

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Microsoft Corporation  
Serial No.: 87/473,722  
Mark: WINDOWS  
Class: 9, 38, 41, 42  
Office Action Date: August 22, 2017  
Examiner: Meredith Maresca (L.O. 109)

**RESPONSE TO  
OFFICE ACTION**

This response ("Response") to the Office Action issued August 22, 2017 ("Office Action") regarding the application by Microsoft Corporation ("Applicant") for registration of the mark WINDOWS ("Mark") in Class 9, 38, 31 and 42 ("Application") addresses the following issues:

1. The request by the Examining Attorney ("Examiner") to clarify the goods and services covered by the Application ("Goods and Services");
2. The refusal of the Application as merely descriptive under Section 2(e)(1); and
3. The potential refusal in view of U.S. Application Serial Nos. 86944001, 87396792 and 87401547.

Based on the response to these issues below, Applicant respectfully requests that the Examiner approve the Application for publication on the Principal Register.

**I. AMENDMENTS**

Applicant amends the Goods and Services in the Application as follows (added language shown underlined and language removed shown ~~[[in brackets]]~~ or ~~struck through~~).

**Class 9:** Computers, tablets tablet computers, laptops; ~~computer software~~; software developer kits; portable electronic devices for receiving and reading text, images and sound through wireless internet access, namely, electronic book readers, MP3 players,

mobile computers, portable computers, mobile phones; computer software for use in connection with the transmission of voice and data; computer software used for controlling stand-alone voice controlled information devices, namely, cloud-connected and voice-controlled smart devices to monitor and control the functioning of household and electronic devices; ~~voice and data~~ electronic and wireless transmitters and receivers for transmitting and receiving voice and data; voice processing software, namely, software for the control of voice controlled information and communication devices; voice-activated software, namely, software for controlling stand-alone voice controlled information devices comprised of cloud-connected and voice-controlled information devices; voice-activated software, namely, software for controlling stand-alone voice controlled information devices comprised of cloud-connected and voice controlled smart devices with virtual personal assistant capabilities; Mixed-reality computing platforms for integrating real world and virtual reality environments; computer software for creating, uploading, and sharing 3D images and models; Malware protection software; Software for securing access to laptops, phones, and computers; facial recognition software; fingerprint recognition software; iris recognition software; software that enables a user to hand-write notes and text with a digital pen onto touch-enabled devices; software that interprets hand-written content on touch-enabled devices; computer software for creating, editing, uploading and sharing digital drawing-applications; software that allows for annotations to image via digital ink; software ~~that allows for~~ connecting a smartphone or tablet computer to ~~attach to~~ a monitor, mouse, and keyboard and project the desktop to the monitor.

**Class 38:** ~~Broadcasting and~~ Electronic transmission of voice, data, images, music, audio, video, multimedia, television, and radio by internet and cellular telephone transmission broadcasting; broadcast and electronic transmission of streamed music, audio, video, and multimedia content; subscription and pay-per-view television broadcasting and electronic data transmission services; cellular electronic transmission of mail, electronic messaging, electronic data transmission, audioconferencing, and videoconferencing services; providing access to telecommunications networks, computer networks, the Internet, satellite communications, wireless communications networks, and cable television; providing access to websites, databases, electronic bulletin boards, on-line forums, directories, music, and video and audio programs; communication by computer; information, advisory and consultancy services relating to all the aforesaid.

**Class 41:** ~~Educational services;~~ Education services, namely, arranging, organizing, conducting, and presenting educational seminars, workshops, classes, non-downloadable webinars, educational conferences, online instruction, and distance learning programs, all in the field of technology, computing, productivity, mixed reality, education, gaming, and creative arts; production, distribution, and presentation of radio programs, television programs, motion pictures, sound recordings; entertainment services, namely, providing ongoing television, radio, audio, non-downloadable video, podcast, and webcast programs, all in the field of entertainment, sports, musical, current events, art, culture, technology, computing, productivity, mixed reality, education, gaming, and creative arts; entertainment services, namely, providing entertainment, sports, music, ~~informational~~, news, and current events continuing programs by means of telecommunications

networks, computer networks, the Internet, satellite, radio, wireless communications networks, television, and cable television; providing a website featuring non-downloadable videos in the field of entertainment, sports, music, ~~informational~~, news, and current events; entertainment services, namely, providing a continuing program featuring educational, entertainment, sports, music, ~~informational~~, news, current events, and arts and culture accessible by means of the internet and web-based computer applications; entertainment services, namely, providing a continuing program featuring information in the field of education, entertainment, music, sports, news, and arts and culture accessible by means of the internet and web-based computer applications; entertainment services, namely, providing temporary use of non-downloadable computer games, electronic games, interactive games, and video games; providing a website and web-based applications featuring non-downloadable books, periodicals, newspapers, newsletters, manuals, blogs, journals, and magazines and articles in the field of entertainment, sports, musical, current events, art, culture, technology, computing, productivity, mixed reality, education, gaming, and creative arts.

**Class 42:** ~~Non-downloadable computer game programs;~~ Providing on-line non-downloadable computer programs for monitoring automobile performance, for mapping and navigation, for transmitting and receiving electronic mail and wireless communications, and for maintaining personal directories, contact lists, address and telephone number lists; Providing on-line non-downloadable computer programs for accessing global communication networks; Providing on-line non-downloadable computer programs for accessing global communication networks and displaying content therefrom; ~~and a full line of~~ providing on-line non-downloadable web-based business application programs for e-mail, internet access, calendaring, creating and editing documents, note-taking, project management, electronic publishing, presentations, storytelling, business intelligence, database management, and productivity; design and development of computer hardware and software; computer services, namely remote hosting of operating systems and computer applications for others; providing hosted operating systems and computer applications through the internet; rental of computing and data storage facilities of variable capacity; providing, developing and designing on-line non-downloadable software accessible over a global computer network for managing computer applications; constructing in the nature of designing and building a computer an internet platform on the internet for electronic commerce for others; ~~designing,~~ managing and monitoring the websites of others that feature online discussion forums ~~for discussion;~~ ~~creating~~ designing and developing electronically stored web pages for online services on the internet; data warehousing; elaboration and maintenance of web sites for third parties; managing web sites for others; rental of web servers; web site maintenance, creation and hosting services for others; application service provider, namely, providing, hosting, managing, developing and maintaining applications, software, websites and databases in the fields of ecommerce, online payments, order queuing, website design, data storage, shared computing capacity scaling, messaging services and calculation of website ranking based on user traffic.

Applicant believes that the amendments above should be acceptable because they clarify the original identification, do not expand or add different goods to the original identification, and conform with the Examiner's suggestion. 37 C.F.R. § 2.71(a); T.M.E.P. § 1402.06.

Applicant further adds the following services in a new class:

Class 35 (proposed): Arranging and conducting business seminars and business conference in the field of technology.

Applicant believes that the amendments above should be acceptable because the items originally recited are properly classified in a class not originally indicated, and the Applicant is submitting the additional fee necessary for the new class. T.M.E.P. § 1403.02(c).

## **II. RESPONSE**

### **A. The Amended Goods/Services Are Specific, Definite and Clear**

The Examiner has requested an amendment to the Application to clarify the Goods and Services. In response, Applicant has amended the Goods and Services to conform in large part with the Examiner's suggestion. Applicant's amendment is acceptable under the Trademark Manual of Examining Procedure because it clarifies the description and does not expand nor add different goods or services. Accordingly, Applicant believes that the amendment above should be acceptable and that the description of goods and services as amended is sufficiently specific, definite, and clear. *See* 37 C.F.R. § 2.71(a); T.M.E.P. § 1402.01, 1402.06.

Applicant respectfully disagrees that certain specific amendments requested by the Examiner are necessary. Specifically, the Examiner has requested that Applicant clarify the following terms, which Applicant submits are sufficiently clear:

- “providing access to websites, databases, electronic bulletin boards, on-line forums, directories, music, and video and audio programs;”
- “communication by computer;”

- “design and development of computer hardware and software; computer services, namely remote hosting of operating systems and computer applications for others;” and
- “providing hosted operating systems and computer applications through the internet;”

Regarding the first term, Applicant refers the Examiner to comparable language accepted, for example, in U.S. Registration Nos. 5399679 (“Providing access to databases”) and 5209941 (“providing access to websites, databases, electronic bulletin boards, online forums, directories, music, and audio and video content programs on the Internet by means of telecommunications networks.”). Regarding the second term, the additional term by “terminal” proposed by the Examiner is unnecessary insofar as “computer” is sufficiently precise. Regarding the last two terms, Applicant submits that the nature or function of the computer applications provided to customers should not require specification as Applicant may provide such software without limitation to nature or function. For these reasons, Applicant respectfully requests that the Examiner withdraw these requests for amendments to the Goods and Services.

**B. The Mark is Not Merely Descriptive for the Goods and Services Covered by the Application**

The Examiner has refused the Application under Section 2(e)(1) as merely descriptive for the Goods and Services covered by the Application. The Examiner specifically argued that the singular form “Window” refers to “a rectangular area on a screen in which a document, database, or application can be viewed independently of other such areas.” Applicant respectfully disagrees and requests that the Examiner withdraw this refusal.

Although the software goods and services covered by the Application will necessarily appear on a display screen, “windows” does not describe a feature or function of the Goods and

Services covered by the Application. Rather, the term “WINDOWS” is arbitrary with respect to the functionality of the software goods and services covered by the Application and refers to Applicant’s well-known trademark, which informs consumers that the goods and services are associated with Applicant.

To this point, the USPTO has issued numerous registrations for marks including the wording WINDOWS to this Applicant in connection with computer software goods and services without requiring a disclaimer of said wording, a claim of acquired distinctiveness, or amendment to the Supplemental Register. Examples of such registrations are provided below:

<b>Mark</b>	<b>Reg. No. Reg. Date</b>	<b>Relevant Goods / Services</b>
WINDOWS HELLO	535544 December 12, 2017	<p><u>Class 9</u>: Computer software, namely, security software, user authentication software, password management and protection software for mobile digital electronic devices and computing devices.</p> <p><u>Class 42</u>: Online computer services, namely, online scanning, detecting, managing and authenticating security and log in credentials for users of mobile digital electronic devices and computing devices; software as a service (SaaS) services featuring security software, user authentication software, password and log in management and protection software.</p>
WINDOWS INK	5279659 September 5, 2017	<p><u>Class 9</u>: Computer software for processing, creating, editing, importing, exporting, and sending user interfaces, web pages, software applications, digital media, graphics, drawings, text, and images; Computer software for integrating digital media, graphics, drawings, text, and images with and into other software programs and applications.</p>
WINDOWS PHONE	4389703 August 20, 2013	<p><u>Class 9</u>: Computer software for wireless telecommunications for use with wireless devices.</p>

Mark	Reg. No. Reg. Date	Relevant Goods / Services
WINDOWS	4407849 September 24, 2013	<u>Class 9</u> : computer software for wireless telecommunications for use with wireless devices; computer operating system software for wireless communication devices.
WINDOWS INTUNE	4127544 April 17, 2012	<p><u>Class 9</u>: Computer software for providing remote access to computer systems within a designated network for the purpose of administering, monitoring, and auditing computer systems and software; computer software for use in delivering and deploying software applications and data over computer networks; computer software for diagnosing and repairing software problems; computer software for scanning, detecting, quarantining and eliminating harmful and unauthorized data and programs from computer systems and electronic devices.</p> <p><u>Class 42</u>: Non-downloadable online software for the purpose of administering, monitoring, and auditing computer systems and computer networks; non-downloadable online software for use in the delivery of software applications and data over computer networks; computer services, namely, troubleshooting in the nature of diagnosing computer software problems; computer services, namely, on-line scanning, detecting, quarantining and eliminating harmful and unauthorized data and programs from computer systems and electronic devices.</p>
WINDOWS POWERSHELL	3769421 March 30, 2010	<u>Class 9</u> : Computer software for administration of computer networks; and computer software development tools for use by computer network administrators
WINDOWS CARDSpace	3424624 May 6, 2008	<u>Class 9</u> : operating system software and utilities; computer software for managing user's personal, financial and credit information; and computer software for entering, viewing and editing data to be supplied to online vendors and other websites.

Mark	Reg. No. Reg. Date	Relevant Goods / Services
WINDOWS LIVE	3999208 July 19, 2011	<u>Class 42</u> : computer services, namely, hosting and maintaining web sites for others.
WINDOWS SERVER	3056149 January 31, 2006	<u>Class 9</u> : Operating system programs; computer programs, namely, operating system programs and utility programs for messaging and file sharing; computer programs for distributed relational database management and development; operating system programs; computer software for use by computer network administrators to deploy and manage application software and network server software; computer network server software for managing user content on computer networks and global computer networks; computer software for managing secure communications over computer networks and global computer networks; computer software for managing communications between computer networks and wireless networks; computer software for developing, managing and operating intranet sites; computer network operating software and utilities; computer software development tools for network servers and applications; computer software for inventorying and monitoring computer hardware and software assets and use within an organization

Copies of the TSDR records for the aforementioned registrations are attached as **Exhibit A**.

Thus, Applicant respectfully submits that WINDOWS is not merely descriptive of the Goods and Services covered by the Application, and therefore the refusal under Section 2(e)(1) should be withdrawn.

**C. The Potential Refusals Under Section 2(d) Should Be Withdrawn**

The Examiner has cited U.S. Trademark Application Nos. 86944001, 87396792 and 87401547 (collectively, the “Cited Applications”) as potential bases for refusal of the



Application under Section 2(d). While Applicant reserves the right to present additional arguments in the event that the Examiner later issues a refusal under Section 2(d), Applicant respectfully submits that none of the cited applications provides a basis for refusal of the Application.

With respect to U.S. Trademark Application No. 86944001 (the “‘001 Application”), Applicant has reached an agreement with applicant QBEATS, Inc. (“QBEATS”) regarding the cited application as set forth in the Trademark Registration Consent agreement attached as **Exhibit B**. Pursuant to this agreement, QBEATS has agreed to amend its mark as filed in the ‘001 Application to PAYWINDOW, and given that anticipated amendment as well as Microsoft’s well-established rights to the WINDOWS mark, the parties have concluded that the use and registration of the WINDOWS and PAYWINDOW marks by the parties for the parties’ respective offerings is unlikely to cause confusion. As such, the parties mutually consent to the registration of their respective marks, and Applicant respectfully submits that the Examiner should withdraw the ‘001 Application from consideration as a potential basis for refusal under Section 2(d). *See* T.M.E.P. § 1207.01(d)(viii).

With respect to U.S. Trademark Application Nos. 87396792 and 87401547 for WINDOWS CLASSIC and WINDOWS 8, respectively, Applicant notes that both third party applications have been refused by the USPTO in view of Applicant’s prior, well-established rights to the famous WINDOWS mark in connection with various software goods and services. Applicant . Indeed, the deadlines to respond to these refusals have passed for both applications without a response from the respective applicants, and as a result, a Notice of Abandonment was issued for U.S. Trademark Application No. 87396792 on February 5, 2018, and should be forthcoming for U.S. Trademark Application No. 87401547 shortly.

Thus, in view of the aforementioned developments with respect to each of the Cited Applications, Applicant respectfully submits that none of the Cited Applications present a basis for refusal of the Application under Section 2(d).

### **III. CONCLUSION**

Based upon the foregoing, Applicant submits that it has addressed each of the issues raised in the Office Action and respectfully requests that the Mark be allowed to proceed to publication. If there are any remaining concerns with respect to this application, please contact the Attorney of Record.