

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

U.S. Application Serial No. 79345163

Mark: SHIMMER

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Applicant: IOTA Stiftung

Reference/Docket No. N/A

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**NONFINAL OFFICE ACTION
Notice of Provisional Full Refusal**

International Registration No. 1672527

Deadline for responding. The USPTO must receive applicant's response **within six months of the "date on which the notification was sent to WIPO (mailing date)"** located on the WIPO cover letter, or the U.S. application will be abandoned (see <https://www.uspto.gov/trademarks-application-process/abandoned-applications> for information on abandonment). To confirm the mailing date, go to the USPTO's Trademark Status and Document Retrieval (TSDR) database at <https://tsdr.uspto.gov/>, select "US Serial, Registration, or Reference No.," enter the U.S. application serial number in the blank text box, and click on "Documents." The mailing date used to calculate the response deadline is the "Create/Mail Date" of the "IB-1st Refusal Note."

Respond to this Office action using the USPTO's Trademark Electronic Application System (TEAS). A link to the appropriate TEAS response form appears at the end of this Office action.

Discussion of provisional full refusal. This is a provisional full refusal of the request for extension of protection to the United States of the international registration, known in the United States as a U.S. application based on Trademark

Act Section 66(a). *See* 15 U.S.C. §§1141f(a), 1141h(c).

The referenced application has been reviewed by the assigned trademark examining attorney. Applicant must respond timely and completely to the issue(s) below. 15 U.S.C. §1062(b); 37 C.F.R. §§2.62(a), 2.65(a); TMEP §§711, 718.03.

SUMMARY OF ISSUES:

- SECTION 2(d) REFUSAL – LIKELIHOOD OF CONFUSION IN PART
- ADVISORY: PRIOR-FILED APPLICATIONS
- AMENDED IDENTIFICATION OF GOODS AND SERVICES REQUIRED
- MARK DESCRIPTION AND AMENDED COLOR CLAIM REQUIRED
- CLARIFICATION OF FOREIGN ENTITY REQUIRED
- EMAIL ADDRESS REQUIRED
- U.S.-LICENSED ATTORNEY REQUIRED

SECTION 2(d) REFUSAL – LIKELIHOOD OF CONFUSION IN PART

Please note—This refusal applies only to the following Class 009 goods identified by applicant: "software for decentralised applications; . . . software for connecting global computer networks; computer software for communication between computers over a local network; . . . machine- to-machine [m2m] applications".

Registration of the applied-for mark is refused because of a likelihood of confusion with the mark in U.S. Registration No.5076322. Trademark Act Section 2(d), 15 U.S.C. §1052(d);*see* TMEP §§1207.01 *et seq.* See the attached registration.

Applicant's mark is "SHIMMER"(stylized characters plus design) for, in relevant part, “software for decentralised applications; . . . software for connecting global computer networks; computer software for communication between computers over a local network; . . . machine- to- machine [m2m] applications” in International Class 009.

Registrant's mark is "SHIMMER GOLD" (standard characters) for, in relevant part, "Computer application software for the integration of text, audio, graphics, still images and moving pictures into an interactive delivery for multimedia applications; Computer application software for mobile phones for receiving and transmission of messages in the nature of data, text, language, sound, image and video" in International Class 009.

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 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) t

he relatedness of the compared

goods

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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 and differences in the marks."); TMEP §1207.01.

Similarity of the Marks

Marks are compared in their entirety 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).

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).

Applicant’s mark, “SHIMMER”, and registrant’s mark, “SHIMMER GOLF”, create an overall similar commercial impression. The wording in applicant’s mark is fully incorporated within registrant’s mark.

Incorporating the entirety of the wording of one mark within another does not obviate the similarity between the compared marks, as in the present case, nor does it overcome a likelihood of confusion under Section 2(d). See *Wella Corp. v. Cal. Concept Corp.*, 558 F.2d 1019, 1022, 194 USPQ 419, 422 (C.C.P.A. 1977) (holding CALIFORNIA CONCEPT and surfer design and CONCEPT confusingly similar); *Coca-Cola Bottling Co. v. Jos. E. Seagram & Sons, Inc.*, 526 F.2d 556, 557, 188 USPQ 105, 106 (C.C.P.A. 1975) (holding BENGAL LANCER and design and BENGAL confusingly similar); *Double Coin Holdings, Ltd. v. Tru Dev.*, 2019 USPQ2d 377409, at *6-7 (TTAB 2019) (holding ROAD WARRIOR and WARRIOR (stylized) confusingly similar); *In re Mr. Recipe, LLC*, 118 USPQ2d 1084, 1090 (TTAB 2016) (holding JAWS DEVOUR YOUR HUNGER and JAWS confusingly similar); TMEP §1207.01(b)(iii). In the present case, the marks are identical in part.

In addition, while registrant’s mark includes the wording “GOLD”, not present in

applicant's mark,

applicant's mark is likely to appear to prospective purchasers as a shortened form of registrant's mark. *See In re Mighty Leaf Tea*, 601 F.3d 1342, 1348, 94 USPQ2d 1257, 1260 (Fed. Cir. 2010) (quoting *United States Shoe Corp.*, 229 USPQ 707, 709 (TTAB 1985)). Thus, merely omitting some of the wording from a registered mark may not overcome a likelihood of confusion. *See In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257; *In re Optica Int'l*, 196 USPQ 775, 778 (TTAB 1977); TMEP §1207.01(b)(ii)-(iii). In this case, applicant's mark does not create a distinct commercial impression from the registered mark because it contains some of the wording in the registered mark and does not add any wording that would distinguish it from that mark.

Finally, while applicant's mark includes a design whereas registrant's mark is in standard characters, w

hen evaluating a composite mark consisting of words and a design, the word portion is normally accorded greater weight because it is likely to make a greater impression upon purchasers, be remembered by them, and be used by them to refer to or request the goods. *In re Aquitaine Wine USA, LLC*, 126 USPQ2d 1181, 1184 (TTAB 2018) (citing *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012)); TMEP §1207.01(c)(ii). Thus, although marks must be compared in their entireties, the word portion is often considered the dominant feature and is accorded greater weight in determining whether marks are confusingly similar, even where the word portion has been disclaimed. *In re Viterra Inc.*, 671 F.3d at 1366-67, 101 USPQ2d at 1911 (citing *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 1570-71, 218 USPQ2d 390, 395 (Fed. Cir. 1983)).

Relatedness of the Goods

The goods 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).

The compared goods 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] 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 uses broad wording to describe “software for decentralised applications; . . . software for connecting global computer networks; computer software for communication between computers over a local network; . . . machine- to- machine [m2m] applications” in International Class 009, which presumably encompasses all goods of the type described, including registrant's more narrow "Computer application software for the integration of text, audio, graphics, still images and moving pictures into an interactive delivery for multimedia applications; Computer application software for mobile phones for receiving and transmission of messages in the nature of data, text, language, sound, image and video". *See, e.g., 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 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)).

Additionally, the goods 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)). Thus, applicant's and registrant's goods and/or services are related

Based on the *du Pont* factors discussed above, a likelihood of confusion exists

between applicant's and registrant's marks because these marks create a confusingly similar commercial impression and the goods at issue are overlapping. Therefore, applicant's mark is refused registration under Trademark Act Section 2(d).

Applicant should note the following additional potential ground for refusal.

ADVISORY: PRIOR-FILED APPLICATION

The filing dates of pending U.S. Application Serial Nos. 90578022, 90208037, and 79299245 precede applicant's filing date. See attached referenced applications. 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 mark(s). *See* 15 U.S.C. §1052(d); 37 C.F.R. §2.83; TMEP §§1208 *et seq.* Therefore, upon receipt of applicant's response to this Office action, action on this application may be suspended pending final disposition of the earlier-filed referenced applications.

In response to this Office action, applicant may present arguments in support of registration by addressing the issue of the potential conflict between applicant's mark and the marks in the referenced applications. Applicant's election not to submit arguments at this time in no way limits applicant's right to address this issue later if a refusal under Section 2(d) issues.

Although applicant's mark has been refused registration, applicant may respond to the refusal(s) by submitting evidence and arguments in support of registration. However, if applicant responds to the refusal(s), applicant must also respond to the requirement(s) set forth below.

AMENDED IDENTIFICATION OF GOODS AND SERVICES REQUIRED

The applicant's identification of goods and services contains a number of words that are indefinite and/or overbroad as it contains words that do not clearly identify goods and services within a class and/or could identify goods and services in more than one international class. *See* 37 C.F.R. §2.32(a)(6); TMEP §§ 1402.01, 1402.03.

Moreover, m

ultiple identifications for software in International Classes 009 are indefinite and too broad and must be clarified to specify (1) the purpose or function of the software and its content or field of use, if content- or field- specific; and/or (2) whether its format is downloadable or recorded. *See* 37 C.F.R. §2.32(a)(6); TMEP §§1402.03(d), 1402.11(a). Downloadable and recorded goods are in International Class 9, whereas providing their temporary, online non-downloadable use is a service in International Class 42. *See* TMEP §1402.03(d).

The USPTO requires such specificity in order for a trademark examining attorney to examine the application properly and make appropriate decisions concerning possible conflicts between the applicant's mark and other marks. *See In re N.A.D. Inc.*, 57 USPQ2d 1872, 1874 (TTAB 2000); TMEP §1402.03(d).

The international classification of goods in applications filed under Trademark Act Section 66(a) cannot be changed from the classification the International Bureau assigned to the goods in the corresponding international registration. 37 C.F.R. §2.85(d); TMEP §1401.03(d). Therefore, although software may be classified in international classes other than International Class 9, any modification to the identification must identify goods in International Class 9 only, the class specified in the application for such goods. *See* TMEP §1904.02(c)(ii).

Applicant should also note that the USPTO has the discretion to determine the degree of particularity needed to clearly identify goods and/or services covered by a mark. *In re SICPA Holding*, 2021 USPQ2d 613, at *4 (TTAB 2021) (quoting *In re Omega SA*, 494 F.3d 1362, 1365, 83 USPQ2d 1541, 1543-44 (Fed. Cir. 2007)). Accordingly, the USPTO requires the description of goods and/or services in a U.S. application to be specific, definite, clear, accurate, and concise. *In re tapio GmbH*, 2020 USPQ2d 11387, at *6 (TTAB 2020) (quoting *In re Cordua Rests., Inc.*, 823 F.3d 594, 605, 118 USPQ2d 1632, 1639 (Fed. Circ. 2016)); TMEP §1402.01.

Finally, the identification of goods and/or services contains brackets. Generally, an applicant should *not* use parentheses and brackets, including curly brackets, in identifications in order to avoid confusion with the USPTO's practice of using parentheses and brackets in registrations to indicate (1) goods and/or services that have been deleted from registrations, (2) goods and/or services not claimed in an affidavit of incontestability, or (3) guidance to users of the USPTO's *U.S. Acceptable Identification of Goods and Services Manual* to draft an acceptable identification. *See* TMEP §§1402.04, 1402.12. The only exception for including parenthetical information in identifications is if it serves to explain or translate the matter immediately preceding the parenthetical phrase in such a way that it does not affect the clarity or scope of the identification, e.g., "fried tofu pieces (abura-age)." *See* TMEP §1402.12.

Applicant may adopt the following wording to address the errors identified above, if accurate (please note, added language has been bolded and removed language has been struck through):

- Class 009: {state format, e.g., downloadable, recorded, etc.} Software for {state function, e.g., use as a spreadsheet, word processing, database integration, etc.} in the field of distributed ledger technology, cryptocurrencies, non- fungible tokens and other digital assets; {state format, e.g., downloadable, recorded, etc.} software for {state function, e.g., use as a spreadsheet, word processing, database integration, etc.} in the field of decentralised applications; {state format, e.g., downloadable, recorded, etc.} software for {state function, e.g., use as a spreadsheet, word processing, database integration, etc.} in the field of decentralised finance; {state format, e.g., downloadable, recorded, etc.} software for buying and selling cryptocurrencies, ~~non-fungible~~ **non-fungible** tokens and other digital assets; {state format, e.g., downloadable, recorded, etc.} software for creating and issuing cryptocurrencies, ~~non-fungible~~ **non-fungible** tokens and other digital assets; downloadable e-wallets **being downloadable computer software for use as an electronic wallet**; {state format, e.g., downloadable, recorded, etc.} software for use as an **electronic wallet** for securing and storing cryptocurrencies, ~~non-fungible~~ **non-fungible** tokens and other digital assets; {state format, e.g., downloadable, recorded, etc.} computer software for database and network management; {state format, e.g., downloadable, recorded, etc.} computer software for encryption; {state format, e.g., downloadable, recorded, etc.} computer application software for use {state function, e.g., connecting, operating, managing, etc.} networked {indicate devices, e.g., cars, kitchen appliances, HVAC systems, etc.} in ~~implementing~~ the internet of things ~~[i_ot]~~ (IoT); {state format, e.g., downloadable, recorded, etc.} {state function of software, e.g., networking, communications, etc.} software for connecting global computer networks; {state format, e.g., downloadable, recorded, etc.} {state function of software, e.g., networking, communications, etc.} computer software for {state function, e.g., monitoring, controlling, etc.} communication between computers over a local network; {state format, e.g., downloadable, recorded, etc.} software to enable secure financial transactions; {state format, e.g., downloadable, recorded, etc.} ~~computer software for electronic commerce software to allow users to perform electronic business transactions via a global computer network~~; {state format, e.g., downloadable, recorded, etc.} computer software for performing secure cryptocurrency transactions; {state format, e.g., downloadable, recorded, etc.} ~~machine-to-machine~~ **[m₂m]-machine-to-machine applications being software for {state function, e.g., use as a spreadsheet, word processing, database integration, etc.}**

- Class 036: Virtual currency services, **namely, {describe services in greater detail, e.g., virtual currency exchange services, virtual currency transfer services, etc.}**; electronic payment processing for virtual currencies; cryptocurrency services, namely, issuing virtual currency ~~or~~ **and** digital tokens **of value** for use by members of an online community via a global computer network; cryptocurrency services, namely, issuing of a peer-to-peer digital currency **of value** that incorporates cryptographic protocols, operates over the internet, and is used as a method of payment for goods and services; issuing of tokens of value, namely, issuing of stablecoins, stable tokens, tokenized fiat, tokenized assets, virtual currency and digital tokens of value using smart contracts, asset-backed tokens, fiat-backed tokens and digital assets; electronic financial trading services, namely, ~~digital assets~~ **{describe digital assets being traded in greater detail, e.g., digital currency, digital securities, cryptocurrency, etc.}** trading services; currency transfer services, namely, transfer of ~~digital assets~~ **{describe digital assets being traded in greater detail, e.g., digital currency, digital securities, cryptocurrency, etc.}**; financial services, namely, ~~for~~ buying, selling and trading **{describe items being traded, e.g., art images, music, video clips, etc.}** authenticated by non-fungible tokens; decentralised finance services, **namely, {describe financial services in greater detail, e.g., microfinance lending services, asset and investment acquisition, vehicle title loans, etc.}**
- Class 042: Development of software for distributed ledger technology, including cryptocurrencies, non-fungible tokens and other digital assets; development of software for secure network operations; technical advisory services **in the field of {state Class 042 field, e.g., cryptocurrency, datacenter architecture, artificial intelligence software customization, etc.}** relating to distributed ledger technology, including cryptocurrencies, ~~non-fungible~~ **non-fungible** tokens and other digital assets; expert consultancy services ~~in connection with computing networks~~ **in the field of {describe consulting services in greater detail to identify Class 042 services, e.g., computer network security, computer networking hardware design, design of computer networks, etc.}**; providing **technology** information ~~about the~~ **in the field of** design and development of computer software, systems and networks relating to distributed ledger technology, including cryptocurrencies, ~~non-fungible~~ **non-fungible** tokens and other digital assets; computer programming services for electronic data security; programming of operating software for computer networks and servers; data security consultancy; design and development of electronic data security systems; data encryption and decoding services

For assistance with identifying and classifying goods and services in trademark applications, please see the USPTO's online searchable *U.S. Acceptable Identification of Goods and Services Manual*. See TMEP §1402.04.

Applicant's goods and/or services may be clarified or limited, but may not be expanded beyond those originally itemized in the application or as acceptably narrowed. *See* 37 C.F.R. §2.71(a); TMEP §§1402.06, 1904.02(c)(iv). Applicant may clarify or limit the identification by inserting qualifying language or deleting items to result in a more specific identification; however, applicant may not substitute different goods and/or services or add goods and/or services not found or encompassed by those in the original application or as acceptably narrowed. *See* TMEP §1402.06(a)-(b). The scope of the goods and/or services sets the outer limit for any changes to the identification and is generally determined by the ordinary meaning of the wording in the identification. TMEP §§1402.06(b), 1402.07(a)-(b). Any acceptable changes to the goods and/or services will further limit scope, and once goods and/or services are deleted, they are not permitted to be reinserted. TMEP §1402.07(e). Additionally, for applications filed under Trademark Act Section 66(a), the scope of the identification for purposes of permissible amendments is limited by the international class assigned by the International Bureau of the World Intellectual Property Organization (International Bureau); and the classification of goods and/or services may not be changed from that assigned by the International Bureau. 37 C.F.R. §2.85(d); TMEP §§1401.03(d), 1904.02(b). Further, in a multiple-class Section 66(a) application, classes may not be added or goods and/or services transferred from one existing class to another. 37 C.F.R. §2.85(d); TMEP §1401.03(d).

MARK DESCRIPTION AND AMENDED COLOR CLAIM REQUIRED

Applicant must submit a description of the mark. 37 C.F.R. §2.37; *see* TMEP §§808.01, 808.02. Applications for marks not in standard characters must include an accurate and concise description of the entire mark that identifies all the literal and design elements. *See* 37 C.F.R. §2.37; TMEP §§808 *et seq.* In this case, the drawing of the mark is not in standard characters.

Applicant must also submit an amended color claim as "green-turquoise" is not a generic color.

Generic color names must be used to describe the colors in a color claim and description, e.g., red, yellow, blue. TMEP §807.07(a)(i)-(ii).

The following description and amended color claim are suggested, if accurate:

- **Mark Description: The mark consists of a design of a turquoise circle detached along a diagonal to resemble two semicircles. This design is**

placed to the left of the black wording “SHIMMER”.

- Amended Color Claim: The color(s) turquoise and black is/are claimed as a feature of the mark.

CLARIFICATION OF FOREIGN ENTITY REQUIRED

The application identifies applicant as a “Foundation under German civil code”, which is not acceptable as an entity designation in the United States because there is no clear U.S. equivalent legal entity and the entity designation does not appear in Appendix D of the *Trademark Manual of Examining Procedure*. See TMEP §803.03(i). Applicant must indicate the U.S. equivalent of its legal entity or provide a description of the nature of the foreign entity. See 37 C.F.R. §§2.32(a)(3), 2.61(b); TMEP §803.03(i).

EMAIL ADDRESS REQUIRED

Applicant must provide applicant’s email address, which is a requirement for a complete application. See 37 C.F.R. §2.32(a)(2); Mandatory Electronic Filing & Specimen Requirements, Examination Guide 1-20, at III.A. (Rev. Feb. 2020). Applicant’s email address cannot be identical to the listed primary correspondence email address of any attorney retained to represent applicant in this application. See Examination Guide 1-20, at III.A.

U.S.-LICENSED ATTORNEY REQUIRED

Applicant must be represented by a U.S.-licensed attorney to respond to or appeal the provisional refusal. An applicant whose domicile is located outside of the United States or its territories is foreign-domiciled and must be represented by an attorney who is an active member in good standing of the bar of the highest court of a U.S. state or territory. 37 C.F.R. §§2.11(a), 11.14; Requirement of U.S.-Licensed Attorney for Foreign-Domiciled Trademark Applicants & Registrants, Examination Guide 4-19, at I.A. (Rev. Sept. 2019). An individual applicant’s domicile is the place a person resides and intends to be the person’s principal home. 37 C.F.R. §2.2(o); Examination Guide 4-19, at I.A. A juristic entity’s domicile is the principal place of business; i.e., headquarters, where a juristic entity applicant’s senior executives or officers ordinarily direct and control the entity’s activities. 37 C.F.R. §2.2(o); Examination Guide 4-19, at I.A. Because applicant is foreign-domiciled, applicant must appoint such a U.S.-

licensed attorney qualified to practice under 37 C.F.R. §11.14 as its representative before the application may proceed to registration. 37 C.F.R. §2.11(a). See Hiring a U.S.-licensed trademark attorney at <https://www.uspto.gov/trademarks-getting-started/why-hire-private-trademark-attorney> for more information.

Only a U.S.-licensed attorney can take action on an application on behalf of a foreign-domiciled applicant. 37 C.F.R. §2.11(a). Accordingly, the USPTO will not communicate further with applicant about the application beyond this Office action or permit applicant to make future submissions in this application. And applicant is not authorized to make amendments to the application.

To appoint or designate a U.S.-licensed attorney. To appoint an attorney, applicant should submit a completed Trademark Electronic Application System (TEAS) Change Addressor Representation form at <https://teas.uspto.gov/wna/ccr/car>. The newly-appointed attorney must submit a TEAS Response to Examining Attorney Office Action form at <https://teas.uspto.gov/office/roa/> indicating that an appointment of attorney has been made and address all other refusals or requirements in this action, if any. Alternatively, if applicant retains an attorney before filing the response, the attorney can respond to this Office action by using the appropriate TEAS response form and provide his or her attorney information in the form and sign it as applicant's attorney. See 37 C.F.R. §2.17(b)(1)(ii).

RESPONDING TO THIS OFFICE ACTION

For this application to proceed, applicant must explicitly address each refusal and/or requirement in this Office action. For a refusal, applicant may provide written arguments and evidence against the refusal, and may have other response options if specified above. For a requirement, applicant should set forth the changes or statements. Please see “[Responding to Office Actions](#)” and the informational [video “Response to Office Action”](#) for more information and tips on responding.

Please call or email the assigned trademark examining attorney with questions about this Office action. Although an examining attorney cannot provide legal advice, the examining attorney can provide additional explanation about the refusal(s) and/or requirement(s) in this Office action. See TMEP §§705.02, 709.06.

The USPTO does not accept emails as responses to Office actions; however, emails can be used for informal communications and are included in the application record. *See* 37 C.F.R. §§2.62(c), 2.191; TMEP §§304.01-.02, 709.04-.05.

How to respond. Click to file a response to this nonfinal Office action.

/Alberto I. Manca/

Alberto I. Manca

Trademark Examining Attorney

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RESPONSE GUIDANCE

- **Missing the response deadline to this letter will cause the application to abandon.** The response must be received by the USPTO before midnight **Eastern Time** of the last day of the response period. TEAS maintenance or unforeseen circumstances could affect an applicant's ability to timely respond.
- **Responses signed by an unauthorized party** are not accepted and can **cause the application to abandon**. If applicant does not have an attorney, the response must be signed by the individual applicant, all joint applicants, or someone with legal authority to bind a juristic applicant. If applicant has an attorney, the response must be signed by the attorney.
- If needed, **find contact information for the supervisor** of the office or unit listed in the signature block.

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

U.S. Application Serial No. 79345163

Mark: SHIMMER

Correspondence Address:

Dentons Europe LLP
Thurn-und-Taxis-Platz 6
60313 Frankfurt GERMANY

Applicant: IOTA Stiftung

Reference/Docket No. N/A

Correspondence Email Address:

NONFINAL OFFICE ACTION
Notice of Provisional Full Refusal

International Registration No. 1672527

Deadline for responding. The USPTO must receive applicant's response **within six months of the "date on which the notification was sent to WIPO (mailing date)"** located on the WIPO cover letter, or the U.S. application will be abandoned (see <https://www.uspto.gov/trademarks-application-process/abandoned-applications> for information on abandonment). To confirm the mailing date, go to the USPTO's Trademark Status and Document Retrieval (TSDR) database at <https://tsdr.uspto.gov/>, select "US Serial, Registration, or Reference No.," enter the U.S. application serial number in the blank text box, and click on "Documents." The mailing date used to calculate the response deadline is the "Create/Mail Date" of the "IB-1st Refusal Note."

Respond to this Office action using the USPTO's Trademark Electronic Application System (TEAS). A link to the appropriate TEAS response form appears at the end of this Office action.

Discussion of provisional full refusal. This is a provisional full refusal of the request for extension of protection to the United States of the international registration, known in the United States as a U.S. application based on Trademark Act Section 66(a). See 15 U.S.C. §§1141f(a), 1141h(c).

The referenced application has been reviewed by the assigned trademark examining attorney. Applicant must respond timely and completely to the issue(s) below. 15 U.S.C. §1062(b); 37 C.F.R. §§2.62(a), 2.65(a); TMEP §§711, 718.03.

SUMMARY OF ISSUES:

- SECTION 2(d) REFUSAL – LIKELIHOOD OF CONFUSION IN PART
- ADVISORY: PRIOR-FILED APPLICATIONS
- AMENDED IDENTIFICATION OF GOODS AND SERVICES REQUIRED
- MARK DESCRIPTION AND AMENDED COLOR CLAIM REQUIRED
- CLARIFICATION OF FOREIGN ENTITY REQUIRED
- EMAIL ADDRESS REQUIRED
- U.S.-LICENSED ATTORNEY REQUIRED

SECTION 2(d) REFUSAL – LIKELIHOOD OF CONFUSION IN PART

Please note—This refusal applies only to the following Class 009 goods identified by applicant: "software for decentralised applications; . . . software for connecting global computer networks; computer software for communication between computers over a local network; . . . machine- to-machine [m2m] applications".

Registration of the applied-for mark is refused because of a likelihood of confusion with the mark in U.S. Registration No. 5076322. Trademark Act Section 2(d), 15 U.S.C. §1052(d); *see* TMEP §§1207.01 *et seq.* See the attached registration.

Applicant's mark is "SHIMMER" (stylized characters plus design) for, in relevant part, "software for decentralised applications; . . . software for connecting global computer networks; computer software for communication between computers over a local network; . . . machine- to- machine [m2m] applications" in International Class 009.

Registrant's mark is "SHIMMER GOLD" (standard characters) for, in relevant part, "Computer application software for the integration of text, audio, graphics, still images and moving pictures into an interactive delivery for multimedia applications; Computer application software for mobile phones for receiving and transmission of messages in the nature of data, text, language, sound, image and video" in International Class 009.

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 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. *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 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).

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).

Applicant’s mark, “SHIMMER”, and registrant’s mark, “SHIMMER GOLD”, create an overall similar commercial impression. The wording in applicant’s mark is fully incorporated within registrant’s mark. Incorporating the entirety of the wording of one mark within another does not obviate the similarity between the compared marks, as in the present case, nor does it overcome a likelihood of confusion under Section 2(d). *See Wella Corp. v. Cal. Concept Corp.*, 558 F.2d 1019, 1022, 194 USPQ 419, 422 (C.C.P.A. 1977) (holding CALIFORNIA CONCEPT and surfer design and CONCEPT confusingly similar); *Coca-Cola Bottling Co. v. Jos. E. Seagram & Sons, Inc.*, 526 F.2d 556, 557, 188 USPQ 105, 106 (C.C.P.A. 1975) (holding BENGAL LANCER and design and BENGAL confusingly similar); *Double Coin Holdings, Ltd. v. Tru Dev.*, 2019 USPQ2d 377409, at *6-7 (TTAB 2019) (holding ROAD WARRIOR and WARRIOR (stylized) confusingly similar); *In re Mr. Recipe, LLC*, 118 USPQ2d 1084, 1090 (TTAB 2016) (holding JAWS DEVOUR YOUR HUNGER and JAWS confusingly similar); TMEP §1207.01(b)(iii). In the present case, the marks are identical in part.

In addition, while registrant’s mark includes the wording “GOLD”, not present in applicant’s mark, applicant’s mark is likely to appear to prospective purchasers as a shortened form of registrant’s mark. *See In re Mighty Leaf Tea*, 601 F.3d 1342, 1348, 94 USPQ2d 1257, 1260 (Fed. Cir. 2010) (quoting *United States Shoe Corp.*, 229 USPQ 707, 709 (TTAB 1985)). Thus, merely omitting some of the wording from a registered mark may not overcome a likelihood of confusion. *See In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257; *In re Optica Int’l*, 196 USPQ 775, 778 (TTAB 1977); TMEP §1207.01(b)(ii)-(iii). In this case, applicant’s mark does not create a distinct commercial impression from the registered mark because it contains some of the wording in the registered mark and does not add any wording that would distinguish it from that mark.

Finally, while applicant’s mark includes a design whereas registrant’s mark is in standard characters, when evaluating a composite mark consisting of words and a design, the word portion is normally

accorded greater weight because it is likely to make a greater impression upon purchasers, be remembered by them, and be used by them to refer to or request the goods. *In re Aquitaine Wine USA, LLC*, 126 USPQ2d 1181, 1184 (TTAB 2018) (citing *In re Viterro Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012)); TMEP §1207.01(c)(ii). Thus, although marks must be compared in their entireties, the word portion is often considered the dominant feature and is accorded greater weight in determining whether marks are confusingly similar, even where the word portion has been disclaimed. *In re Viterro Inc.*, 671 F.3d at 1366-67, 101 USPQ2d at 1911 (citing *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 1570-71, 218 USPQ2d 390, 395 (Fed. Cir. 1983)).

Relatedness of the Goods

The goods 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).

The compared goods 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] 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 uses broad wording to describe "software for decentralised applications; . . . software for connecting global computer networks; computer software for communication between computers over a local network; . . . machine- to- machine [m2m] applications" in International Class 009, which presumably encompasses all goods of the type described, including registrant's more narrow "Computer application software for the integration of text, audio, graphics, still images and moving pictures into an interactive delivery for multimedia applications; Computer application software for mobile phones for receiving and transmission of messages in the nature of data, text, language, sound, image and video". *See, e.g., 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 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)).

Additionally, the goods 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 Viterro 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)). Thus, applicant's and registrant's goods and/or services are related

Based on the *du Pont* factors discussed above, a likelihood of confusion exists between applicant's and registrant's marks because these marks create a confusingly similar commercial impression and the goods at issue are overlapping. Therefore, applicant's mark is refused registration under Trademark Act Section 2(d).

Applicant should note the following additional potential ground for refusal.

ADVISORY: PRIOR-FILED APPLICATION

The filing dates of pending U.S. Application Serial Nos. 90578022, 90208037, and 79299245 precede applicant's filing date. See attached referenced applications. 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 mark(s). See 15 U.S.C. §1052(d); 37 C.F.R. §2.83; TMEP §§1208 *et seq.* Therefore, upon receipt of applicant's response to this Office action, action on this application may be suspended pending final disposition of the earlier-filed referenced applications.

In response to this Office action, applicant may present arguments in support of registration by addressing the issue of the potential conflict between applicant's mark and the marks in the referenced applications. Applicant's election not to submit arguments at this time in no way limits applicant's right to address this issue later if a refusal under Section 2(d) issues.

Although applicant's mark has been refused registration, applicant may respond to the refusal(s) by submitting evidence and arguments in support of registration. However, if applicant responds to the refusal(s), applicant must also respond to the requirement(s) set forth below.

AMENDED IDENTIFICATION OF GOODS AND SERVICES REQUIRED

The applicant's identification of goods and services contains a number of words that are indefinite and/or overbroad as it contains words that do not clearly identify goods and services within a class and/or could identify goods and services in more than one international class. See 37 C.F.R. §2.32(a)(6); TMEP §§ 1402.01, 1402.03.

Moreover, multiple identifications for software in International Classes 009 are indefinite and too broad and must be clarified to specify (1) the purpose or function of the software and its content or field of use, if content- or field- specific; and/or (2) whether its format is downloadable or recorded. See 37 C.F.R. §2.32(a)(6); TMEP §§1402.03(d), 1402.11(a). Downloadable and recorded goods are in International Class 9, whereas providing their temporary, online non-downloadable use is a service in International Class 42. See TMEP §1402.03(d).

The USPTO requires such specificity in order for a trademark examining attorney to examine the application properly and make appropriate decisions concerning possible conflicts between the applicant's mark and other marks. See *In re N.A.D. Inc.*, 57 USPQ2d 1872, 1874 (TTAB 2000); TMEP §1402.03(d).

The international classification of goods in applications filed under Trademark Act Section 66(a) cannot be changed from the classification the International Bureau assigned to the goods in the corresponding international registration. 37 C.F.R. §2.85(d); TMEP §1401.03(d). Therefore, although

software may be classified in international classes other than International Class 9, any modification to the identification must identify goods in International Class 9 only, the class specified in the application for such goods. *See* TMEP §1904.02(c)(ii).

Applicant should also note that the USPTO has the discretion to determine the degree of particularity needed to clearly identify goods and/or services covered by a mark. *In re SICPA Holding*, 2021 USPQ2d 613, at *4 (TTAB 2021) (quoting *In re Omega SA*, 494 F.3d 1362, 1365, 83 USPQ2d 1541, 1543-44 (Fed. Cir. 2007)). Accordingly, the USPTO requires the description of goods and/or services in a U.S. application to be specific, definite, clear, accurate, and concise. *In re tapio GmbH*, 2020 USPQ2d 11387, at *6 (TTAB 2020) (quoting *In re Cordua Rests., Inc.*, 823 F.3d 594, 605, 118 USPQ2d 1632, 1639 (Fed. Circ. 2016)); TMEP §1402.01.

Finally, the identification of goods and/or services contains brackets. Generally, an applicant should *not* use parentheses and brackets, including curly brackets, in identifications in order to avoid confusion with the USPTO's practice of using parentheses and brackets in registrations to indicate (1) goods and/or services that have been deleted from registrations, (2) goods and/or services not claimed in an affidavit of incontestability, or (3) guidance to users of the USPTO's *U.S. Acceptable Identification of Goods and Services Manual* to draft an acceptable identification. *See* TMEP §§1402.04, 1402.12. The only exception for including parenthetical information in identifications is if it serves to explain or translate the matter immediately preceding the parenthetical phrase in such a way that it does not affect the clarity or scope of the identification, e.g., "fried tofu pieces (abura-age)." *See* TMEP §1402.12.

Applicant may adopt the following wording to address the errors identified above, if accurate (please note, added language has been bolded and removed language has been struck through):

- **Class 009: {state format, e.g., downloadable, recorded, etc.} Software for {state function, e.g., use as a spreadsheet, word processing, database integration, etc.} in the field of distributed ledger technology, cryptocurrencies, non- fungible tokens and other digital assets; {state format, e.g., downloadable, recorded, etc.} software for {state function, e.g., use as a spreadsheet, word processing, database integration, etc.} in the field of decentralised applications; {state format, e.g., downloadable, recorded, etc.} software for {state function, e.g., use as a spreadsheet, word processing, database integration, etc.} in the field of decentralised finance; {state format, e.g., downloadable, recorded, etc.} software for buying and selling cryptocurrencies, ~~non-fungible~~ **non-fungible** tokens and other digital assets; {state format, e.g., downloadable, recorded, etc.} software for creating and issuing cryptocurrencies, ~~non-fungible~~ **non-fungible** tokens and other digital assets; downloadable e-wallets **being downloadable computer software for use as an electronic wallet**; {state format, e.g., downloadable, recorded, etc.} software **for use as an electronic wallet** for securing and storing cryptocurrencies, ~~non-fungible~~ **non-fungible** tokens and other digital assets; {state format, e.g., downloadable, recorded, etc.} computer software for database and network management; {state format, e.g., downloadable, recorded, etc.} computer software for encryption; {state format, e.g., downloadable, recorded, etc.} computer application software for ~~use~~ {state function, e.g., connecting, operating, managing, etc.} **networked {indicate devices, e.g., cars, kitchen appliances, HVAC systems, etc.} in implementing the internet of things {iot} (IoT)**; {state format, e.g., downloadable, recorded, etc.} {state function of software, e.g., networking, communications, etc.} software for connecting global computer networks; {state format, e.g., downloadable, recorded, etc.} {state function of software, e.g., networking, communications, etc.} computer software for {state function, e.g., monitoring, controlling, etc.} communication between computers over a local network; {state format, e.g.,**

downloadable, recorded, etc.} software to enable secure financial transactions; **{state format, e.g., downloadable, recorded, etc.}** computer software ~~for~~ electronic commerce **software to allow users to perform electronic business transactions via a global computer network;** **{state format, e.g., downloadable, recorded, etc.}** computer software for performing secure cryptocurrency transactions; **{state format, e.g., downloadable, recorded, etc.}** ~~machine-to-machine [m2m]~~ **machine-to-machine applications being software for {state function, e.g., use as a spreadsheet, word processing, database integration, etc.}**

- Class 036: Virtual currency services, **namely, {describe services in greater detail, e.g., virtual currency exchange services, virtual currency transfer services, etc.}**; electronic payment processing for virtual currencies; cryptocurrency services, namely, issuing virtual currency ~~or~~ **and digital tokens of value** for use by members of an online community via a global computer network; cryptocurrency services, namely, issuing of a peer-to-peer digital currency **of value** that incorporates cryptographic protocols, operates over the internet, and is used as a method of payment for goods and services; issuing of tokens of value, namely, issuing of stablecoins, stable tokens, tokenized fiat, tokenized assets, virtual currency and digital tokens of value using smart contracts, asset-backed tokens, fiat-backed tokens and digital assets; electronic financial trading services, namely, ~~digital assets~~ **{describe digital assets being traded in greater detail, e.g., digital currency, digital securities, cryptocurrency, etc.}** trading services; currency transfer services, namely, transfer of ~~digital assets~~ **{describe digital assets being traded in greater detail, e.g., digital currency, digital securities, cryptocurrency, etc.}**; financial services, namely, ~~for~~ buying, selling and trading **{describe items being traded, e.g., art images, music, video clips, etc.}** authenticated by non-fungible tokens; decentralised finance services, **namely, {describe financial services in greater detail, e.g., microfinance lending services, asset and investment acquisition, vehicle title loans, etc.}**
- Class 042: Development of software for distributed ledger technology, including cryptocurrencies, non-fungible tokens and other digital assets; development of software for secure network operations; technical advisory services **in the field of {state Class 042 field, e.g., cryptocurrency, datacenter architecture, artificial intelligence software customization, etc.}** relating to distributed ledger technology, including cryptocurrencies, ~~non-fungible non-fungible~~ tokens and other digital assets; expert consultancy services ~~in connection with computing networks~~ **in the field of {describe consulting services in greater detail to identify Class 042 services, e.g., computer network security, computer networking hardware design, design of computer networks, etc.}**; providing **technology** information ~~about the~~ **in the field of** design and development of computer software, systems and networks relating to distributed ledger technology, including cryptocurrencies, ~~non-fungible non-fungible~~ tokens and other digital assets; computer programming services for electronic data security; programming of operating software for computer networks and servers; data security consultancy; design and development of electronic data security systems; data encryption and decoding services

For assistance with identifying and classifying goods and services in trademark applications, please see the USPTO's online searchable *U.S. Acceptable Identification of Goods and Services Manual*. See TMEP §1402.04.

Applicant's goods and/or services may be clarified or limited, but may not be expanded beyond those originally itemized in the application or as acceptably narrowed. See 37 C.F.R. §2.71(a); TMEP §§1402.06, 1904.02(c)(iv). Applicant may clarify or limit the identification by inserting qualifying language or deleting items to result in a more specific identification; however, applicant may not substitute different goods and/or services or add goods and/or services not found or encompassed by those in the original application or as acceptably narrowed. See TMEP §1402.06(a)-(b). The scope of

the goods and/or services sets the outer limit for any changes to the identification and is generally determined by the ordinary meaning of the wording in the identification. TMEP §§1402.06(b), 1402.07(a)-(b). Any acceptable changes to the goods and/or services will further limit scope, and once goods and/or services are deleted, they are not permitted to be reinserted. TMEP §1402.07(e). Additionally, for applications filed under Trademark Act Section 66(a), the scope of the identification for purposes of permissible amendments is limited by the international class assigned by the International Bureau of the World Intellectual Property Organization (International Bureau); and the classification of goods and/or services may not be changed from that assigned by the International Bureau. 37 C.F.R. §2.85(d); TMEP §§1401.03(d), 1904.02(b). Further, in a multiple-class Section 66(a) application, classes may not be added or goods and/or services transferred from one existing class to another. 37 C.F.R. §2.85(d); TMEP §1401.03(d).

MARK DESCRIPTION AND AMENDED COLOR CLAIM REQUIRED

Applicant must submit a description of the mark. 37 C.F.R. §2.37; *see* TMEP §§808.01, 808.02. Applications for marks not in standard characters must include an accurate and concise description of the entire mark that identifies all the literal and design elements. *See* 37 C.F.R. §2.37; TMEP §§808 *et seq.* In this case, the drawing of the mark is not in standard characters.

Applicant must also submit an amended color claim as "green-turquoise" is not a generic color. Generic color names must be used to describe the colors in a color claim and description, e.g., red, yellow, blue. TMEP §807.07(a)(i)-(ii).

The following description and amended color claim are suggested, if accurate:

- **Mark Description: The mark consists of a design of a turquoise circle detached along a diagonal to resemble two semicircles. This design is placed to the left of the black wording "SHIMMER".**
- **Amended Color Claim: The color(s) turquoise and black is/are claimed as a feature of the mark.**

CLARIFICATION OF FOREIGN ENTITY REQUIRED

The application identifies applicant as a "Foundation under German civil code", which is not acceptable as an entity designation in the United States because there is no clear U.S. equivalent legal entity and the entity designation does not appear in Appendix D of the *Trademark Manual of Examining Procedure*. *See* TMEP §803.03(i). Applicant must indicate the U.S. equivalent of its legal entity or provide a description of the nature of the foreign entity. *See* 37 C.F.R. §§2.32(a)(3), 2.61(b); TMEP §803.03(i).

EMAIL ADDRESS REQUIRED

Applicant must provide applicant's email address, which is a requirement for a complete application. *See* 37 C.F.R. §2.32(a)(2); *Mandatory Electronic Filing & Specimen Requirements*, Examination Guide 1-20, at III.A. (Rev. Feb. 2020). Applicant's email address cannot be identical to the listed primary correspondence email address of any attorney retained to represent applicant in this application. *See* Examination Guide 1-20, at III.A.

U.S.-LICENSED ATTORNEY REQUIRED

Applicant must be represented by a U.S.-licensed attorney to respond to or appeal the provisional refusal. An applicant whose domicile is located outside of the United States or its territories is foreign-domiciled and must be represented by an attorney who is an active member in good standing of the bar of the highest court of a U.S. state or territory. 37 C.F.R. §§2.11(a), 11.14; Requirement of U.S.-Licensed Attorney for Foreign-Domiciled Trademark Applicants & Registrants, Examination Guide 4-19, at I.A. (Rev. Sept. 2019). An individual applicant's domicile is the place a person resides and intends to be the person's principal home. 37 C.F.R. §2.2(o); Examination Guide 4-19, at I.A. A juristic entity's domicile is the principal place of business; i.e., headquarters, where a juristic entity applicant's senior executives or officers ordinarily direct and control the entity's activities. 37 C.F.R. §2.2(o); Examination Guide 4-19, at I.A. Because applicant is foreign-domiciled, applicant must appoint such a U.S.-licensed attorney qualified to practice under 37 C.F.R. §11.14 as its representative before the application may proceed to registration. 37 C.F.R. §2.11(a). See Hiring a U.S.-licensed trademark attorney at <https://www.uspto.gov/trademarks-getting-started/why-hire-private-trademark-attorney> for more information.

Only a U.S.-licensed attorney can take action on an application on behalf of a foreign-domiciled applicant. 37 C.F.R. §2.11(a). Accordingly, the USPTO will not communicate further with applicant about the application beyond this Office action or permit applicant to make future submissions in this application. And applicant is not authorized to make amendments to the application.

To appoint or designate a U.S.-licensed attorney. To appoint an attorney, applicant should submit a completed Trademark Electronic Application System (TEAS) Change Address or Representation form at <https://teas.uspto.gov/wna/ccr/car>. The newly-appointed attorney must submit a TEAS Response to Examining Attorney Office Action form at <https://teas.uspto.gov/office/roa/> indicating that an appointment of attorney has been made and address all other refusals or requirements in this action, if any. Alternatively, if applicant retains an attorney before filing the response, the attorney can respond to this Office action by using the appropriate TEAS response form and provide his or her attorney information in the form and sign it as applicant's attorney. See 37 C.F.R. §2.17(b)(1)(ii).

RESPONDING TO THIS OFFICE ACTION

For this application to proceed, applicant must explicitly address each refusal and/or requirement in this Office action. For a refusal, applicant may provide written arguments and evidence against the refusal, and may have other response options if specified above. For a requirement, applicant should set forth the changes or statements. Please see "Responding to Office Actions" and the informational video "Response to Office Action" for more information and tips on responding.

Please call or email the assigned trademark examining attorney with questions about this Office action. Although an examining attorney cannot provide legal advice, the examining attorney can provide additional explanation about the refusal(s) and/or requirement(s) in this Office action. See TMEP §§705.02, 709.06.

The USPTO does not accept emails as responses to Office actions; however, emails can be used for informal communications and are included in the application record. See 37 C.F.R. §§2.62(c), 2.191; TMEP §§304.01-.02, 709.04-.05.

How to respond. [Click to file a response to this nonfinal Office action.](#)

/Alberto I. Manca/
Alberto I. Manca

Trademark Examining Attorney
Law Office 108
(571) 272-5232
alberto.manca@uspto.gov

RESPONSE GUIDANCE

- **Missing the response deadline to this letter will cause the application to abandon.** The response must be received by the USPTO before midnight **Eastern Time** of the last day of the response period. TEAS maintenance or unforeseen circumstances could affect an applicant's ability to timely respond.
- Responses signed by an unauthorized party are not accepted and can **cause the application to abandon**. If applicant does not have an attorney, the response must be signed by the individual applicant, all joint applicants, or someone with legal authority to bind a juristic applicant. If applicant has an attorney, the response must be signed by the attorney.
- If needed, **find** contact information for the supervisor of the office or unit listed in the signature block.

Print: Mon Jul 18 2022

86745630

(4) STANDARD CHARACTER MARK

Shimmer Gold

Mark Punctuated
SHIMMER GOLD

Translation

Goods/Services

- IC 009. US 021 023 026 036 038.G & S: Smart phones; Portable communications apparatus, namely, handsets for MP3 players, walkie-talkies, satellite telephones and Personal Digital Assistants (PDA); Audio electronic components, namely, comprising surround sound speakers, loud speakers, tuners, sound mixers, equalizers, audio recorders, and radios; Apparatus for the recording/transmission or reproduction of sound and images; Computer application software for the integration of text, audio, graphics, still images and moving pictures into an interactive delivery for multimedia applications; Computer application software for mobile phones for receiving and transmission of messages in the nature of data, text, language, sound, image and video; Television receivers; Wearable smart phones; Mobile phone cases; Mobile phone stands; Stylus for smart phones; Portable chargers for mobile phones; Headphones; Earphones; Wireless headphones

Mark Drawing Code

(4) STANDARD CHARACTER MARK

Design Code

Serial Number

86745630

Filing Date

20150902

Current Filing Basis

44E

Original Filing Basis

1B;44D

Publication for Opposition Date

20160823

Registration Number

5076322

Date Registered

20161108

Owner

(REGISTRANT) LG ELECTRONICS INC. CORPORATION REPUBLIC OF KOREA 128, Yeoui-daero,
Yeongdeungpo-gu Seoul REPUBLIC OF KOREA 07336

Priority Date

20150311

Disclaimer Statement

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "GOLD" APART FROM THE MARK AS SHOWN

Description of Mark

Type of Mark

TRADEMARK

Register

PRINCIPAL

Live Dead Indicator

LIVE

Attorney of Record

Michael T. Smith

Print: Mon Jul 18 2022

90578022

(4) STANDARD CHARACTER MARK

SHIMMER

Mark Punctuated

SHIMMER

Translation

Goods/Services

- IC 009, US 021 023 026 036 038.G & S: Downloadable computer application software for computers and mobile phones, namely, software for improving driver safety; downloadable computer application software for mobile computers and vehicles, namely, software for alerting drivers of increased collision risk; vehicle-based electronic modules for alerting drivers of increased collision risk; vehicle-based electronic modules for vehicle-to-everything (V2X) communication

Mark Drawing Code

(4) STANDARD CHARACTER MARK

Design Code

Serial Number

90578022

Filing Date

20210314

Current Filing Basis

1B

Original Filing Basis

1B

Publication for Opposition Date

20211116

Registration Number

Date Registered

Owner

(APPLICANT) John Lindsay INDIVIDUAL UNITED STATES 11700 Preston Rd Ste 660-167 Dallas TEXAS 75230

Priority Date

Disclaimer Statement

Description of Mark

Type of Mark

TRADEMARK

Register

PRINCIPAL

Live Dead Indicator

LIVE

Attorney of Record

John Lindsay

Print: Mon Jul 18 2022

90208037

(4) STANDARD CHARACTER MARK

shimmer

Mark Punctuated

SHIMMER

Translation

Goods/Services

- IC 009. US 021 023 026 036 038.G & S: Computer software and computer peripheral devices, namely, LED lighting controls for use with commercial buildings for purposes of general illumination, energy management, lighting design and lighting digital effects, animation of lighting, and for use with specific apparatus such as lighting fixtures for indoor and outdoor environments, building products and peripherals in the nature of wireless switches, occupancy sensors, cameras and security devices, thermostats, window shade systems, and fans; Downloadable lighting control software for use in commercial and industrial facilities; Office automation systems comprised of computer hardware, wireless and wired controllers, and downloadable software for automating indoor and outdoor LED lights, building products and control peripherals in the nature of wireless switches, occupancy sensors, cameras and security devices, thermostats, window shade systems, and fans. FIRST USE: 20180115. FIRST USE IN COMMERCE: 20180415

Mark Drawing Code

(4) STANDARD CHARACTER MARK

Design Code

Serial Number

90208037

Filing Date

20200924

Current Filing Basis

1B

Original Filing Basis

1A

Publication for Opposition Date

Registration Number

Date Registered

Owner

(APPLICANT) Shimmer Industries, Inc DBA Shimmer CORPORATION DELAWARE 130 Kenyon Road
Morris CONNECTICUT 06763

Priority Date

Disclaimer Statement

Description of Mark

Type of Mark
TRADEMARK

Register
PRINCIPAL

Live Dead Indicator
LIVE

Attorney of Record
Karen Won

(4) STANDARD CHARACTER MARK

SHIMMR

Mark Punctuated
SHIMMR

Translation

Goods/Services

- IC 009. US 021 023 026 036 038.G & S: Advertising display apparatus for use in displaying advertisements within lightshow spectacles, shown at sporting or entertainment events, namely, electric luminescent display panels; downloadable computer software for using mobile electronic devices to generate and display lightshow spectacles, derived from video files, at sporting and entertainment events; recorded computer software for using mobile electronic devices to generate and display lightshow spectacles, derived from video files, at sporting and entertainment events; downloadable computer software applications for using mobile electronic devices to generate and display lightshow spectacles, derived from video files, at sporting and entertainment events; instruments for the projection of graphic images, being instruments for projecting lightshow spectacles at sporting and entertainment events, namely, liquid crystal display (LCD) projectors and photography projectors; visual display apparatus and visual display screens for use in lightshow spectacles displayed at sporting and entertainment events, namely, LCD large-screen displays; illuminated advertisements featured within lightshow spectacles displayed at sporting and entertainment events, namely, electronic advertisement boards featuring a neon lamp; video editing apparatus, namely, recorded computer programs for editing images, sound and video for use in creating and editing video files for use in a mobile software application to generate lightshows for display at sporting and entertainment events
- IC 035. US 100 101 102.G & S: Advertising services being the production and display of advertisements at lightshow entertainment events and within lightshow spectacles displayed at sporting and entertainment events, and the rental of advertising space within such displays; arranging exhibitions for advertising purposes, namely, the displaying advertisements for others within lightshow spectacles or at lightshow entertainment events; promotion of entertainment events; promotion of sports competitions and events
- IC 041. US 100 101 107.G & S: Multimedia production, other than for advertising purposes; production of audio and video recordings, other than advertising; production of sound recordings, other than advertising; video editing; video editing services for events; digital imaging services; video production services of entertainment videos; all of the foregoing services only being in relation to producing and editing lightshow spectacles for display at sporting and entertainment events; advisory services relating to entertainment; arranging of entertainment shows, namely, live music concerts and live sporting events; organisation of events for educational, entertainment, sporting or cultural purposes; entertainment services, namely, arranging and conducting entertainment competitions in the field of athletics; production of live entertainment in the nature of live concerts; all of the foregoing services only being in relation to lightshow spectacles displayed at sporting and entertainment events; rental of entertainment apparatus, namely, rental of audio equipment; rental of electrical apparatus for the recording of video signals, namely, rental of video equipment; rental of electrical apparatus for the reproduction of video signals; video equipment hire, namely, rental of audio visual equipment; video rental services; hire of sound recording apparatus, namely, rental of sound recordings; rental of sound reproducing apparatus; all of the foregoing only relating to the hire and rental of equipment for use in displaying lightshow spectacles at sporting and entertainment events; sound engineering services for events and sound

recording services relating only to the display of lightshow spectacles at sporting and entertainment events

- IC 042. US 100 101.G & S: Advisory services relating to computer software; computer software design; computer software development; computer software engineering; consultancy in the design and development of computer software; computer software application development in the field of audio and visual advertisement; installation and maintenance of computer software; rental of computer software; upgrading of computer software; writing of computer software; platform as a service (PaaS) featuring computer software platforms for using mobile electronic devices to generate and display lightshow spectacles, derived from video files, at sporting and entertainment events; hosting of software as a service (SaaS), namely, hosting software for use by others for using mobile electronic devices to generate and display lightshow spectacles, derived from video files, at sporting and entertainment events; software as a service (SaaS) featuring software for using mobile electronic devices to generate and display lightshow spectacles, derived from video files, at sporting and entertainment events; all the foregoing services only being in relation to software that enables the creation and generation of lightshows by electronic mobile devices for display at sporting and entertainment events; technological services, namely, providing temporary use of on-line, non-downloadable software for the transfer of images between different media, to use images in video files within lightshows that are generated through mobile electronic devices, for display at sporting and entertainment events; graphic design of promotional materials; graphic design of promotional matter; visual design services in the nature of designing visual elements for on-line, broadcast, print, outdoor and other communication media; multidisciplinary visual design services; all the foregoing design services only being in relation to designing the content of lightshow displays to be shown in sporting and entertainment venues

Mark Drawing Code

(4) STANDARD CHARACTER MARK

Design Code

Serial Number

79299245

Filing Date

20201027

Current Filing Basis

66A

Original Filing Basis

66A

Publication for Opposition Date

20220531

Registration Number

Date Registered

Owner

(APPLICANT) SCIMIAN PTY LTD PROPRIETARY LIMITED COMPANY AUSTRALIA PO BOX 586
NORTH CARLTON VIC 3054 AUSTRALIA

Priority Date

20200427

Disclaimer Statement

Description of Mark

Type of Mark

TRADEMARK, SERVICE MARK

Register

PRINCIPAL

Live Dead Indicator

LIVE

Attorney of Record

Robert Kleinman