Attorney Docket: 12839.0034-00000

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

Applicant: Xiaomi Inc.
Serial Number: 86245850
Filing date: April 8, 2014
Mark: MI BOX

Examining Attorney: Lee B. Hunt, Esq.
Law Office: 115

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

RESPONSE TO OFFICE ACTION

Applicant submits the following remarks in response to the Office Action dated July 29, 2014.

REMARKS

The Examining Attorney has refused registration of Applicant's MI BOX mark in class 9 on the ground that it is likely to be confused with the mark shown below

(Reg. No. 3987135) owned by Meebox Inc., ("Registrant") for "computer hardware and computer peripheral devices; computer joysticks; computer keyboard controllers; computer memory hardware, computer printers."

Applicant respectfully suggests that the above amendments to the application render confusion with this mark unlikely under *Du Pont* because Applicant's mark presents a different overall commercial impression from Registrant's mark, because

Applicant's and Registrant's goods are different and are sold in different contexts, and because Applicant's and Registrant's customers are sophisticated and unlikely to be confused. Accordingly, given these differences, the refusal should be withdrawn.

A. Applicant's and Registrant's Marks Create Different Commercial Impressions.

In this case, Applicant's MI BOX mark has a sufficiently different appearance, meaning, and commercial impression from the mark to render confusion unlikely. The marks are spelled differently, have different formatting and stylizations, and would suggest different meanings to consumers.

Regarding spelling and appearance, Registrant's mark appears to consumers as "MEEB" space "X." In contrast, Applicant's mark is formatted so it clearly appears as MI BOX. Consequently, the term BOX is not readily apparent in Registrant's mark as it is in Applicant's mark. AS such, the two marks present different overall visual impressions.

Under Court and TTAB precedent, the Examining Attorney must take into account the different meanings of the marks in determining whether there is a likelihood of confusion. E.g., Revlon, Inc. v. Jerell, Inc., 713 F. Supp. 93, 98 (S.D.N.Y. 1989) (TO THE NINES and INTO THE NINETIES present different meanings); In re British Bulldog, Ltd., 224 USPQ 854 (TTAB 1984) (finding PLAYERS for shoes implies a product adapted to outdoor activities while PLAYERS for men's underwear implies an "indoor" activity); In re Best Products Co., Inc., 231 USPQ 988, 989-90 (TTAB 1986) (finding that "JEWELERS' BEST connotes a selection of jewelry reflecting a quality level

perceived by the jeweler personally" while BEST JEWELRY indicated the house mark "BEST" and the generic name for the goods offered).

In this case, consumers take away a completely different meaning from Applicant's mark and Registrant's mark. Applicant owns a family of telecommunication products bearing the MI house mark, as shown in its web page (Exhibit A) and its U.S. trademark registration (Exhibit B). The MI house mark is taken from the Chinese word for "rice" (Exhibit C), and is a shortened form of Applicant's corporate name XIAOMI which means "little rice" (Exhibit D). Indeed, Applicant promotes its XIAOMI and MI products in the press by referencing its meaning in Chinese, as shown in the enclosed articles (Exhibit E). Applicant has an entire family of telecommunications products that commence with its house mark MI, such as MI PAD (App. No. 86245842), and MI WIFI (App. No. 86245855). Consequently, consumers familiar with Applicant's line of products will immediately see that the MI BOX mark merely identifies another product within Applicant's MI line of products.

Given the differences in appearance, meaning, and commercial impression, the Examining Attorney should withdraw the refusal to register Applicant's mark.

B. Applicant's and Registrant's Products Are Different And Are Sold In Different Contexts

The Examining Attorney's refusal to register Applicant's mark is based largely on references to computer products in Applicant's original identification of goods in Class 9. Specifically, the Examining Attorney argues that Applicant's goods might encompass Registrant's "computer hardware and computer peripheral devices." However, Applicant has amended its identification of goods so that it is no longer broadly worded to encompass computer products, but instead narrowly identifies Applicant's goods as

telecommunication/home entertainment devices, namely set-top boxes and recorders used primarily to receive cable and satellite programming on televisions or other video viewing devices, as well as related software and remote controls. The nature of Applicant's MI BOX product is borne out by Applicant's web site which illustrates the MI BOX products as a television viewing device. (Exhibit F).

In contrast, Registrant's goods are desktop and laptop computers. (Exhibit G). Such products do not perform the same function as Applicant's products, and would not compete with Applicant's product. Nor would television set-top boxes be sold together with desktop and laptop computers. Rather, Applicant's product is typically provided by with the home entertainment/video content providers and other telecommunication service providers.

With respect to the remotes, Applicant respectfully submits that the Examining Attorney has failed to establish that television and video remote controls such as the one Applicant is marketing are related to Registrant's printers. The remotes the Examining Attorney placed in the record are for projectors and other office equipment, not telecommunications/television/home entertainment equipment.

The Examining Attorney suggests that Applicant's and Registrant's goods may be "related" because they both could somehow be viewed as "computer products" or "electronics products." The mere fact that both Applicant's mark and the cited mark might in some way generally relate to "computer products" or "electronic products" is not sufficient to support a finding that confusion is likely. Two marks are not necessarily confusingly similar merely because they could theoretically relate to the same broad class of goods and services:

> The issue of whether or not two products are related does not revolve around the question of whether a term can be used that describes them both, or whether both can be classified under the same general category.

Electronic Data Systems Corp. v. EDSA Micro Corp., 23 USPQ2d 1460, 1463 (TTAB 1992) (products not related merely because both involve computer hardware). See also Information Resources Inc. v. X*Press Information Services, 6 USPQ2d 1034, 1038 (TTAB 1988) (same); In re Farm Fresh Catfish Co., 231 USPQ 495, 495 (TTAB 1986) (two food products are not necessarily "related" for trademark purposes). Rather, The issue of whether or not two products are related depends on whether they are sold in the same market or field, and will thus be encountered under similar circumstances so as to cause consumer confusion as to their source. TMEP § 1207(a)(i); *see also M2 Software, Inc. v. M2 Commc'ns, Inc.*, 78 U.S.P.Q.2d 1944, 1949 (Fed. Cir. 2006). Applicant' respectfully submits that, as detailed above, its television top-set box will not be encountered in the same circumstances desktop and laptop computers, and thus will not be likely to cause consumer confusion. Accordingly, given the differences in the goods, the Examining Attorney should withdraw the refusal to register the mark.

C. Applicant's And Registrant's Goods Are Expensive and Consumers Will Exercise Care In Purchasing Such Products

Confusion between Applicant's and Registrant's marks is rendered unlikely because their products are relatively expensive and their respective consumers will exercise care in selecting these electronic devices They are unlikely to be confused given the vastly different appearances of the marks and the different functions of the products. E.g., In re N.A.D., Inc., 754 F.2d 996, 999-1000 (Fed. Cir. 1985) (circumstances suggesting consumer care indicates confusion is unlikely); American

Optical Corp. v. Atwood Oceanics Inc., 180 USPQ 532 (TTAB 1973) (purchasers of lasers are sophisticated consumers, no confusion is likely); Electronic Design & Sales, Inc. v. Electronic Data Systems Corp., 954 F.2d 713 (Fed Cir. 1992) (confusion unlikely in connection with professional computer services).

CONCLUSION

In view of the differences in the Applicant's and Registrant's marks, their goods, and the expense of the products, Applicant believes that confusion between these marks is unlikely and that the refusal should be withdrawn and the mark be approved for publication.

Respectfully submitted,

Xiaomi, Inc.

Dated: January 28, 2015

By: /B. Brett Heavner/

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