

ESTTA Tracking number: **ESTTA314791**

Filing date: **11/02/2009**

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

Proceeding	91189418
Party	Defendant Phoenix 2008 LLC
Correspondence Address	BRIAN J. HURH DAVIS WRIGHT TREMAINE LLP 1919 PENNSYLVANIA AVE NW STE 200 WASHINGTON, DC 20006-3402 UNITED STATES brianhurh@dwt.com
Submission	Opposition/Response to Motion
Filer's Name	Brian J. Hurh
Filer's e-mail	brianhurh@dwt.com
Signature	/brian j. hurh/
Date	11/02/2009
Attachments	PHOENIX RESPONSE_EXHIBIT A.pdf (22 pages)(1313184 bytes)

EXHIBIT A

Document Description: **Response to Office Action**
 Mail / Create Date: **22-Sep-2008**

Previous Page Next Page You are currently on page 1 of 5

PTO Form 1957 (Rev 9/2005)
 OMB No. 0651-0050 (Exp. 04/2009)

Response to Office Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	77497086
LAW OFFICE ASSIGNED	LAW OFFICE 104

MARK SECTION (no change)

ARGUMENT(S)

On behalf of Phoenix 2008 LLC ("Applicant"), we hereby respond to the Office Action mailed September 2, 2008 regarding the application for registration of SPEEDVISION (Serial No. 77/497068) (the "Mark").

Likelihood of Confusion

The Examining Attorney refused the Mark for publication because of a likelihood of confusion with the mark in US Registration No. 2517630.

As of September 13, 2008, US Registration No. 2517630 was cancelled under Section 8, and therefore is no longer an active registered mark. Accordingly, Applicant respectfully requests that the Examining Attorney withdraw her refusal for likelihood of confusion

Furthermore, because US Registration No. 2517630 has been cancelled, the issue of ownership of the cited mark is no longer relevant.

Identification of Goods

The Examining Attorney found that Applicant's identification of goods under Class 16 is indefinite and must be clarified because Applicant must indicate the specific type of publications. The Examining Attorney further found that "electronic print media" should be classified in Class 09.

Applicant respectfully disagrees that the addition of Class 09 is necessary. Pursuant to TMEP § 1401.02(a), Class 09 is for "Electrical and scientific apparatus," including, in particular, "all computer programs and software regardless of recording media or means of dissemination." Applicant's Mark is not associated with any electrical or

regardless of recording media or means of dissemination." Applicant's Mark is not associated with any electrical or scientific apparatus or instrument, and is not a computer program or software (the computer program or software would be the code underlying the electronic printed matter).

Class 16 is not exclusively for paper goods, but is "mainly" for paper goods. Moreover, it includes "printed matter" without any limitation. TMEP § 1401.02(a) (describing Class 16). While Applicant's Mark is intended to cover traditional paper publications, namely, newsletters, magazines, and journals, it is also intended to cover other types of "printed matter" not necessarily published on paper. For instance, newsletters, magazines and journals are widely published on the Internet, *i.e.*, in an electronic format. *See, e.g.*, MSNBC Newsletters online, available at <http://www.msnbc.msn.com/id/7422001> (attached); Newsweek Magazine online, available at <http://www.newsweek.com> (attached). These goods do not consist of Class 09 instruments or apparatuses (such as the computer or mobile device on which the publication is read), but the "printed matter" itself. Class 16 is not exclusively for paper goods, but includes "printed matter" generally.

Further support for Applicant's position is the fact that there is no other class that could properly include electronic "printed matter." As discussed above, Class 09 would be for the apparatus or instrument on which the electronic printed matter is read. Applicant's publications would not fall under Class 42, either, as the good in question is not the website service, but the electronic printed matter. No other class could conceivably include Applicant's goods. As "printed matter," Applicant's electronic newsletters, magazines, and journals should be deemed goods under Class 09, as set forth in its initial application.

Nevertheless, if the Examining Attorney desires a more definite identification of Applicant's goods, Applicant offers the following amendment to its identification of goods to better conform to the description of Class 16 as set forth in TMEP (amendment in capital letters):

Class 16: Publications, namely, newsletters, magazines, journals, and other PRINTED MATTER (IN PAPER, ELECTRONIC, AND OTHER PRINT MEDIUM) in the fields of automobiles, airplanes, motorcycles, boats, and other modes of transportation.

Applicant believes that the above-amended recitation of goods for Class 16 does not include services outside the scope of the goods set forth in Applicant's initial application.

CONCLUSION

For the foregoing reasons, Applicant requests that the Examining Attorney pass the Mark for registration on the Principal Register.

Principal Register.

EVIDENCE SECTION

EVIDENCE FILE NAME(S)	
ORIGINAL PDF FILE	evi_6620815115-143940649_ _MSNBC_newsletter.pdf
CONVERTED PDF FILE(S) (2 pages)	\\TICRS\EXPORT3\IMAGEOUT3\774\970\77497086\xml3\ROA0002.JPG
	\\TICRS\EXPORT3\IMAGEOUT3\774\970\77497086\xml3\ROA0003.JPG
ORIGINAL PDF FILE	evi_6620815115-143940649_ _Newsweek_magazine.pdf
CONVERTED PDF FILE(S) (2 pages)	\\TICRS\EXPORT3\IMAGEOUT3\774\970\77497086\xml3\ROA0004.JPG
	\\TICRS\EXPORT3\IMAGEOUT3\774\970\77497086\xml3\ROA0005.JPG
DESCRIPTION OF EVIDENCE FILE	Website printouts

SIGNATURE SECTION

RESPONSE SIGNATURE	/brian j. hurh/
SIGNATORY'S NAME	Brian J. Hurh
SIGNATORY'S POSITION	Attorney
DATE SIGNED	09/22/2008
AUTHORIZED SIGNATORY	YES

FILING INFORMATION SECTION

SUBMIT DATE	Mon Sep 22 14:43:55 EDT 2008
TEAS STAMP	USPTO/ROA-66.208.15.115-2 0080922144355331025-77497 086-430c4ca2237b23b452071 f874bb703be354-N/A-N/A-20 080922143940649906

PTO Form 1957 (Rev 9/2005)
OMB No. 0651-0050 (Exp. 04/2009)

Response to Office Action**To the Commissioner for Trademarks:**

Application serial no. 77497086 has been amended as follows:

ARGUMENT(S)

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

On behalf of Phoenix 2008 LLC ("Applicant"), we hereby respond to the Office Action mailed September 2, 2008 regarding the application for registration of SPEEDVISION (Serial No. 77/497068) (the "Mark").

Likelihood of Confusion

The Examining Attorney refused the Mark for publication because of a likelihood of confusion with the mark in US Registration No. 2517630.

As of September 13, 2008, US Registration No. 2517630 was cancelled under Section 8, and therefore is no longer an active registered mark. Accordingly, Applicant respectfully requests that the Examining Attorney withdraw her refusal for likelihood of confusion

Furthermore, because US Registration No. 2517630 has been cancelled, the issue of ownership of the cited mark is no longer relevant.

Identification of Goods

The Examining Attorney found that Applicant's identification of goods under Class 16 is indefinite and must be clarified because Applicant must indicate the specific type of publications. The Examining Attorney further found that "electronic print media" should be classified in Class 09.

Applicant respectfully disagrees that the addition of Class 09 is necessary. Pursuant to TMEP § 1401.02(a), Class 09 is for "Electrical and scientific apparatus," including, in particular, "all computer programs and software regardless of recording media or means of dissemination." Applicant's Mark is not associated with any electrical or scientific apparatus or instrument, and is not a computer program or software (the computer program or software would be the code underlying the electronic printed matter).

Class 16 is not exclusively for paper goods, but is "mainly" for paper goods. Moreover, it includes "printed matter" without any limitation. TMEP § 1401.02(a) (describing Class 16). While Applicant's Mark is intended to cover traditional paper publications, namely, newsletters, magazines, and journals, it is also intended to cover other types of "printed matter" not necessarily published on paper. For instance, newsletters, magazines and journals are widely published on the Internet, *i.e.*, in an electronic format. *See, e.g.*, MSNBC Newsletters online, available at <http://www.msnbc.msn.com/id/7422001> (attached); Newsweek Magazine online, available at <http://www.newsweek.com> (attached). These goods do not consist of Class 09 instruments or apparatuses (such as the computer or mobile device on which the publication is read), but the "printed matter" itself. Class 16 is not

exclusively for paper goods, but includes "printed matter" generally.

exclusively for paper goods, but includes "printed matter" generally.

Further support for Applicant's position is the fact that there is no other class that could properly include electronic "printed matter." As discussed above, Class 09 would be for the apparatus or instrument on which the electronic printed matter is read. Applicant's publications would not fall under Class 42, either, as the good in question is not the website service, but the electronic printed matter. No other class could conceivably include Applicant's goods. As "printed matter," Applicant's electronic newsletters, magazines, and journals should be deemed goods under Class 09, as set forth in its initial application.

Nevertheless, if the Examining Attorney desires a more definite identification of Applicant's goods, Applicant offers the following amendment to its identification of goods to better conform to the description of Class 16 as set forth in TMEP (amendment in capital letters):

Class 16: Publications, namely, newsletters, magazines, journals, and other PRINTED MATTER (IN PAPER, ELECTRONIC, AND OTHER PRINT MEDIUM) in the fields of automobiles, airplanes, motorcycles, boats, and other modes of transportation.

Applicant believes that the above-amended recitation of goods for Class 16 does not include services outside the scope of the goods set forth in Applicant's initial application.

CONCLUSION

For the foregoing reasons, Applicant requests that the Examining Attorney pass the Mark for registration on the Principal Register.

EVIDENCE

Evidence in the nature of Website printouts has been attached.

Original PDF file:

[evi_6620815115-143940649_MSNBC_newsletter.pdf](#)

Converted PDF file(s) (2 pages)

[Evidence-1](#)

[Evidence-2](#)

Original PDF file:

[evi_6620815115-143940649_Newsweek_magazine.pdf](#)

Converted PDF file(s) (2 pages)

[Evidence-1](#)

[Evidence-2](#)

SIGNATURE(S)**Response Signature**

Signature: /brian.j.hurh/ Date: 09/22/2008

Signatory's Name: Brian J. Hurh

Signatory's Position: Attorney

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.

Serial Number: 77497086

Internet Transmission Date: Mon Sep 22 14:43:55 EDT 2008

TEAS Stamp: USPTO/ROA-66.208.15.115-2008092214435533

1025-77497086-430c4ca2237b23b452071f874b

b703be354-N/A-N/A-20080922143940649906

TDR Home

This document may be displayed as a PDF file containing images without text. You may view online or save the entire document by clicking on the file download icon in the upper right corner of this page. [[required PDF viewer](#)]

[FAQ: Are you seeing only the first page of this PDF document?](#)

If you need help:

- **General trademark information:** Please e-mail TrademarkAssistanceCenter@uspto.gov, or telephone either 571-272-9250 or 1-800-786-9199.
- **Technical help:** For instructions on how to use TDR, or help in resolving technical glitches, please e-mail TDR@uspto.gov. If outside of the normal business hours of the USPTO, please e-mail [Electronic Business Support](#), or call 1-800-786-9199.
- **Questions about USPTO programs:** Please e-mail [USPTO Contact Center \(UCC\)](#).

NOTE: Within any e-mail, please include your telephone number so we can talk to you directly, if necessary. Also, include the relevant serial number or registration number, if existing.

Document Description: **Response to Office Action**
 Mail / Create Date: **22-Sep-2008**

PTO Form 1857 (Rev 9/2005)
 OMB No. 0651-0050 (Exp. 04/2009)

Response to Office Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	77478035
LAW OFFICE ASSIGNED	LAW OFFICE 104

MARK SECTION (no change)

ARGUMENT(S)

On behalf of Phoenix 2008 LLC ("Applicant"), we hereby respond to the Office Action mailed September 2, 2008 regarding the application for registration of SPEEDVISION (Serial No. 77/478035) (the "Mark").

Likelihood of Confusion

The Examining Attorney refused the Mark for publication because of a likelihood of confusion with the mark in US Registration No. 2517630. The refusal is applicable only to the Mark's Class 38 and 41 services only.

As of September 13, 2008, US Registration No. 2517630 was cancelled under Section 8, and therefore is no longer an active registered mark. Accordingly, Applicant respectfully requests that the Examining Attorney withdraw her refusal for likelihood of confusion.

Furthermore, because US Registration No. 2517630 has been cancelled, the issue of ownership of the cited mark is no longer relevant.

Identification of Goods/Recitation of Services

The Examining Attorney found that a portion Applicant's recitation of services under Class 41 is indefinite and must be clarified because it is too broad and could include services in other international classes. The Examining Attorney has suggested amended language for Applicant's Class 41 services, as well as the addition of services under Class 09. The Examining Attorney found Applicant's recitation of services for Classes 25 and 38 to be acceptable.

With respect to Class 09, Applicant respectfully disagrees that the addition of Class 09 is necessary. Applicant's

With respect to Class 09, Applicant respectfully disagrees that the addition of Class 09 is necessary. Applicant's Mark is for programming that may be distributed on DVDs and other digital materials, but is not for the digital materials themselves. Moreover, the Examining Attorney's amendment to Applicant's services under Class 41 adequately covers Applicant's services as distributed on DVDs and other digital materials.

With respect to Class 41, Applicant accepts the Examining Attorney's amended language, and further specifies its Class 41 services in accordance with the Office Action, as follows (in its entirety):

Class 41: Entertainment services, namely, an on-going series featuring automobiles, airplanes, motorcycles, boats, and other modes of transportation provided through broadcast, cable and satellite television, radio broadcasts, mobile communications devices, wireless networks, and global computer networks;
 Entertainment services, namely, production of CDs, DVDs, videotapes, and other digital media featuring an on-going series featuring automobiles, airplanes, motorcycles, boats, and other modes of transportation;
 Production of cable television programs.

Applicant believes that the above-amended recitation of services for Class 41 does not include services outside the scope of the services set forth in Applicant's initial application. Applicant further states that, to the best of its knowledge, the filing fees for Classes 25, 38, and 41 have already been paid.

CONCLUSION

For the foregoing reasons, Applicant requests that the Examining Attorney pass the Mark for registration on the Principal Register.

SIGNATURE SECTION

DECLARATION SIGNATURE	The filing Attorney has elected not to submit the signed declaration, believing no supporting declaration is required under the <i>Trademark Rules of Practice</i> .
RESPONSE SIGNATURE	/brian j. hurh/
SIGNATORY'S NAME	Brian J. Hurh
SIGNATORY'S POSITION	Attorney
DATE SIGNED	09/22/2008
AUTHORIZED SIGNATORY	YES

FILING INFORMATION SECTION

SUBMIT DATE	Mon Sep 22 14:20:41 EDT 2008
-------------	------------------------------

TEAS STAMP	USPTO/ROA-66.208.15.115-2 0080922142041479160-77478 035-430a1fd4e4eeefbae5c01 3e3835b927e7fN/A-N/A-200 80922140317789460
-------------------	--

PTO Form 1957 (Rev. 9/2005)
OMB No. 0651-0050 (Exp. 04/2009)

Response to Office Action

To the Commissioner for Trademarks:

Application serial no. **77478035** has been amended as follows:

ARGUMENT(S)

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

On behalf of Phoenix 2008 LLC ("Applicant"), we hereby respond to the Office Action mailed September 2, 2008 regarding the application for registration of SPEEDVISION (Serial No. 77/478035) (the "Mark").

Likelihood of Confusion

The Examining Attorney refused the Mark for publication because of a likelihood of confusion with the mark in US Registration No. 2517630. The refusal is applicable only to the Mark's Class 38 and 41 services only.

As of September 13, 2008, US Registration No. 2517630 was cancelled under Section 8, and therefore is no longer an active registered mark. Accordingly, Applicant respectfully requests that the Examining Attorney withdraw her refusal for likelihood of confusion.

Furthermore, because US Registration No. 2517630 has been cancelled, the issue of ownership of the cited mark is no longer relevant.

Identification of Goods/Recitation of Services

The Examining Attorney found that a portion Applicant's recitation of services under Class 41 is indefinite and must be clarified because it is too broad and could include services in other international classes. The Examining Attorney has suggested amended language for Applicant's Class 41 services, as well as the addition of services under Class 09.

The Examining Attorney found Applicant's recitation of services for Classes 25 and 38 to be acceptable.

With respect to Class 09, Applicant respectfully disagrees that the addition of Class 09 is necessary. Applicant's

Mark is for programming that may be distributed on DVDs and other digital materials, but is not for the digital

Mark is for programming that may be distributed on DVDs and other digital materials, but is not for the digital materials themselves. Moreover, the Examining Attorney's amendment to Applicant's services under Class 41 adequately covers Applicant's services as distributed on DVDs and other digital materials.

With respect to Class 41, Applicant accepts the Examining Attorney's amended language, and further specifies its Class 41 services in accordance with the Office Action, as follows (in its entirety):

Class 41: Entertainment services, namely, an on-going series featuring automobiles, airplanes, motorcycles, boats, and other modes of transportation provided through broadcast, cable and satellite television, radio broadcasts, mobile communications devices, wireless networks, and global computer networks; Entertainment services, namely, production of CDs, DVDs, videotapes, and other digital media featuring an on-going series featuring automobiles, airplanes, motorcycles, boats, and other modes of transportation; Production of cable television programs.

Applicant believes that the above-amended recitation of services for Class 41 does not include services outside the scope of the services set forth in Applicant's initial application. Applicant further states that, to the best of its knowledge, the filing fees for Classes 25, 38, and 41 have already been paid.

CONCLUSION

For the foregoing reasons, Applicant requests that the Examining Attorney pass the Mark for registration on the Principal Register.

SIGNATURE(S)

Declaration Signature

I hereby elect to bypass the submission of a signed declaration, because I believe a declaration is not required by the rules of practice. I understand that the examining attorney could still, upon later review, require a signed declaration.

Response Signature

Signature: /brian j. hurh/ Date: 09/22/2008

Signatory's Name: Brian J. Hurh

Signatory's Position: Attorney

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

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.

Serial Number: 77478035

Internet Transmission Date: Mon Sep 22 14:20:41 EDT 2008

TEAS Stamp: USPTO/ROA-66.208.15.115-2008092214204147

9160-77478035-430a1fdc4eecedbae5c013e383

5b927e7f-N/A-N/A-20080922140317789460

TDR Home

This document may be displayed as a PDF file containing images without text. You may view online or save the entire document by clicking on the file download icon in the upper right corner of this page. [required PDF viewer]

FAQ: Are you seeing only the first page of this PDF document?

If you need help:

- **General trademark information:** Please e-mail TrademarkAssistanceCenter@uspto.gov, or telephone either 571-272-9250 or 1-800-786-9199.
- **Technical help:** For instructions on how to use TDR, or help in resolving **technical** glitches, please e-mail TDR@uspto.gov. If outside of the normal business hours of the USPTO, please e-mail [Electronic Business Support](#), or call 1-800-786-9199.
- **Questions about USPTO programs:** Please e-mail [USPTO Contact Center \(UCC\)](#).

NOTE: Within any e-mail, please include your telephone number so we can talk to you directly, if necessary. Also, include the relevant serial number or registration number, if existing.

Document Description: **Response to Office Action**
 Mail / Create Date: **22-Sep-2008**

PTO Form 1957 (Rev 9/2005)
 OMB No. 0651-0050 (Exp. 04/2009)

Response to Office Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	77476107
LAW OFFICE ASSIGNED	LAW OFFICE 104
MARK SECTION (no change)	
ARGUMENT(S)	

On behalf of Phoenix 2008 LLC ("Applicant"), we hereby respond to the Office Action mailed September 2, 2008 regarding the application for registration of SPEEDVISION HD (Serial No. 77/476107) (the "Mark").

Likelihood of Confusion

The Examining Attorney refused the Mark for publication because of a likelihood of confusion with the mark in US Registration No. 2517630.

As of September 13, 2008, US Registration No. 2517630 was cancelled under Section 8, and therefore is no longer an active registered mark. Accordingly, Applicant respectfully requests that the Examining Attorney withdraw her refusal for likelihood of confusion

Furthermore, because US Registration No. 2517630 has been cancelled, the issue of ownership of the cited mark is no longer relevant.

Identification of Goods/Recitation of Services

The Examining Attorney found that a portion Applicant's recitation of services under Class 41 is indefinite and must be clarified because it is too broad and could include services in other international classes. The Examining Attorney has suggested amended language for Applicant's Class 41 services, as well as the addition of services under Class 09. The Examining Attorney found Applicant's recitation of services for Class 38 to be acceptable.

With respect to Class 09, Applicant respectfully disagrees that the addition of Class 09 is necessary. Applicant's

With respect to Class 09, Applicant respectfully disagrees that the addition of Class 09 is necessary. Applicant's Mark is for programming that may be distributed on DVDs and other digital materials, but is not for the digital materials themselves. Moreover, the Examining Attorney's amendment to Applicant's services under Class 41 adequately covers Applicant's services as distributed on DVDs and other digital materials.

With respect to Class 41, Applicant accepts the Examining Attorney's amended language, and further specifies its Class 41 services in accordance with the Office Action, as follows (in its entirety):

Class 41: Entertainment services, namely, an on-going series featuring automobiles, airplanes, motorcycles, boats, and other modes of transportation provided through broadcast, cable and satellite television, radio broadcasts, mobile communications devices, wireless networks, and global computer networks; Entertainment services, namely, production of CDs, DVDs, videotapes, and other digital media featuring an on-going series featuring automobiles, airplanes, motorcycles, boats, and other modes of transportation; Production of cable television programs.

Applicant believes that the above-amended recitation of services for Class 41 does not include services outside the scope of the services set forth in Applicant's initial application. Applicant further states that, to the best of its knowledge, the filing fees for Classes 38 and 41 have already been paid.

DISCLAIMER REQUIRED

Applicant agrees to disclaim "HD" apart from the Mark as shown, and will amend its application accordingly.

CONCLUSION

For the foregoing reasons, Applicant requests that the Examining Attorney pass the Mark for registration on the Principal Register.

ADDITIONAL STATEMENTS SECTION

DISCLAIMER	No claim is made to the exclusive right to use HD apart from the mark as shown.
-------------------	---

SIGNATURE SECTION

DECLARATION SIGNATURE	The filing Attorney has elected not to submit the signed declaration, believing no supporting declaration is required under the <i>Trademark Rules of Practice</i> .
RESPONSE SIGNATURE	/brian j. hurh/
SIGNATORY'S NAME	Brian J. Hurh
SIGNATORY'S POSITION	Attorney
DATE SIGNED	09/22/2008

AUTHORIZED SIGNATORY	YES
FILING INFORMATION SECTION	
SUBMIT DATE	Mon Sep 22 14:30:33 EDT 2008
TEAS STAMP	USPTO/ROA-66.208.15.115-2 0080922143033748597-77476 107-430ba7ace82b2cd657fbb 394f8f169c2bc-N/A-N/A-200 80922142604741493

PTO Form 1957 (Rev 9/2005)
OMB No. 0651-0050 (Exp. 04/2009)

Response to Office Action

To the Commissioner for Trademarks:

Application serial no. **77476107** has been amended as follows:

ARGUMENT(S)

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

On behalf of Phoenix 2008 LLC ("Applicant"), we hereby respond to the Office Action mailed September 2, 2008 regarding the application for registration of SPEEDVISION HD (Serial No. 77/476107) (the "Mark").

Likelihood of Confusion

The Examining Attorney refused the Mark for publication because of a likelihood of confusion with the mark in US Registration No. 2517630.

As of September 13, 2008, US Registration No. 2517630 was cancelled under Section 8, and therefore is no longer an active registered mark. Accordingly, Applicant respectfully requests that the Examining Attorney withdraw her refusal for likelihood of confusion

Furthermore, because US Registration No. 2517630 has been cancelled, the issue of ownership of the cited mark is no longer relevant.

Identification of Goods/Recitation of Services

The Examining Attorney found that a portion Applicant's recitation of services under Class 41 is indefinite and must be clarified because it is too broad and could include services in other international classes. The Examining Attorney has

suggested amended language for Applicant's Class 41 services, as well as the addition of services under Class 09.

suggested amended language for Applicant's Class 41 services, as well as the addition of services under Class 09. The Examining Attorney found Applicant's recitation of services for Class 38 to be acceptable.

With respect to Class 09, Applicant respectfully disagrees that the addition of Class 09 is necessary. Applicant's Mark is for programming that may be distributed on DVDs and other digital materials, but is not for the digital materials themselves. Moreover, the Examining Attorney's amendment to Applicant's services under Class 41 adequately covers Applicant's services as distributed on DVDs and other digital materials.

With respect to Class 41, Applicant accepts the Examining Attorney's amended language, and further specifies its Class 41 services in accordance with the Office Action, as follows (in its entirety):

Class 41: Entertainment services, namely, an on-going series featuring automobiles, airplanes, motorcycles, boats, and other modes of transportation provided through broadcast, cable and satellite television, radio broadcasts, mobile communications devices, wireless networks, and global computer networks; Entertainment services, namely, production of CDs, DVDs, videotapes, and other digital media featuring an on-going series featuring automobiles, airplanes, motorcycles, boats, and other modes of transportation; Production of cable television programs.

Applicant believes that the above-amended recitation of services for Class 41 does not include services outside the scope of the services set forth in Applicant's initial application. Applicant further states that, to the best of its knowledge, the filing fees for Classes 38 and 41 have already been paid.

DISCLAIMER REQUIRED

Applicant agrees to disclaim "HD" apart from the Mark as shown, and will amend its application accordingly.

CONCLUSION

For the foregoing reasons, Applicant requests that the Examining Attorney pass the Mark for registration on the Principal Register.

ADDITIONAL STATEMENTS

Disclaimer

No claim is made to the exclusive right to use HD apart from the mark as shown.

SIGNATURE(S)

Declaration Signature

I hereby elect to bypass the submission of a signed declaration, because I believe a declaration is not required by the rules of practice. I understand that the examining attorney could still, upon later review, require a signed declaration.

Response Signature

Signature: /brian j. hurh/ Date: 09/22/2008

Signatory's Name: Brian J. Hurh

Signatory's Position: Attorney

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.

Serial Number: 77476107

Internet Transmission Date: Mon Sep 22 14:30:33 EDT 2008

TEAS Stamp: USPTO/ROA-66.208.15.115-2008092214303374

8597-77476107-430ba7ace82b2cd657fb394f8

fl69c2bc-N/A-N/A-20080922142604741493

TDR Home

This document may be displayed as a PDF file containing images without text. You may view online or save the entire document by clicking on the file download icon in the upper right corner of this page. [[required PDF viewer](#)]

FAQ: Are you seeing only the first page of this PDF document?

If you need help:

- **General trademark information:** Please e-mail TrademarkAssistanceCenter@uspto.gov, or telephone either 571-272-9250 or 1-800-786-9199.
- **Technical help:** For instructions on how to use TDR, or help in resolving **technical** glitches, please e-mail TDR@uspto.gov. If outside of the normal business hours of the USPTO, please e-mail [Electronic Business Support](#), or call 1-800-786-9199.
- **Questions about USPTO programs:** Please e-mail [USPTO Contact Center \(UCC\)](#).

NOTE: Within any e-mail, please include your telephone number so we can talk to you directly, if necessary. Also, include the relevant serial number or registration number, if existing.

Document Description: **Response to Office Action**
 Mail / Create Date: **22-Sep-2008**

PTO Form 1957 (Rev 9/2005)
 OMB No. 0651-0050 (Exp. 04/2009)

Response to Office Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	77476098
LAW OFFICE ASSIGNED	LAW OFFICE 104
MARK SECTION (no change)	
ARGUMENT(S)	

On behalf of Phoenix 2008 LLC ("Applicant"), we hereby respond to the Office Action mailed September 2, 2008 regarding the application for registration of SPEEDVISION (Serial No. 77/476098) (the "Mark").

Likelihood of Confusion

The Examining Attorney refused the Mark for publication because of a likelihood of confusion with the mark in US Registration No. 2517630.

As of September 13, 2008, US Registration No. 2517630 was cancelled under Section 8, and therefore is no longer an active registered mark. Accordingly, Applicant respectfully requests that the Examining Attorney withdraw her refusal for likelihood of confusion.

Furthermore, because US Registration No. 2517630 has been cancelled, the issue of ownership of the cited mark is no longer relevant.

Recitation of Services

The Examining Attorney found that a portion Applicant's recitation of services under Class 41 is indefinite and must be clarified because it is too broad and could include services in other international classes. The Examining Attorney has suggested amended language for Applicant's Class 41 services, as well as the addition of services under Class 09. The Examining Attorney found Applicant's recitation of services for Class 38 to be acceptable.

With respect to Class 09, Applicant respectfully disagrees that the addition of Class 09 is necessary. Applicant's

With respect to Class 09, Applicant respectfully disagrees that the addition of Class 09 is necessary. Applicant's Mark is for programming that may be distributed on DVDs and other digital materials, but is not for the digital materials themselves. Moreover, the Examining Attorney's amendment to Applicant's services under Class 41 adequately covers Applicant's services as distributed on DVDs and other digital materials.

With respect to Class 41, Applicant accepts the Examining Attorney's amended language, and further specifies its Class 41 services in accordance with the Office Action, as follows (in its entirety):

Class 41: Entertainment services, namely, an on-going series featuring automobiles, airplanes, motorcycles, boats, and other modes of transportation provided through broadcast, cable and satellite television, radio broadcasts, mobile communications devices, wireless networks, and global computer networks;

Entertainment services, namely, production of CDs, DVDs, videotapes, and other digital media featuring an on-going series featuring automobiles, airplanes, motorcycles, boats, and other modes of transportation;

Production of cable television programs.

Applicant believes that the above-amended recitation of services for Class 41 does not include services outside the scope of the services set forth in Applicant's initial application. Applicant further states that, to the best of its knowledge, the filing fees for Classes 38 and 41 have already been paid.

CONCLUSION

For the foregoing reasons, Applicant requests that the Examining Attorney pass the Mark for registration on the Principal Register.

SIGNATURE SECTION

RESPONSE SIGNATURE	/brian j. hurh/
SIGNATORY'S NAME	Brian J. Hurh
SIGNATORY'S POSITION	Attorney
DATE SIGNED	09/22/2008
AUTHORIZED SIGNATORY	YES

FILING INFORMATION SECTION

SUBMIT DATE	Mon Sep 22 14:25:23 EDT 2008
TEAS STAMP	USPTO/ROA-66.208.15.115-2 0080922142523205865-77476 098-4307715a1378f57ca84fd 9bc8b6b2d552-N/A-N/A-2008

0922142148808508

PTO Form 1957 (Rev 9/2005)
OMB No. 0651-0050 (Exp. 04/2009)

Response to Office Action

To the Commissioner for Trademarks:

Application serial no. 77476098 has been amended as follows:

ARGUMENT(S)

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

On behalf of Phoenix 2008 LLC ("Applicant"), we hereby respond to the Office Action mailed September 2, 2008 regarding the application for registration of SPEEDVISION (Serial No. 77/476098) (the "Mark").

Likelihood of Confusion

The Examining Attorney refused the Mark for publication because of a likelihood of confusion with the mark in US Registration No. 2517630.

As of September 13, 2008, US Registration No. 2517630 was cancelled under Section 8, and therefore is no longer an active registered mark. Accordingly, Applicant respectfully requests that the Examining Attorney withdraw her refusal for likelihood of confusion

Furthermore, because US Registration No. 2517630 has been cancelled, the issue of ownership of the cited mark is no longer relevant.

Recitation of Services

The Examining Attorney found that a portion Applicant's recitation of services under Class 41 is indefinite and must be clarified because it is too broad and could include services in other international classes. The Examining Attorney has suggested amended language for Applicant's Class 41 services, as well as the addition of services under Class 09.

The Examining Attorney found Applicant's recitation of services for Class 38 to be acceptable.

With respect to Class 09, Applicant respectfully disagrees that the addition of Class 09 is necessary. Applicant's Mark is for programming that may be distributed on DVDs and other digital materials, but is not for the digital materials themselves. Moreover, the Examining Attorney's amendment to Applicant's services under Class 41 adequately covers Applicant's services as distributed on DVDs and other digital materials.

adequately covers Applicant's services as distributed on DVDs and other digital materials.

With respect to Class 41, Applicant accepts the Examining Attorney's amended language, and further specifies its Class 41 services in accordance with the Office Action, as follows (in its entirety):

Class 41: Entertainment services, namely, an on-going series featuring automobiles, airplanes, motorcycles, boats, and other modes of transportation provided through broadcast, cable and satellite television, radio broadcasts, mobile communications devices, wireless networks, and global computer networks; Entertainment services, namely, production of CDs, DVDs, videotapes, and other digital media featuring an on-going series featuring automobiles, airplanes, motorcycles, boats, and other modes of transportation; Production of cable television programs.

Applicant believes that the above-amended recitation of services for Class 41 does not include services outside the scope of the services set forth in Applicant's initial application. Applicant further states that, to the best of its knowledge, the filing fees for Classes 38 and 41 have already been paid.

CONCLUSION

For the foregoing reasons, Applicant requests that the Examining Attorney pass the Mark for registration on the Principal Register.

SIGNATURE(S)

Response Signature

Signature: /brian j. hurh/ Date: 09/22/2008

Signatory's Name: Brian J. Hurh

Signatory's Position: Attorney

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.

Serial Number: 77476098

Internet Transmission Date: Mon Sep 22 14:25:23 EDT 2008

TEAS Stamp: USPTO/ROA-66.208.15.115-2008092214252320
5865-77476098-4307715a1378f57ca84fd9bc8b
6b2d552-N/A-N/A-20080922142148808508

TDR Home

This document may be displayed as a PDF file containing images without text. You may view online or save the entire document by clicking on the file download icon in the upper right corner of this page. [[required PDF viewer](#)]

FAQ: Are you seeing only the first page of this PDF document?

If you need help:

- **General trademark information:** Please e-mail TrademarkAssistanceCenter@uspto.gov, or telephone either 571-272-9250 or 1-800-786-9199.
- **Technical help:** For instructions on how to use TDR, or help in resolving **technical** glitches, please e-mail TDR@uspto.gov. If outside of the normal business hours of the USPTO, please e-mail [Electronic Business Support](#), or call 1-800-786-9199.
- **Questions about USPTO programs:** Please e-mail [USPTO Contact Center \(UCC\)](#).

NOTE: Within any e-mail, please include your telephone number so we can talk to you directly, if necessary. Also, include the relevant serial number or registration number, if existing.