

UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)  
OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION

U.S. APPLICATION SERIAL NO. 79226707

MARK: MIUI

**\*79226707\***

**CORRESPONDENT ADDRESS:**

Beijing Sunland Law Firm  
31/F, Beijing Silver Tower,  
No. 2 Dong San Huan North Road,  
Beijing  
CHINA

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**APPLICANT:** Xiaomi Inc.

**CORRESPONDENT'S REFERENCE/DOCKET NO:**

N/A

**CORRESPONDENT E-MAIL ADDRESS:**

**OFFICE ACTION**

**INTERNATIONAL REGISTRATION NO. 1388677**

**STRICT DEADLINE TO RESPOND TO THIS NOTIFICATION:** TO AVOID ABANDONMENT OF THE REQUEST FOR EXTENSION OF PROTECTION OF THE INTERNATIONAL REGISTRATION, THE USPTO MUST RECEIVE A COMPLETE RESPONSE TO THIS PROVISIONAL FULL REFUSAL NOTIFICATION **WITHIN 6 MONTHS** OF THE "DATE ON WHICH THE NOTIFICATION WAS SENT TO WIPO (MAILING DATE)" LOCATED ON THE WIPO COVER LETTER ACCOMPANYING THIS NOTIFICATION.

In addition to the Mailing Date appearing on the WIPO cover letter, a holder (hereafter "applicant") may confirm this Mailing Date using the USPTO's Trademark Status and Document Retrieval (TSDR) system at <http://tsdr.uspto.gov/>. To do so, enter the U.S. application serial number for this application and then select "Documents." The Mailing Date used to calculate the response deadline for this provisional full refusal is the "Create/Mail Date" of the "IB-1rst Refusal Note."

This is a **PROVISIONAL FULL REFUSAL** of the request for extension of protection of the mark in the above-referenced U.S. application. See 15 U.S.C. §1141h(c). See below in this notification (hereafter "Office action") for details regarding the provisional full refusal.

The referenced application has been reviewed by the assigned trademark examining attorney. Applicant must respond timely and completely to the issue(s) below. 15 U.S.C. §1062(b); 37 C.F.R. §§2.62(a), 2.65(a); TMEP §§711, 718.03.

**Summary of the Issues**

- 1. Prior Pending Application;**
- 2. Identification of the Goods;**
- 3. Description of the Mark Omitted;**
- 4. Entity Indefinite.**

**Prior Pending Application**

The filing date of pending U.S. Application Serial No. 86303933 precedes applicant's filing date. See attached referenced application. If the mark in the referenced application registers, applicant's mark may be refused registration under Trademark Act Section 2(d) because of a likelihood of confusion between the two marks. See 15 U.S.C. §1052(d); 37 C.F.R. §2.83; TMEP §§1208 *et seq.* Therefore, upon receipt of applicant's response to this Office action, action on this application may be suspended pending final disposition of the earlier-filed referenced application.

In response to this Office action, applicant may present arguments in support of registration by addressing the issue of the potential conflict between applicant's mark and the mark in the referenced application. Applicant's election not to submit arguments at this time in no way limits applicant's right to address this issue later if a refusal under Section 2(d) issues.

**Identification of the Goods**

The applicant has applied for the mark MIUI for "Data processing apparatus; computer memory devices; computers; disks, magnetic; floppy disks; computer operating programs, recorded; computer peripheral devices; computer software, recorded; couplers (data processing equipment); magnetic data media; monitors (computer programs); processors (central processing units)/central processing units (processors); integrated circuit cards (smart cards)/smart cards (integrated circuit cards); notebook computers; computer game software; laptop computers; computer software applications, downloadable; computer hardware; interactive touch screen terminals; humanoid robot with artificial intelligence; mobile telephones/cell phones/cellular phones software applications, downloadable; image, audio and video editing (computer programs); operating system programs; computer programs for enabling access control; virtual reality game softwares; computer programs for Internet and world-wide-web; quantity indicators; facsimile machines; smartphones; intercommunication apparatus; scales; navigational instruments; wearable activity trackers; audio- and video-receivers; video recorders;

cameras (photography); measuring instruments; inductors (electricity); mirrors (optics); wires, electric; chips (integrated circuits); sensors; time switches, automatic; couplings, electric/connections, electric; theft prevention installations, electric; spectacles (optics); batteries, electric; chargers for electric batteries; animated cartoons” in International Class 9.

Where noted below, the wording in the identification of goods is indefinite and must be clarified. See 37 C.F.R. §2.32(a)(6); TMEP §1402.01. Specifically, the applicant must provide the common commercial name of the goods; must indicate the form of its disks; must indicate the function, purpose and use of its software.

The identification of goods and/or services contains parentheses. Generally, applicants should *not* use parentheses and brackets in identifications in their applications so as to avoid confusion with the USPTO’s practice of using parentheses and brackets in registrations to indicate goods and/or services that have been deleted from registrations or in an affidavit of incontestability to indicate goods and/or services not claimed. See TMEP §1402.12. The only exception is that parenthetical information is permitted in identifications in an application if it serves to explain or translate the matter immediately preceding the parenthetical phrase in such a way that it does not affect the clarity or scope of the identification, e.g., “fried tofu pieces (abura-age).” *Id.*

Therefore, applicant must remove the parentheses from the identification and incorporate any parenthetical or bracketed information into the description of the goods.

In the identification of goods, applicant must use the common commercial or generic names for the goods, be as complete and specific as possible, and avoid the use of indefinite words and phrases. TMEP §1402.03(a); see 37 C.F.R. §2.32(a)(6). If applicant uses indefinite words such as “apparatus,” “components,” “devices,” “materials,” or “parts,” such wording must be followed by “namely,” and a list of each specific product identified by its common commercial or generic name. See TMEP §§1401.05(d), 1402.03(a).

Applicant may substitute the following wording, if accurate:

“Data processing apparatus; computer memory devices; computers; *blank magnetic* disks; *blank floppy computer* disks; *recorded* computer operating programs; computer peripheral devices; *recorded* computer software *for use in database management; data processing equipment, namely,* couplers; magnetic data media, *namely, blank magnetic disks; computer* monitors; central processing units; *blank* integrated circuit cards; notebook computers; computer game software; laptop computers; *downloadable* computer software applications *for use in database management;* computer hardware; interactive touch screen terminals; humanoid robot with artificial intelligence; mobile telephones; cell phones; cellular phones; *downloadable* software applications *for use in operating mobile telephones, cell phones, and cellular phones; computer software for use in editing images,* audio *recordings* and *videos*; operating system programs; computer programs for enabling *computer* access control; virtual reality game software; *communication software* for *providing access to the* Internet and world-wide-web; quantity indicators, *namely, measuring hoses for measuring quantity of the concentration of fluids in hydraulic or pneumatic systems;* facsimile machines; smartphones; intercommunication apparatus, *namely, intercoms;* scales; *electric* navigational instruments; wearable activity trackers; audio and video receivers; video recorders; *photography* cameras; measuring instruments, *namely, measuring rulers; electrical* inductors; *optical* mirrors; wires, electric; *integrated circuit* chips *for digital video compression and decompression; optical* sensors; time switches, automatic; *electric* couplings; theft prevention installations, *namely, electrical burglar alarms;* spectacles; batteries, electric; chargers for electric batteries; *video disks with recorded* animated cartoons” in International Class 9.

*The identification of goods or services should be clear, accurate and as concise as possible.* See Procter & Gamble Co. v. Economics Laboratory, Inc., 175 USPQ 505 (TTAB 1972); In re Cardinal Laboratories, Inc., 149 USPQ 709 (TTAB 1966); California Spray-Chemical Corp. v. Osmose Wood Preserving Co. of America, Inc., 102 USPQ 321 (Comm’r Pats. 1954); Ex parte A.C. Gilbert Co., 99 USPQ 344 (Comm’r Pats. 1953). *Furthermore, the identification of goods and services must be specific and definite.* In re Societe Generale des Eaux Minerales de Vittel S.A., 1 USPQ2d 1296 (TTAB 1986), rev’d on other grounds, 824 F.2d 957, 3 USPQ2d 1450 (Fed. Cir. 1987).

The examining attorney may make any requirements necessary to ensure that the identification is clear and accurate and conforms to the requirements of the statute and rules. When an applicant has submitted an indefinite identification of goods or services, it is Office practice to suggest an acceptable identification. However, *it is the applicant’s duty and prerogative to identify the goods and services.* TMEP Section 1402.01(d).

In a Trademark Act Section 66(a) application, classification of goods and/or services may not be changed from that assigned by the International Bureau of the World Intellectual Property Organization. 37 C.F.R. §2.85(d); TMEP §§1401.03(d), 1904.02(b). Additionally, classes may not be added or goods and/or services transferred from one class to another in a multiple-class Section 66(a) application. 37 C.F.R. §2.85(d); TMEP §1401.03(d).

Applicant’s goods and/or services may be clarified or limited, but may not be expanded beyond those originally itemized in the application or as acceptably amended. See 37 C.F.R. §2.71(a); TMEP §1402.06. Applicant may clarify or limit the identification by inserting qualifying language or deleting items to result in a more specific identification; however, applicant may not substitute different goods and/or services or add goods and/or services not found or encompassed by those in the original application or as acceptably amended. See TMEP §1402.06(a)-(b). The scope of the goods and/or services sets the outer limit for any changes to the identification and is generally determined by the ordinary meaning of the wording in the identification. TMEP §§1402.06(b), 1402.07(a)-(b). Any acceptable changes to the goods and/or services will further limit scope, and once goods and/or services are deleted, they are not permitted to be reinserted. TMEP §1402.07(e).

For assistance with identifying and classifying goods and services in trademark applications, please see the USPTO’s online searchable [\*U.S. Acceptable\*](#)

### **Description of the Mark**

The applied-for mark is not in standard characters and applicant did not provide a description of the mark with the initial application. Applications for marks not in standard characters must include an accurate and concise description of the entire mark that identifies literal elements as well as any design elements. See 37 C.F.R. §2.37; TMEP §§808.01, 808.02, 808.03(b).

Therefore, applicant must provide a description of the applied-for mark. The following is suggested:

**The mark consists of the stylized word “MIUI”. The entire mark is on a shaded background.**

### **Entity Indefinite**

The application identifies applicant as Xiaomi Inc., an “Incorporation.” This is not an acceptable legal entity designation because it does not identify a particular type of legal entity. See TMEP §803.03. Therefore, applicant must specify the particular type of legal entity applying, e.g., corporation, association, partnership, or joint venture, and provide the additional information explained below about that entity. See 37 C.F.R. §§2.32(a)(3)(ii)-(iv), 2.61(b); TMEP §803.03.

If applicant is a corporation, applicant must specify the foreign country under which it is incorporated. TMEP §803.03(c).

If, in response to the above request, applicant provides information indicating that it is not the owner of the mark, registration will be refused because the application was void as filed. See 37 C.F.R. §2.71(d); TMEP §§803.06, 1201.02(b). An application must be filed by the party who owns or is entitled to use the mark as of the application filing date. See 37 C.F.R. §2.71(d); TMEP §1201.02(b).

### **Closing**

Because of the legal technicalities and strict deadlines involved in the USPTO application process, applicant may wish to hire a private attorney specializing in trademark matters to represent applicant in this process and provide legal advice. Although the undersigned trademark examining attorney is permitted to help an applicant understand the contents of an Office action as well as the application process in general, no USPTO attorney or staff is permitted to give an applicant legal advice or statements about an applicant’s legal rights. TMEP §§705.02, 709.06.

For attorney referral information, applicant may consult the [American Bar Association’s Consumers’ Guide to Legal Help](#); an online directory of legal professionals, such as [FindLaw®](#); or a local telephone directory. The USPTO, however, may not assist an applicant in the selection of a private attorney. 37 C.F.R. §2.11.

**WHO IS PERMITTED TO RESPOND TO THIS PROVISIONAL FULL REFUSAL:** Any response to this provisional refusal must be personally signed by an individual applicant, all joint applicants, or someone with legal authority to bind a juristic applicant (e.g., a corporate officer or general partner). 37 C.F.R. §§2.62(b), 2.193(e)(2)(ii); TMEP §712.01. If applicant hires a qualified U.S. attorney to respond on his or her behalf, then the attorney must sign the response. 37 C.F.R. §§2.193(e)(2)(i), 11.18(a); TMEP §§611.03(b), 712.01. Qualified U.S. attorneys include those in good standing with a bar of the highest court of any U.S. state, the District of Columbia, Puerto Rico, and other U.S. commonwealths or U.S. territories. See 37 C.F.R. §§2.17(a), 2.62(b), 11.1, 11.14(a); TMEP §§602, 712.01. Additionally, for all responses, the proper signatory must personally sign the document or personally enter his or her electronic signature on the electronic filing. See 37 C.F.R. §2.193(a); TMEP §§611.01(b), 611.02. The name of the signatory must also be printed or typed immediately below or adjacent to the signature, or identified elsewhere in the filing. 37 C.F.R. §2.193(d); TMEP §611.01(b).

In general, foreign attorneys are not permitted to represent applicants before the USPTO (e.g., file written communications, authorize an amendment to an application, or submit legal arguments in response to a requirement or refusal). See 37 C.F.R. §11.14(c), (e); TMEP §§602.03-.03(b), 608.01.

**DESIGNATION OF DOMESTIC REPRESENTATIVE:** The USPTO encourages applicants who do not reside in the United States to designate a domestic representative upon whom any notice or process may be served. TMEP §610; see 15 U.S.C. §§1051(e), 1141h(d); 37 C.F.R. §2.24(a)(1)-(2). Such designations may be filed online at <http://www.uspto.gov/trademarks/teas/correspondence.jsp>.

If the applicant has any questions, please contact the undersigned.

/Ty Murray/  
Attorney-Advisor  
United States Patent and Trademark Office  
Law Office 113  
(571)272-9438  
ty.murray@uspto.gov

**TO RESPOND TO THIS LETTER:** Go to [http://www.uspto.gov/trademarks/teas/response\\_forms.jsp](http://www.uspto.gov/trademarks/teas/response_forms.jsp). Please wait 48-72 hours from the issue/ mailing date before using the Trademark Electronic Application System (TEAS), to allow for necessary system updates of the application. For *technical* assistance with online forms, e-mail [TEAS@uspto.gov](mailto:TEAS@uspto.gov). For questions about the Office action itself, please contact the assigned trademark examining attorney. **E-mail communications will not be accepted as responses to Office actions; therefore, do not respond to this Office action by e-mail.**

**All informal e-mail communications relevant to this application will be placed in the official application record.**

**WHO MUST SIGN THE RESPONSE:** It must be personally signed by an individual applicant or someone with legal authority to bind an applicant (i.e., a corporate officer, a general partner, all joint applicants). If an applicant is represented by an attorney, the attorney must sign the response.

**PERIODICALLY CHECK THE STATUS OF THE APPLICATION:** To ensure that applicant does not miss crucial deadlines or official notices, check the status of the application every three to four months using the Trademark Status and Document Retrieval (TSDR) system at <http://tsdr.uspto.gov/>. Please keep a copy of the TSDR status screen. If the status shows no change for more than six months, contact the Trademark Assistance Center by e-mail at [TrademarkAssistanceCenter@uspto.gov](mailto:TrademarkAssistanceCenter@uspto.gov) or call 1-800-786-9199. For more information on checking status, see <http://www.uspto.gov/trademarks/process/status/>.

**TO UPDATE CORRESPONDENCE/E-MAIL ADDRESS:** Use the TEAS form at <http://www.uspto.gov/trademarks/teas/correspondence.jsp>.

**DESIGN MARK**

**Serial Number**

86303933

**Status**

THIRD EXTENSION - GRANTED

**Word Mark**

MIUI

**Standard Character Mark**

Yes

**Type of Mark**

TRADEMARK

**Register**

PRINCIPAL

**Mark Drawing Code**

(4) STANDARD CHARACTER MARK

**Owner**

Ramkumar, Somasundaram INDIVIDUAL INDIA 28 South Street, Tallakulam  
Madurai Tamil Nadu INDIA

**Goods/Services**

Class Status -- ACTIVE. IC 009. US 021 023 026 036 038. G & S:  
Mobile phones; operating system software; software for use in  
developing, executing, and running other software on mobile devices,  
computers, computer networks, and global communication networks;  
computer software development tools; computer software for use in  
transmitting and receiving data over computer networks and global  
communication networks; computer software for managing communications  
and data exchange among and between mobile devices and desktop  
computers; computer middleware, namely, software that mediates between  
the operating system of a mobile device and the application software  
of a mobile device; computer software for mobile phones, namely,  
computer game applications, photo editing applications, and bank  
account management applications; laptop computers; tablet personal  
computer; computer memories; computer keyboards; recorded computer  
operating programs; computer peripheral devices; monitors; readers for  
data processing equipment, namely, electronic memory card readers;  
scanners; optical discs containing software used for operating  
systems; printers for use with computers; central processing units;  
notebook computers; computer mouse; calculators; downloadable  
software, namely, computer operating system programs; mouse pads,  
wrist rests for use with computers, computer game programs;  
downloadable mobile phone ringtones; downloadable music files;  
downloadable image files containing photographs and artwork for mobile

phones; universal serial bus hardware; portable computers; satellite mobile phone; cellular telephones adapted for use with plurality of subscribed identify module (SIM) cards; television; plasma television; LCD television; LED television.

**Translation Statement**

The wording "MIUI" has no meaning in a foreign language.

**Filing Date**

2014/06/09

**Examining Attorney**

FICKES, JERI J.

**Attorney of Record**

Andrew D. Dorisio

MIUI