

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Microsoft Corporation Attorney Docket No. 25936-T1357
Serial No.: 88/352,998 Examiner: Gabriel Mitchell
Filed: March 22, 2019 Law Office: 127
Mark: P International Classes: 9, 42

APPLICANT’S RESPONSE TO SUSPENSION LETTER

In the Suspension Letter delivered to Applicant on April 24, 2019, the Examining Attorney suspended action on Applicant’s design mark shown below:



(Serial No. 88/352,998) (the “**Mark**”).

The application for the Mark lists the following goods and services:

“recorded and downloadable computer programs for providing enhanced electronic mail and scheduling capabilities, . . . namely, recorded and downloadable computer programs for managing, viewing, and editing files, documents, electronic mail messages and private network and global computer network communications; . . . for meeting and event scheduling, managing group calendars, task delegation and reporting, recording notes, transferring data to and from databases and to and from computer programs and computer files; . . . address book computer programs, . . . telephone dialing computer programs, . . . programs for correcting typographical and capitalization errors and . . . for tallying voting responses” in Class 9

and “cloud computing featuring software for use in presentation graphics and accessing remotely stored data for such applications; providing temporary use of . . . software and applications for presentation graphics; providing technical information in the field of computer software and cloud computing” in Class 42.

The Suspension Letter is based on the grounds that a prior-filed pending application for the standard character mark, “P” (Serial No. 87/385,370) (the “**Cited Mark**”) *may* present a bar to registration of the Mark as a result of confusion in violation of Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d).

Based on the arguments and evidence submitted, Applicant respectfully disagrees with the findings and requests that the Examining Attorney reconsider and withdraw the suspension of the Mark.

THE MARK IS PART OF A CROWDED FIELD THAT IS NARROWLY PROTECTED AND DISTINGUISHABLE BY ITS DESIGN ELEMENTS.

The Examining Attorney issued a Suspension Letter to Applicant on the grounds that the Cited Mark precedes the filing date of the Mark's application and if the Cited Mark registers, the Mark may be refused registration due to a likelihood of confusion with the Cited Mark. The Cited Mark is the word mark "P" in connection with a broad and lengthy list of goods and services in classes 9, 35, 36, 38, 41, 42 and 45. The goods and services include computer software primarily involving financial transactions for charity contributions, religious institutions and government-regulated entities as well as the design and development of computer hardware and software, and the hosting of websites to manage financial transactions, religious tithes, and charitable financial gifts. The Cited Mark is an intent to use application filed on March 24, 2017. No additional evidence or information was provided in the Suspension Letter.

In turn, the Cited Mark's application is currently suspended as it may cause confusion with two prior-pending applications for design marks containing the literal element "P". *See Exhibit A* (showing copies of the TSDR record for the Cited Mark and suspension letter for the Cited Mark). Of these prior-pending applications, the "P" design mark for computer application software and handheld computer goods, shown below, has since been abandoned:



(Serial No. 87/097,037) (the "**Abandoned Mark**"). *See Exhibit B* (showing copies of the TSDR record for the Abandoned Mark).

The second prior-pending application cited in the Cited Mark's suspension letter filed its application on August 23, 2017 in connection with promotion and advertising services involving electronic

and print marketing for various landscaping, irrigation, lighting and turf protection products in Class 35, see below:



(Serial No. 87/580,891) (the “**P Pending Mark**”). The P Pending Mark application was actually filed after the Cited Mark making the suspension incorrect. In addition, prior to receiving a suspension letter, the Cited Mark was also issued an office action that contained a 2(d) refusal citing nine different registered ‘P’ marks. *See Exhibit C* (showing a copy of the office action against the Cited Mark). While the examiner for the Cited Mark might argue that the refusals are due to the lengthy list of goods and services in the Cited Mark’s application, the exhibit provides evidence of the numerous registered marks that contain the “P” element and are able to co-exist.


To continue the cycle, the P Pending Mark received an office action on June 4, 2019 refusing its registration due to a likelihood of confusion with two design marks containing the literal element “P” and an advisory for the possibility of confusion with a prior-pending application that happens to be the Cited Mark. *See Exhibit D* (showing copies of the TSDR report for the P Pending Mark and the office action for the P Pending Mark). Therefore, the Cited Mark and the P Pending Mark will essentially fight suspensions against each other.





Two conclusions can be drawn from this: 1) due to citing an incorrect prior-filed application, these marks could remain pending for an extensive period of time, and 2) due to the high saturation of “P” marks, each should receive a narrow scope of protection and the design elements should be considered in a likelihood of confusion analysis. The design elements are an essential element of the Mark, and each mark should be judged in its entirety, as it is incorrect to focus upon only one feature of a mark and decide likely confusion solely upon that feature, ignoring all other elements of the mark. *See Massey Junior College, Inc. v. Fashion Institute of Technology*, 492 F.2d 1399, 181 U.S.P.Q. 272 (C.C.P.A. 1974); *see also Franklin Mint Corp. v. Master Mfg. Co.*, 667 F.2d 1005, 212 U.S.P.Q. 233 (C.C.P.A. 1981) (“It is








axiomatic that a mark should not be dissected and considered piecemeal; rather, it must be considered as a whole in determining likelihood of confusion”). The only similarity between the Applicant’s Mark, the Cited Mark, the Abandoned Mark and the P Pending Mark is the use of the literal element “P”, however three of the four marks use distinctive design elements. The Applicant’s Mark contains clear design distinctions apart from its use of the literal element “P” that separate it from other similar marks for related goods or services.



Even when marks are similar and the goods or services of the marks are related, a determination that there is no likelihood of confusion may be appropriate because these factors are outweighed by others, such as the presence in the marketplace of a significant number of similar marks in use on similar goods and services. *See* TMEP 1207.01(b); *see also Standard Brands Incorporated v. RJR Foods, Inc.*, 192 U.S.P.Q. 383, 385, 1976 WL 21135 (TTAB 1976). If a mark is hemmed in on all sides by similar marks for similar goods, it is merely one of a crowd of marks or considered part of a “crowded field.” *See Miss World (UK) Ltd. v Mrs. America Pageants, Inc.*, 856 F.2d 1445, 1449 (9th Cir. 1988). In such a crowd, consumers are unlikely to confuse any two of the crowd as consumers have learned to carefully differentiate one from the other. *See id.*; *see also Standard Brands Inc.*, 192 USPQ at 385 (finding no proof that the public had been educated by exposure to many uses of ROYAL marks to distinguish between different ROYAL marks “on the basis of minute distinctions”).

The Trademark Office’s database currently has over 1,000 applications for the word mark “P” or a design mark with the literal element “P” that are able to co-exist. Of those applications, 147 of those marks are used in connection with computer software, 21 are used in connection with cloud-based services, and 18 are used in connection with computer programs. A few examples of these marks are listed below:

MARK	REG. / SERIAL NO.	GOODS / SERVICES
	1921620	9: computer software for use with mainframe system architectures and/or compatible environments, providing programmers and operators tools to enhance their ability to view and control resources within the environment.

	3701964	<p>9: Wireless power transmitters; wireless power receivers; wireless power transmitting and receiving networks; controllers for power transmitting and receiving networks; battery chargers; computer programs for the control of battery chargers; computer programs for the control of electrical power supplies; computer hardware and software for controlling wireless power transmitting and receiving networks; computer networking hardware and software.</p>
	5193366	<p>9: Notebook and laptop computers; notebook computer carrying cases; desktop computers; tablet computers; protective case for tablet PC; convertible PC; personal digital assistant; embedded type controller, namely, network server, communications server, digital media server, Internet server and computer server for home automation; computer network servers; multifunction computer keyboards; data storage apparatus, namely, network attached storage which consists of electrical controller and electric control panels and network interface and storage media in the nature of blank electronic storage media, blank digital storage media, hard disk drives, blank USB flash drives, DVD drives and optical disk drives; docking station for computer; data processing apparatus; smart phone application, namely, software for playing games, word processing and uploading data to social media websites used by smart phone users by downloading it from software application providers or other application software downloading service web sites, such as, social networking service websites, game websites, and utility websites; computer software linked with smart phone application, namely, software for playing games, word processing and uploading data to social media websites used by smart phone users by downloading it from software application providers or other application software downloading service web sites, such as, social networking service websites, game websites, and utility websites; digital still and motion cameras; digital camera holding devices which make digital camera as wearable device in order to attach digital camera on clothes, or carrying bag, namely, camera straps, camera handles and camera mounts and support; smart set-top boxes</p>
	5435384	<p>9: Computer programs and software for creating personality tests, trivia quizzes, polls and games in the field of entertainment; game software, namely software for creating interactive computer games; downloadable computer game software; interactive multimedia software for playing games; computer game programs downloadable via the Internet; downloadable interactive entertainment software for playing computer games; computer game software downloadable via a global computer network and wireless devices; computer software platforms for creating content items, namely, personality tests, trivia quizzes, polls and other games, and allowing others to share and publish them</p>
	4279740	<p>9: downloadable software in the nature of a mobile application for creating, sharing, disseminating and posting photos, videos, personal and general information for the purposes of social, personal and professional networking; downloadable software in the nature of a mobile application for social and personal networking; downloadable software in the nature of a mobile application for displaying and sharing a user's location and personal preferences and finding, locating, and interacting with other users and places; application programming interface (API) software for allowing data retrieval, upload, access and management; API software for use in building software applications; software for geo-location based advertising and product and service promotions.</p>

	4565106	<p>9: Computers and downloadable software for monitoring and analyzing various parameters associated with the operation of a bicycle or exercise cycle and for fitness training; ear phones; digital media, namely, downloadable audio and audiovisual recordings, all in the field of exercise, fitness, wellness and personal development; downloadable software in the nature of an application for use by individuals participating in exercise classes, physical training, and exercise instruction for detecting, storing and reporting daily human energy expenditure and physical activity level, for developing and monitoring personal activity and exercise plans, training goals and giving feedback on the achieved result</p>
	3923097	<p>9: Software that captures and manages images, video and metadata, namely, GPS coordinates, magnetometer data, project location data, aspect ratio formats, sunrise and sunset data, and time of day data, and facilitates digital asset management workflow for use in identifying locations; software that provides cinematographic aspect ratios on an image capturing device.</p>
	4415679	<p>42: Computer software services, namely, customization, installation, maintenance and support services for computer software in the field of assessing automotive vehicle parking demand and parking supply and modeling automotive parking solutions.</p>
	4618014	<p>Computer software and mobile software applications, known as apps, for use in mobile devices, all in the field of human traffic analytics, which allow users, businesses, consumers, and organizations to measure and analyze traffic flow, length of wait or delay, crowd size, length of queue, and any other measurable human traffic-related data that impacts the experience of a visitor to a physical place.</p>
	4317546	<p>42: Computer service, namely, acting as an application service provider in the field of knowledge management to host computer application software for creating searchable databases of information and data to allow users to perform, on-line, the collecting and analyzing of different types of opinion surveys; performing survey design and research.</p>
	4658462	<p>42: Software as a service (SAAS) services, namely, hosting software for use by others for use in managing processes and information related to product management business processes.</p>
	4715590	<p>9: Computer software, namely, an open source tool for embedded systems.</p>

	4971355	9: CAD/CAM software for Game Simulations; Computer aided design (CAD) software for 3D terrain modeling; Computer game programs; Computer game software; Computer game software for use with personal computers, home video game consoles used with televisions and arcade-based video game consoles; Computer programs for video and computer games; Computer software development tools; Computer software for computer system and application development, deployment and management; Computer software for use in relation to digital animation and special effects of images; Computer software for golf course simulations; Computer software platforms for 3D modeling; Electronic sports training simulators; Interactive game programs; Interactive game software; Video and computer game programs.
	5147711	9: Downloadable online games and multimedia files for use with gaming with mobile phones and hand held devices; computer software facilitating social gaming, game playing and payments in connection with game play on mobile phones and hand held devices; computer software for facilitating the development and distribution of games for mobile phones and hand held devices

See Exhibit E (showing copies of the TSDR records for the ‘P’ mark registrations listed in the chart above).

As the Trademark Office’s database shows, the use of the letter “P” to represent computer programs, cloud services, and computer software goods or services is so common that the public will look to other elements to distinguish the source of the goods or services. See *Plus Products v. Star-Kist Foods, Inc.*, 220 USPQ 541, 544 (T.T.A.B. 1983) (using third party registrations to show that PLUS was diluted for food and vitamin products); TMEP § 1207.01(d)(iii). In such a case, even minor differences between marks may be sufficient to distinguish them and avoid a likelihood of confusion.

The numerous filings of “P” marks support the conclusion that consumers are able to distinguish marks that share the “P” element as a result of design distinctions. The Mark clearly incorporates design elements that set it apart from other “P” marks. The Mark includes a small curved-cornered red square with a white letter “P” in the center. The square exerts shadows in the lower right corner giving it a three dimensional perspective. Behind the square and to the right is a larger circle divided in half horizontally with the upper portion divided again vertically into identical halves. The circle has no shadow making its appearance flat against the background. Each divided portion of the circle is colored with a different shade of red. The lightest shade starts in the upper right corner, a slightly darker shade in the upper left corner,

and the darkest shade in the lower half of the circle and in the square. Clearly, the letter “P” is only one of several elements of the Mark. The design elements of the Mark are easy to distinguish when put side by side with any of the other “P” marks, especially the Cited Mark which contains no design element. As the Cited Mark would fade into the background, it is the design elements that the Applicant’s consumer would likely notice first rather than the letter “P”.

In addition, the Cited Mark’s scope of protection should not be so broad that it prevents the use of any “P” mark with computer software. Where the same term has been registered by multiple entities for identical or competitive goods, the term may be entitled to a narrower scope of protection. *See, Plus Products v. Redken Laboratories, Inc.*, 199 USPQ 111, 116 (TTAB 1978). Even though the Mark and the Cited Mark both involve computer software goods, the function of the software for the marks is different. The Mark’s computer software is primarily used in connection with its well-known computer presentation program, PowerPoint, and to manage schedules, tasks, documents and messages. The Cited Mark is used with software that primarily manages financial transactions and charitable gifts for religious and government organizations. The two goods do not function similarly, do not carry a similar purpose and do not target the same audience.

These details involving the distinction in appearance of the Mark and Cited Mark due to the design elements as well as the clear differentiation in the types of computer software are what set the Applicant’s Mark apart to consumers from the Cited Mark and any of the other “P” marks listed in the table above.

CONCLUSION

Overall, due to the common use of the letter “P” in marks in connection with computer programs and software, the use appears to be part of a crowded field. Although the Mark and the Cited Mark both consist of the literal element “P”, the design elements create distinctive appearances and commercial impressions so as to avoid any confusion among consumers. The co-existence of the attached third-party registrations in connection with computer software is evidence that the Trademark Office is aligned with this argument. For the foregoing reasons, Applicant respectfully requests that the suspension of its

application be withdrawn, and the application be allowed to proceed to publication. If any further information or response is required, please contact Applicant's attorney at 206-757-8297 or laurenschulz@dwt.com.