

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Axon Enterprise, Inc. Law Office: 121
Serial No.: 90/059,331 Examining Attorney: Courtney Caliendo
Filing Date: July 17, 2020
Title: ARC

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

Commissioner:

RESPONSE TO OFFICE ACTION

Applicant hereby timely responds to the Office Action dated September 22, 2020, in the above-identified application. Applicant respectfully requests consideration of the following Remarks, which are made in support of Applicant’s request for registration on the Principal Register of its mark ARC, Application Serial No. 90/059,331 (“Applicant’s Mark”).

REMARKS

The Examining Attorney has preliminarily rejected the above-referenced trademark application on the following grounds:

- I. Partial Section 2(d) Refusal – Likelihood of Confusion
- II. Prior-Filed Applications – Potentially Conflicting Marks – Advisory
- III. Identification of Goods – Amendment Required
- IV. Multiple-Class Application Requirements – Advisory

I. Likelihood of Confusion

The Examining Attorney has preliminarily refused registration for Applicant’s Mark based on a likelihood of confusion with U.S. Registration Nos. 5326987, 4714608, 3254990, and 2219420.

Legal Standard for Likelihood of Confusion

A likelihood of confusion between two marks at the USPTO is determined by a review of all the relevant factors under the *DuPont* test. *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1367, 177 USPQ 563 (CCPA 1973). The two key considerations in ex parte likelihood of confusion analysis are the similarity of the marks and the similarity of the goods or services. *See Federated Goods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). Even where

two marks are *identical*, courts and the TTAB routinely hold that there is no likelihood of confusion “if the goods in question are not related 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.” TMEP § 1207.1(a)(i) (*citing Local Trademarks, Inc. v. Handy Boys, Inc.*, 16 U.S.P.Q.2d 1156 (T.T.A.B. 1990) (LITTLE PLUMBER for drain opener confusingly similar to LITTLE PLUMBER and Design for advertising services for plumbers). The Board has also held that differences in the functions or purpose of products or services may prevent likelihood of confusion. *Aries Systems Corp. v. World Book, Inc.*, 26 U.S.P.Q.2d 1926, * 21 (T.T.A.B. 1993).

Although the Examining Attorney maintains that the cited marks are “highly similar”, there are clear differences between Applicant’s Mark and each of the cited registrations, particularly, the respective businesses and the goods provided under each cited mark. There is no evidence in the record other than the parties’ respective identification of goods. A thorough analysis of the significant differences in the goods leads to the conclusion that the Office has not carried its burden of establishing a likelihood of confusion in this case.

Applicant’s Business

Applicant is a leading provider of energy weapons, video cameras, equipment, and software for law enforcement, public safety officials, first responders, private security, and the military. Applicant’s goods offered under Applicant’s Mark consist of video cameras that are used by these consumer groups to record events in real-time. The video cameras can be worn or mounted in vehicles and come equipped with the ability to connect with and interact with energy weapons, signaling devices, mobile phones, and other electronic devices. The captured video and sound data are stored in the video camera and can be transferred using proprietary smartphone apps and software-as-a-service software available through a subscription across a data network. The video cameras feature geo-spatial tagging and the ability to communicate with weapons systems to ensure seamless recording during an incident. Applicant’s wearable video cameras are part of a larger data management ecosystem of smartphone software and cloud-based computer software that allows for secure storage of sensitive data, management within an organization, and sharing with relevant groups.

Applicant’s video camera and software systems are designed to allow the user to diffuse potentially violent situations and promote compliance by persons who may act differently outside the presence of a video camera. The video cameras and software systems are further intended to allow users the convenience of using a small, compact camera to gather evidence during in-field conflicts and prevent later assertions of impropriety by third parties. By their very nature, such video cameras and software are purchased for use by an entire organization and are subjected to many layers of evaluation by a potential consumer.

In its trademark application, Applicant has included the following goods in class 9:

Computers; computer peripheral devices; computer hardware; portable electronic devices for the sending and receiving of digital data, for use as a handheld computer; video cameras; portable electronic devices for the sending and receiving of digital data, for use as a video camera; computer software for connecting, operating, integrating, controlling, and managing networked portable electronic devices via wireless networks; computer software for the redirection of messages, Internet e-mail, and/or other data to one or

more portable electronic devices from a data store on or associated with a personal computer or a server.

Applicant's Goods Are Not Similar to the Goods Offered Under Registration Nos. 4,714,608 and 3,254,990

Applicant's goods offered under Applicant's Mark are different from those listed under the commonly owned 4,174,608 (the "'608 registration") and 3,254,990 (the "'990 registration") registrations. The description of goods for Applicant's Mark includes items which are largely connected with video camera systems, including specially-purposed computer hardware designed to integrate video cameras with other electronic devices such as smartphones, tablet computers, and electronic weapons. Conversely, the description of goods for each of the '608 registration and the '990 registration do not include any items pertaining to video cameras or computer software pertaining to video cameras. Indeed, the description of goods for these registrations are exclusively focused on customized components for "high-performance microprocessor cores" and "embedded systems applications", none of which appear to be linked to video camera systems. A review of the registrant's website confirms the highly specialized nature of the goods marketed under the ARC marks. According to the registrant's website, the products consist of "proven 32-/64-bit CPU and DSP cores, subsystems and software development tools" and are "supported by a broad spectrum of 3rd party tools, operating systems, and middleware from leading industry vendors enrolled in the ARC Access Program". Screenshots from the registrant's website are enclosed as *Attachment 1*. Therefore, it is clear that the registrant develops specialized computer hardware in the form of computer processors and not video camera systems or software relating to video camera systems, as included under Applicant's Mark.

The Examining Attorney appears to have cited the '608 registration and the '990 registration as a potential obstacle to registration because the description of goods for these registrations also includes computer hardware and computer software products. The '608 registration and the '990 registration do not, however, cover the very specific computer hardware and software products covered by Applicant's application, nor could any language in the descriptions for these registrations be construed broadly enough to encompass Applicant's goods. It is well-established that computer software products are not automatically "related" goods for purposes of determining whether a likelihood of confusion between two marks exists. In the case of computer software products, the Board has often allowed identical marks to coexist for different types of computer software. For example, in *Reynolds & Reynolds Co. v. I.E. Systems, Inc.*, 5 USPQ2d 1749 (TTAB 1987), the Board found no likelihood of confusion between identical marks both used for computer software products, when applicant used the mark for operational software products and registrant used the mark for application software.

Thus, Applicant's goods cannot be considered related to goods referenced in the '608 and '990 registrations for likelihood of confusion purposes.

Applicant's Goods Are Not Similar to the Goods Offered Under Registration 5,326,987

The goods reflected in the description for the 5,326,987 ("987") registration also do not contain any references to video camera systems or software systems related to video cameras and sending/receiving information captured on a video camera. Furthermore, the description of goods for the '987 registration appears wholly directed to computer software for sharing "content and information in the fields of religion, church planting services, Christian ministry services and leadership training". These are specific consumer groups and usage applications which are distinct

from those targeted by Applicant, which markets its goods and services primarily to public safety officers and first responders. Thus, Applicant's goods cannot be considered related to goods referenced in the '987 registration for likelihood of confusion purposes.

Conclusion

In summary, consumers are unlikely to confuse Applicant's use of ARC with any of the cited registrations, given the differences between the parties' goods, the unique way in which Applicant sells its goods to its customers, and the differences between the parties' classes of purchasers and channels of trade. Applicant therefore respectfully requests that the Examining Attorney approve Applicant's application for publication without formally citing Registration Nos. 5,326,987, 4714608, or 3254990.

II. Prior Pending Applications

The Examining Attorney has cited pending U.S. application nos. 87/982,894 and 79/282,210 and argues that each application may, if approved and registered, pose a threat to registration of Applicant's Mark. Applicant respectfully disagrees that either of the referenced applications should be considered as a potential 2(d) bar to registration of Applicant's Mark. Without waiving any argument as to the referenced trademark applications, Applicant reserves the right to respond to any office action which may issue based on application nos. 87/982,894 and 79/282,210.

III. Description of Goods

The Examining Attorney concludes that the description of goods is indefinite and must be clarified. Specifically, the Examining Attorney requested Applicant to specify the common commercial or generic name for the goods. Applicant hereby proposes the following amended description of goods:

International Class 9: Computers; computer peripheral devices; computer hardware; portable electronic devices for the sending and receiving of digital data, for use as a handheld computer; video cameras; portable electronic devices for the sending and receiving of digital data, for use as a video camera; downloadable computer software for connecting, operating, integrating, controlling, and managing networked portable electronic devices via wireless networks; downloadable telephone-based information retrieval software, namely, downloadable mobile application software for accessing, browsing and searching an online database on a smartphone; downloadable personal vehicle integration software, namely, downloadable software for connecting personal devices to a vehicles communication hub; electronic voice recognition apparatus; downloadable computer software for personal information management; downloadable voice recognition software; downloadable speech to text conversion software; downloadable computer software for accessing, browsing and searching online database; downloadable computer software for the redirection of messages, Internet e-mail, and/or other data to one or more portable electronic devices from a data store on or associated with a personal computer or a server; downloadable computer software used to process voice commands, and create audio responses to voice commands; downloadable computer software for dictation; downloadable computer software for enabling hands-free use of a portable electronic

device through voice recognition; downloadable computer software for global positioning and for providing travel directions; downloadable computer software for providing information in the field of public safety; computer-aided dispatch systems comprised of computer hardware and downloadable computer software used together for dispatching vehicles and personnel.

IV. MULTI-CLASS APPLICATION

The Examining Attorney suggests that Applicant consider adding an additional class to the application (class 42) on the grounds that some of the items in the description are more appropriately classified in the additional class. Applicant believes, in light of the proposed amendments to the description listed above, that the additional class is not necessary.

CONCLUSION

Applicant respectfully requests that the initial rejection be withdrawn and that the application be passed on to publication on the Principal Register. If the Examining Attorney has any further questions or believes that a telephone conversation might be productive, the Applicant is ready to discuss these matters at the convenience of the Examining Attorney. Thank you for your consideration of these matters.

Respectfully Submitted,

Justin Clark

Justin Clark, Esq.
J. Clark Law Firm, PLLC

Attachment 1



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The DesignWare® ARC® Processor IP portfolio consists of proven 32-/64-bit CPU and DSP cores, subsystems (/designware-ip/processor-solutions/designware-arc-subsystems.html) and software development tools (/designware-ip/processor-solutions/arc-development-tools.html). ARC processors are supported by a broad spectrum of 3rd-party tools, operating systems and middleware from leading industry vendors enrolled in the ARC

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Access Program (/designware-ip/processor-solutions/arc-access-program.html), as well as a comprehensive suite of free and open source software available through the embARC Open Software Platform (<https://www.synopsys.com/dw/ipdir.php?ds=embarc>).

Synopsys offers the ASIP Designer (<https://www.synopsys.com/dw/ipdir.php?ds=asip-designer>) tool for automating the design and implementation of application-specific instruction-set processors (ASIPs). ASIP Designer enables designers to create custom processors and programmable hardware accelerators for specialized processing requirements.

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WHITE PAPER

VIDEO

Fast Cycle
Approximate
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Kyocera Launches AI-enabled MFP
SoC with ARC EV Processor IP
(<https://news.synopsys.com/2021-03-09-Synopsys-ARC-EV-Processor-Enables-Kyocera-Document-Solutions-to-Launch-AI-enabled-Multifunctional-Printer-SoC>)

Synopsys and SIMa.ai Collaborate
to Bring ML Inference to the
Embedded Edge
(<https://news.synopsys.com/2020-10-14-Synopsys-and-SIMa-ai-Collaborate-to-Bring-Machine-Learning-Inference-at-Scale-to-the-Embedded-Edge>)

Reference Flow for Predictable
Execution of ASIL D-Compliant
SoC Design
(<https://news.synopsys.com/2020-10-14-Synopsys-and-Samsung-Foundry-Announce-Reference-Flow-for-Predictable-Execution-of-ASIL-D-Compliant-SoC-Design-for-Automotive-Applications>)

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System-level Power and Performance Optimization of AI SoC Architectures
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Pitfalls of IP Power Estimation for AI & Vision SoCs, and How to Avoid Them
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ARC Processor Virtual Summit – Now Available On-Demand.
(<https://www.synopsys.com/designip/processor-solutions/arc-processor-summit/arc-processor-virtual-summit-2020.html>)

VIDEOS (/DESIGNWARE-IP/VIDEOS/PROCESSOR-SOLUTIONS.HTML)

Sensor Fusion for Autonomous Vehicles: Strategies, Methods, and Tradeoffs
(<https://youtu.be/2Fcmh7SLPBI>)

Products

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(<http://www.synopsys.com/dw/ipdir.php?ds=arc-sem>)

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