To: Elipsa. Inc(jkimmel@elipsa.ai)
Subject: U.S. Trademark Application Serial No. 90798371 - ELIPSA
Sent: November 16, 2022 10:20:53 AM EST
Sent As: tmng.notices@uspto.gov

Attachments

88397932
88442698

United States Patent and Trademark Office (USPTO)
Office Action (Official Letter) About Applicant's Trademark Application

U.S. Application Serial No. 90798371

Mark: ELIPSA

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Applicant: Elipsa. Inc

Reference/Docket No. N/A

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NONFINAL OFFICE ACTION

The USPTO must receive applicant's response to this letter within six months of the issue date below or the application will be abandoned. Respond using the Trademark Electronic Application System (TEAS). A link to the appropriate TEAS response form appears at the end of this Office action.

Issue date: November 16, 2022

This Office Action is in response to applicant's Response to Office Action, dated March 25, 2022.

In a previous Office action dated March 24, 2022, the following issues were outstanding with this application:

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1. Section 2(d) - Likelihood of Confusion Refusal
2. Substitute Specimen Not Properly Verified

In the Response, applicant:

- Verified the previous specimen; and
- Provided arguments against the Section 2(d) Refusal.

The examining attorney has reviewed the applicant's response and determined the following:

1. Applicant's verification of the previously submitted specimen is accepted. Accordingly, the specimen requirement is ***satisfied***;
2. Applicant's arguments against the Section 2(d) Refusal are not persuasive. Accordingly, the Section 2(d) - Likelihood of Confusion Refusal is ***maintained and continued***;
3. The assigned trademark examining attorney inadvertently omitted a potential refusal relevant to the mark in the subject application. See TMEP §§706, 711.02. Specifically, pending U.S. Application Serial Nos. 88442698 and 88397932 precede applicant's filing date and if one or more of the marks in the referenced applications register, applicant's mark may be refused registration under Trademark Act Section 2(d) because of a likelihood of confusion with the registered marks. The trademark examining attorney apologizes for any inconvenience caused by the delay in raising this issue.

SUMMARY OF ISSUES:

- Section 2(d) - Likelihood of Confusion Refusal
- **NEW ISSUE:** Potential Section 2(D) Refusal - Two Pending Application

SECTION 2(d) - LIKELIHOOD OF CONFUSION REFUSAL

Registration of the applied-for mark is refused because of a likelihood of confusion with the marks in U.S. Registration Nos. 5975570, 5918441 and 2901906. Trademark Act Section 2(d), 15 U.S.C. §1052(d); *see* TMEP §§1207.01 *et seq.* See the previously attached registrations.

Applicant has applied to register the mark **ELIPSA** in standard characters for use in connection with "*Software as a service (SAAS) services featuring software using artificial intelligence for use in machine learning, deep learning, diagnostic analytics, predictive analytics, prescriptive analytics, natural language processing, computer vision*" in Class 42.

Registration No. **5975570** is the mark **ELIPSE E3** in standard characters for use in connection with "*Recorded and downloadable computer software to create supervisory control and data acquisition (SCADA) applications used in industrial, infrastructure and building automation*" in Class 9.

Registration No. **5918441** is the mark **ELIPSE SOFTWARE** in standard characters for use in connection with "*Recorded and downloadable computer software for creating human machine interfaces, supervisory control and data acquisition applications and plant information management system applications, used in industrial, electrical, water and wastewater, infrastructure and building automation; and recorded and downloadable mobile software for creating human machine interfaces, supervisory control and data acquisition applications and plant information management system*

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applications for on-the-go monitoring, used in industrial, electrical, water and wastewater, infrastructure and building automation" in Class 9.

Registration No. **2901906** is the mark **ELLIPSE** in typed characters for use in connection with "*Computer software, namely, computer software programs for managing maintenance, repair and operations, materials management, human resources and financial systems of a company; compact discs featuring software for managing maintenance, repair and operations, materials management, human resources and financial systems of a company; and instructional manuals sold therewith; data processing software programs and business to business e-commerce software applications, all specializing in the management of assets, and business process and logistics for capital intensive industries, namely, mining, utilities, transportation and government*" in Class 9.

Trademark Act Section 2(d) bars registration of an applied-for mark that is so similar to a registered mark that it is likely consumers would be confused, mistaken, or deceived as to the commercial source of the goods and/or services of the parties. *See* 15 U.S.C. §1052(d). Likelihood of confusion is determined on a case-by-case basis by applying the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973) (called the "*du Pont* factors"). *In re i.am.symbolic, llc*, 866 F.3d 1315, 1322, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017). Any evidence of record related to those factors need be considered; however, "not all of the *DuPont* factors are relevant or of similar weight in every case." *In re Guild Mortg. Co.*, 912 F.3d 1376, 1379, 129 USPQ2d 1160, 1162 (Fed. Cir. 2019) (quoting *In re Dixie Rests., Inc.*, 105 F.3d 1405, 1406, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997)).

Although not all *du Pont* factors may be relevant, there are generally two key considerations in any likelihood of confusion analysis: (1) the similarities between the compared marks and (2) the relatedness of the compared goods and/or services. *See In re i.am.symbolic, llc*, 866 F.3d at 1322, 123 USPQ2d at 1747 (quoting *Herbko Int'l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1164-65, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002)); *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 1103, 192 USPQ 24, 29 (C.C.P.A. 1976) ("The fundamental inquiry mandated by [Section] 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods [or services] and differences in the marks."); TMEP §1207.01.

Similarity of the Marks

Marks are compared in their entireties for similarities in appearance, sound, connotation, and commercial impression. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 1321, 110 USPQ2d 1157, 1160 (Fed. Cir. 2014) (quoting *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 1371, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005)); TMEP §1207.01(b)-(b)(v). "Similarity in any one of these elements may be sufficient to find the marks confusingly similar." *In re Inn at St. John's, LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018) (citing *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014)), *aff'd per curiam*, 777 F. App'x 516, 2019 BL 343921 (Fed. Cir. 2019); TMEP §1207.01(b).

U.S. Registration Nos. 5975570 and 5918441

Here, applicant's mark, **ELIPSA**, is confusingly similar to the registered mark, **ELIPSE E3** and **ELIPSE SOFTWARE** in appearance, sound and commercial impression.

In particular, the marks share the similar terms ELIPSA and ELIPSE which begin with the identical

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wording ELIPS. Thus, the marks sound similar. The fact that the marks have different endings does not diminish the confusing similarity of the marks. Slight differences in the sound of similar marks will not avoid a likelihood of confusion. *In re Energy Telecomms. & Elec. Ass'n*, 222 USPQ 350, 351 (TTAB 1983); *see In re Viterra Inc.*, 671 F.3d 1358, 1367, 101 USPQ2d 1905, 1912 (Fed. Cir. 2012). Additionally, the terms ELIPSA and ELIPSE both translate to ELLIPSE. Accordingly, the marks convey the same commercial impression of an oval or a closed plane curve generated by a point moving in such a way that the sums of its distances from two fixed points is a constant. *See the previously attached translation evidence from Collins and Linguee and the definition of ellipse from Merriam-Webster Dictionary*.
Moreover, even if consumers do not know the translation of the terms ELIPSA and ELIPSE, the marks both generate the same impression of a misspelling of the term "ellipse" due to the wording ELIPS.

The inclusion of the additional wording E3 and SOFTWARE in the registered marks does not obviate the confusing similarity of the marks. When comparing marks, "[t]he proper test is not a side-by-side comparison of the marks, but instead whether the marks are sufficiently similar in terms of their commercial impression such that [consumers] who encounter the marks would be likely to assume a connection between the parties." *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 1373, 127 USPQ2d 1797, 1801 (Fed. Cir. 2018) (quoting *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1368, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012)); TMEP §1207.01(b). The proper focus is on the recollection of the average purchaser, who retains a general rather than specific impression of trademarks. *In re Ox Paperboard, LLC*, 2020 USPQ2d 10878, at *4 (TTAB 2020) (citing *In re Bay State Brewing Co.*, 117 USPQ2d 1958, 1960 (TTAB 2016)); *In re Inn at St. John's, LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018); TMEP §1207.01(b); *see In re St. Helena Hosp.*, 774 F.3d 747, 750-51, 113 USPQ2d 1082, 1085 (Fed. Cir. 2014). While consumers may perceive differences in the marks, consumers with a general recollection of the marks are likely to recall the similar sound, appearance and commercial impression of the terms ELIPSA and ELIPSE in the marks and be confused as to the source of the goods and services.

U.S. Registration No. 2901906

Here, applicant's mark, **ELIPSA**, is confusingly similar to the registered mark, **ELLIPSE** in appearance, sound and commercial impression. In particular, the marks share the similar wording ELIPS and ELLIPS. Additionally, the English translation of applicant's mark ELIPSA is ELLIPSE. Accordingly, the marks convey the same commercial impression of an oval or a closed plane curve generated by a point moving in such a way that the sums of its distances from two fixed points is a constant. *See the previously attached translation evidence from Linguee and the definition of ellipse from Merriam-Webster Dictionary*.

Under the doctrine of foreign equivalents, a mark in a common, modern foreign language and a mark that is its English equivalent may be held confusingly similar. TMEP §1207.01(b)(vi)*; see, e.g.*, *In re Aquamar, Inc.*, 115 USPQ2d 1122, 1127-28 (TTAB 2015); *In re Thomas*, 79 USPQ2d 1021, 1025 (TTAB 2006). Consequently, marks comprised of foreign wording are translated into English to determine similarity in meaning and connotation with English word marks. *See Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee en 1772*, 396 F.3d 1369, 1377, 73 USPQ2d 1689, 1696 (Fed. Cir. 2005). Equivalence in meaning and connotation may be sufficient to find such marks confusingly similar. *See In re Aquamar, Inc.*, 115 USPQ2d at 1127-28; *In re Thomas*, 79 USPQ2d at 1025.

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Applicant's mark is in Polish, which is a common, modern language in the United States. *See In re New Yorker Cheese Co.*, 130 USPQ 120 (TTAB 1961) (Polish).

The doctrine is applied when "the ordinary American purchaser" would "stop and translate" the foreign term into its English equivalent. *Palm Bay*, 396 F.3d at 1377, 73 USPQ2d at 1696 (quoting *In re Pan Tex Hotel Corp.*, 190 USPQ 109, 110 (TTAB 1976)); TMEP §1207.01(b)(vi)(A). The ordinary American purchaser includes those proficient in the foreign language. *In re Spirits Int'l, N.V.*, 563 F.3d 1347, 1352, 90 USPQ2d 1489, 1492 (Fed. Cir. 2009); *see In re Thomas*, 79 USPQ2d at 1024.

In this case, the ordinary American purchaser would likely stop and translate the mark because the Polish language is a common, modern language spoken by an appreciable number of consumers in the United States.

Ultimately, when purchasers call for the goods and services of applicant and registrants using **ELIPSA**, **ELIPSE E3**, **ELIPSE SOFTWARE** and **ELLIPSE**, they are likely to be confused as to the source of those goods and services by the similarities between the marks. **Thus, the marks are confusingly similar**.

Relatedness of the Goods and Services

The goods and/or services are compared to determine whether they are similar, commercially related, or travel in the same trade channels. *See Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1369-71, 101 USPQ2d 1713, 1722-23 (Fed. Cir. 2012); *Herbko Int'l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1165, 64 USPQ2d 1375, 1381 (Fed. Cir. 2002); TMEP §§1207.01, 1207.01(a)(vi).

U.S. Registration Nos. 5975570 and 5918441

Here, applicant's Class 42, "*Software as a service (SAAS) services featuring software using artificial intelligence for use in machine learning, deep learning, diagnostic analytics, predictive analytics, prescriptive analytics, natural language processing, computer vision*" are closely related to registrant's Class 9 "*Recorded and downloadable computer software to create supervisory control and data acquisition (SCADA) applications used in industrial, infrastructure and building automation*" and "*Recorded and downloadable computer software for creating human machine interfaces, supervisory control and data acquisition applications and plant information management system applications, used in industrial, electrical, water and wastewater, infrastructure and building automation; and recorded and downloadable mobile software for creating human machine interfaces, supervisory control and data acquisition applications and plant information management system applications for on-the-go monitoring, used in industrial, electrical, water and wastewater, infrastructure and building automation*".

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 uses broad wording to describe services that feature software that uses artificial intelligence for machine learning, deep learning, diagnostic analytics, predictive analytics, prescriptive analytics, natural language processing, computer vision, which presumably encompasses

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