

UNITED STATES PATENT AND TRADEMARK OFFICE  
EXAMINATION DIVISION

**Applicant: Infoblox Inc.**  
**Trademark: BLOXONE**  
**United States App. No.: 88062882**  
**Classes: 9, 37, 42**

**RESPONSE TO OFFICE ACTION**

Applicant submits this Response to the Office Action of November 19, 2018.

**I. AMENDMENTS**

**Identification of Goods and Services**

The Examining Attorney requested revisions to, and Applicant offers to delete portions of and amend the identification of goods and services as follows (“Amended Goods and Services”):

**Class 9:** computer software for network security, namely, software for managing, monitoring, and providing information regarding network security; computer software for providing security features to control access from malware or other unauthorized intrusion or vulnerabilities on a computer network; computer software for the administration of computer networks in the field of computer networks and network security

**Class 37:** domain name system (DNS) management and maintenance services, namely, **maintenance of computer hardware** relating to domain name system server computer security and prevention of computer risks to domain name systems; providing technological consulting and assistance in the field of computer hardware, namely, providing advice about **the repair and maintenance of** computers and **computer** components via the internet

**Class 42:** computer security services, namely, restricting access to and by computer networks to and of undesired websites and media; domain name system (DNS) management and maintenance services, namely, maintenance of computer software relating to domain name system server computer security and prevention of computer risks to domain name systems; monitoring of computer systems, namely, domain name systems, by remote access to ensure proper functioning; technical support, namely, monitoring technological functions of computer domain name systems; computer software-as-a- service (SaaS) services featuring software that assists in cloud and virtualization monitoring and management

## II. REMARKS

The Examining Attorney refused registration of Applicant's mark based on Registration Nos. 4571706 and 5254199, for ONEBLOX, both in Class 9 (Cited Marks). Applicant disagrees with the Examiner and believe the marks do create different impressions and convey different meanings. The Cited Marks begin with "one" and followed by "blox", which is one letter off the word "box" to convey the meaning of 'one box'. The owner of the Cited Marks means to provide the suggestion that all a business needs to solve its "escalating data storage needs" is 'one box' as a storage solution, meaning its own (box) storage hardware product, ONEBLOX. See Cited Marks' product brief at <https://www.storagecraft.com/sites/default/files/2018-03/OneBlox-Product-Brief.pdf> as follows:

### A New and Effective Approach to Storage

StorageCraft has designed a unique storage solution from the ground-up for small and midsize enterprises to help address their escalating data storage needs and deal with runaway storage costs and information management nightmares. StorageCraft offers OneBlox, a scale-out storage solution that is an on-premises hardware appliance combined with OneSystem, an integrated, enterprise-grade cloud-based storage management service.

OneBlox is a purpose-built appliance with all enterprise-grade features built-in such as continuous data protection, compression, inline deduplication, and disaster recovery and is completely automated for the IT personnel to setup and operate. The unique scale-out, converged storage appliance consolidates primary data as well as the backup and archival data.



### Product Brief

[www.storagecraft.com](http://www.storagecraft.com) • [sales@storagecraft.com](mailto:sales@storagecraft.com)

Applicant's mark has no such meaning or connotation and indeed has nothing to do with a hardware box, nor does the mark convey 'one box'.

In addition to very different commercial impressions and connotations, the Cited Marks are not for related goods or services, being specifically for hardware and software for storage of data and information. Applicant's Amended Goods and Services are not data storage at all and are specific to software and services related to network and DNS security, restricting and controlling access to networks and monitoring for potential attack, malware or similar intrusion into a network, which obviates any likelihood confusion with the Cited Marks. *See M2 Software, Inc. v. M2 Commc'ns, Inc.*, 450 F.3d 1378, 1383, 78 USPQ2d 1944, 1947–48 (Fed. Cir. 2006) (noting that relatedness between software-related goods may not be presumed merely because the goods are delivered in the same media format and that, instead, a subject-matter-based mode of analysis is appropriate). Applicant respectfully the Examining Attorney to withdraw the citations.

### III. CONCLUSION

Based on the foregoing, if the Examiner agrees the Amended Goods and Services obviate the 2(d) citations, Applicant respectfully requests that Examining Attorney enter the Amendments, withdraw the citations, and issue a priority action for the additional class fee.

Respectfully submitted,

*/Holly Pranger/*

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