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

U.S. Application Serial No. 79346376

Mark: KAN-THERM

Correspondence Address:

DANUTA DOBKOWSKA Ul. Rycerska 79 PL-15-159 BIALYSTOK POLAND

Applicant: KAN SP.Z O.O.

Reference/Docket No. N/A

Correspondence Email Address:

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

International Registration No. 0862220

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. applicationwill 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 DocumentRetrieval (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-1 rst Refusal Note."

Respond to this Office action using the USPTO's TrademarkElectronic 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
- AMENDED IDENTIFICATION OF GOODS AND SERVICES REQUIRED
- LEGAL NATURE AND PLACE INCORPORATED 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 applicant's goods in Class 009.

Registration of the applied-for mark is refused because of a likelihood of confusion with the marks in U.S. Registration Nos. 5885333 and 3026465. Trademark Act Section 2(d), 15 U.S.C. §1052(d); see TMEP §§1207.01 et seq.

See the attached registrations.

Applicant applied to register "KAN-THERM" (standard characters) for, in relevant part, "Water meters, colorimeters, circuit-breakers, compensators with sleeve, disc thermometers and manometers, room thermostats" in Class 009.

The cited marks are as follows:

• "KAN" (stylized wording plus design) (Reg. No. 5885333) for "Battery cables; Cell phone battery chargers; Cell phone cases; Electric cables and wires; Mounting devices for cameras and monitors; Protective films adapted for smartphones; Touchscreen monitors; Wireless ear buds; Protective covers and cases for cell phones" in Class 009; and

• "KAN" (stylized wording plus design) (Reg. No. 3026465) for "Accumulators, namely, electric accumulators, accumulator boxes, electric accumulators for vehicles; galvanic cells, namely, photovoltaic cells; battery chargers; batteries, capacitors, electric sockets, electric plugs and other contacts, namely, electrical connectors, cable connectors, insulated electrical connectors; material for use with electricity mains, namely, wires and cables, electric wires, power wires, electrical wires, battery cables, coaxial cables, electrical cables, power cables; stable electric source, namely, power line conditioners, voltage regulators; couplings; namely, electric couplings, couplings for meters, mains couplings; low voltage electrical power supplies" in 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, Ilc, 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, Ilc, 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 USPQ2d1689, 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 USPQ2d1713, 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 742, 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, "KAN-THERM", and registrants' marks, both "KAN", create an overall similar commercial impression. Applicant's mark consists of the word "KAN", which is the wording comprising the entirety of registrants' marks, combined with the word "THERM". The word "KAN" at the beginning of applicant's mark is the dominant wording in the mark.

Consumers are generally more inclined to focus on the first word, prefix, or syllable in any trademark or service mark. See Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772, 396 F.3d 1369, 1372, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005) (finding similarity between VEUVE ROYALE and two VEUVE CLICQUOT marks in part because "VEUVE . . . remains a 'prominent feature' as the first word in the mark and the first word to appear on the label"); Century 21 Real Estate Corp. v. Century Life of Am., 970 F.2d 874, 876, 23 USPQ2d 1698, 1700 (Fed Cir. 1992) (finding similarity between CENTURY 21 and CENTURY LIFE OF AMERICA in part because "consumers must first notice th[e] identical lead word"); see also In re Detroit Athletic Co., 903 F.3d 1297, 1303, 128 USPQ2d 1047, 1049 (Fed. Cir. 2018) (finding "the identity of the marks' two initial words is particularly significant because consumers typically notice those words first").

Moreover, while applicant's mark includes the wording "-THERM", not present in registrant's mark,

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dding a term to a registered mark generally 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 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 and BENGAL LANCER and design confusingly similar); re Toshiba Med. Sys. Corp., 91 USPQ2d 1266, 1269 (TTAB 2009) (holding TITAN and VANTAGE TITAN confusingly similar); In re El Torito Rests., Inc., 9 USPQ2d 2002, 2004 (TTAB 1988) (holding MACHO and MACHO COMBOS confusingly similar); TMEP §1207.01(b)(iii). In the present case, the marks are identical in part.

Finally, while applicant's mark is in standard characters whereas the cited marks include a design, 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 and/or services. In re Viterra Inc., 671 F.3d 1358, 1362, 101 USPQ2d1905, 1908 (Fed. Cir. 2012) (quoting CBS Inc. v. Morrow, 708 F.2d 1579, 1581-82, 218 USPQ 198, 200 (Fed. Cir. 1983)); Made in Nature, LLC v. Pharmavite LLC, 2022 USPQ2d 557, at *41 (TTAB 2022) (quoting Sabhnani v. Mirage Brands, LLC, 2021 USPQ2d1241, at *31 (TTAB 2021)); 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)).

For the reasons set forth above, applicant's and registrants' marks are confusingly similar.

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) (quoting7-Eleven Inc. v. Wechsler, 83 USPQ2d1715, 1724 (TTAB 2007)); TMEP §1207.01(a)(i);see Made in Nature, LLC v. Pharmavite LLC, 2022 USPQ2d 557, at *44 (TTAB 2022) (quoting In re Jump Designs LLC, 80 USPQ2d 1370, 1374 (TTAB 2006)).

The attached Internet evidence from Newegg.com, Bestbuy.com, and Microcenter.com establishes that the relevant goods are sold or provided through the same trade channels and used by the same classes of consumers in the same fields of use. Thus, applicant's and registrants'

good

are considered related for likelihood of confusion purposes. *See, e.g., In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1202-04 (TTAB 2009); *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266, 1268-69, 1271-72 (TTAB 2009).

Based on the *du Pont* factors discussed above, a likelihood of confusion exists between applicant's and registrants' 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).

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. The proposed amendments set forth in this requirement, *infra*, address this overbroad and/or indefinite language.

Moreover, a

pplicant must correct the punctuation in the identification to clarify the individual items in the list of goods and/or services. See 37 C.F.R. §2.32(a)(6); TMEP §1402.01(a). Proper punctuation in identifications is necessary to delineate explicitly each product or service within a list and to avoid ambiguity. Commas, semicolons, and apostrophes are the only punctuation that should be used in an identification of goods and/or services. TMEP §1402.01(a). An applicant should not use colons, periods, exclamation points, and question marks in an identification. Id. In addition, applicants should not use symbols in the identification such as asterisks (*), at symbols (@), or carets. Id.

In general, **commas** should be used in an identification (1) to separate a series of related items identified within a particular category of goods or services, (2) before and after "namely," and (3) between each item in a list of goods or services following "namely" (e.g., personal care products, namely, body lotion, bar soap, shampoo). *Id.* **Semicolons** generally should be used to separate a series of distinct categories of goods or services within an international class (e.g., personal care products, namely, body lotion; deodorizers for pets; glass cleaners). *Id.*

Thus, where applicant has used commas to separate distinct categories of goods or services, applicant should replace the commas with semicolons, if appropriate, or rewrite the identification with the commas deleted and the goods or services specified using definite and unambiguous language.

Furthermore, t

he identification of goods and/or services contains parentheses. 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>U.S. Acceptable Identification of Goods and Services Manual</u> 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.

Therefore, applicant must remove the parentheses from the identification and incorporate any parenthetical or bracketed information into the description of the goods and/or services.

In addition, p

articular wording in the identification in the application is indefinite and must be clarified because it does not appear to describe any goods and/or services in the identified international class(es). See 37 C.F.R. §2.32(a)(6); TMEP §§1402.01, 1904.02(c)(iii). Generally, a trademark examining attorney will recommend language to replace unacceptable wording in identifications of goods and/or services. See TMEP §1402.01(e). However, in this case, the trademark examining attorney is unable to suggest alternative wording because the text that follows in International Classes 008, 009, 011, and 017 is indefinite and does not appear to describe any goods and/or services in these classes:

- Applicant's Class 006 wording "T-squares" does not appear to describe any goods in Class 006. For example, T-squares for measuring are classified in Class 009 and T-squares for drawing are classified in Class 016.
- Applicant's Class 011 wording "notched protective tubes with fixing handles" does not appear to describe any goods in Class 011. For example, plastic tubes for protecting electrical wires are classified in Class 011.
- Applicant's Class 017 wording "Handles and staples for fixing pipes" does not appear to describe any goods in Class 017. For example, metal staples for construction use are classified in Class 006 and ratchet handles are classified in Class 008.

Applicant may respond by amending this wording to clarify the nature of the goods and/or services; however, any amendment to the identification must identify goods and/or services in the international classes in which they are classified in the application and be within the scope of the wording in the initial application. *See* TMEP §§1402.01(c), 1402.07(a), 1904.02(c)(iii). The scope of the identification for purposes of permissible amendments is limited by the international class(es) assigned by the International Bureau of the World Intellectual Property Organization (International Bureau). 37 C.F.R. §2.85(f); TMEP §§1402.07(a), 1904.02(c). If an applicant amends to goods and/or services that are in a class other than that assigned by the International Bureau, the amendment will not be accepted because it would exceed the scope and those goods and/or services would no longer have a basis for registration under U.S. law. TMEP §§1402.01(c), 1904.02(c).

Alternatively, applicant may delete this unacceptable wording from the identification. See TMEP §1904.02(c)(iii)-(iv). However, once an application has been expressly amended to delete goods and/or services, those items generally may not later be re-inserted. See TMEP §1402.07(e).

If applicant believes the classification assigned by the International Bureau was in error, applicant may contact the International Bureau and request correction of, or recordation of a limitation to, the international registration. TMEP §1904.02(c)(iii)-(iv), (e)(i)-(e)(ii). However, filing such a request with the International Bureau is not considered a formal response to this Office action. See TMEP §1904.02(c)(iv), (e)(iii). Applicant must also file a timely and complete response to this Office action, stating that applicant has filed a request for a correction or to record a limitation with the International Bureau that will resolve the outstanding issue. See 15 U.S.C. §1062(b); 37 C.F.R. §2.62(a); TMEP §§711, 718.03, 1904.02(c)(iii)-(iv), (e)(iii). The response should include (1) a copy of the request for correction or limitation filed with the International Bureau and (2) a request to suspend action on the application, which will normally be granted under such circumstances. See TMEP §§716.02(g), 1904.02(c)(iii)-(iv).

Further, t

he identification for "brass screw systems" in International Class 006 is indefinite and too broad and must be clarified because the wording does not make clear the nature of the specific systems and could identify goods in more than one international class. *See* 37 C.F.R. §2.32(a)(6); TMEP §1401.05(d). For example, "lawn-care systems comprised of herbicides, pesticides, and lawn sprinklers" are in International Class 5, and "lawn-care systems comprised of lawn mowers and herbicides" are in International Class 7.

Applicant must clarify the goods by (1) describing the nature, purpose, or use of the system, and (2) listing the system's parts or components, using common generic terms and referencing the primary parts or components of the system first. See 37 C.F.R. §2.32(a)(6); TMEP §1402.01.

The international classification of goods in applications filed under Trademark Act Section 66(a) cannot be changed from the classification the International Bureau of the World Intellectual Property Organization assigned to the goods in the corresponding international registration. 37 C.F.R. §2.85(d); TMEP §1401.03(d). Therefore, although systems may be classified in several international classes, any modification to the identification must identify goods in International Class 006 only, the class specified in the application for such goods. See TMEP §1904.02(c)(ii).

The primary parts or components of the system must include only goods, not services. TMEP §1401.05(d). For example, if computer software is listed as a component of a system, the identification must indicate that the computer software is recorded or downloadable in International Class 9 and does not include the services of providing temporary use of online non-downloadable software in International Class 42. An identification for a system including software must also specify the function and any field of use of the software. See id.

Finally, applicant should note that t

he USPTO has the discretion to determine the degree of particularity needed to clearly identify goods and 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 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.

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

- Class 006: Brass {specify connector type, e.g., pipe, structural joint, decking, etc.} connectors; elbow joints being structural joint connectors of metal; T-squares, rings, namely, {list specific Class 006 goods, e.g., screw rings of metal, ring-shaped fittings of metal, compressed hog rings of metal, etc.}; sleeves, namely, {list specific Class 006 goods, e.g., metal junction sleeves for non-electric cables, cable junction sleeves of metal, metal expanding sleeves for affixing screws, etc.}; extension pieces, namely, {list specific Class 006 goods, e.g., metal stilt leg extension attached to shoes for extending the vertical reach of workmen, extendable guard rails of metal, extendable metal crowd control barriers, etc.}; connectors, namely, {list specific Class 006 goods, e.g., metal pipe connectors, metal connectors for decking, structure joint connectors of metal, etc.}; reducing sleeves of metal, namely, {list specific Class 006 goods, e.g., metal junction sleeves for non-electric cables, cable junction sleeves of metal, etc.}; and plugs of metal; adapter sleeves for copper pipes, namely, {list specific Class 006 goods, e.g., metal junction sleeves for non-electric cables, cable junction sleeves of metal, metal expanding sleeves for affixing screws, etc.}; metal nuts for copper pipes;; copper pipe bends being metal pipe joints for copper pipes; steel assembly plates and metal screws; brass screw systems comprised of {list component parts, using guidance above, e.g., brass screws, steel plates, metal nuts, etc.}; closing flaps of metal for cats
- <u>Class 008</u>: Shears for cutting installation pipes of plastics; hand tools, namely, hand operated presses for pipe connectors (hand tools); hand tools, namely, expanders (hand tools); cases specially adapted for clamping tools being hand-operated clamps
- <u>Class 009</u>: Water meters; colorimeters; circuit-breakers; compensators with sleeve, namely, buoyancy compensator jacket for use in scuba diving; disc thermometers {specify Class 009 nature of thermometers, e.g., for candy, for meat, not for medical purposes, etc.}; and disc manometers; room thermostats
- Class 011: Apparatus and installations for the distribution of drinking water, namely, {list specific Class 011 goods, e.g., water coolers, water fountains, water filters, etc.};; sanitary installations, including their fittings and framework, namely, {list specific Class 011 goods, e.g., pressure regulators for sanitary installations, steam rooms, hand basins, etc.}; central heating installations; and their central heating installation pipework, namely, {list specific Class 011 goods, e.g., pipes for heating boilers, heat pipes to cool heat producing components, heat-stabilized polypropylene pipes for heating installations, etc.}; regulator valves, namely, {list specific Class 011 goods, e.g., gas regulators, pressure regulators for gas installations, pressure regulators for sanitary installations, etc.}; mixing taps being mixer taps for water pipes; parts

011 goods, e.g., electric cabinets used to control temperature for heating food goods, dough proofing units in the nature of heating controlling units for processing dough, electronic fireplace dampers, etc.} (parts of heating installations); notehed protective tubes with fixing handles, water heating equipment, namely, {list specific Class 011 goods, e.g., hot water heaters, water bed heaters, feed water heaters, etc.}; central heating boilers; valves for {specify Class 011 purpose of valves, e.g., air conditioners, steam, radiators, etc.}; mixers, namely, {list specific Class 011 goods, e.g., plumbing fixes in the nature of shower mixers, mixer taps for water pipes, mixer faucets for water pipes, etc.}; air vents, namely, direct vents for gas appliances; thermostat valves and heads being thermostatic valves; retention valves, namely, {specify Class 011 goods, e.g., steam valves, valves for air conditioners, valves as part of radiators, etc.}; complex valves for {specify Class 011 purpose of valves, e.g., air conditioners, steam, radiators, etc.}; selective valves, namely, {specify Class 011 goods, e.g., steam valves, valves for air conditioners, valves as part of radiators, etc.}; parts of dometic or industrial installations, namely, filters for {specify Class 011 purpose, e.g., air and gas conditioning, air extractor hoods, drinking water, etc.} (parts of domestic or industrial installations)

of heating installations, namely, heating control units being {specify Class

- <u>Class 017</u>: Handles and staples for fixing pipes,; knuckle joints and connecting pieces of plastic, namely, {list specific Class 017 goods, e.g., elastomer expansion joints, non-metal pipe couplings and joints, etc.}
- <u>Class 020</u>: **non-metal hooks, namely,** Hooks of plastic for pipes; closing flaps of plastics, **namely, tamper-evident plastic bands used on food packaging with seaming and a flap**
- <u>Class 037</u>: Installation, handling and repair services for water supply apparatus and heating systems; handling services being {specify nature of "handling" service, e.g., maintenance, construction, etc.} for water supply apparatus and heating systems
- <u>Class 042</u>: Project preparation services **being computer project management services** relating to in the field of water supply and heating installations

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

Amendment of Identification in a Section 66(a) Application Restricted by Scope.

Applicant's

goods and 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 services

or add

goods and 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 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 services

will further limit scope, and once

goods and 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 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 services

transferred from one existing class to another. 37 C.F.R. §2.85(d); TMEP §1401.03(d).

LEGAL NATURE AND PLACE INCORPORATED REQUIRED

Applicant must specify its legal entity type and national citizenship or foreign country of organization or incorporation, as applicant did not include this information in the application. *See* 37 C.F.R. §§2.32(a)(3)(i)-(v), 2.61(b); TMEP §§803.03, 803.04. This information is required for all U.S. trademark applications, including those filed under Trademark Act Section 66(a). *See* 37 C.F.R. §7.25(a)-(b); TMEP §1904.02(a).

Acceptable legal entity types include an individual, a partnership, a corporation, a joint venture, or the foreign equivalent. See TMEP §\$803.03 et seq. If applicant's legal entity type is an individual, applicant must so specify and provide his or her national citizenship. 37 C.F.R. §2.32(a)(3)(i); TMEP §803.03(a). If applicant is a corporation, association, partnership, joint venture, or the foreign equivalent, applicant must so specify and provide the foreign country under whose laws applicant is organized or incorporated. 37 C.F.R. §2.32(a)(3)(ii); TMEP §803.03(b)-(c). For an association, applicant must also specify whether the association is incorporated or unincorporated, unless the foreign country and the designation or description "association/associazione" appear in Appendix D of the Trademark Manual of Examining Procedure (TMEP). TMEP§803.03(c). If applicant is organized under the laws of a foreign province or geographical region, applicant should specify both the foreign province or geographical region and the foreign country in which the province or region is located. See TMEP §803.04.

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); TMEP §803.05(b). This email address cannot be identical to the primary correspondence email address of a U.S.-licensed attorney retained to represent applicant in this application. See TMEP §803.05(b).

U.S.-LICENSED ATTORNEY REQUIRED

Applicant is required to be represented by a U.S.-licensed attorney to respond to or appeal the provisional refusal because applicant's domicile is located outside of the United States and applicant does not appear to be represented by a

qualified U.S. attorney. 37 C.F.R. §2.11(a); TMEP §601.01(a). An applicant whose domicile is located outside of the United States or its territories 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); TMEP In this case, applicant's domicile is identified in the §§601, 601.01(a). application as outside of the United States or its territories. For more information, the Counsel see U.S. webpage at https://www.uspto.gov/trademark/laws-regulations/trademark-rule-requiresforeign-applicants-and-registrants-have-us and Hiring a U.S.-licensed trademark attorney webpage at https://www.uspto.gov/trademarks-getting-started/why-hireprivate-trademark-attorney.

To appoint a U.S.-licensed attorney in this application, applicant should submit a completed Trademark Electronic Application System (TEAS) Change Address or Representation form at https://teas.uspto.gov/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. 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); TMEP §604.01.

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 Manca/ Alberto 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. TEASmaintenance 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 <u>contact information for the supervisor</u> 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. 79346376

Mark: KAN-THERM

Correspondence Address: DANUTA DOBKOWSKA Ul. Rycerska 79 PL-15-159 BIALYSTOK POLAND

Applicant: KAN SP.Z O.O.

Reference/Docket No. N/A

Correspondence Email Address:

NONFINAL OFFICE ACTION Notice of Provisional Full Refusal

International Registration No. 0862220

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-1rst 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
- AMENDED IDENTIFICATION OF GOODS AND SERVICES REQUIRED

- LEGAL NATURE AND PLACE INCORPORATED 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 applicant's goods in Class 009.

Registration of the applied-for mark is refused because of a likelihood of confusion with the marks in U.S. Registration Nos. 5885333 and 3026465. Trademark Act Section 2(d), 15 U.S.C. §1052(d); see TMEP §§1207.01 et seq. See the attached registrations.

Applicant applied to register "KAN-THERM" (standard characters) for, in relevant part, "Water meters, colorimeters, circuit-breakers, compensators with sleeve, disc thermometers and manometers, room thermostats" in Class 009.

The cited marks are as follows:

- "KAN" (stylized wording plus design) (Reg. No. 5885333) for "Battery cables; Cell phone battery chargers; Cell phone cases; Electric cables and wires; Mounting devices for cameras and monitors; Protective films adapted for smartphones; Touchscreen monitors; Wireless ear buds; Protective covers and cases for cell phones" in Class 009; and
- "KAN" (stylized wording plus design) (Reg. No. 3026465) for "Accumulators, namely, electric accumulators, accumulator boxes, electric accumulators for vehicles; galvanic cells, namely, photovoltaic cells; battery chargers; batteries, capacitors, electric sockets, electric plugs and other contacts, namely, electrical connectors, cable connectors, insulated electrical connectors; material for use with electricity mains, namely, wires and cables, electric wires, power wires, electrical wires, battery cables, coaxial cables, electrical cables, power cables; stable electric source, namely, power line conditioners, voltage regulators; couplings; namely, electric couplings, couplings for meters, mains couplings; low voltage electrical power supplies" in 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, "KAN-THERM", and registrants' marks, both "KAN", create an overall similar commercial impression. Applicant's mark consists of the word "KAN", which is the wording comprising the entirety of registrants' marks, combined with the word "THERM". The word "KAN" at the beginning of applicant's mark is the dominant wording in the mark. Consumers are generally more inclined to focus on the first word, prefix, or syllable in any trademark or service mark. See Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772, 396 F.3d 1369, 1372, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005) (finding similarity between VEUVE ROYALE and two VEUVE CLICQUOT marks in part because "VEUVE . . . remains a 'prominent feature' as the first word in the mark and the first word to appear on the label'); Century 21 Real Estate Corp. v. Century Life of Am., 970 F.2d 874, 876, 23 USPQ2d 1698, 1700 (Fed Cir. 1992) (finding similarity between CENTURY 21 and CENTURY LIFE OF AMERICA in part because "consumers must first notice th[e] identical lead word"); see also In re Detroit Athletic Co., 903 F.3d 1297, 1303, 128 USPQ2d 1047, 1049 (Fed. Cir. 2018) (finding "the identity of the marks' two initial words is particularly significant because consumers typically notice those words first").

Moreover, while applicant's mark includes the wording "-THERM", not present in registrant's mark, adding a term to a registered mark generally 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 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 and BENGAL LANCER and design confusingly similar); In re Toshiba Med. Sys. Corp., 91 USPQ2d 1266, 1269 (TTAB 2009) (holding TITAN and VANTAGE TITAN confusingly similar); In re El Torito Rests., Inc., 9 USPQ2d 2002, 2004 (TTAB 1988) (holding MACHO and MACHO COMBOS confusingly similar); TMEP §1207.01(b)(iii). In the present case, the marks are identical in part.

Finally, while applicant's mark is in standard characters whereas the cited marks include a design, 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 and/or services. In re Viterra Inc., 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (quoting CBS Inc. v. Morrow, 708 F.2d 1579, 1581-82, 218 USPQ 198, 200 (Fed. Cir. 1983)); Made in Nature, LLC v. Pharmavite LLC, 2022 USPQ2d 557, at *41 (TTAB 2022) (quoting Sabhnani v. Mirage Brands, LLC, 2021 USPQ2d 1241, at *31 (TTAB 2021)); 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)).

For the reasons set forth above, applicant's and registrants' marks are confusingly similar.

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); *see Made in Nature, LLC v. Pharmavite LLC*, 2022 USPQ2d 557, at *44 (TTAB 2022) (quoting *In re Jump Designs LLC*, 80 USPQ2d 1370, 1374 (TTAB 2006)).

The attached Internet evidence from Newegg.com, Bestbuy.com, and Microcenter.com establishes that the relevant goods are sold or provided through the same trade channels and used by the same classes of consumers in the same fields of use. Thus, applicant's and registrants' good are considered related for likelihood of confusion purposes. *See*, *e.g.*, *In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1202-04 (TTAB 2009); *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266, 1268-69, 1271-72 (TTAB 2009).

Based on the *du Pont* factors discussed above, a likelihood of confusion exists between applicant's and registrants' 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).

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. The proposed amendments set forth in this requirement, *infra*, address this overbroad and/or indefinite language.

Moreover, applicant must correct the punctuation in the identification to clarify the individual items in the list of goods and/or services. See 37 C.F.R. §2.32(a)(6); TMEP §1402.01(a). Proper punctuation in identifications is necessary to delineate explicitly each product or service within a list and to avoid ambiguity. Commas, semicolons, and apostrophes are the only punctuation that should be used in an identification of goods and/or services. TMEP §1402.01(a). An applicant should not use colons, periods, exclamation points, and question marks in an identification. Id. In addition, applicants should not use symbols in the identification such as asterisks (*), at symbols (@), or carets. Id.

In general, **commas** should be used in an identification (1) to separate a series of related items identified within a particular category of goods or services, (2) before and after "namely," and (3) between each item in a list of goods or services following "namely" (e.g., personal care products, namely, body lotion, bar soap, shampoo). *Id.* **Semicolons** generally should be used to separate a series of distinct categories of goods or services within an international class (e.g., personal care products, namely, body lotion; deodorizers for pets; glass cleaners). *Id.*

Thus, where applicant has used commas to separate distinct categories of goods or services, applicant should replace the commas with semicolons, if appropriate, or rewrite the identification with the commas deleted and the goods or services specified using definite and unambiguous language.

Furthermore, the identification of goods and/or services contains parentheses. 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.

Therefore, applicant must remove the parentheses from the identification and incorporate any parenthetical or bracketed information into the description of the goods and/or services.

In addition, particular wording in the identification in the application is indefinite and must be clarified because it does not appear to describe any goods and/or services in the identified international class(es). See 37 C.F.R. §2.32(a)(6); TMEP §§1402.01, 1904.02(c)(iii). Generally, a trademark examining attorney will recommend language to replace unacceptable wording in identifications of goods and/or services. See TMEP §1402.01(e). However, in this case, the trademark examining attorney is unable to suggest alternative wording because the text that follows in International Classes 008, 009, 011, and 017 is indefinite and does not appear to describe any goods and/or services in these classes:

• Applicant's Class 006 wording "T-squares" does not appear to describe any goods in Class 006. For example, T-squares for measuring are classified in Class 009 and T-squares for

drawing are classified in Class 016.

- Applicant's Class 011 wording "notched protective tubes with fixing handles" does not appear to describe any goods in Class 011. For example, plastic tubes for protecting electrical wires are classified in Class 011.
- Applicant's Class 017 wording "Handles and staples for fixing pipes" does not appear to describe any goods in Class 017. For example, metal staples for construction use are classified in Class 006 and ratchet handles are classified in Class 008.

See TMEP §1904.02(c)(iii).

Applicant may respond by amending this wording to clarify the nature of the goods and/or services; however, any amendment to the identification must identify goods and/or services in the international classes in which they are classified in the application and be within the scope of the wording in the initial application. *See* TMEP §§1402.01(c), 1402.07(a), 1904.02(c)(iii). The scope of the identification for purposes of permissible amendments is limited by the international class(es) assigned by the International Bureau of the World Intellectual Property Organization (International Bureau). 37 C.F.R. §2.85(f); TMEP §§1402.07(a), 1904.02(c). If an applicant amends to goods and/or services that are in a class other than that assigned by the International Bureau, the amendment will not be accepted because it would exceed the scope and those goods and/or services would no longer have a basis for registration under U.S. law. TMEP §§1402.01(c), 1904.02(c).

Alternatively, applicant may delete this unacceptable wording from the identification. *See* TMEP \$1904.02(c)(iii)-(iv). However, once an application has been expressly amended to delete goods and/or services, those items generally may not later be re-inserted. *See* TMEP \$1402.07(e).

If applicant believes the classification assigned by the International Bureau was in error, applicant may contact the International Bureau and request correction of, or recordation of a limitation to, the international registration. TMEP §1904.02(c)(iii)-(iv), (e)(i)-(e)(ii). However, filing such a request with the International Bureau is not considered a formal response to this Office action. *See* TMEP §1904.02(c)(iv), (e)(iii). Applicant must also file a timely and complete response to this Office action, stating that applicant has filed a request for a correction or to record a limitation with the International Bureau that will resolve the outstanding issue. *See* 15 U.S.C. §1062(b); 37 C.F.R. §2.62(a); TMEP §§711, 718.03, 1904.02(c)(iii)-(iv), (e)(iii). The response should include (1) a copy of the request for correction or limitation filed with the International Bureau and (2) a request to suspend action on the application, which will normally be granted under such circumstances. *See* TMEP §§716.02(g), 1904.02(c)(iii)-(iv).

Further, the identification for "brass screw systems" in International Class 006 is indefinite and too broad and must be clarified because the wording does not make clear the nature of the specific systems and could identify goods in more than one international class. *See* 37 C.F.R. §2.32(a)(6); TMEP §1401.05(d). For example, "lawn-care systems comprised of herbicides, pesticides, and lawn sprinklers" are in International Class 5, and "lawn-care systems comprised of lawn mowers and herbicides" are in International Class 7.

Applicant must clarify the goods by (1) describing the nature, purpose, or use of the system, and (2) listing the system's parts or components, using common generic terms and referencing the primary parts or components of the system first. See 37 C.F.R. §2.32(a)(6); TMEP §1402.01.

The international classification of goods in applications filed under Trademark Act Section 66(a) cannot be changed from the classification the International Bureau of the World Intellectual Property Organization assigned to the goods in the corresponding international registration. 37 C.F.R. §2.85(d); TMEP §1401.03(d). Therefore, although systems may be classified in several international classes, any modification to the identification must identify goods in International Class 006 only, the class specified in the application for such goods. *See* TMEP §1904.02(c)(ii).

The primary parts or components of the system must include only goods, not services. TMEP §1401.05(d). For example, if computer software is listed as a component of a system, the identification must indicate that the computer software is recorded or downloadable in International Class 9 and does not include the services of providing temporary use of online non-downloadable software in International Class 42. An identification for a system including software must also specify the function and any field of use of the software. *See id.*

Finally, applicant should note that the USPTO has the discretion to determine the degree of particularity needed to clearly identify goods and 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 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.

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

- Class 006: Brass {specify connector type, e.g., pipe, structural joint, decking, etc.} connectors; elbow joints being structural joint connectors of metal; T-squares, rings, namely, {list specific Class 006 goods, e.g., screw rings of metal, ring-shaped fittings of metal, compressed hog rings of metal, etc.}; sleeves, namely, {list specific Class 006 goods, e.g., metal junction sleeves for non-electric cables, cable junction sleeves of metal, metal expanding sleeves for affixing screws, etc.}; extension pieces, namely, {list specific Class 006 goods, e.g., metal stilt leg extension attached to shoes for extending the vertical reach of workmen, extendable guard rails of metal, extendable metal crowd control barriers, etc.}; connectors, namely, {list specific Class 006 goods, e.g., metal pipe connectors, metal connectors for decking, structure joint connectors of metal, etc.}; reducing sleeves of metal, namely, {list specific Class 006 goods, e.g., metal junction sleeves for non-electric cables, cable junction sleeves of metal, etc.}; and plugs of metal; adapter sleeves for copper pipes, namely, {list specific Class 006 goods, e.g., metal junction sleeves for non-electric cables, cable junction sleeves of metal, metal expanding sleeves for affixing screws, etc.}; metal nuts for copper pipes;; copper pipe bends being metal pipe joints for copper pipes;; steel assembly plates and metal screws; brass screw systems comprised of {list component parts, using guidance above, e.g., brass screws, steel plates, metal nuts, etc.}; closing flaps of metal for cats
- <u>Class 008</u>: Shears for cutting installation pipes of plastics; hand tools, namely, hand operated presses for pipe connectors (hand tools); hand tools, namely, expanders (hand tools); cases specially adapted for clamping tools being hand-operated clamps

- <u>Class 009</u>: Water meters;; colorimeters;; circuit-breakers;; compensators with sleeve, namely, buoyancy compensator jacket for use in scuba diving;; disc thermometers {specify Class 009 nature of thermometers, e.g., for candy, for meat, not for medical purposes, etc.}; and disc manometers; room thermostats
- Class 011: Apparatus and installations for the distribution of drinking water, namely, {list specific Class 011 goods, e.g., water coolers, water fountains, water filters, etc.}; sanitary installations, including their fittings and framework, namely, {list specific Class 011 goods, e.g., pressure regulators for sanitary installations, steam rooms, hand basins, etc.}; central heating installations; and their central heating installation pipework, namely, {list specific Class 011 goods, e.g., pipes for heating boilers, heat pipes to cool heat producing components, heat-stabilized polypropylene pipes for heating installations, etc.}; regulator valves, namely, {list specific Class 011 goods, e.g., gas regulators, pressure regulators for gas installations, pressure regulators for sanitary installations, etc.}; mixing taps being mixer taps for water pipes; parts of heating installations, namely, heating control units being {specify Class 011 goods, e.g., electric cabinets used to control temperature for heating food goods, dough proofing units in the nature of heating controlling units for processing dough, electronic fireplace dampers, etc.} (parts of heating installations); notehed protective tubes with fixing handles, water heating equipment, namely, {list specific Class 011 goods, e.g., hot water heaters, water bed heaters, feed water heaters, etc.}; central heating boilers; valves for {specify Class 011 purpose of valves, e.g., air conditioners, steam, radiators, etc.}; mixers, namely, {list specific Class 011 goods, e.g., plumbing fixes in the nature of shower mixers, mixer taps for water pipes, mixer faucets for water pipes, etc.}; air vents, namely, direct vents for gas appliances; thermostat valves and heads being thermostatic valves; retention valves, namely, {specify Class 011 goods, e.g., steam valves, valves for air conditioners, valves as part of radiators, etc.}; complex valves for {specify Class 011 purpose of valves, e.g., air conditioners, steam, radiators, etc.}; selective valves, namely, {specify Class 011 goods, e.g., steam valves, valves for air conditioners, valves as part of radiators, etc.}; parts of dometic or industrial installations, namely, filters for {specify Class 011 purpose, e.g., air and gas conditioning, air extractor hoods, drinking water, etc.} (parts of domestic or industrial installations)
- <u>Class 017</u>: Handles and staples for fixing pipes,; knuckle joints and connecting pieces of plastic, namely, {list specific Class 017 goods, e.g., elastomer expansion joints, non-metal pipe couplings and joints, etc.}
- <u>Class 020</u>: **non-metal hooks, namely,** Hooks of plastic for pipes; closing flaps of plastics, namely, tamper-evident plastic bands used on food packaging with seaming and a flap
- <u>Class 037</u>: Installation, handling and repair services for water supply **apparatus** and heating systems; handling services being {specify nature of "handling" service, e.g., maintenance, construction, etc.} for water supply apparatus and heating systems
- <u>Class 042</u>: Project preparation services being computer project management services relating to in the field of water supply and heating installations

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

Amendment of Identification in a Section 66(a) Application Restricted by Scope. Applicant's goods and 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 services or add goods and 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 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 services will further limit scope, and once goods and 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 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 services transferred from one existing class to another. 37 C.F.R. §2.85(d); TMEP §1401.03(d).

LEGAL NATURE AND PLACE INCORPORATED REQUIRED

Applicant must specify its legal entity type and national citizenship or foreign country of organization or incorporation, as applicant did not include this information in the application. *See* 37 C.F.R. §§2.32(a)(3)(i)-(v), 2.61(b); TMEP §§803.03, 803.04. This information is required for all U.S. trademark applications, including those filed under Trademark Act Section 66(a). *See* 37 C.F.R. §7.25(a)-(b); TMEP §1904.02(a).

Acceptable legal entity types include an individual, a partnership, a corporation, a joint venture, or the foreign equivalent. *See* TMEP §803.03 *et seq.* If applicant's legal entity type is an individual, applicant must so specify and provide his or her national citizenship. 37 C.F.R. §2.32(a)(3)(i); TMEP §803.03(a). If applicant is a corporation, association, partnership, joint venture, or the foreign equivalent, applicant must so specify and provide the foreign country under whose laws applicant is organized or incorporated. 37 C.F.R. §2.32(a)(3)(ii); TMEP §803.03(b)-(c). For an association, applicant must also specify whether the association is incorporated or unincorporated, unless the foreign country and the designation or description "association/associazione" appear in Appendix D of the *Trademark Manual of Examining Procedure* (TMEP). TMEP §803.03(c). If applicant is organized under the laws of a foreign province or geographical region, applicant should specify both the foreign province or geographical region and the foreign country in which the province or region is located. *See* TMEP §803.04.

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); TMEP §803.05(b). This email address cannot be identical to the primary correspondence email address of a U.S.-licensed attorney retained to represent applicant in this application. See TMEP §803.05(b).

U.S.-LICENSED ATTORNEY REQUIRED

Applicant is required to be represented by a U.S.-licensed attorney to respond to or appeal the provisional refusal because applicant's domicile is located outside of the United States and applicant does not appear to be represented by a qualified U.S. attorney. 37 C.F.R. §2.11(a); TMEP §601.01(a). An applicant whose domicile is located outside of the United States or its territories 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); TMEP §§601, 601.01(a). In this case, applicant's domicile is identified in the application as outside of the United States or its territories. For more U.S. https://www.uspto.gov/trademark/laws-Counsel webpage information, see the at regulations/trademark-rule-requires-foreign-applicants-and-registrants-have-us and Hiring a U.S.licensed trademark attorney webpage at https://www.uspto.gov/trademarks-getting-started/why-hireprivate-trademark-attorney.

To appoint a U.S.-licensed attorney in this application, applicant should submit a completed Trademark Electronic Application System (TEAS) Change Address or Representation form at https://teas.uspto.gov/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. 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); TMEP §604.01.

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 Manca/ Alberto 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 <u>abandon</u>. The response must be received by the USPTO before midnight Eastern Time of the last day of the response period. TEAS maintenance or <u>unforeseen circumstances</u> 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** <u>contact information for the supervisor</u> of the office or unit listed in the signature block.

Print: Thu Apr 06 2023 78283629

(3) DESIGN PLUS WORDS, LETTERS, AND/OR NUMBERS



Mark Punctuated KAN

Translation

Goods/Services

IC 009. US 021 023 026 036 038.G & S: Accumulators, namely, electric accumulators, accumulator boxes, electric accumulators for vehicles; galvanic cells, namely, photovoltaic cells; battery chargers; batteries, capacitors, electric sockets, electric plugs and other contacts, namely, electrical connectors, cable connectors, insulated electrical connectors; material for use with electricity mains, namely, wires and cables, electric wires, power wires, electrical wires, battery cables, coaxial cables, electrical cables, power cables; stable electric source, namely, power line conditioners, voltage regulators; couplings; namely, electric couplings, couplings for meters, mains couplings; low voltage electrical power supplies. FIRST USE: 19961201. FIRST USE IN COMMERCE: 20021201

Mark Drawing Code (3) DESIGN PLUS WORDS, LETTERS, AND/OR NUMBERS

Design Code 261709

Serial Number 78283629

Filing Date 20030806

Current Filing Basis

14

Original Filing Basis

1A

Publication for Opposition Date 20050920

Registration Number 3026465

Date Registered 20051213

Owner

(REGISTRANT) Zhejiang Kan Battery Co., Ltd. LIMITED LIABILITY COMPANY CHINA No. 998 KAN Road, Suichang 323300, Zhejiang CHINA

Priority Date

Disclaimer Statement

Description of Mark

Color is not claimed as a feature of the mark. THE MARK ITSELF IS A LONG "C" WITH THE LETTERS "KAN" INSIDE THE "C".

Type of Mark TRADEMARK

Register PRINCIPAL

Live Dead Indicator LIVE

Attorney of Record Mary Beth Ciocco Print: Thu Apr 06 2023 88389198

(3) DESIGN PLUS WORDS, LETTERS, AND/OR NUMBERS



Mark Punctuated KAN

Translation

The wording "KAN" has no meaning in a foreign language.

Goods/Services

 IC 009. US 021 023 026 036 038.G & S: Battery cables; Cell phone battery chargers; Cell phone cases; Electric cables and wires; Mounting devices for cameras and monitors; Protective films adapted for smartphones; Touchscreen monitors; Wireless ear buds; Protective covers and cases for cell phones. FIRST USE: 20160429, FIRST USE IN COMMERCE: 20180118

Mark Drawing Code

(3) DESIGN PLUS WORDS, LETTERS, AND/OR NUMBERS

Design Code

260912 260921 261701 261704 261706 270301

Serial Number

88389198

Filing Date

20190417

Current Filing Basis

iA

Original Filing Basis

1A

Publication for Opposition Date

20190730

Registration Number

5885333

Date Registered

20191015

Owner

(REGISTRANT) K.AN COMPANY, INC. CORPORATION REPUBLIC OF KOREA 1006, 187, Simin-daero, Dongan-gu Anyang-si, Gyeonggi-do REPUBLIC OF KOREA 14047

Priority Date

Disclaimer Statement

Description of Mark

Color is not claimed as a feature of the mark. The mark consists of stylized wording "KAN" and a design of a

square located directly left to the wording, wherein abstract letters are provided in the square.

Type of Mark TRADEMARK

Register PRINCIPAL

Live Dead Indicator LIVE

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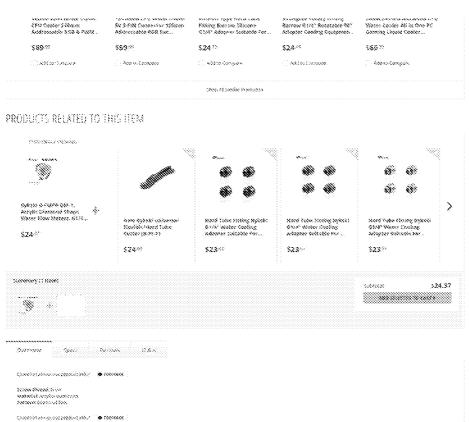








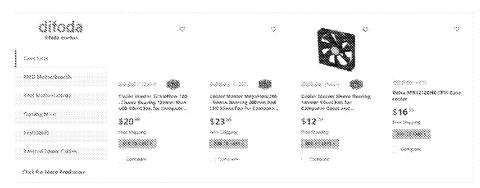




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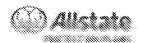
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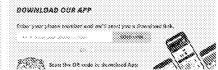
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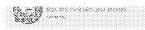
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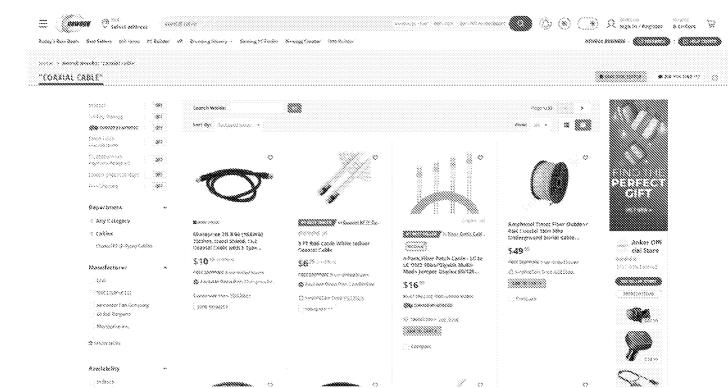
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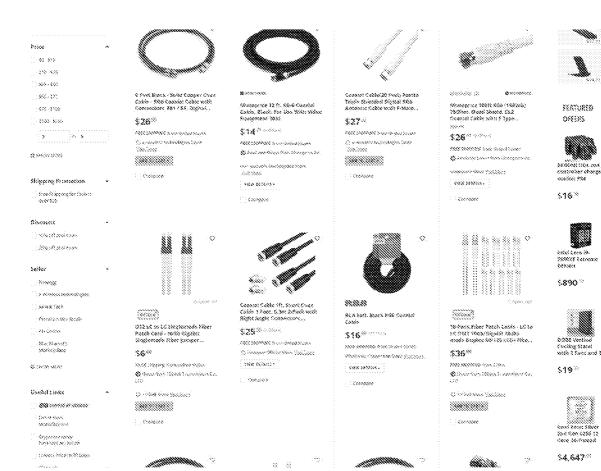
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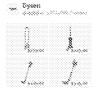
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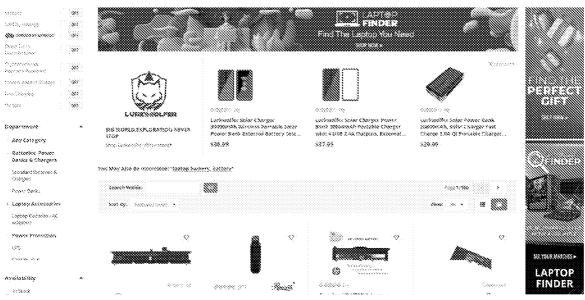
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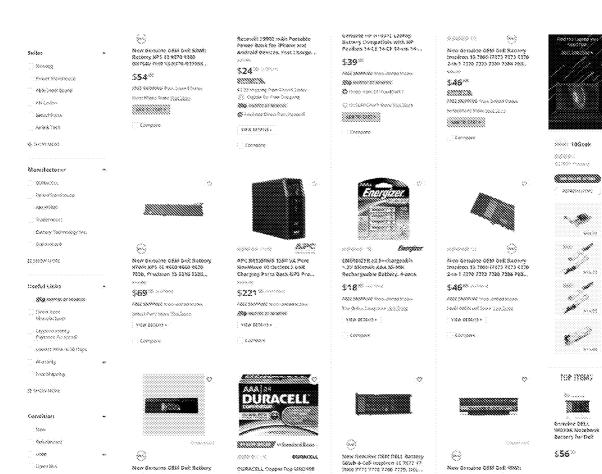


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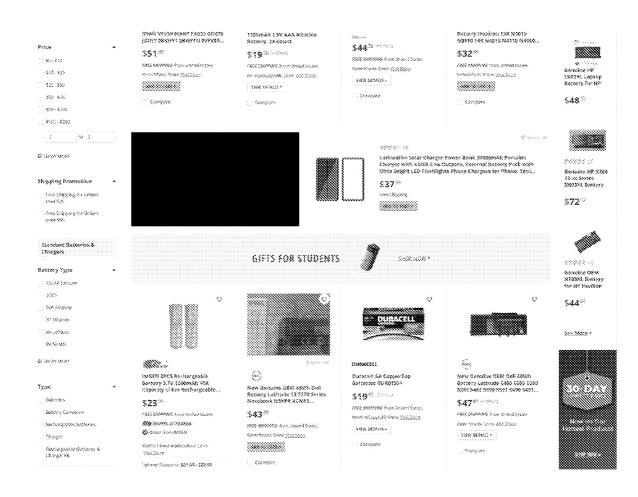
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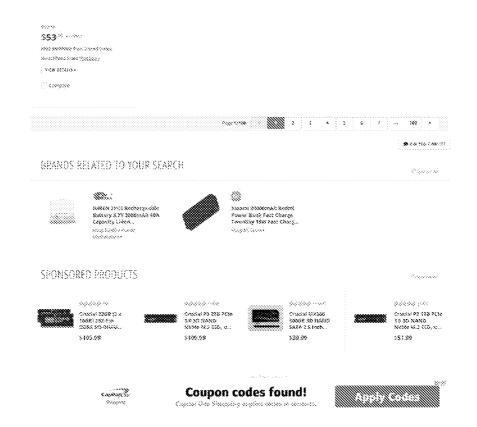
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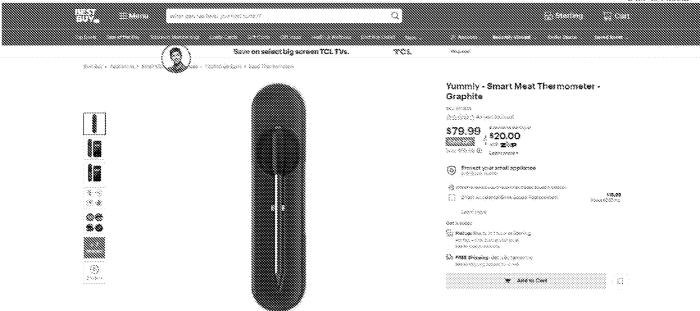


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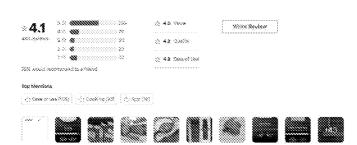
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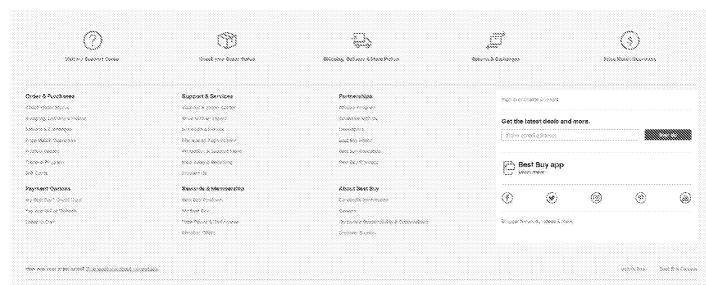












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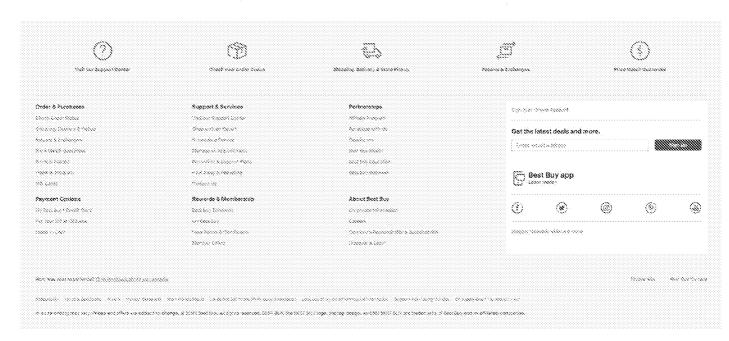
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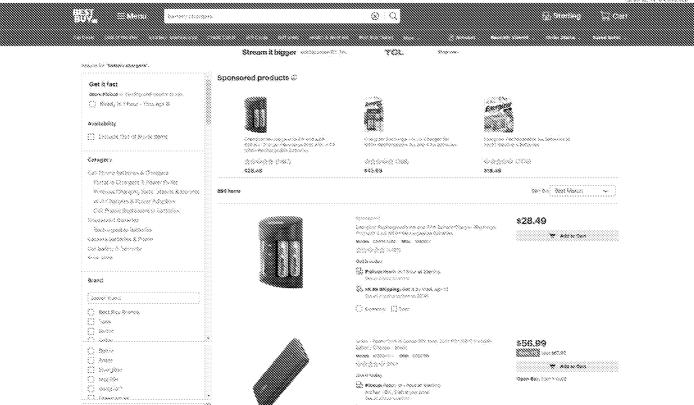








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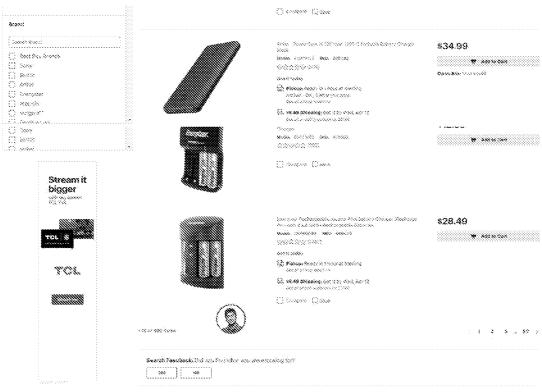
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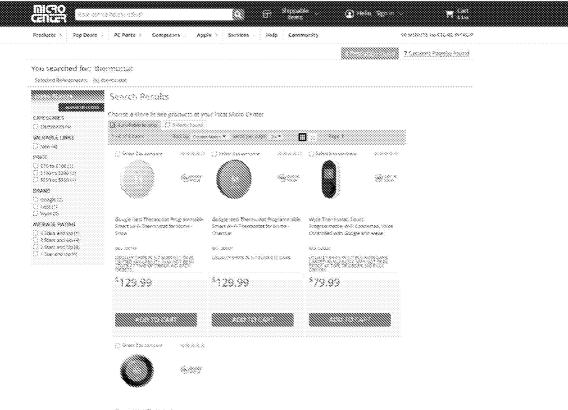




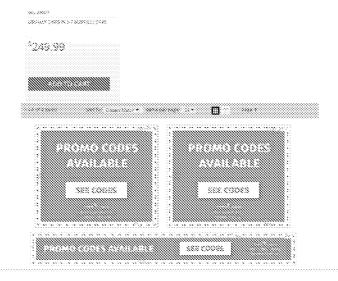


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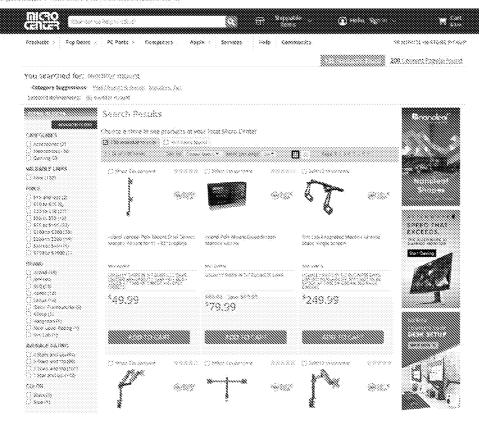


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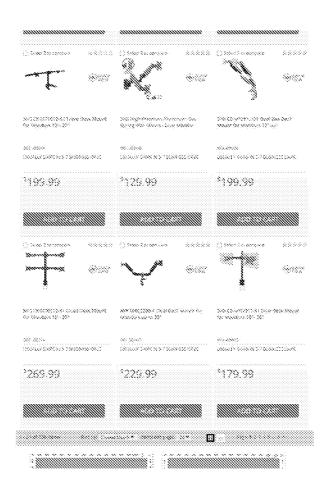




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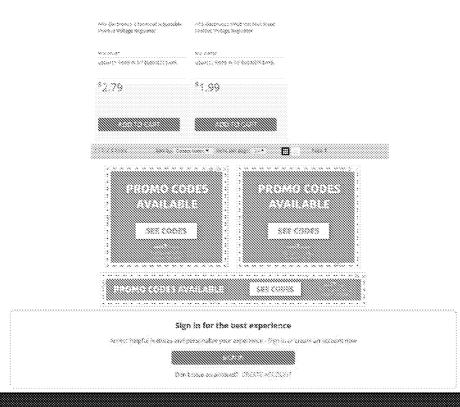
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