

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Orbital Engineering, Inc.

Serial No.: 88/778,718

Filing Date: January 30, 2020

Mark: OI

Docket No.: TM19-168

RESPONSE TO SUSPENSION OF APPLICATION

To the Commissioner for Trademarks:

Applicant respectfully requests withdrawal of the suspension of Applicant's application No. 88/778,718 for OI in standard character form ("Applicant's Mark") for at least the reasons set forth below. The suspension notice cited three prior-filed applications as potential bars to Applicant's Mark, and the Examining Attorney subsequently withdrew the objection based on Application No. 87923767. The remaining applications are No. 88634084 in Class 42 for "OI SYSTEMS" and No. 88742889 in Class 35 for "OI."

I. There is no likelihood of confusion with Application No. 88634084 due to differences in sight, sound, meaning and overall commercial impression as well as fundamental differences in the associated services.

Applicant's Mark is comprised of two letters, "OI," which do not form an identifiable word in the English language. As such, Applicant's Mark is a strong trademark that is not susceptible to interpretation without additional information regarding Applicant and the associated services.

In this case, the "O" in Applicant's Mark is a reference to Applicant's name and family mark, "Orbital." In addition, Applicant's Mark is used in connection with technical services utilizing artificial intelligence, virtual reality and augmented reality as a means to address complex engineering and manufacturing issues. When placed fully in context, Applicant's Mark can be understood to be a clever twist on the acronym "AI" for artificial intelligence – creating a unique acronym for "Orbital Intelligence."

In contrast, Application No. 88634084 includes two terms, "OI SYSTEMS" and incorporates a readily identifiable English word ("systems") that consumers understand to mean an "interacting or interdependent group of items forming a unified whole." (See Exhibit 1, attached.) As a consequence, Application No. 88634084 not only looks and sounds different from Applicant's Mark, but it creates a completely different commercial impression.

Although both applications include the term "OI," this similarity does not mandate a finding of confusion. Marks must be compared in their entireties to assess any likelihood of

confusion. “It is axiomatic that a mark should not be dissected and considered piecemeal; rather, it must be considered as a whole in determining likelihood of confusion.” *Franklin Mint Corp. v. Master Mfg. Co.*, 667 F.2d 1005, 1007, 212 U.S.P.Q. 233 (C.C.P.A. 1981) (citation omitted).

There is ample support in the case law for concluding that the visual, aural and meaning differences between Applicant’s Mark and Application No. 88634084 reduce any likelihood of confusion. *See, e.g., Bell Laboratories, Inc. v. Colonial Prods., Inc.*, 644 F. Supp. 542, 547 (S.D. Fla. 1986) (“Final flip” and “Flip” marks for same product are “ultimately different and different sounding”); *In re Hearst Corp.*, 982 F.2d 493, 494 (Fed. Cir. 1992) (“Varga girl” and “Vargas” are “sufficiently different in sound, appearance, connotation, and commercial impression, to negate likelihood of confusion”); *Mr. Hero Sandwich Sys., Inc. v. Roman Meal Co.*, 781 F.2d 884, 888 (Fed. Cir. 1986) (“Romanburger” and “Roman” marks for food products “are not similar in appearance”); *Little Caesar Enterprises v. Pizza Caesar, Inc.*, 834 F.2d 568, 571 (“Pizza Caesar U.S.A.” not similar to “Little Caesar’s”); *Conde Nast Pubs., Inc. v. Miss. Quality, Inc.*, 507 F.2d 1404, 1407 (CCPA 1975) (“Country Vogues” and “Vogue” publications “do not look or sound alike”); *Pacquin-Lester Co. v. Charmaceuticals, Inc.*, 484 F.2d 1384 (CCPA 1973) (“Silk ‘n’ Satin” beauty and bath lotion and oil not similar to “Silk” face cream).

The risk of confusion is further mitigated by the fundamentally different services associated with each mark.

Applicant’s Mark seeks registration, *inter alia*, in Class 42 for “providing temporary use of non-downloadable software and applications using artificial intelligence, virtual reality and augmented reality for use in the provision of civil, electrical, mechanical and environmental engineering services; providing temporary use of non-downloadable software and applications using artificial intelligence, virtual reality and augmented reality for use in the provision of environmental engineering, testing and inspection services; providing temporary use of non-downloadable software and applications using artificial intelligence, virtual reality and augmented reality for use in the provision of environmental services, namely, technical consultation in the field of environmental services with respect to safety and inspection; computer modeling services; algorithmic predictive modeling services for inspections.”

In contrast, Application No. 88634084 seeks registration in Class 42 for “detection, monitoring, and analysis of inflow and infiltration, and overflow events, ***in wastewater collection systems.***” None of these services are claimed by Applicant’s Mark. Likewise, the cited application does not encompass the temporary use of software for any purpose. Moreover, by the nature of the services associated with Application No. 88634084, “OI SYSTEMS” will be targeting companies that run or oversee wastewater collection systems. Applicant’s Mark has no such focus.

Based on all of the foregoing, Applicant submits that there is no risk of confusion between Applicant’s Mark and cited Application No. 88634084.

II. Applicant's Mark targets sophisticated consumers and is used in connection with services that are distinguishable from those encompassed in Application No. 88742889, resulting in no risk of confusion.

The suspension letter also cites Application No. 88742889 as a potential bar to registration of Applicant's Mark because both marks consider of "OI."

However, identical marks may co-exist on Principal Register when used on different goods and services – even when those goods or services fall within the same general industry. For example, the Seventh Circuit found that the defendant's ZAZU mark for hair products did not infringe plaintiff's ZAZU mark for hair salon services. *Zazú Designs v. L'Oreal, S.A.*, 979 F.2d 499 (7th Cir. 1992). Likewise, the Tenth Circuit held that the plaintiff's mark, HEARTSPRING, for books, pamphlets and educational materials was not infringed by defendant's use of the mark, HEARTSPRINGS, for a residential school for disabled children. *Heartsprings, Inc. v. Heartspring, Inc.*, 143 F.3d 550 (10th Cir. 1998).

Time and time again, courts have found that identical marks are permissible when the *specific* goods or services at issue are sufficiently distinct. *See, e.g., Vitarroz Corp. v. Borden, Inc.*, 644 F.2d 960 (2d Cir. 1981) (no likelihood of confusion between BRAVO'S for crackers and BRAVOS for tortilla chips due to different contexts in which the marks are presented); *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357 (C.C.P.A. 1973) (no confusion regarding RALLY for general purpose cleaner and RALLY for auto cleaning product); *Kiekhaefer Corp. v. Willys-Overland Motors, Inc.*, 236 F.2d 423 (C.C.P.A. 1956) (no confusion between HURRICANE for outboard motors and HURRICANE for auto engines); *Clayton Mark & Co. v. Westinghouse Electric Corp.*, 356 F.2d 943 (C.C.P.A. 1966) (no likelihood of confusion for MARK for electrical conduit and MARK 75 for industrial circuit breakers); *Pabst Brewing Co. v. Decatur Brewing Co.*, 284 F. 110 (7th Cir. 1922) (BLUE RIBBON for beer does not preclude registration of BLUE RIBBON for malt extract).

In this case, Applicant's Mark claims the following in Class 35: "Business consulting services utilizing artificial intelligence, virtual reality and augmented reality in the fields of asset management planning, design and design-build of new plants and equipment, capital cost estimation, operating cost estimation and conceptual feasibility studies, manufacturing process planning and development, business management, business audits, business risk assessments and business cost assessment, master project planning and business operations support, sustainable manufacturing and/or process efficiency, reliability, capability and control; business consulting services utilizing artificial intelligence, virtual reality and augmented reality in the fields of manufacturing technology demonstration and validation, manufacturing process commissioning, assessment of business opportunities for manufacturing process improvement and risk investigations all related to manufacturing processes, plants and equipment."

In turn, Application No. 88742889 covers the following in Class 35: "Consulting services in business organization and management; Consulting services, namely, expert analysis and management consulting in economics and accounting; Business consulting services in the field of organizational change management; Business consulting, management, planning and supervision; Business management consulting; Business management consulting and advisory services; Business management consulting and advisory services for the innovation consulting

industry; Business management consulting in the field of team development; Business management consulting services in the field of innovation; Business organization and management consulting services; Business organization and management consulting; Personnel management consulting.”

Applicant acknowledges that both marks are used in connection with types of consulting. However, Applicant’s Mark is sufficiently distinct in that Applicant’s services are provided “utilizing artificial intelligence, virtual reality and augmented reality.” As such, Applicant’s services are readily distinguishable from the generalized business consulting services described in Application No. 88742889, which does not entail the high-end technology affiliated with Applicant’s Mark.

In addition, given the nature of its services, Applicant’s targeted consumers are tech-savvy individuals who are accustomed to careful investigation before undertaking any consultancy involving complex engineering, process and manufacturing issues. The degree of sophistication of the relevant consumers further reduces any risk of confusion.

CONCLUSION

Based on the foregoing, Applicant respectfully requests that U.S. Patent and Trademark Office lift the suspension and allow Applicant’s application to proceed to publication.

If the Examining Attorney has any questions or comments, please contact the undersigned representative.