

REFUSAL UNDER TRADEMARK ACT SECTION 2(D) – LIKELIHOOD OF CONFUSION – CLASS 9 ONLY

The Examiner refused registration of the applied-for mark, “Verse,” in Class 9 only, because of a likelihood of confusion with the marks in U.S. Registration Nos. 5900451 (Verse), 4695449 (Verse Solutions), 4688087 (Verse Solutions), 4868509 (Verse), and 4415537 (Verse). In response, Applicant has amended the description of goods in Class 9 to more specifically identify the type of software it is providing under the mark and to distinguish the description from each of those registrations. Based on the revised description, Applicant believes that there is no likelihood of confusion.

Compared goods need to be “related in some manner and/or if the circumstances surrounding their marketing are such that they could give rise to the mistaken belief that [the goods and/or services] emanate from the same source” in order for there to be a likelihood of confusion. *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1369, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012) (quoting *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1724 (TTAB 2007)); TMEP §1207.01(a)(i).

Determining likelihood of confusion is based on the description of the goods and/or services stated in the application and registration at issue, not on extrinsic evidence of actual use. *See In re Detroit Athletic Co.*, 903 F.3d 1297, 1307, 128 USPQ2d 1047, 1052 (Fed. Cir. 2018) (citing *In re i.am.symbolic, llc*, 866 F.3d 1315, 1325, 123 USPQ2d 1744, 1749 (Fed. Cir. 2017)).

Applicant’s revised description of good in Class 9, specifies that the downloadable software it is providing under the mark is specifically to enable the electronic transfer of money between users. This description is dissimilar to the types of software identified in Registration Numbers 4868509, 4415537, 4688087, 4695449 and 5900451 (the “Registered Marks”).

Indeed, the revised description is for a goods so different from the goods identified in the Registered Marks that the consumer will not be likely to assume that they come from the same source. “If the goods or services in question are not related or marketed in such a way that they would be encountered by the same persons in situations that would create the incorrect assumption that they originate from the same source, then, even if the marks are identical, confusion is not likely.” TEMP 1207.01(a)(i); *see, e.g., Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1371, 101 USPQ2d 1713, 1723 (Fed. Cir. 2012) (affirming the Board’s dismissal of opposer’s likelihood-of-confusion claim, noting “there is nothing in the record to suggest that a purchaser of test preparation materials who also purchases a luxury handbag would consider the goods to emanate from the same source” though both were offered under the COACH mark); *Shen Mfg. Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 1244-45, 73 USPQ2d 1350, 1356 (Fed. Cir. 2004) (reversing TTAB’s holding that contemporaneous use of RITZ for cooking and wine selection classes and RITZ for kitchen textiles is likely to cause confusion, because the relatedness of the respective goods and services was not supported by substantial evidence); *In re Thor Tech, Inc.*, 113 USPQ2d 1546, 1551 (TTAB 2015) (finding use of identical marks for towable trailers and trucks not likely to cause confusion given the difference in the nature of the goods and their channels of trade and the high degree of consumer care likely to be exercised by the relevant consumers); *Local Trademarks, Inc. v. Handy Boys Inc.*, 16 USPQ2d 1156, 1158 (TTAB 1990) (finding liquid drain opener and advertising services in the plumbing field to be such different

goods and services that confusion as to their source is unlikely even if they are offered under the same marks); *Quartz Radiation Corp. v. Comm/Scope Co.*, 1 USPQ2d 1668, 1669 (TTAB 1986) (holding QR for coaxial cable and QR for various apparatus used in connection with photocopying, drafting, and blueprint machines not likely to cause confusion because of the differences between the parties' respective goods in terms of their nature and purpose, how they are promoted, and who they are purchased by).

RN 4868509 is described as "Downloadable mobile applications used for creating, modifying, and distributing multimedia content; downloadable computer software for processing and playing digital media files; downloadable software for creating, modifying, and distributing multimedia content." Applicant's Mark now describes a banking, money transfer application; whereas RN 4868509 describes an application for creating, distributing, and playing media files. These are vastly different types of applications that one would not expect to come from the same source.

RN 4415537 is described as "providing temporary use of on-line non-downloadable software for quality management, FDA compliance and for achieving compliance with various environmental health and safety laws and regulations" The reasonable consumer is not likely to assume that the provider of non-downloadable software for compliance with health and safety laws also provides a mobile application that allows users to transfer money to their friends.

Similarly, RNs 4688087 and 4695449 are described as "[p]roviding temporary use of on-line non-downloadable cloud computing software for database and workflow management, business operations management, quality management, FDA compliance and for achieving compliance with various environmental health and safety laws and regulations.; Providing temporary use of on-line non-downloadable software development tools for database and workflow management, business operations management, quality management, FDA compliance and for achieving compliance with various environmental health and safety laws and regulations." Again, the reasonable consumer is not likely to assume that the provider of non-downloadable software for compliance with health and safety laws also creates a mobile application that allows users to transfer money to their friends.

RN 5900451 is described as "[p]rotective cases for mobile phones in the nature of frames with removable protective inserts for use with mobile devices..." The majority of mobile phone case providers do not sell mobile applications and vice-versa. Indeed, the only companies that sell both are the makers of cell phones (i.e. Apple, Samsung, Google).

NOTICE OF PRIOR PENDING APPLICATIONS

The Examining Attorney noted that Applicant's Mark may cause of likelihood of confusion with the pending U.S. Application Serial Nos. 88186608, 88749231, 88636798 and 88616230. Applicant believes that it's amendment to its description of goods in Class 9 resolves any potential confusion with each of these applications.

Serial No. 88749231 is for “[d]ownloadable computer software development tools for implementing a computer programming language,” this class is unrelated to both downloadable mobile applications and financial services.

Serial No. 88616230 is for computer goods (i.e. track balls, track pads, touch pads, keyboards, mice, mouse pads, light pens and other light sensitive detectors, pressure styluses, joysticks, web cams). Typically, computer accessories are not sold by the same brands as downloadable mobile applications.

Serial No. 88186608 is for “[s]oftware as a service (SAAS) services for use in leveraging voice interactions and chat services by translating and transcribing voice, audio and text; Software as a service (SAAS) services for use in voice analytics, voice translation and voice recognition services; Providing temporary use of non-downloadable cloud-based software for use in leveraging voice interactions and chat services by translating and transcribing voice, audio and text; Providing temporary use of non-downloadable cloud-based software for use in voice analytics, voice translation and voice recognition services; Intelligent voice recognition services using cloud-based software technology” and Serial No. 88636798 is a registration for “Providing temporary use of non-downloadable cloud-based software for communicating between users and for analyzing, storing and managing data, for use in connection with engaging, nurturing and qualifying sales leads via phone, SMS, email, social and other messaging technologies in the fields of marketing, sales, customer service, and customer support.” The reasonable consumer is not likely to assume that the provider of non-downloadable cloud-based software for business activities would also be the provider of a downloadable mobile application that allows users to transfer money to their friends.

In addition, Serial No. 88749231 is not a prior pending application because it was filed on January 7, 2020, whereas the Mark was submitted on December 30, 2019.