

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

September 25, 2019



Marynelle W. Wilson
Examining Attorney
Law Office 113
United States Patent and Trademark Office

Re: Serial No: 88346245
Mark: ASI
Applicant: ASI Computer Technologies, Inc.
Office Action: June 7, 2019

APPLICANT'S RESPONSE TO OFFICE ACTION



The following is the response of Applicant, ASI Computer Technologies, Inc., by Counsel, to the Office Action sent via email on June 7, 2019, by Examining Attorney Marynelle W. Wilson.

REFUSAL UNDER SECTION 2(d) - LIKELIHOOD OF CONFUSION

The Examining Attorney has refused registration for the mark  (the "Applied-for Mark") on the basis of being confusingly similar under Section 2(d) to the registrations for  and ASI (the "Cited Marks"). Applicant respectfully traverses the Examining Attorney's refusal for the following reasons and submits that the Applied-for Mark is deserving of registration.

Likelihood of confusion is determined by a review of all of the relevant factors under the DuPont test. *In re E.I. du Pont de Nemours & Co.*, 476 F.2d1357, 177 USPQ 563 (CCPA 1973). Although the issue of likelihood of confusion typically revolves around the similarity or dissimilarity of the marks and the relatedness of the goods or services, "there is no mechanical test for determining likelihood of confusion and 'each case must be decided on its own facts.'" TMEP § 1207.01 (citing *du Pont*, 476 F.2d at 1361, 77USPQ at 567). Each of the thirteen DuPont factors may be considered in weighing likelihood of confusion, if raised, and any one may be dispositive. See TMEP § 1207.01.

Applicant's and Registrant's Marks

Applicant's Mark	Cited Marks
	
<p>Class 35: On-line wholesale and retail store services featuring electronic and computer goods and accessories and distributorship services featuring electronic and computer goods and accessories.</p>	<p>Class 9: Digital signage monitors; electronic LED and LCD signs; luminous signs; neon signs.</p>

The Court of Custom and Patent Appeals in *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973), delineated the principal factors to be considered in determining whether there is a likelihood of confusion under Section 2(d). The *DuPont* Court recognized that not all of the factors are relevant in all cases, and emphasized there is no one factor that is determinative. *Id.* A fact finder must consider all the evidence before making a decision of likelihood of confusion. The Examining Attorney based her determination that the marks are likely to be confused exclusively on consideration of the similarity of the marks and similarity of the goods and services.

The court pointed out that “[i]n every case turning on likelihood of confusion, it is the duty of the examiner, the board and this court to find, upon consideration of *all* the evidence, whether or not confusion appears likely.” *DuPont*, 476 F.2d at 1362 (emphasis in original). “In discharging this duty, the thirteen *DuPont* factors ‘must be considered’ ‘when [they] are of record.’ *In re Dixie Rests., Inc.*, 105 F.3d 1405, 1406 (Fed. Cir. 1997) (quoting *DuPont*, 476 F.2d at 1361).

However, as explained below, the care exercised by sophisticated purchasers of the goods and services, the fact that the respective goods and services are not related, the distinct commercial impressions conveyed by the respective marks and the lack of any actual confusion during a co-existence for about ten years make consumer confusion unlikely. As a result, the Applied-for Mark should be allowed to proceed to publication on the *Official Gazette* for registration on the Principal Register.

1. The Applied-for Mark is Dissimilar to the Cited Mark

TMEP Section 1207.01(b) states that “the first factor requires examination of the similarity or dissimilarity of the marks in their *entireties* as to appearance, sound, connotation and commercial impression.” The test of likelihood of confusion is not whether the marks can be distinguished when subjected to a side-by-side comparison, but whether the marks are sufficiently similar that there is a likelihood of confusion as to the source of the goods or services. *See Zheng Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1801 (Fed. Cir. 2018).

One must apply a sight, sound and meaning analysis, comparing the appearance of the marks, how they sound, and the meanings of the words or designs compared. *J.T. McCarthy on Trademarks and Unfair Competition*, §23.21 (4th ed. 2009). When marks contain both design and word elements, there is no general rule as to which portion of the mark is dominant and even where one portion of the mark is dominant, that is not dispositive. *See Spice Islands, Inc v. Frank Tea & Spice Co.*, 184 USPQ 35, 37 (CCPA 1974) (improper to ignore portion of composite mark).

Applicant respectfully argues the Examining Attorney compared the marks without regard to the overall commercial impression, without consideration of the relative differences in the stylization of the words and design features and without consideration of the weakness of the word portion of the respective marks. Accordingly, instead of merely concluding, based on the similarity of the word elements, that the marks were likely to be confused, the Examining Attorney should have considered (a) that the weakness of the word element reduces its significance, and (b) the distinct commercial impression created by the distinct design elements and stylization of the respective marks.

Composite marks must be compared on a case-by-case basis without reliance on mechanical rules of construction. *See* TMEP 1207.01(c)(ii). There is no rule that, when marks which contain both words and designs are compared, the words always dominate the analysis. Further, “whether a mark is classified as ‘strong’ or ‘weak’ is a very important element in deciding likelihood of confusion.” *J.T. McCarthy on Trademarks and Unfair Competition* § 23:48 (4th ed.). “Evidence of third-party use of similar marks on similar goods is relevant to show that a mark is relatively weak and entitled to only a narrow scope of protection.” *See Palm*

Bay Imports Inc. v Veuve Clicquot Ponsardin Maison Fondée En 1772, 73 USPQ2d 1689, 16g3 (Fed. Cir 2005).

In the case of Registrant's mark, the letter combination ASI is frequently used in connection with goods in Class 9. (See Exhibit A). Applicant notes twenty-seven registered marks which contain, or consist entirely of, the letters ASI. The significant number of co-existing marks which contain the ASI letter combination suggests that this particular letter combination is commonly used on goods in Class 9, and that the relevant consumers are accustomed to distinguishing between various marks which contain the letter combination ASI. Accordingly, the letter combination ASI is weak and entitled to a narrow degree of protection. Thus, when comparing the marks, the word portions should not be given undue weight and the distinct design elements and stylization, as discussed below, serve to distinguish the marks and eliminate the likelihood of consumer confusion.

Even where two marks employ the same word elements, and even where those elements are dominant, use of distinct stylization, graphics and colors may create a distinct commercial impression, making it unlikely that consumers will confuse the source of the respective goods or services. *See King of the Mountain Sports Inc. v. Chrysler Corp.*, 51 USPQ2d 1349, 1353 (10th Cir. 1999). With regard to color, the court observed the plaintiff's mark was displayed in a camouflage color scheme while the defendant's mark was displayed in bright blue, purple and red. *Id.* In addition, though both marks contained a "mountain" design element, the designs were entirely distinct. Notwithstanding the similar word elements, the court found the distinct stylization, color scheme and design elements of the respective marks lent each a distinct commercial impression. Consequently, the marks were considered distinct.

In the present case, the word element of Applicant's mark is depicted in a distinctive stylization and color, and in connection with highly distinctive design feature. The Applied-for Mark includes a yellow circle to the left of a blue triangle, which slightly encloses the yellow circle. The Registrant's mark consists of three diamond shapes followed by the letters "ASI". The design distinctions lead to an entirely different commercial impression and avoids any consumer confusion.

Even with respect to the only common feature, the letter combination "ASI," the typefaces used are distinct and Applicant's depiction of ASI is distinguished by blue capital letters. Due to the distinct colors, typefaces, dominant design elements and weak word elements,

consumers are unlikely to confuse the source of the goods associated with these respective marks.

2. The Goods and the Channels of Trade are not Related

Applicant submits that the proposed amended goods and services description included in the following paragraph, along with the conditions and circumstances under which the parties' goods/services are purchased, eliminate any likelihood of confusion between the Applied-for Mark and Cited Marks. The Federal Circuit has noted that customer "sophistication is important and often dispositive because sophisticated consumers may be expected to exercise greater care." *Electronic Design & Sales v. Electronic Data Sys. Corp.*, 21 USPQ2d 1388, 1392 (Fed. Cir. 1992) (citations omitted). The normal standard used to determine likelihood of confusion is that of the reasonably prudent person. *J.T. McCarthy on Trademarks and Unfair Competition*, §23.91 (4th ed. 2009). However, if the goods or services are expensive and purchased after careful consideration, then a more stringent standard, that of the "discriminating purchaser," is used. *Id.* at § 23:96. Similarly, "[w]here the relevant buyer class is composed solely of professional, or commercial purchasers, it is reasonable to set a higher standard of care than exists for consumers." *Id.* at §23:101. See also *Checkpoint Systems Inc. v. Check Point Software Technologies Inc.*, 60 USPQ2d 1609, 1617 (3rd Cir. 2001).

Before examining the distinctive nature of the respective consumers, and in response to the Examining Attorney's request for clarification of the goods and services description in the application, the Applicant proposes the following amended language:

"On-line wholesale and retail store services featuring electronic goods, namely, computers, tablets, computer monitors, displays, projectors, CPUs, memory, headphones, speakers, power supply, drones, fans and heat control components, printers, cables, cases, keyboards, mice, security and surveillance systems and components, drivers, storage systems, laptops, motherboards, enclosures, servers, drives, soundcards, networking components scanners, software, adapters, video cards, and computer goods and accessories, and distributorship services featuring electronic goods, namely, computers, tablets, computer monitors, displays, projectors, CPUs, memory, headphones, speakers, power supply, drones, fans and heat control components, printers, cables, cases, keyboards, mice, security and surveillance systems and components, drivers, storage systems, laptops, motherboards, enclosures, servers, drives, soundcards, networking components scanners, software, adapters, video cards, and computer goods and accessories."

In addition to clarifying the nature of the goods used in connection with the Applied-for Mark, the language above also significantly aids in finding no likelihood of confusion between the Applied-for Mark and the Cited Mark's referenced in the Section 2(d) refusal. The Applicant's website, taken along with the proposed language, at <https://www.asipartner.com/> reinforces the fact that the Applicant is a national distributor of IT hardware and software products, components and accessories as described above, which are not related to, nor do they share channels with, the signage products offered in connection with the Cited Mark. (See Exhibit B). The goods offered under the Cited Marks include "digital signage monitors; electronic LED and LCD signs; luminous signs; neon signs." The goods are offered on the Registrant's website at <https://asisignage.com/>. Their website indicates that they offer interior, exterior and digital signage. (See Exhibit C). These goods are inherently different than IT services and products.

More importantly, professional and commercial purchasers are the target consumers for both the Applicant and Registrant. Applicant submits that the likelihood of confusion by the relevant purchasing consumers is negligible, if at all, as the parties operate in different trade channels, with highly sophisticated discriminating consumers. The amended goods and services description along with the discerning nature of the Applicant's and Registrant's respective targeted consumers, being reasonable, well-informed and circumspect are not likely to be confused into thinking that the Applicant's goods and the Registrant's goods originate from the same or related sources.

3. No Evidence of Actual Confusion


The Applied-for mark is almost twenty-two years old – it has been in use since 1987. The Cited Marks have been in use since 2009. As such, the marks have co-existed for ten years without any evidence of actual confusion. The *DuPont* factors include consideration of "the length of time during and conditions under which there has been concurrent use without evidence of actual confusion." There has been no knowledge and/or communications from third parties regarding any confusion, nor has Applicant received any charge of infringement from the Registrant.

Conclusion



When the marks are viewed on the whole and the respective goods and consumers considered, the relevant *DuPont* factors weigh heavily in favor of the registration of Applicant's

mark. The application of those factors to the marks at issue here demonstrates that consumers are not likely to be confused between the Applied-for Mark and Registrant's Marks cited against it by the Examining Attorney.

PRIOR PENDING APPLICATION

The Examining Attorney has indicated the potential for refusal based on a prior pending application for the mark  (the "Pending Mark"). Applicant respectfully disagrees that the Pending Mark is confusingly similar to the Applied-for Mark.

Applicant's and the Pending Mark

Applicant's Mark	Pending Mark
	
<p>Class 35: On-line wholesale and retail store services featuring electronic and computer goods and accessories and distributorship services featuring electronic and computer goods and accessories.</p>	<p>Class 9: Electrotechnical and electronic equipment, namely IT, audiovisual, multimedia and photographic equipment, apparatus, instruments and cables for electricity, security, safety, protective and signaling apparatus and measuring, detection and monitoring instruments, devices and regulators; building environment, access and security control components and elements, in particular electrotechnical and electronic actuators and sensors, including inductor, capacitive and optoelectronic proximity switches, and installations, devices and equipment consisting of and assembled from electrotechnical and electronic apparatus; building environment, access and security control components and elements, namely IT audiovisual, multimedia and photographic equipment, apparatus, instruments and cables for electricity, security, safety, protective and signaling apparatus and measuring, detection and monitoring instruments, devices and regulators.</p>

1. The Applied-for Mark is Dissimilar to the Pending Mark

As discussed above, the letter combination ASI is frequently used in connection with goods in Class 9. The significant number of co-existing marks which contain the ASI letter

combination suggests that this particular letter combination is commonly used for goods in Class 9, and that the relevant consumers are accustomed to distinguishing between various marks which contain the letter combination ASI. Accordingly, the letter combination ASI is weak and entitled to a narrow degree of protection. Thus, when comparing the marks, the word portions should not be given undue weight and the distinct design elements and stylization, as discussed below, serve to distinguish the marks and eliminate the likelihood of consumer confusion.

As described above, the word element of Applicant's mark is depicted in a distinctive stylization and color, and in connection with highly distinctive design feature. The Applied-for Mark includes a yellow circle to the left of a blue triangle which slightly encloses the yellow circle. The Pending Mark consists of the stylized letters "ASI" in black with the letters forming the lower left portion of a triangle. The remaining portions of the triangle are yellow. The design distinctions lead to an entirely different commercial impression and avoid any consumer confusion.

Even with respect to the only common feature, the letter combination "ASI," the typefaces used are distinct and Applicant's depiction of ASI is distinguished by blue capital letters. Due to the distinct colors, typefaces, dominant design elements and weak word elements, consumers are unlikely to confuse the source of the goods associated with these respective marks.

2. The Goods and the Channels of Trade are not Related

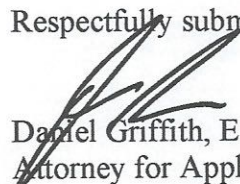
Here, the goods under the Applied-for Mark and the Pending Mark are being purchased predominantly by professional and/or commercial purchasers. The goods offered under the Pending Mark are "[e]lectrotechnical and electronic equipment, namely IT, audiovisual, multimedia and photographic equipment, apparatus, instruments and cables for electricity, security, safety, protective and signaling apparatus and measuring, detection and monitoring instruments, devices and regulators; building environment, access and security control components and elements, in particular electrotechnical and electronic actuators and sensors, including inductor, capacitive and optoelectronic proximity switches, and installations, devices and equipment consisting of and assembled from electrotechnical and electronic apparatus; building environment, access and security control components and elements, namely IT audiovisual, multimedia and photographic equipment, apparatus, instruments and cables for

electricity, security, safety, protective and signaling apparatus and measuring, detection and monitoring instruments, devices and regulators.”

The goods are offered on the website at <https://www.as-interface.net/technologie/basis/>. Their website indicates that they provide products related to, and installation of, modern automation systems. (See Exhibit D). These goods are extremely different than IT services and products offered under the Applied-for Mark. The target consumer of the goods under the Pending Mark is large companies seeking automation products, installation and support further avoiding any likelihood of confusion. (See Exhibit E)

Applicant submits that the likelihood of confusion by the relevant purchasing consumers is negligible, if at all, as the parties are in fact in different trade channels, with discriminating and different target consumers. The targeted consumer, being reasonable, well-informed and circumspect is not likely to be confused into thinking that the Applicant’s goods and the Pending Mark’s goods originate from the same or related sources.

Respectfully submitted,



Daniel Griffith, Esq.
Attorney for Applicant

Exhibit A



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11	85004356	4727844	ASIS MINIMIZING DOWNTIME	TSDR	LIVE
12	85004126	4727843	ASIS	TSDR	LIVE
13	85674908	4413133	ASI	TSDR	LIVE
14	79255226		ASI	TSDR	LIVE
15	79075626	4051338	E-GEOS AN ASI/TELESPAZIO COMPANY	TSDR	LIVE
16	78694732	3221553	ASI DATAMYTE	TSDR	LIVE
17	77723948	3714890	ASI	TSDR	LIVE
18	77773260	4179764	ASI	TSDR	LIVE
19	77787893	3757292	ASI EXEC	TSDR	LIVE
20	77129213	3737365	ASI	TSDR	LIVE
21	76640303	3122470	ASI	TSDR	LIVE
22	76640399	3128515	ASI	TSDR	LIVE
23	75882492	2410666	ASI-MV	TSDR	LIVE
24	75764468	2875873	ASI COMPUTER SYSTEMS	TSDR	LIVE
25	75421800	2852247	ASI INQUIRE	TSDR	LIVE
26	75398272	2847081	ASI	TSDR	LIVE
27	75461922	2828739	ASI BUSINESS SOLUTIONS	TSDR	LIVE
28	75453742	2474746	ASI CONSOLE	TSDR	LIVE
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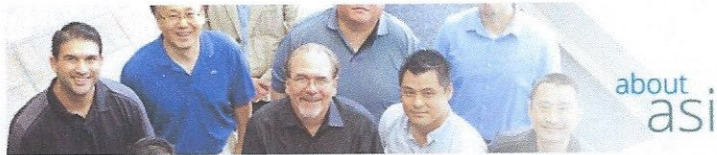
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Exhibit B



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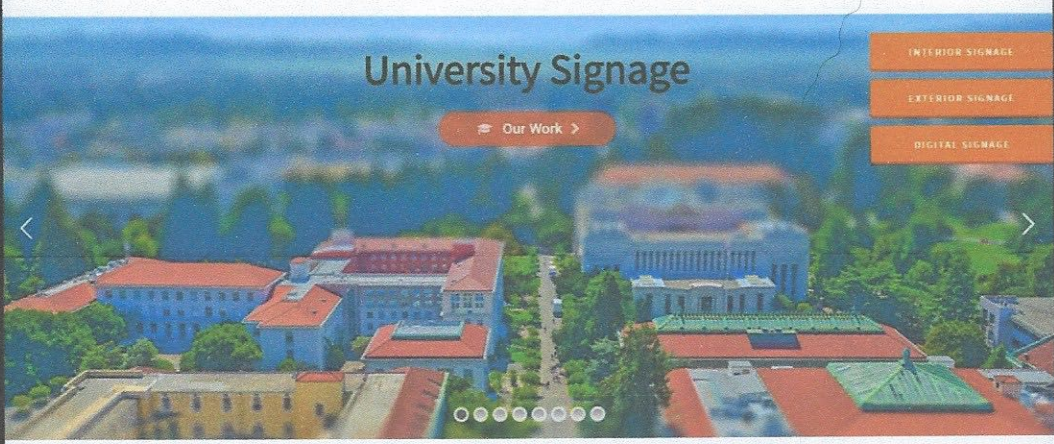


Founded in 1987, ASI Corp. is a national distributor of IT hardware and software products, maintaining a professional staff of 500 employees and 13 sales/warehouse locations in the US and Canada. For over 30 years, ASI has continually taken a lead role in setting new standards in the distribution of IT solutions and value-add services. Today, ASI carries over 150 product lines and has over 20,000 of the most in-demand products.

ASI's corporate headquarters is located in Fremont, California and has regional US offices in Atlanta, Chicago, Dallas, Houston, Kansas, Los Angeles, Miami, New Jersey, and Portland, as well as Canadian offices in Montreal, Toronto and Vancouver. In addition, ASI has offices in Mexico located in Monterrey and Nuevo Laredo.

ASI's diverse portfolio of products and services give us the ability to service a broad spectrum of customers, including VARs, system integrators, retailers, DMRs and OEM accounts. We believe every customer is a VIP and thus every account is assigned a highly trained regional account manager and given access to our veteran technical support team.

Exhibit C



University Signage

Our Work

- INTERIOR SIGNAGE
- EXTERIOR SIGNAGE
- DIGITAL SIGNAGE



Exhibit D



Products

Marketplace of possibilities

The openness of the AS-Interface system offers the user a wealth of possibilities. Automation specialists around the world have used the freely available specification to develop solutions for common and specialized automation solutions.

As an application-oriented platform, it offers a wide variety of access options to the product world of the AS-Interface. As open as the system itself, the manufacturers face each other directly next to each other. Comparison desired!

Products

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Manufacturer



Exhibit E



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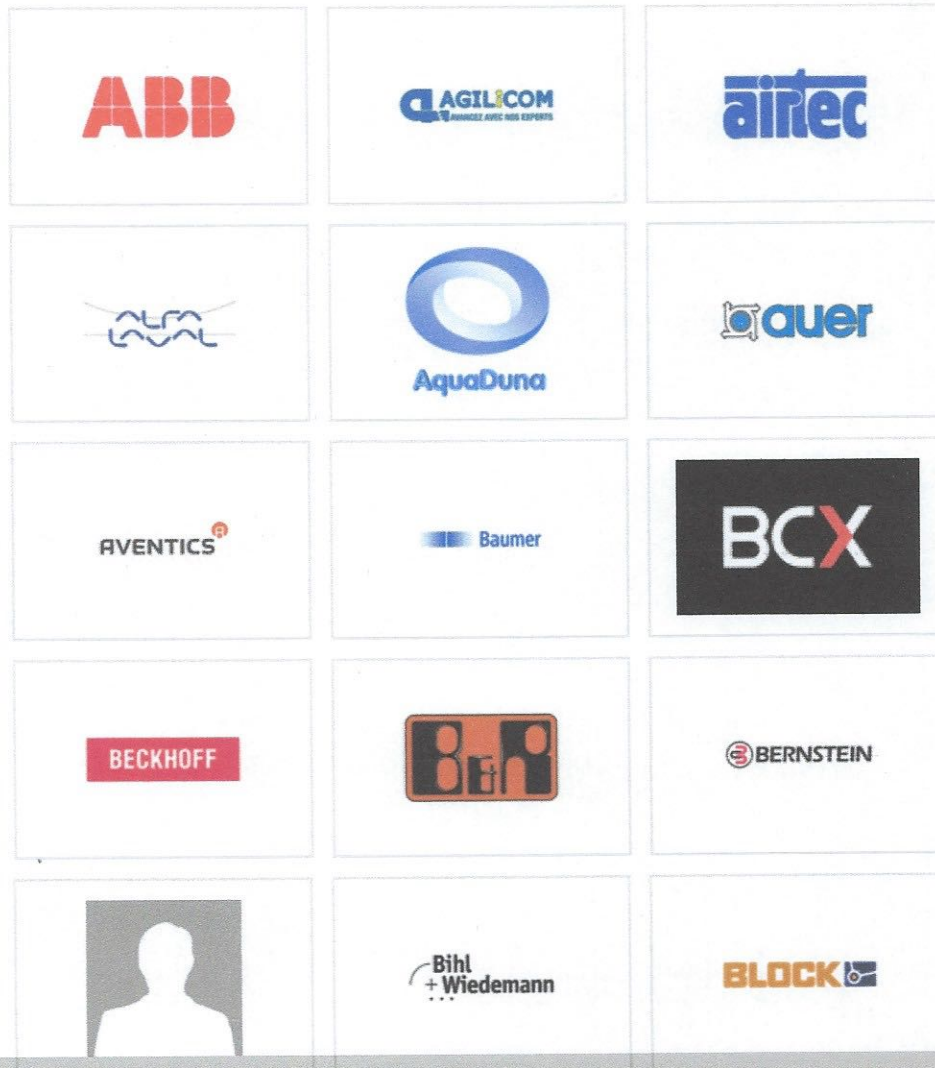
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