

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Serial Number: 88/471,468

Filing Date: June 13, 2019

**Applicant: Softwire Technology Limited
aka Softwire**

Application Basis: Foreign Registration

Examiner: Shanoski, Joanna M.

Docket Number: 750001

Mark: **Softwire** word plus design mark

RESPONSE TO NON-FINAL OFFICE ACTION

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

Dear Commissioner:

In response to the Examining Attorney's Non-Final Office Action dated September 11, 2019 (hereinafter "Office Action"), Applicant responds as follows:

REMARKS IN SUPPORT OF REGISTRATION

Applicant respectfully requests reconsideration of the Office Action's refusal of the instant Application based upon the Likelihood of Confusion Refusal, the U.S. Counsel Requirement, the Mark Description, and the Foreign Registration Requirement.¹

I. LIKELIHOOD OF CONFUSION REFUSAL

Applicant respectfully requests reconsideration of the Office Action's refusal of the instant Application based upon the Likelihood of Confusion Refusal with the SOFTWARE word mark, Registration No. 4,743,824 (hereinafter referred to as "Cited Mark").² The Office Action initially

¹ Office Action pp. 2-4.

² Office Action pp. 2-3.

refused registration of Applicants' Mark based upon a finding regarding the following factors: "(1) the similarities between the compared marks and (2) the relatedness of the compared goods and/or services."³

Applicant notes with appreciation the Office Action's Option to Overcome the Refusal based upon the Likelihood of Confusion with the Cited Mark by way of limiting the Identification of the Services.⁴ In accordance with this suggestion, Applicant wishes to amend the Services as follows:

A. As Filed:

Design and development of computer hardware and software; Scientific and technological services, namely, research and design in the field of computer software, data science and artificial intelligence; Computer programming and computer system analysis; in Class 042;

B. As Amended:

Design and development of computer hardware and software, **not in the fields of energy management, lighting control, or temperature control**; Scientific and technological services, namely, research and design in the field of computer software, **not related to the fields of energy management, lighting control, or temperature control**, data science and artificial intelligence; Computer programming and computer system analysis, **not in the fields of energy management, lighting control, or temperature control**; in Class 042;

C. Final Identification:

Design and development of computer hardware and software, not in the fields of energy management, lighting control, or temperature control; Scientific and technological services, namely, research and design in the field of computer software, not related to the fields of energy management, lighting control, or temperature control, data science and artificial intelligence; Computer programming and computer system analysis, not

³ Office Action p. 2; *In re i.am.symbolic, llc*, 866 F.3d 1315, 1322, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017).

⁴ Office Action p. 3.

in the fields of energy management, lighting control, or temperature control; in Class 042.

Considering the amendment to the Identification of the Services in accordance with the Office Action's suggestion, Applicant respectfully requests the refusal based upon the Likelihood of Confusion with the Cited Mark be overcome and withdrawn. Given the forgoing amendment, it is not likely that a consumer would be confused as to the source when encountering the Cited Mark's Goods and Applicant's Services in the marketplace.

II. U.S. COUNSEL REQUIREMENT

Applicant also respectfully requests reconsideration of the instant Application based upon the U.S. Counsel Requirement.⁵ The Office Action refused registration of Applicant's Mark due to Applicant's foreign domicile and lack of representation by counsel in the United States related to this Application.⁶ Applicant filed its Revocation, Appointment, and/or Change of Address of Attorney/Domestic Representative on November 01, 2019 appointing the undersigned Counsel of Record, who is licensed in the United States. This appointment has since been reflected on the Application data.

Considering the November 01, 2019 filing, Applicant respectfully requests the refusal based upon the U.S. Counsel Requirement be overcome and withdrawn.

III. MARK DESCRIPTION

Applicant respectfully requests reconsideration of the Office Action's refusal of the instant Application based upon the Description of the Mark.⁷ The Office Action refused registration of Applicant's Mark based upon a finding that the Description of the Mark is indefinite.⁸ Applicant

⁵ Office Action p. 3.

⁶ 37 C.F.R. §§2.11(a).

⁷ Office Action p. 4.

⁸ 37 C.F.R. §2.37.

wishes to amend the Description of the Mark to adopt the language proposed in the Office Action, which is as follows:

The mark consists of the word “SOFTWARE” where the letter “T” is dotted with a triangle pointing to the right, all in blue.

IV. FOREIGN REGISTRATION REQUIREMENT

Applicant also respectfully requests reconsideration of the instant Application based upon the Foreign Registration Requirement.⁹ Applicant is submitting a scanned certified copy of the foreign registration to this Response as Exhibit A. Submission of this certified copy should satisfy the foreign registration requirement, rendering the refusal based upon such moot.

Considering the submission of the certified copy of the foreign registration, Applicant respectfully requests the refusal based upon the Foreign Registration Requirement be overcome and withdrawn.

V. CONCLUSION

In view of the aforementioned amendments and remarks, it is respectfully requested that the refusal based upon the Likelihood of Confusion Refusal, U.S. Counsel Requirement, Mark Description, and the Foreign Registration Requirement, be reconsidered, overcome, and withdrawn.

The undersigned hereby certifies that this Response is being electronically transmitted under 37 CFR 2.197 using TEAS with the United States Patent and Trademark Office. The undersigned being warned that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. §1001, and that such willful false statements and the like may jeopardize the validity of the Application or document or any registration resulting therefrom,

⁹ Office Action p. 4.

declares that all statements made of her knowledge are true; and all statements made on information and belief are believed to be true. Therefore, registration of Applicant's Mark upon the Principal Registry should be allowed and such action is earnestly solicited.

Respectfully,

/Brittany J. Maxey-Fisher/
Brittany J. Maxey-Fisher, Esq.
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Attorney for Applicant

CERTIFICATE OF MAILING OR TRANSMISSION UNDER 37 CFR 2.197:

I hereby certify that this correspondence is being electronically transmitted using TEAS with the United States Patent and Trademark Office.

12/06/2019
Date

/Brittany J. Maxey-Fisher/
Brittany J. Maxey-Fisher, Esq.

Exhibit A



Intellectual
Property
Office

Certified Copy

I certify that the attached is a true copy of the entry of a trade mark in the United Kingdom register of trade marks.

Tim Moss
Comptroller General of Patents, Designs and Trade Marks
Intellectual Property Office

Dated: 03 June 2019



Mark:

Softwire

Trade Mark No: UK00003228846

Mark type: Figurative mark

Trade Mark status: Registered, OPEN

Trade Mark type: Standard

Filing Date: 04/05/2017 **Registration Date:** 21/07/2017

Renewal Date: 04 May 2027

Journal First Advert

Journal Number:2017/019

Publication Date: 12/05/2017

Goods and Services List:

Class 35:

Advertising; business management; business administration; office functions.

Class 42:

Scientific and technological services and research and design relating thereto; industrial analysis and research services; design and development of computer hardware and software.

Owner(s) Details:

Softwire Technology Limited

Softwire, Unit 110, Highgate Studios, 53-79 Highgate Road, London, NW5 1TL

UNITED KINGDOM



Softwire Technology Limited
Unit 110, Highgate Studios
53-79 Highgate Road
LONDON
NW5 1TL
UNITED KINGDOM

Your Reference: SoftwireTMAApplication
Trade Mark No: UK00003410684
Date: 27 September 2019

Dear Sir or Madam,

Trade Mark No: UK00003410684
Mark: SOFTWARE
Series of Marks: 2
Owner: Softwire Technology Limited
Class(es): 42

Registration Certificate

Please find enclosed your trade mark registration certificate for your trade mark detailed above.

To keep your trade mark registered, you must renew it every ten years on the anniversary of the filing date. We will write to remind you six months before the renewal is due. For further information on what you can do with your registered trade mark, please go to our website at:

ipo.gov.uk/guidance/license-mortgage-transfer-merge-and-market-your-trade-mark

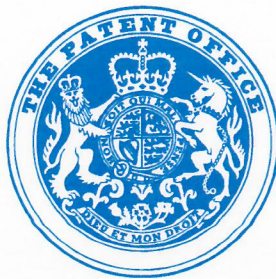
Remember to tell us if you change your postal address or email details by sending us a Form TM21A 'Change of owner's name or address'. You can download the form from our website, visit ipo.gov.uk/tmforms

Please be aware that some customers have received unsolicited invitations from companies offering services to help them protect their intellectual property (IP) rights in return for a fee. Should you receive such mail, we would advise that you do **not** pay until you have checked to see what services are offered and whether it is from an official source. For more information visit our website ipo.gov.uk/warning

Yours faithfully

Intellectual Property Office

TRADE MARKS REGISTRY



REGISTRATION CERTIFICATE

Trade Marks Act 1994 of

Great Britain and Northern Ireland

I certify that the marks shown below have been registered as a series of 2 marks under No. UK00003410684 effective as of the date 01/07/2019 and have been entered in the register on 27/09/2019

Signed this day at my direction

Tim Moss
REGISTRAR

Representation of Marks
Mark 1

SOFTWARE

Mark 2

Softwire

The marks have been registered in respect of:

Class 42:

Analysis (Computer systems -);Analytic services relating to computers;Analytical services relating to computer programmes;Computer programming and maintenance of computer programs;Computer programming and software design;Computer programming consultancy;Computer programming for data processing;Computer programming for data processing and communication systems;Computer programming for others;Computer programming services;Computer programming services for data warehousing;Computer software advisory services;Computer software consultancy;Computer software consultancy services;Computer software consulting;Computer software consulting services;Computer software design;Computer software design and development;Computer software design and updating;Computer software design for others;Computer software design services;Computer software development;Computer software development for others;Computer software engineering;Computer software integration;Computer software maintenance;Computer software maintenance services;Computer software

TRADE MARKS REGISTRY



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programming services;Computer software technical support services;Computer system analysis;Computer system design;Computer system design and development;Computer system integration services;Computer systems design;Computer systems development;Computer systems integration services;Computer technology consultancy;Computer website design;Conducting feasibility studies relating to computer information systems;Conducting feasibility studies relating to computer software;Consultancy and advice on computer software and hardware;Consultancy and information services in the field of computer system integration;Consultancy and information services in the field of information technology;Consultancy and information services in the field of information technology architecture and infrastructure;Consultancy and information services relating to computer system integration;Consultancy and information services relating to information technology;Consultancy and information services relating to information technology architecture and infrastructure;Consultancy and information services relating to software maintenance;Consultancy and information services relating to the design, programming and maintenance of computer software;Consultancy (Computer software -);Consultancy in the field of computer software;Consultancy in the field of computers;Consultancy in the field of software design;Consultancy relating to computer database programs;Consultancy relating to computer software;Consultancy relating to computer systems;Consultancy relating to computers;Consultancy relating to software design and development;Consultancy relating to software maintenance;Consultancy relating to the design and development of computer database programs;Consultancy relating to the design and development of computer programs;Consultancy relating to the design and development of computer software programs;Consultancy relating to the updating of software;Consultancy services for designing information systems;Consultancy services in relation to computer software;Consultancy services relating to computer programming;Consultancy services relating to computer systems;Consultation services relating to computer software;Consultation services relating to computer systems;Consulting services relating to computer software;Creating, maintaining, and modernizing computer software;Creating, maintaining, and updating computer software;Creating of computer programs;Creating programmes for data processing;Custom design of software packages;Customized design of computer software;Data mining;Database design and development;Design and development of computer database programs;Design and development of computer database software;Design and development of computer databases;Design and development of computer software;Design and development of computer software architecture;Design and development of computer software for evaluation and calculation of data;Design and development of computer software for others;Design and development of data processing programs;Design and development of data processing software;Design and development of data processing systems;Design and development of data retrieval software;Design and development of data storage systems;Design and development of databases;Design and development of software

TRADE MARKS REGISTRY



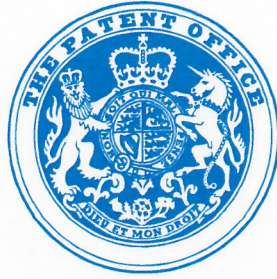
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for database management; Design and development of software for importing and managing data; Design and development of software in the field of mobile applications; Design and development of systems for data input, output, processing, display and storage; Design and writing of computer software; Design, development and implementation of software; Design, development and programming of computer software; Design, maintenance, development and updating of computer software; Design of computer programs; Design of computer software; Design of computer systems; Design of programs for computers; Design services for computer programs; Design services for data processing systems; Design services relating to computer programmes; Design services relating to computer software; Design services relating to computer systems; Design services relating to computerised information processing systems; Design services relating to data processing systems; Design services relating to the development of computerised information processing systems; Design, updating and maintenance of computer software; Designing of computer programs; Designing of data processing programmes; Designing of data processing systems; Developing and updating computer software; Developing computer software; Developing computer software for others; Development and creation of computer programmes for data processing; Development and design of mobile applications; Development and maintenance of computer database software; Development and maintenance of computer software; Development and testing of computing methods, algorithms and software; Development and testing of software; Development of computer based networks; Development of computer database software; Development of computer programmes; Development of computer software; Development of computer software application solutions; Development of computer systems; Development of programs for computers; Development of software; Development services in the field of computer software and advisory services relating thereto; Development services relating to computer programmes; Development services relating to computer software application solutions; Development services relating to computer systems; Development services relating to data processing systems; Development, updating and maintenance of software and database systems; Information technology consulting; Information technology [IT] consulting services; Information technology services; Maintenance and repair of software; Maintenance and updating of computer software; Maintenance and upgrading of computer software; Maintenance of and updating of computer software; Maintenance of computer programmes; Maintenance of computer software; Maintenance of software; Modifying of computer programs; Professional advisory services relating to computer software; Research and consultancy services relating to computer software; Research and development for others; Research and development of computer software; Research in the field of computer programs and software; Research in the field of data processing technology; Research relating to the development of computer programs and software; Research relating to the development of computer software; Research services relating to computer

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programmes;Scientific and technological services;Services for designing computer software;Services for the design of computer software;Services for the design of computer systems;Services for the updating of computer programmes;Services for the writing of computer software;Services for updating computer software;Software consultancy services;Software consulting services;Software design and development;Software design for others;Software development;Software development services;Software engineering;Software engineering services;Software engineering services for data processing programs;Software maintenance services;Software research;Support and maintenance services for computer software;Systems analysis (Computer -);Technological services and design relating thereto;Technological services and research relating thereto;Technological services relating to computers;Technological services relating to design;Testing of computer programs;Testing of computer software;Updating and design of computer software;Updating and maintenance of computer software;Updating and maintenance of computer software and programs;Updating and upgrading of computer software;Updating of computer software;Up-dating of computer software;Updating of computer software for others;Updating of software;Upgrading and maintenance of computer software;Upgrading of computer software;Writing and updating computer software;Writing of computer programs;Writing of computer programs for medical applications;Writing of computer software;Writing of data processing programs;Writing of programs for data processing.

In the name of Softwire Technology Limited
Company number 03824658