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

APPLICATION SERIAL NO. 85676048

MARK: HARNESSING THE FULL POWER OF THE

CORRESPONDENT ADDRESS:
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APPLICANT: Jugnoo Inc.

CORRESPONDENT’S REFERENCE/DOCKET NO : J0258.20008U
CORRESPONDENT E-MAIL ADDRESS:

OFFICE ACTION

STRict DEADLINE TO RESPOND TO THIS LETTER

TO AVOID ABANDONMENT OF APPLICANT’S TRADEMARK APPLICATION, THE USPTO MUST RECEIVE APPLICANT’S COMPLETE RESPONSE TO THIS LETTER WITHIN 6 MONTHS OF THE ISSUE/MAILING DATE BELOW.

ISSUE/MAILING DATE:

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, 2.65(a); TMEP §§711, 718.03.

SUMMARY OF ISSUES

Registration is refused pending the following:

- Applicant must clarify its filing bases.
- Applicant must clarify the identification of goods and services.

No Conflicting Marks Found

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

CLARIFICATION OF FILING BASIS

Applicant must clarify its filing basis.

Applicant identifies 1(b) and 44(d) for these goods and services. The application specifies both an intent to use basis under Trademark Act Section 1(b) and a claim of priority under Section 44(d) based on a foreign application. See 15 U.S.C. §§1051(b), 1126(d); 37 C.F.R. §2.34(a)(2), (a)(4). However, no copy of a foreign registration has been provided even though the application indicates applicant’s intent to rely on Section 44(e) as an additional basis for registration. See 15 U.S.C. §1126(e).

An application with a Section 44(e) basis must include a true copy, photocopy, certification, or certified copy of a foreign registration from an
applicant’s country of origin. 15 U.S.C. §1126(e); 37 C.F.R. §2.34(a)(3)(ii); TMEP §§1004, 1004.01, 1016. In addition, an applicant’s country of origin must be a party to a convention or treaty relating to trademarks to which the United States is also a party, or must extend reciprocal registration rights to nationals of the United States by law. 15 U.S.C. §1126(b); TMEP §§1002.01, 1004.

Therefore, applicant must provide a copy of the foreign registration from applicant’s country of origin when it becomes available. TMEP §1003.04(a). A copy of a foreign registration must consist of a document issued to an applicant by, or certified by, the intellectual property office in applicant’s country of origin. TMEP §1004.01. If applicant’s country of origin does not issue registrations or Madrid Protocol certificates of extension of protection, applicant may submit a copy of the Madrid Protocol international registration that shows that protection of the international registration has been extended to applicant’s country of origin. TMEP §1016. In addition, applicant must also provide an English translation if the foreign registration is not written in English. 37 C.F.R. §2.34(a)(3)(ii); TMEP §1004.01(a)-(b). The translation should be signed by the translator. TMEP §1004.01(b).

If the foreign registration has not yet issued, or applicant requires additional time to procure a copy of the foreign registration (and English translation, as appropriate), applicant should so inform the trademark examining attorney and request that the U.S. application be suspended until a copy of the foreign registration is available. TMEP §§716.02(b), 1003.04(b).

If applicant cannot satisfy the requirements of a Section 44(e) basis, applicant may request that the mark be approved for publication based solely on the Section 1(b) basis. See 15 U.S.C. §§1051(b), 1126(e); 37 C.F.R. §2.35(b)(1); TMEP §§806.02(f), 806.04(b), 1003.04(b). Although the mark may be approved for publication on the Section 1(b) basis, it will not register until an acceptable allegation of use has been filed. See 15 U.S.C. §1051(c)-(d); 37 C.F.R. §§2.76, 2.88; TMEP §1103. Please note that, if the U.S. application satisfied the requirements of Section 44(d) as of the U.S. application filing date, applicant may retain the priority filing date under Section 44(d) without perfection of the Section 44(e) basis, provided there is a continuing valid basis for registration. See 37 C.F.R. §2.35(b)(1), (4); TMEP §§806.02(f), 806.04(b).

IDENTIFICATION AND CLASSIFICATION OF GOODS AND SERVICES

The identification of goods and services is indefinite and must be clarified. See TMEP §1402.01. Applicant must adopt the appropriate international classification number for the goods and/or services identified in the application. The United States follows the International Classification of Goods and Services for the Purposes of the Registration of Marks, established by the World Intellectual Property Organization, to classify goods and services. 37 C.F.R. §2.85(a); TMEP §§1401.02, 1401.02(a).

The following is guidance in order to properly identify the wording in the identification of goods and services.

Computer software may be classified in two international classes - as a product in International Class 9 or a service in International Class 42. Computer software is a product classified in International Class 9 if it is (1) recorded on media (such as CDs) or (2) downloadable and thus can be transferred or copied from a remote computer system for use on a long-term basis. However, on-line non-downloadable software is considered a computer service in International Class 42 because it is generally provided for use on a temporary basis. See generally TMEP §1402.11(a).

Based on the above guidance, applicant must properly identify its software either as recorded on computer media or downloadable. In the alternative, applicant may clarify that the software is provided as a computer service as non-downloadable software. In addition, applicant must correctly classify the computer software products.

Furthermore, an identification for computer software must specify the purpose or function of the software. See TMEP §1402.03(d). If the software is field-specific, the identification must also specify the field of use. Id. Clarification of the purpose, function, or field of use of the software is necessary for the USPTO to properly examine the application 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).

In the case of “COMPUTER SOFTWARE FOR VIDEO RENDERING,” applicant must amend to clearly specify the purpose or function of the software. Examples include: software for use in the encryption and decryption of video; software for use in the safeguarding of video files.

COMPUTER SOFTWARE FOR PROVIDING INTERACTIVE MEDIA PLATFORMS FOR INTERNET USERS; COMPUTER SOFTWARE FOR PROVIDING INTERACTIVE MEDIA PLATFORMS, NAMELY, TELEVISION AND RADIO PLATFORMS BROADCASTED VIA THE INTERNET; … COMPUTER SERVICES, NAMELY, PROVIDING INTERACTIVE PLATFORMS FOR INTERNET USERS… COMPUTER SERVICES, NAMELY, PROVIDING INTERACTIVE TELEVISION AND RADIO PLATFORMS BROADCASTED VIA THE INTERNET
The function or purpose of the software is described vaguely. Please specify the purpose of the media platform(s). Does it feature interactive game software? Does it feature interactive multimedia software for audio and video via television or radio broadcasting?

For the television and radio platforms, please specify what the software does. For example, does the software enable the transmission of data and information?

In this case, the wording "COMPUTER SOFTWARE FOR ADVERTISING AND PROMOTING THE GOODS OF OTHERS OVER THE INTERNET" merely identifies the content or field of the software, and does not specify the function of the software. For example, is the purpose or function of the software to aggregate coupons, or to provide links to the websites of others, or for wireless content delivery? Please amend accordingly.

The following services must be clarified and classified properly.

For “PROVIDING ON-LINE VIDEO RENDERING SERVICES,” applicant must clarify the nature of the services. Applicant must specify the common commercial or generic name for the services. If there is no common commercial or generic name, applicant must describe the services and intended consumer as well as its main purpose and intended uses. For example, is applicant providing non-downloadable films via a video-on-demand services? In the alternative, the nature of the online service could be a website featuring video presentations in a specific subject matter. If so, then the subject matter of the videos must be identified, since it determines the proper classification. In this case, the subject matter of website must be a Class 41 subject matter to keep the entire identification in Class 41.

For “COMPUTER SERVICES FOR CREATING AND MANIPULATING VISUAL IMAGERY AND VISUAL SPECIAL EFFECTS, AND SOUNDS AND AUDIO SPECIAL EFFECTS FOR USE IN MAKING MOTION PICTURES, FILMS, VIDEOS, AND VIDEO AND AUDIO PRODUCTIONS,” applicant must clarify the services and classify accordingly.

If applicant is providing special effects design services for others, then Class 42 is proper. If applicant’s services consist of “special effects animation services for film and video,” then Class 41 is proper, since the preparation of special effects as an entertainment service is in Class 41. Please note however, that the production of special effects including model-making services, computer-generated imagery and computer-generated graphics for the production of videos, movies is in Class 41, but if the services are for the production of advertising commercials, then the proper classification is Class 35. Please review the Identification Manual for further guidance.

In the case of “COMPUTER SERVICES, NAMELY IMAGE AND AUDIO PROCESSING SERVICES FOR VIDEO RENDERING,” classification is an issue. The terminology is broad so that it may encompass “digital imaging services” or “photographic computer imaging” in Class 41 or “computer services, namely electronic imaging of photographs, artwork, etc.” in Class 42. Electronic imaging is a Class 42 service that uses computers to copy, process and manipulate visual material such as photographic images, artwork, paintings, etc. through digitization.

The term “audio processing” is vague and indefinite. Applicant must provide further information about the service in order to ensure proper classification. For example, the editing or recording of sounds is a Class 41 service.

ONLINE TELEVISION STATION SERVICES, NAMELY, THE OPERATION OF AN ONLINE TELEVISION STATION; ONLINE RADIO STATION SERVICES, NAMELY, THE OPERATION OF AN ONLINE RADIO STATION; BROADCASTING SERVICES, NAMELY, TELEVISION BROADCASTING FOR DISTRIBUTION VIA THE INTERNET;

The nature of television and radio is to be considered a broadcasting service in Class 38. However, if provided online, then the services are Internet broadcasting services, either radio or video broadcasting via the Internet. The services should be specified as such. Please note the proper class is 38, even if the service is provided via the Internet.

ENTERTAINMENT SERVICES, NAMELY, DEVELOPING AND PRODUCING ENTERTAINMENT CONTENT AND ENTERTAINMENT PROGRAMMING FOR ONLINE DISTRIBUTION

The services are classified incorrectly. Applicant must amend the application to classify the services in International Class 41. See 37 C.F.R. §§2.32(a)(7), 2.85; TMEP §§1401.02(a), 1401.03(b).

NEWS SERVICES, NAMELY, DEVELOPING AND PRODUCING NEWS CONTENT AND NEWS PROGRAMMING FOR ONLINE DISTRIBUTION;
The wording must be clarified in order to ensure proper classification. News reporter services in the nature of news analysis and news commentary is the language from the Nice Agreement and refers to the collecting of breaking news usually for broadcast or newspaper publication activities. This is a Class 41 service. This is distinguished from “news agency services for electronic transmission,” which is a Class 38 service. Applicant must clarify the wording based on the preceding recommendations and classify accordingly.

COMPUTER SERVICES, NAMELY, ENABLING ORGANIZATIONS OR INDIVIDUALS TO ACCESS INFORMATION ABOUT INTERNET USERS’ INTERESTS AND REAL TIME LOCATION ON THE INTERNET;

The identification of services is indefinite because it suggests both the services of providing Internet access and providing Internet content, and thus identifies services that are classified in more than one international class. See generally TMEP §§1402.01, 1402.01(a).

Providing multiple-user access to the Internet is a service provided by Internet Service Providers (“ISPs”) who supply the computer connection that enables computer users to access the Internet and all its data and content. If applicant is an Internet service provider, applicant must amend the identification to specify these services and to classify them in International Class 38. The following format is suggested, as appropriate: “Internet service provider (ISP),” in International Class 38.

If applicant is providing information via the Internet, such as on a website, the subject matter of the information being provided determines classification of these services. TMEP §1402.11(a). Therefore, applicant must amend the identification to specify the subject matter of the information being provided via the Internet, and to specify the proper classification. Id. In addition, the identification for these services should not include the word “access” because such wording is suggestive of services in International Class 38, as described above.

The following are examples of acceptable identifications for Internet content provider services and the proper classifications for those services: “providing information via the Internet in the field of banking” in International Class 36; “providing information via the Internet regarding the repair and maintenance of automobiles” in International Class 37; and “providing information via the Internet in the field of travel destinations” in International Class 39.

COMPUTER SERVICES, NAMELY, ENABLING WEBSITE OWNERS TO COMMUNICATE WITH INTERNET USERS REGARDLESS OF THEIR REAL TIME LOCATION ON THE INTERNET

Providing technology that enables users to perform an activity, in this case the ability to communicate with others, is a technology service. These services are not classified based on the subject matter of the activity performed, rather these services are classified in International Class 42. The service should be drafted as “providing a website featuring technology that enables internet users to {indicate functions or tasks that the technology enables}.”

PROVIDING A VIRTUAL ONLINE SHOPPING MALL ON THE INTERNET BY BRINGING INTERNET VISITORS AND WEBSITE OWNERS TOGETHER

The services are classified incorrectly. Applicant must amend the application to classify the services in International Class 35. See 37 C.F.R. §§2.32(a)(7), 2.85; TMEP §§1401.02(a), 1401.03(b).

PROVIDING DOWNLOADABLE SOFTWARE THAT DRIVES INTERNET TRAFFIC AND PROVIDES AN INTERACTIVE INTERNET EXPERIENCE

Providing a website featuring downloadable software is not an acceptable identification because it is unclear whether the applicant is offering goods in the nature of downloadable software in Class 9, or whether the applicant is offering services in the nature of website hosting in Class 42. The proper wording should be: "Providing a website featuring on-line non-downloadable software that enables users to {specify the function of the programs, e.g., for use in database management, for use as spreadsheet, for word processing, etc. and, if software is content- or field-specific, the field of use} or specify activities that may be performed using the software, e.g., design websites, edit digital photographs, prepare and file tax forms, etc.}"

The wording “ADVERTISING AND INFORMATION DISTRIBUTION SERVICES, NAMELY, PROVIDING ADVERTISING SPACE VIA A GLOBAL COMPUTER NETWORK” is classified incorrectly. Applicant must amend the application to classify the services in International Class 35. See 37 C.F.R. §§2.32(a)(7), 2.85; TMEP §§1401.02(a), 1401.03(b).

COMPUTER SERVICES, NAMELY, PROVIDING SOFTWARE INTERFACES AVAILABLE OVER A NETWORK IN ORDER TO CREATE A PERSONALIZED ON-LINE INFORMATION SERVICE

The wording is vague and indefinite. What does “creating a personalized online information service” refer to? Please refer to the guidance above regarding the proper wording for “providing software online or via a website.” Providing a website featuring downloadable software is
not an acceptable identification because it is unclear whether the applicant is offering goods in the nature of downloadable software in Class 9, or whether the applicant is offering services in the nature of website hosting in Class 42.

EXTRACTION AND RETRIEVAL OF INFORMATION AND DATA MINING BY MEANS OF GLOBAL COMPUTER NETWORKS

The services are classified incorrectly. Applicant must amend the application to classify the services in International Class 42. See 37 C.F.R. §§2.32(a)(7), 2.85; TMEP §§1401.02(a), 1401.03(b).

CREATING INDEXES OF INFORMATION, INDEXES OF WEB SITES AND INDEXES OF OTHER INFORMATION SOURCES IN CONNECTION WITH GLOBAL COMPUTER NETWORKS;

Applicant must specify the indexes are “computer network-based.” This entry was modified from “computer services, namely, creating indexes of information, sites and other resources available on computer networks” in order to clarify that the wording “available on computer networks” referred to the indexes themselves and to clarify the overall nature of the services.

The services are classified incorrectly. Applicant must amend the application to classify the services in International Class 42. See 37 C.F.R. §§2.32(a)(7), 2.85; TMEP §§1401.02(a), 1401.03(b).

PROVIDING MULTIPLE USER ACCESS TO PROPRIETARY COLLECTIONS OF INFORMATION BY MEANS OF GLOBAL COMPUTER INFORMATION NETWORKS;

The services are classified incorrectly. Applicant must amend the application to classify the services in International Class 38. See 37 C.F.R. §§2.32(a)(7), 2.85; TMEP §§1401.02(a), 1401.03(b).

BUSINESS MARKETING AND PROMOTIONAL SERVICES; ONLINE BUSINESS MARKETING AND PROMOTIONAL SERVICES; PROVIDING MARKETING AND PROMOTIONAL STRATEGIES FOR OTHERS; PROVIDING INFORMATION AND REPORTS ABOUT THE RESULTS OF MARKETING AND PROMOTIONAL ACTIVITIES AND STRATEGIES

The services are classified incorrectly. Applicant must amend the application to classify the services in International Class 35. See 37 C.F.R. §§2.32(a)(7), 2.85; TMEP §§1401.02(a), 1401.03(b).

Identifications of goods and/or services can be amended only to clarify or limit the goods and/or services; adding to or broadening the scope of the goods and/or services is not permitted. 37 C.F.R. §2.71(a); see TMEP §§1402.06 et seq., 1402.07. Therefore, applicant may not amend the identification to include goods and/or services that are not within the scope of the goods and/or services set forth in the present identification.

For assistance with identifying and classifying goods and/or services in trademark applications, please see the online searchable Manual of Acceptable Identifications of Goods and Services at http://tess2.uspto.gov/netahtml/tidm.html. See TMEP §1402.04.

**Applicant has only paid for 1 International Class. If adding International Classes to the application, then note:**

For an application with more than one international class, called a “multiple-class application,” an applicant must meet all the requirements below for those international classes based on an intent to use the mark in commerce under Trademark Act Section 1(b) and a foreign registration under Section 44(e):

1. **LIST GOODS AND/OR SERVICES BY INTERNATIONAL CLASS:** Applicant must list the goods and/or services by international class.

2. **PROVIDE FEES FOR ALL INTERNATIONAL CLASSES:** Applicant must submit an application filing fee for each international class of goods and/or services not covered by the fee(s) already paid (confirm current fee information at http://www.uspto.gov/trademarks/tm_fee_info.jsp).

See 15 U.S.C. §§1051(b), 1112, 1126(e); 37 C.F.R. §§2.34(a)(2)-(3), 2.86(a); TMEP §§1403.01, 1403.02(c).
There is no required format or form for responding to an Office action. The Office recommends applicants use the Trademark Electronic Application System (TEAS) to respond to Office actions online at http://www.uspto.gov/teas/index.html. However, if applicant responds on paper via regular mail, the response should include the title “Response to Office Action” and the following information: (1) the name and law office number of the examining attorney, (2) the serial number and filing date of the application, (3) the mailing date of this Office action, (4) applicant’s name, address, telephone number and e-mail address (if applicable), and (5) the mark. 37 C.F.R. §2.194(b)(1); TMEP §302.03(a).

The response should address each refusal and/or requirement raised in the Office action. If a refusal has issued, applicant can argue against the refusal; i.e., applicant can submit arguments and evidence as to why the refusal should be withdrawn and the mark should register. To respond to requirements, applicant should set forth in writing the required changes or statements and request that the Office enter them into the application record.

The response must be personally signed or the electronic signature manually entered by applicant or someone with legal authority to bind applicant (i.e., a corporate officer of a corporate applicant, the equivalent of an officer for unincorporated organizations or limited liability company applicants, a general partner of a partnership applicant, each applicant for applications with multiple individual applicants). TMEP §§605.02, 712.

/Giselle Agosto-Hincapie/
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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 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 Trademark Applications and Registrations Retrieval (TARR) at http://tarr.uspto.gov/. Please keep a copy of the complete TARR screen. If TARR shows no change for more than six months, call 1-800-786-9199. For more information on checking status, see http://www.uspto.gov/trademarks/process/status/.