IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

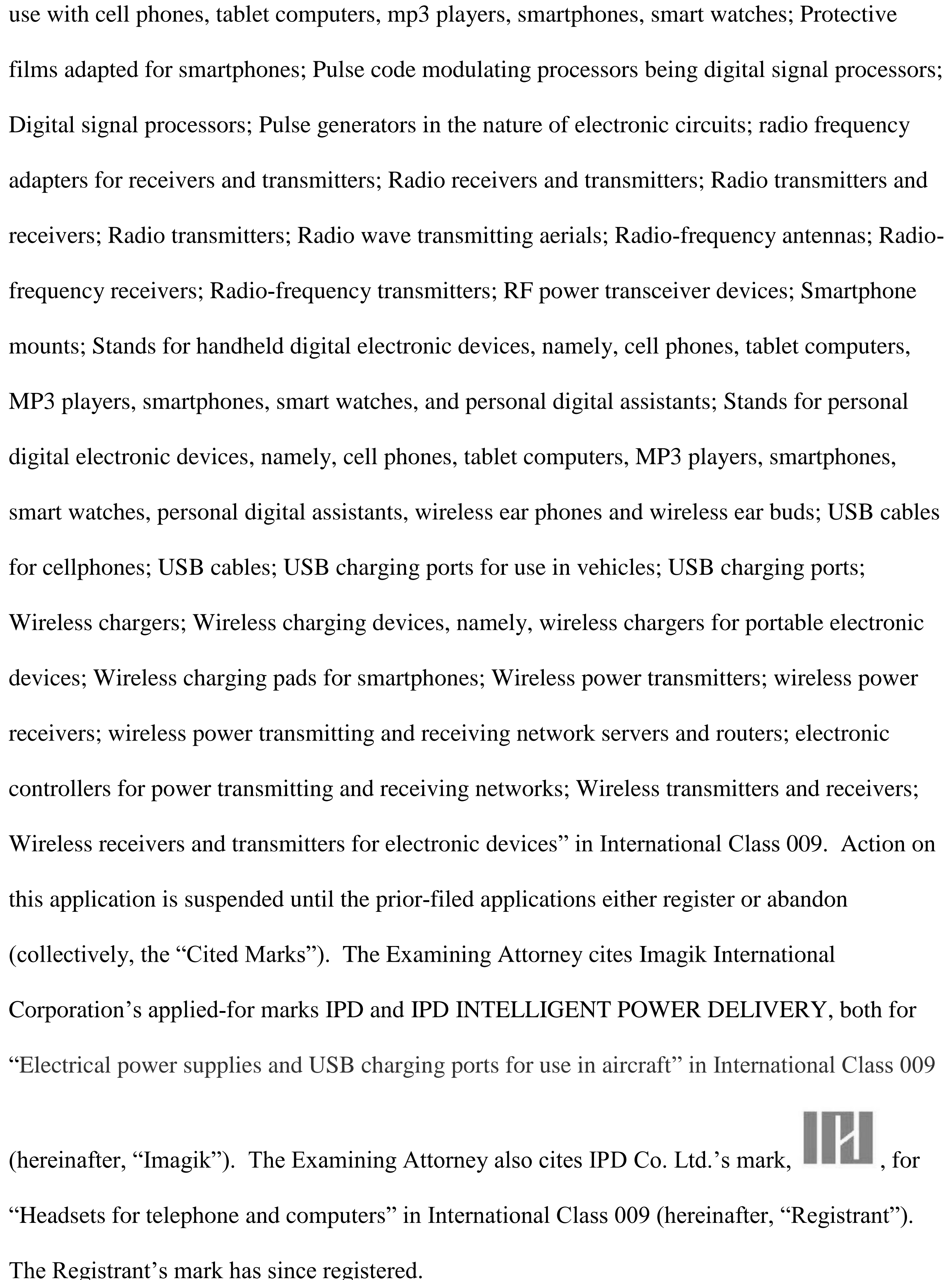
In re Application of:	)	International Class: 009
Spigen Korea Co., Ltd.	)	
	)	Trademark Attorney:
Serial No. 88/449,654	)	Deborah Meiners, Esq.
	)	
Filed: May 28, 2019	)	Law Office: 110
	)	
For: IPD	)	
	)	

RESPONSE TO SUSPENSION NOTICE

Serial No. 88449654

Applicant Spigen Korea Co., Ltd. (hereinafter "Applicant" or "Spigen") submits this response to the Suspension Notice dated March 1, 2020 (hereinafter "Suspension Notice"). The Examining Attorney has suspended the application for the mark, IPD (hereinafter, "Applicant's Mark"), for "Adjustable smartphone and PC tablet stabilizers and mounts; Antennas; Batteries and battery chargers; Battery cables; Battery cases; Battery charge devices; Battery chargers for mobile phones; Battery chargers for tablet computers; Battery chargers; battery charging cables; battery charging devices; Battery packs for charging portable electronic devices; Battery packs; Auxiliary battery packs; Carrying cases for cell phones; Cases for mobile phones; cases for smartphones; Cell phone battery chargers for use in vehicles; Cell phone battery chargers; Cell phone cases; Cell phone covers; cell phone cradles for battery charging; Chargers for batteries; Chargers for electric batteries; Battery charger for smart phones; Charging appliances for rechargeable equipment; Battery charging cradle for personal digital electronic devices, namely, cell phones, tablet computers, MP3 players, smartphones, smart watches, personal digital assistants, wireless ear phones, wireless ear buds and wireless ear pieces; Battery charging mount

for personal digital electronic devices, namely, cell phones, tablet computers, MP3 players, smartphones, smart watches, personal digital assistants, wireless ear phones and wireless ear buds; Battery charging stand for personal digital electronic devices, namely, cell phones, tablet computers, MP3 players, smartphones, smart watches, personal digital assistants, wireless ear phones and wireless ear buds; Battery charging stand for smart phones; Clear protective covers specially adapted for personal electronic devices, namely, cell phones, personal digital assistants, tablet personal computers, smartwatches; Computer hardware and downloadable software for controlling wireless power transmitting and receiving networks; downloadable computer programs for the control of electrical power supplies; downloadable computer software for controlling and managing access server applications; downloadable computer software for sending and receiving wireless power; Data cables; Electric batteries; Electric charging cables; Electric control devices for electrical charging; Electric control devices for energy management, electrical energy supplier; Electric control devices for heating and energy management; Electrical controlling devices; Electric storage batteries; Electrical cells and batteries; Electronic docking stations; Fitted plastic films known as skins for covering and protecting electronic apparatus, namely, cell phones, tablet computers, mp3 players, smartphones, smart watches; Fitted plastic films known as skins for covering and providing a scratch proof barrier or protection for electronic devices, namely, MP3 players, mobile telephones, smart telephones, digital cameras, global positioning systems and personal digital assistants; In-car telephone handset cradles; Micro USB cables; Mobile telephone batteries; PC tablet mounts; portable battery rechargers; Protective cases for audio equipment in the nature of radio; Protective cases for smartphones; Protective covers and cases for cell phones, laptops and portable media players; Protective covers and cases for tablet computers; Protective display screen covers adapted for

use with cell phones, tablet computers, mp3 players, smartphones, smart watches; Protective films adapted for smartphones; Pulse code modulating processors being digital signal processors; Digital signal processors; Pulse generators in the nature of electronic circuits; radio frequency adapters for receivers and transmitters; Radio receivers and transmitters; Radio transmitters and receivers; Radio transmitters; Radio wave transmitting aerials; Radio-frequency antennas; Radio-frequency receivers; Radio-frequency transmitters; RF power transceiver devices; Smartphone mounts; Stands for handheld digital electronic devices, namely, cell phones, tablet computers, MP3 players, smartphones, smart watches, and personal digital assistants; Stands for personal digital electronic devices, namely, cell phones, tablet computers, MP3 players, smartphones, smart watches, personal digital assistants, wireless ear phones and wireless ear buds; USB cables for cellphones; USB cables; USB charging ports for use in vehicles; USB charging ports; Wireless chargers; Wireless charging devices, namely, wireless chargers for portable electronic devices; Wireless charging pads for smartphones; Wireless power transmitters; wireless power receivers; wireless power transmitting and receiving network servers and routers; electronic controllers for power transmitting and receiving networks; Wireless transmitters and receivers; Wireless receivers and transmitters for electronic devices" in International Class 009. Action on this application is suspended until the prior-filed applications either register or abandon (collectively, the "Cited Marks"). The Examining Attorney cites Imagik International Corporation's applied-for marks IPD and IPD INTELLIGENT POWER DELIVERY, both for "Electrical power supplies and USB charging ports for use in aircraft" in International Class 009 (hereinafter, "Imagik"). The Examining Attorney also cites IPD Co. Ltd.'s mark, , for "Headsets for telephone and computers" in International Class 009 (hereinafter, "Registrant"). The Registrant's mark has since registered.

Applicant respectfully requests removal of this application from suspension for the reasons set forth below.

I. The Application Should Proceed Because No Likelihood of Confusion Exists

The Examining Attorney erroneously concluded that a likelihood of confusion exists with the pending and registered marks. Applicant maintains that no likelihood of confusion as to the source of the goods exists between the Applicant's Mark and the Cited Marks after analysis of the relevant *du Pont* factors. *See In re E.I. du Pont de Nemours & Co*., 476 F.2d 1357, 1361-62 (C.C.P.A. 1973). Not all *du Pont* factors are applicable to every case, and not all factors require the same level of consideration. *Id*. at 1361; s*ee also Citigroup Inc. v. Capital City Bank Group., Inc.*, 637 F.3d 1344, 1355 (Fed. Cir. 2011) ("Not all of the DuPont factors are necessarily relevant or of equal weight in a given case, and any one of the factors may control a particular case." (internal quotations omitted)). That is, there is no mechanical test for determining whether a likelihood of confusion exists, and each case must be decided on its own facts. *See* TMEP § 1207.01; *du Pont*, 476 F.2d at 1361. Applicant respectfully requests the suspension be lifted. As elucidated below, consumer confusion is unlikely because the goods are unrelated, travel in different channels of trade, and are sold to sophisticated consumers.

A. The Respective Goods are Unrelated

There can be no rule that certain goods or services are *per se* related, such that there must be a likelihood of confusion from the use of similar marks in relation thereto. *See, e.g*., *In re White Rock Distilleries Inc.*, 92 USPQ2d 1282, 1285 (TTAB 2009) (regarding alcoholic beverages); *Info. Res. Inc. v. X*Press Info. Servs.*, 6 USPQ2d 1034, 1038 (TTAB 1988) (regarding computer hardware and software). The relatedness analysis is intensely factual. "Goods may fall under the same general product category but operate in distinct niches....Where two products are part of distinct sectors of a broad product category, they can be sufficiently

unrelated that consumers are not likely to assume the products originate from the same mark." *Checkpoint Sys. Inc. v. Check Point Software Techs. Inc.*, 269 F.2d 270, 1619-20 (3d Cir. 2001); *see*, *e.g.*, *In re Farm Fresh Catfish Co.*, 231 USPQ 495 (TTAB 1986) (CATFISH BOBBERS for fish is not likely to be confused with BOBBER for restaurant services); *Shawnee Milling*, 225 USPQ 747 (TTAB 1985) (GOLDEN CRUST for flour was not likely to be confused with ADOLPH'S GOLD'N CRUST for coating and seasoning for food items). Moreover, "[t]rademark law does not include a rule that all products sold 'under the same roof' with similar marks will engender confusion as to source, connection, or sponsorship." *Worthington Foods, Inc. v. Kellogg Co.*, 732 F.Supp. 1417, 1477 (S.D. Ohio 1990); s*ee, e.g., Hi-Country Foods Corp. v. Hi Country Beef Jerky*, 4 USPQ2d 1169 (TTAB 1987) (finding that fruit juices and meat snacks were not confusingly similar merely because they were both sold in grocery or convenience stores). The Court has made it clear that the issue is not whether the respective marks, or the goods offered under the marks, are likely to be confused, but rather, whether there is a likelihood of confusions as to the source of the goods because of the marks used. *See In re Majestic Distilling Co.*, 315 F.3d 1311, 1316 (Fed. Circ. 2003); TMEP §1207.01

Here, the respective goods underlying the Applicant's Mark and the Cited Marks are sufficiently distinguishable to ensure there would be no likelihood of confusion as to the source from which the goods stem. The Applicant's Mark covers in relevant part goods for portable or mobile devices. The Registrant provides "headsets for telephone and computers" and Imagik's applied-for marks cover "electrical power supplies and USB charging ports ***for use in aircraft***" which are altogether different categories of goods from the Applicant's goods for portable or mobile devices. Although the Applicant's Mark and the Cited Marks fall under a broad product category, they are part of a distinct sector within the electronics industry which are sufficiently

unrelated so that consumers are not likely to assume the products originate from the same mark. The Registrant's niche product offering of electronic goods are limited to headsets for *non-portable* telephones and computers in a *professional* capacity and Imagik's goods are particular to aircrafts. In contrast, the Applicant's goods are sold to different purchasers in different markets to enhance the use of *personal portable or mobile* devices. Even if Applicant's goods were sold within similar markets, there would no likelihood of confusion as to the source of goods. *See Elec. Design & Sales, Inc. v. Elec. Data Sys. Corp.*, 954 F.2d 713, 717-18 (Fed. Cir. 1992) (No likelihood of confusion for E.D.S. for computer services and EDS for power supplies and battery charges where the respective goods and services were sold to different purchasers within similar markets). Thus, the goods related to Applicant's Mark and the Cited Marks fall under the same broad product category of electronics but operate in distinct niches, where they are sufficiently unrelated that consumers are not likely to assume the products originate from the same mark.

B. <u>The Goods Travel in Different Channels of Trade and the Consumers Are Sophisticated Which Precludes a Likelihood of Confusion</u>

Even if, *arguendo*, the Applicant's goods are deemed similar or related to the goods offered under the Cited Marks, a determination that there is no likelihood of confusion is appropriate because this factor is outweighed by other factors, such as the differences in relevant trade channels or the sophistication of the consumer discussed below. *See* TMEP § 1207.01; *see also In re Shell Oil Co*., 992 F.2d 1204, 1207 (Fed. Cir. 1993) ("The degree of 'relatedness' must be viewed in the context of all the factors, in determining whether the services are sufficiently related that a reasonable consumer would be confused as to source or sponsorship.").

If two different goods are not marketed or traded in such a way that they would be

encountered by the same persons in situations that would create the incorrect assumption that they originate from the same source, then the products are not likely to be confused by consumers even if the marks are identical. *See* e.g., *Local Trademarks, Inc. v. Handy Boys Inc*., 16 USPQ2d 1156 (TTAB 1990) (finding LITTLE PLUMBER liquid drain opener and LITTLE PLUMBER & Design advertising services in the plumbing field to be such different goods and services that confusion as to their source unlikely even though they are offered under the same marks). Consequently, the scope and nature of the Applicant's goods are limited to ancillary products for portable personal electronic devices. With respect to Imagik's applied-for marks, its own description of goods is limiting in nature and type. The fact that Imagik will only provide its goods for use on aircrafts necessarily restricts its trade channels, marketing strategies, and class of purchasers. This narrow scope of use further indicates that the goods will move in different channels of trade and that no likelihood of confusion will result from coexistence with the Applicant's Mark because their goods are not likely to be encountered together in the marketplace. With respect to the Registrant's headsets, the nature and purpose of its goods are for professional use in offices and contact centers. *See* Exhibit A. Consumers for professional headsets in offices and contact centers are distinct from consumers for ancillary products for portable personal electronic devices. The distinctions of the goods include their nature and purpose of personal versus professional products, how they are promoted, and who they are purchased by. *See Quartz Radiation Corp. v. Comm/Scope Co.*, 1 USPQ2d 1668, 1669 (TTAB 1986) (QR for coaxial cable and QR for various apparatus used in connection with photocopying, drafting, and blueprint machines not likely to cause confusion because of the differences between the parties' respective goods in terms of their nature and purpose, how they are promoted, and who they are purchased by). Marketing strategies for professional products

tend to be technical in nature, while marketing for personal products tend to be more user friendly. Further, professional products tend to be more expensive than products for personal use. Professional products are generally located in specialty stores, while personal products are not. Consequently, "significant differences in the price of the products, or the type of stores (i.e., discount or specialty) at which the respective products are sold may decrease the likelihood of confusion. *See Stark v. Diageo Chateau & Estate Wines Co*., 907 F. Supp. 2d 1042, 1057 (N.D. Cal. 2012); *L.A. Gear, Inc. v. Thom McAn Shoe Co.*, 988 F.2d 1117, 1134 (Fed. Cir. 1993). Even if the Applicant's and Registrant's goods were used together, that would not, in itself, justify a finding of relatedness. *See Shen Mfg.Co. v. Ritz Hotel Ltd*., 393 F.3d 1238, 1244 (Fed. Cir. 2004). Given the significant differences between the Applicant's goods and the goods covered under the Cited Marks in terms of their nature and purpose, marketing strategies, and distinct consumer classes, consumer confusion is unlikely. Therefore, this factor favors a finding that there would be no likelihood of confusion.

It is well settled that the likelihood of confusion is reduced where the prospective buyers of the relevant goods or services are sophisticated and do not make purchasing decisions lightly. *See Hewlett-Packard Co. v. Human Performance Measurement Inc.*, 23 USPQ2d 1390 (TTAB 1991). A consumer exercising a high degree of care in selecting a good or service reduces the likelihood of confusing similar marks. *See Heartsprings, Inc. v. Heartspring, Inc.*, 143 F.3d 550, 557 (1998). If likelihood of confusion exists, it must be based on the confusion of some relevant purchaser, and there is always less likelihood of confusion where goods are expensive or purchased after careful consideration. *See e.g.*, *Pignons S.A. de Mecanique de Precision v. Polaroid Corp.*, 657 F.2d 482, 487 (1st Cir. 1981); *Astra Pharm. Prods. v. Beckman Instruments, Inc.*, 718 F.2d 1201, 1206 (1st Cir. 1983). Even where goods are not expensive, the "reasonably

prudent ordinary-buyer standard" can be elevated to a "higher, more discriminating level based on assumptions about the nature of certain buyers." J. Thomas McCarthy, 4 McCarthy on Trademarks and Unfair Competition § 23:99 (5th ed.).

Prospective buyers of the Applicant's and the Cited Mark's goods are sophisticated and discriminating customers. Purchasing products for portable or mobile devices, professional headsets, and electronics and electrical power supplies for aircrafts is inherently expensive. This increases the likelihood that such purchases would be made with care and mitigates any alleged confusion. *See e.g.*, *Astra Pharm. Prod., Inc. v. Beckman Instruments, Inc.*, 718 F.2d 1201, 1206 (1st. Cir. 1983) (finding expensive machines are not purchased on impulse and "involves careful consideration of the reliability and dependability of the manufacturer and seller of the product" which leads to a conclusion that confusion by consumers is unlikely). The highly regulated nature of the aviation industry due to safety concerns, compels purchasers of electrical power supplies for aircrafts to exercise great care. Professional products such as professional headsets for offices and call centers require discrimination and special knowledge from the purchasing departments of companies. Further, they are usually more expensive than accessories for portable or mobile devices. There are many competing products to Applicant's goods. Customers must be discriminating and sophisticated in deciding which product to purchase. The decision cannot be made solely on price or on a whim, but after making certain that the goods for portable or mobile devices are the right size, type, specification, and functionality to meet their tastes. Thus, it is reasonable to conclude that the different consumers of the Applicant's goods, professional headsets, and electrical power supplies for aircrafts are likely to exercise a high degree of care in their purchasing decisions and that purchase of these goods would likely be the result of forethought and analysis. Applicant submits that there is no likelihood of confusion and

that the Applicant's Mark and the Cited Marks are capable of distinguishing the source of their respective goods. Thus, there is no likelihood of confusion between the Applicant's Mark and the Cited Marks.

II. Conclusion

Based on the foregoing, Applicant respectfully requests that the Examining Attorney remove the suspension and allow this application to proceed to publication.

Dated: April 15, 2020

Respectfully submitted,

/s/ Karen Y. Kim

Karen Y. Kim
Lucem, PC
660 S. Figueroa St., Suite 1200
Los Angeles, California 90017
Tel: 213-387-3630