wording in the marks, ‘CLOUD’ and ‘EXPERIENCE’ create highly similar overall commercial impressions.” However, each case must be determined on the basis of *all* of the relevant facts and circumstances presented therein. *In re Sears*, 2 U.S.P.Q.2d 1312, 1313 (TTAB 1987) (citations omitted). Here, the Examining Attorney has not asserted that the Applicant’s mark and Registrant’s marks have the same meaning or connotation and sound alike.

Thus, the Office Action does not provide *prima facie* evidence that consideration of at least those two factors weighs in favor of a finding of likelihood of confusion.

The marks are different in appearance, sound, connotation, and commercial impression. The marks are dissimilar in appearance. Viewing the marks as a whole, the Applicant's mark differs in appearance from the Registered mark. While some of the words are the same, they are transposed, which makes the marks look different from one another. Further, the marks are dissimilar in sound. Because the words of the Applicant's and Registered marks are transposed, one of "cloud" and "experience" will be articulated before the other depending on the mark. Accordingly, the initial sound spoken for the Applicant's mark comes from "cloud" while that of the Registered mark is "experience." The same difference is true of the second sound of each mark, although in reverse. The Registered mark and the Applicant's mark also differ in their connotations and commercial impressions. As to the comparison of the meaning or connotation between Applicant's mark and Registrant's marks, the *Sears* decision supports Applicant's position that there is no likelihood of confusion.

In the *Sears* decision the marks at issue were identical in sound and appearance - ("applicant's mark 'CROSS-OVER' and registrant's mark 'CROSSOVER' are identical in sound, and are also identical in appearance but for the inclusion in applicant's mark of a hyphen, which, for purposes herein, is of no legal significance"). *Id.* The TTAB reasoned that "[t]he relationship of the goods and the similarity of the marks in this case are factors which, if considered in and of themselves, ***without regard to any other relevant factors*** revealed by the record, would be indicative of a finding of likelihood of confusion." *Id.* (emphasis supplied). The TTAB held that because the two marks conveyed a different meaning, the two marks created a different commercial impression, and found no likelihood of confusion. *Id.* at 1314.

The analysis conducted by the TTAB in the *Sears* decision is applicable here. In *Sears* the TTAB reasoned that the "mark 'CROSS-OVER', when applied to brassieres, is *suggestive* of the construction of the brassieres. . . [r]egistrant's mark "CROSSOVER", on the other hand, conveys no such meaning when applied to ladies' sportswear, namely, tops, shorts, and pants. . . [r]ather, it appears to us that registrant's mark is likely to be perceived by purchasers either as an entirely arbitrary designation, or as being suggestive of sportswear which 'crosses over' the line between informal and more formal wear (i.e., is appropriate for either use), or the line between two seasons." *Id. See also In re British Bulldog, Ltd.*, 224 U.S.P.Q. 854 (TTAB 1984) (PLAYERS for men's underwear held not likely to be confused with PLAYERS for shoes because the underwear line suggested a male sexual identity while the shoes were for athletic players); *In re Sydel Lingerie Co., Inc.*, 197 U.S.P.Q. 629 (TTAB 1977) (BOTTOMS UP for ladies' and children's underwear held not likely to be confused with BOTTOMS UP for men's clothing because the mark associated with the men's line suggested the salutation "drink up").

Likewise, when considering the services listed under the subject mark, the mark CLOUD EXPERIENCE conveys a meaning suggestive of the services related to accessing the cloud, without any association to Adobe which is a well-known brand. By contrast, the mark ADOBE EXPERIENCE CLOUD conveys a meaning of accessing the services traditionally (for over twenty years) offered by Adobe through desktop applications, through the cloud on a subscription basis. Thus, the Applicant's mark and Registrant's mark convey different meanings or connotations. Consequently, Applicant's mark and Registrant's mark create a different commercial impression. *Id.*

The Examining Attorney contends that the "presence of a house mark to an otherwise confusingly similar mark will not obviate a likelihood of confusion," but Applicant respectfully

disagrees. Even if the Applicant's marks and Registrant's marks were similar in appearance (which Applicant disputes), additions or deletions to marks may be sufficient to avoid a likelihood of confusion if: (1) the marks in their entireties convey significantly different commercial impressions (as discussed above); or (2) the matter common to the marks is not likely to be perceived by purchasers as distinguishing source because it is merely descriptive or diluted. *See, e.g., Citigroup Inc. v. Capital City Bank Group, Inc.*, 637 F.3d 1344, 1356, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011) (affirming TTAB's holding that contemporaneous use of applicant's CAPITAL CITY BANK marks for banking and financial services, and opposer's CITIBANK marks for banking and financial services, is not likely cause confusion, based, in part, on findings that the phrase "City Bank" is frequently used in the banking industry and that "CAPITAL" is the dominant element of applicant's marks, which gives the marks a geographic connotation as well as a look and sound distinct from opposer's marks); *Shen Mfg. Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 1245, 73 USPQ2d 1350, 1356-57 (Fed. Cir. 2004) (reversing TTAB's holding that contemporaneous use of THE RITZ KIDS for clothing items (including gloves) and RITZ for various kitchen textiles (including barbeque mitts) is likely to cause confusion, because, *inter alia*, THE RITZ KIDS creates a different commercial impression); *Safer, Inc. v. OMS Invs., Inc.*, 94 USPQ2d 1031, 1044-45 (TTAB 2010) (holding DEER-B-GON for animal repellent used to repel deer, other ruminant animals, and rabbits, and DEER AWAY and DEER AWAY PROFESSIONAL for repellent for repelling deer, other big game, and rabbits, not likely to cause confusion, noting that "DEER" is descriptive as applied to the relevant goods and thus has no source-indicating significance); *Bass Pro Trademarks, L.L.C. v. Sportsman's Warehouse, Inc.*, 89 USPQ2d 1844, 1857-58 (TTAB 2008) (finding that, although cancellation petitioner's and respondent's marks were similar by virtue of the shared descriptive wording "SPORTSMAN'S WAREHOUSE," this similarity was outweighed

by differences in terms of sound, appearance, connotation, and commercial impression created by other matter and stylization in the respective marks); *In re Farm Fresh Catfish Co.*, 231 USPQ 495, 495-96 (TTAB 1986) (holding CATFISH BOBBERS (with "CATFISH" disclaimed) for fish, and BOBBER for restaurant services, not likely to cause confusion, because the word "BOBBER" has different connotation when used in connection with the respective goods and services); *In re Shawnee Milling Co.*, 225 USPQ 747, 749 (TTAB 1985) (holding GOLDEN CRUST for flour, and ADOLPH'S GOLD'N CRUST and design (with "GOLD'N CRUST" disclaimed) for coating and seasoning for food items, not likely to cause confusion, noting that, because "GOLDEN CRUST" and "GOLD'N CRUST" are highly suggestive as applied to the respective goods, the addition of "ADOLPH'S" is sufficient to distinguish the marks); *In re S.D. Fabrics, Inc.*, 223 USPQ 54, 55-56 (TTAB 1984) (holding DESIGNERS/FABRIC (stylized) for retail fabric store services, and DAN RIVER DESIGNER FABRICS and design for textile fabrics, not likely to cause confusion, noting that, because of the descriptive nature of "DESIGNERS/FABRIC" and "DESIGNER FABRICS," the addition of "DAN RIVER" is sufficient to avoid a likelihood of confusion); *see also* TMEP §1207.01(b)(viii).

In addition, if a transposed mark creates a distinctly different commercial impression, then confusion is not likely. *See, e.g., In re Best Products Co., Inc.*, 231 U.S.P.Q. 988 (TTAB 1986) (BEST JEWELRY and design (with "JEWELRY" disclaimed) for retail jewelry store services held not likely to be confused with JEWELERS' BEST for jewelry); *In re Mavest, Inc.*, 130 U.S. P.Q. 40 (TTAB 1961)(SQUIRETOWN for men's sport clothes creates a different commercial impression than TOWN SQUIRES for men's shoes, despite resulting from reversal of nearly identical elements); *Murphy, Brill & Sahner, Inc. v. New Jersey Rubber Co.*, 102 USPQ 420 (Comm. 1954) (TOPFLITE was found to have a definite meaning when used for

shoe soles, but FLITE TOP was considered to have little meaning as applied to hosiery. Moreover, the marks TOPFLITE and FLITE TOP were found to be quite different in appearance); *In re Akzona, Inc.*, 219 USPQ 94 (TTAB 1983) (the Board found the marks SILKY TOUCH for synthetic yarns and TOUCH O' SILK for men's dress shirts to each have a distinct meaning, the first a feel of silk, the second a small amount of silk. And once again, the Board pointed to the differences in the sound and appearance of the marks). Similarly, a consumer considering the Applicant's mark would find it to be quite different in sound and appearance from Registrant's mark and would likely not "attribute the services specified in the application to the same source as the registrant's services" as the Examining Attorney suggests. Specifically, the transposition of the words related to the subject application would convey a message related to experiencing the cloud, while the prior registration would convey a message of experiencing Adobe services.

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

In the Office Action, the Examining Attorney stated that:

In the present case, the software services of the applicant and registrant describe highly similar and overlapping functions. Specifically, the registrant's software services feature computer software for creating, designing, building, publishing, and managing websites, content for websites, and for creating, editing and managing images, graphics, data and text on web sites and for the customization and layout of text, images. and graphics for web sites. The applicant's similarly described software services involve the creation of Internet applications and client interfaces, software to design and management content of websites and applications, and services to access back end services involving the syncing, storage, control and transmission of data, notification, user management, reporting and other functions. As such, the services of the parties both involve the design and administration of websites and web applications.

Applicant respectfully submits that the goods and services are not highly similar in this case. Registrant's mark relates to application service provider services (ASP). By contrast, Applicant's mark relates to software as a service (SaaS). ASP is used to provide computer-based

services to clients over a network. It allows customers to gain access to an application program via a standard protocol, for instance, CRM over the Internet or via HTTP. SaaS extends the ASP model idea. While ASPs try to focus on managing and hosting 3rd-party ISV software, SaaS vendors manage the software they have developed on their own. In addition, ASPs provide more traditional client-server applications, requiring installation of software on users' PCs. On the other hand, SaaS rely solely on the Web and can be accessed via a web browser. Additionally, ASPs' software architecture required that, for each business, you must maintain a separate instance of the application. However, SaaS does not maintain such requirements, as SaaS solutions use a multi-tenant architecture in which the application serves multiple users and businesses. Users access SaaS over the internet and it works in maintenance and service operation. Also, users pay per use and not as per a license, while the provider is responsible for maintenance and storage of data and business logic in the cloud. SaaS is an all-inclusive business architecture and a value delivery model other than a software delivery method. It is characterized by an inbuilt, scalable, multi-tenancy, allowing for shared resources and infrastructure.

Goods and services are not necessarily related simply because they fall under the same broad category. *Edwards Lifesciences Corporation v. VigiLanz Corporation*, 94 USPQ2d 1399 (TTAB 2010) (VIGILANZ and VIGILANCE not confusingly similar although both marks were used in connection with patient monitoring devices in hospital settings. The Board stated that the relatedness of the goods inquiry "is not based on whether a general term or overarching relationship can be found to encompass them both.") In considering the similarity of the goods and services offered under two marks, the inquiry must focus on the relation of the goods and services in the minds of consumers. *Packard Press, Inc. v. HewlettPackard, Inc.*, 227 F.3d 1352, 1358 (Fed. Cir. 2000). Confusion is not necessarily likely simply because the goods or services can be

described as being in the same category or field. See *Therma-scan, Inc. v. Thermoscan, Inc.*, 295 F.3d 623 (6th Cir. 2002). Indeed, “[g]oods [and services] may fall under the same general product category but operate in distinct niches,” thereby avoiding confusion. *Checkpoint Systems, Inc. v. Check Point Software Technologies, Inc.*, 269 F.3d 270, 288 (3d Cir. 2001). While Applicant’s and Registrant’s goods and services both fall under the same broad category, Applicant’s mark relates to SaaS, and Registrant’s mark relates to ASP services and therefore, the two are not related.

Nature And Extent Of Any Actual Confusion

Applicant submits that it has never been contacted by any third parties requesting information about Registrant, and therefore, Applicant is not in possession of any evidence that any actual confusion exists. Further, nothing in the record reflects any evidence of actual confusion.

The Length Of Time During And Conditions Under Which There Has Been Concurrent Use Without Evidence Of Actual Confusion

This factor weighs in Applicant’s favor. Applicant’s mark has been in use since January 2015. Registrant’s mark has been in use since March 2017. As stated above, Applicant is not aware of any actual confusion between the marks.

The Variety Of Goods On Which A Mark Is Or Is Not Used (House Mark, “Family” Mark, Product Mark)

The Examining Attorney claims that “although the registrant's mark includes the house mark ‘ADOBE,’ consumers would likely attribute the services specified in the application to the same source as the registrant's services.” Applicant respectfully submits that no such attribution is likely. In *Rolex Watch U.S.A., Inc. v. PRL USA Holdings, Inc.*, Opposition No. 91170868 (T.T.A.B. June 7, 2012) (non-precedential), the Trademark Trial and Appeal Board (TTAB) recently determined that there was no likelihood of confusion between the marks RLX RALPH

LAUREN and RALPH LAUREN RLX for “jewelry and watches” and the mark ROLEX for “watches, watch bracelets, and related jewelry products.” The TTAB found that the addition of the applicant’s well-known house mark could alleviate any possible likelihood of confusion. It opined that when RLX was “joined with the well-known name RALPH LAUREN the letters serve[d] as his initials RL combined with X, indicating an expansion of his product line.” The Board was of the view that, “given the different connotation and commercial impression engendered by the presence of the well-known mark RALPH LAUREN,” consumers would not perceive RLX as an abbreviation of ROLEX, even in the case where the RLX portion of the mark was emphasized. Similarly, here the common element in the parties’ marks, which are transposed, coupled with Registrant’s well-known ADOBE mark, create a different connotation and commercial impression which is not likely to cause consumers to attribute the Applicant’s services to the same source as the Registrant's services.

Extent Of Potential Confusion (Whether De Minimis Or Substantial)

In light of the fact that there are several products in the computing industry that market and sell a product referred to as an experience cloud (see Exhibit A), which is more confusingly similar to Registrant’s ADOBE EXPERIENCE CLOUD than Applicant’s CLOUD EXPERIENCE, Applicant respectfully submits that the extent of any potential confusion would be *de minimis*.

Balancing the Factors

In sum, the presence in the dissimilarity and nature of the goods and services, the unrelatedness of the goods and services as described in the application and registration, the length of time during which there has been concurrent use without evidence of actual confusion, and the variety of goods on which a mark is or is not used, are sufficient reasons to prevent a finding of

likelihood of confusion. Accordingly, Applicant respectfully requests that the statutory refusal be withdrawn and that the application be permitted to proceed to publication.

III. IDENTIFICATION OF SERVICES

Applicant hereby respectfully requests amendment of its identification of goods as follows:

CLASS 42: Software as a Service (~~SaaS~~) (SaaS) featuring software for the creation of Internet applications and client interfaces; Software as a Service (~~SaaS~~) (SaaS) featuring software to design and manage content of websites and applications; Software as a Service (~~SaaS~~) (SaaS) featuring software to access back end services, namely, syncing data, data storage, data control, data transmission, push notifications, user management, application performance reporting, mobile messaging, social media platforms, video player, mobile payment services.

IV. DISCLAIMER REQUIRED

No claim is made to the exclusive right to use “CLOUD” apart from the mark as shown.

V. CONCLUSION

If the Examining Attorney has any questions or requires further information, he is invited to telephone the undersigned at the telephone number indicated below.

Date: January 20, 2020

Respectfully submitted,

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CERTIFICATE OF TRANSMISSION

I hereby certify that this correspondence is being transmitted by electronic mail to the United States Patent and Trademark Office on the date shown below. I have been warned that willful false statements and the like are punishable by fine or imprisonment, or both (18 U.S.C. 1001), and may jeopardize the validity of this application, document, or registration resulting therefrom.

Date: January 20, 2020

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