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

U.S. APPLICATION SERIAL NO. 79231535

MARK: PEPPER

79231535

CORRESPONDENT ADDRESS:

MARKS & CLERK FRANC; Mme. Martine ADAMOF Immeuble Visium, 22 avenue Aristide Briand F-94117 ARCUEIL CEDEX FRANCE

APPLICANT: SOFTBANK ROBOTICS EUROPE

CORRESPONDENT'S REFERENCE/DOCKET NO: N/A
CORRESPONDENT E-MAIL ADDRESS:

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OFFICE ACTION

STRICT DEADLINE TO RESPOND TO THIS LETTER

INTERNATIONAL REGISTRATION NO. 1400443

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-1 rst 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.

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 ISSUES

• Section 2(d) Refusal—Likelihood of Confusion

SECTION 2(d) REFUSAL - LIKELIHOOD OF CONFUSION

Registration of the applied-for mark is refused because of a likelihood of confusion with the mark in U.S. Registration No. 4813007 and 4920360 both "PEPPER" and owned by Aldebaran Robotics. Trademark Act Section 2(d), 15 U.S.C. §1052(d); see TMEP §§1207.01 et seq. See the attached registrations.

Trademark Act Section 2(d) bars registration of an applied-for mark that so resembles a registered mark that it is likely a consumer would be confused, mistaken, or deceived as to the source of the goods and/or services of the applicant and registrant(s). See 15 U.S.C. §1052(d). Determining likelihood of confusion is made on a case-by-case basis by applying the factors set forth in In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973). In re i.am.symbolic, Ilc, 866 F.3d 1315, 1322, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017). However, "[n]ot all of the [du Pont] factors are relevant to every case, and only factors of significance to the particular mark need be considered." Coach Servs., Inc. v. Triumph Learning LLC, 668 F.3d 1356, 1366, 101 USPQ2d 1713, 1719 (Fed. Cir. 2012) (quoting In re Mighty Leaf Tea, 601. F.3d 1342, 1346, 94 USPQ2d 1257, 1259 (Fed. Cir. 2010)). The USPTO may focus its analysis "on dispositive factors, such as similarity of the marks and relatedness of the goods [and/or services]." In re i.am.symbolic, Ilc, 866 F.3d at 1322, 123 USPQ2d at 1747 (quoting Herbko Int'l, Inc. v. Kappa Books, Inc., 308 F.3d 1156, 1164-65, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002)); see TMEP §1207.01.

Comparing the Marks

In a likelihood of confusion determination, the marks in their entireties are compared for similarities in appearance, sound, connotation, and commercial impression. *In re i.am.symbolic, llc*, 866 F.3d 1315, 1323, 123 USPQ2d 1744, 1748 (Fed. Cir. 2017); *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 1321, 110 USPQ2d 1157, 1160 (Fed. Cir. 2014) (quoting *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 1371, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005)); *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973); TMEP §1207.01(b)-(b)(v).

In the present case, applicant's mark is PEPPER and registrant's marks are PEPPER. These marks are identical in appearance, sound, and meaning, "and have the potential to be used . . . in exactly the same manner." *In re i.am.symbolic, llc*, 116 USPQ2d 1406, 1411 (TTAB 2015), *aff'd*, 866 F.3d 1315, 123 USPQ2d 1744 (Fed. Cir. 2017). Additionally, because they are identical, these marks are likely to engender the same connotation and overall commercial impression when considered in connection with applicant's and registrant's respective goods and/or services. *Id.*

Therefore, the marks are confusingly similar.

Taken together, the marks are confusingly similar.

Comparing the Goods and Services

The applicant's goods are "Humanoid robots with artificial intelligence," in Class 9. See application.

The registrant's goods relevant to this refusal are identified as follows:

Reg. No. 4920360:

Class 9: Laboratory robots; robots for personal, educational and hobby use and structural parts therefor; interfaces for computers; electric batteries, control apparatus, namely, apparatus comprising of a remote control and memory card for the remote control of entertainment robots; excluding software for content, data, document and business process management; none of the aforesaid goods being related to computer games, videos games, skill games, social games or gaming services on the Internet or mobile phones, tablets and other mobile devices with the exception of interactive games with a humanoid robot or between humanoid robots; all the aforesaid goods being used to make function entertainment robots

Reg. No. 4813007

Class 7: Industrial humanoid robots for studies and industrial humanoid robots for surveying, industrial assistance robots

See attached registrations.

The compared goods and/or services need not be identical or even competitive to find a likelihood of confusion. See On-line Careline Inc. v. Am. Online Inc., 229 F.3d 1080, 1086, 56 USPQ2d 1471, 1475 (Fed. Cir. 2000); Recot, Inc. v. Becton, 214 F.3d 1322, 1329, 54 USPQ2d 1894, 1898 (Fed. Cir. 2000); TMEP §1207.01(a)(i). They need only be "related in some manner and/or if the circumstances surrounding their marketing are such that they could give rise to the mistaken belief that [the goods and/or services] emanate from the same source." Coach Servs., Inc. v. Triumph Learning LLC, 668 F.3d 1356, 1369, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012) (quoting 7-Eleven Inc. v. Wechsler, 83 USPQ2d 1715, 1724 (TTAB 2007)); TMEP §1207.01(a)(i).

In this case, applicant and registrant both produce robots. Registrant's wording is broad and encompasses robots of all types, including for laboratory, industrial, personal, and educational use. Applicant's robots have no particular purpose and thus could be used in any field, including those of the type identified by the registrant. Further, the attached Internet evidence consists of screenshots from Omron and Kawasaki which shows that the same entity provides robots for a variety of purposes under the same mark and in the same channels of trade. This evidence establishes that the same entity commonly provides the relevant goods and/or services and markets the goods and/or services under the same mark and in the same general channels of trade. Therefore, applicant's and registrant's goods and/or services are considered related for likelihood of confusion purposes. *See, e.g., In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1202-04 (TTAB 2009); *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266, 1268-69, 1271-72 (TTAB 2009).

The overriding concern is not only to prevent buyer confusion as to the source of the goods and/or services, but to protect the registrant from adverse commercial impact due to use of a similar mark by a newcomer. See In re Shell Oil Co., 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993). Therefore, any doubt regarding a likelihood of confusion determination is resolved in favor of the registrant. TMEP §1207.01(d)(i); see Hewlett-Packard Co. v. Packard Press, Inc., 281 F.3d 1261, 1265, 62 USPQ2d 1001, 1003 (Fed. Cir. 2002); In re Hyper Shoppes (Ohio), Inc., 837 F.2d 463, 464-65, 6 USPQ2d 1025, 1026 (Fed. Cir. 1988).

In this case, the marks are identical and the goods are closely related. Thus, consumers are likely to be confused and mistakenly believe that the goods emanate from a common source. Accordingly, the applicant's proposed mark is refused for likelihood of confusion under Trademark Act Section 2(d).

Although applicant's mark has been refused registration, applicant may respond to the refusal(s) by submitting evidence and arguments in support of registration.

APPLICANT MAY WISH TO SEEK TRADEMARK COUNSEL

Because of the legal technicalities and strict deadlines involved in the USPTO application process, applicant may wish to hire a qualified U.S. 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 <u>American Bar Association's Consumers' Guide to Legal Help</u> or an online directory of legal professionals, such as <u>Fixell aw@</u>. The USPTO, however, may not assist an applicant in the selection of an attorney. 37 C.F.R. §2.11.

Please note that foreign attorneys, other than authorized Canadian 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. §§2.17(e), 11.14(c), (e); TMEP §602.03-.03(c).

RESPONDING TO OFFICE ACTIONS

For this application to proceed further, applicant must explicitly address each refusal and/or requirement raised in this Office action. If the action includes a refusal, applicant may provide arguments and/or evidence as to why the refusal should be withdrawn and the mark should register. Applicant may also have other options specified in this Office action for responding to a refusal, and should consider those options carefully. To respond to requirements and certain refusal response options, applicant should set forth in writing the required changes or statements. For more information and general tips on responding to USPTO Office actions, response options, and how to file a response online, see "Responding to Office Actions" on the USPTO's website.

If applicant does not respond to this Office action within six months of the date on which the USPTO sends this Office action to the International Bureau, or responds by expressly abandoning the application, the application process will end and the trademark will fail to register. *See* 15 U.S.C. §1062(b); 37 C.F.R. §§2.65(a), 2.68(a); TMEP §§711, 718.01, 718.02.

When an application has abandoned for failure to respond to an Office action, an applicant may timely file a petition to revive the application, which, if granted, would allow the application to return to active status. See 37 C.F.R. §2.66; TMEP §1714. The petition must be filed within two months of the date of issuance of the notice of abandonment and may be filed online via the Trademark Electronic Application System (TEAS) with a \$100 fee. See 37 C.F.R. §§2.6(a)(15)(ii), 2.66(a)(1), (b)(1).

If applicant has questions regarding this Office action, please telephone or e-mail the assigned trademark examining attorney. All relevant e-mail communications will be placed in the official application record; however, an e-mail communication will not be accepted as a response to this Office action and will not extend the deadline for filing a proper response. See 37 C.F.R. §§2.62(c), 2.191; TMEP §§304.01-.02, 709.04-.05. Further, although the trademark examining attorney may provide additional explanation pertaining to the refusal(s) and/or requirement(s) in this Office action, the trademark examining attorney may not provide legal advice or statements about applicant's rights. See TMEP §§705.02, 709.06.

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.

NOTICE: The USPTO proposes to change federal trademark rules to require applicants and registrants to (1) file submissions concerning applications and registrations online using the USPTO's Trademark Electronic Application System (TEAS) and (2) provide and maintain an accurate email address for receiving correspondence from the USPTO. See the Mandatory Electronic Filing Rules webpage for more information.

/Diane Collopy/ Examining Attorney Law Office 107 diane.collopy@uspto.gov (informal communications only) (571) 270-3118

TO RESPOND TO THIS LETTER: Go to http://www.uspfo.gov/trademarks/tras/prase_forus.isp. 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@uspfo.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 http://www.uspto.gov/rademarks/process/status/. 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 duspto.gov or call 1-800-786-9199. For more information on checking status, see http://www.uspto.gov/trademarks/process/status/.

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DESIGN MARK

Serial Number

86143137

Status

REGISTERED

Word Mark

PEPPER

Standard Character Mark

Yes

Registration Number

4920360

Date Registered

2016/03/22

Type of Mark

TRADEMARK; SERVICE MARK

Register

PRINCIPAL

Mark Drawing Code

(4) STANDARD CHARACTER MARK

Owner

Aldebaran Robotics société par actions simplifiée (sas) FRANCE 168bis-170 rue Raymond Losserand Paris FRANCE 75014

Goods/Services

Class Status -- ACTIVE. IC 009. US 021 023 026 036 038. G & S: Laboratory robots; robots for personal, educational and hobby use and structural parts therefor; interfaces for computers; electric batteries, control apparatus, namely, apparatus comprising of a remote control and memory card for the remote control of entertainment robots; excluding software for content, data, document and business process management; none of the aforesaid goods being related to computer games, videos games, skill games, social games or gaming services on the Internet or mobile phones, tablets and other mobile devices with the exception of interactive games with a humanoid robot or between humanoid robots; all the aforesaid goods being used to make function entertainment robots.

Goods/Services

Class Status -- ACTIVE. IC 041. US 100 101 107. G & S: Teaching services in the field of remedial reading, live performances displaying robotic achievements; music teaching via a humanoid robot;

excluding encouraging amateur sports and physical education by organizing, promoting, sponsoring, sanctioning, conducting, administering, regulating and governing amateur athletic programs and activities; excluding conducting training programs in the field of entertainment, sporting, and cultural activities; none of the aforesaid services being related to computer games, videos games, skill games, social games or games services on the Internet or mobile phones, tablets and other mobile devices with the exception of interactive games with a humanoid robot or between humanoid robots.

Goods/Services

Class Status -- ACTIVE. IC 042. US 100 101. G & S: Design and development of robots, data processing equipment for information processing, robotics engineering services; excluding design and maintenance of web sites for others.

Foreign Country Name

FRANCE

Foreign Priority

FOREIGN PRIORITY CLAIMED

Foreign Application Number

134036144

Foreign Filing Date

2013/09/30

Foreign Registration Number

134036144

Foreign Registration Date

2014/11/07

Foreign Expiration Date

2023/09/30

Filing Date

2013/12/13

Examining Attorney

SPRUILL, DARRYL

Attorney of Record

William R. Samuels

PEPPER

DESIGN MARK

Serial Number

86975095

Status

REGISTERED

Word Mark

PEPPER

Standard Character Mark

Yes

Registration Number

4813007

Date Registered

2015/09/15

Type of Mark

TRADEMARK: SERVICE MARK

Register

PRINCIPAL

Mark Drawing Code

(4) STANDARD CHARACTER MARK

Owner

Aldebaran Robotics société par actions simplifiée (sas) FRANCE 168bis-170 rue Raymond Losserand Paris FRANCE 75014

Goods/Services

Class Status -- ACTIVE. IC 007. US 013 019 021 023 031 034 035. G & S: Industrial humanoid robots for studies and industrial humanoid robots for surveying, industrial assistance robots.

Goods/Services

Class Status -- ACTIVE. IC 028. US 022 023 038 050. G & S: Toy robots, electronic toys, namely, action toys and learning toys, electronic action games, electronic games for teaching children; toy humanoid robots for role-playing research and humanoid robots for engineer work, entertainment robots in the nature of toys, leisure robots, namely, toys.

Goods/Services

Class Status -- ACTIVE. IC 035. US 100 101 102. G & S: Presentation of goods in the nature of promoting the goods and services of others by distributing advertising materials through all communication media for retail purposes; online advertising on a

computer network, none of the aforesaid services being related to computer games, videos games, skill games, social games or gaming services on the Internet or mobile phones, tablets and other mobile devices with the exception of interactive games with a humanoid robot or between humanoid robots.

Goods/Services

Class Status -- ACTIVE. IC 038. US 100 101 104. G & S: Telecommunications, namely, transmission of voice, data, graphics, sound and video by means of broadband power line or wireless networks; radio and telephone communications, telecommunication electronic display services, namely, electronic data transmission and transmission of data, graphics and video by bulletin board system and billboard or a combination thereof, electronic messaging services, teleconferencing and video conferencing services.

Goods/Services

Class Status -- ACTIVE. IC 044. US 100 101. G & S: Medical assistance services by remote monitoring.

Goods/Services

Class Status -- ACTIVE. IC 045. US 100 101. G & S: Monitoring and anti-intruder alarms services.

Foreign Country Name

FRANCE

Foreign Priority

FOREIGN PRIORITY CLAIMED

Foreign Application Number

134036144

Foreign Filing Date

2013/09/30

Foreign Registration Number

134036144

Foreign Registration Date

2013/09/30

Foreign Expiration Date

2023/09/30

Foreign Country Name

FRANCE

Foreign Priority

FOREIGN PRIORITY CLAIMED

Print: Jun 23, 2018 86975095

Foreign Application Number 4042750

Foreign Filing Date 2013/10/25

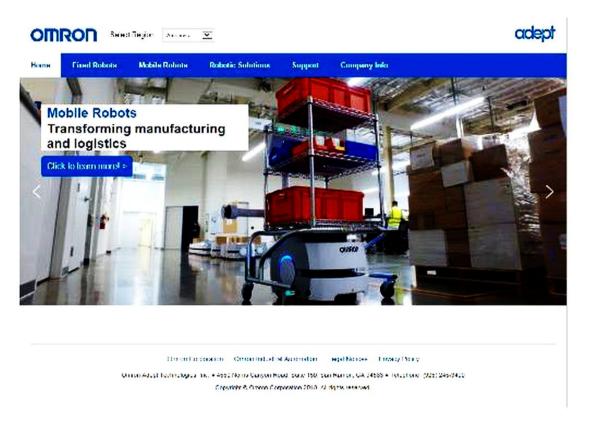
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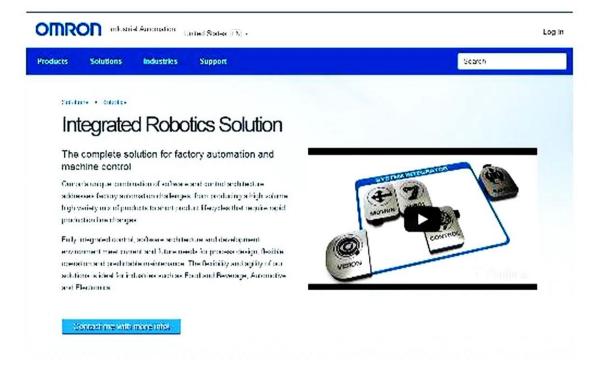
2013/12/13

Examining Attorney SPRUILL, DARRYL

Attorney of Record William R. Samuels

PEPPER





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Advanced, Integrated Technology

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Transforming Manufacturing and Logistics

Complete Automation Expertise

The new Omron Robotic Automation solution cohances the most

- Performance Overall throughput is guaranteed by the synchronization of our machine control with the new vision guided or but.
- Quick Belivery Five automated wavehoused to provide particle short time.
- Simple Shortening the startup and maintenance time by the integrated software only renment that controls the line.
- <u>Litticient</u> All producate data coming from the robots, controllers, sensors are collected, shared and managed to optimize productivity.
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Industrial Robots Solutions Brochure

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Robotic Applications

Anyfeeder

Control AnyFeeder Solution combines distortion and robotics with our powerful ACL Sight software to deliver a complete system for Boarde bulk partitioning.

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PackXpert

The Coron PackStert Solution tringstogether our complete line of robots automation products into a single fully integrated packaging system.

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The Omran Adopt Quattre rabot is the cold parallel rehects the



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Hornet 565 Delta Robot Dosigned for Primary and Secondary Food Backgring The speed and profision of Adam Viger six-axis motels make them ideal for operations regulding fast and procise automation is the only paratetropoun the work with patented leasures and USDA accepted for meat and pountly processing.

Intelligent Vehicle (MV)

Secondary Lood Packaging



eCobra Robot Series

cCobia SCARA Robot Series ofters a compact system (colpin), saving valuable (col space white minimang installation costs and complexity



Delta Robat Series

The fastest picking system integrated in the Systhac platform



Cobra

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AnyFeeder

Complete Flexible Feeding System optimized to work together with vision, motion and robots.



R88-L Linear Axis

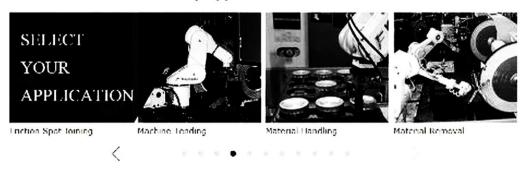
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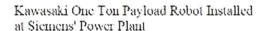




June 20, 2018

Kawasaki and AIBS create world's first common interface for collaborative robots

robots
The easy to use, industry-



The Kawasaki M010HL robot, installed at the Siemens Lausward power plant in Dusseldort, has a payload capacity of up to 1,000 kg and a 4 meter reach. The powerful, extra large payload Kawasaki robot was installed to perform the Siemens)



lune 20, 2018

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June 15, 2016

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