


This filing is in response to the Office Action mailed 7 October 2020 in which the Examiner initially refused registration of the mark COUNT (“Applicant’s Mark”) under Section 2(d) of the Trademark Act on the grounds that the Applicant’s Mark is likely to be confused with Registration No. 5000602 for the mark V-COUNT & design (“Cited Mark”).

Initially, Applicant is amending the identification of goods (“Applicant’s Goods”) in its application as follows:

IC 009: ~~Downloadable software for the identification of identifying natural persons by means of face and/or voice recognition and the subsequent transmission of user-specific data to third parties; Downloadable computer software designed to be deployed on web servers for the identification of natural persons; Downloadable computer software for the identification of natural persons; Recorded computer software designed to be deployed on web servers for the identification of natural persons; Recorded computer software for the identification of natural persons~~

Applicant submits that this clarification of the identification of Applicant’s Goods further differentiates Applicant’s Goods from the goods identified in the Cited Mark so as to further alleviate any likelihood of confusion.

Applicant further submits that overall Applicant’s Mark is not likely to be confused with the Cited Mark. Registration of Applicant’s Mark, COUNT has been refused by the

Examiner over Registration No. 5000602 for the mark  in connection with computer software for counting people in IC 009. Applicant respectfully submits that the Applicant’s Mark is not confusingly similar to the Cited Mark under *In re DuPont De Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). Applicant submits that when all of the *DuPont* factors are considered, the marks themselves and the goods and services supplied thereunder are sufficiently dissimilar to eliminate a likelihood of confusion.

Specifically, Applicant submits that careful consideration of several *DuPont* factors, such as:

- (A) the dissimilarity of the appearance, sound, connotation, and commercial impression of the marks when considered in their entireties;
- (B) 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 and in the channels of trade; and
- (C) the conditions under which and buyers to whom sales are made, i.e. “impulse” vs. careful, sophisticated purchasing,

weighs toward a finding of no likelihood of confusion between Applicant's Mark and the Cited Mark.

A. The Marks Are Not Confusingly Similar in Appearance, Sound, Connotation or Commercial Impression when Considered in their Entireties.

When determining whether two marks are confusingly similar, one must consider the marks **in their entireties**. As explained by Professor McCarthy:

[C]onflicting marks must be compared in their entireties. A mark should not be dissected or split up into its component parts and each part then compared with corresponding parts of the conflicting mark to determine the likelihood of confusion. It is the impression that the marks as a whole create on the average reasonably prudent buyer and not the parts thereof, that is important. As the Supreme Court observed: "The commercial impression of a trademark is derived from it as a whole, not from its elements separated and considered in detail. For this reason it should be considered in its entirety."

J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION ("MCCARTHY") § 23.15[1][a] (3d ed. 1995) (citation omitted). In fact, it is error to fail to compare marks in their entireties. See *Opryland USA, Inc. v. Great American Music Show, Inc.*, 970 F2d 847, 851, 23 USPQ2d 1471 (Fed. Cir. 1992).

In an analogous case, *In re Hearst Corp.*, 982 F2d 493 (Fed. Cir. 1992), the Federal Circuit reviewed the TTAB's decision to refuse registration of the mark "VARGA GIRL" on the ground of likelihood of confusion with the registered trademark "VARGAS", both for calendars. The court observed that the TTAB found that "VARGA" was the dominant element of the "VARGA GIRL" mark, and that "GIRL" was merely descriptive and thus should be entitled to little weight in comparing the marks. In reversing the TTAB's decision, the court first noted that "marks tend to be perceived in their entireties, and all components must be given appropriate weight." *Id.* at 494. After examining the marks in their entireties, the court found that "[t]he appearance, sound, sight, and commercial impression of 'VARGA GIRL' derive significant contribution from the component 'girl.' By stressing the portion 'varga' and diminishing the portion 'girl', the Board inappropriately changed the mark." *Id.* The court concluded that the marks "VARGA GIRL" and "VARGAS" were sufficiently different in sight, sound, connotation and commercial impression to negate the likelihood of confusion under §2(d) of the Trademark Act. Similarly, the presence of the leading "V-" and the use of the "cloud" design in the Cited Mark sufficiently differentiates the Cited Mark and Applicant's Mark.

There are numerous other examples of marks which, when viewed in their entireties, were held to be not confusingly similar in spite of the fact that they both contain a common word as in the present case: *Champagne Louis Roederer S.A. v. Delicato Vinwards*, 4714 USPQ2d 59 (Fed. Cir. 1998) (CRISTAL for champagne and CRYSTAL

CREEK for wine are not confusingly similar because the marks evoke very different images in the mind of consumers); *Colgate-Palmolive Co. v. Carter-Wallace, Inc.*, 167 USPQ 529 (CCPA 1970) (PEAK for dentrifice and PEAK PERIOD for deodorant were not confusingly similar); *Mobil Oil Corp. v. Mobile Mechanics, Inc.*, 192 USPQ 744 (D. Conn. 1976) (MOBILE for gasoline not confusingly similar to MOBILE MECHANICS for auto repair and towing); *Lever Bros. Co. v. Barcolene Co.*, 174 USPQ 392 (CCPA 1972) (ALL CLEAR not confusingly similar to ALL); *In re Ferrero*, 178 USPQ 167 (CCPA 1973) (TIC TAC not confusingly similar to TIC TAC TOE); *Conde Nast Publications, Inc. v. Miss Quality, Inc.*, 184 USPQ 422 (CCPA 1975) (COUNTRY VOGUES not confusingly similar to VOGUE for magazines); *Plus Products v. General Mills, Inc.*, 188 USPQ 520 (TTAB 1975) (PROTEIN PLUS not confusingly similar to PLUS); *Gruner + Jahr USA Pub., a Div. of Gruner + Jahr Printing and Pub. Co. v. Meredith Corp.*, 26 USPQ2d 1583 (2d Cir. 1993) (PARENTS not confusingly similar to PARENTS DIGEST, both for magazines); *Time, Inc. v. Petersen Pub. Co. LLC*, 50 USPQ2d 1474 (2d Cir. 1999) (TEEN and TEEN PEOPLE, both for magazines, not confusingly similar).

Also, Applicant submits that in the very crowded computer software field slight differences in the types of goods for even similar marks also alleviate any likelihood of confusion. Applicant's Goods are amended to "downloadable software for identifying natural persons by means of face and/or voice recognition and the subsequent transmission of user-specific data to third parties", while the Cited Mark lists "computer software for counting people". Applicant submits that this difference in the type of computer software is sufficient to alleviate any likelihood of confusion, especially in light of the differences in the marks themselves as shown above.



Finally, and most obviously, COUNT and V-COUNT do not look or sound the same. One mark has one word and no design; the other has one word and a leading letter and a design. As these differences in the sight, sound, and meanings of the marks are more than slight differences, and (as explained in more detail below) as the goods associated with the marks are different, registration of the Applicant's Mark would present no likelihood of confusion.

B. The Nature of the Goods Identified in Applicant's Application and in the Cited Mark are Dissimilar.

Applicant's goods are sufficiently different from the goods of the Cited Mark. There is no *per se* rule that requires a finding of a likelihood of confusion when two marks are used in connection with computer-related goods, such as hardware and software, and one must look at the realities of the marketplace to determine whether the computer-related goods are sufficiently different and specialized. *In re Quadram Corp.*, 228 USPQ 863, 865 (TTAB 1985) (no likelihood of confusion between MICROFAZER for a specific specialized piece of computer peripheral equipment, namely a buffer, and the mark FASER for use in connection with computer programs in the field of energy

conservation and management). Other examples of cases in which the TTAB has recognized that distinctions can be made between marks used in the computer field, so that use of two similar marks for related computer goods does not automatically result in a likelihood of confusion include: *Information Resources Inc. v. X*Press Information Services*, 6 USPQ2d 1034 (TTAB 1988) (EXPRESS for information analysis computer software packages not confusingly similar to X*PRESS for service consisting of transmittal of new and general information to home and business computers via satellite and cable television lines); *Electronic Data Systems Corp. v. EDSA Micro Corp.*, 23 USPQ2d 1460 (TTAB 1992) (EDSA for computer programs for electrical distribution system analysis and design not confusingly similar to EDS for computer data processing services, notwithstanding the fame of the EDS mark); and *Aries Systems Corp. v. World Book Inc.*, 26 USPQ2d 1926 (TTAB 1993) (INFORMATION FINDER for computer programs on compact disks for use in general research not confusingly similar to KNOWLEDGE FINDER for computer programs that retrieve information from databases containing citations to, and abstracts of, biomedical journal articles that are sold primarily to medical professionals).

A similar result should be reached in this matter. The goods identified by the Applicant's Mark and the Cited Mark are used for different purposes and, as found by the TTAB in the aforementioned cases, there is no likelihood of confusion based these differences. In this case, Applicant's Goods are "downloadable software for identifying natural persons by means of face and/or voice recognition and the subsequent transmission of user-specific data to third parties", while the Cited Mark's goods are "computer software for counting people". According to the Registrant's website, www.v-count.com, the Cited Mark's goods "provide retailers with platforms to measure how customers behave in their physical stores" in which "[v]isitor data is collected and analyzed". This is markedly different from Applicant's Goods.

Also, when the users of marks are operating in completely different areas of commerce, as is the case between the goods of Applicant's Mark and the Cited Mark, consumers are less likely to assume that their similar branded products come from the same source. See *Virgin Enters. Ltd. v. Nawab*, 67 USPQ2d 1420 (2d Cir. 2003). As the goods at issue here are sufficiently different (and narrow), they are logically marketed and sold in different trade channels, which further mitigates the likelihood of confusion in this case. It is well settled that where two parties have different customers and market their goods or services in different ways, the likelihood of confusion decreases. E.g., *Therma-Scan, Inc. v. Thermoscan, Inc.*, 295 F3d 623, 636 (6th Cir. 2002).

C. The Buyers to Whom Sales are Made are Both Careful and Sophisticated with Regard to the Applicant's Mark and the Cited Mark.

When consumers are sophisticated confusion is less likely. See, e.g., *Astra*, 220 USPQ at 790 ("[T]here is always less likelihood of confusion where goods are expensive and purchased after careful consideration."); *Bristol-Myers Squibb v. McNeil-P.P.C, Inc.*, 24 USPQ2d 1161, 1170 (2d Cir. 1992) ("Generally, the more sophisticated and careful

the average consumer of a product is, the less likely it is that similarities in trade dress or trade marks will result in confusion concerning the source or sponsorship of the product”).

As explained in detail above, both Applicant’s Goods and the Cited Mar’s goods are specialized software. Thus, the consumer looking to use either Applicant’s Goods or the Cited Mark’s goods can be considered sufficiently sophisticated to perform careful and diligent research and deliberation before investing in such software. None of the goods of any of the marks are likely to be purchased on impulse. Confusion is less likely where the goods “are relatively expensive items purchased with a certain amount of care and thought, rather than inexpensive items purchased on impulse.” *Information Res. Inc. v. X*Press Info. Serv.*, 6 USPQ2d 1034, 1039 (TTAB 1988). As the consumers of each of the goods of the Marks can be considered careful and sophisticated, the marks are not likely to be confused.

D. Conclusion.

Given the dissimilarity of the Marks, the sophistication of the purchasers of the goods of both marks, and the differences in the nature of the goods and in their respective channels of trade, Applicant submits that there is no likelihood of confusion present. When these elements are taken together, Applicant submits that Applicant’s Mark is not confusingly similar to the Cited Mark, and Applicant’s Mark is registrable.