


IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
OFFICE OF THE COMMISSIONER FOR TRADEMARKS

Applicant: TOOLBOX TVE, LLC
Serial No.: 88/411,348

Applicant's Mark: TOOLBOX

RESPONSE TO OFFICE ACTION

Applicant, Toolbox TVE, LLC, has carefully considered the Office Action dated July 23, 2019 and respectfully disagrees that there is a partial likelihood of confusion between Applicant's Mark TOOLBOX and U.S. Reg. No. 3,465,384 for  TOOLBOX STUDIOS registered in association with *inter alia* "interactive computer software development" in International Class 42 (the "Cited Mark"). For at least the following reasons, Applicant respectfully requests reconsideration and withdrawal of the partial refusal. Additionally, Applicant herein briefly addresses the Office Action's note regarding prior-filed applications.

I. Introduction

Applicant's Mark has been applied-for in connection with a variety of services in International Classes 38 and 42. This partial refusal is only with respect to a subset of the class 42 applied-for services, namely "Development of cloud computer software; development of software components for end-user devices, namely, television, mobile phones and personal computers." Applicant appreciates that Applicant's Mark has no conflict with the Cited Mark with respect to the remaining services.

Upon applying the familiar *du Pont* likelihood of confusion factors, it becomes clear that consumer confusion is unlikely. The marks, which must be viewed in their entirety, are notably different in appearance, sound, and commercial impression. This is especially true given the

crowded field of “toolbox” registrations peacefully coexisting. The services and trade channels for the respective marks are also dissimilar. The Cited Mark’s services are for *interactive* computer software development, which the Office Action alleges to be a “broad wording” that “presumably encompasses all services of the type.” Applicant respectfully disagrees with this characterization of the Cited Mark’s services, particularly in view of the Cited Mark’s prosecution history. When the identification of the Cited Mark’s services is properly interpreted, it is clear that the services are dissimilar and operate within distinct trade channels. Finally, the Office Action fails to consider that purchasers of Applicant’s applied-for services are highly educated, sophisticated consumers who are unlikely to be confused between these two marks.

Additionally, Applicant respectfully submits that suspension in view of the two other identified pending applications would be inappropriate. One of these applications has been cancelled, while the other is unlikely to cause confusion for similar reasons as the principally at-issue Cited Mark. Accordingly, Applicant respectfully requests withdrawal of the partial-refusal and early passage to publication.

II. Section 2(d) Partial Refusal – Likelihood of Confusion

While likelihood of confusion refusals pursuant to §2(d) of the Lanham Act are typically undertaken pursuant to the familiar *E.I. du Pont* factors, it is imperative to be mindful that “[t]he issue is not whether the respective marks themselves, or the goods or services offered under the marks, are likely to be confused but, rather, where there is a likelihood of confusion as to the source or sponsorship of the goods or services offered under the marks used thereon.” TMEP §1207.01. In explaining the §2(d) refusal, the Office Action reduces the likelihood of confusion analysis to a mere comparison of the marks and the respective services, against the TMEP’s warning not to oversimplify the analysis. The Federal Circuit, however, provides several other

includes the very large, prominently displayed letters RR” that served to “draw attention to the RR letters apart from the wording.” *Id.* Accordingly, the Board found “that the overall commercial impression of Applicant’s mark is dominated by its design features, ***particularly the large double-letter RR configuration***, and that this weighs heavily against a conclusion that confusion is likely.” *Id.*, at 1172 (emphasis added).

The comparison between Applicant’s Mark and the Cited Mark is analogous to the precedential TTAB decision of *In re Covalinski*. Here, the Cited Mark includes a prominent “T” that is stylized through an eye-popping colored background and angled orientation of the letter. The “T” is also significantly larger than either “toolbox” or “studios.” Indeed, the stylized “T” is roughly twice the combined height of the stacked “toolbox” and “studios.” Just as the “RR” was the dominant portion in *In re Covalinski*, the “T” is the dominant portion of the Cited Mark.




Cited Mark

The Office Action takes the position that the shared term “toolbox” is the dominant feature of the Cited Mark. In taking this position, the Office Action ignores “studios” as a descriptive, disclaimed term, and summarily dismisses the “T” as a “slight difference” that merely “reinforces the dominance of the wording ‘Toolbox.’” This amounts to an improper dissection of the Cited Mark. If there is a dominant term, it is the large, stylized “T.” The TTAB did not consider the “RR” to merely reinforce the wording of “Redneck Racegirl,” but instead found the “RR” to create its own dominant commercial impression. Additionally, the term “studios” cannot be ignored in the analysis. This is because “confusion is evaluated from the perspective of the purchasing public, which is not aware that certain words or phrases have been

disclaimed.” *Shen Mfg. Co., Inc. v. Ritz Hotel, Ltd.*, 393 F.3d 1238, 1243 (Fed. Cir. 2004); *In re National Data Corp.*, 753 F.2d 1056, 1059 (Fed. Cir. 1985). At a minimum, the stylized “T” coupled with the additional and equally prominent “studios” term serves to deemphasize “toolbox” such that “toolbox” does not dominant the commercial impression of the Cited Mark when viewing the Cited Mark as a whole.

Applicant’s position that “toolbox” is *not* the dominant portion of the Cited Mark is bolstered by the “crowded field” of “toolbox” marks. Attached as Exhibit A is a recent TESS search showing 51 registered or pending marks related to computers or software incorporating the at issue term “toolbox.” Many of these are marks are registered with services for computer aided designing or developing in some capacity:

| Mark | Registration or Serial No. | Goods/Services | Applicant/Registrant |
|---|-------------------------------------|---|-----------------------------|
| TOOLBOX | 2055667 | computer programs for creating fonts featuring a stylized typeface (Int. Class 009) | Adobe Systems Incorporated |
| GRAPHICS-TOOLBOX | 3548509 (Supplemental) | computer software for use in developing text, images, art and designs (Int. Class 009) | Great Software Tools, Inc. |
| REPAIR TOOLBOX Disclaimer: "Repair" | 4263880 | Downloadable computer software and computer software on DVD and CD media for the management of data and recovery of lost, altered or damaged data and files... (Int. Class 009) Operating a website providing information in the field of licensing software for data management and recovery of lost, altered or damaged data and files... (Int. Class 045) | Bobrov, Victor |
| COMPLETIONS TOOLBOX Disclaimer: "Completions" | 88367253 (NoA mailed Aug. 13, 2019) | Product designs services related to oil and gas well completion and stimulation (Int. Class 042) | GEODynamics, Inc. |

| | | | |
|--|---------|---|---------------------------|
|  Disclaimer: "Technical" | 4583109 | Computer application software for design and maintenance of energy pipelines (Int. Class 009) Pipeline inspection services (Int. Class 042) | Technical Toolboxes, Inc. |
| BAKER'S TOOLBOX | 2906393 | Application service provider featuring computer software solutions for banks and financial institutions (Int. Class 042) | Banker's Toolbox, Inc. |
| LAWTOOLBOX | 3103283 | computer service, namely, acting as an application service provider in the field of knowledge management to host computer application software for searching and retrieving information from databases and computer networks (Int. Class 042) | LawToolBox.com, Inc. |

Given the “crowded field” of “toolbox” marks, the addition or deletion of distinctive material (such as a large prominent “T” plus the extra term “studios”) as well as other distinctions (as discussed below) should serve to distinguish Applicant’s Mark from the Cited Mark.¹

¹ This also implicates the sixth *du Pont* factor, number and nature of similar marks used on similar goods, which weighs in favor of Applicant. *See In re Mighty Leaf Tea*, 601 F.3d 1342, 1347 (Fed. Cir. 2010); *Entrepreneur Media, Inc. v. Smith*, 279 F.3d 1135, 1144 (9th Cir. 2002) (“that the marketplace is replete with products using a particular trademarked word indicates not only the difficulty in avoiding its use but also, and directly, the likelihood that consumers will *not* be consumed by its use.”); *Halo Managements, LLC v. Interland, Inc.*, 309 F.Supp.2d 1019, 1036-37 (N.D. Cal. 2003) (“the relevant trademark “field” is “crowded,” a conclusion that cuts against [plaintiff’s] likelihood of confusion claim”); *Nautilus Group, Inc. v. Savvier, Inc.*, 427 F.Supp.2d 990, 995 (W.D Wash. 2006) (“A mark exists in a crowded field if it is hemmed in by similar marks selling similar goods”).

In short, the Cited Mark and Applicant’s Mark are significantly different in appearance, sound, and commercial impression as a consequence of a) the notable differences between the marks, and b) the “crowded field” of the shared “toolbox” term.

B. The Services are Dissimilar

Services are similar if consumers are likely to think that the parties’ services emanate from the same source. *See Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 1329 (Fed. Cir. 2000); *In re Shell Oil Co.*, 992 F.2d 1204, 1207 (Fed. Cir. 1993); TMEP §1207.01(a)(i). In maintaining a *prima facie* rejection, “[t]he examining attorney must provide evidence showing that the goods and services are related.” TMEP §1207.01(a)(vi). Applicant respectfully submits that the Office Action failed to meet this burden, and further that the services are indeed dissimilar.

At the outset, Applicant respectfully submits that the Office Action mischaracterizes, without supporting evidence, the scope of the services in the Cited Mark. “The nature and scope of a party’s goods or services must be determined on the basis of the goods or services recited in the application or registration.” TMEP §1207.01(a)(iii). The Office Action takes the position that Cited Mark’s identification of services “uses broad wording...which presumably encompasses all services of the type described, including applicant’s more narrowly described [services].” Applicant respectfully disagrees that the Cited Mark’s identification is “broad” and encompasses the partially-refused services in Applicant’s Mark.

| Cited Mark | Applicant’s Mark (partially refused services) |
|--|--|
| <i>interactive</i> computer software development (emphasis added) | development of <i>cloud computing</i> software; development of <i>software components for end-user devices</i> , namely, television, mobile phones and personal computers. (emphasis added) |

First, the Office Action offers no evidence that interactive computer software development is broad and encompasses the services recited in Applicant's Mark. The burden falls on the Examining Attorney, not the Applicant, in demonstrating the similarity of the goods or services and trade channels. *See In re HerbalScience Group, LLC*, 2010 WL 5651672, at *4 (TTAB Sept. 23, 2010) ("If the examining attorney wished to contend that such botanical and chemical products used in the manufacturing of finished products are purchased by the general public, it was her burden to prove this")' *In re White Rock Distilleries Inc.*, 92 USPQ 2d. 1282, at *3 (TTAB 2009) (Examining attorney's "evidence, however, is hardly sufficient to convince us that applicant's energy vodka infused with caffeine and registrant's wines are related.").

Second, the Cited Mark's services are not all encompassing but instead are for a particular type of designing services that is dissimilar with Applicant's services. Selected portions of the prosecution history of the Cited Mark, attached as Exhibit B, as well as the specimen for the Cited Mark, attached as Exhibit C, are illustrative. With respect to "development" related services, the owner of the Cited Mark originally filed for *inter alia* "flash and interactive development" in International Class 35. *See* Exhibit B at 15-16. In an office action, the Examining Attorney required the originally filed lengthy list of services to be broken out into multiple classes and proposed *inter alia* "interactive computer software development" in International Class 42. *See Id.*, at 7. The owner of the Cited Mark accepted this proposal in its response. *See Id.*, at 1. Accordingly, the owner of the Cited Mark clearly considered "flash" to be an exemplary type of "interactive" software development.² The industry generally understands Adobe Flash to be a software platform "commonly used to display interactive web pages, online

² A mark's prosecution history is considered probative evidence in a likelihood of confusion analysis. *See Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 1340 (Fed. Cir. 2015); *Loader Boat Trailers, Inc. v. Cox Trailers, Inc.*, 213 U.S.P.Q. 597 (TTAB 1982).

games, and to playback video and audio content.” *See e.g.*

https://en.wikipedia.org/wiki/Adobe_Flash.³ Accordingly, the identification of the Cited Mark’s services are necessarily limited to multimedia on online platforms, particularly websites. The specimen of the Cited Mark confirms this interpretation. *See* Exhibit C, at 1 (“Toolbox produced a Flash-driven website”); at 5 (offering “Flash and Interactive Development” services”); and at 10 (listing creative services including “Website and Interactive Design” and “Flash Development”).

When properly interpreted, the services are quite dissimilar between the Cited Mark and Applicant’s Mark. Developing software for “cloud computing” or for components of end user devices does not fit under the umbrella of multimedia for websites. They are two entirely different contexts used by two entirely different type of consumers. An exemplary source of the Cited Mark’s services would be a marketing company, such as the owner of the Cited Mark, and the consumers would be companies interested in improving their website with multimedia content. *See* Exhibit C, at 8 (“Toolbox Studios is a communication design firm that specializes in creative solutions for highly complex marketing challenges.”). On the other hand, the services identified in Applicant’s Mark would most likely be offered by developers of back-end systems for consumers requiring cloud computing (*i.e.* remote data processing or storage) solutions.

The Office Action fails to carry its burden to demonstrate how these services are similar and could emanate from the same source. On the contrary, the evidence of record demonstrates it is unlikely they would come from the same source. This factor also weighs against a likelihood of confusion refusal.

³ Extrinsic evidence is appropriate to demonstrate that an “identification has specific meaning to members of the trade.” TMEP §1207.01(a)(iii).

C. The Trade Channels are Dissimilar

The third *du Pont* factor considers “the similarity or dissimilarity of the trade channels which goods are sold and the purchasers to whom the parties’ goods are marketed.” *Coach Services, Inc. v. Triumph Learning, LLC*, 668 F.3d 1356, 1370 (Fed. Cir. 2012). As evidenced above, the services of the Cited Mark would be offered through different trade channels (such as from a marketing company to develop a client’s website) than Applicant’s Mark (such as from a software company to develop cloud storage solutions). Thus, Applicant respectfully submits the third *du Pont* factor favors no likelihood of confusion.

D. Applicant’s Services Are Purchased by Sophisticated Consumers

It is well settled that the likelihood of confusion is reduced where purchasers and potential purchasers of goods and/or services are sophisticated. *See Electronic Design & Sales, Inc. v. Electronic Data Systems Corp.*, 954 F.2d 713 (Fed. Cir. 1992) (no confusion between identical marks where, *inter alia*, both parties’ goods and/or services are “usually purchased after careful consideration by person who are highly knowledgeable about the goods or services and their source.”); *see also* TMEP §1207.01(d)(vii) (care in purchasing tends to minimize the likelihood of confusion). The likely purchasers of Applicant’s services are highly educated consumers often with advanced technical degrees in computer programming and/or computer system design. *See e.g. Inc Publ’g Group v. Manhattan Magazine, Inc.*, 616 F.Supp. 370, 381 (S.D.N.Y. 1985) (consumers of business magazines were “well educated” and thus sophisticated). Because these highly educated consumers would exercise greater care in purchasing Applicant’s services, consumer confusion is further unlikely.

E. Conclusion

Viewing the *du Pont* factors together, it becomes clear that consumer confusion is unlikely. The marks are quite different in sound, appearance, and commercial impression particularly when considering the shared term is part of a crowded field of marks. The services are also quite different as they would usually emanate from different sources and marketed to different consumers in different trade channels. Confusion would be further unlikely given that the purchasers of Applicant's services would be highly educated and, thus, discerning and sophisticated consumers.

Based on the foregoing, Applicant respectfully requests favorable reconsideration and withdrawal of the partial refusal.

III. Prior-Filed Applications

The Office Action further notes that if either U.S. Application Serial Nos. 87797588 or 8812583 register, Applicant's Mark may be refused registration under Section 2(d). Application No. 8812583 is now abandoned, rendering the possibility of a Section 2(d) refusal moot. As for Application No. 87797588, which is pending and has been suspended, Applicant respectfully submits that a Section 2(d) refusal would be unwarranted under the *du Pont* factors especially in view of many of the above arguments, particularly the "crowded field" of toolbox marks as well as the sophistication of consumers.

Date: January 23, 2020

Respectfully Submitted,

/Rafael Perez-Pineiro/
Attorney of Record