

To: Kreditech Holding SSL GmbH (ruy@garcia-zamor.com)
Subject: U.S. TRADEMARK APPLICATION NO. 86583673 - KREDITECH - PIM-TM005
Sent: 1/26/2016 1:17:10 PM
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**UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)
OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION**

U.S. APPLICATION SERIAL NO. 86583673

MARK: KREDITECH

86583673

CORRESPONDENT ADDRESS:

Ruy Garcia-Zamor
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APPLICANT: Kreditech Holding SSL GmbH

PIM-TM005

CORRESPONDENT E-MAIL ADDRESS:

ruy@garcia-zamor.com

OFFICE ACTION

STRICT DEADLINE TO RESPOND TO THIS LETTER

TO AVOID ABANDONMENT OF APPLICANT'S TRADEMARK APPLICATION, THE USPTO MUST RECEIVE APPLICANT'S COMPLETE RESPONSE TO THIS LETTER **WITHIN 6 MONTHS** OF THE ISSUE/MAILING DATE BELOW.

ISSUE/MAILING DATE: 1/26/2016

The Office has reassigned this application to the undersigned trademark examining attorney.

INTRODUCTION – STATUS OF APPLICATION

This Office action is in response to applicant's communication filed on December 10, 2015, where applicant:

- Provided arguments against the Section 2(d) Refusal
- Amended the description of the mark
- Provided a statement concerning the significance of the mark
- Amended the identification of goods and services in the mark
- Provided a certificate of foreign registration for each class in the application
- Provided a statement concerning applicant's bona fide and effective industrial or commercial establishment in Kazakhstan

The trademark examining attorney has thoroughly reviewed applicant's response and has determined the following:

- Applicant's arguments are unpersuasive to overcome the Section 2(d) refusal, and the refusal is **continued and maintained**
- Applicant's amendment to the mark description is acceptable and made of record, and the requirement is **satisfied**
- Applicant's statement concerning the significance of the mark is acceptable and made of record, and the requirement is **satisfied**
- Applicant's amendment to the identification of goods and services is acceptable in part. However, certain wording in the Class 9 identification requires further clarification, and the requirement is **continued and maintained**
- Applicant's certificates of foreign registration are acceptable and made of record. However, applicant has not provided a translation of the registration certificates, and this creates a **new issue** to which applicant must respond
- Applicant's statement concerning applicant's bona fide and effective industrial or commercial establishment in Kazakhstan is acceptable and made of record, and the advisory concerning the country of origin is **obviated**

The trademark examining attorney **continues and maintains** the Section 2(d) refusal and the identification of goods requirement, and now raises the following **new issue** in the summary of issues below. *See* 37 C.F.R. §2.64(a); TMEP §714.04. The trademark examining attorney's arguments and evidence from the initial Office action are incorporated by reference.

SUMMARY OF ISSUES that applicant must address:

- Translation of Foreign Registration Requirement
- Identification of Goods Requirement – Specified Goods Only
- Advisory – Preliminary Response to Applicant's Arguments against the Section 2(d) Refusal

TRANSLATION OF FOREIGN REGISTRATION REQUIREMENT

The applicant must submit an English translation of the foreign registration. 37 C.F.R. §2.34(a)(3)(ii); TMEP §1004.01(a)-(b). The translation should be signed by the translator. TMEP §1004.01(b).

IDENTIFICATION OF GOODS – SPECIFIED CLASS 9 GOODS ONLY

The wording “Computer programs for the direct and indirect provision of financial services, as well as risk modeling and assessment” in the Class 9 identification of goods is indefinite and must be clarified because the function of the software is vague. See TMEP §1402.01. This wording provides a field, but not a *function* for the software. An identification for computer software must specify the purpose or function of the software. See TMEP §1402.03(d). If the software is field-specific, the identification must also specify the field of use. *Id.* Clarification of the purpose, function, or field of use of the software is necessary for the USPTO to properly examine the application and make appropriate decisions concerning possible conflicts between the applicant’s mark and other marks. See *In re N.A.D. Inc.*, 57 USPQ2d 1872, 1874 (TTAB 2000). Applicant’s wording only indicates that the software is used in the provision of financial services, but it does not identify what the software does. Accordingly, this wording is indefinite and must be clarified.

Applicant may change this wording to “Computer programs for **analyzing financial data as part of** the direct and indirect provision of financial services, **and for modeling and assessing financial risk**” in Class 9, if accurate. See TMEP §1402.01.

The remainder of the amended identification is acceptable and made of record.

An applicant may only amend an identification to clarify or limit the goods, but not to add to or broaden the scope of the goods. 37 C.F.R. §2.71(a); see TMEP §§1402.06 *et seq.*, 1402.07.

For assistance with identifying and classifying goods and services in trademark applications, please see the USPTO’s online searchable *U.S. Acceptable Identification of Goods and Services Manual* at <http://tess2.uspto.gov/netahtml/tidm.html>. See TMEP §1402.04.

PRELIMINARY RESPONSE TO APPLICANT’S ARGUMENTS

Applicant had argued against the Section 2(d) refusals concerning Classes 9 and 35. Applicant’s arguments are unpersuasive for the reasons indicated below. The trademark examining attorney may provide a further response to these arguments in a Final Office Action, if necessary.

First, applicant argues that the differences in spelling and appearance create different commercial impressions. This argument is unconvincing. Although there are differences in the spelling of the marks, the similarities of the marks outweigh the differences. When comparing marks, the test is not whether the marks can be distinguished in a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression that confusion as to the source of the goods and services offered under the respective marks is likely to result. *Midwestern Pet Foods, Inc. v. Societe des Produits Nestle S.A.*, 685 F.3d 1046, 1053, 103 USPQ2d 1435, 1440 (Fed. Cir. 2012); *In re Davia*, 110 USPQ2d 1810, 1813 (TTAB 2014); TMEP §1207.01(b). The proper focus is on the recollection of the average purchaser, who retains a general rather than specific impression of trademarks. *United Global Media Grp., Inc. v. Tseng*, 112 USPQ2d 1039, 1049, (TTAB 2014); *L’Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1438 (TTAB 2012); TMEP §1207.01(b).

Applicant points out that applicant’s mark uses a “K” at the beginning of the mark, while registrants’ marks use a “C”. Also, applicant notes that its mark uses a “CH” at the end of “TECH,” while registrants’ marks use an “X” or a “K.” However, all of the marks will be pronounced nearly identically. The marks are essentially phonetic equivalents and thus sound similar. Similarity in sound alone may be sufficient to support a finding that the marks are confusingly similar. *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988); see *In re 1st USA Realty Prof’ls, Inc.*, 84 USPQ2d 1581, 1586 (TTAB 2007); TMEP §1207.01(b)(iv). Purchasers with a general recollection of the marks, or that hear the marks spoken aloud, are unlikely to remember or be aware of these minor differences in appearance. Thus, the similarities in sound outweigh the differences in appearance.

Further, the trademark examining attorney recognizes that applicant’s mark is stylized and features a design element. However, registrants’ marks are in typed drawing format or standard character. A mark in typed or standard characters may be displayed in any lettering style; the rights reside in the wording or other literal element and not in any particular display or rendition. See *In re Viterra Inc.*, 671 F.3d 1358, 1363, 101 USPQ2d 1905, 1909 (Fed. Cir. 2012); *In re Mighty Leaf Tea*, 601 F.3d 1342, 1348, 94 USPQ2d 1257, 1260 (Fed. Cir. 2010); 37 C.F.R. §2.52(a); TMEP §1207.01(c)(iii). Thus, a mark presented in stylized characters and/or with a design element generally will not avoid likelihood of confusion with a mark in typed or standard characters because the marks could be presented in the same manner of display. See, e.g., *In re Viterra Inc.*, 671 F.3d at 1363, 101 USPQ2d at 1909; *Squirtco v. Tomy Corp.*, 697 F.2d 1038, 1041, 216 USPQ 937, 939 (Fed. Cir. 1983) (stating

that “the argument concerning a difference in type style is not viable where one party asserts rights in no particular display”).

Applicant further argues that these differences in spelling create such an incongruity from the expected spelling of the wording in the marks that purchasers will recall and focus on the differences. However, these misspellings are minor and do not outweigh the overall impressions of the marks. The attached third-party registration show just some examples of the other marks that have used KREDIT for CREDIT (U.S. Registration Nos. 4369855 and 4168079), TEK for TECH (U.S. Registration Nos. 4881663, 4790067, 4571461, and 4450579), or TEX for TECHS (U.S. Registration Nos. 4046746, 4236716, and 4164456). Because purchases are accustomed to seeing these spelling differences, they are unlikely to apply so much thought and awareness to the minor misspellings to recognize them as the primary indicator of source in the marks. On the contrary, they are likely to consider the overall *meaning* of the marks—all of which suggest technology relating to credit. Thus, because of the highly similar meanings of the marks, purchasers are likely to be confused as to the source of the goods and services.

Applicant next argues that the goods and services differ significantly and are provided in different channels of trade. Applicant impermissibly reads limitations and restrictions into the scope of the registrations and application that are not present therein. When analyzing an applicant’s and registrant’s goods and services for similarity and relatedness, that determination is based on the description of the goods and services stated in the application and registrations at issue, not on extrinsic evidence of actual use. *See Octocom Sys. Inc. v. Hous. Computers Servs. Inc.*, 918 F.2d 937, 942, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990); *see also Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 1267, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002).

Concerning the first cited registration, CREDITEX for Class 9 goods, neither the application nor the registration limits the goods to particular channels of trade or classes of consumers. Applicant and registrant’s identifications both list software for providing financial services relating to financial risk, which encompasses credit risk. Applicant’s other identified functions broadly identify uses related to “financial information,” “financial reports,” and “financial records.” This broad wording encompasses the registrant’s specify areas relating to credit risk. Both identifications are broad enough to target similar consumers for their goods which would create a likelihood of confusion between the goods.

Likewise, the second cited registration, CREDITEK for Class 35 services, also identifies services that are encompassed in applicant’s broadly wording identification. Applicant does not specify a particular industry, channel of trade, or class of consumers. Again, both identifications are broad enough to target similar consumers for their goods which would create a likelihood of confusion between the goods.

Because the descriptions of the goods and services in application and registrations overlap significantly, applicant’s arguments are insufficient to overcome the confusing similarity of the goods and services in registrants’ marks.

RESPONSE GUIDELINES

For this application to proceed toward registration, applicant must explicitly address each refusal and/or requirement raised in this Office action. If the action includes a refusal, applicant may provide arguments and/or evidence as to why the refusal should be withdrawn and the mark should register. Applicant may also have other options for responding to a refusal and should consider such options carefully. To respond to requirements and certain refusal response options, applicant should set forth in writing the required changes or statements.

If applicant does not respond to this Office action within six months of the issue/ mailing date, or responds by expressly abandoning the application, the application process will end, the trademark will fail to register, and the application fee will not be refunded. *See* 15 U.S.C. §1062(b); 37 C.F.R. §§2.65(a), 2.68(a), 2.209(a); TMEP §§405.04, 718.01, 718.02. Where the application has been abandoned for failure to respond to an Office action, applicant’s only option would be to file a timely petition to revive the application, which, if granted, would allow the application to return to active status. *See* 37 C.F.R. §2.66; TMEP §1714. There is a \$100 fee for such petitions. *See* 37 C.F.R. §§2.6, 2.66(b)(1).

If applicant has questions regarding this Office action, please telephone or e-mail the assigned trademark examining attorney. All relevant e-mail communications will be placed in the official application record; however, an e-mail communication will not be accepted as a response to this Office action and will not extend the deadline for filing a proper response. *See* 37 C.F.R. §§2.62(c), 2.191; TMEP §§304.01-.02, 709.04-.05. Further, although the trademark examining attorney may provide additional explanation pertaining to the refusal and requirements in this Office action, the trademark examining attorney may not provide legal advice or statements about applicant’s rights. *See* TMEP §§705.02, 709.06.

TEAS PLUS OR TEAS REDUCED FEE (TEAS RF) APPLICANTS – TO MAINTAIN LOWER FEE, ADDITIONAL REQUIREMENTS MUST BE MET, INCLUDING SUBMITTING DOCUMENTS ONLINE: Applicants who filed their application online using the lower-fee TEAS Plus or TEAS RF application form must (1) file certain documents online using TEAS, including responses to Office actions (see TMEP §§819.02(b), 820.02(b) for a complete list of these documents); (2) maintain a valid e-mail correspondence address;

and (3) agree to receive correspondence from the USPTO by e-mail throughout the prosecution of the application. See 37 C.F.R. §§2.22(b), 2.23(b); TMEP §§819, 820. TEAS Plus or TEAS RF applicants who do not meet these requirements must submit an additional processing fee of \$50 per international class of goods and/or services. 37 C.F.R. §§2.6(a)(1)(v), 2.22(c), 2.23(c); TMEP §§819.04, 820.04. However, in certain situations, TEAS Plus or TEAS RF applicants may respond to an Office action by authorizing an examiner's amendment by telephone without incurring this additional fee.

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All informal e-mail communications relevant to this application will be placed in the official application record.

WHO MUST SIGN THE RESPONSE: It must be personally signed by an individual applicant or someone with legal authority to bind an applicant (i.e., a corporate officer, a general partner, all joint applicants). If an applicant is represented by an attorney, the attorney must sign the response.

PERIODICALLY CHECK THE STATUS OF THE APPLICATION: To ensure that applicant does not miss crucial deadlines or official notices, check the status of the application every three to four months using the Trademark Status and Document Retrieval (TSDR) system at <http://tsdr.uspto.gov/>. Please keep a copy of the TSDR status screen. If the status shows no change for more than six months, contact the Trademark Assistance Center by e-mail at TrademarkAssistanceCenter@uspto.gov or call 1-800-786-9199. For more information on checking status, see <http://www.uspto.gov/trademarks/process/status/>.

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