

## Request for Reconsideration after Final Action

**The table below presents the data as entered.**

Input Field	Entered
<b>SERIAL NUMBER</b>	79250118
<b>LAW OFFICE ASSIGNED</b>	LAW OFFICE 125
<b>MARK SECTION</b>	
<b>MARK</b>	<a href="https://tmng-al.uspto.gov/resting2/api/img/79250118/large">https://tmng-al.uspto.gov/resting2/api/img/79250118/large</a>
<b>LITERAL ELEMENT</b>	NEXIM
<b>STANDARD CHARACTERS</b>	YES
<b>USPTO-GENERATED IMAGE</b>	YES
<b>MARK STATEMENT</b>	The mark consists of standard characters, without claim to any particular font style, size or color.
<b>OWNER SECTION (current)</b>	
<b>NAME</b>	FUJI CORPORATION
<b>OWNER SECTION (proposed)</b>	
<b>NAME</b>	FUJI CORPORATION
<b>EMAIL</b>	mailroom@mg-ip.com
<b>ARGUMENT(S)</b>	
<p>Initially, Applicant's undersigned counsel thanks the Examining Attorney for discussing the refusal to register. As discussed, Applicant has amended its goods in Class 9, by further limiting and clarifying the specific nature of Applicant's computer programs. Applicant's software, as described by the amended list of goods, is used on product manufacturing lines in the production of printed circuit boards and providing information and reports relating to those activities. These goods should be contrasted with the cited registration, which identify the goods as "computer programs for use in computer aided engineering and design", or CAD software. As described by Wikipedia, "Computer-aided design" (CAD) is the use of computers (or workstations) to aid in the creation, modification, analysis, or optimization of a design. (<a href="https://en.wikipedia.org/wiki/Computer-aided_design">https://en.wikipedia.org/wiki/Computer-aided_design</a>). Applicant's software would be used in manufacturing lines to control the production of printed circuit boards and provide the manufacturer of those goods with detailed information about the manufacturing process. Thus, the goods serve different purposes and will be used in different settings, thereby making the risk of confusion very limited, and certainly not creating a likelihood of confusion, the requirement to refuse registration under Section 2(d) of the Trademark Act. It is well established that there is no per se rule that all software is related. See <i>Toro Co. v. ToroHead, Inc.</i>?61 USPQ2d 1164 (TTAB 2001); <i>In re Quadram Corp.</i>, 228 USPQ 863 (TTAB 1985); and <i>Hasbro Inc. v. Clue Computing, Inc.</i>, 66 F.Supp.2d 117, 52 USPQ2d. 1402 (D. Mass. 1999). Rather, the test that should apply is, as the Court of Appeals for the Federal Circuit instructed the Board, to simply "compare the services described in [applicant's] application with the goods and services described in [opposer's] registrations." <i>Hewlett-Packard Co. v. Packard Press Inc.</i>, 281 F.3d 1261, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002). In the present case, considering the respective goods, it becomes clear that the purpose of the two parties' software does not reasonably overlap, and is software that would be provided for different purposes and applications. In assessing the du Pont factors, <i>In re E. I. du Pont de Nemours &amp; Co.</i>, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973), the Examining Attorney will also consider, as an important factor, the sophistication of the purchasers. Applicant's goods, being commercial software that would be used in connection with assembly lines manufacturing printed circuit boards, would only be purchased by highly sophisticated consumers of such software. For the above reasons, Applicant respectfully submits that the cited registration should not serve as a barrier to registration of Applicant's mark, and the refusal should be withdrawn. Should the Examining Attorney have any questions, he is invited to contact Applicant's undersigned counsel. Meanwhile, due to the finality of this Office Action, Applicant has also noted an appeal with the TTAB and hopes that upon review of the amended identification and the arguments presented, the refusal will be withdrawn and the application allowed.</p>	
<b>GOODS AND/OR SERVICES SECTION (current)</b>	
<b>INTERNATIONAL CLASS</b>	009

<b>DESCRIPTION</b>	
Electronic computers including central processing units, electronic circuits and magnetic discs recorded with computer programs, other computer peripherals; recorded media, namely, recorded computer programs for managing printed circuit board assembly line management output; recorded media, namely, recorded computer programs for supporting creation of job data and component data of printed circuit board; recorded media, namely, recorded computer programs for managing job data and component data of printed circuit board reports	
<b>GOODS AND/OR SERVICES SECTION (proposed)</b>	
<b>INTERNATIONAL CLASS</b>	009
<b>TRACKED TEXT DESCRIPTION</b>	
<del>Electronic computers including central processing units, electronic circuits and magnetic discs recorded with computer programs, other computer peripherals; recorded media, exclusively used in product manufacturing lines, namely, recorded computer programs for managing printed circuit board assembly line management output; recorded media, namely, recorded computer programs for managing printed circuit board assembly line management output; recorded media, exclusively used in product manufacturing lines, namely, recorded computer programs for supporting creation of job data and component data of printed circuit board; recorded media, namely, recorded computer programs for supporting creation of job data and component data of printed circuit board; recorded media, exclusively used in product manufacturing lines, namely, recorded computer programs for managing job data and component data of printed circuit board reports, including predictive maintenance; recorded media, namely, recorded computer programs for managing job data and component data of printed circuit board reports</del>	
<b>FINAL DESCRIPTION</b>	
Recorded media, exclusively used in product manufacturing lines, namely, recorded computer programs for managing printed circuit board assembly line management output; recorded media, exclusively used in product manufacturing lines, namely, recorded computer programs for supporting creation of job data and component data of printed circuit board; recorded media, exclusively used in product manufacturing lines, namely, recorded computer programs for managing job data and component data of printed circuit board reports, including predictive maintenance	
<b>CORRESPONDENCE INFORMATION (current)</b>	
<b>NAME</b>	Jeffrey H. Kaufman
<b>PRIMARY EMAIL ADDRESS FOR CORRESPONDENCE</b>	jhk@mg-ip.com
<b>SECONDARY EMAIL ADDRESS(ES) (COURTESY COPIES)</b>	NOT PROVIDED
<b>DOCKET/REFERENCE NUMBER</b>	FUMA.US.0001
<b>CORRESPONDENCE INFORMATION (proposed)</b>	
<b>NAME</b>	Jeffrey H. Kaufman
<b>PRIMARY EMAIL ADDRESS FOR CORRESPONDENCE</b>	jhk@mg-ip.com
<b>SECONDARY EMAIL ADDRESS(ES) (COURTESY COPIES)</b>	mailroom@mg-ip.com
<b>DOCKET/REFERENCE NUMBER</b>	FUMA.US.0001
<b>SIGNATURE SECTION</b>	
<b>RESPONSE SIGNATURE</b>	/Jeffrey H. Kaufman/
<b>SIGNATORY'S NAME</b>	Jeffrey H. Kaufman
<b>SIGNATORY'S POSITION</b>	Attorney of Record, VA State Bar Member
<b>SIGNATORY'S PHONE NUMBER</b>	703-649-3800
<b>DATE SIGNED</b>	03/12/2020
<b>AUTHORIZED SIGNATORY</b>	YES
<b>CONCURRENT APPEAL NOTICE FILED</b>	NO
<b>FILING INFORMATION SECTION</b>	
<b>SUBMIT DATE</b>	Thu Mar 12 15:16:44 ET 2020

TEAS STAMP

USPTO/RFR-XXX.XXX.XXX.XXX  
-20200312151644032461-792  
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PTO Form 1960 (Rev 10/2011)  
OMB No. 0651-0050 (Exp 09/20/2020)

## Request for Reconsideration after Final Action

### To the Commissioner for Trademarks:

Application serial no. **79250118** NEXIM(Standard Characters, see <https://tmng-al.uspto.gov/resting2/api/img/79250118/large>) has been amended as follows:

#### ARGUMENT(S)

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

Initially, Applicant's undersigned counsel thanks the Examining Attorney for discussing the refusal to register. As discussed, Applicant has amended its goods in Class 9, by further limiting and clarifying the specific nature of Applicant's computer programs. Applicant's software, as described by the amended list of goods, is used on product manufacturing lines in the production of printed circuit boards and providing information and reports relating to those activities. These goods should be contrasted with the cited registration, which identify the goods as "computer programs for use in computer aided engineering and design", or CAD software. As described by Wikipedia, "Computer-aided design" (CAD) is the use of computers (or workstations) to aid in the creation, modification, analysis, or optimization of a design. ([https://en.wikipedia.org/wiki/Computer-aided\\_design](https://en.wikipedia.org/wiki/Computer-aided_design)). Applicant's software would be used in manufacturing lines to control the production of printed circuit boards and provide the manufacturer of those goods with detailed information about the manufacturing process. Thus, the goods serve different purposes and will be used in different settings, thereby making the risk of confusion very limited, and certainly not creating a likelihood of confusion, the requirement to refuse registration under Section 2(d) of the Trademark Act. It is well established that there is no per se rule that all software is related. See *Toro Co. v. ToroHead, Inc.*?61 USPQ2d 1164 (TTAB 2001); *In re Quadram Corp.*, 228 USPQ 863 (TTAB 1985); and *Hasbro Inc. v. Clue Computing, Inc.*, 66 F.Supp.2d 117, 52 USPQ2d. 1402 (D. Mass. 1999). Rather, the test that should apply is, as the Court of Appeals for the Federal Circuit instructed the Board, to simply "compare the services described in [applicant's] application with the goods and services described in [opposer's] registrations." *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002). In the present case, considering the respective goods, it becomes clear that the purpose of the two parties' software does not reasonably overlap, and is software that would be provided for different purposes and applications. In assessing the *du Pont* factors, *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973), the Examining Attorney will also consider, as an important factor, the sophistication of the purchasers. Applicant's goods, being commercial software that would be used in connection with assembly lines manufacturing printed circuit boards, would only be purchased by highly sophisticated consumers of such software. For the above reasons, Applicant respectfully submits that the cited registration should not serve as a barrier to registration of Applicant's mark, and the refusal should be withdrawn. Should the Examining Attorney have any questions, he is invited to contact Applicant's undersigned counsel. Meanwhile, due to the finality of this Office Action, Applicant has also noted an appeal with the TTAB and hopes that upon review of the amended identification and the arguments presented, the refusal will be withdrawn and the application allowed.

#### CLASSIFICATION AND LISTING OF GOODS/SERVICES

##### Applicant proposes to amend the following:

**Current:** Class 009 for Electronic computers including central processing units, electronic circuits and magnetic discs recorded with computer programs, other computer peripherals; recorded media, namely, recorded computer programs for managing printed circuit board assembly line management output; recorded media, namely, recorded computer programs for supporting creation of job data and component data of printed circuit board; recorded media, namely, recorded computer programs for managing job data and component data of printed circuit board reports  
**Filing Basis Section 66(a)**, Request for Extension of Protection to the United States. Section 66(a) of the Trademark Act, 15 U.S.C. §1114f.

##### Proposed:

**Tracked Text Description:** ~~Electronic computers including central processing units, electronic circuits and magnetic discs recorded with computer programs, other computer peripherals;~~ Recorded media, exclusively used in product manufacturing lines, namely, recorded computer programs for managing printed circuit board assembly line management output; ~~recorded media, namely, recorded computer programs for managing printed circuit board assembly line management output;~~ recorded media, exclusively used in product manufacturing lines, namely,

~~recorded computer programs for supporting creation of job data and component data of printed circuit board; recorded media, namely, recorded computer programs for supporting creation of job data and component data of printed circuit board; recorded media, exclusively used in product manufacturing lines, namely, recorded computer programs for managing job data and component data of printed circuit board reports, including predictive maintenance; recorded media, namely, recorded computer programs for managing job data and component data of printed circuit board reports~~

Class 009 for Recorded media, exclusively used in product manufacturing lines, namely, recorded computer programs for managing printed circuit board assembly line management output; recorded media, exclusively used in product manufacturing lines, namely, recorded computer programs for supporting creation of job data and component data of printed circuit board; recorded media, exclusively used in product manufacturing lines, namely, recorded computer programs for managing job data and component data of printed circuit board reports, including predictive maintenance

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

#### **OWNER AND/OR ENTITY INFORMATION**

##### **Applicant proposes to amend the following:**

**Current:** FUJI CORPORATION, a corporation of Japan

**Proposed:** FUJI CORPORATION, a corporation of Japan

Email Address: mailroom@mg-ip.com

##### **Correspondence Information (current):**

Jeffrey H. Kaufman

PRIMARY EMAIL FOR CORRESPONDENCE: jhk@mg-ip.com

SECONDARY EMAIL ADDRESS(ES) (COURTESY COPIES): NOT PROVIDED

The docket/reference number is FUMA.US.0001.

##### **Correspondence Information (proposed):**

Jeffrey H. Kaufman

PRIMARY EMAIL FOR CORRESPONDENCE: jhk@mg-ip.com

SECONDARY EMAIL ADDRESS(ES) (COURTESY COPIES): mailroom@mg-ip.com

The docket/reference number is FUMA.US.0001.

**Requirement for Email and Electronic Filing:** I understand that a valid email address must be maintained by the owner/holder and the owner's/holder's attorney, if appointed, and that all official trademark correspondence must be submitted via the Trademark Electronic Application System (TEAS).

#### **SIGNATURE(S)**

##### **Request for Reconsideration Signature**

Signature: /Jeffrey H. Kaufman/ Date: 03/12/2020

Signatory's Name: Jeffrey H. Kaufman

Signatory's Position: Attorney of Record, VA State Bar Member

Signatory's Phone Number: 703-649-3800

The signatory has confirmed that he/she is a U.S.-licensed attorney who is an active member in good standing of the bar of the highest court of a U.S. state (including the District of Columbia and any U.S. Commonwealth or territory); and he/she is currently the owner's/holder's attorney or an associate thereof; and to the best of his/her knowledge, if prior to his/her appointment another U.S.-licensed attorney not currently associated with his/her company/firm previously represented the owner/holder in this matter: the owner/holder has revoked their power of attorney by a signed revocation or substitute power of attorney with the USPTO; the USPTO has granted that attorney's withdrawal request; the owner/holder has filed a power of attorney appointing him/her in this matter; or the owner's/holder's appointed U.S.-licensed attorney has filed a power of attorney appointing him/her as an associate attorney in this matter.

The applicant is not filing a Notice of Appeal in conjunction with this Request for Reconsideration.

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Muncy, Geissler, Olds & Lowe, P.C.

4000 Legato Rd Ste 310

Fairfax, Virginia 22033

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Serial Number: 79250118

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032461-79250118-710e5634bb2c36c82859ea94

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b-N/A-N/A-20200312150857893113