

ARGUMENT SECTION OF RESPONSE

In the Office Action dated July 3, 2019, the Examining Attorney refused registration of Applicant's mark AIDA ("Applicant's Mark"), sought to be registered in connection with the goods and services set forth in this application in Classes 9, 38, 41 and 42 ("Applicant's Goods & Services") under Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d), on the basis of an alleged likelihood of confusion between Applicant's Mark and the marks set forth in the noted registrations (or application) covering the noted services:

- (i) U.S. Reg. No. 5,093,295 (A.I.D.A.) registered for "Electronic transmission of invoices; telecommunications and electronic data transmission, in particular the transmission of data, images and documents between and via computer terminals and computer networks, as well as via the Internet; providing access to data in computer databases and computer networks and on the Internet; delivery of messages by electronic transmission," in Class 38;
- (ii) U.S. Reg. No. 5,404,874 (AIDA) registered for "educational services, namely, providing courses of instruction in the field of insurance and data analytics and providing on-line courses of instruction containing content in the field of insurance and data analytics," in Class 41;
- (iii) U.S. Reg. No. 3,140,905 (AIDA CRUISES) registered for "education, namely, providing training services in the fields of tourism, geography, travel, nautical practice, tennis, golf, biking, diving, dancing and cooking," in Class 41; and
- (iv) U.S. Appl. Serial No. 79/259,817 (AIDAF), a prior-pending application, pending for various services in Classes 35 and 41, including "education and training on information processing technology; education on information processing systems; education and training on management strategy; [and] education and training on product sales," in Class 41 (collectively, the "Cited Marks").

Applicant respectfully traverses the grounds of refusal and submits that Applicant's Mark should proceed to publication for opposition. Applicant addresses the refusal in the discussion set forth below.

DISCUSSION

Applicant's Mark does not conflict with any of the Cited Marks and should be registered on the Principal Register. In short, an otherwise viable trademark application should not be refused under Section 2(d) unless a potential consumer is likely to be confused or mistaken about whether the applicant's goods or services and those of a senior registrant emanate from the same source. *See* 15 U.S.C. § 1052(d); *Paula Payne Prods. Co. v. Johnson's Pub'g Co.*, 473 F.2d 901, 902, 177 U.S.P.Q. 76, 77 (C.C.P.A. 1973) ("[T]he question is not whether people will confuse the marks, but rather whether the marks will confuse people into believing that the goods they identify emanate from the same source.").

Applicant respectfully submits that Applicant's Mark is not likely to cause confusion with the Cited Marks because: (i) the Cited Marks are weak due to wide registration and use and therefore the Cited Marks have only a very narrow scope of protection; (ii) the respective services are not similar and are not sufficiently related to cause a likelihood of confusion; and (iii) the respective services are purchased with a high degree of care, which further avoids a likelihood of confusion.

I. The Cited Marks are weak due to wide registration and use and therefore the Cited Marks have only a very narrow scope of protection

The Court of Appeals for the Federal Circuit and the Trademark Trial and Appeal Board have recognized that weak designations are generally entitled to a narrower scope of protection compared to marks that are strong. *See Trademark Manual of Examining Procedure* § 1207.01(b)(ix) ("TMEP"). Weak marks are entitled to a narrow scope of protection because they are less likely to impress or be remembered by the relevant public, less likely to be associated with a single source, and less likely to be confused. *See Richard L. Kirkpatrick, Likelihood of Confusion in Trademark Law* § 3.3 (4th ed. 1999).

A likelihood of confusion between two marks is greatly reduced where the cited mark is weakened due to third-party registration and apparent use for similar goods or services. *See, e.g., The Land-O-Nod Co. v. Paulson*, 220 U.S.P.Q. 61, 66-67 (T.T.A.B. 1983) (finding no likelihood of confusion between CHIRO-MATIC and CHIROPRACTIC and CHIRO-, all for mattresses and box springs, in part due to the number of third party registrations and uses of the term CHIRO for mattresses and box springs). Additionally, third-party registrations may be relevant to show that the cited mark is weak and thus entitled to a narrow scope of protection. *See TMEP* § 1207.01(d)(iii) ("[T]hird-party registrations may be relevant to show that a mark or a portion of a mark is ... so commonly used that the public will look to other elements to distinguish the source of the goods or services").

Applicant submits that the Cited Marks are weakened due to third-party registrations and apparent uses of marks registered and used for goods and services that overlap with and are related to services covered by the registrations for the Cited Marks, as evidenced by the marks identified in the tables below.

The following relevant marks are coexisting with the Cited Mark A.I.D.A. in Class 38:

<u>Mark</u>	<u>Owner</u>	<u>Reg. No. / Serial No.</u>	<u>Goods/Services</u>
A.I.D.A.	Lufthansa AirPlus Servicekarte n GmbH	5,093,295	Electronic transmission of invoices; telecommunications and electronic data transmission, in particular the transmission of data, images and documents between and via computer terminals and computer networks, as well as via the Internet; providing access to data in computer databases and computer networks and on the Internet; delivery of messages by electronic transmission, in Class 38

<u>Mark</u>	<u>Owner</u>	<u>Reg. No. / Serial No.</u>	<u>Goods/Services</u>
AIDASS	Airbus Defence & Space GmbH	3,510,349	Transmission of data from test equipment via telecommunications media and via Internet and local area networks, in Class 38
AYDE	Ayde Belize LTD	88/283,134 (Allowed)	(including) Electronic transmission of audio, video, and multimedia content by means of the Internet; electronic exchange of voice, data, audio, video, and text communications stored in databases accessible via telecommunications networks; instant messaging services; providing interactive internet chat rooms for transmission of messages among users; electronic transmission of e-mail; transmission of information on optical telecommunication networks; providing access to databases; providing multiple user access to a global computer information network; internet telephone communication services; electronic computer data transmission services; delivery of digital music by electronic transmission, in Class 38
AIDO	AIDO International LTD.	87/092,565 (Allowed)	(including) Telecommunications and broadcast communication services, namely, telecommunication access and gateway services, digital network telecommunications services, transmission of webcasts and podcasts, providing electronic message alerts via the internet, personal communication services and, providing multiple-user access to a global computer network, transmission of voice, data, graphics, images, audio and video by means of telecommunications networks, wireless communication networks, and the Internet; providing access to databases; providing access to online databases via online community portal; electronic data interchange; telecommunications services, namely, providing access to computer databases; providing access to databases for the purpose of downloading information via electronic media, in Class 38

(See Exhibit A – true and correct copies of printouts from the USPTO’s TESS database for the marks and registrations and applications referenced above are attached as Exhibit A).

Additionally, the following relevant marks are coexisting with the Cited Marks in Class 41:

<u>Mark</u>	<u>Owner</u>	<u>Reg. No. / Serial No.</u>	<u>Goods/Services</u>
AIDA	American Institute for Chartered Property Casualty Underwriters	5,404,874	(including) Educational services, namely, providing courses of instruction in the field of insurance and data analytics and providing on-line courses of instruction containing content in the field of insurance and data analytics, in Class 41
AIDA CRUISES	AIDA Cruises German Branch of Costa Crociere S.P.A.	3,140,905	(Including) Education, namely, providing training services in the fields of tourism, geography, travel, nautical practice, tennis, golf, biking, diving, dancing and cooking; and organizing community sporting and cultural events, namely, golf excursions, golf tournaments, diving excursions, biking tours and dancing tournaments, in Class 41
AIDAF	Yoshimasa Masuda	79/259,817*	(including) Education and training on information processing technology; education on information processing systems; education and training on management strategy; [and] education and training on product sales,” in Class 41 * = June 20, 2019 Office Action indicated that the Examining Attorney found no conflicting marks that would bar registration under Trademark Act Section 2(d)
A.I.D.E.	Transportation Safety Systems	5,912,455	Professional driver education courses, in Class 41
AIDO	AIDO International LTD.	87/092,565 (Allowed)	(including) Teaching, education, training and entertainment services, namely, providing classes, seminars, workshops in the fields of art, music and artistic performances, entertainment, fashion, sports, culture, film production; provision of non-downloadable films and television programs via video- on-demand services; arranging and conducting professional workshop courses and educational congresses; Organization of exhibitions for cultural or educational purposes; Publication of online books and online journals, in Class 41
AIDE UNIVERSITY & Design	Kenyon Healthcare Consulting, LLC	4,844,323	Education services, namely, providing online training courses in the field of chronic disease care, in Class 41

(See Exhibit B – true and correct copies of printouts from the USPTO’s TESS database for the marks and registrations and applications referenced above are attached as Exhibit B).

The relevant third-party registrations and applications covering overlapping and related services in Classes 38 and 41 captured in the tables above, along with the Cited Marks, demonstrate that the Cited Marks are weak and entitled to only a very narrow scope of protection.

The narrow scope of protection for the Cited Marks suggests that there is no likelihood of confusion between Applicant’s Mark and the Cited Marks. *See Angelica Corp. v. Collins & Aikman Corp.*, 192 U.S.P.Q. 387, 393-394 (T.T.A.B. 1976) (stating that third-party registrations and uses were relevant to show that the element “ANGEL” was relatively weak, which supported the finding that there was no likelihood of confusion between the marks ANGELICA and GUARDIAN ANGEL used for identical goods and services).

In situations such as this one, a likelihood of confusion is reduced because consumers have learned to carefully pick out one mark from another based on small distinctions among the crowded field of marks. *See, e.g., Steve’s Ice Cream v. Steve’s Famous Hot Dogs*, 3 U.S.P.Q.2d 1447, 1479 (T.T.A.B. 1987) (stating that numerous third-party registrations and uses of “STEVE’S” in the related industries of restaurants and food stores showed that the purchasing public is able to distinguish the marks based on small differences and holding that STEVE’S & Design for restaurant services was not confusing similar for STEVE’S for ice cream for consumption on and off the premises). *See also Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee en 1772*, 73 U.S.P.Q.2d 1689, 1693 (Fed. Cir. 2005) (stating that if the evidence establishes that the consuming public is exposed to third-party use of similar marks on similar goods, it “is relevant to show that a mark is relatively weak and entitled to only a narrow scope of protection.”).

Accordingly, the weak nature of the Cited Marks suggests that there is no likelihood of confusion between Applicant’s Mark and the Cited Marks and that the relevant consuming public will be able to distinguish between the respective marks.

II. The respective services are not similar and are not sufficiently related to cause a likelihood of confusion

Applicant respectfully submits that it is not appropriate to conclude that the respective services are similar merely because they can broadly be classified “telecommunications” and “transmission services” in Class 38, and “educational services” in Class 41. Among the du Pont factors, the relatedness of the goods or services in question is among the most relevant for determining likelihood of confusion. *See TMEP* § 1207.01; *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 1103, 192 U.S.P.Q. 24, 29 (C.C.P.A. 1976) (“[t]he fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.”).

As courts have noted, “even when two products or services fall within the same general field, it does not mean that the two products or services are sufficiently similar to create a likelihood of confusion.” *Harlem Wizards Entm’t Basketball, Inc. v. NBA Properties, Inc.*, 952 F. Supp. 1084, 1095 (D.N.J. 1997). Importantly, there is no “per se” rule that certain products are to be deemed related by nature or by virtue of their capability of being sold in the same store or same channel of

trade. See *Interstate Brands Corp. v. Celestial Seasonings, Inc.*, 198 U.S.P.Q. 151, 152-153 (C.C.P.A. 1978) (holding that there is no “per se” rule that all food products are deemed related goods by nature and determining that there was no likelihood of confusion between ZINGERS for snack cakes and RED ZINGER for herb tea). See also 4 J. Thomas McCarthy, *McCarthy on Trademarks & Unfair Competition*, § 24:48, at 24-128 (4th Ed. Rel. 79 Sept. 2016) (noting that there is no per se rule of confusion between food products and indicating that a likelihood of confusion as to similar marks used on different food items must be analyzed by the appropriate du Pont factors) (hereinafter “McCarthy”).

In this instance, Applicant’s “telecommunications” and “transmission services” in Class 38, include “provision of chat rooms on the Internet”; “transmission of video-on-demand footage”; “wireless broadcasting services” and “telecommunication services, namely, transmission of podcasts.” Conversely, the services in the Cited Mark in Class 38 (Reg. No. 5,093,295), include “electronic transmission of invoices” and “providing access to data in computer databases and computer networks and on the Internet.”

Additionally, as amended, Applicant seeks to register Applicant’s Mark in connection with, *inter alia*, “Educational services, namely, providing tutoring, teaching and personal coaching services in various disciplines **at the primary, secondary, undergraduate, graduate, vocational and professional development levels** and “personalized learning services in various disciplines **at the primary, secondary, undergraduate, graduate, vocational and professional development levels** using artificial intelligence” (emphasis added).

Conversely, the registrations and application for the three Cited Marks in Class 41 cover services that do no overlap with Applicant’s services because the registrations and application for the three Cited Marks cover distinct services such as “providing courses of instruction in the field of insurance and data analytics” (Reg. No. 5,404,874); “providing training services in the fields of tourism, geography, travel, nautical practice, tennis, golf, biking, diving, dancing and cooking” (Reg. No. 3,140,905); and “education and training on information processing technology” and “education on information processing systems” (Appl. No. 79/259,817).

Further, Applicant notes that the AIDA mark of Registration No. 5,404,874 was allowed to register on the Principal Register notwithstanding the prior existence of Registration No. 3,140,905 and that neither registration was has been cited against Application No. 79/259,817 of the AIDAF mark. Therefore, the fact that each of these marks has been allowed to coexist on the Principal Register also supports the basis that Applicant’s Mark may similarly coexist and mature to registration on the Principal Register given the differing goods and services in the application.

Accordingly, Applicant respectfully submits that it is not appropriate to conclude that Applicant’s services and the services offered under the Cited Marks are related merely because the services generally relate to telecommunications and transmission services in Class 38 and educational services in Class 41.

III. The relevant goods are purchased with a high degree of care, which further avoids a likelihood of confusion.

The degree of care used by consumers and the conditions under which the goods and services at issue are purchased are important factors that should be considered when assessing the existence of a likelihood of confusion. *See In re E.I. Du Pont de Nemours & Co.*, 177 U.S.P.Q. 563, 567 (C.C.P.A. 1973).

Applicant respectfully submits that, given the specialized nature of the respective services (“telecommunications services” and “transmission services” in Class 38, and “educational services” in Class 41), there is no likelihood of confusion between Applicant’s Mark and the Cited Marks in light of the conditions under which the respective services are offered and purchased. The prudent ordinary-buyer standard may be elevated to a “higher, more discriminating level” based on the nature of the goods/services being purchased. *McCarthy, supra*, § 23:96.

In this instance, with respect to telecommunication services, Applicant respectfully submits that, for example, “provision of chat rooms on the Internet;” “transmission of video-on-demand footage;” and “transmission of videos on demand,” are specialized in their nature and purpose such that the noted services are only purchased by the relevant consumers after prudent and careful consideration. Similarly, given the specialized nature and purpose of the Class 38 services covered by Reg. No. 5,093,295 (including “electronic transmission of invoices”), Applicant respectfully submits that such services are also only purchased by the relevant customers after purchasers have exercised prudent and discriminating consideration.

Additionally, with respect to educational services, Applicant respectfully submits that, for example, educational services in the nature of “tutoring, teaching and personal coaching services in various disciplines at the primary, secondary, undergraduate, graduate, vocational and professional development levels,” are specialized in their nature and purpose such that the noted services are only purchased by the relevant consumers after prudent and careful consideration.

Similarly, given the specialized nature and purpose of the educational services covered by the registrations and application for the Cited Marks in Class 41 (including, “providing courses of instruction in the field of insurance and data analytics” (Reg. No. 5,404,874); “providing training services in the fields of tourism, geography, travel, nautical practice, tennis, golf, biking, diving, dancing and cooking” (Reg. No. 3,140,905); and “education and training on information processing technology; education on information processing systems” (Appl. No. 79/259,817)), Applicant respectfully submits that such services are also only purchased by the relevant customers after purchasers have exercised prudent and discriminating consideration.

In short, in all instances involving the respective services, when the respective relevant purchasers are making their purchasing decisions involving such services, the respective purchasers are exercising great care and are more prudent than the ordinary buyer who purchases inexpensive items that are regularly purchased without much thought, like inexpensive snacks, fast food services, or convenience store services. *See id.* In other words, given their respective purpose and nature, Applicant submits that the respective services are not purchased on impulse but rather with great care.

Consequently, in light of the respective specialized nature, the respective services are purchased with a high degree of care, which further suggests that the relevant purchasers are not likely to mistakenly believe that Applicant's Mark (and its underlying services) are associated with the Cited Marks (or their corresponding services).

CONCLUSION

Based on the foregoing, Applicant hereby submits that the application is in condition for publication and respectfully requests action consistent therewith. The Examining Attorney is requested to contact the Attorney of record for Applicant if a telephone conference might be of assistance.