

RESPONSE TO NON-FINAL OFFICE ACTION
Dated June 7, 2019

U.S. Trademark Application Serial No.: 88/352,915

Filing Date: March 22, 2019

Mark: ARC

Class: 042

Goods: “*Software as a service featuring software for use in flight planning and flight navigation; chart preparation being mapping services in digital form; application service provider featuring software for use in flight planning and flight navigation; design of computer programs and software relating to aircraft; design and development of computer software for evaluation and calculation of data in connection with aircraft flight path; providing temporary use of online non-downloadable, interactive software featuring interactive maps, allowing users to explore places, plan and book travel activities*”

Applicant: Panasonic Avionics Corporation

Attorney Docket No.: 106475-10US03

RESPONSE AND ARGUMENT

In the United States Patent and Trademark Office (USPTO) Non-Final Office Action dated June 7, 2019, the Examining Attorney (1) issued a likelihood of confusion refusal under Trademark Act Sec. 2(d), 15 U.S.C. §1052(d) with regard to U.S. Registration No. 5599348, and (2) required amendment to the identification of services. The Trademark Examining Attorney’s remarks and analysis were reviewed and carefully considered, and Applicant responds to each issue raised in turn below.

I. SECTION 2(d) REFUSAL – LIKELIHOOD OF CONFUSION

The Examining Attorney issued a likelihood of confusion refusal under Trademark Act Sec. 2(d), 15 U.S.C. §1052(d) with regard to U.S. Registration No. 5599348 for the stylized mark “ARC” covering “*Online non-downloadable web based software and applications for corporate flight departments, private aviation commercial operators, private aviation owners and operators, general aviation pilots, drone operators, and flight schools for submitting, storing, analyzing and auditing Safety Management System data as well as for the development and distribution of operations support documentation*”, in Class 42. As discussed in detail below, Applicant respectfully disagrees with the Examining Attorney, as there are significant differences in Applicant’s and Registrant’s services, such that no likelihood of confusion exists.

Trademark Act Section 2(d) bars registration of an applied-for mark that so resembles a registered mark that it is likely a potential consumer would be confused, mistaken, or deceived as to the source of the goods and/or services of the applicant and registrant. *See* 15 U.S.C. §1052(d). A determination of likelihood of confusion under Section 2(d) is made on a case-by case basis and the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973) aid in this determination. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d 1344, 1349, 98 USPQ2d 1253, 1256 (Fed. Cir. 2011) (citing *On-Line*

Careline, Inc. v. Am. Online, Inc., 229 F.3d 1080, 1085, 56 USPQ2d 1471, 1474 (Fed. Cir. 2000)). Not all the *du Pont* factors, however, are necessarily relevant or of equal weight, and any one of the factors may control in a given case, depending upon the evidence of record. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d at 1355, 98 USPQ2d at 1260; *In re Majestic Distilling Co.*, 315 F.3d 1311, 1315, 65 USPQ2d 1201, 1204 (Fed. Cir. 2003); see *In re E. I. du Pont de Nemours & Co.*, 476 F.2d at 1361-62, 177 USPQ at 567. In this case, the dissimilar nature of the services, and the sophistication of the purchasers and the conditions under which the services are purchased are the most relevant factors to be considered.

As an initial matter, Applicant notes that the Examining Attorney has approved for publication Applicant's co-pending U.S. Application Serial No. 88/352,897 for the same mark "ARC", covering the actual Class 09 goods used in rendering Applicant's Class 42 services. Moreover, Applicant's Class 09 application was initially refused registration based on a likelihood of confusion with U.S. Registration No. 5599348, also cited herein against the instant application. The Examining Attorney withdrew the refusal of the Class 09 application upon consideration of Applicant's Response to Office Action explaining the differences between Applicant's Class 09 goods and Registrant's Class 42 services, and agreed that no likelihood of confusion existed. Therefore, in this case, Applicant respectfully requests uniform consideration of its instant application covering its Class 42 services, and that the Examining Attorney finds no likelihood of confusion between its applied-for mark in Class 42 and the cited registration.

a. Applicant's and Registrant's Services Are Dissimilar

The Examining Attorney argues that Applicant's and Registrant's services are highly similar and related, and submits third-party evidence allegedly showing that safety management software services, such as those provided by Registrant, also incorporate mapping, flight planning, and location functions such as those referenced in the application, and that those providing such software also provide services such as design and development of software related to aircraft. Applicant respectfully disagrees with the Examining Attorney and for the reasons discussed below submits that there is no likelihood of confusion.

Applicant's and Registrant's services are dissimilar, as Applicant's services are for the provision of information and data specifically for navigational mapping and circulation of data relating to the flight path of an aircraft displayed to passengers and enabling them to interact with the map on the headrest television on commercial flights. Applicant's SaaS is provided via the television screen located on the back of each seat on the aircraft displaying the global position of the commercial aircraft to commercial passengers, while Registrant's services are for aviation operators to actively mitigate risk by organizing and controlling variables to help facilitate the safe operation of aircraft.

Applicant's description of services in the instant application contains sufficient limitations indicating the software as a service (SaaS) is limited to navigational mapping. It is reasonable to say the majority of consumers who have taken a commercial flight have experienced Applicant's products and services first hand during a commercial flight when viewing and using the interactive map on the seat back in front of them, which displays the real-time position of the

aircraft during the flight, and contains data about the flight, such as altitude, speed, air temperature, flight time remaining, etc. *See* photo of interactive in-flight map resembling the provision of Applicant's services attached at Exhibit 1. Applicant's services provide information on the status of a flight path. Passengers cannot use this information to control any variable about the aircraft or the flight, nor is the information intended to keep the passengers safe or used to monitor the safety of the aircraft, as is the case for the safety management system software provided by Registrant.

Registrant's services are intended to enable users to maintain safety management systems (SMS) for Fortune 500 flight departments, pilot management companies, and small single aircraft private operators. *See* Registrant's specimen describing its services attached at Exhibit 2. Registrant's aviation SMS software services are essentially designed to provide a centralized database for submitting and storing files relating to flight risk assessment, maintenance logs, processes, resources, and manuals used in mitigating risk and ensuring safety standards are met in operating aircraft. *See* Registrant's website describing its SMS services attached at Exhibit 3, <https://aviationmanuals.com/aviation-safety-management-software/>. *See* definition of Aviation Safety Management System at Exhibit 4, <https://www.asms-pro.com/SMS/AviationSafetyManagementSystem.aspx>. An SMS is designed for and utilized by aircraft operators to manage procedures required to ensure the safe operation of aircraft, proper documentation of flight information and data is maintained and stored, and to ensure proper adherence to Federal Aviation Administration (FAA) regulations and other policies and guidelines governing the operation of aircraft. *See* FAA information relating to SMS attached at Exhibit 5 <https://www.faa.gov/about/initiatives/sms/>. An SMS such as the services provided by Registrant is entirely dissimilar and unrelated to Applicant's navigational mapping SaaS used by passengers on commercial airlines. Consumers would not be confused between Applicant's and Registrant's services.

In view of the above, Applicant's and Registrant's services are very dissimilar, and there is no likelihood of confusion.

b. Consumers of Applicant's and Registrant's Services are Highly Sophisticated and the Conditions Under Which the Services are Purchased Require Careful Decision Making

Moreover, consumer confusion between Applicant's and Registrant's services is unlikely because the consumers of both Applicant's and Registrant's services are highly sophisticated purchasers who will distinguish the services and the marks, and will exercise a great deal of care in the purchasing decision after careful consideration of the services. *See, e.g., In re N.A.D., Inc.*, 754 F.2d 996, 999-1000, 224 USPQ 969, 971 (Fed. Cir. 1985) (concluding that, because only sophisticated purchasers exercising great care would purchase the relevant goods, there would be no likelihood of confusion merely because of the similarity between the marks NARCO and NARKOMED); *Primrose Ret. Cmty., LLC v. Edward Rose Senior Living, LLC*, 122 USPQ2d 1030, 1039 (TTAB 2016) (finding that, "even in the case of the least sophisticated purchaser, a decision as important as choosing a senior living community will be made with some thought and research, even when made hastily"); *In re Homeland Vinyl Prods., Inc.*, 81 USPQ2d 1378, 1380, 1383 (TTAB 2006). In this case, only sophisticated purchasers exercising great care will

purchase Applicant's and Registrant's services, and therefore there will be no likelihood of confusion. The purchasers of Applicant's services are commercial airline manufacturers who owe a duty to passengers to carefully select equipment that is safe, functional and reliable. Likewise, consumers purchasing Registrant's SMS services are operators of aircraft specifically selecting the services to mitigate risk and ensure the safe operation of aircraft to protect the lives of passengers and individuals operating the aircraft. Certainly, both commercial airline manufacturers and aircraft operators are sophisticated purchasers who exercise a great deal of care in making purchasing decisions of aircraft instruments and equipment. Both have a duty to ensure passenger and operator safety, and would not be confused between the navigational mapping software services offered by Applicant, and the safety management system software services offered by Registrant. The decision to purchase the services of Applicant and the services of Registrant is made only after careful research and deliberation.

In view of the above, only sophisticated purchasers exercising great care will purchase Applicant's and Registrant's services, and therefore there will be no likelihood of confusion.

Applicant's and Registrant's services are dissimilar, as Applicant's navigational mapping software services enabling passengers to interact with the map on the headrest television on commercial airlines is very different than Registrant's safety management system software designed to mitigate risk and ensure the safe operation of aircraft to protect the lives of passengers and individuals operating the aircraft. Therefore, no likelihood of confusion exists based on the dissimilar nature of Applicant's and Registrant's services, and the sophistication of the relevant purchasers and the conditions under which the services are purchased. As a result, Applicant respectfully requests withdrawal of the likelihood of confusion refusal.

II. AMENDMENT TO IDENTIFICATION OF SERVICES

The Examining Attorney required amendment to the Class 042 services listed in the instant application.

Applicant accepts the Examining Attorney's suggested amendments and requests the amended Class 042 description of services be submitted herein. As amended, Applicant's Class 042 services shall read as follows:

“Software as a service featuring software for use in flight planning and flight navigation; chart preparation being mapping services in digital form; application service provider featuring software for use in flight planning and flight navigation; design of computer programs and software relating to aircraft; design and development of computer software for evaluation and calculation of data in connection with aircraft flight path; providing temporary use of online non-downloadable, interactive software featuring interactive maps, allowing users to explore places, plan and book travel activities”

LISTING OF EVIDENCE

Applicant respectfully submits the following evidence in support of its arguments:

- Exhibit 1: Photo of interactive in-flight map resembling Applicant's services
- Exhibit 2: Cited Registration No. 5599348 Specimen describing SMS services
- Exhibit 3: Website of owner of Cited Registration describing its SMS services
- Exhibit 4: Definition of Aviation Safety Management System
- Exhibit 5: Federal Aviation Administration information relating to SMS

CONCLUSION

With this Response, Applicant believes its application is now in condition for publication and allowance, and respectfully requests the Examining Attorney withdraws the refusal, and allows the application to proceed to publication and allowance.

Should any outstanding issues remain, the Examining Attorney is courteously invited to contact Lisel M. Ferguson via telephone at 619-515-3207, or via email at lisel.ferguson@procopio.com.

Respectfully submitted,

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