

Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	85463991
LAW OFFICE ASSIGNED	LAW OFFICE 106
MARK SECTION (no change)	
ARGUMENT(S)	
<p>Applicant hereby requests suspension of the instant application pending the disposition of the cancellation proceeding filed by Applicant with the Trademark Trial and Appeal Board of the United States Patent and Trademark Office. A copy of Applicant's Petition for Cancellation is attached. According to T.M.E.P. Section 716.02(a), "if the Examining Attorney refuses registration under §2(d) of the Trademark Act in view of the mark in a prior registration, the Applicant may file a petition to cancel the registration under 15 U.S.C. §1064 and, within a proper response period, inform the Examining Attorney that the petition to cancel has been filed. This will constitute a proper response to the §2(d) refusal The examining attorney will then suspend further action until the termination of the cancellation proceeding, if the application is otherwise in condition for approval or final refusal. "</p> <p>Applicant therefore respectfully requests that the Examining Attorney suspend the instant application since all other issues have been resolved and, if not for the 2(d) refusal, the application would be in condition for approval and publication.</p>	
EVIDENCE SECTION	
EVIDENCE FILE NAME(S)	
ORIGINAL PDF FILE	evi_71198214145-212723825_.Chromepfcancellation_20130219_15432701.pdf
CONVERTED PDF FILE(S) (8 pages)	\\TICRS\EXPORT16\IMAGEOUT16\854\639\85463991\xml5\RFR0002.JPG
	\\TICRS\EXPORT16\IMAGEOUT16\854\639\85463991\xml5\RFR0003.JPG
	\\TICRS\EXPORT16\IMAGEOUT16\854\639\85463991\xml5\RFR0004.JPG
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DESCRIPTION OF EVIDENCE FILE	a copy of Applicant's Petition for Cancellation filed today
SIGNATURE SECTION	
RESPONSE SIGNATURE	/anne h. peck/
SIGNATORY'S NAME	Anne H. Peck
SIGNATORY'S POSITION	Attorney of record, California bar member
SIGNATORY'S PHONE NUMBER	(650) 843-5096
DATE SIGNED	02/19/2013
AUTHORIZED SIGNATORY	YES
CONCURRENT APPEAL NOTICE FILED	YES
FILING INFORMATION SECTION	
SUBMIT DATE	Tue Feb 19 21:31:05 EST 2013
TEAS STAMP	USPTO/RFR-71.198.214.145-20130219213105037604-85463991-500db608a56487dae2b9db85f20f7fa91e9e4737211acfff987b0f55b2727f67f-N/A-N/A-20130219212723825342

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

Application serial no. **85463991** has been amended as follows:

ARGUMENT(S)

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

Applicant hereby requests suspension of the instant application pending the disposition of the cancellation proceeding filed by Applicant with the Trademark Trial and Appeal Board of the United States Patent and Trademark Office. A copy of Applicant's Petition for Cancellation is attached. According to T.M.E.P. Section 716.02(a), "if the Examining Attorney refuses registration under §2(d) of the Trademark Act in view of the mark in a prior registration, the Applicant may file a petition to cancel the registration under 15 U.S.C. §1064 and, within a proper response period, inform the Examining Attorney that the petition to cancel has been filed. This will constitute a proper response to the §2(d) refusal The examining attorney will then suspend further action until the termination of the cancellation proceeding, if the application is otherwise in condition for approval or final refusal. "

Applicant therefore respectfully requests that the Examining Attorney suspend the instant application since all other issues have been resolved and, if not for the 2(d) refusal, the application would be in condition for approval and publication.

EVIDENCE

Evidence in the nature of a copy of Applicant's Petition for Cancellation filed today has been attached.

Original PDF file:

[evi_71198214145-212723825_Chromepfcancellation_20130219_15432701.pdf](#)

Converted PDF file(s) (8 pages)

[Evidence-1](#)

[Evidence-2](#)

[Evidence-3](#)

[Evidence-4](#)

[Evidence-5](#)

[Evidence-6](#)

[Evidence-7](#)

[Evidence-8](#)

SIGNATURE(S)

Request for Reconsideration Signature

Signature: /anne h. peck/ Date: 02/19/2013

Signatory's Name: Anne H. Peck

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

Signatory's Phone Number: (650) 843-5096

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 applicant'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 applicant in this matter: (1) the applicant 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 applicant has filed a power of attorney appointing him/her in this matter; or (4) the applicant'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: 85463991

Internet Transmission Date: Tue Feb 19 21:31:05 EST 2013

TEAS Stamp: USPTO/RFR-71.198.214.145-201302192131050

37604-85463991-500db608a56487dae2b9db85f

20f7fa91e9e4737211acfff987b0f55b2727f67f

-N/A-N/A-20130219212723825342

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the matter of Registration No. 3,360,331
For the Trademark CHROME
Issued December 25, 2007

In the matter of Registration No. 3,951,287
For the Trademark CHROME
Issued April 26, 2011

GOOGLE INC.,)	
)	
Petitioner,)	
)	
v.)	Cancellation No.
)	
VIA TECHNOLOGIES, INC.,)	
)	
Registrant.)	
_____)	

CONSOLIDATED PETITION FOR CANCELLATION

Petitioner Google Inc. ("Google"), a Delaware corporation having its principal place of business at 1600 Amphitheatre Parkway, Mountain View, California 94043, believes that it is being and/or will be damaged by the continued registration in the United States Patent and Trademark Office ("USPTO") of the CHROME marks shown in Registration Nos. 3,360,331 and 3,951,287, owned by VIA Technologies, Inc. ("Registrant") and which registered on December 25, 2007 and April 26, 2011, respectively (the "Subject Registrations"). Google hereby petitions to cancel the Subject Registrations under Section 14 of the Trademark Act of 1947, 15 U.S.C. § 1064.

Pursuant to 37 C.F.R. § 2.112(b), Google files this Consolidated Petition against the Subject Registrations as both are both owned by Registrant, both consist solely of the mark CHROME, and both raise common issues of law and/or fact.

As grounds for this Petition, Google alleges that:

1. Google is a Delaware corporation having its principal place of business at 1600 Amphitheatre Parkway, Mountain View, California 94043.

2. On information and belief, Registrant is a Taiwanese corporation having its principal place of business at 8F, 533 Chung-Cheng Road, Hsin-Tien 231, Taiwan.

3. Google is the owner of the following U.S. trademark applications: Serial No. 85/462,997, filed on November 2, 2011, for the mark CHROME; Serial No. 85/463,547, filed on November 3, 2011, for the mark GOOGLE CHROME; Serial No. 85/463,562, filed on November 3, 2011, for the mark CHROMEBOOK; Serial No. 85/463,991, filed on November 3, 2011 for the mark CHROME and Design; and Serial No. 85/464,001, filed on November 3, 2011, for the mark CHROMEBOX (collectively, the "Google CHROME Applications").

4. On or about February 22, 2007, Registrant filed Application Serial No. 77/113,063 for CHROME covering certain goods in Class 9 based on its purported *bona fide* intent to use the mark in United States commerce for all goods listed in the application. On or about October 12, 2007, Registrant submitted a Statement of Use in support of Application Serial No. 77/113,063 declaring under oath that it "is using the mark in commerce on or in connection with the goods/services identified [in the application]...." Thereafter, on December 25, 2007, Application Serial No. 77/113,063 matured to registration as Registration No. 3,360,331.

5. Registration No. 3,360,331 covers the following Class 9 goods: "Computers, namely, personal computers, portable computers, handheld computers, notebook computers, microcomputers, desktop computers; computer system components, parts and fittings, namely, motherboards, central processing units (CPUs), base PC modules, computer housing, computer casing, computer chassis, computer frames, computer hardware, namely, semiconductors, microprocessors, graphics processors, integrated circuits, computer chips, computer motherboards, computer graphics boards, computer interface boards, computer accelerator board, circuit boards, computer memory cards, memory chips, blank magnetic data carriers,

hard drives, electronic computer locks, computer speakers, disc drives, computer peripherals, computer keyboards, computer printers, computer monitors, multimedia and digital displays, namely, CRT monitors, DVI displays, LCD panels, HDTV displays, GPS navigational displays and automotive visual displays, computer cables, disc and tape controller cards, input devices, namely, scanners, computer mice, joysticks, microphones; computer network adapters, networking switches, routers, modems, power adapters for computers; hand-held devices, namely, Personal Digital Assistants (PDAs), electronic personal organizers, MP3 players; software and hardware for management, storage, communications and network management of digital media and enhancement of graphical and video display; pre-recorded computer discs featuring documentary programs, drama, musical entertainment; portable computer carry bags; cases to carry CDs and DVDs; computer firmware, namely, computer utility software and other computer software used to maintain and operate computer system all stored in a computer's read only memory or elsewhere in the computer's circuitry, operating system software; BIOS software; printed and electronic instructional manuals, specification sheets, data sheets, computer reference manuals, user guides and documents providing instruction in the use and operation of various electronic digital devices, sold as a unit therewith the aforesaid goods."

6. On or about February 14, 2013, Registrant filed a combined Declaration of Use and Incontestability under Sections 8 and 15 deleting certain goods from Registration No. 3,360,331 and purporting to declare as to the remaining goods that "the mark has been continuously used in commerce for five (5) consecutive years after the date of registration, or the date of publication under Section 12(c), and is still in use in commerce on or in connection with these goods or services" ("Registrant's Section 8 and 15 Declaration").

7. On or about September 9, 2008, Registrant filed Application Serial No. 77/566,090 for CHROME covering certain services in Class 42 based on its purported *bona fide* intent to use the mark in United States commerce for all services listed in the application. On or about March 1, 2011, Registrant submitted a Statement of Use in support of Application Serial

No. 77/566,090 declaring under oath that it "is using the mark in commerce on or in connection with the goods/services identified [in the application]...." Thereafter, on April 26, 2011, Application Serial No. 77/566,090 matured to registration as Registration No. 3,951,287.

8. Registration No. 3,951,287 covers the following Class 42 services: "Computer services, namely, providing on-line information available on computer networks, global information networks and wireless communication networks in the fields of the design, development and customization of computer hardware, computer software, computer graphics software, information technology, wireless communication devices, multimedia technology, robotics, namely, the design and development of new technology in the field of robotics, business computing and environmentally-friendly computing, and specifically excluding computer games and video games, using both an interactive and non-interactive format; technical support services, namely, troubleshooting of computer hardware and software problems in person, by telephone, by electronic, computer and communications networks; provision of computer systems analysis and computer diagnostic services; design of computer hardware, integrated circuits, computer networks and communications hardware and software for others; consultancy in the field of design, development, configuration, installation, updating, upgrading or maintenance of computer software - excluding computer game and video game software; computer programming for others; research and development of 3d content, 3d technology and processes, 3d animation technology, 3d processing power, 3d techniques, and flexible forward projection; creating, designing and maintaining web sites."

9. The USPTO has issued Office Actions against each of the Google CHROME Applications and has refused registration based on the Subject Registrations.

10. As set forth below, on information and belief, Registrant had not used and was not using the marks in the Subject Registrations in commerce on or in connection with some or all of the goods and services listed in the Subject Registrations when it filed the Statements of Use in support of Application Serial Nos. 77/113,063 and 77/566,090. On information and belief,

Registrant was not using and had not continuously used the mark which is the subject of Registration No. No. 3,360,331 in commerce on or in connection with some or all of the goods listed in Registrant's Section 8 and 15 Declaration when it filed Registrant's Section 8 and 15 Declaration. On information and belief, Registrant has not used the marks in the Subject Registrations in commerce on or in connection with some or all of the goods and services listed in the Subject Registrations.

11. As set forth below, on information and belief, Registrant has abandoned the marks for which the Subject Registrations were issued.

12. Google believes that it is and/or will be damaged by the continued registration of the Subject Registrations.

FIRST CLAIM FOR RELIEF:

THE MARKS IN THE SUBJECT REGISTRATIONS
HAVE NOT BEEN USED IN U.S. COMMERCE

13. Google repeats and realleges each and every allegation set forth in Paragraphs 1 through 12 as if fully set forth herein.

14. On information and belief, Registrant was not using the marks in the Subject Registrations in commerce on or in connection with some or all of the goods and services listed in the Subject Registrations when it filed the Statements of Use in support of Application Serial Nos. 77/113,063 and 77/566,090.

15. On information and belief, Registrant was not using and had not continuously used the mark which is the subject of Registration No. 3,360,331 in commerce on or in connection with some or all of the goods listed in Registrant's Section 8 and 15 Declaration when it filed Registrant's Section 8 and 15 Declaration.

16. On information and belief, Registrant has not used the marks in the Subject Registrations in commerce on or in connection with some or all of the goods and services listed in the Subject Registrations.

17. Accordingly, the Subject Registrations should be cancelled.

18. As the Subject Registrations have been cited as a potential block to the registration of the Google CHROME Applications by the USPTO, these registrations are causing damage and injury to Google.

SECOND CLAIM FOR RELIEF:

REGISTRANT HAS ABANDONED THE MARKS IN THE SUBJECT REGISTRATIONS

19. Google repeats and realleges each and every allegation set forth in Paragraphs 1 through 18 as if fully set forth herein.

20. On information and belief, Registrant has abandoned the marks in the Subject Registrations for some or all of the goods and services identified therein.

21. On information and belief, Registrant does not sell some or all of the goods listed in Registration No. 3,360,331 in the United States, and has no intention to sell such goods in the future.

22. On information and belief, Registrant does not render some or all of the services listed in Registration No. 3,951,287 in the United States, and has no intention to render such services in the future.

23. As the Subject Registrations have been cited as a potential block to registration of the Google CHROME Applications by the USPTO, these registrations are causing damage and injury to Google.

CONSOLIDATED PETITION TO CANCEL
REG. NOS. 3,360,331 AND 3,951,287

WHEREFORE, Google requests that the present Consolidated Petition for Cancellation
be sustained and Registration Nos. 3,360,331 and 3,951,287 be cancelled.

Respectfully submitted,

COOLEY LLP

Date: February 19, 2013

By: /Anne H. Peck/
Janet L. Cullum, Esq.
Anne H. Peck, Esq.
Attorneys for Petitioner Google Inc.
1299 Pennsylvania Avenue, NW
Suite 700
Washington, DC 20004
Telephone: (650) 843-5000
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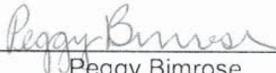
CERTIFICATE OF SERVICE

I hereby certify that on February 19, 2013, I mailed the foregoing **CONSOLIDATED PETITION FOR CANCELLATION** regarding Google Inc. v. VIA Technologies, Inc. by depositing true and correct copies of the same with the United States Postal Service, postage prepaid, in envelopes addressed to Registrant's attorney of record and Registrant's counsel:

Jonathan Chang
VIA Technologies, Inc.
940 Mission Ct.
Fremont, California 94539-8202

Irene Y. Lee
Russ August & Kabat
12th Floor
12424 Wilshire Boulevard
Los Angeles, California 90025

Date: February 19, 2013



Peggy Bimrose