

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK EXAMINING DIVISION**

Applicant:	Equifax Inc.)	
)	
Mark:	LUMINATE)	
)	Laura Taraban
Serial No.:	88789009)	Examining Attorney
)	Law Office 127
Filed:	February 7, 2020)	

AMENDMENT AND RESPONSE TO OFFICE ACTION

Equifax Inc. (“Applicant”) received and reviewed the Office Action sent April 28, 2020, regarding U.S. Trademark Application Serial No. 88789009 (“Application”) to register the mark LUMINATE (“Applicant’s Mark”). Applicant submits the following Amendment and Response regarding the Application.

I. AMENDMENT TO THE IDENTIFICATION OF GOODS

In response to the Examining Attorney’s request, Applicant hereby requests that the identification of goods in the Application be amended as follows.

~~Class 36: Financial services, identity and fraud detection, protection, management, and assessment services rendered by financial analysis of big data, proprietary data, mathematical modeling, and risk scoring.~~

Class 42: Software as a services (SAAS) services for risk analysis, identity verification, identity authentication, data analysis, decisioning and analysis, consumer account management, and risk modeling, scoring, and analytics in the field of fraud detection and protection, and for providing alerts and notifications concerning possible fraud to detect and protect against fraud

~~Class 45: Providing fraud detection and alert services, namely, monitoring of the internet and public records and providing an alert as to changes therein to facilitate the detection and prevention of identity theft and fraud.~~

II. CONFUSION IS UNLIKELY

The Examining Attorney refused registration of Applicant's Mark based on a perceived likelihood of confusion with Registration No. 4810260 of the mark CODELUMINATE and Registration No. 5274207 of the mark CODELUMINATE & Design (collectively the "Cited Marks"). Applicant respectfully disagrees with this conclusion and submits that no likelihood of confusion exists between Applicant's Mark and the Cited Marks based on the differences in the marks and the differences in the services, particularly when considering the many other LUMINATE marks with which the Cited Marks already peacefully coexist, as well as the sophistication of the relevant consumers, the lack of any predatory intent, and the lack of actual confusion in the time the marks have coexisted.

In *In re E.I. DuPont de Nemours & Co.*, 177 U.S.P.Q. 563 (C.C.P.A. 1973), the Court of Customs and Patent Appeals listed thirteen factors to be considered in determining if a likelihood of confusion exists under Section 2(d) of the Trademark Act. According to that court, these factors **must** be considered when of record, and include the following factors pertinent to this

Response:

1. the similarity or **dissimilarity of the marks in their entirety**;
2. the similarity or **dissimilarity and nature of the goods or services as described** in an application or registration or in connection with which a prior mark is in use;
3. the conditions under which, and **buyers to whom, sales are made**, i.e., "impulse" vs. careful, sophisticated purchasing;
4. the **number and nature of similar marks in use on similar goods**;
5. the **length of time during and conditions under which there has been concurrent use without evidence of actual confusion**; and

6. any other established fact probative of the effect of use.

Id. at 567 (emphasis added).

The question of likelihood of confusion turns “not [on] the **nature** of the mark, but [on] its **effect** when applied to the goods of the applicant.” *Id.* at 567 (emphasis added). “The words ‘when applied’ do not refer to a mental exercise, but to all of the known circumstances surrounding use of the mark” in the marketplace. *Id.* Thus, in addition to the enumerated factors, other probative factors (such as the absence of predatory intent, for example) should be considered.

The Office Action addressed only the similarity of Applicant’s Mark to the Cited Marks and similarities between Applicant’s services and the services offered under the Cited Marks. However, careful consideration of these factors, together with a full evaluation of the other above factors, confirms there is no likelihood of confusion between Applicant’s Mark and the Cited Marks.

A. Applicant’s Mark is Dissimilar from the Cited Marks.

Applicant’s Mark is not likely to cause confusion with the Cited Marks because the marks are notably different when compared in their entireties. It is “a basic rule of comparison of marks” that “marks must be considered in their entireties in determining whether there is a likelihood of confusion or mistake.” *Massey Junior Coll., Inc. v. Fashion Inst. of Tech.*, 181 U.S.P.Q. 272, 273-74 (C.C.P.A. 1974) (holding FIT and FIT & Design not confusingly similar to FIA & Design); *accord In re Hearst Corp.*, 25 U.S.P.Q.2d 1238, 1239 (Fed. Cir. 1992) (holding VARGA GIRL not confusingly similar to VARGAS; “Marks tend to be perceived in their entireties, and all components thereof must be given appropriate weight.”).

Compared in their entireties, the marks are different in numerous respects, especially as the marks have completely different beginning terms. Courts have long held that the addition of

extra terms, or replacement with different terms, can appreciably reduce the likelihood of confusion between two marks. *See In re Hartz Hotel Servs. Inc.*, 102 U.S.P.Q.2d 1150, 1154 (T.T.A.B. 2012) (GRAND HOTELS NYC and GRAND HOTEL, both for hotel services, not confusingly similar); *Safer, Inc. v. OMS Invs., Inc.*, 94 U.S.P.Q.2d 1031, 1044-45 (T.T.A.B. 2010) (DEER-B-GON not confusingly similar to DEER AWAY, both used for animal repellent); *Sweats Fashions, Inc. v. Pannill Knitting Co.*, 4 U.S.P.Q.2d 1793, 1796 (Fed. Cir. 1987) (SWEATS not confusingly similar to ULTRA SWEATS, both used for sportswear); *Consol. Cigar Corp. v. R.J. Reynolds Tobacco Co.*, 181 U.S.P.Q. 44, 45 (C.C.P.A. 1974) (DUTCH APPLE for pipe tobacco not confusingly similar to DUTCH MASTERS for cigars); *Colgate Palmolive Co. v. Carter-Wallace, Inc.*, 167 U.S.P.Q. 529, 530 (C.C.P.A. 1970) (PEAK PERIOD not confusingly similar to PEAK); *Servo Corp. of Am. v. Servo-Tek Prod. Co.*, 129 U.S.P.Q. 352, 353 (C.C.P.A. 1961) (SERVOSPEED not confusingly similar to SERVO). Here, the inclusion of the term “CODE” in the Cited Marks CODELUMINATE and CODELUMINATE & Design renders those marks distinguishable from Applicant’s Mark for a number of reasons.

First, the term “CODE” makes the marks distinct visually, and the CODELUMINATE & Design mark additionally includes a distinctive circular shape with opposing curved lines passing through it (shown below), even further differentiating that mark.



Second, the Cited Marks, when spoken, include an additional syllable resulting in a longer sounding mark. The Cited Marks begin with a hard consonant “Koh” sound in contrast to the softer, more lyrical “Loo” sound present in the first, and most prominent portion of Applicant’s

Mark. Indeed, the “Loo” sound in the Cited Marks is buried in the second syllable and tends to blur with the “Duh” sound at the end of the first syllable of those marks.

These important visual and aural differences substantially reduce the likelihood of confusion between the marks. *See Hornady Mfg. Co. v. Doubletap, Inc.*, 746 F.3d 995, 1003 (10th Cir. 2014) (finding no confusion between TAP and DOUBLE TAP and noting that “the monosyllabic ‘tap’ does not sound like the polysyllabic ‘double tap’ ”); *see also Promark Brands Inc. & H.J. Heinz Co.*, 114 U.S.P.Q.2d 1232, 1244-45 (T.T.A.B. Mar. 27, 2015) (finding that, where the number of syllables is different, confusion is less likely); *Nat’l Distillers & Chem. Corp. v. William Grant & Sons, Inc.*, 184 U.S.P.Q. 34 (C.C.P.A. 1974) (finding no likelihood of confusion and noting the importance of the differences in pronunciation of DUET as compared to DUVET).

Third, the marks are clearly different in terms of connotation and commercial impression when considered together with the services offered under the marks. Significantly, the Cited Marks incorporate the term “CODE” as the initial and dominant term; it is well-established that purchasers are far more likely to focus on this first portion of the Registrant’s Marks than the second. *See, e.g., Younghusband v. Kurlash Co.*, 94 F.2d 230, 231–32 (C.C.P.A. 1938) (“We believe that purchasers would pay little attention to the last syllable of the marks as bearing upon the origin of the goods, but, seeing the marks as a whole, the mind would fasten upon the syllable ‘Kur’ in appellee’s [KURLASH] mark and ‘Star’ in appellant’s [STARLASH] mark, and the last syllable in each mark would be given little attention other than with respect to its descriptive character.”). The Board has in fact stressed that the lead element in a mark is the dominant portion of a trademark because “it is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered.” *Presto Prods., Inc. v. Nice-Pak*

Prods., Inc., 9 U.S.P.Q.2d 1895, 1897 (T.T.A.B. 1988); *see also Flagstar Bank, FSB v. Freestar Bank, N.A.*, 687 F. Supp. 2d 811, 824 (C.D. Ill. 2009) (confusion unlikely between FLAGSTAR and FREESTAR marks for competitive banking services because “the first word of each mark is distinctly different”); *Glenmore Distilleries Co. v. Nat’l Distillers Prods. Corp.*, 39 U.S.P.Q. 65, 69 (E.D. Va. 1938) (“Where the competing trade marks each consists of two words, the last word in each being the same and the first word in each being distinctly different, the great weight of authority is that no infringement exists.”); *Coca-Cola Co. v. Carlisle Bottling Works*, 43 F.2d 101, 110 (E.D. Ky. 1929) (“[I]n all such cases the first word is the more prominent of the two both to the eye and to the ear. Indeed, the prominence may be such as to dominate.”), *aff’d*, 43 F.2d 119 (6th Cir. 1930).

Here, given that the services offered under the Cited Marks relate to computer security, consumers are likely to view the Cited Marks as connoting services related to illuminating computer code for purposes of computer security. And, consumers are particularly apt to rely on the “CODE” portion of the Cited Marks for providing information about the services offered under those marks in view of the coexistence of other LUMINATE-formative marks on the trademark registry (as identified below). In contrast to the Cited Marks, Applicant’s Mark does not similarly include the term “CODE” or a term similar thereto, nor does it in any way evoke computer code; this is because Applicant’s services do not relate to computer code or computer security services. Rather, Applicant’s Mark, which comprises the term “LUMINATE” standing alone, could be read by consumers as having numerous meanings when considered in connection with Applicant’s fraud- and identity-related services (which are not related to computer systems or computer security), including connoting services related to shining light on data available through the internet and public records, or suggesting services of providing the user with insights

about fraud that can be used in making important decisions related to consumer accounts. Because Applicant's Mark and the Cited Marks have such different meanings and commercial impressions, they stimulate different responses in the minds of consumers, making confusion between the overall marks unlikely. *See 7-Eleven, Inc. v. Wechsler*, 83 U.S.P.Q.2d 1715, 1725-26 (T.T.A.B. 2007) (no likelihood of confusion between the BIG GULP and GULPY where "the differences in the connotation and commercial impression engendered by GULP and BIG GULP, on the one hand, and GULPY, on the other, outweigh any similarities in the appearance and sound of the marks"); *see also Morrison Milling Co. v. General Mills, Inc.*, 436 F.2d 1050 (C.C.P.A. 1971) (finding no likelihood of confusion between CORN-KITS and CORN KIX, despite similarities in sound and appearance, because the marks "possess entirely different connotations").

Notwithstanding these differences, the Office Action speculates that "Applicant's mark is likely to appear to prospective purchasers as a shortened form of registrant's mark." This position not only ignores the notable differences in the sight, sound, and commercial impressions of the marks, it is also contrary to established precedent regarding the importance of the first portion of the mark in a consumer's mind, especially when shortening a mark. The Cited Marks are relatively short, comprising a succinct four syllables, and thus are unlikely to be shortened at all. To the extent they might be shortened, it is far less likely that the second portion of the trademark, rather than the first, would receive the attention from consumers (particularly in view of the field of coexisting LUMINATE-formative marks identified below). The Cited Marks thus are more likely to be shortened to CODE than to LUMINATE. Indeed, both cases cited by the Office Action for the proposition that Applicant's Mark would be perceived as a shortened form of the Cited Marks support the conclusion that the Cited Marks are likely to be shortened to

CODE: in both cases confusingly similarity was found based on the first portion of the cited mark, which was assumed to be retained by consumers. *See In re Mighty Leaf Tea*, 601 F.3d 1342 (Fed. Cir. 2010) (ML found confusingly similar to ML MARK LEES); *In re Optica Int'l*, 196 U.S.P.Q. 775 (T.T.A.B. 1977) (OPTIQUE found confusingly similar to OPTIQUE BOUTIQUE). *See also Younghusband v. Kurlash Co.*, 94 F.2d 230, 231–32 (C.C.P.A. 1938) (“We believe that purchasers would pay little attention to the last syllable of the marks as bearing upon the origin of the goods, but, seeing the marks as a whole, the mind would fasten upon the syllable ‘Kur’ in appellee’s [KURLASH] mark and ‘Star’ in appellant’s [STARLASH] mark, and the last syllable in each mark would be given little attention other than with respect to its descriptive character.”). Given the general prominence of the first portion of a trademark, the Office Action’s assertion that Applicant’s Mark would be seen as a shortened version of the Cited Marks is unlikely and pure speculation.

Comparing Applicant’s Mark and the Cited Marks as a whole, the differences in the marks are significant and preclude a likelihood of confusion.

B. The Services Offered Under Applicant’s Mark are Sufficiently Distinct From the Services Offered under the Cited Marks to Avoid Confusion.

The services offered under Applicant’s Mark are different from the services of the Cited Marks, further establishing a lack of likely confusion. The fact that both parties offer technology-related services is not determinative of confusion. Indeed, the law is clear that even if two parties’ goods or services are sold in the same general field, *per se* rules for categories of goods and services are “improper and inconsistent with § 2(d) of the Lanham Act.” *Interstate Brands Corp. v. Celestial Seasonings, Inc.*, 576 F.2d 926, 928 (C.C.P.A. 1978) (confusion unlikely between ZINGERS for cakes and RED ZINGERS for herb tea); *see In re Promark Brands Inc.*, No. 75941977, 2004 WL 2202257, at *3 (T.T.A.B. Sept. 7, 2004) (confusion unlikely between

NATURE’S GOODNESS for baby food and NATURE’S GOODNESS for dietary supplements); *see also Good Earth Corp. v. M.D. Horton & Assoc.*, No. CV-94-3455-CAL, 156 F.3d 1236, 1998 WL 391450 (Table) *2-3 (9th Cir. 1998) (confusion unlikely between GOOD EARTH for teas and natural foods and GOOD EARTH for restaurant services); *see also Elec. Design & Sales, Inc. v. Elec. Data Sys. Co.*, 954 F.2d 713, 716 (Fed. Cir. 1992) (confusion unlikely between E.D.S. & Design for power supplies and EDS for computer programming services); *H.D.T. Co. Factors, Inc. v. Sinclair*, 288 F.2d 947, 949 (C.C.P.A. 1961) (confusion unlikely between CORAL for soap and BLUE CORAL for cleaner and wax). The Board has even allowed registration of virtually identical marks (which is not the case here) used on “undeniably related goods.” *See, e.g., In re Sears, Roebuck & Co.*, 2 U.S.P.Q.2d 1312, 1314 (T.T.A.B. 1987) (confusion unlikely between CROSS-OVER for bras and CROSSOVER for ladies’ sportswear).

Here, the differences in the services offered under the respective marks are far more substantial than the Office Action suggests, and consumers are unlikely to be confused as to the source of services offered under Applicant’s Mark. Although the Office Action submits that “the application and registration use broad wording” which encompasses the other party’s services, this is simply not the case. The Office Action focused specifically on a perceived similarity of the following services:

Cited Marks’ Services: **Monitoring** of **computer software and systems for security purposes.**

Applicant’s Services: Providing fraud detection and alert services, namely, **monitoring** of the **internet and public records** and providing an alert as to changes therein **to facilitate the detection and prevention of identity theft and fraud.**

The differences in the services are readily apparent when compared with each other side-by-side. In particular, the services under the Cited Marks involve the monitoring of computer software, whereas the services under the Application involve the monitoring of the internet and public

records. The services covered by the Cited Marks are focused internally, on the user's computer, and the services covered by Applicant's Mark are focused externally, on data outside the user's computer system and software. The only similarity between the services is that monitoring is involved; but what is being monitored is entirely different.

Moreover, the user's services are for "security purposes," and, indeed, the phrase "*computer security*" is used several times throughout the description of services in the Cited Marks. In contrast, Applicant's services "facilitate the detection and prevention of *identity theft and fraud*." The Office Action's conclusion as to similarity appears to be based on an improper assumption that computer security and identity theft and fraud are the same. However, "Computer Security" refers to "the protection of computer systems and information from harm, theft, and unauthorized use." See <https://www.britannica.com/technology/computer-security> and **Exhibit A** (providing a true and accurate printout of the Britannica.com page devoted to "computer security"). "Computer security" therefore involves protecting against theft, vandalism, fraud, and invasion of privacy as those risks pertain to *a user's computer*. In contrast, "identity theft and identity fraud are terms used to refer to all types of crimes in which someone wrongfully obtains another person's personal data in some way that involves fraud or deception." See <https://www.justice.gov/criminal-fraud/identity-theft/identity-theft-and-identity-fraud> and **Exhibit B** (providing a true and accurate printout of the United States Department of Justice's definition of Identity Theft and Identity Fraud). The "detection and prevention of identity theft and fraud" therefore involves identifying and stopping crimes involving the theft of an *individual's personal information*. The services offered under the Cited Marks providing protection against a risk to computer hardware and software are wholly distinguishable from Applicant's services involving protection against a risk to an individual's identity, and for this

reason the “monitoring” performed by the parties under their respective marks—i.e., “monitoring of computer software and systems” versus “monitoring of the Internet and public records”—is different.

The Office Action also noted a perceived similarity of the following services, taking the position that the Cited Marks’ services cited below are encompassed by Applicant’s below-cited services:

Cited Marks’ Services: Security service, namely, restricting access to and by computer networks to and of undesired websites, media and individuals and facilities; computer security services, namely, enforcing, restricting and controlling access of privileges of users of computing resources for cloud, mobile or network resources based on assigned credentials.

Applicant’s Services: Software as a services (SAAS) services for risk analysis, identity verification, identity authentication, data analysis, decisioning and analysis, consumer account management, and risk modeling, scoring, and analytics in the field of fraud detection and protection, and for providing alerts and notifications concerning possible fraud to detect and protect against fraud.

Specifically, according to the Office Action, the Cited Marks’ Services “merely identify specific types of identity verification and authentication and consumer account management used to restrict, enforce, and control access to computer networks and resources.” However, neither the services recitations nor any evidence cited in the Office Action supports such a conclusion. The Cited Marks involve “computer security”, i.e., services pertaining to a user’s computer. In contrast, the Applicant’s Marks are used to identify, verify, and analyze the risk posed by potentially fraudulent actors external to the user’s computer. There is no indication in Applicant’s recitation that its services related to identity verification and authentication would in any way involve the Cited Mark’s computer-security-related services of “restricting access to and by computer networks to and of undesired websites” or of “enforcing, restricting and controlling access of privileges of [computer] users”; this is because Applicant simply does not

offer such services under Applicant's Mark, as confirmed in the product sheet for Applicant's LUMINATE services, which is attached as **Exhibit C**. Indeed, as previously explained, Applicant's services are not directed at computer security but rather towards fraud and identity theft, and more specifically, at providing businesses with tools to help make them aware of possible fraud and provide them with tools to analyze data, perform risk analysis, verify and authenticate the identity of consumers, make decisions relating to new customer accounts, and create risk models and scores, all related to fraud. *See* Exhibit C.

Because the respective marks offer two entirely distinct and specialized services, they are unlikely to be confused. Moreover, only a sophisticated group of consumers seek out and purchase these specialized services.

C. The Sophistication of the Buyers and the Careful Conditions Under Which Applicant's Services and Those of the Cited Marks are Purchased Makes Confusion Even Less Likely.

In determining the likelihood of confusion between marks, courts must examine "[t]he conditions under which, and buyers to whom, sales are made, i.e. 'impulse' vs. careful, sophisticated purchasing." *Du Pont*, 476 F.2d at 1361. As the Federal Circuit has explained, even if purchasers of two mark owners' goods or services are the same, "their sophistication is important and often dispositive because sophisticated consumers may be expected to exercise greater care." *Elec. Design & Sales Inc. v. Elec. Data Sys. Corp.*, 954 F.2d 713, 718 (Fed. Cir. 1992) (quoting *Pignons S.A. de Mecanique de Precision v. Polaroid Corp.*, 657 F.2d 482, 489, (1st Cir. 1981)).

Confusion between Applicant's Mark and the Cited Marks is unlikely because consumers of Applicant's fraud management platform and the consumers of computer security services covered by the Cited Marks are sophisticated consumers that purchase such services with great

care. The Board has found in the past that participants in certain industries are inherently sophisticated, even if the claims at issue in the USPTO are unrestricted as to customers. *See Calypso Tech., Inc. v. Calypso Capital Mgmt., LP*, 100 U.S.P.Q.2d 1213, 1222 (T.T.A.B. 2011) (“[B]ecause of the cost and the purpose of the [applicant’s] software, the financial institutions purchasing software for core processing and control will be careful and sophisticated as well.”). *See also Edwards Lifesciences Corp. v. VigiLanz Corp.*, 94 U.S.P.Q.2d 1399, 1413 (T.T.A.B. 2010) (confusion unlikely between VIGILANZ and VIGILANCE marks, both for medical monitoring equipment, in part on ground that parties’ goods “are purchased and licensed only after careful consideration by persons who are highly knowledgeable about the products”); *Universal Money Ctr.*, 797 F. Supp. at 896 (UNIVERSAL for combination telephone and retail credit card not confusingly similar to UNIVERSAL MONEY CARD for ATM card in part because “average consumer will be aware of the services” offered by credit card “and will be aware of the source”).

Specifically, the target audience for Applicant’s services, i.e., services related to identifying identity theft and fraud, is a sophisticated one, and purchases are made with great care. *See Exhibit C* (showing that target market of services is businesses’ “risk managers”). Likewise, consumers seeking the computer security services offered under the Cited Marks are prudent consumers knowledgeable about such services who are highly likely to be cautious purchasers. *Checkpoint Sys., Inc. v. Check Point Software Techs., Inc.*, 269 F.3d 270, 285 (3d Cir. 2001) (finding no likelihood of confusion between CHECKPOINT for physical security products and CHECKPOINT for computer network security products, in part because consumers of such products “place great importance on, and take great care in, purchasing these products”).

Here, because the target consumers are making purchases carefully and deliberately, rather than impulsively, the risk of consumer confusion is significantly reduced. *See Nationwide Mut. Ins. v First Nationwide Sav.*, 221 U.S.P.Q. 686, 691 (S.D.N.Y. 1982) (holding no confusion likely in the common use of NATIONWIDE mark for insurance and for banking services because highly sophisticated clients purchase insurance or invest in a savings and loan); *Wachovia Bank & Trust Co. v. Crown Nat'l Bancorp*, 835 F. Supp. 882, 27 U.S.P.Q.2d 1698 (W.D.N.C. 1993) (WACHOVIA CROWN ACCOUNT for banking services and CROWN NATIONAL BANK for banking services not likely to be confused in part because consumers who are “likely to shop for financial services . . . [are] less likely to be confused than the general public.”).

D. The Coexistence of Other Marks Incorporating the Term LUMINATE for Security-Related Services Supports Registration of Applicant’s Mark.

The Cited Marks peacefully coexist on the registry with several marks covering services in Class 42, including the following.



Mark	Reg./App. No.	Relevant Classes / Goods	Owner
LUMINATE	Reg. 5677251	Class 42: Design and development of computer hardware and software for the collection and analysis of data and its subsequent interpretation and dissemination all relating to transport; installation, commissioning, maintenance and repair of computer software and information systems software for transport; software as a service (SAAS) services, namely, hosting software for use by others for use in transport signalling control, operational management, data analysis, information dissemination, and provision of recommendations relating to transport.	Resonate Group Limited

Mark	Reg./App. No.	Relevant Classes / Goods	Owner
LUMINATE	Reg. 5671593	Class 42: Computer services, namely, creating an on-line community for registered users to organize groups and events, participate in discussions, get feedback from their peers and engage in social, business and community networking.	Luminate Labs, LLC
LUMINATE	Reg. 4491488	Class 42: Design and development of software and software development tools in the field of interactive image applications; platform as a service (PAAS) featuring computer software platforms for facilitating digital image interactivity; providing online non-downloadable software and software development tools for use in viewing, organizing, manipulating, tagging, commenting on, drawing on, adding content to, sharing, and obtaining additional information about digital images and video...	Luminate, Inc.
LUMINATE	Reg. 4136791	Class 42: Computer software consulting services in the fields of fund-raising, special event and advocacy software; Providing on-line non-downloadable software for constituent relationship management in the fields of fundraising, special event planning and public advocacy...	Convio, Inc.
eLUMINATE	Reg. 4651515	Class 42: Providing temporary use of online non-downloadable software for customer relationship management, generating custom reports to track preset performance metrics and employee progress, and creating customizable documents and data fields.	eGenerationMarketing, Inc.
LUMINATE	App. 87816339 (Allowed)	Class 42: Software as a service (SAAS) services, namely, hosting software for use by others for use	JDA Software Group, Inc.

Mark	Reg./App. No.	Relevant Classes / Goods	Owner
		for managing supply and demand chains in the retail, grocery, wholesale distribution, manufacturing, hospitality and media industries; Software as a service (SAAS) services, namely, hosting software for use by others for managing and planning operations, resource allocation, inventory, customers, customer service, pricing and revenue...	

The certificates for the above registrations and TSDR printout for the application are attached as **Exhibit D**. These registrations and application are all active and all currently coexist with the Cited Marks. Indeed, the registry even includes several other LUMINATE-formative marks explicitly covering security-related services, including the following:

Mark	Reg./App. No.	Relevant Classes / Goods	Owner
ILLUMINATE	Reg. 5928302	<p>Class 35: Business data analysis; collection and analysis of data for business purposes; compiling and analyzing statistics, data and other sources of information for business purposes; consulting services in the field of company, business sector, and industry data and research.</p> <p>Class 42: Machine data management services, namely, collecting, monitoring and analyzing data generated by computer applications, computer systems, and computer networks for use in IT operations, IT application management, IT security and compliance; educational services, namely, conducting end user conferences and seminars for product- and service- specific training in the field of real-time machine data analytics.</p>	Sumo Logic, Inc.

Mark	Reg./App. No.	Relevant Classes / Goods	Owner
RISKIQ ILLUMINATE	Reg. 6013002	Class 42: Cloud computing featuring software for use in digital risk management to identify, protect, detect, respond and recover from cybersecurity and reputation events in the fields of information security and cybersecurity; managed cybersecurity services to identify, protect, detect, respond, and recover from cybersecurity and reputation events in the fields of information security and cybersecurity	RiskIQ, Inc.
ELLUMINATES SOFTWARE	Reg. 2883895	Class 42: Computer consultation on the computer-related aspects of e-commerce and information technology security	Elluminates Software Corporation
	Reg. 6048237	Class 42: Computer consultation on the computer-related aspects of e-commerce and information technology security	Elluminates Software Corporation
	Reg. 2972473	Class 42: Computer consultation on the computer-related aspects of e-commerce and information technology security	Elluminates Software Corporation
ILLUMINATE THE DEEP DARK WEB	Reg. 4940185	Class 42: Computer consultation in the field of computer security; software as a service (saas) services featuring software for use in security threat analysis, namely, software for collecting, filtering, sanitizing, normalizing, tracking, converting, interpreting, indexing, analyzing and managing data and intelligence from communication and computer network systems, and providing reports and alerts in connection therewith; software as a service (SAAS) services featuring software for use in cybersecurity intelligence and protection, namely, software for the detection and mitigation of computer viruses, malware, network anomalies and security breaches.	EJ2 Communications, Inc.

Mark	Reg./App. No.	Relevant Classes / Goods	Owner
		Class 45: providing news and information concerning safety and security threats to governments, individuals, businesses and organizations; providing a website with news and information concerning safety and security threats to governments, individuals, businesses and organizations; consultation services concerning homeland safety and security issues; consulting services in the field of maintaining the security and integrity of databases; security threat analysis for personal protection purposes; security threat analysis for protecting public safety; security threat analysis for personal protection and public safety purposes and preparation of reports in connection therewith; security services, namely, collecting data and information from communication and computer network systems to alert security teams about increased risks and threats; security monitoring services, namely, monitoring communication and computer network systems for security purposes.	

The certificates for these registrations are attached as **Exhibit E**. These applications and registrations are all active and all currently coexist with the Cited Marks.

By allowing registration of both of the Cited Marks as well as the marks outlined in the chart above, the USPTO has confirmed that the differences between the marks are sufficient to render them distinguishable. The extent of active third-party registered marks incorporating the term LUMINATE precludes any of these users, as well as the owners of the Cited Marks, from “claim[ing] a right to exclusive use extending beyond a specific mark for specific goods.”

Keebler Co. v. Assoc. Biscuits, Ltd., 207 U.S.P.Q. 1034, 1039 (T.T.A.B. 1980) (no confusing similarity between JACOB’S CLUB and CLUB); *see also In re Broadway Chicken, Inc.*, 38 U.S.P.Q.2d 1559 (T.T.A.B. 1996) (BROADWAY CHICKEN not confusingly similar to BROADWAY PIZZA, both for restaurant services); *General Mills, Inc. v. Health Valley Foods*, 24 U.S.P.Q.2d 1270 (T.T.A.B. 1992) (FIBER 7 FLAKES not confusingly similar to FIBER ONE, both for breakfast cereals); *U.S. Plywood-Champion Papers, Inc. v. Novagard Corp.*, 179 U.S.P.Q. 561 (T.T.A.B. 1973) (NOVACALK for caulk not confusingly similar to “NOVI” and “NOVO” family of marks in the construction industry).

The fact that the foregoing registrations coexist with the Cited Marks, despite the shared term LUMINATE, demonstrates that customers can distinguish such marks on the basis of other differences between the marks and underlying services. Given the abundance of third party registrations, there is no likelihood that consumers would be confused as to the source of the services at issue. *In re Thor Tech, Inc.*, 113 U.S.P.Q.2d 1546 (T.T.A.B. Jan. 26, 2015) (finding confusion unlikely between TERRAIN for towable trailers and TERRAIN for trucks given the many third-party registrations for similar marks for vehicles and recreational vehicle trailers). Thus, confusion is unlikely because the coexisting registrations incorporating the term LUMINATE accustom consumers to discriminate between these types of marks.

Given the number of coexisting registrations owned by unrelated applicants that incorporate the term LUMINATE, the differences between Applicant’s Mark and those marks and the Cited Marks, and the differences in the respect services, Applicant submits that confusion between its mark and the Cited Marks is highly unlikely.

E. The Absence of Any Evidence of Actual Confusion Confirms Confusion Between the Marks is Unlikely.

The concurrent use of marks without actual consumer confusion constitutes additional evidence future confusion is unlikely. *See, e.g., In re E.I. Du Pont de Nemours & Co.*, 476 F.2d at 1361; *see also* Restatement (Third) of Unfair Competition § 23, cmt. d at 251 (1995) (“[T]he absence of evidence of actual confusion may . . . justify the inference that the actor’s use does not create a likelihood of confusion.”). Applicant’s Mark has been in use in connection with the services offered under the Application since September 2019 and the Cited Marks have been in use since 2013 and 2015 respectively¹. Therefore, the marks have been in concurrent use for over a year. Applicant is not aware of a single incident of actual or possible confusion during this period. “This lack of evidence [of actual confusion] is certainly not dispositive where the issue is likelihood of confusion, mistake or deception, but it does suggest that the marks are not so easily confused.” *Mr. Hero Sandwich Sys., Inc. v. Roman Meal Co.*, 781 F.2d 884, 888 (Fed. Cir. 1986).

F. There Is No Intent of Applicant to Trade Off of the Goodwill of the Cited Marks.

“It is well established that an intent of the alleged infringer to gain through confusing customers or others is relevant to the issue of likelihood of confusion.” 4 J. Thomas McCarthy, *MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION* § 23:110 (4th ed. 2017). Therefore, “courts regularly include intent as one of the factors to be assessed in evaluating likelihood of confusion.” *RESTATEMENT (THIRD) OF UNFAIR COMPETITION* § 22 rptr. note to cmt. b, at 246 (1995). In this instance, Applicant had no intent to trade upon anyone’s reputation by applying to

¹ Indeed investigations into use of the Cited Marks has revealed that the registrant is not using the Cited Marks and has not used the Cited Marks since August 2018, over a year prior to the first use date claimed in the Application even further reducing any likelihood of consumer confusion.

register Applicant's Mark, including that of the Cited Marks' registrants. Thus, this factor also supports registration of Applicant's Mark. *See, e.g., Pinkette Clothing, Inc. v. Cosmetic Warriors Ltd.*, 894 F.3d 1015, 1028 (9th Cir. 2018) (considering good-faith adoption of junior mark probative evidence of unlikelihood of confusion); *accord Tana v. Dantanna's*, 611 F.3d 767, 778 (11th Cir. 2010); *Icebreaker Ltd. v. Gilmar S.P.A.*, 911 F. Supp. 2d 1099, 1010-11 (D. Or. 2012); *GoSMiLE, Inc. v. Dr. Jonathan Levine, D.M.D. P.C.*, 769 F. Supp. 2d 630, 645-66 (S.D.N.Y. 2011); *Kastanis v. Eggstacy LLC*, 752 F. Supp. 2d 842, 857-58 (N.D. Ill. 2011); *Omaha Nat'l Bank v. Citibank (S.D.), N.A.*, 229 U.S.P.Q. 51, 52 (D. Neb. 1986).

G. Under an Application of all the Relevant Factors, Confusion is Unlikely.

When determining whether Applicant's Mark creates a likelihood of confusion with a mark covered by a cited registration or application, "[a] showing of mere possibility of confusion is not enough; a **substantial likelihood** that the public will be confused must be shown." *Omaha Nat'l Bank v. Citibank (S.D.), N.A.*, 229 U.S.P.Q. at 52 (emphasis added). Applicant submits that the factors set forth in *DuPont* for which there is record evidence support registration of Applicant's Mark and do not raise a substantial likelihood of confusion. Under these circumstances, Applicant's Mark should be approved for publication.

III. CONCLUSION

Accordingly, in light of the foregoing arguments in favor of publication, Applicant respectfully requests that its Application be approved for publication.