

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Petuum, Inc.
Application No. : 88/462,448
Filed : June 6, 2019
Mark : NEUROBOT
International Classes : 009; 042
Examining Attorney : Clinton Johnson
Law Office : 107
Docket No. : PETUUM-P0019
Date : March 10, 2020

RESPONSE TO OFFICE ACTION

This response is being submitted in reply to the Office Action dated September 11, 2019. Applicant thanks the Examining Attorney for diligent examination of this application. In the Office Action mailed September 11, 2019, Examining Attorney requests clarification to certain goods and services identified in International Classes 9 and 42. Additionally, Examining Attorney refuses registration under Trademark Act § 2(d) claiming there is a likelihood of confusion between the applied-for mark and the cited mark in U.S. Registration No. 4690156.

In response, Applicant amends the goods and services identified in Classes 9 and 42. Additionally, Applicant respectfully presents the below arguments in support of registration against any likelihood of confusion between the Applied-for mark and the Cited mark.

Amendment of Identification of Goods

In response to Examiner's request to clarify, Applicant amends the identification of goods and services as set forth below:

Class 9:

Downloadable computer software for use in process automation, business automation, business process automation, robotic process automation, **and** intelligent process automation; Downloadable computer software for use in process automation, business automation, business process automation, robotic process automation, **and** intelligent process automation in the field of tax, human resource, finance, marketing, advertising, insurance, healthcare, manufacture, education, lending, information technology consulting, training, front end support, back end support, technical support service, customer support, customer service, retail service, product recommendation, report generation, virtual product tryout such as virtual clothing fitting, **and** resource management; Downloadable computer software **featuring a** user interface using artificial intelligence, machine learning, deep learning, statistical learning, data mining, contextual prediction, predictive analytics, risk analysis, predictive analysis and business intelligence for use in process automation, business automation, business process automation, robotic process automation, **and** intelligent process automation in the field of tax, human resource, finance, marketing,

advertising, insurance, healthcare, manufacture, education, lending, information technology consulting, training, front end support, back end support, technical support service, customer support, customer service, retail service, product recommendation, report generation, virtual product tryout such as virtual clothing fitting, **and** resource management;

Software **and computer programs, namely, downloadable software in the nature of a mobile application for use in process automation, business automation, business process automation, robotic process automation, and intelligent process automation;**

data processing equipment **namely for use in process automation, business automation, business process automation, robotic process automation, and intelligent process automation;**

~~computers; computer peripherals; computer programs~~

downloadable software development kits (SDKs) **namely for use in process automation, business automation, business process automation, robotic process automation, and intelligent process automation;**

downloadable computer software for collecting, analyzing, editing, managing, organizing, modifying, book marking, transmission, storage and sharing of data and information;

downloadable computer software for use in data management and analysis;

downloadable computer software development tools **namely for use in process automation, business automation, business process automation, robotic process automation, and intelligent process automation;**

downloadable intelligent personal assistance software **namely for use in process automation, business automation, business process automation, robotic process automation, and intelligent process automation** and **accompanying** devices, **all sold as a unit;**

computer databases **namely, electronic database involving namely, artificial Intelligence, Machine Learning, Deep Learning, and Neural Network algorithm technologies, recorded on computer media;**

computer data in recorded form **namely, computer programs recorded for featuring function of the programs for use in process automation, business automation, business process automation, robotic process automation, and intelligent process automation;**

electronic publications, **namely, downloadable electronic publications in the field of utilizing Artificial Intelligence, Machine Learning, Deep Learning, and Neural Network algorithm technologies;**

audio recordings and video recordings for educational and training purposes **involving Artificial Intelligence, Machine Learning, Deep Learning, and Neural Network algorithm technologies**; Downloadable computer software for data analytics, data processing, business process management (BPM), business process organization, and business operations automatization; downloadable computer software based on artificial intelligence and machine learning for use by business enterprises for automating business operations, business process organization, and business process management; Downloadable computer software utilizing Artificial Intelligence, Machine Learning Deep Learning, **and** Neural Network algorithm **[for use in process automation, business automation, business process automation, robotic process automation, and intelligent process automation]**; Artificial Intelligence, Machine Learning Deep Learning, **and** Neural Network based downloadable software for business for use in process automation, business automation, business process automation, robotic process automation, **and** intelligent process automation in the field of tax, human resource, finance, marketing, advertising, insurance, healthcare, manufacture, education, lending, information technology consulting, training, front end support, back end support, technical support service, customer support, customer service, retail service, product recommendation, report generation, virtual product tryout **namely,** virtual clothing fitting, **and** resource management; Downloadable computer software for enterprises, namely, artificial-intelligence (AI) based software that integrates and connects technologies for businesses, namely, cloud mobility, SaaS mobility, robotic process automation, dynamic workflow, computational linguistics, virtual data science, computer vision, conversational artificial intelligence, data services analytics, advanced visualization analytics, data engineering, and machine learning; downloadable computer software for tracking, maintaining, processing, logging and storing data; downloadable computer software for monitoring, tracking, logging, analyzing, auditing and reporting in the fields of regulatory compliance, corporate governance, and internal business controls

Class 42:

Software as a service (SaaS) **services featuring software and** Platform as a service (PaaS) services **featuring computer software platforms, both** for process automation, business automation, business process automation, robotic process automation, **and** intelligent process automation; Software as a service (SaaS) **services featuring software and** Platform as a service (PaaS) services **featuring computer software platforms, both** for process automation, business automation, business process automation, robotic process automation, **and** intelligent process automation in the field of tax, human resource, finance, marketing, advertising, insurance, healthcare, manufacture, education, lending, information technology consulting, training, front end support, back end support, technical support service, customer support, customer service, retail service, product recommendation, report generation, virtual product tryout **namely,** virtual clothing fitting, **and** resource management; Software as a service (SaaS) **services featuring software and** Platform as a service (PaaS) services **featuring computer software platforms, both** for collecting, analyzing, editing, managing, organizing, modifying, book marking, transmission, storage and sharing of data and information; Software as a service (SaaS) **services featuring software and** Platform as a service (PaaS) services **featuring computer software platforms, both for use** in data management and analysis; Software

as a service (SaaS) **services featuring software and** Platform as a service (PaaS) services **featuring computer software platforms, both** for data analytics, data processing, business process management (BPM), business process organization, and business operations automatization; Software as a service (SaaS) **services featuring software and** Platform as a service (PaaS) services **featuring computer software platforms, both** based on artificial intelligence and machine learning for use by business enterprises for automating business operations, business process organization, and business process management; Software as a service (SaaS) **services featuring software and** or Platform as a service (PaaS) services **featuring computer software platforms, both** utilizing Artificial Intelligence, Machine Learning Deep Learning, **and** Neural Network algorithm **[for use in process automation, business automation, business process automation, robotic process automation, and intelligent process automation]**;

Artificial Intelligence, Machine Learning Deep Learning, **and** Neural Network based Software as a service (SaaS) **services featuring software and** Platform as a service (PaaS) services **featuring computer software platforms, both** for process automation, business automation, business process automation, robotic process automation, or intelligent process automation in the field of tax, human resource, finance, marketing, advertising, insurance, healthcare, manufacture, education, lending, information technology consulting, training, front end support, back end support, technical support service, customer support, customer service, retail service, product recommendation, report generation, virtual product tryout **namely** virtual clothing fitting, **and** resource management; Software as a service (SaaS) **services featuring software and** Platform as a service (PaaS) services **featuring computer software platforms, both** for enterprises, namely, artificial-intelligence (AI) based Software as a service (SaaS) **services featuring software and** Platform as a service (PaaS) services **featuring computer software platforms, both** that integrates and connects technologies for businesses, namely, cloud mobility, SaaS mobility, robotic process automation, dynamic workflow, computational linguistics, virtual data science, computer vision, conversational artificial intelligence, data services analytics, advanced visualization analytics, data engineering, and machine learning; downloadable computer software for tracking, maintaining, processing, logging and storing data; downloadable computer software for monitoring, tracking, logging, analyzing, auditing and reporting in the fields of regulatory compliance, corporate governance, and internal business controls; Software as a service (SaaS) **services featuring software and** Platform as a service (PaaS) services featuring computer software platforms utilizing cognitive computing technology and knowledge-based automation technology for automating business operations, business process organization, and business management; Software as a service (SaaS) **services featuring software and** or Platform as a service (PaaS) services **featuring computer software platforms, both**, namely, software for data analytics, data processing, business process management (BPM), business process organization, and business operations automatization; Software as a service (SaaS) **services featuring software and** Platform as a service (PaaS) services **featuring computer software platforms, both**, namely, artificial-intelligence (AI) based software that integrates and connects technologies for businesses, namely, cloud mobility, SaaS mobility, robotic process automation, dynamic workflow, computational linguistics, virtual data science, computer vision, conversational artificial intelligence, data services analytics, advanced

visualization analytics, data engineering, and machine learning; Computer software consulting; Computer software development in the field of process automation, business automation, business process automation, robotic process automation, **and** intelligent process automation; technical **technology** consulting services in the field of computer data management, computer data analytics, process automation, business automation, business process automation, robotic process automation, or intelligent process automation, **all the aforementioned relating to computer and software technology**

Argument Against Likelihood of Confusion

In the Office Action, Examiner refuses registration of the Applied-for mark by asserting that there is a likelihood of confusion between the Applied-for mark and the Cited mark in Registration No. 4690156. Information regarding both marks are provided below.

MARK	Relevant Goods and Services	Serial No. and Date
<p>NEUROBOT</p> <p>(Applicant’s Mark)</p> <p>Owner: Petuum, Inc.</p>	<p><u>Class 9</u> (as amended)</p> <p>Downloadable computer software for use in process automation, business automation, business process automation, robotic process automation, and intelligent process automation; Downloadable computer software for use in process automation, business automation, business process automation, robotic process automation, and intelligent process automation in the field of tax, human resource, finance, marketing, advertising, insurance, healthcare, manufacture, education, lending, information technology consulting, training, front end support, back end support, technical support service, customer support, customer service, retail service, product recommendation, report generation, virtual product tryout such as virtual clothing fitting, and resource management; Downloadable computer software featuring a user interface using artificial intelligence, machine learning, deep learning, statistical learning, data mining, contextual prediction, predictive analytics, risk analysis, predictive analysis and business intelligence for use in process automation, business automation, business process automation, robotic process automation, and intelligent process automation in the field of tax, human resource, finance, marketing, advertising, insurance, healthcare, manufacture, education, lending, information technology consulting, training, front end support, back end support, technical support service, customer support, customer service, retail service, product recommendation, report generation, virtual product tryout such as virtual clothing fitting, and resource management;</p> <p>Software and computer programs, namely, downloadable software in the nature of a mobile application for use in process automation, business automation, business process automation, robotic process automation, and intelligent process automation;</p>	<p>Serial No. 88/462,448</p> <p>Filing Date: June 6, 2019</p>

	<p>data processing equipment namely for use in process automation, business automation, business process automation, robotic process automation, and intelligent process automation;</p> <p>downloadable software development kits (SDKs) namely for use in process automation, business automation, business process automation, robotic process automation, and intelligent process automation;</p> <p>downloadable computer software for collecting, analyzing, editing, managing, organizing, modifying, book marking, transmission, storage and sharing of data and information;</p> <p>downloadable computer software for use in data management and analysis;</p> <p>downloadable computer software development tools namely for use in process automation, business automation, business process automation, robotic process automation, and intelligent process automation;</p> <p>downloadable intelligent personal assistance software namely for use in process automation, business automation, business process automation, robotic process automation, and intelligent process automation and accompanying devices, all sold as a unit;</p> <p>computer databases namely, electronic database involving namely, artificial Intelligence, Machine Learning, Deep Learning, and Neural Network algorithm technologies, recorded on computer media;</p> <p>computer data in recorded form namely, computer programs recorded for featuring function of the programs for use in process automation, business automation, business process automation, robotic process automation, and intelligent process automation;</p> <p>electronic publications, namely, downloadable electronic publications in the field of utilizing Artificial Intelligence, Machine Learning, Deep Learning, and Neural Network algorithm technologies;</p> <p>audio recordings and video recordings for educational and training purposes involving Artificial Intelligence, Machine Learning, Deep Learning, and Neural Network algorithm technologies; Downloadable computer software for data analytics, data processing, business process management (BPM), business process organization, and business operations automatization; downloadable computer software based on artificial intelligence and machine learning for use by business enterprises for automating business operations, business process organization, and business process management; Downloadable computer software utilizing Artificial Intelligence, Machine Learning Deep Learning, and Neural Network algorithm [for use in process automation, business automation, business process automation, robotic process automation, and intelligent process automation]; Artificial Intelligence, Machine Learning Deep Learning, and Neural Network</p>	
--	---	--

based downloadable software for business for use in process automation, business automation, business process automation, robotic process automation, and intelligent process automation in the field of tax, human resource, finance, marketing, advertising, insurance, healthcare, manufacture, education, lending, information technology consulting, training, front end support, back end support, technical support service, customer support, customer service, retail service, product recommendation, report generation, virtual product tryout namely, virtual clothing fitting, and resource management; Downloadable computer software for enterprises, namely, artificial-intelligence (AI) based software that integrates and connects technologies for businesses, namely, cloud mobility, SaaS mobility, robotic process automation, dynamic workflow, computational linguistics, virtual data science, computer vision, conversational artificial intelligence, data services analytics, advanced visualization analytics, data engineering, and machine learning; downloadable computer software for tracking, maintaining, processing, logging and storing data; downloadable computer software for monitoring, tracking, logging, analyzing, auditing and reporting in the fields of regulatory compliance, corporate governance, and internal business controls

Class 42 (as amended)

Software as a service (SaaS) services featuring software and Platform as a service (PaaS) services featuring computer software platforms, both for process automation, business automation, business process automation, robotic process automation, and intelligent process automation; Software as a service (SaaS) services featuring software and Platform as a service (PaaS) services featuring computer software platforms, both for process automation, business automation, business process automation, robotic process automation, and intelligent process automation in the field of tax, human resource, finance, marketing, advertising, insurance, healthcare, manufacture, education, lending, information technology consulting, training, front end support, back end support, technical support service, customer support, customer service, retail service, product recommendation, report generation, virtual product tryout namely, virtual clothing fitting, and resource management; Software as a service (SaaS) services featuring software and Platform as a service (PaaS) services featuring computer software platforms, both for collecting, analyzing, editing, managing, organizing, modifying, book marking, transmission, storage and sharing of data and information; Software as a service (SaaS) services featuring software and Platform as a service (PaaS) services featuring computer software platforms, both for use in data management and analysis; Software as a service (SaaS) services featuring software and Platform as a service (PaaS) services featuring computer software platforms, both for data analytics, data processing, business process management (BPM), business process organization, and business operations automatization; Software as a service (SaaS) services featuring software and Platform as a service (PaaS) services featuring computer software platforms, both based on artificial intelligence and machine learning for use by business enterprises for automating business

	<p>operations, business process organization, and business process management; Software as a service (SaaS) services featuring software and or Platform as a service (PaaS) services featuring computer software platforms, both utilizing Artificial Intelligence, Machine Learning Deep Learning, and Neural Network algorithm [for use in process automation, business automation, business process automation, robotic process automation, and intelligent process automation];</p> <p>Artificial Intelligence, Machine Learning Deep Learning, and Neural Network based Software as a service (SaaS) services featuring software and Platform as a service (PaaS) services featuring computer software platforms, both for process automation, business automation, business process automation, robotic process automation, or intelligent process automation in the field of tax, human resource, finance, marketing, advertising, insurance, healthcare, manufacture, education, lending, information technology consulting, training, front end support, back end support, technical support service, customer support, customer service, retail service, product recommendation, report generation, virtual product tryout namely virtual clothing fitting, and resource management; Software as a service (SaaS) services featuring software and Platform as a service (PaaS) services featuring computer software platforms, both for enterprises, namely, artificial-intelligence (AI) based Software as a service (SaaS) services featuring software and Platform as a service (PaaS) services featuring computer software platforms, both that integrates and connects technologies for businesses, namely, cloud mobility, SaaS mobility, robotic process automation, dynamic workflow, computational linguistics, virtual data science, computer vision, conversational artificial intelligence, data services analytics, advanced visualization analytics, data engineering, and machine learning; downloadable computer software for tracking, maintaining, processing, logging and storing data; downloadable computer software for monitoring, tracking, logging, analyzing, auditing and reporting in the fields of regulatory compliance, corporate governance, and internal business controls; Software as a service (SaaS) services featuring software and Platform as a service (PaaS) services featuring computer software platforms utilizing cognitive computing technology and knowledge-based automation technology for automating business operations, business process organization, and business management; Software as a service (SaaS) services featuring software and or Platform as a service (PaaS) services featuring computer software platforms, both, namely, software for data analytics, data processing, business process management (BPM), business process organization, and business operations automatization; Software as a service (SaaS) services featuring software and Platform as a service (PaaS) services featuring computer software platforms, both, namely, artificial-intelligence (AI) based software that integrates and connects technologies for businesses, namely, cloud mobility, SaaS mobility, robotic process automation, dynamic workflow, computational linguistics, virtual data science, computer vision, conversational artificial intelligence, data services analytics, advanced visualization analytics, data engineering, and machine learning; Computer software consulting; Computer software development in the field of process automation,</p>	
--	---	--

	business automation, business process automation, robotic process automation, and intelligent process automation; technical technology consulting services in the field of computer data management, computer data analytics, process automation, business automation, business process automation, robotic process automation, or intelligent process automation, all the aforementioned relating to computer and software technology	
NEUROBOTIK (Cited Mark) Owner: Xemory, LLC.	<u>Class 9</u> Electronic game software; Game software; Interactive game software; Computer software for providing entertainment in the nature of computer games and robot simulators; Computer software for use in robot simulator systems; Computer game software downloadable from a global computer network; Downloadable electronic game software for use on mobile and cellular phones, handheld computers, portable media players, and tablets; Educational software featuring instruction in robot controls	Registration No.: 4690156 Reg. Date: February 17, 2015

Determination under Trademark Act § 2(d) is based on the analysis of the probative facts that are relevant to the factors bearing on a likelihood of confusion. *In re E.I. DuPont DeNemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (“*DuPont* Factors”). Only the significantly relevant [*DuPont*] factors to the particular mark need be considered. *Id*; *see also Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1719 (Fed. Cir. 2012) (quoting *In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257, 1259 (Fed. Cir 2010)). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and/or services. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) (“The fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.”).

Applicant addresses each of the following relevant factors in turn below showing there is no likelihood of confusion: (1) the similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression, (2) the similarity or dissimilarity and nature of the goods as described in the application and cited registrations, and (3) similarity or dissimilarity of established, likely-to-continue trade channels. Applicant further submits that the law weighs against any finding of likelihood of confusion and the Examining Attorney bears the burden to show a finding of likelihood of confusion. *In re. St. Helena Hosp.*, 774 F.3d 747, 750, 113 USPQ2d 1082 (Fed. Cir. 2014) (citing 15 USC § 1052).

Based on the arguments and evidence presented below, Applicant respectfully contends that there is no likelihood of confusion between the Applied-for mark and the Cited mark. The marks are not sufficiently similar to find any likelihood of confusion. The respective goods/services of both the Applicant and the Cited mark owner are not related enough to warrant a finding of likelihood of

confusion. Additionally, the different trade channels viewed together with high consumer sophistication weigh against any finding of likelihood of confusion. Therefore, there is no likelihood of confusion between the Applied-for mark and the cited mark.

A. There is no likelihood of confusion because the marks are sufficiently different.

First, Applicant submits that the marks are sufficiently different in appearance, sound, connotation, and overall commercial impression that there is no likelihood of confusion between the Applied-for mark and the Cited mark.

The marks are compared in their entireties as to appearance, sound, connotation and commercial impression. *Palm Bay Imps. Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005) (quoting *DuPont*, 177 USPQ at 567). Use of ***identical, even dominant words in common does not automatically mean that two marks are confusingly similar***. See *General Mills, Inc. v. Kellgo Co.*, 824 F. 2d 622, 627 (8th Cir. 1987) (citing *Freedom Sav. & Loan Ass'n v. Way*, 757 F.2d 1176, 1183 (11th Cir. 1985)). In the words of the prominent trademark scholar J. McCarthy, “under the overall impression analysis, there is no rule that confusion is automatically likely if a junior user has a mark which contains in part the whole of another’s mark.” 3 J. McCarthy, *Trademarks and Unfair Competition* § 23:41 at 91 (4th ed.).

In the present case, the Applied-for mark “NEUROBOT” and the Cited mark “NEUROBOTIK” are different both in appearance and sound. Two marks contain different number of letters and different number of syllables. The Cited mark contains ten letters and appears much longer in length when perceived in comparison to the Applied-for mark. The additional “IK” at end of the Cited mark results not only an appearance distinction but also one additional syllable in pronunciation. In numerous cases, the TTAB Board has decided that ***confusion is not likely when two marks differ by one letter*** even when (*unlike here*) the sound is identical. See *In re Conti*, 1983 TTAB LEXIS 36 (TTAB 1983)(SHEER not likely to be confused with SHEAR); *In re Finetex Int'l (USA), Inc.*, 1997 TTAB LEXIS 431 (TTAB 1997) (FINETEX not likely to be confused with FINTEX); *In re Reach Elecs., Inc.*, 1972 TTAB LEXIS 203, (TTAB 1972)(REAC and REACH not likely to be confused); *In re Warren Petroleum Corp.*, 1976 TTAB LEXIS 90, (TTAB 1976)(EXTRA not likely to be confused with XTRA). Here, the marks differ by more than one letter as to appearance and are phonetically different with different number of syllables, therefore confusion between the two marks is not likely.

In addition, two marks convey different connotations and commercial impressions which they create. The Cited mark is most likely to be perceived as “Neu Robotiks” by consumers. “Robotiks” a play on the word “robotics” is defined as: (1) the use of computer-controlled ***robots*** to perform manual tasks, especially on an assembly line (dictionary.com); and (2) technology dealing with the design,

construction, and operation of *robots* (merriam-webster.com). And “robot” *conveys a very specific connotation* and is defined as: (1) a *machine or mechanical device* that resembles a human and does mechanical, routine tasks on command (dictionary.com); and (2) a *machine* that resembles a living creature in being capable of moving independently (merriam-webster.com). (See Attachment A) The Cited mark when perceived implies the association to robotics and conveys a very specific connotation and commercial impression of a physical robot. A search in fact shows that the associated goods of the Cited mark is a simulation game specifically for kids to design robots. (Attachment B)

In contrast, the Applied-for mark conveys different connotation and commercial impression, applying to an entirely different industry of goods. The Applied-for mark is most likely to be perceived as “Neuro Bot.” Term “Bot” refers to any software or computer program in general capable of performing automated tasks, and is defined as: (1) a *computer program* that perform automatic repetitive tasks (merriam-webster dictionary); and (2) a *computer program* that runs automated tasks over the internet (oxford dictionary online). While term “Neuro” implying association to nerves or brain is defined as: (1) connected with the nerves (oxford dictionary online). (Attachment C) When applied to Applicant’s goods (provided in the table above) – software involving advanced technology such as machine learning and artificial intelligence, the Applied-for mark conveys a completely different connotation of computer software applying to an entirely different industry of goods. (Attachment D)

Even marks that are identical in sound and/or appearance (*unlike here*) may create sufficiently different commercial impressions when applied to the respective parties’ goods or services so that there is no likelihood of confusion. *See, e.g., In re Sears, Roebuck & Co.*, 2 USPQ2d 1312, 1314 (TTAB 1987) (holding CROSS-OVER for bras and CROSSOVER for ladies’ sportswear not likely to cause confusion, noting that the term "CROSS-OVER" was suggestive of the construction of applicant’s bras, whereas "CROSSOVER," as applied to registrant’s goods, was "likely to be perceived by purchasers either as an entirely arbitrary designation, or as being suggestive of sportswear which "crosses over" the line between informal and more formal wear . . . or the line between two seasons"); *In re British Bulldog, Ltd.*, 224 USPQ 854, 856 (TTAB 1984) (holding PLAYERS for men’s underwear and PLAYERS for shoes not likely to cause confusion, agreeing with applicant's argument that the term "PLAYERS" implies a fit, style, color, and durability suitable for outdoor activities when applied to shoes, but ""implies something else, primarily indoors in nature" when applied to men’s underwear); *In re Sydel Lingerie Co.*, 197 USPQ 629, 630 (TTAB 1977) (holding BOTTOMS UP for ladies’ and children’s underwear and BOTTOMS UP for men’s clothing not likely to cause confusion, noting that the wording connotes the drinking phrase "Drink Up" when applied to men’s clothing, but does not have this connotation when applied to ladies’ and children’s underwear). Here, the Cited mark conveys a very specific association to robots while the Applied-for mark implies computer software. Two marks convey at the very least sufficiently different

connotations and commercial impressions when applied to their respective industry of goods, therefore confusion is unlikely.

Further on this note, Examiner asserts that because the marks are identical in part, they are likely to engender the same connotation and overall commercial impression. Caselaw has decided on this very point - the use of *identical, even dominant words in common does not automatically mean that two marks are confusingly similar*. See *General Mills, Inc. v. Kellgo Co.*, 824 F. 2d 622, 627 (8th Cir. 1987) (citing *Freedom Sav. & Loan Ass'n v. Way*, 757 F.2d 1176, 1183 (11th Cir. 1985)). In the words of the prominent trademark scholar J. McCarthy, “under the overall impression analysis, there is no rule that confusion is automatically likely if a junior user has a mark which contains in part the whole of another’s mark.” 3 J. McCarthy, *Trademarks and Unfair Competition* § 23:41 at 91 (4th ed.). Here, the Applied-for mark and the Cited mark are sufficiently different in appearance and sound as well as the connotation and the commercial impression which they create when applied to the respective goods and services. Therefore, confusion is unlikely. The Board has deceived in many cases that marks with identical parts or the whole of another’s mark to be not confusingly similar and unlikely to cause confusion. To list a few, some examples are provided below:

	MARKS	Class of Goods and Services	Serial or Registration Number
1	SLIM v. SLIMDIP	SLIM - 009 SLIMDIP - 009	Reg. No. 3581787 Reg. No. 5357408
2	PAPER v. PAPER BY FIFTYTHREE	PAPER - 009 PAPER BY FIFTYTHREE - 009	Reg. No. 5268647 Reg. No. 4457350
3	OBSERVANT v. OBSERVANT OWL	OBSERVANT – 009 & 042 OBSERVANT OWL - 009	Reg. No. 4398801 Reg. No. 5032163
4	ALICE v. KATIE ALICE	ALICE - 009 KATIE ALICE – 8, 9, 16, 21, 24, 35, 43	Reg. No. 85924540 Reg. No. 4516830
5	ARTEMIS v. ARTEMIS HEALTH	ARTEMIS – 09 & 042 ARTEMIS HEALTH - 042	Serial No. 87042698 Reg. No. 5037107
6	MISTORE v. MYSTORE XPRESS	MISTORE - 009 MYSTORE XPRESS - 009	Reg. No. 4774971 Reg. No. 3630524
7	PILOT v. PILOT PLUS	PILOT – 35, 36, 39 PILOT PLUS - 009	Reg. No. 4003615 Serial No. 86642536
8	SYNTHON v. SYNTHEON	SYNTHON – 5, 35, 40, 45 SYNTHEON – 40 & 42	Reg. No. 5923742 Reg. No. 3625206
9	FRANCY v. FRANCIEPANTS	FRANCY – 25 FRANCIEPANTS - 25	Reg. No. 4466618 Reg. No. 5870769
10	CROSSOVER v. CROSS-OVER	CROSSOVER – 25 CROSS-OVER - 25	Reg. No. 1262476 Reg. No. 502919

Based on the above analysis, the two marks, when compared both in their entirety and individual portions, differ in appearance and sound, and create at least sufficiently, if not completely, different connotation and commercial impressions. See *In Re Sears, Roebuck & Co.*, 2 U.S.P.Q.2d 1312 (TTAB

Feb. 27, 1987) (“the two marks create different commercial impressions, notwithstanding the fact that they are legally identical in sound and appearance”); *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1368 (Fed. Cir. 2012) (“Here, the [TTAB] Board found that, although the marks are identical in terms of sight and sound, they differ as to connotation and commercial impression.”). Therefore, a comparison of the marks indicates there is no likelihood of confusion.

B. There is no likelihood of confusion because Applicant’s goods and services are sufficiently different from the goods and services of the cited application.

Next, Applicant submits that the respective goods and services associated with both marks are sufficiently different that there is no likelihood of confusion between the two marks. Examiner asserts that Applicant’s and Registrant’s goods/services are legally identical. Applicant has amended the identified goods and services as recommended by the Examiner.

Evaluating likelihood of confusion involves considering the similarity or dissimilarity of the goods and services, and one looks to the identifications in Applicant’s application and the cited application. *DuPont*, 177 USPQ at 567; *see also In re Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1052 (Fed. Cir. 2018); *Stone Lion Capital Partners v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014);

More specifically, in evaluating this particular *DuPont* factor, the analysis considers whether the consuming public may perceive [the respective goods and services of the parties] as related enough to cause confusion about the source or origin of the goods and services.” *Hewlett Packard Co. v. Packard Press, Inc.*, 281 F.2d 1261, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002) (citing *Recot, Inc. v. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1898 (Fed. Cir. 2000)). Central issue of determining whether goods or services sufficiently related is there is ***likely to be sufficient overlap of the respective purchasers*** of the parties’ goods and services to confuse actual and potential purchasers. *Electronic Design & Sales, Inc. v. Electronic Data Sys. Corp.*, 954 F.2d 713, 716 (Fed. Cir. 1992).

Here, there is no sufficient overlap of the respective purchasers of both goods because the goods are not sufficiently related and the target audiences are different, therefore the consuming public will not perceive the respective goods to be related enough to cause confusion about their source or origin.

Based on the registration of the Cited mark, the associated goods of the Cited mark are electronic game software. A search of limited available information shows the goods are **“a game that allows kids to design and perfect robot brains** by simulating evolution.” (Attachment B) The Cited mark’s goods is kids computer game software for entertainment purpose of designing robots. The respective purchasers of the Cited mark’s associated goods are mostly kids and kids’ parents.

In contrast, goods and services identified on Applicant’s application, in sum, are (Class 9) “downloadable computer software for use in process automation, business automation, business process

automation, robotic process automation, and intelligent process automation” across various industries and fields, and (Class 42) “Software as a service (SaaS) or platform as a service (PaaS) for use in process automation, business automation, business process automation, robotic process automation, and intelligent process automation” across various industries and fields. As shown on Applicant’s website, the Neurobots product line are “a series of intelligent process automation (IPA) tools” providing advanced artificial intelligence and machine learning technology to “*automate business tasks*” and “*enable enterprise customers* to quickly and cost-effectively deploy powerful RPA bots...” Applicant’s website further states “We believe AI technology must be *accessible to all companies of all sizes across different industries to achieve better business results.*” (Attachment D) Applicant’s goods are to serve industrial business needs across various industry sectors, and the respective purchasers industry players, enterprises, and companies of all sizes across various industry sectors.

Numerous decisions of the TTAB Board have found that no likelihood of confusion for identical or substantially similar marks that are used for readily distinguishable goods or services, even when the goods or services fall within the same general field. *See In re Donnay Int’l*, 31 USPQ 2d 1953, 1955 (TTAB 1994) (finding no confusion as between the marks GHOST for tennis equipment and THE GHOST for soccer equipment reasoning, that “militating in favor of finding of no likelihood of confusion, are the differences in the goods”); *See also Local Trademarks Inc. v. the Handy Boys Inc.*, 16 USPQ 2d 1156, 1158 (TTAB 1990) (finding LITTLE PLUMBER for liquid drain opener held not confusingly similar to LITTLE PLUMBER and Design for advertising services in the plumbing field). If the goods and services are not related or marketed in such a way that they would be encountered by the same person in situations that would create the incorrect assumption that they originate from the same source, then, even if the marks are identical (*unlike here*), confusion is not likely. *See e.g. Local Trademarks, Inc. v. Handy Boys, Inc.*, 16 USPQ 2d 1156 (TTAB 1990).

Software is a broad general field that involves various sectors and industries. For two goods both being software is far from remotely indicating that these goods are related and even more, confusingly similar. Applicant’s goods serve industrial business needs across various industry sectors, with the respective purchasers being enterprises and companies of all sizes, while goods of the Cited mark are kids computer game software designed for entertainment. There is no overlap of the respective purchasers at all and the goods are inherently too different for the consuming public to confuse about the origin of the source. Therefore, comparison of the goods and services indicates there is no likelihood of confusion.

C. There is no likelihood of confusion because the respective goods of both marks are likely to be purchased by highly sophisticated purchasers.

Furthermore, Applicant submits that at least Applicant's goods and services are to be purchased by sophisticated consumers after careful consideration that there is no likelihood of confusion.

Purchaser sophistication or degree of care may tend to minimize likelihood of confusion, and circumstances suggesting care in purchasing may tend to minimize the likelihood of confusion. *See, e.g., In re N.A.D., Inc.*, 754 F.2d 996, 999-1000, 224 USPQ 969, 971 (Fed. Cir. 1985) (concluding that, because only sophisticated purchasers exercising great care would purchase the relevant goods, there would be no likelihood of confusion merely because of the similarity between the marks NARCO and NARKOMED); *Primrose Ret. Cmty., LLC v. Edward Rose Senior Living, LLC*, 122 USPQ2d 1030, 1039 (TTAB 2016) (finding that, "even in the case of the least sophisticated purchaser, a decision as important as choosing a senior living community will be made with some thought and research, even when made hastily"); *In re Homeland Vinyl Prods., Inc.*, 81 USPQ2d 1378, 1380, 1383 (TTAB 2006).

In the present case, the prospective ***purchasers of Applicant's goods are those that are highly sophisticated and likely to apply a high degree of care in purchasing.*** Professional consumers are likely to apply a high degree of care and their professional training and knowledge when shopping for the parties' respective goods. *See CMM Cable Rep., Inc. v. Ocean Coast Properties, Inc.*, 888 F. Supp. 192, 36 USPQ2d 1458 (D. Me. 1995), order aff'd, 97 F.3d 1504, 41 USPQ2d 1065 (1st Cir. 1996) (Informed professional buyers "are less likely to be confused as to the source or origin of a product than ordinary consumers of inexpensive foods or services."); *see also Clayton Mark & Co. v. Westinghouse Electric Corp.*, 356 F.2d 943 (C.C.P.A. 1966) (finding purchasers of industrial circuit breakers unlikely to be confused, as they would be sophisticated purchasers who are likely to know what they are buying, why they are buying it, and who is producing the product). As previously mentioned, Applicant's prospective purchasers are industry players, enterprises and companies across various industry sectors. Further, due to the nature of Applicant's goods, the prospective purchasers are those looking to fulfill the specific enterprise / business operational need of specific industry. Applicant's goods involving the advanced state of the art, artificial intelligence and machine learning technology require purchasers and consumer to possess at the very least some training and knowledge of the technology. Therefore, the prospective purchasers of Applicant's goods are those that are highly sophisticated and likely to apply a high degree of care in purchasing.

Furthermore, ***Applicant's goods are the type that would be selected with great care*** because of goods' price, specific functions, and the transaction process. Previously mentioned, Applicant's goods incorporate advanced state of the art machine learning and artificial intelligence technology serving industrial / enterprise needs across multiple industry sectors. Applicant's goods are charged monthly or yearly at a price ranging typically between 5 to 6 figures depending on consumers' specific needs. It is well established that "confusion is less likely where goods are expensive than where they are purchased casually", as consumers will use careful consideration before buying a product. *Magnaflux Corp. v. Sonoflux*

Corp., 231 F.2d 669, 109 USPQ 313 (C.C.P.A. 1956). Involving highly advanced state of the art, Applicant's goods incorporating artificial intelligence and machine learning technology require the enterprise consumers and prospective purchasers to possess at least a fundamental degree of knowledge and skills of the technology. Lastly, the transaction process of Applicant's goods is reasonably extensive and involves communication and in-depth and personalized sales process. They are sold directly by Applicant's enterprise sales team, system integrators, and/or software distributors. The products can be customized to tailored to meet individual consumers' needs, and the transaction process involve extensive contact and communication between potential consumers. The sales team must possess and inform potential consumers with in-depth and personalized knowledge of Applicant's goods during the transaction process. Based on factors including Applicant's goods price, their specific purposes, and the transaction process, prospective purchasers are those with high sophistication and would apply a high degree of care during purchasing. In sum for all of the reasons noted here, confusion is unlikely.

In light of the arguments presented and supporting documents enclosed, there is no likelihood of confusion between the two marks.

Conclusion

Applicant believes that the application now is in condition for allowance and respectfully requests forwarding of the application for publication for the purpose of opposition. The Examining Attorney is encouraged to telephone the undersigned if a telephonic interview would be helpful to a prompt publication of the application.

Respectfully Submitted,

/Linna Chen/

Linna Chen
Magstone Law, LLP
4633 Old Ironsides Drive, Suite 160
Santa Clara, CA 95054
(650) 513-2555 ext.106
lchen@magstonelaw.com