

Applicant's Response to Office Action for U.S. Application Serial No. 88/454,180

Graysky Capital Group, LLC applied to register the mark NOW (Serial No. 88/454,180) (the "Mark" or "Applicant's Mark" or the "Application") for use in connection with "[t]eleconferencing and telepresence communication services offered by means of a kiosk" in International Class 38 and "[m]edical consultations" in International Class 44.

The Examiner issued a refusal to register the Mark under Section 2(d) of the Lanham Act, 15 U.S.C. 1052(d), asserting there is a likelihood of confusion with the mark NOW (Reg. No. 4,211,879) (the "'879 Mark" or the "EMI Mark" or the "EMI Registration") owned by EMI (IP) registered for use in connection with

- "[m]usical sound recordings; audiovisual recordings featuring music; enhanced musical sound recordings; enhanced audiovisual recordings featuring music; [interactive musical sound recordings; interactive audiovisual recordings featuring music;] DVDs and CD-ROMs featuring music and musical performances, namely, performances of musical artists; downloadable musical sound recordings; downloadable digital musical sound recordings provided from MP3 Internet websites" in International Class 9,
- "[r]etail store services featuring musical sound recordings, audiovisual recordings featuring music, enhanced musical sound recordings, enhanced audiovisual recordings featuring music, [interactive musical sound recordings, interactive audiovisual recordings] featuring music, and DVDs and CD-ROMs featuring music and musical performances, downloadable musical sound recordings, downloadable digital musical sound recordings provided from MP3 Internet web sites; promoting the goods and services of others in the recording industry and in the music industry through the distribution of printed and audio promotional materials; management of performing artists" in International Class 35,
- "[e]lectronic transmission of digital music and information concerning music and musical performances; electronic transmission of news and current affairs information relating to music or musical performances" in International Class 38,

- “[m]usical entertainment services, namely, live musical performances, concerts and shows; production of musical sound recordings, musical audiovisual recordings, live musical performances and live music concerts; music production services; music publishing services; [recording studio services;] providing on-line information in the field of sound recordings and audiovisual recordings featuring musical performances; [rental of sound and audiovisual recordings featuring musical performances;] providing a website featuring non-downloadable pre-recorded digital music; provision of online non-downloadable electronic publications in the nature of magazines and newsletters relating to sound recordings and audiovisual recordings featuring musical performances and musical entertainment” in International Class 41, and
- “[e]xploitation and licensing of intellectual property rights in musical and lyrical works for and on behalf of authors, composers or conductors of such works; providing online information relating to intellectual property rights in musical and lyrical works” (collectively, “EMI Registrant’s Services”).

Additionally, the Examiner issued a refusal to register the Mark under Section 2(d) of the Lanham Act, 15 U.S.C. 1052(d), asserting there is a likelihood of confusion with the mark NOW (Reg. No. 4,508,923) (the “‘923 Mark” or the “Ability Mark” or the “Ability Registration”) owned by Ability Network Inc. registered for use in connection with

- “[h]ealthcare information exchange services, namely, promoting the exchange of information and resources among healthcare organizations to achieve advances in the field of healthcare; Providing a web-based system and online portals for promoting the exchange of information and resources among healthcare organizations to achieve advances in the field of healthcare; Business collaboration services, namely, providing a secure web-based network for health care professionals and providers to connect with one another on healthcare information exchange” in International Class 35,
- “[p]roviding an Internet website portal that features technology that enables the for secure exchange of health information by users” in International Class 42, and

- “[p]roviding a website via a global computer network featuring information and comprehensive content in the fields of healthcare providers; Provision of health care and medical services by health care professionals via the Internet or telecommunication networks” in International Class 44 (collectively, “Ability Registrant’s Services”).

Concurrent with this Response to Office Action, Applicant proposes to amend its services description in Class 38 to read “teleconferencing and telepresence communications services involving medical consultations and services offered by means of a kiosk” in International Class 38, to go with its services of “[m]edical consultations” in International Class 44 (collectively, Applicant’s Services”). Applicant contends such amendment further differentiates Applicant’s Mark from the EMI Mark in the EMI Registration so as to support a finding that such marks are not likely to be confused. Applicant therefore respectfully submits that there is no likelihood of confusion between Registrant’s Mark and the EMI Mark for the reasons set forth below. Additionally, Applicant respectfully submits that the Ability Mark that is the subject of the Ability Registration differs from Applicant’s Mark in its meaning and its channels of trade and is unlikely to cause confusion amongst the sophisticated class of healthcare providers and consumers encountering a crowded field of NOW-formative marks in the medicine field. Applicant therefore respectfully submits that there is no likelihood of confusion between Applicant’s Mark and the Ability Mark for the reasons set forth below.

I. Applicant’s Mark is Unlikely to be Confused with the EMI Mark and is Entitled to Registration

Numerous factors are relevant to determining whether a likelihood of confusion exists between two marks. *See* Trademark Manual of Examining Procedure §1207.01 (hereinafter, “TMEP”) (citing *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361 (C.C.P.A. 1973) (listing thirteen factors that must be considered, when of record in the current proceeding)). In refusing registration of Applicant’s Mark based on a likelihood of confusion, the Examining Attorney has cited similarity of the marks and similarity and relatedness of the goods as most relevant. Applicant respectfully submits that analysis of these factors shows there is no likelihood of confusion.

A. Amendment of Applicant's Class 38 Services Description Eliminates Likelihood of Confusion with the EMI Mark

As noted above, Applicant proposes to amend its Class 38 description to specify its services involve medical consultation. Accordingly, Applicant respectfully submits that there is no likelihood of confusion between Applicant's Mark and the EMI Mark as further stated below.

B. The Nature of the Services Offered Under Applicant's Mark Differs from the Services Offered Under the EMI Mark

Even where two marks are similar or identical, the Trademark Trial and Appeal Board will find there is no likelihood of confusion when the goods offered under the marks are different. *See Autac Inc. v. Walco Sys., Inc.*, 195 U.S.P.Q. 11 (T.T.A.B. 1977) (finding no likelihood of confusion between AUTAC for temperature regulators and AUTAC for retractile cords used in the wire manufacturing industry). “[S]imilarity or even identity of marks is not sufficient to establish confusion where non-competitive goods are involved.” *Bd. Of Governors of Univ. of N. Carolina v. Helpingstine*, 714 F. Supp. 167, 173, 11 U.S.P.Q.2d 1506 (M.D.N.C. 1989). Applicant respectfully submits Applicant's Services and the EMI Registrant's Services are substantially different.

As noted above, Applicant intends to amend its Class 38 description to specify that its services are related to medical consultations and has done so elsewhere on this form. This amendment should assuage the Examiner's concerns with regard to the EMI Registration, which clearly focusses on music, including music recordings, electronic transmission of music, musical performances, musical entertainment services, and licensing of intellectual property rights in music. Nearly each of the identified EMI Registrant's Services specifically includes a relation to music. There is no likelihood of confusion between services related to providing music and those involving the provision of medical consultations and communications.

The Trademark Examiner provided evidence indicating that Google, Apple, and Snapchat all offer both music streaming services and teleconferencing services. However, this evidence does not establish that the same entity provides both medical consultation via teleconferencing and music streaming services. Given the Class 38 amendment to Applicant's Services description, it is clear that Applicant's Mark will be used in connection with medical consultation, and thus the services at issue are unrelated.

C. Applicant's Mark Differs in Meaning from the EMI Mark

The Trademark Examiner contends that the Applicant's Mark is identical to the EMI Mark in appearance, sound, and meaning. Applicant respectfully submits that the marks at issue are in fact dissimilar in their meaning and thus unlikely to be confused. "Even marks that are identical in sound and/or appearance may create sufficiently different commercial impressions when applied to the respective parties' goods or services so that there is no likelihood of confusion." Trademark Manual of Examining Procedure § 1207.01(b)(v) (hereinafter "TMEP"); *see also In re Sears, Roebuck & Co.*, 2 USPQ2d 1312, 1314 (holding the marks CROSSOVER and CROSS-OVER not likely to cause confusion when applied to bras versus sportswear); *see also Coach Services, Inc. v. Triumph Learning LLC*, 668F.3d 1356, 1366 (Fed. Cir. 2012) (affirming TTAB's finding of no likelihood of confusion based in part on the differing meanings of the term COACH when applied to the services at issue); *see also Care One, LLC v. Caring One LLC*, 2018 WL 1603931 at *6 (TTAB March 30, 2018) (finding CARING ONE and CARE ONE dissimilar in their meaning and unlikely to be confused).

It is important to note here that Applicant's Mark uses NOW as an acronym for "Neurosurgeon on Wheels." Courts will consider the constituent words of acronyms in analyzing the similarity of two marks. *See, e.g. Florida Int. Univ. Board of Trustees v. Florida Nat. Univ., Inc.*, 830 F.3d 1242, 1260–61 (11th Cir. 2016) (analyzing the meaning of the acronyms FIU and FNU); *see also New York State Elec. & Gas Corp. v. U.S. Gas & Elec., Inc.*, 697 F.Supp.2d 415, 433 (W.D.N.Y. 2010) ("The reality is that consumers are likely, when they see these marks, to associate the letters 'E' and 'G' with the words that they stand for in the parties' names.") Consumers frequently encounter acronyms of this sort without periods indicating their acronym status. *See Exhibit A* for example grammar guides explaining acronyms need not appear with periods; *see also Exhibit B* for a collection of acronyms consumers frequently encounter without periods. On the other hand, the Registrant's Mark uses NOW for its dictionary definition of "at the present time or moment." *See* Registrant's webpage available at <http://www.nowthatsmusic.com/>. By using NOW in this way, the owner of the EMI Registration indicates that its music compilations are contemporary or else are classics that appeal to contemporary sensibilities. This distinction clearly indicates that Applicant's Mark and the EMI Mark differ significantly in their meaning. The weight of this distinction is only multiplied when considered in relation to Applicant's Services and the EMI Services. As noted above, Applicant is amending the Application to clarify that its services involve medical consultation. As such, it is likely consumers would not understand

Applicant's Mark to indicate that it offers contemporary medical consultations, or that they would believe EMI's Mark involving contemporary musical compilations has anything to do with medical consultations. Such a difference in meaning "can weigh strongly in the likelihood of confusion analysis." *Care One*, 2018 WL 1603931 at *6 (citations omitted). Thus, the marks differ in their meaning when considered in relation to the services offered in connection therewith and are unlikely to cause consumer confusion.

II. Applicant's Mark is Unlikely to be Confused with the Ability Registration and is Entitled to Registration

The Trademark Examiner found a likelihood of confusion with the Ability Registration as well, again citing the similarity of both the marks and the goods. Applicant respectfully submits that the Ability Mark differs in key ways from Applicant's Mark, and both marks are directed at sophisticated consumers unlikely to be confused by the two marks considering the differences both in their meaning and the channels of trade they move in, especially considering they exist in a crowded field of NOW-formative marks.

A. Applicant's Services and the Ability Registrant's Services are Marketed to Sophisticated Consumers Unlikely to be Confused in their Purchasing Decisions

Sophisticated purchasers exercising care in their purchasing decisions are less likely to be confused as to the source of services. TMEP § 1207.01(d)(vii); *see also In re N.A.D., Inc.*, 754 F.2d 996, 999-1000, (Fed. Cir. 1985) (holding sophisticated consumers exercising great care minimizes the likelihood of confusion between the marks NARCO and NARKOMED). This consideration applies with equal force even where the marks are identical. *See, e.g. In re Thor Tech, Inc.*, 113 USPQ2d 1546, 1-6 (TTAB 2015) (holding two TERRAIN for vehicle hitches unlikely to be confused in part because of the degree of consumer care).

Ability Registrant's Services are marketed to healthcare professionals, and, as stated above, Applicant's Services involve teleconferencing and telepresence services with respect to medical consultations for use by patients. Healthcare professionals are obviously sophisticated consumers when it comes to goods and services related to the medical profession and provision of services to the medical profession. Likewise, consumers seeking medical services, especially neurosurgical medical services, will pay close attention to the selection of the provider of such services. *See, e.g., Carefirst of Maryland Inc. v. FirstHealth of the Carolinas, Inc.*, 77 UPSQ2d 1492, 1053 (TTAB 2005). Any healthcare professional seeking, for example, either the online Medicare data

entry services offered under the Ability Mark or the kiosk neurosurgical consultation services under the Applicant's Mark is unlikely to be confused merely based on the common NOW element. And, any consumer who is a patient seeking neurosurgical consultation services under the Applicant's Mark is unlikely to be confused by services involving online Medicare data entry or the other services offered under the Ability Mark. These are business and personal health decisions that have a high-degree of impact on the decision-maker. These types of decisions will always involve careful research and are unlikely to be made on impulse. As such, sophisticated consumers making such important decision will perform their due diligence on service providers and are highly unlikely to be confused merely by the inclusion of the NOW element of the mark. This is especially the case considering the difference in the services offered by Applicant and those included in the Ability Registration. Where the Ability Registration focuses on healthcare information exchange services and a network for health care professionals and providers, Applicant offers physical kiosks or other physical, mobile hardware to use to provide neurosurgical medical consultation services to consumers.

On the face of the goods and services descriptions in the Application and the Ability Registration, it is clear that the Applicant's Mark is used in connection with a kiosk or similar equipment that patients use to connect with healthcare providers for consultation. In contrast, the Ability Registrant's Services are offered via the Internet or telecommunication networks for communication or exchange of information between healthcare professionals and medical providers. As shown in its description as well as in the Ability Registration's specimen, the Ability Registration is not used with respect to any form of specific hardware for access to the services, and instead the services are offered via an online portal to be used between medical professionals and healthcare providers. All of the foregoing not targeted at patients or connecting patients with medical providers for medical consultations. The Ability Registrant's Services do not involve patient directed healthcare services, it is instead software or a portal related to healthcare information exchange, processing of insurance, and other administrative tasks. While extrinsic evidence may not be used to narrow a broad description of goods or services in an application or registration, extrinsic evidence is appropriate to clarify the meaning of the services that is specific to the trade or industry and show that the Applicant's Services are not related to Ability Registrant's Services. TMEP § 1207.01(a)(iii); *see also In re Trackmobile, Inc.*, 15 USPQ2D 1152, 1154 (TTAB 1990) ("when the description of goods for a cited registration is somewhat unclear .

. . it is improper to simply consider that description in a vacuum and attach all possible interpretations to it when the applicant has presented extrinsic evidence showing that the description of goods has a specific meaning to members of the trade”).

In this case, the distinction of “kiosk” versus “Internet” requires further clarification. Members of the telemedicine trade attach a specific meaning to providing services via “kiosk” versus “Internet.” See Exhibit C collecting screenshots of telemedicine kiosks. This key distinction further supports that no healthcare provider or consumer searching for medical services will confuse the Ability Mark with Applicant’s Mark as the distinction between software platforms and kiosks is known to the relevant consumers.

B. Confusion is Not Likely Because Applicant’s Services are Not Marketed or Sold in the Same Trade Channels

A likelihood of confusion analysis must focus on the way the identified goods and services are encountered in the marketplace by consumers. 3 J. Thomas McCarthy on *Trademarks and Unfair Competition*, § 23:58 (4th ed. 2004). “Where the parties . . . market their goods or services in different ways, the likelihood of confusion decreases.” *Therma-Scan, Inc. v. Thermoscan, Inc.*, 295 F.3d 623, 636-37 (6th Cir. 2002). In order to properly determine whether goods travel in the same channels of trade, one must consider “how and to whom the respective goods or services of the parties are sold.” *Homeowners Group, Inc. v. Home Marketing Specialists, Inc.*, 931 F.2d 1100, 1110 (6th Cir. 1991).

As discussed above, Applicant provides its services via the use of a kiosk or other hardware. Such a kiosk will require physical interaction with the consumers seeking medical services for the delivery of those services. This necessity for physical interaction is not present for the Ability Registrant’s Services, which can be purchased and delivered and utilized entirely via the “Internet.” The distinctions between these purchasing processes further reduces any potential likelihood of confusion. No healthcare provider encountering a kiosk offering Applicant’s Services related to medical consultations will be confused into thinking he or she is encountering an online Web portal or software providing for the exchange of healthcare information among healthcare professionals.

The Examining Attorney attached examples of third party registrations the Examiner contends show that both the Ability Registrant’s Services and Applicant’s Services emanate from a single source. Applicant respectfully disagrees as the attached third-party registrations

demonstrate only that telecommunications companies often sell both software and hardware, and that there are other extant telemedicine services. While telecommunications companies may offer both software and hardware, this does not mean that both kiosk telemedicine and healthcare information exchange or insurance processing services via the Internet are offered by the same companies. None of the telemedicine registrations cited by the Examiner offer both services via a kiosk and services via an online portal marketed to different potential consumers.

C. Applicant's Mark Differs in Meaning from the Ability Registration and is Unlikely to Cause Confusion

As discussed above, similarity in meaning is a factor to be considered in the likelihood of confusion analysis. TMEP § 1207.01. Applicant respectfully submits that Applicant's Mark differs significantly in meaning from the Ability Mark. Applicant's Mark is an acronym for "Neurosurgeon on Wheels." As discussed above, courts will examine the words making up an acronym in a likelihood of confusion analysis. *See, e.g. Florida Int.* 830 F.3d at 1260–61; *see also New York State Elec. & Gas Corp.*, 697 F.Supp.2d at 433. There is no indication that the Ability Mark uses NOW for anything other than its dictionary definition. The Ability Mark seemingly uses NOW to indicate the immediacy or speed of its services. This stands in contrast to Applicant's Mark, which is an acronym used to connote the mobility of Applicant's Services and the focus on neurosurgical medical consultations. As such, Applicant's Mark differs from the Ability Mark and is unlikely to be confused.

D. Applicant's Mark and the Ability Mark Exist in a Crowded Field of NOW-formative Marks

This difference in meaning is especially important considering the crowded field of NOW-formative Marks in medicine related services. Where there is a crowded field of marks employing a common element, members of the public are less likely to associate any one of the marks with another. *See, e.g., Moose Creek, Inc. v. Abercrombie & Fitch Co.*, 331 F.Supp.2d 1214, 1225 (C.D. Cal 2004) (denying preliminary injunction, despite identical goods and similar moose logos, in part because consumers are used to seeing moose logos on clothing elsewhere in the marketplace). Here, it is a common practice for businesses offering telemedicine or related medical services to include NOW as part of their mark. *See* Exhibit D for a collection of NOW-formative registration certificates in the field of telemedicine. As such, the Ability Mark, including only the element

NOW with no further meaning or distinguishing features, is weak and unlikely to be confused with Applicant's Mark. *See Moose Creek, Inc.*, 331 F.Supp.2d at 1225.

In contrast, Applicant's Mark is strengthened by its creative use of the NOW element. By using it as an acronym to describe Applicant's Services, Applicant adds new meaning to NOW and distinguishes itself from the field. This is especially true in the crowded field, where small differences such as this are the only purchase consumers can find to distinguish marks. The foregoing, combined with the sophistication of consumers, the difference in the channels of trade, and the difference in the meaning of the marks makes it unlikely that any consumer will confuse the Applicant's Mark and the Ability Mark.

Conclusion

As demonstrated above, Applicant's Mark is dissimilar in both services offered and connotation as compared to the EMI Mark and the Ability Mark. Applicant's services are wholly different from those included in the EMI Registrant's Services and the Ability Registrant's Services. There also exists a difference in channels of trade between Applicant's Mark and both the EMI Mark and the Ability Mark. Finally, a crowded field means that only a small amount of distinction is necessary to avoid any likelihood of confusion. Accordingly, Applicant respectfully requests that the likelihood of confusion refusal be withdrawn, and Applicant respectfully requests that the Examining Attorney pass Applicant's Mark to publication.