

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: LG Corp.
Serial Number: 76719078
Filing Date: Aug. 27, 2013
Mark: GOLDSTAR

Examining Atty: Mark Sparacino, Esq.
Law Office: 103

Commissioner for Trademarks
P.O. Box 1451
Alexandria, Virginia 22313-1451

RESPONSE TO OFFICE ACTION

The Examining Attorney has partially refused registration of Applicant's mark GOLDSTAR with respect to "television receivers" on the ground it is confusingly similar to the mark GOLD STAR WARRANTY in Registration No. 3701218 for extended warranty services for audiovisual solutions. For the reasons discussed below, no likelihood of confusion exists and Applicant respectfully requests that the partial refusal be withdrawn.

A. The Cited Registration Is Entitled to a Narrow Scope of Protection

A predominant factor in the likelihood of confusion analysis is the strength of the cited mark. *Basic Vegetable Prod., Inc. v. General Foods Corp.*, 165 USPQ 781, 784 (TTAB 1970). Where a mark is highly suggestive or laudatory, the scope of protection is limited to "substantially identical designations" used for "substantially identical goods" or services. *Id.* Here, unlike Applicant's unitary mark GOLDSTAR, Registrant's separately worded GOLD STAR WARRANTY mark for warranty services is highly laudatory, as the mark immediately conveys that the warranty services provided are somehow exceptional or outstanding. Indeed, that is the dictionary meaning of "gold

star” (two words) (See Exhibit 1, https://en.oxforddictionaries.com/definition/us/gold_star and <http://www.dictionary.com/browse/gold-star>.)

Not surprisingly, the TTAB has on numerous occasions found that the term “gold,” and certain non-unitary marks containing that term, are laudatory. See, e.g., *In re South Park Cigar, Inc.*, 82 USPQ.2d 1507 (TTAB 2007) (“[W]e find that GOLD is highly suggestive and laudatory, simply connoting the high quality of the goods...”); *In re Glendale Int’l Corp.*, 2004 TTAB LEXIS 231 (TTAB Apr. 14, 2004) (“We also agree with the Examining Attorney that the term “gold” has a laudatory significance.”); *Hyde Park Footwear Co. v. Hampshire-Designers, Inc.*, 197 U.S.P.Q. 639 (TTAB 1977) (noting that GOLD SEAL is “a commonly used laudatory expression”); *In re S. Martinelli & Co.*, 2003 TTAB LEXIS 86 (TTAB Feb. 26, 2003) (“In view of the foregoing, it is likely that purchasers will consider the term GOLD MEDAL in a trademark to be laudatory in nature and, thus, highly suggestive of the quality of the goods so identified.”).

In view of the laudatory nature of Registrant’s GOLD STAR WARRANTY mark, the scope of protection for that mark is extremely limited and should not extend beyond the warranty services covered by the registration.

B. Applicant’s Television Receivers and Registrant’s Warranty Services for Audiovisual Solutions Are Not Related

Registrant’s identification covers, “Providing extended warranties on presentation products, namely, video players and recorders, DVD players, projectors, high definition optical disc players, LCD televisions, plasma televisions, television receivers, and televisions.” Registrant’s warranty services for audiovisual products/solutions and Applicant’s television receivers have nothing in common apart from the fact that both

can broadly be classified as audiovisual products/services. See *Vetronix Corp. v. Am. Fin. Warranty Corp.*, 2004 TTAB LEXIS 50 (TTAB Feb. 5, 2004) (“In previous decisions we have stated that it is not enough to find one term that may generically describe the goods. Here, we find opposer’s efforts to put its goods and applicant’s services into a single category to be, to say the least, a real ‘stretch.’ Opposer’s tester for automobile electronics systems and applicant’s vehicle service insurance plans are very different.”) (internal citation omitted); *Americar Rental Sys. v. N. Am. Warranty Serv.*, 1998 TTAB LEXIS 311 (TTAB Sept. 9, 1998) (“Turning first to our analysis of the respective services of the parties, we note that this record does not show that a prospective purchaser of extended warranty services for automobiles has any reason to expect the same entity which provides such warranty services to also render car rental services, which is opposer’s main business, or, for that matter, the other services opposer provides, such as valet parking, auto cleaning, limousine services, or automobile dealership services.”).

In view of the narrow scope of protection to which Registrant’s GOLD STAR WARRANTY mark is entitled, as discussed above, Registrant’s rights in GOLD STAR WARRANTY are limited to warranty services and should not prevent Applicant’s registration of GOLDSTAR for television receivers.

C. Registrant’s Institutional Purchasers Are Sophisticated and Exercise a High Degree of Care

The sophistication of purchasers is an important factor in the likelihood-of-confusion analysis and often dispositive because “[s]ophisticated consumers may be expected to exercise greater care.” *Electronic Design & Sales, Inc. v. Electronic Data Systems Corp.*, 21 USPQ2d 1388 (Fed. Cir. 1992). Here, Registrant’s extended

warranties for audiovisual “presentation products” are inherently geared toward commercial customers. This is confirmed by a review of Registrant’s website, which reveals that Registrant provides primarily commercial customers with audiovisual and IT system solutions (see Exhibit 2, <http://stampede-global.com/company/profile/>.) Such institutional purchasers are, by their very nature, sophisticated and likely to exercise a high degree of care. Moreover, as Applicant’s “television receivers” may cost several thousand dollars, consumers can likewise be expected to purchase such products only after careful consideration.

Accordingly, the professional audiovisual companies purchasing extended warranty services from Registrant are unlikely to be confused by the co-existence of Applicant’s GOLDSTAR mark for television receivers.

CONCLUSION

In light of the foregoing, Applicant respectfully requests that the partial refusal of registration be withdrawn and the application approved for publication.

Respectfully submitted,

LG Corp.

Dated: October 18, 2016

By:  

Mark Sommers
Naresh Kilaru
Finnegan, Henderson, Farabow,
Garrett & Dunner, LLP
901 New York Avenue, N.W.
Washington, D.C. 20001-4413
Telephone: 202-408-4000
Facsimile: 202-408-4400
Attorneys for Applicant