# TO THE UNITED STATES
# COMMISSIONER FOR TRADEMARKS

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|---|---|
| APPLICANT: | Telchemy, Inc. |
| SERIAL NO.: | 88251978 |
| FILED: | Jan. 07, 2019 |
| MARK: | **VQANALYZER** |
| EXAMINER: | Rebecca D. Coughlan |
| TRADEMARK LAW OFFICE: | 115 |
| OUR DOCKET | 500426 |

*FILED ELECTRONICALLY VIA TEAS*

## RESPONSE TO OFFICE ACTION

Dear Commissioner:

This is in response to the Office Action mailed on May 13, 2020.

## I.  SUMMARY

In this Office Action, the Examiner noted the following summary of issues:

- Section 2(d) Refusal – Likelihood of Confusion

In response, Applicant, through its undersigned attorney, respectfully presents arguments as to why the application is now worthy of approval, and respectfully pleads that the grounds for refusal are now overcome and that the application should advance to publication.

## II. HISTORY

### A) Applicant's Application

Applicant's application is summarized as follows:

| | |
|---|---|
| **Trademark:** | VQANALYZER |
| **Appn no:** | 88251978 |
| **Filing date:** | Jan. 07, 2019 |
| **Goods/Services:** | Downloadable software application for processing a captured series of voice and video packets for monitoring and testing the performance of Internet Protocol based data and content (Class 009)<br><br>Providing temporary use of a non-downloadable software application for processing a captured series of voice and video packets for monitoring and testing the performance of Internet Protocol based data and content (Class 042) |
| **Applicant:** | Telchemy, Inc. |

B) Section 2(d) Refusal – Likelihood of Confusion

The Examiner issued a Section 2(d) refusal based on the following single registration:

| MARK | REG NO | GOODS/SERVICES |
|------|--------|----------------|
| **VQ** | **6004828** | Computer software which provides tools for users to ingest, store, index, archive, tag, search, retrieve, visualize, annotate, transmit and digitize video and imagery data types and metadata, namely, electro-optical and infrared video data, still image data, wide area imagery data, commercial satellite data, multi-spectral and hyperspectral data, geospatial data, track location data, text data, and cyber network data, and tools that provide automated, analysis of video and imagery data types, namely, person, vehicle, ship, object, face, and group, activity detection, recognition, and tracking, pattern recognition, deep learning, classification, artificial intelligence, and the association and fusion of information across data types, all of the aforementioned goods of class 9 not for surveying, measuring or laser scanning (CLASS 009) <br><br> Providing cloud computing services, providing software as a services (SAAS) and providing platform as a service (PAAS) which provides tools for users to ingest, store, index, archive, tag, search, retrieve, visualize, annotate, transmit and digitize video and imagery data types and metadata, namely, electro-optical and infrared video data, still image data, wide area imagery data, commercial satellite data, multi-spectral and hyperspectral data, geospatial data, track location data, text data, and cyber network data, and tools that provide automated, analysis of video and imagery data types, namely, person, vehicle, ship, object, face, and group, activity detection, recognition, and tracking, pattern recognition, deep learning, classification, artificial intelligence, and the association and fusion of information across data types, all of the aforementioned services of class 42 not for surveying, measuring or laser scanning (CLASS 042) |

C) Similarity of the Marks

The Examiner set forth the following comments under the heading "**SECTION 2(D) REFUSAL**":

> *Marks are compared in their entireties for similarities in appearance, sound, connotation, and commercial impression. Stone Lion Capital Partners, LP v. Lion Capital LLP, 746 F.3d 1317, 1321, 110 USPQ2d 1157, 1160 (Fed. Cir. 2014) (quoting Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772, 396 F.3d 1369, 1371, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005)); TMEP §1207.01(b)-(b)(v). "Similarity in any one of these elements may be sufficient to find the marks confusingly similar." In re Inn at St. John's, LLC, 126 USPQ2d 1742, 1746 (TTAB 2018) (citing In re Davia, 110 USPQ2d 1810, 1812 (TTAB 2014)), aff'd per curiam, 777 F. App'x 516, 2019 BL 343921 (Fed. Cir. 2019); TMEP §1207.01(b).*

> *Applicant's mark VQANALYZER and registrant's mark VQ  are confusingly similar.*

> *Applicant's mark and registrant's mark are similar in appearance, sound, meaning, and commercial impression. The marks share the  term VQ which is identical in appearance and sound and which create the same impression of vector quantization in each of the marks. See attached evidence from acronymfinder.com dfining VQ*

> *Applicant's addition of the word ANALYZER to the registered mark does not obviate a finding of a likelihood of confusion. Adding a term to a registered mark generally does not obviate the similarity between the compared marks, as in the present case, nor does it overcome a likelihood of confusion under Section 2(d). See Coca-Cola Bottling Co. v. Jos. E. Seagram & Sons, Inc., 526 F.2d 556, 557, 188 USPQ 105, 106 (C.C.P.A. 1975) (finding BENGAL and BENGAL LANCER and design confusingly similar); In re Toshiba Med. Sys. Corp., 91 USPQ2d 1266, 1269 (TTAB 2009) (finding TITAN and VANTAGE TITAN confusingly similar); In re El Torito Rests., Inc., 9 USPQ2d 2002, 2004 (TTAB 1988) (finding MACHO and MACHO COMBOS confusingly similar); TMEP §1207.01(b)(iii). In the present case, the marks are identical in part.*

> *Additionally, the applied-for mark incorporates the entirety of the registered mark. Incorporating the entirety of one mark within another does not obviate the similarity between the compared marks, as in the present case, nor does it overcome a likelihood of confusion under Section 2(d). See Wella Corp. v. Cal. Concept Corp., 558 F.2d 1019, 1022, 194 USPQ 419, 422 (C.C.P.A. 1977) (finding CALIFORNIA CONCEPT andsurfer design and CONCEPT confusingly similar); Coca-Cola Bottling Co. v. Jos. E. Seagram & Sons, Inc., 526 F.2d 556, 557, 188 USPQ 105, 106 (C.C.P.A. 1975) (finding BENGAL LANCER and design and BENGAL confusingly similar); In re Integrated Embedded, 120 USPQ2d 1504, 1513 (TTAB 2016) (finding BARR GROUP and BARR confusingly similar); In re Mr. Recipe, LLC, 118 USPQ2d 1084, 1090 (TTAB 2016) (finding JAWS DEVOUR YOUR HUNGER and JAWS confusingly similar); TMEP §1207.01(b)(iii). In the present case, the marks are identical in part.*

> *Therefore, although the applicant's mark and registrant's marks have minor differences, the marks are very similar and thus have the same overall commercial impression, and as a result, purchasers are likely to be confused as to the source of the applicant's and registrant's goods and services. Therefore, the marks are confusingly similar.*

<u>D) Relatedness of the Goods</u>

The Examiner included the following comments under the heading "**RELATEDNESS OF THE GOODS AND SERVICES**":

The g*oods and services are compared to determine whether they are similar, commercially related, or travel in the same trade channels. See Coach Servs., Inc. v. Triumph Learning LLC, 668 F.3d 1356, 1369-71, 101 USPQ2d 1713, 1722-23 (Fed. Cir. 2012); Herbko Int'l, Inc. v. Kappa*

*Books, Inc., 308 F.3d 1156, 1165, 64 USPQ2d 1375, 1381 (Fed. Cir. 2002); TMEP §§1207.01, 1207.01(a)(vi).*

*When analyzing an applicant's and registrant's  goods and services for similarity and relatedness, that determination is based on the description of the goods and services in the application and registration at issue, not on extrinsic evidence of actual use. See Stone Lion Capital Partners, LP v. Lion Capital LLP, 746 F.3d 1317, 1323, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014) (quoting Octocom Sys. Inc. v. Hous. Computers Servs. Inc., 918 F.2d 937, 942, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990)).*

*Applicant' s goods " Downloadable software application for processing a captured series of voice and video packets for monitoring and testing the performance of Internet Protocol based data and content" in International Class 009 and services " Providing temporary use of a non- downloadable software application for processing a captured series of voice and video packets for monitoring and testing the performance of Internet Protocol based data and content" in International Class 042 are related to registrant's goods " Computer software which provides tools for users to ingest, store, index, archive, tag, search, retrieve, visualize, annotate, transmit and digitize video and imagery data types and metadata, namely, electro-optical and infrared video data, still image data, wide area imagery data, commercial satellite data, multi-spectral and hyperspectral data, geospatial data, track location data, text data, and cyber network data, and tools that provide automated, analysis of video and imagery data types, namely, person, vehicle, ship, object, face, and group, activity detection, recognition, and tracking, pattern recognition, deep learning, classification, artificial intelligence, and the association and fusion of information across data types, all of the aforementioned goods of class 9 not for surveying, measuring or laser scanning" in International Class 009 and services " Providing cloud computing services, providing software as a services (SAAS) and providing platform as a service (PAAS) which provides tools for users to ingest, store, index, archive, tag, search, retrieve, visualize, annotate, transmit and digitize video and imagery data types and metadata, namely, electro-optical and infrared video data, still image data, wide area imagery data, commercial satellite data, multi-spectral and hyperspectral data, geospatial data, track location data, text data, and cyber network data, and tools that provide automated, analysis of video and imagery data types, namely, person, vehicle, ship, object, face, and group, activity detection, recognition, and tracking, pattern recognition, deep learning, classification, artificial intelligence, and the association and fusion of information across data types, all of the aforementioned services of class 42 not for surveying, measuring or laser scanning" in International Class 042.*

*The applicant and registrant both generally provide downloadable and non-downloadable software for analyzing and processing audio and video data and content. The attached Internet evidence from codimg.com, elecard.com, and transana.com establishes that the same entity commonly provides the relevant goods and services and markets the goods and services under the same mark and that the relevant goods and services are sold or provided through the same trade channels and used by the same classes of consumers in the same fields of use. Thus, applicant's and registrant's goods and services are considered related for likelihood of confusion purposes. See, e.g., In re Davey Prods. Pty Ltd., 92 USPQ2d 1198, 1202-04 (TTAB 2009); In re Toshiba Med. Sys. Corp., 91 USPQ2d 1266, 1268-69, 1271-72 (TTAB 2009).*

*Because the marks are  confusingly similar and the goods and services are related, there is a likelihood of confusion between the marks. Therefore, registration is refused pursuant to Section 2(d) of the Trademark Act*

*Although applicant's mark has been refused registration, applicant may respond to the refusal by submitting evidence and arguments in support of registration.*

## III. APPLICANT'S REMARKS AND PLEA

### A) Summary

Applicant hereby submits remarks, followed by a plea for advancement of the present application to publication.

In summary, applicant, through its attorney, respectfully submits that the difference between applicant's mark from the cited marks, along with the existence of multiple separately owned registrations revealing the nature in which **the term VQ has been diluted in the relevant registered market**, show that that consumers would not be confused, mistaken, or deceived as to the commercial source of the goods and/or services of the parties.

The Examiner submits that "*Applicant's mark VQANALYZER and registrant's mark VQ are confusingly similar.*" However, the Examiner neglects to note that, as will be shown in detail below, the cited *registrant's mark VQ also* **overlaps with four other** separately owned registrations and/or approved applications for **VQ** – type marks, resulting in a significant dilation of same. As such, all of the additional, uncited, registrations should all be considered when the strength of the marks and determining customer confusion.

Note in particular the oldest, senior, registration is *also held by the applicant* – namely "**VQMON",** Regno 2717824, registered May 20, 2003 for "**Computer software**" and other goods.

| Mark | Goods/Services | Status | Owner |
|---|---|---|---|
| **VQMON** | **Computer Software** (and other goods) | **Registered** – Reg. No 2717824, Reg Date May 20, 2003 | Telchemy, Inc. |
| **VQ** | **Computer Software** (and other goods/services) | **Registered** – Reg No 5522436 Reg Date | Merricks, Jonathan |
| **VQ CONFERENCE MANAGER** | **Computer Software** (and other goods/services) | **Approved and Published** September 22, 2020 Appn no 88367043 | VQ Communications |
| **VQ** | **Computer services;** temporary use of non-downloadable **software** (and other goods) | **NOA issued** Oct. 08, 2019 – waiting on use Appn no 88369664 | Inflection Associates, Inc. |

In light of the crowded field of use of **VQ** – type registered and/or approved marks in this field of services (computer software), it is respectfully submitted that the applicant's applied for mark **VQ**, for the listed goods and services, would not cause confusion in the marketplace with the marks cited above. Details are below.

Thus, Applicant respectfully submits that the grounds for refusal should be reconsidered and withdrawn, and that the application should advance to publication. Details of Applicant's remarks are below.

## B) Details

*1 – Restatement of 2(d) Rejection*

As noted above, the present application has been rejected under Section 2(d), with the Examiner citing the following registration:

| MARK | REG NO | GOODS/SERVICES |
|---|---|---|
| **VQ** | **6004828** | Computer software which provides tools for users to ingest, store, index, archive, tag, search, retrieve, visualize, annotate, transmit and digitize video and imagery data types and metadata, namely, electro-optical and infrared video data, still image data, wide area imagery data, commercial satellite data, multi-spectral and hyperspectral data, geospatial data, track location data, text data, and cyber network data, and tools that provide automated, analysis of video and imagery data types, namely, person, vehicle, ship, object, face, and group, activity detection, recognition, and tracking, pattern recognition, deep learning, classification, artificial intelligence, and the association and fusion of information across data types, all of the aforementioned goods of class 9 not for surveying, measuring or laser scanning (CLASS 009)<br><br>Providing cloud computing services, providing software as a services (SAAS) and providing platform as a service (PAAS) which provides tools for users to ingest, store, index, archive, tag, search, retrieve, visualize, annotate, transmit and digitize video and imagery data types and metadata, namely, electro-optical and infrared video data, still image data, wide area imagery data, commercial satellite data, multi-spectral and hyperspectral data, geospatial data, track location data, text data, and cyber network data, and tools that provide automated, analysis of video and imagery data types, namely, person, vehicle, ship, object, face, and group, activity detection, recognition, and tracking, pattern recognition, deep learning, classification, artificial intelligence, and the association and fusion of information across data types, all of the aforementioned services of class 42 not for surveying, measuring or laser scanning (CLASS 042) |

As may be seen, other <u>*non-cited*</u> registrations or approved applications for **VQMON,** (Registration no. 2717824), **VQ,** (Registration no. 5522436) and the two recently approved (and published) **VQ CONFERENCE MANAGER,** (appn no. 88367043), and **VQ** (appn no 88369664) **overlap completely** with the cited registrations, in the area of "**computer software"** or related services.

Note in particular the oldest registration is <u>*also held by the applicant*</u> – namely "**VQMON",** Regno 2717824, registered May 20, 2003 for "**Computer software**" and other goods.

| Mark | Goods/Services | Status | Owner |
|---|---|---|---|
| **VQMON** | **Computer Software** (and other goods) | **Registered** – Reg. No 2717824, Reg Date May 20, 2003 | Telchemy, Inc. |
| **VQ** | **Computer Software** (and other goods/services) | **Registered** – Reg No 5522436 Reg Date | Merricks, Jonathan |
| **VQ CONFERENCE MANAGER** | **Computer Software** (and other goods/services) | **Approved and Published** September 22, 2020 Appn no 88367043 | VQ Communications |
| **VQ** | **Computer services;** temporary use of non-downloadable **software** (and other goods) | **NOA issued** Oct. 08, 2019 – waiting on use Appn no 88369664 | Inflection Associates, Inc. |

In light of the crowded field of use of **VQ** – type registered and/or approved marks in in the area of "**computer software"** or related services, including applicant's commonly owned senior mark **VQMON**, it is respectfully submitted that the applicant's applied for mark **VQ**, for the listed goods and services, would not cause confusion in the marketplace with the marks cited above.

Below is an illustration of the differences of the applicant's mark, as well as the crowded field in which the term **VQ** is being used, registered, and applied for in the area of "**computer software**" or related services
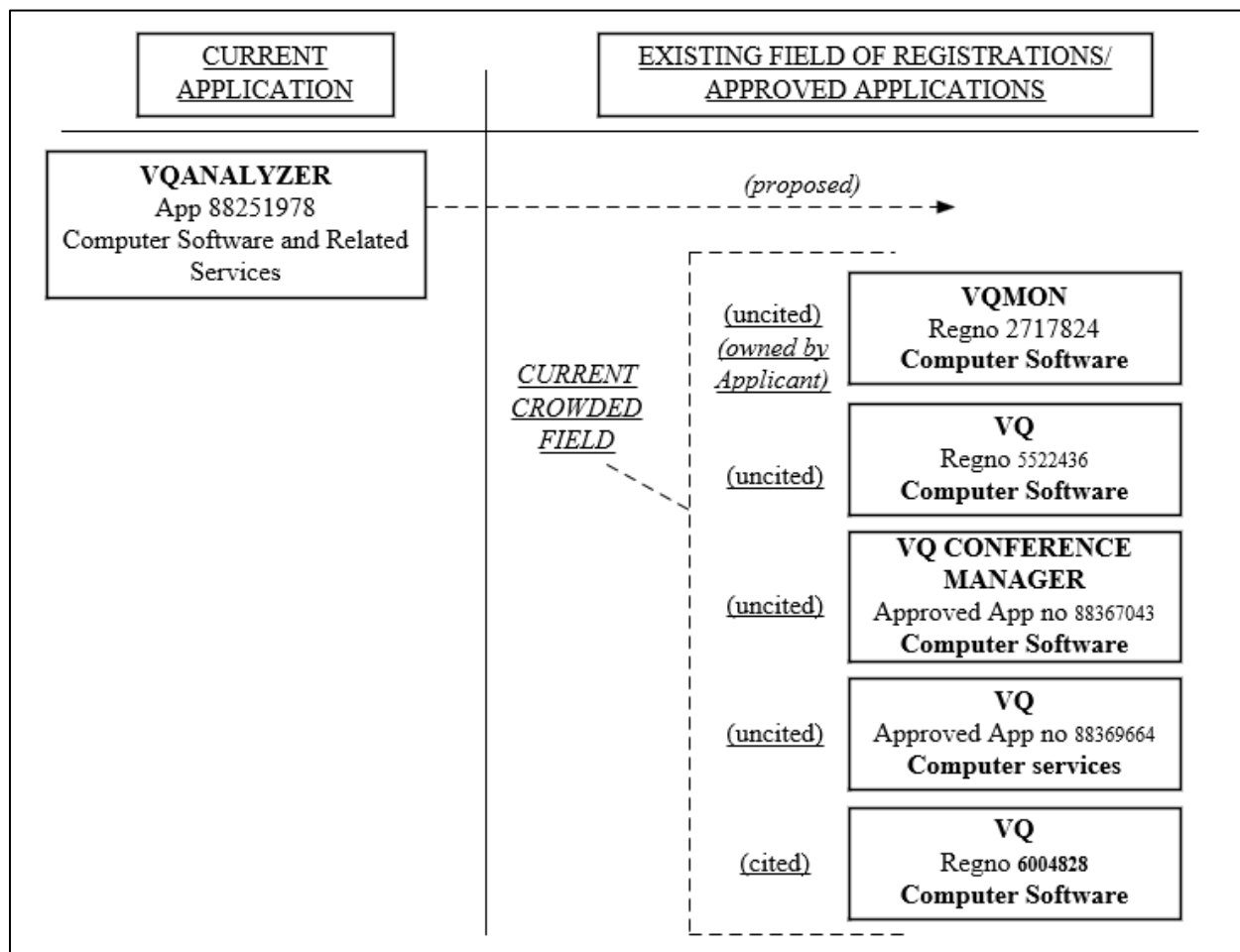


As may be seen, applicant's mark is *different* than all of the four other marks, including applicant's commonly owned senior mark **VQMON**, as well as **VQ CONFERENCE MANAGER**, and **VQ** (two marks).

This difference in marks, as well as the existence of multiple separately owned **VQ** – type registered and/or approved marks in in the area of "**computer software**" or related services, shows that consumers would not be confused, mistaken, or deceived as to the commercial source of the goods and/or services of the parties.

*4 – Conclusion and Plea*

In light of the above, Applicant respectfully submits that the grounds for refusal are now overcome and that the application should advance to publication.

## C) Closing

In light of the difference in applicant's marks from the cited marks, and also in light of the crowded field of multiple separately owned **VQ** – type registered and/or approved marks in in the area of "**computer software**" or related services, including applicant's commonly owned senior mark **VQMON**, it is respectfully submitted that consumers would not be confused, mistaken, or deceived as to the commercial source of the goods and/or services of the parties.

## VI. CONCLUSION

Based on the foregoing discussion, Applicant respectfully submits that the grounds for refusal should be reconsidered and withdrawn, and that the application should advance to publication.

The above is submitted as a complete response to the outstanding official action. Should this not be the case, or should the Examiner have additional questions, a telephone call to the undersigned attorney is welcomed.

Respectfully submitted,
/Gregory T Gronholm/
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