

Mark: SMARTSCORE
Application No.: 88/577,232
Attorney Docket No.: SST-00003TM09
Office Action Dated: November 15, 2019

REMARKS:

In response to the communication mailed November 15, 2019, please enter this Amendment and reconsider this application in view of the amendments and the remarks provided herein.

A. Indefinite Identification of the Goods - Applicant expresses appreciation for the guidance in the Office Action regarding Applicant's identification of goods. Applicant has amended the identification of the goods patterned after the suggestions made in the Office Action and to reflect terminology used in the marketplace, to be acceptably definite, and to satisfy the requirements raised in the Office Action. Thus, no further action by Applicant is believed necessary regarding the identification of the goods for this application.


B. Alleged Likelihood of Confusion Under Section 2(d) Between the Applied for SMARTSCORE Mark and the Marks in U.S. Registration Nos. 4642330, 4642331, 3333997, 4514575 and 4510938 – The Office Action raises an issue of alleged likelihood of confusion with U.S. Registration Nos. 4642330, 4642331, 3333997, 4514575 and 4510938. Applicant respectfully submits that the current amended application is allowable over such registrations.

The case of *E.I du Pont de Nemours & Co.*, 476 F.2d 1357, 177 U.S.P.Q. 563 (C.C.P.A. 1973) relied upon in the Office Action, provides guidance in making a likelihood of confusion determination. While "there is no litmus rule which can provide a ready guide to all cases" of determining likelihood of confusion (177 U.S.P.Q. at 567), the *du Pont* case provides a list of evidentiary elements to be considered in an analysis under Section 2(d). Importantly, one or more evidentiary elements may, from case to case, play a dominant role with no particular evidentiary element always having merit greater than the others. Examination of the pertinent factors from "*du Pont* with the applicable facts present here lead to a conclusion that there is no likelihood of confusion between the cited registrations and the mark set forth in the present application.

One factor to be considered in a Section 2(d) analysis is the "similarity or dissimilarity and nature of the goods or services as described in an application or registration." (*Id.*) Applicant respectfully submits that, as amended, the present identification of goods indicates there are differences between the respective goods of the present application and those of the cited registrations. These differences support a conclusion that there is no likelihood of confusion in the present case.

In the present case, the identified goods in the present application, as amended, are in international class 9 and are defined as "Downloadable software for use in tracking analytics and metrics in the field of mental health and well-being; Downloadable software for tracking analytics and metrics relating to confidence, energy, mood, self-esteem, stress, eating habits, physical activity, sleep, socialization, and planned activities."

The cited registrations are all in international class 9 and do not identify these same goods in this application. Instead, they identify goods in class 9 as follows:

- a. SmartScore NoteReader
U.S. Registration No. 4,642,330
Registration Date: November 18, 2014
Class 9 – Computer application software for mobile phones, portable media players, tablets, and portable computers, namely, software for optical scanning, recognizing and playback of printed music
Owner: Musitek
- b. 
U.S. Registration No. 4,642,331
Registration Date: November 18, 2014
Class 9 – Computer application software for mobile phones, portable media players, tablets, and portable computers, namely, software for optical scanning, recognizing and playback of printed music
Owner: Musitek
- c. SMARTSCORE
U.S. Registration No. 3,333,997
Registration Date: November 13, 2007
Class 9 – computer [hardware and] software for collecting, managing and reporting data regarding process equipment leaks
Owner: Orr Corporation
- d. SmartScore
U.S. Registration No. 4,514,575
Registration Date: April 15, 2014
Class 9 – Computer programs for audio and optical scanning, recognizing, performing, recording, transposing, and editing musical scores, musical notes, and sheet music
Owner: Musitek
- e. SMARTSCORE
U.S. Registration No. 4,510,938
Registration Date: April 8, 2014
Class 9 – Medical software for reviewing, analyzing and monitoring images obtained from CT scanners
Owner: General Electric Company

Thus, Applicant respectfully submits the differences between the amended identification of goods and the goods cited in the prior registrations strongly supports a conclusion that there is no

likelihood of confusion.

Further, another factor to be considered under a proper analysis is the "number and nature of similar marks in use on similar goods." *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973). As explained at TMEP 1207.01(d)(iii), active third-party registrations may be relevant to show that a portion of a mark is commonly used, and the public will look to other elements to distinguish the source of the goods or services. *See, e.g., In re i.am.symbolic, llc*, 866 F.3d 1315, 123 USPQ2d 1744 (Fed. Cir. 2017); *Jack Wolfskin Ausrustung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129 (Fed. Cir. 2015); *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 1338-40, 115 USPQ2d 1671, 1674-75 (Fed. Cir. 2015); *Primrose Ret. Cmtys., LLC v. Edward Rose Senior Living, LLC*, 122 USPQ2d 1030, 1036 (TTAB 2016); *In re Hartz Hotel Servs., Inc.*, 102 USPQ2d 1150, 1153-54 (TTAB 2012); *In re Melville Corp.*, 18 USPQ2d 1386, 1388 (TTAB 1991); *In re Dayco Products-Eagle Motive Inc.*, 9 USPQ2d 1910, 1911-12 (TTAB 1988); *Plus Prods. v. Star-Kist Foods, Inc.*, 220 USPQ 541, 544 (TTAB 1983).

In the present case, U.S. Registration Nos. 4642330, 4642331, 3333997, 4514575 and 4510938 have all co-existed without confusion in the marketplace as consumers are already used to distinguishing between them. Additionally, the marks and class 9 goods of U.S. Registration Nos. 4642330, 4642331, 3333997, 4514575 and 4510938 are more similar to one another than as to the mark of this application which further supports a conclusion that there is no likelihood of confusion with the mark of the present application.

CONCLUSION

For the above reasons, Applicant submits that there is no likelihood of confusion and the 2(d) refusal should be withdrawn. Applicant respectfully submits that registration on the Principal Register is appropriate. If any impediment to passing this mark onto publication remains after entry of this Amendment and consideration of these remarks, the Examining Attorney is invited to initiate a telephone interview with the attorney of record.