

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Mobi, Inc.
Serial No.: 90589514
Filed: March 19, 2021
Mark: MOBI
Int. Class 38
Examining Attorney: Candace W. Hays
Law Office: 110

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

RESPONSE TO OFFICE ACTION

Dear Commissioner:

This is in response to an Office Action dated November 4, 2021 for the mark MOBI, U.S. Serial No. 90589514 ("Applicant's Mark"). In this response, Applicant responds to the citation to MOBIWEB, U.S. Reg. No. 6407948, and MOBIWEB MAKING THE WORLD SEEM SMALLER! & Design, U.S. Reg. No. 6407949, for "Providing Internet access; communication by computer terminals; Internet service provider services; providing voice chat services; providing on-line chat rooms for social networking; telephone voice messaging services; instant messaging services; provision of voice short message services (VSMS); wireless telephone telecommunications services, namely, wireless mobile telephone calling plans; telecommunications reseller services for businesses, namely, providing long distance telecommunication services, voice telecommunication services, local telephone service, and Internet access services," owned

by Mobiweb Telecom Limited (the "Cited Registrations") as a bar to registration of Applicant's Mark for "Wireless telephone telecommunications services, namely, wireless mobile telephone calling plans."

REMARKS

I. Petition for Cancellation

On April 29, 2022, Applicant filed a Petition for Cancellation against the Cited Registrations, based on Applicant's use of Applicant's Mark prior to the date of first use set forth in the Cited Registrations, and the fact that Mobiweb Technologies Limited had not used the Cited Registrations in connection with certain goods and services listed in the Cited Registrations prior to filing its applications (the "Cancellation Proceeding").¹ Accordingly, Applicant respectfully requests that the Examining Attorney suspend further action on the Application until the termination of the Cancellation Proceeding. *See* TMEP § 716.02(a).

In the alternative, Applicant respectfully submits that there is no likelihood of confusion between Applicant's Mark and the Cited Registrations, and accordingly Applicant's Mark should be approved for publication.

II. No Likelihood of Confusion

The Examining Attorney has initially refused registration of Applicant's Mark on grounds that it is likely to be confused with the Cited Registrations. Applicant respectfully submits that, upon consideration of the relevant likelihood of confusion factors, there is no likelihood of confusion between Applicant's Mark and the Cited

¹ While the Cancellation Proceeding has not yet been officially initialized, attached hereto as Exhibit A is a true and correct copy of the Petition for Cancellation Filed with the TTAB.

Registrations. Factors negating any likelihood of confusion here include (i) the different commercial impressions conveyed by Applicant's Mark and the Cited Registrations, (ii) the coexistence of other federally registered marks that bear greater similarity than the Applicant's Mark to the Cited Registration, (iii) the differences in the respective channels of trade, (iv) the sophistication of the relevant consumers, and (v) the absence of any evidence of actual confusion. See, e.g., E. I. Du Pont DeNemours & Co., 476 F.2d 1357 (C.C.P.A. 1973) (enumerating likelihood-of-confusion factors).

A. The Commercial Impression of the Parties' Marks Differ

Applicant respectfully submits that the Examining Attorney was incorrect in determining that the Applicant's Mark and the Cited Registrations are confusingly similar in terms of commercial impression, and in particular that the Examining Attorney did not appropriately factor in the inclusion of the term "web" in the Cited Registrations.

While both Applicant's Mark and the Cited Registrations contain the term "Mobi," which suggests a connection to mobile telephone services, the inclusion of the suffix "web" in the Cited Registrations conveys an additional association with the internet (which association is absent from Applicant's Mark). Thus, whereas the commercial impression conveyed by Applicant's Mark focuses exclusively on mobile phone services, the commercial impression conveyed by the Cited Registrations suggests a connection with *both* mobile phone services and the internet.

This difference in commercial impression is reinforced by the actual services offered by the parties—Applicant provides traditional mobile phone telecommunication services (*see, e.g.,* <https://mobi.com/about/>), whereas the Cited Registrations are used primarily in connection with SMS text messaging services, including the provision of

"virtual" mobile numbers using internet functionality. *See, e.g.,* <https://www.solutions4mobiles.com/products/2-way-sms>.

In sum, the important addition of "web" to the Cited Registrations entirely changes their meaning and creates a distinct commercial impression, dissimilar to that created by Applicant's Mark. *See Tricia Guild Assocs. LTD*, 38 U.S.P.Q.2d at 1316 ("[W]hile the marks DESIGNERS GUILD and THE DESIGN GUILD share similarities which are too obvious to discuss, nevertheless, the differences, however slight, are sufficient to 'convey different connotations and commercial impressions.>"). Similarly, different numbers of syllables in the relevant marks militates in favor of a finding of no likelihood of confusion. *See, e.g., StonCor Grp., Inc. v. Specialty Coatings, Inc.*, 759 F.3d 1327, 1332 (Fed. Cir. 2014) (stating that the "differing number of syllables in the two complete marks" supported the finding that no likelihood of confusion existed). Here, Applicant's Mark contains only two syllables, whereas the Cited Registrations contain three syllables each, thus further counseling against a finding of confusion.

B. The Cited Registrations are Entitled to a Narrow Scope of Protection

Applicant submits that the Cited Registrations have coexisted on the Principal Register with other third-party registrations and applications that in some way arguably relate to the telecommunications industry or related fields that include the term "Mobi," evidencing that the Cited Registrations are diluted and entitled to only a narrow scope of protection. These coexisting federal registrations include:

Mark	Reg. No.	Goods
Mobie	4897749	Computer application software for mobile phones
Mobi	4163711	Inventory management in the field of wireless

		communication devices; Software as a service for use in managing and monitoring wireless communication device inventory
Mobi	3813777	Maintenance of wireless telephone and wireless communication devices
Mobi	3866639	Support services for wireless devices
Mobi	3730878	Wireless communication device accessories
Mobie	4873856	Computer application software for mobile phones
Moby	5985721	Computer software for communicating with users of hand-held computers; computer application software for mobile phones
Mobii	5566162	Downloadable computer software in the nature of a mobile application
Mobiecom	5863582	Software as a service for optimization of ecommerce websites on mobile devices
Mobinar	4909364	Internet services; telecommunication services
Mobioos	5608979	Internet provision services; telecommunication services
Mobisys	4033339	Electronic data transmission of business process software systems; rental of telecommunication apparatus for business process software systems

The numerous third-party marks in other telecommunication and computer software classes, as well as other related fields, containing the term "Mobi" are relevant to show that the Cited Registrations are "relatively weak and entitled to only a narrow scope of protection," and would not be confused with different marks, such as the Applicant's Mark. Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée

En 1772, 396 F.3d 1369, 1373 (Fed. Cir. 2005); see also Standard Brands Inc. v. Peters, 191 U.S.P.Q. 168, 172 (T.T.A.B. 1976) ("the limited orbit of protection to be afforded (trademarked) term is clearly revealed by third-party registrations").

C. The Respective Channels of Trade Differ Significantly

The SMS-focused, enterprise solution services offered under the Cited Registrations are marketed toward business. *See, e.g.*, <https://www.solutions4mobiles.com/>. In fact, all services offered by Mobiweb Technologies Limited, the owner of the Cited Registrations, are intended for use by businesses or other enterprise customers. *See id.* Applicant's services, by contrast, are marketed specifically toward individual mobile phone users. There is no likelihood that a customer seeking to purchase a suite of enterprise solutions for communicating with a business's customers—primarily by SMS messaging—would be confused into contacting Applicant's wireless company. Similarly, there is no likelihood that an individual seeking a new personal cellphone plan would contact Mobiweb Technologies Limited, which does not offer any services for individual customers, nor any traditional mobile telecommunication services at all.

D. Sophistication of Customers Obviates Likelihood of Confusion

Applicant submits that consumers will readily understand the distinction between Applicant's Mark and the Cited Registrations, and the services offered thereunder. The consumers of the enterprise solutions offered under the Cited Registrations apparently must undertake an extensive process of registering an account and discussing their needs with Mobiweb Technologies Limited prior to receiving any information on pricing or plans. *See* <http://sms.solutions4mobiles.com/accounts/register.php?cta=>. Such consumers are likely to be sophisticated and cost-conscious, and conduct substantial

research before investing in a service for their business. As such, it is highly unlikely that such a sophisticated consumer, spending significant amounts of time and money on the services offered under the Cited Registrations, would be misled into thinking that Applicant's Mark is related to the Cited Registrations. Similarly, it is highly unlikely that any of Applicant's customers, who are looking for simple and affordable mobile phone plans would be confused into believing that Mobiweb Technologies Limited's enterprise services or the Cited Registrations were related to Applicant's services or Applicant's Mark.

E. Absence of Actual Confusion

Applicant submits that confusion is not likely here, as Applicant has been using Applicant's Mark since at least as early as 2006, and greatly expanded its U.S.-wide use in 2018, and is unaware of any actual confusion between Applicant's Mark and the Cited Registrations. Accordingly, given that the marks have coexisted in the market for at least 18 months without any instances of actual confusion, Applicant submits that any future confusion is not likely.

* * *

For all the foregoing reasons, there is no likelihood of confusion between Applicant's Mark and the Cited Mark.

CONCLUSION

In light of the above remarks, Applicant respectfully requests that the Examining Attorney approve Applicant's Mark for publication.

Date: May 3, 2022

Respectfully Submitted,

/Bruce Goldner/

Bruce Goldner

M. Oren Epstein

David M. Lamb

SKADDEN, ARPS, SLATE,

MEAGHER & FLOM LLP

One Manhattan West

New York, New York 10001

Telephone: (212) 735-3000

Attorneys for Applicant

Exhibit A

4. The U.S. Patent And Trademark Office Examining Attorney who has reviewed the Applications has refused to publish the Applications for opposition and has cited Registration Nos. 6407948 and 6407949 as the basis for such refusal.

Petitioner's Priority in the Marks

5. The Registrations list October 3, 2020 as the first use in commerce date. Attached hereto as Exhibit B is a true and correct printout from the United States Patent And Trademark Office Trademark Status & Document Retrieval (TSDR) reflecting the Registrations.

6. This first use date postdates Petitioner's first use in commerce, including as reflected in the Hawai'i Registration, by at least 2 years. Attached hereto as Exhibit C is a true and correct copy of the Hawai'i Registration.

7. Accordingly, to the extent there is a likelihood of confusion between the Registrations and Petitioner's marks as reflected in the Applications, Petitioner has priority, and the Registrations are subject to cancellation pursuant to 15 U.S.C. §§ 1052(d) and 1064(1).

Registrant's Non-Use of Mark In Commerce Before Application

8. The Registrations claim that the Registrants' mark was purportedly used in connection with, *inter alia*: (i) "Providing Internet access;" (ii) "Internet service provider services;" and (iii) "wireless telephone telecommunications services, namely, wireless mobile telephone calling plans" prior to the filing date. *See* Exhibit B.

9. Upon information and belief, Registrant did not use the marks covered by the Registrations in U.S. commerce, or any similar mark, in connection with such goods or services prior to filing for the Registrations, nor does Registrant use the marks covered by the Registrations in U.S. commerce in connection with such goods or services currently.

10. Accordingly, the Registrations are void *ab initio* and are subject to cancellation pursuant to 15 U.S.C. §§ 1051(a)-(d) and 1064(1).

Injury to Petitioner

11. Petitioner is and will continue to be injured and damaged by the existence of the Registrations because it is preventing Petitioner's Applications from proceeding to registration. Petitioner therefore has a real interest in seeking cancellation of the Registrations and standing to bring this action.

Relief Requested

WHEREFORE, Petitioner requests that the Registrations be cancelled in their entirety and that this Petition For Cancellation be sustained in favor of Petitioner.

Dated: April 29, 2022

Respectfully submitted,

/M. Oren Epstein/
Bruce Goldner
M. Oren Epstein
David M. Lamb
SKADDEN, ARPS, SLATE,
MEAGHER & FLOM LLP
One Manhattan West
New York, New York 10001
Telephone: (212) 735-3000
Attorneys for Petitioner Mobi, Inc.

Exhibit A

Generated on: This page was generated by TSDR on 2022-04-29 18:02:08 EDT

Mark: MOBI

Mobi

US Serial Number: 90589514

Application Filing Date: Mar. 19, 2021

Filed as TEAS Plus: Yes

Currently TEAS Plus: Yes

Register: Principal

Mark Type: Service Mark

TM5 Common Status Descriptor:



LIVE/APPLICATION/Under Examination

The trademark application has been accepted by the Office (has met the minimum filing requirements) and that this application has been assigned to an examiner.

Status: A non-final Office action has been sent (issued) to the applicant. This is a letter from the examining attorney requiring additional information and/or making an initial refusal. The applicant must respond to this Office action. To view all documents in this file, click on the Trademark Document Retrieval link at the top of this page.

Status Date: Nov. 04, 2021

Mark Information

Mark Literal Elements: MOBI

Standard Character Claim: Yes. The mark consists of standard characters without claim to any particular font style, size, or color.

Mark Drawing Type: 4 - STANDARD CHARACTER MARK

Goods and Services

Note:

The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis ((..)) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- Asterisks *..* identify additional (new) wording in the goods/services.

For: Wireless telephone telecommunications services, namely, wireless mobile telephone calling plans

International Class(es): 038 - Primary Class

U.S Class(es): 100, 101, 104

Class Status: ACTIVE

Basis: 1(a)

First Use: Sep. 15, 2005

Use in Commerce: Jan. 03, 2006

Basis Information (Case Level)

Filed Use: Yes

Currently Use: Yes

Filed ITU: No

Currently ITU: No

Filed 44D: No

Currently 44E: No

Filed 44E: No

Currently 66A: No

Filed 66A: No

Currently No Basis: No

Filed No Basis: No

Current Owner(s) Information

Owner Name: Mobi, Inc.

Owner Address: 1668 South King St Ste 101
Honolulu, HAWAII UNITED STATES 96826

Legal Entity Type: CORPORATION

State or Country HAWAII
Where Organized:

Attorney/Correspondence Information

Attorney of Record - None

Correspondent

Correspondent Name/Address: MOBI, INC.
1668 SOUTH KING ST STE 101
HONOLULU, HAWAII UNITED STATES 96826

Phone: 808-723-2000

Correspondent e-mail: justen@mobi.com notifications@trademarkengine.com

Correspondent e-mail Authorized: Yes

Domestic Representative - Not Found

Prosecution History

Date	Description	Proceeding Number
Nov. 04, 2021	NOTIFICATION OF NON-FINAL ACTION E-MAILED	6325
Nov. 04, 2021	NON-FINAL ACTION E-MAILED	6325
Nov. 04, 2021	NON-FINAL ACTION WRITTEN	95354
Oct. 22, 2021	ASSIGNED TO EXAMINER	95354
Jun. 22, 2021	NEW APPLICATION OFFICE SUPPLIED DATA ENTERED IN TRAM	
Mar. 23, 2021	NEW APPLICATION ENTERED IN TRAM	

TM Staff and Location Information

TM Staff Information

TM Attorney: HAYS, CANDACE W

Law Office Assigned: LAW OFFICE 110

File Location

Current Location: TMO LAW OFFICE 110 - EXAMINING
ATTORNEY ASSIGNED

Date in Location: Nov. 04, 2021

Generated on: This page was generated by TSDR on 2022-04-29 18:03:55 EDT

Mark: M MOBI



US Serial Number: 90678746

Application Filing Date: Apr. 28, 2021

Filed as TEAS Plus: Yes

Currently TEAS Plus: Yes

Register: Principal

Mark Type: Service Mark

TM5 Common Status Descriptor:



LIVE/APPLICATION/Under Examination

The trademark application has been accepted by the Office (has met the minimum filing requirements) and that this application has been assigned to an examiner.

Status: A non-final Office action has been sent (issued) to the applicant. This is a letter from the examining attorney requiring additional information and/or making an initial refusal. The applicant must respond to this Office action. To view all documents in this file, click on the Trademark Document Retrieval link at the top of this page.

Status Date: Nov. 04, 2021

Mark Information

Mark Literal Elements: M MOBI

Standard Character Claim: No

Mark Drawing Type: 3 - AN ILLUSTRATION DRAWING WHICH INCLUDES WORD(S)/ LETTER(S)/NUMBER(S)

Description of Mark: The mark consists of The mark consists of a stylized letter "M" above the word "Mobi," with the tittle of the lowercase "i" and the right stem of the letter "M" forming a design element to represent a wireless signal.

Design Search Code(s): 24,19,04 - Curved lines, bars, or wave symbol indicating mobile internet, radio, or wireless communication access or service signal; Wireless communication symbol

Goods and Services

Note:

The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis (..) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- Asterisks *..* identify additional (new) wording in the goods/services.

For: Wireless telephone telecommunications services, namely, wireless mobile telephone calling plans

International Class(es): 038 - Primary Class

U.S Class(es): 100, 101, 104

Class Status: ACTIVE

Basis: 1(a)

First Use: Mar. 07, 2018

Use in Commerce: Mar. 14, 2018

Basis Information (Case Level)

Filed Use: Yes

Currently Use: Yes

Filed ITU: No

Currently ITU: No

Filed 44D: No

Currently 44E: No

Filed 44E: No

Currently 66A: No

Filed 66A: No

Currently No Basis: No

Filed No Basis: No

Current Owner(s) Information

Owner Name: Mobi, Inc.

Owner Address: 1668 South King St Ste 101
Honolulu, HAWAII UNITED STATES 96826

Legal Entity Type: CORPORATION

State or Country Where Organized: HAWAII

Attorney/Correspondence Information

Attorney of Record - None

Correspondent

Correspondent Name/Address: MOBI, INC.
1668 SOUTH KING ST STE 101
HONOLULU, HAWAII UNITED STATES 96826

Phone: 808-723-2000

Correspondent e-mail: justen@mobi.com notifications@trademarkengine.com

Correspondent e-mail Authorized: Yes

Domestic Representative - Not Found

Prosecution History

Date	Description	Proceeding Number
Nov. 04, 2021	NOTIFICATION OF NON-FINAL ACTION E-MAILED	6325
Nov. 04, 2021	NON-FINAL ACTION E-MAILED	6325
Nov. 04, 2021	NON-FINAL ACTION WRITTEN	95354
Oct. 22, 2021	ASSIGNED TO EXAMINER	95354
Aug. 04, 2021	NOTICE OF DESIGN SEARCH CODE E-MAILED	
Aug. 03, 2021	NEW APPLICATION OFFICE SUPPLIED DATA ENTERED IN TRAM	
May 01, 2021	NEW APPLICATION ENTERED IN TRAM	

TM Staff and Location Information

TM Staff Information

TM Attorney: HAYS, CANDACE W

Law Office Assigned: LAW OFFICE 110

File Location

Current Location: TMO LAW OFFICE 110 - EXAMINING ATTORNEY ASSIGNED

Date in Location: Nov. 04, 2021

Exhibit B

Generated on: This page was generated by TSDR on 2022-04-29 18:17:11 EDT

Mark: MOBIWEB

US Serial Number: 90233543

Application Filing Date: Oct. 03, 2020

US Registration Number: 6407948

Registration Date: Jul. 06, 2021

Register: Principal

Mark Type: Service Mark

TM5 Common Status Descriptor:



LIVE/REGISTRATION/Issued and Active

The trademark application has been registered with the Office.

Status: Registered. The registration date is used to determine when post-registration maintenance documents are due.

Status Date: Jul. 06, 2021

Publication Date: Apr. 20, 2021

Mark Information

Mark Literal Elements: MOBIWEB

Standard Character Claim: Yes. The mark consists of standard characters without claim to any particular font style, size, or color.

Mark Drawing Type: 4 - STANDARD CHARACTER MARK

Goods and Services

Note:

The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis ((.)) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- Asterisks *..* identify additional (new) wording in the goods/services.

For: Providing Internet access; communication by computer terminals; Internet service provider services; providing voice chat services; providing on-line chat rooms for social networking; telephone voice messaging services; instant messaging services; provision of voice short message services (VSMS); wireless telephone telecommunications services, namely, wireless mobile telephone calling plans; telecommunications reseller services for businesses, namely, providing long distance telecommunication services, voice telecommunication services, local telephone service, and Internet access services

International Class(es): 038 - Primary Class

U.S Class(es): 100, 101, 104

Class Status: ACTIVE

Basis: 1(a)

First Use: Oct. 03, 2020

Use in Commerce: Oct. 03, 2020

Basis Information (Case Level)

Filed Use: Yes

Currently Use: Yes

Filed ITU: No

Currently ITU: No

Filed 44D: No

Currently 44E: No

Filed 44E: No

Currently 66A: No

Filed 66A: No

Currently No Basis: No

Filed No Basis: No

Current Owner(s) Information

Owner Name: MOBIWEB TELECOM LIMITED

Owner Address: Third Floor
207 Regent Street
London, London UNITED KINGDOM W1B3HH

Legal Entity Type: limited company (Ltd.)

State or Country Where Organized: UNITED KINGDOM

Attorney/Correspondence Information

Attorney of Record

Attorney Name: Jeremy Peter Green

Attorney Primary Email Address: docket@jpglegal.com

Attorney Email Authorized: Yes

Correspondent

Correspondent Name/Address: Jeremy Peter Green
JPG LEGAL
68 JAY STREET
SUITE 612
BROOKLYN, NEW YORK UNITED STATES 11201

Phone: 917-268-7054

Correspondent e-mail: docket@jpglegal.com

Correspondent e-mail Authorized: Yes

Domestic Representative - Not Found

Prosecution History

Date	Description	Proceeding Number
Jul. 06, 2021	REGISTERED-PRINCIPAL REGISTER	
Apr. 20, 2021	OFFICIAL GAZETTE PUBLICATION CONFIRMATION E-MAILED	
Apr. 20, 2021	PUBLISHED FOR OPPOSITION	
Mar. 31, 2021	NOTIFICATION OF NOTICE OF PUBLICATION E-MAILED	
Mar. 18, 2021	APPROVED FOR PUB - PRINCIPAL REGISTER	
Mar. 17, 2021	TEAS/EMAIL CORRESPONDENCE ENTERED	88889
Mar. 16, 2021	CORRESPONDENCE RECEIVED IN LAW OFFICE	88889
Mar. 16, 2021	TEAS RESPONSE TO OFFICE ACTION RECEIVED	
Mar. 01, 2021	NOTIFICATION OF NON-FINAL ACTION E-MAILED	6325
Mar. 01, 2021	NON-FINAL ACTION E-MAILED	6325
Mar. 01, 2021	NON-FINAL ACTION WRITTEN	69195
Mar. 01, 2021	ASSIGNED TO EXAMINER	69195
Nov. 18, 2020	NEW APPLICATION OFFICE SUPPLIED DATA ENTERED IN TRAM	
Oct. 07, 2020	NEW APPLICATION ENTERED IN TRAM	

TM Staff and Location Information

TM Staff Information - None

File Location

Current Location: PUBLICATION AND ISSUE SECTION

Date in Location: Jul. 06, 2021

Generated on: This page was generated by TSDR on 2022-04-29 18:18:50 EDT

Mark: MOBIWEB MAKING THE WORLD SEEM SMALLER!



US Serial Number: 90233549

Application Filing Date: Oct. 03, 2020

US Registration Number: 6407949

Registration Date: Jul. 06, 2021

Register: Principal

Mark Type: Service Mark

TM5 Common Status Descriptor:



LIVE/REGISTRATION/Issued and Active

The trademark application has been registered with the Office.

Status: Registered. The registration date is used to determine when post-registration maintenance documents are due.

Status Date: Jul. 06, 2021

Publication Date: Apr. 20, 2021

Mark Information

Mark Literal Elements: MOBIWEB MAKING THE WORLD SEEM SMALLER!

Standard Character Claim: No

Mark Drawing Type: 3 - AN ILLUSTRATION DRAWING WHICH INCLUDES WORD(S)/ LETTER(S)/NUMBER(S)

Description of Mark: The mark consists of the stylized wording "MOBIWEB", with the "MOBI" in thin blue font, the "WEB" in double lined orange font, underneath this wording, the phrase "MAKING THE WORLD SEEM SMALLER!" appears in blue in small simple font. Over the "M" in "MOBI" on the top right is a trail of application squares descending in size to the left appearing in light blue.

Color(s) Claimed: The color(s) light blue, blue and orange is/are claimed as a feature of the mark.

Design Search Code(s): 26.09.14 - Three or more squares; Squares, three or more
26.09.21 - Squares that are completely or partially shaded

Goods and Services

Note:

The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis ((...)) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- Asterisks *...* identify additional (new) wording in the goods/services.

For: Providing Internet access; communication by computer terminals; Internet service provider services; providing voice chat services; providing on-line chat rooms for social networking; telephone voice messaging services; instant messaging services; provision of voice short message services (VSMS); wireless telephone telecommunications services, namely, wireless mobile telephone calling plans; telecommunications reseller services for businesses, namely, providing long distance telecommunication services, voice telecommunication services, local telephone service, and Internet access services

International Class(es): 038 - Primary Class

U.S Class(es): 100, 101, 104

Class Status: ACTIVE

Basis: 1(a)

First Use: Oct. 03, 2020

Use in Commerce: Oct. 03, 2020

Basis Information (Case Level)

Filed Use: Yes

Currently Use: Yes

Filed ITU: No

Currently ITU: No

Filed 44D: No

Currently 44E: No

Filed 44E: No

Currently 66A: No

Filed 66A: No

Currently No Basis: No

Filed No Basis: No

Current Owner(s) Information

Owner Name: MOBIWEB TELECOM LIMITED

Owner Address: Third Floor
207 Regent Street
London, London UNITED KINGDOM W1B3HH

Legal Entity Type: limited company (Ltd.)

State or Country Where Organized: UNITED KINGDOM

Attorney/Correspondence Information

Attorney of Record

Attorney Name: Jeremy Peter Green

Attorney Primary Email Address: docket@jpglegal.com

Attorney Email Authorized: Yes

Correspondent

Correspondent Name/Address: Jeremy Peter Green
JPG LEGAL
68 JAY STREET
SUITE 612
BROOKLYN, NEW YORK UNITED STATES 11201

Phone: 917-268-7054

Correspondent e-mail: docket@jpglegal.com

Correspondent e-mail Authorized: Yes

Domestic Representative - Not Found

Prosecution History

Date	Description	Proceeding Number
Jul. 06, 2021	REGISTERED-PRINCIPAL REGISTER	
Apr. 20, 2021	OFFICIAL GAZETTE PUBLICATION CONFIRMATION E-MAILED	
Apr. 20, 2021	PUBLISHED FOR OPPOSITION	
Mar. 31, 2021	NOTIFICATION OF NOTICE OF PUBLICATION E-MAILED	
Mar. 18, 2021	APPROVED FOR PUB - PRINCIPAL REGISTER	
Mar. 17, 2021	TEAS/EMAIL CORRESPONDENCE ENTERED	88889
Mar. 16, 2021	CORRESPONDENCE RECEIVED IN LAW OFFICE	88889
Mar. 16, 2021	TEAS RESPONSE TO OFFICE ACTION RECEIVED	
Mar. 01, 2021	NOTIFICATION OF NON-FINAL ACTION E-MAILED	6325
Mar. 01, 2021	NON-FINAL ACTION E-MAILED	6325
Mar. 01, 2021	NON-FINAL ACTION WRITTEN	69195
Mar. 01, 2021	ASSIGNED TO EXAMINER	69195
Nov. 19, 2020	NOTICE OF DESIGN SEARCH CODE E-MAILED	
Nov. 18, 2020	NEW APPLICATION OFFICE SUPPLIED DATA ENTERED IN TRAM	
Oct. 07, 2020	NEW APPLICATION ENTERED IN TRAM	

TM Staff and Location Information

TM Staff Information - None

File Location

Current Location: PUBLICATION AND ISSUE SECTION

Date in Location: Jul. 06, 2021

Exhibit C

FILED 02/08/2018 07:03 PM
Business Registration Division
DEPT. OF COMMERCE AND
CONSUMER AFFAIRS
State of Hawaii

STATE OF HAWAII
DEPARTMENT OF COMMERCE AND CONSUMER AFFAIRS
Business Registration Division
335 Merchant Street
Mailing Address: P.O. Box 40, Honolulu, Hawaii 96810
Phone No. (808) 586-2727



APPLICATION FOR REGISTRATION OF SERVICE MARK

(Chapter 482, Hawaii Revised Statutes)

PLEASE TYPE OR PRINT LEGIBLY IN BLACK INK

J.B. 1. Applicant's Name: MOBIPCS LLC 184882 C5
Business Address: 307 KAMANI ST, STE A, HONOLULU, HI 96813, USA
(including city, state, and zip code)

2. Registration is (check one): New OR Renewal (Certificate No. _____)

3. Status of Applicant (check only one): Sole Proprietor Corporation Partnership LLC LLP
 Unincorporated Association OR Other (explain): _____

4. If applicant is an entity, list state or country of incorporation/formation/organization: HAWAII

5. Service Mark is specifically described as: MOBI

6. Service mark is being used in connection with the following services: TELECOMMUNICATIONS SERVICES; HIGH SPEED WIRELESS
TRANSMISSION OF VOICE, DATA, AND MESSAGING SERVICES; CELLULAR VOICE, DATA, MESSAGING AND FACSIMILE SERVICES; ELECTRONIC TRANSMISSION OF MESSAGES AND DATA; PROVIDING ELECTRONIC MAIL SERVICES.

7. State the mode or manner in which the service mark is being used in connection with the services provided: BUSINESS CARDS,
LETTERHEAD, SIGNAGE, ADVERTISING, PROMOTIONAL MATERIALS, ELECTRONIC COMMUNICATIONS, WEBSITES, AND OTHER MARKETING OR BRANDED MATERIALS.

8. State the classification for this service mark: 38
(See instructions on reverse side - only one classification per application allowed)

9. Date mark first used anywhere: 09-15-2005; Date mark first used in Hawaii: 09-15-2005

I certify, under the penalties set forth in Section 482-3.5, Hawaii Revised Statutes, that (check one): I am the applicant OR

I am the MANAGER OF THE APPLICANT NAMED IN THE of the applicant named in the foregoing application, that the applicant is the owner of the
(Office Held)
mark, that I am authorized to sign this application, and to the best of my knowledge and belief, the mark has been and is still in use, that no other person has registered, either federally or in this State, or has the right to use, the mark either in the identical form thereof or in such near resemblance thereto as to be likely, when applied to the services of the other person, to cause confusion, to cause mistake, or to device, and that the above statements are true and correct.

JUSTEN BURDETTE

JUSTEN BURDETTE

02-08-2018

(Print Name)

(Signature)

(Date)

SEE INSTRUCTIONS ON REVERSE SIDE

(DEPARTMENTAL USE ONLY)

Certificate of Registration No. 4199085

CERTIFICATE OF REGISTRATION OF SERVICE MARK

In accordance with the provisions of Chapter 482, Hawaii Revised Statutes, this Certificate of Registration is issued to secure the aforesaid applicant the use of the said SERVICE MARK throughout the State of Hawaii for the term of five years from February 8, 2018 to February 7, 2023.

REGISTRATION OF A SERVICE MARK WITH THE DEPARTMENT DOES NOT GRANT YOU OWNERSHIP OF THE SERVICE MARK

DEPARTMENT OF COMMERCE AND CONSUMER AFFAIRS
STATE OF HAWAII
Dated: February 8, 2018
Catharine P. O'Neal
DIRECTOR OF COMMERCE AND CONSUMER AFFAIRS
(Director of Commerce and Consumer Affairs)
April 29, 2022
\$48 (Fee)
\$16 (SH)

I HEREBY CERTIFY that this is a true and correct copy of the official record(s) of the Business Registration Division.

02/08/201847586

SPECIMEN

The screenshot shows a web browser window with the URL <https://mobicps.com/mobi/AboutUs/tuoid/2018/Default.aspx>. The page features the Mobi PCS logo and a navigation menu with links for PLANS, PHONES, BROADBAND, SERVICES, SUPPORT, DEALS, and RETAIL STORE INFO. The main content area is titled "About Mobi" and includes a paragraph about nationwide coverage, a bulleted list of features, and a paragraph about the company's value. Below this is an "About Us" section with a paragraph about the company's history and a paragraph with contact information. A "Support" button is visible in the bottom right corner.

About Us

Secure <https://mobicps.com/mobi/AboutUs/tuoid/2018/Default.aspx>

mobi
PCS

PLANS PHONES BROADBAND SERVICES SUPPORT DEALS RETAIL STORE INFO

About Mobi

Mobi offers nationwide coverage on America's most reliable 4G LTE network. All of our no-contract plans are affordably priced and include unlimited talk and text with the option to choose the data allotment that is right for you! You know what you're getting - and for exactly how much. If you are considering getting a no-contract phone and plan here's more about what we offer:

- Nationwide coverage on America's most reliable 4G LTE network
- Affordably priced no-contract monthly rate plans
- A selection of the most popular smartphones from Apple, Motorola, Samsung, LG, and more

Mobi gives you the best value for the best price, without sacrificing quality. Welcome to a better way of talking.

About Us

Mobi PCS was formed in 2003 to bring innovative communication services to Hawaii. Mobi continues to be based in Hawaii and led by a local team.

If you have questions, just give us a call at 808.723.1111, dial *611 from your Mobi PCS phone, or write to us attn: Customer Service, 1467 South King Street, Suite B, Honolulu, Hawaii 96814.

Support

Receipt

Your submission has been received by the USPTO.
The content of your submission is listed below.
You may print a copy of this receipt for your records.

ESTTA tracking no.: **E**
Filing date: **0**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Petition for Cancellation

Notice is hereby given that the following party has filed a petition to cancel the registration indicated below.

Petitioner information

Name	Mobi, Inc.		
Entity	Corporation	Citizenship	HI
Address	1668 South King Street, Suite 101 Honolulu, HI 96826 UNITED STATES		

Attorney information	Michael Oren Epstein Skadden, Arps, Slate, Meagher & Flom LLP One Manhattan West New York, NY 10001-8602 UNITED STATES Primary email: oren.epstein@skadden.com Secondary email(s): bgoldner@skadden.com, oren.epstein@skadden.com dlamb@skadden.com, smarquez@skadden.com 212.735.2517
Docket no.	
Bar information (bar information will not appear in the record, or e-mail confirmation, and will not be publically displayed)	Year of admission: 2004 U.S. state/commonwealth/territory: NY Membership no.: 4185823 This attorney of record is an active member in good standing of the bar of the highest court of a U.S. state, the District of Columbia, or any U.S. Commonwealth or territory.

Registration subject to cancellation

Registration no.	6407948	Registration date	07/06/2021
Register	Principal		
Registrant	MOBIWEB TELECOM LIMITED Third Floor 207 Regent Street London, London, W1B3HH UNITED KINGDOM		

Goods/services subject to cancellation

Class 038. First Use: Oct 3, 2020 First Use In Commerce: Oct 3, 2020
All goods and services in the class are subject to cancellation, namely: Providing Internet access; communication by computer terminal service provider services; providing voice chat services; providing on-line chat rooms for social networking; telephone voice messaging instant messaging services; provision of voice short message services (VSMS); wireless telephone telecommunications services, name mobile telephone calling plans; telecommunications reseller services for businesses, namely, providing long distance telecommunication voice telecommunication services, local telephone service, and Internet access services

Grounds for cancellation

Priority and likelihood of confusion	Trademark Act Sections 14(1) and 2(d)
No use of mark in commerce before application, amendment to allege use, or statement of use was due	Trademark Act Sections 14(1) and 1(a), (c), and (d)

Registration subject to cancellation

Registration no.	6407949	Registration date	07/06/2021
Register	Principal		
Registrant	MOBIWEB TELECOM LIMITED Third Floor 207 Regent Street London, London, W1B3HH UNITED KINGDOM		

Goods/services subject to cancellation

Class 038. First Use: Oct 3, 2020 First Use In Commerce: Oct 3, 2020
All goods and services in the class are subject to cancellation, namely: Providing Internet access; communication by computer terminal service provider services; providing voice chat services; providing on-line chat rooms for social networking; telephone voice messaging instant messaging services; provision of voice short message services (VSMS); wireless telephone telecommunications services, name mobile telephone calling plans; telecommunications reseller services for businesses, namely, providing long distance telecommunication

voice telecommunication services, local telephone service, and Internet access services

Grounds for cancellation

Priority and likelihood of confusion	Trademark Act Sections 14(1) and 2(d)
No use of mark in commerce before application, amendment to allege use, or statement of use was due	Trademark Act Sections 14(1) and 1(a), (c), and (d)

Marks cited by petitioner as basis for cancellation

U.S. application no.	90589514	Application date	03/19/2021
Register	Principal		
Registration date	NONE	Foreign priority date	NONE
Word mark	MOBI		
Design mark	90589514#TMSN.png		
Description of mark	NONE		
Goods/services	Class 038. First use: First Use: Sep 15, 2005 First Use In Commerce: Jan 3, 2006 Wireless telephone telecommunications services, namely, wireless mobile telephone calling plans		

U.S. application no.	90678746	Application date	04/28/2021
Register	Principal		
Registration date	NONE	Foreign priority date	NONE
Word mark	M MOBI		
Design mark	90678746#TMSN.png		
Description of mark	The mark consists of The mark consists of a stylized letter "M" above the word "Mobi," with the tittle of th and the right stem of the letter "M" forming a design element to represent a wireless signal.		
Goods/services	Class 038. First use: First Use: Mar 7, 2018 First Use In Commerce: Mar 14, 2018 Wireless telephone telecommunications services, namely, wireless mobile telephone calling plans		

Attachments	90589514#TMSN.png(bytes) 90678746#TMSN.png(bytes) Petition for Cancellation.pdf(2336974 bytes)
--------------------	---

Signature	/M. Oren Epstein/
Name	Michael Oren Epstein
Date	04/29/2022

Return to ESTTA home page Start another ESTTA filing

Marquez, Sylvia (NYC)

From: Estta_autoreply@uspto.gov
Sent: Friday, April 29, 2022 7:22 PM
To: Goldner, Bruce (NYC); Lamb, David M (NYC); Marquez, Sylvia (NYC)
Subject: [Ext] ESTTA Filing Receipt: Proceeding or Serial or Registration No. 6407948, 6407949
Petition for Cancellation Filing Receipt for ESTTA Tracking No: ESTTA1206187

ESTTA Filing Receipt

This ESTTA Filing Receipt confirms receipt of your submission associated with the above-identified ESTTA Tracking Number.

Your submission may be viewed on TTABVUE at <https://ttabvue.uspto.gov/ttabvue/> . If you don't see your submission on TTABVUE a week after you file, or if you received an error message or experienced a technical issue while submitting your submission on ESTTA, please send an email to estta@uspto.gov and provide the ESTTA Tracking Number and the Serial, Registration or Proceeding Number identified above, and a brief description of the error message or technical issue you encountered.

For non-technical status or information inquiries, please contact the TTAB Assistance Center at ttabinfo@uspto.gov or 571-272-8500 Monday through Friday from 8:30 a.m. to 5:00 p.m. Eastern Time (ET).

Tracking no.: ESTTA1206187
Filing date: 04/29/2022

Petition for Cancellation

Notice is hereby given that the following party requests to cancel indicated registration.

Petitioner information

Name: Mobi, Inc.
Entity: Corporation
Citizenship: HIAddress: 1668 SOUTH KING STREET, SUITE 101
HONOLULU, HI 96826
UNITED STATES

Attorney information:

MICHAEL OREN EPSTEIN
SKADDEN, ARPS, SLATE, MEAGHER & FLOM LLP
ONE MANHATTAN WEST
NEW YORK, NY 10001-8602
UNITED STATES

Primary email: oren.epstein@skadden.com
Secondary email(s): bgoldner@skadden.com, oren.epstein@skadden.com, dlamb@skadden.com,
smarquez@skadden.com
212.735.2517

Registration subject to cancellation

Registration no.: 6407948

Register: Principal

Registration date: 07/06/2021

Registrant:

MOBIWEB TELECOM LIMITED

THIRD FLOOR

207 REGENT STREET

LONDON, LONDON, W1B3HH

UNITED KINGDOM

Goods/services subject for cancellation

Class 038. First Use: Oct 3, 2020 First Use In Commerce: Oct 3, 2020

All goods and services in the class are subject to cancellation, namely: Providing Internet access; communication by computer terminals; Internet service provider services; providing voice chat services; providing on-line chat rooms for social networking; telephone voice messaging services; instant messaging services; provision of voice short messages services (VSMS); wireless telephone telecommunications services, namely, wireless mobile telephone calling plans; telecommunications reseller services for businesses, namely, providing long distance telecommunication services, voice telecommunication services, local telephone service, and Internet access services

Grounds for cancellation:

Priority and likelihood of confusion

Trademark Act Sections 14(1) and 2(d)

No use of mark in commerce before application, amendment to allege use, or statement of use was due

Trademark Act Sections 14(1) and 1(a), (c), and (d)

Registration subject to cancellation

Registration no.: 6407949

Register: Principal

Registration date: 07/06/2021

Registrant:

MOBIWEB TELECOM LIMITED

THIRD FLOOR

207 REGENT STREET

LONDON, LONDON, W1B3HH

UNITED KINGDOM

Goods/services subject for cancellation

Class 038. First Use: Oct 3, 2020 First Use In Commerce: Oct 3, 2020

All goods and services in the class are subject to cancellation, namely: Providing Internet access; communication by computer terminals; Internet service provider services; providing voice chat services; providing on-line chat rooms for social networking; telephone voice messaging services; instant messaging services; provision of voice short messages services (VSMS); wireless telephone telecommunications services, namely, wireless mobile telephone calling plans; telecommunications reseller services for businesses, namely, providing long distance telecommunication services, voice telecommunication services, local telephone service, and Internet access services

Grounds for cancellation:

Priority and likelihood of confusion

Trademark Act Sections 14(1) and 2(d)

No use of mark in commerce before application, amendment to allege use, or statement of use was due Trademark Act Sections 14(1) and 1(a), (c), and (d)

Marks cited by petitioner as basis for cancellation

U.S. application no.: 90589514

Register: Principal

Application date: 03/19/2021

Word mark: MOBI

Goods/services:

Class 038 First Use: Sep 15, 2005 First Use In Commerce: Jan 3, 2006

Wireless telephone telecommunications services, namely, wireless mobile telephone calling plans

U.S. application no.: 90678746

Register: Principal

Application date: 04/28/2021

Word mark: M MOBI

Goods/services:

Class 038 First Use: Mar 7, 2018 First Use In Commerce: Mar 14, 2018

Wireless telephone telecommunications services, namely, wireless mobile telephone calling plans

Attachments:

90589514#TMSN.png

90678746#TMSN.png

Petition for Cancellation.pdf

Michael Oren Epstein

/M. Oren Epstein/

04/29/2022