

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Mark: ATOM

Serial No.: 88449147

Our Ref: KPLN 1905845

RESPONSE TO OFFICE ACTION

ARGUMENT

Registration for Applicant's mark was partially refused under Section 2(d) on the basis of Registration Nos. 4270918 and 4675908, for the marks ATOM and ATOM and Design, respectively, owned by different registrants. The cited registration 4270918 for ATOM covers only Class 41. The cited registration 4675908 for ATOM and Design covers multiple classes of goods and services. The Office action identified only the following goods and services covered by the prior registrations as giving rise to a perceived likelihood of confusion:

Registration No. 4270918

Class 41: educational services, namely, providing courses in the field of surgery and distribution of educational course materials in connection therewith

Registration No. 4675908

Class 9: Computer software for use in telecommunications and communications management, namely, software used to manage voice mail, facsimile, electronic mail, the receipt and delivery of messages, the receipt and delivery of documents, the receipt and delivery of images, electronic transmission of data; computer software for personal contacts management, telephone call management and time and schedule management; computer software for enabling and managing simultaneous, multiple modes of communication over local area networks and the Internet via Voice over Internet Protocol (VoIP), sensing and providing user presence information, and telephony; computer software for remotely accessing office management and communication applications

Class 42: Providing on-line non-downloadable software for use in telecommunications and communications management, namely, software used to manage voice mail, facsimile, electronic mail, the receipt and delivery of messages, the receipt and delivery of documents, the receipt and delivery of images, electronic transmission of data; providing on-line non-downloadable software for personal contacts management, telephone call management and time and schedule management; providing on-line non-downloadable software for enabling and managing simultaneous, multiple modes of communication over local area networks and the Internet via instant messaging, Voice over Internet Protocol (VoIP), sensing and providing user presence information, and telephony; providing on-line non-downloadable software for remotely accessing office management and communication applications

The refusal is limited to the following goods and services in Applicant's application:

Class 9: downloadable software for multimedia electronic communication that allows users to view and exchange data, documents and applications with others, to view the online status of users, and to communicate with and among users

Class 41: Educational services, namely, conducting courses of instruction in the field of math, reading, **science**, language arts, social science, standardized tests, **certification courses, and professional exams** and distribution of course material and content in connection therewith

Class 42: **computer technology support services, namely, help desk services**; providing a website featuring non-downloadable software that allows users to view and exchange data, documents and applications with others, to view the online status of users, and to communicate with and among users.

Applicant has now deleted the services identified above that are shown in “red.”

For the reasons set forth below, and following the amendments now made to the application, Applicant respectfully submits that there is no likelihood of confusion and that the refusals can be withdrawn.

The Parties are in Different Areas of Business, and the Marks are for Unrelated Goods and Services.

Applicant intends to use the mark ATOM for its learning experience platform for content creators, educators, and learners that enhances the learning experience by delivering assessment & learning content at scale: www.learnwithatom.com (full website printout included as Exhibit A):



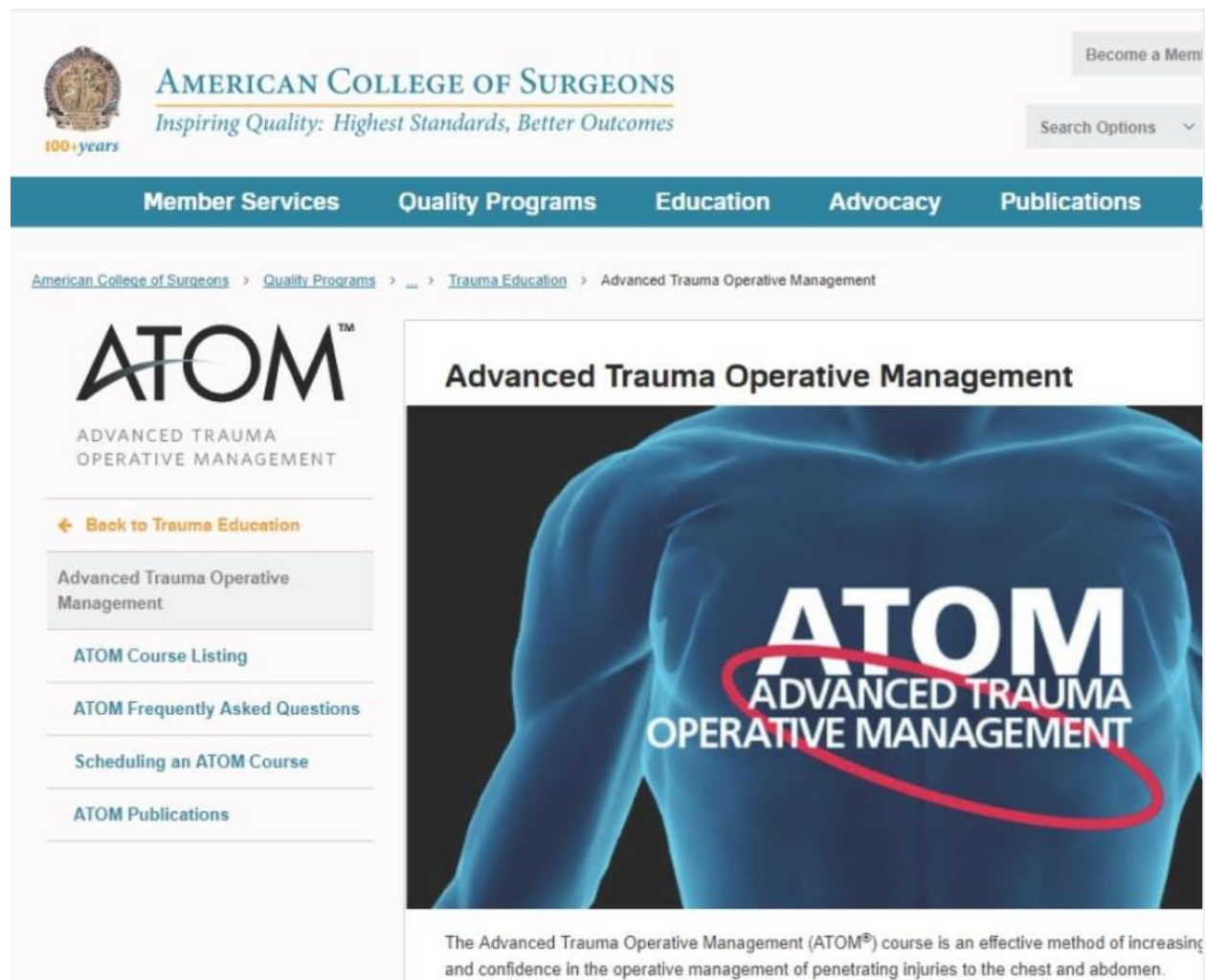
Atom is a learning experience platform by Kaplan

A one-stop solution for content creators, educators, and learners that enhances learning experience by delivering assessment & learning content at scale

This is a specific, sophisticated and targeted solution for educators and learners to enable educators to track trends in learner and class progress, receive actionable insight on subjects in which a class or learner is weak, enable learners to view reports on their progress and status, and to enable content creators to create, update and import content to the ATOM platform.

Registration No. 4270918

The cited mark ATOM is intended for use with educational services in the field of surgery, which is not a field that is identified in or related to the present application. The specimen filed with the Section 8 declaration shows that the mark is an acronym for **Advanced Trauma Operative Management** (see Exhibit B):



Students for surgery education services are experienced health care practitioners. In seeking a surgery course, they will be careful to ensure that the course they are signing up for is the intended course, offered by the intended provider. They will not blindly sign up for a course entitled ATOM (especially if it does not deal with surgery) without ensuring that it is the intended course.



The cited mark ATOM and Design is in the field of telecommunications and communications management, which is a distinct field that is distinguishable from applicant’s platform that enables the provision of educational content with additional integrated tools and functions. The present application identifies software that, in part, allows users to communicate with each other, but that communication is part of the overall learning platform; it is not the type of enterprise communications software offered in connection with the ATOM and Design mark. The specimen submitted for the ATOM and Design mark in 2014 advertises ATOM as a personal assistant who can “tell callers when you’re in a meeting,” “schedule a lunch meeting,” “separate personal and business communications on your mobile device.” Full specimen attached as Exhibit C. The same specimen lists the following features of ATOM:

Atom Features

Mobile Client
Separates Personal and Business Communications
iPhone® and Android™ Native Client
Visual Call Screening of Incoming Calls
Contact Management and Dialing
View and Manage Voicemails and Faxes
Settings Management

Mobility
Location-Based Services: Geofencing and Wifi
Single Number Reach
Mobile Number Protection
Missed Call Notification
Call Transfer

Federated Presence
Federated Presence to Calendar Including Microsoft® Exchange and Office 365™
Federated Presence to Microsoft Lync®

Voice User Interface (VUI)
“Call John Smith”
“Dial 949 699 2300”
“Get new voice messages”
“Get new email”
“Get my calendar for today”
“Accept meeting request”
“Schedule a meeting”
“Change my availability to mobile”
“Enable do not disturb”

Call Screening on Any Device
Accept Call
Reject Call
Acknowledge the Caller with a Quick Message
Call Divert or Redirect (Prior to Answering)
Accept and Record the Call
Whisper Call Waiting

Atom is available on both CX-E and CX-S.

Unified Messaging (UM)
Deliver UM to Multiple Email Systems (Premise and Public Cloud) Including Microsoft Outlook, Office 365, Lotus® Notes®, Google™ Gmail™, Novell® GroupWise® and IMAP 4 Complaint Email
Integrates Email, Voicemail and Fax into a Single View
Access via Mobile Device, Email Clients, Web Client, Speech or DTMF Telephone Interface
Flexible UM Storage Model to Meet Security and Compliance Needs: Server, Client, Secure and Simplified UM
Voicemail-to-Text (3rd party service)
Text-to-Speech
Localized Desktop Clients: Danish, Dutch, English, Finnish, French, German, Italian, Norwegian, Spanish and Swedish

Atom Speech-based Multi-Lingual Support
US English, US Spanish, Canadian French, UK English, Swedish and Australian English

These services are offered in the field of telecommunications, but there is no educational aspect to the services. The services are akin to a personal mobile assistant, and are entirely unrelated to Applicant’s identified services.

The functionality of Applicant’s software is wholly unrelated to enterprise communications. The fact that users can message and transmit data to each other within the ATOM platform – a common feature of any online software platform -- does not create an overlap with the cited ATOM and Design telecommunications/mobile personal assistant services.

The Trademark Trial and Appeal Board and the courts have held on many occasions that there is no *per se* rule that all computer or software-related goods and services are related. TMEP § 1207.01(a)(iv), citing *M2 Software, Inc. v. M2 Communications, Inc.*, 450 F.3d 1378, 1383, 78 USPQ2d 1944, 1947–48 (Fed. Cir. 2006) (noting that relatedness between software-related goods may not be presumed merely because the goods are delivered in the same media format and that, instead, a subject-matter-based mode of analysis is appropriate). Here, the software at issue is completely unrelated. See also, *Electronic Design & Sales, Inc. v. Electronic Data Systems Corp.*, 21 U.S.P.Q.2d 1388, 1391 (Fed. Cir. 1992) (no likelihood of confusion between E.D.S. for computer services and EDS for power supplies and battery chargers because the buyers were sophisticated purchasers); *STMicroelectronics NV*, Serial No. 77500550 (March 10, 2010) [not precedential] (no likelihood of confusion between the mark FLEXILOGIC for "computer hardware and software for noise reduction, spatial and strength processing, temporal tracking and gesture recognition of touch devices," and the same mark for "computer software design for others").

So, too, in this case, the mark ATOM for software that enables users of the platform to communicate and share documents with each other as part of the overall purpose of the platform to help educators and learner would not be thought to come from the same source as ATOM for



educational services in the field of surgery and telecommunications services.

The Cited Mark ATOM and Design is Coexisting on the Register with Other ATOM Marks for Software with Different Functionality

Registration No. 4675908 for ATOM and Design is already coexisting on the Register with other ATOM marks for software, including software that enables communication between users (highlighted below). The marks below do not specifically identify the field of telecommunications, despite providing software that enables people to connect with one another. The fact that the communication takes place in different fields and with different goods and services is sufficient to distinguish these marks. The same can be said for Applicant’s mark, which enables communication between users but its consumers are educators and learners, not enterprise clients seeking large-scale communications solutions such as a personal mobile assistant.

TM/AN/RN/Disclaimer	Status/Key Dates	Full Goods/Services	Owner Information
ATOM RN: 4919102 SN: 86448991	Registered March 15, 2016 Int'l Class: 09,42 First Use: March, 2015 Filed: November 8, 2014	(Int'l Class: 09) downloadable mobile applications for use in the field of movies, entertainment events, and sporting events, namely, for providing ticketing, reservations and purchasing of concessions, for connecting users with other users to coordinate and schedule	Atom Tickets, LLC (Delaware Limited Liability Company) 2700 Colorado Avenue Santa Monica California 90404

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		<p>attendance, for social networking, for matching available ticket inventory with consumers, for offering special pricing and promotions, for advertising, and for providing analytics to venue owners and content creators concerning sales and attendance; point-of-sale terminals; software for point-of-sale terminals (Int'l Class: 42)</p> <p>providing temporary use of on-line non-downloadable software for use in the field of movies, entertainment events, and sporting events, namely, for providing ticketing, reservations and purchasing of concessions, for connecting users with other users to coordinate and schedule attendance, for social networking, for matching available ticket inventory with consumers, for offering special pricing and promotions, for advertising, and for providing analytics to venue owners and content creators concerning sales and attendance</p>	
<p>ATOM RN: 5973894 SN: 88197584</p>	<p>Registered January 28, 2020 Int'l Class: 09 First Use: August 8, 2019 Filed: November 16, 2018</p>	<p>(Int'l Class: 09) Downloadable software for music synthesis being downloadable software for arranging and producing music</p>	<p>Emastered LLC (Delaware Limited Liability Company) 3900 W. Alameda Ave. Burbank California 91505</p>
<p>ATOM RN: 5849904 SN: 88289940</p>	<p>Registered September 3, 2019 Int'l Class: 35,42 First Use: June 17, 2009 Filed: February 5, 2019</p>	<p>(Int'l Class: 35) Advertising, marketing services, sales promotion services, and customer relationship management communication services for automotive manufacturers and dealerships (Int'l Class: 42) Providing temporary use of non-downloadable online software for providing advertising, marketing, promotion, and customer relationship management communications services in the automotive industry</p>	<p>Gs Marketing, Inc. (Delaware Corp.) 1345 Enclave Parkway Houston Texas 77077</p>

TM/AN/RN/Disclaimer	Status/Key Dates	Full Goods/Services	Owner Information
<u>ATOM</u> RN: 5914511 SN: 88421043	Registered November 19, 2019 Int'l Class: 42 First Use: January 1, 2009 Filed: May 8, 2019	(Int'l Class: 42) Providing temporary use of a web-based software application for timekeeping and attendance management with access control	Toadfly Technologies, LLC (Texas Limited Liability Company) Suite 106 12000 Aerospace Ave Houston Texas 77034
<u>ATOM</u> RN: 3461231 SN: 77311749	Renewed July 8, 2018 Int'l Class: 09,42 First Use: June, 2007 Filed: October 24, 2007 Registered: July 8, 2008	(Int'l Class: 09) computer software, namely, computer software for use in data and application integration within and/or among enterprises (Int'l Class: 42) online software services, namely, providing temporary use via global and/or local communications networks of non-downloadable dynamic runtime engine software for use in data and application integration within and/or among enterprises	Boomi, Inc. (Delaware Corp.) One Dell Way Round Rock Texas 78682
<u>ATOMGRAPH</u> RN: 5294288 SN: 87173467	Registered September 26, 2017 Filed: September 16, 2016	(Int'l Class: 09) computer database management software for use in personalizing the content of e-mail communications; computer software for creating searchable databases of information and data; computer software for providing an on-line database in the field of transaction processing to upload transactional data, provide statistical analysis, and produce notifications and reports; computer software for the collection, editing, organizing, modifying, book marking, transmission, storage and sharing of data and information; computer software for the field of warehousing and distribution, to manage transactional data, provide statistical analysis, and produce notifications and reports; computer application software for mobile phones, namely, software for web application building; computer application software for web	Uab Linked Data (Lithuania Limited Liability Company) E. Ozeskienes G. 47 Kaunas Lt44254 Lithuania

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		<p>application building, namely, software for integrated data; computer application software for web application building, namely, software for data integration; computer software platforms for web application building; computer software for application and database integration; downloadable cloud-based software for web application building; downloadable cloud-computing software for web application building; downloadable software for web application building; enterprise software in the nature of a database for non-transactional data and a search engine for database content (Int'l Class: 42)</p> <p>data automation and collection service using proprietary software to evaluate, analyze and collect service data; database design and development; database development services; platform as a service (paas) featuring computer software platforms for web application building; application service provider (asp) featuring software for use web application building; application service provider, namely, hosting, managing, developing, and maintaining applications, software, and web sites, in the fields of personal productivity, wireless communication, mobile information access, and remote data management for wireless delivery of content to handheld computers, laptops and mobile electronic devices; cloud computing featuring software for use in web application building; computer services, namely, database development services, namely, configuration and customization of computer databases containing information regarding public health care eligibility; computer services, namely, providing search platforms to allow users to build web</p>	

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		<p>applications; computer technical support services, namely, 24/7 service desk or help desk services for it infrastructure, operating systems, database systems, and web applications; design and development of software and hardware for data and multimedia content conversion from and to different protocols; design and development of software and hardware for multimedia data storing and recalling; design and development of computer software for web application building; development, updating and maintenance of software and database systems; providing a web site featuring temporary use of non-downloadable software for web application building; providing a website featuring non-downloadable software for web application building; providing a website featuring resources, namely, non-downloadable software for web application building; providing temporary use of a web-based software application for web application building; providing temporary use of on-line non-downloadable cloud computing software for web application building; providing temporary use of on-line non-downloadable software and applications for web application building; providing temporary use of on-line non-downloadable software development tools for web application building; providing temporary use of on-line non-downloadable software for web application building; reconstruction of database systems for others; rental of a database server (to third parties); technical support services, namely, 24/7 monitoring of network systems, servers and web and database applications and notification of related events and alerts; technical support services, namely, installation,</p>	

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		administration, and troubleshooting of web and database applications; technical support services, namely, migration of datacenter, server and database applications; updating and rental of software for data processing	

TSDR printouts of these records are attached as Exhibit D.

Against this backdrop, the differences in the marks, the goods and services, and the customers to whom they are marketed are significant. The foregoing demonstrates that the Register already has numerous marks featuring the term ATOM for software, all coexisting in different industries, but with software or platforms to enable communications and the transmission of data between consumers.

Indeed, in a recent case, *In re Boston Juicery, LLC*, Ser. No. 86877537 (T.T.A.B. Aug. 21, 2018) (not precedential), the Board reversed the refusal to register due to the weak and diluted nature of the term SQUEEZE. At issue in that case was the applicant’s word mark SQUEEZE JUICE COMPANY (JUICE COMPANY disclaimed) for “fruit juices; vegetable juices; smoothies” in Class 32, and “juice bar services; smoothie bar services; café services” in Class 43. The cited mark, covering “bar service; juice bar services” is shown below:



The services were considered to be identical, and both marks had SQUEEZE as the dominant element of the mark. The Board found that both marks were similar in sound, connotation and commercial impression. However, in view of the twelve third-party marks with the term SQUEEZE for beverages or juice bars, the Board concluded (at p. 10):

Given the number of third-party registrations for the involved goods or services, consumers are conditioned to look for differences between SQUEEZE and SQUEEZE formative marks to determine the source of a given product and therefore less likely to be confused.

The Board found that "consumers are conditioned to look for differences between SQUEEZE and SQUEEZE formative marks to determine the source of a given product and therefore less likely to be confused." So, too, the record in this case establishes that consumers are accustomed to distinguishing between software that uses the term ATOM, and that uses of this term in connection with software can coexist if the true function of the software is distinguishable.

As explained above, the Applicant's educational services and software are in a different category – providing an educational platform for educators and learners with assessment and learning content, offered to different consumers (educators and learners who are tracking their progress, creating lesson plans, viewing content and businesses seeking enterprise communications solutions), all of whom are sophisticated and experienced, and would not possibly confuse the marks or their respective sources since the functionality of the software is so different.

A case closely on point is *Astra Pharmaceutical Products, Inc. v. Beckman Instruments, Inc.*, 220 U.S.P.Q. 786 (1st Cir. 1983). In the *Astra* case, the court dismissed the case on summary judgment, finding no likelihood of confusion with respect to use of the mark ASTRA for a computerized blood analyzer machines, as against the prior registrant's use of the identical mark for syringes and pharmaceutical preparations used for administering local anesthetic or cardiovascular treatments. As noted in the *Astra* case, the Beckman analyzer was sold only to hospital chemistry labs and never to pharmacies or to anyone who would administer ASTRA drugs. The court particularly noted that the decision to buy a machine worth thousands of dollars is obviously not done on impulse; rather, such decision involves careful consideration of the reliability of the machine as well as the manufacturer and seller of the products.

In the end, commercial realities must be considered in determining likelihood of confusion. Merely matching up the marks and classes does not demonstrate likelihood of confusion. Here, we have the ATOM educational platform marketed for the purpose of tracking and engaging educators and learners, allowing data to drive lesson planning and content creation, juxtaposed with extremely specific and highly specialized educational services in the field of surgery, and software for use in telecommunications and communications management. As the Court of Appeals for the Federal Circuit noted in *Electronic Design & Sales, supra*, 21 U.S.P.Q. 2d at 1391, "we are not concerned with mere theoretical possibilities of confusion, deception, or mistake or with de minimis situations but with the practicalities of the commercial world, with which the trademark laws deal."

Accordingly, Applicant respectfully submits that the refusal to register should be withdrawn, and the application approved for publication.

AMENDMENTS

The descriptions of goods and services are amended as follows:

*Class 9: Downloadable software for **managing and creating** employee training courses and instructional content in the areas of sales, marketing, communication, customer service and product support, and employee efficiency, all for purposes of attracting, managing, developing, training, and retaining employees; downloadable software **for creating and managing** educational content and curricula, **tracking** learner progress, and **conducting** data analysis and reporting **in the fields of education and test preparation**; Downloadable ~~software for~~ multimedia electronic communication **software that allowed users to for viewing and exchangeing** data, documents and applications with others, ~~to~~ **viewing** the online status of users, and ~~to~~ **communicateing** with and among users*

Class 41: Educational services, namely, conducting courses of instruction in the field of math, reading, science, language arts, social science, standardized tests, certification courses, and professional exams and distribution of course material and content in connection therewith; Educational services, namely, providing **online information** in the fields of learning, education, **and** curriculum management and assessment

Class 42: Computer services, namely, hosting and maintaining an online website for others **in the field of** education, learning and training, and assessment of students and employees; ~~computer technology support services, namely, help desk services;~~ providing a website featuring non-downloadable software ~~that allows users to~~ **for** viewing and exchanging data, documents and applications with others, ~~to~~ **viewing** the online status of users, and ~~to~~ **communicating** with and among users; software as a service (SAAS) services featuring software for business **management** in the field of learning management systems; software as a service (SAAS) services featuring software for employee training courses and instructional content in the areas of sales, marketing, communication, customer service and product support, and employee efficiency; software as a service (SAAS) services **for creating** and **managing** educational content and curriculum, **tracking** learner progress, and **conducting** data analysis and reporting in the fields of education and test preparation; platform as a service (PAAS) services **for creating** and **managing** educational course and curriculum, **tracking** learner progress, and **conducting** data analysis and reporting in the fields of education and test preparation