

## **Filing Basis**

Applicant does not wish to rely on Section 44(e) as a filing basis for this application, but would like to retain the priority date of its foreign application under Section 44(d).

## **Likelihood of Confusion**

The examining attorney cited the following registrations as obstacles to registration under Section 2(d) of the Trademark Act:

- Netopia, Inc.'s FARALLON & Design (RN 1,606,264); and
- Farallon Consulting, LLC's FARALLON (RN 3,440,267).

Based on the records on file at the USPTO's website, Netopia's registration of FARALLON & Design (RN 1,606,264) was due for renewal on July 17, 2010, but was not renewed. The grace period for renewing the registration has expired, and the registration should therefore be formally cancelled by the USPTO in due course.

The examining attorney has cited Farallon Consulting's registration of FARALLON (RN 3,440,267) on the grounds that the goods covered by the Applicant's identification (namely, "computer hardware" and "computer software") are broad enough to encompass Farallon Consulting's goods ("apparatus for testing gas, liquids and solids"). Applicant respectfully disagrees with the assumption that testing "apparatus" should be interpreted to encompass computer software or hardware. The word "apparatus" appears in identifications in 17 different International Classes in the *Trademark Acceptable Identification of Goods and Services Manual*, not just in Class 9, so there is no implication that "apparatus" encompasses computer hardware or software. In Class 9, the word "computer" modifies "apparatus" in several identifications, making it clear that computers and apparatus are two different elements – for example, "computer hardware and software for medical imaging apparatus" and "computer-controlled sheet feeding apparatus." Two such identifications are specifically for testing apparatus -- "computer-controlled apparatus for testing and measuring" and "computer-controlled electronic apparatus for electrophysiological measurement and testing of cells" – so there is no implication that "apparatus" is computerized unless the word appears explicitly in the identification. Similarly, when testing apparatus in Class 9 is electronic, the word "electronic" modifies it in the Manual. See attached exhibit.

Thus, one cannot assume that a registration for "apparatus for testing gas, liquids and solids" covers either computer hardware or software, and the Farallon Consulting registration does not encompass computer goods. In any event, Applicant has now amended its identification to clarify the nature of the goods, making it even more obvious that this application does not overlap with the goods listed in Farallon Consulting's registration. Applicant therefore respectfully requests that the examining attorney withdraw the Section 2(d) refusal, and approve the application for publication.

tess2.uspto.gov/netacgi/nph-brs?sect2=THESOFF&sect3=PLURON&s1=(APPARATUS)+AND+(A[ST]+OR+M[ST]+OR+X[ST])&l=MAX&sect1=IDMLIC		
90	009	Carrying cases specially adapted for electronic equipment, namely, {specify type of electronic equipment, e.g., printers, computers, cell phones, etc.} [excluding gaming apparatus]
91	009	Carrying cases, holders, protective cases and stands featuring power supply connectors, adaptors, speakers and battery charging devices, specially adapted for use with handheld digital electronic devices, namely, {indicate specific device, e.g., cell phones, MP3 players, personal digital assistants, etc.} [excluding gaming apparatus]
92	009	Cases for photographic apparatus
93	009	Casings and casing parts for electrical equipment, namely, housing for switching apparatus
94	009	Cell culture apparatus for laboratory use, namely, {specify items, e.g., cell culture dishes, tissue culture flasks, etc.}
95	009	Change-over switches [for telecommunication apparatus]
96	009	Chemical vapor deposition apparatus for use in research
97	009	Choking coils for use in electrical apparatus
98	009	Chromatography apparatus for laboratory use
99	009	Cinematographic machines and apparatus
100	009	Clear protective covers specially adapted for personal electronic devices, namely, {indicate specific device, e.g., cell phones, MP3 players, personal digital assistants, etc.} [excluding gaming apparatus]
101	009	Computer apparatus, namely, a converter that superimposes an Ethernet signal on an existing cable
102	009	Computer based apparatus for designing the layout of electronic circuits
103	009	Computer hardware and software for medical imaging apparatus
104	009	Computer peripheral apparatus
105	009	Computer-controlled sheet-feeding apparatus
106	009	Computer-controlled apparatus for testing and measuring {specify, e.g., radio frequency signals, concentrations of gas and liquids, audio signals} [not for medical purposes]
107	009	Computer-controlled electronic apparatus for electrophysiological measurement and testing of cells
108	009	Continuity test apparatus for electrical circuits
109	009	Data acquisition apparatus

tess2.uspto.gov/netacgi/nph-brs?sect2=THESOFF&sect3=PLURON&s1=(testing+apparatus)+AND+(A[ST]+OR+M[ST]+OR+X[ST])&l=MAX&sect1=		
1	009	Apparatus for testing gas, liquids and solids
2	009	Calibration devices for calibrating Industrial X-ray apparatus in the nature of testing equipment for determining industrial flaws
3	009	Computer-controlled apparatus for testing and measuring {specify, e.g., radio frequency signals, concentrations of gas and liquids, audio signals} [not for medical purposes]
4	009	Computer-controlled electronic apparatus for electrophysiological measurement and testing of cells
5	009	Diagnostic apparatus for testing food
6	009	Electrical apparatus for testing the state of operability of electronic sirens and public address systems
7	009	Electronic apparatus for testing the electrical conductivity of {indicate goods being tested, e.g., medical hydrogel electrodes, etc.}
8	009	Electronic apparatus for testing automobile engine oil
9	009	Electronic apparatus for testing the sterility of pharmaceuticals and injectable solutions
10	009	Electronic apparatus for testing the sterility of medical equipment
11	009	Electronic apparatus for electropysiological measurement and testing of cells
12	009	Electronic apparatus and instruments for controlling, adjusting and testing of drives and motors
13	009	Electronic apparatus for testing the curing and drying of elastomeric materials
14	009	Electronic apparatus for testing compression, strength, hardness and tensile characteristics of industrial materials
15	009	Electronic testing equipment, namely, telecommunication line integrity testing apparatus
16	009	Industrial X-ray apparatus in the nature of testing equipment for determining industrial flaws
17	009	