



Birch
Stewart
Kolasch
Birch LLP

Robert J. Kenney
(703) 205-8000

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

September 28, 2016

Darryl M. Spruill
Trademark Attorney
Law Office 112
(571) 272-9418 (office)
(571) 273-9418 (fax)
darryl.spruill@uspto.gov

Re: Mark: LIME
Appl. No.: 86/826,158
Applicant: LG Electronics Inc.
Office Action dated March 28, 2016
Our Ref.: 3449-2550US1

APPLICANT'S RESPONSE TO OFFICE ACTION

The following is the response of Applicant, LG Electronics Inc., by counsel, to the Office Action dated March 28, 2016. Applicant thanks the Examining Attorney for the thorough consideration given the present application.

Section 2(d) Refusal -Likelihood of Confusion

The Examining Attorney refused registration pursuant to Section 2(d), 15 U.S.C. § 1052(d), on the ground that the mark is likely to be confused with the marks in Registration Nos. 4833960, 4833962, 3863048, 3863049, 4229419, 4501224, and 4501230. For the following reasons, Applicant respectfully disagrees with this refusal and requests that the Examining Attorney reconsiders and allows registration of Applicant's mark.

The Examining Attorney relies on the similarity of the marks, similarity and nature of the goods and/or services, and similarity of the trade channels of the goods and/or services in the refusal based on Section 2(d). While Applicant respectfully disagrees with the Examining Attorney's conclusion regarding likelihood of confusion, in order to advance prosecution, Applicant has amended its identification of goods so that any goods which the Examining Attorney may consider to be similar to the cited registrations' goods are deleted. The Applicant's amended identification of goods no longer includes goods or services that are completely encompassed by or overlap with the goods of the cited registrations. For example, the following goods, *inter alia*, have been deleted, "Computer application software for smart phones, mobile phones, smart TV and handheld electric communication device, which is used for implementing internet of things," "Remote multi switches; Smart phones; Display for smart phones; Mobile phones; Wearable smart phones," "Computer application software; Downloadable computer software applications; Computer application software for mobile phones; Software for mobile phones; Software for TV," and "Telemetric apparatus and instruments; Remote control telemetering machines and apparatus; Mobile phones; Telecommunication machines and implements." Due to the differences between Applicant and Registrants' products, it is unlikely that a prospective purchaser of either company's product would believe there is any relationship between the companies or their respective goods.

Where the goods of the Applicant and Registrant are different, the Examining Attorney bears the burden of showing that Applicant's and Registrants' different goods would commonly be provided by the same source. *E.g., In re Shipp*, 4 USPQ2d 1174, 1176 (TTAB 1987) (Examining Attorney's argument that small segment of market would be familiar with both

Applicant's use of PURITAN in connection with dry cleaning services and Registrants' uses of PURITAN in connection with dry cleaning equipment and dry cleaning chemicals rejected due to lack of proof of trade practices and failure to show likelihood, rather than possibility, of confusion; refusal reversed). There is no evidence of record that the companies' respective goods are related for purposes of the likelihood of confusion analysis.

There is no per se rule that goods or services sold in the same field or industry are similar or related for purposes of likelihood of confusion. *See Cooper Industries, Inc. v. Repcoparts USA, Inc.*, 218 USPQ 81, 84 (TTAB 1983); *Lloyd's Food Products, Inc. v. Eli's, Inc.*, 987 F.2d 766, 25 USPQ2d 2027 (Fed. Cir. 1993) (reversing likelihood of confusion cancellation of LLOYD'S for barbecued meats based on LLOYD's for restaurant services). Goods or services "may fall under the same general product category but operate in distinct niches. When two products are part of distinct sectors of a broad product category, they can be sufficiently unrelated that customers are not likely to assume the products originate from the same mark." *Checkpoint Systems, Inc. v. Check Point Software Technologies, Inc.*, 269 F.3d 270, 288 (3rd Cir. Oct. 19, 2001). There is no evidence that Applicant's goods travel in the same trade channels as the goods in the cited registrations.

Applicant's LIME mark is not identical to all of the cited registrations and differs in appearance, meaning, and sound from Registration Nos. 4833962, 3863048, 3863049, 4229419, 4501224, and 4501230. It is well established that "likelihood of confusion cannot be predicated on dissection of a mark . . . the ultimate conclusion rests on consideration of the marks in their entireties." *In re National Data Corp.*, 224 U.S.P.Q. 749, 751 (Fed. Cir. 1985); TMEP §1207.01(b)(iv). When Applicant's mark and Registration Nos. 4833962, 3863048, 3863049,

4229419, 4501224, and 4501230's marks are compared in their entireties, they are significantly different in visual and aural impression, in meaning, and in overall commercial impression. For example, the cited Registrations include marks that include words in addition to the wording "lime," and the additional wording communicates the types of goods and services associated with the marks. For example, Registration Nos. 4501224 and 4501230 for the mark "LIME INSTRUMENTS" covers goods that include, "Computer hardware and software systems for the remote monitoring, servicing and operation of oil and gas equipment; Electrical integrated control systems for use in the field of oil and gas extraction," which could be considered oil and gas instruments. Registration Nos. 3863048 and 3863049 for the mark "LIME CELLULAR" cover goods that include, "Telecommunication services, namely, wireless telephone services," which brings to mind the "CELLULAR" part of the mark. Applicant's wording, "LIME," does not bring to mind the same meaning or overall commercial impression as Registration Nos. 4833962, 3863048, 3863049, 4229419, 4501224, and 4501230. Any perceived similarity between Applicant's mark and the marks in the non-identical cited registrations does not rise to the level of similarity required to support a finding of likelihood of confusion given Applicant's amendment to the identification of goods and the resulting diverse goods and services. *Cf. In re J.M. Originals Inc.*, 6 USPQ2d 1393, 1394 (TTAB 1987) (where the goods and/or services of an applicant and registrant are "similar in kind and/or closely related," the degree of similarity between the marks required to support a finding of likelihood of confusion is not as great as in the case of diverse goods and/or services); *see Shen Mfg. Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 1242, 73 USPQ2d 1350, 1354 (Fed. Cir. 2004); TMEP §1207.01(b).

Given Applicant's amendments to the identification of goods and the lack of similar wording for all but one of the cited Registrations' marks, there is no likelihood that consumers will be confused as to the source of the respective goods offered in connection with Applicant's mark and the marks in the cited registrations. Accordingly, Applicant respectfully requests that the statutory refusal be withdrawn and that the application be permitted to proceed to publication.

Prior Pending Application

The Examining Attorney has cited U.S. Application Serial No. 85/592,453 as having a filing date that precedes Applicant's filing date. As described in the prior section, Applicant's amended goods are narrowed in this response. Due to this amendment, there is no possibility of a likelihood of confusion with the cited prior pending application. Applicant's amended goods and the goods in the prior pending application are not identical or related. In addition, the cited prior pending application's mark is not identical to or similar to the appearance, meaning, and sound of Applicant's mark. For example, Applicant's mark is one word "LIME" while the prior pending applicant's mark is two words, "LIME LAB." Therefore, given Applicant's amendment to its identification of goods and the lack of similarity of the marks, the sources of Applicant's goods and the cited prior pending application's goods are not likely to be confused by consumers.

Section 2(e)(1) Refusal - Merely Descriptive:

Applicant's LIME mark is refused registration under section 2(e)(1) as being merely descriptive of a feature or characteristic of Applicant's goods. Applicant respectfully disagrees, but to advance prosecution of the application, Applicant seeks herein to amend the application to

seek registration of the mark on the Supplemental Register. In view of the foregoing, Applicant respectfully requests that the refusal under Section 2(e)(1) be withdrawn.

Additional Information:

In response to the information request, Applicant states that it has none of the requested materials showing use of the mark, but that the goods with which the mark is intended for use, e.g., digital cameras, television receivers, etc., are consumer electronics available directly to the public through retail stores.

Amendment to Registration Basis:

Applicant respectfully requests that the basis be amended to Section 44(e) based on South Korean Registration No. 1190517, a copy of which and a translation of which are submitted herewith. The Applicant has had a bona fide and effective industrial or commercial establishment in South Korea as of the date of issuance of the foreign registration. Applicant believes that all requirements to establish the Section 44(e) basis have been satisfied and the Applicant respectfully requests that the Section 1(b) basis be deleted if the Section 44(e) basis is accepted by the Examining Attorney.

* * *

There being no other issues raised in the Office Action, Applicant believes that the present application is in condition for allowance. If the Examiner has any questions concerning this application, the Examiner is requested to contact Robert J. Kenney at (703) 205-8000 in the Washington, D.C. area.