

## Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
<b>SERIAL NUMBER</b>	86080705
<b>LAW OFFICE ASSIGNED</b>	LAW OFFICE 106
<b>MARK SECTION (no change)</b>	
<b>ARGUMENT(S)</b>	
<p>The Examining Attorney has maintained the 2(d) refusal of Applicant's Virtuoso and Design application based upon a citation to two registered VIRTUOSO marks (the Cited Marks). For the reasons set forth below, and those included in Applicant's previous response, the Applicant's Mark is unlikely to be confused with the Cited Marks. Furthermore, with this response, Applicant has amended its application to further narrow and specify its field of use. As such, in light of the differences between and among the Marks, and Applicant's narrowed description of goods, Applicant respectfully requests that the Examining Attorney reconsider the refusal to register.</p> <p style="text-align: center;"><b>I. Applicant's Goods are Specialized and Distinct from the Registrants' Goods and Services</b></p> <p>In the final refusal, the Examining Attorney notes that Applicant made no limitation in its description of services and, therefore, the marks were presumed to travel in the same channels of trade and be targeted to the same classes of purchases. However, with this response, applicant amends its description of goods as set forth below:</p> <p>Computer appliance, namely computer hardware and software for data backup <b>for use in the field of enterprise information technology</b>; computer software for data deduplication, data storage and data replication <b>for use in the field of enterprise information technology</b></p> <p>This limitation limits and defines Applicant's field of use and further distinguishes Applicant's mark from the Cited Marks. Specifically, Applicant's Mark is directed to the information technology market, whereas the Cited Marks are limited to the fields of financial services and planning, business planning,</p>	

education collaboration, social networking, mentoring (for registration number 3380179) and the field of medical pathology (for registration number 4042479). These fields are so specialized and distinct that the likely purchasers of Applicant's goods (IT professionals) do not overlap with the likely purchases of the Registrants' goods and services (finance and medical professionals).

## **II. The Stylization of Applicant's Mark is Sufficiently Distinct to Create a Different Impression Than the Cited Marks**

The Examining Attorney notes that the design elements of Applicant's Mark are "merely a semi-circle around the second 'O.'" This diminishes the importance of Applicant's highly stylized font and intentional capitalization of the letters SO in the its Virtuoso Mark. This stylization creates a different impression than the Cited Marks, which consist merely of standard characters. Indeed, the letters SO are emphasized in the mark precisely because these letters mean something to Applicant's consumers – SO is an abbreviation for "Scale-Out," a term that is suggestive of Applicant's enterprise-specific computer goods. By ignoring the important differences that distinguish Applicant's Mark from the Cited Marks, the Examining Attorney fails to consider the marks in their entirety.

## **III. The Third Party Registrations Cited by Applicant and the Coexistence of the Cited Marks Themselves Weigh Against a Finding of Likely Confusion**

In the final refusal, the Examining Attorney also notes that the third party VIRTUOSO registrations cited by Applicant in its prior response are not entitled to much weight. However, Applicant has referenced these marks not simply to show that the term VIRTUOSO is weak, but also to show that coexistence of marks using the term VIRTUOSO is quite common and therefore, consumers encounter numerous brand names using the term VIRTUOSO. As such, consumers are likely to be able to differentiate between these various uses easily, as long as there are at least minor differences in the marks, the goods/services, or the context in which each is encountered. This widespread use, combined with the highly stylized elements of Applicant's mark and the differences in the fields of use, make confusion unlikely. Applicant recognizes that this coexistence of third party marks are not conclusive on the question of the registrability of its Mark, but they are at least of substantial persuasive value.

For example, in *In re Broadway Chicken Inc.*, 38 U.S.P.Q.2d 1559 (TTAB 1996), the applicant sought to register the mark BROADWAY CHICKEN for "restaurant services." The Examining Attorney refused registration based on likelihood of confusion with the registered marks BROADWAY PIZZA

for "restaurant services" and BROADWAY BAR & PIZZA for "restaurant and bar services." *Id.* at 1560. In reversing the refusal to register, the TTAB emphasized that "[e]vidence of widespread third-party use of marks containing a shared term is competent to suggest that purchasers have been conditioned to look to the other elements of the marks as a means of distinguishing the source of goods or services in the field." *Id.* at 1565-66.

Indeed, the two cited marks are owned by different registrants, yet they coexist on the register and in the marketplace without confusion. This coexistence weighs in favor of a finding that there is no likelihood of confusion between Applicant's Mark and the Cited Marks, just as there is no confusion between the two Cited Marks themselves.

For the reasons set forth above, and in Applicant's prior response, there is no likelihood of confusion between Applicant's Mark and the Cited Marks. As such, Applicant respectfully requests that the Examining Attorney withdraw the refusal and allow the application to proceed to registration.

**GOODS AND/OR SERVICES SECTION (current)**

INTERNATIONAL CLASS	009
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**DESCRIPTION**

Computer appliance, namely computer hardware and software for data backup; computer software for data deduplication, data storage and data replication

FILING BASIS	Section 1(b)
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**GOODS AND/OR SERVICES SECTION (proposed)**

INTERNATIONAL CLASS	009
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**TRACKED TEXT DESCRIPTION**

~~Computer appliance, namely computer hardware and software for data backup;~~ Computer appliance, namely computer hardware and software for data backup for use in the field of enterprise information technology; ~~computer software for data deduplication, data storage and data replication;~~ computer software for data deduplication, data storage and data replication for use in the field of enterprise information technology

**FINAL DESCRIPTION**

Computer appliance, namely computer hardware and software for data backup for use in the field of enterprise information technology; computer software for data deduplication, data storage and data replication for use in the field of enterprise information technology

FILING BASIS	Section 1(b)
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<b>SIGNATURE SECTION</b>	
<b>RESPONSE SIGNATURE</b>	/Sara Beccia/
<b>SIGNATORY'S NAME</b>	Sara Beccia
<b>SIGNATORY'S POSITION</b>	Attorney for Applicant, Massachusetts bar member
<b>SIGNATORY'S PHONE NUMBER</b>	617-345-3648
<b>DATE SIGNED</b>	02/06/2015
<b>AUTHORIZED SIGNATORY</b>	YES
<b>CONCURRENT APPEAL NOTICE FILED</b>	YES
<b>FILING INFORMATION SECTION</b>	
<b>SUBMIT DATE</b>	Fri Feb 06 15:52:11 EST 2015
<b>TEAS STAMP</b>	USPTO/RFR-216.200.160.206 -20150206155211210719-860 80705-5306de99351e8f26ddb d3f1acabc1f4f9d7c054923e9 e5a5fe207eaf4f31329c1-N/A -N/A-20150206154554203159

**Request for Reconsideration after Final Action  
To the Commissioner for Trademarks:**

Application serial no. **86080705** has been amended as follows:

**ARGUMENT(S)**

**In response to the substantive refusal(s), please note the following:**

The Examining Attorney has maintained the 2(d) refusal of Applicant's VirtuoSO and Design application based upon a citation to two registered VIRTUOSO marks (the Cited Marks). For the reasons set forth below, and those included in Applicant's previous response, the Applicant's Mark is unlikely to be confused with the Cited Marks. Furthermore, with this response, Applicant has amended its application to further narrow and specify its field of use. As such, in light of the differences between and among the Marks, and Applicant's narrowed description of goods, Applicant respectfully requests that the

Examining Attorney reconsider the refusal to register.

### **I. Applicant's Goods are Specialized and Distinct from the Registrants' Goods and Services**

In the final refusal, the Examining Attorney notes that Applicant made no limitation in its description of services and, therefore, the marks were presumed to travel in the same channels of trade and be targeted to the same classes of purchases. However, with this response, applicant amends its description of goods as set forth below:

Computer appliance, namely computer hardware and software for data backup **for use in the field of enterprise information technology**; computer software for data deduplication, data storage and data replication **for use in the field of enterprise information technology**

This limitation limits and defines Applicant's field of use and further distinguishes Applicant's mark from the Cited Marks. Specifically, Applicant's Mark is directed to the information technology market, whereas the Cited Marks are limited to the fields of financial services and planning, business planning, education collaboration, social networking, mentoring (for registration number 3380179) and the field of medical pathology (for registration number 4042479). These fields are so specialized and distinct that the likely purchasers of Applicant's goods (IT professionals) do not overlap with the likely purchases of the Registrants' goods and services (finance and medical professionals).

### **II. The Stylization of Applicant's Mark is Sufficiently Distinct to Create a Different Impression Than the Cited Marks**

The Examining Attorney notes that the design elements of Applicant's Mark are "merely a semi-circle around the second 'O.'" This diminishes the importance of Applicant's highly stylized font and intentional capitalization of the letters SO in the its VirtuoSO Mark. This stylization creates a different impression than the Cited Marks, which consist merely of standard characters. Indeed, the letters SO are emphasized in the mark precisely because these letters mean something to Applicant's consumers – SO is an abbreviation for "Scale-Out," a term that is suggestive of Applicant's enterprise-specific computer goods. By ignoring the important differences that distinguish Applicant's Mark from the Cited Marks, the Examining Attorney fails to consider the marks in their entirety.

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For the reasons set forth above, and in Applicant's prior response, there is no likelihood of confusion between Applicant's Mark and the Cited Marks. As such, Applicant respectfully requests that the Examining Attorney withdraw the refusal and allow the application to proceed to registration.

#### **CLASSIFICATION AND LISTING OF GOODS/SERVICES**

**Applicant proposes to amend the following class of goods/services in the application:**

**Current:** Class 009 for Computer appliance, namely computer hardware and software for data backup;

computer software for data deduplication, data storage and data replication

Original Filing Basis:

**Filing Basis: Section 1(b), Intent to Use:** The applicant has had a bona fide intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the identified goods and/or services as of the filing date of the application. (15 U.S.C. Section 1051(b)).

**Proposed:**

**Tracked Text Description:** ~~Computer appliance, namely computer hardware and software for data backup~~; Computer appliance, namely computer hardware and software for data backup for use in the field of enterprise information technology; ~~computer software for data deduplication, data storage and data replication~~; computer software for data deduplication, data storage and data replication for use in the field of enterprise information technology

Class 009 for Computer appliance, namely computer hardware and software for data backup for use in the field of enterprise information technology; computer software for data deduplication, data storage and data replication for use in the field of enterprise information technology

**Filing Basis: Section 1(b), Intent to Use:** The applicant has a bona fide intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the identified goods and/or services as of the filing date of the application. (15 U.S.C. Section 1051(b)).

**SIGNATURE(S)**

**Request for Reconsideration Signature**

Signature: /Sara Beccia/ Date: 02/06/2015

Signatory's Name: Sara Beccia

Signatory's Position: Attorney for Applicant, Massachusetts bar member

Signatory's Phone Number: 617-345-3648

The signatory has confirmed that he/she is an attorney who is a member in good standing of the bar of the highest court of a U.S. state, which includes the District of Columbia, Puerto Rico, and other federal territories and possessions; and he/she is currently the applicant's attorney or an associate thereof; and to the best of his/her knowledge, if prior to his/her appointment another U.S. attorney or a Canadian attorney/agent not currently associated with his/her company/firm previously represented the applicant in this matter: (1) the applicant has filed or is concurrently filing a signed revocation of or substitute power of attorney with the USPTO; (2) the USPTO has granted the request of the prior representative to withdraw; (3) the applicant has filed a power of attorney appointing him/her in this matter; or (4) the applicant's appointed U.S. attorney or Canadian attorney/agent has filed a power of attorney appointing him/her as an associate attorney in this matter.

The applicant is filing a Notice of Appeal in conjunction with this Request for Reconsideration.

Serial Number: 86080705

Internet Transmission Date: Fri Feb 06 15:52:11 EST 2015

TEAS Stamp: USPTO/RFR-216.200.160.206-20150206155211

210719-86080705-5306de99351e8f26ddb3f1a

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1-N/A-N/A-20150206154554203159