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Filing date: **01/05/2017**

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

Proceeding	91229012
Party	Plaintiff ROBERT BOSCH GMBH
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Signature	/Michael J. Striker/
Date	01/05/2017
Attachments	SKMBT_42117010510170.pdf(895246 bytes)

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

ROBERT BOSCH GMBH,)	
)	
Opposer,)	Opposition No. 91229012
)	
v)	Mark: BOSH
)	
PIVOTAL SOFTWARE, INC.,)	App. Serial No.: 86,808,248
)	
Applicant.)	Published: March 22, 2016
_____)	

**OPPOSER’S MEMORANDUM IN REPLY TO APPLICANT’S BRIEF IN OPPOSITION
TO OPPOSER’S MOTION FOR SUMMARY JUDGMENT**

January 5, 2017

Robert Bosch GmbH, the Opposer, herein, herewith responds to Applicant’s Brief in Opposition as follows:

First, it is noted that Applicant has not disputed and therefore has conceded the following factors:

1. Standing - Applicant has conceded that Opposer has standing to bring this proceeding.
2. Priority - Applicant does not dispute the fact that Opposer has priority of use of its trademark BOSCH in commerce in the United States. Priority is therefore not an issue.

3. Ownership of an Incontestable Registration - Applicant has conceded that Opposer is the owner of a prior incontestable trademark registration upon which it is entitled to rely upon in this proceeding.

LIKELIHOOD OF CONFUSION

In view of the above, the sole remaining issue for determination is likelihood of confusion between the respective marks BOSCH and BOSH for Opposer's goods, "design of computer software for use in data processing" and Applicant's "downloadable computer software..."

In this respect, Opposer herewith responds to Applicant's arguments as follows:

Applicant Argues that the Marks BOSH and BOSCH are Phonetically Distinct and Have Different Meanings.

Applicant is incorrect. The marks BOSH and BOSCH are phonetically identical. Period. While no treatise or authority can be cited for this proposition, nevertheless common sense dictates that the words BOSH and BOSCH are phonetically completely identical. While there is no right or wrong way to pronounce a trademark, in this case the marks are pronounced in exactly the same way.

This substantially heightens likelihood of confusion:

“In this age of business over the telephone and advertising on TV and radio, the close similarity in sound...would be likely to result in mistake if not confusion.”
TBC Corp. v Holsa, Inc., 126 F.3d 1470,1472, 44 USPQ 2d 1315,1318: Fed. Cir. 1997

An example of the confusion, presumably created by the identical pronunciation of respective marks can be found in the Notification of Suspension by Interlocutory Attorney M. Katherine Faint and filed in this Opposition Proceeding on December 12, 2016, of which a copy is attached as Exhibit A.

Note that the Opposer is indicated as Robert Bosh GmbH, whereas the correct name of the Opposer is Robert Bosch GmbH. This represents a clear act of actual confusion and exemplifies the plain fact that the marks involved are phonetically completely identical, and visually virtually identical and therefore confused.

Applicant further argues that the marks have different meanings. Applicant cites a dictionary definition for the word BOSH as ‘foolish talk.’

In this respect it is noted that the Cambridge Dictionary refers to the word BOSH as “old fashioned.” See Exhibit B.

Indeed, it is believed that the Board may take judicial notice of the fact that the word Bosh is not only old fashioned, but that it is arcane and not within the lexicon of an average person. Under these circumstances it cannot be reasonably said that likelihood of confusion would in any way be obviated due to any differences in meaning. Both marks are effectively without meaning, thereby substantially raising the risk of confusion.

Applicant Argues that Pivotal's Goods are not Similar to Opposer's Services.

Opposer's services as set forth in Registration No. 2,100,692 is " Design of computer software for use in data processing. (The Registration also recites other services, separated by a semi-colon and not relevant herein)

Applicant wishes to correct a typographical error taking place in its Motion for Summary Judgment. At page 3, Opposer recites the services set forth in Opposer's Registration No. 2,100,692 and indicates a comma after the wording '... data processing'. This is incorrect. The correct punctuation is a semi-colon.

This is important as it indicates that the ' Design of computer software for use in data processing' is discrete and independent of itself. It does not depend on any of the other services set forth in the registration.

"Semicolons should generally be used to separate distinct categories of goods for services within a single class."

-TMEP Sec. 1402.01.(a)

See also *Midwest Gaming & Entm't LLC*, 106 USPQ 2d 1163,1166 (TTAB 2013).

Pivotal's trademark application opposed herein for the mark BOSH is for goods including a type of downloadable computer software. First, it is noted that the fact that Applicant's listing relates to goods, whereas Opposer's trademark relates to services is irrelevant. Classification of goods or services does not dictate whether confusion is likely. What controls are the goods and services named in the involved application and/or

registration, not the class or classes in which the goods or services are classified. See *Jean Patou, Inc. v Theon, Inc.*, 9 F.3d 971,975, 29 USPQ 2d 1771,1774 (Fed. Cir. 1993). See also Trademark Rule 2.85(g), 37 CFR § 2.85(g) “Classification schedules shall not limit or extend the applicant’s rights.”

Opposer’s goods include the “Design of computer software for use in data processing.” The terminology “computer software” is extremely broad, including any type of software and any type of computer. Similarly, the terminology “data processing” is extremely broad.

Oxford Dictionaries defines data processing as “a series of operations on data, especially by a computer, to retrieve, transform or classify information.

Opposer’s Listing of Services in its incontestable registration, ‘ Design of computer software for data processing’, is unlimited in its application. No channels of trade or limitations whatsoever are set forth.

Accordingly, it can be reasonably assumed that Opposer’s design of computer software for data processing would be deemed to include design of computer software for data processing in the field of computer software for release engineering, deployment and life cycle management of small and large scale cloud software.

Additionally, it should be emphasized that identity of goods and services is not a requirement for likelihood of confusion:

“The test is not whether the goods or services of the parties are the same or even competitive, but rather whether they are sufficiently related in a commercial sense that consumers would be likely to attribute them to the same source if the goods or services are sold under the same mark or a similar mark.”(citing authorities)
- *Guide to TTAB Practice*, Jeffery A. Handelman 2016 Supplement, Sec. 6.06

Applicant Argues that the Customers of the Goods and Services Involved Herein are Sophisticated and Discerning.

Applicant’s argument as to a sophisticated purchaser theory does not hold water here. First, Applicant has failed to submit any evidence that the goods allegedly offered for sale by the Applicant are expensive or that any purchasers thereof are of particularly sophisticated or discerning. Additionally, Applicant has failed to submit any evidence as to the extent of use, if any, of its mark.

However, even if, *arguendo*, the goods and services of the respective parties are purchased by discerning purchasers, this factor in itself does not obviate likelihood of confusion:

“That the relevant class of buyers may exercise care does not necessarily impose on that class the responsibility of distinguishing between similar trademarks for similar goods.”
In Re: Research & Trading Corp., 793 F.2d 1276,1279, 230 USPQ 49,50 (Fed. Cir. 1986).

“It is settled, however, that even sophisticated purchasers are not immune from source confusion, especially in cases such as the instant one involving similar marks and closely related goods.”

Edom Laboratories, Inc. v Lichter, 102 USPQ 2d 1546,1552 (TTAB 2012)

“It is true that in most instances technicians would use the products of either party and they are a discriminating group of people, but that does not eliminate the likelihood of purchaser confusion here. Being skilled in their own art does not necessarily preclude their mistaking one trademark for another when the marks are as similar as those here in issue (i.e. WINCO & RINCO), and cover merchandise in the same general field.”

Wincharger Corp. v RINCO, Inc., 297 F.2d 261,264. 132 USPQ 289,292 (CCPA 1963).

In this case, the subject marks are phonetically identical and visually virtually identical and the goods are either identical or clearly overlap. Under such circumstances, even if the purchasers are discerning, likelihood of confusion will take place.

Imagine for instance an individual, no matter how discerning inquiring of another as to a software system recently having been installed. The answer given may well be BOSCH. However, is it BOSH or is it BOSCH? The person will be confused. Imagine an individual, no matter how discerning, seeing a Bosch advertisement. Will that person, no matter how discerning they may be, still remember a few weeks later if it was Bosch or Bosh? Confusion is highly likely to ensue.

Applicant Argues That Trade Channels Differ

Opposer has cited *In re Cook Medical Technologies LLC* 105 USPQ 2D 1377,1381 (TTAB 2012) for the proposition that the absence of trade channel restrictions in Applicant's Application and Opposer's Registration leads to the conclusion that the respective trade channels overlap.

Applicant argues that *In re Cook* does not apply since at *Cook*, the goods of the respective parties were in the same class whereas here the respective goods and service classes are different. This argument however is incorrect: What controls are the goods and services named in the involved application and registration, not the classes in which the goods or services are classified. See: *Tuxedo Monopolies, Inc. v. General Mills Fun Group, Inc.* 648 F2d 1335, 1336. 209 USPQ 986, 988 (CCPA 1981).

Applicant further argues that *In re Cook* does not apply as it was an ex parte decision. However, the mere fact that the decision may have been ex parte appears to be irrelevant. It is still good law.

The plain fact is, as argued at *In re Cook* that where, as here the services specified in the Opposer's registration are broad enough to cover the goods in the application: '...the legal effect of this fact is that the goods and channels of trade are to be considered the same for the purposes of [the] Opposition.- *INT'L Paper Co. v. Valley Paper Co.*, 468 F2d 937,938; 175 USPQ 704, 705 (CCPA 1972).

Applicant Argues an Absence of Actual Confusion.

Applicant argues that there has been an absence of actual confusion.

First, Applicant has failed to submit evidence readily available to support concurrent use. We do not know the extent of use, if any of Applicant's mark BOSH in commerce in the United States. Very limited usage would mitigate against actual confusion.

In any event it is well settled that evidence of actual confusion is not required to prove that likelihood of confusion exists. See: *In re Majestic Distilling Co.*, 315 F3d, 1311, 1317, 65 USPQ2d 1201, 1205 (Fed Cir. 2003) wherein the Court stated:

“...uncorroborated statements of no known
Instances of actual confusion are of little evidentiary value.”

In any event, Applicant's statement is not correct. Actual confusion has indeed taken place as exemplified in Exhibit A hereto, which is the Notification of Suspension issued by the Board, in which the creator thereof became actually confused as to the correct name of the Opposer and utilized the name Robert Bosh GmbH instead of the correct name, Robert Bosch GmbH.

In fact, other instances of actual confusion abound:

See; Exhibit C - Google Search for word BOSH in which the first hit is the BOSCH Official Site (This is the official site of the Opposer herein). This is actual confusion.

See: Exhibit D - Bing Search for word BOSH in which 16 Hits for the word BOSCH appear.
This is actual confusion.

SUMMARY

Applicant has conceded priority; standing and the fact that Opposer is the owner of an incontestable trademark registration for the design of computer software for data processing.

Applicant's downloadable computer software falls clearly within the ambit of Opposer's incontestable registration. Indeed, the mere fact that it is downloadable admits that the software comes within the ambit of data processing. The respective marks are phonetically identical

Applicant has not submitted any genuine issue of material fact and the evidence appears to overwhelmingly support a Summary Judgment.

In view of all of the above, Opposer's Motion for Summary Judgment should be granted and registration to the Applicant should be refused.

Respectfully submitted,



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103 East Neck Road
Huntington, New York 11743

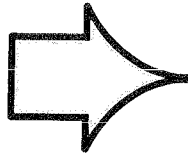
EXHIBIT A

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451
General Contact Number: 571-272-8500

lw

Mailed: December 12, 2016

Opposition No. 91229012



Robert Bosh GMBH

v.

Pivotal Software, Inc.

**M. Catherine Faint,
Interlocutory Attorney:**

Proceedings are suspended pending disposition of Opposer's motion for summary judgment (filed November 21, 2016). Any paper filed during the pendency of this motion which is not relevant thereto will be given no consideration. *See* Trademark Rule 2.127(d).

In addition to tolling the time to respond to outstanding discovery requests, suspension of proceedings tolls the time for parties to make required disclosures. *See* TBMP § 528.03.

The motion for summary judgment will be decided in due course.

EXHIBIT B

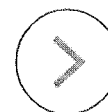


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Meaning of "bosh" in the English Dictionary

British dictionary ▾

"bosh" in British English

▶ See all translations

bosh



exclamation, noun [U] • UK /bɒʃ/ US /bɑːʃ/ OLD-FASHIONED

★ **nonsense:**

Don't talk such bosh!



(Definition of "bosh" from the Cambridge Advanced Learner's Dictionary & Thesaurus © Cambridge University Press)

Translations of "bosh"

in Chinese (Simplified) ▾

胡说...

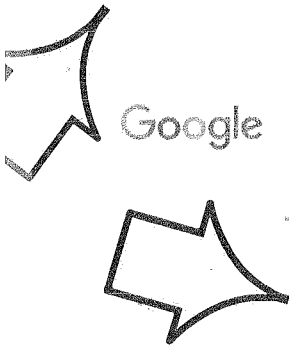


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EXHIBIT C



BOSH

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<https://bosh.cloudfoundry.org/>
BOSH is an open source tool for release engineering, deployment, lifecycle management, and monitoring of distributed systems. See docs.
Stemcell · Cf-mysql 26 Details

Chris Bosh - Wikipedia
https://en.wikipedia.org/wiki/Chris_Bosh
Christopher Wesson Bosh (born March 24, 1984) is an American professional basketball player for the Miami Heat of the National Basketball Association (NBA).

Bosh | Facebook
<https://www.facebook.com/boshtv/>
Bosh. 639837 likes · 222572 talking about this. We make it easier for you to eat #allplants.

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Chris Bosh Stats - Miami Heat - ESPN
www.espn.com/nba/player/stats/_id/1977/chris-bosh
Get the latest updated stats for Miami Heat power forward Chris Bosh on ESPN.com.

Miami Heat won't clear Chris Bosh to return after failed physical
www.espn.com/nba/story/_id/.../miami-heat-clear-chris-bosh-return-failed-physical
Sep 23, 2016 - Chris Bosh has failed his physical, meaning the Heat will not clear him for training camp next week, casting serious doubt on his playing future.

Chris Bosh stats, details, videos, and news. | NBA.com
www.nba.com/players/chris/bosh/2547
Find a complete bio, stats and videos about Chris Bosh, for the . Stay up to date on all news from the official NBA site.

GitHub - cloudfoundry/bosh: Cloud Foundry BOSH is an open source ...
<https://github.com/cloudfoundry/bosh>
Cloud Foundry BOSH is an open source tool chain for release engineering, deployment and lifecycle management of large scale distributed services.



Chris Bosh

Basketball player

Christopher Wesson Bosh is an American profes for the Miami Heat of the National Basketball Ass

Born: March 24, 1984 (age 32), Dallas, TX

Height: 6' 11"

Spouse: Adrienne Williams Bosh (m. 2011)

Current team: Miami Heat (#1 / Power forward, C

Children: Dylan Skye Bosh, Lennox Noel Bosh, Bosh, Phoenix Avery Bosh

Education: Georgia Institute of Technology, Lino

Profiles



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Dwyane Wade



LeBron James



Adrienne Williams Bosh
Spouse



Ha: Wh Tea

EXHIBIT D

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www.bosch-home.com/us
Bosch has been designing home and kitchen appliances for over 125 years, consistently raising the standards in quietness, efficiency and integrated design.

Bosch Power Tools NA - Official Site
<https://www.boschtools.com/us/en>
 The Power Tools Division of the **Bosch** Group is one of the world's leading providers of cordless & corded power tools, tool accessories & measuring tools

BOSH - Official Site
<https://bosh.io>
BOSH is an open source tool for release engineering, deployment, lifecycle management, and monitoring of distributed systems. See docs.

Bosch in the USA | Bosch USA
www.bosch.us/en/us/startpage_1/country-landingpage.php
 Find your **Bosch** software challenge. Ready to be part of something that brings impressive ideas to life? As a software specialist at **Bosch**, you can help overcome ...

Bosh | Definition of Bosh by Merriam-Webster
<https://www.merriam-webster.com/dictionary/bosh>
 Define **bosh**: foolish words or ideas — **bosh** in a sentence

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www.bosch.com/en/com/home/index.php
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Bosch dishwashers - Bosch Home Appliances
www.bosch-home.com/us/products/dishwashers.html
Bosch is an industry leader in quiet built-in dishwashers for the home. **Bosch** Kitchen dishwashers are extremely quiet and energy efficient.

BOSH - Wikipedia
<https://en.wikipedia.org/wiki/BOSH>
 Bidirectional-streams Over Synchronous HTTP (**BOSH**) is a transport protocol that emulates a bidirectional stream between two entities (such as a client and a server ...

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<https://www.boschtools.com/us/en/boschtools-ocs/power-tools-22064-c>
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★★★★★ 67	★★★★★ 6		
			
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Robert Bosch GmbH (Company)
 Robert Bosch GmbH, or Bosch, is a German multinational engineering and electronics company headquartered in Gerlingen, near Stuttgart, Germany. It is the world's largest supplier of automotive component... 

Chris Bosh (American Professional Basketball Player)
 Christopher Wesson Bosh is an American professional basketball player for the Miami Heat of the National Basketball Association. A high school "Mr. Basketball" ... 

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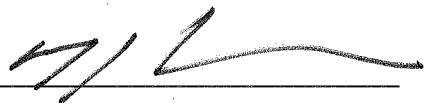
It is hereby certified that a true and complete copy of the attached Memorandum in Reply was served upon Counsel for the Applicant via First Class Mail and email at the following addresses:

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P.O. Box 1022
Minneapolis MN 55440-1022

trademarkgroup-sv@fr.com

tmdoctc@fr.com

This 5th day of January, 2017



Michael Striker