

**UNITED STATES PATENT AND TRADEMARK OFFICE**

SERIAL NO: 79/014242

APPLICANT: Nokia Corporation

**\*79014242\***

**CORRESPONDENT ADDRESS:**

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**RETURN ADDRESS:**

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P.O. Box 1451  
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MARK: MAEMO

CORRESPONDENT'S REFERENCE/DOCKET NO: N/A

CORRESPONDENT EMAIL ADDRESS:

Please provide in all correspondence:

1. Filing date, serial number, mark and applicant's name.
2. Date of this Office Action.
3. Examining Attorney's name and Law Office number.
4. Your telephone number and e-mail address.

**OFFICE ACTION**

**RESPONSE TIME LIMIT:** TO AVOID ABANDONMENT, THE OFFICE MUST RECEIVE A PROPER RESPONSE TO THIS OFFICE ACTION WITHIN 6 MONTHS OF THE MAILING OR E-MAILING DATE.

Serial Number 79/014242

**INTERNATIONAL REGISTRATION NO.** 0858859

This is a **PROVISIONAL PARTIAL REFUSAL** of the trademark and/or service mark in the above-referenced U.S. application that **applies to only the following goods in International Class 9 in the application: "libraries used for the development of other software applications" and "application suites, namely applications for business productivity, personal information management, multimedia content players, multimedia encoders and decoders, and synchronization with desktop PC's for hand-held devices."** 15 U.S.C. §1141h(c).

**APPLICANT OR ATTORNEY CAN RESPOND TO PROVISIONAL REFUSAL:**

Applicant may respond directly to this provisional refusal Office action, or applicant's attorney may respond on applicant's behalf.

NOTE: Attorneys hired to represent an applicant in a trademark matter before the Office must be eligible under 37 C.F.R. §10.14:

- (1) *Attorneys residing in the United States* who are in good standing with the bar of any United States court or the highest court of any state, may practice before the Office in trademark matters.
- (2) *A foreign attorney not residing in the United States* who is in good standing before the patent or trademark office of the country in which he or she resides, may practice before the Office in trademark matters only in cases where the patent and trademark office of that foreign country allows substantially reciprocal privileges to those permitted to practice

before the Office. Currently, Canadian attorneys are the only foreign attorneys recognized as meeting this criterion. A foreign attorney who meets the requirements of 37 C.F.R. §10.14 (c) can only represent parties located in the country in which the foreign attorney resides and practices. TMEP §602.

The Office cannot aid in the selection of an attorney. 37 C.F.R. §2.11.

If applicant is not represented by an attorney, applicant may appoint a domestic representative who would receive correspondence from the Office and be served process or notice of proceedings affecting the application. 15 U.S.C. §1141h(d); 37 C.F.R. §2.24.

**THE APPLICATION HAS BEEN PROVISIONALLY PARTIALLY REFUSED AS FOLLOWS:**

**NOTE:** This is a partial refusal Office action. The refusal(s) and/or requirement(s) in this Office action apply only to specified goods in the U.S. application.

The assigned trademark examining attorney has reviewed the referenced application, and has determined the following:

**Search Results**

The examining attorney has searched the Office records and has found no similar registered or pending mark which would bar registration under Trademark Act Section 2(d), 15 U.S.C. §1052(d). TMEP §704.02.

However, before the mark can be approved for publication, the applicant must address the following informalities:

**Identification of Goods in International Class 9**

a. The wording "Computer software . . . **libraries**" in the identification of goods needs clarification because it is unclear what the goods actually are or in what format they appear. Applicant must amend the identification of goods to specify the common commercial or generic name for the goods. If there is no common commercial or generic name for the product, then applicant must describe the product and intended consumer as well as its main purpose and intended uses. TMEP §1402.01. The applicant may adopt the following wording, if accurate: Electronic database in the field of {indicate subject matter or field} recorded on computer media.

b. The wording "application suites, namely applications for business productivity, personal information management, multimedia content players, multimedia encoders and decoders, and synchronization with desktop PC's for hand-held devices" in the identification of goods is unacceptable as indefinite. The applicant may amend this wording to "application software suites, namely, computer application software for hand-held devices for business productivity, personal information management, multimedia content players, multimedia encoders and decoders, and synchronization with desktop PCs." if accurate. TMEP §1402.01.

c. Applicant may adopt the following identification of goods in International Class 9, if accurate: Computer software tools used for the development of other software applications; electronic database in the field of computer software development tools recorded on computer media; computer software development tools; computer software for creating and managing a computer desktop; computer software for use as a graphical user interface; computer software for word processing, database management, and use as a spreadsheet; computer software for hand-held devices in various fields functioning as a desktop center for storing and entering personal information management data, executing applications and transferring data to hand-held devices; and

application software suites, namely, computer application software for hand-held devices for business productivity, personal information management, multimedia content players, multimedia encoders and decoders, and synchronization with desktop PCs. TMEP §1402.01.

d. Please note that, while the identification of goods may be amended to clarify or limit the goods, adding to the goods or broadening the scope of the goods is not permitted. 37 C.F.R. §2.71 (a); TMEP §1402.06. Therefore, applicant may not amend the identification to include goods that are not within the scope of the goods set forth in the present identification.

If applicant should fail to respond to this Office action within the six month time limit, then the following goods in International Class 9 will be deleted from the application: “libraries used for the development of other software applications” and “application suites, namely applications for business productivity, personal information management, multimedia content players, multimedia encoders and decoders, and synchronization with desktop PC's for hand-held devices.” The application will then proceed forward for the following goods and services only: “Computer software tools used for the development of other software applications; computer software development tools; computer software for creating and managing a computer desktop; computer software for use as a graphical user interface; computer software for word processing, database management, and use as a spreadsheet; computer software for hand-held devices in various fields functioning as a desktop center for storing and entering personal information management data, executing applications and transferring data to hand-held devices” in International Class 9, and International Class 42 in its entirety. 37 C.F.R. §2.65(a).

### **RESPONSE GUIDELINES**

1. No set form is required for response to this Office action. The applicant must respond to each point raised. The applicant should simply set forth the required changes or statements and request that the Office enter them. The applicant must sign the response. In addition to the identifying information required at the beginning of this letter, the applicant should provide a telephone number to speed up further processing.
2. In all correspondence to the Patent and Trademark Office, the applicant should list the name and law office of the examining attorney, the serial number of this application, the mailing date of this Office action, and the applicant's telephone number.
3. If the applicant has any questions or needs assistance in responding to this Office action, please telephone the assigned examining attorney.

A prompt response to this Office action will expedite the handling of this matter.

/Barbara A. Gaynor/  
Barbara A. Gaynor  
Trademark Examining Attorney  
Law Office 115  
(571) 272-9164

### **HOW TO RESPOND TO THIS OFFICE ACTION:**

- **ONLINE RESPONSE:** You may respond formally using the Office’s Trademark Electronic Application System (TEAS) Response to Office Action form (visit <http://www.uspto.gov/teas/index.html> and follow the instructions, but if the Office Action has been issued via email, you must wait 72 hours after receipt of the Office Action to respond via TEAS).

- **REGULAR MAIL RESPONSE:** To respond by regular mail, your response should be sent to the mailing return address above and include the serial number, law office number and examining attorney's name in your response.

**STATUS OF APPLICATION:** To check the status of your application, visit the Office's Trademark Applications and Registrations Retrieval (TARR) system at <http://tarr.uspto.gov>.

**VIEW APPLICATION DOCUMENTS ONLINE:** Documents in the electronic file for pending applications can be viewed and downloaded online at <http://portal.uspto.gov/external/portal/tow>.

**GENERAL TRADEMARK INFORMATION:** For general information about trademarks, please visit the Office's website at <http://www.uspto.gov/main/trademarks.htm>

**FOR INQUIRIES OR QUESTIONS ABOUT THIS OFFICE ACTION, PLEASE CONTACT THE ASSIGNED EXAMINING ATTORNEY SPECIFIED ABOVE.**