

Response to Office Action

Applicant hereby responds to a first Office Action issued January 6, 2015. The Office Action partially refused registration of Applicant's trademark under 15 U.S.C. § 1052(d), due to an alleged likelihood of confusion with the trademarks shown in U.S. registration nos. 1,307,817, 1,334,145, and 1,610,490 (collectively, the "Cited Registrations"). Applicant respectfully requests that the Examining Attorney consider the following arguments and evidence.

Introduction and Background

Applicant's trademark ("Applicant's Mark") is VOLTE TECHNOLOGY, for use in connection with various goods in Class 9 and certain services in Class 42. The Section 2(d) objection concerns only the Class 9 goods, which are (as amended elsewhere herein) "Electrotechnical and electronic devices for harvesting mechanical energy, energy conversion, and energy generation, namely, electrical power supplies for sensors and electric actuators for pollutants, heat, motion, location detection, communication, pressure and electricity; vibration sensors for applications such as monitoring equipment and environmental conditions, vibration meters, radio receivers, radio transmitters, piezo electric sensors, piezo electric actuators, and optical transmitters; weighing, signaling, measuring, counting, recording, monitoring, testing, and open- and closed-loop control and switching devices, namely, radio-controlled electric switches, electric sensors and electric actuators for pollutants, location detection, communication, heat, motion, pressure and electricity."

The instant application to register the mark VOLTE TECHNOLOGY represents the third time Applicant has applied to register a VOLTE trademark with the Office. Applicant's first application, for the mark VOLTE & Design, proceeded directly to approval for publication in 2011 and eventually received registration no. 4514966 in 2014, after a showing of use.

Applicant's second application, for the mark VOLTE TECHNOLOGY, claimed protection for goods identical to those in the instant application; that application, too, readily gained approval for publication, and it received a Notice of Allowance before lapsing before evidence of use could be filed.

Now, examining this second application to register the mark VOLTE TECHNOLOGY for goods identical to those approved in the prior application, the Examining Attorney has refused registration due to an alleged likelihood of confusion with two earlier-registered trademarks. All three of the Cited Registrations, however, predate Applicant's earlier registration for the mark VOLTE and Design and also Applicant's earlier, approved application for VOLTE TECHNOLOGY for goods identical to those in the instant application.

Applicant thus asks the Examining Attorney to reconsider the Section 2(d) objection, in light of the following facts: (i) the objection is inconsistent with the Office's prior stance with regard to Applicant's VOLTE and Design registration and VOLTE TECHNOLOGY trademark application for the same goods; (ii) Applicant's VOLTE TECHNOLOGY trademark differs meaningfully from the marks shown in the Cited Registrations, which claim protection for use with goods different from those of Applicant; and (iii) in response to the Examining Attorney's request, Applicant has elsewhere in this response clarified the nature of its goods, with the further effect of highlighting the differences between Applicant's goods and those shown in the Cited Registrations.

Argument

I. The Office twice has approved Applicant's VOLTE and VOLTE TECHNOLOGY marks, despite the existence of the cited marks.

As noted above, Applicant owns a companion registration (the "Companion Registration") for the mark VOLTE and Design, for Class 42 services identical to those claimed

in the instant application and which are closely related to Applicant's Class 9 goods claimed in the instant application. Immediately upon being examined, the Companion Registration was approved for publication in August, 2011. The Companion Registration is for a mark highly similar to the mark shown in the instant application.¹ Similarly, in May, 2011, the Office approved for publication Applicant's previous application to register the mark VOLTE TECHNOLOGY (ser. no. 85/090,743, the "Previous Application"), for goods identical to those shown in the instant application. That Previous Application was approved for publication without any mention of the Cited Registrations.

The Cited Registrations were issued on the following dates: registration no. 1,307,817 was issued on December 4, 1984; registration no. 1,334,145 was issued on May 7, 1985, and registration no. 1,610,490 was issued on August 21, 1990. In other words, the Office's prior two examinations did not find any likelihood of confusion between Applicant's VOLTE marks -- in one case, for goods identical to those claimed herein, and in the other case, for services closely related to such goods -- and the marks in the Cited Registrations.

In such situations, the Trademark Manual of Examining Procedure ("*TMEP*") directs Examining Attorneys considering such a later-filed, follow-on application to "act consistently with the [applicant's prior] registration, unless it would be clear error to do so." *TMEP* § 702.03(a)(iii). Such consistency is an important goal of the Office, and it weighs in favor of approval for publication.²


¹ As the Examining Attorney notes here in the first Office Action, the word TECHNOLOGY in Applicant's mark is merely descriptive and has been disclaimed; disregarding that descriptive element leaves only the word VOLTE, and renders the textual portion of Applicant's mark effectively identical to the mark in Applicant's Companion Registration.

² The Patent and Trademark Office recently has emphasized the importance of examining companion registrations and applications consistently. See United States Patent and Trademark Office Consistency Initiative, available at <http://www.uspto.gov/trademark/trademark-updates-and-announcements/consistency-initiative>.

II. Applicant's trademark and claimed goods are distinct from the marks in the Cited Registrations and their associated goods.

Applicant's trademark is VOLTE TECHNOLOGY, and the marks shown in the Cited Registrations are VOLTEC (reg. no. 1,307,817) for "electronic and electro-mechanical monitors, sensors and controls, computers and computer programs for environmental management of buildings"; VOLTEX (reg. no. 1,334,145) for "electric batteries"; and VOLTEX (reg. no. 1,610,490) for "stand-by power supplies for electronic equipment."

Although Applicant's mark and the marks in the Cited Registrations share the prefix "VOLT," Applicant notes that in the industry electrical-power products, there are many marks which share that prefix with Applicant's mark. (The popularity of such marks is unsurprising, given that the word "volt" names the measure of electrical potential.) For instance, Applicant notes the existence of the following active registrations for such marks, from among many:

Mark	Reg. No.	Goods/Services
VOLTSTAR	3850628	Class 9: Cell phone battery chargers; battery chargers; power supplies; [etc.]
	4076580	Class 9: Computer programs for power management of batteries and battery life extension
VOLTMASER	4040840	Class 7: Centrifugal pumps; electric generators, namely, electric power generators for industrial, commercial and agricultural use, but not for use in the marine industry; generators of electricity, namely, electric power generators for industrial, commercial and agricultural use, but not for use in the marine industry; portable electric power generators, namely, portable electric power generators for industrial, commercial and agricultural use, but not for use in the marine industry
VOLTCONNECT	4645774	Class 9: Electric transformers; Electric voltage transformers; Electrical transformers; Surge protectors; Transformers; Voltage surge protectors.
VOLTBOLT	3351439	Class 9: Locking electrical power cords and locking electrical extension cords

As with the registrations noted above, Applicant's mark, too, has a suffix which is different from that of the marks in the Cited Registrations.

Moreover, Applicant's VOLTE TECHNOLOGY goods are substantially different in nature from those offered under the VOLTEC and VOLTEX trademarks. Applicant's goods all pertain to energy harvesting; specifically, Applicant's goods concern extracting and harvesting power from novel sources such as ocean waves, human movement, and slowing vehicles. Applicant's goods do not relate to or make use of conventional, powerline-based energy, as do the goods in the Cited Registrations, and Applicant's goods do not concern power storage, as in the case of the VOLTEX mark, nor do they concern devices for the environmental management of buildings, as does the VOLTEC mark.

The vast and diverse power-products industry allows these various VOLT marks to coexist without confusing consumers, and Applicant knows of no instance of confusion between the marks in the Cited Registrations and Applicant's VOLTE trademarks. (Indeed, the marks in the Cited Registrations – which are more closely associated with each other than either is with Applicant's mark – have coexisted on the Principal Register for nearly 30 years.) These factors all argue in favor of approval for publication.

III. Applicant's revised description of goods clarifies the nature of those goods and further distinguishes Applicant's mark from the cited marks.

Finally, Applicant notes that it has elsewhere in this response clarified and narrowed its description of goods, in response to the Examining Attorney's request for same, with the added effect that the description more clearly highlights the differences between Applicant's goods and those in the Cited Registrations. By way of example, Applicant has replaced the phrase "power sources for sensors and actuators" with "electrical power supplies for sensors and electric actuators," and Applicant has replaced "vibration sensors" with "vibration sensors for

applications such as monitoring equipment and environmental conditions.” By narrowing and specifying its goods, Applicant has mitigated any likelihood that a consumer would find the VOLTE TECHNOLOGY mark and the marks in the Cited Registrations to be confusingly similar.

For the reasons stated above, Applicant respectfully requests that the refusal to register Applicant’s Mark be reversed, and that the subject application be approved for publication.