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Subject:	U.S. Trademark Application Serial No. 88791552 - XX - Priv/TM-004 - Examiner Brief
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Attachments

United States Patent and Trademark Office (USPTO)

U.S. Application Serial No. 88791552

Mark: XX

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Reference/Docket No. Priv/TM-004

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EXAMINING ATTORNEY'S APPEAL BRIEF

The applicant has appealed the trademark examining attorney's final refusal to register the mark XX in standard characters for "downloadable software for blockchain-based platforms and networks, namely, software for the operation of a decentralized blockchain consensus mechanism; downloadable software for the operation of a blockchain-based distributed and decentralized computing application, network, or platform; downloadable computer software that deploys nodes and connects them to blockchains; downloadable computer software platforms that deploy nodes and connect them to blockchains, and that enables users to manage blockchain applications; downloadable software for use

in managing blockchain data; downloadable software for the operation of nodes for auditing and verifying decentralized blockchains" in International Class 9; and "non-downloadable software for blockchain-based platforms and networks, namely, software for the operation of a decentralized blockchain consensus mechanism; nondownloadable software for the operation of a blockchain-based distributed and decentralized computing application, network, or platform; nondownloadable computer software that deploys nodes and connects them to blockchains; platform as a service (PAAS) featuring computer software platforms that deploy nodes and connect them to blockchains, and that enables users to manage blockchain applications; electronic data storage, namely, providing a blockchain technology-based, distributed database ledger for the storage of public, private or encrypted data, and information; non-downloadable software for use in managing blockchain data; platform as a service (PAAS) featuring blockchain-based computer software platforms and distributed computing software platforms for auditing and verifying digital information and codes; non-downloadable software for the operation of nodes for auditing and verifying decentralized blockchains" in International Class 42 based on a likelihood of confusion with U.S. Registration No. 5098752 under Section 2(d) of the Act. It is respectfully requested that the refusal be affirmed.

FACTS

On February 10, 2020, applicant XX Network SEZC filed U.S. Trademark Application Serial No. 88791552, seeking registration of the proposed mark, XX in standard characters for "Downloadable software for use in facilitating communications over a global computer network, namely, electronic messaging software for use in sending, receiving and storing electronic messages; downloadable software for providing an electronic platform that facilitates the transaction of payments, digital currency, digital tokens, and financial transactions over a global computer network; downloadable software for enabling the electronic transfer of money, digital currency, and digital tokens between users; downloadable software for mobile digital electronic devices that allows streaming, downloading, and viewing of audiovisual and multimedia content; downloadable software for the development and maintenance of a decentralized digital currency utilizing a blockchain; downloadable software for operating a computing network; downloadable software for blockchain-based platforms and networks, namely, software for the operation of a decentralized blockchain consensus mechanism; downloadable

software for the operation of a blockchain-based distributed and decentralized computing application, network, or platform; downloadable software for managing and verifying transactions on a blockchain; downloadable software to facilitate the use of a blockchain or distributed ledger to execute and record financial transactions; downloadable computer software that deploys nodes and connects them to blockchains; downloadable computer software platforms that deploy nodes and connect them to blockchains, and that enables users to manage blockchain applications; downloadable software for use in managing blockchain data; downloadable software, namely, software that runs on a distributed or decentralized computing system; downloadable software for the operation of nodes for auditing and verifying decentralized blockchains" in International Class 9; "Financial services, namely, providing the electronic transfer of digital currency, digital tokens, and money via a global computer network, distributed ledger network, or open-source, distributed protocol governed by a consensus mechanism; electronic funds transfer services; financial services, namely, providing digital currency or digital tokens for use by participants of a distributed ledger network or open-source, distributed protocol governed by a consensus mechanism" in International Class 36; "Communication services, namely, the transmission of text, data, images, and video via a global computer network; electronic messaging" in International Class 38; and "Providing temporary use of online, non-downloadable software for use in facilitating communications over a global computer network, namely, electronic messaging software for use in sending, receiving and storing electronic messages; software as a service, namely, software for providing an electronic platform that facilitates the transaction of payments, digital currency, digital tokens, and financial transactions over a global computer network; providing temporary use of online, non-downloadable software for enabling the electronic transfer of money, digital currency, and digital tokens between users; providing temporary use of online, nondownloadable software for mobile digital electronic devices that allows streaming, downloading, and viewing of audiovisual and multimedia content; non-downloadable software for development and maintenance of a decentralized digital currency utilizing a blockchain; nondownloadable software for operating a computing network; non-downloadable software for blockchain based platforms and networks, namely, software for the operation of a decentralized blockchain consensus mechanism; non-downloadable software for the operation of a blockchain-based distributed and decentralized computing application, network, or platform; nondownloadable software for managing and verifying transactions on a blockchain; non-

downloadable software to facilitate the use of a blockchain or distributed ledger to execute and record financial transactions; nondownloadable computer software that deploys nodes and connects them to blockchains; platform as a service (PAAS) featuring computer software platforms that deploy nodes and connect them to blockchains, and that enables users to manage blockchain applications; electronic data storage, namely, providing a blockchain technology-based, distributed database ledger for the storage of public, private or encrypted data, transactions, and information; non-downloadable software for use in managing blockchain data; non-downloadable software, namely, software that runs on a distributed or decentralized computing system; development of distributed or decentralized computing software; development of software that runs on a distributed or decentralized computing system; platform as a service (PAAS) featuring blockchain-based computer software platforms and distributed computing software platforms; non-downloadable software for the operation of nodes for auditing and verifying decentralized blockchains" in International Class 42.

On May 7, 2020, the trademark examining attorney issued an Office Action refusing registration of the mark based on likelihood of confusion under Trademark Act Section 2(d) and requiring applicant to amend the identification of goods and/or services.

On November 9, 2020, the applicant responded to the Office Action arguing against the refusal to register the mark and amending the identification of goods and/or services and deleting the services in International Class 36.

On December 1, 2020, the application was suspended pending filing of maintenance documents of a cited prior U.S. Registration.

On September 30, 2021, the trademark examining attorney issued an Office Action where the requirement for an acceptable identification and the refusal to register the mark under Section 2(d) were made final, in part.

On March 30, 2022, the applicant filed a Notice of Appeal and a Request for Reconsideration. The Request for Reconsideration argued against the refusal to register the mark and amended the identification of services in International Class 42.

On May 11, 2022, the Request for Reconsideration was denied.

On July 5, 2022, the applicant filed a Motion to Divide the Application and a Request for Remand and on July 7, 2022, the applicant filed an Appeal Brief with the Trademark Trial and Appeal Board.

The application was remanded to the trademark examining attorney on September 9, 2022.

On October 3, 2022, the Office granted the Request to Divide and the services in International Class 38 were moved to a child application that was subsequently approved for publication.

On December 5, 2022, the trademark examining attorney denied the Request for Reconsideration with respect to the Section 2(d) Refusal in part, and indicated that the amendment to the identification of services in International Class 42 was acceptable and satisfied that requirement. Therefore, the identification of services is not at issue in the appeal.

On March 10, 2023, applicant filed a Supplemental Brief with the Trademark Trial and Appeal Board. The application was forwarded to the trademark examining attorney for a brief in accordance with Trademark Rule 2.142(b) on March 14, 2023.

ISSUE

The sole issue on appeal is whether applicant's mark XX in standard characters for, inter alia, "downloadable software for blockchain-based platforms and networks, namely, software for the operation of a decentralized blockchain consensus mechanism; downloadable software for the operation of a blockchain-based distributed and decentralized computing application, network, or platform; downloadable computer software that deploys nodes and connects them to blockchains; downloadable computer software platforms that deploy nodes and connect them to blockchains, and that enables users to manage blockchain applications; downloadable software for use in managing blockchain data; downloadable software for the operation of nodes for auditing and verifying decentralized blockchains" in International Class 9; and "non-downloadable software for blockchain-based platforms and networks, namely, software for the operation of a decentralized blockchain consensus mechanism; nondownloadable software for the operation of a blockchain-based distributed and decentralized computing application, network, or platform; nondownloadable computer software that deploys nodes and connects them to blockchains; platform as a service (PAAS) featuring computer software platforms that deploy nodes and connect them to blockchains, and that enables users to manage blockchain applications; electronic data storage, namely, providing a blockchain technology-based, distributed database ledger for the storage of public, private or encrypted data, and information;

non-downloadable software for use in managing blockchain data; platform as a service (PAAS) featuring blockchain-based computer software platforms and distributed computing software platforms for auditing and verifying digital information and codes; non-downloadable software for the operation of nodes for auditing and verifying decentralized blockchains" in International Class 42, is confusingly similar to the mark in U.S. Registration No. 5098752 XX (stylized) for "Financial services, namely, providing an online financial exchange platform for trading and transmitting digital assets and currencies; financial administration of an exchange for trading and transmitting digital assets and currencies; financial management of virtual currency exchange transactions" in International Class 36; and "Temporary use of non-downloadable online software for electronically trading and transmitting digital assets and currencies; computer services, namely, remote management of IT systems for others related to a virtual currency exchange for trading and transmitting digital assets and currencies and virtual currency exchange transactions" in International Class 42 thus creating a likelihood of confusion within the meaning of Section 2(d) of the Trademark Act.[1]

ARGUMENTS

Trademark Act Section 2(d) bars registration where an applied-for mark so resembles a registered mark that it is likely, when applied to the goods and/or services, to cause confusion, mistake or to deceive the potential consumer as to the source of the goods and/or services. TMEP §1207.01. The Court in *In re E. I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973), listed the principal factors to consider in determining whether there is a likelihood of confusion. Among these factors are the similarity of the marks as to appearance, sound, meaning and commercial impression, and the relatedness of the goods and/or services. The overriding concern is to prevent buyer confusion as to the source of the goods and/or services. *Miss Universe, Inc. v. Miss Teen U.S.A., Inc.*, 209 USPQ 698 (N.D. Ga. 1980). Therefore, any doubt as to the existence of a likelihood of confusion must be resolved in favor of the registrant. *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988); *Lone Star Mfg. Co. v. Bill Beasley, Inc.*, 498 F.2d 906, 182 USPQ 368 (C.C.P.A. 1974).

I. THE MARKS ARE HIGHLY SIMILAR

Turning first to consideration of the marks at issue, the applicant’s mark is XX in standard characters. The mark in cited U.S. Registration No. 5098752 is XX stylized.

Here, the marks are highly similar. Both marks are comprised of a double X, or XX. The applicant's mark is in standard characters while registrant's mark is stylized. However, a mark in typed or standard characters may be displayed in any lettering style; the rights reside in the wording or other literal element and not in any particular display or rendition. *See In re Viterra Inc.*, 671 F.3d 1358, 1363, 101 USPQ2d 1905, 1909 (Fed. Cir. 2012); *In re Mighty Leaf Tea*, 601 F.3d 1342, 1348, 94 USPQ2d 1257, 1260 (Fed. Cir. 2010); 37 C.F.R. §2.52(a); TMEP §1207.01(c)(iii). Thus, a mark presented in typed or standard characters generally will not avoid likelihood of confusion with a mark in stylized characters and/or with a design element because the word portion could be presented in the same manner of display. *See, e.g.*, *In re Viterra Inc.*, 671 F.3d at 1363, 101 USPQ2d at 1909; *Squirtco v. Tomy Corp.*, 697 F.2d 1038, 1041, 216 USPQ 937, 939 (Fed. Cir. 1983) (stating that “the argument concerning a difference in type style is not viable where one party asserts rights in no particular display”). Further, applicant does not argue that the marks are distinct.

It is well settled that the trademark examining attorney must resolve any doubt as to the issue of likelihood of confusion in favor of the registrant and against the applicant who has a legal duty to select a mark which is totally dissimilar to trademarks already being used. Burroughs Wellcome Co. v. Warner-Lambert Co., 203 USPQ 191 (TTAB 1979).

II. THE GOODS AND/OR SERVICES ARE HIGHLY RELATED

The second consideration pertains to the goods and/or services at issue and the channels of trade for said goods and/or services. The trademark examining attorney submits that the goods and/or services at issue are highly related.

The applicant’s goods and/or servicesat issue are, “downloadable software for blockchain-based platforms and networks, namely, software for the operation of a decentralized blockchain consensus mechanism; downloadable software for the operation of a blockchain-based distributed and decentralized computing application, network, or platform; downloadable computer software that deploys nodes and connects them to blockchains; downloadable computer software platforms that

deploy nodes and connect them to blockchains, and that enables users to manage blockchain applications; downloadable software for use in managing blockchain data; downloadable software for the operation of nodes for auditing and verifying decentralized blockchains" in International Class 9; and "non-downloadable software for blockchain-based platforms and networks, namely, software for the operation of a decentralized blockchain consensus mechanism; nondownloadable software for the operation of a blockchain-based distributed and decentralized computing application, network, or platform; nondownloadable computer software that deploys nodes and connects them to blockchains; platform as a service (PAAS) featuring computer software platforms that deploy nodes and connect them to blockchains, and that enables users to manage blockchain applications; electronic data storage, namely, providing a blockchain technology-based, distributed database ledger for the storage of public, private or encrypted data, and information; non-downloadable software for use in managing blockchain data; platform as a service (PAAS) featuring blockchain-based computer software platforms and distributed computing software platforms for auditing and verifying digital information and codes; non-downloadable software for the operation of nodes for auditing and verifying decentralized blockchains" in International Class 42. The services in U.S. Registration No. 5098752 are "Financial services, namely, providing an online financial exchange platform for trading and transmitting digital assets and currencies; financial administration of an exchange for trading and transmitting digital assets and currencies; financial management of virtual currency exchange transactions" in International Class 36; and "Temporary use of non-downloadable online software for electronically trading and transmitting digital assets and currencies; computer services, namely, remote management of IT systems for others related to a virtual currency exchange for trading and transmitting digital assets and currencies and virtual currency exchange transactions" in International Class 42.

Applicant argues that there is no likelihood of confusion because blockchain technology has many uses and is not limited to the finance and cryptocurrency industry or applications. Further applicant argues that the goods and/or services are not in the same channels of trade. The examining attorney does not find these arguments persuasive.

The compared goods and/or services need not be identical or even competitive to find a likelihood of confusion. *See* On-line Careline Inc. v. Am. Online Inc., 229 F.3d 1080, 1086, 56 USPQ2d 1471, 1475 (Fed. Cir. 2000); Recot, Inc. v. Becton, 214 F.3d 1322, 1329, 54 USPQ2d 1894, 1898 (Fed. Cir. 2000);

TMEP §1207.01(a)(i). They 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).

Determining likelihood of confusion is based on the description of the goods and/or services stated in the application and registration at issue, not on extrinsic evidence of actual use. *See In re Detroit Athletic Co.*, 903 F.3d 1297, 1307, 128 USPQ2d 1047, 1052 (Fed. Cir. 2018) (citing *In re i.am.symbolic, llc*, 866 F.3d 1315, 1325, 123 USPQ2d 1744, 1749 (Fed. Cir. 2017)).

In this case, the application use(s) broad wording to describe the function of the software goods and/or services. Therefore, the software presumably encompasses all goods and/or services of the type described, including registrant's more narrow software for electronically trading and transmitting digital assets and currencies. *See, e.g., Made in Nature, LLC v. Pharmavite LLC*, 2022 USPQ2d 557, at *44 (TTAB 2022); *In re Solid State Design Inc.*, 125 USPQ2d 1409, 1412-15 (TTAB 2018); *Sw. Mgmt., Inc. v. Ocinomled, Ltd.*, 115 USPQ2d 1007, 1025 (TTAB 2015). Thus, applicant's and registrant's goods and/or services are legally identical. *See, e.g., In re i.am.symbolic, llc*, 127 USPQ2d 1627, 1629 (TTAB 2018) (citing *Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp., Inc.*, 648 F.2d 1335, 1336, 209 USPQ 986, 988 (C.C.P.A. 1981); *Inter IKEA Sys. B.V. v. Akea, LLC*, 110 USPQ2d 1734, 1745 (TTAB 2014); *Baseball Am. Inc. v. Powerplay Sports Ltd.*, 71 USPQ2d 1844, 1847 n.9 (TTAB 2004)).

Applicant's software is used to manage blockchain data and is also used for operating a blockchain based computing applications which could be in the field of, or used to trade cryptocurrency. The examining attorney notes that the printout of applicant's webpage shows that its software goods and/or services are used in the field of cryptocurrency. September 30, 2022, Offc Action Outgoing, TSDR pg 2-11. The applicant's and registrant's goods and/or services would be found in the same channels of trade and encountered by the same consumers.

Additionally, the goods and/or services of the parties have no restrictions as to nature, type, channels of trade, or classes of purchasers and are "presumed to travel in the same channels of trade to the same

class of purchasers." *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (quoting *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1268, 62 USPQ2d 1001, 1005 (Fed. Cir. 2002)); *Made in Nature, LLC v. Pharmavite LLC,* 2022 USPQ2d 557, at *49. Thus, applicant's and registrant's goods and/or services are related.

Finally, the greater the degree of similarity between the applied-for mark and the registered mark, the lesser the degree of similarity between the goods and/or services of the parties is required to support a finding of likelihood of confusion. In re C.H. Hanson Co., 116 USPQ2d 1351, 1353 (TTAB 2015) (citing In re Opus One Inc., 60 USPQ2d 1812, 1815 (TTAB 2001)); In re House Beer, LLC, 114 USPQ2d 1073, 1077 (TTAB 2015) (citing In re Shell Oil Co., 992 F.2d 1204, 1206, 26 USPQ2d 1687, 1688 (Fed. Cir. 1993); Time Warner Ent. Co. v. Jones, 65 USPQ2d 1650, 1661 (TTAB 2002); In re Opus One Inc., 60 USPQ2d at 1815); TMEP §1207.01(a).

Based on the similarity of the marks and the close relationship of the goods and/or services, the trademark examining attorney submits that purchasers who encounter the marks of applicant and registrant would mistakenly believe that the goods and/or services originate from or are in some way associated with the same producer. *See* Hercules Inc. v. National Starch and Chemical Corp., 223 USPQ 1244, 1247 (TTAB 1984).

SUMMARY

In summary, the marks are similar in appearance, sound and commercial impression and the goods and/or services at issue are highly related to each other. Because consumers would mistakenly believe that the goods and/or services of the applicant and the registrant emanate from a common source, there is a likelihood of confusion as to the source of the goods and/or services. Therefore, it is respectfully requested that the refusal to register the mark pursuant to Section 2(d) of the Trademark Act be affirmed as to the goods and/or services outlined.

Respectfully submitted,

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End Notes

1. The Section 2(d) Refusal was issued in part and the following goods and/or services are not included in the refusal:

   "Downloadable software for use in facilitating communications over a global computer network, namely, electronic messaging software for use in sending, receiving and storing electronic messages; downloadable software for mobile digital electronic devices that allows streaming, downloading, and viewing of audiovisual and multimedia content; downloadable software for operating a computing network; downloadable software, namely, software that runs on a distributed or decentralized computing system for playing video games, social media, business productivity, computer network security, anti-virus protection, and intrusion detection and prevention, transmission of voice, data, images, audio, video, and information, and for content management, online project management, creating, offering, hosting, and delivering online conferences, meetings, demonstrations, tours, presentations and interactive discussions" in International Cass 9; and "Providing temporary use of online, non-downloadable software for use in facilitating communications over a global computer network, namely, electronic messaging software for use in sending, receiving and storing electronic messages; providing temporary use of online, non-downloadable software for mobile digital electronic devices that allows streaming, downloading, and viewing of audiovisual and multimedia content; non-downloadable software, namely, software that runs on a distributed or decentralized computing system for playing video games, social media, business productivity, computer network security, anti-virus protection, and intrusion detection and prevention, transmission of voice, data, images, audio, video, and information, transmission of voice, data, images, audio, video, and information, and for content management, online project management, creating, offering, hosting, and delivering online conferences, meetings, demonstrations, tours, presentations and interactive discussions; development of distributed or decentralized computing software; development of software that runs on a distributed or decentralized computing system" in International Class 42

United States Patent and Trademark Office (USPTO)

USPTO OFFICIAL NOTICE

Examining attorney's appeal brief has issued
on May 5, 2023 for
U.S. Trademark Application Serial No. 88791552

A USPTO examining attorney has issued an appeal brief. Follow the steps below.

(1) Read the appeal brief. This email is NOT the appeal brief.

(2) Submit reply brief within 20 days of May 5, 2023 , if you wish to do so. If submitted, a reply brief must be submitted using the Electronic System for Trademark Trials and Appeals (ESTTA) and received by the USPTO on or before 11:59 p.m. **Eastern Time** of the last day of the reply period.

(3) Direct questions about the appeal proceeding to the Trademark Trial and Appeal Board at 571-272-8500 or TTABInfo@uspto.gov.