UNITED STATES DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

In Re the Application of:		)	
Applicant:	Solve HQ, Inc.	)	
Mark:	SOLVE	)	
Serial No.:	88307782	)	Trademark Law Office: 126
Class:	9	)	Examiner: Carl A. Konschak, Esq.
Filed:	February 19, 2019	)	

RESPONSE TO OFFICE ACTION

On May 3, 2019, the Examining Attorney refused registration for SOLVE, in connection with goods in Class 9, on the grounds that it is likely to cause confusion with four pre-existing registrations, cited to five previously-filed applications, and requested that Applicant amend its description of goods to clarify its class 9 goods and to move some of them to class 42. Applicant responded on November 4, 2019, amending its description as requested, and explaining why there was no likelihood of confusion with any of the cited applications or registrations.

On December 9, 2019, the Examining Attorney suspended the application based on one of the prior-filed applications - Ser. No. 87869632 for SOLVE IT in connection with “Board games; Card games” in Class 28. The Examining Attorney noted that all of the other “refusal[s] and requirements are satisfied and/or obviated,” including the Section 2(d) refusal for likelihood of confusion with the cited registrations and the citations to the remaining prior-filed applications. Specifically, the Examining Attorney did not cite Application Ser. No. 88154865 for PICSOLVE in the suspension notice. The Examining Attorney likewise did not cite to a likelihood of confusion with Reg. Nos. 5343758 or 5352924 as a basis for refusing registration.

On April 9, Applicant responded to the suspension notice and further amended its identification of goods and services to remove "computer game software." It likewise explained why, especially given the amendments, there was no likelihood of confusion with the SOLVE IT mark for board games and card games.

The Examining Attorney issued an Office Action on May 26, 2020, again refusing registration. Despite the fact that Applicant had merely removed "computer game software" from its Class 9 description, the Examining Attorney refused registration based on Reg. Nos. 5343758 and 5352924 for SOLVE in Classes 9 and 41 and Reg. No. 6010873 for PICSOLVE, which had matured from the previously-cited Application Ser. No. 88154865, and which Applicant had previously obviated ("Cited Marks").

For the reasons set forth below, Applicant respectfully submits that there is no likelihood of confusion between its SOLVE mark and any of the Cited Marks.

I. AMENDMENT AND LIMITATIONS TO IDENTIFICATION OF SERVICES

Applicant hereby amends and limits its Identification of Services to read as follows:

> "Downloadable computer software applications for transmitting videos and films in the fields of **touch-controlled interactive drama and audience-controlled scripted** drama**,** ~~**live action, and comedy entertainment**~~ to wireless devices via a global computer network; Computer software, namely, downloadable computer software for streaming audio-visual media content via the Internet to mobile digital electronic devices ~~**and to downloadable media players**~~ for viewing audio-visual media content in the fields of **touch-controlled interactive drama and audience-controlled scripted** drama**,** ~~**live action, and comedy entertainment**~~**"** in International Class 9;

> "Providing temporary use of non-downloadable computer software for streaming audio-visual media content via the Internet to mobile digital electronic devices ~~**and to downloadable media players**~~ for viewing audio-visual media content in the fields of **touch controlled interactive drama and audience-controlled scripted** drama**,** ~~**live action, and comedy entertainment**~~" in International Class 42.

II. APPLICANT'S MARK IS NOT LIKED TO BE CONFUSED WITH THE CITED MARKS

In determining whether there is a likelihood of confusion, courts and the Trademark Trial and Appeal Board ("the TTAB" or "the Board") look to many factors, including the following, which are most relevant in the present analysis:

- the relatedness of the goods or services as described in the application and registration(s);
- the similarity of the trade channels of goods and services; and
- the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation, and commercial impression;
- the number and nature of similar marks in use on similar goods.

See In re E.I. DuPont De Nemours & Co., 476 F.2d 1357, 1361 (C.C.P.A. 1973); T.M.E.P. § 1207.01. There is no mechanical test for determining likelihood of confusion and "each case must be decided on its own facts." *Id.* The application of these factors in this case leads inevitably to the conclusion that no confusion is likely between Applicant's Mark and the Cited Marks.

1. *The Goods and Services of the Parties Are Not Related*

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. T.M.E.P. § 1207.01(a)(i).

There is no likelihood of confusion between Applicant's SOLVE trademark, as clarified and amended, and any of the Cited Marks, all of which are used for distinct software products that do not overlap and are not otherwise related with Applicant's goods.

Reg. Nos. 5343758 and 5352924 are for SOLVE and SOLVE (& Design), respectively, in connection with "Audio and video recordings featuring talks, demonstrations, performances, seminars, and workshops, in the field of community and global problem solving; audio and video recordings featuring talks, demonstrations, and performances, in the nature of speeches and artistic presentations in the field of problem solving, informing the audience and covering the subject matter of technology, business, science, education, medicine, genomics, global issues, health, economics, the environment, politics, the humanities, leadership, public policy, and social and cultural issues" and well as educational services such as "providing an in-person educational forum for local community groups of businesses, NGOs, schools, and individuals to facilitate and foster activities to address community and global challenges in the field of problem solving" on the same topics.

Respectfully, there is no likelihood of confusion between SOLVE for "transmitting videos and films in the fields of touch-controlled interactive drama and audience-controlled scripted drama" on the one hand, and SOLVE for talks, demonstrations, seminars, and workshops in the field of community and global problem solving" on the other. Nor is the likelihood of confusion between non-downloadable software featuring audience-controlled scripted drama or educational services to business, NGOs, schools and individuals on solving global issues regarding health care, the environment, or politics. The goods and services do not overlap, and respectfully, the evidence cited by the Examining Attorney does not demonstrate any such overlap. The Examining Attorney cited evidence from NPR.org, PBS.org, and CNN.com for the proposition that "'software for streaming audio-visual media content via the Internet and to mobile digital electronic devices' is commonly marketed and sold from the same sources, under the same brands or marks, as services like 'providing online non-downloadable videos featuring talks, demonstrations, and performances in the nature of speeches and artistic presentations in the field of problem solving, informing the audience and

covering the subject matter of technology, business, science, education, medicine, genomics, global issues, health, economics, the environment, politics, the humanities, leadership, public policy, and social and cultural issues.'" However, the Examining Attorney misconstrues the nature of Applicant's services, and excludes the limitation regarding the *nature* of Applicant's videos and films – i.e., previously, "drama, live action, and comedy entertainment" and now, clarified, "touch-controlled interactive drama and audience-controlled scripted drama." Mobile application software for transmitting touch-controlled interactive drama is not related to audio and video recordings of talks, speeches, and demonstrations regarding global problem-solving programming. None of the evidence cited by the Examining Attorney shows any such overlap.

Similarly, Reg. No. 6010873 is for PICSOLVE in connection with numerous goods and services in classes 9, 41, and 42, and the Examining Attorney specifically cited to ""downloadable computer software for creating, *transmitting*, modifying and *displaying* images and videos", "downloadable computer software for creating, *transmitting*, modifying and *displaying* images and videos", "downloadable computer software for the collection, editing, organizing, modifying, *transmission*, storage and *sharing* of data and information", "downloadable computer software and hardware for creating, *transmitting*, modifying and *displaying* images and videos", "computer software applications, downloadable for mobile phones, portable media players and handheld computers namely, for the collection, editing, organising, modifying, *transmission*, storage and *sharing* of data and information", and "computer software platforms, recorded or downloadable for the collection, editing, organising, modifying, *transmission*, storage and *sharing* of data and information." This does not encompass and is also unrelated to Applicant's touch-controlled interactive drama and audience-controlled scripted drama. As PICSOLVE's September 23 response to office action for the PICSOLVE application makes clear, its goods "clearly…relate to

photography." Photo and video editing software is not similar to applications allowing for consumers to view and interact with touch-controlled drama. The Examining Attorney has presented no evidence that consumers encounter video editing software and touch-controlled interactive drama under the same mark.

Given the coexistence of all of the above marks in connection with their various goods and services (described more fully below), Applicant's mark should be permitted to coexist as well given the differences in goods and services.

2. *The Appearances, Sounds, and Commercial Impressions of the Applicant's Mark and the Cited Marks Are Different.*

Applicant's Mark SOLVE is not likely to be confused with any of the Cited Marks because, when viewed in their entireties, the marks convey completely different appearances, sounds, and commercial impressions. *See DuPont,* 476 F.2d at 1361.

While Applicant's mark bears some similarities with the Cited Marks in terms of the "solve" letter chain, those marks coexist. Accordingly, and taking into account the different goods and services, there is no likelihood of confusion, as consumers will differentiate between the marks, and will focus on the differences between them to identify source. PICOLVE, for example, connotes photography software. SOLVE, in connection with lectures and talks regarding global-problem solving also connotes a relation to global problem solving and not touch-controlled interactive drama. These offer different commercial impressions than SOLVE in connection with Applicant's goods and services.

3. *The Nature and Number of Similar Marks in Use on Similar Goods Mitigates the Likelihood of Confusion.*

Evidence of third-party use falls under the sixth *DuPont* factor – the "number and nature of similar marks in use on similar goods." *DuPont*, 476 F.2d at 1361. If the evidence establishes that the consuming public is exposed to third-party use of similar marks on similar goods, it "is relevant to

show that a mark is relatively weak and entitled to only a narrow scope of protection." *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee en 1772*, 396 F.3d 1369, 1373-74, 73 USPQ2d 1689, 1693 (Fed. Cir. 2005); *see also Mini Melts, Inc. v. Reckitt Benckiser LLC*, 118 USPQ2d 1464, 1470 (TTAB 2016) (noting that evidence that third parties had adopted marks that were the same as or similar to opposer's mark for use in connection with food products "may show that a term carries a highly suggestive connotation in the industry and, therefore, may be considered weak ").

"During the examination of an application, the examining attorney should consider separately each registration found in a search of the marks registered in the USPTO that may bar registration of the applicant's mark under §2(d). If the examining attorney finds registrations that appear to be owned by more than one registrant, he or she should consider the extent to which dilution may indicate that there is no likelihood of confusion." T.M.E.P. § 1207.01(d)(x).

In his initial Office Action, the Examining Attorney cited to multiple registrations owned by more than one registrant, which indicates a level of dilution that mitigates the likelihood of confusion in this case. Indeed, given that all of the Cited Marks coexist, even in the broad category of software, there is no reason to conclude that consumers of Applicant's goods would be unable to distinguish its SOLVE goods from those offered under the Cited Marks. Those registrations include:

- Reg. No. 3513787 for SOLV in connection with "computer software for managing and scheduling appointments; computer software for providing users with reminders about appointments; computer software for allowing users to check in for appointments; computer software for verifying insurance eligibility status; computer software for allowing users to create, view and update medical profiles; computer software for allowing users to communicate regarding medical care and medical advice"

- Reg. No. 4722879 and 4722881 for ISOLVE and ISOLVE (& Design), respectively, in connection with "computer software for use in connection with the management and monitoring of the operations of business in the produce industry relating to inventories, sales, grower accounting, quality control, crop costs, traceability of orders and shipments, general accounting, receivables, payables, relationships with banks and lenders and the production of financial reports" in Class 9
- Reg. No. 5710645 for ESOLVE in connection with "computer software for a web-based crisis investigation, major case, and serious crime management software program" in Class 9
- Reg. No. 5911972 for SOLV in connection with "Providing temporary use of on-line non-downloadable cloud computing software used to monitor, analyze, maintain, and control wind energy based power plant sites and data collected from such sites" in Class 42
- Ser. No. 88292152 for SOLV= and Ser. No. 88292148 for SOLVE (published for opposition, but not yet registered), both in connection with "Downloadable computer software to automate data warehousing; Downloadable software for use in managing data infrastructure and security of data access; Downloadable software for enabling access to and collaboration on business data and managing data security and performance; Downloadable software for configuring and maintaining data in multi-cloud or on-premise environments for businesses; Downloadable software for data analytics and software development" in Class 9
- Ser. No. 88169270 for iSOLVE (published, but not yet registered) in connection with "Software as a service (SAAS) services featuring software for use by others to

generate life insurance quotations; Providing a website featuring on-line non-downloadable software that enables users to expedite and facilitate the marketing, selling and processing of insurance and financial products for the insurance industry" in Class 42.

In addition, numerous mobile applications coexist on the app stores with names that include the term "Solve." These include:

- SolveThis+
- Solve It – Mathematics
- Solve This in 30s
- Solve This in 15s
- Solve It Now
- Solve – Brain Training
- Solved App
- Solve It

See **Attachment A** for screen shots of each of these applications.

Given the numerous types of software that use the SOLVE mark, and given the differences in goods and services and commercial impression of Applicant's mark and the Cited Marks, Applicant should be permitted to coexist with the Cited Marks because there is no likelihood of consumer confusion.

III. CONCLUSION

Applicant's Mark is not likely to be confused with the Cited Marks due to differences in the marks, differences in the respective goods and services, and dilution of the term "SOLVE." Accordingly, Applicant requests that the Examining Attorney withdraw the refusal and that Applicant's Mark be approved for publication.

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