

ESTTA Tracking number: **ESTTA613046**

Filing date: **07/01/2014**

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

Petition for Cancellation

Notice is hereby given that the following party requests to cancel indicated registration.

Petitioner Information

Name	GENIEO INNOVATION LTD.		
Entity	Corporation	Citizenship	Israel
Address	Hasadnaot 10 Herzlia Pitua, 46733 ISRAEL		

Attorney information	Jamie E. Platkin Cantor Colburn LLP 20 Church Street Floor 22 Hartford, CT 06103 UNITED STATES TM-CT@cantorcolburn.com, jplatkin@cantorcolburn.com Phone:860-286-2929
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Registration Subject to Cancellation

Registration No	4407296	Registration date	09/24/2013
Registrant	GENIO MULTIMEDIA, LLC 3401 SW 160th Avenue Suite 430 Miramar, FL 33027 UNITED STATES		

Goods/Services Subject to Cancellation

Class 009. First Use: 2010/09/03 First Use In Commerce: 2010/09/03 All goods and services in the class are cancelled, namely: Computer hardware and computer software programs for the integration of text, audio, graphics, still images and moving pictures into an interactive delivery for multimedia applications

Grounds for Cancellation

Abandonment	Trademark Act section 14
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Attachments	-Petition to Cancel with Exhibits.pdf(260011 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by Overnight Courier on this date.

Signature	/Jamie E. Platkin/
Name	Jamie E. Platkin

Date	07/01/2014
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of U.S. Trademark Registration No. 4,407,296

Mark: GENIO

Filed: January 22, 2010

Registered: September 24, 2013

GENIEO INNOVATION LTD.

Petitioner,

v.

GENIO MULTIMEDIA, LLC

Registrant.

Cancellation No: _____

PETITION TO CANCEL

Genieo Innovation Ltd. (“Petitioner”) believes that it has been and will continue to be damaged by the registration of the mark GENIO, which is the subject of U.S. Trademark Registration No. 4,407,296 (the “Registration”), registered to Genio Multimedia, LLC (“Registrant”). Accordingly, Petitioner, by its attorneys, hereby petitions for the cancellation of the Registration pursuant to 15 U.S.C. § 1064(3). As grounds for cancellation, Petitioner alleges as follows:

1. Petitioner is a corporation organized and existing under the laws of Israel, with a principal place of business at Hasadnaot 10, Herzlia, Pitua, Israel 46733.
2. Petitioner is the owner of pending U.S. Application Serial No. 85045221 for the trademark GENIEO (Stylized) and Design to identify “computer software that provides integrated application and software management by analyzing information about the user implicit actions and providing personalization services to applications within the user devices as computers, mobile phones, and TV's, combining information from

various applications, presenting it in a personalized homepage over the internet, and delivering online advertisements and services based on behavioral principles,” in International Class 9, filed on May 21, 2010 (the “Application”). A copy of the Application is attached hereto as **Exhibit A**. In addition, the TSDR record for the Application from the USPTO electronic database is attached hereto as **Exhibit B**.

3. Petitioner has been using the mark GENIEO (Stylized) and Design in connection with the goods listed in the Application since in or around late 2009.

Petitioner therefore owns common law rights to the mark GENIEO (Stylized) and Design for the goods listed in the Application.

4. In an Office Action dated March 26, 2014, the U.S. Patent and Trademark Office (“USPTO”) refused to register the GENIEO (Stylized) and Design mark, as depicted in the Application, based on a likelihood of confusion under Trademark Act Section 2(d) with the GENIO mark depicted in the Registration. This Office Action is attached hereto as **Exhibit C**. Petitioner will request that prosecution on the Application be suspended pending the outcome of this cancellation action.

5. The Registration indicates that the registrant of record is Genio Multimedia, LLC, a corporation organized under the laws of the State of Florida, with a principal place of business at 3401 SW 160th Avenue, Suite 430, Miramar, Florida 33027.

6. The Registration for GENIO lists “computer hardware and computer software programs for the integration of text, audio, graphics, still images and moving pictures into an interactive delivery for multimedia applications,” in International Class 9. The Registration indicates that the application was filed on January 22, 2010 and the

Registration issued on September 24, 2013. The Registration claims that GENIO has been in use in commerce since at least as early as September 3, 2010. A copy of the Registration Certificate for the Registration from the USPTO electronic database is attached hereto as **Exhibit D**. In addition, the TSDR record for the Registration from the USPTO electronic database is attached hereto as **Exhibit E**.

7. Petitioner is entitled to cancellation of the Registration because, on information and belief, Registrant has discontinued use of the mark GENIO in connection with the goods listed in the Registration and has no intent to resume such use. Thus, the GENIO trademark has been abandoned under 15 U.S.C. § 1127.

8. Petitioner is being and will be damaged by Registrant's registration of GENIO because the Registration is operating to bar registration of Petitioner's Application for the mark GENIEO (Stylized) and Design.

9. Based on the foregoing, the Board should cancel the Registration on the ground of abandonment pursuant to 15 U.S.C. § 1064(3).

WHEREFORE, Petitioner Genieo Innovation Ltd. respectfully requests the following:

- (a) That its Petition to Cancel be granted; and
- (b) That U.S. Registration No. 4,407,296 be cancelled.

Respectfully submitted,
Genieo Innovation Ltd.

Dated: July 1, 2014

By: /Jamie E. Platkin/
Jamie E. Platkin, Esq.
CANTOR COLBURN LLP
20 Church Street, 22nd Floor
Hartford, CT 06103
(860) 286-2929 (phone)
(860) 286-0115 (fax)
jplatkin@cantorcolburn.com

Attorney for Petitioner
GENIEO INNOVATION LTD.

CERTIFICATE OF SERVICE

I, Jamie E. Platkin, Esq., counsel to Genieo Innovation Ltd. in the above-captioned matter, certify that on the 1st day of July, 2014, served a copy of the foregoing Petition to Cancel via FEDEX upon the attorney of record for U.S. Registration No. 4,407,296 at the correspondence address of record:

Carol N. Green, Esq.
3401 SW 160TH Avenue
Suite 430
Miramar, FL 33027-6305

/Jamie E. Platkin/
Jamie E. Platkin

**In the United States Patent and Trademark Office
Before the Trademark Trial and Appeal Board**

In the Matter of U.S. Trademark Registration No. 4,407,296

Mark: GENIO

Filed: January 22, 2010

Registered: September 24, 2013

GENIEO INNOVATION LTD.

Petitioner,

v.

GENIO MULTIMEDIA, LLC

Registrant.

Cancellation No: _____

PETITIONER'S EXHIBIT A

Trademark/Service Mark Application, Principal Register

Serial Number: 85045221

Filing Date: 05/21/2010

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	85045221
MARK INFORMATION	
*MARK	\\TICRS\EXPORT10\IMAGEOUT10\850\452\85045221\xml1\ APP0002.JPG
SPECIAL FORM	YES
USPTO-GENERATED IMAGE	NO
LITERAL ELEMENT	GENIEO
COLOR MARK	NO
*DESCRIPTION OF THE MARK (and Color Location, if applicable)	The mark consists of a block design containing a house element and a stylized text that can be read as GENIE or GENIEO.
PIXEL COUNT ACCEPTABLE	NO
PIXEL COUNT	944 x 201
REGISTER	Principal
APPLICANT INFORMATION	
*OWNER OF MARK	Genieo Innovation Ltd.
*STREET	Hasadnaot 10, Mailbox No. 12630
*CITY	Herzlia Pitua
*COUNTRY	Israel
*ZIP/POSTAL CODE (Required for U.S. applicants only)	46733
LEGAL ENTITY INFORMATION	
TYPE	corporation
STATE/COUNTRY OF INCORPORATION	Israel

GOODS AND/OR SERVICES AND BASIS INFORMATION	
INTERNATIONAL CLASS	009
*IDENTIFICATION	Computer software that provides integrated application and software management by analyzing information about the user implicit actions and providing personalization services to applications within the user devices as computers, mobile phones, and TV's, combining information from various applications, presenting it in a personalized homepage over the internet, and delivering online advertisements and services based on behavioral principles
FILING BASIS	SECTION 1(b)
ATTORNEY INFORMATION	
NAME	Stephen L. Baker
FIRM NAME	Baker and Rannells, PA
STREET	575 Route 28, Suite 102
CITY	Raritan
STATE	New Jersey
COUNTRY	United States
ZIP/POSTAL CODE	08869
PHONE	908-722-5640
FAX	908-725-7088
EMAIL ADDRESS	officeactions@br-tmlaw.com
AUTHORIZED TO COMMUNICATE VIA EMAIL	Yes
OTHER APPOINTED ATTORNEY	Stephen Baker, Neil B. Friedman, John M. Rannells, Ryan A. McGonigle
CORRESPONDENCE INFORMATION	
NAME	Stephen L. Baker
FIRM NAME	Baker and Rannells, PA
STREET	575 Route 28, Suite 102
CITY	Raritan
STATE	New Jersey
COUNTRY	United States

ZIP/POSTAL CODE	08869
PHONE	908-722-5640
FAX	908-725-7088
EMAIL ADDRESS	officeactions@br-tmlaw.com
AUTHORIZED TO COMMUNICATE VIA EMAIL	Yes
FEE INFORMATION	
NUMBER OF CLASSES	1
FEE PER CLASS	325
*TOTAL FEE DUE	325
*TOTAL FEE PAID	325
SIGNATURE INFORMATION	
SIGNATURE	/Stephen L. Baker/
SIGNATORY'S NAME	Stephen L. Baker
SIGNATORY'S POSITION	attorney of record NY/NJ
DATE SIGNED	05/21/2010

Trademark/Service Mark Application, Principal Register

Serial Number: 85045221

Filing Date: 05/21/2010

To the Commissioner for Trademarks:

MARK: GENIEO (stylized and/or with design, see [mark](#))

The literal element of the mark consists of GENIEO.

The applicant is not claiming color as a feature of the mark. The mark consists of a block design containing a house element and a stylized text that can be read as GENIE or GENIEO.

The applicant, Genieo Innovation Ltd., a corporation of Israel, having an address of

Hasadnaot 10, Mailbox No. 12630

Herzlia Pitua 46733

Israel

requests registration of the trademark/service mark identified above in the United States Patent and Trademark Office on the Principal Register established by the Act of July 5, 1946 (15 U.S.C. Section 1051 et seq.), as amended, for the following:

International Class 009: Computer software that provides integrated application and software management by analyzing information about the user implicit actions and providing personalization services to applications within the user devices as computers, mobile phones, and TV's, combining information from various applications, presenting it in a personalized homepage over the internet, and delivering online advertisements and services based on behavioral principles

Intent to Use: The applicant has a bona fide intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the identified goods and/or services. (15 U.S.C. Section 1051(b)).

The applicant's current Attorney Information:

Stephen L. Baker and Stephen Baker, Neil B. Friedman, John M. Rannells, Ryan A. McGonigle of Baker and Rannells, PA

575 Route 28, Suite 102

Raritan, New Jersey 08869

United States

The applicant's current Correspondence Information:

Stephen L. Baker

Baker and Rannells, PA

575 Route 28, Suite 102

Raritan, New Jersey 08869

908-722-5640(phone)

908-725-7088(fax)

officeactions@br-tmlaw.com (authorized)

A fee payment in the amount of \$325 has been submitted with the application, representing payment for 1 class(es).

Declaration

The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. Section 1001, and that such willful false statements, and the like, may jeopardize the validity of the application or any resulting registration, declares that he/she is properly authorized to execute this application on behalf of the applicant; he/she believes the applicant to be the owner of the trademark/service mark sought to be registered, or, if the application is being filed under 15 U.S.C. Section 1051(b), he/she believes applicant to be entitled to use such mark in commerce; to the best of his/her knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive; and that all statements made of his/her own knowledge are true; and that all statements made on information and belief are believed to be true.

Signature: /Stephen L. Baker/ Date Signed: 05/21/2010

Signatory's Name: Stephen L. Baker

Signatory's Position: attorney of record NY/NJ

RAM Sale Number: 4517

RAM Accounting Date: 05/24/2010

Serial Number: 85045221

Internet Transmission Date: Fri May 21 16:45:36 EDT 2010

TEAS Stamp: USPTO/BAS-67.85.218.146-2010052116453621

9947-85045221-460de70d9926b6d761b18ada74

734d5ad6e-CC-4517-20100521163425140992



**In the United States Patent and Trademark Office
Before the Trademark Trial and Appeal Board**

In the Matter of U.S. Trademark Registration No. 4,407,296

Mark: GENIO

Filed: January 22, 2010

Registered: September 24, 2013

GENIEO INNOVATION LTD.

Petitioner,

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Registrant.

Cancellation No: _____

PETITIONER'S EXHIBIT B

Generated on: This page was generated by TSDR on 2014-07-01 09:40:57 EDT

Mark: GENIEO



US Serial Number: 85045221

Application Filing Date: May 21, 2010

Register: Principal

Mark Type: Trademark

Status: A non-final Office action has been sent (issued) to the applicant. This is a letter from the examining attorney requiring additional information and/or making an initial refusal. The applicant must respond to this Office action. To view all documents in this file, click on the Trademark Document Retrieval link at the top of this page.

Status Date: Mar. 26, 2014

Mark Information

Mark Literal Elements: GENIEO

Standard Character Claim: No

Mark Drawing Type: 3 - AN ILLUSTRATION DRAWING WHICH INCLUDES WORD(S)/ LETTER(S)/NUMBER(S)

Description of Mark: The mark consists of a block design containing a house element and a stylized text that can be read as GENIE or GENIEO.

Color(s) Claimed: Color is not claimed as a feature of the mark.

Design Search Code(s): 07.01.04 - Detached house
07.01.06 - Other houses
26.01.17 - Concentric circles, two; Circles, two concentric; Two concentric circles
26.01.21 - Circles that are totally or partially shaded.
26.09.02 - Plain single line squares; Squares, plain single line
26.11.21 - Rectangles that are completely or partially shaded
27.03.01 - Geometric figures forming letters, numerals or punctuation

Goods and Services

Note: The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis ((...)) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- Asterisks *..* identify additional (new) wording in the goods/services.

For: Computer software that provides integrated application and software management by analyzing information about the user implicit actions and providing personalization services to applications within the user devices as computers, mobile phones, and TV's, combining information from various applications, presenting it in a personalized homepage over the internet, and delivering online advertisements and services based on behavioral principles

International Class(es): 009 - Primary Class

U.S Class(es): 021, 023, 026, 036, 038

Class Status: ACTIVE

Basis: 1(b)

Basis Information (Case Level)

Filed Use: No

Currently Use: No

Amended Use: No

Filed ITU: Yes

Currently ITU: Yes

Amended ITU: No

Filed 44D: No

Currently 44D: No

Amended 44D: No

Filed 44E: No

Currently 44E: No

Amended 44E: No

Filed 66A: No

Currently 66A: No

Filed No Basis: No

Currently No Basis: No

Current Owner(s) Information

Owner Name: Genieo Innovation Ltd.

Owner Address: Hasadnaot 10, Mailbox No. 12630
Herzlia Pitua 46733
ISRAEL

Legal Entity Type: CORPORATION

State or Country Where Organized: ISRAEL

Attorney/Correspondence Information

Attorney of Record

Attorney Name: Jamie E. Platkin

Docket Number: YSC0008TUS

Attorney Primary Email tm-ct@cantorcolburn.com
Address:

Attorney Email Yes
Authorized:

Correspondent

Correspondent Name/Address: Jamie E. Platkin
Cantor Colburn LLP
20 Church Street
22nd Floor
Hartford, CONNECTICUT 06103
UNITED STATES

Phone: 8602862929

Fax: 8602860115

Correspondent e-mail: tm-ct@cantorcolburn.com

Correspondent e-mail Yes
Authorized:

Domestic Representative

Domestic Representative Name: Jamie E. Platkin

Phone: 8602862929

Fax: 8602860115

Domestic Representative e-mail: tm-ct@cantorcolburn.com

Domestic Representative e-mail Yes
Authorized:

Prosecution History

Date	Description	Proceeding Number
May 29, 2014	ATTORNEY REVOKED AND/OR APPOINTED	
May 29, 2014	TEAS REVOKE/APPOINT ATTORNEY RECEIVED	
Mar. 26, 2014	NOTIFICATION OF NON-FINAL ACTION E-MAILED	6325
Mar. 26, 2014	NON-FINAL ACTION E-MAILED	6325
Mar. 26, 2014	NON-FINAL ACTION WRITTEN	68356
Mar. 12, 2014	LIE CHECKED SUSP - TO ATTY FOR ACTION	70629
Sep. 11, 2013	REPORT COMPLETED SUSPENSION CHECK CASE STILL SUSPENDED	
Mar. 11, 2013	REPORT COMPLETED SUSPENSION CHECK CASE STILL SUSPENDED	
Feb. 08, 2013	ASSIGNED TO EXAMINER	68356
Sep. 10, 2012	REPORT COMPLETED SUSPENSION CHECK CASE STILL SUSPENDED	70629
Mar. 08, 2012	REPORT COMPLETED SUSPENSION CHECK CASE STILL SUSPENDED	70629
Sep. 08, 2011	REPORT COMPLETED SUSPENSION CHECK CASE STILL SUSPENDED	70629
Mar. 08, 2011	REPORT COMPLETED SUSPENSION CHECK CASE STILL SUSPENDED	70629
Mar. 08, 2011	ASSIGNED TO LIE	70629
Sep. 03, 2010	NOTIFICATION OF LETTER OF SUSPENSION E-MAILED	6332
Sep. 03, 2010	LETTER OF SUSPENSION E-MAILED	6332
Sep. 03, 2010	SUSPENSION LETTER WRITTEN	83361
Sep. 03, 2010	ASSIGNED TO EXAMINER	83361
May 27, 2010	NOTICE OF DESIGN SEARCH CODE AND PSEUDO MARK MAILED	
May 26, 2010	NEW APPLICATION OFFICE SUPPLIED DATA ENTERED IN TRAM	
May 25, 2010	NEW APPLICATION ENTERED IN TRAM	

TM Staff and Location Information

TM Staff Information

TM Attorney: VANSTON, KATHLEEN MARY

Law Office Assigned: LAW OFFICE 107

File Location

Current Location: TMEG LAW OFFICE 107 - EXAMINING
ATTORNEY ASSIGNED

Date in Location: Mar. 26, 2014

**In the United States Patent and Trademark Office
Before the Trademark Trial and Appeal Board**

In the Matter of U.S. Trademark Registration No. 4,407,296

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GENIEO INNOVATION LTD.

Petitioner,

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GENIO MULTIMEDIA, LLC

Registrant.

Cancellation No: _____

PETITIONER'S EXHIBIT C

To: Genieo Innovation Ltd. (officeactions@br-tmlaw.com)
Subject: U.S. TRADEMARK APPLICATION NO. 85045221 - GENIEO - N/A
Sent: 3/26/2014 6:57:19 AM
Sent As: ECOM107@USPTO.GOV
Attachments: [Attachment - 1](#)
[Attachment - 2](#)

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

U.S. APPLICATION SERIAL NO. 85045221

MARK: GENIEO

85045221

CORRESPONDENT ADDRESS:

STEPHEN L. BAKER
BAKER AND RANNELLS, PA
575 ROUTE 28 STE 102
RARITAN, NJ 08869-1354

CLICK HERE TO RESPOND TO
<http://www.uspto.gov/trademarks/teas/r>

APPLICANT: Genieo Innovation Ltd.

CORRESPONDENT'S REFERENCE/DOCKET NO :

N/A

CORRESPONDENT E-MAIL ADDRESS:

officeactions@br-tmlaw.com

OFFICE ACTION

STRICT DEADLINE TO RESPOND TO THIS LETTER

TO AVOID ABANDONMENT OF APPLICANT'S TRADEMARK APPLICATION, THE USPTO MUST RECEIVE APPLICANT'S COMPLETE RESPONSE TO THIS LETTER **WITHIN 6 MONTHS** OF THE ISSUE/MAILING DATE BELOW.

ISSUE/MAILING DATE: 3/26/2014

Application Serial No. 77/918083 has matured into a registration. Prosecution of this application is, therefore, resumed.

SECTION 2(d) REFUSAL – LIKELIHOOD OF CONFUSION

Registration of the applied-for mark is refused because of a likelihood of confusion with the mark in U.S. Registration No. 4407296. Trademark Act Section 2(d), 15 U.S.C. §1052(d); *see* TMEP §§1207.01 *et seq.* See the enclosed registration.

In any likelihood of confusion determination, two key considerations are similarity of the marks and similarity or relatedness of the goods. *Syndicat Des Proprietaires Viticulteurs De Chateauneuf-Du-Pape v. Pasquier DesVignes*, 107 USPQ2d 1930, 1938 (TTAB 2013) (citing *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 1103, 192 USPQ 24, 29 (C.C.P.A. 1976)); *In re Iolo Techs., LLC*, 95 USPQ2d 1498, 1499 (TTAB 2010); see TMEP §1207.01. That is, the marks are compared in their entireties for similarities in appearance, sound, connotation, and commercial impression. *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (quoting *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973)); TMEP §1207.01(b)-(b)(v). Additionally, the goods are compared to determine whether they are similar or commercially related or travel in the same trade channels. See *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1369-71, 101 USPQ2d 1713, 1722-23 (Fed. Cir. 2012); *Herbko Int'l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1165, 64 USPQ2d 1375, 1381 (Fed. Cir. 2002); TMEP §1207.01, (a)(vi).

- *Comparison of Marks*

Applicant is using GENIEO with a house design. For a composite mark containing both words and a design, the word portion may be more likely to be impressed upon a purchaser's memory and to be used when requesting the goods. *Joel Gott Wines, LLC v. Rehoboth Von Gott, Inc.*, 107 USPQ2d 1424, 1431 (TTAB 2013) (citing *In re Dakin's Miniatures, Inc.*, 59 USPQ2d 1593, 1596 (TTAB 1999)); TMEP §1207.01(c)(ii); see *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908, 1911 (Fed. Cir. 2012) (citing *CBS Inc. v. Morrow*, 708 F. 2d 1579, 1581-82, 218 USPQ 198, 200 (Fed. Cir 1983)). Thus, although such marks must be compared in their entireties, the word portion is often considered the dominant feature and is accorded greater weight in determining whether marks are confusingly similar, even where the word portion has been disclaimed. *In re Viterra Inc.*, 671 F.3d at 1366, 101 USPQ2d at 1911 (Fed. Cir. 2012) (citing *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 1570-71, 218 USPQ2d 390, 395 (Fed. Cir. 1983)). GENIEO, therefore, is the dominant feature of applicant's mark.

Registrant is using GENIO. The word portion of applicant's mark is GENIEO. The word portions of the marks are essentially phonetic equivalents and thus sound similar. Similarity in sound alone may be sufficient to support a finding that the marks are confusingly similar. *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988); see *In re 1st USA Realty Prof'ls, Inc.*, 84 USPQ2d 1581, 1586 (TTAB 2007); TMEP §1207.01(b)(iv). The word portions of the marks are nearly identical in appearance, sound, connotation, and commercial impression; therefore, the addition of a design element does not obviate the similarity of the marks in this case. See *In re Shell Oil Co.*, 992 F.2d 1204, 1206, 26 USPQ2d 1687, 1688 (Fed. Cir. 1993); TMEP §1207.01(c)(ii).

- *Comparison of Goods*

The goods of the parties need not be identical or even competitive to find a likelihood of confusion. See *On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 1086, 56 USPQ2d 1471, 1475 (Fed. Cir. 2000); *Recot, Inc. v. Becton*, 214 F.3d 1322, 1329, 54 USPQ2d 1894, 1898 (Fed. Cir. 2000) (“[E]ven if the goods in question are different from, and thus not related to, one another in kind, the same goods can be related in the mind of the consuming public as to the origin of the goods.”); TMEP §1207.01(a)(i).

The respective goods need only be “related in some manner and/or if the circumstances surrounding their marketing [be] such that they could give rise to the mistaken belief that the goods emanate from the same source.” *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1369, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012) (quoting *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1724 (TTAB 2007)); *Gen. Mills Inc. v. Fage Dairy Processing Indus. SA*, 100 USPQ2d 1584, 1597 (TTAB 2011); TMEP §1207.01(a)(i).

Registrant is using its mark on “computer hardware and computer software programs for the integration of text, audio, graphics, still images and moving pictures into an interactive delivery for multimedia applications.” Applicant intends to use its mark on “computer software that provides integrated application and software management by analyzing information about the user implicit actions and providing personalization services to applications within the user devices as computers, mobile phones, and TV's, combining information from various applications, presenting it in a personalized homepage over the internet, and delivering online advertisements and services based on behavioral principles.” Both registrant and applicant are using or intend to use their marks on software for the integration and delivery of multimedia content to users. The function of the software of each party, therefore, is virtually identical.

The similarities between the marks, therefore, and the relatedness of the services create a substantial likelihood that consumers may be confused as to the source of the goods.

Although applicant's mark has been refused registration, applicant may respond to the refusal(s) by submitting evidence and arguments in support of registration.

Applicant must respond to the requirement(s) set forth below.

IDENTIFICATION OF GOODS

The identification of goods is indefinite and must be clarified as noted. *See* TMEP §1402.01. Applicant may adopt the following identification, if accurate: “Computer software for creating a personalized homepage over the Internet, for personalizing applications on user devices in the nature of computers, mobile phones and televisions and for delivery of personalized on-line advertisements and services, all of the foregoing based upon integration of information from a variety of application based sources and incorporating analysis about user implicit actions,” in Class 9.

An applicant may amend an identification of goods only to clarify or limit the goods; adding to or broadening the scope of the goods is not permitted. 37 C.F.R. §2.71(a); *see* TMEP §§1402.06 *et seq.*, 1402.07 *et seq.*

For assistance with identifying and classifying goods and services in trademark applications, please see the USPTO's online searchable *U.S. Acceptable Identification of Goods and Services Manual* at <http://tess2.uspto.gov/netatml/tidm.html>. *See* TMEP §1402.04.

DESCRIPTION OF MARK REQUIRED

The description of the mark is accurate but incomplete because it does not describe all the significant aspects of the applied-for mark. Applications for marks not in standard characters must include an accurate and concise description of the entire mark that identifies literal elements as well as any design elements. *See* 37 C.F.R. §2.37; TMEP §§808 *et seq.*

Therefore, applicant must provide a more complete description of the applied-for mark. The following is suggested:

The mark consists of a block design containing a house element and a stylized text containing the lettering “GENIEO” in which the letter “O” is contained within a rectangular design .

EXPLANATION OF MARK'S SIGNIFICANCE REQUIRED

Applicant must specify whether “GENIEO” in the mark has any meaning in a foreign language. *See* 37 C.F.R. §2.32(a)(9); TMEP §§809, 814. An applicant must submit an English translation of all foreign wording in a mark. 37 C.F.R. §2.32(a)(9); TMEP §809.

Accordingly, if the wording has meaning in a foreign language, applicant should provide the following translation statement:

The English translation of the word “GENIEO” in the mark is “[specify]”.

TMEP §809.03.

Alternatively, if the wording does not have meaning in a foreign language, applicant should provide the following statement:

The wording “GENIEO” has no meaning in a foreign language.

Id.

SUMMARY OF ISSUES that applicant must address:

- Trademark Act Section 2(d) refusal based upon likelihood of confusion with a registered mark
- Requirement to amend the identification of goods
- Requirement to amend the mark description
- Requirement to indicate whether or not GENIEO has an English translation

/Kathleen M. Vanston/
Examining Attorney
Law Office 107
(571) 272-9235
kathy.vanston@uspto.gov [for informal inquiries only]

TO RESPOND TO THIS LETTER: Go to http://www.uspto.gov/trademarks/teas/response_forms.jsp. Please wait 48-72 hours from the issue/ mailing date before using the Trademark Electronic Application System (TEAS), to allow for necessary system updates of the application. For *technical* assistance with online forms, e-mail TEAS@uspto.gov. For questions about the Office action itself, please contact the assigned trademark examining attorney. **E-mail communications will not be accepted as responses to Office actions; therefore, do not respond to this Office action by e-mail.**

All informal e-mail communications relevant to this application will be placed in the official application record.

WHO MUST SIGN THE RESPONSE: It must be personally signed by an individual applicant or someone with legal authority to bind an applicant (i.e., a corporate officer, a general partner, all joint applicants). If an applicant is represented by an attorney, the attorney must sign the response.

PERIODICALLY CHECK THE STATUS OF THE APPLICATION: To ensure that applicant does not miss crucial deadlines or official notices, check the status of the application every three to four months using the Trademark Status and Document Retrieval (TSDR) system at <http://tsdr.uspto.gov/>. Please keep a copy of the TSDR status screen. If the status shows no change for more than six months, contact the Trademark Assistance Center by e-mail at TrademarkAssistanceCenter@uspto.gov or call 1-800-786-9199. For more information on checking status, see <http://www.uspto.gov/trademarks/process/status/>.

TO UPDATE CORRESPONDENCE/E-MAIL ADDRESS: Use the TEAS form at <http://www.uspto.gov/trademarks/teas/correspondence.jsp>.

Print: Mar 26, 2014

77918083

DESIGN MARK

Serial Number

77918083

Status

REGISTERED

Word Mark

GENIO

Standard Character Mark

Yes

Registration Number

4407296

Date Registered

2013/09/24

Type of Mark

TRADEMARK

Register

PRINCIPAL

Mark Drawing Code

(4) STANDARD CHARACTER MARK

Owner

GENIO MULTIMEDIA, LLC CORPORATION FLORIDA 3401 SW 160th Avenue Suite
430 Miramar FLORIDA 33027

Goods/Services

Class Status -- ACTIVE. IC 009. US 021 023 026 036 038. G & S:
Computer hardware and computer software programs for the integration
of text, audio, graphics, still images and moving pictures into an
interactive delivery for multimedia applications. First User
2010/09/03. First Use In Commerce: 2010/09/03.

Filing Date

2010/01/22

Examining Attorney

MCCRAY, RENEE

Attorney of Record

Carol N. Green, Esq.

GENIO

To: Genieo Innovation Ltd. (officeactions@br-tmlaw.com)
Subject: U.S. TRADEMARK APPLICATION NO. 85045221 - GENIEO - N/A
Sent: 3/26/2014 6:57:20 AM
Sent As: ECOM107@USPTO.GOV
Attachments:

UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

**IMPORTANT NOTICE REGARDING YOUR
U.S. TRADEMARK APPLICATION**

USPTO OFFICE ACTION (OFFICIAL LETTER) HAS ISSUED
ON **3/26/2014** FOR U.S. APPLICATION SERIAL NO. 85045221

Please follow the instructions below:

(1) **TO READ THE LETTER:** Click on this [link](#) or go to <http://tsdr.uspto.gov>, enter the U.S. application serial number, and click on “Documents.”

The Office action may not be immediately viewable, to allow for necessary system updates of the application, but will be available within 24 hours of this e-mail notification.

(2) **TIMELY RESPONSE IS REQUIRED:** Please carefully review the Office action to determine (1) how to respond, and (2) the applicable response time period. Your response deadline will be calculated from **3/26/2014** (or sooner if specified in the Office action). For information regarding response time periods, see <http://www.uspto.gov/trademarks/process/status/responsetime.jsp>.

Do NOT hit “Reply” to this e-mail notification, or otherwise e-mail your response because the USPTO does NOT accept e-mails as responses to Office actions. Instead, the USPTO recommends that you respond online using the Trademark Electronic Application System (TEAS) response form located at http://www.uspto.gov/trademarks/teas/response_forms.jsp.

(3) **QUESTIONS:** For questions about the contents of the Office action itself, please contact the assigned trademark examining attorney. For *technical* assistance in accessing or viewing the Office action in the Trademark Status and Document Retrieval (TSDR) system, please e-mail TSDR@uspto.gov.

WARNING

Failure to file the required response by the applicable response deadline will result in the ABANDONMENT of your application. For more information regarding abandonment, see

<http://www.uspto.gov/trademarks/basics/abandon.jsp>.

PRIVATE COMPANY SOLICITATIONS REGARDING YOUR APPLICATION: Private companies **not** associated with the USPTO are using information provided in trademark applications to mail or e-mail trademark-related solicitations. These companies often use names that closely resemble the USPTO and their solicitations may look like an official government document. Many solicitations require that you pay “fees.”

Please carefully review all correspondence you receive regarding this application to make sure that you are responding to an official document from the USPTO rather than a private company solicitation. All official USPTO correspondence will be mailed only from the “United States Patent and Trademark Office” in Alexandria, VA; or sent by e-mail from the domain “@uspto.gov.” For more information on how to handle private company solicitations, see http://www.uspto.gov/trademarks/solicitation_warnings.jsp.

**In the United States Patent and Trademark Office
Before the Trademark Trial and Appeal Board**

In the Matter of U.S. Trademark Registration No. 4,407,296

Mark: GENIO

Filed: January 22, 2010

Registered: September 24, 2013

GENIEO INNOVATION LTD.

Petitioner,

v.

GENIO MULTIMEDIA, LLC

Registrant.

Cancellation No: _____

PETITIONER'S EXHIBIT D

United States of America
United States Patent and Trademark Office

GENIO

Reg. No. 4,407,296

Registered Sep. 24, 2013

Int. Cl.: 9

TRADEMARK

PRINCIPAL REGISTER

GENIO MULTIMEDIA, LLC (FLORIDA CORPORATION)
3401 SW 160TH AVENUE SUITE 430
MIRAMAR, FL 33027

FOR: COMPUTER HARDWARE AND COMPUTER SOFTWARE PROGRAMS FOR THE INTEGRATION OF TEXT, AUDIO, GRAPHICS, STILL IMAGES AND MOVING PICTURES INTO AN INTERACTIVE DELIVERY FOR MULTIMEDIA APPLICATIONS, IN CLASS 9 (U.S. CLS. 21, 23, 26, 36 AND 38).

FIRST USE 9-3-2010; IN COMMERCE 9-3-2010.

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT, STYLE, SIZE, OR COLOR.

SN 77-918,083, FILED 1-22-2010.

RENEE MCCRAY, EXAMINING ATTORNEY



Lisa Street Lee

Deputy Director of the United States Patent and Trademark Office

**REQUIREMENTS TO MAINTAIN YOUR FEDERAL
TRADEMARK REGISTRATION**

**WARNING: YOUR REGISTRATION WILL BE CANCELLED IF YOU DO NOT FILE THE
DOCUMENTS BELOW DURING THE SPECIFIED TIME PERIODS.**

Requirements in the First Ten Years*

What and When to File:

First Filing Deadline: You must file a Declaration of Use (or Excusable Nonuse) between the 5th and 6th years after the registration date. *See* 15 U.S.C. §§1058, 1141k. If the declaration is accepted, the registration will continue in force for the remainder of the ten-year period, calculated from the registration date, unless cancelled by an order of the Commissioner for Trademarks or a federal court.

Second Filing Deadline: You must file a Declaration of Use (or Excusable Nonuse) **and** an Application for Renewal between the 9th and 10th years after the registration date.*
See 15 U.S.C. §1059.

Requirements in Successive Ten-Year Periods*

What and When to File:

You must file a Declaration of Use (or Excusable Nonuse) **and** an Application for Renewal between every 9th and 10th-year period, calculated from the registration date.*

Grace Period Filings*

The above documents will be accepted as timely if filed within six months after the deadlines listed above with the payment of an additional fee.

**The United States Patent and Trademark Office (USPTO) will NOT send you any future notice or
reminder of these filing requirements.**

***ATTENTION MADRID PROTOCOL REGISTRANTS:** The holder of an international registration with an extension of protection to the United States under the Madrid Protocol must timely file the Declarations of Use (or Excusable Nonuse) referenced above directly with the USPTO. The time periods for filing are based on the U.S. registration date (not the international registration date). The deadlines and grace periods for the Declarations of Use (or Excusable Nonuse) are identical to those for nationally issued registrations. *See* 15 U.S.C. §§1058, 1141k. However, owners of international registrations do not file renewal applications at the USPTO. Instead, the holder must file a renewal of the underlying international registration at the International Bureau of the World Intellectual Property Organization, under Article 7 of the Madrid Protocol, before the expiration of each ten-year term of protection, calculated from the date of the international registration. *See* 15 U.S.C. §1141j. For more information and renewal forms for the international registration, see <http://www.wipo.int/madrid/en/>.

NOTE: Fees and requirements for maintaining registrations are subject to change. Please check the USPTO website for further information. With the exception of renewal applications for registered extensions of protection, you can file the registration maintenance documents referenced above online at <http://www.uspto.gov>.

**In the United States Patent and Trademark Office
Before the Trademark Trial and Appeal Board**

In the Matter of U.S. Trademark Registration No. 4,407,296

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GENIO MULTIMEDIA, LLC

Registrant.

Cancellation No: _____

PETITIONER'S EXHIBIT E

Phone: 305-371-5858

Fax: 954-374-8728

Correspondent e-mail: carol.green@isaacdanielgroup.com pamela.bailey@isaacdanielgroup.com legal@isaacdanielgroup.com

Correspondent e-mail Yes
Authorized:

Domestic Representative - Not Found

Prosecution History

Date	Description	Proceeding Number
Sep. 24, 2013	REGISTERED-PRINCIPAL REGISTER	
Aug. 20, 2013	NOTICE OF ACCEPTANCE OF STATEMENT OF USE E-MAILED	
Aug. 19, 2013	LAW OFFICE REGISTRATION REVIEW COMPLETED	73296
Aug. 16, 2013	ALLOWED PRINCIPAL REGISTER - SOU ACCEPTED	
Aug. 13, 2013	STATEMENT OF USE PROCESSING COMPLETE	66530
Aug. 03, 2013	USE AMENDMENT FILED	66530
Aug. 05, 2013	TEAS STATEMENT OF USE RECEIVED	
Apr. 25, 2013	TEAS CHANGE OF CORRESPONDENCE RECEIVED	
Feb. 07, 2013	NOTICE OF APPROVAL OF EXTENSION REQUEST MAILED	
Feb. 06, 2013	EXTENSION 5 GRANTED	66530
Feb. 03, 2013	EXTENSION 5 FILED	66530
Feb. 04, 2013	TEAS EXTENSION RECEIVED	
Aug. 08, 2012	NOTICE OF APPROVAL OF EXTENSION REQUEST MAILED	
Aug. 07, 2012	EXTENSION 4 GRANTED	66530
Aug. 03, 2012	EXTENSION 4 FILED	66530
Aug. 03, 2012	TEAS EXTENSION RECEIVED	
Mar. 03, 2012	NOTICE OF APPROVAL OF EXTENSION REQUEST MAILED	
Mar. 02, 2012	EXTENSION 3 GRANTED	66530
Feb. 03, 2012	EXTENSION 3 FILED	66530
Feb. 03, 2012	TEAS EXTENSION RECEIVED	
Aug. 05, 2011	NOTICE OF APPROVAL OF EXTENSION REQUEST MAILED	
Aug. 04, 2011	EXTENSION 2 GRANTED	66530
Aug. 01, 2011	EXTENSION 2 FILED	66530
Aug. 01, 2011	TEAS EXTENSION RECEIVED	
Feb. 19, 2011	NOTICE OF APPROVAL OF EXTENSION REQUEST MAILED	
Feb. 18, 2011	EXTENSION 1 GRANTED	66530
Feb. 02, 2011	EXTENSION 1 FILED	66530
Feb. 18, 2011	CASE ASSIGNED TO INTENT TO USE PARALEGAL	66530
Feb. 02, 2011	TEAS EXTENSION RECEIVED	
Dec. 29, 2010	TEAS CHANGE OF CORRESPONDENCE RECEIVED	
Aug. 03, 2010	NOA MAILED - SOU REQUIRED FROM APPLICANT	
Jun. 08, 2010	PUBLISHED FOR OPPOSITION	
May 19, 2010	NOTICE OF PUBLICATION	
May 04, 2010	LAW OFFICE PUBLICATION REVIEW COMPLETED	73296
May 04, 2010	ASSIGNED TO LIE	73296
Apr. 22, 2010	APPROVED FOR PUB - PRINCIPAL REGISTER	
Apr. 21, 2010	ASSIGNED TO EXAMINER	78434
Jan. 28, 2010	NEW APPLICATION OFFICE SUPPLIED DATA ENTERED IN TRAM	
Jan. 26, 2010	NEW APPLICATION ENTERED IN TRAM	

TM Staff and Location Information

TM Staff Information - None

File Location

Current Location: PUBLICATION AND ISSUE SECTION

Date in Location: Aug. 19, 2013