


OFFICE ACTION RESPONSE

Applicant’s mark is KE, U.S. Trademark Application Serial No. 88/374,042 for use in connection with, as amended¹:

Construction drafting **for commercial and living housing development only**; Design of interior decor; Dress designing; Providing a web site featuring technology that enables users to remotely view residential house and apartment; Visual home inspection services for sellers and purchasers of residential and commercial properties



(“Applicant’s Mark”). Registration of Applicant’s Mark has been refused under Section 2(d) based on a finding of likelihood of confusion the following marks:

Mark	Reg. No.	Services
KE INSIGHTS	4562585	Class 35: Business consultation services provided to the pharmaceutical, biotechnology, medical device and diagnostics industries to gain key expert insights on current data presented at national medical conferences and other professional venues
	5094937	Class 42: Traffic and transportation engineering

¹ Applicant has amended its services ID in Class 42 as follows:

~~Scientific research and development; Product quality testing; Vehicle roadworthiness testing; Industrial design;~~ Construction drafting **for commercial and living housing development only**; Design of interior decor; Dress designing; ~~Computer programming; Information technology (IT) consulting services; Computer services, namely, integration of private and public cloud computing environments; Authenticating works of art; Graphic arts design; Cartography services; Design and development of multimedia products; Photogrammetry services; Development and creation of computer programmes for data processing; Rental of computer software and programs; Installation, maintenance and repair of computer software; Computer graphics design services; Writing of data processing programs; Electronic storage of consumer data;~~ Providing a web site featuring technology that enables users to remotely view residential house and apartment; Visual home inspection services for sellers and purchasers of residential and commercial properties

The Examining Attorney should therefore consider Applicant’s arguments in light of the amended identification.

Mark	Serial No.	Goods/Services
	87308635	<p><u>Class 9:</u> Uninterruptible electrical power supplies for telecommunications equipment, industrial equipment, Commercial IT equipment, oil and gas equipment, and manufacturing process equipment; Indoor DC power supplies with battery backup and rack supplying 48V DC Power; Outdoor power supplies with battery backup and cabinet supplying 48V DC Power; 48V and 125V DC rectifiers; Electrical power connectors, namely, Power Shelves; Power Controllers; Battery monitoring solutions, namely, devices to monitor batteries, namely, battery monitoring systems comprised of electronic components and controllers; Indoor AC uninterruptible power supplies (UPS) from 1kVA to 1 MVA; Single Phase Indoor AC uninterruptible power supplies (UPS); 3 Phase Indoor uninterruptible power supplies (UPS); Single Phase Outdoor uninterruptible power supplies (UPS) from 0.1kVA to 5KVA; Industrial Rectifiers supplying 125V and 230V DC Power; Voltage regulators, Electrical power Converters and Conditioners; Electrical power Frequency Regulators, Converters and Conditioners; Batteries including Lead Acid, valve-regulated lead-acid(VRLA), Lithium Ion, and nickel-metal hydride (NiMH); Battery Rack systems comprised of racks for batteries and Battery Cabinets</p> <p><u>Class 37:</u> Installation of electrical power generators and hybrid power generators</p> <p><u>Class 40:</u> Custom manufacture of electrical power generators and hybrid power generators</p>
	87482053 ²	<p><u>Class 42:</u> Planning and engineering services in the fields of agricultural and mining industries; Designing material handling systems for the agricultural and mining industries</p>

(collectively, the “Cited Marks”). Furthermore, registration of Applicant’s Mark was refused based on a finding that is primarily merely a surname under Section 2(e)(4). Applicant respectfully

² Serial No. 87482053 has since registered and has been issued Reg. No. 5788404

disagrees and submits this response to the Examining Attorney's refusal based upon the following arguments.

I. THERE IS NO LIKELIHOOD OF CONFUSION BECAUSE THE SERVICES ARE NOT RELATED

The Examining Attorney found that there is a likelihood of confusion because “. . . third parties routinely offer the same or similar goods/services offered by both applicant and registrant under the same mark and/or the relevant goods/services are sold or provided through the same trade channels.” The Examining Attorney also noted that this refusal is partial, and only applies to “Scientific research and development; Product quality testing; Vehicle roadworthiness testing; Industrial design; Cartography services.” Applicant has amended its services in Class 42 to delete the conflicting services, thus obviating the Section 2(d) refusal with respect to the Cited Marks KE INSIGHTS and KE (Reg. No. 5094937). Furthermore, Applicant’s commercial and living housing-related services are not related to the agricultural and mining-related services of the Cited Mark KE (Reg. No. 5788404), nor the industrial electronics-related goods and services of the Cited Mark KE (Serial No. 87308635). Therefore, there is no likelihood of confusion among Applicant’s Mark and the Cited Marks.

II. THE MARK IS NOT PRIMARILY MERELY A SURNAME

The Examining Attorney found that Applicant's Mark is primarily merely a surname based on evidence showing the applied-for mark appearing 490,503 times as a surname in a nationwide phone directory of names, which is a weekly updated directory of cell phone and other phone numbers (such as voice over IP) from various data providers,” and that the evidence “indicates that KE is a common Chinese American surname.” Applicant respectfully disagrees.

Section 2(e)(4) of the Trademark Act precludes registration of a mark which is “primarily merely a surname.” A mark is primarily merely a surname if “the primary significance of the mark to the purchasing public” is a surname. *In re Kahan & Weisz Jewelry Mfg. Corp.*, 508 F.2d 831, 184 USPQ 421, 422 (CCPA 1975), citing *Ex parte Rivera Watch Corp.*, 106 USPQ 145, 149 (Com’r Pat. 1955). The Examining Attorney bears the initial burden of making a *prima facie* showing that a mark is primarily merely a surname. TMEP § 1211.02(a); see also *In re Etablissements Darty et Fils*, 759 F.2d 15, 225 USPQ 652, 653 (Fed. Cir. 1985).

After the Examining Attorney makes a *prima facie* showing, the Board has identified five factors to consider in determining whether a mark is primarily merely a surname:

- (1) the degree of the surname's "rareness";
- (2) whether anyone connected with the applicant has the mark as a surname;
- (3) whether the mark has any recognized meaning other than as a surname;
- (4) whether the mark has the "look and feel" of a surname; and
- (5) whether the manner in which the mark is displayed might negate any surname significance.

See *In re Benthin Mgmt. GmbH*, 37 USPQ2d 1332, 1332-33 (TTAB 1995); see also TMEP § 1211.01. If there is any doubt as to whether a term is primarily merely a surname, the doubt must be resolved in favor of the applicant. See *Benthin*, 37 USPQ2d at 1334; see also TMEP § 1211.01.

A. Applicant's Mark is Not Primarily Merely a Surname Under the *Benthin* Factors

Applicant's Mark is not primarily merely a surname under the Board's *Benthin* factors. Two of the most important factors in determining whether a mark is primarily merely a surname are whether anyone connected with the applicant has the mark as a surname and whether the mark has any recognized meaning other than as a surname. TMEP § 1211.01(a)(i); *In re Benthin Mgmt. GmbH*, 37 USPQ2d 1332, 1333 (TTAB 1995) (finding the fact that BENTHIN was a rare surname to be a factor weighing against a finding that the term would be perceived as primarily merely a surname); *In re Sava Research Corp.*, 32 USPQ2d 1380, 1381 (TTAB 1994) (finding SAVA not primarily merely a surname, where there was evidence that the term had other meaning and no evidence that the term was the surname of anyone connected with applicant); *Fisher Radio Corp. v. Bird Electronic Corp.*, 162 USPQ 265 (TTAB 1969) (holding BIRD not primarily merely a surname); *Ex Parte Omaha Cold Storage Co.*, 111 USPQ 189 (Comm'r Pat. 1956) (holding DOUGLAS not primarily merely a surname due to other, non-surname significance); *In re The Monotype Corp. Plc.*, 14 USPQ2d 1070 (TTAB 1989) (holding CALISTO not primarily merely a surname). Furthermore, when determining surname significance, the Examining Attorney must consider whether the term has any meaning in a foreign language. TMEP § 1211.01(a)(vii); *In re Isabella Fiore LLC*, 75 USPQ2d 1564 (TTAB 2005) (holding FIORE not primarily merely a surname because it is the Italian equivalent of "flower").

Here, no one connected to Applicant has "KE" as a surname. Furthermore, **the term KE has at least 40 different recognized meanings in Mandarin other than as a surname.** See Exhibit A. "KE" is the Hanyu Pinyin transliteration of a wide variety of characters in the Chinese language. Spoken Mandarin Chinese is highly dependent on the pitch inflection of the vowel

sounds in the language. When transcribed to Latin characters, the Hanyu Pinyin system places accent marks above the vowel sounds in order to indicate the pitch inflection of the vowel so that the non-native speaker may use the proper pitch inflection. *See* Exhibit B. The Ke surname is Romanized in Hanyu Pinyin as "kē", which is pronounced in Mandarin Chinese using a steady, high tone. The "kē" pronunciation is associated with nearly 40 different Chinese characters, all with different meanings. *See* Exhibit A. For example, the Chinese character 軻 transliterates into Pinyin as "kē" and is the character that represents the Ke surname. *Id.* However, the same pronunciation can be used to reference other words in Mandarin, such as the character 柯 which translates to "axe handle". *Id.* In contrast, Applicant's Mark is not Romanized in Hanyu Pinyin as "kē", but instead is Romanized in Pinyin as "ké", indicating an upward inflection from low to high tones in the speaker's voice. This correlates with the Chinese character 殼, which translates to "shell". *See* Exhibit C. **Thus, the third *Benthin* factor weighs heavily in favor of Applicant due to the wide range of meanings of the term KE in Mandarin.** For the fourth factor, KE does not have the "look and feel" of a surname -- particularly in view of the clear differences in pronunciation and appearance to signify any purported surname significance in Mandarin Chinese as discussed above. These factors all weigh heavily against a finding that the mark is primarily merely a surname.

Finally, Applicant respectfully reminds the Examining Attorney that all doubt must be resolved in favor of the Applicant because "others who have the same surname and use it or wish to use it for the same or similar goods or services can file a notice of opposition." *In re Benthin*, 37 USPQ2d 1334 (TTAB 1995); *Cf. In re Gourmet Bakers, Inc.*, 173 USPQ 565 (TTAB 1972) (descriptive marks); *In re In Over Our Heads Inc.*, 16 USPQ2d 1653, 1654-55 (TTAB 1990) (scandalous and disparaging marks); *In re Mavety Media Group Ltd.*, 33 F.3d 1367, 31 USPQ2d 1923, 1928 (Fed. Cir. 1994) (immoral and scandalous marks); *In re Hines*, 32 USPQ2d 1376, 1377 (TTAB 1994) (disparaging marks).

III. CONCLUSION

Based on the foregoing, Applicant respectfully submits that Applicant's Mark is not primarily merely a surname and that there is no likelihood of confusion among Applicant's Mark and the Cited Mark. Accordingly, Applicant respectfully requests that the Examining Attorney withdraw the Section 2(d) and Section 2(e)(4) refusals and allow Applicant's Mark to be published for opposition.

