IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Bain & Company Inc.
Serial Number:	88629145
Filing Date:	September 24, 2019
Mark:	ARC

RESPONSE TO OFFICE ACTION

The Examining Attorney has issued a first office action refusing registration of Applicant's ARC mark ("Applicant's Mark") under Section 2(d) of the Lanham Act on the ground of likelihood of confusion with the mark in U.S. Registration No. 6114476 (the "Cited Mark"). Applicant contends that registration of Applicant's Mark is not likely to lead to confusion, mistake or deception as to the source of Applicant's services. Therefore, Applicant respectfully submits that Applicant's Mark should be approved for publication.

SECTION 2(d) REFUSAL

1. Legal Standard

Applicant's Mark is not likely to lead to confusion, mistake, or deception of potential consumers as to the source of Applicant's services and those covered by the Cited Mark. Likelihood of confusion is determined on a case-by-case basis, with application of the factors identified in *In re E.I. du Pont de Nemours & Co.*, 177 U.S.P.Q. 563, 567 (C.C.P.A. 1973). Any particular *du Pont* factor that is material or relevant can be persuasive in analyzing whether a likelihood of confusion exists. *In re Allegiance Staffing*, 115 U.S.P.Q.2d 1319, 1323 (T.T.A.B. 2015). Here, consumer confusion is unlikely because: (1) the Cited Mark is inherently weak and entitled to a narrow scope of protection; and (2) the services are fundamentally different in nature.

2. The Cited Mark is Inherently Weak and Entitled to a Narrow Scope of Protection

The Cited Mark is inherently weak and entitled to narrow protection. It is well established that where marks exist in a crowded field of identical and closely similar marks, each mark "is relatively weak and entitled to only a narrow scope of protection." *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison*, 396 F.3d 1369, 1373 (Fed. Cir. 2005); *see Miss World (UK), Ltd. v. Mrs. Am. Pageants, Inc.*, 856 F.2d 1445, 1449 (9th Cir. 1988) ("In a 'crowded' field of similar marks, each member of the crowd is relatively 'weak' in its ability to prevent use by others in the crowd."); *General Mills, Inc. v. Kellogg Co.*, 284 F.2d 622, 626 (8th Cir. 1987) ("[E]vidence of third party usage of similar marks on similar goods is admissible and relevant to show that the mark is relatively weak and entitled to a narrower scope of protection.").

Here, a TESS search of active registrations identified numerous marks that comprise or contain the term ARC and are registered in connection with services in Class 42, showing clearly that the USPTO has consistently allowed these marks to coexist. A non-exhaustive list of these marks is below, and copies of the corresponding registration certificates are attached hereto as Exhibit A.

Mark	***Services***	***Reg. No.***	***Registrant***
	Cl. 42: Software as a service featuring software for providing scanner services for users to scan websites for machine-detectable accessibility defects and to provide access to program management features namely, consulting deliverables, training modules and helpdesk service	5564451	Paciello Group, LLC
ARC	Cl. 42: Providing a website featuring non-downloadable cloud-based computer software for business to business electronic commerce and for use in invoice automation, electronic invoice processing and payment processing	5181971	VersaPay Corporation
ARC	Cl. 42: Software as a service (SAAS) services, namely, hosting software for use by the retail and consumer packaged goods (CPG) industries for the automation of data warehousing, for application and database integration, for connecting computer network users, for creating searchable databases of information and data, for statistical analysis and the production of electronic notifications and reports, and for providing web-based	5474620	Manthan Systems, Inc.

	access to applications and services through a web operating system or portal interface		
	Cl. 42: 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	5599348	AviationManuals, LLC
	Cl. 42: Software as a service (saas) services in the fields of education and video that allows users to create and manage educational course and curriculum, track learner progress, and communicate with and collaborate amongst employees, employers, administrators, teachers, academic researchers, and learners	5670757	Instructure, Inc.
ARC	Cl. 42: Platform as a service, featuring computer software platforms for online scoring and benchmarking platform that tracks and compares green performance metrics of materials, buildings, communities, districts, neighborhoods, cities and nations	5413867	Green Business Certification Inc.

The law recognizes the marketplace reality that, where the same and similar marks are widely used, consumers are able to differentiate among them. *See* 2 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 11:83 (4th ed.). Evidence of numerous third-party marks containing the same term for particular services is strong evidence that consumers have been conditioned to look to other features of the overall marks to distinguish between the marks, the services, and the source. The fact that each of these marks, along with Applicant's Mark and the Cited Mark, contains the term "ARC" is far from dispositive of a likelihood of confusion. Instead, it demonstrates that consumers are capable of distinguishing between marks in a crowded field. Just as these third-party marks that contain ARC for software services have been allowed to coexist on the Register, Applicant's Mark should similarly be allowed to coexist.

3. The Parties' Services Are Different in Nature

If the services in question are different in nature and are not marketed in a manner that gives consumers the mistaken belief that the services emanate from the same source, then

confusion is not likely to occur. *See M2 Software Inc. v. M2 Commc'ns Inc.*, 78 U.S.P.Q.2d 1944, 1947-48 (Fed. Cir. 2006) (holding M2 COMMUNICATIONS for interactive, healthcare-related CD-ROMs and M2 for interactive, entertainment-related CD-ROMs unlikely to cause confusion due to differences between the parties' respective goods, such as their unrelated nature and dissimilar purchasers and channels of trade); *In re Jump Designs LLC*, 80 U.S.P.Q.2d 1370, 1374 (T.T.A.B. 2006) (suggesting that by narrowly identifying its covered goods and services, an applicant can avoid a finding of likelihood of confusion). Each case must be decided on the facts, including an examination of the nature of, and any similarities between, the services. *See In re Mars, Inc.*, 222 U.S.P.Q. 938, 938 (Fed. Cir. 1984) (finding no likelihood of confusion between CANYON for fresh citrus fruits and CANYON for candy bars). There is no *per se* rule that services sold in the same field or industry are similar or related for purposes of evaluating likelihood of confusion. *See Interstate Brands Corp. v. Celestial Seasonings, Inc.*, 198 U.S.P.Q. 151, 153 (C.C.P.A. 1978) ("[A] per se rule based on a single fact would be improper and inconsistent with § 2(d) of the Lanham Act.").

In the instant case, the Cited Mark is registered in connection with software as a service services intended for managing, measuring and optimizing business revenue cycle outcomes. The registrant is an accounting firm, and its services under the Cited Mark are marketed and directed specifically to healthcare provider organizations seeking to improve their revenue performance. In contrast, Applicant's Mark is applied for in connection with cloud-based software for managing organizational transformations. Applicant is a business management consulting firm, and the services under Applicant's Mark are intended for businesses seeking change management and collaboration solutions for their projects and programs. Applicant's services differ sufficiently from the services identified in the registration for the Cited Mark that,

in a crowded field of identical and similar marks, Applicant's Mark and the Cited Mark can coexist on the Register without a likelihood of consumer confusion.

In addition, confusion is further unlikely because Applicant and the registrant use their marks to convey different meanings. Applicant's Mark is an acronym for ACTION RESULTS COLLABORATION, which conveys to consumers the nature of Applicant's business collaboration software. In contrast, as demonstrated by the registrant's specimen of use, the Cited Mark is an acronym for ADVANCE REVENUE CYCLE. Consumers who view the Cited Mark understand that it is suggestive of the registrant's revenue generation and reporting services. In a crowded field, small differences between marks can be sufficient to mitigate confusion. Here, Applicant submits that the difference in meaning between the marks is sufficient to permit coexistence on the Register.

CONCLUSION

In view of the foregoing, Applicant respectfully requests that the Examining Attorney withdraw the refusal to register Applicant's Mark and permit the application to advance to publication.