

ESTTA Tracking number: **ESTTA978016**

Filing date: **06/03/2019**

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

Proceeding	91247400
Party	Plaintiff Essential Products, Inc.
Correspondence Address	LYNNE E GRAYBEAL PERKINS COIE LLP 1201 THIRD AVENUE, SUITE 4900 SEATTLE, WA 98101 UNITED STATES pctrademarks@perkinscoie.com, LGraybeal@perkinscoie.com, WRava@perkinscoie.com, THolt@perkinscoie.com, AiChang@perkinscoie.com, KThompson@perkinscoie.com 650-838-4300
Submission	Motion to Amend Pleading/Amended Pleading
Filer's Name	Ai-Tang Chang
Filer's email	pctrademarks@perkinscoie.com, LGraybeal@perkinscoie.com, THolt@perkinscoie.com, AiChang@perkinscoie.com, KThompson@perkinscoie.com
Signature	/Ai-Tang Chang/
Date	06/03/2019
Attachments	First Ameded Notice of Opposition ESSENTIAL Clean.pdf(45217 bytes) First Ameded Notice of Opposition ESSENTIAL Redline.pdf(46719 bytes) Exhibit A Applicant Mark.pdf(41042 bytes) Exhibit B Opposer Mark Status.pdf(149541 bytes) Exhibit C Opposer OAs.pdf(159192 bytes) Exhibit D Application and Declaration.pdf(36584 bytes)

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

In the Matter of Trademark Application Serial No.: 86/861,193
Filed: December 29, 2015
For the mark: **ESSENTIAL**
Published in the *Official Gazette* on: December 4, 2018

_____)	
Essential Products, Inc.,)	
)	Opposition No.: 91247400
Opposer,)	
)	FIRST AMENDED NOTICE OF
v.)	OPPOSITION
)	
Spigen, Inc.,)	
)	
Applicant.)	
_____)	

FIRST AMENDED NOTICE OF OPPOSITION

1. Essential Products, Inc. (“Opposer”) is a Delaware corporation having a principal place of business at 380 Portage Avenue, Palo Alto, California 94306. Opposer believes it will be damaged by the registration of the above-identified U.S. Trademark Application Serial No. 86/861,193 for the mark ESSENTIAL (“Mark”), filed on December 29, 2015 by Spigen, Inc. (“Applicant”), and hereby oppose registration of the Mark pursuant to Section 13 of the Trademark Act of July 5, 1946, 15 U.S.C. § 1063. The grounds for opposition are as follows:

APPLICANT AND ITS MARK

2. Applicant is a California corporation having a principal place of business at 9975 Toledo Way No. 100, Irvine, California 92618.

3. Applicant’s Mark was published for opposition on December 4, 2018. Opposer filed and the Board approved extension of time to oppose Applicant’s Mark until April 3, 2019. Opposer filed a Notice of Opposition with the Board on April 3, 2019. Applicant filed a motion

to dismiss the opposition on May 13, 2019. Pursuant to TBMP §§ 503.03 and 507.02, Opposer is allowed to amend the Notice of Opposition as a matter of right within 21 days of the filing of the motions to dismiss. Consequently, this Notice of Opposition is timely filed.

4. Applicant is seeking to register the mark ESSENTIAL in connection with “cameras; portable and handheld digital electronic devices for recording, organizing, transmitting, manipulating, and reviewing text, data, image, and audio files except in relation to automated plumbing systems; wireless communication device featuring voice, data and image transmission including voice, text and picture messaging, a video and still image camera, also functional to purchase music, games, video and software applications over the air for downloading to the device except for in relation to automated plumbing systems; wireless communication devices for transmitting images taken by a camera; wireless communication devices for voice, data or image transmission except for in relation to automated plumbing systems; digital cameras; motion picture cameras; motion-activated cameras; multiple purpose cameras; video cameras; wearable digital electronic devices comprised primarily of software for viewing, sending and receiving texts, emails, data and information from smart phones, tablet computers and portable computers and display screens and also featuring a wristwatch” in International Class 9 (“Applicant’s Goods”). The status of the Mark on Trademark Status & Document Retrieval (“TSDR”) published by the United States Patent and Trademark Offices (“USPTO”) is attached as **Exhibit A**.

OPPOSER AND ITS MARKS

5. Opposer, is in the business of, *inter alia*, developing, manufacturing and selling smartphones, software for smartphones, smartphone peripherals and providing goods and services in connection with smartphones and related products and services.

6. Opposer is the owner of the trademark applications containing the term “ESSENTIAL” (Opposer’s Marks) shown in the chart below. The status of Opposer’s Marks from TSDR are attached hereto as **Exhibit B**.

Mark	Serial No.	Filing Date	Classes
●◻ Essential	87278834	12/22/2016	9
ESSENTIAL	87976086	1/13/2017	35
ESSENTIAL	87976088	1/13/2017	9, 28
ESSENTIAL PRODUCTS	87976107	1/13/2017	9
ESSENTIAL PRODUCTS	87976090	1/13/2017	9
ESSENTIAL PRODUCTS	87976106	1/13/2017	35
ESSENTIAL PRODUCTS	87976092	1/13/2017	9, 28
●◻ Essential	87545739	7/27/2017	41
●◻ Essential	87545749	7/27/2017	42

7. Applicant’s Mark has been cited by USPTO examiners to block registration of Opposer’s Marks. The office actions issued against Opposer’s Marks, demonstrating Applicant’s Mark as one of the cited applications are attached hereto as **Exhibit C**.

8. Pursuant to Section 309.03(b) of Trademark Trial and Appeal Board Manual of Procedure (“TBMP”) Opposer believes it will be damaged by the registration of the Mark because Opposer was advised by USPTO examiners that Opposer’s Marks will be refused of registration when Applicant’s Mark matures into a registration. *See* TBMP § 309.03(b).

FIRST GROUND FOR OPPOSITION
LACK OF BONA-FIDE INTENT TO USE IN COMMERCE

9. Opposer repeats and re-alleges each and every allegation contained in the foregoing paragraphs, as if fully recited herein.

10. Applicant alleges it is the owner of the Mark. On December 29, 2015, Applicant claimed in its application that it has a *bona fide* intent to use the Mark in commerce in the United States in connection with Applicant’s Goods, which include among other things a variety of

wireless communication devices, handheld digital electronic devices, and wearable digital electronic devices. Applicant's application filed on December 29, 2015 and supporting declarations are attached hereto as **Exhibit D**.

11. Opposer has investigated Applicant's alleged intent to use Applicant's Mark by reviewing Applicant's website www.spigen.com, among other resources. Based upon this investigation, Opposer has formed a reasonable belief that Applicant is in the business of manufacturing mobile phone accessories, and does not have the infrastructure, resources and/or experience to offer Applicant's Goods, which contain a wide variety of sophisticated technology products, including without limitation communication devices, handheld digital electronic devices, and wearable digital electronic devices. Applicant's Goods are not reasonable product extensions that would be offered by a company focused exclusively on mobile phone accessories.

12. On information and belief, Applicant's Mark is *void ab initio* because Applicant did not have a *bona fide* intent to use, at the time of filing on December 29, 2015, to use the Mark in commerce in the United States in connection with all of Applicant's Goods.

SECOND GROUND FOR OPPOSITION
FRAUD AS TO APPLICANT'S IDENTIFICATION OF GOODS

13. Opposer repeats and re-alleges each and every allegation contained in the foregoing paragraphs, as if fully recited herein.

14. Upon filing for the Mark, the attorney of record stated that "the applicant has a bona fide intention, and is entitled, to use the mark in commerce on or in connection with the goods/services," and signed a declaration stating that, "willful false statements and the like may jeopardize the validity of the application or any registration resulting therefrom." See **Exhibit D**.

15. On information and belief, Applicant did not have a *bona fide* intent to use the Mark as of the filing date of the Mark on all of Applicant's Goods.

16. Opposer has investigated Applicant's use of Applicant's Mark by reviewing Applicant's website www.spigen.com, among other resources. Based upon this investigation, Opposer has formed a reasonable belief that Applicant is in the business of manufacturing mobile phone accessories, and does not have the infrastructure, resources and/or experience to offer Applicant's Goods, which contain a wide variety of sophisticated technology products, including without limitation wireless communication devices, handheld digital electronic devices, and wearable digital electronic devices. Applicant's Goods are not reasonable product extensions that would be offered by a company focused exclusively on mobile phone accessories. Therefore, Applicant lacked a *bona fide* intent to offer all of the goods listed above at the time such intent was stated by Applicant to the USPTO.

17. On information and belief, Applicant knew that it was making a false representation regarding its *bona fide* intent to offer these goods under the Mark when Applicant, through its attorney of record, signed the declaration on December 29, 2015.

18. Misrepresentations as to the goods and services on which a mark will be used, which defined the full scope of trademark rights, are material to the USPTO.

19. On information and belief, by making such knowingly false misrepresentation to the USPTO in the application for the Mark, Applicant intended to deceive the USPTO and secure a registration granting it rights Applicant was not entitled.

20. Opposer hereby seeks that registration of the Mark be refused on the grounds that Applicant knowingly made a false, material representation in the process of procuring the Mark with the intent to deceive the USPTO.

WHEREFORE, Opposer prays that Applicant's Mark be refused of registration as *void ab initio* and/or for fraud.

DATED: June 3, 2019

Respectfully submitted,

PERKINS COIE LLP

By: Lynne E. Graybeal
Lynne E. Graybeal
William C. Rava
Thomas Holt
Ai-Tang I. Chang
1201 Third Avenue Suite 4900
Seattle, WA 98101-3099
Attorneys for Opposer

CERTIFICATE OF SERVICE

I hereby certify that, on June 3, 2019, I caused a true and complete copy of the FIRST AMENDED NOTICE OF OPPOSITION to be sent via email to Applicant's Attorneys of Record at kim@lucemlaw.com, trademark@lucemlaw.com, iplaw.advocate@gmail.com.

Dated: June 3, 2019
Palo Alto, California

Respectfully submitted,
/Ai-Tang I. Chang/
By: Ai-Tang I. Chang

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

In the Matter of Trademark Application Serial No.: 86/861,193

Filed: December 29, 2015

For the mark: **ESSENTIAL**

Published in the *Official Gazette* on: December 4, 2018

Essential Products, Inc.,)	
)	
Opposer,)	Opposition No.: 91247400
)	
v.)	FIRST AMENDED NOTICE OF
)	OPPOSITION
)	
Spigen, Inc.,)	
)	
Applicant.)	
)	

FIRST AMENDED NOTICE OF OPPOSITION

1. Essential Products, Inc. (“Opposer”) is a Delaware corporation having a principal place of business at 380 Portage Avenue, Palo Alto, California 94306. Opposer believes it will be damaged by the registration of the above-identified U.S. Trademark Application Serial No. 86/861,193 for the mark ESSENTIAL (“Mark”), filed on December 29, 2015 by Spigen, Inc. (“Applicant”), and hereby oppose registration of the Mark pursuant to Section 13 of the Trademark Act of July 5, 1946, 15 U.S.C. § 1063. The grounds for opposition are as follows:

APPLICANT AND ITS MARK

2. Applicant is a California corporation having a principal place of business at 9975 Toledo Way No. 100, Irvine, California 92618.

3. Applicant’s Mark was published for opposition on December 4, 2018. Opposer filed and the Board approved extension of time to oppose Applicant’s Mark until April 3, 2019.

[Opposer filed a Notice of Opposition with the Board on April 3, 2019. Applicant filed a motion](#)

to dismiss the opposition on May 13, 2019. Pursuant to TBMP §§ 503.03 and 507.02, Opposer is allowed to amend the Notice of Opposition as a matter of right within 21 days of the filing of the motions to dismiss. Consequently, tThis Notice of Opposition is timely filed.

4. Applicant is seeking to register the mark ESSENTIAL in connection with “cameras; portable and handheld digital electronic devices for recording, organizing, transmitting, manipulating, and reviewing text, data, image, and audio files except in relation to automated plumbing systems; wireless communication device featuring voice, data and image transmission including voice, text and picture messaging, a video and still image camera, also functional to purchase music, games, video and software applications over the air for downloading to the device except for in relation to automated plumbing systems; wireless communication devices for transmitting images taken by a camera; wireless communication devices for voice, data or image transmission except for in relation to automated plumbing systems; digital cameras; motion picture cameras; motion-activated cameras; multiple purpose cameras; video cameras; wearable digital electronic devices comprised primarily of software for viewing, sending and receiving texts, emails, data and information from smart phones, tablet computers and portable computers and display screens and also featuring a wristwatch” in International Class 9 (“Applicant’s Goods”). The status of the Mark on Trademark Status & Document Retrieval (“TSDR”) published by the United States Patent and Trademark Offices (“USPTO”) is attached as **Exhibit A**.

OPPOSER AND ITS MARKS

5. Opposer, is in the business of, *inter alia*, developing, manufacturing and selling smartphones, software for smartphones, smartphone peripherals and providing goods and services in connection with smartphones and related products and services.

6. Opposer is the owner of the trademark applications containing the term “ESSENTIAL” (Opposer’s Marks) shown in the chart below. The status of Opposer’s Marks from TSDR are attached hereto as **Exhibit B**.

Mark	Serial No.	Filing Date	Classes
●◻ Essential	87278834	12/22/2016	9
ESSENTIAL	87976086	1/13/2017	35
ESSENTIAL	87976088	1/13/2017	9, 28
ESSENTIAL PRODUCTS	87976107	1/13/2017	9
ESSENTIAL PRODUCTS	87976090	1/13/2017	9
ESSENTIAL PRODUCTS	87976106	1/13/2017	35
ESSENTIAL PRODUCTS	87976092	1/13/2017	9, 28
●◻ Essential	87545739	7/27/2017	41
●◻ Essential	87545749	7/27/2017	42

7. Applicant’s Mark has been cited by USPTO examiners to block registration of Opposer’s Marks. The office actions issued against Opposer’s Marks, demonstrating Applicant’s Mark as one of the cited applications are attached hereto as **Exhibit C**.

8. Pursuant to Section 309.03(b) of Trademark Trial and Appeal Board Manual of Procedure (“TBMP”) Opposer believes it will be damaged by the registration of the Mark because Opposer was advised by USPTO examiners that Opposer’s Marks will be refused of registration when Applicant’s Mark matures into a registration. *See* TBMP § 309.03(b).

FIRST GROUND FOR OPPOSITION
LACK OF BONA-FIDE INTENT TO USE IN COMMERCE

9. Opposer repeats and re-alleges each and every allegation contained in the foregoing paragraphs, as if fully recited herein.

10. Applicant alleges it is the owner of the Mark. On December 29, 2015, Applicant claimed in its application that it has *a bona fide* intent to use the Mark in commerce in the United States in connection with Applicant’s Goods, which include among other things a variety of

wireless communication devices, handheld digital electronic devices, and wearable digital electronic devices. Applicant's application filed on December 29, 2015 and supporting declarations are attached hereto as **Exhibit D**.

11. Opposer has investigated Applicant's alleged intent to use Applicant's Mark by reviewing Applicant's website www.spigen.com, among other resources. Based upon this investigation, Opposer has formed a reasonable belief that Applicant is in the business of manufacturing mobile phone accessories, and does not have the infrastructure, resources and/or experience to offer Applicant's Goods, which contain a wide variety of sophisticated technology products, including without limitation communication devices, handheld digital electronic devices, and wearable digital electronic devices. Applicant's Goods are not reasonable product extensions that would be offered by a company focused exclusively on mobile phone accessories.

12. On information and belief, Applicant's Mark is *void ab initio* because Applicant did not have a *bona fide* intent to use, at the time of filing on December 29, 2015, to use the Mark in commerce in the United States in connection with all of Applicant's Goods.

SECOND GROUND FOR OPPOSITION
FRAUD AS TO APPLICANT'S IDENTIFICATION OF GOODS

~~12~~13. Opposer repeats and re-alleges each and every allegation contained in the foregoing paragraphs, as if fully recited herein.

~~13~~14. Upon filing for the Mark, the attorney of record stated that "the applicant has a bona fide intention, and is entitled, to use the mark in commerce on or in connection with the goods/services," and signed a declaration stating that, "willful false statements and the like may jeopardize the validity of the application or any registration resulting therefrom." See **Exhibit D**.

~~14~~15. On information and belief, Applicant did not have a *bona fide* intent to use the Mark as of the filing date of the Mark on all of Applicant's Goods.

~~1516.~~ Opposer has investigated Applicant's use of Applicant's Mark, ~~including, but not limited to, on~~ by reviewing Applicant's website www.spigen.com, among other resources Applicant's Internet website(s). Based upon this investigation, Opposer has ~~received information and has~~ formed a reasonable belief that Applicant is in the business of manufacturing mobile phone accessories, and does not have the infrastructure, resources and/or experience to offer Applicant's Goods, which contain a wide variety of sophisticated technology products, including without limitation wireless communication devices, handheld digital electronic devices, and wearable digital electronic devices. Applicant's Goods are not reasonable product extensions that would be offered by a company focused exclusively on mobile phone accessories. Therefore, Applicant lacked a bona fide intent to offer all of the goods listed above at the time such intent was stated by Applicant to the USPTO.

~~1617.~~ On information and belief, Applicant knew that it was making a false representation regarding its *bona fide* intent to offer these goods under the Mark when Applicant, through its attorney of record, signed the declaration on December 29, 2015.

~~1718.~~ Misrepresentations as to the goods and services on which a mark will be used, which defined the full scope of trademark rights, are material to the USPTO.

~~1819.~~ On information and belief, by making such knowingly false misrepresentation to the USPTO in the application for the Mark, Applicant intended to deceive the USPTO and secure a registration granting it rights Applicant was not entitled.

~~1920.~~ Opposer hereby seeks that registration of the Mark be refused on the grounds that Applicant knowingly made a false, material representation in the process of procuring the Mark with the intent to deceive the USPTO.

WHEREFORE, Opposer prays that Applicant's Mark be refused of registration as *void ab initio* and/or for fraud.

DATED: ~~April~~ June 3, 2019

Respectfully submitted,

PERKINS COIE LLP

By: Lynne E. Graybeal
Lynne E. Graybeal
William C. Rava
Thomas Holt
Ai-Tang I. Chang
1201 Third Avenue Suite 4900
Seattle, WA 98101-3099
Attorneys for Opposer

CERTIFICATE OF SERVICE

I hereby certify that, on June 3, 2019, I caused a true and complete copy of the FIRST AMENDED NOTICE OF OPPOSITION to be sent via email to Applicant's Attorneys of Record at kkim@lucemlaw.com, trademark@lucemlaw.com, iplaw.advocate@gmail.com.

Dated: June 3, 2019

Palo Alto, California

Respectfully submitted,

/Ai-Tang I. Chang/

By: Ai-Tang I. Chang

Exhibit A

Generated on: This page was generated by TSDR on 2019-04-03 20:01:29 EDT

Mark: ESSENTIAL

ESSENTIAL

US Serial Number: 86861193

Application Filing Date: Dec. 29, 2015

Filed as TEAS Plus: Yes

Currently TEAS Plus: Yes

Register: Principal

Mark Type: Trademark

TM5 Common Status Descriptor:



LIVE/APPLICATION/Published for Opposition

A pending trademark application has been examined by the Office and has been published in a way that provides an opportunity for the public to oppose its registration.

Status: A request for an extension of time to file an opposition has been filed with the Trademark Trial and Appeal Board. For further information, see TTABVUE on the Trademark Trial and Appeal Board web page.

Status Date: Jan. 02, 2019

Publication Date: Dec. 04, 2018

Mark Information

Mark Literal Elements: ESSENTIAL

Standard Character Claim: Yes. The mark consists of standard characters without claim to any particular font style, size, or color.

Mark Drawing Type: 4 - STANDARD CHARACTER MARK

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: Cameras; Portable and handheld digital electronic devices for recording, organizing, transmitting, manipulating, and reviewing text, data, image, and audio files except in relation to automated plumbing systems; Wireless communication device featuring voice, data and image transmission including voice, text and picture messaging, a video and still image camera, also functional to purchase music, games, video and software applications over the air for downloading to the device except for in relation to automated plumbing systems; Wireless communication devices for transmitting images taken by a camera; Wireless communication devices for voice, data or image transmission except for in relation to automated plumbing systems; Digital cameras; Motion picture cameras; Motion-activated cameras; Multiple purpose cameras; Video cameras; Wearable digital electronic devices comprised primarily of software for viewing, sending and receiving texts, emails, data and information from smart phones, tablet computers and portable computers and display screens and also featuring a wristwatch

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

Filed ITU: Yes

Currently ITU: Yes

Filed 44D: No

Currently 44E: No

Filed 44E: No

Currently 66A: No

Filed 66A: No

Currently No Basis: No

Filed No Basis: No

Current Owner(s) Information

Owner Name: SPIGEN, INC.

Owner Address: 9975 Toledo Way #100
Irvine, CALIFORNIA UNITED STATES 92618

Legal Entity Type: CORPORATION

State or Country CALIFORNIA
Where Organized:

Attorney/Correspondence Information

Attorney of Record

Attorney Name: Heedong Chae

Docket Number: 7108TM81

Attorney Primary Email Address: trademark@ewpat.com

Attorney Email Authorized: Yes

Correspondent

Correspondent Name/Address: HEEDONG CHAE
Lucem, PC
660 S. FIGUEROA ST. SUITE 1200
LOS ANGELES, CALIFORNIA UNITED STATES 90017

Phone: 213-387-3630

Fax: 2138636332

Correspondent e-mail: trademark@lucemlaw.com iplaw.advocate@gmail.com

Correspondent e-mail Authorized: Yes

Domestic Representative - Not Found

Prosecution History

Date	Description	Proceeding Number
Jan. 02, 2019	EXTENSION OF TIME TO OPPOSE RECEIVED	
Jan. 16, 2019	NOTICE OF ALLOWANCE CANCELLED	
Dec. 04, 2018	NOA E-MAILED - SOU REQUIRED FROM APPLICANT	
Dec. 04, 2018	OFFICIAL GAZETTE PUBLICATION CONFIRMATION E-MAILED	
Dec. 04, 2018	PUBLISHED FOR OPPOSITION	
Nov. 14, 2018	NOTIFICATION OF NOTICE OF PUBLICATION E-MAILED	
Nov. 01, 2018	LAW OFFICE PUBLICATION REVIEW COMPLETED	70629
Nov. 01, 2018	APPLICANT/CORRESPONDENCE CHANGES (NON-RESPONSIVE) ENTERED	70629
Nov. 01, 2018	APPLICANT/CORRESPONDENCE CHANGES (NON-RESPONSIVE) ENTERED	70629
Oct. 29, 2018	APPROVED FOR PUB - PRINCIPAL REGISTER	
Oct. 29, 2018	EXAMINER'S AMENDMENT ENTERED	88888
Oct. 29, 2018	NOTIFICATION OF EXAMINERS AMENDMENT E-MAILED	6328
Oct. 29, 2018	EXAMINERS AMENDMENT E-MAILED	6328
Oct. 29, 2018	EXAMINERS AMENDMENT -WRITTEN	92837
Oct. 18, 2018	PREVIOUS ALLOWANCE COUNT WITHDRAWN	
Oct. 03, 2018	TEAS/EMAIL CORRESPONDENCE ENTERED	70629
Oct. 03, 2018	CORRESPONDENCE RECEIVED IN LAW OFFICE	70629
Oct. 02, 2018	NOTICE OF REVIVAL - E-MAILED	
Oct. 02, 2018	ASSIGNED TO LIE	70629
Oct. 02, 2018	PETITION GRANTED - RESPONSE RECEIVED	70458
Oct. 01, 2018	TEAS RESPONSE TO PETITION DEFICIENCY RECEIVED	
Sep. 28, 2018	INCOMPLETE PETITION NOTICE MAILED	70458
Sep. 21, 2018	ASSIGNED TO PETITION STAFF	70458
Sep. 11, 2018	PETITION TO REVIVE-RECEIVED	
Sep. 12, 2018	EXTENSION OF TIME TO OPPOSE RECEIVED	
Sep. 11, 2018	TEAS PETITION TO DIRECTOR RECEIVED	1111
Aug. 21, 2018	OFFICIAL GAZETTE PUBLICATION CONFIRMATION E-MAILED	
Aug. 21, 2018	PUBLISHED FOR OPPOSITION	

Aug. 01, 2018	NOTIFICATION OF NOTICE OF PUBLICATION E-MAILED	
Jul. 13, 2018	NOTICE OF REINSTATEMENT MAILED	
Jul. 11, 2018	APPROVED FOR PUB - PRINCIPAL REGISTER	
Jul. 11, 2018	EXAMINER'S AMENDMENT ENTERED	88888
Jul. 11, 2018	NOTIFICATION OF EXAMINERS AMENDMENT E-MAILED	6328
Jul. 11, 2018	EXAMINERS AMENDMENT E-MAILED	6328
Jul. 11, 2018	EXAMINERS AMENDMENT -WRITTEN	92837
Jul. 09, 2018	REINSTATEMENT GRANTED - INADVERTENTLY ABANDONED	76151
Jul. 09, 2018	ABANDONMENT - FAILURE TO RESPOND OR LATE RESPONSE	
Dec. 11, 2017	NOTIFICATION OF FINAL REFUSAL EMAILED	
Dec. 11, 2017	FINAL REFUSAL E-MAILED	
Dec. 11, 2017	FINAL REFUSAL WRITTEN	92837
Nov. 20, 2017	TEAS CHANGE OF CORRESPONDENCE RECEIVED	
Nov. 15, 2017	TEAS/EMAIL CORRESPONDENCE ENTERED	88889
Nov. 14, 2017	CORRESPONDENCE RECEIVED IN LAW OFFICE	88889
Nov. 14, 2017	TEAS RESPONSE TO OFFICE ACTION RECEIVED	
Jul. 06, 2017	TEAS CHANGE OF CORRESPONDENCE RECEIVED	
May 14, 2017	NOTIFICATION OF NON-FINAL ACTION E-MAILED	6325
May 14, 2017	NON-FINAL ACTION E-MAILED	6325
May 14, 2017	NON-FINAL ACTION WRITTEN	92837
Nov. 07, 2016	NOTIFICATION OF LETTER OF SUSPENSION E-MAILED	6332
Nov. 07, 2016	LETTER OF SUSPENSION E-MAILED	6332
Nov. 07, 2016	SUSPENSION LETTER WRITTEN	92837
Oct. 15, 2016	TEAS/EMAIL CORRESPONDENCE ENTERED	88889
Oct. 14, 2016	CORRESPONDENCE RECEIVED IN LAW OFFICE	88889
Oct. 14, 2016	TEAS RESPONSE TO OFFICE ACTION RECEIVED	
Apr. 15, 2016	NOTIFICATION OF NON-FINAL ACTION E-MAILED	6325
Apr. 15, 2016	NON-FINAL ACTION E-MAILED	6325
Apr. 15, 2016	NON-FINAL ACTION WRITTEN	92837
Apr. 14, 2016	ASSIGNED TO EXAMINER	92837
Jan. 08, 2016	NEW APPLICATION OFFICE SUPPLIED DATA ENTERED IN TRAM	
Jan. 01, 2016	NEW APPLICATION ENTERED IN TRAM	

TM Staff and Location Information

TM Staff Information

TM Attorney: MARINO, JENNIFER ELLEN

Law Office Assigned: LAW OFFICE 121

File Location

Current Location: PUBLICATION AND ISSUE SECTION

Date in Location: Nov. 01, 2018

Proceedings

Summary

Number of Proceedings: 1

Type of Proceeding: Extension of Time

Proceeding Number: [86861193](#)

Filing Date: Sep 12, 2018

Status: Extension of Time to Oppose Filed

Status Date: Jan 02, 2019

Interlocutory Attorney:

Defendant

Name: SPIGEN, INC.

Correspondent: HEEDONG CHAE

Address: LUCEM, PC
660 S. FIGUEROA ST. SUITE 1200

LOS ANGELES CA UNITED STATES , 90017

Correspondent e-mail: trademark@lucemlaw.com , iplaw.advocate@gmail.com

Associated marks

Mark	Application Status	Serial Number	Registration Number
ESSENTIAL	Request For Extension of Time to File Opposition	86861193	

Potential Opposer(s)

Name: Essential Products, Inc.

Correspondent Address: LYNNE E. GRAYBEAL
PERKINS COIE LLP
1201 THIRD AVENUE, SUITE 4900
SEATTLE WA UNITED STATES , 98101

Correspondent e-mail: pctrademarks@perkinscoie.com , LGraybeal@perkinscoie.com , AIChang@perkinscoie.com , KThompson@perkinscoie.com

Name: Essential Products, Inc.

Correspondent Address: Thomas L. Holt
Perkins Cole LLP
131 South Dearborn St.Suite 1700
Chicago IL UNITED STATES , 60603

Correspondent e-mail: tholt@perkinscoie.com , lgraybeal@perkinscoie.com , pctrademarks@perkinscoie.com

Prosecution History

Entry Number	History Text	Date	Due Date
1	FIRST 90-DAY REQUEST TO EXT TIME TO OPPOSE	Sep 12, 2018	
2	EXT GRANTED	Sep 12, 2018	
3	EXT NOTED AND TERMINATED; APP TO REPUB	Dec 17, 2018	Jan 26, 2019
4	TERMINATED	Dec 17, 2018	
5	FIRST 90-DAY REQUEST TO EXT TIME TO OPPOSE	Jan 02, 2019	
6	EXT GRANTED	Jan 02, 2019	

Exhibit B

Generated on: This page was generated by TSDR on 2019-04-03 20:02:07 EDT

Mark: ESSENTIAL



US Serial Number: 87278834

Application Filing Date: Dec. 22, 2016

Filed as TEAS RF: Yes

Currently TEAS RF: Yes

Register: Principal

Mark Type: Trademark

Status: Suspension check completed. Application remains suspended.

Status Date: Nov. 05, 2018

Mark Information

Mark Literal Elements: ESSENTIAL

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 the wording "ESSENTIAL" to the right of a shaded circle and a shaded square containing a circle.

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

Design Search Code(s): 26.01.13 - Circles, two (not concentric); Two circles

26.01.21 - Circles that are totally or partially shaded.

26.09.21 - Squares that are completely or partially shaded

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: mobile phones; smart phones; computers and tablet computers; replacement parts for all the aforementioned goods; computer operating software for mobile phones, smart phones, computers and tablet computers

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: Essential Products, Inc.

Owner Address: 380 Portage Avenue
Palo Alto, CALIFORNIA 94306
UNITED STATES

Legal Entity Type: CORPORATION

State or Country DELAWARE
Where Organized:

Attorney/Correspondence Information

Attorney of Record

Attorney Name: Lynne E. Graybeal

Docket Number: 119306-4003

Attorney Primary Email Address: pctrademarks@perkinscoie.com

Attorney Email Authorized: Yes

Correspondent

Correspondent Name/Address: Lynne E. Graybeal
Perkins Coie LLP
1201 Third Avenue Suite 4900
Seattle, WASHINGTON 98101
UNITED STATES

Phone: 206-359-8000

Fax: 206-359-9000

Correspondent e-mail: pctrademarks@perkinscoie.com LGraybeal@perkinscoie.com aichang@perkinscoie.com kthompson@perkinscoie.com

Correspondent e-mail Authorized: Yes

Domestic Representative - Not Found

Prosecution History

Date	Description	Proceeding Number
Mar. 14, 2019	ATTORNEY/DOM.REP.REVOKED AND/OR APPOINTED	
Mar. 14, 2019	TEAS REVOKE/APP/CHANGE ADDR OF ATTY/DOM REP RECEIVED	
Nov. 05, 2018	REPORT COMPLETED SUSPENSION CHECK CASE STILL SUSPENDED	66121
May 03, 2018	REPORT COMPLETED SUSPENSION CHECK CASE STILL SUSPENDED	66121
May 03, 2018	ASSIGNED TO LIE	66121
Oct. 17, 2017	NOTIFICATION OF LETTER OF SUSPENSION E-MAILED	6332
Oct. 17, 2017	LETTER OF SUSPENSION E-MAILED	6332
Oct. 17, 2017	SUSPENSION LETTER WRITTEN	92576
Sep. 27, 2017	TEAS CHANGE OF CORRESPONDENCE RECEIVED	
Sep. 28, 2017	TEAS/EMAIL CORRESPONDENCE ENTERED	88889
Sep. 27, 2017	CORRESPONDENCE RECEIVED IN LAW OFFICE	88889
Sep. 27, 2017	TEAS RESPONSE TO OFFICE ACTION RECEIVED	
Mar. 27, 2017	NOTIFICATION OF NON-FINAL ACTION E-MAILED	6325
Mar. 27, 2017	NON-FINAL ACTION E-MAILED	6325
Mar. 27, 2017	NON-FINAL ACTION WRITTEN	92576
Mar. 21, 2017	ASSIGNED TO EXAMINER	92576
Jan. 07, 2017	NOTICE OF DESIGN SEARCH CODE E-MAILED	
Jan. 06, 2017	NEW APPLICATION OFFICE SUPPLIED DATA ENTERED IN TRAM	
Dec. 27, 2016	NEW APPLICATION ENTERED IN TRAM	

TM Staff and Location Information

TM Staff Information

TM Attorney: WRIGHT, MARCO JABBAR

Law Office LAW OFFICE 120
Assigned:

File Location

Current Location: TMO LAW OFFICE 120

Date in Location: Nov. 05, 2018

Generated on: This page was generated by TSDR on 2019-04-03 20:09:49 EDT

Mark: ESSENTIAL



US Serial Number: 87545739

Application Filing Date: Jul. 27, 2017

Filed as TEAS RF: Yes

Currently TEAS RF: Yes

Register: Principal

Mark Type: Service Mark

Status: An Office action suspending further action on the application has been sent (issued) to the applicant. To view all documents in this file, click on the Trademark Document Retrieval link at the top of this page.

Status Date: Nov. 28, 2018

Mark Information

Mark Literal Elements: ESSENTIAL

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 the wording "ESSENTIAL" to the right of a shaded circle and a shaded square containing a circle.

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

Design Search Code(s): 26.01.13 - Circles, two (not concentric); Two circles
26.01.21 - Circles that are totally or partially shaded.
26.09.09 - Squares made of geometric figures, objects, humans, plants or animals
26.09.21 - Squares that are completely or partially shaded

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: Providing a website featuring blogs in the field of technology, namely, cell phones, smartphones, cameras and smart home devices not for others, not including websites featuring services for computerized data management, database development services, data warehousing and database integration services, computer software programming for others, creating and maintaining web sites for others and designing and implementing network web pages for others, application service provider featuring software in the fields of financial and business regulatory compliance management and content conversion and development, business training and business training management, customer and sales support, product updates for employees and customers, organizational growth and development assessment and planning, conversion of business and training data, documents and content from physical form into interactive electronic, digital and web-based media

International Class(es): 041 - Primary Class

U.S Class(es): 100, 101, 107

Class Status: ACTIVE

Basis: 1(a)

First Use: May 30, 2017

Use in Commerce: May 30, 2017

Basis Information (Case Level)

Filed Use:	Yes	Currently Use:	Yes	Amended Use:	No
Filed ITU:	No	Currently ITU:	No	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: Essential Products, Inc.

Owner Address: 380 Portage Avenue
Palo Alto, CALIFORNIA 94306
UNITED STATES

Legal Entity Type: CORPORATION

State or Country Where Organized: DELAWARE

Attorney/Correspondence Information

Attorney of Record

Attorney Name: Lynne E. Graybeal

Docket Number: 119306-4112

Attorney Primary Email Address: pctrademarks@perkinscoie.com

Attorney Email Authorized: Yes

Correspondent

Correspondent Name/Address: Lynne E. Graybeal
Perkins Coie LLP
1201 Third Avenue Suite 4900
Seattle, WASHINGTON 98101
UNITED STATES

Phone: 206-359-8000

Fax: 206-359-9000

Correspondent e-mail: pctrademarks@perkinscoie.com LGraybeal@perkinscoie.com aichang@perkinscoie.com kthompson@perkinscoie.com

Correspondent e-mail Authorized: Yes

Domestic Representative - Not Found

Prosecution History

Date	Description	Proceeding Number
Mar. 14, 2019	ATTORNEY/DOM.REP.REVOKED AND/OR APPOINTED	
Mar. 14, 2019	TEAS REVOKE/APP/CHANGE ADDR OF ATTY/DOM REP RECEIVED	
Nov. 28, 2018	NOTIFICATION OF LETTER OF SUSPENSION E-MAILED	6332
Nov. 28, 2018	LETTER OF SUSPENSION E-MAILED	6332
Nov. 28, 2018	SUSPENSION LETTER WRITTEN	92576
Nov. 28, 2018	TEAS/EMAIL CORRESPONDENCE ENTERED	70629
Nov. 28, 2018	CORRESPONDENCE RECEIVED IN LAW OFFICE	70629
Nov. 28, 2018	ASSIGNED TO LIE	70629
Nov. 19, 2018	TEAS RESPONSE TO OFFICE ACTION RECEIVED	
May 17, 2018	NOTIFICATION OF NON-FINAL ACTION E-MAILED	6325
May 17, 2018	NON-FINAL ACTION E-MAILED	6325
May 17, 2018	NON-FINAL ACTION WRITTEN	92576
Apr. 26, 2018	TEAS/EMAIL CORRESPONDENCE ENTERED	88889
Apr. 25, 2018	CORRESPONDENCE RECEIVED IN LAW OFFICE	88889
Apr. 25, 2018	TEAS RESPONSE TO OFFICE ACTION RECEIVED	
Oct. 25, 2017	NOTIFICATION OF NON-FINAL ACTION E-MAILED	6325
Oct. 25, 2017	NON-FINAL ACTION E-MAILED	6325
Oct. 25, 2017	NON-FINAL ACTION WRITTEN	92576
Oct. 24, 2017	ASSIGNED TO EXAMINER	92576
Oct. 24, 2017	ASSIGNED TO EXAMINER	70729
Aug. 02, 2017	NOTICE OF DESIGN SEARCH CODE E-MAILED	
Aug. 01, 2017	NEW APPLICATION OFFICE SUPPLIED DATA ENTERED IN TRAM	
Jul. 31, 2017	NEW APPLICATION ENTERED IN TRAM	

TM Staff and Location Information

TM Staff Information

TM Attorney: WRIGHT, MARCO JABBAR

Law Office: LAW OFFICE 120

Assigned:

File Location

Current Location: TMO LAW OFFICE 120 - EXAMINING
ATTORNEY ASSIGNED

Date in Location: Nov. 28, 2018

Generated on: This page was generated by TSDR on 2019-04-03 20:09:57 EDT

Mark: ESSENTIAL



US Serial Number: 87545749

Application Filing Date: Jul. 27, 2017

Filed as TEAS RF: Yes

Currently TEAS RF: Yes

Register: Principal

Mark Type: Service Mark

Status: An Office action suspending further action on the application has been sent (issued) to the applicant. To view all documents in this file, click on the Trademark Document Retrieval link at the top of this page.

Status Date: Nov. 28, 2018

Mark Information

Mark Literal Elements: ESSENTIAL

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 the wording "ESSENTIAL" to the right of a shaded circle and a shaded square containing a circle.

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

Design Search Code(s): 26.01.02 - Circles, plain single line; Plain single line circles

26.01.13 - Circles, two (not concentric); Two circles

26.01.21 - Circles that are totally or partially shaded.

26.09.21 - Squares that are completely or partially shaded

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: Technical support services, namely, troubleshooting of computer software problems for cell phones and smart home devices, not including technical support services for computerized data management, database development services, data warehousing and database integration services, computer software programming for others, creating and maintaining web sites for others and designing and implementing network web pages for others, Application service provider (ASP) featuring software in the fields of financial and business regulatory compliance management and content conversion and development, business training and business training management, customer and sales support, product updates for employees and customers, organizational growth and development assessment and planning, conversion of business and training data, documents and content from physical form into interactive electronic, digital and web-based media

International Class(es): 042 - Primary Class

U.S Class(es): 100, 101

Class Status: ACTIVE

Basis: 1(a)

First Use: May 30, 2017

Use in Commerce: May 30, 2017

Basis Information (Case Level)

Filed Use: Yes

Currently Use: Yes

Amended Use: No

Filed ITU: No

Currently ITU: No

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: Essential Products, Inc.

Owner Address: 380 Portage Avenue
Palo Alto, CALIFORNIA 94306
UNITED STATES

Legal Entity Type: CORPORATION

State or Country Where Organized: DELAWARE

Attorney/Correspondence Information

Attorney of Record

Attorney Name: Lynne E. Graybeal

Docket Number: 119306-4113

Attorney Primary Email Address: pctrademarks@perkinscoie.com

Attorney Email Authorized: Yes

Correspondent

Correspondent Name/Address: Lynne E. Graybeal
Perkins Coie LLP
1201 Third Avenue Suite 4900
Seattle, WASHINGTON 98101
UNITED STATES

Phone: 206-359-8000

Fax: 206-359-9000

Correspondent e-mail: pctrademarks@perkinscoie.com LGraybeal@perkinscoie.com aichang@perkinscoie.com kthompson@perkinscoie.com

Correspondent e-mail Authorized: Yes

Domestic Representative - Not Found

Prosecution History

Date	Description	Proceeding Number
Mar. 14, 2019	ATTORNEY/DOM.REP.REVOKED AND/OR APPOINTED	
Mar. 14, 2019	TEAS REVOKE/APP/CHANGE ADDR OF ATTY/DOM REP RECEIVED	
Nov. 28, 2018	NOTIFICATION OF LETTER OF SUSPENSION E-MAILED	6332
Nov. 28, 2018	LETTER OF SUSPENSION E-MAILED	6332
Nov. 28, 2018	SUSPENSION LETTER WRITTEN	92576
Nov. 28, 2018	TEAS/EMAIL CORRESPONDENCE ENTERED	70629
Nov. 28, 2018	CORRESPONDENCE RECEIVED IN LAW OFFICE	70629
Nov. 28, 2018	ASSIGNED TO LIE	70629
Nov. 19, 2018	TEAS RESPONSE TO OFFICE ACTION RECEIVED	
May 17, 2018	NOTIFICATION OF NON-FINAL ACTION E-MAILED	6325
May 17, 2018	NON-FINAL ACTION E-MAILED	6325
May 17, 2018	NON-FINAL ACTION WRITTEN	92576
Apr. 26, 2018	TEAS/EMAIL CORRESPONDENCE ENTERED	88889
Apr. 25, 2018	CORRESPONDENCE RECEIVED IN LAW OFFICE	88889
Apr. 25, 2018	TEAS RESPONSE TO OFFICE ACTION RECEIVED	
Oct. 25, 2017	NOTIFICATION OF NON-FINAL ACTION E-MAILED	6325
Oct. 25, 2017	NON-FINAL ACTION E-MAILED	6325
Oct. 25, 2017	NON-FINAL ACTION WRITTEN	92576
Oct. 24, 2017	ASSIGNED TO EXAMINER	92576
Oct. 24, 2017	ASSIGNED TO EXAMINER	70729
Aug. 02, 2017	NOTICE OF DESIGN SEARCH CODE E-MAILED	
Aug. 01, 2017	NEW APPLICATION OFFICE SUPPLIED DATA ENTERED IN TRAM	
Jul. 31, 2017	NEW APPLICATION ENTERED IN TRAM	

TM Staff and Location Information

TM Staff Information

TM Attorney: WRIGHT, MARCO JABBAR

Law Office: LAW OFFICE 120

Assigned:

File Location

Current Location: TMO LAW OFFICE 120 - EXAMINING
ATTORNEY ASSIGNED

Date in Location: Nov. 28, 2018

Generated on: This page was generated by TSDR on 2019-04-03 20:02:25 EDT

Mark: ESSENTIAL

ESSENTIAL

US Serial Number: 87976086

Application Filing Date: Jan. 13, 2017

Filed as TEAS RF: Yes

Currently TEAS RF: Yes

Register: Principal

Mark Type: Service Mark

Status: Suspension check completed. Application remains suspended.

Status Date: Dec. 06, 2018

Mark Information

Mark Literal Elements: ESSENTIAL

Standard Character Claim: Yes. The mark consists of standard characters without claim to any particular font style, size, or color.

Mark Drawing Type: 4 - STANDARD CHARACTER MARK

Related Properties Information

Child Of: 87301559

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: Retail store services and retail store services provided via communications networks all featuring handheld mobile digital electronic devices and other consumer electronics and computer software; Retail store services of consumer electronic products, namely, mobile phones, smart phones, tablet computers, computer and computer software products, entertainment products, tablet computers, handheld mobile digital electronic devices; On-line retail store services featuring consumer electronic products, namely, mobile phones, smart phones, tablet computers, computers and computer software products, entertainment products, tablet computers, handheld mobile digital electronic Devices

International Class(es): 035 - Primary Class

U.S Class(es): 100, 101, 102

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: Essential Products, Inc.

Owner Address: 380 Portage Avenue

Palo Alto, CALIFORNIA 94306
UNITED STATES

Legal Entity Type: CORPORATION

State or Country DELAWARE
Where Organized:

Attorney/Correspondence Information

Attorney of Record

Attorney Name: Lynne E. Graybeal

Docket Number: 119306-4004

Attorney Primary Email Address: pctrademarks@perkinscoie.com

Attorney Email Authorized: Yes

Correspondent

Correspondent Name/Address: Lynne E. Graybeal
Perkins Coie LLP
1201 Third Avenue Suite 4900
Seattle, WASHINGTON 98101
UNITED STATES

Phone: 206-359-8000

Fax: 206-359-9000

Correspondent e-mail: pctrademarks@perkinscoie.com LGraybeal@perkinscoie.com aichang@perkinscoie.com kthompson@perkinscoie.com

Correspondent e-mail Authorized: Yes

Domestic Representative - Not Found

Prosecution History

Date	Description	Proceeding Number
Mar. 14, 2019	ATTORNEY/DOM.REP.REVOKED AND/OR APPOINTED	
Mar. 14, 2019	TEAS REVOKE/APP/CHANGE ADDR OF ATTY/DOM REP RECEIVED	
Dec. 06, 2018	REPORT COMPLETED SUSPENSION CHECK CASE STILL SUSPENDED	68171
May 31, 2018	REPORT COMPLETED SUSPENSION CHECK CASE STILL SUSPENDED	68171
May 31, 2018	ASSIGNED TO LIE	68171
Nov. 13, 2017	NOTIFICATION OF LETTER OF SUSPENSION E-MAILED	6332
Nov. 13, 2017	LETTER OF SUSPENSION E-MAILED	6332
Nov. 13, 2017	SUSPENSION LETTER WRITTEN	92576
Oct. 20, 2017	DIVISIONAL PROCESSING COMPLETE	
Sep. 27, 2017	DIVISIONAL REQUEST RECEIVED	
Oct. 10, 2017	CASE ASSIGNED TO INTENT TO USE PARALEGAL	74055
Sep. 28, 2017	TEAS/EMAIL CORRESPONDENCE ENTERED	88889
Sep. 27, 2017	CORRESPONDENCE RECEIVED IN LAW OFFICE	88889
Sep. 27, 2017	TEAS RESPONSE TO OFFICE ACTION RECEIVED	
Sep. 27, 2017	TEAS CHANGE OF CORRESPONDENCE RECEIVED	
Mar. 27, 2017	NOTIFICATION OF NON-FINAL ACTION E-MAILED	6325
Mar. 27, 2017	NON-FINAL ACTION E-MAILED	6325
Mar. 27, 2017	NON-FINAL ACTION WRITTEN	92576
Mar. 21, 2017	ASSIGNED TO EXAMINER	92576
Jan. 23, 2017	NEW APPLICATION OFFICE SUPPLIED DATA ENTERED IN TRAM	
Jan. 17, 2017	NEW APPLICATION ENTERED IN TRAM	

TM Staff and Location Information

TM Staff Information

TM Attorney: WRIGHT, MARCO JABBAR

Law Office Assigned: LAW OFFICE 120

File Location

Current Location: TMO LAW OFFICE 120

Date in Location: Dec. 06, 2018

Generated on: This page was generated by TSDR on 2019-04-03 20:02:35 EDT

Mark: ESSENTIAL

ESSENTIAL

US Serial Number: 87976088

Application Filing Date: Jan. 13, 2017

Filed as TEAS RF: Yes

Currently TEAS RF: Yes

Register: Principal

Mark Type: Trademark

TM5 Common Status Descriptor:



LIVE/APPLICATION/Under Examination

The trademark application has been accepted by the Office (has met the minimum filing requirements) and that this application has been assigned to an examiner.

Status: Suspension check completed. Application remains suspended.

Status Date: Dec. 06, 2018

Mark Information

Mark Literal Elements: ESSENTIAL

Standard Character Claim: Yes. The mark consists of standard characters without claim to any particular font style, size, or color.

Mark Drawing Type: 4 - STANDARD CHARACTER MARK

Related Properties Information

Child Of: 87301559

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: Virtual reality headsets and head mounted displays for use in playing video games

International Class(es): 009 - Primary Class

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

Class Status: ACTIVE

Basis: 1(b)

For: Handheld unit for playing electronic games

International Class(es): 028 - Primary Class

U.S Class(es): 022, 023, 038, 050

Class Status: ACTIVE

Basis: 1(b)

Basis Information (Case Level)

Filed Use: No

Currently Use: No

Filed ITU: Yes

Currently ITU: Yes

Filed 44D: No

Currently 44E: No

Filed 44E: No

Currently 66A: No

Filed 66A: No

Currently No Basis: No

Filed No Basis: No

Current Owner(s) Information

Owner Name: Essential Products, Inc.

Owner Address: 380 Portage Avenue
Palo Alto, CALIFORNIA UNITED STATES 94306

Legal Entity Type: CORPORATION

State or Country Where Organized: DELAWARE

Attorney/Correspondence Information

Attorney of Record

Attorney Name: Lynne E. Graybeal

Docket Number: 119306-4004

Attorney Primary Email Address: pctrademarks@perkinscoie.com

Attorney Email Authorized: Yes

Correspondent

Correspondent Name/Address: Lynne E. Graybeal
Perkins Coie LLP
1201 Third Avenue Suite 4900
Seattle, WASHINGTON UNITED STATES 98101

Phone: 206-359-8000

Fax: 206-359-9000

Correspondent e-mail: pctrademarks@perkinscoie.com LGraybeal@perkinscoie.com aichang@perkinscoie.com kthompson@perkinscoie.com

Correspondent e-mail Authorized: Yes

Domestic Representative - Not Found

Prosecution History

Date	Description	Proceeding Number
Mar. 14, 2019	ATTORNEY/DOM.REP.REVOKED AND/OR APPOINTED	
Mar. 14, 2019	TEAS REVOKE/APP/CHANGE ADDR OF ATTY/DOM REP RECEIVED	
Dec. 06, 2018	REPORT COMPLETED SUSPENSION CHECK CASE STILL SUSPENDED	68171
May 31, 2018	REPORT COMPLETED SUSPENSION CHECK CASE STILL SUSPENDED	68171
May 31, 2018	ASSIGNED TO LIE	68171
Nov. 13, 2017	NOTIFICATION OF LETTER OF SUSPENSION E-MAILED	6332
Nov. 13, 2017	LETTER OF SUSPENSION E-MAILED	6332
Nov. 13, 2017	SUSPENSION LETTER WRITTEN	92576
Oct. 20, 2017	DIVISIONAL PROCESSING COMPLETE	
Sep. 27, 2017	DIVISIONAL REQUEST RECEIVED	
Oct. 10, 2017	CASE ASSIGNED TO INTENT TO USE PARALEGAL	74055
Sep. 28, 2017	TEAS/EMAIL CORRESPONDENCE ENTERED	88889
Sep. 27, 2017	CORRESPONDENCE RECEIVED IN LAW OFFICE	88889
Sep. 27, 2017	TEAS RESPONSE TO OFFICE ACTION RECEIVED	
Sep. 27, 2017	TEAS CHANGE OF CORRESPONDENCE RECEIVED	
Mar. 27, 2017	NOTIFICATION OF NON-FINAL ACTION E-MAILED	6325
Mar. 27, 2017	NON-FINAL ACTION E-MAILED	6325
Mar. 27, 2017	NON-FINAL ACTION WRITTEN	92576
Mar. 21, 2017	ASSIGNED TO EXAMINER	92576
Jan. 23, 2017	NEW APPLICATION OFFICE SUPPLIED DATA ENTERED IN TRAM	
Jan. 17, 2017	NEW APPLICATION ENTERED IN TRAM	

TM Staff and Location Information

TM Staff Information

TM Attorney: WRIGHT, MARCO JABBAR

Law Office Assigned: LAW OFFICE 120

File Location

Current Location: TMO LAW OFFICE 120

Date in Location: Dec. 06, 2018

Generated on: This page was generated by TSDR on 2019-04-03 20:02:59 EDT

Mark: ESSENTIAL PRODUCTS

ESSENTIAL PRODUCTS

US Serial Number: 87976090

Application Filing Date: Jan. 13, 2017

Filed as TEAS RF: Yes

Currently TEAS RF: Yes

Register: Principal

Mark Type: Trademark

Status: Suspension check completed. Application remains suspended.

Status Date: Jan. 11, 2019

Mark Information

Mark Literal Elements: ESSENTIAL PRODUCTS

Standard Character Claim: Yes. The mark consists of standard characters without claim to any particular font style, size, or color.

Mark Drawing Type: 4 - STANDARD CHARACTER MARK

Disclaimer: "PRODUCTS"

Related Properties Information

Child Of: 87301561

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: Mobile phones; Smart phones; Computers and tablet computers; Replacement parts for all the aforementioned goods

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: Essential Products, Inc.

Owner Address: 380 Portage Avenue
Palo Alto, CALIFORNIA 94306
UNITED STATES

Legal Entity Type: CORPORATION

State or Country Where Organized: DELAWARE

Attorney/Correspondence Information

Attorney of Record

Attorney Name: Lynne E. Graybeal

Docket Number: 119306-4005

Attorney Primary Email Address: pctrademarks@perkinscoie.com

Attorney Email Authorized: Yes

Correspondent

Correspondent Name/Address: Lynne E. Graybeal
Perkins Coie LLP
1201 Third Avenue Suite 4900
Seattle, WASHINGTON 98101
UNITED STATES

Phone: 206-359-8000

Fax: 206-359-9000

Correspondent e-mail: pctrademarks@perkinscoie.com LGraybeal@perkinscoie.com aichang@perkinscoie.com kthompson@perkinscoie.com

Correspondent e-mail Authorized: Yes

Domestic Representative - Not Found

Prosecution History

Date	Description	Proceeding Number
Mar. 14, 2019	ATTORNEY/DOM.REP.REVOKED AND/OR APPOINTED	
Mar. 14, 2019	TEAS REVOKE/APP/CHANGE ADDR OF ATTY/DOM REP RECEIVED	
Jan. 11, 2019	REPORT COMPLETED SUSPENSION CHECK CASE STILL SUSPENDED	76568
Jun. 01, 2018	REPORT COMPLETED SUSPENSION CHECK CASE STILL SUSPENDED	76568
Jun. 01, 2018	ASSIGNED TO LIE	76568
Nov. 15, 2017	NOTIFICATION OF LETTER OF SUSPENSION E-MAILED	6332
Nov. 15, 2017	LETTER OF SUSPENSION E-MAILED	6332
Nov. 15, 2017	SUSPENSION LETTER WRITTEN	92576
Oct. 25, 2017	DIVISIONAL PROCESSING COMPLETE	
Sep. 27, 2017	DIVISIONAL REQUEST RECEIVED	
Oct. 10, 2017	CASE ASSIGNED TO INTENT TO USE PARALEGAL	74055
Sep. 27, 2017	TEAS CHANGE OF CORRESPONDENCE RECEIVED	
Sep. 28, 2017	TEAS/EMAIL CORRESPONDENCE ENTERED	88889
Sep. 27, 2017	CORRESPONDENCE RECEIVED IN LAW OFFICE	88889
Sep. 27, 2017	TEAS RESPONSE TO OFFICE ACTION RECEIVED	
Mar. 27, 2017	NOTIFICATION OF NON-FINAL ACTION E-MAILED	6325
Mar. 27, 2017	NON-FINAL ACTION E-MAILED	6325
Mar. 27, 2017	NON-FINAL ACTION WRITTEN	92576
Mar. 21, 2017	ASSIGNED TO EXAMINER	92576
Jan. 23, 2017	NEW APPLICATION OFFICE SUPPLIED DATA ENTERED IN TRAM	
Jan. 17, 2017	NEW APPLICATION ENTERED IN TRAM	

TM Staff and Location Information

TM Staff Information

TM Attorney: WRIGHT, MARCO JABBAR

Law Office Assigned: LAW OFFICE 120

File Location

Current Location: TMO LAW OFFICE 120

Date in Location: Jan. 11, 2019

Generated on: This page was generated by TSDR on 2019-04-03 20:03:16 EDT

Mark: ESSENTIAL PRODUCTS

ESSENTIAL PRODUCTS

US Serial Number: 87976092

Application Filing Date: Jan. 13, 2017

Filed as TEAS RF: Yes

Currently TEAS RF: Yes

Register: Principal

Mark Type: Trademark

Status: Suspension check completed. Application remains suspended.

Status Date: Jan. 11, 2019

Mark Information

Mark Literal Elements: ESSENTIAL PRODUCTS

Standard Character Claim: Yes. The mark consists of standard characters without claim to any particular font style, size, or color.

Mark Drawing Type: 4 - STANDARD CHARACTER MARK

Disclaimer: "PRODUCTS"

Related Properties Information

Child Of: 87301561

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: Virtual reality headsets and head mounted displays for use in playing video games

International Class(es): 009 - Primary Class

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

Class Status: ACTIVE

Basis: 1(b)

For: Handheld unit for playing electronic games

International Class(es): 028 - Primary Class

U.S Class(es): 022, 023, 038, 050

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: Essential Products, Inc.

Owner Address: 380 Portage Avenue
Palo Alto, CALIFORNIA 94306
UNITED STATES

Legal Entity Type: CORPORATION

State or Country Where Organized: DELAWARE

Attorney/Correspondence Information

Attorney of Record

Attorney Name: Lynne E. Graybeal

Docket Number: 119306-4005

Attorney Primary Email Address: pctrademarks@perkinscoie.com

Attorney Email Authorized: Yes

Correspondent

Correspondent Name/Address: Lynne E. Graybeal
Perkins Coie LLP
1201 Third Avenue Suite 4900
Seattle, WASHINGTON 98101
UNITED STATES

Phone: 206-359-8000

Fax: 206-359-9000

Correspondent e-mail: pctrademarks@perkinscoie.com LGraybeal@perkinscoie.com aichang@perkinscoie.com kthompson@perkinscoie.com

Correspondent e-mail Authorized: Yes

Domestic Representative - Not Found

Prosecution History

Date	Description	Proceeding Number
Mar. 14, 2019	ATTORNEY/DOM.REP.REVOKED AND/OR APPOINTED	
Mar. 14, 2019	TEAS REVOKE/APP/CHANGE ADDR OF ATTY/DOM REP RECEIVED	
Jan. 11, 2019	REPORT COMPLETED SUSPENSION CHECK CASE STILL SUSPENDED	76568
Jun. 01, 2018	REPORT COMPLETED SUSPENSION CHECK CASE STILL SUSPENDED	76568
Jun. 01, 2018	ASSIGNED TO LIE	76568
Nov. 15, 2017	NOTIFICATION OF LETTER OF SUSPENSION E-MAILED	6332
Nov. 15, 2017	LETTER OF SUSPENSION E-MAILED	6332
Nov. 15, 2017	SUSPENSION LETTER WRITTEN	92576
Oct. 25, 2017	DIVISIONAL PROCESSING COMPLETE	
Sep. 27, 2017	DIVISIONAL REQUEST RECEIVED	
Oct. 10, 2017	CASE ASSIGNED TO INTENT TO USE PARALEGAL	74055
Sep. 27, 2017	TEAS CHANGE OF CORRESPONDENCE RECEIVED	
Sep. 28, 2017	TEAS/EMAIL CORRESPONDENCE ENTERED	88889
Sep. 27, 2017	CORRESPONDENCE RECEIVED IN LAW OFFICE	88889
Sep. 27, 2017	TEAS RESPONSE TO OFFICE ACTION RECEIVED	
Mar. 27, 2017	NOTIFICATION OF NON-FINAL ACTION E-MAILED	6325
Mar. 27, 2017	NON-FINAL ACTION E-MAILED	6325
Mar. 27, 2017	NON-FINAL ACTION WRITTEN	92576
Mar. 21, 2017	ASSIGNED TO EXAMINER	92576
Jan. 23, 2017	NEW APPLICATION OFFICE SUPPLIED DATA ENTERED IN TRAM	
Jan. 17, 2017	NEW APPLICATION ENTERED IN TRAM	

TM Staff and Location Information

TM Staff Information

TM Attorney: WRIGHT, MARCO JABBAR

Law Office Assigned: LAW OFFICE 120

File Location

Current Location: TMO LAW OFFICE 120

Date in Location: Jan. 11, 2019

Generated on: This page was generated by TSDR on 2019-04-03 20:03:07 EDT

Mark: ESSENTIAL PRODUCTS

ESSENTIAL PRODUCTS

US Serial Number: 87976106

Application Filing Date: Jan. 13, 2017

Filed as TEAS RF: Yes

Currently TEAS RF: Yes

Register: Principal

Mark Type: Service Mark

Status: Suspension check completed. Application remains suspended.

Status Date: Dec. 14, 2018

Mark Information

Mark Literal Elements: ESSENTIAL PRODUCTS

Standard Character Claim: Yes. The mark consists of standard characters without claim to any particular font style, size, or color.

Mark Drawing Type: 4 - STANDARD CHARACTER MARK

Related Properties Information

Child Of: 87301561

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: Retail store services and retail store services provided via communications networks all featuring handheld mobile digital electronic devices and other consumer electronics, and computer software; Retail store services of consumer electronic products, namely, mobile phones, smart phones, tablet computers, computer and computer software products, entertainment products, tablet computers, handheld mobile digital electronic devices, On-line retail store services featuring consumer electronic products, namely, mobile phones, smart phones, tablet computers, computers and computer software products, entertainment products, tablet computers, handheld mobile digital electronic devices

International Class(es): 035 - Primary Class

U.S Class(es): 100, 101, 102

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: Essential Products, Inc.

Owner Address: 380 Portage Avenue

Palo Alto, CALIFORNIA 94306
UNITED STATES

Legal Entity Type: CORPORATION

State or Country DELAWARE
Where Organized:

Attorney/Correspondence Information

Attorney of Record

Attorney Name: Lynne E. Graybeal

Docket Number: 119306-4005

Attorney Primary Email Address: pctrademarks@perkinscoie.com

Attorney Email Authorized: Yes

Correspondent

Correspondent Name/Address: Lynne E. Graybeal
Perkins Coie LLP
1201 Third Avenue Suite 4900
Seattle, WASHINGTON 98101
UNITED STATES

Phone: 206-359-8000

Fax: 206-359-9000

Correspondent e-mail: pctrademarks@perkinscoie.com LGraybeal@perkinscoie.com aichang@perkinscoie.com kthompson@perkinscoie.com

Correspondent e-mail Authorized: Yes

Domestic Representative - Not Found

Prosecution History

Date	Description	Proceeding Number
Mar. 14, 2019	ATTORNEY/DOM.REP.REVOKED AND/OR APPOINTED	
Mar. 14, 2019	TEAS REVOKE/APP/CHANGE ADDR OF ATTY/DOM REP RECEIVED	
Dec. 14, 2018	REPORT COMPLETED SUSPENSION CHECK CASE STILL SUSPENDED	59554
Dec. 14, 2018	ASSIGNED TO LIE	59554
Jun. 01, 2018	REPORT COMPLETED SUSPENSION CHECK CASE STILL SUSPENDED	68123
Jun. 01, 2018	ASSIGNED TO LIE	68123
Nov. 15, 2017	NOTIFICATION OF LETTER OF SUSPENSION E-MAILED	6332
Nov. 15, 2017	LETTER OF SUSPENSION E-MAILED	6332
Nov. 15, 2017	SUSPENSION LETTER WRITTEN	92576
Oct. 25, 2017	DIVISIONAL PROCESSING COMPLETE	
Sep. 27, 2017	DIVISIONAL REQUEST RECEIVED	
Oct. 10, 2017	CASE ASSIGNED TO INTENT TO USE PARALEGAL	74055
Sep. 27, 2017	TEAS CHANGE OF CORRESPONDENCE RECEIVED	
Sep. 28, 2017	TEAS/EMAIL CORRESPONDENCE ENTERED	88889
Sep. 27, 2017	CORRESPONDENCE RECEIVED IN LAW OFFICE	88889
Sep. 27, 2017	TEAS RESPONSE TO OFFICE ACTION RECEIVED	
Mar. 27, 2017	NOTIFICATION OF NON-FINAL ACTION E-MAILED	6325
Mar. 27, 2017	NON-FINAL ACTION E-MAILED	6325
Mar. 27, 2017	NON-FINAL ACTION WRITTEN	92576
Mar. 21, 2017	ASSIGNED TO EXAMINER	92576
Jan. 23, 2017	NEW APPLICATION OFFICE SUPPLIED DATA ENTERED IN TRAM	
Jan. 17, 2017	NEW APPLICATION ENTERED IN TRAM	

TM Staff and Location Information

TM Staff Information

TM Attorney: WRIGHT, MARCO JABBAR

Law Office LAW OFFICE 120
Assigned:

File Location

Current Location: TMO LAW OFFICE 120

Date in Location: Dec. 14, 2018

Generated on: This page was generated by TSDR on 2019-04-03 20:02:52 EDT

Mark: ESSENTIAL PRODUCTS

ESSENTIAL PRODUCTS

US Serial Number: 87976107

Application Filing Date: Jan. 13, 2017

Filed as TEAS RF: Yes

Currently TEAS RF: Yes

Register: Principal

Mark Type: Trademark

Status: Suspension check completed. Application remains suspended.

Status Date: Dec. 14, 2018

Mark Information

Mark Literal Elements: ESSENTIAL PRODUCTS

Standard Character Claim: Yes. The mark consists of standard characters without claim to any particular font style, size, or color.

Mark Drawing Type: 4 - STANDARD CHARACTER MARK

Disclaimer: "PRODUCTS"

Related Properties Information

Child Of: 87301561

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 operating software for mobile phones, smart phones, computers and tablet computers

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: Essential Products, Inc.

Owner Address: 380 Portage Avenue
Palo Alto, CALIFORNIA 94306
UNITED STATES

Legal Entity Type: CORPORATION

State or Country DELAWARE
Where Organized:

Attorney/Correspondence Information

Attorney of Record

Attorney Name: Lynne E. Graybeal

Docket Number: 119306-4005

Attorney Primary Email Address: pctrademarks@perkinscoie.com

Attorney Email Authorized: Yes

Correspondent

Correspondent Name/Address: Lynne E. Graybeal
Perkins Coie LLP
1201 Third Avenue Suite 4900
Seattle, WASHINGTON 98101
UNITED STATES

Phone: 206-359-8000

Fax: 206-359-9000

Correspondent e-mail: pctrademarks@perkinscoie.com LGraybeal@perkinscoie.com aichang@perkinscoie.com kthompson@perkinscoie.com

Correspondent e-mail Authorized: Yes

Domestic Representative - Not Found

Prosecution History

Date	Description	Proceeding Number
Mar. 14, 2019	ATTORNEY/DOM.REP.REVOKED AND/OR APPOINTED	
Mar. 14, 2019	TEAS REVOKE/APP/CHANGE ADDR OF ATTY/DOM REP RECEIVED	
Dec. 14, 2018	REPORT COMPLETED SUSPENSION CHECK CASE STILL SUSPENDED	59554
Dec. 14, 2018	ASSIGNED TO LIE	59554
Jun. 01, 2018	REPORT COMPLETED SUSPENSION CHECK CASE STILL SUSPENDED	68123
Jun. 01, 2018	ASSIGNED TO LIE	68123
Nov. 15, 2017	NOTIFICATION OF LETTER OF SUSPENSION E-MAILED	6332
Nov. 15, 2017	LETTER OF SUSPENSION E-MAILED	6332
Nov. 15, 2017	SUSPENSION LETTER WRITTEN	92576
Oct. 25, 2017	DIVISIONAL PROCESSING COMPLETE	
Sep. 27, 2017	DIVISIONAL REQUEST RECEIVED	
Oct. 10, 2017	CASE ASSIGNED TO INTENT TO USE PARALEGAL	74055
Sep. 27, 2017	TEAS CHANGE OF CORRESPONDENCE RECEIVED	
Sep. 28, 2017	TEAS/EMAIL CORRESPONDENCE ENTERED	88889
Sep. 27, 2017	CORRESPONDENCE RECEIVED IN LAW OFFICE	88889
Sep. 27, 2017	TEAS RESPONSE TO OFFICE ACTION RECEIVED	
Mar. 27, 2017	NOTIFICATION OF NON-FINAL ACTION E-MAILED	6325
Mar. 27, 2017	NON-FINAL ACTION E-MAILED	6325
Mar. 27, 2017	NON-FINAL ACTION WRITTEN	92576
Mar. 21, 2017	ASSIGNED TO EXAMINER	92576
Jan. 23, 2017	NEW APPLICATION OFFICE SUPPLIED DATA ENTERED IN TRAM	
Jan. 17, 2017	NEW APPLICATION ENTERED IN TRAM	

TM Staff and Location Information

TM Staff Information

TM Attorney: WRIGHT, MARCO JABBAR

Law Office LAW OFFICE 120
Assigned:

File Location

Current Location: TMO LAW OFFICE 120

Date in Location: Dec. 14, 2018

Exhibit C

To: Essential Products, Inc. (petrademarks@perkinscoie.com)
Subject: U.S. TRADEMARK APPLICATION NO. 87278834 - ESSENTIAL - 119306-4003
Sent: 3/27/2017 9:11:47 PM
Sent As: ECOM120@USPTO.GOV

Attachments: [Attachment - 1](#)
[Attachment - 2](#)
[Attachment - 3](#)
[Attachment - 4](#)
[Attachment - 5](#)
[Attachment - 6](#)
[Attachment - 7](#)
[Attachment - 8](#)
[Attachment - 9](#)
[Attachment - 10](#)
[Attachment - 11](#)
[Attachment - 12](#)
[Attachment - 13](#)
[Attachment - 14](#)
[Attachment - 15](#)
[Attachment - 16](#)
[Attachment - 17](#)
[Attachment - 18](#)
[Attachment - 19](#)
[Attachment - 20](#)
[Attachment - 21](#)
[Attachment - 22](#)
[Attachment - 23](#)
[Attachment - 24](#)
[Attachment - 25](#)
[Attachment - 26](#)
[Attachment - 27](#)
[Attachment - 28](#)
[Attachment - 29](#)
[Attachment - 30](#)
[Attachment - 31](#)
[Attachment - 32](#)
[Attachment - 33](#)
[Attachment - 34](#)
[Attachment - 35](#)
[Attachment - 36](#)
[Attachment - 37](#)
[Attachment - 38](#)
[Attachment - 39](#)
[Attachment - 40](#)
[Attachment - 41](#)
[Attachment - 42](#)
[Attachment - 43](#)
[Attachment - 44](#)

[Attachment - 45](#)
[Attachment - 46](#)
[Attachment - 47](#)
[Attachment - 48](#)
[Attachment - 49](#)
[Attachment - 50](#)
[Attachment - 51](#)
[Attachment - 52](#)
[Attachment - 53](#)
[Attachment - 54](#)
[Attachment - 55](#)
[Attachment - 56](#)
[Attachment - 57](#)

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

U.S. APPLICATION SERIAL NO. 87278834

MARK: ESSENTIAL

87278834

CORRESPONDENT ADDRESS:

MICHAEL GLENN
PERKINS COIE LLP
3150 PORTER DRIVE
PALO ALTO, CA 94304

CLICK HERE TO RESPOND TO THIS LETTER:
http://www.uspto.gov/trademarks/teas/response_forms.jsp

[VIEW YOUR APPLICATION FILE](#)

APPLICANT: Essential Products, Inc.

CORRESPONDENT'S REFERENCE/DOCKET NO :

119306-4003

CORRESPONDENT E-MAIL ADDRESS:

pctrademarks@perkinscoie.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. A RESPONSE TRANSMITTED THROUGH THE TRADEMARK ELECTRONIC APPLICATION SYSTEM (TEAS) MUST BE RECEIVED BEFORE MIDNIGHT **EASTERN TIME** OF THE LAST DAY OF THE RESPONSE PERIOD.

ISSUE/MAILING DATE: 3/27/2017

The referenced application has been reviewed by the assigned trademark examining attorney. Applicant must respond timely and completely to the issues below. 15 U.S.C. §1062(b); 37 C.F.R. §§2.62(a), 2.65(a); TMEP §§711, 718.03.

SUMMARY OF ISSUES

- Refusal under Trademark Act Section 2(d) – Likelihood of Confusion
- Advisory: Prior-Filed Application
- Requirement to Amend the Identification of Goods
- Requirement to Amend the Description of the Mark

SECTION 2(d) REFUSAL – LIKELIHOOD OF CONFUSION

Registration of the applied-for mark (**ESSENTIAL**) is refused because of a likelihood of confusion with the marks in U.S. Registration No. 5014095 (**ESSENTIAL**). Trademark Act Section 2(d), 15 U.S.C. § 1052(d); *see* TMEP §§1207.01 *et seq.* See the attached registration.

Trademark Act Section 2(d) bars registration of an applied-for mark that so resembles a registered mark that it is likely a potential consumer would be confused, mistaken, or deceived as to the source of the goods of the applicant and registrant. *See* 15 U.S.C. §1052(d). A determination of likelihood of confusion under Section 2(d) is made on a case-by-case basis and the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973) aid in this determination. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d 1344, 1349, 98 USPQ2d 1253, 1256 (Fed. Cir. 2011) (citing *On-Line Careline, Inc. v. Am. Online, Inc.*, 229 F.3d 1080, 1085, 56 USPQ2d 1471, 1474 (Fed. Cir. 2000)). Not all the *du Pont* factors, however, are necessarily relevant or of equal weight, and any one of the factors may control in a given case, depending upon the evidence of record. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d at 1355, 98 USPQ2d at 1260; *In re Majestic Distilling Co.*, 315 F.3d 1311, 1315, 65 USPQ2d 1201, 1204 (Fed. Cir. 2003); *see In re E. I. du Pont de Nemours & Co.*, 476 F.2d at 1361-62, 177 USPQ at 567.

In this case, the following factors are the most relevant: similarity of the marks, similarity and nature of the goods, and similarity of the trade channels of the goods. *See In re Viterra Inc.*, 671 F.3d 1358, 1361-62, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *In re Dakin's Miniatures Inc.*, 59 USPQ2d 1593, 1595-96 (TTAB 1999); TMEP §§1207.01 *et seq.*

Comparing the Marks

Marks are compared in their entireties for similarities in appearance, sound, connotation, and commercial impression. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 1321, 110 USPQ2d 1157, 1160 (Fed. Cir. 2014) (quoting *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 1371, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005)); TMEP §1207.01(b)-(b)(v). “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014) (citing *In re Ist USA Realty Prof'ls, Inc.*, 84 USPQ2d 1581, 1586 (TTAB 2007)); *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988)); TMEP §1207.01(b).

In this case, the marks are confusingly similar because the dominant element of applicant’s mark is identical to the registered mark. Applicant’s mark is “ **ESSENTIAL**” with design and registrant’s mark is “ **ESSENTIAL**” in standard characters.

The dominant element in the marks is the word “ESSENTIAL”. The word “ESSENTIAL” is the dominant element of registrant’s mark because it is the only wording in the mark. The word “ESSENTIAL” is the dominant element of applicant’s mark because it is the only literal element in the mark. Although marks must be compared in their entireties, the word portion generally may be considered the dominant and most significant feature of a mark because consumers will request the goods using the wording. *See Bond v. Taylor*, 119 USPQ2d 1049, 1055 (TTAB 2016) (citing *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908, 1911 (Fed. Cir. 2012)); TMEP §1207.01(c)(ii). For this reason, greater weight is being given to the word portion of applicant’s mark. *See In re Viterra Inc.*, 671 F.3d at 1366-67, 101 USPQ2d at 1911 (citing *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 1570-71, 218 USPQ2d 390, 395 (Fed. Cir. 1983)). Accordingly, the literal element in applicant’s mark is identical to the only element in registrant’s mark. As such, the marks are confusingly similar.

Comparing the Goods

Generally, the greater degree of similarity between the applied-for mark and the registered mark, the lesser the degree of similarity between the goods of the parties is required to support a finding of likelihood of confusion. *In re C.H. Hanson Co.*, 116 USPQ2d 1351, 1353 (TTAB 2015) (citing *In re Opus One Inc.*, 60 USPQ2d 1812, 1815 (TTAB 2001)); *In re Thor Tech, Inc.*, 90 USPQ2d 1634, 1636 (TTAB 2009).

With respect to applicant’s and registrant’s goods, the question of likelihood of confusion is determined 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)).

In this case, applicant’s goods are “mobile phones; smart phones; computers and tablet computers; accessories and replacement parts for all the aforementioned goods; computer operating software for mobile phones, smart phones, computers and tablet computers” in International Class 9.

Registrant’s goods are the following:

International Class 9: Adjustable smartphone and pc tablet stabilizers and mounts; audio cables; audio speakers; batteries; battery chargers; battery chargers for use with telephones; battery packs; carrying cases for cell phones; carrying cases for mobile computers; carrying cases specially adapted for electronic equipment, namely, cell phones, tablet computers, mp3 players, smart phones, digital cameras, portable media players and navigation apparatus for

vehicles; cases for mobile phones; cell phone battery chargers; cell phone battery chargers for use in vehicles; cell phone cases; cell phone covers; clear protective covers specially adapted for personal electronic devices, namely, cell phones, tablet computers, mp3 players, smart phones, digital cameras, portable media players and navigation apparatus for vehicles; computer mouse; computer mouse, namely, touchpads; data cables; ear phones; earphones and headphones; external computer hard drives; fitted plastic films known as skins for covering and protecting electronic apparatus, namely, cell phones, tablet computers, mp3 players, smart phones, digital cameras, portable media players and navigation apparatus for vehicles; headphones; keyboards; keyboards for mobile phones; mobile telephone batteries; pc tablet mounts; power adapters; protective cases for smartphones; protective covers and cases for cell phones, laptops and portable media players; protective covers and cases for tablet computers; protective glasses; radio transmitters; smartphone mounts; speaker microphones; stands for handheld digital electronic devices, namely, cell phones, tablet computers, mp3 players, smart phones, digital cameras, portable media players and navigation apparatus for vehicles; straps for mobile phones; tripods for cameras; USB cables; USB cables for cellphones; wireless indoor and outdoor speakers

The identification set forth in the application and registration has no restrictions as to nature, type, channels of trade, or classes of purchasers. Therefore, it is presumed that these goods “travel in the same channels of trade to the same class of purchasers.” *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (quoting *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1268, 62 USPQ2d 1001, 1005 (Fed. Cir. 2002)). Further, the application uses broad wording to describe the goods and this wording is presumed to encompass all goods of the type described, including those in registrant’s more narrow identification. See *In re Jump Designs, LLC*, 80 USPQ2d 1370, 1374 (TTAB 2006) (citing *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981)). Specifically, applicant’s goods include accessories and replacement parts for mobile phones, smart phones, computers, and tablet computers and these goods are broad enough to include applicant’s goods. See Wikipedia.org, https://en.wikipedia.org/wiki/Mobile_phone_accessories (March 25, 2017); Tigerdirect.com, http://www.tigerdirect.com/applications/category/category_tlc.asp?CatId=1 (March 27, 2017); Wikipedia.org, https://en.wikipedia.org/wiki/Computer_hardware (March 27, 2017).

Furthermore, the attached Internet evidence consists of third-party entities that produce applicant’s goods (mobile phones and tablet computers) and registrant’s goods (various mobile phone accessories). See attached webpage screenshots featuring goods from ASUS, Apple, Blackberry, HTC, Alcatel, Samsung, and Sony. This evidence establishes that the same entity commonly produces the relevant goods and markets the goods under the same mark. Therefore, applicant’s and registrant’s goods are considered related for likelihood of confusion purposes. See, e.g., *In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1202-04 (TTAB 2009); *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266, 1268-69, 1271-72 (TTAB 2009).

Conclusion

Applicant’s and registrant’s marks are confusingly similar and their goods are related. Accordingly, the applied-for mark, “**ESSENTIAL**”, is refused for likelihood of confusion under Trademark Act Section 2(d).

ADVISORY: PRIOR-FILED APPLICATION

The filing date of pending U.S. **Application Serial No. 86861193 (ESSENTIAL)** precedes applicant’s filing date. See attached referenced application. If the mark in the referenced application registers, applicant’s mark may be refused registration under Trademark Act Section 2(d) because of a likelihood of confusion between the two marks. See 15 U.S.C. §1052(d); 37 C.F.R. §2.83; TMEP §§1208 *et seq.* Therefore, upon receipt of applicant’s response to this Office action, action on this application may be suspended pending final disposition of the earlier-filed referenced application.

In response to this Office action, applicant may present arguments in support of registration by addressing the issue of the potential conflict between applicant’s mark and the mark in the referenced application. Applicant’s election not to submit arguments at this time in no way limits applicant’s right to address this issue later if a refusal under Section 2(d) issues.

Although applicant’s mark has been refused registration, applicant may respond to the refusals by submitting evidence and arguments in support of registration. However, if applicant responds to the refusal, applicant must also respond to the requirements set forth below.

REQUIREMENT TO AMEND IDENTIFICATION OF GOODS

The wording “**accessories . . . for all the aforementioned goods**” in International Class 9 is indefinite and must be amended to indicate the specific accessories. See 37 C.F.R. §2.32(a)(6); TMEP §1402.01.

For assistance with identifying and classifying goods in trademark applications, please see the USPTO’s online searchable [U.S.](#)

[Acceptable Identification of Goods and Services Manual](#). See TMEP §1402.04.

Applicant may adopt the following identification of goods, if accurate:

International Class 9: Mobile phones; smart phones; computers and tablet computers; **replacement parts for all the aforementioned goods; accessories for all the aforementioned goods, namely, {applicant must further indicate the specific accessories}**; computer operating software for mobile phones, smart phones, computers and tablet computers

Applicant's goods may be clarified or limited, but may not be expanded beyond those originally itemized in the application or as acceptably amended. See 37 C.F.R. §2.71(a); TMEP §1402.06. Applicant may clarify or limit the identification by inserting qualifying language or deleting items to result in a more specific identification; however, applicant may not substitute different goods or add goods not found or encompassed by those in the original application or as acceptably amended. See TMEP §1402.06(a)-(b). The scope of the goods sets the outer limit for any changes to the identification and is generally determined by the ordinary meaning of the wording in the identification. TMEP §§1402.06(b), 1402.07(a)-(b). Any acceptable changes to the goods will further limit scope, and once goods are deleted, they are not permitted to be reinserted. TMEP §1402.07(e).

REQUIREMENT TO AMEND THE MARK DESCRIPTION

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 the wording “ESSENTIAL” to the right of a shaded circle and a shaded square containing a circle.

RESPONSE GUIDELINES

If applicant has questions regarding this Office action, please telephone or e-mail the assigned trademark examining attorney. All relevant e-mail communications will be placed in the official application record; however, an e-mail communication will not be accepted as a response to this Office action and will not extend the deadline for filing a proper response. See 37 C.F.R. §2.191; TMEP §§709.04-.05. Further, although the trademark examining attorney may provide additional explanation pertaining to the refusal and/or requirements in this Office action, the trademark examining attorney may not provide legal advice or statements about applicant's rights. See TMEP §§705.02, 709.06.

TEAS PLUS OR TEAS REDUCED FEE (TEAS RF) APPLICANTS – TO MAINTAIN LOWER FEE, ADDITIONAL REQUIREMENTS MUST BE MET, INCLUDING SUBMITTING DOCUMENTS ONLINE: Applicants who filed their application online using the lower-fee TEAS Plus or TEAS RF application form must (1) file certain documents online using TEAS, including responses to Office actions (see TMEP §§819.02(b), 820.02(b) for a complete list of these documents); (2) maintain a valid e-mail correspondence address; and (3) agree to receive correspondence from the USPTO by e-mail throughout the prosecution of the application. See 37 C.F.R. §§2.22(b), 2.23(b); TMEP §§819, 820. TEAS Plus or TEAS RF applicants who do not meet these requirements must submit an additional processing fee of \$125 per class of goods. 37 C.F.R. §§2.6(a)(1)(v), 2.22(c), 2.23(c); TMEP §§819.04, 820.04. However, in certain situations, TEAS Plus or TEAS RF applicants may respond to an Office action by authorizing an examiner's amendment by telephone or e-mail without incurring this additional fee.

/Marco Wright/
Trademark Examining Attorney
Law Office 120
(571) 272-4918
marco.wright@uspto.gov

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>.

To: Essential Products, Inc. (petrademarks@perkinscoie.com)
Subject: U.S. TRADEMARK APPLICATION NO. 87545739 - ESSENTIAL - 119306-4112
Sent: 5/17/2018 3:44:57 PM
Sent As: ECOM120@USPTO.GOV
Attachments: [Attachment - 1](#)
[Attachment - 2](#)
[Attachment - 3](#)
[Attachment - 4](#)
[Attachment - 5](#)
[Attachment - 6](#)
[Attachment - 7](#)
[Attachment - 8](#)
[Attachment - 9](#)
[Attachment - 10](#)
[Attachment - 11](#)
[Attachment - 12](#)
[Attachment - 13](#)
[Attachment - 14](#)
[Attachment - 15](#)
[Attachment - 16](#)
[Attachment - 17](#)
[Attachment - 18](#)
[Attachment - 19](#)
[Attachment - 20](#)
[Attachment - 21](#)
[Attachment - 22](#)
[Attachment - 23](#)
[Attachment - 24](#)
[Attachment - 25](#)
[Attachment - 26](#)
[Attachment - 27](#)
[Attachment - 28](#)
[Attachment - 29](#)
[Attachment - 30](#)
[Attachment - 31](#)
[Attachment - 32](#)
[Attachment - 33](#)
[Attachment - 34](#)
[Attachment - 35](#)
[Attachment - 36](#)
[Attachment - 37](#)

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

**U.S. APPLICATION
SERIAL NO. 87545739**

MARK: ESSENTIAL

87545739

CORRESPONDENT

ADDRESS:

BRIAN R. COLEMAN
PERKINS COIE LLP
3150 PORTER DRIVE
PALO ALTO, CA 94304

CLICK HERE TO RESPOND TO THIS LETTER:

http://www.uspto.gov/trademarks/teas/response_forms.jsp

[VIEW YOUR APPLICATION FILE](#)

APPLICANT: Essential Products, Inc.

CORRESPONDENT'S REFERENCE/DOCKET NO:

119306-4112

CORRESPONDENT E-MAIL ADDRESS:

pctrademarks@perkinscoie.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. A RESPONSE TRANSMITTED THROUGH THE TRADEMARK ELECTRONIC APPLICATION SYSTEM (TEAS) MUST BE RECEIVED BEFORE MIDNIGHT EASTERN TIME OF THE LAST DAY OF THE RESPONSE PERIOD.

ISSUE/MAILING DATE: 5/17/2018

This Office action is in response to applicant's communication filed on April 25, 2018.

Based on applicant's response, the requirement to amend the mark description has been satisfied; the Section 2(d) refusal based on U.S. Registration Nos. 2593599 (ESSENTIALS) and 3389041 (ESSENTIAL) has been withdrawn; and the previous referenced prior-filed U.S. Application Serial Nos. 87401985 (ESSENTIAL) and 87401980 (ESSENTIAL) no longer present a bar towards registration.

Applicant's identification of services amendment is accepted. However, based on the identification amendment, a Section 2(d) refusal based on other registrations must issue. Accordingly, the Section 2(d) refusal is continued and maintained.

SUMMARY OF ISSUES

- Refusal under Trademark Act Section 2(d) – Likelihood of Confusion
- Advisory: Prior-Filed Application

SECTION 2(d) REFUSAL – LIKELIHOOD OF CONFUSION

Registration of the applied-for mark (ESSENTIAL) is refused because of a likelihood of confusion with the marks in U.S. Registration Nos. 4750424 (ESSENTIAL MIX), 4653719 (MISSIONESSENTIAL), and 4625753 (MISSION ESSENTIAL). Trademark Act Section 2(d), 15 U.S.C. §1052(d); see TMEP §§1207.01 *et seq.* See the attached registrations.

Trademark Act Section 2(d) bars registration of an applied-for mark that so resembles a registered mark that it is likely a consumer would be confused, mistaken, or deceived as to the source of the goods and services of the applicant and registrants. See 15 U.S.C. §1052(d). Determining likelihood of confusion is made on a case-by-case basis by applying the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973). *In re i.am.symbolic, llc*, 866 F.3d 1315, 1322, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017). However, “[n]ot all of the [du Pont] factors are relevant to every case, and only factors of significance to the particular mark need be considered.” *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1366, 101 USPQ2d 1713, 1719 (Fed. Cir. 2012) (quoting *In re Mighty Leaf Tea*, 601 F.3d 1342, 1346, 94 USPQ2d 1257, 1259 (Fed. Cir. 2010)). The USPTO may focus its analysis “on dispositive factors, such as similarity of the marks and relatedness of the goods [and/or services].” *In re i.am.symbolic, llc*, 866 F.3d at 1322, 123 USPQ2d at 1747 (quoting *Herbko Int'l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1164-65, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002)); see TMEP §1207.01.

Comparing the Marks

Marks are compared in their entireties for similarities in appearance, sound, connotation, and commercial impression. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 1321, 110 USPQ2d 1157, 1160 (Fed. Cir. 2014) (quoting *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 1371, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005)); TMEP §1207.01(b)-(b)(v). “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014) (citing *In re 1st USA Realty Prof’ls, Inc.*, 84 USPQ2d 1581, 1586 (TTAB 2007)); *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988)); TMEP §1207.01(b).

In this case, the marks are confusingly similar because the marks contain similar wording and create similar commercial impressions. Applicant’s mark is “**ESSENTIAL**” with design and the registered marks are “**ESSENTIAL MIX**” in standard characters, “**MISSIONESSENTIAL**” in stylized text, and “**MISSION ESSENTIAL**” in standard characters.

When viewing the applied-for mark in its entirety, the literal element of applicant’s mark is being given more weight than the design element because consumers will use this wording when referencing applicant’s services. When evaluating a composite mark containing both words and designs, the word portion is more likely to indicate the origin of the goods and/or services because it is that portion of the mark that consumers use when referring to or requesting the goods and/or services. *Bond v. Taylor*, 119 USPQ2d 1049, 1055 (TTAB 2016) (citing *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908, 1911 (Fed. Cir. 2012)); TMEP §1207.01(c)(ii). Thus, although 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. *In re Viterra Inc.*, 671 F.3d at 1366-67, 101 USPQ2d at 1911 (citing *Giant Food, Inc. v. Nation’s Foodservice, Inc.*, 710 F.2d 1565, 1570-71, 218 USPQ2d 390, 395 (Fed. Cir. 1983)).

Regarding the literal element, applicant mark is created by deleting wording from the registered marks. Although applicant’s mark does not contain the entirety of the registered mark, applicant’s mark is likely to appear to prospective purchasers as a shortened form of registrant’s mark. See *In re Mighty Leaf Tea*, 601 F.3d 1342, 1348, 94 USPQ2d 1257, 1260 (Fed. Cir. 2010) (quoting *United States Shoe Corp.*, 229 USPQ707, 709 (TTAB 1985)). Thus, merely omitting some of the wording from a registered mark may not overcome a likelihood of confusion. See *In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257; *In re Optica Int’l*, 196 USPQ 775, 778 (TTAB 1977); TMEP §1207.01(b)(ii)-(iii). In this case, applicant’s mark does not create a distinct commercial impression from the registered mark because it contains some of the wording in the registered mark and does not add any wording that would distinguish it from that mark.

In light of the closely related goods and services (see attached evidence), the similarities of the marks outweigh any differences. Where the goods and services of an applicant and registrant are “similar in kind and/or closely related,” the degree of similarity between the marks required to support a finding of likelihood of confusion is not as great as in the case of diverse goods and services. *In re J.M. Originals Inc.*, 6 USPQ2d 1393, 1394 (TTAB 1987); see *Shen Mfg. Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 1242, 73 USPQ2d 1350, 1354 (Fed. Cir. 2004); TMEP §1207.01(b).

Comparing the Goods/Services

The compared goods and services 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); TMEP §1207.01(a)(i). They need only be “related in some manner and/or if the circumstances surrounding their marketing are such that they could give rise to the mistaken belief that [the goods and/or services] 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)); TMEP §1207.01(a)(i).

In this case, applicant’s services are “**providing a website featuring blogs in the field of technology, namely, cell phones, smartphones, cameras and smart home devices not for others**, not including websites featuring services for computerized data management, database development services, data warehousing and database integration services, computer software programming for others, creating and maintaining web sites for others and designing and implementing network web pages for others, application service provider featuring software in the fields of financial and business regulatory compliance management and content conversion and development, business training and business training management, customer and sales support, product updates for employees and customers, organizational growth and development assessment and planning, conversion of business and training data, documents and content from physical form into interactive electronic, digital and web-based media” in International Class 41.

The goods in Reg. Nos. 4653719 (MISSIONESSENTIAL) and 4625753 (MISSION ESSENTIAL) include “**computer application software for use on special purpose and general computers, laptops, tablets, smart phones, mobile phones, and other hand-held devices**” and “**computer application software for use on special purpose and general computers, laptops, tablets, smart phones, mobile phones, and other hand-held devices**” in International Class 9.

The goods in Reg. No. 4750424 (ESSENTIAL MIX) include “**mobile phones**” in International Class 9.

The attached Internet evidence consists of third-party entities that produce mobile phones, application software for mobile phones, and also provides blogs in the field of cell phones, smartphones, cameras, and/or smart home devices. See attached webpage screenshots featuring the goods and services from Motorola, Samsung, Apple, HTC, and Sony. This evidence establishes that the same entity commonly produces and provides the relevant goods and services and markets the goods and services under the same mark. Thus, applicant's services and registrant's goods are considered related for likelihood of confusion purposes. See, e.g., *In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1202-04 (TTAB 2009); *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266, 1268-69, 1271-72 (TTAB 2009).

Conclusion

Applicant's and registrants' marks are confusingly similar and their goods/services are related. Accordingly, the applied-for mark, "ESSENTIAL", is refused for likelihood of confusion under Trademark Act Section 2(d).

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

ADVISORY: PRIOR-FILED APPLICATIONS

The filing dates of pending U.S. Application Serial Nos. 86861193 (ESSENTIAL) and 86861819 (SPIGEN ESSENTIAL) precede applicant's filing date. See attached referenced applications. If one or more of the marks in the referenced applications register, applicant's mark may be refused registration under Trademark Act Section 2(d) because of a likelihood of confusion with the registered marks. See 15 U.S.C. §1052(d); 37 C.F.R. §2.83; TMEP §§1208 *et seq.* Therefore, upon receipt of applicant's response to this Office action, action on this application may be suspended pending final disposition of the earlier-filed referenced applications.

In response to this Office action, applicant may present arguments in support of registration by addressing the issue of the potential conflict between applicant's mark and the marks in the referenced applications. Applicant's election not to submit arguments at this time in no way limits applicant's right to address this issue later if a refusal under Section 2(d) issues.

RESPONSE GUIDELINES

If applicant has questions regarding this Office action, please telephone or e-mail the assigned trademark examining attorney. All relevant e-mail communications will be placed in the official application record; however, an e-mail communication will not be accepted as a response to this Office action and will not extend the deadline for filing a proper response. See 37 C.F.R. §2.191; TMEP §§709.04-.05. Further, although the trademark examining attorney may provide additional explanation pertaining to the refusal in this Office action, the trademark examining attorney may not provide legal advice or statements about applicant's rights. See TMEP §§705.02, 709.06.

TEAS PLUS OR TEAS REDUCED FEE (TEAS RF) APPLICANTS – TO MAINTAIN LOWER FEE, ADDITIONAL REQUIREMENTS MUST BE MET, INCLUDING SUBMITTING DOCUMENTS ONLINE: Applicants who filed their application online using the lower-fee TEAS Plus or TEAS RF application form must (1) file certain documents online using TEAS, including responses to Office actions (see TMEP §§819.02(b), 820.02(b) for a complete list of these documents); (2) maintain a valid e-mail correspondence address; and (3) agree to receive correspondence from the USPTO by e-mail throughout the prosecution of the application. See 37 C.F.R. §§2.22(b), 2.23(b); TMEP §§819, 820. TEAS Plus or TEAS RF applicants who do not meet these requirements must submit an additional processing fee of \$125 per class of services. 37 C.F.R. §§2.6(a)(1)(v), 2.22(c), 2.23(c); TMEP §§819.04, 820.04. However, in certain situations, TEAS Plus or TEAS RF applicants may respond to an Office action by authorizing an examiner's amendment by telephone or e-mail without incurring this additional fee.

/Marco Wright/
Trademark Examining Attorney
Law Office 120
(571) 272-4918
marco.wright@uspto.gov

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>.

To: Essential Products, Inc. (petrademarks@perkinscoie.com)

Subject: U.S. TRADEMARK APPLICATION NO. 87545749 - ESSENTIAL - 119306-4113

Sent: 5/17/2018 3:45:31 PM

Sent As: ECOM120@USPTO.GOV

Attachments: [Attachment - 1](#)
[Attachment - 2](#)
[Attachment - 3](#)
[Attachment - 4](#)
[Attachment - 5](#)
[Attachment - 6](#)
[Attachment - 7](#)
[Attachment - 8](#)
[Attachment - 9](#)
[Attachment - 10](#)
[Attachment - 11](#)
[Attachment - 12](#)
[Attachment - 13](#)
[Attachment - 14](#)
[Attachment - 15](#)
[Attachment - 16](#)
[Attachment - 17](#)
[Attachment - 18](#)
[Attachment - 19](#)
[Attachment - 20](#)
[Attachment - 21](#)
[Attachment - 22](#)
[Attachment - 23](#)
[Attachment - 24](#)
[Attachment - 25](#)
[Attachment - 26](#)
[Attachment - 27](#)
[Attachment - 28](#)
[Attachment - 29](#)
[Attachment - 30](#)
[Attachment - 31](#)
[Attachment - 32](#)
[Attachment - 33](#)
[Attachment - 34](#)
[Attachment - 35](#)
[Attachment - 36](#)
[Attachment - 37](#)
[Attachment - 38](#)
[Attachment - 39](#)
[Attachment - 40](#)
[Attachment - 41](#)

U.S. APPLICATION
SERIAL NO. 87545749

MARK: ESSENTIAL

87545749

CORRESPONDENT

ADDRESS:

BRIAN R. COLEMAN
PERKINS COIE LLP
3150 PORTER DRIVE
PALO ALTO, CA 94304

CLICK HERE TO RESPOND TO THIS

LETTER:

http://www.uspto.gov/trademarks/teas/response_forms.jsp

[VIEW YOUR APPLICATION FILE](#)

APPLICANT: Essential
Products, Inc.

CORRESPONDENT'S
REFERENCE/DOCKET
NO:

119306-4113

CORRESPONDENT E-
MAIL ADDRESS:

pctrademarks@perkinscoie.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. A RESPONSE TRANSMITTED THROUGH THE TRADEMARK ELECTRONIC APPLICATION SYSTEM (TEAS) MUST BE RECEIVED BEFORE MIDNIGHT **EASTERN TIME** OF THE LAST DAY OF THE RESPONSE PERIOD.

ISSUE/MAILING DATE: 5/17/2018

This Office action is in response to applicant's communication filed on April 25, 2018.

Based on applicant's response, the requirement to amend the mark description has been satisfied; the refusal under Sections 1 and 45 and the Section 2(d) refusal based on U.S. Registration Nos. 2593599 (ESSENTIALS) and 3389041 (ESSENTIAL) have been withdrawn; and the previous referenced prior-filed U.S. Application Serial Nos. 87401985 (ESSENTIAL) and 87401980 (ESSENTIAL) no longer present a bar towards registration.

Applicant's identification of services amendment is accepted. However, based on the identification amendment, a Section 2(d) refusal based on other registrations must issue. Accordingly, the Section 2(d) refusal is continued and maintained.

SUMMARY OF ISSUES

- Refusal under Trademark Act Section 2(d) – Likelihood of Confusion
- Advisory: Prior-Filed Application

SECTION 2(d) REFUSAL – LIKELIHOOD OF CONFUSION

Registration of the applied-for mark (**ESSENTIAL**) is refused because of a likelihood of confusion with the marks in U.S. Registration Nos. 4750424 (**ESSENTIAL MIX**), 4653719 (**MISSIONESSENTIAL**), and 4625753 (**MISSION ESSENTIAL**). Trademark Act Section 2(d), 15 U.S.C. §1052(d); *see* TMEP §§1207.01 *et seq.* See the attached registrations.

Trademark Act Section 2(d) bars registration of an applied-for mark that so resembles a registered mark that it is likely a consumer would be confused, mistaken, or deceived as to the source of the goods and services of the applicant and registrants. *See* 15 U.S.C. §1052(d). Determining likelihood of confusion is made on a case-by-case basis by applying the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357,

1361, 177 USPQ 563, 567 (C.C.P.A. 1973). *In re i.am.symbolic, llc*, 866 F.3d 1315, 1322, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017). However, “[n]ot all of the [*du Pont*] factors are relevant to every case, and only factors of significance to the particular mark need be considered.” *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1366, 101 USPQ2d 1713, 1719 (Fed. Cir. 2012) (quoting *In re Mighty Leaf Tea*, 601 F.3d 1342, 1346, 94 USPQ2d 1257, 1259 (Fed. Cir. 2010)). The USPTO may focus its analysis “on dispositive factors, such as similarity of the marks and relatedness of the goods [and/or services].” *In re i.am.symbolic, llc*, 866 F.3d at 1322, 123 USPQ2d at 1747 (quoting *Herbko Int’l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1164-65, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002)); see TMEP §1207.01.

Comparing the Marks

Marks are compared in their entireties for similarities in appearance, sound, connotation, and commercial impression. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 1321, 110 USPQ2d 1157, 1160 (Fed. Cir. 2014) (quoting *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 1371, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005)); TMEP §1207.01(b)-(b)(v). “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014) (citing *In re Ist USA Realty Prof’ls, Inc.*, 84 USPQ2d 1581, 1586 (TTAB 2007)); *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988)); TMEP §1207.01(b).

In this case, the marks are confusingly similar because the marks contain similar wording and create similar commercial impressions. Applicant’s mark is “**ESSENTIAL**” with design and the registered marks are “**ESSENTIAL MIX**” in standard characters, “**MISSIONESSENTIAL**” in stylized text, and “**MISSION ESSENTIAL**” in standard characters.

When viewing the applied-for mark in its entirety, the literal element of applicant’s mark is being given more weight than the design element because consumers will use this wording when referencing applicant’s services. When evaluating a composite mark containing both words and designs, the word portion is more likely to indicate the origin of the goods and/or services because it is that portion of the mark that consumers use when referring to or requesting the goods and/or services. *Bond v. Taylor*, 119 USPQ2d 1049, 1055 (TTAB 2016) (citing *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908, 1911 (Fed. Cir. 2012)); TMEP §1207.01(c)(ii). Thus, although 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. *In re Viterra Inc.*, 671 F.3d at 1366-67, 101 USPQ2d at 1911 (citing *Giant Food, Inc. v. Nation’s Foodservice, Inc.*, 710 F.2d 1565, 1570-71, 218 USPQ2d 390, 395 (Fed. Cir. 1983)).

Regarding the literal element, applicant mark is created by deleting wording from the registered marks. Although applicant’s mark does not contain the entirety of the registered mark, applicant’s mark is likely to appear to prospective purchasers as a shortened form of registrant’s mark. See *In re Mighty Leaf Tea*, 601 F.3d 1342, 1348, 94 USPQ2d 1257, 1260 (Fed. Cir. 2010) (quoting *United States Shoe Corp.*, 229 USPQ707, 709 (TTAB 1985)). Thus, merely omitting some of the wording from a registered mark may not overcome a likelihood of confusion. See *In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257; *In re Optica Int’l*, 196 USPQ 775, 778 (TTAB 1977); TMEP §1207.01(b)(ii)-(iii). In this case, applicant’s mark does not create a distinct commercial impression from the registered mark because it contains some of the wording in the registered mark and does not add any wording that would distinguish it from that mark.

In light of the closely related goods and services (see attached evidence), the similarities of the marks outweigh any differences. Where the goods and services of an applicant and registrant are “similar in kind and/or closely related,” the degree of similarity between the marks required to support a finding of likelihood of confusion is not as great as in the case of diverse goods and services. *In re J.M. Originals Inc.*, 6 USPQ2d 1393, 1394 (TTAB 1987); see *Shen Mfg. Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 1242, 73 USPQ2d 1350, 1354 (Fed. Cir. 2004); TMEP §1207.01(b).

Comparing the Goods/Services

The compared goods and services 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); TMEP §1207.01(a)(i). They need only be “related in some manner and/or if the circumstances surrounding their marketing are such that they could give rise to the mistaken belief that [the goods and/or services] 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)); TMEP §1207.01(a)(i).

In this case, applicant’s services are “**technical support services, namely, troubleshooting of computer software problems for cell phones and smart home devices**, not including technical support services for computerized data management, database development services, data warehousing and database integration services, computer software programming for others, creating and maintaining web sites for others and designing and implementing network web pages for others, Application service provider (ASP) featuring software in the fields of financial and business regulatory compliance management and content conversion and development, business training and business training management, customer and sales support, product updates for employees and customers, organizational growth and development assessment and planning, conversion of business and training data, documents and content from physical form into interactive electronic, digital and web-based media” in International Class 42.

The goods in Reg. Nos. 4653719 (MISSIONESSENTIAL) and 4625753 (MISSION ESSENTIAL) include “**computer application software for use on special purpose and general computers, laptops, tablets, smart phones, mobile phones, and other hand-held devices**” and “**computer application software for use on special purpose and general computers, laptops, tablets, smart phones, mobile phones, and other hand-held devices**” in International Class 9.

The goods in Reg. No. 4750424 (ESSENTIAL MIX) include “**mobile phones**” in International Class 9.

The attached Internet evidence consists of third-party entities that produce mobile phones, application software for mobile phones, and also provides technical support services for troubleshooting computer software problems for cell phones and/or smart home devices. See attached webpage screenshots featuring the goods and services from Motorola, Samsung, Apple, HTC, and Sony. This evidence establishes that the same entity commonly produces and provides the relevant goods and services and markets the goods and services under the same mark. Thus, applicant’s services and registrant’s goods are considered related for likelihood of confusion purposes. See, e.g., *In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1202-04 (TTAB 2009); *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266, 1268-69, 1271-72 (TTAB 2009).

Conclusion

Applicant’s and registrants’ marks are confusingly similar and their goods/services are related. Accordingly, the applied-for mark, “**ESSENTIAL**”, is refused for likelihood of confusion under Trademark Act Section 2(d).

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

ADVISORY: PRIOR-FILED APPLICATIONS

The filing dates of pending **U.S. Application Serial Nos. 86861193 (ESSENTIAL)** and 86861819 (**SPIGEN ESSENTIAL**) precede applicant’s filing date. See attached referenced applications. If one or more of the marks in the referenced applications register, applicant’s mark may be refused registration under Trademark Act Section 2(d) because of a likelihood of confusion with the registered marks. See 15 U.S.C. §1052(d); 37 C.F.R. §2.83; TMEP §§1208 *et seq.* Therefore, upon receipt of applicant’s response to this Office action, action on this application may be suspended pending final disposition of the earlier-filed referenced applications.

In response to this Office action, applicant may present arguments in support of registration by addressing the issue of the potential conflict between applicant’s mark and the marks in the referenced applications. Applicant’s election not to submit arguments at this time in no way limits applicant’s right to address this issue later if a refusal under Section 2(d) issues.

RESPONSE GUIDELINES

If applicant has questions regarding this Office action, please telephone or e-mail the assigned trademark examining attorney. All relevant e-mail communications will be placed in the official application record; however, an e-mail communication will not be accepted as a response to this Office action and will not extend the deadline for filing a proper response. See 37 C.F.R. §2.191; TMEP §§709.04-.05. Further, although the trademark examining attorney may provide additional explanation pertaining to the refusal in this Office action, the trademark examining attorney may not provide legal advice or statements about applicant’s rights. See TMEP §§705.02, 709.06.

TEAS PLUS OR TEAS REDUCED FEE (TEAS RF) APPLICANTS – TO MAINTAIN LOWER FEE, ADDITIONAL REQUIREMENTS MUST BE MET, INCLUDING SUBMITTING DOCUMENTS ONLINE: Applicants who filed their application online using the lower-fee TEAS Plus or TEAS RF application form must (1) file certain documents online using TEAS, including responses to Office actions (see TMEP §§819.02(b), 820.02(b) for a complete list of these documents); (2) maintain a valid e-mail correspondence address; and (3) agree to receive correspondence from the USPTO by e-mail throughout the prosecution of the application. See 37 C.F.R. §§2.22(b), 2.23(b); TMEP §§819, 820. TEAS Plus or TEAS RF applicants who do not meet these requirements must submit an additional processing fee of \$125 per class of services. 37 C.F.R. §§2.6(a)(1)(v), 2.22(c), 2.23(c); TMEP §§819.04, 820.04. However, in certain situations, TEAS Plus or TEAS RF applicants may respond to an Office action by authorizing an examiner’s amendment by telephone or e-mail without incurring this additional fee.

/Marco Wright/
Trademark Examining Attorney
Law Office 120
(571) 272-4918
marco.wright@uspto.gov

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>.

To: Essential Products, Inc. (petrademarks@perkinscoie.com)
Subject: U.S. TRADEMARK APPLICATION NO. 87301559 - ESSENTIAL - 119306-4004
Sent: 3/27/2017 9:13:56 PM
Sent As: ECOM120@USPTO.GOV

Attachments: [Attachment - 1](#)
[Attachment - 2](#)
[Attachment - 3](#)
[Attachment - 4](#)
[Attachment - 5](#)
[Attachment - 6](#)
[Attachment - 7](#)
[Attachment - 8](#)
[Attachment - 9](#)
[Attachment - 10](#)
[Attachment - 11](#)
[Attachment - 12](#)
[Attachment - 13](#)
[Attachment - 14](#)
[Attachment - 15](#)
[Attachment - 16](#)
[Attachment - 17](#)
[Attachment - 18](#)
[Attachment - 19](#)
[Attachment - 20](#)
[Attachment - 21](#)
[Attachment - 22](#)
[Attachment - 23](#)
[Attachment - 24](#)
[Attachment - 25](#)
[Attachment - 26](#)
[Attachment - 27](#)
[Attachment - 28](#)
[Attachment - 29](#)
[Attachment - 30](#)
[Attachment - 31](#)
[Attachment - 32](#)
[Attachment - 33](#)
[Attachment - 34](#)
[Attachment - 35](#)
[Attachment - 36](#)
[Attachment - 37](#)
[Attachment - 38](#)
[Attachment - 39](#)
[Attachment - 40](#)
[Attachment - 41](#)
[Attachment - 42](#)
[Attachment - 43](#)
[Attachment - 44](#)

[Attachment - 45](#)
[Attachment - 46](#)
[Attachment - 47](#)
[Attachment - 48](#)

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

U.S. APPLICATION SERIAL NO. 87301559

MARK: ESSENTIAL

87301559

CORRESPONDENT ADDRESS:

MICHAEL GLENN
PERKINS COIE LLP
3150 PORTER DRIVE
PALO ALTO, CA 94304

CLICK HERE TO RESPOND TO THIS LETTER:

http://www.uspto.gov/trademarks/teas/response_forms.jsp

[VIEW YOUR APPLICATION FILE](#)

APPLICANT: Essential Products, Inc.

CORRESPONDENT'S REFERENCE/DOCKET NO :

119306-4004

CORRESPONDENT E-MAIL ADDRESS:

pctrademarks@perkinscoie.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. A RESPONSE TRANSMITTED THROUGH THE TRADEMARK ELECTRONIC APPLICATION SYSTEM (TEAS) MUST BE RECEIVED BEFORE MIDNIGHT **EASTERN TIME** OF THE LAST DAY OF THE RESPONSE PERIOD.

ISSUE/MAILING DATE: 3/27/2017

The referenced application has been reviewed by the assigned trademark examining attorney. Applicant must respond timely and completely to the issues below. 15 U.S.C. §1062(b); 37 C.F.R. §§2.62(a), 2.65(a); TMEP §§711, 718.03.

SUMMARY OF ISSUES

- Refusal under Trademark Act Section 2(d) – Likelihood of Confusion
- Prior-Filed Application
- Requirement to Amend the Identification of Goods and Services
- Multiple-Class Application Requirements

SECTION 2(d) REFUSAL – LIKELIHOOD OF CONFUSION

Registration of the applied-for mark (**ESSENTIAL**) is refused because of a likelihood of confusion with the marks in U.S. Registration Nos. 4728052 (**ESSENTIAL**) and 5014095 (**ESSENTIAL**). Trademark Act Section 2(d), 15 U.S.C. §1052(d); *see* TMEP §§1207.01 *et seq.* See the attached registrations.

Trademark Act Section 2(d) bars registration of an applied-for mark that so resembles a registered mark that it is likely a potential consumer would be confused, mistaken, or deceived as to the source of the goods and/or services of the applicant and registrant. *See* 15 U.S.C. §1052(d). A determination of likelihood of confusion under Section 2(d) is made on a case-by-case basis and the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973) aid in this determination. *Citigroup Inc. v. Capital City Bank Grp.*,

Inc., 637 F.3d 1344, 1349, 98 USPQ2d 1253, 1256 (Fed. Cir. 2011) (citing *On-Line Careline, Inc. v. Am. Online, Inc.*, 229 F.3d 1080, 1085, 56 USPQ2d 1471, 1474 (Fed. Cir. 2000)). Not all the *du Pont* factors, however, are necessarily relevant or of equal weight, and any one of the factors may control in a given case, depending upon the evidence of record. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d at 1355, 98 USPQ2d at 1260; *In re Majestic Distilling Co.*, 315 F.3d 1311, 1315, 65 USPQ2d 1201, 1204 (Fed. Cir. 2003); see *In re E. I. du Pont de Nemours & Co.*, 476 F.2d at 1361-62, 177 USPQ at 567.

In this case, the following factors are the most relevant: similarity of the marks, similarity and nature of the goods and/or services, and similarity of the trade channels of the goods and/or services. See *In re Viterra Inc.*, 671 F.3d 1358, 1361-62, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *In re Dakin's Miniatures Inc.*, 59 USPQ2d 1593, 1595-96 (TTAB 1999); TMEP §§1207.01 *et seq.*

Comparing the Marks

In a likelihood of confusion determination, the marks in their entireties are compared for similarities in appearance, sound, connotation, and commercial impression. *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).

In this case, applicant's mark is " **ESSENTIAL**" and the word " **ESSENTIAL**" is the mark in both registrations. These marks are identical in appearance, sound, and meaning, "and have the potential to be used . . . in exactly the same manner." *In re i.am.symbolic, llc*, 116 USPQ2d 1406, 1411 (TTAB 2015). Additionally, because they are identical, these marks are likely to engender the same connotation and overall commercial impression when considered in connection with applicant's and registrant's respective goods and/or services. *In re i.am.symbolic, llc*, 116 USPQ2d at 1411. Therefore, the marks are confusingly similar.

Comparing the Goods/Services

The goods and/or services 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 and/or services 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 and/or services] 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)); TMEP §1207.01(a)(i).

Where the marks of the respective parties are identical or virtually identical, as in this case, the degree of similarity or relatedness between the goods and/or services needed to support a finding of likelihood of confusion declines. See *In re i.am.symbolic, llc*, 116 USPQ2d 1406, 1411 (TTAB 2015) (citing *In re Shell Oil Co.*, 992 F.2d 1204, 1207, 26 USPQ2d 1687, 1689 (Fed. Cir. 1993)); TMEP §1207.01(a).

Reg. No. 5014095 (ESSENTIAL)

The use of similar marks for retail services and rental services for similar or related goods may result in a likelihood of confusion under Trademark Act Section 2(d). See *BRT Holdings, Inc. v. Homeway, Inc.*, 4 USPQ2d 1952, 1953, 1957 (TTAB 1987) (holding HOMEWAY RENTALS and design for "rental services in the field of home furnishings and appliances" likely to be confused with HOMEWAY for "retail furniture store services"). In *BRT Holdings, Inc.*, the Trademark Trial and Appeal Board stated as follows:

While applicant's rental operation may appeal to a different market segment than opposer's retail sale operation, the rental versus retail sale distinction does not serve to preclude confusion as to *source*. To the contrary, it appears to us that customers who encounter these two types of stores identified by the marks of the parties are almost inevitably likely to conclude, because the similarity in the marks and the close relationship between the services, that these stores are affiliated with one another, that is, that the services which they offer stem from the same ultimate source.

BRT Holdings, Inc., 4 USPQ2d at 1958.

In this case, applicant's goods and services include the following:

- | | |
|-------------------------|--|
| International Class 28: | Handheld unit for playing electronic games; virtual reality headsets and head mounted displays for use in playing video games |
| International Class 35: | Retail store services and retail store services provided via communications networks all featuring handheld mobile digital electronic devices and other consumer electronics, computer software, accessories, and carrying cases for such devices; product demonstrations provided via communications networks; providing consumer product |

information relating to consumer electronic products, namely, mobile phones, smart phones, tablet computers, computer and computer software products, entertainment products, smartwatches, tablet computers, handheld mobile digital electronic devices, wearable electronic devices, and accessories and peripherals for such products; providing an interactive web site featuring consumer product information about consumer electronic products; providing consumer product information via the internet; retail store services of consumer electronic products, namely, mobile phones, smart phones, tablet computers, computer and computer software products, entertainment products, smartwatches, tablet computers, handheld mobile digital electronic devices, wearable electronic devices, and accessories and peripherals for such products; on-line retail store services featuring consumer electronic products, namely, mobile phones, smart phones, tablet computers, computers and computer software products, entertainment products, smartwatches, tablet computers, handheld mobile digital electronic devices, wearable electronic devices and accessories and peripherals for such products; electronic commerce services, namely, providing information about products via telecommunication networks for advertising and sales purposes

Registrant's goods are the following:

International Class 9: Adjustable smartphone and pc tablet stabilizers and mounts; audio cables; audio speakers; batteries; battery chargers; battery chargers for use with telephones; battery packs; carrying cases for cell phones; carrying cases for mobile computers; carrying cases specially adapted for electronic equipment, namely, cell phones, tablet computers, mp3 players, smart phones, digital cameras, portable media players and navigation apparatus for vehicles; cases for mobile phones; cell phone battery chargers; cell phone battery chargers for use in vehicles; cell phone cases; cell phone covers; clear protective covers specially adapted for personal electronic devices, namely, cell phones, tablet computers, mp3 players, smart phones, digital cameras, portable media players and navigation apparatus for vehicles; computer mouse; computer mouse, namely, touchpads; data cables; ear phones; earphones and headphones; external computer hard drives; fitted plastic films known as skins for covering and protecting electronic apparatus, namely, cell phones, tablet computers, mp3 players, smart phones, digital cameras, portable media players and navigation apparatus for vehicles; headphones; keyboards; keyboards for mobile phones; mobile telephone batteries; pc tablet mounts; power adapters; protective cases for smartphones; protective covers and cases for cell phones, laptops and portable media players; protective covers and cases for tablet computers; protective glasses; radio transmitters; smartphone mounts; speaker microphones; stands for handheld digital electronic devices, namely, cell phones, tablet computers, mp3 players, smart phones, digital cameras, portable media players and navigation apparatus for vehicles; straps for mobile phones; tripods for cameras; USB cables; USB cables for cellphones; wireless indoor and outdoor speakers

Applicant's services (retail store services) and registrant's goods (various mobile phone accessories) and are related because registrant's goods are featured in applicant's services. Additionally, applicant's services and registrant's goods commonly emanate from a single source. For example, the attached Internet evidence consists of third-party retailers that provide applicant's services and produce registrant's goods. See webpage screenshots featuring goods and services from Verizon, Asus, Apple, Blackberry, and HTC. The evidence also consists of third-party entities that produce applicant's goods (various mobile phone accessories) and registrant's goods (virtual reality headsets). See webpage screenshots featuring goods from Alcatel, HTC, Samsung, and Sony. This evidence establishes that the same entity commonly produce and provide the relevant goods and services and markets the goods and services under the same mark. Therefore, applicant's and registrant's goods and/or services are considered related for likelihood of confusion purposes. See, e.g., *In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1202-04 (TTAB 2009); *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266, 1268-69, 1271-72 (TTAB 2009).

Reg. No. 4728052 (ESSENTIAL)

With respect to applicant's and registrant's services, the question of likelihood of confusion is determined based on the description of the services 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)).

In this case applicant's services include the following:

International Class 38: Telecommunication access services; communication by computer; transmission of data and of information by electronic means; provision of telecommunications connections to computer databases and the internet; electronic transmission of streamed and downloadable audio and video files via computer and other communications networks; delivery of messages by electronic transmission; provision of telecommunications connections to electronic communications networks, for transmission or reception of audio, video or multimedia content; providing on-line community site; online radio streaming services; wireless broadcasting services, namely, transmitting and streaming digital audio, video, graphics, voice data images, signals, text via the internet, portable and wireless communication devices; providing an online community, namely, providing access to databases and transmission and streaming of digital audio, video, graphics, text and data on internet service enabling transmission

and streaming of digital audio, video, graphics, text and data; providing internet chat rooms; broadcasting services; streaming of data; webcasting services; providing multiple user wireless access to the internet or user access to a global computer network to enable users to access music and video content, data and information provided by means of wired or wireless broadcast, digital broadcast or electronic transmission; providing third party users with wireless access to telecommunication infrastructure to enable users to access music and video content, data and information provided by means of wired or wireless broadcast, digital broadcast or electronic transmission; interactive delivery of music and video over digital networks; computer services, namely, providing on-line facilities for real-time interaction with other computer users concerning topics of general interest (chat rooms); telecommunications services, namely, electronic transmission of virtual reality content and data

International Class 45: On-line social networking services; internet-based social networking services; providing a secure binding process from a user device to a server backend for assured user authentication; providing biometric identification and authentication services in securing online financial transaction

Registrant's goods are the following:

International Class 38: Streaming of audio material, namely, musical recordings, on the Internet; streaming of audiovisual material, namely, musical audiovisual recordings, on the Internet; audio-on-demand and video-on-demand transmission services featuring music and music video; webcasting services featuring music and music video

Applicant's and registrant's services are related because application uses broad wording to describe the services and this wording is presumed to encompass all services of the type described, including those in registrant's more narrow identification. *See In re Jump Designs, LLC*, 80 USPQ2d 1370, 1374 (TTAB 2006) (citing *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981)).

Specifically, applicant's "webcasting services" is broad enough to encompass registrant's "webcasting services featuring music and music video." Additionally, applicant's "online radio streaming services; wireless broadcasting services, namely, transmitting and streaming digital audio, video, graphics, voice data images, signals, text via the internet, portable and wireless communication devices" and "streaming of data" are broad enough to include registrant's "streaming of audio material, namely, musical recordings, on the Internet; streaming of audiovisual material, namely, musical audiovisual recordings, on the Internet."

Furthermore, the attached Internet evidence from Livewire.com, demonstrates that streaming audio material and online social networking services commonly emanate from a single source. *See* Livewire.com, <https://www.lifewire.com/best-social-music-sites-2438411> (March 24, 2017). This evidence establishes that the same entity commonly provides the services and markets the services under the same mark. Therefore, applicant's and registrant's services are considered related for likelihood of confusion purposes. *See, e.g., In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1202-04 (TTAB 2009); *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266, 1268-69, 1271-72 (TTAB 2009).

Conclusion

Applicant's and registrants' marks are confusingly similar and their goods/services are related. Accordingly, the applied-for mark, "ESSENTIAL", is refused for likelihood of confusion under Trademark Act Section 2(d).

ADVISORY: PRIOR-FILED APPLICATION

The filing date of pending **U.S. Application Serial No. 86861193 (ESSENTIAL)** precedes applicant's filing date. See attached referenced application. If the mark in the referenced application registers, applicant's mark may be refused registration under Trademark Act Section 2(d) because of a likelihood of confusion between the two marks. *See* 15 U.S.C. §1052(d); 37 C.F.R. §2.83; TMEP §§1208 *et seq.* Therefore, upon receipt of applicant's response to this Office action, action on this application may be suspended pending final disposition of the earlier-filed referenced application.

In response to this Office action, applicant may present arguments in support of registration by addressing the issue of the potential conflict between applicant's mark and the mark in the referenced application. Applicant's election not to submit arguments at this time in no way limits applicant's right to address this issue later if a refusal under Section 2(d) issues.

Although applicant's mark has been refused registration, applicant may respond to the refusal by submitting evidence and arguments in support of registration. However, if applicant responds to the refusal, applicant must also respond to the requirements set forth below.

REQUIREMENT TO AMEND IDENTIFICATION OF GOODS & SERVICES

Applicant has classified “**virtual reality headsets and head mounted displays for use in playing video games**” in International Class 28; however, the proper classification is International Class 9. Therefore, applicant may respond by reclassifying these goods in the proper international class. Additionally, the wording “**displays**” is indefinite and must be amended to specify the type of display. *See* 37 C.F.R. §2.32(a)(6); TMEP §1402.01.

The wording “**communication by computer**” in International Class 38 is indefinite and must be amended so that it is clear the communication is by computer terminals. *See* 37 C.F.R. §2.32(a)(6); TMEP §1402.01.

The wording “**providing on-line community site**” in International Class 38 must be clarified because it is too broad and could include services in other international classes. *See* 37 C.F.R. §2.32(a)(6); TMEP §§1402.01, 1402.03. In particular, the service of “providing a website” is classified the subject matter featured on the website. Accordingly, this wording could encompass “providing an on-line community site featuring technology that allow users to send messages” in International Class 42 and “online social networking services provided through an on-line community website” in International Class 45.

The wording “**online radio streaming services**” in International Class 38 is indefinite and must be amended to further indicate the type of content or material. *See* 37 C.F.R. §2.32(a)(6); TMEP §1402.01. Applicant may substitute the following wording, if accurate: online radio streaming services, namely, streaming audio material via the Internet.

The wording “**broadcasting services**” in International Class 38 is indefinite and must be amended to further specify the type of broadcasting services. *See* 37 C.F.R. §2.32(a)(6); TMEP §1402.01. Applicant may substitute the following wording, if accurate: Internet, television, and radio broadcasting services.

The wording “**computer services, namely, providing on-line facilities for real-time interaction with other computer users concerning topics of general interest (chat rooms)**” in International Class 38 contains parentheses. Generally, applicants should *not* use parentheses in identifications in their applications so as to avoid confusion with the USPTO’s practice of using parentheses and brackets in registrations to indicate goods and/or services that have been deleted from registrations or in an affidavit of incontestability to indicate goods and/or services not claimed. *See* TMEP §1402.12. The only exception is that parenthetical information is permitted in identifications in an application if it serves to explain or translate the matter immediately preceding the parenthetical phrase in such a way that it does not affect the clarity of the identification, e.g., “sash bands for kimono (obi).” *Id.* Therefore, applicant must remove the parentheses from this identification and incorporate any parenthetical information into the description of the services or delete the wording contained in the parenthetical.

The wording “**providing a secure binding process from a user device to a server backend for assured user authentication**” in International Class 45 is indefinite and must be to clearly identify the nature of the services. *See* 37 C.F.R. §2.32(a)(6); TMEP §1402.01. Applicant may substitute the following wording, if accurate: providing user authentication services in e-commerce transactions via a secure binding process from a user device to a server backend.

The wording “**providing biometric identification and authentication services in securing online financial transaction**” in International Class 45 is indefinite and must be amended so that it is clear applicant is offering identification verification and user authentication services. *See* 37 C.F.R. §2.32(a)(6); TMEP §1402.01. Applicant may substitute the following wording, if accurate: providing biometric identification verification and user authentication services in securing online financial transaction.

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](#). *See* TMEP §1402.04.

Applicant may adopt the following identification of goods and services, if accurate:

- International Class 9: **Virtual reality headsets and head mounted video displays for use in playing video games**
- International Class 28: Handheld unit for playing electronic games
- International Class 38: Telecommunication access services; communication by computer **terminals**; transmission of data and of information by electronic means; provision of telecommunications connections to computer databases and the internet; electronic transmission of streamed and downloadable audio and video files via computer and other communications networks; delivery of messages by electronic transmission; provision of telecommunications connections to electronic communications networks, for transmission or reception of audio, video or multimedia content; online radio streaming services, **namely, streaming audio material via the Internet**; wireless broadcasting services, namely, transmitting and streaming digital audio, video, graphics, voice data images, signals, text via the internet, portable and wireless communication devices; providing an online community, namely, providing access to databases and transmission and streaming of digital audio, video, graphics, text and data on internet service enabling transmission and streaming of digital audio, video, graphics, text and data; providing internet chat rooms; **Internet, television, and radio** broadcasting services; streaming of data; webcasting services; providing multiple user wireless access to the internet or user access to a global computer

network to enable users to access music and video content, data and information provided by means of wired or wireless broadcast, digital broadcast or electronic transmission; providing third party users with wireless access to telecommunication infrastructure to enable users to access music and video content, data and information provided by means of wired or wireless broadcast, digital broadcast or electronic transmission; interactive delivery of music and video over digital networks; computer services, namely, providing on-line facilities for real-time interaction with other computer users concerning topics of general interest; telecommunications services, namely, electronic transmission of virtual reality content and data

International Class 45: On-line social networking services; internet-based social networking services; **providing user authentication services in e-commerce transactions via a secure binding process from a user device to a server backend**; providing biometric identification **verification** and **user authentication** services in securing online financial transaction; **online social networking services provided through an on-line community website**

The services in International Class 35 are acceptable as written.

Applicant's goods and/or services may be clarified or limited, but may not be expanded beyond those originally itemized in the application or as acceptably amended. See 37 C.F.R. §2.71(a); TMEP §1402.06. Applicant may clarify or limit the identification by inserting qualifying language or deleting items to result in a more specific identification; however, applicant may not substitute different goods and/or services or add goods and/or services not found or encompassed by those in the original application or as acceptably amended. See TMEP §1402.06(a)-(b). The scope of the goods and/or services sets the outer limit for any changes to the identification and is generally determined by the ordinary meaning of the wording in the identification. TMEP §§1402.06(b), 1402.07(a)-(b). Any acceptable changes to the goods and/or services will further limit scope, and once goods and/or services are deleted, they are not permitted to be reinserted. TMEP §1402.07(e).

MULTIPLE-CLASS APPLICATION REQUIREMENTS

The application identifies goods and/or services in more than one international class; therefore, applicant must satisfy all the requirements below for each international class based on Trademark Act Section 1(b):

- (1) **List the goods and/or services by their international class number** in consecutive numerical order, starting with the lowest numbered class.
- (2) **Submit a filing fee for each international class** not covered by the fees already paid (view the USPTO's current fee schedule at http://www.uspto.gov/trademarks/tm_fee_info.jsp). The application identifies goods and/or services that are classified in at least 6 classes; however, applicant submitted fees sufficient for only 4 classes. Applicant must either submit the filing fees for the classes not covered by the submitted fees or restrict the application to the number of classes covered by the fees already paid.

See 15 U.S.C. §§1051(b), 1112, 1126(e); 37 C.F.R. §§2.32(a)(6)-(7), 2.34(a)(2)-(3), 2.86(a); TMEP §§1403.01, 1403.02(c).

For an overview of the requirements for a Section 1(b) multiple-class application and how to satisfy the requirements online using the Trademark Electronic Application System (TEAS) form, please go to <http://www.uspto.gov/trademarks/law/multiclass.jsp>.

Fees For Additional Classes

The fee for adding classes to a TEAS Reduced Fee (RF) application is \$275 per class. *See 37 C.F.R. §§2.6(a)(1)(iii), 2.23(a).* See [more information](#) regarding the requirements for maintaining the lower TEAS RF fee and, if these requirements are not satisfied, for adding classes at a higher fee using regular TEAS.

RESPONSE GUIDELINES

If applicant has questions regarding this Office action, please telephone or e-mail the assigned trademark examining attorney. All relevant e-mail communications will be placed in the official application record; however, an e-mail communication will not be accepted as a response to this Office action and will not extend the deadline for filing a proper response. *See 37 C.F.R. §2.191; TMEP §§709.04-.05.* Further, although the trademark examining attorney may provide additional explanation pertaining to the refusal and/or requirements in this Office action, the trademark examining attorney may not provide legal advice or statements about applicant's rights. *See TMEP §§705.02, 709.06.*

TEAS PLUS OR TEAS REDUCED FEE (TEAS RF) APPLICANTS – TO MAINTAIN LOWER FEE, ADDITIONAL REQUIREMENTS MUST BE MET, INCLUDING SUBMITTING DOCUMENTS ONLINE: Applicants who filed their application online using the lower-fee TEAS Plus or TEAS RF application form must (1) file certain documents online using TEAS, including responses to

Office actions (see TMEP §§819.02(b), 820.02(b) for a complete list of these documents); (2) maintain a valid e-mail correspondence address; and (3) agree to receive correspondence from the USPTO by e-mail throughout the prosecution of the application. See 37 C.F.R. §§2.22(b), 2.23(b); TMEP §§819, 820. TEAS Plus or TEAS RF applicants who do not meet these requirements must submit an additional processing fee of \$125 per class of goods and/or services. 37 C.F.R. §§2.6(a)(1)(v), 2.22(c), 2.23(c); TMEP §§819.04, 820.04. However, in certain situations, TEAS Plus or TEAS RF applicants may respond to an Office action by authorizing an examiner's amendment by telephone or e-mail without incurring this additional fee.

/Marco Wright/
Trademark Examining Attorney
Law Office 120
(571) 272-4918
marco.wright@uspto.gov

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>.

To: Essential Products, Inc. (petrademarks@perkinscoie.com)
Subject: U.S. TRADEMARK APPLICATION NO. 87301559 - ESSENTIAL - 119306-4004
Sent: 3/27/2017 9:13:56 PM
Sent As: ECOM120@USPTO.GOV

Attachments: [Attachment - 1](#)
[Attachment - 2](#)
[Attachment - 3](#)
[Attachment - 4](#)
[Attachment - 5](#)
[Attachment - 6](#)
[Attachment - 7](#)
[Attachment - 8](#)
[Attachment - 9](#)
[Attachment - 10](#)
[Attachment - 11](#)
[Attachment - 12](#)
[Attachment - 13](#)
[Attachment - 14](#)
[Attachment - 15](#)
[Attachment - 16](#)
[Attachment - 17](#)
[Attachment - 18](#)
[Attachment - 19](#)
[Attachment - 20](#)
[Attachment - 21](#)
[Attachment - 22](#)
[Attachment - 23](#)
[Attachment - 24](#)
[Attachment - 25](#)
[Attachment - 26](#)
[Attachment - 27](#)
[Attachment - 28](#)
[Attachment - 29](#)
[Attachment - 30](#)
[Attachment - 31](#)
[Attachment - 32](#)
[Attachment - 33](#)
[Attachment - 34](#)
[Attachment - 35](#)
[Attachment - 36](#)
[Attachment - 37](#)
[Attachment - 38](#)
[Attachment - 39](#)
[Attachment - 40](#)
[Attachment - 41](#)
[Attachment - 42](#)
[Attachment - 43](#)
[Attachment - 44](#)

[Attachment - 45](#)
[Attachment - 46](#)
[Attachment - 47](#)
[Attachment - 48](#)

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

U.S. APPLICATION SERIAL NO. 87301559

MARK: ESSENTIAL

87301559

CORRESPONDENT ADDRESS:

MICHAEL GLENN
PERKINS COIE LLP
3150 PORTER DRIVE
PALO ALTO, CA 94304

CLICK HERE TO RESPOND TO THIS LETTER:
http://www.uspto.gov/trademarks/teas/response_forms.jsp

[VIEW YOUR APPLICATION FILE](#)

APPLICANT: Essential Products, Inc.

CORRESPONDENT'S REFERENCE/DOCKET NO :

119306-4004

CORRESPONDENT E-MAIL ADDRESS:

pctrademarks@perkinscoie.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. A RESPONSE TRANSMITTED THROUGH THE TRADEMARK ELECTRONIC APPLICATION SYSTEM (TEAS) MUST BE RECEIVED BEFORE MIDNIGHT **EASTERN TIME** OF THE LAST DAY OF THE RESPONSE PERIOD.

ISSUE/MAILING DATE: 3/27/2017

The referenced application has been reviewed by the assigned trademark examining attorney. Applicant must respond timely and completely to the issues below. 15 U.S.C. §1062(b); 37 C.F.R. §§2.62(a), 2.65(a); TMEP §§711, 718.03.

SUMMARY OF ISSUES

- Refusal under Trademark Act Section 2(d) – Likelihood of Confusion
- Prior-Filed Application
- Requirement to Amend the Identification of Goods and Services
- Multiple-Class Application Requirements

SECTION 2(d) REFUSAL – LIKELIHOOD OF CONFUSION

Registration of the applied-for mark (**ESSENTIAL**) is refused because of a likelihood of confusion with the marks in U.S. Registration Nos. 4728052 (**ESSENTIAL**) and 5014095 (**ESSENTIAL**). Trademark Act Section 2(d), 15 U.S.C. §1052(d); *see* TMEP §§1207.01 *et seq.* See the attached registrations.

Trademark Act Section 2(d) bars registration of an applied-for mark that so resembles a registered mark that it is likely a potential consumer would be confused, mistaken, or deceived as to the source of the goods and/or services of the applicant and registrant. *See* 15 U.S.C. §1052(d). A determination of likelihood of confusion under Section 2(d) is made on a case-by-case basis and the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973) aid in this determination. *Citigroup Inc. v. Capital City Bank Grp.*,

Inc., 637 F.3d 1344, 1349, 98 USPQ2d 1253, 1256 (Fed. Cir. 2011) (citing *On-Line Careline, Inc. v. Am. Online, Inc.*, 229 F.3d 1080, 1085, 56 USPQ2d 1471, 1474 (Fed. Cir. 2000)). Not all the *du Pont* factors, however, are necessarily relevant or of equal weight, and any one of the factors may control in a given case, depending upon the evidence of record. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d at 1355, 98 USPQ2d at 1260; *In re Majestic Distilling Co.*, 315 F.3d 1311, 1315, 65 USPQ2d 1201, 1204 (Fed. Cir. 2003); see *In re E. I. du Pont de Nemours & Co.*, 476 F.2d at 1361-62, 177 USPQ at 567.

In this case, the following factors are the most relevant: similarity of the marks, similarity and nature of the goods and/or services, and similarity of the trade channels of the goods and/or services. See *In re Viterra Inc.*, 671 F.3d 1358, 1361-62, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *In re Dakin's Miniatures Inc.*, 59 USPQ2d 1593, 1595-96 (TTAB 1999); TMEP §§1207.01 *et seq.*

Comparing the Marks

In a likelihood of confusion determination, the marks in their entireties are compared for similarities in appearance, sound, connotation, and commercial impression. *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).

In this case, applicant's mark is " **ESSENTIAL**" and the word " **ESSENTIAL**" is the mark in both registrations. These marks are identical in appearance, sound, and meaning, "and have the potential to be used . . . in exactly the same manner." *In re i.am.symbolic, llc*, 116 USPQ2d 1406, 1411 (TTAB 2015). Additionally, because they are identical, these marks are likely to engender the same connotation and overall commercial impression when considered in connection with applicant's and registrant's respective goods and/or services. *In re i.am.symbolic, llc*, 116 USPQ2d at 1411. Therefore, the marks are confusingly similar.

Comparing the Goods/Services

The goods and/or services 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 and/or services 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 and/or services] 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)); TMEP §1207.01(a)(i).

Where the marks of the respective parties are identical or virtually identical, as in this case, the degree of similarity or relatedness between the goods and/or services needed to support a finding of likelihood of confusion declines. See *In re i.am.symbolic, llc*, 116 USPQ2d 1406, 1411 (TTAB 2015) (citing *In re Shell Oil Co.*, 992 F.2d 1204, 1207, 26 USPQ2d 1687, 1689 (Fed. Cir. 1993)); TMEP §1207.01(a).

Reg. No. 5014095 (ESSENTIAL)

The use of similar marks for retail services and rental services for similar or related goods may result in a likelihood of confusion under Trademark Act Section 2(d). See *BRT Holdings, Inc. v. Homeway, Inc.*, 4 USPQ2d 1952, 1953, 1957 (TTAB 1987) (holding HOMEWAY RENTALS and design for "rental services in the field of home furnishings and appliances" likely to be confused with HOMEWAY for "retail furniture store services"). In *BRT Holdings, Inc.*, the Trademark Trial and Appeal Board stated as follows:

While applicant's rental operation may appeal to a different market segment than opposer's retail sale operation, the rental versus retail sale distinction does not serve to preclude confusion as to *source*. To the contrary, it appears to us that customers who encounter these two types of stores identified by the marks of the parties are almost inevitably likely to conclude, because the similarity in the marks and the close relationship between the services, that these stores are affiliated with one another, that is, that the services which they offer stem from the same ultimate source.

BRT Holdings, Inc., 4 USPQ2d at 1958.

In this case, applicant's goods and services include the following:

- | | |
|-------------------------|--|
| International Class 28: | Handheld unit for playing electronic games; virtual reality headsets and head mounted displays for use in playing video games |
| International Class 35: | Retail store services and retail store services provided via communications networks all featuring handheld mobile digital electronic devices and other consumer electronics, computer software, accessories, and carrying cases for such devices; product demonstrations provided via communications networks; providing consumer product |

information relating to consumer electronic products, namely, mobile phones, smart phones, tablet computers, computer and computer software products, entertainment products, smartwatches, tablet computers, handheld mobile digital electronic devices, wearable electronic devices, and accessories and peripherals for such products; providing an interactive web site featuring consumer product information about consumer electronic products; providing consumer product information via the internet; retail store services of consumer electronic products, namely, mobile phones, smart phones, tablet computers, computer and computer software products, entertainment products, smartwatches, tablet computers, handheld mobile digital electronic devices, wearable electronic devices, and accessories and peripherals for such products; on-line retail store services featuring consumer electronic products, namely, mobile phones, smart phones, tablet computers, computers and computer software products, entertainment products, smartwatches, tablet computers, handheld mobile digital electronic devices, wearable electronic devices and accessories and peripherals for such products; electronic commerce services, namely, providing information about products via telecommunication networks for advertising and sales purposes

Registrant's goods are the following:

International Class 9: Adjustable smartphone and pc tablet stabilizers and mounts; audio cables; audio speakers; batteries; battery chargers; battery chargers for use with telephones; battery packs; carrying cases for cell phones; carrying cases for mobile computers; carrying cases specially adapted for electronic equipment, namely, cell phones, tablet computers, mp3 players, smart phones, digital cameras, portable media players and navigation apparatus for vehicles; cases for mobile phones; cell phone battery chargers; cell phone battery chargers for use in vehicles; cell phone cases; cell phone covers; clear protective covers specially adapted for personal electronic devices, namely, cell phones, tablet computers, mp3 players, smart phones, digital cameras, portable media players and navigation apparatus for vehicles; computer mouse; computer mouse, namely, touchpads; data cables; ear phones; earphones and headphones; external computer hard drives; fitted plastic films known as skins for covering and protecting electronic apparatus, namely, cell phones, tablet computers, mp3 players, smart phones, digital cameras, portable media players and navigation apparatus for vehicles; headphones; keyboards; keyboards for mobile phones; mobile telephone batteries; pc tablet mounts; power adapters; protective cases for smartphones; protective covers and cases for cell phones, laptops and portable media players; protective covers and cases for tablet computers; protective glasses; radio transmitters; smartphone mounts; speaker microphones; stands for handheld digital electronic devices, namely, cell phones, tablet computers, mp3 players, smart phones, digital cameras, portable media players and navigation apparatus for vehicles; straps for mobile phones; tripods for cameras; USB cables; USB cables for cellphones; wireless indoor and outdoor speakers

Applicant's services (retail store services) and registrant's goods (various mobile phone accessories) and are related because registrant's goods are featured in applicant's services. Additionally, applicant's services and registrant's goods commonly emanate from a single source. For example, the attached Internet evidence consists of third-party retailers that provide applicant's services and produce registrant's goods. See webpage screenshots featuring goods and services from Verizon, Asus, Apple, Blackberry, and HTC. The evidence also consists of third-party entities that produce applicant's goods (various mobile phone accessories) and registrant's goods (virtual reality headsets). See webpage screenshots featuring goods from Alcatel, HTC, Samsung, and Sony. This evidence establishes that the same entity commonly produce and provide the relevant goods and services and markets the goods and services under the same mark. Therefore, applicant's and registrant's goods and/or services are considered related for likelihood of confusion purposes. See, e.g., *In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1202-04 (TTAB 2009); *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266, 1268-69, 1271-72 (TTAB 2009).

Reg. No. 4728052 (ESSENTIAL)

With respect to applicant's and registrant's services, the question of likelihood of confusion is determined based on the description of the services 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)).

In this case applicant's services include the following:

International Class 38: Telecommunication access services; communication by computer; transmission of data and of information by electronic means; provision of telecommunications connections to computer databases and the internet; electronic transmission of streamed and downloadable audio and video files via computer and other communications networks; delivery of messages by electronic transmission; provision of telecommunications connections to electronic communications networks, for transmission or reception of audio, video or multimedia content; providing on-line community site; online radio streaming services; wireless broadcasting services, namely, transmitting and streaming digital audio, video, graphics, voice data images, signals, text via the internet, portable and wireless communication devices; providing an online community, namely, providing access to databases and transmission and streaming of digital audio, video, graphics, text and data on internet service enabling transmission

and streaming of digital audio, video, graphics, text and data; providing internet chat rooms; broadcasting services; streaming of data; webcasting services; providing multiple user wireless access to the internet or user access to a global computer network to enable users to access music and video content, data and information provided by means of wired or wireless broadcast, digital broadcast or electronic transmission; providing third party users with wireless access to telecommunication infrastructure to enable users to access music and video content, data and information provided by means of wired or wireless broadcast, digital broadcast or electronic transmission; interactive delivery of music and video over digital networks; computer services, namely, providing on-line facilities for real-time interaction with other computer users concerning topics of general interest (chat rooms); telecommunications services, namely, electronic transmission of virtual reality content and data

International Class 45: On-line social networking services; internet-based social networking services; providing a secure binding process from a user device to a server backend for assured user authentication; providing biometric identification and authentication services in securing online financial transaction

Registrant's goods are the following:

International Class 38: Streaming of audio material, namely, musical recordings, on the Internet; streaming of audiovisual material, namely, musical audiovisual recordings, on the Internet; audio-on-demand and video-on-demand transmission services featuring music and music video; webcasting services featuring music and music video

Applicant's and registrant's services are related because application uses broad wording to describe the services and this wording is presumed to encompass all services of the type described, including those in registrant's more narrow identification. *See In re Jump Designs, LLC*, 80 USPQ2d 1370, 1374 (TTAB 2006) (citing *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981)).

Specifically, applicant's "webcasting services" is broad enough to encompass registrant's "webcasting services featuring music and music video." Additionally, applicant's "online radio streaming services; wireless broadcasting services, namely, transmitting and streaming digital audio, video, graphics, voice data images, signals, text via the internet, portable and wireless communication devices" and "streaming of data" are broad enough to include registrant's "streaming of audio material, namely, musical recordings, on the Internet; streaming of audiovisual material, namely, musical audiovisual recordings, on the Internet."

Furthermore, the attached Internet evidence from Livewire.com, demonstrates that streaming audio material and online social networking services commonly emanate from a single source. *See* Livewire.com, <https://www.lifewire.com/best-social-music-sites-2438411> (March 24, 2017). This evidence establishes that the same entity commonly provides the services and markets the services under the same mark. Therefore, applicant's and registrant's services are considered related for likelihood of confusion purposes. *See, e.g., In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1202-04 (TTAB 2009); *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266, 1268-69, 1271-72 (TTAB 2009).

Conclusion

Applicant's and registrants' marks are confusingly similar and their goods/services are related. Accordingly, the applied-for mark, "ESSENTIAL", is refused for likelihood of confusion under Trademark Act Section 2(d).

ADVISORY: PRIOR-FILED APPLICATION

The filing date of pending **U.S. Application Serial No. 86861193 (ESSENTIAL)** precedes applicant's filing date. See attached referenced application. If the mark in the referenced application registers, applicant's mark may be refused registration under Trademark Act Section 2(d) because of a likelihood of confusion between the two marks. *See* 15 U.S.C. §1052(d); 37 C.F.R. §2.83; TMEP §§1208 *et seq.* Therefore, upon receipt of applicant's response to this Office action, action on this application may be suspended pending final disposition of the earlier-filed referenced application.

In response to this Office action, applicant may present arguments in support of registration by addressing the issue of the potential conflict between applicant's mark and the mark in the referenced application. Applicant's election not to submit arguments at this time in no way limits applicant's right to address this issue later if a refusal under Section 2(d) issues.

Although applicant's mark has been refused registration, applicant may respond to the refusal by submitting evidence and arguments in support of registration. However, if applicant responds to the refusal, applicant must also respond to the requirements set forth below.

REQUIREMENT TO AMEND IDENTIFICATION OF GOODS & SERVICES

Applicant has classified “**virtual reality headsets and head mounted displays for use in playing video games**” in International Class 28; however, the proper classification is International Class 9. Therefore, applicant may respond by reclassifying these goods in the proper international class. Additionally, the wording “**displays**” is indefinite and must be amended to specify the type of display. *See* 37 C.F.R. §2.32(a)(6); TMEP §1402.01.

The wording “**communication by computer**” in International Class 38 is indefinite and must be amended so that it is clear the communication is by computer terminals. *See* 37 C.F.R. §2.32(a)(6); TMEP §1402.01.

The wording “**providing on-line community site**” in International Class 38 must be clarified because it is too broad and could include services in other international classes. *See* 37 C.F.R. §2.32(a)(6); TMEP §§1402.01, 1402.03. In particular, the service of “providing a website” is classified the subject matter featured on the website. Accordingly, this wording could encompass “providing an on-line community site featuring technology that allow users to send messages” in International Class 42 and “online social networking services provided through an on-line community website” in International Class 45.

The wording “**online radio streaming services**” in International Class 38 is indefinite and must be amended to further indicate the type of content or material. *See* 37 C.F.R. §2.32(a)(6); TMEP §1402.01. Applicant may substitute the following wording, if accurate: online radio streaming services, namely, streaming audio material via the Internet.

The wording “**broadcasting services**” in International Class 38 is indefinite and must be amended to further specify the type of broadcasting services. *See* 37 C.F.R. §2.32(a)(6); TMEP §1402.01. Applicant may substitute the following wording, if accurate: Internet, television, and radio broadcasting services.

The wording “**computer services, namely, providing on-line facilities for real-time interaction with other computer users concerning topics of general interest (chat rooms)**” in International Class 38 contains parentheses. Generally, applicants should *not* use parentheses in identifications in their applications so as to avoid confusion with the USPTO’s practice of using parentheses and brackets in registrations to indicate goods and/or services that have been deleted from registrations or in an affidavit of incontestability to indicate goods and/or services not claimed. *See* TMEP §1402.12. The only exception is that parenthetical information is permitted in identifications in an application if it serves to explain or translate the matter immediately preceding the parenthetical phrase in such a way that it does not affect the clarity of the identification, e.g., “sash bands for kimono (obi).” *Id.* Therefore, applicant must remove the parentheses from this identification and incorporate any parenthetical information into the description of the services or delete the wording contained in the parenthetical.

The wording “**providing a secure binding process from a user device to a server backend for assured user authentication**” in International Class 45 is indefinite and must be to clearly identify the nature of the services. *See* 37 C.F.R. §2.32(a)(6); TMEP §1402.01. Applicant may substitute the following wording, if accurate: providing user authentication services in e-commerce transactions via a secure binding process from a user device to a server backend.

The wording “**providing biometric identification and authentication services in securing online financial transaction**” in International Class 45 is indefinite and must be amended so that it is clear applicant is offering identification verification and user authentication services. *See* 37 C.F.R. §2.32(a)(6); TMEP §1402.01. Applicant may substitute the following wording, if accurate: providing biometric identification verification and user authentication services in securing online financial transaction.

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](#). *See* TMEP §1402.04.

Applicant may adopt the following identification of goods and services, if accurate:

- | | |
|--------------------------------|---|
| <u>International Class 9:</u> | Virtual reality headsets and head mounted video displays for use in playing video games |
| <u>International Class 28:</u> | Handheld unit for playing electronic games |
| <u>International Class 38:</u> | Telecommunication access services; communication by computer terminals ; transmission of data and of information by electronic means; provision of telecommunications connections to computer databases and the internet; electronic transmission of streamed and downloadable audio and video files via computer and other communications networks; delivery of messages by electronic transmission; provision of telecommunications connections to electronic communications networks, for transmission or reception of audio, video or multimedia content; online radio streaming services, namely, streaming audio material via the Internet ; wireless broadcasting services, namely, transmitting and streaming digital audio, video, graphics, voice data images, signals, text via the internet, portable and wireless communication devices; providing an online community, namely, providing access to databases and transmission and streaming of digital audio, video, graphics, text and data on internet service enabling transmission and streaming of digital audio, video, graphics, text and data; providing internet chat rooms; Internet, television, and radio broadcasting services; streaming of data; webcasting services; providing multiple user wireless access to the internet or user access to a global computer |

network to enable users to access music and video content, data and information provided by means of wired or wireless broadcast, digital broadcast or electronic transmission; providing third party users with wireless access to telecommunication infrastructure to enable users to access music and video content, data and information provided by means of wired or wireless broadcast, digital broadcast or electronic transmission; interactive delivery of music and video over digital networks; computer services, namely, providing on-line facilities for real-time interaction with other computer users concerning topics of general interest; telecommunications services, namely, electronic transmission of virtual reality content and data

International Class 45: On-line social networking services; internet-based social networking services; **providing user authentication services in e-commerce transactions via a secure binding process from a user device to a server backend**; providing biometric identification **verification** and **user authentication** services in securing online financial transaction; **online social networking services provided through an on-line community website**

The services in International Class 35 are acceptable as written.

Applicant's goods and/or services may be clarified or limited, but may not be expanded beyond those originally itemized in the application or as acceptably amended. See 37 C.F.R. §2.71(a); TMEP §1402.06. Applicant may clarify or limit the identification by inserting qualifying language or deleting items to result in a more specific identification; however, applicant may not substitute different goods and/or services or add goods and/or services not found or encompassed by those in the original application or as acceptably amended. See TMEP §1402.06(a)-(b). The scope of the goods and/or services sets the outer limit for any changes to the identification and is generally determined by the ordinary meaning of the wording in the identification. TMEP §§1402.06(b), 1402.07(a)-(b). Any acceptable changes to the goods and/or services will further limit scope, and once goods and/or services are deleted, they are not permitted to be reinserted. TMEP §1402.07(e).

MULTIPLE-CLASS APPLICATION REQUIREMENTS

The application identifies goods and/or services in more than one international class; therefore, applicant must satisfy all the requirements below for each international class based on Trademark Act Section 1(b):

- (1) **List the goods and/or services by their international class number** in consecutive numerical order, starting with the lowest numbered class.
- (2) **Submit a filing fee for each international class** not covered by the fees already paid (view the USPTO's current fee schedule at http://www.uspto.gov/trademarks/tm_fee_info.jsp). The application identifies goods and/or services that are classified in at least 6 classes; however, applicant submitted fees sufficient for only 4 classes. Applicant must either submit the filing fees for the classes not covered by the submitted fees or restrict the application to the number of classes covered by the fees already paid.

See 15 U.S.C. §§1051(b), 1112, 1126(e); 37 C.F.R. §§2.32(a)(6)-(7), 2.34(a)(2)-(3), 2.86(a); TMEP §§1403.01, 1403.02(c).

For an overview of the requirements for a Section 1(b) multiple-class application and how to satisfy the requirements online using the Trademark Electronic Application System (TEAS) form, please go to <http://www.uspto.gov/trademarks/law/multiclass.jsp>.

Fees For Additional Classes

The fee for adding classes to a TEAS Reduced Fee (RF) application is \$275 per class. *See 37 C.F.R. §§2.6(a)(1)(iii), 2.23(a).* See [more information](#) regarding the requirements for maintaining the lower TEAS RF fee and, if these requirements are not satisfied, for adding classes at a higher fee using regular TEAS.

RESPONSE GUIDELINES

If applicant has questions regarding this Office action, please telephone or e-mail the assigned trademark examining attorney. All relevant e-mail communications will be placed in the official application record; however, an e-mail communication will not be accepted as a response to this Office action and will not extend the deadline for filing a proper response. *See 37 C.F.R. §2.191; TMEP §§709.04-.05.* Further, although the trademark examining attorney may provide additional explanation pertaining to the refusal and/or requirements in this Office action, the trademark examining attorney may not provide legal advice or statements about applicant's rights. *See TMEP §§705.02, 709.06.*

TEAS PLUS OR TEAS REDUCED FEE (TEAS RF) APPLICANTS – TO MAINTAIN LOWER FEE, ADDITIONAL REQUIREMENTS MUST BE MET, INCLUDING SUBMITTING DOCUMENTS ONLINE: Applicants who filed their application online using the lower-fee TEAS Plus or TEAS RF application form must (1) file certain documents online using TEAS, including responses to

Office actions (see TMEP §§819.02(b), 820.02(b) for a complete list of these documents); (2) maintain a valid e-mail correspondence address; and (3) agree to receive correspondence from the USPTO by e-mail throughout the prosecution of the application. See 37 C.F.R. §§2.22(b), 2.23(b); TMEP §§819, 820. TEAS Plus or TEAS RF applicants who do not meet these requirements must submit an additional processing fee of \$125 per class of goods and/or services. 37 C.F.R. §§2.6(a)(1)(v), 2.22(c), 2.23(c); TMEP §§819.04, 820.04. However, in certain situations, TEAS Plus or TEAS RF applicants may respond to an Office action by authorizing an examiner's amendment by telephone or e-mail without incurring this additional fee.

/Marco Wright/
Trademark Examining Attorney
Law Office 120
(571) 272-4918
marco.wright@uspto.gov

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>.

To: Essential Products, Inc. (petrademarks@perkinscoie.com)
Subject: U.S. TRADEMARK APPLICATION NO. 87301561 - ESSENTIAL PRODUCTS - 119306-4005
Sent: 3/27/2017 9:12:56 PM
Sent As: ECOM120@USPTO.GOV

Attachments: [Attachment - 1](#)
[Attachment - 2](#)
[Attachment - 3](#)
[Attachment - 4](#)
[Attachment - 5](#)
[Attachment - 6](#)
[Attachment - 7](#)
[Attachment - 8](#)
[Attachment - 9](#)
[Attachment - 10](#)
[Attachment - 11](#)
[Attachment - 12](#)
[Attachment - 13](#)
[Attachment - 14](#)
[Attachment - 15](#)
[Attachment - 16](#)
[Attachment - 17](#)
[Attachment - 18](#)
[Attachment - 19](#)
[Attachment - 20](#)
[Attachment - 21](#)
[Attachment - 22](#)
[Attachment - 23](#)
[Attachment - 24](#)
[Attachment - 25](#)
[Attachment - 26](#)
[Attachment - 27](#)
[Attachment - 28](#)
[Attachment - 29](#)
[Attachment - 30](#)
[Attachment - 31](#)
[Attachment - 32](#)
[Attachment - 33](#)
[Attachment - 34](#)
[Attachment - 35](#)
[Attachment - 36](#)
[Attachment - 37](#)
[Attachment - 38](#)
[Attachment - 39](#)
[Attachment - 40](#)
[Attachment - 41](#)
[Attachment - 42](#)
[Attachment - 43](#)
[Attachment - 44](#)

[Attachment - 45](#)
[Attachment - 46](#)
[Attachment - 47](#)
[Attachment - 48](#)
[Attachment - 49](#)
[Attachment - 50](#)
[Attachment - 51](#)
[Attachment - 52](#)
[Attachment - 53](#)
[Attachment - 54](#)
[Attachment - 55](#)
[Attachment - 56](#)
[Attachment - 57](#)
[Attachment - 58](#)
[Attachment - 59](#)
[Attachment - 60](#)
[Attachment - 61](#)
[Attachment - 62](#)
[Attachment - 63](#)
[Attachment - 64](#)
[Attachment - 65](#)
[Attachment - 66](#)
[Attachment - 67](#)
[Attachment - 68](#)
[Attachment - 69](#)
[Attachment - 70](#)
[Attachment - 71](#)
[Attachment - 72](#)
[Attachment - 73](#)
[Attachment - 74](#)
[Attachment - 75](#)
[Attachment - 76](#)
[Attachment - 77](#)
[Attachment - 78](#)
[Attachment - 79](#)
[Attachment - 80](#)
[Attachment - 81](#)
[Attachment - 82](#)
[Attachment - 83](#)
[Attachment - 84](#)
[Attachment - 85](#)

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

U.S. APPLICATION SERIAL NO. 87301561

MARK: ESSENTIAL PRODUCTS

87301561

CORRESPONDENT ADDRESS:

MICHAEL GLENN
PERKINS COIE LLP
3150 PORTER DRIVE
PALO ALTO, CA 94304

CLICK HERE TO RESPOND TO THIS LETTER:

http://www.uspto.gov/trademarks/teas/response_forms.jsp

[VIEW YOUR APPLICATION FILE](#)

APPLICANT: Essential Products, Inc.

CORRESPONDENT'S REFERENCE/DOCKET NO :

119306-4005

CORRESPONDENT E-MAIL ADDRESS:

pctrademarks@perkinscoie.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. A RESPONSE TRANSMITTED THROUGH THE TRADEMARK ELECTRONIC APPLICATION SYSTEM (TEAS) MUST BE RECEIVED BEFORE MIDNIGHT **EASTERN TIME** OF THE LAST DAY OF THE RESPONSE PERIOD.

ISSUE/MAILING DATE: **3/27/2017**

The referenced application has been reviewed by the assigned trademark examining attorney. Applicant must respond timely and completely to the issues below. 15 U.S.C. §1062(b); 37 C.F.R. §§2.62(a), 2.65(a); TMEP §§711, 718.03.

SUMMARY OF ISSUES

- Refusal under Trademark Act Section 2(d) – Likelihood of Confusion
- Prior-Filed Applications
- Requirement to Disclaim “PRODUCTS”
- Requirement to Amend the Identification of Goods and Services
- Multiple-Class Application Requirements

SECTION 2(d) REFUSAL – LIKELIHOOD OF CONFUSION

Registration of the applied-for mark (**ESSENTIAL PRODUCTS**) is refused because of a likelihood of confusion with the marks in U.S. Registration Nos. 4728052 (**ESSENTIAL**) and 5014095 (**ESSENTIAL**). Trademark Act Section 2(d), 15 U.S.C. §1052(d); *see* TMEP §§1207.01 *et seq.* See the attached registrations.

Trademark Act Section 2(d) bars registration of an applied-for mark that so resembles a registered mark that it is likely a potential consumer would be confused, mistaken, or deceived as to the source of the goods and/or services of the applicant and registrant. *See* 15 U.S.C. §1052(d). A determination of likelihood of confusion under Section 2(d) is made on a case-by-case basis and the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973) aid in this determination. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d 1344, 1349, 98 USPQ2d 1253, 1256 (Fed. Cir. 2011) (citing *On-Line Careline, Inc. v. Am. Online, Inc.*, 229 F.3d 1080, 1085, 56 USPQ2d 1471, 1474 (Fed. Cir. 2000)). Not all the *du Pont* factors, however, are necessarily relevant or of equal weight, and any one of the factors may control in a given case, depending upon the evidence of record. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d at 1355, 98 USPQ2d at 1260; *In re Majestic Distilling Co.*, 315 F.3d 1311, 1315, 65 USPQ2d 1201, 1204 (Fed. Cir. 2003); *see In re E. I. du Pont de Nemours & Co.*, 476 F.2d at 1361-62, 177 USPQ at 567.

In this case, the following factors are the most relevant: similarity of the marks, similarity and nature of the goods and/or services, and similarity of the trade channels of the goods and/or services. *See In re Viterra Inc.*, 671 F.3d 1358, 1361-62, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *In re Dakin's Miniatures Inc.*, 59 USPQ2d 1593, 1595-96 (TTAB 1999); TMEP §§1207.01 *et seq.*

Comparing the Marks

Marks are compared in their entireties for similarities in appearance, sound, connotation, and commercial impression. *Stone Lion Capital*

Partners, LP v. Lion Capital LLP, 746 F.3d 1317, 1321, 110 USPQ2d 1157, 1160 (Fed. Cir. 2014) (quoting *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 1371, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005)); TMEP §1207.01(b)-(b)(v). “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014) (citing *In re 1st USA Realty Prof’ls, Inc.*, 84 USPQ2d 1581, 1586 (TTAB 2007)); *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988)); TMEP §1207.01(b).

In this case, the marks are confusingly similar because the dominant element of applicant’s mark is identical to the registered marks. Applicant’s mark is “ **ESSENTIAL PRODUCTS**” and registered mark in both applications is the word “ **ESSENTIAL**”.

Although marks are compared in their entireties, one feature of a mark may be more significant or dominant in creating a commercial impression. *See In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *In re Nat’l Data Corp.*, 753 F.2d 1056, 1058, 224 USPQ 749, 751 (Fed. Cir. 1985); TMEP §1207.01(b)(viii), (c)(ii). Matter that is descriptive of or generic for a party’s goods and/or services is typically less significant or less dominant in relation to other wording in a mark. *See Anheuser-Busch, LLC v. Innvopak Sys. Pty Ltd.*, 115 USPQ2d 1816, 1824-25 (TTAB 2015) (citing *In re Chatam Int’l Inc.*, 380 F.3d 1340, 1342-43, 71 USPQ2d 1944, 1946 (Fed. Cir. 2004)).

In this case, the attached evidence shows that the wording “PRODUCTS” in the applied-for mark is merely descriptive of or generic for applicant’s goods and/or services. Thus, this wording is less significant in terms of affecting the mark’s commercial impression, and renders the wording “ESSENTIAL” the more dominant element of the mark; which is identical to the only element in the registered marks. As such, the marks are confusingly similar.

Comparing the Goods/Services

The goods and/or services 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 and/or services 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 and/or services] 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)); TMEP §1207.01(a)(i).

Where the marks of the respective parties are identical or virtually identical, as in this case, the degree of similarity or relatedness between the goods and/or services needed to support a finding of likelihood of confusion declines. *See In re i.am.symbolic, llc*, 116 USPQ2d 1406, 1411 (TTAB 2015) (citing *In re Shell Oil Co.*, 992 F.2d 1204, 1207, 26 USPQ2d 1687, 1689 (Fed. Cir. 1993)); TMEP §1207.01(a).

Reg. No. 5014095 (ESSENTIAL)

The use of similar marks for retail services and rental services for similar or related goods may result in a likelihood of confusion under Trademark Act Section 2(d). *See BRT Holdings, Inc. v. Homeway, Inc.*, 4 USPQ2d 1952, 1953, 1957 (TTAB 1987) (holding HOMEWAY RENTALS and design for “rental services in the field of home furnishings and appliances” likely to be confused with HOMEWAY for “retail furniture store services”). In *BRT Holdings, Inc.*, the Trademark Trial and Appeal Board stated as follows:

While applicant’s rental operation may appeal to a different market segment than opposer’s retail sale operation, the rental versus retail sale distinction does not serve to preclude confusion as to *source*. To the contrary, it appears to us that customers who encounter these two types of stores identified by the marks of the parties are almost inevitably likely to conclude, because the similarity in the marks and the close relationship between the services, that these stores are affiliated with one another, that is, that the services which they offer stem from the same ultimate source.

BRT Holdings, Inc., 4 USPQ2d at 1958.

In this case, applicant’s goods and services include the following:

- | | |
|-------------------------|--|
| International Class 9: | Mobile phones; smart phones; computers and tablet computers; accessories and replacement parts for all the aforementioned goods; computer operating software for mobile phones, smart phones, computers and tablet computers |
| International Class 28: | Handheld unit for playing electronic games; virtual reality headsets and head mounted displays for use in playing video games |
| International Class 35: | Retail store services and retail store services provided via communications networks all featuring handheld mobile |

digital electronic devices and other consumer electronics, computer software, accessories, and carrying cases for such devices; product demonstrations provided via communications networks; providing consumer product information relating to consumer electronic products, namely, mobile phones, smart phones, tablet computers, computer and computer software products, entertainment products, smartwatches, tablet computers, handheld mobile digital electronic devices, wearable electronic devices, and accessories and peripherals for such products; providing an interactive web site featuring consumer product information about consumer electronic products; providing consumer product information via the internet; retail store services of consumer electronic products, namely, mobile phones, smart phones, tablet computers, computer and computer software products, entertainment products, smartwatches, tablet computers, handheld mobile digital electronic devices, wearable electronic devices, and accessories and peripherals for such products; on-line retail store services featuring consumer electronic products, namely, mobile phones, smart phones, tablet computers, computers and computer software products, entertainment products, smartwatches, tablet computers, handheld mobile digital electronic devices, wearable electronic devices and accessories and peripherals for such products; electronic commerce services, namely, providing information about products via telecommunication networks for advertising and sales purposes

Registrant's goods are the following:

International Class 9: Adjustable smartphone and pc tablet stabilizers and mounts; audio cables; audio speakers; batteries; battery chargers; battery chargers for use with telephones; battery packs; carrying cases for cell phones; carrying cases for mobile computers; carrying cases specially adapted for electronic equipment, namely, cell phones, tablet computers, mp3 players, smart phones, digital cameras, portable media players and navigation apparatus for vehicles; cases for mobile phones; cell phone battery chargers; cell phone battery chargers for use in vehicles; cell phone cases; cell phone covers; clear protective covers specially adapted for personal electronic devices, namely, cell phones, tablet computers, mp3 players, smart phones, digital cameras, portable media players and navigation apparatus for vehicles; computer mouse; computer mouse, namely, touchpads; data cables; ear phones; earphones and headphones; external computer hard drives; fitted plastic films known as skins for covering and protecting electronic apparatus, namely, cell phones, tablet computers, mp3 players, smart phones, digital cameras, portable media players and navigation apparatus for vehicles; headphones; keyboards; keyboards for mobile phones; mobile telephone batteries; pc tablet mounts; power adapters; protective cases for smartphones; protective covers and cases for cell phones, laptops and portable media players; protective covers and cases for tablet computers; protective glasses; radio transmitters; smartphone mounts; speaker microphones; stands for handheld digital electronic devices, namely, cell phones, tablet computers, mp3 players, smart phones, digital cameras, portable media players and navigation apparatus for vehicles; straps for mobile phones; tripods for cameras; USB cables; USB cables for cellphones; wireless indoor and outdoor speakers

Applicant's services (retail store services) and registrant's goods (various mobile phone accessories) and are related because registrant's goods are featured in applicant's services. Additionally, applicant's services and registrant's goods commonly emanate from a single source. For example, the attached Internet evidence consists of third-party retailers that provide applicant's services and produce registrant's goods. See webpage screenshots featuring goods and services from Verizon, Asus, Apple, Blackberry, and HTC. The evidence also consists of third-party entities that produce applicant's goods (various mobile phone accessories) and registrant's goods (virtual reality headsets). See webpage screenshots featuring goods from Alcatel, HTC, Samsung, and Sony. Finally, the evidence also consist of entities that produce applicant's goods (mobile phones and tablet computers) and registrant's goods (various mobile phone accessories). See attached webpage screenshots featuring goods from ASUS, Apple, Blackberry, HTC, Alcatel, Samsung, and Sony. All of this evidence establishes that the same entity commonly produce and provide the relevant goods and services and markets the goods and services under the same mark. Therefore, applicant's and registrant's goods and/or services are considered related for likelihood of confusion purposes. See, e.g., *In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1202-04 (TTAB 2009); *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266, 1268-69, 1271-72 (TTAB 2009).

Reg. No. 4728052 (ESSENTIAL)

With respect to applicant's and registrant's services, the question of likelihood of confusion is determined based on the description of the services 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)).

In this case applicant's services include the following:

International Class 38: Telecommunications connections to computer databases and the internet; electronic transmission of streamed and downloadable audio and video files via computer and other communications networks; delivery of messages by electronic transmission; provision of telecommunications connections to electronic communications networks, for transmission or reception of audio, video or multimedia content; providing on-line community site; online radio streaming services; wireless broadcasting services, namely, transmitting and streaming digital audio, video,

graphics, voice data images, signals, text via the internet, portable and wireless communication devices; providing an online community, namely, providing access to databases and transmission and streaming of digital audio, video, graphics, text and data on internet service enabling transmission and streaming of digital audio, video, graphics, text and data; providing internet chat rooms; broadcasting services; streaming of data; webcasting services; providing multiple user wireless access to the internet or user access to a global computer network to enable users to access music and video content, data and information provided by means of wired or wireless broadcast, digital broadcast or electronic transmission; providing third party users with wireless access to telecommunication infrastructure to enable users to access music and video content, data and information provided by means of wired or wireless broadcast, digital broadcast or electronic transmission; interactive delivery of music and video over digital networks; computer services, namely, providing on-line facilities for real-time interaction with other computer users concerning topics of general interest (chat rooms); telecommunications services, namely, electronic transmission of virtual reality content and data

International Class 45: On-line social networking services; internet-based social networking services; providing a secure binding process from a user device to a server backend for assured user authentication; providing biometric identification and authentication services in securing online financial transaction

Registrant's goods are the following:

International Class 38: Streaming of audio material, namely, musical recordings, on the Internet; streaming of audiovisual material, namely, musical audiovisual recordings, on the Internet; audio-on-demand and video-on-demand transmission services featuring music and music video; webcasting services featuring music and music video

Applicant's and registrant's services are related because application uses broad wording to describe the services and this wording is presumed to encompass all services of the type described, including those in registrant's more narrow identification. *See In re Jump Designs, LLC*, 80 USPQ2d 1370, 1374 (TTAB 2006) (citing *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981)).

Specifically, applicant's "webcasting services" is broad enough to encompass registrant's "webcasting services featuring music and music video." Additionally, applicant's "online radio streaming services; wireless broadcasting services, namely, transmitting and streaming digital audio, video, graphics, voice data images, signals, text via the internet, portable and wireless communication devices" and "streaming of data" are broad enough to include registrant's "streaming of audio material, namely, musical recordings, on the Internet; streaming of audiovisual material, namely, musical audiovisual recordings, on the Internet."

Furthermore, the attached Internet evidence from Livewire.com, demonstrates that streaming audio material and online social networking services emanate from a single source. *See* Livewire.com, <https://www.lifewire.com/best-social-music-sites-2438411> (March 24, 2017). This evidence establishes that the same entity commonly provides the services and markets the services under the same mark. Therefore, applicant's and registrant's services are considered related for likelihood of confusion purposes. *See, e.g., In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1202-04 (TTAB 2009); *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266, 1268-69, 1271-72 (TTAB 2009).

Conclusion

Applicant's and registrants' marks are confusingly similar and their goods/services are related. Accordingly, the applied-for mark, "**ESSENTIAL PRODUCTS**", is refused for likelihood of confusion under Trademark Act Section 2(d).

ADVISORY: PRIOR-FILED APPLICATION

The filing date of pending **U.S. Application Serial No. 86861193 (ESSENTIAL)** precedes applicant's filing date. See attached referenced application. If the mark in the referenced application registers, applicant's mark may be refused registration under Trademark Act Section 2(d) because of a likelihood of confusion between the two marks. *See* 15 U.S.C. §1052(d); 37 C.F.R. §2.83; TMEP §§1208 *et seq.* Therefore, upon receipt of applicant's response to this Office action, action on this application may be suspended pending final disposition of the earlier-filed referenced application.

In response to this Office action, applicant may present arguments in support of registration by addressing the issue of the potential conflict between applicant's mark and the mark in the referenced application. Applicant's election not to submit arguments at this time in no way limits applicant's right to address this issue later if a refusal under Section 2(d) issues.

Although applicant's mark has been refused registration, applicant may respond to the refusal by submitting evidence and arguments in support of registration. However, if applicant responds to the refusal, applicant must also respond to the requirement set forth below.

REQUIREMENT TO DISCLAIM “PRODUCTS”

Applicant must disclaim the wording “PRODUCTS” because it merely describes the nature of applicant’s goods and/or services, and thus is an unregistrable component of the mark. *See* 15 U.S.C. §§1052(e)(1), 1056(a); *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 1251, 103 USPQ2d 1753, 1755 (Fed. Cir. 2012) (quoting *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 1173, 71 USPQ2d 1370, 1371 (Fed. Cir. 2004)); TMEP §§1213, 1213.03(a).

This wording is defined as “[a]n article or substance that is manufactured or refined for sale.” [Oxforddictionaries.com, https://en.oxforddictionaries.com/definition/us/product](https://en.oxforddictionaries.com/definition/us/product) (March 27, 2017). Applicant’s goods include mobile phones, computers, and tablet computers. The attached evidence from mobile phone and computer manufactures demonstrates that applicant’s goods are manufactured for sale.

Additionally, attached are copies of printouts from the USPTO X-Search database, which show third-party registrations of marks used in connection with the same or similar goods as those of applicant in this case. These printouts have probative value to the extent that these registrants disclaimed the term “PRODUCTS” because it is descriptive of the registrant’s Class 9 goods.

Third-party registrations featuring goods the same as or similar to applicant’s goods are probative evidence on the issue of descriptiveness where the relevant word or term is disclaimed, registered under Trademark Act Section 2(f) based on acquired distinctiveness, or registered on the Supplemental Register. *See Inst. Nat’l des Appellations D’Origine v. Vintners Int’l Co.*, 958 F.2d 1574, 1581-82, 22 USPQ2d 1190, 1196 (Fed. Cir. 1992); *In re Box Solutions Corp.*, 79 USPQ2d 1953, 1955 (TTAB 2006); *In re Finisar Corp.*, 78 USPQ2d 1618, 1621 (TTAB 2006). Therefore, the wording merely describes the nature of applicant’s goods.

An applicant may not claim exclusive rights to terms that others may need to use to describe their goods and/or services in the marketplace. *See Dena Corp. v. Belvedere Int’l, Inc.*, 950 F.2d 1555, 1560, 21 USPQ2d 1047, 1051 (Fed. Cir. 1991); *In re Aug. Storck KG*, 218 USPQ 823, 825 (TTAB 1983). A disclaimer of unregistrable matter does not affect the appearance of the mark; that is, a disclaimer does not physically remove the disclaimed matter from the mark. *See Schwarzkopf v. John H. Breck, Inc.*, 340 F.2d 978, 978, 144 USPQ 433, 433 (C.C.P.A. 1965); TMEP §1213.

If applicant does not provide the required disclaimer, the USPTO may refuse to register the entire mark. *See In re Stereotaxis Inc.*, 429 F.3d 1039, 1040-41, 77 USPQ2d 1087, 1088-89 (Fed. Cir. 2005); TMEP §1213.01(b).

Applicant should submit a disclaimer in the following standardized format:

No claim is made to the exclusive right to use “PRODUCTS” apart from the mark as shown.

For an overview of disclaimers and instructions on how to satisfy this disclaimer requirement online using the Trademark Electronic Application System (TEAS) form, please go to <http://www.uspto.gov/trademarks/law/disclaimer.jsp>.

REQUIREMENT TO AMEND IDENTIFICATION OF GOODS & SERVICES

The wording “**accessories . . . for all the aforementioned goods**” in International Class 9 is indefinite and must be amended to indicate the specific accessories. *See* 37 C.F.R. §2.32(a)(6); TMEP §1402.01.

Applicant has classified “**virtual reality headsets and head mounted displays for use in playing video games**” in International Class 28; however, the proper classification is International Class 9. Therefore, applicant may respond by reclassifying these goods in the proper international class. Additionally, the wording “**displays**” is indefinite and must be amended to specify the type of display. *See* 37 C.F.R. §2.32(a)(6); TMEP §1402.01.

The wording “**providing on-line community site**” in International Class 38 must be clarified because it is too broad and could include services in other international classes. *See* 37 C.F.R. §2.32(a)(6); TMEP §§1402.01, 1402.03. In particular, the service of “providing a website” is classified the subject matter featured on the website. Accordingly, this wording could encompass “providing an on-line community site featuring technology that allow users to send messages” in International Class 42 and “online social networking services provided through an on-line community website” in International Class 45.

The wording “**online radio streaming services**” in International Class 38 is indefinite and must be amended to further indicate the type of content or material. *See* 37 C.F.R. §2.32(a)(6); TMEP §1402.01. Applicant may substitute the following wording, if accurate: online radio streaming services, namely, streaming audio material via the Internet.

The wording “**broadcasting services**” in International Class 38 is indefinite and must be amended to further specify the type of broadcasting services. *See* 37 C.F.R. §2.32(a)(6); TMEP §1402.01. Applicant may substitute the following wording, if accurate: Internet, television, and

radio broadcasting services.

The wording “**computer services, namely, providing on-line facilities for real-time interaction with other computer users concerning topics of general interest (chat rooms)**” in International Class 38 contains parentheses. Generally, applicants should *not* use parentheses in identifications in their applications so as to avoid confusion with the USPTO’s practice of using parentheses and brackets in registrations to indicate goods and/or services that have been deleted from registrations or in an affidavit of incontestability to indicate goods and/or services not claimed. See TMEP §1402.12. The only exception is that parenthetical information is permitted in identifications in an application if it serves to explain or translate the matter immediately preceding the parenthetical phrase in such a way that it does not affect the clarity of the identification, e.g., “sash bands for kimono (obi).” *Id.* Therefore, applicant must remove the parentheses from this identification and incorporate any parenthetical information into the description of the services or delete the wording contained in the parenthetical.

The wording “**providing a secure binding process from a user device to a server backend for assured user authentication**” in International Class 45 is indefinite and must be to clearly identify the nature of the services. See 37 C.F.R. §2.32(a)(6); TMEP §1402.01. Applicant may substitute the following wording, if accurate: providing user authentication services in e-commerce transactions via a secure binding process from a user device to a server backend.

The wording “**providing biometric identification and authentication services in securing online financial transaction**” in International Class 45 is indefinite and must be amended so that it is clear applicant is offering identification verification and user authentication services. See 37 C.F.R. §2.32(a)(6); TMEP §1402.01. Applicant may substitute the following wording, if accurate: providing biometric identification verification and user authentication services in securing online financial transaction.

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](#). See TMEP §1402.04.

Applicant may adopt the following identification of goods and services, if accurate:

International Class 9: Mobile phones; smart phones; computers and tablet computers; replacement parts for all the aforementioned goods; accessories for all the aforementioned goods, **namely, {applicant must further indicate the specific accessories}**; computer operating software for mobile phones, smart phones, computers and tablet computers; **virtual reality headsets and head mounted video displays for use in playing video games**

International Class 28: Handheld unit for playing electronic games

International Class 38: Telecommunications connections to computer databases and the internet; electronic transmission of streamed and downloadable audio and video files via computer and other communications networks; delivery of messages by electronic transmission; provision of telecommunications connections to electronic communications networks, for transmission or reception of audio, video or multimedia content; online radio streaming services, **namely, streaming audio material via the Internet**; wireless broadcasting services, namely, transmitting and streaming digital audio, video, graphics, voice data images, signals, text via the internet, portable and wireless communication devices; providing an online community, namely, providing access to databases and transmission and streaming of digital audio, video, graphics, text and data on internet service enabling transmission and streaming of digital audio, video, graphics, text and data; providing internet chat rooms; **Internet, television, and radio** broadcasting services; streaming of data; webcasting services; providing multiple user wireless access to the internet or user access to a global computer network to enable users to access music and video content, data and information provided by means of wired or wireless broadcast, digital broadcast or electronic transmission; providing third party users with wireless access to telecommunication infrastructure to enable users to access music and video content, data and information provided by means of wired or wireless broadcast, digital broadcast or electronic transmission; interactive delivery of music and video over digital networks; computer services, namely, providing on-line facilities for real-time interaction with other computer users concerning topics of general interest; telecommunications services, namely, electronic transmission of virtual reality content and data

International Class 45: On-line social networking services; internet-based social networking services; **providing user authentication services in e-commerce transactions via a secure binding process from a user device to a server backend**; providing biometric identification **verification** and **user** authentication services in securing online financial transaction; **online social networking services provided through an on-line community website**

The services in International Class 35 are acceptable as written.

Applicant’s goods and/or services may be clarified or limited, but may not be expanded beyond those originally itemized in the application or as acceptably amended. See 37 C.F.R. §2.71(a); TMEP §1402.06. Applicant may clarify or limit the identification by inserting qualifying

language or deleting items to result in a more specific identification; however, applicant may not substitute different goods and/or services or add goods and/or services not found or encompassed by those in the original application or as acceptably amended. See TMEP §1402.06(a)-(b). The scope of the goods and/or services sets the outer limit for any changes to the identification and is generally determined by the ordinary meaning of the wording in the identification. TMEP §§1402.06(b), 1402.07(a)-(b). Any acceptable changes to the goods and/or services will further limit scope, and once goods and/or services are deleted, they are not permitted to be reinserted. TMEP §1402.07(e).

MULTIPLE-CLASS APPLICATION REQUIREMENTS

The application identifies goods and/or services in more than one international class; therefore, applicant must satisfy all the requirements below for each international class based on Trademark Act Section 1(b):

- (1) **List the goods and/or services by their international class number** in consecutive numerical order, starting with the lowest numbered class.
- (2) **Submit a filing fee for each international class** not covered by the fees already paid (view the USPTO's current fee schedule at http://www.uspto.gov/trademarks/tm_fee_info.jsp). The application identifies goods and/or services that are classified in at least 6 classes; however, applicant submitted fees sufficient for only 5 classes. Applicant must either submit the filing fees for the classes not covered by the submitted fees or restrict the application to the number of classes covered by the fees already paid.

See 15 U.S.C. §§1051(b), 1112, 1126(e); 37 C.F.R. §§2.32(a)(6)-(7), 2.34(a)(2)-(3), 2.86(a); TMEP §§1403.01, 1403.02(c).

For an overview of the requirements for a Section 1(b) multiple-class application and how to satisfy the requirements online using the Trademark Electronic Application System (TEAS) form, please go to <http://www.uspto.gov/trademarks/law/multiclass.jsp>.

Fees For Additional Classes

The fee for adding classes to a TEAS Reduced Fee (RF) application is \$275 per class. See 37 C.F.R. §§2.6(a)(1)(iii), 2.23(a). See [more information](#) regarding the requirements for maintaining the lower TEAS RF fee and, if these requirements are not satisfied, for adding classes at a higher fee using regular TEAS.

RESPONSE GUIDELINES

If applicant has questions regarding this Office action, please telephone or e-mail the assigned trademark examining attorney. All relevant e-mail communications will be placed in the official application record; however, an e-mail communication will not be accepted as a response to this Office action and will not extend the deadline for filing a proper response. See 37 C.F.R. §2.191; TMEP §§709.04-.05. Further, although the trademark examining attorney may provide additional explanation pertaining to the refusal and/or requirements in this Office action, the trademark examining attorney may not provide legal advice or statements about applicant's rights. See TMEP §§705.02, 709.06.

TEAS PLUS OR TEAS REDUCED FEE (TEAS RF) APPLICANTS – TO MAINTAIN LOWER FEE, ADDITIONAL REQUIREMENTS MUST BE MET, INCLUDING SUBMITTING DOCUMENTS ONLINE: Applicants who filed their application online using the lower-fee TEAS Plus or TEAS RF application form must (1) file certain documents online using TEAS, including responses to Office actions (see TMEP §§819.02(b), 820.02(b) for a complete list of these documents); (2) maintain a valid e-mail correspondence address; and (3) agree to receive correspondence from the USPTO by e-mail throughout the prosecution of the application. See 37 C.F.R. §§2.22(b), 2.23(b); TMEP §§819, 820. TEAS Plus or TEAS RF applicants who do not meet these requirements must submit an additional processing fee of \$125 per class of goods and/or services. 37 C.F.R. §§2.6(a)(1)(v), 2.22(c), 2.23(c); TMEP §§819.04, 820.04. However, in certain situations, TEAS Plus or TEAS RF applicants may respond to an Office action by authorizing an examiner's amendment by telephone or e-mail without incurring this additional fee.

/Marco Wright/
Trademark Examining Attorney
Law Office 120
(571) 272-4918
marco.wright@uspto.gov

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>.

To: Essential Products, Inc. (petrademarks@perkinscoie.com)
Subject: U.S. TRADEMARK APPLICATION NO. 87301561 - ESSENTIAL PRODUCTS - 119306-4005
Sent: 3/27/2017 9:12:56 PM
Sent As: ECOM120@USPTO.GOV

Attachments: [Attachment - 1](#)
[Attachment - 2](#)
[Attachment - 3](#)
[Attachment - 4](#)
[Attachment - 5](#)
[Attachment - 6](#)
[Attachment - 7](#)
[Attachment - 8](#)
[Attachment - 9](#)
[Attachment - 10](#)
[Attachment - 11](#)
[Attachment - 12](#)
[Attachment - 13](#)
[Attachment - 14](#)
[Attachment - 15](#)
[Attachment - 16](#)
[Attachment - 17](#)
[Attachment - 18](#)
[Attachment - 19](#)
[Attachment - 20](#)
[Attachment - 21](#)
[Attachment - 22](#)
[Attachment - 23](#)
[Attachment - 24](#)
[Attachment - 25](#)
[Attachment - 26](#)
[Attachment - 27](#)
[Attachment - 28](#)
[Attachment - 29](#)
[Attachment - 30](#)
[Attachment - 31](#)
[Attachment - 32](#)
[Attachment - 33](#)
[Attachment - 34](#)
[Attachment - 35](#)
[Attachment - 36](#)
[Attachment - 37](#)
[Attachment - 38](#)
[Attachment - 39](#)
[Attachment - 40](#)
[Attachment - 41](#)
[Attachment - 42](#)
[Attachment - 43](#)
[Attachment - 44](#)

[Attachment - 45](#)
[Attachment - 46](#)
[Attachment - 47](#)
[Attachment - 48](#)
[Attachment - 49](#)
[Attachment - 50](#)
[Attachment - 51](#)
[Attachment - 52](#)
[Attachment - 53](#)
[Attachment - 54](#)
[Attachment - 55](#)
[Attachment - 56](#)
[Attachment - 57](#)
[Attachment - 58](#)
[Attachment - 59](#)
[Attachment - 60](#)
[Attachment - 61](#)
[Attachment - 62](#)
[Attachment - 63](#)
[Attachment - 64](#)
[Attachment - 65](#)
[Attachment - 66](#)
[Attachment - 67](#)
[Attachment - 68](#)
[Attachment - 69](#)
[Attachment - 70](#)
[Attachment - 71](#)
[Attachment - 72](#)
[Attachment - 73](#)
[Attachment - 74](#)
[Attachment - 75](#)
[Attachment - 76](#)
[Attachment - 77](#)
[Attachment - 78](#)
[Attachment - 79](#)
[Attachment - 80](#)
[Attachment - 81](#)
[Attachment - 82](#)
[Attachment - 83](#)
[Attachment - 84](#)
[Attachment - 85](#)

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

U.S. APPLICATION SERIAL NO. 87301561

MARK: ESSENTIAL PRODUCTS

87301561

CORRESPONDENT ADDRESS:

MICHAEL GLENN
PERKINS COIE LLP
3150 PORTER DRIVE
PALO ALTO, CA 94304

CLICK HERE TO RESPOND TO THIS LETTER:

http://www.uspto.gov/trademarks/teas/response_forms.jsp

[VIEW YOUR APPLICATION FILE](#)

APPLICANT: Essential Products, Inc.

CORRESPONDENT'S REFERENCE/DOCKET NO :

119306-4005

CORRESPONDENT E-MAIL ADDRESS:

pctrademarks@perkinscoie.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. A RESPONSE TRANSMITTED THROUGH THE TRADEMARK ELECTRONIC APPLICATION SYSTEM (TEAS) MUST BE RECEIVED BEFORE MIDNIGHT **EASTERN TIME** OF THE LAST DAY OF THE RESPONSE PERIOD.

ISSUE/MAILING DATE: 3/27/2017

The referenced application has been reviewed by the assigned trademark examining attorney. Applicant must respond timely and completely to the issues below. 15 U.S.C. §1062(b); 37 C.F.R. §§2.62(a), 2.65(a); TMEP §§711, 718.03.

SUMMARY OF ISSUES

- Refusal under Trademark Act Section 2(d) – Likelihood of Confusion
- Prior-Filed Applications
- Requirement to Disclaim “PRODUCTS”
- Requirement to Amend the Identification of Goods and Services
- Multiple-Class Application Requirements

SECTION 2(d) REFUSAL – LIKELIHOOD OF CONFUSION

Registration of the applied-for mark (**ESSENTIAL PRODUCTS**) is refused because of a likelihood of confusion with the marks in U.S. Registration Nos. 4728052 (**ESSENTIAL**) and 5014095 (**ESSENTIAL**). Trademark Act Section 2(d), 15 U.S.C. §1052(d); *see* TMEP §§1207.01 *et seq.* See the attached registrations.

Trademark Act Section 2(d) bars registration of an applied-for mark that so resembles a registered mark that it is likely a potential consumer would be confused, mistaken, or deceived as to the source of the goods and/or services of the applicant and registrant. *See* 15 U.S.C. §1052(d). A determination of likelihood of confusion under Section 2(d) is made on a case-by-case basis and the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973) aid in this determination. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d 1344, 1349, 98 USPQ2d 1253, 1256 (Fed. Cir. 2011) (citing *On-Line Careline, Inc. v. Am. Online, Inc.*, 229 F.3d 1080, 1085, 56 USPQ2d 1471, 1474 (Fed. Cir. 2000)). Not all the *du Pont* factors, however, are necessarily relevant or of equal weight, and any one of the factors may control in a given case, depending upon the evidence of record. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d at 1355, 98 USPQ2d at 1260; *In re Majestic Distilling Co.*, 315 F.3d 1311, 1315, 65 USPQ2d 1201, 1204 (Fed. Cir. 2003); *see In re E. I. du Pont de Nemours & Co.*, 476 F.2d at 1361-62, 177 USPQ at 567.

In this case, the following factors are the most relevant: similarity of the marks, similarity and nature of the goods and/or services, and similarity of the trade channels of the goods and/or services. *See In re Viterra Inc.*, 671 F.3d 1358, 1361-62, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *In re Dakin's Miniatures Inc.*, 59 USPQ2d 1593, 1595-96 (TTAB 1999); TMEP §§1207.01 *et seq.*

Comparing the Marks

Marks are compared in their entireties for similarities in appearance, sound, connotation, and commercial impression. *Stone Lion Capital*

Partners, LP v. Lion Capital LLP, 746 F.3d 1317, 1321, 110 USPQ2d 1157, 1160 (Fed. Cir. 2014) (quoting *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 1371, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005)); TMEP §1207.01(b)-(b)(v). “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014) (citing *In re 1st USA Realty Prof’ls, Inc.*, 84 USPQ2d 1581, 1586 (TTAB 2007)); *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988)); TMEP §1207.01(b).

In this case, the marks are confusingly similar because the dominant element of applicant’s mark is identical to the registered marks. Applicant’s mark is “ **ESSENTIAL PRODUCTS**” and registered mark in both applications is the word “ **ESSENTIAL**”.

Although marks are compared in their entireties, one feature of a mark may be more significant or dominant in creating a commercial impression. *See In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *In re Nat’l Data Corp.*, 753 F.2d 1056, 1058, 224 USPQ 749, 751 (Fed. Cir. 1985); TMEP §1207.01(b)(viii), (c)(ii). Matter that is descriptive of or generic for a party’s goods and/or services is typically less significant or less dominant in relation to other wording in a mark. *See Anheuser-Busch, LLC v. Innvopak Sys. Pty Ltd.*, 115 USPQ2d 1816, 1824-25 (TTAB 2015) (citing *In re Chatam Int’l Inc.*, 380 F.3d 1340, 1342-43, 71 USPQ2d 1944, 1946 (Fed. Cir. 2004)).

In this case, the attached evidence shows that the wording “PRODUCTS” in the applied-for mark is merely descriptive of or generic for applicant’s goods and/or services. Thus, this wording is less significant in terms of affecting the mark’s commercial impression, and renders the wording “ESSENTIAL” the more dominant element of the mark; which is identical to the only element in the registered marks. As such, the marks are confusingly similar.

Comparing the Goods/Services

The goods and/or services 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 and/or services 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 and/or services] 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)); TMEP §1207.01(a)(i).

Where the marks of the respective parties are identical or virtually identical, as in this case, the degree of similarity or relatedness between the goods and/or services needed to support a finding of likelihood of confusion declines. *See In re i.am.symbolic, llc*, 116 USPQ2d 1406, 1411 (TTAB 2015) (citing *In re Shell Oil Co.*, 992 F.2d 1204, 1207, 26 USPQ2d 1687, 1689 (Fed. Cir. 1993)); TMEP §1207.01(a).

Reg. No. 5014095 (ESSENTIAL)

The use of similar marks for retail services and rental services for similar or related goods may result in a likelihood of confusion under Trademark Act Section 2(d). *See BRT Holdings, Inc. v. Homeway, Inc.*, 4 USPQ2d 1952, 1953, 1957 (TTAB 1987) (holding HOMEWAY RENTALS and design for “rental services in the field of home furnishings and appliances” likely to be confused with HOMEWAY for “retail furniture store services”). In *BRT Holdings, Inc.*, the Trademark Trial and Appeal Board stated as follows:

While applicant’s rental operation may appeal to a different market segment than opposer’s retail sale operation, the rental versus retail sale distinction does not serve to preclude confusion as to *source*. To the contrary, it appears to us that customers who encounter these two types of stores identified by the marks of the parties are almost inevitably likely to conclude, because the similarity in the marks and the close relationship between the services, that these stores are affiliated with one another, that is, that the services which they offer stem from the same ultimate source.

BRT Holdings, Inc., 4 USPQ2d at 1958.

In this case, applicant’s goods and services include the following:

- | | |
|-------------------------|--|
| International Class 9: | Mobile phones; smart phones; computers and tablet computers; accessories and replacement parts for all the aforementioned goods; computer operating software for mobile phones, smart phones, computers and tablet computers |
| International Class 28: | Handheld unit for playing electronic games; virtual reality headsets and head mounted displays for use in playing video games |
| International Class 35: | Retail store services and retail store services provided via communications networks all featuring handheld mobile |

digital electronic devices and other consumer electronics, computer software, accessories, and carrying cases for such devices; product demonstrations provided via communications networks; providing consumer product information relating to consumer electronic products, namely, mobile phones, smart phones, tablet computers, computer and computer software products, entertainment products, smartwatches, tablet computers, handheld mobile digital electronic devices, wearable electronic devices, and accessories and peripherals for such products; providing an interactive web site featuring consumer product information about consumer electronic products; providing consumer product information via the internet; retail store services of consumer electronic products, namely, mobile phones, smart phones, tablet computers, computer and computer software products, entertainment products, smartwatches, tablet computers, handheld mobile digital electronic devices, wearable electronic devices, and accessories and peripherals for such products; on-line retail store services featuring consumer electronic products, namely, mobile phones, smart phones, tablet computers, computers and computer software products, entertainment products, smartwatches, tablet computers, handheld mobile digital electronic devices, wearable electronic devices and accessories and peripherals for such products; electronic commerce services, namely, providing information about products via telecommunication networks for advertising and sales purposes

Registrant's goods are the following:

International Class 9: Adjustable smartphone and pc tablet stabilizers and mounts; audio cables; audio speakers; batteries; battery chargers; battery chargers for use with telephones; battery packs; carrying cases for cell phones; carrying cases for mobile computers; carrying cases specially adapted for electronic equipment, namely, cell phones, tablet computers, mp3 players, smart phones, digital cameras, portable media players and navigation apparatus for vehicles; cases for mobile phones; cell phone battery chargers; cell phone battery chargers for use in vehicles; cell phone cases; cell phone covers; clear protective covers specially adapted for personal electronic devices, namely, cell phones, tablet computers, mp3 players, smart phones, digital cameras, portable media players and navigation apparatus for vehicles; computer mouse; computer mouse, namely, touchpads; data cables; ear phones; earphones and headphones; external computer hard drives; fitted plastic films known as skins for covering and protecting electronic apparatus, namely, cell phones, tablet computers, mp3 players, smart phones, digital cameras, portable media players and navigation apparatus for vehicles; headphones; keyboards; keyboards for mobile phones; mobile telephone batteries; pc tablet mounts; power adapters; protective cases for smartphones; protective covers and cases for cell phones, laptops and portable media players; protective covers and cases for tablet computers; protective glasses; radio transmitters; smartphone mounts; speaker microphones; stands for handheld digital electronic devices, namely, cell phones, tablet computers, mp3 players, smart phones, digital cameras, portable media players and navigation apparatus for vehicles; straps for mobile phones; tripods for cameras; USB cables; USB cables for cellphones; wireless indoor and outdoor speakers

Applicant's services (retail store services) and registrant's goods (various mobile phone accessories) and are related because registrant's goods are featured in applicant's services. Additionally, applicant's services and registrant's goods commonly emanate from a single source. For example, the attached Internet evidence consists of third-party retailers that provide applicant's services and produce registrant's goods. See webpage screenshots featuring goods and services from Verizon, Asus, Apple, Blackberry, and HTC. The evidence also consists of third-party entities that produce applicant's goods (various mobile phone accessories) and registrant's goods (virtual reality headsets). See webpage screenshots featuring goods from Alcatel, HTC, Samsung, and Sony. Finally, the evidence also consist of entities that produce applicant's goods (mobile phones and tablet computers) and registrant's goods (various mobile phone accessories). See attached webpage screenshots featuring goods from ASUS, Apple, Blackberry, HTC, Alcatel, Samsung, and Sony. All of this evidence establishes that the same entity commonly produce and provide the relevant goods and services and markets the goods and services under the same mark. Therefore, applicant's and registrant's goods and/or services are considered related for likelihood of confusion purposes. See, e.g., *In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1202-04 (TTAB 2009); *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266, 1268-69, 1271-72 (TTAB 2009).

Reg. No. 4728052 (ESSENTIAL)

With respect to applicant's and registrant's services, the question of likelihood of confusion is determined based on the description of the services 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)).

In this case applicant's services include the following:

International Class 38: Telecommunications connections to computer databases and the internet; electronic transmission of streamed and downloadable audio and video files via computer and other communications networks; delivery of messages by electronic transmission; provision of telecommunications connections to electronic communications networks, for transmission or reception of audio, video or multimedia content; providing on-line community site; online radio streaming services; wireless broadcasting services, namely, transmitting and streaming digital audio, video,

graphics, voice data images, signals, text via the internet, portable and wireless communication devices; providing an online community, namely, providing access to databases and transmission and streaming of digital audio, video, graphics, text and data on internet service enabling transmission and streaming of digital audio, video, graphics, text and data; providing internet chat rooms; broadcasting services; streaming of data; webcasting services; providing multiple user wireless access to the internet or user access to a global computer network to enable users to access music and video content, data and information provided by means of wired or wireless broadcast, digital broadcast or electronic transmission; providing third party users with wireless access to telecommunication infrastructure to enable users to access music and video content, data and information provided by means of wired or wireless broadcast, digital broadcast or electronic transmission; interactive delivery of music and video over digital networks; computer services, namely, providing on-line facilities for real-time interaction with other computer users concerning topics of general interest (chat rooms); telecommunications services, namely, electronic transmission of virtual reality content and data

International Class 45: On-line social networking services; internet-based social networking services; providing a secure binding process from a user device to a server backend for assured user authentication; providing biometric identification and authentication services in securing online financial transaction

Registrant's goods are the following:

International Class 38: Streaming of audio material, namely, musical recordings, on the Internet; streaming of audiovisual material, namely, musical audiovisual recordings, on the Internet; audio-on-demand and video-on-demand transmission services featuring music and music video; webcasting services featuring music and music video

Applicant's and registrant's services are related because application uses broad wording to describe the services and this wording is presumed to encompass all services of the type described, including those in registrant's more narrow identification. *See In re Jump Designs, LLC*, 80 USPQ2d 1370, 1374 (TTAB 2006) (citing *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981)).

Specifically, applicant's "webcasting services" is broad enough to encompass registrant's "webcasting services featuring music and music video." Additionally, applicant's "online radio streaming services; wireless broadcasting services, namely, transmitting and streaming digital audio, video, graphics, voice data images, signals, text via the internet, portable and wireless communication devices" and "streaming of data" are broad enough to include registrant's "streaming of audio material, namely, musical recordings, on the Internet; streaming of audiovisual material, namely, musical audiovisual recordings, on the Internet."

Furthermore, the attached Internet evidence from Livewire.com, demonstrates that streaming audio material and online social networking services emanate from a single source. *See* Livewire.com, <https://www.lifewire.com/best-social-music-sites-2438411> (March 24, 2017). This evidence establishes that the same entity commonly provides the services and markets the services under the same mark. Therefore, applicant's and registrant's services are considered related for likelihood of confusion purposes. *See, e.g., In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1202-04 (TTAB 2009); *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266, 1268-69, 1271-72 (TTAB 2009).

Conclusion

Applicant's and registrants' marks are confusingly similar and their goods/services are related. Accordingly, the applied-for mark, "**ESSENTIAL PRODUCTS**", is refused for likelihood of confusion under Trademark Act Section 2(d).

ADVISORY: PRIOR-FILED APPLICATION

The filing date of pending **U.S. Application Serial No. 86861193 (ESSENTIAL)** precedes applicant's filing date. See attached referenced application. If the mark in the referenced application registers, applicant's mark may be refused registration under Trademark Act Section 2(d) because of a likelihood of confusion between the two marks. *See* 15 U.S.C. §1052(d); 37 C.F.R. §2.83; TMEP §§1208 *et seq.* Therefore, upon receipt of applicant's response to this Office action, action on this application may be suspended pending final disposition of the earlier-filed referenced application.

In response to this Office action, applicant may present arguments in support of registration by addressing the issue of the potential conflict between applicant's mark and the mark in the referenced application. Applicant's election not to submit arguments at this time in no way limits applicant's right to address this issue later if a refusal under Section 2(d) issues.

Although applicant's mark has been refused registration, applicant may respond to the refusal by submitting evidence and arguments in support of registration. However, if applicant responds to the refusal, applicant must also respond to the requirement set forth below.

REQUIREMENT TO DISCLAIM “PRODUCTS”

Applicant must disclaim the wording “PRODUCTS” because it merely describes the nature of applicant’s goods and/or services, and thus is an unregistrable component of the mark. *See* 15 U.S.C. §§1052(e)(1), 1056(a); *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 1251, 103 USPQ2d 1753, 1755 (Fed. Cir. 2012) (quoting *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 1173, 71 USPQ2d 1370, 1371 (Fed. Cir. 2004)); TMEP §§1213, 1213.03(a).

This wording is defined as “[a]n article or substance that is manufactured or refined for sale.” Oxforddictionaries.com, <https://en.oxforddictionaries.com/definition/us/product> (March 27, 2017). Applicant’s goods include mobile phones, computers, and tablet computers. The attached evidence from mobile phone and computer manufactures demonstrates that applicant’s goods are manufactured for sale.

Additionally, attached are copies of printouts from the USPTO X-Search database, which show third-party registrations of marks used in connection with the same or similar goods as those of applicant in this case. These printouts have probative value to the extent that these registrants disclaimed the term “PRODUCTS” because it is descriptive of the registrant’s Class 9 goods.

Third-party registrations featuring goods the same as or similar to applicant’s goods are probative evidence on the issue of descriptiveness where the relevant word or term is disclaimed, registered under Trademark Act Section 2(f) based on acquired distinctiveness, or registered on the Supplemental Register. *See Inst. Nat’l des Appellations D’Origine v. Vintners Int’l Co.*, 958 F.2d 1574, 1581-82, 22 USPQ2d 1190, 1196 (Fed. Cir. 1992); *In re Box Solutions Corp.*, 79 USPQ2d 1953, 1955 (TTAB 2006); *In re Finisar Corp.*, 78 USPQ2d 1618, 1621 (TTAB 2006). Therefore, the wording merely describes the nature of applicant’s goods.

An applicant may not claim exclusive rights to terms that others may need to use to describe their goods and/or services in the marketplace. *See Dena Corp. v. Belvedere Int’l, Inc.*, 950 F.2d 1555, 1560, 21 USPQ2d 1047, 1051 (Fed. Cir. 1991); *In re Aug. Storck KG*, 218 USPQ 823, 825 (TTAB 1983). A disclaimer of unregistrable matter does not affect the appearance of the mark; that is, a disclaimer does not physically remove the disclaimed matter from the mark. *See Schwarzkopf v. John H. Breck, Inc.*, 340 F.2d 978, 978, 144 USPQ 433, 433 (C.C.P.A. 1965); TMEP §1213.

If applicant does not provide the required disclaimer, the USPTO may refuse to register the entire mark. *See In re Stereotaxis Inc.*, 429 F.3d 1039, 1040-41, 77 USPQ2d 1087, 1088-89 (Fed. Cir. 2005); TMEP §1213.01(b).

Applicant should submit a disclaimer in the following standardized format:

No claim is made to the exclusive right to use “PRODUCTS” apart from the mark as shown.

For an overview of disclaimers and instructions on how to satisfy this disclaimer requirement online using the Trademark Electronic Application System (TEAS) form, please go to <http://www.uspto.gov/trademarks/law/disclaimer.jsp>.

REQUIREMENT TO AMEND IDENTIFICATION OF GOODS & SERVICES

The wording “**accessories . . . for all the aforementioned goods**” in International Class 9 is indefinite and must be amended to indicate the specific accessories. *See* 37 C.F.R. §2.32(a)(6); TMEP §1402.01.

Applicant has classified “**virtual reality headsets and head mounted displays for use in playing video games**” in International Class 28; however, the proper classification is International Class 9. Therefore, applicant may respond by reclassifying these goods in the proper international class. Additionally, the wording “**displays**” is indefinite and must be amended to specify the type of display. *See* 37 C.F.R. §2.32(a)(6); TMEP §1402.01.

The wording “**providing on-line community site**” in International Class 38 must be clarified because it is too broad and could include services in other international classes. *See* 37 C.F.R. §2.32(a)(6); TMEP §§1402.01, 1402.03. In particular, the service of “providing a website” is classified the subject matter featured on the website. Accordingly, this wording could encompass “providing an on-line community site featuring technology that allow users to send messages” in International Class 42 and “online social networking services provided through an on-line community website” in International Class 45.

The wording “**online radio streaming services**” in International Class 38 is indefinite and must be amended to further indicate the type of content or material. *See* 37 C.F.R. §2.32(a)(6); TMEP §1402.01. Applicant may substitute the following wording, if accurate: online radio streaming services, namely, streaming audio material via the Internet.

The wording “**broadcasting services**” in International Class 38 is indefinite and must be amended to further specify the type of broadcasting services. *See* 37 C.F.R. §2.32(a)(6); TMEP §1402.01. Applicant may substitute the following wording, if accurate: Internet, television, and

radio broadcasting services.

The wording “**computer services, namely, providing on-line facilities for real-time interaction with other computer users concerning topics of general interest (chat rooms)**” in International Class 38 contains parentheses. Generally, applicants should *not* use parentheses in identifications in their applications so as to avoid confusion with the USPTO’s practice of using parentheses and brackets in registrations to indicate goods and/or services that have been deleted from registrations or in an affidavit of incontestability to indicate goods and/or services not claimed. *See* TMEP §1402.12. The only exception is that parenthetical information is permitted in identifications in an application if it serves to explain or translate the matter immediately preceding the parenthetical phrase in such a way that it does not affect the clarity of the identification, e.g., “sash bands for kimono (obi).” *Id.* Therefore, applicant must remove the parentheses from this identification and incorporate any parenthetical information into the description of the services or delete the wording contained in the parenthetical.

The wording “**providing a secure binding process from a user device to a server backend for assured user authentication**” in International Class 45 is indefinite and must be to clearly identify the nature of the services. *See* 37 C.F.R. §2.32(a)(6); TMEP §1402.01. Applicant may substitute the following wording, if accurate: providing user authentication services in e-commerce transactions via a secure binding process from a user device to a server backend.

The wording “**providing biometric identification and authentication services in securing online financial transaction**” in International Class 45 is indefinite and must be amended so that it is clear applicant is offering identification verification and user authentication services. *See* 37 C.F.R. §2.32(a)(6); TMEP §1402.01. Applicant may substitute the following wording, if accurate: providing biometric identification verification and user authentication services in securing online financial transaction.

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](#). *See* TMEP §1402.04.

Applicant may adopt the following identification of goods and services, if accurate:

International Class 9: Mobile phones; smart phones; computers and tablet computers; replacement parts for all the aforementioned goods; accessories for all the aforementioned goods, **namely, {applicant must further indicate the specific accessories}**; computer operating software for mobile phones, smart phones, computers and tablet computers; **virtual reality headsets and head mounted video displays for use in playing video games**

International Class 28: Handheld unit for playing electronic games

International Class 38: Telecommunications connections to computer databases and the internet; electronic transmission of streamed and downloadable audio and video files via computer and other communications networks; delivery of messages by electronic transmission; provision of telecommunications connections to electronic communications networks, for transmission or reception of audio, video or multimedia content; online radio streaming services, **namely, streaming audio material via the Internet**; wireless broadcasting services, namely, transmitting and streaming digital audio, video, graphics, voice data images, signals, text via the internet, portable and wireless communication devices; providing an online community, namely, providing access to databases and transmission and streaming of digital audio, video, graphics, text and data on internet service enabling transmission and streaming of digital audio, video, graphics, text and data; providing internet chat rooms; **Internet, television, and radio** broadcasting services; streaming of data; webcasting services; providing multiple user wireless access to the internet or user access to a global computer network to enable users to access music and video content, data and information provided by means of wired or wireless broadcast, digital broadcast or electronic transmission; providing third party users with wireless access to telecommunication infrastructure to enable users to access music and video content, data and information provided by means of wired or wireless broadcast, digital broadcast or electronic transmission; interactive delivery of music and video over digital networks; computer services, namely, providing on-line facilities for real-time interaction with other computer users concerning topics of general interest; telecommunications services, namely, electronic transmission of virtual reality content and data

International Class 45: On-line social networking services; internet-based social networking services; **providing user authentication services in e-commerce transactions via a secure binding process from a user device to a server backend**; providing biometric identification **verification** and **user** authentication services in securing online financial transaction; **online social networking services provided through an on-line community website**

The services in International Class 35 are acceptable as written.

*Applicant’s goods and/or services may be clarified or limited, but may not be expanded beyond those originally itemized in the application or as acceptably amended. *See* 37 C.F.R. §2.71(a); TMEP §1402.06. Applicant may clarify or limit the identification by inserting qualifying*

language or deleting items to result in a more specific identification; however, applicant may not substitute different goods and/or services or add goods and/or services not found or encompassed by those in the original application or as acceptably amended. See TMEP §1402.06(a)-(b). The scope of the goods and/or services sets the outer limit for any changes to the identification and is generally determined by the ordinary meaning of the wording in the identification. TMEP §§1402.06(b), 1402.07(a)-(b). Any acceptable changes to the goods and/or services will further limit scope, and once goods and/or services are deleted, they are not permitted to be reinserted. TMEP §1402.07(e).

MULTIPLE-CLASS APPLICATION REQUIREMENTS

The application identifies goods and/or services in more than one international class; therefore, applicant must satisfy all the requirements below for each international class based on Trademark Act Section 1(b):

- (1) **List the goods and/or services by their international class number** in consecutive numerical order, starting with the lowest numbered class.
- (2) **Submit a filing fee for each international class** not covered by the fees already paid (view the USPTO's current fee schedule at http://www.uspto.gov/trademarks/tm_fee_info.jsp). The application identifies goods and/or services that are classified in at least 6 classes; however, applicant submitted fees sufficient for only 5 classes. Applicant must either submit the filing fees for the classes not covered by the submitted fees or restrict the application to the number of classes covered by the fees already paid.

See 15 U.S.C. §§1051(b), 1112, 1126(e); 37 C.F.R. §§2.32(a)(6)-(7), 2.34(a)(2)-(3), 2.86(a); TMEP §§1403.01, 1403.02(c).

For an overview of the requirements for a Section 1(b) multiple-class application and how to satisfy the requirements online using the Trademark Electronic Application System (TEAS) form, please go to <http://www.uspto.gov/trademarks/law/multiclass.jsp>.

Fees For Additional Classes

The fee for adding classes to a TEAS Reduced Fee (RF) application is \$275 per class. See 37 C.F.R. §§2.6(a)(1)(iii), 2.23(a). See [more information](#) regarding the requirements for maintaining the lower TEAS RF fee and, if these requirements are not satisfied, for adding classes at a higher fee using regular TEAS.

RESPONSE GUIDELINES

If applicant has questions regarding this Office action, please telephone or e-mail the assigned trademark examining attorney. All relevant e-mail communications will be placed in the official application record; however, an e-mail communication will not be accepted as a response to this Office action and will not extend the deadline for filing a proper response. See 37 C.F.R. §2.191; TMEP §§709.04-.05. Further, although the trademark examining attorney may provide additional explanation pertaining to the refusal and/or requirements in this Office action, the trademark examining attorney may not provide legal advice or statements about applicant's rights. See TMEP §§705.02, 709.06.

TEAS PLUS OR TEAS REDUCED FEE (TEAS RF) APPLICANTS – TO MAINTAIN LOWER FEE, ADDITIONAL REQUIREMENTS MUST BE MET, INCLUDING SUBMITTING DOCUMENTS ONLINE: Applicants who filed their application online using the lower-fee TEAS Plus or TEAS RF application form must (1) file certain documents online using TEAS, including responses to Office actions (see TMEP §§819.02(b), 820.02(b) for a complete list of these documents); (2) maintain a valid e-mail correspondence address; and (3) agree to receive correspondence from the USPTO by e-mail throughout the prosecution of the application. See 37 C.F.R. §§2.22(b), 2.23(b); TMEP §§819, 820. TEAS Plus or TEAS RF applicants who do not meet these requirements must submit an additional processing fee of \$125 per class of goods and/or services. 37 C.F.R. §§2.6(a)(1)(v), 2.22(c), 2.23(c); TMEP §§819.04, 820.04. However, in certain situations, TEAS Plus or TEAS RF applicants may respond to an Office action by authorizing an examiner's amendment by telephone or e-mail without incurring this additional fee.

/Marco Wright/
Trademark Examining Attorney
Law Office 120
(571) 272-4918
marco.wright@uspto.gov

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>.

To: Essential Products, Inc. (petrademarks@perkinscoie.com)
Subject: U.S. TRADEMARK APPLICATION NO. 87301561 - ESSENTIAL PRODUCTS - 119306-4005
Sent: 3/27/2017 9:12:56 PM
Sent As: ECOM120@USPTO.GOV

Attachments: [Attachment - 1](#)
[Attachment - 2](#)
[Attachment - 3](#)
[Attachment - 4](#)
[Attachment - 5](#)
[Attachment - 6](#)
[Attachment - 7](#)
[Attachment - 8](#)
[Attachment - 9](#)
[Attachment - 10](#)
[Attachment - 11](#)
[Attachment - 12](#)
[Attachment - 13](#)
[Attachment - 14](#)
[Attachment - 15](#)
[Attachment - 16](#)
[Attachment - 17](#)
[Attachment - 18](#)
[Attachment - 19](#)
[Attachment - 20](#)
[Attachment - 21](#)
[Attachment - 22](#)
[Attachment - 23](#)
[Attachment - 24](#)
[Attachment - 25](#)
[Attachment - 26](#)
[Attachment - 27](#)
[Attachment - 28](#)
[Attachment - 29](#)
[Attachment - 30](#)
[Attachment - 31](#)
[Attachment - 32](#)
[Attachment - 33](#)
[Attachment - 34](#)
[Attachment - 35](#)
[Attachment - 36](#)
[Attachment - 37](#)
[Attachment - 38](#)
[Attachment - 39](#)
[Attachment - 40](#)
[Attachment - 41](#)
[Attachment - 42](#)
[Attachment - 43](#)
[Attachment - 44](#)

[Attachment - 45](#)
[Attachment - 46](#)
[Attachment - 47](#)
[Attachment - 48](#)
[Attachment - 49](#)
[Attachment - 50](#)
[Attachment - 51](#)
[Attachment - 52](#)
[Attachment - 53](#)
[Attachment - 54](#)
[Attachment - 55](#)
[Attachment - 56](#)
[Attachment - 57](#)
[Attachment - 58](#)
[Attachment - 59](#)
[Attachment - 60](#)
[Attachment - 61](#)
[Attachment - 62](#)
[Attachment - 63](#)
[Attachment - 64](#)
[Attachment - 65](#)
[Attachment - 66](#)
[Attachment - 67](#)
[Attachment - 68](#)
[Attachment - 69](#)
[Attachment - 70](#)
[Attachment - 71](#)
[Attachment - 72](#)
[Attachment - 73](#)
[Attachment - 74](#)
[Attachment - 75](#)
[Attachment - 76](#)
[Attachment - 77](#)
[Attachment - 78](#)
[Attachment - 79](#)
[Attachment - 80](#)
[Attachment - 81](#)
[Attachment - 82](#)
[Attachment - 83](#)
[Attachment - 84](#)
[Attachment - 85](#)

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

U.S. APPLICATION SERIAL NO. 87301561

MARK: ESSENTIAL PRODUCTS

87301561

CORRESPONDENT ADDRESS:

MICHAEL GLENN
PERKINS COIE LLP
3150 PORTER DRIVE
PALO ALTO, CA 94304

CLICK HERE TO RESPOND TO THIS LETTER:

http://www.uspto.gov/trademarks/teas/response_forms.jsp

[VIEW YOUR APPLICATION FILE](#)

APPLICANT: Essential Products, Inc.

CORRESPONDENT'S REFERENCE/DOCKET NO :

119306-4005

CORRESPONDENT E-MAIL ADDRESS:

pctrademarks@perkinscoie.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. A RESPONSE TRANSMITTED THROUGH THE TRADEMARK ELECTRONIC APPLICATION SYSTEM (TEAS) MUST BE RECEIVED BEFORE MIDNIGHT **EASTERN TIME** OF THE LAST DAY OF THE RESPONSE PERIOD.

ISSUE/MAILING DATE: **3/27/2017**

The referenced application has been reviewed by the assigned trademark examining attorney. Applicant must respond timely and completely to the issues below. 15 U.S.C. §1062(b); 37 C.F.R. §§2.62(a), 2.65(a); TMEP §§711, 718.03.

SUMMARY OF ISSUES

- Refusal under Trademark Act Section 2(d) – Likelihood of Confusion
- Prior-Filed Applications
- Requirement to Disclaim “PRODUCTS”
- Requirement to Amend the Identification of Goods and Services
- Multiple-Class Application Requirements

SECTION 2(d) REFUSAL – LIKELIHOOD OF CONFUSION

Registration of the applied-for mark (**ESSENTIAL PRODUCTS**) is refused because of a likelihood of confusion with the marks in U.S. Registration Nos. 4728052 (**ESSENTIAL**) and 5014095 (**ESSENTIAL**). Trademark Act Section 2(d), 15 U.S.C. §1052(d); *see* TMEP §§1207.01 *et seq.* See the attached registrations.

Trademark Act Section 2(d) bars registration of an applied-for mark that so resembles a registered mark that it is likely a potential consumer would be confused, mistaken, or deceived as to the source of the goods and/or services of the applicant and registrant. *See* 15 U.S.C. §1052(d). A determination of likelihood of confusion under Section 2(d) is made on a case-by-case basis and the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973) aid in this determination. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d 1344, 1349, 98 USPQ2d 1253, 1256 (Fed. Cir. 2011) (citing *On-Line Careline, Inc. v. Am. Online, Inc.*, 229 F.3d 1080, 1085, 56 USPQ2d 1471, 1474 (Fed. Cir. 2000)). Not all the *du Pont* factors, however, are necessarily relevant or of equal weight, and any one of the factors may control in a given case, depending upon the evidence of record. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d at 1355, 98 USPQ2d at 1260; *In re Majestic Distilling Co.*, 315 F.3d 1311, 1315, 65 USPQ2d 1201, 1204 (Fed. Cir. 2003); *see In re E. I. du Pont de Nemours & Co.*, 476 F.2d at 1361-62, 177 USPQ at 567.

In this case, the following factors are the most relevant: similarity of the marks, similarity and nature of the goods and/or services, and similarity of the trade channels of the goods and/or services. *See In re Viterra Inc.*, 671 F.3d 1358, 1361-62, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *In re Dakin's Miniatures Inc.*, 59 USPQ2d 1593, 1595-96 (TTAB 1999); TMEP §§1207.01 *et seq.*

Comparing the Marks

Marks are compared in their entireties for similarities in appearance, sound, connotation, and commercial impression. *Stone Lion Capital*

Partners, LP v. Lion Capital LLP, 746 F.3d 1317, 1321, 110 USPQ2d 1157, 1160 (Fed. Cir. 2014) (quoting *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 1371, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005)); TMEP §1207.01(b)-(b)(v). “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014) (citing *In re 1st USA Realty Prof’ls, Inc.*, 84 USPQ2d 1581, 1586 (TTAB 2007)); *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988)); TMEP §1207.01(b).

In this case, the marks are confusingly similar because the dominant element of applicant’s mark is identical to the registered marks. Applicant’s mark is “ **ESSENTIAL PRODUCTS**” and registered mark in both applications is the word “ **ESSENTIAL**”.

Although marks are compared in their entireties, one feature of a mark may be more significant or dominant in creating a commercial impression. See *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *In re Nat’l Data Corp.*, 753 F.2d 1056, 1058, 224 USPQ 749, 751 (Fed. Cir. 1985); TMEP §1207.01(b)(viii), (c)(ii). Matter that is descriptive of or generic for a party’s goods and/or services is typically less significant or less dominant in relation to other wording in a mark. See *Anheuser-Busch, LLC v. Innvopak Sys. Pty Ltd.*, 115 USPQ2d 1816, 1824-25 (TTAB 2015) (citing *In re Chatam Int’l Inc.*, 380 F.3d 1340, 1342-43, 71 USPQ2d 1944, 1946 (Fed. Cir. 2004)).

In this case, the attached evidence shows that the wording “PRODUCTS” in the applied-for mark is merely descriptive of or generic for applicant’s goods and/or services. Thus, this wording is less significant in terms of affecting the mark’s commercial impression, and renders the wording “ESSENTIAL” the more dominant element of the mark; which is identical to the only element in the registered marks. As such, the marks are confusingly similar.

Comparing the Goods/Services

The goods and/or services 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 and/or services 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 and/or services] 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)); TMEP §1207.01(a)(i).

Where the marks of the respective parties are identical or virtually identical, as in this case, the degree of similarity or relatedness between the goods and/or services needed to support a finding of likelihood of confusion declines. See *In re i.am.symbolic, llc*, 116 USPQ2d 1406, 1411 (TTAB 2015) (citing *In re Shell Oil Co.*, 992 F.2d 1204, 1207, 26 USPQ2d 1687, 1689 (Fed. Cir. 1993)); TMEP §1207.01(a).

Reg. No. 5014095 (ESSENTIAL)

The use of similar marks for retail services and rental services for similar or related goods may result in a likelihood of confusion under Trademark Act Section 2(d). See *BRT Holdings, Inc. v. Homeway, Inc.*, 4 USPQ2d 1952, 1953, 1957 (TTAB 1987) (holding HOMEWAY RENTALS and design for “rental services in the field of home furnishings and appliances” likely to be confused with HOMEWAY for “retail furniture store services”). In *BRT Holdings, Inc.*, the Trademark Trial and Appeal Board stated as follows:

While applicant’s rental operation may appeal to a different market segment than opposer’s retail sale operation, the rental versus retail sale distinction does not serve to preclude confusion as to *source*. To the contrary, it appears to us that customers who encounter these two types of stores identified by the marks of the parties are almost inevitably likely to conclude, because the similarity in the marks and the close relationship between the services, that these stores are affiliated with one another, that is, that the services which they offer stem from the same ultimate source.

BRT Holdings, Inc., 4 USPQ2d at 1958.

In this case, applicant’s goods and services include the following:

- | | |
|-------------------------|--|
| International Class 9: | Mobile phones; smart phones; computers and tablet computers; accessories and replacement parts for all the aforementioned goods; computer operating software for mobile phones, smart phones, computers and tablet computers |
| International Class 28: | Handheld unit for playing electronic games; virtual reality headsets and head mounted displays for use in playing video games |
| International Class 35: | Retail store services and retail store services provided via communications networks all featuring handheld mobile |

digital electronic devices and other consumer electronics, computer software, accessories, and carrying cases for such devices; product demonstrations provided via communications networks; providing consumer product information relating to consumer electronic products, namely, mobile phones, smart phones, tablet computers, computer and computer software products, entertainment products, smartwatches, tablet computers, handheld mobile digital electronic devices, wearable electronic devices, and accessories and peripherals for such products; providing an interactive web site featuring consumer product information about consumer electronic products; providing consumer product information via the internet; retail store services of consumer electronic products, namely, mobile phones, smart phones, tablet computers, computer and computer software products, entertainment products, smartwatches, tablet computers, handheld mobile digital electronic devices, wearable electronic devices, and accessories and peripherals for such products; on-line retail store services featuring consumer electronic products, namely, mobile phones, smart phones, tablet computers, computers and computer software products, entertainment products, smartwatches, tablet computers, handheld mobile digital electronic devices, wearable electronic devices and accessories and peripherals for such products; electronic commerce services, namely, providing information about products via telecommunication networks for advertising and sales purposes

Registrant's goods are the following:

International Class 9: Adjustable smartphone and pc tablet stabilizers and mounts; audio cables; audio speakers; batteries; battery chargers; battery chargers for use with telephones; battery packs; carrying cases for cell phones; carrying cases for mobile computers; carrying cases specially adapted for electronic equipment, namely, cell phones, tablet computers, mp3 players, smart phones, digital cameras, portable media players and navigation apparatus for vehicles; cases for mobile phones; cell phone battery chargers; cell phone battery chargers for use in vehicles; cell phone cases; cell phone covers; clear protective covers specially adapted for personal electronic devices, namely, cell phones, tablet computers, mp3 players, smart phones, digital cameras, portable media players and navigation apparatus for vehicles; computer mouse; computer mouse, namely, touchpads; data cables; ear phones; earphones and headphones; external computer hard drives; fitted plastic films known as skins for covering and protecting electronic apparatus, namely, cell phones, tablet computers, mp3 players, smart phones, digital cameras, portable media players and navigation apparatus for vehicles; headphones; keyboards; keyboards for mobile phones; mobile telephone batteries; pc tablet mounts; power adapters; protective cases for smartphones; protective covers and cases for cell phones, laptops and portable media players; protective covers and cases for tablet computers; protective glasses; radio transmitters; smartphone mounts; speaker microphones; stands for handheld digital electronic devices, namely, cell phones, tablet computers, mp3 players, smart phones, digital cameras, portable media players and navigation apparatus for vehicles; straps for mobile phones; tripods for cameras; USB cables; USB cables for cellphones; wireless indoor and outdoor speakers

Applicant's services (retail store services) and registrant's goods (various mobile phone accessories) and are related because registrant's goods are featured in applicant's services. Additionally, applicant's services and registrant's goods commonly emanate from a single source. For example, the attached Internet evidence consists of third-party retailers that provide applicant's services and produce registrant's goods. See webpage screenshots featuring goods and services from Verizon, Asus, Apple, Blackberry, and HTC. The evidence also consists of third-party entities that produce applicant's goods (various mobile phone accessories) and registrant's goods (virtual reality headsets). See webpage screenshots featuring goods from Alcatel, HTC, Samsung, and Sony. Finally, the evidence also consist of entities that produce applicant's goods (mobile phones and tablet computers) and registrant's goods (various mobile phone accessories). See attached webpage screenshots featuring goods from ASUS, Apple, Blackberry, HTC, Alcatel, Samsung, and Sony. All of this evidence establishes that the same entity commonly produce and provide the relevant goods and services and markets the goods and services under the same mark. Therefore, applicant's and registrant's goods and/or services are considered related for likelihood of confusion purposes. See, e.g., *In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1202-04 (TTAB 2009); *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266, 1268-69, 1271-72 (TTAB 2009).

Reg. No. 4728052 (ESSENTIAL)

With respect to applicant's and registrant's services, the question of likelihood of confusion is determined based on the description of the services 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)).

In this case applicant's services include the following:

International Class 38: Telecommunications connections to computer databases and the internet; electronic transmission of streamed and downloadable audio and video files via computer and other communications networks; delivery of messages by electronic transmission; provision of telecommunications connections to electronic communications networks, for transmission or reception of audio, video or multimedia content; providing on-line community site; online radio streaming services; wireless broadcasting services, namely, transmitting and streaming digital audio, video,

graphics, voice data images, signals, text via the internet, portable and wireless communication devices; providing an online community, namely, providing access to databases and transmission and streaming of digital audio, video, graphics, text and data on internet service enabling transmission and streaming of digital audio, video, graphics, text and data; providing internet chat rooms; broadcasting services; streaming of data; webcasting services; providing multiple user wireless access to the internet or user access to a global computer network to enable users to access music and video content, data and information provided by means of wired or wireless broadcast, digital broadcast or electronic transmission; providing third party users with wireless access to telecommunication infrastructure to enable users to access music and video content, data and information provided by means of wired or wireless broadcast, digital broadcast or electronic transmission; interactive delivery of music and video over digital networks; computer services, namely, providing on-line facilities for real-time interaction with other computer users concerning topics of general interest (chat rooms); telecommunications services, namely, electronic transmission of virtual reality content and data

International Class 45: On-line social networking services; internet-based social networking services; providing a secure binding process from a user device to a server backend for assured user authentication; providing biometric identification and authentication services in securing online financial transaction

Registrant's goods are the following:

International Class 38: Streaming of audio material, namely, musical recordings, on the Internet; streaming of audiovisual material, namely, musical audiovisual recordings, on the Internet; audio-on-demand and video-on-demand transmission services featuring music and music video; webcasting services featuring music and music video

Applicant's and registrant's services are related because application uses broad wording to describe the services and this wording is presumed to encompass all services of the type described, including those in registrant's more narrow identification. *See In re Jump Designs, LLC*, 80 USPQ2d 1370, 1374 (TTAB 2006) (citing *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981)).

Specifically, applicant's "webcasting services" is broad enough to encompass registrant's "webcasting services featuring music and music video." Additionally, applicant's "online radio streaming services; wireless broadcasting services, namely, transmitting and streaming digital audio, video, graphics, voice data images, signals, text via the internet, portable and wireless communication devices" and "streaming of data" are broad enough to include registrant's "streaming of audio material, namely, musical recordings, on the Internet; streaming of audiovisual material, namely, musical audiovisual recordings, on the Internet."

Furthermore, the attached Internet evidence from Livewire.com, demonstrates that streaming audio material and online social networking services emanate from a single source. *See* Livewire.com, <https://www.lifewire.com/best-social-music-sites-2438411> (March 24, 2017). This evidence establishes that the same entity commonly provides the services and markets the services under the same mark. Therefore, applicant's and registrant's services are considered related for likelihood of confusion purposes. *See, e.g., In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1202-04 (TTAB 2009); *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266, 1268-69, 1271-72 (TTAB 2009).

Conclusion

Applicant's and registrants' marks are confusingly similar and their goods/services are related. Accordingly, the applied-for mark, "ESSENTIAL PRODUCTS", is refused for likelihood of confusion under Trademark Act Section 2(d).

ADVISORY: PRIOR-FILED APPLICATION

The filing date of pending **U.S. Application Serial No. 86861193 (ESSENTIAL)** precedes applicant's filing date. See attached referenced application. If the mark in the referenced application registers, applicant's mark may be refused registration under Trademark Act Section 2(d) because of a likelihood of confusion between the two marks. *See* 15 U.S.C. §1052(d); 37 C.F.R. §2.83; TMEP §§1208 *et seq.* Therefore, upon receipt of applicant's response to this Office action, action on this application may be suspended pending final disposition of the earlier-filed referenced application.

In response to this Office action, applicant may present arguments in support of registration by addressing the issue of the potential conflict between applicant's mark and the mark in the referenced application. Applicant's election not to submit arguments at this time in no way limits applicant's right to address this issue later if a refusal under Section 2(d) issues.

Although applicant's mark has been refused registration, applicant may respond to the refusal by submitting evidence and arguments in support of registration. However, if applicant responds to the refusal, applicant must also respond to the requirement set forth below.

REQUIREMENT TO DISCLAIM “PRODUCTS”

Applicant must disclaim the wording “PRODUCTS” because it merely describes the nature of applicant’s goods and/or services, and thus is an unregistrable component of the mark. *See* 15 U.S.C. §§1052(e)(1), 1056(a); *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 1251, 103 USPQ2d 1753, 1755 (Fed. Cir. 2012) (quoting *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 1173, 71 USPQ2d 1370, 1371 (Fed. Cir. 2004)); TMEP §§1213, 1213.03(a).

This wording is defined as “[a]n article or substance that is manufactured or refined for sale.” Oxforddictionaries.com, <https://en.oxforddictionaries.com/definition/us/product> (March 27, 2017). Applicant’s goods include mobile phones, computers, and tablet computers. The attached evidence from mobile phone and computer manufactures demonstrates that applicant’s goods are manufactured for sale.

Additionally, attached are copies of printouts from the USPTO X-Search database, which show third-party registrations of marks used in connection with the same or similar goods as those of applicant in this case. These printouts have probative value to the extent that these registrants disclaimed the term “PRODUCTS” because it is descriptive of the registrant’s Class 9 goods.

Third-party registrations featuring goods the same as or similar to applicant’s goods are probative evidence on the issue of descriptiveness where the relevant word or term is disclaimed, registered under Trademark Act Section 2(f) based on acquired distinctiveness, or registered on the Supplemental Register. *See Inst. Nat’l des Appellations D’Origine v. Vintners Int’l Co.*, 958 F.2d 1574, 1581-82, 22 USPQ2d 1190, 1196 (Fed. Cir. 1992); *In re Box Solutions Corp.*, 79 USPQ2d 1953, 1955 (TTAB 2006); *In re Finisar Corp.*, 78 USPQ2d 1618, 1621 (TTAB 2006). Therefore, the wording merely describes the nature of applicant’s goods.

An applicant may not claim exclusive rights to terms that others may need to use to describe their goods and/or services in the marketplace. *See Dena Corp. v. Belvedere Int’l, Inc.*, 950 F.2d 1555, 1560, 21 USPQ2d 1047, 1051 (Fed. Cir. 1991); *In re Aug. Storck KG*, 218 USPQ 823, 825 (TTAB 1983). A disclaimer of unregistrable matter does not affect the appearance of the mark; that is, a disclaimer does not physically remove the disclaimed matter from the mark. *See Schwarzkopf v. John H. Breck, Inc.*, 340 F.2d 978, 978, 144 USPQ 433, 433 (C.C.P.A. 1965); TMEP §1213.

If applicant does not provide the required disclaimer, the USPTO may refuse to register the entire mark. *See In re Stereotaxis Inc.*, 429 F.3d 1039, 1040-41, 77 USPQ2d 1087, 1088-89 (Fed. Cir. 2005); TMEP §1213.01(b).

Applicant should submit a disclaimer in the following standardized format:

No claim is made to the exclusive right to use “PRODUCTS” apart from the mark as shown.

For an overview of disclaimers and instructions on how to satisfy this disclaimer requirement online using the Trademark Electronic Application System (TEAS) form, please go to <http://www.uspto.gov/trademarks/law/disclaimer.jsp>.

REQUIREMENT TO AMEND IDENTIFICATION OF GOODS & SERVICES

The wording “**accessories . . . for all the aforementioned goods**” in International Class 9 is indefinite and must be amended to indicate the specific accessories. *See* 37 C.F.R. §2.32(a)(6); TMEP §1402.01.

Applicant has classified “**virtual reality headsets and head mounted displays for use in playing video games**” in International Class 28; however, the proper classification is International Class 9. Therefore, applicant may respond by reclassifying these goods in the proper international class. Additionally, the wording “**displays**” is indefinite and must be amended to specify the type of display. *See* 37 C.F.R. §2.32(a)(6); TMEP §1402.01.

The wording “**providing on-line community site**” in International Class 38 must be clarified because it is too broad and could include services in other international classes. *See* 37 C.F.R. §2.32(a)(6); TMEP §§1402.01, 1402.03. In particular, the service of “providing a website” is classified the subject matter featured on the website. Accordingly, this wording could encompass “providing an on-line community site featuring technology that allow users to send messages” in International Class 42 and “online social networking services provided through an on-line community website” in International Class 45.

The wording “**online radio streaming services**” in International Class 38 is indefinite and must be amended to further indicate the type of content or material. *See* 37 C.F.R. §2.32(a)(6); TMEP §1402.01. Applicant may substitute the following wording, if accurate: online radio streaming services, namely, streaming audio material via the Internet.

The wording “**broadcasting services**” in International Class 38 is indefinite and must be amended to further specify the type of broadcasting services. *See* 37 C.F.R. §2.32(a)(6); TMEP §1402.01. Applicant may substitute the following wording, if accurate: Internet, television, and

radio broadcasting services.

The wording “**computer services, namely, providing on-line facilities for real-time interaction with other computer users concerning topics of general interest (chat rooms)**” in International Class 38 contains parentheses. Generally, applicants should *not* use parentheses in identifications in their applications so as to avoid confusion with the USPTO’s practice of using parentheses and brackets in registrations to indicate goods and/or services that have been deleted from registrations or in an affidavit of incontestability to indicate goods and/or services not claimed. See TMEP §1402.12. The only exception is that parenthetical information is permitted in identifications in an application if it serves to explain or translate the matter immediately preceding the parenthetical phrase in such a way that it does not affect the clarity of the identification, e.g., “sash bands for kimono (obi).” *Id.* Therefore, applicant must remove the parentheses from this identification and incorporate any parenthetical information into the description of the services or delete the wording contained in the parenthetical.

The wording “**providing a secure binding process from a user device to a server backend for assured user authentication**” in International Class 45 is indefinite and must be to clearly identify the nature of the services. See 37 C.F.R. §2.32(a)(6); TMEP §1402.01. Applicant may substitute the following wording, if accurate: providing user authentication services in e-commerce transactions via a secure binding process from a user device to a server backend.

The wording “**providing biometric identification and authentication services in securing online financial transaction**” in International Class 45 is indefinite and must be amended so that it is clear applicant is offering identification verification and user authentication services. See 37 C.F.R. §2.32(a)(6); TMEP §1402.01. Applicant may substitute the following wording, if accurate: providing biometric identification verification and user authentication services in securing online financial transaction.

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](#). See TMEP §1402.04.

Applicant may adopt the following identification of goods and services, if accurate:

International Class 9: Mobile phones; smart phones; computers and tablet computers; replacement parts for all the aforementioned goods; accessories for all the aforementioned goods, **namely, {applicant must further indicate the specific accessories}**; computer operating software for mobile phones, smart phones, computers and tablet computers; **virtual reality headsets and head mounted video displays for use in playing video games**

International Class 28: Handheld unit for playing electronic games

International Class 38: Telecommunications connections to computer databases and the internet; electronic transmission of streamed and downloadable audio and video files via computer and other communications networks; delivery of messages by electronic transmission; provision of telecommunications connections to electronic communications networks, for transmission or reception of audio, video or multimedia content; online radio streaming services, **namely, streaming audio material via the Internet**; wireless broadcasting services, namely, transmitting and streaming digital audio, video, graphics, voice data images, signals, text via the internet, portable and wireless communication devices; providing an online community, namely, providing access to databases and transmission and streaming of digital audio, video, graphics, text and data on internet service enabling transmission and streaming of digital audio, video, graphics, text and data; providing internet chat rooms; **Internet, television, and radio** broadcasting services; streaming of data; webcasting services; providing multiple user wireless access to the internet or user access to a global computer network to enable users to access music and video content, data and information provided by means of wired or wireless broadcast, digital broadcast or electronic transmission; providing third party users with wireless access to telecommunication infrastructure to enable users to access music and video content, data and information provided by means of wired or wireless broadcast, digital broadcast or electronic transmission; interactive delivery of music and video over digital networks; computer services, namely, providing on-line facilities for real-time interaction with other computer users concerning topics of general interest; telecommunications services, namely, electronic transmission of virtual reality content and data

International Class 45: On-line social networking services; internet-based social networking services; **providing user authentication services in e-commerce transactions via a secure binding process from a user device to a server backend**; providing biometric identification **verification** and **user** authentication services in securing online financial transaction; **online social networking services provided through an on-line community website**

The services in International Class 35 are acceptable as written.

Applicant’s goods and/or services may be clarified or limited, but may not be expanded beyond those originally itemized in the application or as acceptably amended. See 37 C.F.R. §2.71(a); TMEP §1402.06. Applicant may clarify or limit the identification by inserting qualifying

language or deleting items to result in a more specific identification; however, applicant may not substitute different goods and/or services or add goods and/or services not found or encompassed by those in the original application or as acceptably amended. See TMEP §1402.06(a)-(b). The scope of the goods and/or services sets the outer limit for any changes to the identification and is generally determined by the ordinary meaning of the wording in the identification. TMEP §§1402.06(b), 1402.07(a)-(b). Any acceptable changes to the goods and/or services will further limit scope, and once goods and/or services are deleted, they are not permitted to be reinserted. TMEP §1402.07(e).

MULTIPLE-CLASS APPLICATION REQUIREMENTS

The application identifies goods and/or services in more than one international class; therefore, applicant must satisfy all the requirements below for each international class based on Trademark Act Section 1(b):

- (1) **List the goods and/or services by their international class number** in consecutive numerical order, starting with the lowest numbered class.
- (2) **Submit a filing fee for each international class** not covered by the fees already paid (view the USPTO's current fee schedule at http://www.uspto.gov/trademarks/tm_fee_info.jsp). The application identifies goods and/or services that are classified in at least 6 classes; however, applicant submitted fees sufficient for only 5 classes. Applicant must either submit the filing fees for the classes not covered by the submitted fees or restrict the application to the number of classes covered by the fees already paid.

See 15 U.S.C. §§1051(b), 1112, 1126(e); 37 C.F.R. §§2.32(a)(6)-(7), 2.34(a)(2)-(3), 2.86(a); TMEP §§1403.01, 1403.02(c).

For an overview of the requirements for a Section 1(b) multiple-class application and how to satisfy the requirements online using the Trademark Electronic Application System (TEAS) form, please go to <http://www.uspto.gov/trademarks/law/multiclass.jsp>.

Fees For Additional Classes

The fee for adding classes to a TEAS Reduced Fee (RF) application is \$275 per class. See 37 C.F.R. §§2.6(a)(1)(iii), 2.23(a). See [more information](#) regarding the requirements for maintaining the lower TEAS RF fee and, if these requirements are not satisfied, for adding classes at a higher fee using regular TEAS.

RESPONSE GUIDELINES

If applicant has questions regarding this Office action, please telephone or e-mail the assigned trademark examining attorney. All relevant e-mail communications will be placed in the official application record; however, an e-mail communication will not be accepted as a response to this Office action and will not extend the deadline for filing a proper response. See 37 C.F.R. §2.191; TMEP §§709.04-.05. Further, although the trademark examining attorney may provide additional explanation pertaining to the refusal and/or requirements in this Office action, the trademark examining attorney may not provide legal advice or statements about applicant's rights. See TMEP §§705.02, 709.06.

TEAS PLUS OR TEAS REDUCED FEE (TEAS RF) APPLICANTS – TO MAINTAIN LOWER FEE, ADDITIONAL REQUIREMENTS MUST BE MET, INCLUDING SUBMITTING DOCUMENTS ONLINE: Applicants who filed their application online using the lower-fee TEAS Plus or TEAS RF application form must (1) file certain documents online using TEAS, including responses to Office actions (see TMEP §§819.02(b), 820.02(b) for a complete list of these documents); (2) maintain a valid e-mail correspondence address; and (3) agree to receive correspondence from the USPTO by e-mail throughout the prosecution of the application. See 37 C.F.R. §§2.22(b), 2.23(b); TMEP §§819, 820. TEAS Plus or TEAS RF applicants who do not meet these requirements must submit an additional processing fee of \$125 per class of goods and/or services. 37 C.F.R. §§2.6(a)(1)(v), 2.22(c), 2.23(c); TMEP §§819.04, 820.04. However, in certain situations, TEAS Plus or TEAS RF applicants may respond to an Office action by authorizing an examiner's amendment by telephone or e-mail without incurring this additional fee.

/Marco Wright/
Trademark Examining Attorney
Law Office 120
(571) 272-4918
marco.wright@uspto.gov

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>.

To: Essential Products, Inc. (petrademarks@perkinscoie.com)
Subject: U.S. TRADEMARK APPLICATION NO. 87301561 - ESSENTIAL PRODUCTS - 119306-4005
Sent: 3/27/2017 9:12:56 PM
Sent As: ECOM120@USPTO.GOV

Attachments: [Attachment - 1](#)
[Attachment - 2](#)
[Attachment - 3](#)
[Attachment - 4](#)
[Attachment - 5](#)
[Attachment - 6](#)
[Attachment - 7](#)
[Attachment - 8](#)
[Attachment - 9](#)
[Attachment - 10](#)
[Attachment - 11](#)
[Attachment - 12](#)
[Attachment - 13](#)
[Attachment - 14](#)
[Attachment - 15](#)
[Attachment - 16](#)
[Attachment - 17](#)
[Attachment - 18](#)
[Attachment - 19](#)
[Attachment - 20](#)
[Attachment - 21](#)
[Attachment - 22](#)
[Attachment - 23](#)
[Attachment - 24](#)
[Attachment - 25](#)
[Attachment - 26](#)
[Attachment - 27](#)
[Attachment - 28](#)
[Attachment - 29](#)
[Attachment - 30](#)
[Attachment - 31](#)
[Attachment - 32](#)
[Attachment - 33](#)
[Attachment - 34](#)
[Attachment - 35](#)
[Attachment - 36](#)
[Attachment - 37](#)
[Attachment - 38](#)
[Attachment - 39](#)
[Attachment - 40](#)
[Attachment - 41](#)
[Attachment - 42](#)
[Attachment - 43](#)
[Attachment - 44](#)

[Attachment - 45](#)
[Attachment - 46](#)
[Attachment - 47](#)
[Attachment - 48](#)
[Attachment - 49](#)
[Attachment - 50](#)
[Attachment - 51](#)
[Attachment - 52](#)
[Attachment - 53](#)
[Attachment - 54](#)
[Attachment - 55](#)
[Attachment - 56](#)
[Attachment - 57](#)
[Attachment - 58](#)
[Attachment - 59](#)
[Attachment - 60](#)
[Attachment - 61](#)
[Attachment - 62](#)
[Attachment - 63](#)
[Attachment - 64](#)
[Attachment - 65](#)
[Attachment - 66](#)
[Attachment - 67](#)
[Attachment - 68](#)
[Attachment - 69](#)
[Attachment - 70](#)
[Attachment - 71](#)
[Attachment - 72](#)
[Attachment - 73](#)
[Attachment - 74](#)
[Attachment - 75](#)
[Attachment - 76](#)
[Attachment - 77](#)
[Attachment - 78](#)
[Attachment - 79](#)
[Attachment - 80](#)
[Attachment - 81](#)
[Attachment - 82](#)
[Attachment - 83](#)
[Attachment - 84](#)
[Attachment - 85](#)

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

U.S. APPLICATION SERIAL NO. 87301561

MARK: ESSENTIAL PRODUCTS

87301561

CORRESPONDENT ADDRESS:

MICHAEL GLENN
PERKINS COIE LLP
3150 PORTER DRIVE
PALO ALTO, CA 94304

CLICK HERE TO RESPOND TO THIS LETTER:

http://www.uspto.gov/trademarks/teas/response_forms.jsp

[VIEW YOUR APPLICATION FILE](#)

APPLICANT: Essential Products, Inc.

CORRESPONDENT'S REFERENCE/DOCKET NO :

119306-4005

CORRESPONDENT E-MAIL ADDRESS:

pctrademarks@perkinscoie.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. A RESPONSE TRANSMITTED THROUGH THE TRADEMARK ELECTRONIC APPLICATION SYSTEM (TEAS) MUST BE RECEIVED BEFORE MIDNIGHT EASTERN TIME OF THE LAST DAY OF THE RESPONSE PERIOD.

ISSUE/MAILING DATE: 3/27/2017

The referenced application has been reviewed by the assigned trademark examining attorney. Applicant must respond timely and completely to the issues below. 15 U.S.C. §1062(b); 37 C.F.R. §§2.62(a), 2.65(a); TMEP §§711, 718.03.

SUMMARY OF ISSUES

- Refusal under Trademark Act Section 2(d) – Likelihood of Confusion
- Prior-Filed Applications
- Requirement to Disclaim “PRODUCTS”
- Requirement to Amend the Identification of Goods and Services
- Multiple-Class Application Requirements

SECTION 2(d) REFUSAL – LIKELIHOOD OF CONFUSION

Registration of the applied-for mark (**ESSENTIAL PRODUCTS**) is refused because of a likelihood of confusion with the marks in U.S. Registration Nos. 4728052 (**ESSENTIAL**) and 5014095 (**ESSENTIAL**). Trademark Act Section 2(d), 15 U.S.C. §1052(d); *see* TMEP §§1207.01 *et seq.* See the attached registrations.

Trademark Act Section 2(d) bars registration of an applied-for mark that so resembles a registered mark that it is likely a potential consumer would be confused, mistaken, or deceived as to the source of the goods and/or services of the applicant and registrant. *See* 15 U.S.C. §1052(d). A determination of likelihood of confusion under Section 2(d) is made on a case-by-case basis and the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973) aid in this determination. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d 1344, 1349, 98 USPQ2d 1253, 1256 (Fed. Cir. 2011) (citing *On-Line Careline, Inc. v. Am. Online, Inc.*, 229 F.3d 1080, 1085, 56 USPQ2d 1471, 1474 (Fed. Cir. 2000)). Not all the *du Pont* factors, however, are necessarily relevant or of equal weight, and any one of the factors may control in a given case, depending upon the evidence of record. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d at 1355, 98 USPQ2d at 1260; *In re Majestic Distilling Co.*, 315 F.3d 1311, 1315, 65 USPQ2d 1201, 1204 (Fed. Cir. 2003); *see In re E. I. du Pont de Nemours & Co.*, 476 F.2d at 1361-62, 177 USPQ at 567.

In this case, the following factors are the most relevant: similarity of the marks, similarity and nature of the goods and/or services, and similarity of the trade channels of the goods and/or services. *See In re Viterra Inc.*, 671 F.3d 1358, 1361-62, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *In re Dakin's Miniatures Inc.*, 59 USPQ2d 1593, 1595-96 (TTAB 1999); TMEP §§1207.01 *et seq.*

Comparing the Marks

Marks are compared in their entireties for similarities in appearance, sound, connotation, and commercial impression. *Stone Lion Capital*

Partners, LP v. Lion Capital LLP, 746 F.3d 1317, 1321, 110 USPQ2d 1157, 1160 (Fed. Cir. 2014) (quoting *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 1371, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005)); TMEP §1207.01(b)-(b)(v). “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014) (citing *In re 1st USA Realty Prof’ls, Inc.*, 84 USPQ2d 1581, 1586 (TTAB 2007)); *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988)); TMEP §1207.01(b).

In this case, the marks are confusingly similar because the dominant element of applicant’s mark is identical to the registered marks. Applicant’s mark is “ **ESSENTIAL PRODUCTS**” and registered mark in both applications is the word “ **ESSENTIAL**”.

Although marks are compared in their entireties, one feature of a mark may be more significant or dominant in creating a commercial impression. *See In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *In re Nat’l Data Corp.*, 753 F.2d 1056, 1058, 224 USPQ 749, 751 (Fed. Cir. 1985); TMEP §1207.01(b)(viii), (c)(ii). Matter that is descriptive of or generic for a party’s goods and/or services is typically less significant or less dominant in relation to other wording in a mark. *See Anheuser-Busch, LLC v. Innvopak Sys. Pty Ltd.*, 115 USPQ2d 1816, 1824-25 (TTAB 2015) (citing *In re Chatam Int’l Inc.*, 380 F.3d 1340, 1342-43, 71 USPQ2d 1944, 1946 (Fed. Cir. 2004)).

In this case, the attached evidence shows that the wording “PRODUCTS” in the applied-for mark is merely descriptive of or generic for applicant’s goods and/or services. Thus, this wording is less significant in terms of affecting the mark’s commercial impression, and renders the wording “ESSENTIAL” the more dominant element of the mark; which is identical to the only element in the registered marks. As such, the marks are confusingly similar.

Comparing the Goods/Services

The goods and/or services 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 and/or services 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 and/or services] 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)); TMEP §1207.01(a)(i).

Where the marks of the respective parties are identical or virtually identical, as in this case, the degree of similarity or relatedness between the goods and/or services needed to support a finding of likelihood of confusion declines. *See In re i.am.symbolic, llc*, 116 USPQ2d 1406, 1411 (TTAB 2015) (citing *In re Shell Oil Co.*, 992 F.2d 1204, 1207, 26 USPQ2d 1687, 1689 (Fed. Cir. 1993)); TMEP §1207.01(a).

Reg. No. 5014095 (ESSENTIAL)

The use of similar marks for retail services and rental services for similar or related goods may result in a likelihood of confusion under Trademark Act Section 2(d). *See BRT Holdings, Inc. v. Homeway, Inc.*, 4 USPQ2d 1952, 1953, 1957 (TTAB 1987) (holding HOMEWAY RENTALS and design for “rental services in the field of home furnishings and appliances” likely to be confused with HOMEWAY for “retail furniture store services”). In *BRT Holdings, Inc.*, the Trademark Trial and Appeal Board stated as follows:

While applicant’s rental operation may appeal to a different market segment than opposer’s retail sale operation, the rental versus retail sale distinction does not serve to preclude confusion as to *source*. To the contrary, it appears to us that customers who encounter these two types of stores identified by the marks of the parties are almost inevitably likely to conclude, because the similarity in the marks and the close relationship between the services, that these stores are affiliated with one another, that is, that the services which they offer stem from the same ultimate source.

BRT Holdings, Inc., 4 USPQ2d at 1958.

In this case, applicant’s goods and services include the following:

- | | |
|-------------------------|--|
| International Class 9: | Mobile phones; smart phones; computers and tablet computers; accessories and replacement parts for all the aforementioned goods; computer operating software for mobile phones, smart phones, computers and tablet computers |
| International Class 28: | Handheld unit for playing electronic games; virtual reality headsets and head mounted displays for use in playing video games |
| International Class 35: | Retail store services and retail store services provided via communications networks all featuring handheld mobile |

digital electronic devices and other consumer electronics, computer software, accessories, and carrying cases for such devices; product demonstrations provided via communications networks; providing consumer product information relating to consumer electronic products, namely, mobile phones, smart phones, tablet computers, computer and computer software products, entertainment products, smartwatches, tablet computers, handheld mobile digital electronic devices, wearable electronic devices, and accessories and peripherals for such products; providing an interactive web site featuring consumer product information about consumer electronic products; providing consumer product information via the internet; retail store services of consumer electronic products, namely, mobile phones, smart phones, tablet computers, computer and computer software products, entertainment products, smartwatches, tablet computers, handheld mobile digital electronic devices, wearable electronic devices, and accessories and peripherals for such products; on-line retail store services featuring consumer electronic products, namely, mobile phones, smart phones, tablet computers, computers and computer software products, entertainment products, smartwatches, tablet computers, handheld mobile digital electronic devices, wearable electronic devices and accessories and peripherals for such products; electronic commerce services, namely, providing information about products via telecommunication networks for advertising and sales purposes

Registrant's goods are the following:

International Class 9: Adjustable smartphone and pc tablet stabilizers and mounts; audio cables; audio speakers; batteries; battery chargers; battery chargers for use with telephones; battery packs; carrying cases for cell phones; carrying cases for mobile computers; carrying cases specially adapted for electronic equipment, namely, cell phones, tablet computers, mp3 players, smart phones, digital cameras, portable media players and navigation apparatus for vehicles; cases for mobile phones; cell phone battery chargers; cell phone battery chargers for use in vehicles; cell phone cases; cell phone covers; clear protective covers specially adapted for personal electronic devices, namely, cell phones, tablet computers, mp3 players, smart phones, digital cameras, portable media players and navigation apparatus for vehicles; computer mouse; computer mouse, namely, touchpads; data cables; ear phones; earphones and headphones; external computer hard drives; fitted plastic films known as skins for covering and protecting electronic apparatus, namely, cell phones, tablet computers, mp3 players, smart phones, digital cameras, portable media players and navigation apparatus for vehicles; headphones; keyboards; keyboards for mobile phones; mobile telephone batteries; pc tablet mounts; power adapters; protective cases for smartphones; protective covers and cases for cell phones, laptops and portable media players; protective covers and cases for tablet computers; protective glasses; radio transmitters; smartphone mounts; speaker microphones; stands for handheld digital electronic devices, namely, cell phones, tablet computers, mp3 players, smart phones, digital cameras, portable media players and navigation apparatus for vehicles; straps for mobile phones; tripods for cameras; USB cables; USB cables for cellphones; wireless indoor and outdoor speakers

Applicant's services (retail store services) and registrant's goods (various mobile phone accessories) and are related because registrant's goods are featured in applicant's services. Additionally, applicant's services and registrant's goods commonly emanate from a single source. For example, the attached Internet evidence consists of third-party retailers that provide applicant's services and produce registrant's goods. See webpage screenshots featuring goods and services from Verizon, Asus, Apple, Blackberry, and HTC. The evidence also consists of third-party entities that produce applicant's goods (various mobile phone accessories) and registrant's goods (virtual reality headsets). See webpage screenshots featuring goods from Alcatel, HTC, Samsung, and Sony. Finally, the evidence also consist of entities that produce applicant's goods (mobile phones and tablet computers) and registrant's goods (various mobile phone accessories). See attached webpage screenshots featuring goods from ASUS, Apple, Blackberry, HTC, Alcatel, Samsung, and Sony. All of this evidence establishes that the same entity commonly produce and provide the relevant goods and services and markets the goods and services under the same mark. Therefore, applicant's and registrant's goods and/or services are considered related for likelihood of confusion purposes. See, e.g., *In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1202-04 (TTAB 2009); *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266, 1268-69, 1271-72 (TTAB 2009).

Reg. No. 4728052 (ESSENTIAL)

With respect to applicant's and registrant's services, the question of likelihood of confusion is determined based on the description of the services 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)).

In this case applicant's services include the following:

International Class 38: Telecommunications connections to computer databases and the internet; electronic transmission of streamed and downloadable audio and video files via computer and other communications networks; delivery of messages by electronic transmission; provision of telecommunications connections to electronic communications networks, for transmission or reception of audio, video or multimedia content; providing on-line community site; online radio streaming services; wireless broadcasting services, namely, transmitting and streaming digital audio, video,

graphics, voice data images, signals, text via the internet, portable and wireless communication devices; providing an online community, namely, providing access to databases and transmission and streaming of digital audio, video, graphics, text and data on internet service enabling transmission and streaming of digital audio, video, graphics, text and data; providing internet chat rooms; broadcasting services; streaming of data; webcasting services; providing multiple user wireless access to the internet or user access to a global computer network to enable users to access music and video content, data and information provided by means of wired or wireless broadcast, digital broadcast or electronic transmission; providing third party users with wireless access to telecommunication infrastructure to enable users to access music and video content, data and information provided by means of wired or wireless broadcast, digital broadcast or electronic transmission; interactive delivery of music and video over digital networks; computer services, namely, providing on-line facilities for real-time interaction with other computer users concerning topics of general interest (chat rooms); telecommunications services, namely, electronic transmission of virtual reality content and data

International Class 45: On-line social networking services; internet-based social networking services; providing a secure binding process from a user device to a server backend for assured user authentication; providing biometric identification and authentication services in securing online financial transaction

Registrant's goods are the following:

International Class 38: Streaming of audio material, namely, musical recordings, on the Internet; streaming of audiovisual material, namely, musical audiovisual recordings, on the Internet; audio-on-demand and video-on-demand transmission services featuring music and music video; webcasting services featuring music and music video

Applicant's and registrant's services are related because application uses broad wording to describe the services and this wording is presumed to encompass all services of the type described, including those in registrant's more narrow identification. *See In re Jump Designs, LLC*, 80 USPQ2d 1370, 1374 (TTAB 2006) (citing *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981)).

Specifically, applicant's "webcasting services" is broad enough to encompass registrant's "webcasting services featuring music and music video." Additionally, applicant's "online radio streaming services; wireless broadcasting services, namely, transmitting and streaming digital audio, video, graphics, voice data images, signals, text via the internet, portable and wireless communication devices" and "streaming of data" are broad enough to include registrant's "streaming of audio material, namely, musical recordings, on the Internet; streaming of audiovisual material, namely, musical audiovisual recordings, on the Internet."

Furthermore, the attached Internet evidence from Livewire.com, demonstrates that streaming audio material and online social networking services emanate from a single source. *See* Livewire.com, <https://www.lifewire.com/best-social-music-sites-2438411> (March 24, 2017). This evidence establishes that the same entity commonly provides the services and markets the services under the same mark. Therefore, applicant's and registrant's services are considered related for likelihood of confusion purposes. *See, e.g., In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1202-04 (TTAB 2009); *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266, 1268-69, 1271-72 (TTAB 2009).

Conclusion

Applicant's and registrants' marks are confusingly similar and their goods/services are related. Accordingly, the applied-for mark, "**ESSENTIAL PRODUCTS**", is refused for likelihood of confusion under Trademark Act Section 2(d).

ADVISORY: PRIOR-FILED APPLICATION

The filing date of pending **U.S. Application Serial No. 86861193 (ESSENTIAL)** precedes applicant's filing date. See attached referenced application. If the mark in the referenced application registers, applicant's mark may be refused registration under Trademark Act Section 2(d) because of a likelihood of confusion between the two marks. *See* 15 U.S.C. §1052(d); 37 C.F.R. §2.83; TMEP §§1208 *et seq.* Therefore, upon receipt of applicant's response to this Office action, action on this application may be suspended pending final disposition of the earlier-filed referenced application.

In response to this Office action, applicant may present arguments in support of registration by addressing the issue of the potential conflict between applicant's mark and the mark in the referenced application. Applicant's election not to submit arguments at this time in no way limits applicant's right to address this issue later if a refusal under Section 2(d) issues.

Although applicant's mark has been refused registration, applicant may respond to the refusal by submitting evidence and arguments in support of registration. However, if applicant responds to the refusal, applicant must also respond to the requirement set forth below.

REQUIREMENT TO DISCLAIM “PRODUCTS”

Applicant must disclaim the wording “PRODUCTS” because it merely describes the nature of applicant’s goods and/or services, and thus is an unregistrable component of the mark. *See* 15 U.S.C. §§1052(e)(1), 1056(a); *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 1251, 103 USPQ2d 1753, 1755 (Fed. Cir. 2012) (quoting *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 1173, 71 USPQ2d 1370, 1371 (Fed. Cir. 2004)); TMEP §§1213, 1213.03(a).

This wording is defined as “[a]n article or substance that is manufactured or refined for sale.” Oxforddictionaries.com, <https://en.oxforddictionaries.com/definition/us/product> (March 27, 2017). Applicant’s goods include mobile phones, computers, and tablet computers. The attached evidence from mobile phone and computer manufactures demonstrates that applicant’s goods are manufactured for sale.

Additionally, attached are copies of printouts from the USPTO X-Search database, which show third-party registrations of marks used in connection with the same or similar goods as those of applicant in this case. These printouts have probative value to the extent that these registrants disclaimed the term “PRODUCTS” because it is descriptive of the registrant’s Class 9 goods.

Third-party registrations featuring goods the same as or similar to applicant’s goods are probative evidence on the issue of descriptiveness where the relevant word or term is disclaimed, registered under Trademark Act Section 2(f) based on acquired distinctiveness, or registered on the Supplemental Register. *See Inst. Nat’l des Appellations D’Origine v. Vintners Int’l Co.*, 958 F.2d 1574, 1581-82, 22 USPQ2d 1190, 1196 (Fed. Cir. 1992); *In re Box Solutions Corp.*, 79 USPQ2d 1953, 1955 (TTAB 2006); *In re Finisar Corp.*, 78 USPQ2d 1618, 1621 (TTAB 2006). Therefore, the wording merely describes the nature of applicant’s goods.

An applicant may not claim exclusive rights to terms that others may need to use to describe their goods and/or services in the marketplace. *See Dena Corp. v. Belvedere Int’l, Inc.*, 950 F.2d 1555, 1560, 21 USPQ2d 1047, 1051 (Fed. Cir. 1991); *In re Aug. Storck KG*, 218 USPQ 823, 825 (TTAB 1983). A disclaimer of unregistrable matter does not affect the appearance of the mark; that is, a disclaimer does not physically remove the disclaimed matter from the mark. *See Schwarzkopf v. John H. Breck, Inc.*, 340 F.2d 978, 978, 144 USPQ 433, 433 (C.C.P.A. 1965); TMEP §1213.

If applicant does not provide the required disclaimer, the USPTO may refuse to register the entire mark. *See In re Stereotaxis Inc.*, 429 F.3d 1039, 1040-41, 77 USPQ2d 1087, 1088-89 (Fed. Cir. 2005); TMEP §1213.01(b).

Applicant should submit a disclaimer in the following standardized format:

No claim is made to the exclusive right to use “PRODUCTS” apart from the mark as shown.

For an overview of disclaimers and instructions on how to satisfy this disclaimer requirement online using the Trademark Electronic Application System (TEAS) form, please go to <http://www.uspto.gov/trademarks/law/disclaimer.jsp>.

REQUIREMENT TO AMEND IDENTIFICATION OF GOODS & SERVICES

The wording “**accessories . . . for all the aforementioned goods**” in International Class 9 is indefinite and must be amended to indicate the specific accessories. *See* 37 C.F.R. §2.32(a)(6); TMEP §1402.01.

Applicant has classified “**virtual reality headsets and head mounted displays for use in playing video games**” in International Class 28; however, the proper classification is International Class 9. Therefore, applicant may respond by reclassifying these goods in the proper international class. Additionally, the wording “**displays**” is indefinite and must be amended to specify the type of display. *See* 37 C.F.R. §2.32(a)(6); TMEP §1402.01.

The wording “**providing on-line community site**” in International Class 38 must be clarified because it is too broad and could include services in other international classes. *See* 37 C.F.R. §2.32(a)(6); TMEP §§1402.01, 1402.03. In particular, the service of “providing a website” is classified the subject matter featured on the website. Accordingly, this wording could encompass “providing an on-line community site featuring technology that allow users to send messages” in International Class 42 and “online social networking services provided through an on-line community website” in International Class 45.

The wording “**online radio streaming services**” in International Class 38 is indefinite and must be amended to further indicate the type of content or material. *See* 37 C.F.R. §2.32(a)(6); TMEP §1402.01. Applicant may substitute the following wording, if accurate: online radio streaming services, namely, streaming audio material via the Internet.

The wording “**broadcasting services**” in International Class 38 is indefinite and must be amended to further specify the type of broadcasting services. *See* 37 C.F.R. §2.32(a)(6); TMEP §1402.01. Applicant may substitute the following wording, if accurate: Internet, television, and

radio broadcasting services.

The wording “**computer services, namely, providing on-line facilities for real-time interaction with other computer users concerning topics of general interest (chat rooms)**” in International Class 38 contains parentheses. Generally, applicants should *not* use parentheses in identifications in their applications so as to avoid confusion with the USPTO’s practice of using parentheses and brackets in registrations to indicate goods and/or services that have been deleted from registrations or in an affidavit of incontestability to indicate goods and/or services not claimed. See TMEP §1402.12. The only exception is that parenthetical information is permitted in identifications in an application if it serves to explain or translate the matter immediately preceding the parenthetical phrase in such a way that it does not affect the clarity of the identification, e.g., “sash bands for kimono (obi).” *Id.* Therefore, applicant must remove the parentheses from this identification and incorporate any parenthetical information into the description of the services or delete the wording contained in the parenthetical.

The wording “**providing a secure binding process from a user device to a server backend for assured user authentication**” in International Class 45 is indefinite and must be to clearly identify the nature of the services. See 37 C.F.R. §2.32(a)(6); TMEP §1402.01. Applicant may substitute the following wording, if accurate: providing user authentication services in e-commerce transactions via a secure binding process from a user device to a server backend.

The wording “**providing biometric identification and authentication services in securing online financial transaction**” in International Class 45 is indefinite and must be amended so that it is clear applicant is offering identification verification and user authentication services. See 37 C.F.R. §2.32(a)(6); TMEP §1402.01. Applicant may substitute the following wording, if accurate: providing biometric identification verification and user authentication services in securing online financial transaction.

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](#). See TMEP §1402.04.

Applicant may adopt the following identification of goods and services, if accurate:

International Class 9: Mobile phones; smart phones; computers and tablet computers; replacement parts for all the aforementioned goods; accessories for all the aforementioned goods, **namely, {applicant must further indicate the specific accessories}**; computer operating software for mobile phones, smart phones, computers and tablet computers; **virtual reality headsets and head mounted video displays for use in playing video games**

International Class 28: Handheld unit for playing electronic games

International Class 38: Telecommunications connections to computer databases and the internet; electronic transmission of streamed and downloadable audio and video files via computer and other communications networks; delivery of messages by electronic transmission; provision of telecommunications connections to electronic communications networks, for transmission or reception of audio, video or multimedia content; online radio streaming services, **namely, streaming audio material via the Internet**; wireless broadcasting services, namely, transmitting and streaming digital audio, video, graphics, voice data images, signals, text via the internet, portable and wireless communication devices; providing an online community, namely, providing access to databases and transmission and streaming of digital audio, video, graphics, text and data on internet service enabling transmission and streaming of digital audio, video, graphics, text and data; providing internet chat rooms; **Internet, television, and radio** broadcasting services; streaming of data; webcasting services; providing multiple user wireless access to the internet or user access to a global computer network to enable users to access music and video content, data and information provided by means of wired or wireless broadcast, digital broadcast or electronic transmission; providing third party users with wireless access to telecommunication infrastructure to enable users to access music and video content, data and information provided by means of wired or wireless broadcast, digital broadcast or electronic transmission; interactive delivery of music and video over digital networks; computer services, namely, providing on-line facilities for real-time interaction with other computer users concerning topics of general interest; telecommunications services, namely, electronic transmission of virtual reality content and data

International Class 45: On-line social networking services; internet-based social networking services; **providing user authentication services in e-commerce transactions via a secure binding process from a user device to a server backend**; providing biometric identification **verification** and **user** authentication services in securing online financial transaction; **online social networking services provided through an on-line community website**

The services in International Class 35 are acceptable as written.

Applicant’s goods and/or services may be clarified or limited, but may not be expanded beyond those originally itemized in the application or as acceptably amended. See 37 C.F.R. §2.71(a); TMEP §1402.06. Applicant may clarify or limit the identification by inserting qualifying

language or deleting items to result in a more specific identification; however, applicant may not substitute different goods and/or services or add goods and/or services not found or encompassed by those in the original application or as acceptably amended. See TMEP §1402.06(a)-(b). The scope of the goods and/or services sets the outer limit for any changes to the identification and is generally determined by the ordinary meaning of the wording in the identification. TMEP §§1402.06(b), 1402.07(a)-(b). Any acceptable changes to the goods and/or services will further limit scope, and once goods and/or services are deleted, they are not permitted to be reinserted. TMEP §1402.07(e).

MULTIPLE-CLASS APPLICATION REQUIREMENTS

The application identifies goods and/or services in more than one international class; therefore, applicant must satisfy all the requirements below for each international class based on Trademark Act Section 1(b):

- (1) **List the goods and/or services by their international class number** in consecutive numerical order, starting with the lowest numbered class.
- (2) **Submit a filing fee for each international class** not covered by the fees already paid (view the USPTO's current fee schedule at http://www.uspto.gov/trademarks/tm_fee_info.jsp). The application identifies goods and/or services that are classified in at least 6 classes; however, applicant submitted fees sufficient for only 5 classes. Applicant must either submit the filing fees for the classes not covered by the submitted fees or restrict the application to the number of classes covered by the fees already paid.

See 15 U.S.C. §§1051(b), 1112, 1126(e); 37 C.F.R. §§2.32(a)(6)-(7), 2.34(a)(2)-(3), 2.86(a); TMEP §§1403.01, 1403.02(c).

For an overview of the requirements for a Section 1(b) multiple-class application and how to satisfy the requirements online using the Trademark Electronic Application System (TEAS) form, please go to <http://www.uspto.gov/trademarks/law/multiclass.jsp>.

Fees For Additional Classes

The fee for adding classes to a TEAS Reduced Fee (RF) application is \$275 per class. See 37 C.F.R. §§2.6(a)(1)(iii), 2.23(a). See [more information](#) regarding the requirements for maintaining the lower TEAS RF fee and, if these requirements are not satisfied, for adding classes at a higher fee using regular TEAS.

RESPONSE GUIDELINES

If applicant has questions regarding this Office action, please telephone or e-mail the assigned trademark examining attorney. All relevant e-mail communications will be placed in the official application record; however, an e-mail communication will not be accepted as a response to this Office action and will not extend the deadline for filing a proper response. See 37 C.F.R. §2.191; TMEP §§709.04-.05. Further, although the trademark examining attorney may provide additional explanation pertaining to the refusal and/or requirements in this Office action, the trademark examining attorney may not provide legal advice or statements about applicant's rights. See TMEP §§705.02, 709.06.

TEAS PLUS OR TEAS REDUCED FEE (TEAS RF) APPLICANTS – TO MAINTAIN LOWER FEE, ADDITIONAL REQUIREMENTS MUST BE MET, INCLUDING SUBMITTING DOCUMENTS ONLINE: Applicants who filed their application online using the lower-fee TEAS Plus or TEAS RF application form must (1) file certain documents online using TEAS, including responses to Office actions (see TMEP §§819.02(b), 820.02(b) for a complete list of these documents); (2) maintain a valid e-mail correspondence address; and (3) agree to receive correspondence from the USPTO by e-mail throughout the prosecution of the application. See 37 C.F.R. §§2.22(b), 2.23(b); TMEP §§819, 820. TEAS Plus or TEAS RF applicants who do not meet these requirements must submit an additional processing fee of \$125 per class of goods and/or services. 37 C.F.R. §§2.6(a)(1)(v), 2.22(c), 2.23(c); TMEP §§819.04, 820.04. However, in certain situations, TEAS Plus or TEAS RF applicants may respond to an Office action by authorizing an examiner's amendment by telephone or e-mail without incurring this additional fee.

/Marco Wright/
Trademark Examining Attorney
Law Office 120
(571) 272-4918
marco.wright@uspto.gov

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>.

Exhibit D

Trademark/Service Mark Application, Principal Register

TEAS Plus Application

Serial Number: 86861193

Filing Date: 12/29/2015

*NOTE: Data fields with the * are mandatory under TEAS Plus. The wording "(if applicable)" appears where the field is only mandatory under the facts of the particular application.*

The table below presents the data as entered.

Input Field	Entered
TEAS Plus	YES
MARK INFORMATION	
*MARK	ESSENTIAL
*STANDARD CHARACTERS	YES
USPTO-GENERATED IMAGE	YES
LITERAL ELEMENT	ESSENTIAL
*MARK STATEMENT	The mark consists of standard characters, without claim to any particular font, style, size, or color.
REGISTER	Principal
APPLICANT INFORMATION	
*OWNER OF MARK	SPIGEN, INC.
*STREET	9975 Toledo Way #100
*CITY	Irvine
*STATE (Required for U.S. applicants)	California
*COUNTRY	United States
*ZIP/POSTAL CODE (Required for U.S. applicants)	92618
LEGAL ENTITY INFORMATION	
*TYPE	CORPORATION
* STATE/COUNTRY OF INCORPORATION	California
GOODS AND/OR SERVICES AND BASIS INFORMATION	
*INTERNATIONAL CLASS	009
	Cameras; Computer application software for mobile phones, portable media players, handheld computers , namely, software for use in database management, use in electronic storage of data ; Computer software for communicating with users of hand-held computers; Computer software for controlling the operation of audio and video devices; Portable

*IDENTIFICATION	and handheld digital electronic devices for recording, organizing, transmitting, manipulating, and reviewing text, data, image, and audio files; Wireless communication device featuring voice, data and image transmission including voice, text and picture messaging, a video and still image camera, also functional to purchase music, games, video and software applications over the air for downloading to the device; Wireless communication devices for transmitting images taken by a camera; Wireless communication devices for voice, data or image transmission; Digital cameras; Electric control devices for home automation ; Home and office electrical power automation systems comprising wireless and wired controllers, controlled devices, and software for appliances, lighting, HVAC, security and other home and office electrical power monitoring and control applications; Motion picture cameras; Motion-activated cameras; Multiple purpose cameras; Video cameras; Wearable digital electronic devices comprised primarily of software for viewing, sending and receiving texts, emails, data and information from smart phones, tablet computers and portable computers and display screens and also featuring a wristwatch
*FILING BASIS	SECTION 1(b)
ADDITIONAL STATEMENTS INFORMATION	
*TRANSLATION (if applicable)	
*TRANSLITERATION (if applicable)	
*CLAIMED PRIOR REGISTRATION (if applicable)	
*CONSENT (NAME/LIKENESS) (if applicable)	
*CONCURRENT USE CLAIM (if applicable)	
ATTORNEY INFORMATION	
NAME	Heedong Chae
ATTORNEY DOCKET NUMBER	7108TM81
FIRM NAME	East West Law Group
STREET	3600 Wilshire Blvd Suite., 702
CITY	Los Angeles
STATE	California
COUNTRY	United States
ZIP/POSTAL CODE	90010
PHONE	213-387-3630
FAX	2137883365
EMAIL ADDRESS	trademark@ewpat.com
AUTHORIZED TO COMMUNICATE VIA EMAIL	Yes
CORRESPONDENCE INFORMATION	
*NAME	Heedong Chae

FIRM NAME	East West Law Group
*STREET	3600 Wilshire Blvd Suite., 702
*CITY	Los Angeles
*STATE (Required for U.S. addresses)	California
*COUNTRY	United States
*ZIP/POSTAL CODE	90010
PHONE	213-387-3630
FAX	2137883365
*EMAIL ADDRESS	trademark@ewpat.com;trademark@ewpat.com; iplaw.advocate@gmail.com
*AUTHORIZED TO COMMUNICATE VIA EMAIL	Yes
FEE INFORMATION	
APPLICATION FILING OPTION	TEAS Plus
NUMBER OF CLASSES	1
FEE PER CLASS	225
*TOTAL FEE PAID	225
SIGNATURE INFORMATION	
* SIGNATURE	/hc/
* SIGNATORY'S NAME	Heedong Chae
* SIGNATORY'S POSITION	Attorney of Record, CA bar member
* DATE SIGNED	12/29/2015

Trademark/Service Mark Application, Principal Register

TEAS Plus Application

Serial Number: 86861193

Filing Date: 12/29/2015

To the Commissioner for Trademarks:

MARK: ESSENTIAL (Standard Characters, see [mark](#))

The literal element of the mark consists of ESSENTIAL.

The mark consists of standard characters, without claim to any particular font, style, size, or color.

The applicant, SPIGEN, INC., a corporation of California, having an address of
9975 Toledo Way #100
Irvine, California 92618
United States

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:

For specific filing basis information for each item, you must view the display within the Input Table.

International Class 009: Cameras; Computer application software for mobile phones, portable media players, handheld computers, namely, software for use in database management, use in electronic storage of data; Computer software for communicating with users of hand-held computers; Computer software for controlling the operation of audio and video devices; Portable and handheld digital electronic devices for recording, organizing, transmitting, manipulating, and reviewing text, data, image, and audio files; Wireless communication device featuring voice, data and image transmission including voice, text and picture messaging, a video and still image camera, also functional to purchase music, games, video and software applications over the air for downloading to the device; Wireless communication devices for transmitting images taken by a camera; Wireless communication devices for voice, data or image transmission; Digital cameras; Electric control devices for home automation; Home and office electrical power automation systems comprising wireless and wired controllers, controlled devices, and software for appliances, lighting, HVAC, security and other home and office electrical power monitoring and control applications; Motion picture cameras; Motion-activated cameras; Multiple purpose cameras; Video cameras; Wearable digital electronic devices comprised primarily of software for viewing, sending and receiving texts, emails, data and information from smart phones, tablet computers and portable computers and display screens and also featuring a wristwatch

Intent to Use: The applicant has a bona fide intention, and is entitled, to use the mark in commerce on or in connection with the identified goods/services. (15 U.S.C. Section 1051(b)).

The applicant's current Attorney Information:

Heedong Chae of East West Law Group 3600 Wilshire Blvd Suite., 702
Los Angeles, California 90010
United States
213-387-3630(phone)
2137883365(fax)
trademark@ewpat.com (authorized)

The attorney docket/reference number is 7108TM81.

The applicant's current Correspondence Information:

Heedong Chae
East West Law Group
3600 Wilshire Blvd Suite., 702
Los Angeles, California 90010
213-387-3630(phone)
2137883365(fax)
trademark@ewpat.com;trademark@ewpat.com;iplaw.advocate@gmail.com (authorized)

E-mail Authorization: I authorize the USPTO to send e-mail correspondence concerning the application to the applicant or applicant's attorney at the e-mail address provided above. I understand that a valid e-mail address must be maintained and that the applicant or the applicant's attorney must file the relevant subsequent application-related submissions via the Trademark Electronic Application System (TEAS). Failure to do so will result in an additional processing fee of \$50 per international class of goods/services.

A fee payment in the amount of \$225 has been submitted with the application, representing payment for 1 class(es).

Declaration

The signatory believes that: if the applicant is filing the application under 15 U.S.C. § 1051(a), the applicant is the owner of the trademark/service mark sought to be registered; the applicant is using the mark in commerce on or in connection with the goods/services in the application; the specimen(s) shows the mark as used on or in connection with the goods/services in the application; and/or if the applicant filed an application under 15 U.S.C. § 1051(b), § 1126(d), and/or § 1126(e), the applicant has a bona fide intention, and is entitled, to use the mark in commerce on or in connection with the goods/services in the application. The signatory believes that to the best of the signatory's knowledge and belief, no other persons, except, if applicable, concurrent users, have the right to use the mark in commerce, either in the identical form or in such near resemblance as to be likely, when used on or in connection with the goods/services of such other persons, to cause confusion or mistake, or to deceive. The signatory being warned that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. § 1001, and that such willful false statements and the like may jeopardize the validity of the application or any registration resulting therefrom, declares that all statements made of his/her own knowledge are true and all statements made on information and belief are believed to be true.

Signature: /hc/ Date Signed: 12/29/2015

Signatory's Name: Heedong Chae

Signatory's Position: Attorney of Record, CA bar member

RAM Sale Number: 86861193

RAM Accounting Date: 12/30/2015

Serial Number: 86861193

Internet Transmission Date: Tue Dec 29 21:07:43 EST 2015

TEAS Stamp: USPTO/FTK-XXX.XXX.XX.XXX-201512292107439

60807-86861193-550dbe7f5e07d542923cc8bc2

2fecf3864f96342df9475c166a4897f7871dcc66

7e-CC-6150-20151229194008856474

ESSENTIAL