**To:** Bub-Joo S. Lee(bjslee@lacwkrr.com)

Subject: U.S. Trademark Application Serial No. 97120213 - TRUE FRIEND KOREA

INVESTMENT & SECURITIES US, INC. - CMID 9262

**Sent:** August 23, 2022 09:56:58 PM EDT

**Sent As:** tmng.notices@uspto.gov

### **Attachments**

screencapture-financial-dictionary-thefreedictionary-com-Securities-16613035742311 screencapture-www-jpmorgan-com-solutions-cib-securities-services-16613044310731 screencapture-www-northerntrust-com-united-states-what-we-do-asset-servicing-securities-services-16613043502411

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Merriam-Webster US.png

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screencapture-www-truefriend-com-eng-company-network01-shtm-16612991135391

# United States Patent and Trademark Office (USPTO) Office Action (Official Letter) About Applicant's Trademark Application

# U.S. Application Serial No. 97120213

Mark: TRUE FRIEND KOREA INVESTMENT & SECURITIES US, INC.

# **Correspondence Address:**

BUB-JOO S. LEE LEE ANAV CHUNG WHITE KIM RUGER & RICHTER LLP 10TH FLOOR 520 S. GRAND AVENUE, SUITE 1070 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 <u>six months</u> of the issue date below or the application will be <u>abandoned</u>. 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

- Disclaimer Requirement
- Mark Description Requirement

# DISCLAIMER REQUIREMENT

Applicant must disclaim the wording "KOREA INVESTMENT & SECURITIES US. INC." because it is merely descriptive and primarily geographically descriptive of applicant's services.

The wording "INVESTMENT & SECURITIES" merely describes an ingredient, quality, characteristic, function, feature, purpose, or use of applicant's services. *See* 15 U.S.C. §1052(e)(1); *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 1251, 103 USPQ2d 1753, 1755 (Fed. Cir. 2012). Specifically, this wording names applicant's services and a featured type of INVESTMENT service provided.

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 (bonds)." See https://financialequity (stocks) debt obligations or dictionary.thefreedictionary.com/Securities. Investment services providers commonly provide services encompassing e.g., https://www.jpmorgan.com/solutions/cib/securitiessecurities. See services, https://www.northerntrust.com/united-states/what-we-do/asset-servicing/securities-services. Thus, the wording INVESTMENT and SECURITIES merely names applicant's services and describes a feature of the services.

In addition, the wording "KOREA" and "US" is primarily geographically descriptive of the origin of applicant's services. *See* 15 U.S.C. §1052(e)(2); *In re Societe Generale des Eaux Minerales de Vittel S.A.*, 824 F.2d 957, 959, 3 USPQ2d 1450, 1451-52 (Fed. Cir. 1987); TMEP §§1210.01(a), 1210.06(a), 1213.03(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 Unites States. *See* https://www.merriam-webster.com/dictionary/us. Thus, the primary significance of these terms in the mark is as geographic locations.

Further, 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, this wording must be disclaimed.

Applicant may respond to this issue by submitting a disclaimer in the following format:

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

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

# MARK DESCRIPTION REQUIREMENT

Applicant submitted a color drawing with a color claim listing the colors in the mark; however, applicant did not provide a complete description specifying where each color appears in the literal and design elements in the mark. See 37 C.F.R. §§2.37, 2.52(b)(1); TMEP §807.07(a)-(a)(ii). Therefore, applicant must provide a corrected mark description identifying all the colors in the mark and where they appear. See TMEP §807.07(a)(ii).

Generic color names must be used to describe the colors in the mark, e.g., red, yellow, blue. TMEP \$807.07(a)(i)-(ii). If black, white, and/or gray represent background, outlining, shading, and/or transparent areas and are not part of the mark, applicant must so specify in the description. *See* TMEP \$807.07(d).

Further, applicant merely indicates that the letter "F" in the word "FRIEND" is stylized. Applicant does not provide a more detailed description of the design element making up the letter or where color appears in this element.

The following description is suggested, if accurate:

The mark consists of the wording "TRUE FRIEND" in brown with a {Specify, e.g., Korean character} making up the letter "F" in brown with one stroke that is pastel blue, and the wording "KOREA INVESTMENT" in black positioned above wording "& SECURITIES US, INC." in black.

## 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/ Trademark Examining Attorney Law Office 116 (571) 270-5577 rebecca.eubank@uspto.gov

# RESPONSE GUIDANCE

- Missing the response deadline to this letter will cause the application to <u>abandon</u>. The response must be received by the USPTO before midnight **Eastern Time** of the last day of the response period. TEAS maintenance or <u>unforeseen circumstances</u> 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.

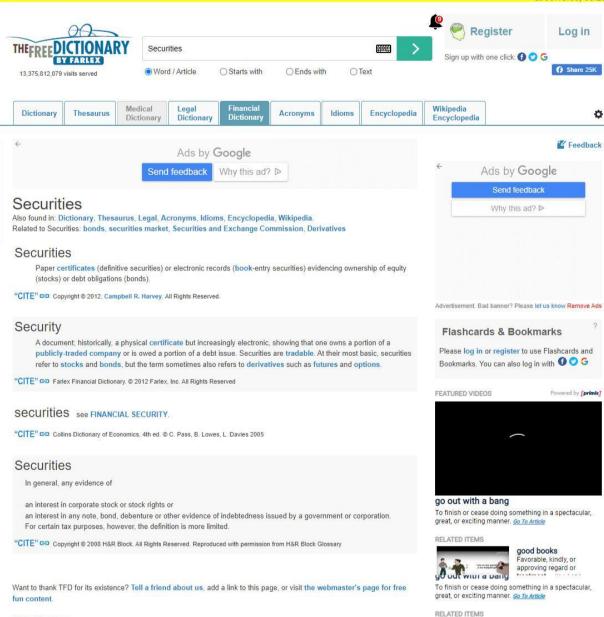
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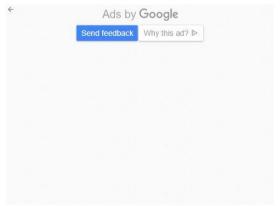
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**good going**An informal expression of praise for having done something... Watch Video



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Hybrid securities have been around for decades and play an important role in Insurers' investments.

Hubrid 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.

Financial browser

secured creditor
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secured lease obligation bond
secured liability
Secured loan
Secured Note
Securities
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Securities Act of 1933
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Full browser

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ABC Sécurité, Maintenance Installation et Protection Incendie

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Securities

Securities & Exchange Commission

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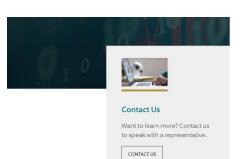
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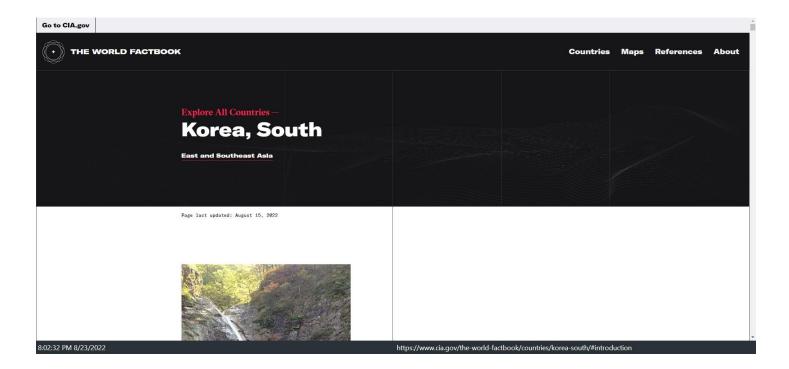
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# Introduction

# **Background**

The first recorded kingdom (Choson) on the Korean Peninsula dates from approximately 2300 B.C. Over the subsequent centuries, three main kingdoms – Kogoryo, Paekche, and Silla – were established on the Peninsula. By the 5th century A.D., Kogoryo emerged as the most powerful, with control over much of the Peninsula, as well as part of Manchuria (modernday 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 20<sup>th</sup> 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 communistratyle 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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Military and Security
Transnational Issues

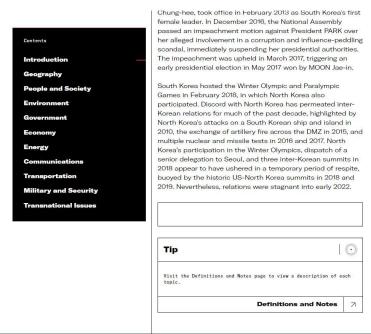
Soviet Union. A 1953 armistice split the Peninsula along a demillitarized zone at about the 38th parallel. PARK Chung-hee took over leadership of the country in a 1961 coup. During his regime from 1961 to 1979, South Korea achieved rapid economic growth, with per capita income rising to roughly 17 times 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 arrillery fire across the DMZ in 2016, and multiple nuclear and missile tests in 2016 and 2017. North

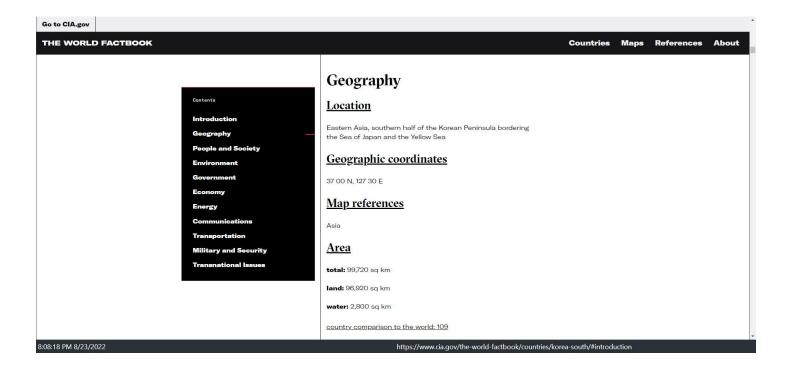
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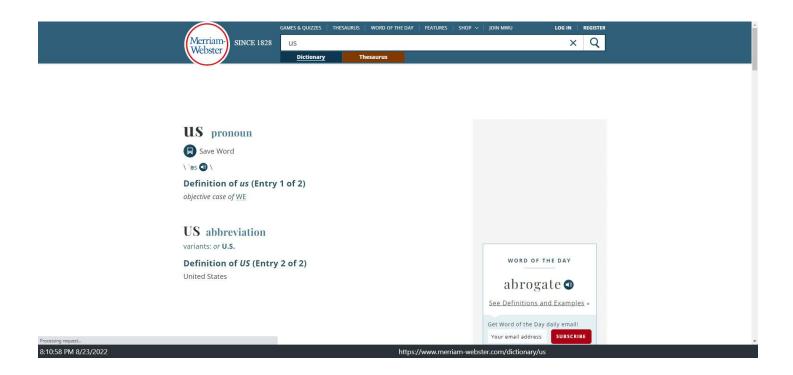
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Peter Key

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Address. 30 Crown Place, 10th Floor, London, EC2A 4EB, UK

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# **United States Patent and Trademark Office (USPTO)**

# USPTO OFFICIAL NOTICE

Office Action (Official Letter) has issued on August 23, 2022 for U.S. Trademark Application Serial No. 97120213

A USPTO examining attorney has reviewed your trademark application and issued an Office action. You must respond to this Office action in order to avoid your application abandoning. Follow the steps below.

- (1) Read the Office action. This email is NOT the Office action.
- (2) **Respond to the Office action by the deadline** using the Trademark Electronic Application System (TEAS). Your response must be received by the USPTO on or before 11:59 p.m. **Eastern Time** of the last day of the response period. Otherwise, your application will be <u>abandoned</u>. See the Office action itself regarding how to respond.
- (3) **Direct general questions** about using USPTO electronic forms, the USPTO <u>website</u>, the application process, the status of your application, and whether there are outstanding deadlines to the <u>Trademark Assistance Center (TAC)</u>.

After reading the Office action, address any question(s) regarding the specific content to the USPTO examining attorney identified in the Office action.

# GENERAL GUIDANCE

- <u>Check the status</u> of your application periodically in the <u>Trademark Status & Document Retrieval (TSDR)</u> database to avoid missing critical deadlines.
- <u>Update your correspondence email address</u> to ensure you receive important USPTO notices about your application.
- Beware of trademark-related scams. Protect yourself from people and companies that may try to take financial advantage of you. Private companies may call you and pretend to be the USPTO or may send you communications that resemble official USPTO documents to trick you. We will never request your credit card number or social security number over the phone. And all official USPTO correspondence will only be emailed from the domain "@uspto.gov." Verify the correspondence originated from us by using your Serial Number in our database, TSDR, to confirm that it appears under the "Documents" tab, or contact the Trademark Assistance Center.

• Hiring a U.S.-licensed attorney. If you do not have an attorney and are not required to have one under the trademark rules, we encourage you to hire a U.S.-licensed attorney specializing in trademark law to help guide you through the registration process. The USPTO examining attorney is not your attorney and cannot give you legal advice, but rather works for and represents the USPTO in trademark matters.

User: Rebecca Eubank

Statistics for Case 97120213								
#	Search	Total Marks	Dead Marks	Live Viewed Docs	Live Viewed Images	Status/Search Duration		
1	97120213[sn]	1	0	1	1	0:00		
2	*tru*[bi,ti]not dead[ld]	27950	0	0	0	0:01		
3	*{"fph"}r{"eyi"}nd*[bi,ti]not dead[ld]	125	0	0	0	0:01		
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6	2 and 5	45	0	45	45	0:01		
7	*true*[bi,ti]not dead[ld]	7632	0	0	0	0:01		
8	7 and "036"[cc]	2905	0	0	0	0:00		
9	7 and (a b "200" "036" "35" "042")[ic]	1055	0	0	0	0:01		
10	7 and (a b "200" "036" "035" "042")[ic]	1658	0	0	0	0:01		
11	7 and (a b "200" "036")[ic]	439	0	32	32	0:01		
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13	7 and (a b "200" "042")[ic]	687	0	0	0	0:01		
14	*friend*[bi,ti]not dead[ld]	5043	0	0	0	0:01		
15	14 and "036"[cc]	2636	0	0	0	0:01		
16	14 and (a b "200" "036")[ic]	374	0	40	40	0:02		
17	14 and (a b "200" "035")[ic]	807	0	0	0	0:01		
18	14 and (a b "200" "042")[ic]	337	0	33	33	0:02		
19	7 and 14	20	0	20	20	0:00		
20	*korea*[bi,ti]not dead[ld]	784	0	0	0	0:01		
21	*investment'*[bi,ti]not dead[ld]	2148	0	0	0	0:01		
22	*investment*[bi,ti]not dead[ld]	2148	0	0	0	0:01		
23	*securit*[bi,ti]not dead[ld]	3361	0	0	0	0:01		
24	*us*[bi,ti]not dead[ld]	186645	0	0	0	0:01		
25	*inc*[bi,ti]not dead[ld]	34500	0	0	0	0:01		
26	(7 14) and (20 22 23 24 25)	876	0	0	0	0:01		
27	(7 14) and (20 22 23)	23	0	23	23	0:01		
28	(7 14) and 24	781	0	0	0	0:01		
29	(7 14) and 25	99	0	99	99	0:01		
30	(7 14) and "us"[bi,ti]not dead[ld]	21	0	21	21	0:01		

Session started 08/23/2022 9:59 am
Session ended 08/23/2022 10:14 am
Total search duration 27.00
Session duration 15 minutes 11 seconds

Adjacency Level 1 Near Level 1 User: Rebecca Eubank

Statistics for Case 97120213									
#	Search	Total Marks	Dead Marks	Live Viewed Docs	Live Viewed Images	Status/Search Duration			
1	97120248[sn]	1	0	1	1	0:00			
2	*{"ckqx"}{v}r{"eyi"}*[bi,ti]not dead[ld]	57369	0	0	0	0:15			
3	*nv{"Eayi"}{"scz"}tm{v0:2}nt*[bi,ti]not dea d[ld]	2150	0	0	0	0:00			
4	${*\{"scz"\}\{"Eayi"\}\{"ckqx"\}\{v\}r\{"eyi"\}t*[bi,ti]n}$ ot dead[ld]	3397	0	0	0	0:01			
5	*us*[bi,ti]not dead[ld]	186645	0	0	0	0:02			
6	*inc*[bi,ti]not dead[ld]	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[ld]	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[ld]	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			

Session started 08/23/2022 9:46 am
Session ended 08/23/2022 9:58 am
Total search duration 90.00
Session duration 12 minutes 28 seconds
Adjacency Level 1
Near Level 1