

XERO
US Serial No. 79223002
Office Action Response

Applicant Xero Limited (“Applicant”) files this Response to the Office Action dated January 9, 2018 (the “Office Action”). The Office Action partially refused Application Serial Number 79223002 (the “Application”) for the mark XERO (“Applicant’s Mark”). The partial refusal only applies to the goods in International Classes 9, 16, 25, and 35.

The partial refusal is based on a perceived a likelihood of consumer confusion between Applicant’s Mark and the marks in U.S. Registration Nos. 1743930, 3919444, 4269015, 4537089. The Examining Attorney also cites potential conflicts with pending U.S. Application Serial Nos. 86310983, 87112062 and 87074811. Applicant notes that U.S. Application Serial No. 86310983 has gone abandoned and is therefore no longer a potential conflict.

Applicant disagrees with the refusal and respectfully requests that Applicant’s Mark be approved for publication. Applicant’s Mark is not likely to be confused with the cited marks because the differences between the relevant goods and services are more than sufficient to prevent confusion among consumers.

SECTION 2(d) REFUSAL – LIKELIHOOD OF CONFUSION

Likelihood-of-confusion analysis is guided by a number of factors set forth in *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). Relevant factors include, among others, the variety of goods on which a mark is used or not used.

The Examining Attorney contends that the relevant goods and services are related. In response, Applicant makes the following amendments to the identification of goods and services:

Class 9: Computers; computer keyboards; rechargeable batteries; power banks **being battery chargers for mobile phones and portable electronic devices**; computer software and hardware **in the fields of accounting, management and reporting for accountants, tax management, financial and annual reporting, documentation, online training, and subscription management**; computer peripherals; mobile phones and related parts and accessories, **namely, cell phone backplates, cell phone covers, cell phone cases, carrying cases for cell phones**; headphones; sleeves for laptops; earbuds; calculators; lanyards **pecially adapted** for cameras; lanyards **pecially adapted** for mobile phones; lanyards **pecially adapted** for holding spectacles; eyeglass lanyards

Class 16: ~~Paper and cardboard;~~ **Printed matter, namely, photographs, magazines, books, printed periodicals, newsletters, brochures in the fields of accounting, management and reporting for accountants, tax management, financial and annual reporting, documentation, online training, and subscription management;** stationery; notebooks; notebook paper; **books in the fields of for accounting, management and reporting for accountants, tax management, financial and annual reporting, documentation, online training, and subscription management;** calendars; clipboards; ink; pens; correction pens; cases for pens; pencils; stickers; decals; laptop decals; 3D decals for use on any surface; stickers **being** {stationery}; sticker books; desktop business card holders; ~~brochures; printed brochures~~

Class 18: Backpacks; bags, **namely, bags for computers;** leather bags; messenger bags; shoulder bags; tote bags; cross-body bags; satchels; ~~luggage tags;~~ umbrellas; wallets; card wallets; credit card cases **being** {wallets}; ~~suitcases; umbrellas~~

Class 21: ~~Household or kitchen utensils;~~ **Household** containers; **beverage** glassware; cups; coffee cups; mugs; drinking cups; glass drinking cup; bottles, **sold empty;** aluminum bottles, **sold empty;** wall plaques made of acrylic

Class 25: ~~Clothing, namely, shirts, tops, dresses, skirts, pants, shorts, sweaters, hooded sweatshirts, hoodies [clothing], jumpers, jackets, coats, gloves;~~ clothing for babies, **namely, babies' trousers, bottoms, pants, dresses, skirts, tops, shirts, jackets, sweaters, hooded sweatshirts, jumpers, coats, bodysuits, hats, cloth bibs;** footwear; headgear; caps **being** [headwear]; tops **being** ~~clothing;~~ Pyjamas

Class 35: ~~Retail and wholesale services;~~ **Incentive award programs to promote the sale of products and services of others, namely,** marketing services provided in the nature of incentive programmes and schemes, privileges and loyalty recognition programmes, customer loyalty incentive programmes and schemes; organisation, operation and supervision of incentive schemes **in the nature of an incentive awards program** and information for issuing of tokens of value, benefits, incentive and other ancillary services **related to such incentive awards program;** market analysis relating to frequent use bonus incentive schemes; organisation and management of incentive **awards program** and sales promotion programmes **being** {frequent buyer programmes}; retail and wholesale **store** services in relation to consumer goods, computers, computer keyboards, rechargeable batteries, powerbanks, computer software and hardware, computer peripherals, mobile phones and related parts and accessories, headphones, sleeves for

laptops, earbuds, calculators, lanyards for cameras, lanyards for mobile phones, lanyards for holding spectacles, eyeglass lanyards, paper and cardboard, printed matter, stationery, notebooks, notebook paper, books, calendars, clipboards, ink, pens, correction pens, cases for pens, pencils, stickers, decals, laptop decals, 3D decals for use on any surface, stickers stationery, sticker books, desktop business card holders, brochures, printed brochures, backpacks, bags, leather bags, messenger bags, shoulder bags, tote bags, cross-body bags, satchels, luggage tags, umbrellas, wallets, card wallets, credit card cases **being** wallets, suitcases, ~~umbrellas~~, household or kitchen utensils and containers, glassware, cups, coffee cups, mugs, drinking cups, glass drinking cup, bottles, aluminum bottles, wall plaques made of acrylic, ~~clothing, clothing for babies, footwear, headgear, caps headwear, tops, pyjamas~~; the provision of the foregoing services online

In view of the foregoing amendments, Applicant respectfully submits that there is no overlap between Applicant's goods/services and the goods/services covered by the cited marks. As such, reasonable consumers are unlikely to confuse the source of the relevant goods and services.

CONCLUSION

Applying the requirements of Trademark Act Section 2(d) to the present case, Applicant respectfully contends that Applicant's Mark should be approved for publication. Accordingly, Applicant respectfully requests that the Examining Attorney withdraw the refusal.