

Response to Nonfinal Office Action (Dated April 25, 2020)

Re: ALLMYLINKS – U.S. Application Serial Nos. 88771316

Applicant respectfully submits this response to the Nonfinal Office Action dated April 19, 2020 (the “Office Action”).

AMENDED IDENTIFICATION OF GOOD/SERVICES

Applicant hereby amends the application’s identification of goods and services to read as follows¹:

Class 9: *Downloadable mobile applications for managing and disseminating entertainment-related internet content; Downloadable mobile applications for locating and accessing entertainment-related internet content of others; none of the foregoing creating on-line virtual communities or chat rooms or relating to health and medical issues or to home automation systems.*

Class 41: *Providing a website featuring on-line non-downloadable software that enables users to manage, provide access to and disseminate entertainment-related internet content for entertainment purposes; Providing a website featuring on-line non-downloadable software that enables users to locate and access entertainment-related internet content of others for entertainment purposes; none of the foregoing creating on-line virtual communities or chat rooms or relating to health and medical issues or to home automation systems.*

Applicant anticipates that the examining attorney (EA) may object to the removal of the wording “social media, social networking and” from the identifications (IDs). But applicant submits that these amendments do not broaden the scope of goods and services. The

¹ To assist the EA in following the changes, below “red-lined” IDs (new language in **bold**; deleted language in ~~strikethrough~~):

Amended Class 9: *Downloadable mobile applications for managing and disseminating **entertainment-related social media, social networking and** internet content; Downloadable mobile applications for locating and accessing entertainment-related ~~social media, social networking and~~ internet content of others; none of the foregoing creating on-line virtual communities or chat rooms or relating to health and medical issues or to home automation systems.*

Amended Class 41: *Providing a website featuring on-line non-downloadable software that enables users to manage, provide access to and disseminate **entertainment-related social media, social networking and** internet content for entertainment purposes; Providing a website featuring on-line non-downloadable software that enables users to locate and access **entertainment-related social media, social networking and** internet content of others for entertainment purposes; none of the foregoing creating on-line virtual communities or chat rooms or relating to health and medical issues or to home automation systems.*

operative part of the original IDs read, in part, “...social media, social networking ***and*** internet content....” (emphasis added.) The original IDs included three forms of content as the “and” signifies. Social media and social networking content are subsets, lesser and included forms, or more specific forms, of the much broader umbrella of internet content. But the original IDs already include “internet content” generally. (The IDs do not read, “...social media, social networking internet content....” The “and” was strategically placed to *not* narrow the scope.) Thus, the amended IDs have the very same scope as the original IDs.

An analogous example of an acceptable amendment would be amending a Class 25 ID for “T-shirts, Blouses, Tank tops and Tops as clothing” to “Tops as clothing,” where “t-shirts, blouses and tank tops” are just more specific, narrower types of “tops as clothing.” So, it is not broadening the scope. An example of an inappropriate amendment would be amending the original ID for “tops as clothing, namely, t-shirts, blouses, and tank tops” to just “tops as clothing.” Applicant submits that, in the IDs at issue, “internet content” is analogous to “tops as clothing.” Thus, the proposed amendments do not broaden the scope of the IDs.

CLASSIFICATION OF GOODS/SERVICES

In the Office Action, the EA also raised the issue that the services should be amended to Class 42. Considering the proposed amendments to the Class 41 ID, applicant submits that the services are properly classified in Class 41. Not only does applicant specifically delete the specified social media and social networking content, it also added the limitations that the internet content is “entertainment-related internet content for entertainment purposes,” as well as expressly excluded services “creating on-line virtual communities or chat rooms.” Therefore, the entertainment services do not involve the creation of social media or social networking services and should not be classified in Class 42. Applicant requests that the EA reconsider and withdraw the requirement to amend the class.

SECTION 2(d) REFUSAL - LIKELIHOOD OF CONFUSION

The EA has preliminarily refused registration of applicant’s **ALLMYLINKS** mark based on a likelihood of confusion, under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), with the

mark in U.S. Registration No. 4790878, namely, **MYLINKS**. The EA also issued an advisory potential refusal based on the prior-filed Application Serial No. 86266056 for the mark **MYLINK**, which since has matured to Registration No. 6108115. So, applicant also will address this Registration No. 6108115, in anticipation of a potential refusal. The EA asserts that the marks are confusingly similar, and that applicant's goods and services are related to each registrants' respective goods and/or services. Applicant respectfully disagrees with both refusals and requests that, in light of the amended IDs, the EA reconsiders the refusals and withdraws them.

Dissimilarity of The Marks

Applicant respectfully submits that, although the marks all share the "mylink" element, each mark is different in appearance, sound, and overall commercial impression such that there is no likelihood of confusion. Applicant's ALLMYLINKS mark differs from the cited MYLINKS mark because of the addition of the "ALL" prefix. The prefix of a term often is viewed as the dominant element and applicant submits that this difference makes a significant impression on consumers. Also, applicant's ALLMYLINKS mark differs from the cited MYLINK mark because of the addition of the "ALL" prefix and the plural "S" at the end. Applicant also notes that even the one-letter difference between the cited MYLINK and MYLINKS marks is significant enough to allow them both to coexist on the federal register. Here, Applicant's mark is further distinguished from both cited marks because it is a combination of three words, not two, and because the sound and meaning of the mark is significantly different from the cited marks. Applicant's mark can coexist on the federal register with the cited marks without a likelihood of confusion, even if there were not differences between the goods and services, which there are, as explained below.

Dissimilarity of Goods and Services

Applicant's goods and services, as amended, are expressly and distinctly different than and unrelated to both cited registrations' respective goods and/or services such that there is no likelihood of confusion between the marks.

Applicant's goods and services (as amended) are as follows:

Class 9: *Downloadable mobile applications for managing and disseminating **entertainment-related** internet content; Downloadable mobile applications for locating and accessing entertainment-related internet content of others; **none of the foregoing creating on-line virtual communities or chat rooms or relating to health and medical issues or to home automation systems**; and*

Class 41: *Providing a website featuring on-line non-downloadable software that enables users to manage, provide access to and disseminate **entertainment-related** internet content for entertainment purposes; Providing a website featuring on-line non-downloadable software that enables users to locate and access entertainment-related internet content of others for entertainment purposes; **none of the foregoing creating on-line virtual communities or chat rooms or relating to health and medical issues or to home automation systems.** (emphasis added)*

Cited registration No. 4790878 for MYLINKS covers goods and services as follows:

Class 9: *Downloadable software in the nature of a mobile application for creating an on-line community for registered users to engaging in social networking **featuring medical and health issues;***

Class 38: *Providing on-line chat rooms via an interactive web site for transmission of messages among users **in the field of health and medicine;** and*

Class 42: *Computer services, namely, creating an on-line community for registered users to participate in discussions, get feedback from their peers and **healthcare professionals,** form virtual communities, and engage in social networking, all in the fields of social media and topics on **medical and health issues;** hosting on-line web facilities for others for organizing and conducting interactive discussions **in the field of medical and health issues;** and*

Class 45: *Online social networking services via an interactive web site **in the field of health and medicine.** (emphasis added)*

Cited registration No. 6108115 for MYLINK covers goods as follows:

Class 9: *Downloadable software, namely, an interface software app for mobile and handheld devices for use in remotely and locally **accessing, operating and managing motorized components of home automation systems,** excluding home automation systems for garage doors with the exception of insect screens for door openings and motorized retractable screens; **Electronic plug-in modules comprising hardware and interface software for mobile and handheld devices for use in remotely and locally accessing, operating and managing motorized components of home automation***

systems, excluding home automation systems for garage doors, with the exception of insect screens for door openings and motorized retractable screens. (emphasis added)

Applicant's goods and services are software (downloadable and non-downloadable) that is expressly related to *entertainment* content on the internet that do not include social media software or services. By contrast, the MYLINKS registration's goods and services are software and services in the field of medicine and health and medical issues. Those serious issues aren't typically associated with or related to entertainment. Similarly, the MYLINK registration's goods are software and hardware that control home automation systems like interior shades, blinds and other motorized home equipment that are components of home automation systems. The MYLINK home automation software is not related to the MYLINKS software and services for health, medicine, and medical issues, just like both are not related to software and websites related to entertainment. Especially with the express limitations in applicant's amended goods and services, there is zero overlap in the respective goods and services of these marks. And the simple fact that all three records involve software *per se* is not enough to conclude that the respective marks goods and services are similar, related, competitive, complimentary or even travel in the same or similar channels of trade. Therefore, applicant's goods and services are related to the cited registrations respective goods and services for likelihood of confusion purposes.

Coexistence of Marks

As noted above, the USPTO has allowed the MYLINK and MYLINKS marks, which are more similar to each other than applicant's mark is to either of those marks, recognizing that both can coexist on the federal register and create no likelihood of confusion. The owner of the prior registration for the MYLINKS mark also implicitly recognized that there would be no likelihood of confusion and therefore did not oppose registration of the later-filed application for the MYLINK mark. Applicant believes that it, too, should be treated similarly and should be approved for publication to give the cited registrants the opportunity to oppose registration of applicant's mark, if either or both registrants believe that it would be damaged by the registration of applicant's mark.

Section 2(d) Conclusion

In light of the foregoing, applicant has established that the two key considerations in any likelihood of confusion analysis -- (1) the similarities between the compared marks and (2) the relatedness of the compared goods and/or services – do not support a conclusion that there is a likelihood of confusion. First, the respective marks have enough dissimilarities that they are not confusingly similar. Second, applicant’s goods and services are not the same as or related to the cited registrations’ goods and/or services. Thus, applicant’s ALLMYLINKS mark when used for applicant’s goods and services does not create a likelihood of confusion with U.S. Registration No. 4790878 for MYLINKS and No. 6108115 for MYLINK. Accordingly, applicant respectfully requests that the EA withdraw this refusal to registration under Section 2(d).

CONCLUSION

Having satisfactorily addressed all the issues raised in the Office Action and having amended the identification of goods and services, applicant respectfully requests that the EA withdraw the Section 2(d) refusal and classification requirement and approve the application for publication.