

April 8, 2019

Via E-Filing

Commissioner for Trademarks
Alexandria, VA 22313-1451

Re: Application Serial No.: 88122400
Mark: BOUNDLESS
Filing Date: September 18, 2018
Applicant: Boundless Labs Inc.
Office Action Mailing Date: January 3, 2019
Examining Attorney: Mildred Black

RESPONSE TO OFFICE ACTION

Applicant hereby responds to the Office Action mailed on January 3, 2019 (the “Office Action”).

I. Recitation of Services

Applicant has amended its recitation of services to address the Examining Attorney’s concerns. Specifically, it amends them to read as follows:

Class 42: Providing temporary use of non-downloadable computer software for use in ~~creating, customizing, building, drafting,~~ hosting and managing websites; providing temporary use of non-downloadable computer software tools for ~~creating, customizing, building, drafting,~~ hosting and managing websites; ~~providing temporary use of non-downloadable computer software tools for creating, customizing, building, drafting, hosting and managing websites, namely, providing application programming interfaces and customizable webpage templates;~~ providing temporary use of non-downloadable computer software for providing website data, namely, customer relationship management data, campaign analytics, and web traffic data; ~~providing temporary use of non-downloadable computer software development tools.~~

II. Section 2(d) Refusal

The USPTO has refused registration of Applicant’s BOUNDLESS mark (“Applicant’s Mark”) Trademark Act § 2(d), 15 U.S.C. § 1052(d), citing U.S. Registration No. 5580679 for BOUNDLESS MIND (the “Cited Registration”).

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In light of the proposed amendments to the application, the Examiner's Section 2(d) refusal should be withdrawn. The Applicant has narrowed its Class 42 recitations significantly to make clear that the services do not include software development tools. Applicant's amended recitations further differentiate the application from the services identified in the Cited Registration.

The courts and the Trademark Trial and Appeal Board (TTAB) routinely hold that, even in a situation where two marks are identical, which is not the case here, consumer confusion is unlikely "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 . . ." Trademark Manual of Examining Procedure ("T.M.E.P.") § 1207.01(a)(i) (citing Local Trademarks, Inc. v. Handy Boys, Inc., 16 U.S.P.Q.2d 1156 (T.T.A.B. 1990) (LITTLE PLUMBER for drain opener not confusingly similar to LITTLE PLUMBER and Design for advertising services)). Here, Applicant's services, as amended, exclude software development tools. The services in the Cited Registration are fundamentally distinct.

For the reasons set forth above, the Examining Attorney should thus withdraw the Section 2(d) objection.

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III. Conclusion

Applicant respectfully submits that the Application should now proceed to publication.

Respectfully submitted,

WILSON SONSINI GOODRICH & ROSATI
Professional Corporation

By: /Susanna P. Lichter/
Susanna P. Lichter

Attorney for Applicant
Boundless Labs, Inc.