

UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO. 88326319

MARK: FLIGHTDECK

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APPLICANT: Synthesis Technology Corp.

RESPONSE TO OFFICE ACTION
DATED DECEMBER 9, 2019

Applicant Synthesis Technology Corp. ("Applicant") files this response to the Office Action dated December 9, 2019 ("Office Action").

The Office Action refused registration of the mark FLIGHTDECK because of the likelihood of confusion with the mark U.S. Registration No. 5810025, registered to Leidos Innovations Technology, Inc. ("Registrant"). For the reasons set forth in this response, Applicant requests that the Examiner withdraw the refusal and approve application Serial No. 88326319.

Since it was developed in 2011, Applicant has marketed and sold FLIGHTDECK as a sales and marketing software tool for asset managers to create custom and regulatory compliant presentations for their pitchbooks and other sales and marketing content that can be automatically updated with the latest data. Applicant focuses its sales to financial services organizations, asset and wealth managers, retirement plan providers, and private banks. See Exhibit A, Toepfer Declaration ¶¶ 3-5. Applicant filed for the mark on March 5, 2019 in International Class 042 for "application service provider (ASP) featuring software for use by sales and marketing teams in regulated industries to manage, customize, download, and distribute marketing and sales materials." The specimen attached to the application includes a page from Applicant's FLIGHTDECK brochure, showing an end-to-end flow chart. A copy of the specimen is attached to this Response as Exhibit B. On December 9, 2019, Applicant received the Office Action that is the subject of this response.

Registrant's mark is in a different International Class (i.e., 009) for "Downloadable middleware for software application integration." Leidos Innovation Technology, Inc. is controlled by Leidos Holdings, Inc. Leidos provides services and solutions in the defense, intelligence, civil, and health markets. See Exhibit C, Leidos Form 10-K at 1. Its clients in the United States include the U.S. Department of Defense, U.S. Intelligence Community, U.S. Department of Homeland Security, Federal Aviation Administration, Department of Veterans Affairs, and other governmental agencies. Leidos generated 87 percent of its fiscal 2019 revenues from U.S. government contracts. Exhibit C, 10-K at 1. Also available at <https://www.sec.gov/ix?doc=/Archives/edgar/data/1336920/000133692020000023/ldos01032020form10-k.htm>. The limited nature of the use of Registrant's mark to this highly sophisticated market was

confirmed by Registrant in response to a request for information by the Examining Attorney in its Office Action dated April 20, 2018. (See Exhibit D to this Response.) <http://tsdr.uspto.gov/documentviewer?caseId=sn87747053&docId=OOA20180420161439#docIndex=10&page=1>. In its response to the request for additional information on the goods, Registrant responded:

In response to the Examining Attorney's inquiry, Applicant advises that the goods are an embedded software suite that provides high availability, command and control, system analysis, system maintenance, and a range of data replication/management frameworks for embedded ground based Air Traffic Control (ATC) systems.

Exhibit E.

<http://tsdr.uspto.gov/documentviewer?caseId=sn87747053&docId=ROA20180815193200#docIndex=7&page=1>.

In its 10-K filed with the U.S. Securities and Exchange Commission, Registrant describes its role in aviation as a "trusted systems integrator serving Air Navigation Service Providers including the FAA, the Transportation Security Administration ('TSA') and airport operators." Exhibit C, 10-K at 2. Registrant notes that its business is heavily regulated and that its contracts are determined by or negotiated with the U.S. government. Exhibit C, 10-K at 6-7.

Section 2(d) Refusal—Likelihood of Confusion

Similarity of the Marks

The Office Action found that Applicant's mark and Registrant's mark are similar in their entireties in appearance and sound and the potential to be used in exactly the same manner, relying on *In re i.am. symbolic, llc*, 866 F.3d 1315 (Fed. Cir. 2017). *i.am. symbolic* filed trademark applications for registration of its mark in three classes. In each class, there already was a registered mark for the identical goods. *i.am. symbolic* attempted to avoid this conflict by amending its applications to add the words "associated with William Adams, professionally known as will.i.am." Both the TTAB and the appellate court found this limitation was inadequate to distinguish the marks and that the goods were in the same trade channels and the classes of purchasers overlapped. The *Symbolic* court noted the question of likelihood of confusion is a question of law based on the underlying findings of facts by using the relevant factors in *Application of E. I. DuPont DeNemours & Co.*, 476 F.2d 1357 (C.C.P.A. 1973) ("DuPont"). Because the marks in *Symbolic* were the same, the trade channels were the same, and the classes of purchasers overlapped, there was a likelihood of confusion in the marks. The opposite is true in the instant case. While the marks are the same, they are in different international classes, the trade channels are different, the classes of purchasers are different, and the customers are extremely sophisticated. In addition, for over nine years, there has been no actual confusion of the Applicant's and Registrant's marks. Exhibit A, Dec. at ¶ 10. Therefore, when the relevant *DuPont* factors are applied as discussed below, there is no likelihood of confusion and Applicant's mark should be approved.

Relatedness of the Goods/Services

The initial Office Action refused registration, asserting that Applicant's and Registrant's goods are similar, commercially related, and travel in the same trade channels, citing *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356 (Fed. Cir. 2012), and *Herbko Int'l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156

(Fed. Cir. 2002). While the marks are identical, the goods are dissimilar, are not commercially related, and travel in different trade channels for purchase and use by sophisticated users.

Coach does not support the Office Action but instead demonstrates why Applicant's mark should be registered. In *Coach*, the court affirmed the TTAB finding that, even though Coach was a famous mark, because there was no overlap of goods, "customer confusion is not likely between the parties' respective COACH marks. Although CSI's COACH mark is famous for likelihood of confusion purposes, the unrelated nature of the parties' goods and their different channels of trade weigh heavily against CSI [the opposer]. Absent overlap as to either factor, it is difficult to establish likelihood of confusion." *Coach*, 668 F.3d at 1371. Here, Registrant's mark is not famous and there is no overlapping of goods, nor has there been any actual confusion for over nine years.

Herbko also is distinguishable from the facts in this case. *Herbko* was a cancellation proceeding. The marks were used for crossword puzzle rolls and a crossword puzzle book. The court found both involved crossword puzzles printed on paper, both of which were marketed through department stores to similar classes of purchasers, which "bolsters the likelihood of confusion." *Herbko*, 308 F.3d at 1166. Here, the goods are different, are not marketed in the same channels, are sold to sophisticated purchasers in different industries, and in nine years have not experienced any incidences of confusion.

The Office Action also argues that the goods and services need not be identical to find a likelihood of confusion, citing *On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080 (Fed. Cir. 2000), and *Recot, Inc. v. Becton*, 214 F.3d 1322 (Fed. Cir. 2000).

On-Line Careline involved On-line Careline's application for a mark and its petition to cancel America Online's registration of a similar mark. On-line Careline and America Online both used their marks for providing internet access. The case noted that a decision on whether a likelihood of confusion exists must be based on underlying factual determinations. In *On-Line Careline*, America Online opposed the application, arguing that the applied for mark and the registered mark were for the same service in the same international class. This is distinguished from the facts here where the goods are different, the marks are in different international classes, the trade channels are not the same, the customers are sophisticated in highly technical professions, and there has been no confusion in the past nine years.

Recot involved a famous mark. There, the TTAB dismissed the registrant's opposition to the applicant's mark. In reversing, the court found the TTAB failed to consider the fact that Recot's mark, Frito-Lay, was famous. As a result of being a famous mark, it enjoyed "a wide latitude of legal protection," *Recot*, 214 F.3d at 1327, including products that do not fall under the goods and services listed in the registration. In contrast, the instant case does not involve a famous mark, so *Recot's* decision is inapposite.

The Office Action cites *In re I-Coat Co.*, 126 USPQ2d 1730 (TTAB 2018); *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993); and *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467 (TTAB 1988) for the proposition that Applicant's and Registrant's marks come from a single source. These cases are distinguishable from the facts in this application and, as a result, should not be grounds for denying this application.

In re I-Coat Co. concerns marks for optical lenses. The Examining Attorney found the marks at issue were identical, the goods were similar, and they travelled in common trade channels to the same consumers. In this case, other than the marks being identical, none of the *In re I-Coat Co.* findings are the

same. Applicant's goods are different from Registrant's goods, the trade channels are different, and the goods are purchased by sophisticated customers in different industries.

In *Trostel*, the TTAB reversed the Examining Attorney's finding of similarity between the goods. *Trostel* concerned an application for a mark for raw leather. The case is not particularly useful here because there was an agreement between the applicant and mark holder to allow registration. In his initial refusal, the Examining Attorney cited a mark for luggage and other finished products and disallowed publication, even though the applicant and mark holder agreed there was no confusion. In reversing the Examining Attorney, the TTAB noted that "[c]onsidering the differences in the goods, trade channels, and classes of purchasers of applicant and registrant, we are not inclined 'to second-guess the conclusions of those most familiar with the market place' on the issue of likelihood of confusion." *Trostel*, 29 USPQ2d at *4.

In *Mucky Duck*, the issue was whether to allow registration for mustard when there existed a registration for restaurant services. The TTAB found that, because of the "unique and memorable nature of registrant's mark," persons seeing the mustard on a grocery shelf "are likely to believe that the mustard originates with or is in some way associated with registrant." *Mucky Duck*, 6 USPQ2d 1467 at *3. The instant case does not deal with a low-cost everyday item like mustard. Rather, Applicant and Registrant sell highly specialized goods to sophisticated purchasers.

The Office Action states that *In re Davey Prods. Pty*, 92 USPQ2d 1198 (TTAB 2009), and *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266 (TTAB 2009), require a finding that Applicant's and Registrant's marks are related for likelihood of confusion purposes. This is an incorrect interpretation of the cases. In both *Davey Prods.* and *Toshiba Med.*, the TTAB conducted a review using the *DuPont* factors, finding the products were similar and flowed through similar channels. In *Davey Prods.*, the applicant described the goods as including pressure control, which the TTAB found was similar to parts of air compressors, noting that "[o]ur likelihood of confusion determination under Section 2(d) is based on an analysis of all of the facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue (the *DuPont* factors)." Similarly, in *Toshiba Med.*, which concerned medical diagnostic equipment [MSI and ultrasound] that "can be used together," the TTAB said "[i]n a case involving a refusal under Section 2(d), we analyze the facts as they relate to the relevant factors set out in [*DuPont*]." The Office Action here did not conduct a *DuPont* analysis. An appropriate *DuPont* analysis (as provided below) would find that Applicant's mark should be registered.

Finally, the Office Action's reliance on *In re Shell Oil Co.*, 992 F.2d 1204 (Fed. Cir. 1993); *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261 (Fed. Cir. 2002); and *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463 (Fed. Cir. 1988), is misplaced. It is true that all three cases note that, if there is a doubt of likelihood of confusion, the issue should be resolved against the applicant. However, in the instant case, there is no likelihood of confusion and, therefore, there is no presumption that the matter be resolved against Applicant.

In *Shell*, the issue was the use of the phrase RIGHT A WAY for service station oil and lubrication services and the same phrase for distributorship services in the field of automotive parts. The TTAB found the services were related and would be so perceived by consumers. *Shell*, 992 F.2d at 1207. However, in finding the services were related, the court said that the discrimination and degree of care by users of the services must be considered. *Id.* at 1208. The court was careful to distinguish the case "from those wherein the primary consumers of both purveyors' services are professional purchasers." *Id.* at 1209, citing *Astra Pharmaceutical Products, Inc. v. Beckman Instruments, Inc.* 718 F.2d 1201 (1st Cir. 1983). *Astra*

Pharmaceutical concerned the use of the mark ASTRA for a local anesthetic and a computerized instrument used in hospital laboratories to determine the quantity of certain substances in the blood. While both were used in the medical profession, the court said, while the marks are similar, “this conclusion alone does not mandate a holding of likelihood of confusion.” *Astra*, 718 F.2d at 1205. Using the factors articulated in *Pignons S.A. de Mecanique v. Polaroid Corp.*, 657 F.2d 482 (1st Cir. 1981), the *Astra* court found the most critical factor “is the sophistication of the class of prospective purchasers of the subject products. If likelihood of confusion exists, it must be based on confusion of some relevant person; *i.e.*, a customer or purchaser. And there is always less likelihood of confusion where goods are expensive and purchased after careful consideration.” *Id.* at 1206. Therefore, there was no likelihood of confusion for the ASTRA mark. A similar result is appropriate in the instant case, where both Applicant’s and Registrant’s customers are highly sophisticated purchasers of technical products.

In *Hewlett-Packard*, the applicant sought registration for goods and services that were identical to the mark holder, so as a matter of law there was a likelihood of confusion, thereby allowing the holder to oppose the mark. Likewise, in *Hyper Shoppes*, the court found there was overlap in the goods and services for the identical marks in the same market.

Unlike in *Shell*, *Hewlett-Packard*, and *Hyper Shoppes*, there is no likelihood of confusion in the instant case, and there is no reason to give deference to the registered mark. The purchasers of Applicant’s and Registrant’s goods are sophisticated, and the goods are highly technical. In fact, in the case of Registrant, the FLIGHTDECK product is sold to governmental entities as part of a bidding or negotiation process. There is no likelihood of confusion under such circumstances, and Applicant’s mark should be registered.

Analysis of the Relevant DuPont Factors

The *DuPont* case includes 13 factors to review in determining whether a mark may be confusingly similar to another. “Not all of the DuPont factors are relevant to every case, and only factors of significance to the particular mark need be considered.” *In re Mighty Leaf Tea*, 601 F.3d 1342, 1346 (Fed. Cir. 2010). We review here the most relevant factors:

1. *The similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation, and commercial impression.*

The marks are identical. However, the similarity of the marks does not bar registration because the marks here are for different uses, use different channels, and are purchased by highly sophisticated users. In addition, there has been no actual confusion for nine years, as explained below.

2. *The similarity or dissimilarity and nature of the goods or services as described in an application or registration or in connection with which a prior mark is in use.*

The nature of the goods offered by Applicant and Registrant is different. Even when identical marks are at issue, they may both be registered if their respective goods are used by different people in different environments such that there would not be a likelihood of confusion as to their sources. *Chase Brass & Copper Co., Inc. v. Special Springs, Inc.*, 199 U.S.P.Q. 243 (finding no likelihood of confusion where applicant and opposer had identical BLUE DOT marks on goods sold to different players in the automotive industry). As noted above, Applicant’s mark is used in connection with a sales and marketing tool for managers in highly regulated industries to create custom and regulatory-compliant presentations for their

sales and marketing content. Exhibit A, Dec. at ¶¶ 3-6. In contrast, Registrant's mark is used for an embedded software suite for ground-based Air Traffic Control systems, a type of middleware rather than an end-user tool. Exhibit E and Exhibit A., Dec. at ¶ 8. Similar to the situation in *Chase Brass & Copper*, the different products here are used by different, highly skilled professionals for different purposes in different technical or highly regulated industries, which makes it unlikely there would be any confusion as to their source. Therefore, while Applicant's mark is identical to registrant's mark, the dissimilarity of the goods and their uses weighs in favor of registration of Applicant's mark. These differences also explain why the marks have coexisted for nine years with no confusion. Exhibit A., Dec. at ¶ 10.

3. *The similarity or dissimilarity of established, likely-to-continue trade channels.*

The trade channels used by Applicant and Registrant are different. While both parties have websites, only Applicant uses the mark on its website. Registrant does not use its mark on a website. In fact, the specimen used in support of its application is an instruction sheet for customers, who are governmental agencies or contractors working on air traffic control systems. Exhibit F. <http://tsdr.uspto.gov/documentviewer?caseId=sn87747053&docId=SPE20180111073349#docIndex=12&page=1>. Applicant markets its services to financial services organizations, asset and wealth managers, retirement plan providers, and private banks. Exhibit A, Dec. at ¶ 5. Registrant, on the other hand, states that it "is a FORTUNE 500® science, engineering and information technology company that provides services and solutions in the defense, intelligence, civil and health markets." Exhibit C, 10-K at 1. It offers services and solutions to U.S. government customers and international governments. Exhibit C, 10-K at 1. In fact, 87 percent of its total revenues are from contracts with the U.S. government either as a prime contractor or a subcontractor. Exhibit C, 10-K at 32. Registrant explained that its business "is heavily regulated" and that the "U.S. government procurement environment has evolved due to statutory and regulatory procurement reform initiatives." Exhibit C, 10-K at 6. "Generally, the type of contract for our services and products is determined by or negotiated with the U.S. government and may depend on certain factors, including the type and complexity of the work to be performed, degree and timing of the responsibility to be assumed by the contractor for the costs of performance, [and] the extent of price competition" among other things. Exhibit C, 10-K at 7. Thus, Applicant and Registrant market their products through different trade channels, eliminating any likelihood of confusion.

4. *The conditions under which and buyers to whom sales are made, that is, "impulse" versus careful, sophisticated purchasing.*

The buyers of Applicant's and Registrant's products are not impulse buyers. The products are used by professionals in highly sophisticated areas. For Applicant, the buyers and users are sophisticated financial services organizations, asset and wealth managers, retirement plan providers, and private banks in highly regulated industries. Exhibit A, Dec. at ¶¶ 3-6. For Registrant, the buyers are the U.S. government and other governmental agencies via a bid or negotiation process. Exhibit C, 10-K at 1. Both Applicant and Registrant sell to careful, sophisticated buyers. The careful, sophisticated purchasing processes for Applicant's and Registrant's products demonstrate that there would be no likelihood of confusion.

5. *The nature and extent of any actual confusion.*

There is no evidence of actual confusion. In fact, the record evidences the opposite. In nine years of coexistence, there has been no case of actual confusion. Exhibit A., Dec. at ¶ 10.

6. *The length of time during and conditions under which there has been concurrent use without evidence of actual confusion.*

The marks have been used concurrently for nine years without any actual confusion. Exhibit A., Dec. at ¶ 10.

7. *The extent of potential confusion, that is, whether de minimis or substantial.*

Applicant's and Registrant's products are different, they are targeted at different sophisticated clients, and they are marketed through different channels. Exhibit A., Dec. at ¶ 9. There has been no actual confusion for nine years. Exhibit A, Dec. at ¶ 10. This history demonstrates that potential confusion is non-existent.

8. *Any other established fact probative of the effect of use.*

As noted throughout this Response, there has been no actual confusion for the past nine years where the marks have coexisted in the marketplace. Because the marks are for different products provided to separate and distinct industries where the buyers are sophisticated and purchase through careful buying processes, it is unlikely that any confusion will occur. A party seeking embedded software for maintenance and management of an air traffic control system is either the federal government or a governmental airport authority. Such an entity would not be confused by Applicant's program that assists highly regulated financial institutions to prepare regulatory-compliant marketing materials.

Conclusion

Having appropriately and fully addressed the concerns raised in the December 9, 2019 Office Action, Applicant Synthesis Technology Corp. respectfully requests the application Serial No. 88326319 for the mark FLIGHTDECK be approved for publication on the Principal Register.

Respectfully submitted,

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