From: Collopy, Diane

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Subject: U.S. TRADEMARK APPLICATION NO. 86601529 - PHOTON - 02214-00144 - Request for Reconsideration Denied - Return to TTAB

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

U.S. APPLICATION SERIAL NO. 86601529

MARK: PHOTON

CORRESPONDENT ADDRESS:
BRETT A AUGUST

PATTISHALL MCAULIFFE NEWBURY HILLIARD &

200 S WACKER DR STE 2900

CHICAGO, IL 60606-5896

GENERAL TRADEMARK INFORMATION:

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

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APPLICANT: VMware, Inc.

CORRESPONDENT'S REFERENCE/DOCKET NO:

02214-00144

CORRESPONDENT E-MAIL ADDRESS:

baugust@pattishall.com

REQUEST FOR RECONSIDERATION DENIED

ISSUE/MAILING DATE: 9/20/2016

The trademark examining attorney has carefully reviewed applicant's request for reconsideration and is denying the request for the reasons stated below. *See* 37 C.F.R. §2.63(b)(3); TMEP §§715.03(a)(ii)(B), 715.04(a). The following refusal made final in the Office action dated 2/29/16 is maintained and continues to be final: Section 2(d) Refusal—Likelihood of Confusion. *See* TMEP §§715.03(a)(ii)(B), 715.04(a).

Applicant has argued that the applicant is prejudiced by the registrant's over broad terminology. This is unpersuasive. Applicant holds a registration for "Computer software for development, operation and publication of connected applications, including multiplayer video games, on any computerized platform, including personal computers, dedicated gaming consoles, hand held devices and mobile phones." The mere presence of the word "including" in an identification of goods does not render the entire identification indefinite.

Further, Section 2(d) Refusals are based on the description of the goods stated in the application and registration at issue, not on extrinsic evidence of actual use. *See Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 1323, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014) (quoting *Octocom Sys. Inc. v. Hous. Computers Servs. Inc.*, 918 F.2d 937, 942, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990)). The applicant's argument that the registrant is only using the mark in connection with gaming software is not persuasive in a likelihood of confusion determination based on the goods stated in the application and registration at issue. Similarly, applicant's arguments regarding the sophistication of the purchasers are not persuasive. The fact that purchasers are sophisticated or knowledgeable in a particular field does not necessarily mean that they are sophisticated or knowledgeable in the field of trademarks or immune from source confusion. TMEP §1207.01(d)(vii); *see, e.g.*, *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d. 1317, 1325, 110 USPQ2d 1157, 1163-64 (Fed. Cir. 2014); *Top Tobacco LP v. N. Atl. Operating Co.*, 101 USPQ2d 1163, 1170 (TTAB 2011). In a situation with identical marks and related goods, even sophisticated purchasers may be confused as to the source of particular goods, even if they would not confuse the goods themselves.

Moreover, applicant's evidence from its website shows that the applicant's goods are described as software to "build, run, and manage cloud native applications," which is encompassed by the registrant's identified "computer software for development, operation, and publication of connected applications […] on any computerized platform." *See* applicant's Exhibit 1.

Lastly, where the marks of the respective parties are identical or virtually identical, the relationship between the relevant goods need not be as close to support a finding of likelihood of confusion. *See In re Shell Oil Co.*, 992 F.2d 1204, 1207, 26 USPQ2d 1687, 1689 (Fed. Cir. 1993); *In re House Beer, LLC*, 114 USPQ2d 1073, 1077 (TTAB 2015); *In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1202 (TTAB 2009); TMEP §1207.01(a). In this case, the degree of similarity required to find a likelihood of confusion between the applicant's and registrant's goods is met as demonstrated by the respective identifications and the previously attached evidence.

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

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

If no appeal has been filed and time remains in the six-month response period to the final Office action, applicant has the remainder of the response period to (1) comply with and/or overcome any outstanding final requirement(s) and/or refusal(s), and/or (2) file a notice of appeal to the Board. TMEP §715.03(a)(ii)(B); *see* 37 C.F.R. §2.63(b)(1)-(3). The filing of a request for reconsideration does not stay or extend the time for filing an appeal. 37 C.F.R. §2.63(b)(3); *see* TMEP §§715.03, 715.03(a)(ii)(B), (c).

/Diane Collopy/

Examining Attorney

Law Office 107

diane.collopy@uspto.gov (informal communications only)

(571) 270-3118