

This is submitted in response to the Office Action concerning Application No. 88424253 for the mark XVX (“Applicant’s Mark”), whereby the Examining Attorney issued a likelihood of confusion refusal pursuant to 15 U.S.C. § 1052(d).

LIKELIHOOD OF CONFUSION REFUSAL

INTRODUCTION

The Examining Attorney has initially refused registration of Applicant’s Mark for all the goods and services in Classes 9 and 42. The initial refusal is pursuant to 15 U.S.C. § 1052(d) on a likelihood of confusion with the prior registration for XVX (Reg. No. 5512987) (the “Cited Mark”), owned by an individual in China, Mr. Zhang Xiaopeng, for use with:

“Batteries; Battery boxes; Battery cases; Battery charge devices; Battery chargers; Blank USB flash drives; Cabinets for loudspeakers; Cases adapted for mobile phones; Cases for smartphones; Cases for mobile phones; Cell phone backplates; Cell phone battery chargers for use in vehicles; Cell phone covers; Cell phone faceplates; Cell phones; Computer bags; Computer cameras; Computer card adapter; Computer carrying cases; Computer cases; Computer mounts; Computer network adapters; Computer screen filters; Covers for smartphones; Eye glass cases; Eye glasses; Hands free devices for mobile-phones; Headphones; Keyboards; Laptop carrying cases; Laptop computers; Laptops; Loudspeakers; Luminous signs; Microphones; Mobile phones; Mounting devices for cameras and monitors; Mounting devices for monitors; Mounting devices for photographic equipment; Mounting brackets adapted for computer monitors; Mouse pads; Protective films adapted for smartphones; Scales; Stands adapted for mobile phones; Switch boxes; Switches, electric; Time clocks; Time recording apparatus; USB cables; USB cables for cellphones; USB card readers; USB charging ports; USB charging ports for use in vehicles; USB hubs; USB wireless routers; Backpacks especially adapted for holding laptops; Blank USB cards; Camera lens mounts; Carrying cases for cell phones; Carrying cases, holders, protective cases and stands featuring power supply connectors, adaptors, speakers and battery charging devices, specially adapted for use with handheld digital electronic devices, namely, cell phones; Cell phone cases; Cell phone battery chargers; Electric batteries; Electric switch plates; External computer hard drives; Head-mounted video displays; Laptop computer cooling pads; Micro USB cables; Micro USB ports; PC tablet mounts; Power switches; Protective covers for smartphones; Protective covers and cases for cell phones, laptops and portable media players; Sleeves for laptops; Smartphone mounts; Speaker microphones; Tablet computer; Telephone headsets; Wrist-mounted smartphones,” in Class 9.

Applicant respectfully submits that its goods and services as now amended are readily distinguishable from the Cited Mark. Applicant’s Mark can coexist on the registry along with the Cited Mark without causing confusion.

ANALYSIS

In support of the likelihood of confusion objection, the Office Action states that: “companies commonly provide computer hardware, computer programs, and consulting/support services as well as registrant’s goods. Thus, applicant’s and registrant’s goods and/or services are considered related for likelihood of confusion purposes.” The Office Action further states that: “upon encountering applicant’s and registrant’s marks, consumers are likely to be confused and mistakenly believe that the respective goods and services emanate from a common source.” Applicant respectfully requests that the Examining Attorney reconsider this rejection.

Applicant’s goods and services do not overlap with and are not closely related to the goods identified in the Cited Mark. Applicant’s goods and services as amended are limited to the computerized automation of financial transactions and related support services clearly targeted to highly sophisticated purchasers. There is nothing in Applicant’s identification of goods and services that overlaps with the identified Class 9 goods of the Cited Mark. Indeed, the Cited Mark does not even include computer software, computer programs, or electronic publications. Applicant’s software and technical services, as clarified by the amendments in this Response to Office Action, are worlds away from the cell phone cases, ear phones, batteries, USB cables and all the other computer accessories in the Cited Mark.

Applicant’s goods/services identified by Office Action as confusingly similar (now amended per the below)	Cited Mark
<p>Class 9: computer programs, namely, downloadable and recorded computer programs for the purposes of data transmission, data encryption, data processing, data communication or distributed computation, all in the field of computerized automation of financial transactions; computer software, namely, downloadable and recorded computer software for the purposes of data transmission, data encryption, data processing, data communication or distributed computation, all in the field of computerized automation of financial transactions; downloadable electronic publications, namely, technical guides, user guides, brochures, promotional materials, newsletters, product documentation, research papers and articles in the fields of computer software for the automation of financial transactions, cryptography, distributed technology, payments, payment systems, financial settlement, financial settlement systems, and capital and financial market infrastructure</p>	<p>Class 9: Batteries; Battery boxes; Battery cases; Battery charge devices; Battery chargers; Blank USB flash drives; Cabinets for loudspeakers; Cases adapted for mobile phones; Cases for smartphones; Cases for mobile phones; Cell phone backplates; Cell phone battery chargers for use in vehicles; Cell phone covers; Cell phone faceplates; Cell phones; Computer bags; Computer cameras; Computer card adapter; Computer carrying cases; Computer cases; Computer mounts; Computer network adapters; Computer screen filters; Covers for smartphones; Eye glass cases; Eye glasses; Hands free devices for mobile-phones; Headphones; Keyboards; Laptop carrying cases; Laptop computers; Laptops; Loudspeakers; Luminous signs; Microphones; Mobile phones; Mounting devices for cameras and monitors; Mounting devices for monitors; Mounting devices for photographic equipment; Mounting brackets adapted for computer monitors; Mouse pads; Protective films adapted for smartphones; Scales; Stands adapted for mobile phones; Switch boxes; Switches, electric; Time clocks; Time recording apparatus; USB cables; USB cables for cellphones; USB card readers; USB charging ports; USB charging ports for use in vehicles; USB hubs; USB wireless routers; Backpacks especially adapted for holding laptops; Blank USB cards; Camera lens</p>

	<p>mounts; Carrying cases for cell phones; Carrying cases, holders, protective cases and stands featuring power supply connectors, adaptors, speakers and battery charging devices, specially adapted for use with handheld digital electronic devices, namely, cell phones; Cell phone cases; Cell phone battery chargers; Electric batteries; Electric switch plates; External computer hard drives; Head-mounted video displays; Laptop computer cooling pads; Micro USB cables; Micro USB ports; PC tablet mounts; Power switches; Protective covers for smartphones; Protective covers and cases for cell phones, laptops and portable media players; Sleeves for laptops; Smartphone mounts; Speaker microphones; Tablet computer; Telephone headsets; Wrist-mounted smartphones.</p>
<p>Class 42: Research and development of software relating to the computerised automation of financial transactions; computer programming, consulting, and maintenance services relating to computer programs for the computerized automation of financial transactions; software development relating to the computerised automation of financial transactions; computer technical assistance and support, namely, 24/7 help desk services and providing remote infrastructure management services for troubleshooting, monitoring, administration and management of computer programs for the automation of financial transactions.</p>	<p><i>No Class 42 services, but the Examining Attorney generally states: “companies commonly provide computer hardware, computer programs, and consulting/support services as well as registrant’s goods.”</i></p>

The significant differences in the goods and services offered in connection with the respective marks obviate any potential likelihood of confusion. “[C]onfusion is related not to the *nature* of the mark but to its *effect* when applied to the goods of the Applicant. The only relevant application is made in the marketplace.” *In re E.I. DuPont de Nemours & Co.*, 476 F.2d 1357, 1360 (CCPA 1973) (emphasis in original). Registrant’s goods are for computer and cell phone hardware, peripherals and accessories, as identified in the chart above, in Class 9, and underscored by the specimen submitted by Registrant in support of the Cited Mark, attached as Exhibit A hereto, showing a USB cable and earphones adorned with cartoon characters.

By contrast, Applicant’s goods and services relate to computer software, documentation, research and development, and support services, **all specifically limited to the computerized automation of financial transactions**. The only relationship between the respective goods and services is that both generally fall within the broad computer technology field, but in two different channels of trade, to different end users, and in different ways. There is no “per se” rule that certain goods or services are related. T.M.E.P. § 1207.01(a)(iv); *Information Resources, Inc. v. X*PRESS Information Services*, 6 U.S.P.Q. 2d 1034, 1038 (T.T.A.B. 1988) (holding no likelihood of confusion between computer hardware and software). The mere fact that both marks may generally relate to computers does not necessitate a finding of likelihood of confusion. Applicant’s identification of goods and services relates to the computerized automation of financial transactions, and (as discussed below) its goods and services are utilized by and marketed to global

banks and financial institutions. Registrant's goods, on the other hand, relate to peripherals and accessories one might find in an airport or shopping mall kiosk. Due to the wholly different uses for these marks and the differences in users of these products and services, it is not likely or probable that consumers would confuse Applicant's goods and services with the goods purportedly offered in connection with the Cited Mark.

While the Cited Mark appears to target individuals seeking cell phone cases, USB cables, earphones, and the like, Applicant's Mark solely targets highly sophisticated purchasers. Applicant offers software and support and development services for the computerized settlement of financial transaction. For context, and as the articles and information attached as Exhibit B explain, Applicant's software and services are part of "a new, streamlined payment mechanism for institutional purposes, that could potentially replace clearinghouses and other intermediaries that sits between buyers and sellers of assets." Moreover, Applicant's development has been through the Utility Settlement Coin ("USC") project that Applicant co-founded, and the collaborators include "ten of the world's biggest banks aimed to create/develop a digital cash system to effectively process inter-bank transactions via blockchain or distributed ledger technology." *Id.* By way of example, these participants, who ultimately are consumers of the goods and services as well, include UBS, BNY Mellon, Deutsche Bank, Santander, broker/dealer ICAP, Barclays, HSBC, State Street, Credit Suisse, MUFG, and the Canadian Imperial Bank of Commerce. *Id.* The consumers of the goods and services marketed under the Applicant's Mark are arguably as sophisticated as it gets. It follows that they would not be confused between Applicant as the source of the goods and services in Applicant's Mark, and the USB cables and cartoon character-adorned headphones that Mr. Xiaopeng claims to offer under the Cited Mark.

The level of sophistication of purchasers is a significant factor in determining likelihood of confusion. *See Industrial Nucleonics Corp. v. Hinde*, 475 F.2d 1197, 177 U.S.P.Q. 386 (C.C.P.A. 1973). The more sophisticated a customer is, the less likely that he or she will be confused as to the source of a product. *See Palm Bay Imports v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369 (Fed. Cir. 2005); *Electronic Design & Sales v. E.D.S.*, 954 F.2d 713, 718 (Fed. Cir. 1992). Moreover, as the Board explained in *Calypso Technology, Inc. v. Calypso Capital Management, LP*, 100 USPQ2d 1213 (TTAB 2011), sophisticated purchasers are aware that a single source would not offer disparate products, even, as was the case in that dispute, were the products targeted to the same companies, *e.g.*, financial institutions.

Applicant's Mark and the Cited Marks are not confusingly similar. The USPTO often has concluded that identical marks with similar goods and services can coexist without confusion. While Applicant's Mark is identical to the Cited Mark, there are meaningful differences in the nature of the goods and services offered. Moreover, the channels of trade are distinct, and the purchasers of Applicant's products and services are highly sophisticated financial institutions. These distinctions support Applicant's assertion that Applicant's Mark should be able to coexist on the registry along with the Cited Mark without causing confusion in the marketplace. In this instance, consumers simply are **not** likely to be confused and mistakenly believe that the respective goods and services emanate from a common source

Applicant respectfully requests that the Examining Attorney withdraw the refusal and approve Applicant's Mark for publication.