

Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	79149204
LAW OFFICE ASSIGNED	LAW OFFICE 108
MARK SECTION	
MARK	http://tmng-al.uspto.gov/resting2/api/img/79149204/large
LITERAL ELEMENT	EXPLORER
STANDARD CHARACTERS	YES
USPTO-GENERATED IMAGE	YES
MARK STATEMENT	The mark consists of standard characters, without claim to any particular font style, size or color.
ARGUMENT(S)	
Please see the actual argument text attached within the Evidence section.	
EVIDENCE SECTION	
EVIDENCE FILE NAME(S)	
ORIGINAL PDF FILE	evi_637653-20150904103502449504_.response.pdf
CONVERTED PDF FILE(S) (5 pages)	\\TICRS\EXPORT16\IMAGEOUT16\791\492\79149204\xml12\RFR0002.JPG
	\\TICRS\EXPORT16\IMAGEOUT16\791\492\79149204\xml12\RFR0003.JPG
	\\TICRS\EXPORT16\IMAGEOUT16\791\492\79149204\xml12\RFR0004.JPG
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	\\TICRS\EXPORT16\IMAGEOUT16\791\492\79149204\xml12\RFR0006.JPG
DESCRIPTION OF EVIDENCE FILE	full argument that support the registrability of the mark
GOODS AND/OR SERVICES SECTION (009)(current)	

INTERNATIONAL CLASS	009
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DESCRIPTION

Computer hardware, excluding hardware for playing bingo and other wagering games and excluding hardware featuring travel guides and tour information; computer software for communications devices and personal electronic devices, to enable wi-fi connectivity, and television and radio connections; computer firmware for communications devices and personal electronic devices; computer processors, including central processing units, communications processors, data processors and radio processing units; integrated circuits; instruction set architectures and processor architecture, namely, microprocessors; integrated circuit chips; computer chip sets; microprocessors; data processors; central processing units; digital signal processing apparatus and equipment, namely, radio processing units (RPU) in the nature of semi-conductor chips for enabling network connectivity and television and radio reception, and digital signal processors; application specific integrated circuits; speech synthesis apparatus and equipment, namely, computer hardware for speech synthesis and speech synthesis software; downloadable computer operating software for use with programmable computer hardware; data processors for use in wireless communication devices for voice, data, or image transmission; computer operating programs for use in electronic devices; operating system programs for use in electronic devices; microchips for electronic devices; parts and fittings of all the aforesaid goods, namely, radio processing units (RPU) in the nature of semi-conductor chips for enabling network connectivity and television and radio reception, and digital signal processors

GOODS AND/OR SERVICES SECTION (009)(proposed)

INTERNATIONAL CLASS	009
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TRACKED TEXT DESCRIPTION

~~Computer hardware, excluding hardware for playing bingo and other wagering games and excluding hardware featuring travel guides and tour information;~~ Computer hardware for communications and personal electronics devices, to enable wireless network connectivity, and television and radio connections; ~~computer software for communications devices and personal electronic devices, to enable wi-fi connectivity, and television and radio connections;~~ computer software for communications devices and personal electronic devices, to enable wireless network connectivity, and television and radio connections; ~~computer firmware for communications devices and personal electronic devices;~~ computer firmware for operating communications devices and personal electronic devices; computer processors, including central processing units, communications processors, data processors and radio processing units; integrated circuits; instruction set architectures and processor architecture, namely, microprocessors; integrated circuit chips; computer chip sets; microprocessors; data processors; central processing units; digital signal processing apparatus and equipment, namely, radio processing units (RPU) in the nature of semi-conductor chips for enabling network connectivity and television and radio reception, and digital signal processors; application specific integrated circuits; speech synthesis apparatus and equipment, namely, computer hardware for speech synthesis and speech synthesis software; downloadable computer operating software for use with programmable computer hardware; data processors for use in wireless communication devices for voice, data, or image transmission; computer operating programs for use in electronic devices; operating system programs for use in electronic devices; microchips for electronic devices; parts and fittings of all the aforesaid goods, namely, radio processing units (RPU) in the nature of semi-conductor chips for enabling network connectivity and television and radio reception, and digital signal processors; all of the foregoing being for use by semiconductor manufacturers, network operators and original equipment manufactures, and

[original design manufacturers](#)

FINAL DESCRIPTION

Computer hardware for communications and personal electronics devices, to enable wireless network connectivity, and television and radio connections; computer software for communications devices and personal electronic devices, to enable wireless network connectivity, and television and radio connections; computer firmware for operating communications devices and personal electronic devices; computer processors, including central processing units, communications processors, data processors and radio processing units; integrated circuits; instruction set architectures and processor architecture, namely, microprocessors; integrated circuit chips; computer chip sets; microprocessors; data processors; central processing units; digital signal processing apparatus and equipment, namely, radio processing units (RPU) in the nature of semi-conductor chips for enabling network connectivity and television and radio reception, and digital signal processors; application specific integrated circuits; speech synthesis apparatus and equipment, namely, computer hardware for speech synthesis and speech synthesis software; downloadable computer operating software for use with programmable computer hardware; data processors for use in wireless communication devices for voice, data, or image transmission; computer operating programs for use in electronic devices; operating system programs for use in electronic devices; microchips for electronic devices; parts and fittings of all the aforesaid goods, namely, radio processing units (RPU) in the nature of semi-conductor chips for enabling network connectivity and television and radio reception, and digital signal processors; all of the foregoing being for use by semiconductor manufacturers, network operators and original equipment manufactures, and original design manufacturers

GOODS AND/OR SERVICES SECTION (042)(no change)

SIGNATURE SECTION

RESPONSE SIGNATURE	/Arkadia Olson/
SIGNATORY'S NAME	Arkadia DeLay Olson
SIGNATORY'S POSITION	Attorney of record, Missouri bar member
SIGNATORY'S PHONE NUMBER	314.345.6215
DATE SIGNED	09/04/2015
AUTHORIZED SIGNATORY	YES
CONCURRENT APPEAL NOTICE FILED	YES

FILING INFORMATION SECTION

SUBMIT DATE	Fri Sep 04 16:55:26 EDT 2015
TEAS STAMP	USPTO/RFR-63.76.5.3-20150 904165526528043-79149204- 540de2ad0397ce6e443bb94b3 88698884cdc7816ba3b9f5fc5 9e79203b75d814db-N/A-N/A-

Request for Reconsideration after Final Action To the Commissioner for Trademarks:

Application serial no. **79149204** EXPLORER(Standard Characters, see <http://tmng-al.uspto.gov/resting2/api/img/79149204/large>) has been amended as follows:

ARGUMENT(S)

In response to the substantive refusal(s), please note the following:

Please see the actual argument text attached within the Evidence section.

EVIDENCE

Evidence in the nature of full argument that support the registrability of the mark has been attached.

Original PDF file:

[evi_637653-20150904103502449504_response.pdf](#)

Converted PDF file(s) (5 pages)

[Evidence-1](#)

[Evidence-2](#)

[Evidence-3](#)

[Evidence-4](#)

[Evidence-5](#)

CLASSIFICATION AND LISTING OF GOODS/SERVICES

Applicant proposes to amend the following class of goods/services in the application:

Current: Class 009 for Computer hardware, excluding hardware for playing bingo and other wagering games and excluding hardware featuring travel guides and tour information; computer software for communications devices and personal electronic devices, to enable wi-fi connectivity, and television and radio connections; computer firmware for communications devices and personal electronic devices; computer processors, including central processing units, communications processors, data processors and radio processing units; integrated circuits; instruction set architectures and processor architecture, namely, microprocessors; integrated circuit chips; computer chip sets; microprocessors; data processors; central processing units; digital signal processing apparatus and equipment, namely, radio processing units (RPU) in the nature of semi-conductor chips for enabling network connectivity and television and radio reception, and digital signal processors; application specific integrated circuits; speech synthesis apparatus and equipment, namely, computer hardware for speech synthesis and speech synthesis software; downloadable computer operating software for use with programmable computer hardware; data processors for use in wireless communication devices for voice, data, or image transmission; computer operating programs for use in electronic devices; operating system programs for use in electronic devices; microchips for electronic devices; parts and fittings of all the aforesaid goods, namely, radio processing units (RPU) in the nature of semi-conductor chips for enabling network connectivity and television and

radio reception, and digital signal processors

Original Filing Basis:

Filing Basis Section 66(a) , Request for Extension of Protection to the United States. Section 66(a) of the Trademark Act, 15 U.S.C. §1141f.

Proposed:

Tracked Text Description: ~~Computer hardware, excluding hardware for playing bingo and other wagering games and excluding hardware featuring travel guides and tour information;~~ Computer hardware for communications and personal electronics devices, to enable wireless network connectivity, and television and radio connections; ~~computer software for communications devices and personal electronic devices, to enable wi-fi connectivity, and television and radio connections;~~ computer software for communications devices and personal electronic devices, to enable wireless network connectivity, and television and radio connections; ~~computer firmware for communications devices and personal electronic devices;~~ computer firmware for operating communications devices and personal electronic devices;

computer processors, including central processing units, communications processors, data processors and radio processing units; integrated circuits; instruction set architectures and processor architecture, namely, microprocessors; integrated circuit chips; computer chip sets; microprocessors; data processors; central processing units; digital signal processing apparatus and equipment, namely, radio processing units (RPU) in the nature of semi-conductor chips for enabling network connectivity and television and radio reception, and digital signal processors; application specific integrated circuits; speech synthesis apparatus and equipment, namely, computer hardware for speech synthesis and speech synthesis software; downloadable computer operating software for use with programmable computer hardware; data processors for use in wireless communication devices for voice, data, or image transmission; computer operating programs for use in electronic devices; operating system programs for use in electronic devices; microchips for electronic devices; parts and fittings of all the aforesaid goods, namely, radio processing units (RPU) in the nature of semi-conductor chips for enabling network connectivity and television and radio reception, and digital signal processors; all of the foregoing being for use by semiconductor manufacturers, network operators and original equipment manufactures, and original design manufacturers

Class 009 for Computer hardware for communications and personal electronics devices, to enable wireless network connectivity, and television and radio connections; computer software for communications devices and personal electronic devices, to enable wireless network connectivity, and television and radio connections; computer firmware for operating communications devices and personal electronic devices; computer processors, including central processing units, communications processors, data processors and radio processing units; integrated circuits; instruction set architectures and processor architecture, namely, microprocessors; integrated circuit chips; computer chip sets; microprocessors; data processors; central processing units; digital signal processing apparatus and equipment, namely, radio processing units (RPU) in the nature of semi-conductor chips for enabling network connectivity and television and radio reception, and digital signal processors; application specific integrated circuits; speech synthesis apparatus and equipment, namely, computer hardware for speech synthesis and speech synthesis software; downloadable computer operating software for use with programmable computer hardware; data processors for use in wireless communication devices for voice, data, or image transmission; computer operating programs for use in electronic devices; operating system programs for use in electronic devices; microchips for electronic devices; parts and fittings of all the aforesaid goods, namely, radio processing units (RPU) in the nature of semi-conductor chips for enabling network connectivity and television and radio reception, and digital signal processors; all of the foregoing being for use by semiconductor manufacturers, network operators and original equipment manufactures, and original design manufacturers

Filing Basis Section 66(a) , Request for Extension of Protection to the United States. Section 66(a) of the

Trademark Act, 15 U.S.C. §1141f.

SIGNATURE(S)

Request for Reconsideration Signature

Signature: /Arkadia Olson/ Date: 09/04/2015

Signatory's Name: Arkadia DeLay Olson

Signatory's Position: Attorney of record, Missouri bar member

Signatory's Phone Number: 314.345.6215

The signatory has confirmed that he/she is an attorney who is a member in good standing of the bar of the highest court of a U.S. state, which includes the District of Columbia, Puerto Rico, and other federal territories and possessions; and he/she is currently the owner's/holder's attorney or an associate thereof; and to the best of his/her knowledge, if prior to his/her appointment another U.S. attorney or a Canadian attorney/agent not currently associated with his/her company/firm previously represented the owner/holder in this matter: (1) the owner/holder has filed or is concurrently filing a signed revocation of or substitute power of attorney with the USPTO; (2) the USPTO has granted the request of the prior representative to withdraw; (3) the owner/holder has filed a power of attorney appointing him/her in this matter; or (4) the owner's/holder's appointed U.S. attorney or Canadian attorney/agent has filed a power of attorney appointing him/her as an associate attorney in this matter.

The applicant is filing a Notice of Appeal in conjunction with this Request for Reconsideration.

Serial Number: 79149204

Internet Transmission Date: Fri Sep 04 16:55:26 EDT 2015

TEAS Stamp: USPTO/RFR-63.76.5.3-20150904165526528043

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884cdc7816ba3b9f5fc59e79203b75d814db-N/A

-N/A-20150904103502449504

RESPONSE TO OFFICE ACTION FOR 79149204 - EXPLORER

The Examining Attorney has maintained refusal of registration of Applicant’s mark EXPLORER due to likely confusion with respect to the three registrations listed below (the “Cited Marks”). For the reasons set forth in its prior response and below, and due to the further significant limitations to its Class 9 goods listing, as reflected in this response, Applicant submits that its mark is not likely to lead to consumer confusion with respect to the Cited Marks, and accordingly respectfully requests that its application be approved for publication.

Specifically, Applicant notes that the very specific nature of its goods, as illustrated by its further amendment herein, and coupled with its prior arguments, illustrates that no confusion is likely due to the Cited Marks, due the completely different nature of the respective products, and the sophisticated consumers for the various marks. *See M2 Software Inc. v. M2 Communications Inc.*, 450 F3d 1378 (Fed. Cir. 2006) (“The fact that both parties provide computer programs does not establish a relationship between the goods or services, such that consumers would believe that all computer software programs emanate from the same source simply because they are sold under similar marks.”), citing *Electronic Design & Sales, Inc. v. Electronic Data Systems Corp.*, at 1463. See also *Real Networks Inc. v. QSA Toolworks LLC*, 91 USPQ2d 1720 (W.D. Wash. 2009) (“When fundamental functionality [of streaming media software on the one hand and database management software on the other hand] is distinct, the case law supports a finding of ‘no confusion’”, and finding no confusion between identical marks); *In re Stimulation Techniques, Inc.*, Ser. No. 75/271,392 (TTAB 2002) (overruling Examiner’s refusal to register mark SIMTEST for software for lab testing due to prior registration for CIMTEST for software for testing automotive equipment, based largely on sophistication of respective purchasers, each buying a specialized testing software product for very different purposes).

In the case at hand, the Class 9 goods associated with Applicant’s mark and the remaining Cited Marks are as follows (Applicant has not copied below its Class 42 services, so those services are not at issue):

Applicant’s Mark:

Mark	Goods/Services (as amended)
EXPLORER	<p>Class 9</p> <p>Computer hardware <u>for communications and personal electronics devices, to enable wireless network connectivity, and television and radio connections;</u> computer software for communications devices and personal electronic devices, to enable <i>wireless network</i> connectivity, and television and radio connections; computer firmware <i>for operating</i> communications devices and personal electronic devices; computer processors, including central processing units, communications processors, data processors and radio processing units; integrated circuits; instruction set architectures and</p>

Mark	Goods/Services (as amended)
	<p>processor architecture, namely, microprocessors; integrated circuit chips; computer chip sets; microprocessors; data processors; central processing units; digital signal processing apparatus and equipment, namely, radio processing units (RPU) in the nature of semi-conductor chips for enabling network connectivity and television and radio reception, and digital signal processors; application specific integrated circuits; speech synthesis apparatus and equipment, namely, computer hardware for speech synthesis and speech synthesis software; downloadable computer operating software for use with programmable computer hardware; data processors for use in wireless communication devices for voice, data, or image transmission; computer operating programs for use in electronic devices; operating system programs for use in electronic devices; microchips for electronic devices; parts and fittings of all the aforesaid goods, namely, radio processing units (RPU) in the nature of semi-conductor chips for enabling network connectivity and television and radio reception, and digital signal processors; <u>all of the foregoing being for use by semiconductor manufacturers, network operators and original equipment manufactures, and original design manufacturers</u></p>

Cited Marks:

Citation No.	Mark	Goods/Services
1	<p>EXPLORER, under U.S. Registration No. 3151139, owned by Thrane & Thrane A/S</p>	<p>Class 9: Portable communication terminals with integrated antenna for high-speed communication via satellite, giving access to telephone and fax services, e-mail servers, large file transfers, Internet browsing, video-conferencing and streaming; communications servers via virtual private networks (VPN); accessories to the terminals, namely blue-tooth communication handsets devices and battery chargers for wireless voice and data, remote antennas and cables for longer-term set-up, pole-mount kits for practical deployment, low-voltage battery chargers for use from a vehicle,</p>

Citation No.	Mark	Goods/Services
		and batteries
2	EXPLORER under U.S. Registration No. 4166425, owned by FORTUNET, INC	Class 9: Hand-held computer devices, namely, computer hardware for playing bingo and other games for wagering purposes
3	X-PLOERER under U.S. Registration No. 4378976, owned by Antenna International, LLC	Class 9: Computer hardware and computer software featuring travel guides and tour information for museums, galleries, cruise ships, universities, tourist attractions, points of interest and other sites of cultural, educational, artistic, natural or historic interest; and hand-held computers with audio recording, receiving, and playing features used to contain travel guide and tour information for museums, galleries, cruise ships, universities, tourist attractions, points of interest, and other sites of cultural, educational, artistic, natural or historic interest

As further illustrated below, Applicant submits that the goods associated with the various Cited Marks, as compared to the goods under Applicant’s mark (as amended herein) are very different from one another and do not overlap, and would not be marketed to the same sorts of customer.

As argued previously, Applicant provides highly specialized, business-to-business software and hardware products for companies that design and market telecommunications products. Applicant does not sell or market any general telecommunications products at all, to consumers or otherwise, and instead markets and sells its components therefor to semiconductor manufacturers, network operators and original equipment manufacturers (OEMs) and original design manufacturers (ODMs). As such, Applicant’s client base is highly sophisticated, and also limited in scope.

Due to the specialized nature of Applicant’s goods and services, Applicant respectfully requests that the Examiner re-consider the refusal bases in the initial Office Action, and Applicant further provides the following additional information regarding each Cited Mark:

Cited Marks 2 and 3

Cited Mark 2 relates to hand-held computer devices for playing bingo and other games for wagering purposes, and Cited Mark 3 relates to hardware and software relating to travel and tour information.

Applicant has herein amended its hardware products such that it is now clear that there could be no overlap between Applicant's hardware and the hardware under Cited Marks 2 and 3. Not only does Applicant herein more specifically modify its description of its hardware, Applicant also herein has limited all of its Class 9 listing of goods to clarify that all are only marketed to semiconductor manufacturers, network operators and original equipment manufactures, and original design manufacturers. Given the specialized trade channels, Applicant respectfully requests that the Cited Marks 2 and 3 be withdrawn, especially since, as previously presented, the owner of the Cited Mark 2 itself argued to the Trademark Office that its own mark was distinctive from an earlier cited registration for EXPLORER covering "computer software, firmware and hardware," due to the specialized nature of gaming-related hardware goods under the Cited Mark 7 (stating: "Applicant's EXPLORER device is leased by the Applicant to bingo halls, casinos, and other gaming establishments, who in turn make the device available to bingo players for use at the bingo hall or gaming establishment. Applicant's EXPLORER device also may be used for 'other games for wagering purposes,' which would be played in casinos, which also are regulated by state gaming commissions"), and especially due to the third party coexisting marks.

Cited Mark 1

Cited Mark 1 relates to portable communication terminals and accessories to the terminals, which would be large, specialized, and expensive terminals for establishing connection to the Internet, and which are also very different from Applicant's generally small and highly specialized operating components for a specific type of consumer.

The Examiner has presented a link to a web page to support the position that the owner of Cited Mark 1 may also sell smaller firmware components; however, Applicant does not see "firmware" listed under the recitation of goods for Cited Mark 1. Moreover, the product shown at the link provided by the Office illustrates a product sold at a very high price point (over \$5,000), and a representative client listing, featuring several sophisticated business clients. As previously submitted, Applicant's products do not compete with, and are otherwise not compatible with, or marketed to, similar customers that would be purchasing goods under the Cited Mark 1.

The differences are further illustrated due to Applicant's inclusion of limiting wording to its Class 9 listing, which clarify the distinct and specialized customers to whom Applicant sells and markets. This is especially evident when considering the prior statements of the Cited Mark 1 owner itself, as pointed out in Applicant's prior response. *See* Office Action Response, Ser. No. 79/013047 (March 4, 2005). ("In short, the applicant's goods and services are inherently specialized, complex and expensive goods for sophisticated users, and not for the general public...[and] EXPLORER marks are both highly suggestive and laudatory and highly diluted....Many such marks are obviously coexisting on the register.")

Given the factors, and the fact that Applicant's goods and services are very different than the large and highly specialized terminals associated with Cited Mark 3, Applicant respectfully requests that the Cited Mark 3 be withdrawn as a bar to register Applicant's mark.