

Response to Office Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	78441047
LAW OFFICE ASSIGNED	LAW OFFICE 112
MARK SECTION (no change)	
ARGUMENT(S)	
<p>In response to the Office Action dated September 13, 2005, Applicant notes that WINDOWS MOBILE is Applicant's trademark for its operating system for hand-held computers, cell phones and other portable devices. Applicant owns U.S. Registration No. 2,988,040 for WINDOWS MOBILE for various software and hardware goods in class 9 and has disclaimed "Mobile" in that registration.</p> <p>Here, Applicant seeks registration of WINDOWS MOBILE, again with "Mobile" disclaimed, for services relating to its WINDOWS MOBILE operating system and devices that run WINDOWS MOBILE. In particular, Applicant seeks registration for:</p> <ul style="list-style-type: none">- communication services, namely, electronic transmission of data and documents among users of computers; electronic mail services; web messaging services; paging services; streaming of audio material on the Internet; wireless voice mail services; voice-activated dialing services; and providing wireless access to computer networks and the Internet <p>The Examining Attorney has refused registration of this application in its present form, asserting that "Windows" is merely descriptive of Applicant's services and therefore Applicant must claim 2(f) status for the Windows portion of this mark in order to secure registration. Applicant requests reconsideration and withdrawal of this refusal for the reasons explained below.</p> <p>Applicant began using the mark "Windows" for its operating system products and related goods and services in the mid-1980s. Windows was initially designed to run on IBM and IBM-compatible personal computers (PCs), and ran on top of the MS-DOS[®] operating system. Almost all PC software at that time had a character-based user interface, meaning users typed command words to make selections and little or no graphics were displayed on the computer screen. The original versions of Windows gave users, among numerous other features, a graphical user interface in which users used icons and pull-down menus to make selections, and applications were presented in graphical windows that could be moved around the screen and that had scroll bars for moving content within each window. When information is needed from a user, a dialog box appears prompting the user to provide the</p>	

needed information.

Graphical user interfaces have been an established standard for PC and other software since the introduction and widespread acceptance of Windows 95, released in 1995. Users think nothing of the fact that a program uses icons, graphical menus, dialog boxes and windows. The features are ubiquitous.

Microsoft sought registration for its Windows mark in 1990. At that time, Windows still ran on top of the MS-DOS operating system and a significant number of PCs still used character-based user interfaces. Microsoft secured U.S. Registration No. 1872264 under Section 2(f) after showing significant sales and consumer recognition of Windows as its trademark.

While Applicant acknowledged that “Windows” was merely descriptive of its goods in the 1980s and early 1990s, changes in the nature of the Windows product (it is now a complete, stand alone operating system) and the marketplace (having a graphical user interface is no longer a feature of note to consumers) are such that “Windows” is no longer merely descriptive of PC operating systems. The mark “Windows” conveys no reasonably accurate or tolerably distinct descriptive information about the goods. The fact that the goods use windows as part of their user interface, a ubiquitous feature found in virtually every modern PC software product, conveys nothing of significance about the goods. The only meaning conveyed by Windows is the trademark meaning that associates the goods with Applicant.

Applicant’s WINDOWS MOBILE operating system goods do not run on PCs, but instead operate on small hand-held computers, cell phones and other portable devices. The nature of these goods takes them even further away from any credible argument that Windows is merely descriptive of the goods. Unlike PC software where users may have several windows open on their computer screen to run different software programs, WINDOWS MOBILE users see a single screen.

Applicant files herewith as Exhibit 1, excerpts from a third party tutorial book for its Windows Mobile products, “Master VISUALLY Windows Mobile 2003” by Bill Landon, that shows screens a user would see doing various tasks. The second page of Exhibit 1 shows a typical Windows Mobile display on a hand-held computer. A single small screen displays a Notes application in use by the users.

Pages 106 and 107 of the Landon book show the series of screens seen by a user when working with the Calendar program in Windows Mobile. Pages 122 and 123 show screens seen by a user when working with Contacts. Pages 198 and 199 show screens seen when setting up a new Folder. These screen shots show that Applicant’s Windows Mobile goods use a graphical user interface with icons, menus and dialog boxes, but only a single display screen. There are no overlapping application windows – which was the basis on which Applicant’s Windows mark was considered merely descriptive of PC operating system products in the early 1990s. Thus, even if Windows is still considered merely descriptive for PC operating systems (which Applicant submits it is not, as explained above), there is no basis for it to be merely descriptive of goods like Windows Mobile. Indeed, as noted above, WINDOWS MOBILE has been registered with a 2(f) claim as to the Windows portion of the mark.

Similarly, Windows is not merely descriptive of the services for which registration is sought here. The inclusion of Windows in the mark tells users nothing descriptive about the

services. Its only meaning is the trademark meaning, which in combination with Mobile tells users that the services are associated with Applicant and its WINDOWS MOBILE products.

In *The Money Store, v. Harriscorp Finance*, 689 F.2d 666 (7th Cir. 1982), the court considered the mark THE MONEY STORE for an establishment involved in lending money. The court noted that the mark conveyed the idea of a commercial establishment whose services involve supplying money but that it did not convey the essence of the relevant business, money lending. *Id.* at 674. It then held that “[s]ome imagination and perception are...required to identify the precise nature of the services offered....”

In a similar case, the Board held that:

“THE MONEY SERVICE” is composed of commonly used words in the English language, it suggests a number of things, but yet falls short of describing applicant’s services in any one degree of particularity. ... In short, what we are saying is that applicant’s mark “THE MONEY SERVICE” does not directly or indirectly convey any vital purposes, characteristics or qualities of applicant’s services. Thus, the mark is a suggestive and not merely descriptive designation.

In re TMS Corp. of America, 200 U.S.P.Q. 57, 59 (T.T.A.B. 1978)

As stated in TMEP Section 1209.01(b):

To be registrable on the Principal Register, a mark does not have to be devoid of all meaning relative to the goods or services. It is not prohibited that a mark have the capacity to draw attention to what the product or its characteristics are. A term is suggestive if, when applied to the goods, it requires imagination, thought and perception to reach a conclusion as to the nature of the goods. A suggestive term, thus, differs from a descriptive term, which immediately tells something about the product. (Emphasis in the original.)

Also, as stated under TMEP Section 1209.01(b), to be refused registration under Section 2(e)(1) of the statute, a mark must be “merely” descriptive, and the term “merely” is to be taken in its ordinary meaning of “only” or “solely.” That is, when considered with the particular goods or services, the mark must, because of its meaning, do nothing but describe the goods.

In view of the above, Applicant submits that Windows is not merely descriptive of the services for which registration is sought here and therefore WINDOWS MOBILE is entitled to registration without Applicant claiming 2(f) status for the Windows portion of the mark. Thus, Applicant believes this application is in condition for allowance. If questions remain, the Examining Attorney is invited to contact Applicant's counsel, William O. Ferron, Jr., by email at BillF.docketing@SeedIP.com or by telephone at (206) 622-4900.

EVIDENCE SECTION

EVIDENCE FILE NAME

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784\410\78441047\xml1\RO A0002.JPG](#)

EVIDENCE FILE NAME	\\TICRS\EXPORT6\IMAGEOUT6 \784\410\78441047\xml1\RO A0003.JPG
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DESCRIPTION OF EVIDENCE FILE	Exhibit 1 - excerpts from a third party tutorial book for Applicant's Windows Mobile products.
SIGNATURE SECTION	
RESPONSE SIGNATURE	/WOF/
SIGNATORY NAME	William O. Ferron, Jr.
SIGNATORY POSITION	Attorney for Applicant
SIGNATURE DATE	03/13/2006
FILING INFORMATION SECTION	
SUBMIT DATE	Mon Mar 13 18:07:35 EST 2006
TEAS STAMP	USPTO/ROA-204.182.125.140 -20060313180735758957-784 41047-320b1edfada1da95347 e253e5652ec25-N/A-N/A-200 60313172723941134

Response to Office Action
To the Commissioner for Trademarks:

Application serial no. 78441047 has been amended as follows:

Argument(s)

In response to the substantive refusal(s), please note the following:

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- communication services, namely, electronic transmission of data and documents among users of computers; electronic mail services; web messaging services; paging services; streaming of audio material on the Internet; wireless voice mail services; voice-activated dialing services; and providing wireless access to computer networks and the Internet

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Evidence

Evidence in the nature of Exhibit 1 - excerpts from a third party tutorial book for Applicant's Windows Mobile products. has been attached.

[Evidence-1](#)

[Evidence-2](#)

[Evidence-3](#)

[Evidence-4](#)

[Evidence-5](#)

[Evidence-6](#)

[Evidence-7](#)

[Evidence-8](#)

Response Signature

Signature: /WOF/ Date: 03/13/2006

Signatory's Name: William O. Ferron, Jr.

Signatory's Position: Attorney for Applicant

Serial Number: 78441047

Internet Transmission Date: Mon Mar 13 18:07:35 EST 2006

TEAS Stamp: USPTO/ROA-204.182.125.140-20060313180735

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5652ec25-N/A-N/A-20060313172723941134



Read Less-Learn More®



MASTER VISUALLY®

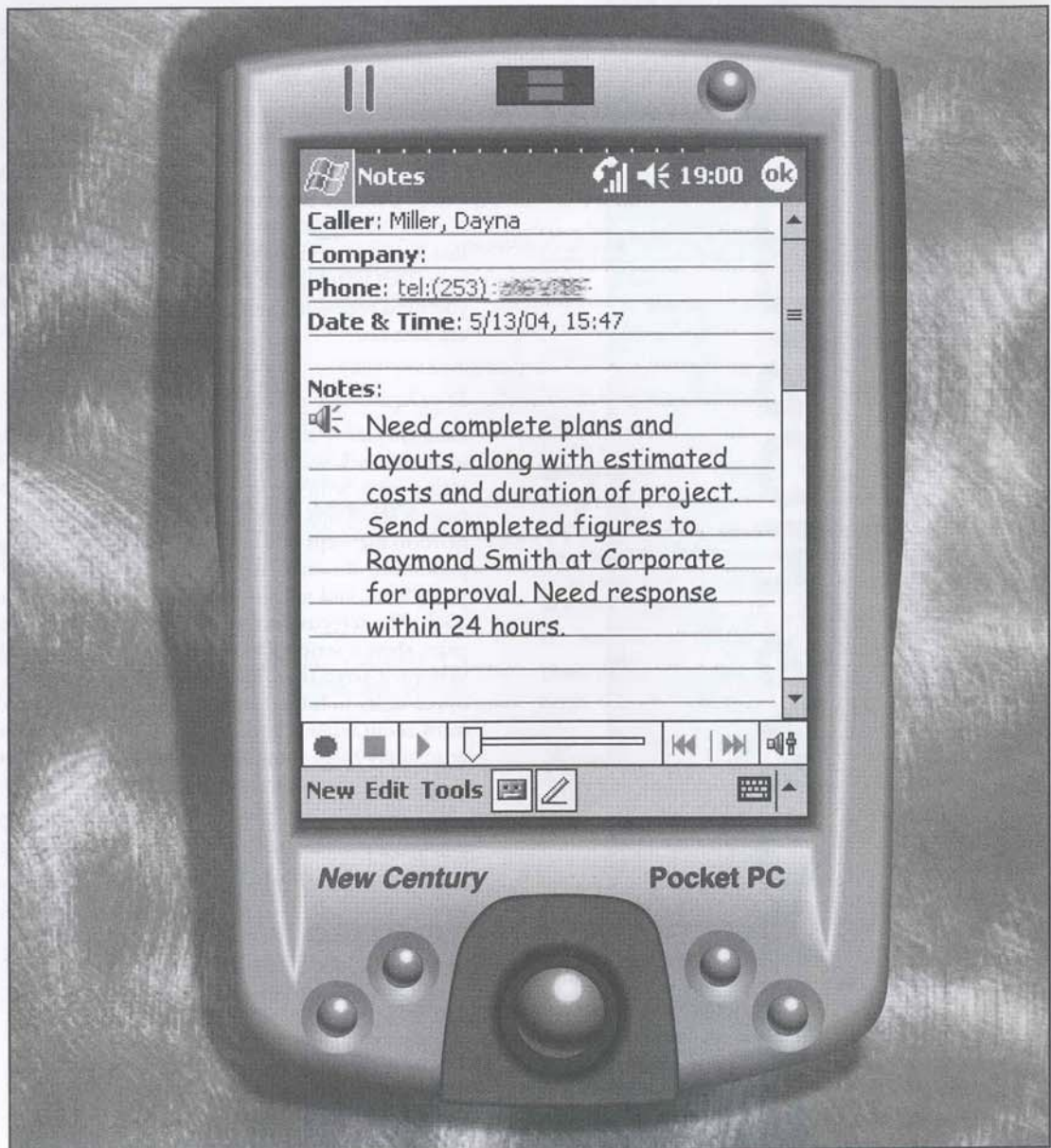
The Complete Visual Reference



- Start getting more from your Pocket PC!
- Step-by-step tutorials and screen shots show you how

Windows Mobile™ 2003

TABLE OF CONTENTS



DISPLAY THE CALENDAR AND APPOINTMENTS

The Calendar provides you with a complete list of your daily appointments. You can use the Calendar to view scheduled appointments, meetings, and other events. By default, the Calendar displays appointments that you have scheduled for the current day. You can also display your appointments for additional days. You can view your appointments by agenda, day, week, and month.

You can use the Agenda view to display a simplified list of all your appointments in an easy-to-read format. Upcoming appointments are displayed in bold, and previous days' appointments are displayed in gray. You can scroll through each day of appointments using the Agenda view.

You can view detailed appointment information in any view by simply tapping the appointment.

The Calendar also enables you to view all the days of the current month as well as the preceding and following months. The current day is displayed with a red pulsating outline in the Month view.

For your convenience, small blue arrows will indicate if there are more appointments above or below the current screen in the Day or Week views.

DISPLAY THE CALENDAR AND APPOINTMENTS

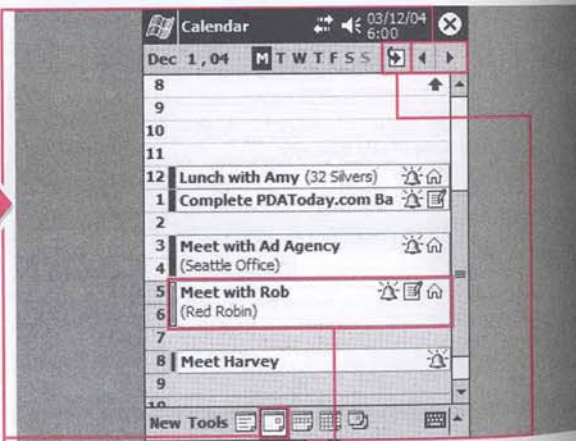


DISPLAY THE CALENDAR

1 Tap the Start menu.

2 Tap Calendar.

The calendar appears.



3 Tap the Day View button.

A detail of the day's calendar entries is displayed.

4 Tap the left or right arrows to change the day being viewed.

5 Tap the appointment that you want to display.

You can tap the Return arrow to go back to the current day.

Note: If you tap the date, the current month is displayed in a pick so that you can easily change months.



Why do past appointments still appear in the calendar?

- ✓ Past appointments can provide useful historical information when you have to refer back to earlier appointment information or need to track time spent on completed projects. You can delete previous appointments when they are no longer needed: Simply tap and hold the appointment and select Delete Appointment.

What do the boxes in the Calendar Week view indicate?

- ✓ A box indicates that an appointment has been made for the time shown. You can tap the box, and the appointment summary will be displayed.

In the Month view, what do the small triangles and squares represent?

- ✓ An upward triangle represents a morning appointment, and a downward triangle represents an afternoon appointment. A solid square is displayed if you have both morning and evening appointments. A hollow square is displayed for an all-day event.



■ A detailed display of your appointment is now shown, including notes.

6 Tap OK to return your last Calendar view mode.



CHANGE THE CALENDAR'S VIEW

1 Tap the button representing how you want to view the Calendar (by agenda, day, week, month, or year).

■ The new view appears.

Note: In certain views, you see small blue up and down arrows. These indicate an appointment above or below the current screen. You can scroll up or down to view them.

COPY, DELETE, AND BEAM CONTACTS

You can copy or delete contacts from your device with a couple quick taps. If you have multiple people in the same company that have the same address, phone number, and so on, then it is much easier to just copy one and change the name on the copy than to enter the same

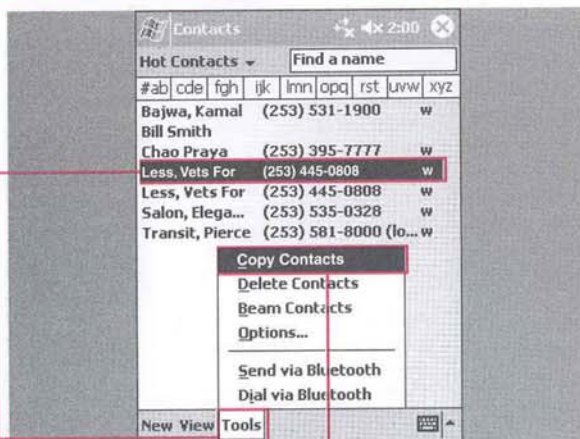
information several times for each contact. You may need to delete contacts if they leave jobs, move out of town, or simply no longer need to be in your contact list.

You can also beam contacts via infrared if you want to share information with fellow PDA

owners. Do not forget to align the infrared ports when beaming.

You can delete or beam a contact two different ways: by using the Tools menu from the Contacts list or by opening the contact and then using the Tools menu.

COPY, DELETE, AND BEAM CONTACTS



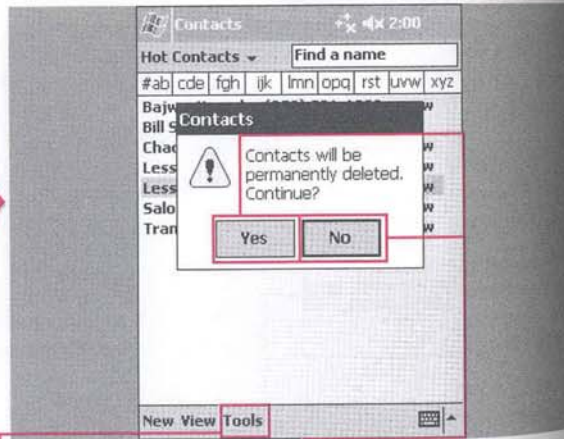
COPY A CONTACT

- 1 Select a contact without opening the editing window.
- 2 Tap Tools.
 - A menu with six items appears.

3 Tap Copy Contacts.

- A copy of the contact appears in the list.

Note: Nothing is added to the copied contact title to differentiate it from the original contact.



DELETE A CONTACT

- 4 Perform steps 1 and 2.
- 5 Tap Delete Contacts.
 - A dialog pop-up box appears asking if you are sure that you want to delete the contact.

6 Tap Yes.

- If you change your mind and do not want to delete the contact, you can tap No.
- The dialog box closes, and you are returned to the original list.



Can I beam a contact to a Palm PDA?

- ✓ Yes, Windows Mobile 2003 supports the OBEX infrared system, which enables you to beam a contact without any third-party software or utility.

Can I beam a contact to Pocket PCs not running Windows Mobile 2003?

- ✓ Yes, you can beam to devices running previous versions of the Pocket PC operating system.

Can I beam my virtual business card to others?

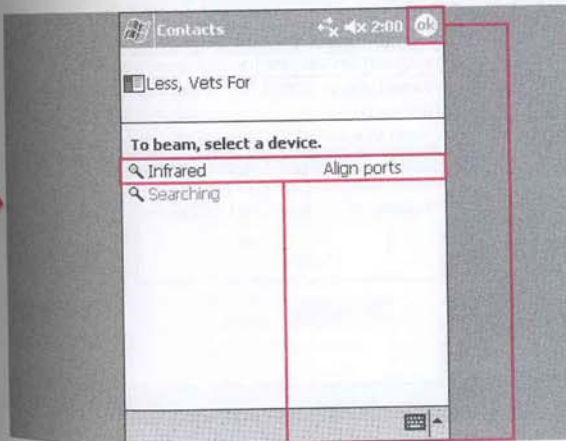
- ✓ Yes, Windows Mobile 2003 supports vCard exchange.

Can I copy a contact to another category?

- ✓ No, when you copy a contact, an exact duplicate is made and placed in the list with the existing contact. You can then edit the duplicate contact to reflect the changes that you want.

Can I delete, copy, or beam multiple contacts?

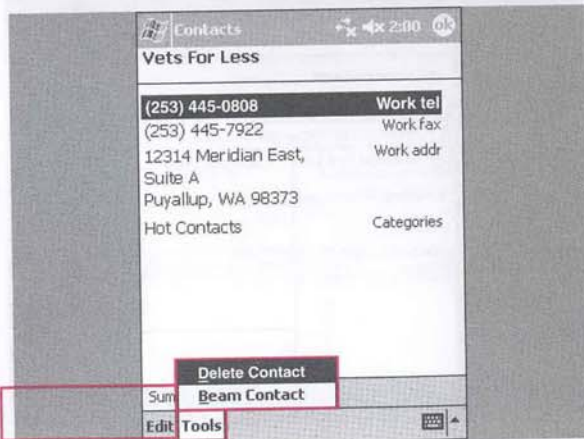
- ✓ Yes, tap and drag your stylus over the contacts and then tap and hold the highlighted section to access the menu with these options. You can also tap the Tools menu after making your selection.



BEAM A CONTACT

- 7 Perform steps 1 and 2.
- 8 Tap Beam Contacts.
 - The infrared beaming utility appears.

- 9 Align the ports of the two devices.
- 10 Tap the device name to which you want to beam the contact.
- 11 Tap OK to close the beaming utility.



DELETE OR BEAM WITH THE CONTACT OPEN

- 1 In the Contacts list, tap a contact to go the individual view screen.
- 2 Tap Tools.
- 3 Tap Delete Contact or Beam Contact to perform

- The delete dialog box or beaming utility appears, depending on your selection.
- If you are deleting a contact, tap Yes.
- If you are beaming a contact, perform steps 9 to 11.

CREATE A NEW FOLDER

You can create an unlimited number of folders to organize and file your data. The Windows, My Documents, Program Files, iPAQ File Store (or other accessible ROM file), and Temp folders are preloaded on your device. The Storage Card(s) folder

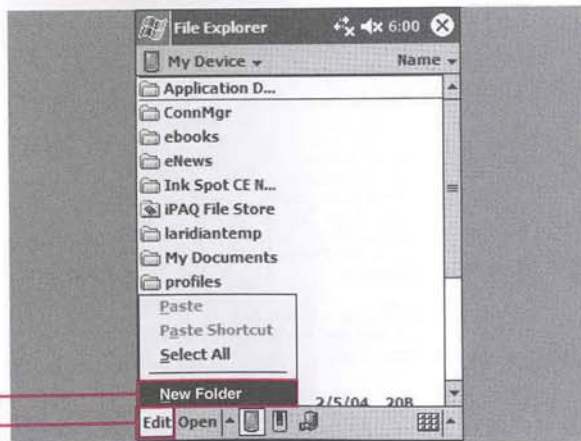
is automatically created when an external storage card is inserted into your device. The Windows folder cannot be deleted because it is a system folder and contains items found in the ROM. Some applications also add folders to your device when they are installed.



Can I have folders within folders?

- ✓ Yes, you can create a hierarchy of folders. For example, by default, there are a few levels of folders in the Windows directory installed on your device.

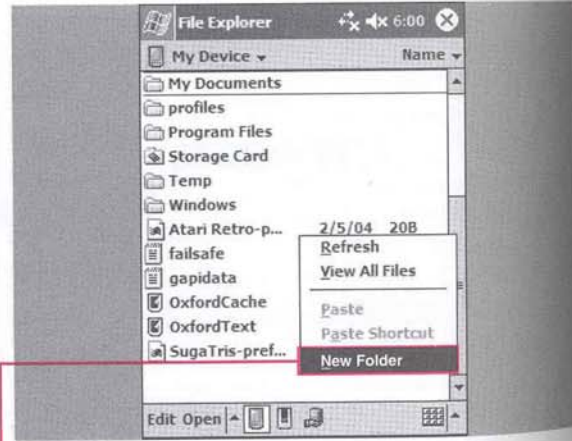
CREATE A NEW FOLDER



USING THE EDIT MENU

- 1 In File Explorer, tap Edit.
- 2 Tap New Folder.

- A folder named New Folder appears and is selected automatically.
- 3 Type a name for the new folder.
- The new folder is created.



USING A CONTEXTUAL MENU

- 1 Tap and hold anywhere in the window.
- A pop-up menu appears.
- 2 Tap New Folder.

- A folder named New Folder appears and is selected automatically.

- 3 Type a name for the new folder.

- The folder with the new name is selected.

Note: After you open and close File Explorer again, the new folder will be sorted with the other folders.

SORT A FILE LIST

You can have your folders and files sorted on your display using four different methods: You can sort them by name, date, size, or type. By default, files and folders are sorted by name in alphabetical order. Sorting files and folders can help you to quickly find a file, see when it was last modified, see how much memory it is consuming, and group files by their types.



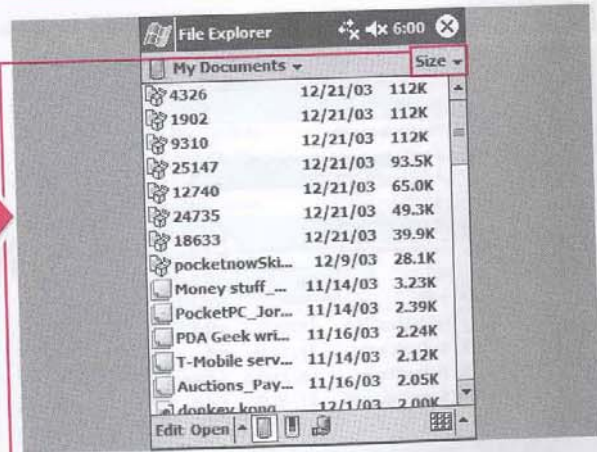
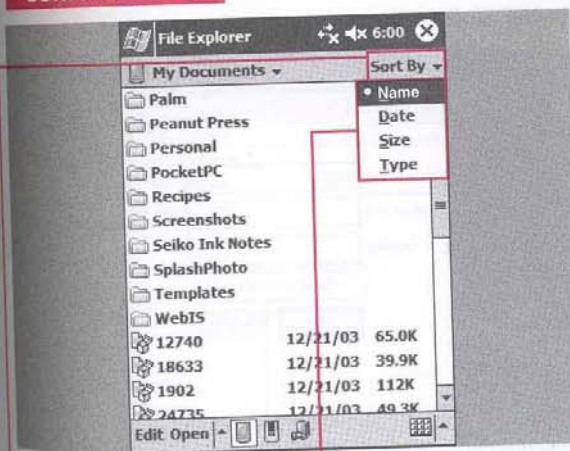
How does File Explorer sort folders?

✓ The folders are always grouped together and are either above or below all the files. The folders are always sorted by their name if you select Name, Type, or Size, and their order changes only if you select Date.

Is there any other way to access the sort function, aside from using the Sort By menu?

✓ No, a tap-and-hold option for sorting is not available.

SORT A FILE LIST



1 Tap Sort By.

■ A menu appears with Name, Date, Size, and Type.

2 Tap one of the four options to sort your files and folders.

■ The files and folders are sorted by the method that you selected.

3 Tap the current menu name.

■ The menu appears again.

4 Tap the same option that you chose in step 2.

■ The files and folders are sorted in reverse order.