

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant: RIPLE LABS INC.

Mark: 

Application No.: 88/001,478

Filed: June 14, 2018

Examining Attorney: Stephanie Rydland

Law Office: 117

**RESPONSE TO OFFICE ACTION**  
**DATED SEPTEMBER 11, 2018**

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

Dear Sir:

The following amendments and remarks are submitted in response to the Office Action dated September 11, 2018.

**I. REMARKS**

**A. Amendment to the Services in Classes 36 and 41**

The Office Action accepts the identification of goods for Class 9 and the identification of services for Class 38. The Office Action, however, requests clarifying amendments to the

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identification of services in Classes 36 and 42. Applicant submits the following clarifying amendments for Classes 36 and 42:

- Class 36: Monetary services for receiving and disbursing payments and gifts in fiat currencies and virtual currencies over a computer network, **namely, payment and funds verification services and payment transaction processing services** and exchanging fiat currencies and virtual currencies over a computer network; financial transaction services, namely, receiving and disbursing payments and gifts in fiat currencies and virtual currencies over a computer network, **namely, payment and funds verification services and payment transaction processing services**; financial services, namely, providing a virtual currency for exchange and storage over a computer network; currency exchange services, exchanging fiat currencies and virtual currencies over a computer network; payment verification services, namely, delivering payments and gifts from a source to a destination; financial management and administration services, namely, facilitating transfers of digital currency, transmission of digital currency via electronic communication networks, and electronic transmission of digital currency
- Class 42: Software as a service, featuring software for providing an electronic financial platform that facilitates transaction of payments and financial transactions over a computer network; application service provider feature application programming interface (API) software for financial platform that facilitates transaction of payments over a computer network; computer programming; design and development of computer software; computer software development consulting services; support, **namely, troubleshooting computer software problems, help desk services, troubleshooting installation and administration of computer applications** and consultation services for developing computer systems and applications; providing information in the field of computer software development online

Applicant respectfully asserts that the foregoing amendments satisfy the Office Action request to clarify the services in Classes 36 and 42.

**B. Response to Refusal under Section 2(d) – Partial Refusal in Class 42**

The Examining Attorney preliminarily refuses registration of the applied-for mark in Class 42 under Section 2(d) of the Trademark Act which bars registration of a mark which so resembles a registered mark that it is likely a potential consumer would be confused or mistaken or deceived

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as to the source of the goods and/or services of the applicant and registration. Specifically, the applied-for mark has been refused in light of U.S. trademark reg. no. 4,047,327. The details of reg. no. 4,047,327 are shown below:

Mark: RIPPLE  
Reg. No.: 4,047,327  
Reg. Date: November 1, 2011  
Class: 42  
Services: Technical support services for computers and computer networks, namely, diagnosis of computer hardware, software, and network problems, provided in person, by telephone, and by means of a global computer network; installation, updating, maintenance, and repair of computer software for others, provided in person, by telephone, and by means of a global computer network; consulting services in the field of design, selection, implementation, and use of computer hardware, software, and networks for others, provided in person, by telephone, and by means of a global computer network  
Owner: RippleIT, LLC



Applicant respectfully traverses this rejection because there is no likelihood of confusion between Applicant's mark and the mark in the cited registration.

**1. Applicant's Prior Registration and Allowed Trademark Applications**

Applicant is the owner of multiple trademark applications/registrations for the mark "RIPPLE" in connection with services in Class 42. The services in the applications/registration, along with the services in this application, are generally related to and directed towards financial related services such as financial transactions, financial payments, financial trading, and the like. As discussed below, Applicant's services are unrelated to the services provided in connection with the cited registration. Applicant is the owner of the following registration and currently pending applications:

- U.S. registration no. 4,867,705 for the mark RIPPLE TRADE, which was registered on December 8, 2015 for "services in the nature of software as a service featuring computer software platforms for financial trading transactions" in Class 42.

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- U.S. serial no. 87/459,481 for the mark RIPPLE, which was allowed on August 7, 2018, includes the following services in Class 42: “software as a service, featuring software for providing an electronic financial platform that facilitates transaction of payments over a computer network”;
- U.S. serial no. 87/459,507 for the mark  ripple, which was allowed on July 31, 2018, includes the following services in Class 42: “software as a service, featuring software for providing an electronic financial platform that facilitates transaction of payments over a computer network”;
- U.S. serial no. 87/479,623 for the mark RIPPLE, which was allowed on August 7, 2018, includes the following services in Class 42: “software as a service, featuring software for providing an electronic financial platform that facilitates transaction of payments over a computer network; electronic data storage, namely, storage of virtual currency”;
- U.S. serial no. 87/479,632 for the mark  ripple, which was allowed on August 7, 2018, includes the following services in Class 42: “software as a service, featuring software for providing an electronic financial platform that facilitates transaction of payments over a computer network; electronic data storage, namely, storage of virtual currency”;
- U.S. serial no. 87/479,703 for the mark RIPPLENET, which was allowed on July 31, 2018 includes the following services in Class 42: “software as a service, featuring software for providing an electronic financial platform that facilitates transaction of payments over a computer network”; and

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- U.S. serial no. 87/479,709 for the mark RIPPLE NETWORK, which was allowed on July 10, 2018 includes the following services in Class 42: “software as a service, featuring software for providing an electronic financial platform that facilitates transaction of payments over a computer network.”

Applicant is also the owner of the following U.S. trademark registrations for the mark RIPPLE: 4,532,727; 4,528,772; 4,532,726; 4,532,724; 4,528,771; 4,532,723; and 4,453,543; in connection with other goods and/or services.

Therefore, Applicant is the owner of numerous applications and registrations for the mark RIPPLE, and a number of these applications and a registration include the word RIPPLE in connection with services in Class 42. Because the U.S. Patent and Trademark Office has registered or allowed these marks, Applicant respectfully asserts the application for the mark



should also be allowed.


**2. The Marks have Distinct Commercial Impressions, Used in connection with Different Services, and Used by Unrelated Consumers in Dissimilar Channels of Trade**


Pursuant to *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 U.S.P.Q. 563 (C.C.P.A. 1973), the examining attorney must analyze a likelihood of confusion under two initial steps. First, the examining attorney must look at the marks themselves for similarities in appearance, sound, connotation and commercial impression. *Id.* Second, the examining attorney must compare the goods or services to determine if they are related or if the activities surrounding their marketing are such that confusion as to origin is likely. *In re August Storck KG*, 218 USPQ 823 (TTAB 1983); *In re International Telephone and Telegraph Corp.*, 197 USPQ 910 (TTAB

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1978); *Guardian Products Co. v. Scott Paper Co.*, 200 USPQ 738 (TTAB 1978). Finally, *In re E.I. du Pont*, identifies a number of other relevant factors that should be considered, including, the conditions under which and buyers to whom sales are made (*i.e.* impulse vs. careful or sophisticated purchasing). *In re E.I. du Pont*, 476 F.2d at 1361. Applicant respectfully submits that when all relevant factors are considered, there is no confusion between the applied-for mark and cited registration.


Under the first step of the analysis, the similarities of the marks are evaluated. Here, the


application is for the mark  while the cited registration is for the mark RIPPLE. While both marks contain the word RIPPLE, this fact is not determinative. *See* TMEP 1207.01 (“[T]here is no mechanical test for determining likelihood of confusion and each case must be decided on its own facts . . . In some cases, a determination that there is no likelihood of confusion may be appropriate, even where the marks are similar and the goods/services are related, because these factors are outweighed by other factors.”) (citations omitted). As discussed below, the significant differences between the marks, the services, and the high degree of consumer care outweighs any likelihood of confusion.

Applicant’s mark is  and the first portion of the mark is the wording “**RUNS ON**” in bold, capital letters. Because the wording “**RUNS ON**” is in bold, capital letters and the first part of the mark, this wording immediately grabs the attention and focus of consumer. In addition, the wording “**RUNS ON**” is the leading and foremost portion of the mark. Accordingly, the wording “**RUNS ON**” distinguishes Applicant’s mark from the mark in the cited registration.

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In addition, Applicant's mark contains a design element, a triskelion design . The triskelion design is a distinctive design and is the subject of multiple trademark registrations of Applicant. As shown in more detail below, Applicant is the owner of the following registrations that include its triskelion design: U.S. reg. no. 5,644,454 (for services in Class 42); U.S. reg. no. 5,487,954 (for services in Class 42); U.S. reg. no. 4,850,437 (for services in Class 38); U.S. reg. no. 4,850,434 (for services in Class 36); U.S. reg. no. 4,850,428 (for goods in Class 9); U.S. reg. no. 4,532,724 (for services in Class 38); U.S. reg. no. 4,528,771 (for services in Class 36); and U.S. reg. no. 4,532,723 (for goods in Class 9). The goods and services in these registrations for


the triskelion design  are generally related to and directed towards financial related goods/services such as financial transactions, financial payments, financial trading, and the like.

Consequently, the triskelion design  differentiates Applicant's mark from the mark in the cited registration.


The Office Action states "in this case, both the applicant's mark and the registrant's mark prominently feature the wording RIPPLE. The fact that the applicant has added the wording RUNS ON will not obviate the likelihood of confusion in this case as the applicant has completely incorporated the registrant's mark into its own and not changed the commercial impression of the wording RIPPLE." The Examiner further states "Additionally, the fact that the applicant has added a de minimis design element will not obviate the likelihood of confusion in this case either as the dominant portion of the mark is the wording."


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Applicant respectfully traverses the refusal to register the mark because the commercial


impression of Applicant's  mark is separate and distinct from the commercial

impression created by the mark in the cited registration. First, the look of Applicant's mark is distinct because it begins with the wording "**RUNS ON**" in bold, capital letters and then includes

the triskelion design . Thus, the appearance of the marks are dissimilar. Second, the pronunciation of the marks are not the same because Applicant's mark begins with the wording "**RUNS ON**" and it sounds nothing like the word ripple. Therefore, the distinctive sound of Applicant's mark helps confirm there is not a likelihood of confusion between the marks. Third, the meaning of the marks are unrelated. The words in Applicant's mark are "**RUNS ON RIPPLE**" and the connotation of Applicant's mark is different than simply the word "**RIPPLE**" in the cited registration. Consequently, the commercial impression created by Applicant's mark is distinct from the mark in the cited registration.

Importantly, the triskelion design element  is used extensively and exclusively by the Applicant and effectively serves, on its own, to identify Applicant as the source of the services provided.


Applicant is the owner of the following U.S. registrations:

- U.S. registration no. 5,487,497 for the mark , which was registered on June 5, 2018, for "software as a service, featuring software for providing an electronic











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financial platform that facilitates transaction of payments over a computer network”  
and



- U.S. registration no. 5,644,454 for the mark , which was registered on January 1, 2019, for “monetary services for receiving and disbursing payments and gifts in fiat currencies and virtual currencies over a computer network and exchanging fiat currencies and virtual currencies over a computer network; financial transaction services, namely, receiving and disbursing payments and gifts in fiat currencies and virtual currencies over a computer network; financial services, namely, providing a virtual currency for exchange and storage over a computer network; currency exchange services, exchanging fiat currencies and virtual currencies over a computer network; payment verification services, namely, delivering payments and gifts from a source to a destination; financial management and administration services, namely, facilitating transfers of digital currency, transmission of digital currency via electronic communication networks, and electronic transmission of digital currency” in Class 36; “peer-to-peer network computer services, namely, electronic transmission of financial data over electronic communications networks” in Class 38; and “software as a service, featuring software for providing an electronic financial platform that facilitates transaction of payments over a computer network” in Class 42.

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Applicant is also the owner of a number of registrations for the marks  and  **ripple**, for use with closely related goods and services in Classes 9, 36 and 38. Specifically, Applicant is the owner of:

- Registration no. 4,850,428 for  in Class 9;
- Registration no. 4,850,434 for  in Class 36;
- Registration no. 4,850,437 for  in Class 38;
- Registration no. 5,532,723 for  **ripple** in Class 9;
- Registration no. 4,528,771 for  **ripple** in Class 36; and
- Registration no. 4,532,724 for  **ripple** in Class 38;

Applicant is also the owner of the following trademark applications:



- Serial no. 87/459,507 for the mark  **ripple**, allowed on July 31, 2018 for “software as a service, featuring software for providing an electronic financial platform that facilitates transaction of payments over a computer network” and
- Serial no. 87/479,632 for the mark  **ripple**, allowed on August 7, 2018 for “software for providing an electronic financial platform that facilitates the transaction of payments and financial transactions over a computer network” in Class 9; “monetary services for receiving and disbursing payments and gifts in fiat

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currencies and virtual currencies over a computer network and exchanging fiat currencies and virtual currencies over a computer network; financial transaction services, namely, receiving and disbursing payments and gifts in fiat currencies and virtual currencies over a computer network; financial services, namely, providing a virtual currency for exchange and storage over a computer network; currency exchange services, exchanging fiat currencies and virtual currencies over a computer network; payment verification services, namely, delivering payments and gifts from a source to a destination; financial management and administration services, namely, facilitating transfers of digital currency, transmission of digital currency via electronic communication networks, and electronic transmission of digital currency” in Class 36; “peer-to-peer network computer services, namely, electronic transmission of financial data over electronic communications networks” in Class 38; and “software as a service, featuring software for providing an electronic financial platform that facilitates transaction of payments over a computer network” in Class 42.

In summary, Applicant has established itself as a company that provides electronic financial transactions, financial payments, financial trading, financial payment software, and related goods and services. As shown above, consumers know Applicant by its trademarks,

including RIPPLE,  and  **ripple**. Hence, consumers recognize Applicant and its

trademarks RIPPLE,  and  **ripple**, which are well known and easily recognized by consumers in the field of electronic financial payments.

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Accordingly, because Applicant's marks are well-known and easily recognized by consumers, the commercial impression of Applicant's  mark, in its entirety, is substantially different from the commercial impression of the cited registration.


Under the second step of the Section 2(d) analysis, similarities of the services are evaluated. Even where marks are identical, a likelihood of confusion does not exist, "if the goods or services in question are not related or marketed in such a way that they would be encountered by the same persons in situations that would create the incorrect assumption that they originate from the same source." TMEP § 1207.01(a)(i); *see also Shen Mfg. Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 1244-45, 73 USPQ2d 1350, 1356 (Fed. Cir. 2004) (reversing TTAB's holding that contemporaneous use of RITZ for cooking and wine selection classes and RITZ for kitchen textiles is likely to cause confusion, because the relatedness of the respective goods and services was not supported by substantial evidence); *In re Thor Tech, Inc.*, 113 USPQ2d 1546, 1551 (TTAB 2015) (finding use of identical marks for towable trailers and trucks not likely to cause confusion given the difference in the nature of the goods and their channels of trade and the high degree of consumer care likely to be exercised by the relevant consumers); *Local Trademarks, Inc. v. Handy Boys Inc.*, 16 USPQ2d 1156, 1158 (TTAB 1990) (finding liquid drain opener and advertising services in the plumbing field to be such different goods and services that confusion as to their source is unlikely even if they are offered under the same marks). Moreover, "when the relatedness of the goods and services is not evident, well known, or generally recognized, 'something more' than the mere fact that the goods and services are used together must be shown." TMEP 1207.01(a)(ii).

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The Office Action, the Examiner asserts the services in Class 42 of the application are related to the services in Class 42 in the cited registration because “both the applicant and the registrant are providing technical support services.”

A review of the TESS database of the U.S. Patent and Trademark Office indicates the owner of the cited registration, RippleIT LLC, is also the owner of the following two registrations:

- Registration no. 4,241,879 for the mark HUMANS FIRST; and

- Registration no. 4,260,879 for the mark  .

All of Registrant’s marks are for “technical support services for computers and computer networks, namely, diagnosis of computer hardware, software, and network problems, provided in person, by telephone, and by means of a global computer network; installation, updating, maintenance, and repair of computer software for others, provided in person, by telephone, and by means of a global computer network; consulting services in the field of design, selection, implementation, and use of computer hardware, software, and networks for others, provided in person, by telephone, and by means of a global computer network.”

Applicant’s services in Class 42, however, are significantly different than the “technical support services” in the cited registration. Applicant’s services in Class 42 are: “software as a service, featuring software for providing an electronic financial platform that facilitates transaction of payments and financial transactions over a computer network; application service provider feature application programming interface (API) software for financial platform that facilitates transaction of payments over a computer network; computer programming; design and development of computer software; computer software development consulting services; support, namely, troubleshooting computer software problems, help desk services, troubleshooting

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installation and administration of computer applications and consultation services for developing computer systems and applications; providing information in the field of computer software development online.”


Registrant’s services, in contrast to the financial related services of Applicant, include diagnosis of computer hardware, software, and network problems; installation, updating, maintenance, and repair of computer software; consulting services in the field of design, selection, implementation, and use of computer hardware, software, and networks. Therefore, Registrant’s services include installing, updating, diagnosing, maintaining, repairing, and consulting in the field of computer hardware, computer, software, and computer networks.

Applicant, on the other hand, provides software as a service (SAAS) in connection with electronic financial payment software. Because the marks are used in connection with different services, this confirms there is not a likelihood of consumer confusion between the marks.

Further, the respective marks are used in different channels of trade. Applicant’s electronic financial payment software and related services are used by banks and other financial institutions. Applicant’s services are highly specialized and consumers of those services are very knowledgeable and particular, and can easily recognize the source of those services. On the other hand, Registrant provides installation, updates, diagnoses, maintenance, repair, and consulting in the field of computer hardware, computer, software, and computer networks. Because the channels of trade are unrelated and used by different consumers, this also shows that there is not a likelihood of confusion between the marks.

Finally, Applicant’s marks and mark the cited registration have co-existed in commerce for a considerable period of time. For example, Applicant began using the mark RIPPLE at least

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as early as August 31, 2004 (see, e.g., U.S. reg. no. 4,453,543) and the triskelion design  since at least as early as January 1, 2013 (see, e.g., U.S. reg. nos. 4,850,428; 4,850,434; and 4,850,437). The dates of first use in the cited registration are January 1, 2006. Thus, the marks have apparently been simultaneously used in commerce for over a decade. Applicant is not aware of any actual consumer confusion with Registrant's mark. This is another reason why there is no likelihood of between Applicant's mark and the mark in the cited registration.

The foregoing demonstrates that there is no confusion between the applied-for mark and the mark in cited registration because, among other reasons, the differences in the services and target consumers negate any likelihood of confusion. Accordingly, Applicant respectfully asserts that there is no likelihood of confusion between Applicant's applied-for mark and the mark in the cited registration.

**C. Prior-Filed Application**

The Office Action states the filing date of pending U.S. Application Serial No. 87/760,055 for the mark RIPPLE precedes Applicant's filing date. The Office Action further states that Applicant's mark may be refused registration should this prior-filed application mature into a registration.

Applicant respectfully notes that U.S. Application Serial No. 87/760,055 was expressly abandoned on September 24, 2018. Accordingly, this application will not bar registration of Applicant's mark.

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## II. CONCLUSION

The Applicant respectfully asserts that the above information overcomes the Office Action rejections. Accordingly, Applicant respectfully requests the Application for the mark



be promptly allowed for publication.

If the Examining Attorney finds any remaining impediments to a prompt allowance of this Application, the Examining Attorney is encouraged to contact the undersigned attorney of record at 435-252-1360.

Respectfully submitted,

Dated: March 8, 2019

By: /Richard C. Gilmore/

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