

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

U.S. APPLICATION SERIAL NO. 79245234

MARK: MI CLOUD

79245234

CORRESPONDENT ADDRESS:

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APPLICANT: Xiaomi Inc.

CORRESPONDENT'S REFERENCE/DOCKET NO:

N/A

CORRESPONDENT E-MAIL ADDRESS:

OFFICE ACTION

INTERNATIONAL REGISTRATION NO. 1433787

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-1st 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.

Refusal under Section 2(d) – Likelihood of Confusion

- I. **THIS PARTIAL REFUSAL APPLIES ONLY TO THE FOLLOWING GOODS AND SERVICES: Computer software applications, downloadable in International Class 9 and Cloud computing; software as a service [SaaS] in International Class 42.**

Registration of the applied-for mark is refused because of a likelihood of confusion with the mark in **U.S. Registration No. 4444097**. Trademark Act Section 2(d), 15 U.S.C. §1052(d); see TMEP §§1207.01 *et seq.* See the attached registration.

Trademark Act Section 2(d) bars registration of an applied-for mark that is so similar to a registered mark that it is likely consumers would be confused, mistaken, or deceived as to the commercial source of the goods and/or services of the parties. See 15 U.S.C. §1052(d). Likelihood of confusion is determined 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) (called the "du Pont factors"). *In re i.am.symbolic, llc*, 866 F.3d 1315, 1322, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017). Only those factors that are "relevant and of record" need be considered. *M2 Software, Inc. v. M2 Commc'ns, Inc.*, 450 F.3d 1378, 1382, 78 USPQ2d 1944, 1947 (Fed. Cir. 2006) (citing *Shen Mfg. Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 1241, 73 USPQ2d 1350, 1353 (Fed. Cir. 2004)); see *In re Inn at St. John's, LLC*, 126 USPQ2d 1742, 1744 (TTAB 2018).

Although not all *du Pont* factors may be relevant, there are generally two key considerations in any likelihood of confusion analysis: (1) the similarities between the compared marks and (2) the relatedness of the compared goods and/or services. See *In re i.am.symbolic, llc*, 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)); *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 1103, 192 USPQ 24, 29 (C.C.P.A. 1976) ("The fundamental inquiry mandated by [Section] 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods [or services] and differences in the marks."); TMEP §1207.01.

The applicant has applied to register the mark **MI CLOUD** for "computer software applications, downloadable" in International Class 9 and "cloud computing; software as a service [SaaS]" in International Class 42. "**Registration No. 4444097** is for the mark **MY CLOUD** for "computer software to connect and manage networked devices for remote access, back-up, sharing, and syncing of documents and files over a network or the internet."

Similarity of the Marks

The marks are nearly identical and phonetically equivalent. The only difference is that the applicant has changed the letter "Y" in MY" to the phonetically equivalent letter "I." There is no correct pronunciation of a mark because it is impossible to predict how the public will pronounce a particular mark.

See *Embarcadero Techs., Inc. v. RStudio, Inc.*, 105 USPQ2d 1825, 1835 (TTAB 2013) (quoting *In re Viterra Inc.*, 671 F.3d 1358, 1367, 101 USPQ2d 1905, 1912 (Fed. Cir. 2012); *In re The Belgrade Shoe Co.*, 411 F.2d 1352, 1353, 162 USPQ 227, 227 (C.C.P.A. 1969)); TMEP §1207.01(b)(iv). The marks in question could clearly be pronounced the same; such similarity in sound alone may be sufficient to support a finding that the marks are confusingly similar. *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988); see *In re 1st USA Realty Prof'ls, Inc.*, 84 USPQ2d 1581, 1586 (TTAB 2007); TMEP §1207.01(b)(iv).

Relatedness of the Goods and Services

The goods and services must be presumed to be identical or very highly related. The applicant has not stated the function or field of its downloadable computer software and the software featured in its cloud computing services or its software as a service [SaaS] services. Therefore, it must be presumed that function for the software goods and services at least in part is “to connect and manage networked devices for remote access, back-up, sharing, and syncing of documents and files over a network or the internet” and identical to the function of registrant’s software.

II. THIS PARTIAL REFUSAL APPLIES ONLY TO THE FOLLOWING GOODS IN INTERNATIONAL CLASS 9: intercommunication apparatus; portable media players; chips [integrated circuits].

Registration of the applied-for mark is refused because of a likelihood of confusion with the mark in U.S. Registration No. 4448166. Trademark Act Section 2(d), 15 U.S.C. §1052(d); see TMEP §§1207.01 *et seq.* See the attached registration.

Trademark Act Section 2(d) bars registration of an applied-for mark that is so similar to a registered mark that it is likely consumers would be confused, mistaken, or deceived as to the commercial source of the goods and/or services of the parties. See 15 U.S.C. §1052(d). Likelihood of confusion is determined 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) (called the “*du Pont* factors”). *In re i.am.symbolic, llc*, 866 F.3d 1315, 1322, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017). Only those factors that are “relevant and of record” need be considered. *M2 Software, Inc. v. M2 Commc’ns, Inc.*, 450 F.3d 1378, 1382, 78 USPQ2d 1944, 1947 (Fed. Cir. 2006) (citing *Shen Mfg. Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 1241, 73 USPQ2d 1350, 1353 (Fed. Cir. 2004)); see *In re Inn at St. John’s, LLC*, 126 USPQ2d 1742, 1744 (TTAB 2018).

Although not all *du Pont* factors may be relevant, there are generally two key considerations in any likelihood of confusion analysis: (1) the similarities between the compared marks and (2) the relatedness of the compared goods and/or services. See *In re i.am.symbolic, llc*, 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)); *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 1103, 192 USPQ 24, 29 (C.C.P.A. 1976) (“The fundamental inquiry mandated by [Section] 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods [or services] and differences in the marks.”); TMEP §1207.01.

The applicant has applied to register the mark **MI CLOUD** for “intercommunication apparatus; portable media players; chips [integrated circuits].” **Registration No. 4448166** is for the mark **MY CLOUD** for “computer products, namely, data storage products in the nature of digital electronic devices for recording, transmitting, organizing, manipulating, receiving, playing and reviewing text, data, image, audio and video files; computer storage devices in the nature of internal and external disk drives, internal and external solid state drives, network-enabled drives and computer peripherals.”

Similarity of the Marks

The marks are nearly identical and phonetically equivalent. The only difference is that the applicant has changed the letter “Y” in MY” to the phonetically equivalent letter “I.” There is no correct pronunciation of a mark because it is impossible to predict how the public will pronounce a particular mark. See *Embarcadero Techs., Inc. v. RStudio, Inc.*, 105 USPQ2d 1825, 1835 (TTAB 2013) (quoting *In re Viterra Inc.*, 671 F.3d 1358, 1367, 101 USPQ2d 1905, 1912 (Fed. Cir. 2012); *In re The Belgrade Shoe Co.*, 411 F.2d 1352, 1353, 162 USPQ 227, 227 (C.C.P.A. 1969)); TMEP §1207.01(b)(iv). The marks in question could clearly be pronounced the same; such similarity in sound alone may be sufficient to support a finding that the marks are confusingly similar. *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988); see *In re 1st USA Realty Prof'ls, Inc.*, 84 USPQ2d 1581, 1586 (TTAB 2007); TMEP §1207.01(b)(iv).

Relatedness of the Goods

The goods are presumed to be identical or very highly related. Determining likelihood of confusion is based on the description of the goods stated in the application and registration at issue, not on extrinsic evidence of actual use. See *In re Detroit Athletic Co.*, 903 F.3d 1297, 1307, 128 USPQ2d 1047, 1052 (Fed. Cir. 2018) (citing *In re i.am.symbolic, llc*, 866 F.3d 1315, 1325, 123 USPQ2d 1744, 1749 (Fed. Cir. 2017)).

In this case, the application and registration use broad wording to describe their goods and this language presumably encompasses all goods of the type described. Specifically, it must be presumed that the registrant’s “computer products, namely, data storage products in the nature of digital electronic devices for recording, transmitting, organizing, manipulating, receiving, playing and reviewing text, data, image, audio and video files; computer storage devices in the nature of internal and external disk drives, internal and external solid state drives, network-enabled drives and computer peripherals” include applicant’s “intercommunication apparatus; portable media players; chips [integrated circuits]” and visa versa. See, e.g., *In re Solid State Design Inc.*, 125 USPQ2d 1409, 1412-15 (TTAB 2018); *Sw. Mgmt., Inc. v. Ocinomled, Ltd.*, 115 USPQ2d 1007, 1025 (TTAB 2015). Thus, applicant’s and registrant’s goods are legally identical. See, e.g., *In re i.am.symbolic, llc*, 127 USPQ2d 1627, 1629 (TTAB 2018) (citing *Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp., Inc.*, 648 F.2d 1335, 1336, 209 USPQ 986, 988 (C.C.P.A. 1981); *Inter IKEA Sys. B.V. v. Akea, LLC*, 110 USPQ2d 1734, 1745 (TTAB 2014); *Baseball Am. Inc. v. Powerplay Sports Ltd.*, 71 USPQ2d 1844, 1847 n.9 (TTAB 2004)).

Additionally, the goods of the parties have no restrictions as to nature, type, channels of trade, or classes of purchasers and are “presumed to travel in the same channels of trade to the same class of purchasers.” *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (quoting *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1268, 62 USPQ2d 1001, 1005 (Fed. Cir. 2002)). Thus, applicant’s and

registrant's goods are related.

III. THIS PARTIAL REFUSAL APPLIES ONLY TO THE FOLLOWING SERVICES IN INTERNATIONAL CLASS 42: Electronic data storage

Registration of the applied-for mark is refused because of a likelihood of confusion with the mark in U.S. Registration No. 4144324. Trademark Act Section 2(d), 15 U.S.C. §1052(d); see TMEP §§1207.01 *et seq.* See the attached registration.

Trademark Act Section 2(d) bars registration of an applied-for mark that is so similar to a registered mark that it is likely consumers would be confused, mistaken, or deceived as to the commercial source of the goods and/or services of the parties. See 15 U.S.C. §1052(d). Likelihood of confusion is determined 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) (called the “*du Pont* factors”). *In re i.am.symbolic, llc*, 866 F.3d 1315, 1322, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017). Only those factors that are “relevant and of record” need be considered. *M2 Software, Inc. v. M2 Commc’ns, Inc.*, 450 F.3d 1378, 1382, 78 USPQ2d 1944, 1947 (Fed. Cir. 2006) (citing *Shen Mfg. Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 1241, 73 USPQ2d 1350, 1353 (Fed. Cir. 2004)); see *In re Inn at St. John’s, LLC*, 126 USPQ2d 1742, 1744 (TTAB 2018).

Although not all *du Pont* factors may be relevant, there are generally two key considerations in any likelihood of confusion analysis: (1) the similarities between the compared marks and (2) the relatedness of the compared goods and/or services. See *In re i.am.symbolic, llc*, 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)); *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 1103, 192 USPQ 24, 29 (C.C.P.A. 1976) (“The fundamental inquiry mandated by [Section] 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods [or services] and differences in the marks.”); TMEP §1207.01.

The applicant has applied to register the mark MI CLOUD for “electronic data storage.” Registration No. 4144324 is for the mark MYCLOUD for “Storage of electronic media, namely, data, documents, files, text, photos, images, graphics, music, audio, video, and multimedia content; Storage services for archiving databases, images and other electronic data; Storage services for archiving electronic data and consultation in the field of storage services for archiving electronic data.”

Similarity of the Marks

The marks are nearly identical and phonetically equivalent. The only difference is that the applicant has changed the letter “Y” in MY” to the phonetically equivalent letter “I.” There is no correct pronunciation of a mark because it is impossible to predict how the public will pronounce a particular mark. See *Embarcadero Techs., Inc. v. RStudio, Inc.*, 105 USPQ2d 1825, 1835 (TTAB 2013) (quoting *In re Viterro Inc.*, 671 F.3d 1358, 1367, 101 USPQ2d 1905, 1912 (Fed. Cir. 2012); *In re The Belgrade Shoe Co.*, 411 F.2d 1352, 1353, 162 USPQ 227, 227 (C.C.P.A. 1969)); TMEP §1207.01(b)(iv). The marks in question could clearly be pronounced the same; such similarity in sound alone may be sufficient to support a finding that the marks are confusingly similar. *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988); see *In re 1st USA Realty Prof’ls, Inc.*, 84 USPQ2d 1581, 1586 (TTAB 2007); TMEP §1207.01(b)(iv).

Moreover, the fact that applicant’s mark appears as two words and registrant’s mark appears as one does not obviate the likelihood of confusion. This difference represents on a slight difference in appearance. As such, the marks are identical in sound and virtually identical in appearance, and are thus confusingly similar for the purposes of determining likelihood of confusion. See, e.g., *Seaguard Corp. v. Seaward Int’l, Inc.*, 223 USPQ 48, 51 (TTAB 1984) (“[T]he marks ‘SEAGUARD’ and ‘SEA GUARD’ are, in contemplation of law, identical [internal citation omitted].”); *In re Best W. Family Steak House, Inc.*, 222 USPQ 827, 827 (TTAB 1984) (“There can be little doubt that the marks [BEEFMASTER and BEEF MASTER] are practically identical”); *Stock Pot, Inc. v. Stockpot Rest., Inc.*, 220 USPQ 52, 52 (TTAB 1983), *aff’d* 737 F.2d 1576, 222 USPQ 665 (Fed. Cir. 1984) (“There is no question that the marks of the parties [STOCKPOT and STOCK POT] are confusingly similar. The word marks are phonetically identical and visually almost identical.”).

Relatedness of the Services

Both the applicant and the registrant provide storage of data.

IV. THIS PARTIAL REFUSAL APPLIES ONLY TO THE FOLLOWING SERVICES IN INTERNATIONAL CLASS 35: Providing business information via a web site

Registration of the applied-for mark is refused because of a likelihood of confusion with the mark in U.S. Registration No. 4833746. Trademark Act Section 2(d), 15 U.S.C. §1052(d); see TMEP §§1207.01 *et seq.* See the attached registration.

Trademark Act Section 2(d) bars registration of an applied-for mark that is so similar to a registered mark that it is likely consumers would be confused, mistaken, or deceived as to the commercial source of the goods and/or services of the parties. See 15 U.S.C. §1052(d). Likelihood of confusion is determined 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) (called the “*du Pont* factors”). *In re i.am.symbolic, llc*, 866 F.3d 1315, 1322, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017). Only those factors that are “relevant and of record” need be considered. *M2 Software, Inc. v. M2 Commc’ns, Inc.*, 450 F.3d 1378, 1382, 78 USPQ2d 1944, 1947 (Fed. Cir. 2006) (citing *Shen Mfg. Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 1241, 73 USPQ2d 1350, 1353 (Fed. Cir. 2004)); see *In re Inn at St. John’s, LLC*, 126 USPQ2d 1742, 1744 (TTAB 2018).

Although not all *du Pont* factors may be relevant, there are generally two key considerations in any likelihood of confusion analysis: (1) the similarities between the compared marks and (2) the relatedness of the compared goods and/or services. See *In re i.am.symbolic, llc*, 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)); *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 1103, 192 USPQ 24, 29 (C.C.P.A. 1976) (“The fundamental inquiry mandated by [Section] 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods [or services] and differences in the marks.”); TMEP §1207.01.

The applicant has applied to register the mark **MI CLOUD** for “providing business information via a web site.” **Registration No. 4833746** is for the mark **MYCLOUD** for “business consulting services, namely, providing assistance in development of business strategies and creative ideation.”

Similarity of the Marks

The marks are nearly identical and phonetically equivalent. The only difference is that the applicant has changed the letter “Y” in MY” to the phonetically equivalent letter “I.” There is no correct pronunciation of a mark because it is impossible to predict how the public will pronounce a particular mark. See *Embarcadero Techs., Inc. v. RStudio, Inc.*, 105 USPQ2d 1825, 1835 (TTAB 2013) (quoting *In re Viterra Inc.*, 671 F.3d 1358, 1367, 101 USPQ2d 1905, 1912 (Fed. Cir. 2012); *In re The Belgrade Shoe Co.*, 411 F.2d 1352, 1353, 162 USPQ 227, 227 (C.C.P.A. 1969)); TMEP §1207.01(b)(iv). The marks in question could clearly be pronounced the same; such similarity in sound alone may be sufficient to support a finding that the marks are confusingly similar. *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988); see *In re Ist USA Realty Prof'ls, Inc.*, 84 USPQ2d 1581, 1586 (TTAB 2007); TMEP §1207.01(b)(iv).

Moreover, the fact that applicant’s mark appears as two words and registrant’s mark appears as one does not obviate the likelihood of confusion. This difference represents on a slight difference in appearance. As such, the marks are identical in sound and virtually identical in appearance, and are thus confusingly similar for the purposes of determining likelihood of confusion. See, e.g., *Seaguard Corp. v. Seaward Int'l, Inc.*, 223 USPQ 48, 51 (TTAB 1984) (“[T]he marks ‘SEAGUARD’ and ‘SEA GUARD’ are, in contemplation of law, identical [internal citation omitted].”); *In re Best W. Family Steak House, Inc.*, 222 USPQ 827, 827 (TTAB 1984) (“There can be little doubt that the marks [BEEFMASTER and BEEF MASTER] are practically identical”); *Stock Pot, Inc. v. Stockpot Rest., Inc.*, 220 USPQ 52, 52 (TTAB 1983), *aff’d* 737 F.2d 1576, 222 USPQ 665 (Fed. Cir. 1984) (“There is no question that the marks of the parties [STOCKPOT and STOCK POT] are confusingly similar. The word marks are phonetically identical and visually almost identical.”).

Relatedness of the Services

The services are presumed to be identical or very highly related. Determining likelihood of confusion is based on the description of the goods stated in the application and registration at issue, not on extrinsic evidence of actual use. See *In re Detroit Athletic Co.*, 903 F.3d 1297, 1307, 128 USPQ2d 1047, 1052 (Fed. Cir. 2018) (citing *In re i.am.symbolic, llc*, 866 F.3d 1315, 1325, 123 USPQ2d 1744, 1749 (Fed. Cir. 2017)).

Here, it must be presumed that applicant’s business information includes information regarding “development of business strategies and creative ideation.” See, e.g., *In re Solid State Design Inc.*, 125 USPQ2d 1409, 1412-15 (TTAB 2018); *Sw. Mgmt., Inc. v. Ocinomled, Ltd.*, 115 USPQ2d 1007, 1025 (TTAB 2015). Thus, applicant’s and registrant’s goods are legally identical. See, e.g., *In re i.am.symbolic, llc*, 127 USPQ2d 1627, 1629 (TTAB 2018) (citing *Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp., Inc.*, 648 F.2d 1335, 1336, 209 USPQ 986, 988 (C.C.P.A. 1981); *Inter IKEA Sys. B.V. v. Akea, LLC*, 110 USPQ2d 1734, 1745 (TTAB 2014); *Baseball Am. Inc. v. Powerplay Sports Ltd.*, 71 USPQ2d 1844, 1847 n.9 (TTAB 2004)).

Conclusion – Refusals under Section 2(d)

The marks are all nearly identical phonetic equivalents. Where the marks of the respective parties are identical or virtually identical, as in this case, the degree of similarity or relatedness between the goods and/or services needed to support a finding of likelihood of confusion declines. See *In re i.am.symbolic, llc*, 116 USPQ2d 1406, 1411 (TTAB 2015) (citing *In re Shell Oil Co.*, 992 F.2d 1204, 1207, 26 USPQ2d 1687, 1689 (Fed. Cir. 1993)), *aff’d*, 866 F.3d 1315, 123 USPQ2d 1744 (Fed. Cir. 2017); TMEP §1207.01(a).

The goods and services are all presumed to be identical or are very highly related.

The similarities between the marks and the goods and services are so great as to create a likelihood of confusion. 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).

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

If applicant responds to the refusal(s), applicant must also respond to the requirement(s) set forth below.

Description of the Mark

Applicant must submit an amended description of the mark because the current one uses broad, vague language that does not accurately describe the mark. 37 C.F.R. §2.37; see TMEP §§808.01, 808.02. Descriptions must be accurate and identify all the literal and design elements in the mark. See 37 C.F.R. §2.37; TMEP §808.02.

The following description is suggested, if accurate: **The mark consists of the wording MI CLOUD” in stylized font.**

Inquiry of Meaning or Significance

- To permit proper examination of the application, applicant must explain whether the wording in the mark “MI” has any significance in the relevant trade or industry or as applied to applicant’s goods and services, or if such wording is a “term of art” within applicant’s industry. See 37 C.F.R. §2.61(b); TMEP §814. Failure to comply with a request for information is grounds for refusing registration. *In re Harley*, 119 USPQ2d 1755, 1757-58 (TTAB 2016); TMEP §814.

Identification of Goods in International Class 9

- The identification for software in International Class 9 is indefinite and must be clarified by amending to specify the purpose or function of the software. See 37 C.F.R. §2.32(a)(6); TMEP §1402.03(d). If the software is content- or field-specific, applicant must also specify its content or field of use. See TMEP §1402.03(d). The USPTO requires such specificity in identifying computer software in order for a trademark examining attorney to examine the application properly and make appropriate decisions concerning possible conflicts between the applicant’s mark and other marks. See *In re N.A.D. Inc.*, 57 USPQ2d 1872, 1874 (TTAB 2000); TMEP §1402.03(d).

The international classification of goods in applications filed under Trademark Act Section 66(a) cannot be changed from the classification the International Bureau of the World Intellectual Property Organization assigned to the goods in the corresponding international registration. 37 C.F.R. §2.85(d); TMEP §1401.03(d). Therefore, although software may be classified in international classes other than International Class 9 (i.e., International Classes 41 and 42), any modification to the identification must identify goods in International Class 9 only, the class specified in the application for such goods. See TMEP §1904.02(c)(ii).

The following are examples of acceptable identifications for software in International Class 9: “downloadable mobile applications for managing bank accounts,” “desktop publishing software,” “tax preparation software.”

The wording “intercommunication apparatus” “measuring instruments” in the identification of goods is indefinite and must be clarified. See 37 C.F.R. §2.32(a)(6); TMEP §1402.01. Applicant must amend this wording to specify the common commercial or generic name of the goods. See TMEP §1402.01. If the goods have no common commercial or generic name, applicant must describe the product, its main purpose, and its intended uses. See *id.*

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).

The identification of goods contains brackets. 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 brackets from the identification and incorporate any parenthetical or bracketed information into the description of the goods and/or services.

The wording “measuring instruments” and “sensors” in the identification of goods is indefinite and must be clarified because to state the specific control or sensor function. See 37 C.F.R. §2.32(a)(6); TMEP §1402.01.

The identification for “theft prevention installations, electric systems” in International Class 9 is indefinite and too broad and must be clarified because the wording does not make clear the nature of the specific installation and could identify goods in more than one international class. See 37 C.F.R. §2.32(a)(6); TMEP §1401.05(d).

Applicant must clarify the goods by listing the installation’s parts or components, using common generic terms and referencing the primary parts or components of the system first. See 37 C.F.R. §2.32(a)(6); TMEP §§1401.05(d), 1402.01, 1402.03(a).

The international classification of goods in applications filed under Trademark Act Section 66(a) cannot be changed from the classification the International Bureau of the World Intellectual Property Organization assigned to the goods in the corresponding international registration. 37 C.F.R. §2.85(d); TMEP §1401.03(d). Therefore, although systems may be classified in several international classes, any modification to the identification must identify goods in International Class 9 only, the class specified in the application for such goods. See TMEP §1904.02(c)(ii).

The applicant may adopt the following amended identification of goods in **International Class 9**, if accurate: Computer software applications, downloadable for [indicate function(s) of software, and, if field specific, state field]; intercommunication apparatus, namely, [identify by common commercial name]; portable media players; cameras for photography; video screens; remote control apparatus for [indicate what is being controlled]; measuring instruments, namely, [identify by common commercial name]; sensors for [indicate]; computer chips in nature of electronic integrated circuits; photographic transparencies; electric theft prevention installations consisting primarily of burglary alarms; batteries, electric.

Recitation of Services in International Class 38

The wording “message sending” in the identification of services is indefinite and must be clarified. *See* 37 C.F.R. §2.32(a)(6); TMEP §1402.01. Applicant may substitute the following wording, if accurate: Electronic message sending.

The wording “providing online forums” in the identification of services is indefinite and must be clarified. *See* 37 C.F.R. §2.32(a)(6); TMEP §1402.01. Applicant may substitute the following wording, if accurate: providing online forums for transmission of messages among computer users.

The applicant may adopt the following amended recitation of services in **International Class 38**, if accurate: **Electronic message sending; communications by computer terminals; computer aided transmission of messages and images; providing user access to global computer networks; providing access to databases; providing Internet chatrooms; providing online forums for transmission of messages among computer users; video-on-demand transmission; paid television program broadcasting; television broadcasting.**

Recitation of Services in International Class 42

The wording “monitoring of computer systems by remote access” in the identification of services is indefinite and must be clarified to state the specific purpose of the monitoring. *See* 37 C.F.R. §2.32(a)(6); TMEP §1402.01. Applicant may substitute the following wording, if accurate: Monitoring of computer systems by remote access **for detecting unauthorized access or data breach.**

The wording “cloud computing; software as a service [SaaS]” in the identification of services is indefinite and must be clarified to specify the purpose or function of the software provided. *See* 37 C.F.R. §2.32(a)(6); TMEP §1402.03(d). If the software is content- or field-specific, applicant must also specify its content or field of use. *See* TMEP §1402.03(d). The USPTO requires such specificity in identifying computer software in order for a trademark examining attorney to examine the application properly and make appropriate decisions concerning possible conflicts between the applicant's mark and other marks. *See* *In re N.A.D. Inc.*, 57 USPQ2d 1872, 1874 (TTAB 2000); TMEP §1402.03(d).

The identification of contains brackets. 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 brackets from the identification and incorporate any parenthetical or bracketed information into the description of the goods and/or services.

The wording “technical research” in the identification of services is indefinite and must be clarified to indicate the specific field or subject matter. *See* 37 C.F.R. §2.32(a)(6); TMEP §1402.01.

The applicant may adopt the following amended recitation of services in **International Class 42**, if accurate: Monitoring of computer systems by remote access **for detecting unauthorized access or data breach**; computer software design; electronic data storage; conversion of data or documents from physical to electronic media; cloud computing **featuring software for “indicate function(s) of software, and, if field specific, indicate field”**; software as a service [SaaS] **featuring software for “indicate function(s) of software, and, if field specific, indicate field”**; **hosting the websites of others on a computer server for a global computer network**; technical research in the field of [indicate]; industrial design; design of interior decor.

General Guidelines – Identification of Goods and Services

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 narrowed. *See* 37 C.F.R. §2.71(a); TMEP §§1402.06, 1904.02(c)(iv). 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 narrowed. *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). Additionally, for applications filed under Trademark Act Section 66(a), the scope of the identification for purposes of permissible amendments is limited by the international class assigned by the International Bureau of the World Intellectual Property Organization (International Bureau); and the classification of goods and/or services may not be changed from that assigned by the International Bureau. 37 C.F.R. §2.85(d); TMEP §§1401.03(d), 1904.02(b). Further, in a multiple-class Section 66(a) application, classes may not be added or goods and/or services transferred from one existing class to another. 37 C.F.R. §2.85(d); TMEP §1401.03(d).

For assistance with identifying and classifying goods and services in trademark applications, please see the USPTO's online searchable [*U.S. Acceptable Identification of Goods and Services Manual*](#). *See* TMEP §1402.04.

Reply Guidelines

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>.

Please call or email the assigned trademark examining attorney with questions about this Office action. Although the trademark examining attorney cannot provide legal advice or statements about applicant's rights, the trademark examining attorney can provide applicant with additional explanation about the refusal(s) and/or requirement(s) in this Office action. See TMEP §§705.02, 709.06. Although the USPTO does not accept emails as responses to Office actions, emails can be used for informal communications and will be included in the application record. See 37 C.F.R. §§2.62(c), 2.191; TMEP §§304.01-.02, 709.04-.05.

/Julie Watson/
Trademark Examining Attorney
Law Office 109
571-272-9236
julie.watson@uspto.gov

TO RESPOND TO THIS LETTER: Go to 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. 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 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>.

.....
^[1] Please note the recitation of services in International Class 35 is acceptable as written in the application.

DESIGN MARK

Serial Number

85027870

Status

REGISTERED

Word Mark

MY CLOUD

Standard Character Mark

Yes

Registration Number

4444097

Date Registered

2013/12/03

Type of Mark

TRADEMARK

Register

PRINCIPAL

Mark Drawing Code

(4) STANDARD CHARACTER MARK

Owner

Western Digital Technologies, Inc. CORPORATION DELAWARE 3355 Michelson Drive Suite 100 Irvine CALIFORNIA 92612

Goods/Services

Class Status -- ACTIVE. IC 009. US 021 023 026 036 038. G & S: Computer software to connect and manage networked devices for remote access, back-up, sharing, and syncing of documents and files over a network or the internet. First Use: 2013/10/02. First Use In Commerce: 2013/10/02.

Disclaimer Statement

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "CLOUD" APART FROM THE MARK AS SHOWN.

Filing Date

2010/04/30

Examining Attorney

BENMAMAN, ALICE

Attorney of Record

Justin Aida

MY CLOUD

DESIGN MARK

Serial Number

85319318

Status

REGISTERED

Word Mark

MY CLOUD

Standard Character Mark

Yes

Registration Number

4448166

Date Registered

2013/12/10

Type of Mark

TRADEMARK

Register

PRINCIPAL

Mark Drawing Code

(4) STANDARD CHARACTER MARK

Owner

Western Digital Technologies, Inc. CORPORATION DELAWARE 3355 Michelson Drive Suite 100 Irvine CALIFORNIA 92612

Goods/Services

Class Status -- ACTIVE. IC 009. US 021 023 026 036 038. G & S: Computer products, namely, data storage products in the nature of digital electronic devices for recording, transmitting, organizing, manipulating, receiving, playing and reviewing text, data, image, audio and video files; computer storage devices in the nature of internal and external disk drives, internal and external solid state drives, network-enabled drives and computer peripherals. First Use: 2013/10/02. First Use In Commerce: 2013/10/02.

Disclaimer Statement

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "CLOUD" APART FROM THE MARK AS SHOWN.

Filing Date

2011/05/12

Examining Attorney

Print: Nov 19, 2018

85319318

STIGLITZ, SUSAN

Attorney of Record
Justin Aida

MY CLOUD

DESIGN MARK

Serial Number

85384576

Status

SECTION 8-ACCEPTED

Word Mark

MYCLOUD

Standard Character Mark

Yes

Registration Number

4144324

Date Registered

2012/05/15

Type of Mark

SERVICE MARK

Register

PRINCIPAL

Mark Drawing Code

(4) STANDARD CHARACTER MARK

Owner

C & E Vision Services, Inc. CORPORATION CALIFORNIA 1015 Calle Amanecer
San Clemente CALIFORNIA 92673

Goods/Services

Class Status -- ACTIVE. IC 039. US 100 105. G & S: Storage of
electronic media, namely, data, documents, files, text, photos,
images, graphics, music, audio, video, and multimedia content; Storage
services for archiving databases, images and other electronic data;
Storage services for archiving electronic data and consultation in the
field of storage services for archiving electronic data. First Use:
2012/02/01. First Use In Commerce: 2012/02/01.

Filing Date

2011/07/29

Examining Attorney

MITTLER, ROBIN

Mycloud

DESIGN MARK

Serial Number

86522525

Status

REGISTERED

Word Mark

MYCLOUD

Standard Character Mark

Yes

Registration Number

4833746

Date Registered

2015/10/13

Type of Mark

SERVICE MARK

Register

PRINCIPAL

Mark Drawing Code

(4) STANDARD CHARACTER MARK

Owner

Simplivio LIMITED LIABILITY COMPANY MASSACHUSETTS #300 303 Wyman
Street Waltham MASSACHUSETTS 02451

Goods/Services

Class Status -- ACTIVE. IC 035. US 100 101 102. G & S: Business
consulting services, namely, providing assistance in development of
business strategies and creative ideation. First Use: 2015/03/05.
First Use In Commerce: 2015/03/05.

Filing Date

2015/02/03

Examining Attorney

TWOHIG, SHANNON

myCLOUD

DESIGN MARK

Serial Number

87703070

Status

FINAL REFUSAL - MAILED

Word Mark

MYKLOUD

Standard Character Mark

Yes

Type of Mark

SERVICE MARK

Register

PRINCIPAL

Mark Drawing Code

(4) STANDARD CHARACTER MARK

Owner

Arhive Information Management LLC LIMITED LIABILITY COMPANY DELAWARE
6751 Discovery Boulevard Mableton GEORGIA 30126

Goods/Services

Class Status -- ACTIVE. IC 042. US 100 101. G & S: Platform as a service (PaaS) featuring computer software for online document and information storage, management, access, and collaboration; consulting services relating to the electronic destruction of computer data in the nature of hard drive erasure; conversion of business data and other documents from physical to electronic media; scanning and format conversion services, namely, digitization of documents; computer programming for others in the fields of organization, maintenance, storage, management, retention and destruction of business records, vital records, computer data, audiotapes, medical records, films, master recordings, archival materials and records; provision of disaster recovery computer facilities; computer services, namely, electronic data backup and recovery services; computer services for the secure destruction of electronic records, namely, hard drive erasure; data protection services, namely, data encryption and decoding services; data migration; data restoration being recovery of computer data; cloud backup services, namely, providing electronic data back-up services through cloud computing; computer disaster recovery services, namely, recovery of computer data; providing internet based data capture services, namely, electronic storage services for archiving electronic information data; information technology consulting in the field of workflow processes and efficiencies, namely, business process automation services, enterprise

content management, conversion of physical assets to digital assets.

Filing Date

2017/11/30

Examining Attorney

RIEPEL, CHRISTINA

Attorney of Record

Erik M. Pelton

MYKLOUD