RESPONSE TO OFFICE ACTION

Applicant Delta Electronics, Inc. (hereinafter "Applicant"), by Counsel Chen Huang, Esq. of Adli Law Group, P.C., respectfully submits this request for reconsideration that the Examining Attorney withdraw her refusal to register the instant mark under the Trademark Act Section 2(d), stating as follows:

ARGUMENT IN SUPPORT OF REGISTRATION

The Examining Attorney refused registration of the mark on the basis that, if registered, the Applicant's mark, "NEXTGEN" (hereafter "Applicant's Mark") would create a likelihood of confusion with the registered mark "NEXTGEN" identified in U.S. Registration Number 5,346,672 (hereafter "the '672 Mark") and Number 3,760,986 (hereafter "the '986 Mark")(collectively as "cited marks"). In response, Applicant has made following amendments to the description of goods:

(1) Class 9 is deleted from the present application.

(2) Identification of goods in class 11 is amended to the following (with track and changes):

Air-conditioners for telecom power cabinets; air conditioners for cabinet-type electric power supply installations; air conditioners for computer ~~(~~server~~)~~ data center installations; cooling appliances and installations, namely, air-coolers, cabinet-type air cooling appliances, vapor chamber cooler modules for dissipating the heat accumulated in air conditioning systems, ~~liquid-cooled radiators,~~ refrigerating cabinets, refrigerating chambers, and thermoelectric cooler modules in the nature of active electric cooler for cooling water, food or beverages; air conditioning installations; air purifying apparatus and machines; electric fans for air conditioning installations and apparatus; fans sold as integral component parts of air conditioners; ventilators for air conditioning installations and apparatus; ~~electric lighting fixtures, namely, street lights;~~ filters for air conditioning; refrigerating appliances and installations

Section 2(d) Refusal – Likelihood of Confusion

As to the' 986 Mark

The '986 Mark identifies "lighting ballasts" as goods under class 009. In light of Applicant's removal of "electric lighting fixtures, namely, street lights" from class 011 and deletion of class 009, Applicant believes the goods between Applicant's Mark and the '986 Mark are now obviously dissimilar because their goods are different so far as to the functions, purposes and trading channels are concerned. For instance, the light ballast is designed to regulate the current to the lights and provide sufficient voltage to start the light (usually for fluorescent lighting system). It is a sophisticate electronic device that requires careful selection by the technician in lighting industry. On the other hand, rest of the identified goods in Applicant's Mark are related to cooling devices (e.g., air-conditioners, cooling appliances and installations, ventilators, refrigerating appliances etc.) which are used and purchased by sophisticate purchaser from a different and non-lighting industry. As such, likelihood of confusion is unlikely to occur.

Based upon the foregoing remarks and amendment, Applicant submits that confusion with the '986 Mark is unlikely and respectfully request the Examiner to withdraw the rejection.

As to the '672 Mark

The '672 Mark identifies "control systems for industrial furnaces comprising electric control panels, electrical controllers for regulating furnace operating conditions and computer software for use in regulating and controlling industrial furnace operation; furnace sensors and probes; optical sensors; gas sensors and probes; gas analyzers; computer software for controlling industrial equipment and furnaces" as goods under class 011.

The Examining Attorney states that because “applicant’s goods are broadly identified”, “it is presumed that the goods include those for industrial use” and that “registrant’s computer software for controlling industrial equipment is broadly identified and, therefore, presumed to include such software for controlling industrial equipment like applicant’s goods. In response, the Applicate has removed class 9 from the application entirely, so there are no longer software/controller products conflicting with the cited mark. Further, the remaining goods in Class 11 can easily be understood as the air-conditioning apparatus and cooling devices, which are specific, narrow and clear, and can be easily distinguished from the goods in the ‘672 Mark by ordinary consumers.

In addition, the goods of the ‘672 Mark primarily focus on computer software in their nature, while the Applicant’s goods are specific hardware like air-conditioning apparatus and cooling devices which cannot possibly be confused with the software by consumers. Since Applicant has deleted all their identified goods in Class 9, which has eliminated any possible confusion with the cited goods “computer software for controlling industrial equipment”, ordinary consumers would not possibly confuse air-conditioning apparatus and cooling devices identified in Class 11 with “computer software for controlling industrial equipment” in Class 9. Thus, likelihood of confusion is unlikely to occur.

Further, Applicant respectfully disagrees that the Applicant’s goods is “presumed” to include those for industrial use. The similarity judgment between the goods should be primarily based upon the nature and typical function of the specific goods at issue, rather than “presuming” their far-fetched utilizing purpose (i.e. industrial purpose). If such presumption stands, then virtually any hardware, devices, apparatus, equipment, systems, or instruments identified in any other classes can broadly be interpreted as “for the industrial

purpose” and would unreasonably broaden the scope of their identifications and applications.

Based upon the foregoing remarks and amendment, Applicant submits that confusion with the ‘672 Mark is unlikely and respectfully request the Examiner to withdraw the rejection.

As to both Marks

Applicant’s Goods and Registrants’ Goods Are Sold To Careful, Sophisticated Purchasers Under Conditions That Require Thought And Attention To Source

Circumstances suggesting care in purchasing may tend to minimize likelihood of confusion. *See generally* TMEP § 1207.01(d)(vii). The care with which consumers make purchasing decisions renders confusion between Applicant's mark and the cited mark unlikely and weighs heavily in Applicant's favor. *See In re E.I. Dupont de Numours & Co.*, 476 F.2d. 1357, 1361 (C.C.A.P.) (the Examining Attorney should consider "the conditions under which and buyers to whom sales are made, *i.e.* "impulse" vs. careful, sophisticated purchases."); *Magnaflux Corp. v. Sonoflux Corp*., 231 F.2d 669, 109 U.S.P.Q. 313 (C.C.P.A. 1956) ("it has been repeatedly held other things being equal, confusion is less likely where goods are expensive and are purchased after careful consideration than where they are inexpensive and are purchased casually."); McCarthy §§ 23:95 (stating that when the goods or services in question are expensive, "the reasonably prudent person standard is elevated to the standard of the "discriminating purchaser").

Here, the purchase of control system (i.e., computer software) for industrial furnace and purchase of cooling appliances both requires research, comparison and careful, thoughtful consideration on behalf of the purchaser. Thus, confusion is less likely in the

instant matter where parties' goods are expensive and are purchased after careful consideration.

Applicant And The Registrants Offer Their Services In Different Channels Of Trade

Cooling appliance are generally sold in different stores altogether or different parts of a store from the software for industrial furnace in connection with the cited marks. Thus, confusion is unlikely to occur because the goods in Applicant's mark are not in the same channels of trade with goods in the cited marks.

IV. Conclusion

Based upon the foregoing remarks and amendment, Applicant submits that confusion with the Cited Marks is unlikely and publication of this application is courteously solicitated.