

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Kellogg Brown & Root LLC
Serial No.: 90742720
Filed: May 28, 2021
Classes: 42
Mark: AIMS

COMMISSIONER FOR TRADEMARKS
P.O. Box 1451
Alexandria, VA 22313-1451

RESPONSE TO OFFICE ACTION

In the Office Action dated December 4, 2021, the Examining Attorney refused registration of the applied-for mark alleging a likelihood of confusion, failure to function as a service mark, an improper specimen, and requiring certain amendments to the claimed services. Applicant now submits the following response in support of registration.

I. Identification of Services

Applicant amends the services identifications for this application as follows:

Class 42: Engineering services, namely, engineering, design, and engineering consultancy services for handling of solid asphaltene removed in a deasphalting process

Applicant affirms that the above-noted amendments are for clarification purposes only and do not expand the claimed services beyond those originally filed.

II. Failure to Function and Specimen Refusals

Applicant is amending the basis of this application from Section 1(a) to Section 1(b) with this response. Applicant thus respectfully submits that these refusals are obviated.

III. No Likelihood of Confusion Exists

The Examiner refused Kellogg Brown & Root LLC (“KBR”)’s registration of the instant application for the mark AIMS in Class 42 arguing that there is a likelihood of confusion with Sto SE & Co. KGaA (“Sto”)’s U.S. Registration No. 6291615 for AIMS (the “Cited Mark”). The refusal was limited to the portion of the Cited Mark’s claimed services in Class 42 that reads “*Engineering consultancy services; Engineering design and consultancy services*” (the “Relevant Language”).

By agreement of the parties, Sto filed a Section 7 Request to the Cited Mark on March 10, 2022, removing the Relevant Language. As of the time of the filing of this Response to Office Action, the USPTO has not yet reviewed Sto's voluntary Section 7 Request. As a result, in a May 26, 2022 telephone conference, the Examiner recommended that Applicant submit the substance of the amendments made in the Section 7 Request with this response.

The changes filed with Sto's Section 7 Request are shown below (crossed-through language has been removed):

~~Scientific and technological services, namely, research and design in the field of civil engineering; Design services relating to civil engineering;~~ engineering design services in the field of thermal insulation, refurbishing and color; design of specialty interior and exterior environment settings, namely, development and providing of colour designs, colour guide plans and urban planning designs, creating and presentation of construction documentation and design plans for buildings, and studies relating thereto, including project initiation and resolution of design problems; engineering design services, namely, development and testing of technical and design solution in the field of building construction; architectural services, namely, selection and determining of colour tones, surfaces and materials for building parts, individual buildings and urban planning designs; ~~Engineering consultancy services; Engineering design and consultancy;~~ Consultancy in the field of architectural design relating to material selection, colour selection, constructional stone structure, building design services, energy efficiency and saving and environmental planning; urban planning services, namely, preparation of reports in the field of urban planning designs; urban design planning services, namely, preparation of reports in the field of 2D plan views or 3D representations; urban planning services, namely, creating colour print-outs and electronically processed concepts, as well as presentation data, colour designs, colour guide plans and urban planning designs; Scientific and technological services, namely, research in the field of thermal insulation materials for buildings; Software design and development; Design and development of computer hardware; Computer services, namely, providing search engines for finding the information, resources and websites of others on a global computer network; providing engineering and architectural design information relating to the design of colour and material concepts for exterior coverings and interior spaces of individual buildings and groups of buildings via an interactive database; computer programming in the field of creating colour and material concepts for urban design; computer programming in the field of creation of colour and material concepts for facades and interiors of individual buildings and groups of buildings; computer programming in the field of web layouts and web-based ordering systems; consultancy in the field of design and development of the architecture of computer software and hardware; Consultancy and information services relating to information technology architecture and infrastructure; architectural services for building design; Advisory services relating to testing and research services in the field of pollution control; Consultancy services relating to environmental planning

Sto voluntarily withdrew the Relevant Language cited in Examiner's refusal from the Cited Mark. Further, Sto has voluntarily removed the language "scientific and technological services, namely, research and design in the field of civil engineering" and "design services relating to civil

engineering.” In light of these amendments, Applicant respectfully asserts that there is no likelihood of confusion between Applicant’s applied-for mark and the Cited Mark.

SUMMARY

Applicant submits that the above response fully addresses the Examining Attorney’s concerns and the application is now in condition for publication. If any issues remain that are appropriate for resolution, please contact Applicant’s attorney of record.