

Serial No.: 88/600,438
Applicant: Safety Holdings, Inc.
Mailing Date: December 8, 2019
Examining Attorney: Eli J. Hellman
Law Office: 102

RESPONSE TO OFFICE ACTION

The applicant, Safety Holdings, Inc. (“Applicant”), respectfully responds to the December 8, 2019 Office Action as follows:

I. BACKGROUND

The Examining Attorney issued an Office Action against Applicant’s VOLTA mark (the “Mark”) based on (1) a potential 2(d) likelihood of confusion between the Mark and Prior Pending Application No. 87691602 for VOLTA INSURANCE SOLUTIONS (the “Prior Pending Mark”); (2) a required English translation of foreign wording in the Mark; and (3) a required clarification of the recitation of services under the Mark. Applicant respectfully disagrees with the Examining Attorney that a likelihood of confusion exists between the Mark and the Prior Pending Mark, however, because the Prior Pending Mark is the subject of an active opposition proceeding (Proceeding Number 91244969) that includes a motion to amend the application, it is unclear at this time whether the Prior Pending Mark will register at all, and if it does, it is unclear what their final claimed services will be. As such, Applicant withholds any arguments against confusion with the Prior Pending Mark pending the outcome of the opposition proceeding. Should the Prior Pending Mark overcome the opposition and the Examiner still believes there is a likelihood of confusion between the marks, Applicant will submit their arguments against confusion should a new Office Action be issued. Applicant’s responses to the Examining Attorney’s translation and clarification requirements are addressed below.

II. TRANSLATION OF FOREIGN WORDING IN THE MARK

The Examining Attorney has required Applicant to submit an English translation of the foreign wording in the mark and proposed the following:

The English translation of “VOLTA” in the mark is “TIME” or “VAULT.”

While Applicant does not disagree that the proposed translation is a correct one, at the time of creation and of filing, the translation was unknown to Applicant and in creating the Mark Applicant did not intend that the Mark carry any such connotation or meaning. The origin of the Mark for Applicant is related to their family of registered marks, specifically the marks SAMBA (U.S. Registration No. 3722084) and QORTA (U.S. Registration No. 5767816). Applicant’s creation of the VOLTA Mark is derived from the style of dance known as the “Samba,” “Qorta” is the first version of the Samba dance, while “Volta” is the second version of the dance. Therefore, as Applicant had no intention for the mark to correspond with the proposed, or any, foreign translation, and because the Mark is clearly arbitrary if not fanciful in relation to the services described, Applicant respectfully requests that the Examining Attorney obviate the requirement of a translation for the Mark.

III. CLARIFICATION OF THE RECITATION OF SERVICES

The Examining Attorney also requires Applicant to clarify the wording in the identification of services and provided the following proposed substituted wording to the identification of services.

Proposed:

International Class 042: *Software as a service (SAAS) services, namely, hosting software for use by others for {indicate purpose or function, e.g., tracking vehicle usage} in the field of insurance and driver risk management*

Applicant accepts the Examining Attorney's proposed wording and submits the following amended identification of services which should clarify the services without adding to or broadening the scope of the services:

International Class 042: *Software as a service (SAAS) services, namely, hosting software for use by others for {identifying, assessing and pricing driver risk} in the field of insurance and driver risk management; Software as a service (SAAS) services, namely, hosting software for use by others for {collecting, compiling and analyzing data related to driver risk} in the field of insurance and driver risk management;*

Thank you for your reconsideration,
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