Applicant: Microsoft Corporation
Serial No.: 85/953,440
Mark: BING
Class: 9
Examiner: Michael J. Souders (L.O. 115)
Office Action Date: August 22, 2013

RESPONSE TO OFFICE ACTION

This document responds to the Office Action issued August 22, 2013 ("**Office Action**")

regarding the application by Microsoft Corporation ("**Applicant**") for registration of the mark

BING ("**Mark**") in Class 9 ("**Application**"). The Examining Attorney ("**Examiner**") has

initially refused the registration of the Mark on the following grounds: (i) that the description of

goods in the Application is indefinite and (ii) likelihood of confusion with the mark BING, U.S.

Registration No. 4,054,407 under Section 2(d) of the Lanham Act. Applicant addresses each of

these issues below and respectfully requests that the Examiner withdraw the refusals and approve

the Application for publication on the Principal Register.

I.   DISCUSSION

A.   Applicant's Goods, as Amended, are Definite, Specific, and Clear.

Applicant hereby amends its application to modify the identification as follows (deleted

language shown in ~~strikethrough~~ and added language shown in **<u>underlined bold</u>**):

> Computer software **<u>for computers, mobile phones, computer tablets, and other
> personal electronic devices, namely for use in accessing, monitoring, tracking,
> searching, saving, and sharing information in the fields of health, fitness, food,
> beverages, wine, spirits, travel, entertainment, weather, news, sports, maps, and
> finance</u>**; search engine software; ~~mobile device software;~~ graphical user interface
> software; voice-recognition software; computer software for the development of
> computer software applications

The Examiner initially refused the Application in part on grounds that the description of goods is

indefinite. Applicant discussed this issue with the Examiner by phone on February 20, 2014, and

based on that discussion Applicant believes that the amended identification of goods above

clarifies the original identification, does not expand or add different goods to the original

identification, and should be acceptable. 37 C.F.R. § 2.71(a); T.M.E.P. § 1402.06.

B.   Confusion Between Applicant's Mark and the Cited Mark Is Unlikely.

The Examiner has also initially refused to register the Mark under Section 2(d) due to an

alleged likelihood of confusion with the mark BING, U.S. Registration No. 4054407,

("**Registrant's Mark**") registered in Class 9 by Terabyte, Inc. ("**Registrant**") for the following

goods ("**Registrant's Goods**"):

> Computer software for management of system boot and startup parameters and
> environment; Downloadable computer software for management of system boot and
> startup parameters and environment.

Specifically, the Examiner indicates in the Office Action that the reason for the refusal is

(i) the similarity of the respective marks, and (ii) that Applicant's goods could encompass goods

identical to those of the registrant.

When evaluating likelihood of confusion, a number of factors, when of record, must be

considered. *In re E. I. Du Pont de Nemours & Co.*, 476 F.2d 1357, 177 U.S.P.Q. 563 (C.C.P.A.

1973). Indeed, as the Office Action implies, two key important factors are the similarities

between the marks and the similarities between the goods and/or services. *See, e.g., Federated*

Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 U.S.P.Q. 24 (C.C.P.A 1976) *and In*

re Dixie Restaurants Inc., 105 F.3d 1405, 41 U.S.P.Q.2d 1531 (Fed. Cir. 1997). That said,

identical marks may coexist on the Registry as long as the goods or services in question are

sufficiently different to avoid a likelihood of confusion. *See Hi-Country Foods Corp. v. Hi*

Country Beef Jerky, 4 U.S.P.Q.2d 1169, 1171 (T.T.A.B. 1987) (HI-COUNTRY for beef jerky

not confusingly similar to HI-COUNTRY for fruit juices, even though both are edible food

products); *In re Mars, Inc.*, 222 U.S.P.Q. 938 (Fed. Cir. 1984) (Use of CANYON for fresh citrus

fruits and candy bars not likely to cause confusion); *In re British Bulldog, Ltd.*, 224 U.S.P.Q. 854 (T.T.A.B. 1984) (no confusion between PLAYERS, for men's underwear, and PLAYERS, for shoes). Applicant's Goods, as amended in Section A *supra* ("**Applicant's Goods**"), and Registrant's Goods are at least as different and unrelated from each other as the goods in these cases.

Applicant's Goods are software for use by the general public to access and use information of general interest like weather, maps, and sports, and associated tools, *e.g.*, voice recognition software. Registrant's Goods, *i.e.*, system boot, startup parameters, and environment-management software, are used to control the startup processes of a computer, that is, the loading of the computer's operating system onto the machine. For computers that have been configured to run more than one operating system, this type of software can be used to manage the storage of those operating environments on the machine and manage the computer's ability to transition between them [the operating systems]. Excerpts from Wikipedia, Webopedia, and Registrant's websites describing system boot processes and system boot technology, as well as Registrant's specimen of use for Registrant's Mark obtained from the Trademark Office's records describing Registrant's Goods, are attached hereto as **Exhibits A-D**.

Applicant's Goods do not control or manage computer startup processes. In other words, Applicant's Goods do not provide any of the functionality of Registrant's Goods. Applicant's Goods are not competitive to Registrant's Goods. Applicant's Goods do not relate to Registrant's Goods in any way. Accordingly, consumer confusion between the parties' marks is unlikely, and Applicant respectfully requests that the Examiner withdraw the refusal with respect to Section 2(d) and allow the Application to proceed to publication.

II.   CONCLUSION

Based upon the foregoing, Applicant submits that it has addressed each of the issues raised in the Office Action and respectfully requests that the Mark be allowed to proceed to

publication. If there are any remaining concerns with respect to this Application, please contact

the Applicant.