

IN RE APPLICATIONS OF T-MOBILE USA, INC.
SERIAL NOS. 88/129751, 88/129835 AND 88/129830
FILED OCTOBER 17, 2018

Applicant, by its legal counsel, responds to the office actions dated October 17, 2018.

Applicant has applied to register the marks METRO (Serial No. 88/129751), METRO (stylized) (Serial No. 88/129835), and METRO (stylized) (Serial No. 88/129830) ("Metro Applications"), in the following International Classes and for the following goods and services:

IC 009. Wireless telephones; cellular telephones; smartphones; wireless local area networks access points configured as onboard diagnostic system dongles; onboard diagnostic system dongles that provide wireless connectivity to a cellular telecommunications network; internet of things (IoT) devices; SIM cards; memory cards; memory card readers; carrying cases for wireless telecommunications devices; gel skins in the nature of rubber coverings for protecting wireless telephones and smartphones; removable back covers for wireless phones and smartphones; protective transparent display coverings, namely, plastic transparent films for covering and providing a scratch proof barrier or protection for displays on wireless telephones and smartphones; USB cables; high-definition multimedia interface adapters and cables; wired and wireless hands-free microphone and earphone adapters; stereo headphones; ear buds; ear bud covers; car battery chargers; wall battery chargers; power adaptors; belt clip holsters for carrying wireless phones and smartphones; docking stations for recharging of wireless phones and smartphones; in-vehicle holders for holding and charging wireless phones and smartphones; fitted wireless phone and smartphone pouches; near field communications (NFC) tags; downloadable data files consisting of audio, video and multimedia works containing music and ringtones; software for use in controlling and monitoring prepaid wireless services; software for mobile wallet services and mobile commerce; software for downloading and playing data files consisting of audio recordings of voicemail messages; software for locating, triggering an alarm on, locking access to, erasing data and media on and initiation of backup of data and media on misplaced or stolen wireless telecommunications devices; software for blocking incoming telephonic and data communications from third parties; software for receiving and presenting text, audio, images and video consisting of updates and information relating to news, sports, entertainment, weather, cellular telecommunications products and services, contests, promotions and discounts; software for monitoring the location of onboard diagnostic system dongles and providing updates and alerts concerning the location of onboard diagnostic system dongles; software for receiving and viewing updates and alerts concerning performance metrics of motor vehicles; software for receiving and viewing updates and alerts concerning the driving behavior of motor vehicle operators; computer software for establishing geofencing boundaries, establishing rules for the generation of alerts associated with geofenced boundaries, and receiving and viewing alerts associated with geofenced boundaries; computer software for receiving and viewing motor vehicle trip data

IC 035. Retail store services and online retail store services in the field of wireless telecommunications devices, accessories and services; online retail store services featuring downloadable data files consisting of audio, video and multimedia works

IC 036. Cellular telecommunications rate plans; prepaid cellular telecommunications calling card services; cellular telecommunications payment services; insurance administration services for

mobile telecommunications devices; providing extended warranties for mobile telecommunications devices; financing of purchases; equipment financing services; bill payment services; cellular telecommunications payment services, namely, cellular rate plans that exempt music streaming data from cellular rate plan data limits; cellular telecommunications payment services, namely, an adjustable cellular rate plan payment feature that permits a cellular subscriber to exempt data consisting of streamed video content from cellular rate plan data limitations via an opt-in/opt-out interface that activates or deactivates a video resolution limitation

IC 038. Cellular telecommunications services, namely, transmission of voice, audio, data, text, images, video, music, information, facsimiles, advertising, gaming and graphics via cellular telecommunications networks and the Internet; cellular telecommunications services, namely, two-way real-time transmission of voice, audio, video and data between wireless telecommunications devices; text messaging services; multimedia messaging services; providing multiple-user access to a global computer network; providing technical support regarding the usage of cellular telecommunications services and equipment; wireless roaming services; electronic mail services; ringback tone services; electronic voice messaging services, namely, recording and subsequent transmission of audio messages and transmitting textual transcriptions of audio messages; cellular telecommunications services, namely, filtering and blocking of incoming voice telecommunications; cellular telecommunications services, namely, providing transmission of text, audio, images and video content consisting of updates and information relating to news, sports, entertainment, weather, cellular telecommunications products and services, contests, promotions and discounts over a cellular telecommunications network; wireless telecommunications services, namely, providing cellular telecommunications network connectivity to a cellular-enabled onboard diagnostic system dongle; wireless telecommunications services, namely, transmitting data consisting of updates and alerts concerning performance metrics of motor vehicles, the driving behavior of motor vehicle operators, motor vehicle location and trip information, and driver performance information

The Examiner has initially refused registration on the following bases:

- Prior-filed application for the mark METROIQ (Serial No. 87909599).
- Partial refusal based on likelihood of confusion (Lanham Act Section 2(d)) citing the following registrations:
 - o METROCALL (U.S. Trademark Reg. No. 2885673) (“Opposed Registration”)
 - o METRO (U.S. Trademark Reg. No. 4244478)
 - o METROCONNECT (U.S. Trademark Reg. No. 4724220)
 - o METROX (U.S. Trademark Reg. No. 4397687)
 - o METRO (U.S. Trademark Reg. No. 5037298)

The Examiner has additionally required the amendment and clarification of the foregoing goods and services identifications.

ARGUMENT

Applicant herewith amends the identification in substantial compliance with the Examiner's proposed amendments. Applicant believes that the identifications, as amended, resolve the Examiner's concerns regarding the cited registrations identified above (excluding the Opposed Registration).

Applicant notes that the prior filed application for the mark METROIQ (Serial No. 87909599) has been abandoned.

Applicant notes that, on January 17, 2019, Applicant filed a Petition to Cancel the Opposed Registration and U.S. Trademark Reg. No. 1124767, both for the mark METROCALL. Registrant/Respondent failed to answer the petition by the March 4, 2019 deadline and, on March 14, 2019, the Trademark Trial and Appeals Board issued a Notice of Default. (See attached evidence.) Applicant requests that further examination of the Metro Applications be suspended until such time as the Opposed Registration is cancelled.