

Attorney Docket No. 9653-41

TRADEMARK

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Valencell, Inc.
Serial No.: 87/019,430
Filed: April 29, 2016

Examiner: Callaghan, Brian P.
International Class(s): 009
Mark: BENCHMARK

May 22, 2017

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

Sir:

This submission is in reply to the Suspension Notice dated August 23, 2016 ("Suspension Notice"). Applicant respectfully requests reconsideration with respect to registration of the subject mark in view of the following Remarks.

I. Status of the Application

The present application has been suspended based on two earlier filed applications.

II. Applicant's Mark Does Not Create a Likelihood of Confusion

The Suspension Notice for the present trademark application is based on a contention of a possible likelihood of confusion with prior-filed pending Application Serial Nos. 86/243,453 and 86/851,221. U.S. Trademark Act Section 2(d), 15 U.S.C. § 1052(d); 37 C.F.R. §2.83; TMEP §§ 1208 *et seq.* Applicant respectfully disagrees. Applicant's goods are distinct from those of the cited applications and the parties' respective goods differ in ways that are believed to be material to consumers.

Applicant respectfully submits that each of these cited applications describe goods that have a different target consumer, are directed to very different goods and are in a different channel of trade from the goods of the trademark application at issue. The goods of the subject trademark application under the Suspension Notice are restated below for ease of discussion (emphasis added).

multi-functional electronic devices, namely, small multi-functional electronic sensor packs configured to be integrated within human wearable items, including optical sensing electronics, inertial sensing electronics, and signal processing hardware, sold as a unit, for sensing physiological, environmental, and/or physical activity information.

A. Serial Number 86/243,453; Owner: Insurance Services Office, Inc.

This application to Insurance Services Office, Inc. is now registered as Registration Number 5,073,664. The description of goods in the registration is restated below.

CLASS 9: Downloadable reports and data files featuring information and analytics regarding weather and natural hazards that have occurred at geographic locations; downloadable software for creating and viewing reports and maps about weather and natural hazards that have occurred at geographic locations; downloadable electronic maps featuring information and analytics regarding weather and natural hazards

The very different goods of the registration, the different channels of trade and target consumers are self-evident from the description. That is, weather and natural hazard analytics for insurers versus the small multi-functional electronic sensor packs sold as units configured to be integrated with human wearable items as for the mark under suspension would clearly not result in a likelihood of confusion.

B. Serial Number 86/851,221 to Benchmark Holdings PLC

At the mail date of the Suspension Notice, Serial Number 86/851,221 to Benchmark Holdings PLC had an outstanding Office Action with a response due date of October 6, 2016. The Applicant modified the Class 009 description. A subsequent Office Action mailed October 27, 2016 again rejected several classes based on the amended description and required FURTHER modification to IC 009. The Examining Attorney also maintained a Partial Refusal under Trademark Act Section 2(d) for Class 009 in its entirety for Registration 2,217,656 (Classes 005 and 042 were partially rejected for other registered marks).

The current (recently amended) description of goods by Benchmark Holdings PLC with respect to IC 009 clearly demarks different and unrelated goods to the pending application (restated below from the amendment filed April 26, 2017).

International Class 009:

Computer software for the collection, editing, organizing, modifying, bookmarking, transmission, analysis, storage and sharing of data and information; computer software that provides web-based access to applications and services through a web operating system or portal interface; computer software for use in the fields of environmental protection, aquaculture, agriculture, animal health, animal welfare, animal breeding, farming, and food production, namely, software for herd and livestock management, farm resource management, aquaculture breeding and genetics, aquaculture production

management and traceability, aquaculture diagnostics, food chain management, food chain auditing, quality control, environmental data monitoring, CO2 footprint analysis and monitoring; computer software downloadable from the internet for the collection, editing, organizing, modifying, bookmarking, transmission, analysis, storage and sharing and data and information; downloadable computer software that provides web-based access to applications and services through a web operating system or portal interface; ; downloadable computer software used in the fields of environmental protection, aquaculture, agriculture, animal health, animal welfare, animal breeding, farming, and food production, namely, software for herd and livestock management, farm resource management, aquaculture breeding and genetics, aquaculture production management and traceability, aquaculture diagnostics, food chain management, food chain auditing, quality control, environmental data monitoring, CO2 footprint analysis and monitoring; ; computer databases, namely, databases used in the fields of environmental protection, aquaculture, agriculture, animal health, animal welfare, animal breeding, farming, and food production, namely, software for herd and livestock management, farm resource management, aquaculture breeding and genetics, aquaculture production management and traceability, aquaculture diagnostics, food chain management, food chain auditing, quality control, environmental data monitoring, CO2 footprint analysis and monitoring recorded on computer media; ; electronic databases in the fields of environmental protection, aquaculture, agriculture, animal health, animal welfare, animal breeding, farming, and food production, namely, software for herd and livestock management, farm resource management, aquaculture breeding and genetics, aquaculture production management and traceability, aquaculture diagnostics, food chain management, food chain auditing, quality control, environmental data monitoring, CO2 footprint analysis and monitoring for the collection, editing, organizing, modifying, bookmarking, transmission, analysis, storage and sharing and data and information recorded on computer media.

As evidenced in the current description of goods for IC 009, the Benchmark Holdings PLC trademark application is directed to distinctly different target consumers, channels of trade and goods. The computer software and electronic databases described above would clearly not result in a likelihood of confusion with the small multi-functional electronic sensor packs sold as units configured to be integrated with human wearable items as for the mark under suspension.

III. Further Comments

Again, the subject pending application is directed to small multi-functional electronic sensor packs sold as a unit and configured to be integrated with human wearable items. A copy of a product brochure for goods sold using the Benchmark trademark of the pending trademark application of Valencell, Inc. is attached to illustrate the very different goods, target consumers

and channels of trade from either of the prior filed trademark registration applications discussed above.

There is no mechanical test for determining likelihood of confusion and “each case must be decided on its own facts.” Du Pont, 476 F.2d at 1361, 177 USPQ at 567. A few exemplary factors present in the instant situation can be relevant in an ex parte likelihood-of-confusion determination and must be considered if there is pertinent evidence in the record:

- The relatedness of the goods or services as described in the application and registration(s).
- The similarity or dissimilarity of established, likely-to-continue trade channels.
- The conditions under which and buyers to whom sales are made, i.e., “impulse” vs. careful, sophisticated purchasing (see TMEP §1207.01(d)(vii)).
- The number and nature of similar marks in use on similar goods (see TMEP §1207.01(d)(iii)).

As should be clear from the foregoing, in some cases, a determination that there is no likelihood of confusion may be appropriate, even where the marks are similar. Here, not only are the goods unrelated as evidenced by the attached brochure relative to the goods of the registration and application discussed above, the differences in the relevant trade channels of the goods, and the presence in the marketplace of a significant number of similar marks establish facts probative of the effect of use and that there is not a likelihood of confusion.

IV. Conclusion

Applicant respectfully submits that this application is now in condition for allowance, which action is requested. Should the Examiner have any matters outstanding of resolution, he is encouraged to telephone the undersigned at 919-854-1400 for expeditious handling.

Respectfully submitted,



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