

**To:** Jennifer L. Lefere([trademark@weissbrown.com](mailto:trademark@weissbrown.com))  
**Subject:** U.S. Trademark Application Serial No. 97120904 - M+ - 3849.0001  
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**Attachments**

[3833899](#)  
[3833900](#)  
[6599789](#)

**United States Patent and Trademark Office (USPTO)  
Office Action (Official Letter) About Applicant's Trademark Application**

**U.S. Application Serial No.** 97120904

**Mark:** M+

**Correspondence Address:**

JENNIFER L. LEFERE  
WEISS BROWN, PLLC  
6263 N. SCOTTSDALE RD. STE. 340  
SCOTTSDALE AZ 85250 UNITED STATES

**Applicant:** Mediteo GmbH

**Reference/Docket No.** 3849.0001

**Correspondence Email Address:** [trademark@weissbrown.com](mailto:trademark@weissbrown.com)

**NONFINAL OFFICE ACTION**

**The USPTO must receive applicant's response to this letter within six months of the issue date below or the application will be abandoned.** Respond using the Trademark Electronic Application System (TEAS). A link to the appropriate TEAS response form appears at the end of this Office action.

**Issue date:** August 24, 2022

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

2.65(a); TMEP §§711, 718.03.

## SEARCH OF USPTO DATABASE OF MARKS

The trademark examining attorney has searched the USPTO database of registered and pending marks and has found no conflicting marks that would bar registration under Trademark Act Section 2(d). 15 U.S.C. §1052(d); TMEP §704.02.

## SUMMARY OF ISSUES:

- Section 2(d) Refusal – Likelihood Of Confusion (Partial Refusal)
- Identification of Goods and Services - Amendment Required (Partial Requirement)
- Multiple-Class Application Requirements
- Mark Description - Amendment Required

## SECTION 2(d) REFUSAL – LIKELIHOOD OF CONFUSION (PARTIAL REFUSAL)

*THIS PARTIAL REFUSAL APPLIES TO CLASS(ES) 9, 38, 41 and 42 ONLY*

Registration of the applied-for mark is refused because of a likelihood of confusion with the mark(s) in U.S. Registration No(s). 3833899, 3833900 and 6599789. Trademark Act Section 2(d), 15 U.S.C. §1052(d); *see* TMEP §§1207.01 *et seq.* See the attached registration(s).

Trademark Act Section 2(d) bars registration of an applied-for mark that is so similar to a registered mark that it is likely consumers would be confused, mistaken, or deceived as to the commercial source of the goods and/or services of the parties. *See* 15 U.S.C. §1052(d). Likelihood of confusion is determined 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) (called the “*du Pont* factors”). *In re i.am.symbolic, llc*, 866 F.3d 1315, 1322, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017). Any evidence of record related to those factors need be considered; however, “not all of the *DuPont* factors are relevant or of similar weight in every case.” *In re Guild Mortg. Co.*, 912 F.3d 1376, 1379, 129 USPQ2d 1160, 1162 (Fed. Cir. 2019) (quoting *In re Dixie Rests., Inc.*, 105 F.3d 1405, 1406, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997)).

Although not all *du Pont* factors may be relevant, there are generally two key considerations in any likelihood of confusion analysis: (1) the similarities between the compared marks and (2) the relatedness of the compared goods and/or services. *See 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)); *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 1103, 192 USPQ 24, 29 (C.C.P.A. 1976) (“The fundamental inquiry mandated by [Section] 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods [or services] and differences in the marks.”); TMEP §1207.01.

## COMPARISON OF MARKS

The applied-for mark is **M+** in a stylized form.

The registered marks are:

1. U.S. Reg. No. 3833899, **M+** in a standard character form;
2. U.S. Reg. No. 3833900, **M+ MANAGERPLUS** in a stylized form;
3. U.S. Reg. No. 6599789, **M+** in a stylized form & design.

Registered marks U.S. Registration No(s). 3833899 and 3833900 are owned by the same registrant.

Marks are compared in their entirety 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 Inn at St. John’s, LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018) (citing *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014)), *aff’d per curiam*, 777 F. App’x 516, 2019 BL 343921 (Fed. Cir. 2019); TMEP §1207.01(b).

When comparing marks, “[t]he proper test is not a side-by-side comparison of the marks, but instead whether the marks are sufficiently similar in terms of their commercial impression such that [consumers] who encounter the marks would be likely to assume a connection between the parties.” *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 1373, 127 USPQ2d 1797, 1801 (Fed. Cir. 2018) (quoting *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1368, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012)); TMEP §1207.01(b). The proper focus is on the recollection of the average purchaser, who retains a general rather than specific impression of trademarks. *In re Inn at St. John’s, LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018) (citing *In re St. Helena Hosp.*, 774 F.3d 747, 750-51, 113 USPQ2d 1082, 1085 (Fed. Cir. 2014); *Geigy Chem. Corp. v. Atlas Chem. Indus., Inc.*, 438 F.2d 1005, 1007, 169 USPQ 39, 40 (C.C.P.A. 1971)), *aff’d per curiam*, 777 F. App’x 516, 2019 BL 343921 (Fed. Cir. 2019); TMEP §1207.01(b).

In this case, the compared marks are similar in sound, appearance and commercial impression. The compared marks share the identical terms **M+**. Marks may be confusingly similar in appearance where similar terms or phrases or similar parts of terms or phrases appear in the compared marks and create a similar overall commercial impression. *See Crocker Nat’l Bank v. Canadian Imperial Bank of Commerce*, 228 USPQ 689, 690-91 (TTAB 1986), *aff’d sub nom. Canadian Imperial Bank of Commerce v. Wells Fargo Bank, Nat’l Ass’n*, 811 F.2d 1490, 1495, 1 USPQ2d 1813, 1817 (Fed. Cir. 1987) (finding COMMCASH and COMMUNICASH confusingly similar); *In re Corning Glass Works*, 229 USPQ 65, 66 (TTAB 1985) (finding CONFIRM and CONFIRMCELLS confusingly similar); *In re Pellerin Milnor Corp.*, 221 USPQ 558, 560 (TTAB 1983) (finding MILTRON and MILLTRONICS confusingly similar); TMEP §1207.01(b)(ii)-(iii). Consumers could view the applicant’s mark as merely a variation of the registrant’s mark and reasonably assume that the applicant’s goods/services are a new or additional line of goods/services from the same source as the goods/services provided under the registered marks.

The applied-for mark and the registered marks U.S. Registration No(s). 3833899 and 6599789 are essentially phonetic equivalents and thus sound similar. Similarity in sound alone may be sufficient to support a finding that the compared marks are confusingly similar. *In re 1st USA Realty Profls, Inc.*, 84 USPQ2d 1581, 1586 (TTAB 2007) (citing *Krim-Ko Corp. v. Coca-Cola Bottling Co.*, 390 F.2d 728, 732, 156 USPQ 523, 526 (C.C.P.A. 1968)); TMEP §1207.01(b)(iv).

The additional wording U.S. Reg. No. 3833900 in the registered marks does not obviate the similarity because the first terms are **M+**, on which consumers are more likely to focus on. Consumers are

generally more inclined to focus on the first word, prefix, or syllable in any trademark or service mark. *See Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 1372, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005) (finding similarity between VEUVE ROYALE and two VEUVE CLICQUOT marks in part because “VEUVE . . . remains a ‘prominent feature’ as the first word in the mark and the first word to appear on the label”); *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 876, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992) (finding similarity between CENTURY 21 and CENTURY LIFE OF AMERICA in part because “consumers must first notice th[e] identical lead word”); *see also In re Detroit Athletic Co.*, 903 F.3d 1297, 1303, 128 USPQ2d 1047, 1049 (Fed. Cir. 2018) (finding “the identity of the marks’ two initial words is particularly significant because consumers typically notice those words first”). Thus, this wording is less significant in terms of affecting the mark’s commercial impression, and renders the wording **M+** the more dominant element of the mark.

Although applicant’s mark does not contain the entirety of the registered mark U.S. Reg. No. 3833900, 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 USPQ 707, 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(s) because it contains some of the wording in the registered mark(s) and does not add any wording that would distinguish it from the registered mark(s).

In addition, the applied-for mark is entirely incorporated in the registered mark(s) U.S. Reg. No. 3833900. Incorporating the entirety of one mark within another does not obviate the similarity between the compared marks, as in the present case, nor does it overcome a likelihood of confusion under Section 2(d). *See Wella Corp. v. Cal. Concept Corp.*, 558 F.2d 1019, 1022, 194 USPQ 419, 422 (C.C.P.A. 1977) (finding CALIFORNIA CONCEPT and surfer design and CONCEPT confusingly similar); *Coca-Cola Bottling Co. v. Jos. E. Seagram & Sons, Inc.*, 526 F.2d 556, 557, 188 USPQ 105, 106 (C.C.P.A. 1975) (finding BENGAL LANCER and design and BENGAL confusingly similar); *In re Integrated Embedded*, 120 USPQ2d 1504, 1513 (TTAB 2016) (finding BARR GROUP and BARR confusingly similar); *In re Mr. Recipe, LLC*, 118 USPQ2d 1084, 1090 (TTAB 2016) (finding JAWS DEVOUR YOUR HUNGER and JAWS confusingly similar); TMEP §1207.01(b)(iii). In the present case, the marks are identical in part.

When evaluating a composite mark consisting of words and a design, the word portion is normally accorded greater weight because it is likely to make a greater impression upon purchasers, be remembered by them, and be used by them to refer to or request the goods and/or services. *In re Aquitaine Wine USA, LLC*, 126 USPQ2d 1181, 1184 (TTAB 2018) (citing *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (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, even where the word portion has been disclaimed. *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)).

A mark in typed or standard characters, as the registered mark U.S. Reg. No. 3833899 here, may be displayed in any lettering style; the rights reside in the wording or other literal element and not in any particular display or rendition. *See In re Viterra Inc.*, 671 F.3d 1358, 1363, 101

USPQ2d 1905, 1909 (Fed. Cir. 2012); *In re Mighty Leaf Tea*, 601 F.3d 1342, 1348, 94 USPQ2d 1257, 1260 (Fed. Cir. 2010); 37 C.F.R. §2.52(a); TMEP §1207.01(c)(iii). Thus, a mark presented in stylized characters and/or with a design element generally will not avoid likelihood of confusion with a mark in typed or standard characters because the word portion could be presented in the same manner of display. See, e.g., *In re Viterra Inc.*, 671 F.3d at 1363, 101 USPQ2d at 1909; *Squirtco v. Tomy Corp.*, 697 F.2d 1038, 1041, 216 USPQ 937, 939 (Fed. Cir. 1983) (stating that “the argument concerning a difference in type style is not viable where one party asserts rights in no particular display”). In this case, the registered mark may appear in the marketplace in any lettering style, including of the applied-for mark’s style.

Consumers are likely to perceive applicant’s **M+** as being affiliated with or originating from the same enterprise as goods sold and/or services provided under the registered mark(s) **M+** and **M+ MANAGERPLUS**. Therefore, the marks are confusingly similar.

Generally, the greater degree of similarity between the applied-for mark and the registered mark, the lesser the degree of similarity between the goods and/or services 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).

## COMPARISON OF GOODS/SERVICES

The applicant’s goods and/or services are identified as:

- *“Phototelegraphy apparatus; Video telephones; Integrated circuit chips; Compact discs (audio-video); Computers; Computer operating programs; Computer screens; Peripherals adapted for use with computers; Computer programs (downloadable software); Computer software (recorded); Computer keyboards; Data carriers, included in class 9, computer programs and data collections recorded on the aforesaid data carriers; Data processing apparatus; Digital picture frames; Floppy discs; Floppy discs drives (for computers); Printers for computers; Electronic pens (visual display units); Cinematographic apparatus; Cameras; Interfaces (for computers); Computers; Readers (data processing equipment); Magnetic tape units (for computers); Magnetic tapes; Cell phones; Computer hardware monitors; Monitors (computer programs); Notebook computers; Optical data carriers; Optical disc; Disc exchangers (for computers); X-ray apparatus not for medical purposes; X-ray photographs, not for medical purposes; Roentgen films, exposed; Radiology screens for industrial purposes; Scanners; Memories for data processing equipment; telecopying apparatus; Word processing apparatus; Central processing units for data processing equipment”* in International Class 9;
- *“Providing access to computer programs on data networks; Providing access to and transmission of information and providing access to online data services and information on the Internet; Transmission of electronic mail; Transmission of electronic mail; Electronic exchange of messages via chat lines, chatrooms and Internet forums; Computer aided transmission of messages and images; Radio calls (paging); News agencies; Telecommunications; Providing wireless telecommunications connections to global computer networks and other communications networks; Web messaging; Data-protected transmission of programs and information for the acquisition and management of a database accessible via online computer networks; Transmission of messages and data via wireless digital networks”* in International Class 38;
- *“Layout services, other than for advertising purposes; Microfilming; Online publication of electronic books and periodicals; Arranging and conducting of conferences; Arranging and conducting of seminars; Providing computer, electronic and online databases for educational,*

*recreational and amusement use in the field of entertainment and in the fields of secondary, collegiate, social and community interest groups; Entertainment services for sharing audio and video recordings; Publication of electronic journals and web logs, featuring user generated or specified content” in International Class 41;*

*- “Updating of computer software; Computer hardware and software consultancy; Telecommunications engineering consultancy; Software design for others; Computer programming; Medical laboratory services; Digital image processing (graphic design); Computer animation; Computer programming; Scientific reports; Technical research; Creating and maintaining web sites for others; Implementation of computer programs on networks; Configuring computer networks by means of software; Construction drafting; Conversion of computer programs and data (other than physical alteration); Conversion of data or documents from physical to electronic media; Duplicating computer programs; Maintenance and installation of software; research in databases and on the Internet for science and research; Research and development of new products for others; Social science consultancy; Provision of technical consultancy; Conducting technical project studies; Hosting computer sites (websites); Rental of computers and computer software; Rental of data processing equipment; Rental of web servers; Maintenance of software; Recovery of computer data; Computer services, namely, creating virtual communities for registered users to organize groups and events, participate in discussions, and engage in social, business and community networking” in International Class 42.*

The registrant’s goods and/or services are identified as:

1. U.S. Reg. No. 3833899, *“Computer software for business asset management relating to maintenance, depreciation, repair history, identification, inventory, condition, valuation, tracking, location, ownership history, and wear-and-tear of physical assets and cost analysis related thereto; computer software for asset management, namely, retail inventory management; computer software for asset management, namely, customer management, namely, providing a summarized view of customer account information, purchase history and contact information; computer software for asset management, namely, employee management, scheduling and time record keeping” in International Class 9;*
2. U.S. Reg. No. 3833900, *“Computer software for business asset management relating to maintenance, depreciation, repair history, identification, inventory, condition, valuation, tracking, location, ownership history, and wear-and-tear of physical assets and cost analysis related thereto; computer software for asset management, namely, retail inventory management; computer software for asset management, namely, customer management, namely, providing a summarized view of customer account information, purchase history and contact information; computer software for asset management, namely, employee management, scheduling and time record keeping” in International Class 9;*
3. U.S. Reg. No. 6599789, *"Video disks and videotapes with recorded animated cartoons; computer game programs; cameras; electronic tags for goods; camcorders; television apparatus for projection purposes" in International Class 9, "Television broadcasting; transmission of messages; cellular telephone communication; communications by computer terminals; computer aided transmission of messages and images; transmission of electronic mail; telecommunication; electronic bulletin board services; providing telecommunication channels for teleshopping services; providing internet chat rooms" in International Class 38, "Photography services; digital imaging services, as photography; providing online computer games; providing non-downloadable online video recordings; providing online music listening service; entertainment services, namely, planning, organizing and conducting a series of film screening events; film production other than advertising; TV show production; videotape*

*editing; organization of educational and entertainment competitions, namely, arranging competitions concerning education and entertainment for photography competitions; arranging of beauty contests; publishing of on-line electronic publications; information online relating to computer games and computer enhancements for games; game room services; infotainment provided via electronic and digital interactive media, namely, information in the field of television programs, films" in International Class 41, and "Planning and layout design services, other than for advertising purposes for special events; research and development services of new products for others; packaging design; designing, creating, maintaining and hosting electronic websites for others; providing search engines for the Internet; duplication of computer programs; computer system design; providing information on computer technology and programming via a web site; consultancy in the design and development of computer hardware; off-site data backup; electronic data storage; computer services, namely, integration of private and public cloud computing environments" in International Class 42.*

The goods and/or services are compared to determine whether they are similar, commercially related, or travel in the same trade channels. *See Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1369-71, 101 USPQ2d 1713, 1722-23 (Fed. Cir. 2012); *Herbko Int'l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1165, 64 USPQ2d 1375, 1381 (Fed. Cir. 2002); TMEP §§1207.01, 1207.01(a)(vi).

The compared goods and/or 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).

When analyzing an applicant’s and registrant’s goods and/or services for similarity and relatedness, that determination is based on the description of the goods and/or services 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)).

#### A. Similarity of goods/services with U.S. Reg. No(s). 3833899, 3833900

In this case, the application use(s) broad wording to describe “**Computer programs (downloadable software); Computer software (recorded); Computer keyboards**”, which presumably encompasses all goods and/or services of the type described, including registrant(s)’s more narrow “**Computer software for business asset management relating to maintenance, depreciation, repair history, identification, inventory, condition, valuation, tracking, location, ownership history, and wear-and-tear of physical assets and cost analysis related thereto; computer software for asset management, namely, retail inventory management; computer software for asset management, namely, customer management, namely, providing a summarized view of customer account information, purchase history and contact information; computer software for asset management, namely, employee management, scheduling and time record keeping**”. *See, e.g., In re Solid State Design Inc.*, 125 USPQ2d 1409, 1412-15 (TTAB 2018); *Sw. Mgmt., Inc. v. Ocinomled, Ltd.*, 115 USPQ2d 1007, 1025 (TTAB 2015). Thus, applicant’s and registrant’s goods are legally identical. *See, e.g., In re i.am.symbolic, llc*, 127 USPQ2d 1627, 1629 (TTAB 2018) (citing *Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp., Inc.*, 648

F.2d 1335, 1336, 209 USPQ 986, 988 (C.C.P.A. 1981); *Inter IKEA Sys. B.V. v. Akea, LLC*, 110 USPQ2d 1734, 1745 (TTAB 2014); *Baseball Am. Inc. v. Powerplay Sports Ltd.*, 71 USPQ2d 1844, 1847 n.9 (TTAB 2004)).

B. Similarity of goods/services with U.S. Reg. No. 6599789

In this case, the goods and/or services in the application and registration(s) identified as "**Computer aided transmission of messages and images**" are identical. Therefore, it is presumed that the channels of trade and class(es) of purchasers are the same for these goods and/or services. *See Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 1372, 127 USPQ2d 1797, 1801 (Fed. Cir. 2018) (quoting *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012)).

In this case, the application use(s) broad wording to describe "**computer programs (downloadable software)**", "**Computer hardware and software consultancy . . . Creating and maintaining web sites for others . . . Duplicating computer programs . . . Research and development of new products for others . . . Hosting computer sites (websites)**", which presumably encompasses all goods and/or services of the type described, including registrant(s)'s more narrow "**computer game programs**", "**creating, maintaining and hosting electronic websites for others. . . research and development services of new products for others . . . duplication of computer programs . . . consultancy in the design and development of computer hardware**". Likewise, the registration use(s) broad wording to describe "**transmission of messages. . . transmission of electronic mail; telecommunication . . . providing internet chat rooms**", "**providing non-downloadable online video recordings . . . publishing of on-line electronic publications**", which presumably encompasses all goods and/or services of the type described, including applicant(s)'s more narrow "**Transmission of electronic mail; Electronic exchange of messages via . . . chatrooms . . . Telecommunications; Transmission of messages and data via wireless digital networks**", "**Online publication of electronic books and periodicals . . . Entertainment services for sharing audio and video recordings**". *See, e.g., In re Solid State Design Inc.*, 125 USPQ2d 1409, 1412-15 (TTAB 2018); *Sw. Mgmt., Inc. v. Ocinomled, Ltd.*, 115 USPQ2d 1007, 1025 (TTAB 2015). Thus, applicant's and registrant's goods are legally identical. *See, e.g., In re i.am.symbolic, llc*, 127 USPQ2d 1627, 1629 (TTAB 2018) (citing *Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp., Inc.*, 648 F.2d 1335, 1336, 209 USPQ 986, 988 (C.C.P.A. 1981); *Inter IKEA Sys. B.V. v. Akea, LLC*, 110 USPQ2d 1734, 1745 (TTAB 2014); *Baseball Am. Inc. v. Powerplay Sports Ltd.*, 71 USPQ2d 1844, 1847 n.9 (TTAB 2004)).

Additionally, the goods and/or services of the parties have no restrictions as to nature, type, channels of trade, or classes of purchasers and are "presumed to 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)).

Thus, 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).

Where the goods and/or 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/or 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).



## SUMMARY

The overriding concern is not only to prevent buyer confusion as to the source of the goods and/or services, but to protect the registrant from adverse commercial impact due to use of a similar mark by a newcomer. *See In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993). Therefore, any doubt regarding a likelihood of confusion determination is resolved in favor of the registrant. TMEP §1207.01(d)(i); *see Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1265, 62 USPQ2d 1001, 1003 (Fed. Cir. 2002); *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 464-65, 6 USPQ2d 1025, 1026 (Fed. Cir. 1988).

In summary, the applicant's and registrant's marks create the same commercial impression and the respective goods and/or services are commercially related. Therefore, consumers are likely to be confused and mistakenly believe that these goods and/or services originate from a common source. Accordingly, registration must be refused under Section 2(d) of the Trademark Act.

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

### **IDENTIFICATION OF GOODS AND SERVICES - AMENDMENT REQUIRED (PARTIAL REQUIREMENT)**

#### *THIS PARTIAL REQUIREMENT APPLIES ONLY TO THE GOODS AND SERVICES SPECIFIED THEREIN*

Particular wording in the U.S. application's identification of goods and/or services has been found to exceed the scope of the goods and/or services in the foreign registration upon which the U.S. application relies. *See* 37 C.F.R. §2.32(a)(6); TMEP §§1402.06 *et seq.*, 1402.07. For a U.S. application based on Trademark Act Section 44(e), an applicant is required to list only goods and/or services that are within the scope of the goods and/or services in the foreign registration. 37 C.F.R. §2.32(a)(6); TMEP §§1012, 1402.01(b). Therefore, this wording is not considered part of the identification of goods and/or services in the U.S. application, and only the remaining wording in the identification is operative for purposes of future amendment. *See* TMEP §1402.01(b); *cf.* TMEP §1402.07(d).

In this case, the U.S. application identifies the particular goods and/or services as follows: "*Computer operating programs*" and

"*Entertainment services for sharing audio and video recordings.*" However, the foreign registration identifies the following goods and/or services: "*Computer operating programs [recorded]*" and "*Photosharing and video sharing services.*"

These goods and/or services in the U.S. application exceed the scope of the goods and/or services in the foreign registration because the goods do not include the limiting wording "[recorded]" and services include "*sharing audio . . . recordings*" instead of "*photosharing*". Thus, these goods and/or services in the U.S. application are not acceptable.

Applicant may respond to this issue by satisfying one of the following:

- (1) Limiting the identification of goods and/or services in the U.S. application to

correspond to the goods and/or services in the foreign registration and not exceeding the scope of the initial or acceptably amended identification in the U.S. application, and/or deleting from the U.S. application all goods and/or services beyond the scope of the foreign registration; or

(2) Substituting a basis under Section 1(a) or 1(b) for those goods and/or services in the U.S. application that are beyond the scope of the foreign registration. An applicant may assert more than one basis in an application (except Section 1(a) and 1(b) may not be asserted for the same goods and/or services), provided all requirements are satisfied for each claimed basis.

*See* 15 U.S.C. §§1051(a)-(b), 1126; 37 C.F.R. §§2.32(a)(6), 2.34(b), 2.35(b); *Marmark Ltd. v. Nutrexpa S.A.*, 12 USPQ2d 1843, 1845 (TTAB 1989); TMEP §§806.02, 806.03(h), 1402.01(b).

Additionally, applicant may respond by arguing that these goods and/or services are within the scope of the foreign registration and should remain in the U.S. application.

Applicant must clarify the wording "*telecommunications*" in the identification of goods and/or services in International Class(es) 38 because it is indefinite and too broad. *See* 37 C.F.R. §2.32(a)(6); TMEP §§1402.01, 1402.03. This wording is indefinite because it does not make sufficiently clear what type of services encompassed, e.g., telecommunications consultation, telecommunication access services, digital network telecommunications services, telecommunications gateway services, etc. Further, this wording could identify goods and/or services in more than one international class. For example, telecommunications consultation are in International Class 38 and telecommunications technology consultancy are in International Class 42.

The identification for *computer programs* in International Class 9 is indefinite and too broad and must be clarified to specify whether the format is downloadable, recorded, or online non-downloadable. *See* 37 C.F.R. §2.32(a)(6); TMEP §§1402.03(d), 1402.11(a). Downloadable and recorded goods are in International Class 9, whereas providing their temporary, online non-downloadable use is a service in International Class 42. *See* TMEP §1402.03(d).

Applicant must clarify the wording "*entertainment services for sharing video recordings*" in the identification of services in International Class 41, "*computer hardware . . . consultancy*", "*social science consultancy*", "*provision of technical consultancy*" in International Class 42, "*rehabilitation centres*", "*dental services*" in International Class 44 because it is indefinite and too broad. *See* 37 C.F.R. §2.32(a)(6); TMEP §§1402.01, 1402.03. This wording is indefinite because it does not make clear what the specific services are. Further, this wording could identify services in more than one international class. For example, the wording "*entertainment services for sharing video recordings*" may encompass video-on-demand transmission services in International Class 38, providing non-downloadable films via video-on-demand transmission services in International Class 41, and providing a web site featuring temporary use of non-downloadable software allowing web site users to upload, post and display online videos for sharing with others for entertainment purposes in International Class 42.

The identification for *computer programs/software* in International Class 9 is indefinite and must be clarified to specify the purpose or function of the software and its content or field of use, if content- or field- specific. *See* 37 C.F.R. §2.32(a)(6); TMEP §§1402.03(d), 1402.11(a). The USPTO requires such specificity in order for a trademark examining attorney to examine the application properly and make appropriate decisions concerning possible conflicts between the applicant's mark and other marks. *See*

*In re N.A.D. Inc.*, 57 USPQ2d 1872, 1874 (TTAB 2000); TMEP §1402.03(d).

The wording *"integrated circuit chips"*, *"compact discs (audio-video)"*, *"data carriers, included in class 9, computer programs and data collections recorded on the aforesaid data carriers"*, *"digital picture frames"*, *"floppy discs"*, *"printers for computers"*, *"cinematographic apparatus"*, *"magnetic tapes"*, *"monitors (computer programs)"*, *"optical data carriers"*, *"optical disc"*, *"disc exchangers (for computers)"*, *"roentgen films, exposed"*, *"radiology screens for industrial purposes"*, *"providing access to computer programs on data networks"*, *"providing access to and transmission of information and providing access to online data services and information on the Internet"*, *"electronic exchange of messages via chat lines, chatrooms and Internet forums"*, *"news agencies"*, *"providing wireless telecommunications connections to global computer networks and other communications networks"*, *"transmission of messages and data via wireless digital networks"*, *"arranging and conducting of conferences; arranging and conducting of seminars"*, *"providing computer, electronic and online databases for educational, recreational and amusement use in the field of entertainment and in the fields of secondary, collegiate, social and community interest groups"*, *"publication of electronic journals and web logs, featuring user generated or specified content"*, *"digital image processing (graphic design)"*, *"computer animation"*, *"scientific reports; technical research"*, *"implementation of computer programs on networks; configuring computer networks by means of software"*, *"maintenance and installation of software"*, *"research in databases and on the Internet for science and research"*, *"out-patient services"*, *"aromatherapy"*, *"pharmacy advice"*, *"public baths; hospices"*, *"services of medical institutions for hospital care"*, *"hospitals"*, *"sanitary services . . . and sanatoriums"*, *"medical and clinical examinations"*, *"conducting technical project studies"*, *"maintenance of software"*, *"computer services, namely, creating virtual communities for registered users to organize groups and events, participate in discussions, and engage in social, business and community networking"* in the identification of goods/services is indefinite and must be clarified because it does not sufficiently identify the specific type, function or purpose of goods/services encompassed. See 37 C.F.R. §2.32(a)(6); TMEP §1402.01. For example, it is unclear whether the wording *"compact discs (audio-video)"* encompasses blank compact discs or compact discs featuring music, etc. Similarly, the wording *"floppy discs"* is indefinite because descriptions of floppy computer discs must indicate that the goods are blank, if accurate, and descriptions of recorded floppy computer discs must indicate the function of the recorded software programs.

The identification of goods and/or services contains parentheses and brackets. Generally, an applicant should *not* use parentheses and brackets, including curly brackets, in identifications in order to avoid confusion with the USPTO's practice of using parentheses and brackets in registrations to indicate (1) goods and/or services that have been deleted from registrations, (2) goods and/or services not claimed in an affidavit of incontestability, or (3) guidance to users of the USPTO's [U.S. Acceptable Identification of Goods and Services Manual](#) to draft an acceptable identification. See TMEP §§1402.04, 1402.12. The only exception for including parenthetical information in identifications is 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 or scope of the identification, e.g., "fried tofu pieces (abura-age)." See TMEP §1402.12. Therefore, applicant must remove the parentheses and brackets from the identification and incorporate any parenthetical or bracketed information into the description of the goods and/or services.

Applicant is advised to delete or modify the duplicate entry in the identification of goods in International Class 9 for *"computers"* and services in International Class 38 for *"transmission of electronic mail"* and International Class 42 for *"computer programming"*. See generally TMEP §§1402.01, 1402.01(a). If applicant does not respond to this issue, be advised that the USPTO will

remove duplicate entries from the identification prior to registration. If modifying one of the duplicate entries, applicant may amend it to clarify or limit the goods and/or services, but not to broaden or expand the goods and/or services beyond those in the original application or as acceptably amended. *See* 37 C.F.R. §2.71(a); TMEP §1402.06. Also, generally, any deleted goods and/or services may not later be reinserted. TMEP §1402.07(e).

Applicant may substitute the following wording, if accurate:

Class 9: Phototelegraphy apparatus; Video telephones; Integrated circuit chips **for {identify use or purpose, e.g., digital video compression and decompression, encoding and decoding digital video}**; Compact discs **for** audio-video, **namely, {identify type of goods, e.g., blank compact discs, compact discs featuring {indicate subject matter, e.g., music, poetry}}**; Computers; **Recorded** computer operating programs; Computer screens; Peripherals adapted for use with computers; Downloadable computer software programs **for {specify the function of the programs, e.g., use in database management, use in electronic storage of data, etc.}**; Recorded computer software **for {specify the function of the programs, e.g., use in database management, use in electronic storage of data, etc.}**; Computer keyboards; Data carriers, included in class 9, **namely, {identify type of goods, e.g., prerecorded magnetic data carriers featuring {indicate subject matter}, blank magnetic data carriers, blank optical data carriers} and recorded** computer programs **featuring** data collections recorded on the aforesaid data carriers, **sold as a unit**; Data processing apparatus; Digital picture frames, **namely, {identify type of goods, e.g., digital photo frames for displaying {indicate what is being displayed, e.g., digital pictures, video clips, etc.}}**; Floppy discs, **namely, {identify type of goods, e.g., blank floppy computer discs, recorded floppy computer discs for {identify the function of the recorded software programs, e.g., use in database management, use in electronic storage of data, etc.}}**; Floppy discs drives for computers; Printers for computers **for {identify the purpose, e.g., printing documents, printing photos}**; Electronic pens **for** visual display units; Cinematographic apparatus, **namely, {identify type of goods, e.g., cinematographic machines and apparatus, apparatus for editing cinematographic film, sound recording apparatus and instruments}**; Cameras; Interfaces for computers; Readers as data processing equipment, **namely, {identify type of goods, e.g., smart card readers, secure digital (SD) card readers, optical disk readers}**; Magnetic tape units for computers; Magnetic tapes, **namely, {identify type of goods, e.g., blank magnetic computer tapes, blank magnetic tapes for tape recorders}**; Cell phones; Computer hardware monitors; Monitors **for** computer programs, **namely, {identify type of goods, e.g., computer monitors, touchscreen monitors, tablet monitors, digital signage monitors}**; Notebook computers; **Blank** optical data carriers; Optical disc, **namely, {identify type of goods, e.g., blank optical discs, optical discs featuring {indicate content or subject matter}}**; Disc exchangers for computers, **namely, {identify type of goods, e.g., telecommunication exchangers}**; X-ray apparatus not for medical purposes; X-ray photographs, not for medical purposes; Roentgen films, **namely, exposed camera film**; Radiology screens for industrial purposes **in the nature of {identify type of goods, e.g., X-ray apparatus not for medical purposes}**; Scanners; Memories for data processing equipment; telecopying apparatus; Word processing apparatus; Central processing units for data processing equipment

**Class 35:** Social science consultancy, **namely, {identify services in Class 35, e.g., providing economic consultation in the field of {specify field, e.g., energy}, public policy consultancy in the field of {specify field, e.g., economics}}**; Provision of technical consultancy, **namely, {identify services in Class 35, e.g., technical consulting in the field of marketing}**

**Class 37:** Computer hardware consultancy, **namely, consultancy relating to the installation,**

**maintenance and repair of computer hardware; Provision of technical consultancy, namely, {identify services in Class 37, e.g., technical consulting in the field of artificial intelligence (AI) hardware customization}**

Class 38: Providing **user** access to computer programs on data networks; Providing **multi-user** access to **{identify type of access to information, e.g., proprietary collections of information by means of global computer information networks, information on the internet concerning the development and generation of computer software for use in businesses as well as the functions and application of such business software}** and transmission of information **via telecommunications networks** and providing access to online data services and information on the Internet, **namely, {identify specific services, e.g., providing access to the Internet, providing multiple user wireless access to the Internet}**; Transmission of electronic mail; Electronic exchange of messages via chat lines, chatrooms and Internet forums, **namely, {identify specific services, e.g., electronic message transmission, electronic messaging, providing virtual chat rooms established via text messaging, providing on-line chat rooms for transmission of messages among computer users concerning {indicate field or subject of chat room}, providing on-line forums for transmission of messages among computer users}**; Computer aided transmission of messages and images; Radio-paging; News agencies **services for electronic transmission**; Telecommunications, **namely, {identify specific services in Class 42, e.g., telecommunications consultation, telecommunication access services, digital network telecommunications services}**; Providing wireless telecommunications connections to global computer networks and other communications networks, **namely, {identify specific services in Class 42, e.g., wireless telephony and wireless broadband communications services for the transmission of voice and data, providing internet access via broadband optical or wireless networks}**; Web messaging; Data-protected transmission of programs and information for the acquisition and management of a database accessible via online computer networks, **namely, {identify specific services in Class 42, e.g., encrypted electronic transmission and delivery of recovered data, transmission of information by data communications for assisting decision making, electronic transmission of facsimile communications and data featuring encryption and decryption, providing electronic transmission of information stored in a database via interactively communicating computer systems, transmission of database information via telecommunications networks}**; Electronic transmission of messages and data via wireless digital networks; Entertainment services for sharing video recordings, **namely, {identify services in Class 38, e.g., peer-to-peer video sharing services, namely, electronic transmission of video recordings among computers, video-on-demand transmission services}**

**Class 40: Provision of technical consultancy, namely, {identify services in Class 40, e.g., technical consultation in the field of production of solar energy}; dental services, namely, {identify services in Class 40, e.g., dental technician services}**

Class 41: Layout services, other than for advertising purposes; Microfilming; Online publication of electronic books and periodicals; Arranging and conducting of conferences **in the field of {indicate, e.g., telecommunications technology, science, social studies}**; Arranging and conducting of seminars **in the field of {indicate, e.g., telecommunications technology, science, social studies}**; Providing computer, electronic and online databases for educational, recreational and amusement use in the field of entertainment and in the fields of secondary, collegiate, social and community interest groups, **namely, {identify specific subject matter in Class 41, e.g., providing an online interactive database of photos and videos in the field of body art and modification, providing an on-line computer database in the field of virtual vehicle customization for hobby or entertainment purposes, providing an on-line computer database featuring information regarding exercise and**

fitness, providing a searchable database, focusing on prehistory to the present, featuring bibliographical records, full text journals, reference books, periodical articles, primary source documents, monographs, biographies, images, and abstracts in English of articles published in more than forty languages, related to all aspects of American and Canadian history}; Entertainment services for sharing video recordings, namely, {identify services in Class 41, e.g., providing films, not downloadable, via video-on-demand transmission services, providing on-line videos featuring {indicate subject matter e.g., music, mathematics instruction, etc.}, not downloadable}; Publication of electronic journals and web logs, featuring user generated or specified content, namely, on-line journals, namely, blogs featuring {indicate field or subject matter, e.g., telecommunications technology, science, social studies}; Provision of technical consultancy, namely, {identify services in Class 41, e.g., technical consulting in the field of cybersecurity risk management training}

Class 42: Updating of computer software; Computer software consultancy; Computer hardware and software consultancy, namely, {identify specific services in Class 42, e.g., consulting services in the fields of selection, implementation and use of computer hardware and software systems for others, consulting services in the field of design, selection, implementation and use of computer hardware and software systems for others, consulting in the field of configuration management for computer hardware and software, consultancy in the design and development of computer hardware}; Telecommunications engineering consultancy; Software design for others; Computer programming; Medical laboratory services; graphic design, namely, digital image processing in the nature of {identify specific services encompassed, e.g., digital image correction, restoration and enhancement of {specify media, e.g., videos, photos, etc.}, digital formatting and compression of music and video images into downloadable media}; Computer animation, namely, computer graphics design services in the nature of creating of animations; Scientific reports, namely, {identify specific services in Class 42, e.g., providing scientific information in the field of {indicate field or subject matter, e.g., genetics, pharmaceuticals and clinical trials}, providing information on the subject of scientific research in the field of biochemistry and biotechnology}; Technical research in the field of {indicate field or subject matter, e.g., pharmaceutical studies}; Creating and maintaining web sites for others; Implementation of computer programs on networks, namely, {identify specific services encompassed, e.g., design, development and implementation of software, preparation, update, installation and maintenance of computer software}; Configuring computer networks for others by means of software; Construction drafting; Conversion of computer programs and data, other than physical alteration; Conversion of data or documents from physical to electronic media; Duplicating computer programs; Maintenance and installation of {specify type of software, e.g., computer, Internet access, mobile phone} software; research in databases and on the Internet for science and research, namely, {identify services in Class 42. e.g., compiling data for research purposes in the field of medical science and medical consultancy}; Research and development of new products for others; Social science consultancy, namely, {identify specific services in Class 42, e.g., technical consultancy in the field of environmental science}; Provision of technical consultancy, namely, {identify specific services in Class 42, e.g., technical consulting in the field of pharmaceutical studies}; Conducting technical project studies, namely, {identify specific services in Class 42, e.g., technical research in the field of pharmaceutical studies}; Hosting computer websites; Rental of computers and computer software; Rental of data processing equipment; Rental of web servers; Maintenance of {specify type of software, e.g., computer, Internet access, mobile phone} software; Recovery of computer data; Computer services, namely, creating online communities for registered users to organize groups and events, participate in discussions, and engage in social, business and community networking; Telecommunications, namely, {identify specific services in Class 42, e.g., telecommunications technology consultancy, telecommunication

**network security consultancy, telecommunications engineering consultancy**}; Entertainment services for sharing video recordings, **namely, providing a web site featuring temporary use of non-downloadable software allowing web site users to upload, post and display online videos for sharing with others for entertainment purposes**}; dental services, **namely, {identify services in Class 42, e.g., dental research laboratory services}**

Class 44: Out-patient **{identify specific services, e.g., care, health care}** services; Aromatherapy services; Pharmaceutical advice; Public baths, **namely, {identify specific services, e.g., public bath services for hygiene purposes, providing public bath facilities}**; Hospices services; Blood bank services; Services of medical institutions for hospital care, **namely, hospital services**; Medical assistance; Chiropractics; Hospital services; Rehabilitation centres, **namely, {identify specific services, e.g., providing physical rehabilitation facilities, providing mental rehabilitation facilities}**, sanitary services, **namely, {identify specific services, e.g., operation of public baths for sanitary purposes, rental of sanitary installations}**, dental **{identify specific services, e.g., hygienist, care, imaging}** services and sanatorium services; Medical and clinical examinations, **namely, medical examination services**; Massage; Hygienic and beauty care for human beings or animals; Medical services; Telemedicine services

#### **Class 45: Rehabilitation centres, namely, providing spiritual rehabilitation services**

Applicant's goods and/or services may be clarified or limited, but may not be expanded beyond those originally itemized in the U.S. 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 in or encompassed by those in the original U.S. 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). Additionally, for U.S. applications filed under Trademark Act Section 44(e), the scope of the identification for purposes of permissible amendments may not exceed the scope of the goods and/or services identified in the foreign registration. 37 C.F.R. §2.32(a)(6); *Marmark, Ltd. v. Nutrexp, S.A.*, 12 USPQ2d 1843, 1845 (TTAB 1989) (citing *In re Löwenbräu München*, 175 USPQ 178, 181 (TTAB 1972)); TMEP §§1012, 1402.01(b).

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.

### **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 44:

- (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 fee(s) already paid (view the [USPTO's current fee schedule](#)). The application identifies goods and/or services that are classified in at least EIGHT classes; however, applicant submitted a fee(s) sufficient for only FIVE class(es). 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* 37 C.F.R. §2.86(a); TMEP §§1403.01, 1403.02(c).

For an overview of the requirements for a Section 44 multiple-class application and how to satisfy the requirements online using the Trademark Electronic Application System (TEAS) form, see the [Multiple-class Application webpage](#).

## **MARK DESCRIPTION - AMENDMENT REQUIRED**

When an applicant submits a drawing showing the mark in color, applicant's color claim and description must reference all the colors in the mark, including black, white and/or gray. TMEP §807.07(d); *see* 37 C.F.R. §§2.37, 2.52(b)(1). If black, white and/or gray are not a color feature of the mark, applicant must provide a statement in the description that black, white and/or gray represent background, outlining, shading and/or transparent areas and are not part of the mark. TMEP §807.07(d).

The following format is suggested:

Color claim: **"The colors blue, light blue and white are claimed as a feature of the mark."**

Description: **"The mark consists of the stylized dark blue and white capsule overlapping a larger stylized light blue and white capsule in the shape of a checkmark at the center of a square with rounded edges representing a numberless clock face with blue dashes in place of numbers. All other instances of the color white represent background, outlining, shading, and/or transparent areas and are not part of the mark."**

*See* 37 C.F.R. §2.61(b); TMEP §§807.07(d) *et seq.*

## **RESPONSE GUIDELINES**

Please call or email the assigned trademark examining attorney with questions about this Office action. Although an examining attorney cannot provide legal advice, the examining attorney can provide additional explanation about the refusal(s) and/or requirement(s) in this Office action. *See* TMEP §§705.02, 709.06.

The USPTO does not accept emails as responses to Office actions; however, emails can be used for informal communications and are included in the application record. *See* 37 C.F.R. §§2.62(c), 2.191; TMEP §§304.01-.02, 709.04-.05.

**How to respond.** [Click to file a response to this nonfinal Office action.](#)



/Maryna Gipsov/  
Maryna Gipsov  
(571) 270-7630  
maryna.gipsov@uspto.gov

## RESPONSE GUIDANCE

- **Missing the response deadline to this letter will cause the application to [abandon](#).** The response must be received by the USPTO before midnight **Eastern Time** of the last day of the response period. TEAS maintenance or [unforeseen circumstances](#) could affect an applicant's ability to timely respond.
- **[Responses signed by an unauthorized party](#)** are not accepted and can **cause the application to [abandon](#)**. If applicant does not have an attorney, the response must be signed by the individual applicant, all joint applicants, or someone with [legal authority to bind a juristic applicant](#). If applicant has an attorney, the response must be signed by the attorney.
- If needed, **find [contact information for the supervisor](#)** of the office or unit listed in the signature block.

(4) STANDARD CHARACTER MARK

M+

**Mark Punctuated**

M+

**Translation**

**Goods/Services**

- IC 009. US 021 023 026 036 038.G & S: Computer software for business asset management relating to maintenance, depreciation, repair history, identification, inventory, condition, valuation, tracking, location, ownership history, and wear-and-tear of physical assets and cost analysis related thereto; computer software for asset management, namely, retail inventory management; computer software for asset management, namely, customer management, namely, providing a summarized view of customer account information, purchase history and contact information; computer software for asset management, namely, employee management, scheduling and time record keeping. FIRST USE: 20041100. FIRST USE IN COMMERCE: 20041100

**Mark Drawing Code**

(4) STANDARD CHARACTER MARK

**Design Code**

**Serial Number**

77810613

**Filing Date**

20090821

**Current Filing Basis**

1A

**Original Filing Basis**

1A

**Publication for Opposition Date**

20100601

**Registration Number**

3833899

**Date Registered**

20100817

**Owner**

(REGISTRANT) Qquest Asset Management Services, LLC LIMITED LIABILITY COMPANY UTAH 9350 South 150 East, Suite 300 Sandy UTAH 84070 (LAST LISTED OWNER) MANAGERPLUS SOLUTIONS, LP LIMITED PARTNERSHIP DELAWARE 9350 SOUTH 150 EAST, SUITE 650 SANDY UTAH 84070

**Priority Date**

**Disclaimer Statement**

**Description of Mark**

**Type of Mark**  
TRADEMARK

**Register**  
PRINCIPAL

**Live Dead Indicator**  
LIVE

**Attorney of Record**  
James D. Petruzzi

(3) DESIGN PLUS WORDS, LETTERS, AND/OR NUMBERS



**Mark Punctuated**

M+ MANAGERPLUS

**Translation**

**Goods/Services**

- IC 009. US 021 023 026 036 038.G & S: Computer software for business asset management relating to maintenance, depreciation, repair history, identification, inventory, condition, valuation, tracking, location, ownership history, and wear-and-tear of physical assets and cost analysis related thereto; computer software for asset management, namely, retail inventory management; computer software for asset management, namely, customer management, namely, providing a summarized view of customer account information, purchase history and contact information; computer software for asset management, namely, employee management, scheduling and time record keeping. FIRST USE: 20041100. FIRST USE IN COMMERCE: 20041100

**Mark Drawing Code**

(3) DESIGN PLUS WORDS, LETTERS, AND/OR NUMBERS

**Design Code**

241706

**Serial Number**

77810615

**Filing Date**

20090821

**Current Filing Basis**

1A

**Original Filing Basis**

1A

**Publication for Opposition Date**

20100601

**Registration Number**

3833900

**Date Registered**

20100817

**Owner**

(REGISTRANT) Qquest Asset Management Services, LLC LIMITED LIABILITY COMPANY UTAH 9350 South 150 East, Suite 300 Sandy UTAH 84070 (LAST LISTED OWNER) MANAGERPLUS SOLUTIONS,

LP LIMITED PARTNERSHIP DELAWARE 9350 SOUTH 150 EAST, SUITE 650 SANDY UTAH 84070

**Priority Date**

**Disclaimer Statement**

**Description of Mark**

Color is not claimed as a feature of the mark. The mark consists of a stylized "M" with a "+" symbol above the stylized words "ManagerPlus".

**Type of Mark**

TRADEMARK

**Register**

PRINCIPAL

**Live Dead Indicator**

LIVE

**Attorney of Record**

James D. Petruzzi

**(3) DESIGN PLUS WORDS, LETTERS, AND/OR NUMBERS**



**Mark Punctuated**

M+

**Translation**

**Goods/Services**

- IC 009. US 021 023 026 036 038.G & S: Video disks and videotapes with recorded animated cartoons; computer game programs; cameras; electronic tags for goods; camcorders; television apparatus for projection purposes
- IC 035. US 100 101 102.G & S: Advertising; outdoor advertising; on-line advertising on a computer network; modelling for advertising or sales promotion; radio advertising; production of radio commercials and presentations for others; rental of advertising time on communication media; television advertising; advertisement plan, namely, preparation and realization of advertising plans and concepts; advertising agency services; marketing, advertising and promoting the retail goods and services of others through wireless electronic devices; rental of advertising space; dissemination of advertising matter
- IC 038. US 100 101 104.G & S: Television broadcasting; transmission of messages; cellular telephone communication; communications by computer terminals; computer aided transmission of messages and images; transmission of electronic mail; telecommunication; electronic bulletin board services; providing telecommunication channels for teleshopping services; providing internet chat rooms
- IC 040. US 100 103 106.G & S: Photo typesetting services provided via the Internet; photocomposing services; photographic printing; bookbinding; paper treating; photographic film development; processing of cinematographic films; framing of works of art; printing
- IC 041. US 100 101 107.G & S: Photography services; digital imaging services, as photography; providing online computer games; providing non-downloadable online video recordings; providing online music listening service; entertainment services, namely, planning, organizing and conducting a series of film screening events; film production other than advertising; TV show production; videotape editing; organization of educational and entertainment competitions, namely, arranging competitions concerning education and entertainment for photography competitions; arranging of beauty contests; publishing of on-line electronic publications; providing information online relating to computer games and computer enhancements for games; game room services; infotainment provided via electronic and digital interactive media, namely, information in the field of television programs, films
- IC 042. US 100 101.G & S: Planning and layout design services, other than for advertising purposes for special events; research and development services of new products for others; packaging design; designing, creating, maintaining and hosting electronic websites for others; providing search engines for the Internet; duplication of computer programs; computer system design; providing information on computer technology and programming via a web site; consultancy in the design and development of computer hardware; off-site data backup; electronic data storage; computer services, namely, integration

of private and public cloud computing environments

**Mark Drawing Code**

(3) DESIGN PLUS WORDS, LETTERS, AND/OR NUMBERS

**Design Code**

250325 260921

**Serial Number**

87060069

**Filing Date**

20160603

**Current Filing Basis**

44E

**Original Filing Basis**

1B

**Publication for Opposition Date**

20211012

**Registration Number**

6599789

**Date Registered**

20211228

**Owner**

(REGISTRANT) Meitu (China) Limited private company limited by shares (prc) HONG KONG 75B, Sun Tower, The Arch 1 Austin Road West Kowloon HONG KONG

**Priority Date**

**Disclaimer Statement**

**Description of Mark**

The color(s) pink, purple, orange and white is/are claimed as a feature of the mark. The mark consists of the stylized Letter "M" with a plus design to the right. "M+" is in white, with a background of pink, purple and orange colors.

**Type of Mark**

TRADEMARK. SERVICE MARK

**Register**

PRINCIPAL

**Live Dead Indicator**

LIVE

**Attorney of Record**

John Alumit

## United States Patent and Trademark Office (USPTO)

### USPTO OFFICIAL NOTICE

Office Action (Official Letter) has issued  
on August 24, 2022 for  
**U.S. Trademark Application Serial No. 97120904**

A USPTO examining attorney has reviewed your trademark application and issued an Office action. You must respond to this Office action in order to avoid your application abandoning. Follow the steps below.

- (1) **[Read the Office action](#)**. This email is NOT the Office action.
- (2) **Respond to the Office action by the deadline** using the Trademark Electronic Application System (TEAS). Your response must be received by the USPTO on or before 11:59 p.m. **Eastern Time** of the last day of the response period. Otherwise, your application will be **[abandoned](#)**. See the Office action itself regarding how to respond.
- (3) **Direct general questions** about using USPTO electronic forms, the USPTO **[website](#)**, the application process, the status of your application, and whether there are outstanding deadlines to the **[Trademark Assistance Center \(TAC\)](#)**.

After reading the Office action, address any question(s) regarding the specific content to the USPTO examining attorney identified in the Office action.

### GENERAL GUIDANCE

- **[Check the status](#) of your application periodically** in the **[Trademark Status & Document Retrieval \(TSDR\)](#)** database to avoid missing critical deadlines.
- **[Update your correspondence email address](#)** to ensure you receive important USPTO notices about your application.
- **[Beware of trademark-related scams](#)**. Protect yourself from people and companies that may try to take financial advantage of you. Private companies may call you and pretend to be the USPTO or may send you communications that resemble official USPTO documents to trick you. We will never request your credit card number or social security number over the phone. And all official USPTO correspondence will only be emailed from the domain “@uspto.gov.” Verify the correspondence originated from us by using your Serial Number in our database, **[TSDR](#)**, to confirm that it appears under the “Documents” tab, or contact the **[Trademark Assistance Center](#)**.



- **Hiring a U.S.-licensed attorney.** If you do not have an attorney and are not required to have one under the trademark rules, we encourage you to hire a U.S.-licensed attorney specializing in trademark law to help guide you through the registration process. The USPTO examining attorney is not your attorney and cannot give you legal advice, but rather works for and represents the USPTO in trademark matters.

User: Maryna Gipsov

Statistics for Case 97120904						
#	Search	Total Marks	Dead Marks	Live Viewed Docs	Live Viewed Images	Status/Search Duration
1	97120904[sn]	1	0	0	0	0:00
2	"M +"[bi,ti] not dead[ld]	11	0	11	11	0:00

Session started 08/24/2022 10:33 pm

Session ended 08/24/2022 10:33 pm

Total search duration 0.00

Session duration 33 seconds

Adjacency Level 1

Near Level 1

User: Maryna Gipsov

Statistics for Case 97120904						
#	Search	Total Marks	Dead Marks	Live Viewed Docs	Live Viewed Images	Status/Search Duration
1	97120904[sn]	1	0	0	0	0:00
2	"M+"[bi,ti] not dead[ld]	27	0	27	27	0:01

Session started 08/24/2022 10:32 pm

Session ended 08/24/2022 10:33 pm

Total search duration 1.00

Session duration 1 minutes 3 seconds

Adjacency Level 1

Near Level 1

User: Maryna Gipsov

Statistics for Case 97120904						
#	Search	Total Marks	Dead Marks	Live Viewed Docs	Live Viewed Images	Status/Search Duration
1	97120904[sn]	1	0	1	1	0:00
2	"Mediteo GmbH"[on]	3	0	3	3	0:00
3	"m"[bi,ti] not dead[ld]	17117	0	0	0	0:01
4	43[dm] not dead[ld]	11542	0	0	0	0:01
5	3 and 4	136	0	97	136	0:01
6	5 and ("009" "037")[cc]	95	0	95	95	0:00
7	5 and ("009" a b "200")[ic]	26	0	26	26	0:00
8	5 and ("037" a b "200")[ic]	10	0	10	10	0:00
9	5 and ("038" a b "200")[ic]	4	0	4	4	0:00
10	5 and ("041" a b "200")[ic]	15	0	15	15	0:00
11	5 and ("042" a b "200")[ic]	25	0	25	25	0:00
12	5 and ("044" a b "200")[ic]	10	0	10	10	0:00
13	3 and ("009" "037")[cc]	10394	0	0	0	0:00
14	3 and ("009" "037" "038" "041" "044" "035" "042" a b "200")[ic]	7784	0	0	0	0:01
15	3 and ("009" "037" "038" "041" "044" "042" a b "200")[ic]	6325	0	0	0	0:01
16	"m"[fm] not dead[ld]	3166	0	0	0	0:01
17	16 and ("009" "037" "038" "041" "044" "042" a b "200")[ic]	1408	0	0	0	0:01

Session started 08/24/2022 12:42 pm

Session ended 08/24/2022 1:30 pm

Total search duration 7.00

Session duration 47 minutes 57 seconds

Adjacency Level 1

Near Level 1