

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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| In Re: | Application of Positec Group Limited | Filed: 01/07/2022 Trademark Law Office 122 |
| Mark: | EXIT | Trademark Examining Attorney: |
| Serial No.: | 97/207517 | John Salcido |

RESPONSE TO OFFICE ACTION (ARGUMENT SECTION)

Positec Group Limited, by counsel, submits this Response (via e-TEAS) to the Office Action dated 03/25/2022, and requests that the above-referenced Application be approved for publication and registration for the reasons discussed below. Please consider the following arguments and evidence in support of registration.

A. Overview

Applicant's mark EXIT was originally sought for registration for goods in Classes 007, 009, 011, and 021. In the Office Action, two registrations were cited against the Application in support of a refusal under Section 2(d), U.S. Registration Nos. 2777570 (EXIT) and 5466829 (XIT & Design), but only as to particular goods in the Application in Classes 011 and 021: "electric air dryers; hand-held electric hair dryers; hair dryers for household purposes; electric hair dryers" in Class 011 and "Thermally insulated containers for food or beverages; non-electric portable coolers; portable cool boxes, non-electric" in Class 021.

In a voluntary amendment filed on September 15, 2022, Applicant amended the identification of goods (via TEAS) to delete the goods referenced in the Section 2(d) refusal, and addressed informalities set forth in the Office Action by making other clarifying amendments, and perfecting the Section 44(e) basis for the Application. The voluntary amendment thus fully addressed the substance of the Section 2(d) refusal. Additionally, Applicant is responding herein to the Request for Information regarding the nature of the applied-for goods. Applicant therefore requests that the Section 2(d) refusal be withdrawn as to U.S. Registration Nos. 2777570 (EXIT) and 5466829 (XIT & Design).

However, Applicant is mindful of the Advisory regarding prior-pending U.S. Application Serial Nos. 79324048 (EXIT & Design) and 79320383 (EXIT TOYS & Design), which appear as follows:



In this regard, Applicant will address this Advisory in connection with its Request to Divide filed on September 16, 2022, so that the resulting parent and two child applications may move forward to publication.

B. Response To Request For Information

In response to the Request for Information in the Office Action, Applicant states as follows: Applicant's goods are not used in connection with lighted "EXIT" signs, nor are Applicant's goods "EXIT" signs.

C. Section 44(e) Filing Basis (Country of Origin)

Applicant has perfected the Section 44(e) filing basis, and therefore provides the following statement for the record pursuant to TMEP §1002.04: **"Applicant has had a bona fide and effective industrial or commercial establishment in the European Union as of the date of issuance of the foreign registration."**

D. Request to Divide

Applicant's Request to Divide, filed on September 16, 2022, divided out portions of Class 007 and Class 009 into a child application, and divided out portions of Class 011 and 021 into a second child application. The resulting parent and child applications are discussed below in connection with the Section 2(d) refusal and the Advisory regarding prior-pending applications.

1. The Parent Application (97/207517) Should Be Approved For Publication.

After the Request to Divide is processed, the original application should state as follows, with the multiple bases of Section 1(b), Section 44(d), and Section 44(e):

Class 007: Pumps as parts of machines, motors and engines; compressed air machines; juice extractors, electric; whisks, electric, for household purposes; electric vegetable peelers; electric fruit peelers; electric knife sharpeners; electric milk frothers

Class 009: Loudspeakers; cabinets for loudspeakers; horns for loudspeakers; megaphones; microphones; sound transmitting apparatus; sound recording apparatus; portable media players; chargers for electric accumulators; galvanic cells; battery chargers; batteries, electric, for vehicles; accumulators, electric; solar batteries; solar panels for the production of electricity; battery packs; lithium ion batteries; switches, electric; digital projectors; LCD projectors; electrical adaptors; power inverters; inverters for power supply; laser level measuring apparatus

Class 011: light bulbs; electric lamps; lamps; flashlights; electric flashlights; ceiling lights; lighting apparatus for vehicles; LED flashlights; lamps for tents; flat panel lighting apparatus; fans for air conditioning apparatus; electric fans for personal use; electric fans;

portable electric fans; wearable electric fans; clip on electric fans; portable air conditioners; gas grills; charcoal grills; roasting jacks; roasting spits for cooking ovens; electric roasters; roasters powered by propane gas; charcoal roasters for household purposes; coffee roasters; barbecues; bread baking machines; kettles, electric; electric egg boilers; food steamers, electric; barbecue smokers; electric frying pans; electric tea pots; air fryers; cooling appliances and installations for outdoor purposes; portable coolers, electric; portable refrigerators; personal cooling mats; electric heating apparatus for outdoor purposes; heat guns; heating pads, electric, not for medical purposes; electrically heated gloves; electrically heated vests; electrically heated scarfs; electrically heated chairs; electrically heated sleeping bags; portable grills; electric toasters; cooking ovens; electric food warmers; radiators, electric; electric pocket warmers for warming hands; portable electric heaters; laundry dryers, electric; fabric steamers; air purifying apparatus and machines; air purifiers; humidifiers; dehumidifiers; water purification installations; heating apparatus for dispensing hot beverages; drinking water equipment, namely, coolers and hot and cold dispensing consoles; drinking water dispensers

Class 021: ice pails; insect traps; camping grills; cooking utensils, namely, grills; barbecue mitts

The goods referenced in the cited registrations Nos. 2777570 (EXIT) and 5466829 (XIT & Design) have been deleted from the Application, so the Section 2(d) refusal should be withdrawn.

With respect to the prior-pending Serial Nos. 79324048 (EXIT & Design) and 79320383 (EXIT TOYS & Design), the parent application should not be suspended as a result. Both marks have the same general design, with color claims of green and white, the only difference being the wording EXIT and EXIT TOYS, in classes 011, 012, 028, and 041. The Office Action did not express the basis for the reference to these applications, but the original scope of these applications (having been filed pursuant to the Madrid Protocol) were exceedingly broad. Now that they have been amended, the prior-pending applications no longer should be cited against the Parent Application (or the Child Applications, as discussed separately below).

The Parent Application does not contain any goods in Classes 012, 028, or 041. The only class in common is Class 011, but the involved goods, as discussed below, are now disparate and unrelated, as discussed below. The scope of the EXIT & Design mark and the EXIT TOYS & Design mark (which has been amended since the Office Action) is as follows:

Class 011: Sanitary installations in the nature of spas, saunas, steam rooms, pools and equipment therefor; regulating equipment for water supply, namely, metered valves, swimming pool water cleaning and filtering units, and sanitation equipment, namely, faucets and valves for pipes and pipelines being parts of sanitary installations, pressure regulators for sanitary installations; steam bath installations, saunas and spa surrounds; sanitary facilities, namely, apparatus and installations in the nature of spas, saunas, steam rooms, pools for health spas and residential use and health spas

Class 012: Vehicles, namely, pedal cars for transport, carts, go-carts, tricycles not being toys, and bicycles, and pedalless bicycles

Class 028: Games, namely, outdoor ball and hockey sports; gymnastic and sporting articles, namely, backstops and rebound nets for ball sports and hockey, practice and regulation balls for sports; apparatus and equipment for outdoor recreation and adventure, namely, wendy houses being playhouses for children, playhouses, swings, playground equipment being climbing frames, playground slides, see-saws, spinners and trampolines; collapsible, non-folded and stationary goals, namely, football goals, soccer goals, basketball goals; play swimming pools; playtables, sandboxes, water-course sets

Class 041: Providing information relating to recreational gymnastic and sports equipment and games and playthings; providing information relating to vehicle driving instruction; providing information relating to physical fitness; providing information relating to the provision and operation of swimming pools and spas; organizing of recreational events, namely, outdoor recreational and adventure events, e.g., cycling events, running events, walking events, fitness events and sports competitions

The only Class of the EXIT / EXIT TOYS & Design application in common with the Parent Application is Class 011, and the scope of the EXIT / EXIT TOYS & Design application is limited to sanitary installations, water supply regulating equipment, and installations in the nature of spas, steam baths, steam rooms, and pools for health spas and residential use. None of the goods of Class 011 of the Parent Application are sufficiently related to this narrow field of goods so as to lead to a likelihood of consumer confusion. Likewise, none of the other goods of the Parent Application are sufficiently related to those of the prior-pending applications (which focus on various vehicles, games, and sporting and playground equipment, and informational services), so as to lead to a likelihood of consumer confusion. Accordingly, Applicant requests that the Parent Application be approved for publication.

**2. *The Child Application For Classes 007 and 009
Should Be Approved For Publication.***

After the Request to Divide is processed, the Child Application for Classes 007 and 009 should state as follows, with the multiple bases of Section 1(b), Section 44(d), and Section 44(e):

Class 007: compressed air pumps; electric food blenders

Class 009: audio speakers; wireless speakers; cordless speakers; batteries; solar panel chargers; electrical storage batteries; battery charge devices, namely, power stations; inverters; movie projectors; multimedia projectors

The goods referenced in the cited registrations Nos. 2777570 (EXIT) and 5466829 (XIT & Design) have been deleted from the Application, and do not appear in this Child Application, so the Section 2(d) refusal should be withdrawn.

Likewise, Serial Nos. 79324048 (EXIT & Design) and 79320383 (EXIT TOYS & Design), do not contain any goods in Classes 007 or 009. None of the goods of this Child Application are sufficiently related to those of the prior-pending applications so as to lead to a likelihood of consumer confusion. Accordingly, Applicant requests that this Child Application be approved for publication.

**3. *The Child Application For Classes 011 and 021
Should Be Approved For Publication.***

After the Request to Divide is processed, the Child Application for Classes 011 and 021 should state as follows, with the multiple bases of Section 1(b), Section 44(d), and Section 44(e):

Class 011: Lighting apparatus and installations for outdoor purposes; lanterns for lighting; portable misting fans; misting systems for outdoor cooling; barbecue grills; electric grills; coffee machines, electric; electric coolers; ice machines and apparatus; ice making machines; blankets, electric, not for medical purposes; electrically heated clothing; desiccating units for drying personal items

Class 021: diffuser vessels for insect repellents; electric devices for attracting and killing insects; plug-in diffusers for mosquito repellents; ultrasonic mosquito repellents; ultrasonic pest repellents

The goods referenced in the cited registrations Nos. 2777570 (EXIT) and 5466829 (XIT & Design) have been deleted from the Application, and do not appear in this Child Application, so the Section 2(d) refusal should be withdrawn.

Serial Nos. 79324048 (EXIT & Design) and 79320383 (EXIT TOYS & Design) do not contain any goods in Class 021, but those applications do include goods in Class 011. However, as discussed above, the scope of the EXIT / EXIT TOYS & Design application in Class 011 is limited to sanitary installations, water supply regulating equipment, and installations in the nature of spas, steam baths, steam rooms, and pools for health spas and residential use. None of the goods of Class 011 of this Child Application are sufficiently related to this narrow field of goods so as to lead to a likelihood of consumer confusion. Likewise, none of the other goods of this Child Application are sufficiently related to those of the prior-pending applications (which focus on various vehicles, games, and sporting and playground equipment, and informational services), so as to lead to a likelihood of consumer confusion. Accordingly, Applicant requests that this Child Application be approved for publication.

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E. Conclusion

For the foregoing reasons, Applicant's mark EXIT is not likely to cause confusion with the marks of Reg. Nos. 2777570 (EXIT) and 5466829 (XIT & Design), or the marks of the prior-pending Serial Nos. 79324048 (EXIT & Design) and 79320383 (EXIT TOYS & Design). Accordingly, the Section 2(d) refusal should be withdrawn with respect to the Parent Application and the two Child Applications. Applicant respectfully submits that the applications should be approved for publication, and requests such action.

Respectfully submitted,

/Scot A. Duvall/

Scot A. Duvall
Kentucky bar member
Attorney of record for Applicant
Positec Group Limited
September 19, 2022