

Argument in Response to Office Action

As a preliminary matter, Serial No. 88602116 has been abandoned and is no longer at issue.

Numerous trademarks in class using same term cut against a likelihood of confusion.

It is Applicant's contention that Serial Nos. 88761279 (REPLYFAST), 87680560 (REPLY PATH BY GENESYS) and 87680555 (REPLY PATH) are descriptive in nature. To the extent such would be deemed suggestive marks, the marks are weak and have no consumer recognition. (*W.W.W. Pharm. Co. v. Gillette Co.*, 984 F.2d 567, 572-572 (2d Cir. 1993), superseded on other grounds by *Deere & Co. v. MTD Prods., Inc.*, 41 F.3d 39 (2d Cir. 1994).) To date, Serial Nos. 87680560 and 87680555 have not been used in commerce to develop any consumer recognition. (*In re Morinaga Nyugyo Kabushiki Kaisha*, 120 U.S.P.Q.2d 1738, 1745 (T.T.A.B. 2016.)) Serial No. 88761279 has only been used in commerce since January 2020, in contrast to Applicant who has used the applied for mark in a substantial fashion in commerce since March 2015.

While the suggestive nature is not a factor in determining the validity of the registration of said applications, it is relevant when compared with the other 25 live marks in IC 042 (including, without limitation, Registration Nos. 4599599, 5790667, 5015113, and 5709971) that use the term "reply" in some fashion in relation to the design, development, and programming of software for computers and electronic devices. The multitude of marks currently registered in IC 042 that use a variant of the word "reply" strongly suggest that no likelihood of confusion will result from the registration of Applicant's mark because consumers have been exposed to such usage by several companies during the last six to nine years. Further, the targeted consumers are sophisticated users in a specialized and technical area that have experience distinguishing between similar marks for services in the same class of services. (*Checkpoint Sys., Inc. v. Check Point Software Techs., Inc.*, 269 F.3d 270 285-286 (3d Cir. 2011).) As a result, they will be able to distinguish between Applicant's services and those covered under Serial Nos. 88761279, 87680560 and 87680555, as well as the remaining 25 registrations.

The marks are distinguishable.

Applicant's mark is sufficiently distinguishable in name and services from Serial No. 88602116 (REPLYFAST). The mark is different in sound and visually given the use of the term "fast" combined with "reply" to mean a fast voice reply given the mark holder's description of services. Further, the goods are distinguishable. The mark REPLYFAST is used in relation to hosting, managing, and developing software for websites and electronic devices and is limited to personal productivity and remote data management software. The mark does not include sales or sales automation for personal and business communications, that involve the type of sales services identified by Applicant.

Applicant's mark is distinguishable from Serial No. 87680560 (REPLY PATH BY GENESYS), as the mark specifically uses the company name in the mark to relate the term "reply path" to the company, Genesys Telecommunications Laboratories, Inc. (*Autozone v. Tandy*, 373 F.3d 786, 796-797.) The same argument raised above for the descriptive nature of REPLYFAST is the same for REPLY PATH, Serial No. 87680555.

Given the descriptive nature of the applications raised by the examining attorney, or at best, weak suggestive marks, when coupled with the significant number of marks in this class that cover computer services, and consumer sophistication in this specialized, technical area, and ReplyApp's established presence in this area for more than five years to developed brand recognition, any potential likelihood of consumer confusion is minimal.