

Office Action Response
Mark: PEBBLE
App. No. 88489689

Introduction

The Examining Attorney has initially refused registration under Section 2(d) based upon the following mark: “PEBBLES” (Reg. No. 5,753,143), issued for “providing a website featuring temporary use of non-downloadable software that allows users to create custom computer programs; and computer software development.”

In response, Applicant submits that there is no reasonable likelihood of confusion between Applicant’s mark and the cited mark based upon:

- (1) Several third-party marks containing the word “Pebble” registered for software products, including the cited mark, co-exist;
- (2) Applicant’s mark has a unique meaning compared to the cited mark: the word “Pebble” in Applicant’s mark plays on the meaning of the word “Pebble” as a small stone on the surface of a road, calling to the mind the small occupancy sensor placed in the road that will be used with Applicant’s software, while the word does not have that alternative meaning in the cited mark;
- (3) the respective goods and services are extremely different: there are stark differences between the respective goods and services and the trade channels therefor; and
- (4) the relevant purchasers are likely to be sophisticated: the purchasers for Applicant’s products and services are likely to be sophisticated.

As an initial matter, “one of the policies sought to be implemented by the [Trademark] Act [is] to **encourage** the presence on the Register of Trademarks of as many as possible of the marks in actual use so that they are available for search purposes.” Bongrain Int’l v. Delice de France, 811 F.2d 1479, 1485 (Fed. Cir. 1987) (emphasis added). “Moreover, the registration scheme of the Trademark Act is one more inclined to inclusion than exclusion, the obvious idea being to give as comprehensive a notice as possible, to those engaged in commerce, of the trademarks and service marks in which others have claimed rights.” In re Old Glory, 26 U.S.P.Q. 1216, 1220 n.3 (T.T.A.B. 1993). For these reasons, applications for registration are liberally construed and marks actually in use should be registered absent a “**clear violation**” of the statute. Bongrain, 811 F.2d at 1485 (emphasis added).

For these reasons and the reasons set forth below in more detail, the refusal of Applicant’s mark is not supported by the record and would be counter to the policies stated above.

Numerous Third-Party Marks Registered for Software and Containing the Word “Pebble” Co-Exist with the Cited Registration

The Examining Attorney concludes very broadly that confusion is likely because both parties offer software products and services, in general, and some of the largest computer software companies in the world offer similar services.

However, there are several third-party marks that contain the word “Pebble” in connection with software that presently co-exist with the registrant’s mark.

Applicant's independent search of the records of the U.S. Patent and Trademark Office revealed the following additional marks comprising the term "Pebble" for products and services that are no more or less similar to the goods and services of Applicant than the products/services identified in the cited registration.

- **PEBBLE**, Reg. No. 4,662,987, for software for the development of watchapps and wearable digital electronic devices comprised primarily of software and display screens.
- **PEBBLEPOST**, Reg. No. 4,892,683, for software as a service (SAAS) services featuring software for use in tracking and analyzing online activity for use in the development and implementation of targeted marketing campaigns.
- **PEBBLE BEACH**, Reg. No. 1,791,043, for computer game software programs and video game software programs.

Printouts of these registrations are included with this Response.

Accordingly, the Trademark Office has a standing practice of allowing “Pebble” marks to co-exist for software products and services when there are meaningful differences between the nature and purpose of the software, as is the case here.

The **PEBBLE** mark for software for the development of watchapps (which was registered prior to the cited mark) is a prime example of another mark that includes the word “Pebble” and identifies software and co-exists with the cited registration. The application for the cited mark was filed on June 8, 2018, and it proceeded to registration without any objection from the Trademark Office or the owners of the **PEBBLE** registration, Reg. No. 4,662,987, even though the marks are nearly identical and the goods/services both include software, broadly. Obviously, the examiner for the application of the cited mark did not believe that a different software product (for the development of watchapps) was likely to create confusion with a proposed software product for creating computer programs. Similarly, Applicant’s proposed occupancy sensors and software for wireless occupancy sensors for detecting and communicating data related to parking, driving, curb space, and other vehicle characteristics is not likely to create confusion with the cited mark that identifies a software product for creating computer programs.

In view of these coexisting marks, it is clear that the mere fact that Applicant's mark and the cited mark contain the term “Pebble” does not mandate a finding of likelihood of confusion or even suggest that there is any conceivable likelihood of confusion.

Applicant's "Pebble" Mark Has a Unique Meaning Compared to the Cited Mark and This Unique Meaning Obviates Consumer Confusion

"Pebble" can be defined to mean "a small usually rounded stone" or "an irregular, crinkled, or grainy surface." See attached dictionary definition. These meanings are relevant to Applicant's "Pebble" trademark. More specifically, as used in Applicant's mark, the small stone meaning calls to mind a small parking sensor placed in the road that will be used with the complementary software product. The grainy surface additionally calls to mind a surface on which an individual may park a car.

The word "Pebbles" in the cited mark does not appear to have any relevance to parking, stones, or surfaces, because it is simply a software product that allows for consumers to create computer programs. In other words, the cited mark does not similarly play on the multiple relevant meanings of the word "Pebble."

It is well established that in making a comparison of the degrees of identity between the marks at issue, the marks are to be compared with respect to similarity of pronunciation, appearance and verbal translation, *i.e.*, the "sight, sound and meaning trilogy." J.T. McCarthy, McCarthy on Trademarks and Unfair Competition, § 23:21.

With respect to such a comparison, based upon the explanation above, Applicant respectfully disagrees with the Examining Attorney's conclusions the marks are similar just because they share the word "Pebble." To the contrary, the marks have clearly different meanings when Applicant's mark is properly viewed in its entirety. This meaning will be readily apparent to consumers because consumers of Applicant's "Pebble" products and services will be primarily municipalities and others likely to purchase occupancy sensors and software products to facilitate greater efficiency in parking.

Moreover, as set forth in the T.M.E.P. § 1207.01(b)(vi)(C):

Similarity of the marks in one respect – sight, sound, or meaning – does not automatically result in a finding of likelihood of confusion even if the goods are identical or closely related; rather, the rule is that, taking into account all of the relevant facts of a particular case, similarity as to one factor alone may be sufficient to support a holding that the marks are confusingly similar. See In re Thor Tech, Inc., 90 USPQ2d 1634, 1635 (TTAB 2009); In re White Swan Ltd., 8 USPQ2d 1534, 1535 (TTAB 1988); TMEP §1207.01(b)(i).

And as stated more specifically in T.M.E.P. § 1207.01(b)(v) regarding the similarity of **meaning** of marks:

The meaning or connotation of a mark **must be determined in relation to the named goods or services**. 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**. 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).

(emphasis added).

The situation here is nearly identical to the situations addressed in the cases cited above. The meaning of Applicant's "Pebble" mark is entirely different for its occupancy sensors and software used for parking sensors than the software for creating computer programs identified in the cited mark. T.M.E.P. § 1207.01(b)(v).

In sum, given the stark differences in meaning of the respective marks, Applicant submits that there is no likelihood of confusion between Applicant's mark and the cited mark.

The Respective Goods and Services Are Distinct and Are Likely to Be Offered through Starkly Different Trade Channels

Applicant's occupancy sensors and software is designed specifically for parking applications, as described in Applicant's application. The registrant's software products, on the other hand, are provided in connection with creating computer programs. Accordingly, the goods/services identified in the respective application and the cited registration are very different. This becomes abundantly clear when one studies the specific nature and purpose of the goods and services identified in the respective application and the cited registration, in addition to the different trade channels and purchasers for the respective goods and services.

Likelihood of confusion in Trademark Office proceedings is determined by examining the marks **as applied to the goods and services as stated in the application and registrations involved.** Alberto Culver Co. v. F.D.C. Wholesale Corp., 16 U.S.P.Q.2d 1597, 1602 (T.T.A.B. 1990). Here, the goods and services in the cited registration and application are vastly different.

While the registrant's goods and the Applicant's goods and services are each *related* to software, very broadly, there is actually no commercial relationship whatsoever between Applicant's goods and services and the registrant's goods.

The Examining Attorney's citation to companies allegedly providing software of the type offered by Applicant and registrant is also inaccurate. These references were apparently located through searching the terms "software" and "sensor(s)," but the sensors discussed at the cited third party websites have no actual relationship to the sensors that are identified in Applicant's application. For example, the product described at <https://www.microstrain.com/software#web> is described in the following manner: "SensorCloud allows you to upload unlimited amounts of Wireless data to view and analyze from anywhere in the world." Similarly, the software described at <https://www.bsquare.com/products-and-services/iot-software-services/> has absolutely no relationship to Applicant's occupancy sensor products and services.

Similarly, the Examining Attorney cites the fact that a company like Microsoft offers both software related to creating computer programs as well as software related to wireless sensors. This fact does not weigh in favor of finding a likelihood of confusion, as the technology giant Microsoft also offers computer game software, tracking software, and software related to digital electronic devices, in other words, the software covered by the three **PEBBLE** registrations cited above. Microsoft is perhaps the largest software company in the world and its offerings are not remotely representative of what may be common in either the computer programming industry or sensor technology industries. If the Examining Attorney's conclusion regarding the alleged relationship between the Applicant's goods and services and the goods in the cited registration was accurate, there would be many more companies than the three referenced in the Office Action that offer both types of products – two of which do not even offer products or services remotely related to those of Applicant.

Even if the respective products were sold under the same mark by the same companies, they would still be sold to an entirely different class of purchasers.

In sum, the fact that one or two companies may provide the respective products and services under the same house mark does not support the Examining Attorney's conclusion that the "same entity **commonly** provides the relevant services and markets the relevant services under the same mark" (emphasis added). There is nothing "common" about the companies cited and the Examining Attorney has not cited any other evidence showing a real commercial relationship between the respective products.

Put simply, there is almost no setting in which a likely purchaser would encounter the respective goods/services in the same trade channels, because Applicant's products and services goods are occupancy sensor hardware and software that will be offered to municipalities and other organizations to facilitate greater efficiency with parking and urban planning. These same purchasers would not have a need for software related to creating computer programs within the urban planning industry, in general. Because an examining Attorney is bound by the description of the goods/services in the application/registrations at issue when evaluating similarity and relatedness of the goods/services, it is evident that Applicant's goods and services are clearly distinguishable and offered only in a very specific and narrow industry. See Stone Lion Capital Partners, LP v. Lion Capital LLP, 746, F.3d 1317, 1323 (Fed. Cir. 2014) (quotations omitted).

Moreover, even if the respective goods/services were to be encountered by different persons in the same industry, such a fact would not necessarily weigh in favor of a finding of likelihood of

confusion. See Electronic Design & Sales, Inc. v. Electronic Data Systems Corp., 21 U.S.P.Q.2d 1388 (Fed. Cir. 1992) (reversing the decision of the T.T.A.B. sustaining the opposition to registration of "E.D.S." for battery chargers and power supplies and "EDS" for computer services).

The Court in Electronic Design & Sales stated:

[T]he essential inquiry . . . is whether there is likely to be sufficient overlap of the respective purchasers of the parties' goods and services to confuse actual and potential purchasers.

* * * * *

[A]lthough the two parties conduct business not only in the same fields but also with some of the same companies, the mere purchase of the goods and services of both parties by the same institution does not, by itself, establish similarity of trade channels or overlap of customers . . . the likelihood of confusion must be shown to exist not in a purchasing institution, but in a 'customer or purchaser'.

Id. at 1390-91 (emphasis added). See also D&H Distributing Co. v. Designhouse Int'l, Inc., 211 U.S.P.Q. 662 (T.T.A.B. 1981).

Use of even the same mark does not result in a likelihood of confusion where, as here, there are commercially significant differences between the respective goods/services and the channels of trade. See Checkpoint Sys., Inc. v. Check Point Software Tech., Ltd., 269 F.3d 270, 282 (3d Cir. 2001) ("Checkpoint" mark for computer security not confusingly similar to "Checkpoint" mark for physical security products). This is the case even where the marks at issue are used in connection with products and services in the **same industry**. See Astra Pharm. Prods. v. Beckman Instruments, 718 F.2d 1201, 220 U.S.P.Q. 786 (1st Cir. 1983) (no likelihood of confusion between identical "Astra" marks on different medical products sold to the very same hospitals given differences between goods (blood analyzers versus syringes); In re Fesco, Inc., 219 U.S.P.Q. 437 (T.T.A.B. 1983) ("Fesco" for distributorship services for farm equipment not confusingly similar to "Fesco" for fertilizer, oil mill, crushed stone, clay, coal, concrete block and foundry processing equipment and machinery).

Any alleged relationship between Applicant's wireless occupancy sensors and related software and the cited registrant's software for creating computer programs is conceptual, at best. There is no reasonable likelihood of confusion between the marks in view of the stark differences between the goods/services provided under the marks and the fact that it would be extremely unlikely for a purchaser to encounter the respective goods and services under circumstances that would give rise to confusion between the marks.

The Sophistication of the Likely Purchasers for the Products Also Precludes Confusion

Consumer sophistication and purchaser care are also relevant to a determination of likelihood of confusion with respect to Applicant's mark and the cited mark. See In re Research and Trading Corp., 230 U.S.P.Q. 49, 50 (Fed. Cir. 1986).

The purchasers of Applicant's products are likely to be sophisticated – Applicant's sensors and software are not the type of products or services that would be purchased by general consumers.

For Applicant's products and services, the purchasers will be sophisticated and large municipalities and organizations involved with urban planning. In Calypso Technology, Inc. v. Calypso Capital Management, LP, 100 U.S.P.Q.2d 1213 (TTAB 2011), the Board found that financial institutions would be unlikely to be confused over similar marks offering financial services versus software targeted to the financial industry, because financial institutions are likely to be careful, sophisticated consumers that would take great care in searching out and evaluating the cost and purpose of the software products. Similarly, municipalities and organizations involved with urban planning would be investing substantial sums of money in Applicant's occupancy sensors and software products and would need to ensure that the sensors and software will be compatible with both existing technological systems and any applicable regulatory requirements. For Applicant's products and services, they are likely to be purchased only after deliberation by knowledgeable persons looking for specific product applications.

Accordingly, it is not likely that persons would mistakenly confuse Applicant's "Pebble" sensors and software for parking and the different software identified in the cited registration – even if such products and services are offered under a similar name.

Conclusion

The trademark laws seek to prevent likelihood of confusion, not remote possibilities of confusion based on speculation and supposition. See In re Chalet Chocolates, Inc., 212 U.S.P.Q. 968, 969 (T.T.A.B. 1982). A conclusion that there exists a likelihood of confusion between Applicant's mark and the mark of the cited registration would be speculative and not supported by the record whatsoever.

For the reasons stated herein, Applicant respectfully requests that the Examining Attorney withdraw the cited registration as a bar to registration and allow Applicant's mark to proceed to publication.