

ESTTA Tracking number: **ESTTA829324**

Filing date: **06/26/2017**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	86934136
Applicant	Big Data Experts, LLC
Applied for Mark	ONETECHNOLOGY
Correspondence Address	BRIAN J HUNDERTMARK GARSON CLAXTON LLC 7910 WOODMONT AVENUE, SUITE 650 BETHESDA, MD 20814 UNITED STATES Email: bhundertmark@garsonlaw.com
Submission	Reply Brief
Attachments	Applicant Reply Brief.pdf(167889 bytes)
Filer's Name	Brian J. Hundertmark
Filer's email	bhundertmark@garsonlaw.com
Signature	/Brian J. Hundertmark/
Date	06/26/2017

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In re: Big Data Experts, LLC
Application Serial Number: 86934136
Application Filing Date: March 9, 2016
Mark: ONETECHNOLOGY

APPLICANT'S REPLY BRIEF

Applicant, Big Data Experts, LLC, hereby replies to the Examining Attorney's Appeal Brief filed on June 5, 2017. Applicant continues to rely on the arguments advanced in its Appeal Brief, but wishes to address certain arguments raised by the Examining Attorney.

Marks

The Examining Attorney's Appeal Brief notes the similarities of the Applicant's mark and the Registrant's mark and then issues the conclusory statement that "because both of the marks share identical and near identical terms, and are similar in sound and in appearance, they create the same overall commercial impression". However, the Examining Attorney does not provide any support for his determination that, because of the similarities, the two marks necessarily create the same overall commercial impression. Indeed, the Examining Attorney's unsupported statement fails the very test that he sets forth in the next sentence of his Brief: "the test . . . is whether the marks are sufficiently similar in terms of their overall commercial impression that confusion as to the source of the goods and/or services offered under the respective marks is likely to result". Applicant has provided information and arguments demonstrating that no confusion as to the source of the services is likely to result; in contrast, the

Examining Attorney has offered no support for his conclusory statement. This is understandable because it is clear that no confusion is likely to occur.

Services

In addressing the services offered under the respective marks, the Examining Attorney's Appeal Brief reiterates from the Marks section of his Brief the need to address whether any confusion as to the source of the services is likely to result. Here, the Examining Attorney cites to five registrations (of differing marks) that include both website maintenance services and platform as a service (PaaS) services. However, again, the Examining Attorney fails to connect any dots: he fails to take the necessary step of demonstrating that any possible similarity between the services leads to a finding that confusion as to the source of the services is likely to result. Rather, he merely assumes that any possible similarity of services necessarily results in confusion.¹ In contrast, the Applicant's Appeal Brief provides information and arguments related to the differing trade channels, sophisticated nature of purchasing, family mark status, and extent of potential confusion that demonstrate that no confusion as to the source of services is likely to result.

Sophisticated Purchasing

The sophisticated nature of the purchasing of Applicant's and Registrant's services should be determinative of this matter. As fully set forth in the Applicant's Appeal Brief, the sophistication and knowledge of Registrant's and Applicant's clients, including the conditions under which sales are made, demonstrates that the respective clients are very sophisticated and

¹ The Examining Attorney repeats the argument from his final refusal that the Registrant's identification of services "has no restrictions as to nature, type, channels of trade, or classes of purchasers". However, as noted in the Applicant's Appeal Brief, this argument is erroneous. Registrant's identification of services ("Design, creation, hosting and maintenance of internet sites for third parties") restricts the Registrant's "design, creation, hosting and maintenance" services to the "internet sites of third parties". Applicant's identification of services is likewise self-restricting: while the identification of services does not specify the class of purchasers, the only type of purchasers who would seek Applicant's services are the global, multi-billion dollar enterprises that have the technological resources to create their own applications for their specialized needs, to which Applicant markets its services.

knowledgeable in understanding the source of the services represented by the respective marks and are fully immune from source confusion.

The Examining Attorney's only response to the Applicant's argument is to repeat from his initial refusal his misreading of the Trademark Manual of Examining Procedure's statement that "the fact that purchasers are sophisticated or knowledgeable in a particular field does not necessarily mean that they are sophisticated or knowledgeable in the field of trademarks or immune from source confusion". As noted in the Applicant's Appeal Brief, the TMEP's "statement's use of 'does not necessarily mean' only states that sophisticated or knowledgeable purchasers may or may not be immune from source confusion, depending on the individual circumstances of a matter. The Examining Attorney, though, without providing any analysis other than the recitation of the TMEP statement, interprets 'does not necessarily mean that they are sophisticated' as 'means that they are not sophisticated'".

The Examining Attorney still has not provided any analysis other than the recitation of the TMEP statement.² Again, the individual circumstances in this matter are determinative of the likelihood of confusion issue.

Family Mark

The Applicant's Appeal Brief notes that Applicant's mark is part of a family of marks using the ONE prefix. The Examining Attorney's Brief correctly notes that a family of marks argument is not available to overcome a likelihood of confusion refusal before the Trademark Trial and Appeal Board. However, Applicant can use the existence of its family of marks as part of its proof of a lack of potential confusion. As fully set forth in the Appeal Brief, the trademarks, when taken together with their distinctive use of the common prefix ONE in upper

² The Examining Attorney also repeats his argument that the respective identifications of services have no restrictions on the class of purchasers. This argument was refuted in the Applicant's Appeal Brief and in footnote 1, above.

case letters and the following term in lower case letters, leads to recognition in clients and potential clients that the common characteristics are indicative of a common origin for the services, thereby minimizing any risk of potential confusion in the use of the ONEtechnology mark.

Extent of Potential Confusion

The Examining Attorney's Appeal Brief repeatedly refers to the need to address whether any confusion as to the source of the services of the respective marks is likely to result. However, other than stating its existence, the Examining Attorney does not address this important *Du Pont* factor and does not reply to the arguments and information provided in the Applicant's Appeal Brief. The Examining Attorney's reluctance to address this factor is understandable because it is clear that no confusion is likely to occur.

Conclusion

The Examining Attorney's Appeal Brief fails to address the all-important test of whether any confusion as to the sources of the Applicant's mark and the Registrant's mark is likely to result. In contrast, the Applicant's Appeal Brief sets forth strong evidence and arguments supporting the lack of any such confusion. As such, the refusal to register the Applicant's mark should be reversed and the application should proceed to publication.

Respectfully submitted,

Brian J. Hundertmark

Brian J. Hundertmark
Garson Law, LLC
7910 Woodmont Avenue, Suite 650
Bethesda, Maryland 20814
(301) 280-2700

Counsel for Applicant, Big Data Experts, LLC

June 26, 2017

CERTIFICATE OF SERVICE

I hereby certify that I caused a true copy of the foregoing Applicant's Reply Brief to be served by electronic mail, this 26th day of June, 2017, upon the PTO examiner: Sanjeev K. Vohra, sanjeev.vohra@uspto.gov.

Brian J. Hundertmark _____

Brian J. Hundertmark

Garson Law, LLC

7910 Woodmont Avenue, Suite 650

Bethesda, Maryland 20814

(301) 280-2700