

**UNITED STATES PATENT AND TRADEMARK OFFICE
RESPONSE TO OFFICE ACTION**

Applicant:	I.T.L. (PRODUCT TESTING) LTD.)	Trademark Law Office: 121
Serial No.:	88470366)	
Filed:	June 12, 2019)	Examiner:
Mark:)	Matthew D. McClellan
)	
)	Mailing Date of Action:
)	September 11, 2019



Introduction

In an Office Action dated September 11, 2019 related to Applicant's certification mark ITL (and design) ("Applicant's Mark"), the Examiner partially refused registration of Applicant's Mark, under Trademark Act Section 2(d), claiming a likelihood of confusion with the trademarks in U.S. Registration Nos. 3311906 (ITL), 1364372 (ITL), 1045362 (ITL INDUSTRIAL TIRES LTD.), 5073689 (ITL BIOMEDICAL), and 5588759 (ITL ESSENTIALS) (the "Cited Marks").

Response

This Response addresses the Examiner's partial refusal as follows: (1) Applicant amends the description of goods for certification in U.S. Application No. 88470366, to further differentiate such goods from the goods described in the Cited Marks; and (2) Applicant argues that there is no likelihood of confusion between Applicant's Mark and the Cited Marks.

(1) Amendment of Goods for Certification.

Applicant hereby amends the goods for certification, as described in the subject Application, as follows (amendments noted):

Electrical devices, equipment, materials and parts therefor, usually not of a voltage exceeding 600v, namely, Banking equipment/ATMs; Energy and power generation, distribution, storage, and charging equipment, and parts therefor, and related goods; Engines, motors, generators, hydraulic equipment and parts therefor; ~~Electrical devices, equipment, materials and parts therefor, usually not of a voltage exceeding 600v;~~ Lamps, luminaires and lighting equipment, materials and parts therefor; Wire, cable and parts therefor for power, data and telecommunications; Consumer and business electronics, equipment and appliances; Equipment for detecting, handling, storing or using hazardous liquids and gases; Recreation, life safety and power equipment for marine and water use; Heating, ventilation, air conditioning and refrigeration systems, equipment and parts therefor; ~~Medical equipment and devices;~~ Robots and robotic equipment, parts and related goods; Semiconductor devices and equipment; ~~Vehicles and vehicle equipment, parts and related goods;~~ Food processing, preparation, handling and storage equipment and related goods

As amended, the identification of goods for certification will read as follows:

Electrical devices, equipment, materials and parts therefor, usually not of a voltage exceeding 600v, namely, Banking equipment/ATMs, Energy and power generation, distribution, storage, and charging equipment, and parts therefor, and related goods, Engines, motors, generators, hydraulic equipment and parts therefor, Lamps, luminaires and lighting equipment, materials and parts therefor, Wire, cable and parts therefor for power, data and telecommunications, Consumer and business electronics, equipment and appliances, Equipment for detecting, handling, storing or using hazardous liquids and gases, Recreation, life safety and power equipment for marine and water use, Heating, ventilation, air conditioning and refrigeration systems, equipment and parts therefor, Robots and robotic equipment, parts and related goods, Semiconductor devices and equipment, Food processing, preparation, handling and storage equipment and related goods

Further to the arguments set forth below, this amendment to the identification of goods for certification *specifically deletes* the goods for certification to which the Examiner's partial refusal pertains, namely: "Medical equipment and devices" and "Vehicles and vehicle equipment, parts and related goods." As such, Applicant's deletions and amendments clearly distinguish Applicant's goods from those described in the registrations for the Cited Marks. As revised, Applicant's goods are now clearly distinct from the goods described in the Cited Marks.

(2) No Likelihood of Confusion.

Applicant asserts that Applicant's Mark is unlikely to cause confusion with the Cited Marks primarily because the goods described in Applicant's Mark (as revised) are unrelated to the goods described in the Cited Marks.

In finding a likelihood of confusion between Applicant's Mark and the Cited Marks, Examiner clearly states that the refusal is only a partial refusal, and specifically: "THIS PARTIAL REFUSAL APPLIES ONLY TO THE GOODS SPECIFIED THEREIN." Examiner then specifies that for the purpose of the partial refusal, "Applicant's relevant goods for certification are Medical equipment and devices [and] Vehicles and vehicle equipment, parts and related goods."

As noted above, Applicant has amended the identification of goods for certification to delete the goods for certification to which the Examiner's refusal pertains, namely: "Medical equipment and devices" and "Vehicles and vehicle equipment, parts and related goods." As such, the goods described in the application for Applicant's Mark (as revised), and the goods described in the registrations for the Cited Marks, are unrelated and do not overlap. The Cited Marks cover various medical devices and apparatus, and parts and equipment for vehicles, *whereas* Applicant's Mark (as revised) does not cover any medical devices or vehicle parts or equipment. Therefore, the goods covered by the respective marks do not overlap, are not competitive, and as such, are unlikely to cause any confusion.

As stated by McCarthy: "[I]f there is no likelihood of confusion, classic trademark law mandates that it is possible that the exact same marks can peacefully co-exist on different goods and services. And in fact, it is not uncommon in the world of commerce." McCarthy on Trademarks, §24:11,

Page 24-36. Such coexistence is exactly what Applicant argues is fair under the law in this Response.

Conclusion

Based on the sum of the foregoing arguments and explanations, there is no likelihood of confusion between Applicant's Mark and the Cited Marks. Therefore, Applicant respectfully requests that Applicant's Mark proceed to registration in due course, as revised in this Response.