

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: PRGTS, LLC
Serial Number: 88/469,835
Word Mark: SEE WHAT YOU’VE BEEN MISSING
Filing Date: February 24, 2020

RESPONSE TO OFFICE ACTION

Applicant responds to the Office Action mailed September 4, 2019, in which the United States Patent and Trademark Office (the “PTO”) has initially refused to register Applicant’s SEE WHAT YOU’VE BEEN MISSING mark for “providing business auditing services in the nature of recovery auditing; business consultation in the field of recovery auditing; business advisory, consultancy and information services in the field of business and government optimization; government advisory services, namely, providing business advice and assistance to governmental agencies and departments relating to identifying and recovering inappropriate payments; business management consulting featuring specialization in the use of data extraction, transformation and analysis capabilities, namely, data processing, for the reduction of costs and improvement of procurement and payment processes; providing business consulting, business information services in the field of analytics, business operational and business process improvement and outsourcing services for the finance, accounting and procurement functions of commercial and governmental entities; accounting services” (“Applicant’s Mark”) under Section 2(d) of the Trademark Act (“the Act”) based on registration of the mark WE SEE, WHAT YOU MISSED for “tracking and monitoring business expenses for others for account auditing purposes; tracking and monitoring business expenses for others for cost accounting purposes” (the “Cited Mark”).

SUMMARY OF ARGUMENT

Although several of the *du Pont* factors are relevant to the likelihood of confusion analysis in this case, the PTO, in making its determination that Applicant’s Mark is confusingly similar to the Cited Mark, considered only the first two *du Pont* factors: (1) the similarities between the compared marks and (2) the relatedness of the compared services. Further, the PTO’s analysis of these two factors is incomplete. Applicant respectfully submits that a proper analysis of all the applicable *du Pont* factors shows that Applicant’s Mark and the Cited Mark are not confusingly similar. Applicant’s Mark and the Cited Mark sound different, have different connotations, and provide different commercial impressions when considered in their entirety. Moreover, addressing additional important *du Pont* factors, consumers receiving the services offered by Applicant and Registrant are sophisticated and take special care when researching providers of financial services; and the Cited Mark is not famous, but instead considered a rather weak mark entitled to minimal protection. Taking into consideration all of these factors, Applicant respectfully

submits that the PTO should withdraw its refusal based on likelihood of confusion and allow Applicant's Mark to proceed to publication in the *Trademark Official Gazette*.

REMARKS

Applicant respectfully submits that a complete analysis of the similarity of the marks and consideration of all other relevant *du Pont* factors shows that Applicant's Mark and the Cited Mark are not confusingly similar. Applicant's Mark and the Cited Mark are different in sound, connotation, and commercial impression; both Applicant's services and the services identified by the Cited Mark are rendered to sophisticated consumers who carefully consider purchasing decisions and service offerings as opposed to making impulse buys; and the Cited Mark is not famous and as such should be given limited protection.

Under the Lanham Act, trademarks are presumed to be registerable, and no trademark shall be refused registration unless it is likely to cause mistake or deceive. *See* 15 U.S.C. § 1052; *In re E.I. du Pont de Nemours & Co.*, 476 F. 2d 1357, 1360 (C.C.P.A. 1973). As the PTO is aware, the court in *du Pont* laid out 13 factors to be considered when determining whether a mark so resembles a prior mark that it should be refused registration. *See id.* at 1361. Each analysis is highly fact specific. No *du Pont* factor is dispositive, and reasonable people could differ as to the weight given to any specific factor. *See e.g., du Pont*, 476 F. 2d at 1362; *Kellogg Co. v. Pack'em Enterprises, Inc.*, 951 F.2d 331 (Fed. Cir. 1991). Accordingly, there is no mechanical test for determining likelihood of confusion. *du Pont*, 476 F.2d at 1361.

The PTO initially refused to register Applicant's Mark citing Section 2(d) of the Trademark Act and a likelihood of confusion with the mark in U.S. Registration No. 5662993. A determination of likelihood of confusion under Section 2(d) should be based on an analysis of all the probative facts that are relevant to the factors outlined in *In re E.I. du Pont de Nemours & Co.*, 476 F. 2d 1357, 1361 (C.C.P.A. 1973). *See* TMEP § 1207.01. The Applicant respectfully submits that the PTO's analysis of the likelihood of confusion between Applicant's Mark and the Cited Mark is incomplete because (1) its analysis was limited to the similarity of the marks and the similarity of the services, and (2) application of other *du Pont* factors confirms that no likelihood of confusion exists. As the Trademark Manual of Examining Procedure states, a determination that there is no likelihood of confusion may be appropriate, even where the marks are similar and the services are related, when these factors are outweighed by other factors. TMEP § 1207.01. Applicant respectfully submits that had the PTO considered all of the other relevant *du Pont* factors, it should have found that these factors outweigh the alleged similarity of the marks and relatedness of the services, thereby finding that no likelihood of confusion exists between Applicant's Mark and the Cited Mark. Applicant's SEE WHAT YOU'VE BEEN MISSING mark is sufficiently different from the Cited Mark WE SEE, WHAT YOU MISSED to avoid a finding of likelihood of confusion. A thorough examination of all relevant factors strongly supports the conclusion that there is no likelihood of confusion.

I. Applicant's Mark Is Not Confusingly Similar to the Cited Mark

Applicant's SEE WHAT YOU'VE BEEN MISSING mark is not so similar to the WE SEE, WHAT YOU MISSED mark as to create a likelihood of confusion. Marks must be compared in

their entireties as to appearance, sound, connotation, and commercial impression, and likelihood of confusion cannot be predicated on dissection of a mark. *In re Nat'l Data Corp.*, 753 F.2d 1056, 1058 (Fed. Cir. 1985); *du Pont*, 476 F.2d at 1361.

Applicant's Mark sounds significantly different from the Cited Mark. First, Applicant's mark begins with an imperative verb, causing the reader to inflect their voice to convey a sense of command. The Cited Mark, however, is a declarative sentence that begins with a personal pronoun as the subject and expresses a neutral tone. Second, the second portion of Applicant's Mark YOU'VE BEEN MISSING is in the present perfect progressive tense whereas the second portion of the Cited Mark YOU MISSED is in the simple past tense. Third, Applicant's Mark contains 6 syllables whereas the Cited Mark contains only 5 syllables. Fourth, three-fifths of the words in Applicant's Mark are different than the words in the Cited Mark. Lastly, and arguably most importantly, the Cited Mark contains a comma which the PTO appears to have ignored in its examination of the marks. In the Office Action, the PTO improperly states that both marks contain variants of the phrase "see what you miss". However, because of the comma and the mandatory aural pause that it creates after the word "see" when speaking the Cited Mark, the Cited Mark can only be said to contain a variant of the phrase "what you miss" since the "see" is separated from the rest of the phrase by the little but mighty comma.

A comma not only changes the way a phrase sounds, but also has a huge impact on the connotation of a phrase. Take the following as illustrative examples:

- Let's eat Grandma! Vs. Let's eat, Grandma!
- I want to thank my parents, Tom Hanks and Rita Wilson. Vs. I want to thank my parents, Tom Hanks, and Rita Wilson.
- We're going to learn to cut and paste kids! Vs. We're going to learn to cut and paste, kids!
- Rachel Ray finds inspiration in cooking her family and her dog. Vs. Rachel Ray finds inspiration in cooking, her family, and her dog.

The above examples demonstrate the comma's ability to drastically change the meaning of a sentence, even when the words are identical (which is not the case here since 3/5ths of the words in Applicant's Mark are different). The pause created by the comma in the Cited Mark gives the mark a laudatory and even supercilious connotation as to admonish consumers for "missing" something. In contrast, Applicant's Mark has a double meaning, both of which meanings are different from the meaning of the Cited Mark. One meaning of SEE WHAT YOU'VE BEEN MISSING is a signal to consumers that Applicant's services offer consumers a benefit that they are not presently enjoying without Applicant's services. The other meaning is that through Applicant's services, consumers will quite literally, see what they have not been seeing in their audits without Applicant's services. Neither connotation is present with the Cited Mark. Because of these differences in sound, connotation, and commercial impression, there is no likelihood of confusion between Applicant's Mark and the Cited Mark.

II. There Is No Likelihood of Confusion Between Applicant’s Mark and the Cited Mark Because Applicant and Registrant Target Sophisticated Consumers with Focused Needs.

Consumers who purchase services such as the type identified by Applicant’s Mark and the Cited Mark are not impulse buyers. Rather, they will take considerable time researching service providers as part of their process in making deliberate decisions to meet a very specific business need. Due to this careful research, confusion between the sources of the parties’ services will not arise. *See G.H. Mumm & Cie v. Desnoes & Geddes, Ltd.*, 917 F.2d 1292, 1295, 16 U.S.P.Q.2d (BNA) 1635, 1638 (Fed. Cir. 1990) (determining that when consumers enter the marketplace with a “focused need,” confusion between goods or services is less likely). Further, consumers seeking financial services such as those offered by Applicant and Registrant, will make careful, deliberate decisions, as such services involve their money and business accounts.

Indeed, some courts have determined consumer sophistication to be the most critical factor in concluding that no confusion would arise between products or services identified by the same or similar marks. *See, e.g., Astra Pharm. Prods., Inc. v. Beckman Instruments, Inc.*, 220 U.S.P.Q. (BNA) 786, 790 (1st Cir. 1983); *Pignons S. A. de Mecanique de Precision v. Polaroid Corp.*, 212 U.S.P.Q. (BNA) 246 (1st Cir. 1981) (deciding that purchaser sophistication is dispositive in a likelihood of confusion analysis because sophisticated consumers exercise greater care in their purchasing decisions). Moreover, courts have held that purchasers of financial services are sophisticated. *See Citigroup Inc. v. City Holding Co.*, 171 F. Supp. 2d 333 (S.D.N.Y. 2001) (reasoning that in the financial services industry, consumer sophistication “must be considered to weigh against the likelihood of confusion”). In *In re Trustmark Nat’l Bank*, the Board held that no likelihood of confusion existed between “YOURMARK” and “LEAVE YOUR MARK,” noting that consumers purchasing the parties’ respective banking and financial services...

are likely to spend some time in the decision to purchase or use these services. In so doing, they are likely to develop some relationship with the offeror of these services and are likely to know the source of these services. Accordingly, we conclude that, although the services are related, the marks are sufficiently different, and the purchasers are likely to be relatively sophisticated such that confusion is not likely.¹

In re Trustmark Nat’l Bank, 2004 TTAB LEXIS 513 (T.T.A.B. 2004). Just like in *In re Trustmark Nat’l Bank*, Applicant’s and Registrant’s customers are extremely sophisticated customers who closely examine the financial management services being provided to them and develop some relationship with Applicant and Registrant as offerors of these services. And just like the Board found that no likelihood of confusion existed between the marks YOURMARK and LEAVE YOUR MARK, the same result should apply here.

¹ Applicant acknowledges that this case is not citable as precedent. Nevertheless, Applicant respectfully submits that the holding in this case is instructive of how the Board has addressed a similar case.

III. The Cited Mark Is Not Famous and Merits a Narrow Scope of Protection.

The *du Pont* Court instructs the Board to evaluate the fame of the prior mark through a review of sales, advertising, and length of use of the mark. *du Pont*, 476 F.2d at 1361, 177 U.S.P.Q. at 567. The Board affords very broad protection to “famous” marks under Section 2(d). *Blue Man Prods. Inc. v. Tarmann*, 75 U.S.P.Q.2d (BNA) 1811 (T.T.A.B. 2005). However, the Cited Mark is not a “famous” mark. Accordingly, Applicant respectfully submits that the Cited mark should properly be classified as a weak mark. A weak mark commands a lesser degree of protection than the strong. *Nat’l Cable Television Ass’n, Inc. v. Am Cinema Editors, Inc.*, 937 F.3d 1572, 19 U.S.P.Q.2d (BNA) 1424 (Fed. Cir. 1991); *In re Essex Serv. Co.*, 7 U.S.P.Q.2d (BNA) 1748, 1750 (T.T.A.B. 1988); *Kenner Parker Toys, Inc. v. Rose Art Indus., Inc.*, 963 F.2d 350, 22 U.S.P.Q.2d (BNA) 1453, 1456 (Fed. Cir. 1992). Quite simply, the Cited Mark is neither famous nor strong, and is therefore entitled to an extremely narrow scope of protection which does not extend to Applicant’s Mark. Confirming the absence of any recognition associated with the Cited Mark, let alone fame, a search using the Google search engine for “WE SEE, WHAT YOU MISSED” did not disclose one single reference to the Cited Mark. See attached printouts from Google search results. Absent any public recognition, the Cited Mark should be limited to protection that only extends to the Cited Mark itself and does not extend to exclude Applicant’s Mark.

IV. Conclusion

For the reasons laid out in the above analysis, Applicant respectfully submits that no likelihood of confusion exists between its Mark and the Cited Mark because: (1) the marks are different when considered in their entireties, (2) the consumers of the parties’ services are sophisticated and/or are likely to exercise care when making the decision to purchase the parties’ services, and (3) the Cited Mark is not famous or well known, entitling it to a narrower scope of protection. Accordingly, Applicant respectfully submits, for the reasons discussed and the authorities relied upon herein, that its SEE WHAT YOU’VE BEEN MISSING mark be passed to publication and issued a Notice of Allowance for registration on the Principal Register of the U.S. Patent and Trademark Office.