

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Microsoft Corporation

Serial No.: 87/732,781



Mark: FM

Classes: 14, 16, 18, 25, 28, 38, and 41

Office Action Date: February 2, 2018

Examiner: Ira Goodsaid (L.O. 101)

**RESPONSE TO
OFFICE ACTION**

This response ("Response") to the Office Action issued February 2, 2018 ("Office Action") regarding the application by Microsoft Corporation ("Applicant") for registration of the mark FM Design Mark ("Mark") in Classes 14, 16, 18, 25, 28, 38, and 41 ("Application") addresses the issues raised by the Examining Attorney ("Examiner"), namely, a request for clarifications regarding the description of goods and services covered by the Application ("Goods and Services"). Based on the response below, Applicant respectfully requests that the Examiner approve the Application for publication on the Principal Register.

I. AMENDMENTS

Applicant amends the Goods and Services in the Application as follows (added language shown underlined and deleted language ~~struck through~~ or [[in brackets]]).

Class 16: Children's coloring and composition books[[,]]; ~~art~~ books about art, e-sports and video games[[,]]; novels[[,]]; strategy guide books for video games ~~game guides~~[[,]]; notebooks[[,]]; journals[[,]]; posters[[,]]; calendars[[,]]; comic books[[,]]; art prints

Class 18: Wallets[[,]]; sports and travelling bags[[,]]; backpacks[[,]]; messenger bags

Class 25: Clothing, namely, jackets, pants, shorts, sweaters, sweatshirts, hoodies, jerseys, shirts, t-shirts, long-sleeve t-shirts, sleepwear, pajamas, footwear, socks, belts, headwear, headbands, wristbands, rainwear, scarves, beachwear

Class 28: Toy cars[,]; video game controllers[,]; play sets for action figures

Class 38: Streaming of video game competitions via a global computer network;
streaming of video games via a global computer network

The goods in Class 14 and services in Class 41 remain as submitted without amendment.

Applicant believes that the amendments above should be acceptable because they clarify the original identification, do not expand or add different goods or services to the original identification, and conform in large part to the Examiner's original suggestions. 37 C.F.R. § 2.71(a); T.M.E.P. § 1402.06.

II. DISCUSSION

The Examiner has requested amendments to the Application to clarify the Goods and Services. In response, Applicant has amended the Goods and Services to conform in large part with the Examiner's suggested amendments. Applicant's Amendments are acceptable under the Trademark Manual of Examining Procedure because each identification includes definite, accurately described goods using the common names and terminology appropriate for Applicant's line of business. Further, the amendments clarify the description contained in the Application, and do not expand nor add different Goods and Services. Accordingly, Applicant believes that the amendments above should be acceptable and that the description of Goods and Services as amended is sufficiently specific, definite, and clear. *See* 37 C.F.R. § 2.71(a); T.M.E.P. § 1402.01, 1402.06.

With regard to the Examiner's request to amend the goods "video game controllers" and the services "Organizing e-sports competitions; organizing video game competitions" in Class 41, Applicant respectfully submits that no amendment is necessary since these goods and services are sufficiently specific, definite and clear as submitted.

First, with regard to the goods “video game controllers”, this description has been accepted by the USPTO in numerous recently-issued registrations, including U.S. Registration Nos. 5415761 (Design Mark), 5415749 (STUDIO ISTOLIA), 5352230 (Design Mark), 5338334 (Design Mark) and 5298339 (JOY-CON). The TESS records for these registrations are attached as **Exhibit A**.

Second, the amendments proposed by the Examiner for the services “Organizing e-sports competitions; organizing video game competitions”--namely, “Organizing e-sports ~~competitions; organizing~~ video game competitions”--is unnecessary and arguably narrows the scope of services to the organizing of competitions relating to *both* e-sports *and* video games. For these reasons, Applicant submits that the Goods and Services as amended are acceptable.

III. 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 Attorney of Record.