

To: Bub-Joo S. Lee(bjslee@lacwkrr.com)
Subject: U.S. Trademark Application Serial No. 97120248 - KOREA INVESTMENT & SECURITIES US, INC. - CMID 9262
Sent: August 23, 2022 09:41:11 PM EDT
Sent As: tmng.notices@uspto.gov

Attachments

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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. 97120248

Mark: KOREA INVESTMENT & SECURITIES US, INC.

Correspondence Address:

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LOS ANGELES CA 90071 UNITED STATES

Applicant: KOREA INVESTMENT & SECURITIES US, INC.

Reference/Docket No. CMID 9262

Correspondence Email Address: bjslee@lacwkrr.com

NONFINAL OFFICE ACTION

The USPTO must receive applicant's response to this letter within six months of the issue date below or the application will be abandoned. Respond using the Trademark Electronic Application System (TEAS). A link to the appropriate TEAS response form appears at the end of this Office action.

Issue date: August 23, 2022

The referenced application has been reviewed by the assigned trademark examining attorney. Applicant must respond timely and completely to the issues below. 15 U.S.C. §1062(b); 37 C.F.R. §§2.62(a), 2.65(a); TMEP §§711, 718.03.

SEARCH OF USPTO DATABASE OF MARKS

The trademark examining attorney has searched the USPTO database of registered and pending marks and has found no conflicting marks that would bar registration under Trademark Act Section 2(d). 15 U.S.C. §1052(d); TMEP §704.02.

SUMMARY OF ISSUES

- Section 2(e)(2) Refusal - Primarily Geographically Descriptive
- Information About the Services Required
- Supplemental Register Advisory - Amendment To Supplemental Register Suggested With Acceptable Proof Of Use
- Disclaimer Advisory

SECTION 2(e)(2) REFUSAL - PRIMARILY GEOGRAPHICALLY DESCRIPTIVE

Applicant has applied to register KOREA INVESTMENT & SECURITIES US, INC. for "Capital investment; investment of funds; financial investment in the field of securities, real estate, and infrastructure projects; project financing; capital investment services; commercial lending services; financial services, namely, money lending and syndication of loans; loan financing; financial and investment services, namely, asset and investment acquisition" in International Class 36.

Registration is refused because the applied-for mark is primarily geographically descriptive of the origin of applicant's services. Trademark Act Section 2(e)(2), 15 U.S.C. §1052(e)(2); *see* TMEP §§1210, 1210.01(a).

A mark is primarily geographically descriptive when the following is demonstrated:

- (1) The primary significance of the mark to the purchasing public is a generally known location;
- (2) The goods or services originate in the place identified in the mark; and
- (3) The purchasing public would be likely to believe that the goods or services originate in the geographic place identified in the mark; that is, to make a goods-place or services-place association.

See Spiritline Cruises LLC v. Tour Mgmt. Servs., Inc., 2020 USPQ2d 48324, at *5 (TTAB 2020) (citing *In re Nantucket, Inc.*, 677 F.2d 95, 96-97, 213 USPQ 889, 891 (C.C.P.A. 1982)); *see also In re Newbridge Cutlery Co.*, 776 F.3d 854, 860-61, 113 USPQ2d 1445, 1448-49 (Fed. Cir. 2015); *In re Societe Generale des Eaux Minerales de Vittel S.A.*, 824 F.2d 957, 959, 3 USPQ2d 1450, 1452 (Fed. Cir. 1987); *In re JT Tobacconists*, 59 USPQ2d 1080, 1081 (TTAB 2001)); TMEP §1210.01(a).

In this case, the primary significance of KOREA and US is as a generally known geographic locations. The attached evidence from CIA.gov establishes that KOREA identifies the southern half of the Korean peninsula. *See* <https://www.cia.gov/the-world-factbook/countries/korea-south/#introduction>. Further, the attached definition from the Merriam-Webster Dictionary establishes that the letters U.S. denote the United States. *See* <https://www.merriam-webster.com/dictionary/us>. Thus, the primary significance of these terms in the mark is as geographic locations.

A goods-place or services-place association may be presumed where (1) the location in the mark is generally known to the purchasing public, (2) the term's geographical significance is its primary significance, and (3) the goods and/or services do, in fact, originate from the named location in the mark. TMEP §1210.04; *see, e.g., In re Cal. Pizza Kitchen Inc.*, 10 USPQ2d 1704, 1705 (TTAB 1988) (finding a services-place association was presumed between applicant's restaurant services and California because the services originated in California); *In re Handler Fenton Ws., Inc.*, 214 USPQ 848, 850 (TTAB 1982) (finding a goods-place association was presumed between applicant's t-shirts and Denver because the goods had their geographical origin in Denver); *see also In re Nantucket, Inc.*, 677 F.2d 95, 102, 213 USPQ 889, 895 (C.C.P.A. 1982) (Nies, J., concurring) ("[W]e must start with the concept that a geographic name of a place of business is a descriptive term when used on the goods of that business. There is a public goods/place association, in effect, presumed." (internal footnote removed)).

The attached evidence from applicant's website establishes that the services originate in the location named in the mark. Specifically, the attached evidence indicates that applicant is "one of the leading securities companies in Korea. *See* <http://www.truefriend.com/eng/main.jsp>. Thus, the term KOREA in the mark identifies where the services originate. Further, the attached evidence from applicant's website indicates that the services are provided worldwide, including in the U.S. *See* <http://www.truefriend.com/eng/company/network01.shtm>. Thus, the term US in the mark is descriptive of where the services may be provided. Accordingly, the services will originate in the places named in the mark.

Further, the additional wording in the mark is highly descriptive or generic for applicant's services. The addition of generic or highly descriptive wording to a geographic word or term does not diminish that geographic word or term's primary geographic significance. TMEP §1210.02(c)(ii); *see, e.g., Spiritline Cruises LLC v. Tour Mgmt. Servs., Inc.*, 2020 USPQ2d 48324, at *6-7 (TTAB 2020) (holding CHARLESTON HARBOR TOURS primarily geographically descriptive of various travel tour and cruise services because TOURS is generic for the services and CHARLESTON HARBOR is a well-known harbor in Charleston, South Carolina); *In re Hollywood Lawyers Online*, 110 USPQ2d 1852, 1853-54 (TTAB 2014) (holding HOLLYWOOD LAWYERS ONLINE primarily geographically descriptive of attorney referrals, online business information, and an online business directory).

In this case, applicant has identified "Capital *investment*; *investment* of funds; project financing; capital *investment* services" in International Class 36. (Emphasis added). Thus, the term INVESTMENT in the mark names applicant's services. And, the term SECURITIES refers to "Paper

certificates (definitive securities) or electronic records (book-entry securities) evidencing ownership of equity (stocks) or debt obligations (bonds)." See <https://financial-dictionary.thefreedictionary.com/Securities>. Investment services providers commonly provide services encompassing securities. See e.g., <https://www.jpmorgan.com/solutions/cib/securities-services>, <https://www.northerntrust.com/united-states/what-we-do/asset-servicing/securities-services>. Thus, the wording INVESTMENT and SECURITIES merely describes applicant's services.

And, the acronym "INC" is a common business designation. Business type designations and abbreviations such as "Inc.," merely indicate applicant's business type or structure and generally have no source-indicating capacity. TMEP §1213.03(d); see, e.g., *Goodyear's India Rubber Glove Mfg. Co. v. Goodyear Rubber Co.*, 128 U.S. 598, 602-03 (1888); *In re Piano Factory Grp., Inc.*, 85 USPQ2d 1522, 1526 (TTAB 2006); *In re Patent & Trademark Servs., Inc.*, 49 USPQ2d 1537, 1539-40 (TTAB 1998). Accordingly, the primary significance of the mark is geographic.

Finally, the applied-for mark shows the wording in stylized lettering. Stylized descriptive or generic wording is registrable only if the stylization creates a commercial impression separate and apart from the impression made by the wording itself. See *In re Cordua Rests., Inc.*, 823 F.3d 594, 606, 118 USPQ2d 1632, 1639-40 (Fed. Cir. 2016); *In re Northland Aluminum Prods., Inc.*, 777 F.2d 1556, 1561, 227 USPQ 961, 964 (Fed. Cir. 1985); TMEP §1209.03(w). Common and ordinary lettering with minimal stylization, as in this case, is generally not sufficiently striking, unique, or distinctive as to make an impression on purchasers separate from the wording. See *In re Sadoru Grp., Ltd.*, 105 USPQ2d 1484, 1487 (TTAB 2012).

For the foregoing reasons, the mark is primarily geographically descriptive and registration is refused under Section 2(e)(2) of the Trademark Act.

Although applicant's mark has been refused registration, applicant may respond to the refusal by submitting evidence and arguments in support of registration. However, if applicant responds to the refusal, applicant must also respond to the requirements set forth below.

INFORMATION ABOUT SERVICES REQUIRED

To permit proper examination of the application, applicant must provide a written statement specifying where the goods and/or services come from or originate. See 37 C.F.R. §2.61(b); TMEP §§814, 1210.03.

Applicant has a duty to respond directly and completely to this requirement for information. See *In re Ocean Tech., Inc.*, 2019 USPQ2d 450686, at *2 (TTAB 2019) (citing *In re AOP LLC*, 107 USPQ2d 1644, 1651 (TTAB 2013)); TMEP §814. Failure to comply with a requirement for information is an independent ground for refusing registration. *In re SICPA Holding SA*, 2021 USPQ2d 613, at *6 (TTAB 2021) (citing *In re Cheezwhse.com, Inc.*, 85 USPQ2d 1917, 1919 (TTAB 2008); *In re DTI P'ship LLP*, 67 USPQ2d 1699, 1701-02 (TTAB 2003); TMEP §814).

SUPPLEMENTAL REGISTER ADVISORY - AMENDMENT TO SUPPLEMENTAL REGISTER SUGGESTED WITH ACCEPTABLE PROOF OF USE

Although an amendment to the Supplemental Register would be an appropriate response to this refusal in an application based on Trademark Act Section 1(a) or 44, such a response is not appropriate in the present case. The instant application was filed under Section 1(b) and is not eligible for

registration on the Supplemental Register until an acceptable amendment to allege use meeting the requirements of 37 C.F.R. §2.76 has been timely filed. 37 C.F.R. §2.47(d); TMEP §§816.02, 1102.03.

If applicant files an acceptable allegation of use and also amends to the Supplemental Register, the application effective filing date will be the date applicant met the minimum filing requirements under 37 C.F.R. §2.76(c) for an amendment to allege use. TMEP §§816.02, 1102.03; *see* 37 C.F.R. §2.75(b). In addition, the undersigned trademark examining attorney will conduct a new search of the USPTO records for conflicting marks based on the later application filing date. TMEP §§206.01, 1102.03.

Although registration on the Supplemental Register does not afford all the benefits of registration on the Principal Register, it does provide the following advantages to the registrant:

(1) Use of the registration symbol ® with the registered mark in connection with the designated goods and/or services, which provides public notice of the registration and potentially deters third parties from using confusingly similar marks.

(2) Inclusion of the registered mark in the USPTO's database of registered and pending marks, which will (a) make it easier for third parties to find it in trademark search reports, (b) provide public notice of the registration, and thus (c) potentially deter third parties from using confusingly similar marks.

(3) Use of the registration by a USPTO trademark examining attorney as a bar to registering confusingly similar marks in applications filed by third parties.

(4) Use of the registration as a basis to bring suit for trademark infringement in federal court, which, although more costly than state court, means judges with more trademark experience, often faster adjudications, and the opportunity to seek an injunction, actual damages, and attorneys' fees and costs.

(5) Use of the registration as a filing basis for a trademark application for registration in certain foreign countries, in accordance with international treaties.

See 15 U.S.C. §§1052(d), 1091, 1094; J. Thomas McCarthy, *McCarthy on Trademarks & Unfair Competition* §§19:33, 19:37 (rev. 4th ed. Supp. 2017).

DISCLAIMER ADVISORY

Applicant is advised that, if the application is amended to seek registration on the Principal Register under Trademark Act Section 2(f) or on the Supplemental Register, applicant will be required to disclaim "INVESTMENT & SECURITIES" because such wording appears to be generic in the context of applicant's goods and/or services. *See* 15 U.S.C. §1056(a); *In re Wella Corp.*, 565 F.2d 143, 144, 196 USPQ 7, 8 (C.C.P.A. 1977); *In re Creative Goldsmiths of Wash., Inc.*, 229 USPQ 766, 768 (TTAB 1986); TMEP §1213.03(b).

Applicant may submit a disclaimer in the following format:

No claim is made to the exclusive right to use "INVESTMENT & SECURITIES" apart from the mark as shown.

TMEP §1213.08(a)(i).

For an overview of disclaimers and instructions on how to provide one using the Trademark Electronic Application System (TEAS), see the [Disclaimer webpage](#).

RESPONSE AND ASSISTANCE

Please call or email the assigned trademark examining attorney with questions about this Office action.

How to respond. [Click to file a response to this nonfinal Office action.](#)

/Rebecca Eubank/
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rebecca.eubank@uspto.gov

RESPONSE GUIDANCE

- **Missing the response deadline to this letter will cause the application to [abandon](#).** The response must be received by the USPTO before midnight **Eastern Time** of the last day of the response period. TEAS maintenance or [unforeseen circumstances](#) could affect an applicant's ability to timely respond.
- **[Responses signed by an unauthorized party](#)** are not accepted and can **cause the application to [abandon](#)**. If applicant does not have an attorney, the response must be signed by the individual applicant, all joint applicants, or someone with [legal authority to bind a juristic applicant](#). If applicant has an attorney, the response must be signed by the attorney.
- If needed, **find [contact information for the supervisor](#)** of the office or unit listed in the signature block.



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Page last updated: August 15, 2022



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Introduction

Background

The first recorded kingdom (Choson) on the Korean Peninsula dates from approximately 2300 B.C. Over the subsequent centuries, three main kingdoms – Koguryo, Paekche, and Silla – were established on the Peninsula. By the 5th century A.D., Koguryo emerged as the most powerful, with control over much of the Peninsula, as well as part of Manchuria (modern-day northeast China). However, Silla allied with the Chinese to create the first unified Korean state in the late 7th century (688). Following the collapse of Silla in the 9th century, Korea was unified under the Koryo (Goryeo; 918-1392) and the Chosen (Joseon; 1392-1910) dynasties.

Korea became the object of intense imperialistic rivalry between the Chinese (its traditional benefactor), Japanese, and Russian empires in the latter half of the 19th and early 20th centuries. Following the Sino-Japanese War (1894-95) and the Russo-Japanese War (1904-1905), Korea was occupied by Imperial Japan. In 1910, Tokyo formally annexed the entire Peninsula. Korea regained its independence following Japan's surrender to the US and its allies in 1945. After World War II, a democratic government (Republic of Korea, ROK) was set up in the southern half of the Korean Peninsula while a communist-style government was installed in the north (North Korea; aka Democratic People's Republic of Korea, DPRK). During the Korean War (1950-53), US troops and UN forces fought alongside ROK soldiers to defend South Korea from a North Korean invasion supported by communist China and the Soviet Union. A 1953 armistice split the Peninsula along a

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North Korean invasion supported by Communist China and the Soviet Union. A 1953 armistice split the Peninsula along a demilitarized zone at about the 38th parallel. PARK Chung-hee took over leadership of the country in a 1961 coup. During his regime from 1961 to 1979, South Korea achieved rapid economic growth, with per capita income rising to roughly 17 times the level of North Korea in 1979.

PARK was assassinated in 1979, and subsequent years were marked by political turmoil and continued authoritarian rule as the country's pro-democracy movement grew. South Korea held its first free presidential election under a revised democratic constitution in 1987, with former South Korean Army general ROH Tae-woo winning a close race. In 1993, KIM Young-sam (1993-98) became the first civilian president of South Korea's new democratic era. President KIM Dae-jung (1998-2003) won the Nobel Peace Prize in 2000 for his contributions to South Korean democracy and his "Sunshine Policy" of engagement with North Korea. President PARK Geun-hye, daughter of former South Korean President PARK Chung-hee, took office in February 2013 as South Korea's first female leader. In December 2016, the National Assembly passed an impeachment motion against President PARK over her alleged involvement in a corruption and influence-peddling scandal, immediately suspending her presidential authorities. The impeachment was upheld in March 2017, triggering an early presidential election in May 2017 won by MOON Jae-in.

South Korea hosted the Winter Olympic and Paralympic Games in February 2018, in which North Korea also participated. Discord with North Korea has permeated inter-Korean relations for much of the past decade, highlighted by North Korea's attacks on a South Korean ship and island in 2010, the exchange of artillery fire across the DMZ in 2015, and multiple nuclear and missile tests in 2016 and 2017. North Korea's participation in the Winter Olympics disrupted a

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Tip

Visit the Definitions and Notes page to view a description of each topic.

Definitions and Notes



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Geography

Location

Eastern Asia, southern half of the Korean Peninsula bordering the Sea of Japan and the Yellow Sea

Geographic coordinates

37 00 N, 127 30 E

Map references

Asia

Area

total: 99,720 sq km

land: 96,920 sq km

water: 2,800 sq km

[country comparison to the world: 109](#)



SINCE 1828

GAMES & QUIZZES

THESAURUS

WORD OF THE DAY

FEATURES

SHOP

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US

X

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Dictionary

Thesaurus

US pronoun

Save Word

\ 'əs \

Definition of *us* (Entry 1 of 2)

objective case of *WE*

US abbreviation

variants: or **U.S.**

Definition of *US* (Entry 2 of 2)

United States

WORD OF THE DAY

abrogate

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Korea Investment & Securities, a leader in the Korean Securities and asset management industry

Korea Investment & Securities(KIS) is one of the leading securities companies in Korea with a comprehensive range of asset management and investment banking services including securities brokerage for domestic and international investors, underwriting IPOs, derivatives, real estate, fund management, and financial advisory services. Based on its strength in Korea and excellent reputation with foreign investors, KIS is rapidly expanding its activities into other Asian markets.



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OTC
Derivatives



Project &
Structured Finance

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Corporate Profile



CEO Message



History



Sustainability Report

Domestic

| | | | |
|----------|----------|---|-------|
| KOSPI | 2,009.13 | ▲ | 46.47 |
| KOSPI200 | 282.85 | ▲ | 18.41 |
| KOSDAQ | 631.15 | ▼ | 72.39 |
| FUT0012 | 268.00 | ▲ | 2.55 |

Overseas

| | | | |
|--------|-----------|---|-------|
| DOW | 26,797.46 | ▲ | 69.31 |
| NASDAQ | 8,103.07 | ▼ | 13.75 |
| S&P500 | 2,978.71 | ▲ | 2.71 |
| NIKKEI | 21,294.83 | ▲ | 95.26 |

Global Network >



Key Fact Summary >



truefriend Korea Investment & Securities Co., Ltd.

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| |
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| Indonesia KISI Asset Management |
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| New York Korea Investment & Securities America Ltd. |
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Securities

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Security

A document; historically, a physical [certificate](#) but increasingly electronic, showing that one owns a portion of a [publicly-traded company](#) or is owed a portion of a debt issue. Securities are [tradable](#). At their most basic, securities refer to [stocks](#) and [bonds](#), but the term sometimes also refers to [derivatives](#) such as [futures](#) and [options](#).

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securities see [FINANCIAL SECURITY](#).

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Securities

In general, any evidence of

an interest in corporate stock or stock rights or

an interest in any note, bond, debenture or other evidence of indebtedness issued by a government or corporation.

For certain tax purposes, however, the definition is more limited.

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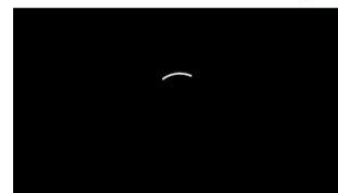
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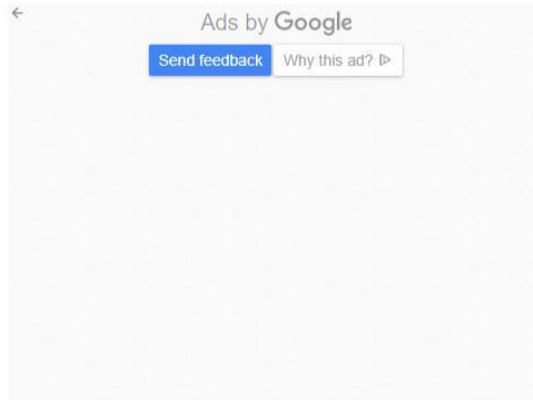
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References in periodicals archive

Hybrid **securities** have been around for decades and play an important role in Insurers' investments.
Hybrid insecurities: the actions of an agency under the National Association of Insurance Commissioners caused financial repercussions in a corner of the investment market. While regulators have offered a short-term solution, industry leaders are calling for additional changes

While plaintiffs' lawyers couldn't accuse corporations of violating federal **securities** laws (those claims may be made in federal courts only), they could accuse corporations of common law fraud or violating state (as opposed to federal) **securities** laws.
High court gives clarity to litigation venues: in a key decision issued earlier this year, the Supreme Court has restricted the ability of plaintiffs' attorneys to shop for accommodating state venues for class action suits. Most must now be pursued in more predictable federal courts

However, the IRS stated that the shorter-term **securities** described in Rev. *Debt instruments in reorganizations*

*** This category also includes claims representing capital of a qualifying **securities** firm.

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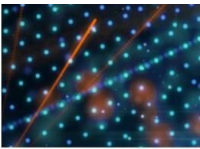
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Digitisation: The New Realm for Securities Services (2:38)

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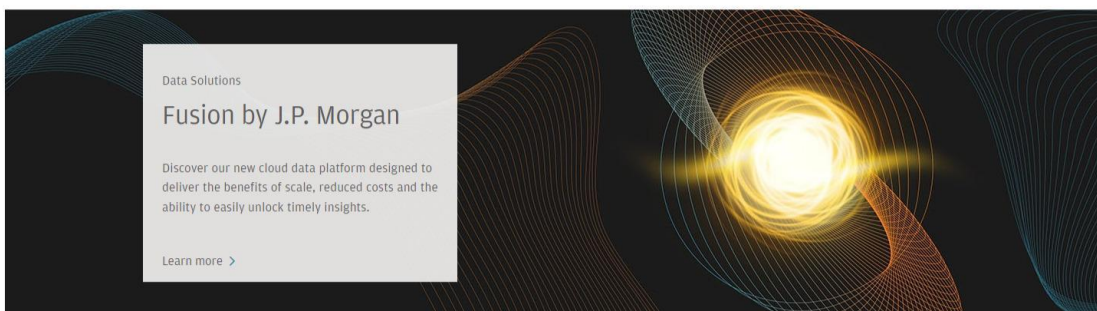
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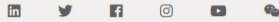
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USPTO OFFICIAL NOTICE

Office Action (Official Letter) has issued
on August 23, 2022 for
U.S. Trademark Application Serial No. 97120248

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| 1 | 97120248[sn] | 1 | 0 | 1 | 1 | 0:00 |
| 2 | *{"ckqx"}{v}r{"eyi"}*[bi,ti]not dead[lid] | 57369 | 0 | 0 | 0 | 0:15 |
| 3 | *nv{"Eayi"}{"scz"}tm{v0:2}nt*[bi,ti]not dead[lid] | 2150 | 0 | 0 | 0 | 0:00 |
| 4 | *{"scz"}{"Eayi"}{"ckqx"}{v}r{"eyi"}t*[bi,ti]not dead[lid] | 3397 | 0 | 0 | 0 | 0:01 |
| 5 | *us*[bi,ti]not dead[lid] | 186645 | 0 | 0 | 0 | 0:02 |
| 6 | *inc*[bi,ti]not dead[lid] | 34500 | 0 | 0 | 0 | 0:01 |
| 7 | 2 and 3 and 4 and 5 and 5 | 5 | 0 | 5 | 5 | 0:14 |
| 8 | 2 and 3 and 4 and 5 and 6 | 3 | 0 | 3 | 3 | 0:21 |
| 9 | 2 and (3 4 5 6) | 8346 | 0 | 0 | 0 | 0:14 |
| 10 | 3 and (4 5 6) | 214 | 0 | 36 | 36 | 0:09 |
| 11 | 4 and (5 6) | 354 | 0 | 43 | 43 | 0:04 |
| 12 | 5 and 6 | 4451 | 0 | 0 | 0 | 0:00 |
| 13 | *korea*[bi,ti]not dead[lid] | 784 | 0 | 0 | 0 | 0:01 |
| 14 | 13 and (3 4 5 6) | 135 | 0 | 135 | 135 | 0:02 |
| 15 | 13 and "036"[cc] | 407 | 0 | 90 | 90 | 0:01 |
| 16 | "us"[bi,ti]not dead[lid] | 6058 | 0 | 0 | 0 | 0:03 |
| 17 | 16 and (3 4) | 25 | 0 | 25 | 25 | 0:02 |
| 18 | 16 and 13 | 5 | 0 | 5 | 5 | 0:00 |

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