

APPLICANT'S RESPONSE TO OFFICE ACTION

The following is the response of the Applicant, AIXEP, Inc. to the Office Action served via email on September 7, 2019 by Examining Attorney Laura E. Fionda. Applicant hereby incorporates by reference its previous evidence.

LIKELIHOOD OF CONFUSION REFUSAL

The Examining Attorney has refused registration of Applicant's BACPAC word mark pursuant to Trademark Act Section 2(d), 15 U.S.C. § 1052(d), on the ground that the mark is likely to be confused with the mark in cited Registration No. 78865359 (the "cited mark"). For the reasons set forth below, Applicant respectfully disagrees with the findings and requests that the Examining Attorney reconsider the statutory refusal and allow registration of Applicant's mark. The USPTO is determined by a review of all of the relevant factors under the du Pont test. *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357. Although the issue of likelihood of confusion typically revolves around the similarity or dissimilarity of the marks and the relatedness of the goods or services, there is no mechanical test for likelihood of confusion. See TMEP § 1207.01; *In re E. I. du Pont de Nemours & Co.* 476 F.2d 1357; *In re Majestic Distilling Co.*, 315 F.3d 1311, 1315, 65 USPQ2d 1201, 1204 (Fed. Cir. 2003). Each of the thirteen du Pont factors may be considered in weighing likelihood of confusion, if raised, and any may be dispositive. See TMEP §1207.01. In some cases, a determination that there is no likelihood of confusion may be appropriate, even where the marks are similar and the goods/services are related, because these factors are outweighed by other factors, such as differences in the relevant trade channels of the goods/services, the presence in the marketplace of a significant number of similar marks in use on similar goods/services, the existence of a valid consent agreement between the parties, or another established fact probative of the effect of use. *Id.*

No Likelihood of Confusion Exists

Applicant's mark and the cited mark are for different customer bases. Backpack (Registration No. 78865359) is a project management tool originally developed by 37 Signals, which became Basecamp. Information from 37 Signals' postings to articles and posts about the cited mark describe the product as a tool for businesses, including as a project management tool. (See attached Evidence.) Applicant's mark, on the other hand, is directed to individual consumers, who must download Applicant's application from the iTunes store. Applicant's specimen, the Home page from its website, directs an interested user to the iTunes Store to download the product.

In addition, the registrant of the cited mark is retiring its product (see Attachment 1 "backpack retired"), and, according to its website (<https://basecamp.com/retired/backpack>), it is no longer actively marketing its product.

There is little likelihood of confusion as to the source of the goods and services offered by Basecamp and that offered by Applicant.