From: Coleman, Nicholas

Sent: 11/23/2015 6:55:54 AM

To: TTAB EFiling

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Subject: U.S. TRADEMARK APPLICATION NO. 85657527 - XPERIA - 74725-334364 - Request for Reconsideration Denied - Return to TTAB - Message 1 of 5

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Attachment Information:

Count: 19

Files: app-ipad-01.jpg, app-ipad-02.jpg, app-ipad-03.jpg, app-ipad-04.jpg, app-ipad-05.jpg, app-ipad-06.jpg, app-ipad-07.jpg, app-ipad-08.jpg, app-ipad-09.jpg, app-ipad-10.jpg, app-ipad-11.jpg, app-ipad-12.jpg, app-ipad-13.jpg, ipad-acc-1.jpg, ipad-acc-2.jpg, ipad-acc-3.jpg, ipad-acc-4.jpg, ipad-acc-5.jpg, 85657527.doc

UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)
OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION

U.S. APPLICATION SERIAL NO. 85657527

MARK: XPERIA

CORRESPONDENT ADDRESS:

ANDREW D PRICE

VENABLE LLP

P O BOX 34385

WASHINGTON, DC 20045-8156

GENERAL TRADEMARK INFORMATION:

http://www.uspto.gov/trademarks/index.jsp

APPLICANT: SONY MOBILE COMMUNICATIONS INC.

CORRESPONDENT'S REFERENCE/DOCKET NO:

74725-334364

CORRESPONDENT E-MAIL ADDRESS:

REQUEST FOR RECONSIDERATION DENIED

ISSUE/MAILING DATE:

The trademark examining attorney has carefully reviewed applicant's request for reconsideration and is in-part denying the request for the reasons stated below. *See* 37 C.F.R. §2.63(b)(3); TMEP §§715.03(a)(ii)(B), 715.04(a). The partial refusal based on a likelihood of confusion with the mark in U.S.

Registration No. 4030262 made final in the Office action dated November 25, 2013 is maintained and continues to be final. *See* TMEP §§715.03(a)(ii)(B), 715.04(a).

The refusal based on a likelihood of confusion with the mark in U.S. Registration No. 4236360 made final in the Office action of November 25, 2013 is **withdrawn**. *See* TMEP §§715.03(a)(ii)(B), 715.04(a).

Further, U.S. Registration No. 3564875 has been cancelled and no longer poses a bar to registration. As such, the refusal based on a likelihood of confusion with the mark therein made final in the Office action of November 25, 2013 is also **withdrawn**.

In the present case, applicant's request has not resolved all the outstanding issues, nor does it raise a new issue or provide any new or compelling evidence with regard to the outstanding issues in the final Office action. In addition, applicant's analysis and arguments are not persuasive nor do they shed new light on the issues. Accordingly, the request is denied in part as to the following goods identified in International Class 9:

<u>International Class 9</u>

Digital or electronic tablets for the recording, transmission, processing and reproduction of sound, images or data; portable and handheld digital electronic devices for the recording, transmission, processing and reproduction of sound, images or data; portable and handheld digital electronic devices for the recording, transmission, processing and reproduction of sound, images or data, namely, accessories for the foregoing devices excluding mobile phones, namely, devices for hands-free use; accessories for the foregoing devices excluding mobile phones, namely, headsets, earphones, ear buds, chargers, batteries, cases, covers, holders, NFC tags, screen protectors, SIM card adaptors, speakers, docking stands, cradles, desk stands, and cables; computer application software for the foregoing devices excluding mobile phones, namely, computer operating systems, computer operating software, computer diagnostic software for troubleshooting in the nature of diagnosing hardware and software problems, and computer software for recording, transmission, processing and reproduction of sound, images or data; embedded computer application software used as an electronic feature found on the foregoing devices excluding mobile phones, namely, computer operating systems, computer operating software, computer diagnostic software for troubleshooting in the nature of diagnosing hardware and software problems

While applicant has submitted a settlement agreement, and referenced the specific exclusion of goods "being or relating to mobile phones or accessories and applications for cellular or mobile phones", the identified goods are beyond the scope of mobile phones. Specifically, they consist of tablets and a broad identification of all "portable and handheld digital electronic devices for the recording, transmission, processing and reproduction of sound, images or data," which would include computers. As such, the settlement and exclusion in the registration do not obviate confusion. In particular, the identification of "digital or electronic tablets for the recording, transmission, processing and reproduction of sound, images or data" and "portable and handheld digital electronic devices for the recording, transmission, processing and reproduction of sound, images or data" would include computers, even the specific "computers for sensory, tactile, visual, aural or mental stimulation that are used for educational, interactive, calming, therapeutic, and/or stimulatory purposes." Thus, unlike mobile phones and their accessories, the goods in the present application identified above and those identified in U.S. Registration No. 4030262 are potentially identical. The remaining items subject to the refusal consist of accessories, operating, and troubleshooting software for computers. The attached evidence from Apple, Microsoft, Samsung, and Google demonstrate that the same companies often offer accessories, such as hands-free devices, ear phones, and chargers, as well as operating software for computers and tablet computers under the same or similar marks as the computers themselves. Therefore, the goods remain both potentially identical in-part, and closely related in-part, and there exists a likelihood of confusion when the respective marks are utilized in connection with identical and closely related goods marketed to the same general consumer through the same channels of trade.

The request is, however, granted with respect to the remaining goods in the application.

As applicant has already filed a timely notice of appeal with the Trademark Trial and Appeal Board, the Board will be notified to resume the appeal. *See* TMEP §715.04(a).

/Nicholas A. Coleman/

Examining Attorney

Law Office 115

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Email: nicholas.coleman@uspto.gov

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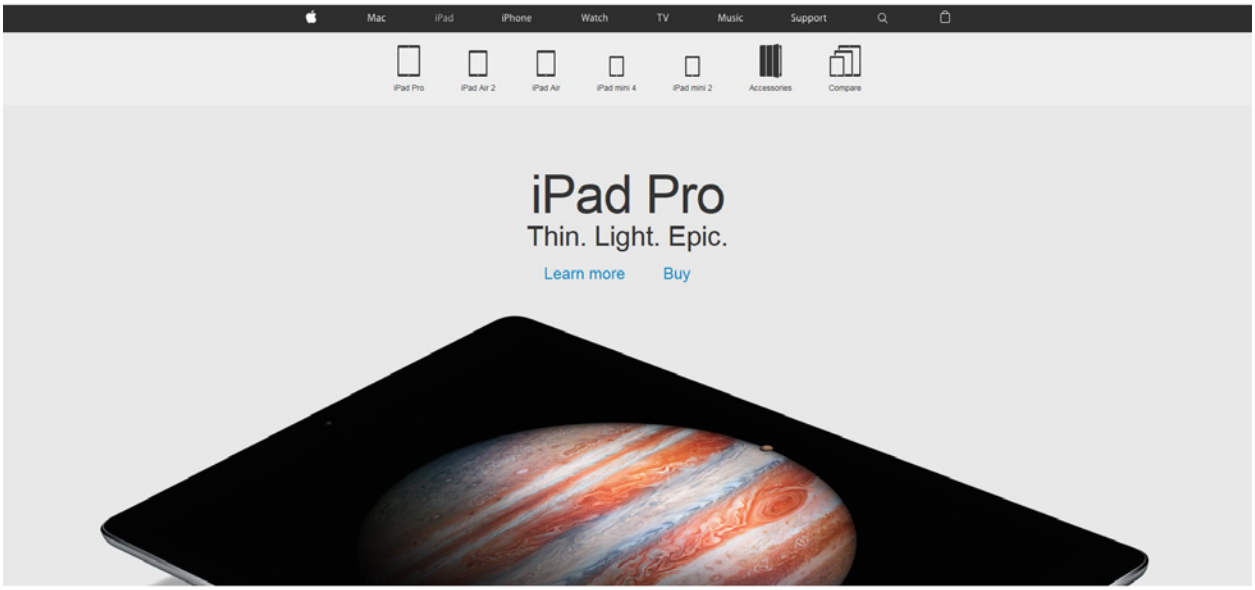

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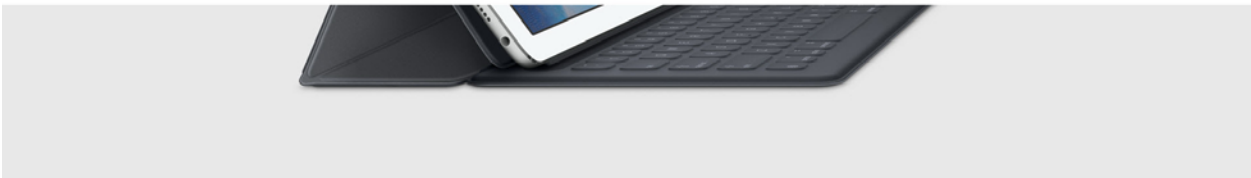

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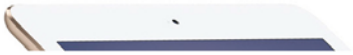

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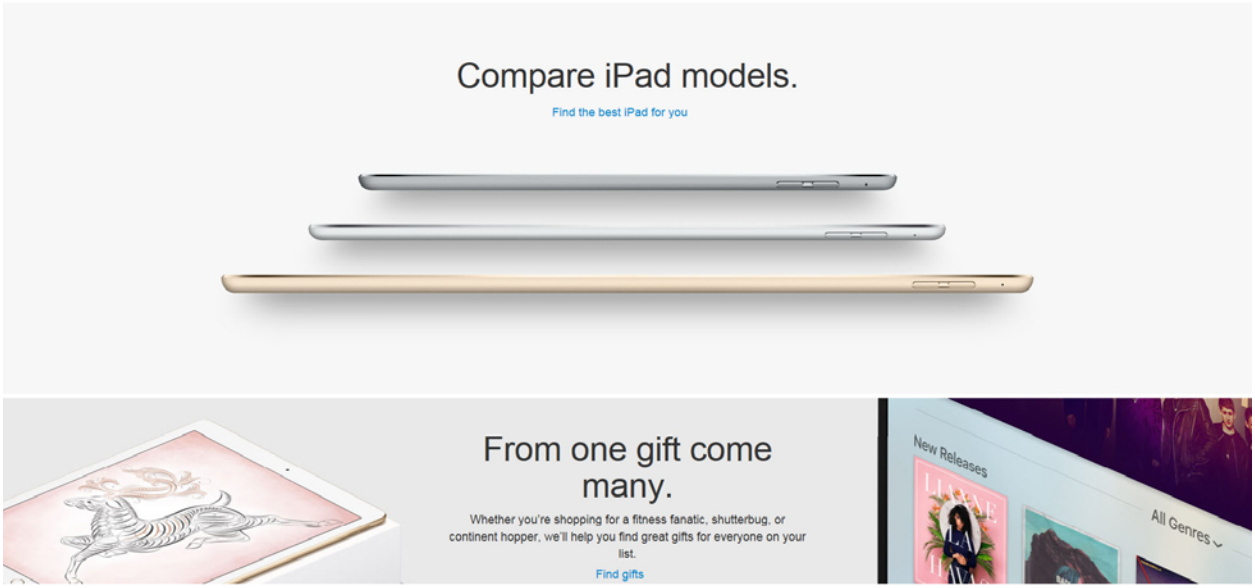
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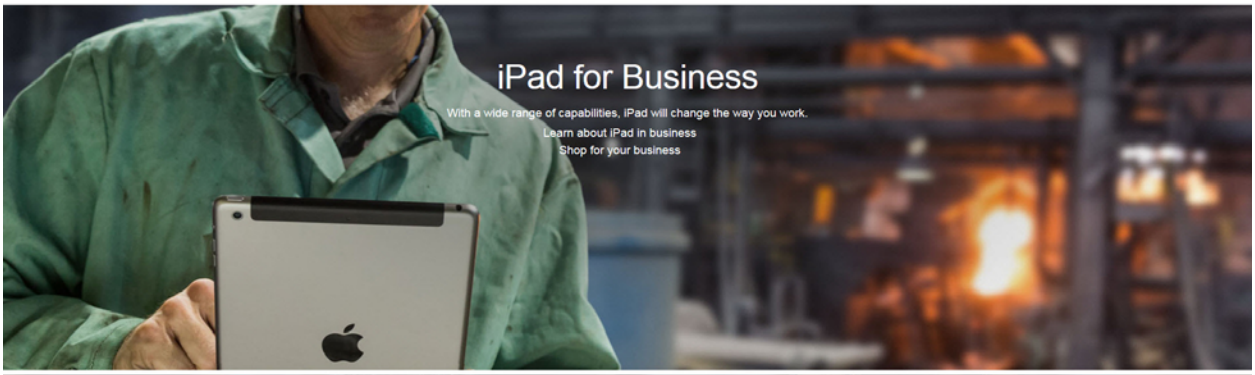
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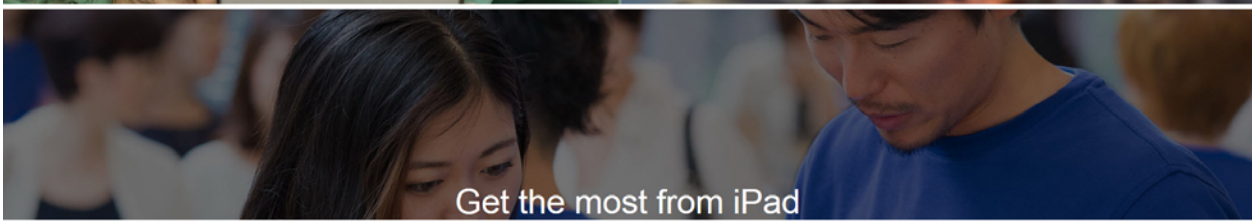
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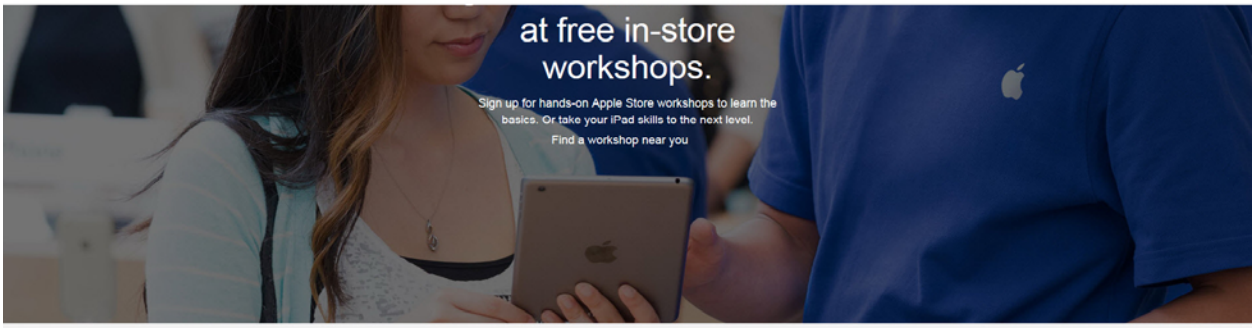

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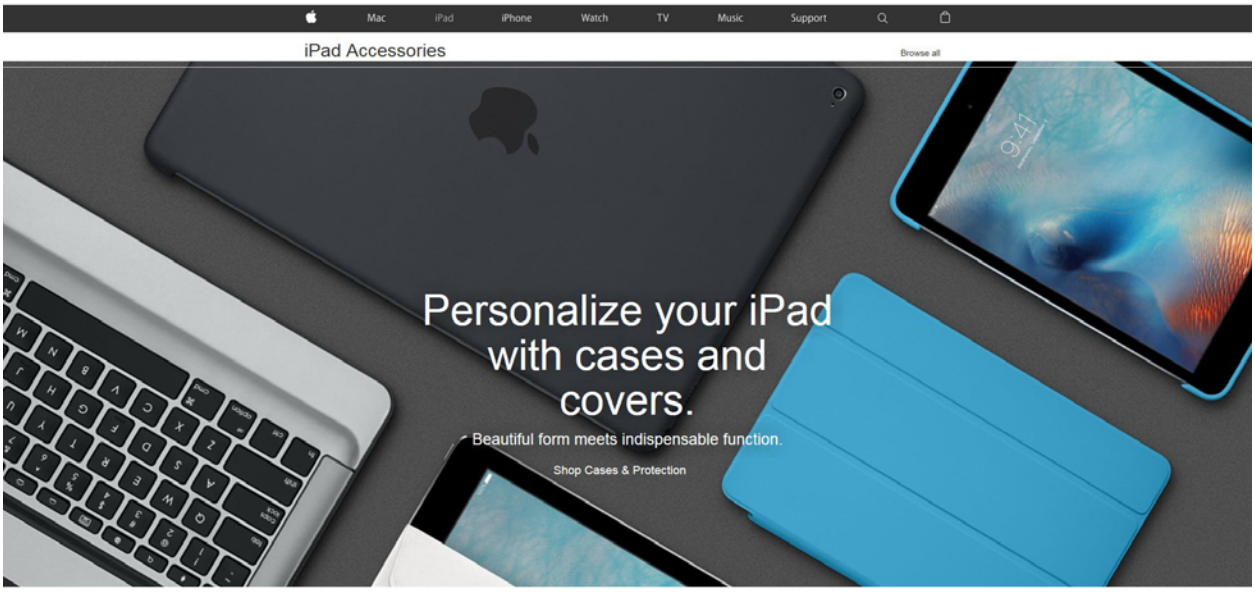

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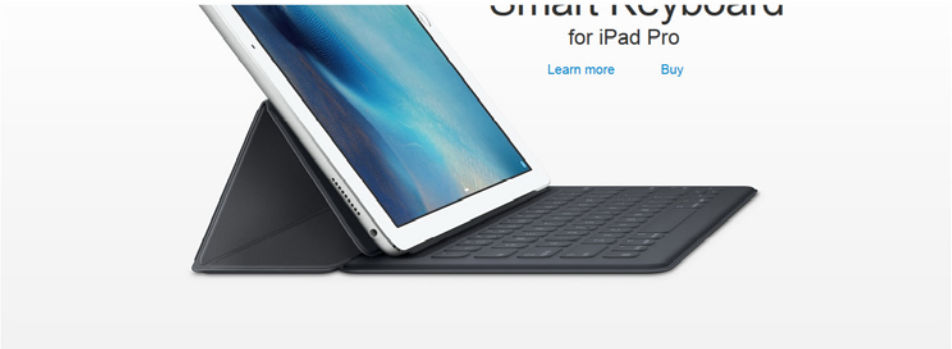

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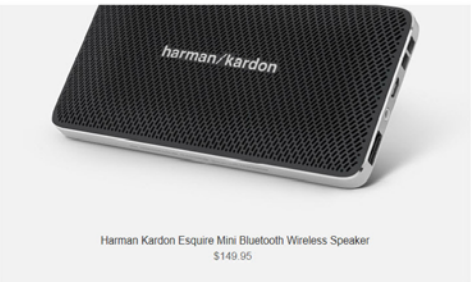

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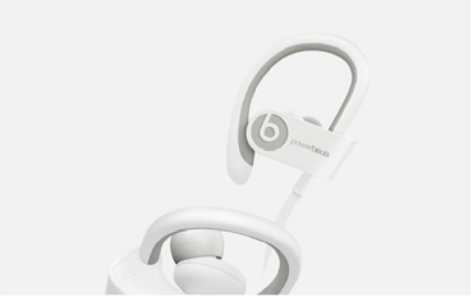
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