

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

Walmart Apollo, LLC

Serial No. 88/040,498



For the Equate & Design Mark:

RESPONSE

This responds to the Office Action dated November 8, 2018, in which the Office asked Walmart Apollo, LLC (“Applicant”) to (1) address any potential conflict between Applicant’s Mark and Application Serial No. 87/451,784; and (2) address the Section 2(d) refusal issued due to a possible likelihood of confusion between Applicant’s Mark and the marks in U.S. Registration Nos. 5,235,684 and 5,579,811.

For the reasons set forth below, Applicant respectfully requests that the application be suspended after the filing of this response.

I. Section 2(d), Possible Likelihood of Confusion Refusals

a. Application Serial No. 87/451,784

The Examining Attorney has raised prior-pending Application Serial No. 87/451,784 for the mark EQUATE, filed by XchangeLabs LLC (“XchangeLabs”), as a potential roadblock to the registration of Applicant’s Mark. The Examining Attorney notes that if the referenced application registers, “applicant’s mark may be refused registration under Trademark Act Section 2(d) because of a likelihood of confusion between the two marks.”

Applicant hereby clarifies that it is the owner of all right, title, and interest in and to the EQUATE mark, which it has used in US commerce with various goods since prior to the filing date of XchangeLabs’s EQUATE application. Indeed, Applicant’s mark has been in use in commerce since at least as early as 1986, long prior to the recent filing date of XchangeLabs’s application, and prior to any use date that XchangeLabs may claim. Due to its long-standing use and many registrations, Applicant’s rights in Applicant’s Mark pre-date XchangeLabs’s, and make XchangeLabs’s rights junior to Applicant’s. In view of the foregoing, on January 29, 2018, Applicant filed a Notice of Opposition against XchangeLabs. The Trademark Trial and Appeal Board (“TTAB”) instituted the proceeding on the same day. The proceeding is currently ongoing.

Given Applicant's senior rights, Applicant respectfully asks the Examining Attorney to withdraw its refusal based on XchangeLabs's mark. Alternatively, Applicant respectfully requests that the Examining Attorney suspend its examination of Applicant's Mark, per TMEP 716.02(d), until the Trademark Trial and Appeal Board ("TTAB") resolves the dispute between Applicant and XchangeLabs.

TMEP § 716.02(d) provides that the Office may suspend the examination of a mark upon learning of a pending proceeding before the TTAB, provided the applicant "submit[s] a copy of the relevant pleadings, the docket number of the proceeding, and a written explanation of why the proceeding is relevant to the registrability of the mark." *Id.* Applicant, who is the opposer in the subject proceeding, has attached as Exhibit A hereto a copy of the Notice of Opposition filed in the subject TTAB proceeding bearing Opposition No. 91239180. The subject TTAB proceeding is relevant as it directly involves Applicant's EQUATE marks for which, like here, Applicant notes are senior to XchangeLabs's mark. In particular, in its Notice of Opposition, Applicant outlines its many EQUATE registrations and applications, and outlines its longstanding use of the EQUATE mark. *See Walmart Apollo, LLC v. XchangeLabs LLC*, Opp. No. 91239180, ¶ 4-6 (TTAB filed Jan. 29, 2018). The adjudication of the pending opposition proceeding may result in XchangeLabs's cited mark being refused registration on the Principal Register. Therefore, Applicant respectfully asks that the Office suspend the examination of Applicant's Mark, pending resolution of the TTAB proceeding discussed herein.

b. Registration No. 5,235,684

The Examining Attorney has also refused registration of Applicant's Mark due to a possible likelihood of confusion between it and Registration No. 5,235,684 for the mark EQUATE for services in Class 42. This mark is owned by Radiation Reviews, LLC ("Radiation Reviews"). At the outset, Applicant notes that on May 8, 2019, concurrently with this Office Action response, Applicant filed a Petition to Cancel Registration No. 5,235,684 (See Exhibit A). Due to Applicant's senior rights in the EQUATE mark for multiple classes, in its Petition to Cancel, Applicant asserted that the Radiation Reviews mark is likelihood to cause confusion under §2(d) of the Lanham Act, likely to cause deception and/or a false suggestions of a suggestion under §2(a), and likely to dilute Applicant's EQUATE marks under § 43(c).

TMEP § 716.02(a) provides the following:

If the examining attorney refuses registration under §2(d) of the Trademark Act in view of the mark in a prior registration, the applicant may file a petition to cancel the registration under 15 U.S.C. §1064 and, within a proper response period, inform the examining attorney that the petition to cancel has been filed.

In view of the same, Applicant respectfully informs the Examining Attorney of its petition to cancel the EQUATE mark registered by Radiation Reviews. Per TMEP §716.02(d) outlined above, Applicant also hereby requests that the Office suspend its examination of the Applicant's Mark until the TTAB resolves the dispute between the parties. Applicant attaches a copy of the relevant pleadings between Applicant and Radiation Reviews. The TTAB has not yet issued a proceeding number in view of today's filing.

c. Registration No. 5,579,811

The Examining Attorney has also refused registration of Applicant's Mark due to a possible

likelihood of confusion between it and Registration No. 5,579,811 for the mark , for goods in Class 9. This mark is owned by Emglare, Inc. ("Emglare"). The Examining Attorney asserts that the Applicant's Mark is "nearly identical" to Emglare's mark. However, Applicant respectfully disagrees.

There is no likelihood of confusion because the cited mark is extremely weak and deserves only an extraordinarily narrow scope of protection. It is well settled that, in evaluating likelihood of confusion, all the relevant factors must be examined and weighed. *In re Du Pont de Nemours & Co.*, 177 U.S.P.Q. 563 (CCPA 1073). While all the factors must be considered when of record, they may be given more or less weight in any particular determination. *Id.* "Indeed, any one of the factors may control a particular case." *In re Dixie Restaurants Inc.*, 41 U.S.P.Q. 2d 1531, 1533 (Fed. Cir. 1997), citing *In re Du Pont de Nemours & Co.*, 177 U.S.P.Q. at 567.

After examining all relevant factors in this case, the inescapable conclusion must be that there is no likelihood of confusion between Applicant's mark and the cited mark.

DISSIMILAR - Applicant's Mark consists of a shaded, or color filled heart, whereas Emglare's mark does not consist of any shading. Additionally, Applicant's Mark largely showcases Applicant's famous EQUATE & design mark, consisting of Applicant's famous EQUATE word mark, and the design of two wave stripes below the mark's wording. On the other hand, Emglare's mark contains no wording. Moreover, the electrocardiogram ("EKG") lines themselves are different. On the inside of the heart featured in Applicant's Mark appears a line with a small, upward facing hump, followed by a small dip, then a line which skyrockets. Conversely, Emglare's mark, from left to right, starts with a tall line, which flows into a small dip. On their faces, these designs are different. All of these factors make confusion unlikely.

In addition, the cited mark is extremely weak rendering the differences in the marks even more significant in distinguishing them. Due to the inherent and commercial weakness of the cited mark, it is entitled, at best, to a very narrow scope of protection. The cited mark consists of the design of a heart with a line inside designed to look like an electrocardiogram. The cited mark identifies software related to measuring and storing health information, goals, and activities, which may include information concerning heart's health and cardio exercise. Thus, the cited mark is inherently weak because the design of a heart with an electrocardiogram inside may be considered descriptive of the goods when some of the goods may be related to the heart's health and cardio exercise. Furthermore, the co-existence of multiple marks featuring EKG lines and hearts, particularly in connection with goods and services in Classes 9 and 42 suggests that consumers are capable of distinguishing such marks and not being confused. Indeed, below are just a few examples of marks with EKG lines and hearts:

Mark	Status	Goods and Services	Owner
	<p>Published (Pending) Intent to Use USPTO Status: Second extension - granted USPTO Status Date: 01-OCT-2018 App 87385101 App 24-MAR-2017</p>	<p>Goods and Services: INT. CL. 9 COMPUTER APPLICATION SOFTWARE FOR MOBILE PHONES, NAMELY, SOFTWARE FOR USE IN THE HOME HEALTH CARE INDUSTRY ALLOWING SALES AND FIELD SERVICE EMPLOYEES AND EMPLOYERS TO UPDATE AND RECEIVE DATA STORED IN AN ENTERPRISE'S COMPUTER DATABASES IN REAL TIME; COMPUTER SOFTWARE, NAMELY, AN APPLICATION ALLOWING SALES AND FIELD SERVICE EMPLOYEES TO UPDATE AND RECEIVE DATA STORED IN AN ENTERPRISE'S COMPUTER DATABASES IN REAL TIME, USING A MOBILE DEVICE, WITH FULL TELEPHONY INTEGRATION WITH THE TELEPHONE AND SOFTWARE FEATURES OF THE MOBILE DEVICE INT. CL. 42 COMPUTER SOFTWARE DEVELOPMENT IN THE FIELD OF MOBILE APPLICATIONS</p>	<p>KEER, CORP. DELAWARE CORPORATION 22430 DARK STAR WAY, LEXINGTON PARK, MARYLAND, 20653</p>
<p>AFIB DETECTION PROGRAM</p>  <p>Disclaims: "AFIB DETECTION PROGRAM"</p>	<p>Published (Pending) Intent to Use USPTO Status: First extension - granted USPTO Status Date: 23-AUG-2018 App 87349376 App 24-FEB-2017</p>	<p>Goods and Services: INT. CL. 9 COMPUTER APPLICATION SOFTWARE FOR MOBILE DEVICES, NAMELY, SOFTWARE USED TO ASSESS AN IRREGULAR HEARTBEAT INT. CL. 16 PRINTED MATTER, NAMELY, BROCHURES AND PROGRAM LITERATURE, FEATURING INFORMATION IN THE FIELD OF MEDICAL RESEARCH INT. CL. 42 PHARMACEUTICAL RESEARCH AND DEVELOPMENT SERVICES RELATING TO DETECTION OF ATRIAL FIBRILLATION</p>	<p>BRISTOL-MYERS SQUIBB COMPANY DELAWARE CORPORATION 430 E. 29TH STREET, 14TH FLOOR NEW YORK, NEW YORK, 10016</p>
 <p>Disclaims: "ORGAN TRACKER"</p>	<p>Registered USPTO Status: Registered USPTO Status Date: 29-NOV-2016 App 86970795 App 11-APR-2016 Reg 5090317 Reg 29-NOV-2016</p>	<p>Goods and Services: INT. CL. 9 COMPUTER SOFTWARE FOR USE IN TRACKING THE LOCATION AND OTHER CONDITIONS OF ORGANS BEING TRANSPORTED OR STORED AND PROVIDING QUALITY ASSURANCE AS TO THE CONDITION OF THE ORGANS</p>	<p>NOVIPOD, LLC PENNSYLVANIA LIMITED LIABILITY CO. 416 MARKET STREET, SUITE 207 LEWISBURG, PENNSYLVANIA, 17837</p>
 <p>Disclaims: "FITNESS"</p>	<p>Registered USPTO Status: Registered USPTO Status Date: 07-FEB-2017 App 86747071 App 03-SEP-2015 Reg 5138376 Reg 07-FEB-2017</p>	<p>Goods and Services: INT. CL. 9 COMPUTER APPLICATION SOFTWARE FOR MOBILE PHONES, NAMELY, SOFTWARE FOR SHARING, STORING, RECORDING AND PROVIDING DATA ABOUT SPORTS, FITNESS, HEALTH AND RECREATIONAL ACTIVITIES; SOFTWARE FOR REGISTERING AND MAKING PAYMENTS FOR SPORTING EVENTS, FITNESS EVENTS, AND RECREATIONAL ACTIVITIES; SOFTWARE FOR USE IN OBTAINING SCHEDULES, LOCATIONS, AND HOURS OF SPORTING EVENTS, FITNESS EVENTS, AND RECREATIONAL ACTIVITIES; SOFTWARE FOR STORING AND TRACKING PLAYERS' STANDINGS, FITNESS GOALS, INDIVIDUAL PERFORMANCE, WORKOUT HISTORIES, AND SCORES IN SPORTING EVENTS, FITNESS EVENTS, AND RECREATIONAL ACTIVITIES; SOFTWARE FOR RECEIVING PROMOTIONAL INFORMATION AND TO CONNECT TO SOCIAL MEDIA; AND SOFTWARE FOR POSTING PHOTOGRAPHS AND</p>	<p>MOKO SOCIAL MEDIA LIMITED AUSTRALIA LIMITED LIABILITY CORPORATION 442 BEAUFORT STREET, SUITE 5, LEVEL 1 HIGHGATE, WA, 6003 AU (AUSTRALIA)</p>

Mark	Status	Goods and Services	Owner
		CONTENT TO THE INTERNET AND OTHER COMMUNICATION NETWORKS	
 Disclaims: "CPR SOCIETY"	Registered USPTO Status: Registered USPTO Status Date: 19-JAN-2016 App 86580328 App 30-MAR-2015 Reg 4888237 Reg 19-JAN-2016	Goods and Services: INT. CL. 9 EDUCATIONAL SOFTWARE FEATURING INSTRUCTION IN CARDIOPULMONARY RESUSCITATION (CPR), AUTOMATED EXTERNAL DEFIBRILLATOR (AED), FIRST AID, BASIC LIFE SUPPORT (BLS) INT. CL. 16 EDUCATIONAL PUBLICATIONS, NAMELY, TRAINING MANUALS IN THE FIELD OF CARDIOPULMONARY RESUSCITATION (CPR), AUTOMATED EXTERNAL DEFIBRILLATOR (AED), FIRST AID, BASIC LIFE SUPPORT (BLS); PRINTED PAMPHLETS, BROCHURES, MANUALS, BOOKS, BOOKLETS, LEAFLETS, INFORMATIONAL FLYERS, INFORMATIONAL SHEETS AND NEWSLETTERS, ADHESIVE BACKED STICKERS, AND KITS COMPRISED SOLELY OF ONE OR MORE OF THE FOREGOING MATERIALS IN THE FIELD OF CARDIOPULMONARY RESUSCITATION (CPR), AUTOMATED EXTERNAL DEFIBRILLATOR (AED), FIRST AID, BASIC LIFE SUPPORT (BLS) INT. CL. 41 EDUCATIONAL SERVICES, NAMELY, CONDUCTING CLASSES, SEMINARS, CONFERENCES, WORKSHOPS, RETREATS, CAMPS AND FIELD TRIPS IN THE FIELD OF CARDIOPULMONARY RESUSCITATION (CPR), AUTOMATED EXTERNAL DEFIBRILLATOR (AED), FIRST AID, BASIC LIFE SUPPORT (BLS) AND DISTRIBUTION OF TRAINING MATERIAL IN CONNECTION THEREWITH	DANIEL JACOB KIPNIS UNITED STATES INDIVIDUAL 3160 S. VALLEY VIEW BLVD, SUITE 108 LAS VEGAS, NEVADA, 89102
	Registered USPTO Status: Registered Reg 4783538 Reg 28-JUL-2015	Goods and Services: INT. CL. 42 Providing an interactive web site featuring technology that enables users to enter, access, track, monitor and generate health and medical information and reports; Software as a service (SAAS) services, namely, hosting software for use by others for use in the field of personal health information INT. CL. 44 Internet-based health care information services	Privit, Inc. 1373 Grandview Avenue, Suite 200 Columbus, OHIO UNITED STATES 43212

Copies of these registrations and applications from the PTO website are attached as Exhibit B.

As shown, multiple marks are capable of peacefully co-existing on the Federal Register. The coexistence of these marks confirms that the design portion of the cited mark is so weak and commercially diluted that the cited mark deserves only an extremely narrow scope of protection. *In re Dayco Products-Eagle Motive, Inc.*, 9 U.S.P.Q. 2d 1910 (TTAB 1988). *King Candy Co. v. Eunice King's Kitchen, Inc.*, 182 U.S.P.Q. 108 (CCPA 1974). **All** the marks listed above consist or contain a heart design with an electrocardiogram line inside, alone or combined with sometimes descriptive, disclaimed words, and they **all** identify various types of health and wellness-related software or software-related services. The fact that these marks have coexisted in the marketplace shows that consumers have learned to distinguish different sources of health-related goods and services identified by marks containing a heart design with an

electrocardiogram line. If these marks can coexist, then minor differences in the marks and/or goods are clearly sufficient to preclude any confusion and Applicant's distinctive mark may coexist without confusion as well.

Similarly, the fact that the U.S. Trademark Office granted registration to the cited mark and to the registrations listed above, or allowed the applications listed above, is irrefutable evidence that the U.S. Trademark Office recognized that the cited mark and these third party marks could coexist without any likelihood of confusion, even though **they all contain a heart design with an electrocardiogram design**, and that **they all identify health and wellness-related software** or related services. When the U.S. Trademark Office granted registration to the following marks owned by different companies, for identical or closely related goods and services, the U.S. Trademark Office recognized that these marks and the cited mark could coexist despite that they both contained a heart design with an electrocardiogram line in a similar manner and that they identify identical or closely related goods and services.



Thus, the U.S. Trademark Office recognized that the cited mark is so weak that extremely minor differences in the shape of the electrocardiogram lines in the designs and/or the addition of other words, including descriptive, disclaimed words, was sufficient to preclude confusion with an otherwise virtually identical mark for goods that could overlap. Because the U.S. Trademark Office admitted that marks consisting of or containing a heart design with an electrocardiogram line, all for health and wellness-related software or related services, can coexist without any likelihood of confusion, the U.S. Trademark Office should likewise reach the conclusion that Applicant's highly distinctive mark will coexist without any confusion as well.

Furthermore, Applicant respectfully contends that no confusion is likely between Applicant's mark and the cited mark in view of the differences in the marks and in their overall commercial impressions. In a likelihood of confusion analysis, the marks at issue must be compared in their entireties. *In re Loew's Theatres, Inc.*, 218 U.S.P.Q. 956 (TTAB 1983), *aff'd*, 226 U.S.P.Q. 856 (Fed. Cir. 1985). There is no *per se* rule compelling a finding of likely confusion where one mark contains a part of another's mark. *See, e.g., Colgate-Palmolive Co. v. Carter-Wallace, Inc.*, 167 U.S.P.Q. 529 (CCPA 1970) (PEAK PERIOD not confusingly similar to PEAK); *In re Ferrero*, 178 U.S.P.Q. 167 (CCPA 1973) (TIC TAC not confusingly similar to TIC TAC TOE); *Conde Nast Publications, Inc. v. Miss Quality, Inc.*, 184 U.S.P.Q. 422 (CCPA 1975) (COUNTRY VOGUES not confusingly similar to VOGUE); *In re Merchandising Motivation, Inc.*, 184 U.S.P.Q. 364 (TTAB 1974) (MMI MENSWEAR not confusingly similar to MEN'S WEAR). To the contrary, the law requires full consideration of the similarity or dissimilarity of the marks (in terms of their appearance, sound, connotation and overall commercial impression) when viewed in their entireties. If this is true when the shared element is a distinctive part of a

word mark, it is clearly true when the shared element consists just of a very weak element and a design element, like in the present case. Therefore, no part of a mark can be discounted in a likelihood of confusion analysis.

The U.S. Court of Appeals for the Federal Circuit has held that the dissimilarity of the marks alone can support a finding that there is no likelihood of confusion. In *Champagne Louis Roederer, S.A. v. Delicato Vineyards*, 148 F.3d 1373 (Fed. Cir. 1998), the Court upheld the TTAB's dismissal of an opposition to registration of the mark CRYSTAL CREEK for wine filed by the owner of the registered mark CRISTAL for champagne. The dismissal was based primarily on the differences created by the addition of the word CREEK. A similar conclusion should be reached in this case.

Here, the cited mark consists of the design of a heart and electrocardiogram line depicted below:



Applicant's mark consists of a design of a square containing a white square shape with rounded corners, featuring a design with a heart in black containing an electrocardiogram line in white inside the heart. Applicant's famous house mark EQUATE is prominently displayed above the heart design, just above two parallel wavy lines, as follows:



As discussed above, the design of a heart with an electrocardiogram line in connection with health and wellness-related software and related services is highly commercially diluted and inherently very weak. Thus, consumers are likely to focus on the dominant portion of Applicant's mark, the famous house mark EQUATE, as the source-indicating feature, instead of on the highly diluted and inherently weak design portion. When compared in their entireties, Applicant's mark and the cited mark look and sound very different. The overall commercial impressions created by the marks are also sufficiently different to preclude any confusion, especially in view of the significant weakness of the cited mark and the exceptional fame and strength of Applicant's house mark EQUATE. Thus, the differences in the marks, combined with the extraordinary weakness of the cited mark, will preclude any confusion.

II. Conclusion

Based on the foregoing, the refusal to register should be withdrawn and Applicant's Mark should be approved for publication as soon as possible. Alternatively, Applicant respectfully requests that its application be suspended pending the formal resolution of the proceedings discussed herein.

Respectfully submitted,

WALMART APOLLO, LLC

Elizabeth H. Cohen

By: _____

Elizabeth H. Cohen

Danielle W. Bulger

Chiara Giuliani

Arent Fox LLP

1301 Avenue of Americas, Floor 42

New York, NY 10019

(212) 457-5418

Elizabeth.Cohen@arentfox.com

Danielle.Bulger@arentfox.com

Chiara.Giuliana@arentfox.com

Attorneys for Applicant