

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
TRADEMARK EXAMINING OPERATION**

In re Application of:  
The Standard Bank of South Africa Limited

Serial No.: 87/554,490

Mark:  **Standard**

Actions Dated: October 25 & 26, 2017

Law Office No. 111

Examining Attorney:  
Ingra Marie Ervin

**RESPONSE TO OFFICE ACTION**

The Standard Bank of South Africa Limited (the “Applicant”) submits the following response to the United States Patent and Trademark Office actions dated October 25 and 26, 2017 (the “Office Action”) refusing United States Trademark Application Serial Number 87/554,490 (the “Application”) to register STANDARD & Design, which appears as follows:



(the “Mark”). The Application identifies the following goods and services to be used with the Mark:

**Class 9:** Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signaling, checking (supervision), life-saving and teaching apparatus and instruments; electric and electronic apparatus and hardware, equipment for the storage and transmission of data and information for use in relation to banking, financial, insurance and general commercial transactions, including those conducted online via the Internet or a computer network, or by telephone or cellular telephone; software, systems, devices and platforms used to enable and facilitate electronic banking, financial, insurance or other commercial transactions, including those via the Internet or a computer network, or by telephone or cellular telephone; including data processing equipment and software for use in relation to banking and financial services including data processing equipment and software; downloadable electronic publications; apparatus and equipment for the electronic transfer of and/or

financial data; telecommunication equipment; automated teller machines; money dispensing machines, electronic fund transfer, payment or point of sale apparatus, machines and terminals; card and bar code scanners; magnetic and magnetically encoded cards; programmable cards; smart cards; cards bearing coded data in magnetic form; cards bearing data for use in computers; cards bearing coded data in punched-out form; cards bearing data for use in data processing apparatus; cards bearing data for use in data storage apparatus; cards bearing electronically recorded data; cards bearing integrated circuits; cards bearing magnetic or encoded data for input; cards bearing micro-chips and computer cards containing chips; credit, charge, debit and/or cash cards; prepayment cards; loyalty or gift cards, readers, scanners, parts and fittings for the aforementioned goods

**Class 38:** Telecommunications and communications services; providing user access to computer networks or the Internet for purposes of facilitating commercial, banking or financial transactions and electronic payments; providing telecommunications connections to the Internet or data bases for purposes of facilitating commercial, banking or financial transactions and electronic payments services ancillary and related to all of the foregoing

(collectively, the “Products”). In response to the Office Action, the Applicant respectfully requests that the Examining Attorney permit the Application to proceed to publication, because the Application, as amended herein, contains a definite identification of services, is not likely to cause confusion with the registrations cited in the Office Actions, does not require an additional Class or corresponding fee and is duly signed and verified.

**I. THE APPLICANT HEREBY AMENDS THE IDENTIFICATION OF GOODS AND SERVICES IN THE APPLICATION**

The identification of goods, as modified herein, is sufficiently definite for the Application to proceed to publication. The Office Actions request that the Applicant modify the description of the Products, contending that the wording is too broad. Accordingly, Applicant respectfully requests that the identification of goods and services in the Application be amended to the following:

**Class 9:** Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signaling, checking (supervision), life-saving and teaching apparatus and instruments; electric and electronic apparatus and hardware, equipment for the storage and transmission of data and information

for use in relation to banking, financial, insurance and general commercial transactions, including those conducted online via the Internet or a computer network, or by telephone or cellular telephone; computer software, computer operating systems, computer peripheral devices and computer software platforms used to enable and facilitate electronic banking, financial, insurance or other commercial transactions, including those via the Internet or a computer network, or by telephone or cellular telephone, including data processing equipment and software for use in relation to banking and financial services including data processing equipment and software; downloadable electronic publications, in the nature of newsletters, magazines, reports, guides, charts, worksheets, forms, instructional materials, educational materials, bulletins, pamphlets, and booklets in the field of banking, financing, financial services, insurance, securities and investment; apparatus and equipment for the electronic transfer of and/or financial data, namely, computer terminals, computer peripheral devices, computer software, computer programs and mobile applications; electronic equipment, namely, transformers, baluns and cables, all used in connection with computers, computer peripheral devices, televisions, audio-video equipment, closed-circuit TV equipment and telecommunication equipment excluding radio transmitters, radio receivers or paging systems; automated teller machines; money counting and sorting machines, point-of-sale terminals for making contactless payments; card and bar code scanners; magnetic and magnetically encoded key, debit and charge cards; magnetically and non-magnetically encoded and programmable cards for use as identity cards, security clearance cards, time-tracking and recording cards, access control cards, debit cards, credit cards, charge cards, stored value cards, gift cards and loyalty cards; blank smart cards; computer equipment, namely, wireless cards; interface cards for data processing equipment in the form of printed circuits; cards bearing data for use in data processing apparatus; cards bearing data for use in data storage apparatus; cards bearing electronically recorded data; cards bearing integrated circuits; cards bearing magnetic or encoded data for input; cards bearing micro-chips and computer cards containing chips; magnetically-encoded credit, charge, debit and/or cash cards; electronic and magnetic ID cards for use in connection with payment for services; electronic loyalty or gift cards, readers, scanners, parts and fittings for the aforementioned goods



**Class 38:** Telecommunication services for providing multiple-user access to a global computer network; telecommunications services, namely, personal communications services; providing user access to computer networks via the Internet for purposes of facilitating commercial, banking or financial transactions and electronic payments; providing telecommunications connections via the Internet to data bases for purposes of facilitating commercial, banking or financial transactions and electronic payments services ancillary and related to all of the foregoing

(the “Amended Products”). The Amended Products omit an identification of “Electronic funds transfer” services and, therefore, the Applicant does not need to add Class 36 or pay the fee

required to add an International Class. Attached hereto as **Exhibit A** is a redline showing the Examining Attorney's requested changes in orange and the Applicant's further revisions in red. Because the Amended Products address all of the requirements in the Office Action, the Applicant respectfully requests that the Application proceed to publication.

## **II. THE MARK AS USED WITH THE AMENDED PRODUCTS IS NOT LIKELY TO CAUSE CONSUMER CONFUSION WITH PRIOR TRADEMARK REGISTRATIONS**

The Mark, as used with the Amended Products herein, need not be refused due to the prior trademarks referenced in the Office Actions. Pursuant to Section 2(d) of the Trademark Act, the United States Patent and Trademark Office may refuse an application if it is likely to cause consumer confusion with previously registered trademarks. 15 U.S.C. § 1052(d). The Office Actions referenced the following United States trademark registrations:

- (1) **STANDARD** (Reg. No. 0,660,451) in Class 9 for "portable radio receivers;"
- (2)  (Reg. No. 0,692,750) in Class 9 for "electrically operated hospital audible visible communication, signaling and paging systems;"
- (3) **STANDARD** (Reg. No. 1,628,035) in Class 9 for "radio transmitters and receivers and accessories therefor, namely, mounting brackets, headphones, belt clips and microphones;" and
- (4)  (Reg. No. 3,830,438) in, *inter alia*, Class 38 for "providing Internet access; computer services, namely, providing on-line facilities for real-time interaction with other computer users concerning topics of general interest."

(collectively, the "Referenced Marks"). As used with the Amended Products, the Mark is not likely to cause consumer confusion with respect to any of the Referenced Marks and, therefore, the Application should proceed to publication.

Consumer confusion between the Mark and the Referenced Marks is unlikely because they are sufficiently dissimilar from each other in appearance and because the goods and services are

dissimilar and sold in different channels. Analysis of likely confusion requires application of the context-specific, multi-factor test first set forth by the Court of Customs and Patent Appeals in *In re E. I. du Pont de Nemours & Company*, 476 F.2d 1357, 177 U.S.P.Q. 563 (C.C.P.A. 1973). The *du Pont* factors include, without limitation:

- The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression;
- The similarity or dissimilarity and nature of the goods ... described in the application or registration;
- The similarity or dissimilarity of established, likely-to-continue trade channels; and
- The conditions under which and buyers to whom sales are made.

*See id.*, 476 F.2d at 1361, 177 U.S.P.Q. at 567. When comparing the Mark with each of the Referenced Marks, these factors weigh decisively against a finding of likely confusion.

**A. Because the Mark and the Referenced Marks are Used with Unrelated Goods and Services, Consumer Confusion is Unlikely**

The Mark is not likely to cause consumer confusion with the Referenced Marks numbered “(1),” “(2)” and “(3)” because the Amended Products do not overlap with the goods identified in those registrations. The Office Actions contend that the identification of “telecommunications equipment” in Class 9 in the original Products was so broad as to overlap with these three Referenced Marks. Specifically, Referenced Marks “(1)” and “(3)” identify varieties of radio transmitters and radio receivers, which the Office Actions contend are types of “telecommunications equipment.” Similarly, Referenced Mark “(2)” identifies “paging systems,” which the Office Actions also contends falls within the category of “telecommunications equipment.” The Applicant’s Amended Products, however, narrow the identification of “telecommunications equipment” to exclude these allegedly overlapping goods and now reads, in the relevant part, “telecommunications equipment excluding radio transmitters, radio receivers and

paging systems.” Because the Application, as amended, and Referenced Marks “(1),” “(2)” and “(3)” do not identify overlapping goods, these registrations should not prevent the Application from proceeding to publication.

Similarly, the Mark is not likely to cause consumer confusion with the Referenced Mark numbered “(4)” because the Amended Products do not overlap with the services in Class 38 identified in that registration. The Applicant, a financial institution, uses the Mark to provide online financial services to its customers, whereas the owner of Referenced Mark numbered “(4),” which operates a hotel chain, uses its mark in connection with providing Internet connectivity to its guests. The Office Actions contend that the service of “providing access to the Internet” identified by the Referenced Mark includes the service of “providing access to computer networks” identified among the original Products. As an initial matter, the Office Actions mistakenly state that the Referenced Mark identifies “providing access to computer networks,” which is instead a service identified in the original description of the Products. In any event, the Amended Products, specify that the service offered by the Applicant with the Mark is “providing access to computer networks *via the Internet*” (emphasis added), which is not included within and is different from “providing access to the Internet.” To offer access *to* the Internet *by* the internet is, abstractly speaking, paradoxical and impossible. Furthermore, internet service providers offer their services, such as dial-up, broadband, wireless and mobile data services, in a distinct manner and through different streams of commerce than the online services identified in the Amended Products. *See* Internet Access – Wikipedia (last visited February 7, 2018), [https://en.wikipedia.org/wiki/Internet\\_access](https://en.wikipedia.org/wiki/Internet_access), attached as **Exhibit B**. The registrant of the Referenced Mark numbered “(4)” specifically offers its services as wireless internet access of various speeds to guests and visitors to its hotel properties. *See* the excerpt from the specimen submitted in support of the Section 8 Declaration of Use for

THE STANDARD (Stylized) (Reg. No. 3,830,438) dated February 10, 2017, attached as **Exhibit C**. Because the services identified in the Amended Products and those identified in the registration for Referenced Mark numbered “(4)” cannot overlap and are distinct, there is no likelihood of confusion between the Mark and that Referenced Mark.

**B. Because the Mark and the Referenced Marks are Dissimilar in Sight, Sound, Meaning and Commercial Impression, Consumer Confusion is Unlikely**

The appearance of the Mark is sufficient to distinguish the Mark from each of the Referenced Marks in the minds of consumers, making confusion unlikely. The particular commercial impression of the Mark’s use of the noun “STANDARD” in combination with the flag design, (which share a common referent, as discussed in more detail in the paragraph below) coupled with the Amended Products is entirely distinct from the commercial impression of the Referenced Marks, all of which lack an equivalent design element and are used in connection with goods and services in a way that evokes an entirely different, adjectival significance of the word “STANDARD.” Further, the Mark and Referenced Marks must be compared “in their entireties as to appearance, sound, connotation and commercial impression.” *du Pont*, 476 F.2d at 1361. “[I]t is improper to dissect a mark when engaging in this analysis, including when a mark contains both words and a design.” *In re Viterra Inc.*, 671 F.3d 1358, 1362 (Fed. Cir.2012); *see also Jack Wolfskin Ausrustung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 1371 (Fed. Cir. 2015). Finally, as to the Referenced Marks that are registered with claims to design or style elements (i.e. numbers “(2)” and “(4)”), the respective differences between these elements and those of the Mark are sufficient to prevent likely confusion. Because the specific characteristics of the individual sight, sound, meaning and commercial impression of the Mark and Referenced Marks are distinct, there is no likely confusion and the Mark should be permitted to proceed to publication.

The Mark's combination of the "STANDARD" element with the flag design evokes a commercial impression that is highly distinct from that created by the use of the "STANDARD" element by each of the Referenced Marks. When determining whether the similar features of marks give rise to likely confusion, their impression on consumers should be viewed in light of other features of the marks as well as the goods or services on which they are used. *See, e.g., In Re Farm Fresh Catfish Co.*, No. 231 U.S.P.Q. (BNA) ¶ 495 (T.T.A.B. Sept. 26, 1986) (finding that "BOBBER" when used with food in the form of nuggets is suggestive of their shape, whereas "BOBBER" when used with restaurant services is entirely arbitrary and, therefore, the marks are not likely to be confused); *In re Spinal USA*, No. 85/386,695, 2013 WL 5407263, at \*2 (July 2, 2013) (finding that the element "ALLAY" was suggestive of the effect when used with pharmaceutical for menstrual cramps whereas "ALLAY" was arbitrary when used with a spinal brace and, therefore, the marks are not likely to be confused). Here, the word "STANDARD" has many meanings in English. *See* Standard | Definition of Standard by Merriam Webster (last accessed February 7, 2018) <https://www.merriam-webster.com/dictionary/standard>, attached as

**Exhibit D.** "STANDARD" used as a noun may refer to:

- a : a long narrow tapering flag that is personal to an individual or corporation and bears heraldic devices
- b : the personal flag of the head of a state or of a member of a royal family
- c : an organization flag carried by a mounted or motorized military unit
- d : banner

*Id.* When the word is used with a design depicting such a flag or banner, as it is in the Mark, this meaning is the impression immediately conveyed to consumers. As used with Referenced Marks numbered "(1)," "(2)" and "(3)," however, the term carries a meaning and commercial impression more relevant to their goods. All of these marks identify goods that electronically transmit



information by uniform systems or processes, namely radios and other audio and visual communications devices, and the term “STANDARD” under the Referenced Marks will be understood in its adjective sense of “constituting or conforming to a standard especially as established by law or custom” or “regularly and widely used, available, or supplied,” because these features are suggestive of qualities that consumers desire in that kind of audio and visual equipment. *Id.* The Referenced Mark numbered “(4)” is unusual in that, while it also refers to the adjectival sense of the word, it uses the term “STANDARD” in an ironic sense. As a result, this use gives a very distinct commercial impression. The registrant Standard International Management, LLC operates a series of boutique hotels in connection with its THE STANDARD & Design trademark (each referred to as “The Standard Hotel”) that are so notable for their eccentricity that *New York Magazine* described one as the “emphatically nonstandard Standard Hotel.” Davidson, Justin, *The Glass Stampede*, NEW YORK MAGAZINE, Sep. 7, 2008, **Exhibit E** at 12; *See also* Boutique Hotel on Sunset Strip | The Standard, West Hollywood – Official Website (last visited Feb. 7, 2018), <https://www.standardhotels.com/la/properties/hollywood>, attached as **Exhibit F** (describing The Standard Hollywood as “[a] true original since day one” that “abounds with curious, unexpected touches”); Boutique Hotel Near South Beach | The Standard, Miami Beach – Official Website (last visited Feb. 7, 2018), <https://www.standardhotels.com/miami/properties/miami-beach>, attached as **Exhibit G** (describing The Standard Miami Beach as “less a ‘hotel,’ and more a spa with guest rooms.”); Boutique Hotel Near NYU : The Standard, East Village – Official Website (last visited Feb. 7, 2018), <https://www.standardhotels.com/new-york/properties/east-village>, attached as **Exhibit H** (describing The Standard East Village as “cozy, charming and eccentric in equal measure”). The irony of Referenced Mark number “(4)” is underscored by its stylistic elements, which invert the word “STANDARD” entirely, to visually

reinforce the impression that the mark connotes precisely the opposite of its ordinary meaning of the word. In sum, because the Mark and the Referenced Marks, convey entirely different meanings in context, and have highly distinct commercial impressions, confusion is highly unlikely and the Application should be permitted to proceed to publication.

Although the Mark and Referenced Marks share the word “STANDARD,” distinct design and style elements of the marks can sufficiently distinguish the marks to prevent consumer confusion in circumstances such as this one. *See, e.g., Bass Pro Trademarks, L.L.C. v. Sportsmans Warehouse, Inc.*, No. 92/045,000, 89 U.S.P.Q.2d 1844 (T.T.A.B. Apr. 4, 2008) (finding that marks sharing the element “SPORTSMAN’S WAREHOUSE” were not likely to be confused where the marks were also distinguished by design and stylistic elements that were also distinct); *In Re Ecopetrol S.A.*, No. 85/789,442, 2015 WL 2170146, at \*4 (Apr. 23, 2015) (finding marks sharing the element “ENERGY FOR THE FUTURE” not likely to be confused where they are distinguished by design and style elements). One can see from the marks displayed below, the Mark and Referenced Marks numbered “(2)” and “(4)” simply look very different.



First and foremost, the Mark contains a design element, specifically the flag or “standard,” that is shared by neither of the Referenced Marks. Furthermore, the word “STANDARD” contained in the Mark is not enclosed in a box, as is true of both Referenced Marks “(2)” and “(4).” The typography of the Mark, which appears with only its first “S” capitalized and in a neo-grotesque typeface with largely uniform stroke width and arranged neatly on the same line in the same font, is very distinct from that of Referenced Mark Number “(2),” which is in all capital letters and a

dramatically modulated sans serif typeface with very contrasting stroke widths, the characters of which are enlarged at the middle so that the top of each character fills the curved space of the arched box in which the word appears. The background and orientation of the word “STANDARD” in the Mark is also very distinct from that of the Referenced Mark number “(4),” in which the word “STANDARD” is inverted and appears in relief against a dark field, whereas, in the Mark, the word “STANDARD” is upright and is plain on its own. All of these distinctions are likely to leave a lasting impression sufficient to distinguish the marks in the minds of consumers, even when they are not viewed in direct comparison to one another.

### **III. APPLICANT WILL MAKE ALL VERIFICATIONS REQUESTED BY THE OFFICE ACTIONS**

In connection with this submission, the Applicant will provide the signed verification requested in the Office Actions.

### **CONCLUSION**

For each of the reasons detailed above, Applicant submits that it has remedied any indefiniteness in its identification of goods, it has paid all necessary fees and it has provided all necessary verifications for the Application. Furthermore, the Applicant has sufficiently demonstrated that there is no likelihood that consumers will confuse the Mark with any of the Referenced Marks in the Office Actions. For these reasons, the Applicant respectfully requests that the Examining Attorney reconsider the initial refusals set forth in the Office Actions and allow the Application to proceed to publication.

The Applicant has responded to all issues raised in the Office Action. If any further information or response is required, please contact the Applicant’s attorney.

Dated: April 25, 2018

Respectfully submitted,

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