

Response to Office Action

Foreign Registration

The applicant advises that it intends to rely on Section 44(e), in addition to Section 1(b), as a basis for registration. The corresponding foreign application has not yet issued to registration. Thus, it is respectfully requested that this subject application be placed in suspension pending receipt of the foreign registration document.

Section 2(d) Refusal – Likelihood of Confusion

The Examining Attorney has refused registration of the subject mark based on an alleged likelihood of confusion with U.S. Registration Nos. 2843622 (“SKYWORKS”), 2843623 (“SKYWORKS”), and 3885738 (“SKYWORKS SOLUTIONS, INC.”). Applicant respectfully disagrees with the Examining Attorney’s assessment.

The *du Pont* decision, *In re E.I. DuPont DeNemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973), set out a number of factors relevant to the confusion analysis. Applicant submits that the factors most relevant to the subject case are the nature of the respective goods and services and trade channels. Despite the similarity in the marks, the applicant’s goods and services and trade channels are substantially different from those of the registrant such that respective purchasers are not likely to be confused as to the source of the goods/services.

Comparison of the Goods and Services

Applicant has applied for registration of SKY WORK for use with the following goods and services:

computer software in the field of enterprise mobility management (EMM) for mobile device management namely, mobile phones, smartphones, personal digital assistants (PDAs), tablet phones, tablet computers, mobile computers, for managing software applications used on mobile phones, smartphones, personal digital assistants (PDAs), tablet phones, tablet computers, mobile computers, for mobile security management, and for managing personal business information on mobile phones, smartphones, personal digital assistants (PDAs), tablet phones, tablet computers, mobile computers; computer software in the field of enterprise mobility management (EMM) for the operation, management, security and maintenance of enterprise computer networks; document management software applications for mobile devices; secure mobile messaging platform, namely, software for mobile devices that allows users to securely exchange electronic messages and digital files via computer and communication networks; downloadable software in the nature of an end-to-end encrypted messaging application; computer software for use on mobile devices and computers for instant messaging, group communication, voice over Internet Protocol calling and secure file sharing including pictures, videos, voice recordings and data files (in class 9); and

mobile device management services in the field of enterprise mobility management (EMM), namely, remote management of mobile devices' software applications, access, and security; software as a service (SAAS) services in the field of enterprise mobility

management (EMM), featuring software for mobile device management, mobile application management, mobile security management and managing personal business information on mobile phones, smartphones, personal digital assistants (PDAs), tablet phones, tablet computers, mobile computers; software as a service (SAAS) services in the field of enterprise mobility management (EMM), featuring software for the operation, management, security and maintenance of enterprise computer networks (in class 42).

Essentially, applicant's SKY WORK mark is used with a device management *software system* for small to mid-sized businesses to secure and protect customer data on employee devices. Features include encrypted customer data, secure email, and protection against malware. Applicant's goods and services support workplace "Bring Your Own Device (BYOD) policies so that employees can use their own smartphones, tablets and computers without sacrificing security.

Cited registration 2843623 ("SKYWORKS") covers the following goods:

radio frequency and base band wireless communications equipment, namely, power amplifiers, attenuators, couplers, amplifiers, power conditioners, base band processors, transmitters, receivers, transceivers, down converters, radios, modulators, demodulators, power units, tuners, base stations, switches, converters, millimeter wave semiconductor controllers, millimeter wave semiconductor mixers, filters, semiconductor devices, chipsets, hardware for radio frequency and base band wireless communication equipment, wafers **and software for use in operating wireless communications equipment** (in class 9).

The Examining Attorney takes the position that the registrant's "software for use in operating wireless communications equipment" is broad enough to encompass the applicant's goods and services. Applicant does not agree.

A *reasonable* interpretation of the registrant's specification of goods as a whole is that the registrant's software is for operation of the types of wireless communications equipment outlined in the registration, i.e. power amplifiers, attenuators, couplers, amplifiers, power conditioners, base band processors, transmitters, receivers, transceivers, down converters, radios, modulators, demodulators, power units, tuners, base stations, switches, converters, millimeter wave semiconductor controllers, millimeter wave semiconductor mixers, filters, semiconductor devices, chipsets, hardware for radio frequency and base band wireless communication equipment, wafers. Applicant sells none of these goods under its SKY WORK mark, nor is its software intended to operate such goods.

A *literal* interpretation of "software for use in operating wireless communications equipment" also shows no overlap with the applied-for goods and services. The registrant's use of the term "wireless communication equipment" makes clear that the registrant's software is used to control the function of physical hardware—not software. As such, registrant's software does not encompass applicant's goods or services. Applicant's software is not for operating wireless communications equipment, but rather is for managing other software applications and enterprise computer networks, for secure messaging, and for document management.

Applicant respectfully submits that there is no overlap between the goods covered by registration No. 2843623 and the goods and services in the subject application, and that applicant's goods and services are readily distinguishable from the registrant's goods in form

and function. Hence, there is no likelihood of confusion between the subject mark and cited registration No. 2843623.

The other two cited registrations cover services only. In particular, cited registration Nos. 2843622 (“SKYWORKS”) covers

consulting services in the fields of radio frequency and base band wireless communications and manufacturing (in class 38); and

custom design, engineering and development services in the fields of radio frequency and base band wireless communications and manufacturing (in class 42).

Cited registration no. 3885738 (SKYWORKS SOLUTIONS, INC.) covers

telecommunications consulting services in the fields of radio frequency and baseband wireless communications (in class 38);

consultation and custom manufacture and assembly of radio frequency and baseband wireless communication equipment (in class 40); and

custom design, engineering, and development of radio frequency and baseband wireless communications equipment and products (in class 42).

The Examining Attorney states that the services covered by cited registration Nos. 2843622 and 3885738 are *related to* the goods and services in the subject application “because registrant’s services feature or are related to those goods and services in the application.” Applicant respectfully submits that this statement is circular and unsupported by evidence.

The Examining Attorney later states that “the registrant’s services feature the same type of products as the applicant’s identified goods and services.” Applicant submits that this is an inaccurate characterization of the parties’ respective goods and services. The applicant’s goods and services are all in the nature of **software or enterprise mobility management services**. None of the registrant’s services “feature” such goods/services.

Moreover, the Examining Attorney has provided no evidence to demonstrate that the services in the cited registrations are *related to* the applicant’s goods and services. According to TMEP §1207.01(a)(vi), the examining attorney must provide evidence showing that the goods and services are related to support a finding of likelihood of confusion. See, e.g., *In re White Rock Distilleries Inc.*, 92 USPQ 2d 1282, 1285 (TTAB 2009).

The applicant and the registrant each provide goods and services with a distinct purpose. In the applicant’s case, it is software and related services for managing customer data on employee mobile devices. On the other hand, the registrant is a manufacturer of semiconductors and other components that would be incorporated into third party products and devices in a variety of markets and industries. Thus, the products and services are in different categories and usages, and not likely to result in any consumer confusion.

Channels of Trade and Classes of Purchasers

The Examining Attorney finds that the goods/services of the parties “have no restrictions as to nature, type, channels of trade, or classes of purchasers and are “presumed to travel in the

same channels of trade to the same class of purchasers.” Applicant respectfully disagrees with this assessment. The differences in the parties’ respective goods and services, addressed above, inform the logical channels of trade and classes of purchasers, and such trade channels and classes of purchasers would not be the same.

Given the nature of the registrant’s products, its target consumers would be manufacturers who would incorporate the registrant’s components (power amplifiers, attenuators, switches, etc.) into their own products and devices. In contrast, applicant’s products and services are targeted at small to medium enterprises with a workforce using digital devices.

Neither of the parties’ goods/services are sold off-the-shelf for general consumers. Rather, each parties’ products and services are specialized and likely to be sold via their own team of sales agents. The decision to purchase the respective goods and services would be made carefully.

A purchaser would have no reason to conclude a relationship between the registrant’s goods and services and the applicant’s goods and services. Quite simply, they serve entirely different purposes.

In view of the foregoing, applicant submits there is no likelihood of confusion.