

Mark: XBOX SERIES X
Application No.: 88956509
Classes: 9, 28, 41
OA Date: July 10, 2020

The examining attorney (“examiner”) requested clarification of goods and services, a disclaimer of SERIES apart from the mark XBOX SERIES X (“Mark”), and information regarding the claimed bases in the Application. In response, Applicant clarifies applied-for goods and services and provides the following arguments to refute the disclaimer requirement.

1. Clarification of Goods and Services

Applicant submits clarification of goods and services in Classes 9, 28, and 41 as provided in the TEAS form.

2. No Disclaimer Is Required Because the Mark is Unitary

XBOX SERIES X is a unitary mark that suggests the nature of Applicant’s goods and services. A mark is considered ‘unitary’ when it creates a commercial impression separate and apart from its individual elements. *See* TMEP § 1213.05. The examiner is required to consider the possible significance of the mark (as a whole) to the average purchaser of the identified goods or services in the relevant marketplace. *In re Chamber of Commerce of the U.S.*, 102 U.S.P.Q.2d 127 (Fed. Cir. 2012). Applicant is well known for its gaming goods and services under the XBOX brand. Over the years, Applicant has released goods and provided services under XBOX, XBOX 360, and XBOX ONE and variations thereof. *See* <https://altarofgaming.com/xbox-console-list/>, attached as Exhibit A. These brand names represent different generations of the XBOX console and associated controllers, games, and services. It follows that potential purchasers (game enthusiasts) will understand the term “XBOX SERIES X” to suggest a new generation of Applicant’s console, controllers, games and services. *See In re Colonial Stores Inc.*, 394 F.2d 549, 157 USPQ 382 (CCPA 1968) (noting that determining whether a mark is suggestive or merely descriptive depends on what the mark would mean to a potential consumer when applied to applicant’s goods).

Similarly, “XBOX SERIES” and “SERIES X” are unitary phrases each of which suggest a different generation of Applicant’s goods and services. *Id.* Applicant notes that the word “series” is inextricably linked to other words in the Mark to form phrases with different meanings. *See* TMEP § 1213.05.

The Mark as a whole has a different meaning and commercial impression than individual words in the Mark. XBOX denotes the first generation of Applicant’s game-related goods and services, and the word “series” means “a group or a number of similar things arranged in a row.” *See* evidence attached to the Office Action.¹ However, in the context of Applicant’s goods and services, the Mark XBOX SERIES X suggests a new generation of Applicant’s console, controller and related goods and services. Moreover, as noted above, “XBOX SERIES” and “SERIES X” are unitary phrases that suggest the new generation of Applicant’s game console,

¹ Applicant disagrees with the examiner that the word “series” as defined in the examiner’s evidence is merely descriptive of Applicant’s applied-for goods and services.

controller and related goods and services. Potential consumers will have a different commercial impression of the Mark as a whole and the unitary phrases in the Mark as compared to the individual words in the Mark. Accordingly, no disclaimer of any word in the Mark is required. *See* TMEP § 1213.05 (noting that if the mark or relevant portion of the mark is unitary, no disclaimer of an element in the mark or relevant portion of the mark is required); *see, e.g., In re Simmons Co.*, 189 USPQ 352 (TTAB 1976) (THE HARD LINE found to be registrable as a unitary phrase for mattresses and bed springs); *In re Delaware Punch Co.*, 186 USPQ 63 (TTAB 1975) (THE SOFT PUNCH found to be registrable as a unitary phrase for noncarbonated soft drinks).

3. Bases Warning

The examiner noted that the application claims 1(b) and 44(e) [sic] bases and that the application will not mature to registration until an acceptable allegation of use has been filed for the goods and/or services based on Section 1(b).

As discussed with the examiner, we note that the current bases claimed are 1(b) and 44(d) and we direct the examiner to the following explanation in the Application:

At this time, the applicant has another basis for registration (Section 1(a) or Section 1(b)) and does NOT intend to rely on Section 44(e) as the basis for registration, but is only asserting a valid claim of priority. The application should not be suspended to await the submission of the foreign registration.

4. Conclusion

Based on the foregoing, Applicant requests that the examiner withdraw the disclaimer requirement and approve the Application.