

**UNITED STATES DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE**

In Re the Trademark Application of:

Applicant: Gemini Data, Inc.

Trademark Law Office: 101

Mark: 
(GEMINI Design)

Examiner: Russ Herman


Serial No: 88421657

Classes: 9, 42

Filed: May 8, 2019

Mailing Date: July 7, 2019

RESPONSE TO OFFICE ACTION

Applicant Gemini Data, Inc. (“Applicant”) hereby responds to the office action issued in connection with its above-captioned application for the GEMINI Design mark  (“Applicant’s Mark”).

I. INFORMALITIES

A. Amendment to Identification

Applicant’s original application sought registration in connection with:

Class 9: Downloadable computer software for use in enterprise data collection, transmission, visualization, integration, analysis, management, and storage using machine learning and artificial intelligence

Class 42: Software as a service (SaaS) services featuring software for use in enterprise data collection, transmission, visualization, integration, analysis, management, and storage using machine learning and artificial intelligence

In order to clarify Applicant’s services, Applicant submits the following revised identification and recitation of goods and services:

Class 9: Downloadable *Recorded* computer software for use in enterprise data collection, transmission, visualization, integration, analysis, management, and storage using machine learning and artificial intelligence, *none of the foregoing for use in connection with energy production*

Class 42: Software as a service (SaaS) services featuring software for use in enterprise data collection, transmission, visualization, integration, analysis, management, and storage using machine learning and artificial intelligence, *none of the foregoing for use in connection with energy production*

Applicant respectfully requests that the amendments be accepted.

B. Filing Basis

Applicant has amended its application to clarify that Applicant’s Mark was filed on the basis of use of the mark in commerce under Trademark Act Section 1(a) in Class 9, and on an intent-to-use basis under Trademark Act Section 1(b) in Class 42.

Concurrently herewith, Applicant submits a specimen of use for Class 9 and a declaration in support of the bases for these filings.

C. Amendment to Mark Description

Applicant accepts the amendments to the mark description suggested by the Examiner, as follows:

The mark consists of a highly stylized version of the term GEMINI in which the letter G is represented by a circle with **an unshaded horizontal bar intersecting the letter G and extending through the letter E**, which is represented as a thick rectangle. The letter M is represented as two triangles **connected at the bottom**. Each letter I is represented by a slender rectangle. **The letter N is shown as two triangles separated by a diagonal space. The point of one triangle faces up and the point of the other triangle faces down.**

Applicant respectfully requests that these amendments be accepted.

II. LIKELIHOOD OF CONFUSION REFUSAL

The Examiner has expressed concern regarding a potential conflict under Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d), between Applicant’s Mark and the following pending, allowed, intent-to-use third party applications (the “Cited Marks”):

| Mark | Serial No. | Owner | Goods/Services |
|-------------------------------------|------------|-----------------|---|
| GeminiXD (“Cited Mark 1”) | 87778488 | McDermott, Inc. | Class 9: Software for monitoring, tracking, analyzing, and integrating aspects of production facilities, including offshore platforms, and vessels; Software for tracking equipment location, maintenance history, inspection records, and parts inventory; Software for |

| | | | |
|--|----------|-----------------|--|
| | | | <p>identifying preventative maintenance schedules; Software for generating or interacting with two-dimensional, three-dimensional, and virtual reality models of a production facility</p> <p>Class 42: Software as a service (SAAS) featuring software for use by others for monitoring, tracking, analyzing, and integrating aspects of production facilities, including offshore platforms, and vessels; Software as a service (SAAS) featuring software for use by others for tracking production facility or vessel equipment location, maintenance history, inspection records, and parts inventory; Software as a service (SAAS) featuring software for use by others for identifying preventative maintenance schedules; Software as a service (SAAS) featuring software for use by others for generating or interacting with two-dimensional, three-dimensional, and virtual reality models of a production facility or vessel</p> |
| <p>Gemini^{XD} ("Cited Mark 2")</p> | 87781672 | McDermott, Inc. | <p>Class 9: Software for monitoring, tracking, analyzing, and integrating aspects of production facilities, including offshore platforms, and vessels; Software for tracking equipment location, maintenance history, inspection records, and parts inventory; Software for identifying preventative maintenance schedules; Software for generating or interacting with two-dimensional, three-dimensional, and virtual reality models of a production facility</p> <p>Class 42: Software as a service (SAAS) featuring software for use by others for monitoring, tracking, analyzing, and integrating aspects of production facilities, including offshore platforms, and vessels; Software as a service (SAAS) featuring software for use by others for tracking production facility or vessel equipment location, maintenance history, inspection records, and parts inventory; Software as a service (SAAS) featuring software for use by others for identifying preventative maintenance schedules; Software as a service (SAAS) featuring software for use by others for generating or interacting with two-dimensional, three-dimensional, and virtual reality models of a production facility or vessel</p> |

For the reasons discussed below, Applicant respectfully submits that Applicant’s Mark is unlikely to be confused with the Cited Marks.

A. Background

The Cited Marks are owned by McDermott, Inc. (“McDermott”), a provider of “solutions to the energy industry,” and in particular “oil and gas.” See Declaration of Rose Kautz (“Kautz Decl.”) Ex. A. More specifically, the software and services covered by the Cited Marks are used to analyze and integrate “aspects of production facilities, including offshore platforms, and

vessels,” “equipment location, maintenance history, inspection records, and parts inventory,” and “two-dimensional, three-dimensional, and virtual reality models of a production facility.” See Kautz Decl. Exs. B-C. As described on the McDermott website, the Cited Marks are used in connection with a software platform that creates “digital twins” of physical oil and gas platforms, namely real-time virtual 3D replicas that are exact digital renderings of a physical project. The Cited Marks are a reference to the “twin constellation” Gemini, and the software is used by corporations such as BP for offshore development. The purpose and function of the software is to improve project delivery efficiency by making “traditionally manual processes”—using engineering diagrams and spreadsheets—“fully digital.” See Kautz Decl. Exs. D-G.

Applicant, on the other hand, has amended its identification of goods and services to clarify that Applicant’s software and services are not focused on or targeted at energy production. Rather, Applicant’s Mark is used in connection with Applicant’s big data analytics software and services, designed to make complex data more meaningful. Applicant’s products are designed to improve data comprehension and reduce the complexity of data in the cloud or on premises. In particular, Applicant provides a situational awareness platform that automates data management using machine learning and artificial intelligence to connect facts and relationships, enabling businesses to develop insights and solve problems more effectively. See Kautz Decl. Exs. H-I.

B. Likelihood of Confusion Factors

It is well-established that likelihood of confusion between marks is “related not to the *nature* of the mark but to its *effect* ‘when applied to the goods of the applicant.’ The only *relevant* application is made in the marketplace. The words ‘when applied’ do not refer to a mental exercise, but to all of the known circumstances surrounding use of the mark.” *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1360-61 (C.C.P.A. 1973) (original emphasis); see also *Electronic Data Sys. Corp. v. EDSA Micro Corp.*, 23 U.S.P.Q. 2d 1460, 1464 (TTAB 1992) (“Section 2(d) of the Trademark Act is concerned about the likelihood of confusion, not some theoretical possibility built on a series of imagined horrors.”).

In determining whether there is a likelihood of confusion, courts assess many factors, including, as particularly relevant here:

1. The strength of the mark, as evidenced by the number and nature of similar marks in use on similar goods and services;
2. The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression;
3. The relatedness of the goods or services; and
4. The conditions under which and buyers to whom sales are made, i.e., “impulse” vs. careful, sophisticated purchasing.

E.I. du Pont de Nemours, 476 F.2d at 1361.

Application of these factors, as set forth below, leads inevitably to the conclusion that confusion is not likely between Applicant’s Mark and the Cited Marks.

III. ARGUMENT

A. Confusion Is Unlikely Because The Cited Marks Are Weak And Are Already Coexisting With Other Similar Marks

Both the Cited Marks and Applicant's Mark share use of the term GEMINI, but so do many other marks—including another word mark for GEMINI in the same industry as the Cited Marks, which was allowed by the USPTO without a citation to the Cited Marks. The weak and diluted nature of the Cited Marks thus weighs against a likelihood of confusion.

During the examination of an application, “[i]f the examining attorney finds registrations that appear to be owned by more than one registrant, he or she should consider the extent to which dilution may indicate that there is no likelihood of confusion.” T.M.E.P. § 1207.01(d)(x). More specifically, when comparing marks that otherwise might be confusingly similar, evidence that the matter common to the marks is diluted may obviate a likelihood of confusion. *See* T.M.E.P. § 1207.01(b)(iii).


The likelihood of consumer confusion is reduced because, where the shared portion of two similar marks is widely used, consumers are more likely to look to other elements of the mark to distinguish the source of the goods. *See In re E.I. DuPont De Nemours & Co.*, 476 F.2d at 1361; *In re Broadway Chicken, Inc.*, 38 U.S.P.Q.2d 1559, 1565-66 (TTAB 1996) (evidence showed that third-party use of the term BROADWAY was so common that consumers would look to the other elements of applicant's mark BROADWAY CHICKEN and thereby would distinguish the source of the goods from BROADWAY PIZZA and BROADWAY BAR & PIZZA). In other words, “in a ‘crowded’ field of similar, look-alike marks, each member of the crowd is relatively ‘weak’ in its ability to prevent use by others in the crowd.” J. Thomas McCarthy, 2 McCarthy on Trademarks and Unfair Competition § 11:85 (4th ed.) “Simply put, ‘a mark which is hemmed in on all sides by similar marks on similar goods . . . is merely one of a crowd of marks . . . [and] customers will not likely be confused between any two of the crowd and may have learned to carefully pick out one from the other.’” *Miss World (UK) Ltd. v. Mrs. Am. Pageants, Inc.*, 856 F.2d 1445, 1449 (9th Cir. 1988) (citing McCarthy § 11:85).

If the evidence establishes that the consuming public is exposed to third-party use of similar marks on similar goods, it is also “relevant to show that a mark is relatively weak and entitled to only a narrow scope of protection.” T.M.E.P. §12.07(d)(iii) (quoting *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772*, 396 F.3d 1369, 1373-74 (Fed. Cir. 2005)).

Here, the Federal Trademark Register and the marketplace are replete with uses of GEMINI in connection with software and technology products and services. The following examples are just a small sample of the widespread third party allowed filings for, registrations for and uses of the term GEMINI:

- GEMINI—U.S. Serial No. 87831085 for, among other things, “Custom design and engineering of chemical and **gas processing plants and fuel and oil refineries**; engineering design services; consulting in the field of engineering; engineering services in the field of **chemical and gas processing and fuel and oil refining**” in Class 42

(emphasis added), an allowed intent-to-use application owned by Siluria Technologies, Inc., *see* Kautz Decl. Ex. J;

-  **GEMINI**—U.S. Reg. No. 5892193 for “Downloadable mobile application which enables users to exchange crypto-currency for currency and vice versa; automatic teller machines for exchanging crypto-currency for currency and currency for crypto-currency and for interfacing with one or more exchanges for trading crypto-currency for currency and currency for crypto-currency” in Class 9, owned by Gemini IP, LLC, *see* Kautz Decl. Ex. K;
- **GEMINI GEMS**—U.S. Serial No. 88210731 for “Computer game software for gaming machines and gaming devices, namely, slot machines and machines which accept a wager” in Class 9, an allowed intent-to-use application owned by Incredible Technologies, Inc., *see* Kautz Decl. Ex. L;
- **GEMINI**—U.S. Reg. No. 5582000 for “Digital image sensors for cinema cameras; charge coupled device (CCD) and complementary metal oxide semiconductors (CMOS) image sensors for cinema cameras” in Class 9, owned by Red.com, LLC, *see* Kautz Decl. Ex. M;
- **GEMINI-DOT**—U.S. Reg. No. 5553510 for “Computer software for interpretation of brain scans provided by diagnostic imaging equipment; computer software for mapping the intersection of gene expression and neurological imaging” in Class 9, owned by BlackThorn Therapeutics, Inc., *see* Kautz Decl. Ex. N;
- **GEMINI**—U.S. Reg. No. 4762398 for “Vacuum measuring apparatus, particularly using cold cathode principle” in Class 9, owned by Inficon GmbH, *see* Kautz Decl. Ex. O;
- **GEMINI**—U.S. Reg. No. 4206336 for, among other things, “Security inspection apparatus for detecting or characterizing materials or persons through the use of x-ray technology, not used for medical purposes” in Class 9 and “Technical support services, namely, troubleshooting in the nature of diagnosing problems in security inspection apparatus for detecting or characterizing materials and persons through the use of x-ray technology; providing technical consulting services regarding the functionality and technology of inspection apparatus for detecting or characterizing materials and persons through the use of x-ray technology” in Class 42, owned by Rapiscan Holdings, Inc., *see* Kautz Decl. Ex. P;
- **GEMINI**—U.S. Reg. No. 1410190 for “remote control door locking systems consisting of door locks and electrical and pneumatic actuators therefor; electrical and pneumatic actuators for remotely locking and unlocking door locks” in Class 9, owned by Architectural Control Systems, Incorporated, *see* Kautz Decl. Ex. Q.

As the above examples demonstrate, the number and nature of similar GEMINI-formative marks in use on similar goods militates against any likelihood of confusion and the matter common to the marks is diluted.



First, the wide use of the term GEMINI indicates that the Cited Marks are weak and are entitled only to a narrow scope of protection. *See Pizzeria Uno Corp. v. Temple*, 747 F.2d 1522, 1530 (4th Cir. 1984) (strength depends on “the frequency of prior use of the word in other marks, particularly in the same field of merchandise or services”). If all of the marks listed above can coexist without confusion, there is no reason why Applicant’s Mark should not also be registered. In fact, the Cited Marks are at least as similar to the third party uses listed above—and in the case of U.S. App. No. 87831085, more similar, since both marks are used in connection with energy production—than to Applicant’s Mark.

Second, in light of the popularity of the term GEMINI, consumers are more likely to look to other elements of GEMINI-formative marks to determine the source of goods and services offered under the name GEMINI. The Cited Marks are not identical to Applicants Mark, but rather differ in appearance, sound, and commercial impression, as discussed further below. Under these circumstances, these differences, including the unique and highly distinctive stylization of Applicant’s Mark, are sufficient to distinguish Applicant’s Mark from the Cited Marks and to obviate any likelihood of confusion.

B. Confusion Is Unlikely Because The Cited Marks Are Dissimilar In Sight, Sound, and Commercial Impression From Applicant’s Unique, Highly Stylized Mark

There is also no likelihood of confusion because Applicant’s Mark is different in sight, sound, and commercial impression from the Cited Marks. For example, Applicant’s Mark uses unique and highly distinctive design elements, whereas the Cited Marks contain the additional suffix –XD and have a different connotation than Applicant’s Mark.

In short, Applicant’s Mark is not identical in sight, sound, or meaning to the Cited Marks, as shown below:

| Cited Marks | Applicant’s Mark |
|---|--|
|  |  |

When comparing the marks, “[a]ll relevant facts pertaining to appearance, sound, and connotation must be considered before similarity as to one or more of those factors may be sufficient to support a finding that the marks are similar or dissimilar.” T.M.E.P. § 1207.01(b) (quoting *Recot, Inc. v. M.C. Becton*, 214 F.3d 1322, 1329, 54 USPQ2d 1894, 1899 (Fed. Cir. 2000)). Similarity of the marks in one respect—sight, sound, or meaning—will not automatically

result in a determination that confusion; rather, the examining attorney must take into account all of the relevant facts of a particular case. T.M.E.P. § 1207.01(b)(i); *see also In re Thor Tech, Inc.*, 90 USPQ2d 1634, 1635 (TTAB 2009); *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988).

Taking into account all relevant facts pertaining to the appearance, sound, and connotation of Applicant's Mark and the Cited Marks, combined with the widespread use of the term GEMINI by multiple third parties and the resulting relatively narrow scope of the Cited Marks, the differences in these marks are sufficient to render consumer confusion unlikely.

1. *Applicant's Mark Includes Unique Design Elements That Visually Distinguish It From The Cited Marks*

Applicant's Mark is immediately distinguished from the Cited Marks by its unique design.

Where marks consist of both words and designs, "[t]here is no general rule as to whether letters or designs will dominate in composite marks; nor is the dominance of letters or design dispositive of the issue." *In re Electrolyte Labs. Inc.*, 929 F.2d 645, 647, 16 USPQ2d 1239, 1240 (Fed. Cir. 1990). "The comparison of composite marks must be done on a case-by-case basis, without reliance on mechanical rules of construction." T.M.E.P. §1207.01(c)(ii). One must review the respective marks in their entireties and consider each mark's "cumulative effect." *Federated Foods, Inc. v. Fort Howard Paper Co.*, 192 USPQ 24, 29 (C.C.P.A. 1976). "It is axiomatic that a mark should not be dissected and considered piecemeal; rather, it must be considered as a whole in determining likelihood of confusion." *Franklin Mint Corp. v. Master Mfg. Co.*, 667 F.2d 1005, 1007 (C.C.P.A. 1981). Moreover, when comparing a design mark with a standard character mark, the Examiner must consider "variations of the depictions of the standard character mark *only with regard to* font style, size, or color of the words." *In re Aquitaine Wine USA, LLC*, 126 USPQ2d 1181, 1187 (TTAB 2018).

Even if marks are composed of the same words or letters, they may be distinguished by the use of different font sizes or dissimilar modes of presentation. *See Globalaw Ltd. v. Carmon & Carmon Law Office*, 452 F. Supp. 2d 1, 49 (D.D.C. 2006) (finding no likelihood of confusion between "GLOBALAW, Inc." and "GLOBALAW Limited"). Design marks are not likely to cause consumer confusion when "there are significant differences in the visual depiction of the respective marks . . . notwithstanding that they are comprised of the same letters in the same order." *IDVN. Am., Inc. v. S & M Brands, Inc.*, 26 F. Supp. 2d 815, 825-26 (E.D. Va. 1998) (no likelihood of confusion between BAILEYS for liqueurs and BAILEYS for cigarettes, based in part on their different "colors, fonts, [and] capitalization").

In *Playmakers LLC v. ESPN, Inc.*, for example, the Ninth Circuit affirmed a finding of no likelihood of confusion between two PLAYMAKERS marks based in part on a finding that, "[a]lthough the two marks share the same sound and meaning, they are visually distinguishable . . . [based on] their noticeable differences in font, typesetting, color, and use of stars." 376 F.3d 894, 898 (9th Cir. 2004). The marks at issue in *Playmakers* are pictured below:

| Plaintiff's Mark | Defendant's Mark |
|---|--|
|  |  |

Similar findings have been made by courts in other circuits. *See e.g., Progressive Distribution Servs., Inc. v. United Parcel Serv., Inc.*, 856 F.3d 416, 433 (6th Cir. 2017) (affirming a finding of no likelihood of confusion between two ORDERLINK marks where marks were “displayed in different colors and fonts and depicted with distinct design elements”); *King of the Mountain Sports, Inc. v. Chrysler Corp.*, 185 F.3d 1084, 1091 (10th Cir. 1999) (no likelihood of confusion between two marks containing KING OF THE MOUNTAIN where “the visual impact of the plaintiff’s mark and defendants’ logo differs dramatically,” base on considerations such as font size, lettering, use of different colors, inclusion of different images and design elements along with lettering, and capitalization).

Finally, even small differences can sufficiently impactful to distinguish marks, when considered in combination with other factors. *See, e.g., Steiger Tractor, Inc. v. Steiner Corporation*, 221 U.S.P.Q. 165 (TTAB 1984) (noting that a “one letter difference cannot be entirely ignored” and finding no likelihood of confusion between STEIGER and STEINER based on “the cumulative differences between the marks at issue and between the goods . . . coupled with the sophistication and care exercised by purchasers”); *In re REACH ELECTRONICS, INC.*, 175 U.S.P.Q. 734 (TTAB 1972) (finding no likelihood of confusion between REACH and REAC based on differences in marks and fact that “the goods of the parties are directed to different segments of the electronics field”).

Here, Applicant’s Mark uses design elements that immediately distinguish it from the Cited Marks, including the use of geometric shapes and negative space in lieu of certain letters. Although Cited Mark 1, as a standard character mark, can be used in any font style, size, or color, it would still be immediately distinguishable from Applicant’s Mark because it lacks these geometric shapes, including the unshaded horizontal bar intersecting the letter G and extending through the letter E, the thick rectangle replacing the letter E, the two triangles connected at the bottom representing the letter M, or the two triangles separated by a diagonal space representing the letter N. Nor does Applicant’s Mark use superscript, as in Cited Mark 2.

This design renders Applicant’s Mark sufficiently different in appearance from the Cited Marks that consumer confusion is unlikely.

2. The Textual Elements of Applicant’s Mark Also Differ In Sound and Appearance From The Cited Marks

Consumer confusion is also unlikely because, although Applicant’s Mark and the Cited Marks share a common term, when viewed in their entireties, the textual elements of Applicant’s Mark and the Cited Marks are distinct in sound, appearance, and overall commercial impression.

Even marks that share a term or terms can be found not confusing based on differences in their overall commercial impression, sound, and appearance. *See In re Electrolyte Labs., Inc.*, 929

F.2d at 647 (K+ and design for dietary potassium supplement held not likely to be confused with K+EFF (stylized) for dietary potassium supplement); *Planet Hollywood, Inc. v. Hollywood Casino Corporation*, 80 F. Supp. 2d 815, 880 (E.D. Ill. 1999) (finding that identical word appearing in a different type style and dominance not confusing).

When marks subject to a likelihood of confusion analysis share only a single term, the marks are often judged to be not likely to be confused because the marks look and sound different overall. *See e.g., Lever Brothers Co. v. The Barcolene Co.*, 463 F.2d 1107, 1109 (C.C.P.A. 1972) (finding “obvious differences” between the marks ALL CLEAR! and ALL, both used on household cleaning products); *Colgate-Palmolive Co.*, 432 F.2d at 1402 (finding that “[t]he difference in appearance and sound of the marks [PEAK and PEAK PERIOD] is too obvious to render detailed discussion necessary. In their entirety, they neither look nor sound alike.”); *In re Hearst Corp.*, 982 F.2d 493 (Fed. Cir. 1992) (finding no likelihood of confusion between use of VARGAS and VARGA GIRL on calendars); *In re Electrolyte Labs., Inc.*, 929 F.2d at 647 (K+ and design for dietary potassium supplement held not likely to be confused with K+EFF (stylized) for dietary potassium supplement). Sound, in particular, is a vital factor in the likelihood of confusion analysis. *Celanese Corp. v. DuPont de Nemours & Co.*, 154 F.2d 143, 145 (C.C.P.A. 1946); *Colgate-Palmolive Co. v. Carter-Wallace, Inc.*, 432 F.2d 1400, 1402 (C.C.P.A. 1970).

In all of the cases cited above, the marks at issue shared terms at the beginning or end of the marks (ALL and ALL CLEAR!, PEAK and PEAK PERIOD, VARGAS and VARGA GIRL, and K+ and design and K+EFF), but were nevertheless found unlikely to cause consumer confusion due to do the differences in sound, appearance, and commercial impression of the marks as a whole.

Although Applicant’s Mark and the Cited Marks share a term at the beginning, the marks are unlikely to be confused when their sound, appearance, and commercial impressions are considered in their entirety. In particular, the Cited Marks end in –XD, while Applicant’s Mark does not. The Cited Marks are thus distinguished from Applicant’s Mark in both sound and appearance, because they consist of two words, five syllables, and eight letters, and end with the consonant “D.” By contrast, Applicant’s Mark consists of one word, three syllables, six letters, and ends with the vowel “I.” These differences meaningfully distinguish Applicant’s Mark in sound and appearance from the Cited Marks and render consumer confusion unlikely.

3. *Applicant’s Mark And The Cited Marks Create Different Commercial Impressions*

Applicant’s Mark and the Cited Marks also create different commercial impressions, which further supports a finding that consumer confusion is unlikely.

Even marks that are identical in sound and/or appearance may create sufficiently different commercial impressions when applied to the respective parties’ goods or services so that there is no likelihood of confusion. *See, e.g., In re Sears, Roebuck & Co.*, 2 USPQ 2d 1312, 1314 (TTAB 1987) (holding CROSS-OVER for bras and CROSSOVER for ladies’ sportswear not likely to cause confusion, noting that the term “CROSS-OVER” was suggestive of the construction of applicant’s bras, whereas “CROSSOVER,” as applied to registrant’s goods, was “likely to be perceived by purchasers either as an entirely arbitrary designation, or as being suggestive of

sportswear which “crosses over” the line between informal and more formal wear . . . or the line between two seasons”).

Here, the Cited Marks are used in connection with “digital twins” of physical oil and gas platforms, and a wordplay and reference to the “twin constellation” in astronomy, Gemini. *See* Kautz Decl. Exs. D-G. Applicant’s goods and services, on the other hand, have no connection to twins. Thus, Applicant’s Mark is likely to be perceived by purchasers as an entirely arbitrary designation. *See* Kautz Decl. Exs. H-I. These differences distinguish the commercial impression of Applicant’s Mark from that of the Cited Marks.

Particularly when taken into consideration along with the other factors discussed in this response, Applicant’s Mark is sufficiently distinct from the Cited Marks to obviate any likelihood of confusion.

C. Confusion Is Unlikely Because The Products Covered By The Cited Marks Are Distinct From The Software And Services Covered By Applicant’s Mark

There is also no likelihood of confusion because the products covered by the Cited Marks are not meaningfully similar to or overlapping with the products and services by Applicant’s Mark, particularly as amended.

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, then, even if the marks are identical, confusion is not likely. T.M.E.P. § 1207.01(a)(i). *See, e.g., Shen Mfg. Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 1244-45 (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); *Local Trademarks, Inc. v. Handy Boys Inc.*, 16 USPQ 2d 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); *cf. Quartz Radiation Corp. v. Comm/Scope Co.*, 1 USPQ 2d 1668, 1669 (TTAB 1986) (holding QR for coaxial cable and QR for various apparatus used in connection with photocopying, drafting, and blueprint machines not likely to cause confusion because of the differences between the parties’ respective goods in terms of their nature and purpose, how they are promoted, and who they are purchased by); *In re Thor Tech, Inc.*, 113 USPQ 2d 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).

Both the Trademark Trial and Appeal Board (“TTAB”) and the Federal Circuit have repeatedly stated that confusion is not likely just because products fall within the same general field, particularly when it comes to computer-related goods and services such as software programs. *See, e.g., Elec. Design & Sales, Inc. v. Elec. Data Sys. Corp.*, 954 F.2d 713, 717 (Fed. Cir. 1992) (no likelihood of confusion between stylized E.D.S. mark for batteries and power supplies and EDS for computer services, both in the broad category of the medical field, noting that, “although the two parties conduct business not only in the same fields but also with some of

the same companies, the mere purchase of the goods and services of both parties by the same institution does not, by itself, establish similarity of trade channels or overlap of customers”); *PerkinElmer Health Science., Inc. v. Atlas Database Software Corp.*, 2011 TTAB LEXIS 405, at *39 (TTAB Dec. 22, 2011) (“The mere fact that the parties’ goods fall under the broad category of software for use in laboratories is not a sufficient basis upon which to find that they are related for purposes of likelihood of confusion.”); *Electronic Data Sys. Corp.*, 23 USPQ 2d at 1460 (no likelihood of confusion between EDS for computer data processing programming/information management services and EDSA for computer programs for electrical distribution system analysis and design, despite the similarity of the parties’ marks and the conceded fame of the opposer’s mark, rejecting argument that they were related simply because “they both involve computer programs”); *Information Resources v. X*Press Info. Servs.*, 6 USPQ 2d 1034 (TTAB 1988) (no likelihood of confusion between X*PRESS for a news service transmitted through cable television to a personal computer and EXPRESS for information analysis computer programs, noting “there is no ‘per se’ rule mandating that likelihood of confusion is to be found in all cases where the goods or services in question involve computer software and/or hardware”); *In re Quadram Corp.*, 228 USPQ 863 (TTAB 1985) (no likelihood of confusion between FASER for energy conservation software and MICROFAZER for hardware buffers, noting that, while both applicant and registrant “are in the broad field of computers, they are in completely different aspects of this field”).

In fact, the Board has repeatedly held, including in a precedential decision, that differences in function or purpose can prevent a likelihood of confusion. *See Aries Sys. Corp. v. World Book, Inc.*, 26 USPQ 2d 1926, 1932 (TTAB 1993) (finding KNOWLEDGE FINDER and INFORMATION FINDER not confusingly similar because, inter alia, “[s]uch products, rather than being... simply computer programs utilized for facilitating research of medical and related scientific topics, are designed to search databases of vastly different levels of content for, concomitantly, significantly different purposes.”); *Embarcadero Techs., Inc. v. RStudio, Inc.*, 105 USPQ 2d 1825, 1840 (TTAB 2013) (precedential) (finding no confusion between RSTUDIO and ER/STUDIO where “the respective software products possess very different functions and purposes”); *PerkinElmer Health Science., Inc.*, 2011 TTAB LEXIS 405 at *39 (finding no likelihood of confusion where “[t]he goods perform different functions and are used for different purposes.”); *Shen Mfg. Co.*, 393 F.3d at 1244-45 (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).

Not only does TTAB and Federal Circuit precedent require this result, but this result is also consistent with the findings of other federal courts. *See Echo Drain v. Newsted*, 307 F. Supp. 2d 1116, 1125 (C.D. Cal. 2003) (quoting *Harlem Wizards Entertainment Basketball, Inc. v. NBA Properties, Inc.*, 952 F.Supp. 1084, 1095 (D.N.J.1997)) (finding no likelihood of confusion between ECHO DRAIN and ECHOBRAIN even though they were both music bands, where bands played different types of music); *see also Matrix Motor Co. v. Toyota Jidosha Kabushiki Kaisha*, 290 F. Supp. 2d 1083, 1092 (C.D. Cal. 2003) (confusion between MATRIX for race cars and passenger cars unlikely, even if products were “superficially within the same category”); *see also The Learning Internet v. Learn.com, Inc.*, No. CV 07-227-AC, 2009 WL 6059550, at *21 (D. Or. Nov. 25, 2009), *report and recommendation adopted*, No. CV 07-227-AC, 2010 WL 1141351 (D. Or. Mar. 18, 2010) (granting summary judgment and finding no likelihood of confusion even though “the products are arguably related under LCI’s broad characterization of educational

materials delivered over the Internet,” where “both the functionality and the customers of the respective products are distinct”).

Moreover, the inquiry into the similarity of goods and services is “ultimately one of common sense and common experience.” *ITT Corporation v. XTRA Corporation, et al.*, 225 USPQ 723 (D. Mass. 1985) (citing *Dwinell-Wright Co. v. National Fruit Product Co.*, 60 USPQ 304 (1st Cir. 1944)). “[I]f 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, then, *even if the marks are identical, confusion is not likely.*” T.M.E.P. § 1207.01(a)(i) (emphasis added). The actual use of the Applicant’s Mark by the Applicant, on the one hand, and the actual use of the Cited Marks by its applicant, on the other hand, is evidence which can and should be considered by the Examiner. *In re Trackmobile, Inc.*, 15 U.S.P.Q. 2d 1152, 1154 *2 (TTAB 1990) (“[W]hen the description of goods for a cited registration is somewhat unclear, as is the case herein, it is improper to simply consider that description in a vacuum”). Without looking to extrinsic evidence to understand the manner in which products are provided under Applicant’s Mark and the Cited Marks, the Examiner would be improperly relying “upon abstract reasoning” in an effort to give vague and broad terms a definite meaning. *Id.* at *3.

Here, Applicant’s data analysis software and services using machine learning and artificial intelligence have nothing to do with the software for energy production facilities, offshore platforms, and vessels covered by the Cited Marks. Indeed, Applicant has amended its identification of goods and services to further clarify that none of its offerings are for in use in connection with energy production.

As shown in the chart below, the only remaining similarities between the goods and services offered under the Cited Marks and those offered under Applicant’s Mark as amended are that both involve “software” or “software as a service” for analyzing and/or integrating something. Nearly any software could be described as having such a function, and such a superficial similarity is insufficient to support a finding that the goods and services are related:

| Cited Marks Goods/Services | Applicant’s Mark Goods/Services |
|--|--|
| <p>Class 9: Software for monitoring, tracking, analyzing, and integrating aspects of production facilities, including offshore platforms, and vessels; Software for tracking equipment location, maintenance history, inspection records, and parts inventory; Software for identifying preventative maintenance schedules; Software for generating or interacting with two-dimensional, three-dimensional, and virtual reality models of a production facility</p> | <p>Class 9: Downloadable computer software for use in enterprise data collection, transmission, visualization, integration, analysis, management, and storage using machine learning and artificial intelligence</p> |
| <p>Class 42: Software as a service (SAAS) featuring software for use by others for monitoring, tracking, analyzing, and integrating aspects of production facilities, including offshore platforms, and vessels; Software as a service (SAAS) featuring software for use by others for tracking production facility or vessel equipment location, maintenance history, inspection records, and parts inventory; Software as a service</p> | <p>Class 42: Software as a service (SaaS) services featuring software for use in enterprise data collection, transmission, visualization, integration, analysis, management, and storage using machine learning and artificial intelligence</p> |

| | |
|--|--|
| <p>(SAAS) featuring software for use by others for identifying preventative maintenance schedules; Software as a service (SAAS) featuring software for use by others for generating or interacting with two-dimensional, three-dimensional, and virtual reality models of a production facility or vessel</p> | |
|--|--|

Common sense and common experience dictate that these goods and services—particularly as amended and clarified by Applicant—serve a different function, have a different purpose, and address an entirely different need than the software and services offered under the Cited Marks.

Specifically, the Cited Marks analyze and integrate “aspects of production facilities, including offshore platforms, and vessels,” “equipment location, maintenance history, inspection records, and parts inventory,” and “two-dimensional, three-dimensional, and virtual reality models of a production facility.” The function and purpose of these offerings is to increase efficiency of production facilities in the oil and gas industry. *See* Kautz Decl. Exs. D-G.

Applicant’s goods and services, on the other hand, access and connect data across disparate data silos, using artificial intelligence and machine learning to identify patterns and draw meaning and discern more useful information from data scattered across multiple sources. *See* Kautz Decl. Exs. H-I. The purpose of Applicant’s software is not related to equipment, maintenance, oil production facilities, or real-time virtual modeling of a 3D environment, but rather to holistically analyze information and uncover actionable insights that businesses can use to gain a competitive advantage. *See id.*

Accordingly, these goods and services 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 Applicant’s goods and services originate from the same source as the goods covered by the Cited Marks. Because there is no overlap between the goods and services offered under Applicant’s Mark and the Cited Marks, this factor also supports a finding that consumer confusion is unlikely.

D. Consumer Confusion is Unlikely Because Of The Conditions Under Which And Buyers To Whom Sales Are Made

Finally, likelihood of confusion is determined from the perspective of the consumer. Thus the classes of consumers to whom the goods are sold, the channels of trade through which the goods are sold, and the conditions under which the goods are purchased are all relevant when determining whether confusion is likely. T.M.E.P. §1207.01.

The likelihood of confusion is reduced where potential purchasers of the products are distinct groups. *See Electronic Design & Sales v. E.D.S.*, 954 F.2d 713, 718 (Fed. Cir. 1992). Where goods and services are sold through different channels of trade to different classes of consumers, such services and goods are so different that confusion is not likely. *See Local Trademarks, Inc. v. Handy Boys, Inc.*, 16 U.S.P.Q.2d 1156 (TTAB 1990); *see also Coach Services Inc. v. Triumph Learning LLC*, 101 USPQ2d 1713 (Fed. Cir. 2012) (no likelihood of consumer confusion between COACH for educational materials and COACH for luxury products, where goods were targeted to different purchasers and sold via different trade channels); *M2 Software*

Inc. v. M2 Communications Inc., 78 USPQ2d 1944 (Fed. Cir. 2006) (no likelihood of confusion between M2 and M2 COMMUNICATIONS where there was “no demonstrated overlap of purchasers or channels of trade”).

The conditions under which the products are sold can also minimize the likelihood of confusion. When products are sold to sophisticated consumers who make careful purchasing decisions, for example, consumer confusion is unlikely. *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); *In re Homeland Vinyl Prods., Inc.*, 81 USPQ2d 1378, 1380, 1383 (TTAB 2006). Purchasers with a “reasonably focused need” or “specific purpose” or plan involving the product will have a higher degree of care. *See Haydon Switch & Instrument, Inc. v. Rexnord, Inc.*, 4 USPQ2d 1510, 1517 (D. Conn. 1987).

In *Haydon Switch*, for example, the court noted that that the parties’ customers “enter[ed] the marketplace in search of specific products for specific industrial purposes” and concluded that the likelihood of confusion was “remote.” *Id.* Similarly, purchasers of expensive goods are less likely to buy casually, and more likely to purchase only after careful consideration. *Weiss Assoc., Inc. v. HRL Assoc., Inc.*, 902 F.2d 1546, 14 USPQ2d 1840 (Fed. Cir. 1990); *see, e.g., McGregor-Doniger, Inc. v. Drizzle, Inc.*, 599 F.2d 1126, 1137, 202 USPQ 81, 92 (2d Cir. 1979) (holding purchasers of women’s coats priced from \$100-\$900 “to be sophisticated and knowledgeable about women’s apparel”). “[T]here is always less likelihood of confusion where goods are expensive and purchased after careful consideration.” *Electronic Design & Sales Inc. v. Electronic Data Systems Corp.*, 954 F.2d. 713, 718 (Fed. Cir. 1992) (citation omitted).

As discussed above, the goods and services covered by the Cited Marks are all related to a “digital twin” system for oil and gas production facilities. These goods and services are marketed to a different class of consumers through different channels of trade than the goods covered by Applicant’s Mark, rendering consumer confusion unlikely. Like the consumers in *Haydon Switch*, consumers of the goods and services offered under the Cited Marks are highly sophisticated business entities such as BP, who enter the market with a specific industrial purposes, and who only make purchases after careful consideration.

Applicant also offers its goods and services to businesses, but has amended its identification of goods and services to clarify that its application does not extend to use of its software and services in connection with energy production. Thus, the channels of trade do not overlap to such a degree that consumer confusion is likely. It is highly unlikely that the Cited Marks and Applicant’s Mark would ever be simultaneously encountered by consumers, nor would the products be sold in close proximity.

These conditions of purchase all further indicate that consumer confusion is unlikely.

E. Summary of the Factors

Applicant respectfully submits that the factors set forth above, namely the weak and diluted nature of the Cited Marks, the differences in sound, appearance, and commercial impression of the

marks at issue, the differences in covered goods and services, and the conditions of purchase all compel the conclusion that Applicant's Mark is not likely to be confused with the Cited Marks.

Conclusion

With the foregoing response, Applicant respectfully believes that it has fully addressed each of the issues raised in the Office Action, and that the Application is in condition for prompt publication.