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

Proceeding	87597189
Applicant	E8 Storage Systems Ltd.
Applied for Mark	E8 STORAGE
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Submission	Reply Brief
Attachments	E8 STORAGE Appeal Brief 87597189.pdf(414681 bytes) Exhibit A - applicant website E8 Storage.pdf(458752 bytes) Exhibit B Registrant of Cited Mark description of activity E8 Security.pdf(179046 bytes)
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Date	04/07/2019

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN THE MATTER OF:

Application for Registration of Mark: **E8 STORAGE**

Applicant: **E8 Storage Systems Ltd.**

Serial No.: **87597189**

Examiner: **Rhoda Nkojo, Examining Attorney; Law Office 117**

Atty. Dkt. No.: **T-13022-US**

APPEAL – APPLICANT REPLY BRIEF

The Applicant respectfully set forth herein its Reply Brief in response to the Examiner's denial of Applicant's request for reconsideration dated February 1, 2019 which was issued in connection with the above-identified application, refusing to register the mark "**E8 STORAGE**" based on Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), due to prior Registration No. 4681429 for the mark "**E8 SECURITY**".

Applicant requests that the refusal will be withdrawn for the following reasons:

- Applicant's mark "**E8 STORAGE**" differs in sound and appearance from the cited registration: "**E8 SECURITY**";
- To avoid any overlap with the goods and services of the cited Registration, the Applicant has amended the list of goods by explicitly **excluding Registrant's users and Registrant's goods**. The list of goods of **Applicant's mark** was amended to read:

Class 9: Computer software for **storage** of data and information; computer software that allows software modules in virtual containers to deliver processing of data; Rack-mounted computer **storage** devices, namely, high speed **storage** sub systems for high performance and high availability storage of electronic data either locally or via a telecommunications network; all the foregoing **NOT** intended for end-users and all the foregoing **EXCLUDING** computer software for use in monitoring and responding to computer **security** breaches; computer anti-virus software.

- Applicant provides **software for storage data**. The purchasers are highly **professional infrastructure designers** of the organizations' servers to form effective servers and storage platforms. Applicant's software is used in the back end of the **servers**. Furthermore, **the price of Applicant's software which amounts to US\$100,000** further supports a careful purchase process which negates likelihood of confusion.
- In **contrast** to Registrant's goods and services, **Applicant's products** are not exposed to end-users because its software is only attached to servers, providing the infrastructure software itself.

- Applicant's products are intended to solve very particular and sophisticated needs of a segment of complex networks such as **clusters** and **data centers**. The purchase process of such goods is careful and made by sophisticated and knowledgeable purchasers who buy the products with a clear understanding of the needs and requirements of the products and are aware of the full spectrum of the respective products' capabilities **and their source**, and hence confusion with the cited mark is not likely.
- Applicant products are **not** related to **Registrant's goods and services** that read:
 - Class 9:** Computer software for use in monitoring and responding to **computer security breaches**; computer **anti-virus** software.
 - Class 42:** Software as a service (SAAS) services featuring software for use in monitoring and responding to **computer security breaches**; computer **security** consultancy services.

Under **Registrant's mark E8 SECURITY**, **Registrant** performs behavior analytics. This means the security element of Registrant monitors **the user's behavior**, learn from it, and act upon it in their security product. Whereas **Applicant's product, by contrast is not even exposed to end-users because it is only attached to the servers.**

Applicant attaches **Exhibits A and B** which describe the different functions of the products of the respective parties.

There is **a complete distinction** between end-devices (such as smartphones, laptops, iPads), which are (a) personal (b) mobile (c) get turned off occasionally (d) not designed for high availability or fault tolerance, **which is the environment Registrant sells to** (e.g. Windows, Android, Iphone, VMware end-user). Versus the target market of **Applicant**, which sells to high performance, always-on (high fault tolerance), rack-mounted infrastructure.

- Accordingly, the **Applicant** provides infrastructure integrated software to form cost-effective **storage servers**. **Applicant does not** sell to **computing administrators** which Registrant's sells to.

All as further detailed below.

ARGUMENTS

I. Legal Standard for Determining Likelihood of Confusion:

1. Likelihood of Confusion is analyzed under a multi-factor test, in which the weight and relevance of various factors necessarily depends on the circumstances of the particular case. See *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357 at 1361-62, 177 USPQ 563 (CCPA 1973).

2. The primary question, as described in the Trademark Act, is whether Applicant's mark "**E8 STORAGE**" is likely, when used on or in connection with the following goods

"Computer software for **storage** of data and information; computer software that allows software modules in virtual containers to deliver processing of data; Rack-mounted computer **storage** devices, namely, high speed **storage** sub systems for high performance and high availability storage of electronic data either locally or via a telecommunications network; all the foregoing **NOT** intended for end-users and all the foregoing **EXCLUDING** computer software for use in monitoring and responding to computer **security** breaches; computer anti-virus software."

of the applicant, to cause confusion, or to cause mistake or to deceive, in light of Registrant's Mark: **E8 SECURITY**.

3. For the reasons discussed in more details below, the specific nature of the goods, the nature of the trade (sophisticated purchasers and knowledgeable purchase process) and the difference between the trademarks in appearance and sound and in the ideas suggested by them, Applicant respectfully submits that the mark in this application presents no likelihood of confusion with the cited registration.

II. Different Good, Functions/Solutions and Sophisticated Buyers:

4. The products sold under Applicant's mark and the cited Registration differ in their functions and the buyers of the respective products are sophisticated. Consequently, the purchase processes are carefully designed, thereby eliminating any remote likelihood of confusion. The respective products stream through different channels of trade and perform entirely different functions:

In the Final Office Action and the Denial of Applicant's Request for Reconsideration, the honorable Examiner explained that the goods of the respective parties "need only be "related in some manner and/or if the circumstances surrounding their marketing are such that they could give rise to the mistaken belief that [the goods and/or services] emanate from the same source." *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1369, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012) (quoting *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1724 (TTAB 2007)); TMEP §1207.01(a)(i)."

However, in this case, the goods and services are **not** related in any manner as the parties do **NOT** offer both type of computer software and services, but rather, each party offers different goods: Registrant- security software, and the Applicant storage software. The fact that other parties may provide security software and storage software by the same source, does **not** warrant that this is the case in the present circumstances as in the present case, the Registrant provides under the trademark registration E8 SECURITY computer software for use in monitoring and responding to **computer security breaches and computer anti-virus** software, and the Applicant provides **patented software for storage data**. Neither party provides the other's party's software.

Furthermore, the honorable Examiner indicated that evidence from the Applicant's and Registrant's websites are not compelling and rather, the list of goods as reflected at the USPTO should be considered. From a review of the Registrant's goods and services it is clear that it is engaged in security software and related software security services. Similarly, Applicant's list of goods as now on record with the USPTO, in particular following the present amendment of the specification, explicitly draws the line between Applicant's software for storage – while specifically indicating that “all the foregoing goods NOT intended for end-users and all the foregoing goods EXCLUDING computer software for use in monitoring and responding to computer security breaches; computer anti-virus software”.

From the respective parties' list of goods and services it is clearly evident that there is a distinction and **no overlap** between Applicant's products (**being software for storage servers**) and the Registrant's goods and services (**being software for security, analyzing end-users behavior to prevent security breaches**). Moreover, **the price of Applicant's software which amounts to US\$100,000** further supports the conclusion that any possibility of confusion is negated.

Sophisticated and Different Buyers:

5. As explained above, the products sold under Applicant's mark and the products of the cited Registration differ in their functions, their buyers and users. Moreover, the buyers of the respective products are sophisticated. Consequently, the purchase processes are carefully designed, thereby eliminating any remote likelihood of confusion. Finally, the respective products and services stream through different channels of trade and perform entirely different functions.

The respective buyers are highly sophisticated with respect to the goods of interest. The purchaser described below, buy the respective products with a clear understanding of the needs and requirements of the products and are aware of the full spectrum of the respective products' capabilities. The law is very precisely summarized in McCarthy on Trademarks, Section 23:101, pages 23-196:

“Many cases state that where the relevant buyer class is composed of professionals or commercial buyers familiar with the field, they are sophisticated enough not to be confused by trademarks that are closely

similar. That is, it is assumed that such professional buyers are less likely to be confused than the ordinary customer. Thus, while two marks might be sufficiently similar to confuse an ordinary consumer, a professional buyer or an expert in the field may be more knowledgeable and will not be confused.”
(citations omitted).

6. Case law supports this notion, not only for similar marks, but for identical marks as well. In *Astra Pharmaceutical Products, Inc. v. Beckman Instruments, Inc.* 718 F.2d 1201, 220 U.S.P.Q. 786 (1st Cir.1983) (**ASTRA** for local anesthetic preparation and **ASTRA** for computerized blood analyzer machine), the Court found the "most critical factor" to be the sophistication of the buyers of the products. See also, *Accord Blue Bell Bio-Medical v. Cin-Bad Inc.*, 864 F.2d 1253, 9 U.S.P.Q.2d 1870(5th Cir.1989)(the care with which hospitals buy medical carts for the operating room makes a mistaken purchase unlikely); *Electronic Design & Sales, Inc. v. Electronic Data Systems Corp.*, 954 F.2d 713, 21 U.S.P.Q.2d 1388(Fed. Cir. 1992)(No likelihood of confusion where **E.D.S.** for computer services sold to experienced corporate officials after significant study and contractual negotiation and **EDS** for power supplies and battery chargers to OEMs.).

In the present case:

7. **The Registrant of the Cited Mark** sells its **security** software through ISVs (**Independent Software Vendors**) like Microsoft (Windows) or VMware. Then, the computing administrators which implement the software in their organizations track and monitor conduct patterns of the end-users to prevent security breaches.

Whereas, Applicant sells its products through VARs (**Value added resellers**), these are resellers that buy physical equipment and integrate Applicant's storage software for their customers thereby providing added value - delivering to their customers full racks of equipment. **Applicant's** products are being incorporated in infrastructure to solve very particular and sophisticated needs for high performance computing.

Careful Purchase Process:

8. The purchase process is carefully designed, thereby eliminating likelihood of confusion. As a result, the conditions surrounding the marketing of the respective products are such that they could not be encountered by the same purchasers under circumstances that could give rise to the mistaken belief that the goods or services come from a common source. The **Applicant** provides infrastructure integrated software to form cost-effective **storage servers to professional infrastructure designers** of the organizations' servers . **Applicant does not** sell to computing administrators which **Registrant's** sells to.

In today's networks world, the variety of products and services increase at tremendous rates. Regardless of the rapid influx of computer software products, they may be utterly different from one another and not at all related. Simply because software is

identified in the respective lists of goods of the parties - there should not be an automatic finding that the products are related.

9. **Another Distinctive Factor - High Purchase Price**: As stated above, the purchase patterns for the respective products are very specific. This fact, together with the difference in nature of the products, the sophistication of the buyers and different channels of trade of the respective products, and **the price of Applicant's software which amounts to US\$100,000** further support the conclusion that any possibility of confusion is negated. Again, the buyers of Applicant's goods do not make the purchase decision hastily. As a matter of necessity, the purchase patterns call for careful consideration and do not allow for impulse purchasing habits. Evidently, the products of the Registrant also address specific needs of Registrant's buyers who seek security software solution for monitoring end-users' behaviour to detect security breaches.

Of particular interest is the analysis concerning "DOX" and "DOC'S" in the ruling set forth in In re Software Design, Inc., Serial No. 364,902, (TTAB), 220 U.S.P.Q (BNA) 662, Dec. 1, 1983, as follows:

This is a close case. However, for the reasons indicated above, we are of the opinion that the cumulative differences between the respective marks and services of applicant and registrant, considered in light of the nature of those services, are sufficient to obviate any reasonable likelihood of confusion."

Both marks in the Software Design Appeal were for services in the computer industry and were phonetically identical. However, since the services were highly sophisticated, technical and relatively expensive, they were found likely to be purchased only with care and deliberation after investigation. **The phonetic similarity was found not to be significant since the goods were not likely to be orally requested in retail stores.**

10. Also analogous to our case are the facts and findings of NEC ELECTRONICS, INC. v. NEW ENGLAND CIRCUIT SALES, INC., 722 F.Supp. 861 (US Dist. 1989); 13 U.S.P.Q.2D (BNA) 1058; in which Defendant's mark "NECS" was determined not to be confusingly similar with the mark "NEC". Both parties in this case were selling chips/integrated circuits, again related to the computer industry. The court recognized that:

"the parties are in the same industry, seek to sell to some of the same organizations and advertise in some of the same media. However, the nature of the products they sell, the different individuals they deal with, the sophistication of prospective customers [emphasis supplied], and the nature of their self-promotion all weigh against a finding that potential purchasers are likely to confuse [the marks]".

11. Finally, also see In re REACH ELECTRONICS, INC., (TTAB, 1972), 175 U.S.P.Q. (BNA) 734; where the difference between “**REAC**” and “**REACH**” with one letter differential and the fact that both the application and cited registration included “power supplies” (both in the electronics field) in the identifications of goods, resulted in a “**non-confusion**” decision in an appeal proceeding.
12. As a result, the conditions surrounding the marketing of the respective products are such that they could not be encountered by the same purchasers under circumstances that could give rise to the mistaken belief that the goods come from a common source.

III. The Subject Mark Is Different In Sound And Appearance From The Cited Registration:

13. “The ultimate conclusion of similarity or dissimilarity of the marks must rest on consideration of the marks in their entirety.” Packard Press, Inc. v. HewlettPackard Co., 227 F.3d 1352 at 1358, 56 U.S.P.Q. 1351 (Fed. Cir. 2000). Marks may be “extremely similar or even identical in [visual appearance or sound, or connotation], and yet **not** be confusingly similar” where the marks differ in one or more aspects. Kabushiki Kaisha Hattori Seiko v. Satellite International Ltd., 29 U.S.P.Q.2d 1317 (T.T.A.B. 1991). A differing number of syllables or a different last syllable can suffice to differentiate two marks that would otherwise be similar. See A&H Sportswear, Inc. v. Victoria’s Secret Stores, Inc., 237 F.3d 198, 217 (3d Cir. 2000). For example, in A&H Sportswear, Inc., the court held that the mark “THE **MIRACLE BRA**” was not confusingly similar to the mark “**MIRACLESUIT**” in light of the fact that the marks contained a different number of syllables and a different final syllable. *Id.*; see also M.D. On-Line, Inc. v. WebMD Corp., 2005 WL 2469668 (D.N.J. 2005) (marks were not confusingly similar where marks had different numbers of syllables and the last syllable was different).
14. In the case at hand, when considered in its entirety, Applicant’s mark “**E8 STORAGE**” is not confusingly similar to “**E8 SECURITY**” as the separate fields of activities of the parties further enhances their differentiation.

A single extra syllable in a mark can serve as a basis for dissimilarity between two marks, even more so, extra meaningful words as in the case at hand: **STORAGE** versus **SECURITY**.

15. The existence of distinguishing elements in pronunciation and appearance of the marks are sufficient to avoid likelihood of confusion. In numerous cases the TTAB has decided that even one letter difference between marks with similar goods can remove the likelihood of confusion. See, e.g., In re Sears, Roebuck and Co., 2 USPQ2d 1312 (TTAB 1987) (**CROSS-OVER** for bras held not likely to be confused with **CROSSOVER** for ladies' sportswear); In re British Bulldog. Ltd., *supra*; In re Sydel Lingerie Co., Inc., 197 USPQ 629 (TTAB 1977)(**BOTTOMS UP** for ladies' and children's underwear held not likely to be confused with **BOTTOMS UP** for men's

clothing). The existence of a similar component does not automatically create a likelihood of confusion, especially where the common component is heavily used by third parties. Pursuant to the 'overall impression' test, the basic rule for determining the likelihood of confusion, there is no presumption that confusion is likely when a junior user adopts a mark which contains as a part, the whole of another's mark. Thus, "JEWELCOR" for retail catalog showrooms was determined not to be similar to the mark "JEWEL" for catalog home shopping in Jewel Companies, Inc. v. Jewelcor Incorporated, 207 USPQ 68 (D.C.M.D. Florida 1980); "ADVANTAGE ASHE" for tennis classes was held not likely to be confused with "ADVANTAGE" for tennis rackets in Ashe v. Pepsico Inc., 205 USPQ 451 (SDNY) 1979. In the case at hand, the differences are compelling to find that confusion is not likely.

CONCLUSION

Applicant respectfully requests withdrawal of the refusal as the Applicant's mark is different in sound and appearance and creates a different overall impression from the Cited Mark. The function of Applicant's goods intended for complex networks support a careful and knowledgeable purchase process of the products that require special and direct contact and source identification. Most importantly, the Applicant further amended the specification of goods **to avoid any overlap with the Cited Mark**. These factors support the conclusion that confusion with the cited registration is not likely and therefore Applicant respectfully requests that the Board grant this Appeal and allow for the registration of the subject mark E8 STORAGE.

Respectfully submitted,

/Tally Eitan/
Tally (Avital) Eitan
Attorney for Applicant
California State Bar No. 129,566

Exhibit A - a printout from the **Applicant's** website, describing its activity under the mark "**E8 STORAGE**"

Exhibit B - a printout from the Registrant's acquiring company's website describing its activity under the mark "**E8 SECURITY**"

(/)

Products

As the first shared NVMe storage solution in the industry, E8 Storage delivers high performance, low latency storage and simplified storage management without compromising on reliability, availability or scalability.



The E8 Storage Difference

E8 Storage has developed a revolutionary storage architecture that meets the demands of mission critical customer applications. E8 Storage's patented software architecture was built from the ground up to leverage NVMe, the only protocol designed exclusively for solid state storage.

- Designed for NVMe, end to end
- Direct host access to shared storage volumes for low latency
- Centralized control ensures data availability and ease of management





Performance Without Compromise

E8 Storage appliances provide up to 10 times the performance of other all-flash-arrays, with consistently strong performance and low latency.

10M

Near line-rate performance

- 10 Million read IOPS
- 40GB/s read throughput

100Gb/s

Optimized for high performance

100Gb/s Ethernet / InfiniBand networks

μs

Latency on par with local SSDs



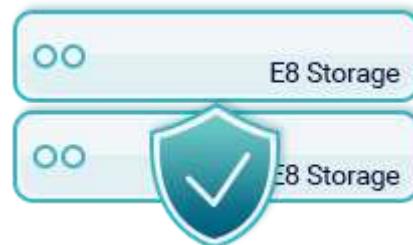
(<https://www.youtube.com/watch?v=JU6aDwMtd6c>)

Built for Enterprise Reliability

E8 Storage is designed for high availability, with no single point of failure across the hardware architecture, while the software architecture provides an additional layer of resiliency through the host-side E8 Agents.



Dual controller with double-parity
RAID data protection



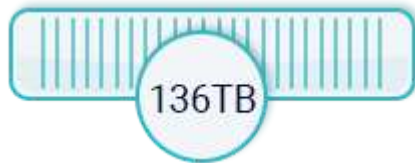
E8 Agents operate independently,
loss of an agent does not impact
other hosts



Non-disruptive software upgrades,
all hardware parts easily
replaceable.

Scalability to Fit Your Needs

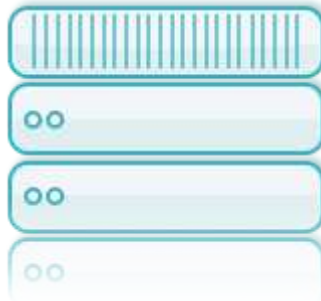
With simple connectivity via Ethernet or InfiniBand, new appliances can be added to the network seamlessly and new storage capacity provisioned to host servers without impacting host availability. E8 Agents can access storage volumes from multiple E8 Storage appliances, enabling capacity scaling into the petabyte range.



Up to 136TB (RAID-6 usable) per E8-D24 storage appliance



Hosts can access capacity from multiple E8 Controllers



Up to 126 host servers per E8 Storage appliance

Simple to Manage, Easy to Deploy

E8 Storage is designed to be easy to deploy and manage for any enterprise data center. With an easy to use and intuitive management interface, E8 Storage delivers simple, centralized storage management for high performance storage.

- 🔗 Plugs into existing top-of-rack Ethernet or InfiniBand switches
- 🔗 Centralized management of hosts and volumes
- 🔗 Auto-discovery for newly provisioned storage volumes



VMware and E8 Security

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VMware and E8 Security

In March 2018, VMware acquired E8 Security, further reinforcing our commitment to deliver the industry's first intelligence-driven digital workspace to empower employee experience and drive predictive security.

Adding E8 Security's user and entity behavior analytics capabilities to our digital workspace platform, VMware Workspace ONE (/il/products/workspace-one.html), will enable VMware customers with a single platform that simplifies management and improves security by correlating data to accurately detect and respond to advanced threats.

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Current VMware Product Name (/il.html)
TBD

Resources

- EUC Blog (<http://blogs.vmware.com/euc/2018/03/e8-security-behavior-analytics-digital-workspace.html>)
- M&A Blog (<https://www.vmware.com/radius/extending-digital-workspace-intelligence-capabilities-strategic-ma>)





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