

Response to Office Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	85949846
LAW OFFICE ASSIGNED	LAW OFFICE 110
MARK SECTION	
MARK	http://tess2.uspto.gov/ImageAgent/ImageAgentProxy?getImage=85949846
LITERAL ELEMENT	KAI ACADEMIES KNOWLEDGE AND INNOVATION IN EDUCATION
STANDARD CHARACTERS	YES
USPTO-GENERATED IMAGE	YES
MARK STATEMENT	The mark consists of standard characters, without claim to any particular font style, size or color.
ARGUMENT(S)	
<p>The Examining Attorney has found no similar register mark that would bar registration under the Trademark Act, but has advised that there may be a likelihood of confusion between Applicant's KAI ACADEMIES KNOWLEDGE AND INNOVATION IN EDUCATION mark and the mark in prior pending U.S. Application Serial No. 85/854,338 (for a design mark including a prominent circular design element along with the wording "KAI Knowledge Advantage Inc.").</p> <p>It is well accepted that a finding of likelihood of confusion requires a probability of confusion and, thus, more than a mere possibility of confusion. <i>American Steel Foundries v. Robertson</i>, 269 U.S. 372 (1926); <i>Rodeo Collection Ltd. v. West Seventh</i>, 2 U.S.P.Q.2d 1205, 1206 (9th Cir. 1987) ("Likelihood of confusion requires that confusion be probable, not simply a possibility."); <i>Blue Bell Bio-Medical v. Cin-Bad, Inc.</i>, 9 U.S.P.Q.2d 1870, 1875 (5th Cir. 1989) ("[Plaintiff] must show, however, that confusion is probable; a mere possibility that some customers might mistakenly identify the [defendant's product] as [plaintiff's] product is not sufficient.").</p> <p>It is further understood that "confusion" with another mark means more than the "calling to mind" of that mark. <i>University of Notre Dame Du Lac v. J.C. Gourmet Food Imports Co.</i>, 217 U.S.P.Q. 505 (Fed. Cir. 1983) (likelihood of confusion means more than the likelihood that the public will recall a famous mark upon seeing the same or similar mark used by another).</p> <p>Applicant respectfully traverses the refusal and submits that confusion between its mark and the cited marks is not likely, for the following reasons.</p> <p>1. The Services Are Distinguishable</p> <p>Applicant's mark is used in connection with services distinguishable from the goods identified in the cited registration. Registrant's goods are "business consulting services relating to the integration of the areas of business process technology, organizational learning, change management, and operationally sustainability," and "educational services, namely, conducting classes, seminars, conferences, workshops, and webinars in the field of knowledge management, leadership development, diversity and multicultural communication, conflict resolution, and distribution of course material in connection therewith," and "IT consulting services." Accordingly, Registrant's services focus on primarily on topics suitable for adults and upper management in corporations and the like – topics generally involving professional training, corporate training, corporate responsibility, leadership, diversity, ethics and organizational behavior-type topics. In sharp contrast, Applicant provides "business services in the nature of management and operation of elementary and secondary schools." Stated more plainly, applicant intends to operate as a service provider providing administrative and operational support on an outsourced basis to run/operate elementary and secondary (K-12) schools. Accordingly, Applicant's services will include matters such as:</p> <ul style="list-style-type: none"> - student recruitment and admissions; - establishment of the school year calendar and school day schedule; - administering and enforcing student disciplinary and special education hearings; 	

- purchasing instructional materials, equipment, and supplies;
- arranging for transportation and food services for students;
- operating and maintaining the school building/facility in accordance with leases, etc.;
- providing personnel services (including recruiting/training of instructional and non-instructional personnel, conducting background checks, and establishing staffing level recommendations);
- performing public relations functions;
- performing financial audits; and
- conducting and maintaining all aspects of the schools business administration, accounting operations, and financial reporting.

Accordingly, Applicant's services will allow an elementary or secondary (K-12) school to outsource its operations responsibilities.

Accordingly, Registrant's registration relates to the delivery of the educational content itself, whereas Applicant's services relate to operational/ministerial aspects of a school's operation. As a result, there are significant differences between the services of the respective parties such that confusion is unlikely.

Further, neither Registrant's services nor Applicant's services may be considered to be the subject of a perfunctory, spontaneous or casual purchase. Rather, the specialized purposes for which each of the goods are individually marketed, require that the goods be purchased only after very **careful**, as opposed to casual, consideration, thereby reducing, if not eliminating, the likelihood of confusion between Applicant's and Registrant's marks. See *McCarthy*, at §23.96; and *Magnaflux Corp. v. Sonoflux Corp.*, 109 U.S.P.Q. 313 (C.C.P.A. 1956) ("other things being equal, confusion is less likely where goods are expensive and purchased after careful consideration than when they are purchased casually."). More specifically, purchases of grapes by winemakers are made only after careful consideration. Similarly, purchases of wine by consumers of wine are typically made only after careful consideration – and often by some of the most discriminating of ordinary consumers.

Therefore, the services are distinguishable, and thus confusion is not likely.

2. The Trade Channels Are Different

Further, there are distinct differences in the trade channels in which Registrant's and Applicant's services travel, not only in connection with the purchasers to whom they are offered, but also in connection with the conditions under which they are offered.

The competing marks are not targeted to or likely to be encountered by the same class of customers. More specifically, Registrant's services are marketed differently than Applicant's services, and they are offered to dissimilar classes of persons.

The purchasers of Registrant's services are likely to be middle/upper management personnel and/or highly trained information technology (IT) or human resources (HR) personnel in a corporation or similar organization.

In contrast, the purchasers of Applicant's services are likely to be members of the school's administrative body, such as the school's principal, or School Board.

Registrant's and Applicant's services are fundamentally different. They are neither competitive with nor complementary to one another, and would not be encountered under similar circumstances as to cause consumer confusion to their source. Further, they move through different channels of trade to different classes of purchasers.

The services simply do not travel in same trade channels -- they are offered and marketed to dissimilar classes of consumers. Accordingly, the likelihood of confusion between the marks is even further reduced. See *McCormick & Co. v. B. Manischewitz Co.*, 98 U.S.P.Q. 367 (6th Cir. 1953) (no likelihood of confusion between spices and Kosher foods); *Applebaum v. Senior*, 115 U.S.P.Q. 243 (1st Dist. 1957) (orthopedic shoes versus ordinary shoes); *Paul Sachs Originals Co. v. Sachs*, 139 U.S.P.Q. 414 (9th Cir. 1963) (girls' dresses and women's dresses sold in different stores to different customers); and *Field Enterprises v. Cove Industries*, 161 U.S.P.Q. 243 (E.D.N.Y. 1969) (different channels of encyclopedia distribution: door-to-door versus department store); see also, *Dynamics Research Corp. v. Langenau Mfg. Co.*, 217 U.S.P.Q. 649 (Fed. Cir. 1983) (affirming decision of Board and its supporting reasoning that, because the prospective customers of the respective products were not the same, any overlap thereof was *de minimis* and the consumers were not uneducated, marketing under identical marks would not be likely to cause confusion, mistake or to deceive).

Therefore, the dissimilarities in the relevant trade channels and purchasers are such that confusion is not likely.

3. The Purchasers Are Sophisticated

As referenced above, the purchasers of Registrant's services are likely to be highly-trained and discerning middle/upper management personnel and/or highly trained information technology (IT) or human resources (HR) personnel in a corporation of similar organization, and thus sophisticated.

Similarly, the purchasers of Applicant's services include highly-trained members of the school's administrative body, such as the school's principal, or School Board. Such purchasers are sophisticated also.

Such professionals are highly discriminating professionals, thereby reducing, if not eliminating, the likelihood of confusion between Applicant's and Registrant's marks. See *McCarthy*, at §23:101. See *Oreck Corp. v. U.S. Floor Systems, Inc.*, 231 U.S.P.Q. 634 (5th Cir. 1986) (purchasers who "are virtually certain to be informed, deliberate buyers" are not easily confused);

Hayden Switch & Instrument, Inc. v. Rexnord, Inc., 4 U.S.P.Q.2d 1510 (D.C. Conn. 1987) ("[S]ophisticated purchasers of the products...enter the marketplace in search of specific products for specific...purposes. The sophistication of these purchasers makes the likelihood of confusion remote."); and *Castle Oil Corp. v. Castle Energy Corp.*, 26 U.S.P.Q.2d 1481 (E.D. Pa. 1992) ("Where, as here, different goods are sold, even if sold under the same mark, to different discriminating purchasers, there is no likelihood of confusion.").

Thus, the purchasers of Applicant's services are highly discriminating and sophisticated professional purchasing agents. In view of such sophistication of the relevant purchasers, confusion is not likely.

In view of the foregoing, it is believed that there is no potential conflict between the instant application and pending U.S. Application Serial No. 85/854,338. Accordingly, reconsideration is requested. It is thus believed that this application is now in condition to be passed for publication. Favorable action is earnestly solicited.

Finally, it is noted that this preliminary response to the Action's assertions in relation to U.S. Application Serial No. 85/854,338 in no way limits applicant's right to address this issue at a later point in time. Applicant expressly reserves the right to further respond to this issue during subsequent prosecution of the present application.

ADDITIONAL STATEMENTS SECTION

DISCLAIMER	No claim is made to the exclusive right to use ACADEMIES apart from the mark as shown.
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SIGNATURE SECTION

RESPONSE SIGNATURE	/gregory s. bernabeo/
SIGNATORY'S NAME	Gregory S. Bernabeo
SIGNATORY'S POSITION	Attorney of record, PA bar member
DATE SIGNED	10/10/2013
AUTHORIZED SIGNATORY	YES

FILING INFORMATION SECTION

SUBMIT DATE	Thu Oct 10 09:59:14 EDT 2013
TEAS STAMP	USPTO/ROA-XX.XXX.XX.XXX-2 0131010095914294764-85949 846-500e9a0f639536aea88b1 bbd74481a6d066227385216fd 425ff2dda248bb59d1ab3-N/A -N/A-20131010095115883466

Response to Office Action

To the Commissioner for Trademarks:

Application serial no. **85949846** KAI ACADEMIES KNOWLEDGE AND INNOVATION IN EDUCATION(Standard Characters, see <http://tess2.uspto.gov/ImageAgent/ImageAgentProxy?getImage=85949846>) has been amended as follows:

ARGUMENT(S)

In response to the substantive refusal(s), please note the following:

The Examining Attorney has found no similar register mark that would bar registration under the Trademark Act, but has advised that there may be a likelihood of confusion between Applicant's KAI ACADEMIES KNOWLEDGE AND INNOVATION IN EDUCATION mark and the mark in prior pending U.S. Application Serial No. 85/854,338 (for a design mark including a prominent circular design element along with the wording "KAI Knowledge Advantage Inc.").

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ADDITIONAL STATEMENTS

Disclaimer

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SIGNATURE(S)

Response Signature

Signature: /gregory s. bernabeo/ Date: 10/10/2013

Signatory's Name: Gregory S. Bernabeo

Signatory's Position: Attorney of record, PA bar member

The signatory has confirmed that he/she is an attorney who is a member in good standing of the bar of the highest court of a U.S. state, which includes the District of Columbia, Puerto Rico, and other federal territories and possessions; and he/she is currently the applicant's attorney or an associate thereof; and to the best of his/her knowledge, if prior to his/her appointment another U.S. attorney or a Canadian attorney/agent not

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