

From: Dubois, Michelle

Sent: 7/21/2020 5:36:11 PM

To: TTAB E Filing

CC:

Subject: U.S. Trademark Application Serial No. 87659076 - MEDIATEK SENSIO - M129520046US - Request for Reconsideration Denied - Return to TTAB

Attachment Information:

Count: 15

Files: 20180915-sou0002.JPG, 86381193P001OF002.JPG, 86381193P002OF002.JPG, 86562031P001OF002.JPG, 86562031P002OF002.JPG, 87761211P001OF003.JPG, 87761211P002OF003.JPG, 87761211P003OF003.JPG, 88500325P001OF002.JPG, 88500325P002OF002.JPG, 20150316-rfa0003.JPG, 20190706-rfa0003.JPG, 20190706-rfa0004.JPG, 20150917-sou0003.JPG, 87659076.doc

United States Patent and Trademark Office (USPTO)
Office Action (Official Letter) About Applicant's Trademark Application

U.S. Application Serial No. 87659076

Mark: MEDIATEK SENSIO

Correspondence Address:

DOUGLAS R WOLF

WOLF GREENFIELD & SACKS PC

600 ATLANTIC AVENUE

BOSTON, MA 02210

Applicant: MEDIATEK INC.

Reference/Docket No. M129520046US

Correspondence Email Address:

drwtrademarks@wolfgreenfield.com

REQUEST FOR RECONSIDERATION
AFTER FINAL ACTION
DENIED

Issue date: **July 21, 2020**

Applicant's request for reconsideration is denied. *See* 37 C.F.R. §2.63(b)(3). The trademark examining attorney has carefully reviewed applicant's request and determined the request did not: (1) raise a new issue, (2) resolve all the outstanding issue(s), (3) provide any new or compelling

evidence with regard to the outstanding issue(s), or (4) present analysis and arguments that were persuasive or shed new light on the outstanding issue(s). TMEP §§715.03(a)(ii)(B), 715.04(a).

Applicant has argued that the marks MEDIATEK SENSIO and XSENSIO are different because the prefix of “XSE” is “jarring,” is unique, and creates a unique pronunciation.

However, the XSENSIO mark is registered with a standard character claim. As such, the registrant is entitled to all depictions of a standard character mark regardless of the font style, size, or color. *See In re Viterra Inc.*, 671 F.3d 1358, 1364-65, 101 USPQ2d 1905, 1910 (Fed. Cir. 2012); *Citigroup Inc. v. Capital City Bank Group, Inc.*, 637 F.3d 1344, 1353, 98 USPQ2d 1253, 1259 (Fed. Cir. 2011). Because of this broad protection, registrant’s mark may appear in commerce with the “SENSIO” portion as more dominant than the “X” prefix. Examples of such uses are attached as evidence to this Office action. The evidence consists of specimens and Office records for the following registrations:

XSPEED for various lights for vehicles.

XSOLAR for “Chargers for batteries; Batteries; Solar-powered rechargeable batteries; Solar charger.”

XSTIM ENABLED for “Telephones; digital telephones; voice over internet protocol (VOIP) telephones; office telephones.”

XSENSE for “Cosmetics; essential oils; fragrances; perfume oils; scented oils.”

The specimens for XSPEED, XSOLAR, and XSTIM ENABLED demonstrate that the “X” portion appears as more of a design element. It will be noted that the “X” appears in a different font and/or coloring than the “SPEED,” “SOLAR,” and “STIM ENABLED” portions.

The specimen showing use of the mark “XSENSE” is similar in nature. The word “SENSE” appears in a different font and is emphasized since it is repeated in the additional language “worksense,” “playsense,” and “restsense” on the product packaging. Therefore, in this case it is the word “SENSE” that stands out to the consumer.

If the registered mark appears in a similar manner as in any of the above specimens, it is maintained that the “X” portion does not necessarily create a “jarring” appearance; that is, the “SENSIO” portion could appear more separate and therefore more dominant.

Finally, it is noted that the identification of goods of the parties are highly similar if not identical in that registrant’s “microchips” are a synonym for “integrated circuit.” Please note that where the goods and/or services of an applicant and registrant are identical or virtually identical, the degree of similarity

between the marks required to support a finding that confusion is likely declines. *See Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 1373, 127 USPQ2d 1797, 1801 (Fed. Cir. 2018) (quoting *In re Viterra Inc.*, 671 F.3d 1358, 1363, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012)); TMEP §1207.01(b).

Accordingly, the following requirement(s) and/or refusal(s) made final in the Office action dated 11/27/19 are **maintained and continued**:

- Section 2(d) refusal

See TMEP §§715.03(a)(ii)(B), 715.04(a).

If applicant has already filed an appeal with the Trademark Trial and Appeal Board, the Board will be notified to resume the appeal. *See* TMEP §715.04(a).

If applicant has not filed an appeal and time remains in the six-month response period, applicant has the remainder of that time to (1) [file another request for reconsideration](#) that complies with and/or overcomes any outstanding final requirement(s) and/or refusal(s), and/or (2) [file a notice of appeal](#) to the Board. TMEP §715.03(a)(ii)(B). Filing a request for reconsideration does not stay or extend the time for filing an appeal. 37 C.F.R. §2.63(b)(3); *see* TMEP §715.03(c).

/med/

Michelle E. Dubois

Trademark Attorney

USPTO, Law Office 107

(571) 272-5887

michelle.dubois@uspto.gov