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

Ex Parte Appeal - Serial No.	88791591
Appellant	xx network SEZC
Applied for mark	XX
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Submission	Appeal brief
Attachments	Brief for Appellant SN 88791591.pdf(172191 bytes)
Appealed classes	Class 009. Appealed goods and services in the class: 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 Class 042. Appealed goods and services in the class: 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; non-downloadable software for the operation of nodes for auditing and verifying decentralized blockchains
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In re Application of xx network SEZC Serial No. 88791591 Filed: 02/10/2020 Trademark:	Law Office 110 Trademark Attorney: Ellen J.G. Perkins

Brief for Appellant

Introduction

Appellant hereby appeals from the Examiner's refusal to register the above-identified mark and respectfully requests the Trademark Trial and Appeal Board to reverse the Examiner's decision.

Appellant's Trademark

Appellant seeks registration on the Principal Register of its mark for the following goods and services in classes 09, 38, and 42, all based on intent to use:

> **Class 09:** 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

(class 09 cont.) 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, 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; downloadable software for the operation of nodes for auditing and verifying decentralized blockchains

Class 38: Communication services, namely, the transmission of text, data, images, and video via a global computer network; electronic messaging

Class 42: 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 for blockchain-based platforms and networks, namely, software for the operation of a decentralized blockchain consensus

(class 42 cont.) mechanism; non-downloadable software for the operation of a blockchain-based distributed and decentralized computing application, network, or platform; non-downloadable 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; 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; platform as a service (PAAS) featuring blockchain-based computer software platforms and distributed computing software platforms for use in distributed or decentralized computing software; non-downloadable software for the operation of nodes for auditing and verifying decentralized blockchains

Prior Registration Cited By the Examiner

Reg. No. 5098752

Literal Element: XX

Class 36: 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

Class 42: 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

The Rejection

The Examining Attorney refused registration of Appellant's mark contending that the mark as applied to the goods so resembles Reg. No. 5098752, as to be likely to cause confusion, or to cause mistake, or to deceive. May 7, 2020 Office Action, TSDR p. 2.

In response to the May 7, 2020 Office Action, Appellant deleted class 36 financial services and financial oriented software in order to avoid confusion. November 9, 2020 Response to Office Action, TSDR p. 3-6.

A Final Office Action was issued, indicating that "goods and/or services listed therein, such as software for electronic messages and operating a blockchain, and trading and transmission of digital assets as well as software for trading virtual currency, are of a kind that may emanate

from a single source under a single mark." September 30, 2021 Final Office Action, TSDR p. 4.

The Examining Attorney also found the following class 42 services indefinite: "platform as a service (PAAS) featuring blockchain-based computer software platforms and distributed computing software platforms for use in distributed or decentralized computing software". September 30, 2021 Final Office Action, TSDR p. 4.

Argument

I. WHEN APPELLANT'S MARK IS COMPARED WITH THE PRIOR CITED REGISTRATION, THERE IS NO LIKELIHOOD OF CONFUSION BECAUSE THE GOODS AND SERVICES ARE NOT RELATED

The terms cryptocurrency, decentralized finance ("defi"), and blockchain tech are used loosely by some for marketing purposes. Service providers and consumers draw sharp distinctions between the goods and services in these fields. A crypto asset exchange like Poloniex, cited by the Examining Attorney, is simply a marketplace for peer-to-peer exchange of cryptocurrency and digital assets. May 11, 2022 Request for Reconsideration Denied, p. 3-6. Coin issuers mint coins and distribute them for various purposes. The coin issuers and exchanges have different business models. E-Trade allows users to buy and sell publicly traded stocks. Adobe sells stocks that can be purchased on E-Trade, but that does not make Adobe's business, content creation software development, the same as E-Trade.

What does blockchain technology have to do with cryptocurrency? A blockchain is an elegant database that may be public or private. March 30, 2022 Request Reconsideration after FOA, p. 14. Many different devices, called nodes, replicate the database. March 30, 2022 Request Reconsideration after FOA, p. 18. To change the database, the nodes must agree. The process of reconciliation of the nodes is called consensus. March 30, 2022 Request Reconsideration after

FOA, p. 16-18. Developers build consensus software, which is a distinguishing feature of different blockchains. March 30, 2022 Request Reconsideration after FOA, p. 53-55. Appellant created consensus protocol software using patented encryption and decryption techniques. May 11, 2022 Request for Reconsideration Denied, p. 9.

As elegant databases, blockchains have many non-cryptocurrency uses, which include supply chain monitoring and administration by companies such as Walmart, authentication of goods such as diamonds, and tracking sales and other internet traffic. March 30, 2022 Request Reconsideration after FOA, p. 24-25. For cryptocurrency, blockchains serve to verify digital currency and digital assets. March 30, 2022 Request Reconsideration after FOA, p. 76.

The uses and commercialization of defi and blockchain tech is rapidly changing, just as internet technology and commerce has evolved since the mid-1990s. The Wikipedia Web3 page, https://en.wikipedia.org/wiki/Web3, references the potential future of the technology, with many believing that blockchains will help the digital world become more transparent. March 30, 2022 Request Reconsideration after FOA, p. 88. People hope that data is shared openly, and decisions are made collectively. March 30, 2022 Request Reconsideration after FOA, p. 88. For example, consider how users publicly propose changes to Wikipedia pages, which the community decides whether to adopt. Wikipedia's decision making is decentralized.

A. Examining Attorney's Evidence is Insufficient to Show Goods and Services are Related.

To support a finding of likelihood of confusion, the trademark office must provide evidence showing that the goods and services are related. *See, e.g., In re White Rock Distilleries Inc.*,92 USPQ2d 1282, 1285 (TTAB 2009). "[W]hen the relatedness of the goods and services is not evident, well known, or generally recognized, "something more" than the mere fact that the goods

and services are used together must be shown." *TMEP 1207.01(a)(ii)* – Establishing Relatedness of Goods to Services. A few third-party registrations for overlapping goods may not be sufficient to show relatedness of those goods without something more. *In re Coors Brewing Co.*, 343 F.3d 1340, 1346, 68 U.S.P.Q.2d 1059, 1063 (Fed. Cir. 2003) (several third-party registrations deemed insufficient to show relatedness). Third-party registrations based on § 44 or § 66 are not based on any actual use in the United States and thus have no probative value at all as to consumer perceptions. *In re 1st USA Realty Professionals, Inc.*, 84 U.S.P.Q.2d 1581, 2007 WL 2315610 (T.T.A.B. 2007).

Marks can co-exist within the computer, software, and internet industries. There is no per se rule that all computer related goods and services are related. *See In re Iolo Technologies, LLC*, 95 U.S.P.Q.2d 1498 (T.T.A.B. 2010); *Electronic Data Systems Corp. v. EDSA Micro Corp.*, 23 U.S.P.Q.2d 1460 (T.T.A.B. 1992) (there is no conflict between EDS for general data processing services and EDSA for computer assisted design for electrical power systems); *Viacom International Inc. v. Komm*, 46 U.S.P.Q.2d 1233 (T.T.A.B. 1998) (no conflict between MY-T-MOUSE THE SOFTWARE THAT MAKES YOUR MOUSE A MOUSE THAT TYPES! for software that creates an on-screen keyboard usable by the computer mouse and MIGHTY MOUSE for a cartoon character merchandised for use on toys, which could include computer toys and games); and *Calypso Technology, Inc. v. Calypso Capital Management, LP*, 100 U.S.P.Q.2d 1213, (T.T.A.B. 2011) (No conflict between senior CALYPSO computer software for financial institutions and CALYPSO for investment management services sold to sophisticated investors.).

In this case, decentralized finance and blockchain technology are not well-known, generally recognized, or self-evident fields. The trademark office cited evidence consisting of four (4) third-party registrations. One of the registrations, FANCO (RN 6451310), is based on Section

44(e) and not probative. The Examining Attorney concluded that such evidence "shows that the goods and/or services listed therein, such as software for electronic messages and operating a blockchain, and trading and transmission of digital assets as well as software for trading virtual currency, are of a kind that may emanate from a single source under a single mark." September 30, 2021 Final Office Action, TSDR p. 4.

Considering the pace of the evolution of the field of blockchain software and the present early stage, and Appellants evidence that blockchain software has varied and still evolving uses, the few Section 1(a) based registrations cited, three (3), are insufficient to meet the burden of proof. *See In re Coors Brewing Co.*, 343 F.3d at 1346, 68 USPQ2d at 1063. More evidence is needed so support the trademark office's conclusion.

B. Enterprise level blockchain software is not in the same channel of trade as an online crypto asset exchange.

The Board has recognized that technology is use specific and trade channel specific, and such differences are sufficient to avoid likelihood of confusion and permit the same or similar mark to be registered. "All computer software programs process data, but it does not necessarily follow that all computer programs are related." *Electronic Data Systems Corp. v. EDSA Micro Corp.*, 23 USPQ2d 1460, 1463 (TTAB 1992). For example, X*PRESS for a news service transmitted through cable television to a personal computer was found not likely to cause confusion with EXPRESS for highly specialized information analysis computer programs. *Information Resources v. X*Press Info. Servs.*, 6 U.S.P.Q.2d 1034 (T.T.A.B. 1988). A trademark used for software in one department of a hospital is not likely to cause confusion with software used in a different department. *Edwards Lifesciences Corporation v. VigiLanz Corporation*, 94 U.S.P.Q.2d 1399 (T.T.A.B. 2010).

In *Arris Enterprises LLC v. Hire U L.L.C*, proceeding no. 91241991 (T.T.A.B. June 4, 2021) (not precedential), the Board concluded that "software for the configuration and management of modems and routers, falls short of an inherent relatedness to Appellant's software for the administration and management of employment recruiting and staffing. We find that the types of software offered by the parties today are distinct; they are used for fundamentally different purposes."

In this case, blockchain software, sophisticated consensus protocol software, is by nature enterprise level software used by developers. Blockchain software is technology infrastructure. In contrast, crypto exchange platforms offer services using retail software. The fact Appellant advertises that enterprise blockchain software tools are useful for a wide range of applications, including decentralized finance, does not make all such applications travel in the same channels of trade.

C. Exposure to blockchain infrastructure technology does not make it related to an online crypto exchange.

The Board recognizes the distinction between infrastructure technology and end user technology. And end user may be unwittingly exposed to infrastructure technology, but that does not make it related. In the matter of *In Re Quadram Corp.*, 228 U.S.P.Q. (BNA) ¶ 863 (T.T.A.B. Oct. 29, 1985), the Board found no likely confusion between FASER for software for energy conservation and MICROFAZER for hardware buffers. The Board found that rather subtle differences in the uses of the technology were sufficient to distinguish. The applicant used its mark for peripheral computer hardware and the registrant for a specialized software. The Board distinguished the goods and services as follows:

> While applicant and registrant are both in the computer field, applicant is seeking registration for a specific, specialized piece of peripheral computer

> hardware, namely buffers. The cited registration, on the other hand, relates to a specific, specialized type of applications software, namely, computer programs in the field of energy conservation and management. While there exists the possibility that those users of registrant's specialized software could also conceivably have a need for applicant's buffers in order to store data, we do not believe that this possibility of overlap in the computer field is significant enough to warrant a finding of likelihood of confusion as to source especially where, as here, applicant has presented a declaration from its president (uncontroverted by any opposing evidence) as to the differences in marketing and otherwise, between applications software designed for a specific practical application and other types of "systems" or "utility" software designed to help the computer or its peripherals operate. The evidence of third-party registrations introduced by the Examining Attorney to show the same mark used in connection with computer hardware and software appears to be limited to "systems" or "utility" type software, as opposed to applications software. Remembering that applicant's goods are not software at all, we are persuaded that even in the event a customer of registrant's applications software is exposed to applicant's buffers, that customer would not be likely to believe the respective goods emanated from the same source, since those are products associated with disparate parts of the computer field.

In this case, Appellant's blockchain software is not actively used by individuals who buy and sell crypto assets on an exchange. Blockchain software is infrastructure technology. The software is used for back-end data management. Consumer confusion is not likely.

II. IDENTIFIED SERVICES

Appellant submits that the following services are sufficiently definite: "platform as a service (PAAS) featuring blockchain-based computer software platforms and distributed computing software platforms for use in distributed or decentralized computing software".

Appellant notes that it submitted a request to amend the class 42 services at issue as follows:

> Current Class 42 (refused portion): platform as a service (PAAS) featuring blockchain-based computer software platforms and distributed computing software platforms for use in distributed or decentralized computing software

Proposed Class 42 (refused portion): platform as a service (PAAS) featuring blockchain-based computer software platforms and distributed computing software platforms for auditing and verifying digital information and codes

Conclusion

Appellant submits that there is no likelihood of confusion between Appellant's mark and the prior cited registrations, and Appellant's mark is entitled to registration. The Board is therefore respectfully requested to reverse the Examiner's decision refusing registration of Appellant's mark.

Respectfully submitted,

/Eric Eagle Hartmans/

Attorney for Appellant

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