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Subject: U.S. TRADEMARK APPLICATION NO. 86191213 - DATA ATOM - N/A - Request for Reconsideration Denied - Return to TTAB

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**UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)  
OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION**

**U.S. APPLICATION SERIAL NO.** 86191213

**MARK:** DATA ATOM



**CORRESPONDENT ADDRESS:**

CLOUD CROWDING CORP.

Parnas St 4/2

Jerusalem, 93879 ISRAEL

**GENERAL TRADEMARK INFORMATION:**

<http://www.uspto.gov/trademarks/index.jsp>

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**APPLICANT:** Cloud Crowding Corp.

**CORRESPONDENT'S REFERENCE/DOCKET NO:**

N/A

**CORRESPONDENT E-MAIL ADDRESS:**

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**REQUEST FOR RECONSIDERATION DENIED**

**ISSUE/MAILING DATE:** 10/3/2016

The trademark examining attorney has carefully reviewed applicant's request for reconsideration and is denying the request for the reasons stated below. See 37 C.F.R. §2.63(b)(3); TMEP §§715.03(a)(ii)(B), 715.04(a). The following requirement(s) and/or refusal(s) made final in the Office action dated March 15, 2016 are maintained and continue to be final: Section 2(d) Likelihood of Confusion. See TMEP §§715.03(a)(ii)(B), 715.04(a).

In the present case, applicant's request has not resolved all the outstanding issue(s), nor does it raise a new issue or provide any new or compelling evidence with regard to the outstanding issue(s) in the final Office action. In addition, applicant's analysis and arguments are not persuasive nor do they shed new light on the issues. Specifically, the applicant has merely repeated their arguments in the previous responses.

The Court of Appeals for the Federal Circuit and the Trademark Trial and Appeal Board have recognized that marks deemed "weak" or merely descriptive are still entitled to protection against the registration by a subsequent user of a similar mark for closely related goods and/or services. TMEP §1207.01(b)(ix); see *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 1401, 182 USPQ 108, 109 (C.C.P.A. 1974) (likelihood of confusion is "to be avoided, as much between 'weak' marks as between 'strong' marks, or as between a 'weak' and 'strong mark'"); *In re Colonial Stores, Inc.*, 216 USPQ 793, 795 (TTAB 1982) ("even weak marks are entitled to protection against registration of similar marks"). This protection extends to marks registered on the Supplemental Register. TMEP §1207.01(b)(ix); see, e.g., *In re Clorox Co.*, 578 F.2d 305, 307-08, 198 USPQ 337, 340 (C.C.P.A. 1978); *In re Hunke & Jochheim*, 185 USPQ 188, 189 (TTAB 1975).

The applicant cited TMEP § 1207.01(b)(ix), but omitted a significant portion in their quotation. The completed section appears below:

#### **1207.01(b)(ix) Weak or Descriptive Marks**

The Court of Appeals for the Federal Circuit and the Trademark Trial and Appeal Board have recognized that merely descriptive and weak designations may be entitled to a narrower scope of protection than an entirely arbitrary or coined word. See *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 1338-39, 115 USPQ2d 1671, 1674 (Fed. Cir. 2015); *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772*, 396 F.3d 1369, 1373, 73 USPQ2d 1689, 1693 (Fed. Cir. 2005); *Giersch v. Scripps Networks, Inc.*, 90 USPQ2d 1020, 1026 (TTAB 2009); *In re Box Solutions Corp.*, 79 USPQ2d 1953, 1957-58 (TTAB 2006); *In re Cent. Soya Co.*, 220 USPQ 914, 916 (TTAB 1984). However, even a weak mark is entitled to protection against the registration of a similar mark for closely related goods or services. See *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 1401 182 USPQ 108, 109 (C.C.P.A. 1974).

With respect to marks registered on the **Supplemental Register**, the Board stated the following in *In re Hunke & Jochheim*:

[R]egistration on the **Supplemental Register** may be considered to establish prima facie that, at least at the time of registration, the registered mark possessed a merely descriptive significance. This is significant because it is well established that the scope of protection afforded a merely

descriptive or even a highly suggestive term is less than that accorded an arbitrary or coined mark. That is, terms falling within the former category have been generally categorized as "weak" marks, and the scope of protection extended to these marks has been limited to the substantially identical notation and/or to the subsequent use and registration thereof for substantially similar goods. 185 USPQ 188, 189 (TTAB 1975) (citation omitted).

However, even marks that are registered on the Supplemental Register may be cited under §2(d). *In re Clorox Co.*, 578 F.2d 305, 308-09, 198 USPQ 337, 341 (C.C.P.A. 1978).

The registrant's mark is not on the Supplemental Register. Hence one cannot presume that the mark was merely descriptive at the time of registration. By omitting the relevant portion regarding registration on the Supplemental Register, the applicant presumed that refusal would be "limited to the substantially identical notation and/or to the subsequent use and registration thereof for substantially similar goods." The registrant's mark was registered on November 10, 2015. The applicant's dictionary definition on page 8 indicates that the dictionary was last updated on April 2009, the article on page 9 was written December 20, 2007, the Business Dictionary has a copyright of 2015, the Wikipedia Article was last modified on July 16, 2014, and the Carnegie Mellon page was November 28, 1995. Since all this information was viewable before or at the time of registration and the registrant's mark does not describe an ingredient, quality, characteristic, function, feature, purpose, or use of an applicant's goods and/or services, then one can presume that the registrant's mark is not descriptive of the registrant's services and it is not a weak mark.

The applicant has merely transposed the registrant's mark with wording that has the same commercial impression as that of the registrant's mark. Confusion is likely between two marks consisting of reverse combinations of the same elements if they convey the same meaning or create substantially similar commercial impressions. TMEP §1207.01(b)(vii); *see, e.g., In re Wine Soc'y of Am. Inc.*, 12 USPQ2d 1139, 1142 (TTAB 1989) (holding THE WINE SOCIETY OF AMERICA and design, for "wine club membership services including the supplying of printed materials, sale of wines to members, conducting wine tasting sessions and recommending specific restaurants offering wines sold by applicant," likely to be confused with AMERICAN WINE SOCIETY 1967 and design, for a newsletter, bulletin and journal of interest to members of the registrant); *In re Nationwide Indus. Inc.*, 6 USPQ2d 1882, 1884 (TTAB 1988) (holding RUST BUSTER, with "RUST" disclaimed, for a rust-penetrating spray lubricant likely to be confused with BUST RUST for a penetrating oil).

The applicant has also not disputed the relatedness of the registrant's and applicant's services. In this case, the identifications set forth in the application and registration are identical or highly related and have no restrictions as to nature, type, channels of trade, or classes of purchasers. Therefore, it is

presumed that these goods and/or services travel in all normal channels of trade, and are available to the same class of purchasers. See *Midwestern Pet Foods, Inc. v. Societe des Produits Nestle S.A.*, 685 F.3d 1046, 1053, 103 USPQ2d 1435, 1440 (Fed. Cir. 2012). For example the registrant provides “information technology consulting services and information technology support services, namely, technical oversight and administration of computer systems and software for others and troubleshooting in the nature of diagnosing and resolving computer systems and software problems” while the applicant provides the highly similar “Consulting services in the field of cloud computing and Technical support services, namely, remote and on-site infrastructure management services for monitoring, administration and management of public and private cloud computing IT and application systems.” In other words, both the applicant and registrant provide IT consulting. Accordingly, the services of applicant and the registrant(s) are considered related for purposes of the likelihood of confusion analysis.

The overriding concern is not only to prevent buyer confusion as to the source of the goods and/or services, but to protect the registrant from adverse commercial impact due to use of a similar mark by a newcomer. See *In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993). Therefore, any doubt regarding a likelihood of confusion determination is resolved in favor of the registrant. TMEP §1207.01(d)(i); see *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1265, 62 USPQ2d 1001, 1003 (Fed. Cir. 2002); *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 464-65, 6 USPQ2d 1025, 1026 (Fed. Cir. 1988).

Accordingly, the request is denied.

If applicant has already filed a timely notice of appeal with the Trademark Trial and Appeal Board, the Board will be notified to resume the appeal. See TMEP §715.04(a).

If no appeal has been filed and time remains in the six-month response period to the final Office action, applicant has the remainder of the response period to (1) comply with and/or overcome any outstanding final requirement(s) and/or refusal(s), and/or (2) file a notice of appeal to the Board. TMEP §715.03(a)(ii)(B); see 37 C.F.R. §2.63(b)(1)-(3). The filing of a request for reconsideration does not stay or extend the time for filing an appeal. 37 C.F.R. §2.63(b)(3); see TMEP §§715.03, 715.03(a)(ii)(B), (c).

/R.M. Herrera/

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