

To: Kreditech Holding SSL GmbH (ruy@garcia-zamor.com)
Subject: U.S. TRADEMARK APPLICATION NO. 86583725 - KREDITECH - PIM-TM004
Sent: 9/2/2016 6:17:45 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. 86583725

MARK: KREDITECH

86583725

CORRESPONDENT ADDRESS:

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APPLICANT: Kreditech Holding SSL GmbH

CORRESPONDENT'S REFERENCE/DOCKET NO :
PIM-TM004

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: 9/2/2016

INTRODUCTION

This Office action is in response to applicant's communication filed on July 18, 2016, where applicant:

- Provided arguments against the Section 2(d) Refusal
- Amended the Identifications for Classes 9 and 35
- Provided a translation of the foreign registration
- Amended the foreign registration on which applicant is relying for Class 9

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 Class 9 identification includes indefinite wording and creates a **new issue** to which applicant must respond
- Applicant's amendment to the identification in Class 35 is acceptable and made of record
- Applicant's translation of the foreign registration is acceptable and made of record, and the requirement is **satisfied**
- Applicant's substituted foreign registration for Class 9 is acceptable and made of record, and the requirement is **satisfied**

The trademark examining attorney **continues and maintains** the Section 2(d) refusal and raises the following **new issue** concerning the specified goods in Class 9 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 NEW ISSUES that applicant must address:

- Identification of Goods Requirement – Specified Class 9 Goods Only
- Advisory – Preliminary Response to Applicant’s Arguments Against the Section 2(d) Refusal

IDENTIFICATION OF GOODS REQUIREMENT – SPECIFIED CLASS 9 GOODS ONLY

The wording “Computer software recorded on data media programs designed for use in construction and automated manufacturing” in International Class 9 is indefinite; applicant must specify the purpose or function of the software. *See* 37 C.F.R. §2.32(a)(6); TMEP §1402.03(d). If the software is content- or field-specific, applicant must also specify its content or field of use. *See* TMEP §1402.03(d). Generally, an identification for software is acceptable when the purpose or function of the software is provided, and, if applicable, its content or field of use. *Id.* The USPTO requires such specificity in identifying computer programs or software in order for a trademark examining attorney to examine the application properly 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); TMEP §1402.03(d).

In this case, the wording specifies the field but not the function of the software. As a variety of types of software may be used in this field, further specificity is required to properly assess the nature of the goods.

Applicant may adopt the following identification in Class 9, if accurate: “Computer software recorded on data media programs designed **for {specify function of software, e.g., financial data analysis, financial modeling, etc.}** for use in construction and automated manufacturing; Computer software for use as a spreadsheet in producing financial reports regarding risk assessment on the direct and indirect provision of financial products to natural persons, behavioral information on the use of third party and proprietary lending platforms, and personal financial management solutions; Computer software for creating searchable databases of historical financial information, namely records relating to risk assessment on the direct and indirect provision of financial products to natural persons, behavioral information on the use of third party and proprietary lending platforms, and personal financial management solutions; Computer software for managing and processing financial transactions not including over-the-counter credit risk, credit risk transactions, and credit risk trading; Financial management software, namely computer software for facilitating day-to-day business operations not including facilitating, processing, and completing over-the-counter credit derivative transactions, credit risk transactions, and credit risk trading; Computer programs for tracking and editing financial records regarding risk assessment on the direct and indirect provision of financial products to natural persons, behavioral information on the use of third party and proprietary lending platforms, and personal financial management solutions”

The identification of services in Classes 35, 36, and 42 are acceptable as written.

Applicant’s goods and/or services may be clarified or limited, but may not be expanded beyond those originally itemized in the application or as acceptably amended. *See* 37 C.F.R. §2.71(a); TMEP §1402.06. Applicant may clarify or limit the identification by inserting qualifying language or deleting items to result in a more specific identification; however, applicant may not substitute different goods and/or services or add goods and/or services not found or encompassed by those in the original application or as acceptably amended. *See* TMEP §1402.06(a)-(b). The scope of the goods and/or services sets the outer limit for any changes to the identification and is generally determined by the ordinary meaning of the wording in the identification. TMEP §§1402.06(b), 1402.07(a)-(b). Any acceptable changes to the goods and/or services will further limit scope, and once goods and/or services are deleted, they are not permitted to be reinserted. TMEP §1402.07(e).

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](#). *See* TMEP §1402.04.

PRELIMINARY RESPONSE TO APPLICANT’S ARGUMENTS

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

As in its prior response, applicant argues that the differences in spelling an appearance obviate a likelihood of confusion. 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/or 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 Bay State Brewing Co.*, 117 USPQ2d 1958, 1960 (TTAB 2016) (quoting *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1368, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012)); 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. *In re Bay State Brewing Co.*, 117 USPQ2d at 1960 ((citing *Spoons Rests., Inc., v. Morrison, Inc.*, 23 USPQ2d 1735, 1741 (TTAB 1991), *aff’d per curiam*, 972 F.2d 1353 (Fed. Cir. 1992)); *In re C.H. Hanson Co.*, 116 USPQ2d 1351, 1353 (TTAB 2015) (citing *Joel Gott Wines LLC v. Rehoboth Von Gott Inc.*, 107 USPQ2d 1424, 1430 (TTAB 2013)); TMEP §1207.01(b).

Applicant improperly analyzes the appearance of the mark as a side-by-side comparison. The overall impressions of the marks is a combination of the words “Credit” and “Tech”. The marks all suggest that the goods and services relate to the use of technology (such as computer software

and as a means of analysis) relating to credit and finances. Therefore, all of the goods have the same connotation and meaning. Also, the marks are highly similar, if not identical, in sound. There is no correct pronunciation of a mark because it is impossible to predict how the public will pronounce a particular mark. See *Embarcadero Techs., Inc. v. RStudio, Inc.*, 105 USPQ2d 1825, 1835 (TTAB 2013) (quoting *In re Viterra Inc.*, 671 F.3d 1358, 1367, 101 USPQ2d 1905, 1912 (Fed. Cir. 2012); *In re The Belgrade Shoe Co.*, 411 F.2d 1352, 1353, 162 USPQ 227, 227 (C.C.P.A. 1969)); TMEP §1207.01(b)(iv). The marks in question could clearly be pronounced the same; such 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).

Moreover, “K” is commonly substituted for “C” in marks, and “tech” commonly misspelled in marks as “tek” or “tech.” Therefore, purchasers are unlikely to rely on these differences to distinguish between the marks. While academics may reach certain conclusions about the perceptions of wording in a psychological context, purchasers with a general recollection of marks are not likely to differentiate between highly similar marks for closely related goods and services based solely on minor visual differences. As the overall connotations of the marks are the same with respect to the goods and services, the marks are more similar than different and are therefore confusingly similar.

Applicant further argues that the amendments to its identifications make clear that the goods and services are separate and distinct. Applicant has not specified its own fields of use or trade channels with specificity; applicant has merely excluded the registrant’s specified uses from applicant’s identification. This exclusion is insufficient. The goods and services of the parties need not be identical or even competitive to find a likelihood of confusion. See *On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 1086, 56 USPQ2d 1471, 1475 (Fed. Cir. 2000); *Recot, Inc. v. Becton*, 214 F.3d 1322, 1329, 54 USPQ2d 1894, 1898 (Fed. Cir. 2000) (“[E]ven if the goods in question are different from, and thus not related to, one another in kind, the same goods can be related in the mind of the consuming public as to the origin of the goods.”); TMEP §1207.01(a)(i).

The respective goods and services need only be “related in some manner and/or if the circumstances surrounding their marketing [be] such that they could give rise to the mistaken belief that [the goods and services] emanate from the same source.” *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1369, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012) (quoting *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1724 (TTAB 2007)); TMEP §1207.01(a)(i). Here, purchasers are unlikely to be aware of such exclusion that appear only on an application or registration certificate.

Finally, applicant has submitted printed or electronic copies of third-party registrations for marks containing the wording “KREDIT” or “TEK” as parts of marks along with different wording, and “CREDIT” and “TECH” or “TECHNOLOGIES” together to support the argument that this wording is weak, diluted, or so widely used that it should not be afforded a broad scope of protection. These registrations appear to be for goods or services that are only marginally related to those identified in applicant’s application.

The weakness or dilution of a particular mark is generally determined in the context of the number and nature of similar marks in use in the marketplace in connection with similar goods and services. See *Nat’l Cable Tel. Ass’n, Inc. v. Am. Cinema Editors, Inc.*, 937 F.2d 1572, 1579-80, 19 USPQ2d 1424, 1430 (Fed. Cir. 1991); *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973). Evidence of widespread third-party use of similar marks with similar goods and services “is relevant to show that a mark is relatively weak and entitled to only a narrow scope of protection” in that industry or field. *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee en 1772*, 396 F.3d 1369, 1373-74, 73 USPQ2d 1689, 1693 (Fed. Cir. 2005); see *In re Coors Brewing Co.*, 343 F.3d 1340, 1345, 68 USPQ2d 1059, 1062-63 (Fed. Cir. 2003).

However, evidence comprising only a small number of third-party registrations for similar marks with similar goods and services, as in the present case, is generally entitled to little weight in determining the strength of a mark. See *AMF Inc. v. Am. Leisure Products, Inc.*, 474 F.2d 1403, 1406, 177 USPQ 268, 269 (C.C.P.A. 1973); *Richardson-Vicks Inc. v. Franklin Mint Corp.*, 216 USPQ 989, 992 (TTAB 1982). These few registrations are “not evidence of what happens in the market place or that customers are familiar with them.” *AMF Inc. v. Am. Leisure Prods., Inc.*, 474 F.2d at 1406, 177 USPQ at 269; see *Richardson-Vicks Inc. v. Franklin Mint Corp.*, 216 USPQ at 992. Specifically, applicant has provided four registrations that include both components of the applied-for mark, but in those registrations, the components are reversed or distinguishable based on the unabbreviated term “technologies”. Although the mark CREDITEX is identical to one of the cited registrations, it is in a different class and has not been cited. Thus, the few similar third-party registrations submitted by applicant are insufficient to establish that the combined wording KREDITECH is weak or diluted.

Further, evidence comprising third-party registrations for similar marks with different or unrelated goods and services, as in the present case, is of limited probative value in determining the strength of a mark. See *Kay Chems., Inc. v. Kelite Chems. Corp.*, 464 F.2d 1040, 1042, 175 USPQ 99, 101 (C.C.P.A. 1972); *In re Thor Tech, Inc.*, 90 USPQ2d 1634, 1639 (TTAB 2009). Here, the relevant registration applicant has provided feature services in Class 36. Only Classes 9 and 35 have been refused pursuant to Section 2(d) in this application. Thus, these third-party registrations submitted by applicant are insufficient to establish that the wording is weak or diluted.

RESPONSE GUIDELINES

For this application to proceed further, 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. For more information and general tips on responding to USPTO Office actions, response options, and how to file a response online, see “[Responding to Office Actions](#)” on the USPTO’s website.

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 and the trademark will fail to register. See 15 U.S.C. §1062(b); 37 C.F.R. §§2.65(a), 2.68(a); TMEP §§718.01, 718.02. Additionally, the USPTO will not refund the application filing fee, which is a required processing fee. See 37 C.F.R. §§2.6(a)(1)(i)-(iv), 2.209(a); TMEP §405.04.

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(s) and/or requirement(s) 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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TO RESPOND TO THIS LETTER: Go to http://www.uspto.gov/trademarks/teas/response_forms.jsp. Please wait 48-72 hours from the issue/ mailing date before using the Trademark Electronic Application System (TEAS), to allow for necessary system updates of the application. For *technical* assistance with online forms, e-mail TEAS@uspto.gov. For questions about the Office action itself, please contact the assigned trademark examining attorney. **E-mail communications will not be accepted as responses to Office actions; therefore, do not respond to this Office action by e-mail.**

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/>.

TO UPDATE CORRESPONDENCE/E-MAIL ADDRESS: Use the TEAS form at <http://www.uspto.gov/trademarks/teas/correspondence.jsp>.

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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

**IMPORTANT NOTICE REGARDING YOUR
U.S. TRADEMARK APPLICATION**

USPTO OFFICE ACTION (OFFICIAL LETTER) HAS ISSUED
ON **9/2/2016** FOR U.S. APPLICATION SERIAL NO. 86583725

Please follow the instructions below:

(1) TO READ THE LETTER: Click on this [link](#) or go to <http://tsdr.uspto.gov>, enter the U.S. application serial number, and click on "Documents."

The Office action may not be immediately viewable, to allow for necessary system updates of the application, but will be available within 24 hours of this e-mail notification.

(2) TIMELY RESPONSE IS REQUIRED: Please carefully review the Office action to determine (1) how to respond, and (2) the applicable response time period. Your response deadline will be calculated from **9/2/2016** (*or sooner if specified in the Office action*). For information regarding response time periods, see <http://www.uspto.gov/trademarks/process/status/responsetime.jsp>.

Do NOT hit "Reply" to this e-mail notification, or otherwise e-mail your response because the USPTO does NOT accept e-mails as responses to Office actions. Instead, the USPTO recommends that you respond online using the Trademark Electronic Application System (TEAS) response form located at http://www.uspto.gov/trademarks/teas/response_forms.jsp.

(3) QUESTIONS: For questions about the contents of the Office action itself, please contact the assigned trademark examining attorney. For *technical* assistance in accessing or viewing the Office action in the Trademark Status and Document Retrieval (TSDR) system, please e-mail TSDR@uspto.gov.

WARNING

Failure to file the required response by the applicable response deadline will result in the ABANDONMENT of your application. For more information regarding abandonment, see <http://www.uspto.gov/trademarks/basics/abandon.jsp>.

PRIVATE COMPANY SOLICITATIONS REGARDING YOUR APPLICATION: Private companies **not** associated with the USPTO are using information provided in trademark applications to mail or e-mail trademark-related solicitations. These companies often use names that closely resemble the USPTO and their solicitations may look like an official government document. Many solicitations require that you pay "fees."

Please carefully review all correspondence you receive regarding this application to make sure that you are responding to an official document from the USPTO rather than a private company solicitation. All official USPTO correspondence will be mailed only from the "United States Patent and Trademark Office" in Alexandria, VA; or sent by e-mail from the domain "@uspto.gov." For more information on how to handle private company solicitations, see http://www.uspto.gov/trademarks/solicitation_warnings.jsp.