

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant: Abnormal Security Corporation

Serial No.: 88657465



Mark:

Classes: 9, 38, 42

Office Action Date: January 22, 2020

Examiner: Caitlin Watts-Fitzgerald

**RESPONSE TO  
OFFICE ACTION**

Abnormal Security Corporation (“Applicant”) respectfully submits the following response to the Non-Final Office Action (“Office Action”) issued by Examining Attorney Caitlin Watts-Fitzgerald (“Examining Attorney”) on January 22, 2020, regarding the application by Applicant to register the above-referenced mark (“Applicant’s Mark”) in Classes 9, 38, and 42. The Examining Attorney raised the following issues in the Office Action: (1) refusal based on a likelihood of confusion with one prior registration; (2) refusal of specimen; and (3) objection to select aspects of the identification of goods and services. Applicant has addressed each of these issues below.

I. Refusal for Likelihood of Confusion

The Examining Attorney has refused registration of Applicant’s Mark under Trademark Act Section 2(d) based on an alleged likelihood of confusion with the mark reflected in US Registration No. 5899852 (the “Cited Mark”) to OncoDNA S.A. (the “Cited Registrant”).

A likelihood of confusion analysis is governed by the factors set forth in *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357 (CCPA 1973). The Examining Attorney identified (1) the similarity of the marks and (2) the relatedness of the goods/services in assessing the potential for confusion in this case. For the reasons discussed below, Applicant respectfully submits that there is no likelihood of confusion with the Cited Mark.

A. Applicant's Mark and Cited Mark are Not Confusingly Similar


It is well settled that for the purposes of likelihood of confusion analysis, the marks must be considered in their entirety as to appearance, sound, connotation, and commercial impression. See *du Pont*, 476 F.2d at 1461; see also TMEP 1207.01(b). Importantly, the Supreme Court has noted that “[t]he commercial impression of a trademark is derived from it as a whole, not from its elements separated and considered in detail.” *Estate of P.D. Beckwith, Inc. v. Comm’r of Patents*, 252 US 538, 545-46 (1920). When the marks are design marks, the degree of similarity is decided primarily on the basis of visual similarity. See *In re Vienna Sausage Mfg. Co.* 16 USPQ.2d 2044 (TTAB 1990). However, even if marks are found to be similar in terms of appearance, this will not automatically result in a conclusive determination of likelihood of confusion. Instead, all relevant factors pertaining to commercial impression must be considered to determine whether the marks are confusingly similar. See *Recot, Inc. v. M.C. Becton*, 214 F.3d 1322, 1329 (Fed. Cir. 2000); see also TMEP 1207.01(b).



As noted in the Office Action, these marks share a similar appearance. Both marks resemble a brain with lines generally illustrating the lobes, though the Cited Mark has a more rounded form with one half of the brain being a different color than the other half of the brain. However, merely because two marks share a similar appearance does not automatically give rise to a likelihood of confusion. Instead, the focus is on the overall commercial impression of the marks. See, e.g., *Grandpa Pidgeon’s of Mo., Inc. v. Borgsmiller*, 477 F.2d 586 (Cust. & Pat. App. 1972) (holding that consumers do not engage in trademark dissection).




Here, the Examining Attorney concludes that “the similarities between the two designs are uncanny, particularly the shape, location and angling of all node lines, including a bizarre short node horizontally through the center of the designs.” However, these marks are not identical in appearance. Specifically, Applicant’s Mark is a top cross-sectional representation of a brain formed by straight lines that has no shading or fill color. Conversely, the Cited Mark is a top cross-sectional representation of a brain formed by curved lines, where one half of the brain has a blue fill color with dots interspersed throughout while the other half of the brain is unfilled. Since these marks

are highly unlikely to be viewed side-by-side in the marketplace by consumers, consideration must be given to what, exactly, consumers' general recollection of these marks. Here, Applicant respectfully submits that while these marks appear similar, a likelihood of confusion is unlikely due to the variations in design (e.g., in shape and color). See *Red Carpet Corp. v. Johnstown Am. Enters.*, 7 USPQ.2d 1404 (TTAB 1988) (holding mark consisting of a highly stylized house design for use in connection with real estate property management, and mark consisting of a highly stylized house design for use in connection with real estate brokerage services, not likely to cause confusion); *Ocean Spray Cranberries, Inc. v. Ocean Garden Prods., Inc.*, 223 USPQ 1027 (TTAB 1984) (holding mark consisting of a circle containing three curved lines with rounded ends, for seafood, and mark consisting of a stylized breaking wave within an oval, for various food items including juices and fruits, not likely to cause confusion).

Further, when there is a proliferation of marks with similar terms or designs, consumers have no doubt been "educated to distinguish between different [such] marks on the basis of minute distinctions." See, e.g., *Standard Brands, Inc. v. RJR Foods, Inc.*, 192 USPQ 383 (TTAB. 1976); *Sun Banks of Florida, Inc. v. Sun Fed. Sav. & Loan Ass'n*, 651 F.2d 311, 316, 211 USPQ 844, 848 (5th Cir. 1981) (finding no confusion since SUN was in use by many different businesses in Florida). A preliminary search of the USPTO database reveals that there are multiple registrations coexisting on the Principal Register for marks that include top cross-sectional representations of brains. For example:

Mark	Registration No.	Goods/Services
	5865556	<p><b>Class 16:</b> Magazines in the field of artificial intelligence in medicine; Printed pamphlets, brochures, manuals, books, booklets, leaflets, informational flyers, informational sheets and newsletters, adhesive backed stickers, and kits comprised solely of one or more of the foregoing materials in the field of artificial intelligence in medicine</p> <p><b>Class 41:</b> Magazines in the field of artificial intelligence in medicine; Printed pamphlets, brochures,</p>

		<p>manuals, books, booklets, leaflets, informational flyers, informational sheets and newsletters, adhesive backed stickers, and kits comprised solely of one or more of the foregoing materials in the field of artificial intelligence in medicine</p>
	<p>5948939</p>	<p><b>Class 42:</b> Software as a service (SAAS) services featuring software for forex trading</p>
	<p>5839245</p>	<p><b>Class 42:</b> Providing temporary use of on-line non-downloadable software for electronic medical record systems, quality measurement registries, insurance companies, third-party vendors, pharmaceutical industry, public health organizations, and government agencies; providing temporary use of on-line non-downloadable software for storing, organizing, and categorizing electronic health records and patient health information; providing temporary use of on-line non-downloadable cloud computing software for electronic medical record systems, quality measurement registries, insurance companies, third-party vendors, pharmaceutical industry, public health organizations, and government agencies; providing temporary use of on-line non-downloadable cloud computing software for storing, organizing, and categorizing electronic health records and patient health information; providing temporary use of on-line non-downloadable software for collecting, storing, organizing, and categorizing user notes and observations; providing temporary use of on-line non-downloadable software for referring and recommending health professionals; providing temporary use of on-line non-downloadable software for communication and transactions between patients, patient families and caregivers, health professionals, and medical administrative support staff; providing temporary use of on-line non-downloadable software for accessing educational videos in the field of central nervous system disorders and mental health disorders; providing temporary use of</p>

		<p>on-line non-downloadable cloud computing software for collecting, storing, organizing, and categorizing user notes and observations; providing temporary use of on-line non-downloadable cloud computing software for referring and recommending health professionals; providing temporary use of on-line non-downloadable cloud computing software for communication and transactions between patients, patient families and caregivers, health professionals, and medical administrative support staff; providing temporary use of on-line non-downloadable cloud computing software for accessing educational videos in the field of central nervous system disorders and mental health disorders</p>
	<p>5570075</p>	<p><b>Class 42:</b> Business technology software consultation services; consulting in the field of computer programming; consulting in the field of computer network management; applied research and development of software in the fields of defense, finance, aerospace, education and healthcare</p>
	<p>5524040</p>	<p><b>Class 42:</b> Design and development of software in the field of mobile applications</p>
	<p>4960180</p>	<p><b>Class 42:</b> Consulting services in the field of the design of computer software; design, development, installation and maintenance of computer software; consulting services in the field of the design of computer software for warehouse management, supply chain management, logistics and cybersecurity; design, development, installation and maintenance of computer software for warehouse management, supply chain management, logistics and cybersecurity</p>

Given the peaceful coexistence of these registrations, Applicant’s Mark should also be able to coexist on the Principal Register without a likelihood of confusion with the Cited Mark.

B. Relatedness of the Goods/Services

In refusing to register Applicant’s Mark under Trademark Act Section 2(d) in view of the Cited Mark, the Examining Attorney concludes that the “goods and services are confusingly similar for purposes of a likelihood of confusion analysis.” Applicant submits that its services are neither identical to, nor competitive with, the services covered by the Cited Mark. The parties’ respective services (including the authorized amendments) are shown below:

<b>Applicant’s Goods/Services</b>	<b>Cited Mark’s Goods/Services</b>
<p><b>Class 42:</b> Computer services, namely, electronic mail (email) protection and security services, namely, services for analyzing email to discover security threats; Software as a service (SaaS) featuring software for the analysis and protection of the security of email and network communications and data; Platform as a service (PAAS) featuring computer software platforms for the analysis and protection of the security of email and network communications and data; Email and messaging management services for others, namely, threat protection in the nature of computer virus protection services, monitoring of computer systems for detecting unauthorized access or data breach, and electronic storage of emails recorded in electronic media; Software as a service (SAAS) featuring software for the analysis and protection of the security of email and network communications and data, cybersecurity, email management virus protection, email archiving, email continuity and email security; computer security consultancy</p>	<p><b>Class 42:</b> Data encryption services; design and development of downloadable mobile computer applications for computer devices; electronic data storage</p>

The Examining Attorney refused registration of Applicant's Mark on the grounds that the identification of the Cited Mark is broadly worded and thus presumably encompasses at least a portion of the identification of Applicant's Mark. While Applicant disagrees that this is the case, a likelihood of confusion does not exist merely because similar marks are used in the same broad categories of goods or services. See, e.g., *Shen Mfg. Co.*, 73 USPQ.2d 1350 (cooking classes and kitchen textiles not related); *Local Trademarks, Inc. v. Handy Boys Inc.*, 16 USPQ.2d 1156 (TTAB 1990) (LITTLE PLUMBER for liquid drain opener held not confusingly similar to LITTLE PLUMBER design for advertising services in the plumbing field); *Quartz Radiation C01p. v. Comm/Scope Co.*, 1 USPQ.2d 1668 (TTAB 1986) (QR for coaxial cable held not confusingly similar to QR for various products in the photocopying field). Instead,

Here, contrary to the assessment in the Office Action, the identification of the Cited Mark is not broadly worded. The identification of the Cited Mark is limited to the fields of "data encryption services; design and development of downloadable mobile computer applications for computer devices; [and] electronic data storage." (Emphasis added.) Meanwhile, the identification for Applicant's Mark has been amended to emphasize that its services concern the analysis of emails to discover security threats.

Further, if the 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 confusion is not likely even if the marks are identical. See, e.g., *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1371, 101 USPQ.2d 1713, 1723 (Fed. Cir. 2012) ("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 COACH mark); *Shen Mfg. Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 1244-45, 73 USPQ.2d 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); *In re Thor Tech, Inc.*, 113 USPQ.2d 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, channels of trade, and high degree of care likely to be exercised by the relevant

consumers); *Local Trademarks, Inc. v. Handy Boys Inc.*, 16 USPQ.2d 1156, 1158 (TTAB 1990) (finding liquid drain opener and advertising services in the plumbing field to be sufficiently different that confusion as to source is unlikely even if offered under the same marks).

Here, consumers are unlikely to be confused as to the source of the services. First, Applicant notes there is no evidence that its services and the services of the Cited Mark (or even the services offered by the Cited Registrant) are complementary or otherwise similar such that both would be encountered as being offered by a single party. In fact, the services of Applicant's Mark are targeted to cybersecurity professionals interested in monitoring the security of an enterprise, while the services of the Cited Mark are targeted to biotechnology professionals interested in processing, analyzing, and storing Next Generation Sequencing (NGS) data for the purpose of discovering/monitoring cancer. As further described on the website of the Cited Registrant, the Cited Mark is used in connection with a software platform through which biotechnology professionals can interpret NGS data. See Exhibit A.

Due to the nature of the services covered by Applicant's Mark and the Cited Mark and the condition under which each mark would be encountered, Applicant further submits that any risk of a likelihood of confusion is eliminated. TMEP 1207.01(d)(vii) states that "circumstances suggesting care in purchasing may tend to minimize the likelihood of confusion." See, e.g., *In re N.A.D., Inc.*, 754 F.2d 996, 999-1000, 224 USPQ 969, 971 (Fed. Cir. 1985) (concluding that, because only sophisticated purchasers exercising great care would purchase the relevant goods, there would be no likelihood of confusion merely because of the similarity between the marks NARCO and NARKOMED); *Primrose Ret. Cmty., LLC v. Edward Rose Senior Living, LLC*, 122 USPQ.2d 1030, 1039 (TTAB 2016) (finding that "even in the case of the least sophisticated purchaser, a decision as important as choosing a senior living community will be made with some thought and research, even when made hastily").

Here, the services of the Cited Mark are targeted to biotechnology professionals. The circumstances surrounding the purchase and use of those services suggest that great care is likely to be taken when deciding whether to contact the Cited Registrant.



The decision to contact the Cited Registrant and acquire its services will not be done without significant research, planning, and discussion. In fact, those goods may only be purchasable by sophisticated individuals like those working in hospitals, research institutions, and the like. The same can be said for the services of Applicant's Mark. Therefore, it is highly unlikely that consumers will be confused as to the source of services offered by Applicant or services offered by the Cited Registrant.

## II. Refusal of Specimen

In the Office Action, the Examining Attorney refused registration because the specimen submitted by Applicant allegedly does not show Applicant's Mark in connection with any of the goods or services specified in Classes 9 and 38. To expedite prosecution, Applicant has elected to cancel Classes 9 and 38 in the present application. As such, Applicant believes that the refusal is moot.

## III. Identification of Goods and Services

The Examining Attorney has requested amendments to the identification of goods and services listed in the present application to clarify the scope. Applicant hereby submits amendments that largely conform with the Examining Attorney's recommendations and thus are believed to be acceptable.

Applicant amends the identification of goods and services in the present application as follows (where omitted language is shown in ~~strikethrough~~ and added language is shown in underlined):

**Class 9:** (Delete entire class) ~~Software for ensuring the security of electronic mail; electronic mail and messaging software; computer software for collection, storage, analysis and presentation of data for forensic analysis of security events and for security compliance; computer software for the administration, monitoring, management, assessment and quantification of security and data breach vulnerability risks;~~

**Class 38:** (Delete entire class) ~~Secure e-mail services;~~

## IV. Conclusion

**Class 42:** Computer services, namely, electronic mail (email) protection and security services, namely, services for analyzing email to discover security threats; Software as a service (SaaS) featuring software for ~~use in~~ the analysis

and protection of the security of email and network communications and data; Platform as a service (PAAS) featuring computer software platforms for use in the analysis and protection of the security of email and network communications and data; Email and messaging management services for others, namely, threat protection in the nature of computer virus protection services, monitoring of computer systems for detecting unauthorized access or data breach, and electronic storage of ~~data and~~ emails recorded in electronic media; Software as a service (SAAS) featuring software for use in the analysis and protection of the security of email and network communications and data, cybersecurity, email management virus protection, email archiving, ~~and~~ email continuity and email security; ~~design and development of antivirus software~~; computer security consultancy; none of the aforementioned related to data encryption services, design and development of downloadable mobile computer applications for computer devices or electronic data storage

Having responded to each of the issues raised in the Office Action, Applicant respectfully requests that the present application be approved for publication. If any questions remain, please contact the attorney of record.