


IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Google LLC
Serial No. : 88869859
Filed : April 13, 2020
Mark : 
Int'l Classes : 35, 42

Law Office : 126
Examining Attorney : Sara Anne Helmers
Attorney Docket No. : 039430

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

RESPONSE TO SUSPENSION NOTICE

Applicant submits this response to the Suspension Notice dated May 21, 2020 issued



against Application Serial No. 88869859 to register the mark **(“Applicant’s Mark”)**, which seeks registration in connection with the following services: *Promoting research in the field of the use of technology to address international political, government, and social issues; promoting public awareness of the use of technology to address international political, government, and social issues*, in Class 35; and *Computer software development in the field of software to address international political, government, and social issues; providing a website featuring information regarding the use of technology to address international political, government, and social issues*, in Class 42 (**“Applicant’s Services”**) based on a potential likelihood of confusion with prior pending U.S. Application No. 88685043 for the mark JIG-SAW (the **“Cited Mark”**), filed by Jig-Saw Inc. on an intent-to-use basis on November 8, 2019 (the **“Cited Application”**), in connection with the following goods and services:¹

Class 9: Portable radio communication machines and apparatus; aeronautical radio communication machines and apparatus; multichannel radio communication machines and apparatus for fixed stations; single-channel radio communication machines and apparatus for fixed stations; vehicular radio communication machines

¹ Applicant notes that the owner of the Cited Application filed a Response to Office Action on August 19, 2020, in which, *inter alia*, amended the goods and services identified in the Cited Application. Consequently, Applicant identifies here the amended descriptions of goods and services as identified in the response.

and apparatus; marine radio communication machines and apparatus; navigational apparatus for vehicles in the nature of on-board computers; radio beacon machines and apparatus; aviation radio direction finders; marine radio direction finders; radar machines and apparatus; loran navigation machines; remote control telemetering machines and instruments; sound recording machines and apparatus; change-over switches for telecommunication apparatus; connectors for telecommunication apparatus, namely, electrical connectors, fiber optic connectors, telephone connectors, Internet connectors; electrical transformers for telecommunication apparatus; protectors for telecommunication apparatus, namely, circuit overload protector devices, protective cases for mobile phones, surge protectors, computer server protectors, network server protectors and Internet server protectors; remote controls for televisions, radios, electric fans, computer network, computer servers and computer software; high-frequency switches; telephones incorporating intercommunication systems; telecommunication transmitting sets for transmitting audio, data and visuals; telecommunication transmitters; electronic key fobs being remote control apparatus; electric installations for the remote control of industrial operations; transmitters of electronic signals; telegraph transmitting apparatus; electric navigational instruments; radiotelegraphy sets; personal digital assistants; downloadable computer software for remote monitoring of computer network, computer servers and computer software; downloadable computer software for remote management of computer network, computer servers and computer software; downloadable computer software for managing vending machine inventory; downloadable computer software used to remotely monitor computer servers to ensure proper functioning; downloadable computer software to monitoring the condition of luggage for quality control; downloadable computer software for remote monitoring of computer systems to ensure proper functioning; downloadable computer software for remote monitoring of operational computer data to ensure proper functioning of computer network, computer servers and computer software; downloadable computer operating software for computer network and computer server systems; downloadable computer operating software to manage and control computer systems; downloadable operating computer software for accessing and using cloud computing networks; computers; integrated circuits; large scale integrated circuits; downloadable computer software for monitoring computer network and computer servers; semi-conductors; printed circuits; printed circuit boards; video projectors; liquid crystal display monitors; flat panel display screens; video projectors; optical correcting lenses; optical correcting goggles; optical correcting contact lenses; mirrors for inspecting work; electrical cells and batteries; electric conductors; detectors for radon, carbon monoxide, smoke, motion, gamma radiation, breakdowns of computer server, computer network and computer software, temperature, humidity, acceleration, distance, weight, pH, carbon monoxide, illuminance, magnetic force, switch on and off; rotary converters; phase modifiers in the nature of phase shifters for communications apparatus; electric or magnetic meters and testers for acoustic, vibration, flow, circuit and torsion; electronic downloadable publications in the nature of magazines, journals, newsletters, reports, brochures and questionnaires in the field of Internet of Things enabled devices; electronic downloadable publications in the nature of magazines, journals, newsletters, reports, brochures and questionnaires in the field of remote monitoring of the functioning and use of electronic equipment;

Class 35: Business management of facilities used for housing and operation of computer systems and providing information relating thereto; management of computerized files; business management and consultancy relating thereto; systemization and editing of information in computer servers connected to the Internet; business


management of facilities used for housing and operation of computer servers and providing information relating thereto; price comparison services and providing information relating thereto; advertising and publicity services; business management analysis; professional business consultancy; marketing research and analysis; providing information concerning commercial sales; and

Class 42: Monitoring of computer systems by remote access to detect breakdowns and providing information relating thereto none of the foregoing for online virtual classrooms; consultancy in the field of monitoring of computer systems none of the foregoing for online virtual classrooms; monitoring of computer data by remote access none of the foregoing for online virtual classrooms; computer system design and consultancy relating thereto none of the foregoing for online virtual classrooms; design and development of operating software for computer networks and servers none of the foregoing for online virtual classrooms; design and maintenance of computer database programs none of the foregoing for online virtual classrooms; providing user access to computer programs in data networks and providing information relating thereto none of the foregoing for online virtual classrooms; consultancy in the field of providing computer programs on data networks none of the foregoing for online virtual classrooms; providing computer programs for computer system operation management none of the foregoing for online virtual classrooms; rental of server storage memory space and providing information relating thereto none of the foregoing for online virtual classrooms; consultancy in the field of rental of server memory space none of the foregoing for online virtual classrooms; intermediary services relating to rental of server storage memory space none of the foregoing for online virtual classrooms; technological advice relating to computer users via support hotline none of the foregoing for online virtual classrooms; consultation in the field of cloud computing none of the foregoing for online virtual classrooms; providing on cloud computing none of the foregoing for online virtual classrooms; intermediary services relating to cloud computing none of the foregoing for online virtual classrooms; cloud storage services for electronic data none of the foregoing for online virtual classrooms; design and maintenance of operating software used to access and use cloud computing networks none of the foregoing for online virtual classrooms; rental of operating software used to access and use cloud computing networks none of the foregoing for online virtual classrooms; providing temporary use of online non-downloadable computer software for remote monitoring of computer network, computer servers and computer software none of the foregoing for online virtual classrooms; providing temporary use of online non-downloadable computer software for remote management of computer network, computer servers and computer software none of the foregoing for online virtual classrooms; providing temporary use of online non-downloadable computer software for managing vending machine inventory none of the foregoing for online virtual classrooms; providing temporary use of online non-downloadable computer software used to remotely monitor of computer servers to ensure proper functioning none of the foregoing for online virtual classrooms; providing temporary use of online non-downloadable computer software to monitoring the condition of luggage for quality control none of the foregoing for online virtual classrooms; providing temporary use of online non-downloadable computer software for remote monitoring of computer systems to ensure proper functioning none of the foregoing for online virtual classrooms; providing temporary use of online non-downloadable computer software for remote monitoring of operational computer data to ensure proper functioning of computer network, computer servers and computer software none of the foregoing for online virtual classrooms; providing temporary use of online non-downloadable computer operating software for computer network and computer server systems none of the

foregoing for online virtual classrooms; providing temporary use of online non-downloadable computer operating software to manage and control computer systems none of the foregoing for online virtual classrooms; providing temporary use of online non-downloadable operating computer software for accessing and using cloud computing networks none of the foregoing for online virtual classrooms; providing temporary use of online non-downloadable computer software for monitoring computer network and computer servers none of the foregoing for online virtual classrooms

(collectively, the “Cited Goods and Services”).

Applicant respectfully disagrees with the Examining Attorney’s conclusion that there is a potential likelihood of confusion between Applicant’s Mark and the Cited Mark. Applicant maintains that consumers are not likely to be confused as to the source, origin, or affiliation of Applicant’s Services and the Cited Goods and Services because 1) Applicant acquired prior rights to the word portion of Applicant’s Mark, namely the term JIGSAW, in connection with Applicant’s services in Classes 35 and 42 before any priority date that the owner of the Cited Mark may claim, based on Applicant’s prior use of the mark in commerce and as demonstrated by its prior registration for the

mark  Jigsaw in Classes 35 and 42; 2) the differences in the associated goods and services are sufficient to distinguish Applicant’s Mark and the Cited Mark, and 3) there are a number of JIGSAW-formative marks peacefully coexisting on the Principal Register in connection with Class 9 goods and Class 42 services, indicating that Applicant’s Mark should be allowed to do the same.

I. There Is No Likelihood of Confusion Between Applicant’s Mark and the Cited Mark

Likelihood of confusion between two marks is determined at the United States Patent and Trademark Office (“PTO”) by a review under the *DuPont* test. *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In *du Pont*, the Court of Customs and Patent Appeals enumerated a list of thirteen factors that should be considered in a likelihood of confusion analysis. The most relevant for purposes of this response are the following:


- a. The fame of the prior mark (sales, advertising, length of use);
- b. The dissimilarity of the goods and services at issue; and
- c. The number and nature of third party marks incorporating the term JIGSAW in connection with Class 9 goods or Class 42 services.

Id., 476 F.2d at 1361.

Because (a) Applicant's Mark acquired prior rights to the literal element JIGSAW, as demonstrated by its prior registration for the J JIGSAW (& Design) mark (U.S. Registration No. 5566341) in connection with identical services in Classes 35 and 42, which registration predates the filing date of the Cited Application; b) Applicant's Services are entirely distinguishable from the Cited Goods and Services, and c) there are a number of JIGSAW-formative marks peacefully co-existing on the Principal Register, Applicant's Mark and the Cited Mark are dissimilar for the purposes of a likelihood of confusion determination and Applicant's Mark should be approved for publication.

a. Applicant Acquired Prior Rights in JIGSAW Before the Filing Date of the Cited Application

Applicant is the owner of multiple JIGSAW marks and has used said marks in commerce in connection with certain promotional, software development, and website provision services - identical to the services identified in Applicant's Application - since at least as early as February 16, 2016. Through its continuous and substantially exclusive use of the JIGSAW marks for over four years, Applicant has acquired distinctiveness for the JIGSAW marks and has earned the recognition of the public. Further, as shown below, Applicant is the owner of, *inter alia*, U.S. Registration No. 5566341 for the mark J JIGSAW (& Design), registered on the Principal Register on September 18, 2018 in connection with the same services in Classes 35 and 42 as those identified in Applicant's Application:

| Reg. No. | Mark | Services | Date of First Use | Status |
|----------|---|---|-------------------|--|
| 5566341 |  | <p>Class 35: Promoting research in the field of the use of technology to address international political, government, and social issues; promoting public awareness of the use of technology to address international political, government, and social issues; and</p> <p>Class 42: Computer software development in the field of software to address international political, government, and social issues; providing a website featuring information regarding the use of technology to address international political, government, and social issues.</p> | February 16, 2016 | Registered on Sept. 18, 2018 (Filed on September 6, 2016) |

Attached hereto as **Exhibit A** is the relevant Trademark Status & Document Retrieval record for the above-referenced registration.

Thus, the date of first use and the date of filing for this prior registration owned by Applicant predate the filing date of the Cited Application, namely November 18, 2019. Further, the Cited Application was filed on a Section 1(b) basis, and as such the Cited Application does not claim a date of first use.

Accordingly, based on its prior use of the mark JIGSAW- the dominant feature of Applicant's Mark - and its prior registration for the mark J JIGSAW (& Design), Applicant acquired prior rights to the term JIGSAW in connection with the relevant services identified in Applicant's Application before the Cited Mark was ever filed. Thus, because Applicant is actually the senior user, and has acquired prior rights, in the shared term JIGSAW in connection with the relevant services, the Cited Mark should not serve as a bar to registration for Applicant's Application based on a likelihood of confusion.

b. Applicant's Services and the Cited Goods and Services Are Not Sufficiently Related So As to Cause Consumer Confusion

One of the two key considerations in a likelihood of confusion analysis is the relatedness of the goods and services at issue. See *In re i.am.symbolic, llc*, 866 F.3d at 1322, 123 USPQ2d at 1747 (quoting *Herbko Int'l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1164-65, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002)); *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 1103, 192 USPQ 24, 29 (C.C.P.A. 1976) ("The fundamental inquiry mandated by [Section] 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods [or services] and differences in the marks.").

As the Examining Attorney issued only a provisional refusal, she has not introduced any evidence to support a finding of the relatedness of Applicant's Services and the Cited Goods and Services. See TMEP § 1207.01(a)(vi) ("The examining attorney must provide evidence showing that the goods and services are related to support a finding of likelihood of confusion"); *In re White Rock Distilleries Inc.*, 92 USPQ2d 1282, 1285 (TTAB 2009) (finding Office had failed to establish that wine and vodka infused with caffeine are related goods because there was no evidence that vodka and wine emanate from a single source under a single mark or that such goods are complementary products that would be bought and used together). Nevertheless, because Applicant's Services and the Cited Goods and Services are so disparate, Applicant addresses this factor herein.

As an initial matter, Applicant's Services and the Cited Goods and Services overlap only as to Classes 35 and 42, and Applicant notes that there is no *per se* rule that all software goods and

services are related for purposes of a likelihood of confusion analysis. See TMEP § 1207.01(a)(iv). On the contrary, the Federal Circuit has explained that relatedness between software goods and services may not be presumed merely because the goods or services are delivered in the same media format and that, instead, a subject-matter-based mode of analysis is appropriate. See *M2 Software, Inc. v. M2 Commc'ns, Inc.*, 450 F.3d 1378, 1383, 78 USPQ2d 1944, 1947–48 (Fed. Cir. 2006). Here, the distinct nature of the parties' goods and services weighs strongly against a finding of likelihood of confusion in this case. *Octocom Systems, Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) (“The authority is legion that the question of registrability of an applicant's mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods, the particular channels of trade or the class of purchasers to which the sales of goods are directed”); *Paula Payne Products v. Johnson Publishing Co.*, 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973) (“Trademark cases involving the issue of likelihood of confusion must be decided on the basis of the respective descriptions of goods”).

In this case, the identifications for Applicant's services in Classes 35 and 42 are sufficiently distinct on their face from the Cited Goods and Services so as to negate a likelihood of consumer confusion. Applicant's Class 42 services are *computer software development in the field of software to address international political, government, and social issues and providing a website featuring information regarding the use of technology to address international political, government, and social issues*. The software and software services identified in Class 9 and Class 42 of the Cited Application are as follows (emphasis added):

Class 9: downloadable computer software for remote monitoring of computer network, computer servers and computer software; downloadable computer software for remote management of computer network, computer servers and computer software; downloadable computer software for managing vending machine inventory; downloadable computer software used to remotely monitor computer servers to ensure proper functioning; downloadable computer software to monitoring the condition of luggage for quality control; downloadable computer software for remote monitoring of computer systems to ensure proper functioning; downloadable computer software for remote monitoring of operational computer data to ensure proper functioning of computer network, computer servers and computer software; downloadable computer operating software for computer network and computer server systems; downloadable computer operating software to manage and control computer systems; downloadable operating computer software for accessing and using cloud computing networks; downloadable computer software for monitoring computer network and computer servers; and

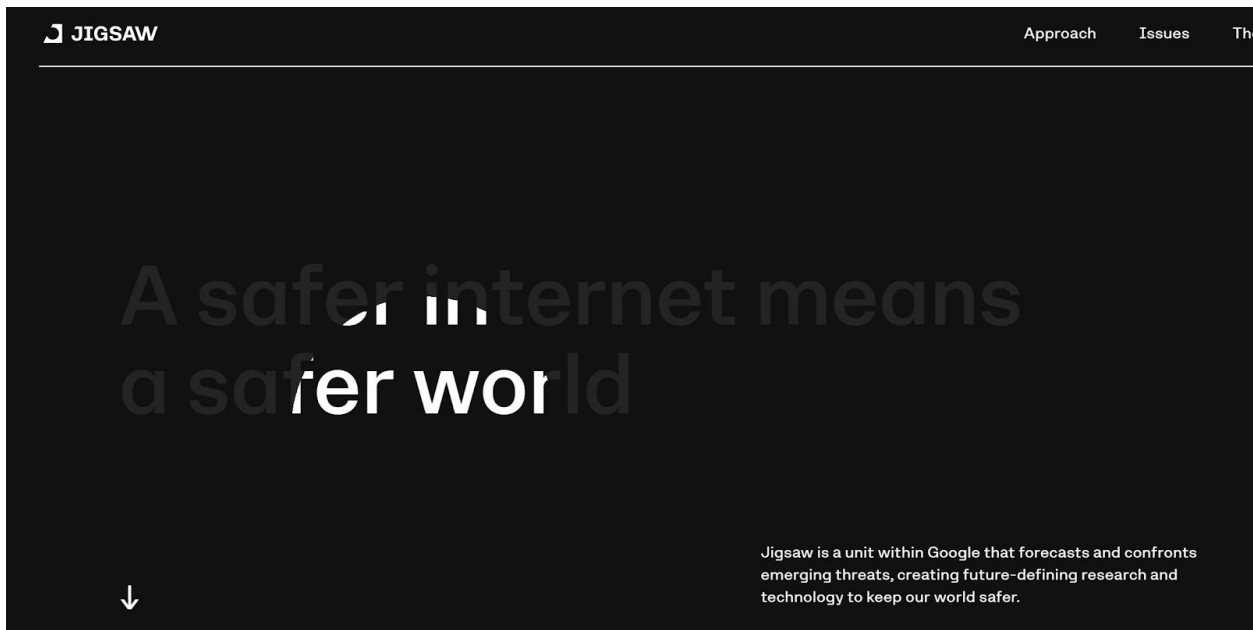
Class 42: design and development of operating software for computer networks and servers none of the foregoing for online virtual classrooms; design and maintenance of operating software used to access and use cloud computing networks none of the foregoing for online virtual classrooms; rental of operating software used to access

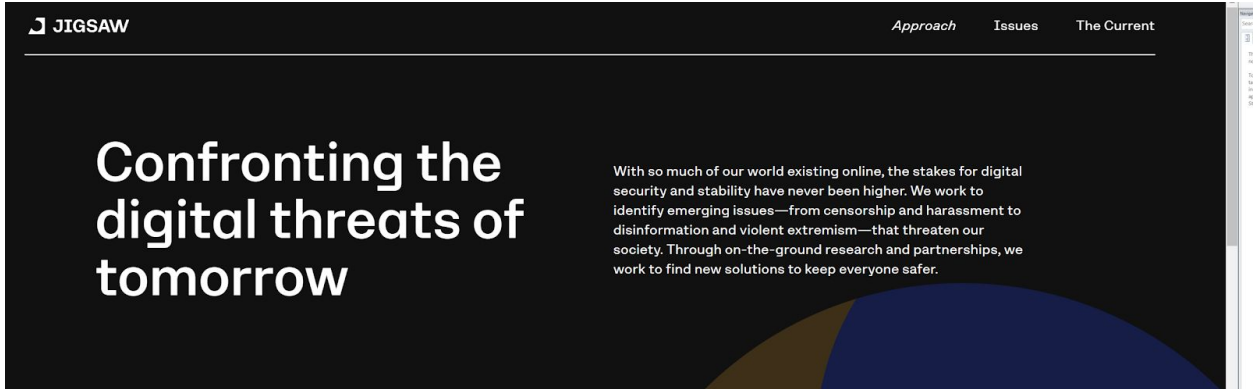
and use cloud computing networks none of the foregoing for online virtual classrooms; providing temporary use of online non-downloadable computer software for remote monitoring of computer network, computer servers and computer software none of the foregoing for online virtual classrooms; providing temporary use of online non-downloadable computer software for remote management of computer network, computer servers and computer software none of the foregoing for online virtual classrooms; providing temporary use of online non-downloadable computer software for managing vending machine inventory none of the foregoing for online virtual classrooms; providing temporary use of online non-downloadable computer software used to remotely monitor of computer servers to ensure proper functioning none of the foregoing for online virtual classrooms; providing temporary use of online non-downloadable computer software to monitoring the condition of luggage for quality control none of the foregoing for online virtual classrooms; providing temporary use of online non-downloadable computer software for remote monitoring of computer systems to ensure proper functioning none of the foregoing for online virtual classrooms; providing temporary use of online non-downloadable computer software for remote monitoring of operational computer data to ensure proper functioning of computer network, computer servers and computer software none of the foregoing for online virtual classrooms; providing temporary use of online non-downloadable computer operating software for computer network and computer server systems none of the foregoing for online virtual classrooms; providing temporary use of online non-downloadable computer operating software to manage and control computer systems none of the foregoing for online virtual classrooms; providing temporary use of online non-downloadable operating computer software for accessing and using cloud computing networks none of the foregoing for online virtual classrooms; providing temporary use of online non-downloadable computer software for monitoring computer network and computer servers none of the foregoing for online virtual classrooms

As shown above, the software goods and services identified in the Cited Application are entirely distinct in function and purpose from Applicant's Class 42 Services. Instead of providing software or websites to address how technology can impact international, political, social, and governmental issues, the software goods and services in the Cited Application are designed to allow for remote monitoring and management of computer systems, vending machine inventory, and luggage quality control, to ensure proper functioning of computer systems, and to allow for access to and use of cloud networks. Further, the remaining goods and services in Classes 9 and 42 of the Cited Application are even more different and distinct from Applicant's Services and encompass communication equipment such as portable radio machines, remote monitoring and navigation equipment, remote control hardware, and telecommunication equipment, circuits and semi-conductors, lenses, batteries, electronic publications in the field of remote monitoring and functioning of electronic equipment, and remote computer monitoring system services, computer and operating software consulting and design services, server storage rental services, and cloud storage and computing services – goods and services that are neither identified nor contemplated by Applicant's Application.

Similarly, Applicant's Class 35 services are entirely unrelated to the Class 35 Services in the Cited Application. Applicant's Class 35 services promote research and public awareness in the field of technology for the purpose of addressing international, political, government, and social issues. By contrast, the Cited Class 35 services involve business management of facilities used for housing and operation of computer systems, management of computerized files, business management and consultancy relating thereto, systemization and editing of information in computer servers connected to the Internet, price comparison services, advertising and publicity services; business management analysis, marketing research and analysis, and providing information concerning commercial sales. Thus, not only are Applicant's Class 35 Services and the Cited Class 35 services wholly different kinds of services with no overlap, but they also serve very different purposes (public research awareness vs. private commercialization).

The realities of Applicant's Services and the Cited Goods and Services further support this conclusion. Applicant uses its JIGSAW marks in connection with services designed to forecast and confront emerging technological threats that could destabilize the internet and, consequently, core underpinning of civil society, such as coordinated disinformation campaigns, online censorship, and online harassment. See **Exhibit B** (<https://jigsaw.google.com/>). Applicant's Services under the JIGSAW marks are aimed at developing cutting-edge research and technology to counter such threats. See *id.*





The owner of the Cited Mark, on the other hand, appears to be using the Cited Mark as a business name in connection with A&A (Auto Sensing x Auto Control) services, internet of things data control services, E2E (end to end) automated data control services including big data, cloud, servers, networking, apps, platforms, security software, internet of things devices, communications modules, devices, equipment, cells, living organisms, etc., as well as secure data control and bidirectional control services in mobile edge computing infrastructure, research and development of automated driving software and next-generate, real-time operating systems and modules, direct control of cells and living organisms through software, and finally, automation, decentralization, and sharing in all industries based on operation technology for business systems. See **Exhibit C** (<https://www.jig-saw.com/en/company-en/>).



Indeed, the owner of the Cited Mark confirmed in its August 19, 2020 Response to Office Action that the nature of its business is accurately summarized on its website. See **Exhibit D** (copy of response filed 8/19/20). The owner of the Cited Mark further clarified that “Applicant clearly seeks high-tech, cutting edge customers to purchase its sophisticated goods and services.” Accordingly, this fact also weighs against a finding of likelihood of confusion. See *Electronic Design & Sales Inc.*, 954 F.2d 713, 21 U.S.P.Q. 2d 1388, 1392 (“...sophistication is important and often dispositive because sophisticated end-users may be expected to exercise greater care”).

Consequently, Applicant’s Services and the Cited Goods and Services are entirely distinct, non-overlapping, non-fungible, non-competitive, and are designed for different functions and purposes. In such situations where the parties’ goods and services are distinct and non-competitive, the Trademark Trial and Appeal Board has concluded that confusion is highly unlikely and indeed, no more than speculative. See *All. Tech. Servs., Inc. v. All. Machine Sys. Int’l., Inc.*, No. 76381608, 2006 WL 2558023, at *14 (T.T.A.B. Aug. 16, 2006) (stating that “Based on the record before us, we see opposer’s likelihood of confusion claim as amounting to only a speculative, theoretical possibility” and finding that opposer had not proven its Section 2(d) claim of likelihood of confusion where Opposer’s goods and services and applicant’s goods were specifically different and non-competitive). Consequently, this factor weighs heavily and decisively in favor of Applicant. See *Kellogg Co. v. Pack ‘em Enterprises Inc.*, 951 F.2d 330, 21 U.S.P.Q. 2d 1142 (Fed. Cir. 1991) (any single factor may play a dominant role in a likelihood of confusion analysis).

Finally, the unrelated nature of Applicant’s Services and the Cited Goods and Services is confirmed by the fact that Applicant’s prior Registration No. 5566341 for the mark



, covering services identical to Applicant’s Services, and which predates the Cited Application, was not cited against the Cited Application as a bar to its registration under Section 2(d).² Thus, there is no evidence to show that Applicant’s Services and the Cited Goods and Services are related in any way or that consumers will make a connection between these goods and services. On the contrary, the identifications of goods and services themselves indicate that Applicant’s Services and the Cited Goods and Services are distinct, non-competitive and non-fungible, and thus sufficiently distinguishable to avert any likelihood of confusion. See *Dynamics Research Corp. v. Langenau Mfg. Co.*, 704 F.2d 1575 (Fed. Cir. 1983) (affirming the conclusion that because the marks are used on goods that are quite different and sold to different, discriminating

² Applicant notes that the Cited Application has been refused registration based on a likelihood of confusion with U.S. Registration Nos. 4571906 and 5029916. However, Applicant’s U.S. Registration No. 5566341 was not cited in the Office Action Refusal issued February 19, 2020.

customers, there is no likelihood of confusion even though both parties used the identical mark DRC). Prior practice of the U.S. Patent and Trademark Office (“PTO”) also confirms that there is no likelihood of confusion based on such goods and services. For the foregoing reasons, Applicant’s Mark and the Cited Mark are not confusingly similar and will not present a likelihood of confusion. Thus, Applicant’s Mark and the Cited Mark should be allowed to coexist peacefully on the Principal Register along with the numerous other JIGSAW-formative marks, as discussed below.

c) Applicant’s Mark Should Be Allowed to Peacefully Coexist With Other Third-Party “JIGSAW” Registrations and Approved Applications

The fact that the Cited Mark and Applicant’s Mark share the same or similar wording does not mandate a finding of a likelihood of confusion. See, e.g., *King Athletic Goods Corporation v. C. Itoh & Co. (America) Inc.*, 192 U.S.P.Q. 661 (TTAB 1976); *Application of Ferrero*, 479 F.2d 1395 (C.C.P.A. 1973). As shown by the examples in the chart below, in addition to Applicant’s prior registration for J JIGSAW (& Design), there are numerous registrations or approved applications comprised of or including the term JIGSAW in connection with Class 9 goods and/or Class 42 services, which coexist peacefully on the Register and, presumably, in the marketplace.

| Reg. No. / App. No. | Mark | Goods and Services | Owner |
|--------------------------------|--|--|---------------------|
| 88914599 (Approved 8/12/20) | JIGSAW | Class 9: Downloadable software in the nature of applications for social media, social networking, social introduction, and dating; Class 42: Providing temporary use of non-downloadable software for social networking, social introduction, and dating services; and Class 45: Dating services; internet-based social networking, social introduction, and dating services | JigTalk App Limited |
| 6010905 | JIGSAW INTERACTIVE Disclaimer: INTERACTIVE | Class 9: Providing a web hosting platform for online virtual classrooms | Jigsaw Meeting, LLC |
| 5866119 | JIGSAW FAMILIES | Class 9: Software for use in lesson plans for teachers in the field of physical, social, and emotional health of children; downloadable computer game programs; downloadable educational materials in the form of lesson plans for teachers in the field of physical, social, and emotional health of children; downloadable music files; downloadable video game programs; downloadable musical sound recordings; all in the fields of personal, | JIGSAW PSHE LTD |

| | | | |
|---------|--------------------------------------|---|--|
| | | <p>emotional skills, spiritual, social skills, health and economic education and development of children;</p> <p>Class 15: Musical instruments, namely, musical chimes;</p> <p>Class 16: Printed publications, namely, newsletters containing teaching, instructional and educational materials in the fields of personal, emotional skills, spiritual, social skills, health and economic education and development of children; and</p> <p>Class 28: Toys, games and playthings, namely, stuffed toys</p> | |
| 5916908 | JIGSAW JOURNEY Disclaimer: JIGSAW | <p>Class 9: Computer game software downloadable from a global computer network; Downloadable game software; Downloadable gaming software that generates or displays wager outcomes of gaming machines; Downloadable computer game software; Downloadable computer game software for personal computers and home video game consoles; Downloadable computer game software for use on mobile and cellular phones; Downloadable computer game software via a global computer network and wireless devices; Downloadable computer software and firmware for playing games of chance on any computerized platform, including dedicated gaming consoles, video based slot machines, reel based slot machines, and video lottery terminals; Downloadable computer software, namely, game engine software for video game development and operation; Downloadable electronic game software; Downloadable electronic game software for cellular telephones; Downloadable electronic game software for handheld electronic devices; Downloadable electronic game software for wireless devices; Downloadable interactive game software; Downloadable video game software; Downloadable virtual reality game software; Recorded game software; Recorded computer game software; Recorded computer gaming software for recreational game playing purposes; Recorded video game software</p> | Shenzhen QiXunXinYou Technology Co., Ltd |
| 4662453 | JIGSAW INFORMATICS | <p>Class 9: Computer application software for mobile devices that enables creating, uploading, scanning, sending and/or sharing</p> | Jigsaw Informatics, Inc. |

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|--|----------------------------|--|--|
| | Disclaimer: INFORMATICS | digital content by the end user; digital photo frames that include a video display and electronics required to download, store and playback video with audio; digital photo frame that consists of electronics required to download and playback audio; computer peripherals, namely, accessory devices for illumination for smartphones and tablets for use in taking pictures; and Class 16: Greeting cards; Invitation cards; Postcards; Memory books | |
|--|----------------------------|--|--|

See **Exhibit E** for copies of registrations and/or TSDR status records for the referenced above.

Given the widespread coexistence of JIGSAW-formative marks, the differences in the goods and services associated with Applicant’s Mark and the Cited Mark, as discussed above, are sufficient to distinguish Applicant’s Mark and the Cited Mark in the eyes of consumers. Because Applicant’s Mark differs from the Cited Mark more significantly than several of the other coexisting JIGSAW-formative registrations above differ from each other, both in terms of commercial impression and related goods and services, Applicant submits that confusion is not likely.

d) In the Alternative, And To The Extent that Applicant’s Mark and the Cited Mark Are Considered Confusingly Similar, the Cited Mark Should Be Blocked by Applicant’s Prior Registration

In the alternative, Applicant posits that to the extent that the Examining Attorney maintains that there is a likelihood of confusion between Applicant’s Mark and the Cited Mark, and that their respective goods and services are related, consistency of PTO practice dictates that the Cited Application should be blocked by Applicant’s prior Registration No. 5566341 for the mark



, which predates the Cited Application. As discussed above, the mark identified in Applicant’s prior registration shares its dominant element – the word JIGSAW – with Applicant’s Mark and covers identical services in Classes 35 and 42. Accordingly, to the extent that Applicant’s Mark is considered confusingly similar to the Cited Mark, the Cited Mark should similarly be considered confusingly similar to Applicant’s J JIGSAW (& Design) mark and refused registration based thereon.

CONCLUSION

Because Applicant has acquired prior rights to the JIGSAW mark based on its earlier use in commerce and prior registration of the J JIGSAW (& Design) mark in connection with services in

Classes 35 and 42 that are identical to those identified in Applicant's Application, which predate the filing date of the Cited Application, because the differences in the associated goods and services are sufficient to distinguish Applicant's Mark from the Cited Mark, and because there are numerous JIGSAW-formative marks coexisting on the Principal Register, Applicant respectfully requests that the Examining Attorney withdraw the potential Section 2(d) refusal based on the Cited Mark, lift the suspension of Applicant's Application, and allow Applicant's Application No. 88869859 to proceed toward registration on the Principal Register.

Respectfully submitted,

Dated: October 19, 2020

By: Monique E. Liburd