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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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| Applicant | SAYMINE TECHNOLOGIES LTD |
| Serial No. | 88/430,882 |
| Trademark | MINE |

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

**RESPONSE TO OFFICIAL ACTION**

Dear Examiner Colton:

In response to the Office Action mailed on August 9, 2019, please enter the following Remarks.

**REFUSAL BASED ON LIKELIHOOD OF CONFUSION**

Determination of likelihood of confusion under Section 2(d) is based on analysis of all of the facts which are relevant bearing on the likelihood of confusion issue. Examination of all of the relevant facts, notably the differences in the marks, the differences in the products and services and their use, the nature of Registrant's mark, the sophistication of purchasers and the conditions of purchase, establish that there is no likelihood of confusion between Applicant's mark and Registrant's mark.

The Office Action has initially refused registration of Applicant's mark MINE under Trademark Act Section 2(d), on the ground that Applicant's mark is likely to cause confusion

with **MINE** – Registration No. 5,119,703 over the following goods "computer software design, development, and implementation in class 042.

Applicant respectfully disagrees with the assertions set forth in the Office Action regarding the likelihood of confusion between Applicant's mark and the Registration No. 5,119,703 ("Registrant's mark") as will be explained below.

## RELEVANT LEGAL AUTHORITY

The phrase "likely to cause confusion" may be restated as: *Likely* means probable; it is irrelevant that confusion is "possible." *See Westchester Media v. PRL USA,* 214 F.3d 658, 663-64, 55 U.S.P.Q.2d 1255 (5th Cir. 2000) ("likelihood of confusion is synonymous with a probability of confusion, which is more than a mere possibility of confusion."); *See also Bongrain Int'l (Am.) Corp. v. Delice de France, Inc.,* 811 F.2d 1479, 1486, 1 U.S.P.Q.2d 1175 (Fed. Cir. 1987). In requiring proof of a "*substantial* likelihood of confusion," one court said that [t]his is more than mere semantics" and declined "to speculate as to any imaginable confusion…" *Church of Larger Fellowship Unitarian Universalist v. Conservation Law Fund of New England, Inc.,* 221 U.S.P.Q. 869, 871 (D. Mass. 1983).

The determination of whether there is a likelihood of confusion is a multifaceted test. The thirteen factors that make up this test were clearly articulated by the Federal Circuit Court of Appeals in *In re E.I. du Pont de Nemours & Co.,* 476 F.2d 1357, 177 U.S.P.Q. 563 (C.C.P.A. 1973). The thirteen *DuPont* 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 in the nature of the goods/services described in the application or registration of the mark, 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 the buyers to whom sales are made; (5) the fame of the prior mark; (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 the 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; (10) the market interface between the applicant and the owner of a prior mark; (11) the extent to which the applicant has a right to exclude others from use of its mark on its goods; (12) the extent of potential confusion;

and (13) any other established fact probative of the effect of use. *DuPont*, 476 F.2d at 1361. Some of these factors which were not discussed by Office Action are examined herein. Trademark Manual of Examining Procedure ("TMEP") §1207.01.

**ARGUMENT**

Turning to the relevant *DuPont* factors with regard to this case, Applicant respectfully submits that a thorough analysis of the significant differences in the marks, goods and services, and channels of trade leads inexorably to the conclusion that the Office Action has not carried its burden of establishing a likelihood of confusion in this case.

1. COMPARISON OF THE MARKS (DU PONT FACTOR #1)

Applicant's mark **does not resemble** Registrant's Mark and it is not likely that the mark will cause any confusion, mistake or deceive. Under *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973), the first factor requires examination of "the similarity or dissimilarity of the marks in their entireties as to appearance, sound, **connotation and commercial impression**." (emphasis added) When considering the similarity of the marks, "[a]ll relevant facts pertaining to appearance, sound, and connotation must be considered before similarity as to one or more of those factors may be sufficient to support a finding that the marks are similar or dissimilar." *Recot, Inc. v. M.C. Becton*, 214 F.3d 1322, 1329, 54 USPQ2d 1894, 1899 (Fed. Cir. 2000).

Applicant's mark and Registrant's mark are different in connotation and commercial impression.

As can be seen in the attached exhibits, the meaning of the Applicant's mark is different than the meaning of the Registrant's mark. The Registrant's mark stands for mining intellectual property "like precious metals or gemstones". In contrast, the Applicant's mark stands for - this personal information, i.e. this information is "MINE."

Consequently, purchasers that are exposed to parties' marks in context of their distinct services understand that there is no connection between the services. In-fact, it is evident that a

potential customer of the Registrant will not mistake the Applicant's services for the Registrant's services.

2. THE NATURE OF THE GOODS AND SERVICES IN APPLICANT'S MARK AND REGISTRANT'S MARK ARE DIFFERENT (DU PONT FACTOR #2)

***Applicant's Goods.*** Applicant's mark has been amended to be directed to "Software as a service (SAAS) services featuring privacy-related software for electronic monitoring, analysis, management and control of personal information that is held or processed by digital service providers or third parties; Software as a service (SAAS) services featuring privacy-related software for handling of personal information for avoiding digital threats thereto and minimizing exposure of said personal information by sending information removal requests to holders and processors of personal information; providing a website featuring information in the field of privacy including information on the state of governmental privacy regulation; providing a website featuring information regarding awareness, interest, requirement, or expectation of the public on handling of personal information" in International Class 042.

***Registrant's Goods***. In contrast, Registrant's Mark is directed to, in relevant part, "computer software design, development, and implementation: International Class 042.

The goods under description of goods in each of Registrant's Mark and Applicant's Mark are substantially different from one another and do not overlap.

While the Registered mark is in-part for "computer software design, development, and implementation" in International Class 42, Applicant's mark does not specify software development services.

Furthermore, the Applicant has amended the identification of services to exclude any software development related services, and now only claiming SAAS privacy related services and providing a website featuring privacy related information, as specified above.

As a result of the amendment, it is now clear that the marketing channels and the identity of the prospective purchasers of the cited and the applied-for mark are different.

Furthermore, it should be mentioned that the software market is an enormous market that contains hundreds of independent sub-markets, which do not interact with one another whatsoever, and the goods in Registrant's Mark and Applicant's Mark each belong to a completely different sub-market with no correlation to the other.

More specifically, Registrant's mark is directed to businesses that provide software development services, tailor software to an existing client's needs, then sell it to the client. In contrast, the SAAS services of Applicant's mark entail providing an online computerized service to the public, where any interested clients register with the applicant in his website and start using the services.

Therefore, purchasers of software development services are inherently different than purchasers of software as a service. While the first searches for developers to develop a software per the client specification and is prepared to pay large sums for the service, the second searches for a service provider that provides a computerized service that best suits the client needs and abilities.

Applicant hereby submits information on his services in Exhibit A and information on Registrant's services in exhibit B.

Therefore, when taking the goods at issue in consideration, it becomes very unlikely any confusion between Registrant's Mark and Applicant's Mark will occur.

In any case, it should be reminded that the USPTO, in various cases, has allowed coexistence of two or more trademarks with higher degree of similarity than in the present case, for same class of goods, when the goods included in the trademarks were highly related to one another or even overlapping, for example:

- MESA, no. 4655199, was registered by M Cubed Technologies, Inc. in class 9, including the goods: COMPONENTS MANUFACTURED FROM METAL AND CERAMIC COMPOSITE MATERIALS, NAMELY, MOTION CONTROL ASSEMBLIES, PLATES, BEAMS, FRAMES, HOUSINGS AND STAGES, FOR USE IN THE MANUFACTURE OF SEMICONDUCTOR CAPITAL

EQUIPMENT, FLAT PANEL DISPLAYS, ROBOTIC INDUSTRIAL DEVICES, AND PRECISION MOTOR CONTROL AND OPTICAL DEVICES.

- MESA, no. 4052608, was registered by Juniper Systems, Inc. in Class 9, including the goods: Computers; computer hardware and peripheral devices; Computer software for the collection and sharing of data and information; Computer software for the collection and sharing of data and information through the use of a global positioning system (GPS); Global positioning system (GPS) consisting of computers, computer software, transmitters, receivers, and network interface devices.
- MESA, no. 3268301, was registered by Mesa/Boogie, Ltd. in Class 9, including the goods: AMPLIFIERS FOR MUSICAL INSTRUMENTS, AUDIO SPEAKERS, AND CABINETS FOR AUDIO SPEAKERS.
- MESA, no. 2544506, was registered by Horiba, Ltd. in Class 9, including the goods: X-ray fluorescence analyzer
- MESA, no. 1894580, was registered by Reliance Comm/Tec Corporation in Class 9, including the goods: cabinets for housing electronic equipment in the telecommunications industry.
- MESA, no. 1857216, was registered by Green Mountain Geophysics, Inc. in Class 9, including the goods: computer programs and program manuals sold as a unit for use in seismic processing.

As set forth above, the USPTO has previously enabled registration of six identical marks under Class 9, wherein the goods in the trademarks are highly related to one another (both 1857216 and 4052608 include computer software; both 1894580 and 3268301 include cabinets for electronic equipment).

In another example, the trademark "POWER" or "POWERS" was registered under class 9 by four different applicant for similar or even identical goods:

- POWER, no. 3949865, registered by Power Music, Inc. in class 9, including the goods: Downloadable musical sound recordings; digital audio, music and video for use for health, fitness or exercise, downloadable from the Internet;

downloadable video recordings for use for health fitness and exercise; downloadable audio/video recordings for use for health, exercise, fitness or exercise; digital video for use for health, fitness or exercise, downloadable from the Internet.

- POWER, no. 2310126, registered by Power Productions International, Inc. in class 9, including the goods: Pre-recorded [ audio and video tapes, ] compact discs [ and/or phonograph records ] featuring music for aerobic, exercise, motivational, health and workout.
- POWERS, no. 4826854, registered by Paradise Publishing, LLC in class 9, including the goods: Pre-recorded audio and audio-visual recordings featuring musical performances; compact discs featuring music; video recordings and downloadable videos featuring musical performances; downloadable musical sound recordings; downloadable audio-visual recordings featuring music.
- POWER, no. 5078383, registered by Starz Entertainment, LLC in class 9, including the goods: Prerecorded video recordings featuring a television series; computer game software; downloadable multimedia files containing artwork, text, audio, video, games and Internet web links, all featuring content from or relating to a television series; downloadable video games accessible via the Internet, computers and wireless devices, all featuring content from or relating to a television series; computer software downloadable to communication devices for use in accessing, playing, reviewing and streaming audio, video and multimedia content relating to a television series; downloadable photographs featuring content from or relating to a television series.

3. REGISTRANT'S MARK AND APPLICANT'S MARK ARE SOLD VIA DIFFERENT TRADE CHANNELS TO DIFFERENT CUSTOMERS (DU PONT FACTOR #3)

Applicant respectfully submits that Registrant's mark and Applicant's Mark as sold via different channels to different consumers.

In view of the amendment to Applicant's list of services, there is no likelihood of confusion between the registered mark and the applied-for mark.

While the Registered mark is in-part for "computer software design, development, and implementation" in International Class 42, the applied-for mark does **not** specify software development services, and is only claiming SAAS privacy related services and providing a website featuring privacy related information, as specified above.

As a result of the amendment, it is now clear that the marketing channels and the identity of the prospective purchasers of the cited and the applied-for mark are different.

More specifically, businesses that provide software development services, tailor software to an existing client's needs, then sell it to the client. In contrast, the SAAS services of the applicant entail providing an online computerized service to the public, where any interested clients register with the applicant in his website and start using the services.

Therefore, purchasers of software development services are inherently different than purchasers of software as a service. While the first searches for developers to develop a software per the client specification and is prepared to pay large sums for the service, the second searches for a service provider that provides a computerized service that best suits the client needs and abilities.

Applicant hereby submits information on his services in Exhibit A and information on registrant services in exhibit B.

As can be seen, the services and channels of trade are clearly different. The registrant takes upon himself to develop software products of newly formed startup companies.

On the other hand, Applicant offers computerized SAAS services to any individual that is interested in discovering and managing his digital footprint (i.e., mapping all information that companies hold on an individual, explaining the risks entailed in holding personal information by companies, and sending requests to delete personal information by exercising privacy regulations such as GDPR, CCPA and other privacy regulations.

In conclusion, a client that requires a software product specially tailored and developed to his requirement and specific purpose (e.g., CRM software, accounting software, etc.), will not register with Applicant's website to receive his advertised privacy related SAAS 'as-is'. Therefore, there cannot be any likelihood of confusion.

**AMENDED DESCRIPTION OF GOODS (Class 042)**

Software as a service (SAAS) services featuring privacy-related software for electronic monitoring, analysis, management and control of personal information that is held or processed by digital service providers or third parties; Software as a service (SAAS) services featuring privacy-related software for handling of personal information for avoiding digital threats thereto and minimizing exposure of said personal information by sending information removal requests to holders and processors of personal information; providing a website featuring information in the field of privacy including information on the state of governmental privacy regulation; providing a website featuring information regarding awareness, interest, requirement, or expectation of the public on handling of personal information.