

FEEL BY WACOM (Stylized) - Response to 5/6/20 Office Action

In the May 6, 2020 office action, the Examiner cited Reg. No. 5321061 for FEEL and Design by Sentio Solutions, Inc. for "Wearable sensor chips for monitoring bio-signals; Wearable computer peripherals; wristbands specially adapted to monitor bio-signals and communicate wirelessly with a computer; Computer software adapted to send and receive signals from a wearable monitor; electronic monitors for monitoring bio-signals; electronic devices for tracking emotion; portable wrist-mounted electronic device for monitoring biosignals; wristband utilizing integrated sensors to measure bio-signals; a mobile application to provide recommendations and coaching to improve emotional well-being."

Applicant has now amended the covered goods in the subject application to "features of computers, namely, software, electronic pens, sensor boards, and controller ICs marketed as integral components of tablet computers, notebook computers, and laptop computers; digital notepads."

1. The marks are used for different types of goods that are sold to different consumers under different conditions

With this amendment, the covered goods (other than digital notepads) are all items that are sold as component parts of other devices, namely, tablet computers, notebook computers, and laptop computers. Such component parts are different in nature from wearable devices for transmitting biosignals and the software associated therewith, which are essentially what the goods in the cited registration are. And the goods in the cited registration are marketed to regular consumers, not to companies that make tablet, notebook, and laptop computers, as applicant's goods are. (In addition, digital notepads are a different type of device from those covered in the cited

registration and would not normally be used with those covered goods, which are for use in monitoring the wearer's body when the wearer is moving from place to place, unlike digital notepads.)

Furthermore, marks used for component parts are displayed in two contexts. The first context is where the seller of the components markets those components to the manufacturer of the devices they will be included in. Such manufacturers are distinct from regular consumers. And they are sophisticated personnel who are making careful decisions in order to produce the best products. Such decisions involve major expenditures. These people will simply not be confused.

The second context in which marks for such components are used is that they are displayed on the devices that the components are included in, together with the marks of the manufacturers of the devices, as well as the marks of the manufacturers of the other components of those devices. Thus, when marks for component parts of tablet computers, notebook computers, and laptop computers are depicted on those end-use products, the end-use consumers are unlikely to be confused into thinking the products showing the client's mark come from the company that uses the cited mark. This is because marks used to signify features of computers, namely, items marketed as an integral component of computers, will be understood to refer to items that have been provided by the owners of those marks to the company that manufactured these types of end-use products. Consumers will be unlikely to believe that these internal components that have been provided by one company to another are produced by a company that markets wearable products to consumers, like the owner of the cited mark.

In addition, the consumers of the products into which applicant's components are incorporated, as well as consumers of the products marketed under the cited mark, are also making careful decisions because of the cost of the end-use products being bought, so confusion is even more unlikely.

2. The cited mark is already co-existing with two registered marks of applicant that are more similar to the cited mark than the subject mark is

It should also be noted that applicant owns Reg. Nos. 4143074 for FEEL (TESS printout submitted herewith as Exhibit A) and 4143073 for FEEL (Stylized) (TESS printout submitted herewith as Exhibit B), both for "input devices for computers, namely, coordinate input apparatus, computer cursor control devices, namely, digitizers, computer input tablets, computer input touch panels and computer input pens" in Class 9. These registrations issued in 2012 based on use in commerce since 2011, whereas the cited registration issued in 2017 based on use in commerce since 2015. The goods covered by these registrations are identical or similar to those in the subject application (but not to those in the cited registration), but the marks in these two registrations owned by applicant are more similar to the cited mark than the subject mark is because the subject mark, unlike applicant's two registered marks, includes BY WACOM. By contrast, applicant's two registered marks, like the cited mark, contain only one word: FEEL.

Thus, if the cited mark can coexist on the register for five years and in the real world for four years with applicant's two registered marks, then the owner of the cited mark cannot be damaged by the registration of the subject mark, because that mark is less likely to be confused with the cited mark than applicant's registered marks are, and all three of applicant's marks cover the same types of products. This is a further reason why confusion is unlikely.

3. The marks themselves are different

Finally, the subject mark and the cited mark differ in two important ways. First, it should be noted that neither the subject application nor the cited registration covers words in block letters. Both cover specific stylizations of the words in the marks. In the case of the subject mark, FEEL is depicted in distinctive script letters that are attached; in the case of the cited mark, FEEL is depicted in distinctive but different non-script letters that are not attached. In addition, the cited mark includes a distinctive squiggle that is completely absent from the subject mark. The difference in stylizations and design of the two marks, which give the impression of different brands and sources, combined with the fact that consumers will understand applicant's mark to refer to component parts while understanding the cited mark to refer to finished products, make it extremely unlikely that the end-use consumers will believe the two marks indicate the same source, which is the relevant inquiry.

The likelihood that end-use consumers will believe the two parties' marks signify the same source is even further reduced by the inclusion of the words BY WACOM in applicant's mark. Those words are not simply additional words that help to visually distinguish the marks; rather, they convey relevant meaning, in two respects. First, they indicate that the true source of applicant's products is an entity identified by WACOM rather than FEEL. Second, the use of BY WACOM reinforces the idea that the mark FEEL BY WACOM is being used to identify a component whose source is different from that of the end use product into which the component is incorporated. And as discussed above, consumers are unlikely to believe that the source of a component part of a tablet computer, notebook computer, or laptop computer is the same as the source of a finished wearable device for monitoring biosignals.

For the above reasons, the citation should be withdrawn and this application should be approved for publication.