

Introduction

Applicant has filed an extension of protection through the Madrid Protocol to register the mark AXIAMANAGER in the United States Patent and Trademark Office (“USPTO”) for use with “computer software for controlling inverters, converters and frequency regulators used in electric motors” in Class 9.

The USPTO has refused to register this mark based on an alleged likelihood of confusion with the marks in four registrations owned by three different parties and a published and allowed earlier filed intent-to-use application, as summarized below:

1. Reg. No. 6148032 for the mark AXIA for use with “Machinery parts for the commercial food service industry, namely, ball catches, ball valves, bearing kits comprised of bearings and bearing housings, bearings, bell crank hooks for ovens, brush holder caps for use in rotating electric machinery, chain breakers, conveyor belt rollers, conveyor belt links, conveyor belts, drain tubes for water removal from machinery, fans for motors, hoses for steam cooking, hot oil cooking and hot water cooking equipment, ignition modules for cooking equipment, gear motors, motors, O-rings being machines parts for cooking and refrigeration equipment, back pressure control valves as parts of machines, pressure regulators, electric pumps, mechanical seals for pumps, pumps for appliances in the nature of refrigerators and freezers, purge valves, spark ignition modules in the nature of spark plug ignition wires, steam traps for cooking equipment, tank gaskets for internal combustion engines” in Class 7; “Electrical apparatus for the commercial food service industry, namely, control valves for regulating flow of gases and liquids, electrical controls for defrost of refrigeration equipment, dial knobs being component parts of timing dials, automatic valves for drains, electric buzzers, electronic touch sensitive switches, electric thermal cutouts functioning as a safety device for monitoring oven temperature, flame sensors for use with cooking equipment, electric switches for controlling flames for use in cooking equipment, float switches for warewashing and cooking equipment, electrical fuse holders, electrical fuses, glass liquid level gauge tubes, electrical resistance heating wires, computer interface boards, electricity limiting switches, liquid level controls in the nature of flow switches for controlling the flow of liquids, magnetrons for use in generating alternating currents at microwave frequencies, magnets, electric contacts for mercury, electrodes for ovens, electrical pin connectors, luminous pointer knobs, potentiometers, proximity switches, push switches for cooking equipment, electric relays, electric relay contractors, pressure relief valves for warewashing and cooking equipment, electric rocker switches for switching off motors, thermally activated manually resettable fire safety valves, sensors for detecting temperature, solenoid valves, sound devices, namely, for commercial cooking equipment alerts, spark sensors for commercial cooking equipment, electrical switch assemblies comprised of switch, hardware and mounting plates, electrical switches, temperature controllers for cooking, refrigeration, and warewashing equipment, temperature probes, electrical terminal blocks, thermal sensors for cooking, refrigeration, and warewashing equipment, thermistors kits comprised of thermistor, wire, and shrink tubing, thermocouples, thermopiles, thermostat dials, thermostats, timer switches, electric toggle switches, transformers, thermionic tube adapters, water level probes, water level sensors, electrical probes and controllers for measuring and controlling ice thickness for ice

machines, electronic valves for controlling gas flow” in Class 9; and “Distributorship featuring equipment and supplies for restaurants, bakeries, bars, and concessions, namely, replacement parts, kitchen accessories, restaurant accessories, smallwares, cookware, brushes, day labels, cutlery, food storage, food pans, utensils, tabletop accessories, flatware, dinnerware, glassware, table service, apparel, carts, serving supplies, shelving, work tables, racks, storage containers, food preparation accessories, baking pans, barware, dispensers, chafers, food carriers, steam table pans, dishwashing accessories, food safety accessories, portion control accessories, trash containers, cleaning supplies, drain and dripping pans, accessories and supplies in the nature of cooking, accessories and supplies in the nature of dishwashing, accessories and supplies in the nature of food-prep, accessories and supplies in the nature of ice-making and accessories and supplies in the nature of refrigeration, plumbing equipment and plumbing fixtures, cleaning supplies, kitchen appliance accessories, kitchen tools, kitchen hardware and products for use by the commercial food service industry” in Class 35. The registration is owned by Diversified Foodservice Supply, LLC and it issued on September 8, 2020.

2. Reg. No. 5791291 for the mark AXIA TECHNOLOGIES for use with “software as a service (SAAS) services, delivered on-demand or via cloud-based offering, featuring software for use by medical practitioners, hospitals, physicians and healthcare suppliers in connection with patient record management, patient billing, and patient payments; providing a website featuring technology which enables users to facilitate the exchange of needed health information among physicians, patients and health plans by means of private computer networks and global computer information networks; Providing temporary use of on-line non-downloadable computer software for use in electronic authorization, processing and management of card present and card not present credit card, debit card and electronic check transactions conducted via global computer networks” in Class 42. The registration is owned by Axia Technologies, Inc. and it issued on July 2, 2019.
3. Reg. No. 5809870 for the mark AXIA TECHNOLOGIES for use with “providing services to healthcare software providers and healthcare providers, namely, electronic payment services involving electronic processing and subsequent transmission of bill payment data, bill payment services and electronic processing of payment data” in Class 36 and “computer services, specifically, providing an online non-downloadable Internet-based system application featuring technology enabling users to securely process and store electronic payment information and cardholder payment data” in Class 42. The registration is owned by Axia Technologies, Inc. and it issued on July 23, 2019.
4. Reg. No. 4822817 for the mark AXIS FUSION for use with “Surface control centers for audio over internet protocol based broadcast studios, namely, a control panel designed to control and mix inputs and outputs as well as display functions for various broadcast studio audio peripherals, namely, routing switchers, mixing engines, signal processors, and computer-based audio recording, editing and/or playback systems” in Class 9. The registration is owned by TLS Corp. and it issued on September 29, 2015.



5. Serial No. 87980183 for the mark  for use with “Machinery parts for the commercial food service industry, namely, ball catches, ball valves, bearing kits comprised of bearings and bearing housings, bearings, bell crank hooks for ovens, brush holder caps for use in rotating electric machinery, chain breakers, conveyor belt rollers, conveyor belt links, conveyor belts, drain tubes for water removal from machinery, fans for motors, hoses for steam cooking, hot oil cooking and hot water cooking equipment, ignition modules for cooking equipment, gear motors, motors, O-rings being machines parts for cooking and refrigeration equipment, back pressure control valves as parts of machines, pressure regulators, electric pumps, mechanical seals for pumps, pumps for appliances in the nature of refrigerators and freezers, purge valves, spark ignition modules in the nature of spark plug ignition wires, steam traps for cooking equipment, tank gaskets for internal combustion engines” in Class 7; “Electrical apparatus for the commercial food service industry, namely, control valves for regulating flow of gases and liquids, electrical controls for defrost of refrigeration equipment, dial knobs being component parts of timing dials, automatic valves for drains, electric buzzers, electronic touch sensitive switches, electric thermal cutouts functioning as a safety device for monitoring oven temperature, flame sensors for use with cooking equipment, electric switches for controlling flames for use in cooking equipment, float switches for warewashing and cooking equipment, electrical fuse holders, electrical fuses, glass liquid level gauge tubes, electrical resistance heating wires, computer interface boards, electricity limiting switches, liquid level controls in the nature of flow switches for controlling the flow of liquids, magnetrons for use in generating alternating currents at microwave frequencies, magnets, electric contacts for mercury, electrodes for ovens, electrical pin connectors, luminous pointer knobs, potentiometers, proximity switches, push switches for cooking equipment, electric relays, electric relay contractors, pressure relief valves for warewashing and cooking equipment, electric rocker switches for switching off motors, thermally activated manually resettable fire safety valves, sensors for detecting temperature, solenoid valves, sound devices, namely, for commercial cooking equipment alerts, spark sensors for commercial cooking equipment, electrical switch assemblies comprised of switch, hardware and mounting plates, electrical switches, temperature controllers for cooking, refrigeration, and warewashing equipment, temperature probes, electrical terminal blocks, thermal sensors for cooking, refrigeration, and warewashing equipment, thermistors kits comprised of thermistor, wire, and shrink tubing, thermocouples, thermopiles, thermostat dials, thermostats, timer switches, electric toggle switches, transformers, thermionic tube adapters, water level probes, water level sensors, electrical probes and controllers for measuring and controlling ice thickness for ice machines, electronic valves for controlling gas flow” in Class 9; and “Distributorship featuring equipment and supplies for restaurants, bakeries, bars, and concessions, namely, replacement parts, kitchen accessories, restaurant accessories, smallwares, cookware, brushes, day labels, cutlery, food storage, food pans, utensils, tabletop accessories, flatware, dinnerware, glassware, table service, apparel, carts, serving supplies, shelving, work tables, racks, storage containers, food preparation accessories, baking pans, barware, dispensers, chafers, food carriers, steam table pans, dishwashing accessories, food safety accessories, portion control accessories, trash containers, cleaning supplies,

drain and dripping pans, accessories and supplies in the nature of cooking, accessories and supplies in the nature of dishwashing, accessories and supplies in the nature of food-prep, accessories and supplies in the nature of ice-making and accessories and supplies in the nature of refrigeration, plumbing equipment and plumbing fixtures, cleaning supplies, kitchen appliance accessories, kitchen tools, kitchen hardware and products for use by the commercial food service industry” in Class 35. This is an intent-to-use application that is owned by Diversified Foodservice Supply, LLC. It was published on December 3, 2019 and allowed on January 28, 2020.

Applicant respectfully requests that the USPTO withdraw these refusals because the marks are not similar in terms of sound, appearance, meaning, and commercial impression; because the marks cover different and unrelated goods and services; and because the USPTO has registered the cited marks to three different parties, showing that the marks are weak and capable of coexisting on the Principal Register. The following provides support for the withdrawal of the refusals.

Likelihood of Confusion Refusals

The USPTO claims that Applicant’s mark is likely to cause confusion with the cited marks because the marks share the wording AXIA; because the marks are allegedly similar in sound, appearance, and meaning; and because the parties’ goods and services are allegedly broad enough to overlap with one another.

Section 2(d) of the Lanham Act states that the USPTO may refuse to register a trademark if it “so resembles” a previously registered trademark “as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive.” 15 U.S.C. § 1052(d).

Likelihood of confusion determinations are made on a case-by-case basis, *On-Line Careline Inc. v. Am. Online Inc.*, 56 USPQ2d 1471, 1474 (Fed. Cir. 2000), taking into consideration the thirteen nonexclusive factors propounded in *In re E.I. duPont de Nemours & Co.*, 177 USPQ 563, 567 (C.C.P.A. 1973): 1) the similarity or dissimilarity of the parties’ marks in their entireties, taking into account the sound, appearance, connotation, and commercial impression of the marks; 2) the similarity or dissimilarity of the parties’ goods or services; 3) the similarity or dissimilarity of the parties’ established, likely-to-continue trade channels; 4) the sophistication of the parties’ consumers; 5) the fame of the prior mark; 6) the number and nature of similar marks in use on similar goods or services; 7) nature and extent of any actual confusion; 8) length of time and conditions under which there was concurrent use of the marks without actual confusion; 9) the variety of goods or services upon which a mark is used or not used; 10) the market interface between the applicant and the owner of the prior mark; 11) the extent to which the applicant has a right to exclude others from using its mark on its goods or services; 12) the extent of potential confusion, i.e., whether *de minimis* or substantial; and 13) any other facts of the effect of use.

In *ex parte* examinations, the *DuPont* factors boil down to what is essentially a two-part inquiry: the similarities between the marks and the relatedness of the goods/services. *Federated Foods, Inc. v. Fort Howard Paper Co.*, 192 USPQ 24, 29 (C.C.P.A. 1976) (“The fundamental inquiry

mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.”). An application of the first of these two factors shows that the marks in this case are not confusingly similar.

The marks are not similar in sound, appearance, or meaning. Applicant’s AXIAMANAGER mark contains a seven-letter word (MANAGER) that does not appear in the cited marks. None of the cited marks contain that word and four of the five cited marks contain words that do not appear in Applicant’s mark: TECHNOLOGIES, FUSION, and FOOD SERVICE PRODUCTS. Moreover, the cited prior pending mark constitutes a composite mark with colorful design elements that do not appear in Applicant’s mark. Marks that contain different words and graphical elements cannot look the same, cannot be pronounced the same, and cannot have the same meanings. When considered in their entirety, as the law dictates, the marks do not look the same, are not spelled the same, and do not convey similar commercial impressions. Consumers could not call for or refer to the marks in the same fashion given that the marks are not phonetically similar or equivalent.

In focusing on just the word AXIA in the marks, the USPTO has ignored the well-established anti-dissection rule. That rule states that the USPTO must compare marks in their entirety and not focus on certain parts while ignoring others. In this case, the marks do contain AXIA but Applicant’s mark and four of the cited marks also contain other wording and elements that differentiate them, as noted above. The claim that the marks are confusingly similar also does not consider the fact that the USPTO has registered or published and allowed all the cited marks over each other. If all the cited marks are coexisting, then Applicant’s mark should be able to do the same. To find otherwise would run counter to the USPTO’s stated goal of consistent examination decisions. This especially the case given the common nature of AXIA-formative marks, of which there are more than 250 pending applications and registrations in the USPTO’s online records.

The assertion that the MANAGER portion of Applicant’s mark does not distinguish the marks does not comport with case law and does not reflect how consumers see, process, and think about trademarks when encountering them in the marketplace. Consumers do not pretend that certain portions of a mark do not exist when they see it. Nor do they randomly remove words from marks when they encounter them in stores or online. That is not how the marketplace or reasonable consumers make purchasing decisions.

Lastly, the parties’ goods and services are neither similar nor related. Applicant’s goods have nothing in common with the health billing and payment services covered by the two cited marks owned by Axia Technologies, Inc. or the broadcasting goods covered by the cited mark owned by TLS Corp. Likewise, the cited marks owned by Diversified Foodservice Supply, LLC have nothing to do with Applicant’s “computer software for controlling inverters, converters and frequency regulators used in electric motors.” Diversified Foodservice Supply, LLC’s goods and services specifically relate to cooking and food preparation goods and services and not software for controlling inverters, converters, and frequency regulators in electric motors. Thus, there is no overlap in the goods and services offered under the respective marks.

For the foregoing reasons, requests that the USPTO withdraw the likelihood of confusion refusals in this case and approve this application for publication.