

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

**Trademark:** EMPLOYEE SAFETY - AT THE TOUCH OF A BUTTON  
**Applicant:** SekureTrak Inc.  
**U.S. Serial No.:** 88/419,527  
**Filed:** May 7, 2019  
**Examining Attorney:** Schwarz, Kathleen, Law Office 123

**RESPONSE TO JULY 30, 2019 OFFICE ACTION**

In the Office Action dated July 30, 2019, the Examining Attorney refused registration of Applicant's EMPLOYEE SAFETY - AT THE TOUCH OF A BUTTON mark ("Applicant's Mark") on the grounds that there is a likelihood of confusion between Applicant's mark and a prior registration for HELP AT THE TOUCH OF A BUTTON by Code Blue Corporation ("Registrant") for use in connection with "Emergency alarm systems comprising emergency warning lights, safety equipment, namely, beacon lights, communications devices, namely, telephones, intercoms, and two-way radios, video surveillance equipment, namely, video cameras, video monitors, and video receivers, and access control equipment, namely, magnetic card strip readers, proximity sensors, and smart card readers, for use in commercial buildings and as freestanding safety kiosks" (Reg. No. 3,794,877) ("Registrant's Mark"). Applicant respectfully disagrees with the Examining Attorney's refusal. In addition, Applicant has provided a response to the Examining Attorney's request for an amendment to its identification of services below.

**REMARKS**

**I. Amendments to Identification of Services**

Per the Examining Attorney's claim that Applicant's current identification of services is indefinite and too broad, Applicant wishes to amend its identification of services.

**Applicant's description of services currently reads:**

- Class 45 - Security services, namely, protecting, tracking, locating, and monitoring personnel and inventory; Emergency response alarm monitoring services, namely, provision of a monitoring computer application connection for the a press-of-button notification to third parties for health and security services

**Applicant wishes to amend its identification of services to read:**

- Class 9 - Downloadable computer application software for emergency response alarm monitoring that provides a press-of-button notification to third parties for health and security response services
- Class 41 - Providing temporary use of on-line non-downloadable computer software applications for emergency response alarm monitoring that provides a press-of-button notification to third parties for health and security response services
- Class 45 - Security services, namely, protecting, tracking, locating, and monitoring personnel and inventory

Per TMEP § 1402.06, Applicant's proposed amendment to its identification of services, limits, not broadens, its identification of services, and should therefore be acceptable.

**II. There is No Likelihood of Confusion Between the Marks**

Applicant contends there is no likelihood of confusion between Applicant's Mark and Registrant's Mark because the parties' goods and services are different, travel in different channels

of trade, are sold to sophisticated purchasers, and the marks are different. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 U.S.P.Q. 563, 567 (C.C.P.A. 1973) (determining likelihood of confusion by thirteen factors, including: similarity of the marks, the conditions under which and buyers to whom sales are made, *i.e.*, “impulse” vs. careful, sophisticated purchasing, and any other probative fact(s)). It is well-settled that each factor is to be given its due weight and that a single *Dupont* factor should not outweigh all the rest. *Kellogg Co. v. Pack ‘Em Enters., Inc.*, 951 F.2d 330, 333, 21 U.S.P.Q.2d 1142, 1145 (Fed. Cir. 1991).

**A. Applicant’s Services and Registrant’s Goods are Dissimilar and Travel in Different Channels of Trade.**

Applicant’s Mark is unlikely to cause confusion with Registrant’s Mark given the differences between the Registrant’s goods and the Applicant’s services. Even identical marks can coexist on the Principal Register when the goods or services associated with the respective marks are sufficiently different to obviate confusion. *See Electronic Design & Sales, Inc. v. Electronic Data Systems, Corp.*, 954 F.2d 713, 717, 21 U.S.P.Q.2d 1388, 1391 (Fed. Cir. 1992) (reversing the Board’s finding of likelihood of confusion between opposer’s registered mark EDS for computer programming services and Applicant’s mark E.D.S. for power supplies and battery chargers, even though both parties were in the medical field); *Triumph Machinery Company v. Kentmaster Manufacturing Company, Inc.*, 1 U.S.P.Q.2d 1826, 1829 (TTAB 1987) (finding no likelihood of confusion between HYDRO-CLIPPER for power operated cattle de-horning shears and HYDRO-CLIPPER (and design) for power mower attachments).

In *Electronic Realty Associates v. Extra Risk Associates*, 217 U.S.P.Q. 810 (TTAB 1982), the opposer owned the mark ERA for real estate brokerage services, and the applicant sought registration of the mark ERA EXTRA RISK ASSOCIATES for insurance brokerage services, with

the words “Extra Risk Associates” disclaimed. The Board found that, notwithstanding the overlap in the term ERA in the marks and the brokerage aspects of the services offered in connection with the respective marks, confusion was unlikely since the services were not so related that consumers would assume a common source or origin. *Id.* at 816.

The similarity between Applicant’s Services and Registrant’s Goods are superficial in nature - the only overlap or similarity is of the relationship to security. Registrant’s goods are alarm kiosks, intercoms and light stations used on university and corporate campuses. *See* Code Blue, *Code Blue*, <https://codeblue.com/> (last visited January 28, 2020), attached as Exhibit A.



Applicant’s software and location tracking services are used in the hotel and hospitality industry to monitor employee location and send notifications and alerts to and from devices worn by personnel. *See* attached specimens, also attached as Exhibit B. Customers are unlikely to be confused by the simultaneous use of Applicant’s Mark and Registrant’s Mark in the broad field of

security when they are used in connection with goods and services that fall into differing niche segments within that industry. *See Checkpoint Sys., Inc. v. Check Point Software Techs., Inc.*, 269 F.3d 270, 288 (3d Cir. 2001) (finding no likelihood of confusion where identical CHECKPOINT marks were both used in the broad corporate security industry because Plaintiff's mark was used for physical corporate security and Defendant's mark was used for electronic corporate security and the parties' products were expensive, highly specialized in function, subject to long sale processes, and advertised to highly specialized consumers); *Harlem Wizards Entm't Basketball, Inc. v. NBA Properties, Inc.*, 952 F. Supp. 1084, 1095 (D.N.J. 1997) (after comparing the Harlem Wizards, a "show basketball" entertainment organization, with the National Basketball League's franchise team the Washington Wizards, finding that "[a]ny similarity between the two teams is superficial and the result of creating over-inclusive categories that are irrelevant to the likelihood of confusion").

These differences also result in the goods and services of each party being sold to different customers in different channels of trade. Applicant's customers are hotel and hospitality management. Registrant's customers are administrators of large outdoor corporate and academic campuses.

Based on the different types of customers and the intended use and purpose of the goods and services, there is no likelihood of confusion. *See, e.g., In Re Shipp*, 4 U.S.P.Q.2d 1174, 1176 (TTAB 1987) (no confusion between PURITAN for laundry and dry-cleaning services, PURITAN for commercial dry cleaning machine filters, or PURITAN for cleaning preparations, because the goods and services were not likely to come to the attention of the same kinds of purchasers); *MTD Products, Inc. v. Universal Tire Corp.*, 193 U.S.P.Q. 56, 59-60 (TTAB 1976) (confusion unlikely between COLUMBIA for automobile tires and COLUMBIA for wheeled products bearing rubber

tires, including bicycles, tricycles, road-hauling tractors, motorized all-terrain vehicles, motorcycles, agricultural tractors, motorized snow throwers, motorized riding mowers, and motorized walking mowers).

**B. Purchasers Exercise a High Degree of Care When Considering Purchasing Applicant's Services and Registrant's Goods.**

In addition to the differences in the goods and services, customers and channels of trade, any likelihood of confusion is significantly reduced due to the high degree of care that would be exercised by the customers for the parties' goods and services. *See* TMEP § 1207.01 (d)(viii) (care in purchasing tends to minimize the likelihood of confusion); *Elec. Design & Sales, Inc. v. Elec. Data Systems Corp.*, 954 F.2 713, 718 (Fed. Cir. 1992) (no confusion between identical marks where, inter alia, both parties' goods and services "are usually purchased after careful consideration by persons who are highly knowledgeable about the goods or services and their source").

Applicant's customers are hospitality managers looking for discreet, personal security and monitoring services for their personnel and inventory. Representative customers for Applicant's services include large hotel chains such as Hyatt, Marriott, and Kimpton. *See, e.g.*, TraknProtect, *Our Clients*, <https://traknprotect.com/our-clients/> (last visited January 28, 2020), attached as Exhibit C. Registrant's customers, are administrators of large corporate and academic campuses looking to purchase emergency communication equipment and kiosks to be installed throughout the grounds of the institution. These types of products and services are not purchased on impulse, but rather after careful research and consideration. *See, e.g., Magnaflux Corp. v. Sonoflux Corp.*, 231 F.2d 669, 109 U.S.P.Q. 313 (C.C.P.A. 1956) ("confusion is less likely where goods are expensive and purchased after careful consideration than where they are inexpensive and

purchased casually”); *Dynamics Research Corp. v. Langenau Mfg. Co.*, 704 F.2d 1575, 1576, 217 U.S.P.Q. 649,650 (Fed. Cir. 1983) (finding no likelihood of confusion between identical DRC marks where the parties’ sold their goods to different, discriminating customers); *In re Thor Tech, Inc.*, 113 U.S.P.Q.2d 1546, 1551 (TTAB 2015) (finding use of identical TERRAIN marks for towable trailers versus trucks not likely to cause confusion given the difference in the nature of the goods and their channels of trade and the high degree of consumer care likely to be exercised by the relevant consumers).

**C. Applicant’s Mark and the Registered Mark are Different in Sound, Appearance, and Commercial Impression.**

Applicant’s EMPLOYEE SAFETY - AT THE TOUCH OF A BUTTON mark is different in sound, appearance, and commercial impression from the Registered Mark, such that confusion is unlikely. Under a likelihood of confusion analysis, the Examining Attorney must examine the marks as a whole, in their entirety. *See G.D. Searle & Co. v. Chas Pfizer & Co.*, 105 U.S.P.Q. 391 (C.C.P.A. 1955). Thus, in determining whether confusion is likely in this instance, Applicant’s and Registrant’s marks should not be dissected but, rather, should be compared in their entirety.

While Applicant’s Mark and the Registered Mark happen to share the commonplace phrase AT THE TOUCH OF A BUTTON, there are substantial differences between the marks and the respective goods and services that result in different commercial impressions when viewed as a whole, as they must be. The mere inclusion of a common element in two marks does not automatically create a likelihood of confusion. 3 McCarthy on Trademarks & Unfair Competition § 23:41 (4th ed. 2015). Registrant’s Mark, HELP AT THE TOUCH OF A BUTTON, begins with the term HELP. Applicant’s Mark begins with the terms EMPLOYEE SAFETY followed by a

hyphen. These marks are distinguishable in sight and sound because HELP and EMPLOYEE SAFETY do not look or sound alike.

The addition of other matter to a mark is sufficient to avoid consumer confusion, even if the additional term is descriptive or suggestive. *See In re Hunke & Jochheim*, 185 U.S.P.Q. 188 (TTAB 1975) (HIG.DURABLE for stationery not similar to DURABUL for record books); *Shen Manufacturing Co. v. Ritz Hotel Ltd.*, 73 U.S.P.Q.2d 1350 (Fed. Cir. 2004) (holding that RITZ and THE RITZ KIDS were deemed to create different commercial impressions); *In re Farm Fresh Catfish Co.*, 231 U.S.P.Q. 495 (TTAB 1986) (holding CATFISH BOBBERS for fish was held not likely to be confused with BOBBER for restaurant services); *Streetwise Maps Inc. v. VanDam Inc.*, 48 U.S.P.Q.2d 1503 (2d. Cir. 1998) (finding no likelihood of confusion between STREETWISE and STREETSMART for maps); *In re Shawnee Milling Co.*, 225 U.S.P.Q. 747, 749 (TTAB 1985) (holding no likelihood of confusion between GOLDEN CRUST for flour, and ADOLPH'S GOLD'N CRUST for coating and seasoning for food items, 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).

### **CONCLUSION**

In view of the foregoing, Applicant believes that the marks are distinguishable and confusion is unlikely. Applicant therefore respectfully requests that the refusal be withdrawn and its mark be published for opposition.

Dated: January 30, 2020

Respectfully submitted,

/s/ Omotara Akinwande  
One of the Attorneys for Applicant  
Quarles & Brady LLP  
300 N LaSalle Street



Suite 4000  
Chicago, IL 60654  
(312)715-2760  
[tm-dept@quarles.com](mailto:tm-dept@quarles.com)