

This is in response to the Office Action of October 8, 2020. In the Office Action, the Trademark Office has refused registration of Applicant's LINKIQ mark on the grounds that the mark, when used on or in connection with the identified goods, so resembles various registered and earlier-filed marks as to be likely to cause confusion, to cause mistake, or to deceive, under Section 2(d) of the Trademark Act. Applicant responds to the refusal below.

RESPONSE

I. APPLICANT'S MARK IS NOT LIKELY TO CAUSE CONFUSION WITH THE CITED REGISTRATION.

Applicant respectfully disagrees with the Trademark Office's contention that its LINKIQ mark, for use in connection with its "electronic test and measurement instruments for use in the fields of networks and telecommunication, namely, cable and network testers for troubleshooting and testing transmission bandwidth of new and existing data and voice communication cables" in Class 9, so resembles the Cited Registration the mark IQ in U.S. Registration No. 4,536,563, for use in connection with "wireless electronic circuit testers, namely, communication link testers for testing wireless communication links" in Class 9, as to be likely to cause confusion, to cause mistake, or to deceive under Section 2(d) of the Trademark Act. Applicant bases this upon, among other factors, the fact that: (1) the goods offered in connection with Applicant's mark are unrelated to those provided by the owner of the Cited Registration; (2) Applicant's LINKIQ mark is dissimilar in overall appearance, sound, meaning, and commercial impression from the Cited Registration; and (3) consumers are accustomed to associating IQ composite marks with Applicant in the telecommunications and network cable-testing marketplace.

A. The Goods Offered in Connection with Applicant’s Mark are Unrelated to Those Provided by the Cited Registrant.

In the Office Action, the Trademark Office has stated that the goods provided by Applicant under the applied-for mark are related to those provided by the Cited Registrant, and confusion between the marks is therefore likely to result. Applicant must respectfully disagree.

As the Examining Attorney will note, the applied-for mark is intended to be used in connection with cable and network testers for troubleshooting and testing transmission bandwidth of new and existing data and voice communication cables in the field of networks and telecommunications. In simplest terms, these goods amount to cable qualifiers used by cabling installers, system integrators, and network technicians to test cable bandwidth and Ethernet switch port capabilities. *See Exhibit A.* These goods are thus comprised of network and telecommunications goods intended for use by cable professionals and technicians for purposes of testing Ethernet connections and the strength thereof. *Id.* Applicant’s goods allow users to find and identify maximum cabling speeds, install and troubleshoot power over Ethernet (i.e. “POE”) devices via switch negotiation and POE load testing, identify connected switch information, like switch name, port number, and VLAN, and document this work for later review. *Id.* This vastly differs from that which is offered by the Cited Registrant under its mark.

The goods offered by the Cited Registrant and the purposes proscribed therefor are wholly unaligned with those goods provided by Applicant under its mark. Whereas Applicant is focused on providing cable and network testers for troubleshooting and testing transmission bandwidth of new and existing data and voice communication cables that address Ethernet connectivity and strength concerns, the owner of the Cited Registration offers goods that operate in entirely different marketplaces and address discrete needs. The Cited Registrant offers “wireless electronic circuit testers, namely, communication link testers for testing wireless

communication links.” Upon review of Registrant’s specimen of use and online resources, these goods amount to equipment for testing wireless devices at high volumes in manufacturing. *See Exhibit B.* In short, Registrant’s goods are used to test wireless equipment, such as smart phones, tablets, and PCs, to ensure that it is in working order. *Id.* For example, one might utilize goods to analyze the wireless capabilities of commonly utilized integrated wireless chipsets. Registrant’s goods can allow its consumers, including large manufacturers of wireless equipment, such as offerors of smart phones, tablets, and PCs, to ensure its products work properly and are in a saleable condition prior to downstream sales of these items.

Registrant’s goods and the purposes and relevant consuming class therefor may be easily contrasted with the goods intended to be offered by Applicant and the purposes and target consumers therefor. Whereas Applicant offers Ethernet cable network testing equipment for the telecommunications and network infrastructure fields to identify and maximize Ethernet connectivity, Registrant offers equipment which tests the working status of wireless computing equipment, like smart phones, tablets, and PCs which assists manufacturers of such goods in placing their equipment into the marketplace in working order. These differing types of goods are unrelated. Moreover, the record does not contain any evidence establishing that such goods are related. Rather, the Trademark Office has taken the unsupported position that the parties’ goods are related based solely upon the broad generalization that “cable and network testers” include “communication link testers.” That assumption is not evidence and the evidence here at issue indicates the opposite – namely, that the parties’ goods are different, serve different purposes, and are offered to different groups of purchasers and prospective purchasers.

With the notable differences in the relevant parties’ goods in mind, including the uses and channels of trade therefor, Applicant respectfully requests that the Trademark Office lift its 2(d)

refusal of the Application. Simply put, consumers are unlikely to confuse Applicant's Ethernet cable network testing goods offered under the mark LINKIQ as emanating from the source that offers the markedly different wireless computing device testing goods offered by the owner of the Cited Registration for the mark IQ.

B. Applicant's LINKIQ Mark is Dissimilar in Overall Appearance, Sound, Meaning, and Commercial Impression from the Cited Registration.

The Trademark Office concludes that Applicant's LINKIQ mark and the IQ mark cited in the Office Action are similar in overall appearance, sound, and meaning because the marks contain the same word – IQ. Applicant, however, disagrees with this conclusion, as Applicant's mark and the Cited Registration differ in appearance, sound, and meaning. Indeed, the Trademark Office has limited its examination of the mark to only half of the applied-for mark. As it stands, Applicant's LINKIQ mark creates a distinct commercial impression from the cited IQ mark, and therefore, does not result in the marks being confusingly similar.

Applicant's LINKIQ mark creates a significantly different impression than the Cited Registration and has only been partially compared thereto. Marks must be considered in their entireties when determining whether there is a likelihood of confusion. *Estate of P.D. Beckwith, Inc., v. Commissioner of Patents*, 252 U.S. 538, 545-46, 40 S. Ct. 414, 64 L. Ed. 705 (1920) (“The commercial impression of a trade-mark is derived from it as a whole, not from its elements separated and considered in detail. For this reason it should be considered in its entirety ...”). A mark should not be dissected or split up into its component parts and each part then compared with corresponding parts of the conflicting mark to determine the likelihood of confusion. 4 *McCarthy on Trademarks and Unfair Competition* § 23:41 (4th ed.). It is the impression that the mark as a whole creates on the average reasonably prudent buyer and not the parts thereof, that is important. *Id.* As the Supreme Court observed: “The commercial impression of a trademark is derived from it

as a whole, not from its elements separated and considered in detail. For this reason it should be considered in its entirety.” *Estate of P. D. Beckwith, Inc.*, 252 U.S. at 545–46. Thus, as Judge Newman has observed: “It is incorrect to compare marks by eliminating portions thereof and then simply comparing the residue.” *China Healthways Institute, Inc. v. Wang*, 491 F.3d 1337, 83 U.S.P.Q.2d 1123 (Fed. Cir. 2007), cert. denied, 128 S. Ct. 661 (2007) (reversing the Board's finding of no likely confusion between CHI and design and CHI PLUS for competing electric massagers because the Trademark Board downplayed the importance of the Chinese word “chi”). The applied-for mark’s inclusion of the wording LINK creates a significantly different impression than the wording IQ alone. In comparing the Application and Cited Registration only as to the IQ portion of the applied-for mark, the Trademark Office has drawn improper conclusions regarding the likelihood of confusion as between them.

The Trademark Office has overlooked the fact that employment of the wording LINK in Applicant’s mark suggests something completely different to consumers than that suggested by the term IQ alone. If conflicting marks each have an aura of suggestion, but each suggests something different to the buyer, this tends to indicate a *lack* of a likelihood of confusion. *McCarthy on Trademarks and Unfair Competition* § 23:28 (4th ed.). Applicant’s use of the wording LINK conveys the impression of something entirely separable from the Cited Registration. Namely, use of the wording LINK is suggestive of Applicant’s ability to test and identify deficiencies or ways in which to maximize Ethernet performance. In short, one may link the information gained from using Applicant’s goods with its goals to possess peak Ethernet cable performance to improve telecommunications and networking infrastructures and systems. Consequently, Applicant’s inclusion of the term LINK serves a clear, highly relevant source identifying function, especially when used in connection with the wording IQ. Thus, it should be foreseeable that the wording

LINK is a dominant feature of Applicant's mark and serves as a key point of parity as to sight, sound, meaning, and commercial impression as compared to the Cited Registration. Given this fact, and in view of all the foregoing, a likelihood of confusion between Applicant's mark and the Cited Registrations is unlikely and the Trademark Office should withdraw its 2(d) refusal.

C. Consumers are Accustomed to Associating IQ Composite Marks With Applicant in the Telecommunications and Network Cable-Testing Marketplace.

A search of the Trademark Office online database indicates the coexistence of the Cited Registration with another mark owned by Applicant, which is highly similar in to the applied-for mark and used in connection with similar Class 9 goods as those set forth in the mark here at issue. *See Exhibit C.* Indeed, for some time, the Cited Registration has coexisted with Applicant's U.S. Registration No. 6,057,111 for the mark CABLEIQ for use in connection with "network cable tester and certifier in the nature of electronic test and measurement devices for use in the fields of networks and telecommunications, namely, instrumentation used to test and certify new and existing data and voice communication cable and coaxial cables" in Class 9. This mark presents the same structure as that in the instant Application, principally, an IQ composite mark with a preliminary term attached to the wording IQ. The goods associated with this registration are nearly identical to those in the applied-for mark and this registration has coexisted with the Cited Registration at common law since at least as early as 2004. Consumers are therefore accustomed to associating IQ composite marks with Applicant and its telecommunications and network cable testing goods. Moreover, based on the registered status of Applicant's U.S. Registration No. 6,057,111, it appears to be the position of the Trademark Office to allow such IQ composite marks for use in connection with telecommunications and network cable testing goods to peacefully coexist with the Cited Registration in the marketplace

and on the Federal Register at least based on the differences between the attendant marks or goods offered thereunder.

Certainly, if the Cited Registration and Applicant's U.S. Registration No. 6,057,111 can coexist on the Federal Register and in the marketplace without confusion, logic must dictate that Applicant's similarly situated LINKIQ mark can likewise coexist without confusion with the Cited Registration, at least based on the differences between the parties' marks and the goods and offered in connection therewith.

II. CONCLUSION.

By this response, Applicant has addressed the issues raised by the Examining Attorney and respectfully requests that the application be approved for publication at an early date.

If the Examining Attorney has any questions or comments, Applicant respectfully requests that the Examining Attorney contact the undersigned Attorney of Record.