



DOGWOOD PATENT AND TRADEMARK LAW

4801 GLENWOOD AVE., STE 200 RALEIGH, NC 27612

June 1, 2021

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Applicant: Soelect

Serial No.: 90038092

Mark: LiX

Filed: July 6, 2020

International Class: 009

Examining Attorney: Joanna Scleidorovich

Law Office: 128

Attorney Docket No.: 226/2 TM

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

RESPONSE TO NON-FINAL OFFICE ACTION

Applicant files the instant reply in response to the Non-Final Office Action pending in connection with the above-referenced trademark application.

Response to the Entity Amendment Refusal

Applicant respectfully requests that the entity information be updated to Soelect, a Delaware Corporation. Applicant submits that the instant trademark application was filed by the owner and there was an inadvertent error in identifying the owner as a North Carolina corporation. Soelect, a North Carolina corporation does not exist, and did not exist at the time the trademark application was filed.

Accordingly, Applicant requests that the owner information be updated to correct inadvertent error. Applicant should be identified as:

Soelect, a Delaware corporation.

Response to the Section 2(e)(1) Refusal

The Examiner has refused registration of Applicant's mark "LiX" for use with batteries and lithium ion batteries in Class 009. Specifically, the Examiner has based the rejection on the assertion that the applied-for mark merely describes a characteristic of Applicant's goods.

In response, Applicant respectfully disagrees and submits that a mark is merely descriptive under Section 2(e)(1) only if it immediately conveys information concerning a significant quality, characteristic, function, ingredient, attribute, or feature of the goods or services identified in the application. *In re Bayer Aktiengesellschaft*, 488 F.3d 960 (Fed. Cir. 2007); *In re Engineering Systems Corp.*, 2 U.S.P.Q.2d 1075 (T.T.A.B. 1986). The information must be conveyed not only immediately, but also with a "degree of particularity." *In re TMS Corp. of the Americas*, 200 U.S.P.Q. 57, 59 (T.T.A.B. 1978) (THE MONEY SERVICE not merely descriptive for transferring money to and from savings accounts because the mark suggests "a number of things, but yet falls short of describing applicant's services in any one degree of particularity"). Thus, Applicant respectfully submits that the test is whether a consumer who knows what the goods or services are will understand the mark to immediately convey information about a quality, purpose, feature, function, or characteristic of the goods or services.

The Examining Attorney finds their refusal of registration of LiX on the proposition that the mark would be understood as describing the *feature, characteristic, or purpose* of Applicant's services. The Examiner asserts that a consumer would immediately understand that Applicant provides batteries containing a lithium-X coefficient, where X represents either bromide or iodine.

However, Applicant respectfully submits that the cited mark cannot describe the feature, characteristic, or purpose of Applicant's goods with any degree of precision, because the term "LiX" each have a variety of meanings such that Applicant's mark does

not *immediately* describe the function or purpose of those goods. Applicant notes that a consumer would not immediately associate the “X” in “LiX” with either bromide or iodine. Even if a consumer understood “Li” to refer to lithium, the “X” would create the commercial impression of an unknown value (e.g., the “x” in mathematics). That is, the letter “x” has been the standard letter to use for an unknown value. Please see, Exhibit A. Thus, the letter “x” inherently refers to an unknown value.

Further, in this case, the terms “Li” and “X” have several dictionary definition meanings. For example, “Li” can refer to (Exhibit B):

1. Long Island (state/local entity)
2. Liechtenstein (country)
3. Light Induced
4. Log In (computers)
5. Limited Information (military)
6. Laser Interferometry (electronics)
7. Love Interest (internet)
8. Licensed Irrigator (occupational)

In addition, “X” can refer to (Exhibit C):

1. Multiplied by (mathematics)
2. Reactance (electronics)
3. Ex (former)
4. Kiss (internet)
5. 10 (mathematics)
6. Xbox (computing)
7. Xena (celebrity)
8. Adults only (Film Censorship)
9. Horizontal axis (mathematics)

Therefore, the term LiX can refer to the Adults Only in Long Island, former Liechtenstein, Xbox Log In, etc.

It is therefore apparent that the LiX mark cannot immediately convey characteristics of Applicant’s products due to the possible number of different meanings of the term. As such, Applicant respectfully submits that the mark should be registered as at least suggestive and not merely descriptive.

The Trademark Trial and Appeal Board continues to apply this principle in reversing refusals of registration. In its decision in *In re Siemens Stromberg-Carlson*, Allen's Trademark Digest, Vol. 13, No. 6, at 30 (Dec. 1999), the Board reiterated the significance of such multiple meanings. In *Siemens*, the Board agreed with the Applicant that the proposed mark was not descriptive, noting that there were several different

interpretations of applicant's mark. Similarly, in *In re PointCast Incorporated*, Allen's Trademark Digest, Vol.13, No. 4, at 59 (Oct. 1999), the Board found that because SMART has multiple, commonly understood meanings, the Examining Attorney's definitions did not prove that SMARTSCREEN had a readily recognized meaning with respect to the Applicant's goods. Applicants respectfully submit that the Board would likely apply the same reasoning to LiX mark in this case.

In addition, the USPTO has previously granted registration on the Principal Register to a number of marks that include the term LI used with at least one other letter with batteries, as shown in the Table below. Accordingly, the USPTO has demonstrated that a mark that includes the term "Li" in combination with an additional letter to describe batteries is generally not descriptive. Printed copies of the marks cited in the Table are included as Exhibit D.

<u>Mark</u>	<u>Registration/Serial No.</u>	<u>Int'l Class</u>	<u>Goods/Services</u>
LIM	5357267	009	Batteries and electrical cells
LI-ION TECHNOLOGY	4934577	009	Apparatus and instruments for conveying, distributing, transforming, storing, regulating and controlling electric current, namely, batteries and battery chargers ...
LiHD	5153148	009	Battery packs; chargers for batteries; batteries
LITHIUMPOWER	3569971	009	Batteries, electrical cells and batteries.
LiSIM	4562465	009	Batteries, namely, battery modules for energy buffering...
Li Lead	5179014	009	Smartphones featuring lithium batteries; Lithium batteries, electric, for vehicles; Lithium battery jars; Lithium battery boxes; Lithium batteries for lighting; Lithium anode batteries; Lithium battery chargers; Lithium galvanic batteries; Lithium batteries, electric; Lithium accumulators, electric; Lithium photovoltaic cells; Solar lithium batteries; solar cell panel for use with lithium batteries; Lithium battery power banks.
LITHIUM SAFE FLEX	5105670	009	Lithium batteries.
Li	5410971	009	Batteries...
Li3	4950008	009	Lithium-Ion batteries; Lithium-Ion electrical cells and batteries

LIION	3881947	009	lithium ion nano-phosphate stored energy motive power solutions, namely, lithium ion nano-phosphate batteries.
LITHIUMLIFE	4709283	009	Batteries; Battery chargers; Chargers for batteries; Lithium ion batteries.
LIJIA	5659686	009	Batteries; Batteries for electronic cigarettes; Batteries for lighting; Batteries, electric, for vehicles; Battery chargers; Battery chargers for laptop computers; Battery packs for video cameras, laptops; Dry cells and batteries; Electrical cells and batteries; Ignition batteries; Lead-acid battery testing, desulfating and regenerating devices; Lithium ion batteries; Mobile telephone batteries; Rechargeable electric batteries.
LIB-IOT	88927168 (Allowed)	009	Lithium Ion Batteries

The Table clearly illustrates that marks that include the term “Li” when used with batteries, lithium ion batteries has previously been found by the USPTO be suggestive, not descriptive. Accordingly, Applicant respectfully submits that the LiX mark should likewise be viewed as suggestive.

Doubt About Descriptiveness Should Be Resolved in Applicant’s Favor

The Board has acknowledged that drawing distinctions between descriptive and suggestive marks involves highly subjective judgments and mandates that close questions are resolved through publication. *In re J. Ray McDermott & Co.*, 170 U.S.P.Q. 524, 525, (T.T.A.B. 1971); see also *In re Pennwalt Corp.*, 173 U.S.P.Q. 317, 373 (T.T.A.B. 1972). Here, the determinations of the Examiner as to the suggestiveness of OBTAIN FITNESS COMPANY at the very least raises serious doubt as to whether the mark is merely descriptive. The TTAB has held that any doubt about descriptiveness should be resolved “in Applicant’s behalf...” *In re Aid Laboratories, Inc.*, 221 USPQ 1215, 1216, (TTAB 1983); and see *In re Grand Metropolitan Foodservice Inc.*, 30 USPQ2d 1974, 1976 (TTAB 1994) (finding MUFFUNS (stylized) not merely descriptive of muffins because “any doubt with respect to the issue of descriptiveness should be resolved in applicant’s behalf.”) Accordingly, applicants respectfully request that the Examining Attorney withdraw the refusal to register LiX as merely descriptive.

With best regards,

A handwritten signature in blue ink, consisting of a stylized 'A' followed by a series of loops and a long horizontal stroke.

Ashley D. Johnson
Dogwood Patent and Trademark Law, PLLC