

Applicant's Response to the August 12, 2019 Office Action

U.S. Application Serial No. 88523919

February 12, 2020

The Examining Attorney issued an Office Action on August 12, 2019. The Examiner refused registration of Applicant's word with a design element mark because of a likelihood of confusion with prior-filed applications for the standard character word marks RAPIDS (Serial No. 88378484) and NVIDIA RAPIDS (Serial No. 88378485) (collectively the "Prior-Filed Applications"). The Examining Attorney stated that the Applicant may submit evidence and arguments in support of registration addressing the issue of the potential conflict between the applied-for mark and the Prior-Filed Applications.

In addition, the Examining Attorney requires Applicant to submit an amended description of the identification of services.

Likelihood of Confusion

The refusal is based on the Examining Attorney's determination that there is a possible Section 2(d) refusal of the applied-for mark if the Prior-Filed Applications proceed to registration.

Comparison of the Services.

In any likelihood of confusion analysis, a key consideration is the similarities between the goods or services. *In re White Rock Distilleries Inc.*, 92 U.S.P.Q.2d 1282, *1 (2009). Where the goods and services between marks are "not related or marketed in such a way that they would be encountered by the same persons in situations that would create the incorrect assumption that they originate from the same source, then, even if the marks are identical, confusion is not likely." Trademark Manual of Examining Procedure, § 1207.01(a).

Here, the Applicant for the applied-for RAPIDS (stylized) mark seeks registration in a separate class and in connection with different services than those offered under the Prior-Filed Applications. Once amended in accordance with the Examiner's suggested substitution for the description in Class 35 (a service class), Applicant seeks registration of the applied-for mark in connection with "Business records management services for medical record documentation for program oversight, compliance, payment integrity, and risk optimization for *healthcare payors*." (emphasis added). In Class 42 (a service class), Applicant seeks registration of the applied-for mark in connection with:

"Software as a service (SAAS) services featuring software for use with data modeling services that support automated medical record documentation retrieval and evaluation for program oversight, compliance, payment integrity, and risk optimization for *health care payors*." (emphasis added).

The Prior-Filed Applications seek registration in Class 9 (a goods class), for an exhaustive list of different forms of downloadable software related to machine learning and artificial intelligence related to graphic and multimedia design. The Prior-Filed Applications additionally seek registration in Class 42 for the similar exhaustive list of services.

There is no question that the described services offered under the applied-for mark are not identical to the described goods and services offered under the Prior-Filed Applications. In *M2 Software*, the Federal Circuit reviewed Trademark Trial and Appeal Board's ("TTAB") determination of no likelihood of confusion between the standard character marks "M2" and "M2 COMMUNICATIONS" (with "COMMUNICATIONS" disclaimed). *M2 Software*, 450 F.3d at 1380. The Federal Circuit affirmed the TTAB's determination that due to the marks being used in connection with goods in different industries, the goods were unrelated. *Id.* at 1383

The description of services for the marks concerned interactive multimedia CD-ROMs containing educational information in the healthcare field for the "M2 COMMUNICATIONS" mark, and computer software and interactive multimedia in the entertainment and music industry, for the "M2" mark. *Id.* The Court affirmed the TTAB's determination that the scope limiting language in the description of the Applicant's goods did not come within the scope of the registered mark. *Id.* at 1382-1383. The Federal Circuit.

Even where marks are identical and may even be encountered by a consumer in the same store, the TTAB has found that where the goods are different, the commercial impression projected by the mark in connection with the respective goods can obviate a finding of likelihood of confusion. *In re Sydel Lingerie Co., Inc.*, 197 U.S.P.Q. 629, *2 (1977), the TTAB compared identical "BOTTOMS UP" marks and found that one mark's use in connection with women's and children's underwear and the other mark's use in connection with men's suits, coats, and trouser had different connotations in each instance. These different connotations were enough that a consumer would not be confused.

Similarly, in the instant case, the stylized RAPIDS being used in connection with business records management services and software related to automated medical record retrieval and evaluation in the healthcare industry creates a different commercial impression from the word RAPIDS being used in connection with computer software related to machine learning and artificial intelligence related to graphic and multimedia design

These differences are significant in the likelihood of confusion analysis determination. Because the Prior-Filed Applications and the applied-for marks are for dissimilar services, a potential customer would likely not be confused as to the origin of the respective services. Confusion between Registrant's and Applicant's dissimilar services is extremely unlikely.

Channels of Trade

Due to the non-relatedness of the services provided under the applied-for mark and the good and services provided under the Prior-Filed Applications, the Examiner cannot presume that the channels of trade are similar. In fact, the channels of trade for the marks are different as the applied-for mark has a restriction in its identification of goods to the healthcare industry. *In Re Homeland Vinyl Products, Inc.*, 81 U.S.P.Q.2d 1378, *1 (2006). *See also* Declaration of Will Dawkins.

Comparison of the Marks.

i. RAPIDS (Stylized) v. RAPIDS (standard character)

The marks are not identical, which is the starting point. While not dispositive, Applicant's mark has design elements in the word, whereas the Prior-Filed Application is a standard character mark. The differences in the applied-for mark are the stylized design element added to each letter in the word "RAPIDS" and the additional "COM."

The fundamental inquiry under section 2(d) is the cumulative effect of these differences in the mark. Comparing the marks, the differences in the Applicant's mark make its mark distinguishable from the Prior-Filed RAPIDS Application, Serial No. 88378484. Here, the comparison is between the Prior-Filed Application for RAPIDS and the Applicant's word with design element mark.

Applicant respectfully maintains that the *DuPont* requirement that the comparison is to be made of the marks "in their entireties" is the primary consideration in the comparison. The TMEP, quoting the Federal Circuit, recognizes that likelihood of confusion cannot be predicated on dissection of a mark, or on only part of a mark. TMEP, § 1207.01(b). In its entirety, Applicant's mark has unique stylized design that distinguishes the applied-for mark from the Prior-Filed RAPIDS Application.

The Federal Circuit and the TTAB have held that it is entirely appropriate in a comparison of marks to accord greater importance to the more distinctive elements in a mark. *In re Covalinski*, 113 USPQ2d 1166, p. 5 (TTAB 2014) [precedential] (no likelihood of confusion); *See Jack Wolfskin Ausrustung Fur Draussen GmbH & Co. KDA v. Millennium Sports, S.L.U.*, 797 F.3d 1363, 1371-72 (Fed. Cir. 2015); *see also In re Giovanni Food Co.*, 97 USPQ2d 1990 (TTAB 2011) (no likelihood of confusion); *Steve's Ice Cream v. Steve's Famous Hot Dogs*, 3 USPQ2d 1477 (TTAB 1987) (no likelihood of confusion); *Spice Islands, Inc. v. Frank Tea & Spice Co.*; 505 F.2d 1293 (C.C.P.A. 1974) (no likelihood of confusion).

The TTAB has found no likelihood of confusion between a mark with a design element compared to a standard character word mark, especially where the goods and services are found not related. *In re British Bulldog, Ltd.*, 224 U.S.P.Q. 854 (1984). Similar to the instant matter, the TTAB compared the stylized "PLAYERS" mark used in connection with men's underwear to the standard character word mark "PLAYERS" used in connection with shoes. *Id.* at *1. While the TTAB recognized the marks were similar, the TTAB found no likelihood of confusion because the nature of the consumers' interaction with marks was distinctly different as they were used in connection with their respective goods. *Id.* at *3.

The distinctive elements of Applicant's applied-for mark are the repeated stylized font of each letter in the word. Compared in their entireties, there is no likelihood of confusion between Applicant's word with design element mark and the Prior-Filed Application.

ii. RAPIDS (Stylized) v. NVIDIA RAPIDS (word)

The applied-for mark and the Prior-Filed NVIDIA RAPIDS Application are also dissimilar because not only does the applied-for mark incorporate a design element, the Prior-Filed Application incorporates an additional first word into the mark. It is well-settled that the first word of a mark is the focal point of the mark. *Citigroup Inc. v. Capital City Bank Group, Inc.* 94 USPQ2d 1645, 1664. The lead word of a mark is prominent because it is likely to be noticed by consumers and thus plays a dominant role in the mark. *Id.*

Here, the Prior-Filed Application for NVIDIA RAPIDS incorporates a lead word which establishes the term “NVIDIA” as the dominant portion of the mark. Though marks must be considered in their entirety, the applied-for mark and the Prior-Filed Application NVIDIA RAPIDS cannot be found to be similar due to the addition of the dominant “NVIDIA” at the beginning of the mark.

The applied-for mark is not similar to the Prior-Filed Application NVIDIA RAPIDS for two material reasons: (1) the services provided under the applied-for mark and the goods and services provided under the Prior-Filed Applications are different and not related, and (2) the Prior-Filed Application NVIDIA RAPIDS has a dominant first word, “NVIDIA.” The Examiner should find that there is no likelihood of confusion.

Other Relevant Dupont Factors:

The Federal Circuit has reminded the TTAB that when analyzing whether a likelihood of confusion exists between two marks, it must consider all likelihood-of-confusion factors for which there is record evidence. *In re Guild Mortgage Company*, Case No. 2017-2620 (Fed. Cir. Jan. 14, 2019). The Examining Attorney should consider other *du Pont* factors that are relevant to the likelihood of confusion evaluation: the conditions under which purchasers make their decisions to use the services of one provider over another.

The Selection and Purchase of Business Records Management Services or Hardware Optimization Software Involves Sophisticated or Experienced Purchasers and Is Carefully Done. The selection and purchase of the services and products offered under each of the marks in question is an informed and careful decision made by a sophisticated purchaser.

Healthcare payors and government agencies relevant to the healthcare industry are the customers who would encounter the services offered under applied-for mark. These healthcare customers are sophisticated purchasers within the healthcare industry.

The owner of the Prior-Filed Applications markets to sophisticated purchasers such as developers, data scientists, researchers, and educators and students within the gaming and artificial intelligence industry. The purchasers of the software tools offered under the marks in the Prior-Filed Applications are developers within the gaming industry who would make a careful and

informed decision regarding their graphic design needs. *See* Declaration of William Dawkins, attached as **Exhibit A**.

That the purchasers of the different services are sophisticated and not impulse driven, weighs heavily in favor of a finding of no likelihood of confusion.

Amendment

Please enter the following amendment (in quotes) with respect to this application, as suggested by the Examining Attorney:

“Applicant submits the following amended identification of services for Class 35: Business records management services for medical record documentation for program oversight, compliance, payment integrity, and risk optimization for healthcare payors.”

Additional Evidence

The following additional evidence supports the Application to register Applicant’s word with design element mark:

A Verified Declaration from William Dawkins, President of Applicant (“Dawkins Declaration”) with attached screenshots from the owner of the Prior-Filed Application’s website.

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