

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
TO THE COMMISSIONER OF PATENTS AND TRADEMARKS**

In re Application of:
Microsoft Corporation

Mark: TROVE

Application Serial No.: 90/304,112

Application Filing Date: November 6, 2020

Atty. Docket No.: 128291.4

Examining Attorney
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Law Office 101

AMENDMENT AND RESPONSE TO OFFICE ACTION

This Amendment and Response is submitted in reply to the Office Action issued March 14, 2021. In the Office Action, the Examining Attorney indicated the following issues and refusal grounds:

- Identification of Goods and Services;
- Preliminary Refusal under Section 2(d) of the Trademark Act — Likelihood of Confusion;
- Potential Refusal to Register Based on Prior-Filed Applications; and
- Certificate of Registration Required for Section 44(e).

The informalities and substantive issues raised in the Office Action are addressed in this Response.

I. IDENTIFICATION OF GOODS AND SERVICES

In response to the request for clarification of the identification of goods and services, Applicant thanks the Examining Attorney for the guidance, and amends the goods and services to the following:

Class 9: downloadable computer software for use in the field of artificial intelligence (AI) processing and machine learning, namely, software for submitting images and digital files to train third party machine learning models; downloadable computer software for use in connection with buying, selling, sharing, searching, downloading, customizing, integrating and reviewing information, data, images, and digital files; downloadable computer software for user data capture, storage and analysis for use in the field of artificial intelligence (AI) processing and machine learning; downloadable computer software allowing users to perform electronic business transactions via a global computer network for use in the field of artificial intelligence (AI) processing and machine learning; downloadable computer software for generating coupon codes, payment processing, payment fraud detection, and creating, using and managing virtual currency for use in the field of artificial intelligence (AI) processing and machine learning, all of the foregoing excluding downloadable software for the electronic transmission of email, downloadable computer game software and video game software, downloadable computer software for

predictive data science and predictive data science analysis, and downloadable software to automate the provisioning and management of databases in a cloud computing environment.

Class 35: operating an on-line marketplace for use in the field of artificial intelligence (AI) and machine learning for contributors to submit images and digital files for AI projects to train third party machine learning models; on-line marketplace services, namely, operating an on-line marketplace featuring information, data, images, and digital files.

Class 38: telecommunications services, namely, transmission and retrieval of data, images, and digital files through computer networks, wireless networks, and the internet to enable third parties to train machine learning models for use in the field of artificial intelligence, all of the foregoing excluding the electronic transmission of e-mail.

Class 42: software as a service (saas) services featuring non-downloadable software for use in the field of artificial intelligence (AI) processing and machine learning, namely, software for submitting images and digital files to train third party machine learning models; platform as a service (paas) services featuring non-downloadable computer software platforms for use in the field of artificial intelligence (AI) processing and machine learning, namely, software for submitting images and digital files to train third party machine learning models; software as a service (saas) services featuring non-downloadable software for use in connection with buying, selling, sharing, searching, downloading, customizing, integrating and reviewing information, data, images, and digital files; platform as a service (paas) services featuring non-downloadable computer software platforms for use in connection with buying, selling, sharing, searching, downloading, customizing, integrating and reviewing information, data, images, and digital files; software as a service (saas) services featuring non-downloadable computer software used for user data capture, storage and analysis; platform as a service (paas) featuring non-downloadable computer software platforms used for user data capture, storage and analysis; software as a service (saas) services featuring non-downloadable computer software allowing users to perform electronic business transactions via a global computer network; platform as a service (paas) services featuring non-downloadable computer software platforms allowing users to perform electronic business transactions via a global computer network; software as a service (saas) services featuring non-downloadable computer software used for generating coupon codes, payment processing, payment fraud detection, and creating, using and managing virtual currency; platform as a service (paas) services featuring computer software platforms used for generating coupon codes, payment processing, payment fraud detection, and creating, using and managing virtual currency; providing a website featuring information in the field of transactions involving information, data, images and digital files; providing a website featuring technology that enables users access to and information about transactions involving information, data, images, and digital files, all of the foregoing excluding non-downloadable software for the electronic transmission of email, non-downloadable computer software for predictive data science and predictive data science analysis services, and non-downloadable software to automate the provisioning and management of databases in a cloud computing environment.

These amendments have been entered into the goods and services amendment section of the electronic response form. Accordingly, Applicant believes the amended identification of goods and services now meet the requirements for clarity.

II. SECTION 2(D) REFUSAL - LIKELIHOOD OF CONFUSION

In view of the foregoing amendments, and the arguments and case law presented below, Applicant respectfully requests that the refusal to register the subject mark be reconsidered and withdrawn.

Registration of Applicant’s mark was preliminarily refused on the basis of an alleged likelihood of confusion. For the Examining Attorney’s ease of reference, the cited marks that form the basis for the objection are set forth in the following table (the “Cited Registrations”):

Trademark	Reg. No.	Goods & Services	Owner Information
TROVE	RN: 6197791	(Class: 9) Computer application software for mobile phones, portable media players, and handheld computers, namely, software for the electronic transmission of email (Class: 38) Electronic transmission of e-mail; Transmission of electronic mail	Trove, Inc. 202 E. Huron Street Ann Arbor, Michigan 48104
TROVE	RN: 5322964	(Class: 9) Computer application software for mobile phones, portable media players, and handheld computers, namely, software for the electronic transmission of email (Class: 38) Electronic transmission of e-mail; Transmission of electronic mail	Trove, Inc. 202 E. Huron Street Ann Arbor, Michigan 48104
TROVE	RN: 4607248	(Class: 9) Computer game software and video game software; Downloadable computer game software via a global computer network and wireless devices (Class: 41) Entertainment services, namely, providing online video games and computer games for others over global and local area computer networks;	Blockescence DLT Solutions GmbH Schlesische Str. 27C Berlin, Germany 10997

		entertainment services in the nature of an on-line interactive game provided by means of a global computer network	
TROVE	RN: 4646746	(Class: 42) Predictive data science services, namely, providing on-line non-downloadable computer software in the nature of data analytical tools for data fusion and data mining across and within data sources; Application service provider (ASP) featuring software for use in information management through data aggregation and analysis for purposes of predictive data science analysis; Computer services, namely, acting as an application service provider in the field of information management, namely, hosting computer application software platforms to aggregate data and provide analysis and forecasting for purposes of predictive data science analysis	E Source Companies 1745 38th Street, Boulder, Colorado 80301
TROVE	RN: 4646074	(Class: 9) Computer software in the nature of data analytical tools for data fusion and data mining across and within data sources for purposes of predictive data science analysis	E Source Companies 1745 38th Street, Boulder, Colorado 80301
TROVE	RN: 4795723	(Class: 9) Software for use by software developers to automate the provisioning and management of databases in a cloud computing environment	OpenStack Foundation 1214 W 6th Street, Suite 205, Austin, Texas 78703

Attached as Exhibit A are the TESS records for the Cited Registrations. At the outset, Applicant notes that the cited U.S. Registration No. 4646074 is now cancelled. For the reasons set forth below, Applicant respectfully submits that there is no likelihood of confusion between Applicant's mark and the Cited Registrations, and requests that the refusal to register its mark on the basis of a likelihood of confusion be withdrawn.

When assessing the likelihood of confusion between marks, it is well settled that the Office must look to the thirteen factors established by the Court of Customs and Patent Appeals in the *duPont* case. *See In re E.I. duPont de Nemours & Co.*, 177 USPQ 563, 567 (CCPA 1973). Not all of the thirteen factors will be relevant in a particular case. *See In re Dixie Rests., Inc.*, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997).

In this case, Applicant submits that *duPont* factors (2) and (6) strongly support a finding of no likelihood of confusion. By contrast, *duPont* factor (1) cited by the Examining Attorney, is not dispositive. Here, Applicant's amended identification clarifies that the nature and purpose of its goods and services are significantly different, and immediately distinguishable, from the Cited Registrations. Taken together, when the foregoing facts are analyzed in the context of the relevant *duPont* factors, it is readily apparent that there is no likelihood of confusion between Applicant's mark and the Cited Registrations.

A. *duPont* Factor (2) - "The Similarity or Dissimilarity and Nature of the Goods or Services" - Strongly Supports a Finding of No Likelihood of Confusion with the Cited Registrations.

duPont factor (2), which focuses on the similarity/dissimilarity of the goods and services, is key to the analysis, and strongly favors a finding of no likelihood of confusion. In the Office Action, the Examining Attorney noted that because Applicant's original identification of goods and services was so indefinite and broad, any possible registration or application that may be confusingly similar was listed. That said, the Examining Attorney also indicated that limitations on Applicant's applied-for goods and services may result in the removal of many of these citations.

In response, Applicant has amended its identification of goods and services to clarify and significantly narrow the indefinite and overly broad terms. In doing so, Applicant further amended the identification to exclude the specific goods and services contained in the Cited Registrations detailed in the table above. As you can see, Applicant's amended goods and services are distinct from those offered by the Cited Registrations. In particular, Applicant's amended goods and services are limited to the field of artificial intelligence processing and machine learning. More specifically, Applicant's amended goods and services are for enabling consumers to submit images and digital files to be used by third party developers to train machine learning models for AI projects. Here, the customers of Applicant's goods and services are not only individuals seeking to monetize their collection of photographs, but also developers simultaneously looking to use the images for machine leaning models.

By contrast, the goods and services covered by the Cited Registrations are predominantly for "the transmission of email," "computer and video games," "predictive data science analysis," and "management of databases in a cloud computing environment." As such, it is readily apparent that Applicant's goods and services are entirely unrelated, used for different, highly specialized purposes, and not likely to cause confusion with the Cited Registrations.

There is no *per se* rule that merely because two products are in the same general category, there is a likelihood of confusion. *See, In re Mars, Inc.*, 222 USPQ 938 (Fed. Cir. 1984) (no likelihood of confusion between "Canyon" for candy bars and "Canyon" for fresh citrus fruits); *Shen Manufacturing Co. v. Ritz Hotel Ltd.*, 73 USPQ2d 1350 (Fed. Cir. 2004) (mere fact that "mitt" is defined as type of glove has no relevance to whether consumer would believe that products emanate from same source, since barbecue mitt is better understood as tool than article of clothing, and since barbecue mitt, which is designed to protect hand from heat while cooking, has different purpose from that of gloves, which are designed to keep hands warm while adding air of style); and *WWW Pharmaceutical Co. Inc. v. The Gillette Co.*, 25 USPQ2d 1593 (2d Cir.

1993) (plaintiff's lip balm and defendant's deodorant antiperspirant products do not compete or serve same purpose, even though they may both be generally defined as personal care products, and even though they share some of same channels of trade).

In this case, with Applicant's amendments, it is clear that its applied-for goods and services are not related, or competitive with the Cited Registrations' goods and services. As such, Applicant submits that *duPont* Factor (2) does not support a finding of likelihood of confusion.

B. *duPont* Factor (6) - "The Number and Nature of Similar Marks in Use on Similar Goods or Services" - Also Strongly Supports a Finding of No Likelihood of Confusion with the Cited Registrations.

duPont factor (6), the number and nature of similar marks in use on similar goods or services, also provides strong support for a finding of no likelihood of confusion between Applicant's mark and the six Cited Registrations. Further, the similarity/dissimilarity of the goods and services (*duPont* factor (2)) analysis set forth above, becomes even stronger when it is viewed in the context of the coexistence of many third party marks that include variations of the term "TROVE."

The evidence of numerous identical or similar marks including the term "TROVE" coexisting without any likelihood of confusion demonstrates that consumers have been conditioned to distinguish between a variety of marks incorporating the term based on slight differences in the goods and services in which the marks are used. When terms are commonly used, the scope of protection when assessing likelihood of confusion is necessarily more limited than is the case with an arbitrary or coined mark. See, for example, *Wooster Brush Co. v. Prager Brush Co.*, 231 USPQ 316 (TTAB 1986), in which POLY-PRO for paint brushes was found not confusingly similar to POLY-GLO for paint applicators. Also, see, *The Land-O-Nod Company v. Paulison*, 220 USPQ 61 (TTAB 1983), in which CHIRO-MATIC for mattresses and box springs was found not confusingly similar to CHIROPRACTIC and CHIRO- for the same goods.

"If the evidence establishes that the consuming public is exposed to third-party use of similar marks on similar goods, the evidence 'is relevant to show that a mark is relatively weak and entitled to only a narrow scope of protection.'" TMEP 1207.01(d)(iii) (citing *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772*, 396 F.3d 1369, 1373 (Fed. Cir. 2005)). Therefore, given the six Cited Registrations are coexisting on the Register, the Cited Registrations are afforded a narrow scope of protection.

When considering the narrow scope of protection afforded to the Cited Registrations, combined with the immediately distinguishable goods and services of the Cited Registrations and Applicant's mark, it is clear that there is no likelihood of confusion between Applicant's mark and the Cited Registrations.

Likelihood of confusion means the probability of confusion, not merely the *possibility* of confusion. See, e.g., *Carter Wallace Inc. v. Proctor & Gamble Co.*, 434 F.2d 794 (9th Cir. 1979); *Sears Roebuck & Co. v. All State Life Insurance Co.*, 246 F.2d 161 (5th Cir. 1957). In addition, likelihood of confusion requires a finding of probable confusion of a substantial number of

reasonable buyers as to the source or connection of the sellers. *See, e.g., Motorola, Inc. v. Griffith Electronics, Inc.*, 317 F.2d 391 (C.C.P.A. 1963). Based on the evidence and case law discussed above, it is clear that there is no probability of confusion between Applicant's mark and the Cited Registrations.

For the reasons set forth above, Applicant respectfully requests that the refusal to register the subject mark based on an alleged likelihood of confusion with U.S. Registration Nos. 6197791, 5322964, 4607248, 4646746, 4646074, and 4795723, be withdrawn.

III. PRIOR-FILED APPLICATIONS

The Office Action also states that the effective filing dates of the pending U.S. Application Serial Nos. 90348258, 90169157, 88503663, 88796557, and 87410178, precede the filing date of the subject application. The Office Action further states that if the potentially cited marks register, Applicant's mark may be refused registration under Section 2(d) because of a likelihood of confusion with the registered mark(s). *See* 15 U.S.C. §1052(d); 37 C.F.R. §2.83; TMEP §§1208 et seq. That said, the Office Action indicates that the clarification of the applied-for goods and services may remove some of the listed citations.

At the outset, Applicant notes the subject application was filed on November 6, 2020, whereas cited U.S. Application Serial No. 90348258 was filed on November 30, 2020. Therefore, Applicant's filing date for the subject application precedes the cited U.S. Application Serial No. 90348258. The TESS record for the application is attached as Exhibit B. Further, Applicant notes that the cited U.S. Application Serial No. 87410178 is now abandoned. The TESS record for the abandoned application is attached as Exhibit C. In view of the foregoing, Applicant respectfully requests that the potential refusal to register the subject mark based on U.S. Application Serial Nos. 90348258 and 87410178, be withdrawn.

At this time, Applicant elects not to submit arguments against the potential refusal based on U.S. Application Serial Nos. 90169157, 88503663, and 88796557, and reserves the right to submit such arguments at a later date, if Applicant's goods and services amendments do not remove the remaining listed citations.

IV. CERTIFICATE OF REGISTRATION REQUIRED FOR SECTION 44(E)

Applicant intends to rely on its Section 1(b) filing basis as the basis for registration, and does not intend to rely on Section 44(e) as the basis for registration, but is only asserting a valid claim of priority. This amendment has been entered into the goods and services amendment section of the electronic response form. Therefore, the application should not be suspended to await the submission of the foreign registration.

V. CONCLUSION

Upon submission of this Response, it is believed that this application is now in condition for publication. Such action is respectfully requested.

If the Examining Attorney has any comments regarding this Response or finds that any of the requirements have not been met, Applicant respectfully requests that the Examining Attorney contact the undersigned counsel.

Respectfully submitted,

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