

Response to Office Action

The table below presents the data as entered.

| Input Field | Entered |
|--|---|
| SERIAL NUMBER | 88331109 |
| LAW OFFICE ASSIGNED | LAW OFFICE 127 |
| MARK SECTION | |
| MARK | https://tmng-al.uspto.gov/resting2/api/img/88331109/large |
| LITERAL ELEMENT | STEINEL DIGITAL CONTROL SOLUTION |
| STANDARD CHARACTERS | YES |
| USPTO-GENERATED IMAGE | YES |
| MARK STATEMENT | The mark consists of standard characters, without claim to any particular font style, size or color. |
| ARGUMENT(S) | |
| In response to the Office Action dated May 30, 2019, the Examiner refused this mark because of likelihood of confusion with the mark STEINEL, Registration Number 2126466, Steinel GMBH being the Registrant. Applicant, Steinel America Inc., is a wholly owned subsidiary of Registrant, Steinel GMBH. Thus Steinel GMBH, as a sole owner of Steinel America Inc., has ownership of both the registration and this application. | |
| GOODS AND/OR SERVICES SECTION (current) | |
| INTERNATIONAL CLASS | 009 |
| DESCRIPTION | |
| digital lighting controls, controllers, sensors, hardware and software, lighting controls, lighting sensors, lighting switches, and interfaces of lighting controls with HVAC and electrical outlets | |
| FILING BASIS | Section 1(b) |
| GOODS AND/OR SERVICES SECTION (proposed) | |
| INTERNATIONAL CLASS | 009 |
| TRACKED TEXT DESCRIPTION | |
| digital lighting controls, controllers, sensors, hardware and software, lighting controls, lighting sensors, lighting switches, and interfaces of lighting controls with HVAC and electrical outlets ; Digital lighting controls; lighting, electrical outlet plug load, and HVAC controllers; Computer hardware and recorded software systems for remotely controlling lighting devices, electrical outlet plug load, and HVAC within a building; lighting controls; light systems comprising light sensors and switches; interfaces of lighting controls with HVAC and electrical outlets | |
| FINAL DESCRIPTION | |
| Digital lighting controls: lighting, electrical outlet plug load, and HVAC controllers; Computer hardware and recorded software systems for remotely controlling lighting devices, electrical outlet plug load, and HVAC within a building; lighting controls; light systems comprising light sensors and switches; interfaces of lighting controls with HVAC and electrical outlets | |
| FILING BASIS | Section 1(b) |
| ADDITIONAL STATEMENTS SECTION | |
| DISCLAIMER | No claim is made to the exclusive right to use DIGITAL CONTROL SOLUTION apart from the mark as shown. |

| ATTORNEY SECTION (current) | |
|---|---------------------------------------|
| NAME | David R. Fairbairn |
| ATTORNEY BAR MEMBERSHIP NUMBER | NOT SPECIFIED |
| YEAR OF ADMISSION | NOT SPECIFIED |
| U.S. STATE/ COMMONWEALTH/ TERRITORY | NOT SPECIFIED |
| FIRM NAME | KINNEY & LANGE, P.A. |
| STREET | 312 SOUTH THIRD STREET |
| CITY | MINNEAPOLIS |
| STATE | Minnesota |
| POSTAL CODE | 55415 |
| COUNTRY | US |
| PHONE | 612-339-1863 |
| FAX | 6123396580 |
| EMAIL | tmdocket@kinney.com |
| AUTHORIZED TO COMMUNICATE VIA EMAIL | Yes |
| DOCKET/REFERENCE NUMBER | S167-022026 |
| ATTORNEY SECTION (proposed) | |
| NAME | David R. Fairbairn |
| ATTORNEY BAR MEMBERSHIP NUMBER | XXX |
| YEAR OF ADMISSION | XXXX |
| U.S. STATE/ COMMONWEALTH/ TERRITORY | XX |
| FIRM NAME | Kinney & Lange, P.A. |
| STREET | 312 South Third Street |
| CITY | Minneapolis |
| STATE | Minnesota |
| POSTAL CODE | 55415 |
| COUNTRY | United States |
| PHONE | 612-339-1863 |
| FAX | 6123396580 |
| EMAIL | tmdocket@kinney.com |
| AUTHORIZED TO COMMUNICATE VIA EMAIL | Yes |
| DOCKET/REFERENCE NUMBER | S167-022026 |
| OTHER APPOINTED ATTORNEY | All Attorneys of Kinney & Lange, P.A. |
| CORRESPONDENCE SECTION (current) | |
| NAME | DAVID R. FAIRBAIRN |
| FIRM NAME | KINNEY & LANGE, P.A. |
| STREET | 312 SOUTH THIRD STREET |
| CITY | MINNEAPOLIS |

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| FAX | 6123396580 |
| EMAIL | tmocket@kinney.com; drfairbairn@kinney.com; mness@kinney.com |
| AUTHORIZED TO COMMUNICATE VIA EMAIL | Yes |
| DOCKET/REFERENCE NUMBER | S167-022026 |
| CORRESPONDENCE SECTION (proposed) | |
| NAME | David R. Fairbairn |
| FIRM NAME | Kinney & Lange, P.A. |
| STREET | 312 South Third Street |
| CITY | Minneapolis |
| STATE | Minnesota |
| POSTAL CODE | 55415 |
| COUNTRY | United States |
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| EMAIL | tmocket@kinney.com; drfairbairn@kinney.com; mness@kinney.com |
| AUTHORIZED TO COMMUNICATE VIA EMAIL | Yes |
| DOCKET/REFERENCE NUMBER | S167-022026 |
| SIGNATURE SECTION | |
| RESPONSE SIGNATURE | /David R. Fairbairn/ |
| SIGNATORY'S NAME | David R. Fairbairn |
| SIGNATORY'S POSITION | Attorney of Record, MN Bar Member |
| SIGNATORY'S PHONE NUMBER | 6123391863 |
| DATE SIGNED | 12/02/2019 |
| AUTHORIZED SIGNATORY | YES |
| FILING INFORMATION SECTION | |
| SUBMIT DATE | Mon Dec 02 15:30:59 EST 2019 |
| TEAS STAMP | USPTO/ROA-XXX.XXX.XXX.XX- 20191202153059609366-8833 1109-700c654939bde4ce981 d61d489aa709566a82dfee084 3963134d82f8c68ac7ef-N/A- N/A-20191202152853962840 |

Response to Office Action

To the Commissioner for Trademarks:

Application serial no. **88331109** STEINEL DIGITAL CONTROL SOLUTION(Standard Characters, see <https://tmng-al.uspto.gov/resting2/api/img/88331109/large>) has been amended as follows:

ARGUMENT(S)

In response to the substantive refusal(s), please note the following:

In response to the Office Action dated May 30, 2019, the Examiner refused this mark because of likelihood of confusion with the mark STEINEL, Registration Number 2126466, Steinel GMBH being the Registrant. Applicant, Steinel America Inc., is a wholly owned subsidiary of Registrant, Steinel GMBH. Thus Steinel GMBH, as a sole owner of Steinel America Inc., has ownership of both the registration and this application.

CLASSIFICATION AND LISTING OF GOODS/SERVICES

Applicant proposes to amend the following class of goods/services in the application:

Current: Class 009 for digital lighting controls, controllers, sensors, hardware and software, lighting controls, lighting sensors, lighting switches, and interfaces of lighting controls with HVAC and electrical outlets

Original Filing Basis:

Filing Basis: Section 1(b), Intent to Use: For a trademark or service mark application: As of the application filing date, the applicant had a bona fide intention, and was entitled, to use the mark in commerce on or in connection with the identified goods/services in the application. **For a collective trademark, collective service mark, or collective membership mark application:** As of the application filing date, the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce by members on or in connection with the identified goods/services/collective membership organization. **For a certification mark application:** As of the application filing date, the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce by authorized users in connection with the identified goods/services, and the applicant will not engage in the production or marketing of the goods/services to which the mark is applied, except to advertise or promote recognition of the certification program or of the goods/services that meet the certification standards of the applicant.

Proposed:

Tracked Text Description: ~~digital lighting controls, controllers, sensors, hardware and software, lighting controls, lighting sensors, lighting switches, and interfaces of lighting controls with HVAC and electrical outlets;~~ [Digital lighting controls: lighting, electrical outlet plug load, and HVAC controllers;](#) [Computer hardware and recorded software systems for remotely controlling lighting devices, electrical outlet plug load, and HVAC within a building;](#) [lighting controls;](#) [light systems comprising light sensors and switches;](#) [interfaces of lighting controls with HVAC and electrical outlets](#)

Class 009 for Digital lighting controls: lighting, electrical outlet plug load, and HVAC controllers; Computer hardware and recorded software systems for remotely controlling lighting devices, electrical outlet plug load, and HVAC within a building; lighting controls; light systems comprising light sensors and switches; interfaces of lighting controls with HVAC and electrical outlets

Filing Basis: Section 1(b), Intent to Use: For a trademark or service mark application: As of the application filing date, the applicant had a bona fide intention, and was entitled, to use the mark in commerce on or in connection with the identified goods/services in the application. **For a collective trademark, collective service mark, or collective membership mark application:** As of the application filing date, the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce by members on or in connection with the identified goods/services/collective membership organization. **For a certification mark application:** As of the application filing date, the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce by authorized users in connection with the identified goods/services, and the applicant will not engage in the production or marketing of the goods/services to which the mark is applied, except to advertise or promote recognition of the certification program or of the goods/services that meet the certification standards of the applicant.

The applicant's current attorney information: David R. Fairbairn. David R. Fairbairn of KINNEY & LANGE, P.A., is located at

312 SOUTH THIRD STREET
MINNEAPOLIS, Minnesota 55415
US

The docket/reference number is S167-022026.

The phone number is 612-339-1863.

The fax number is 6123396580.

The email address is tmdocket@kinney.com

The applicants proposed attorney information: David R. Fairbairn. Other appointed attorneys are All Attorneys of Kinney & Lange, P.A.. David R. Fairbairn of Kinney & Lange, P.A., is a member of the XX bar, admitted to the bar in XXXX, bar membership no. XXX, and the attorney(s) is located at

312 South Third Street
Minneapolis, Minnesota 55415
United States

The docket/reference number is S167-022026.

The phone number is 612-339-1863.

The fax number is 6123396580.

The email address is tmdocket@kinney.com

David R. Fairbairn submitted the following statement: The attorney of record is an active member in good standing of the bar of the highest court of a U.S. state, the District of Columbia, or any U.S. Commonwealth or territory.

The applicant's current correspondence information: DAVID R. FAIRBAIRN. DAVID R. FAIRBAIRN of KINNEY & LANGE, P.A., is located at

312 SOUTH THIRD STREET
MINNEAPOLIS, Minnesota 55415
US

The docket/reference number is S167-022026.

The phone number is 612-339-1863.

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The email address is tmdocket@kinney.com; drfairbairn@kinney.com; mness@kinney.com

The applicants proposed correspondence information: David R. Fairbairn. David R. Fairbairn of Kinney & Lange, P.A., is located at

312 South Third Street
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The docket/reference number is S167-022026.

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The email address is tmdocket@kinney.com; drfairbairn@kinney.com; mness@kinney.com

ADDITIONAL STATEMENTS

Disclaimer

No claim is made to the exclusive right to use DIGITAL CONTROL SOLUTION apart from the mark as shown.

SIGNATURE(S)

Response Signature

Signature: /David R. Fairbairn/ Date: 12/02/2019

Signatory's Name: David R. Fairbairn

Signatory's Position: Attorney of Record, MN Bar Member

Signatory's Phone Number: 6123391863

The signatory has confirmed that he/she is a U.S.-licensed attorney who is an active member in good standing of the bar of the highest court of a U.S. state (including the District of Columbia and any U.S. Commonwealth or territory); and he/she is currently the owner's/holder's attorney or an associate thereof; and to the best of his/her knowledge, if prior to his/her appointment another U.S.-licensed attorney not currently associated with his/her company/firm previously represented the owner/holder in this matter: the owner/holder has revoked their power of attorney by a signed revocation or substitute power of attorney with the USPTO; the USPTO has granted that attorney's withdrawal request; the owner/holder has filed a power of attorney appointing him/her in this matter; or the owner's/holder's appointed U.S.-licensed attorney has filed a power of attorney appointing him/her as an associate attorney in this matter.

Mailing Address: DAVID R. FAIRBAIRN
KINNEY & LANGE, P.A.

312 SOUTH THIRD STREET
MINNEAPOLIS, Minnesota 55415

Mailing Address: David R. Fairbairn
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Serial Number: 88331109

Internet Transmission Date: Mon Dec 02 15:30:59 EST 2019

TEAS Stamp: USPTO/ROA-XXX.XXX.XXX.XX-201912021530596

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