

UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 76/321534

APPLICANT: SmartGate L.C.

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MARK: INVISIBLE SHIELD

CORRESPONDENT'S REFERENCE/DOCKET NO: GPI- 11819/0

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

TO AVOID ABANDONMENT, WE MUST RECEIVE A PROPER RESPONSE TO THIS OFFICE ACTION WITHIN 6 MONTHS OF OUR MAILING OR E-MAILING DATE.

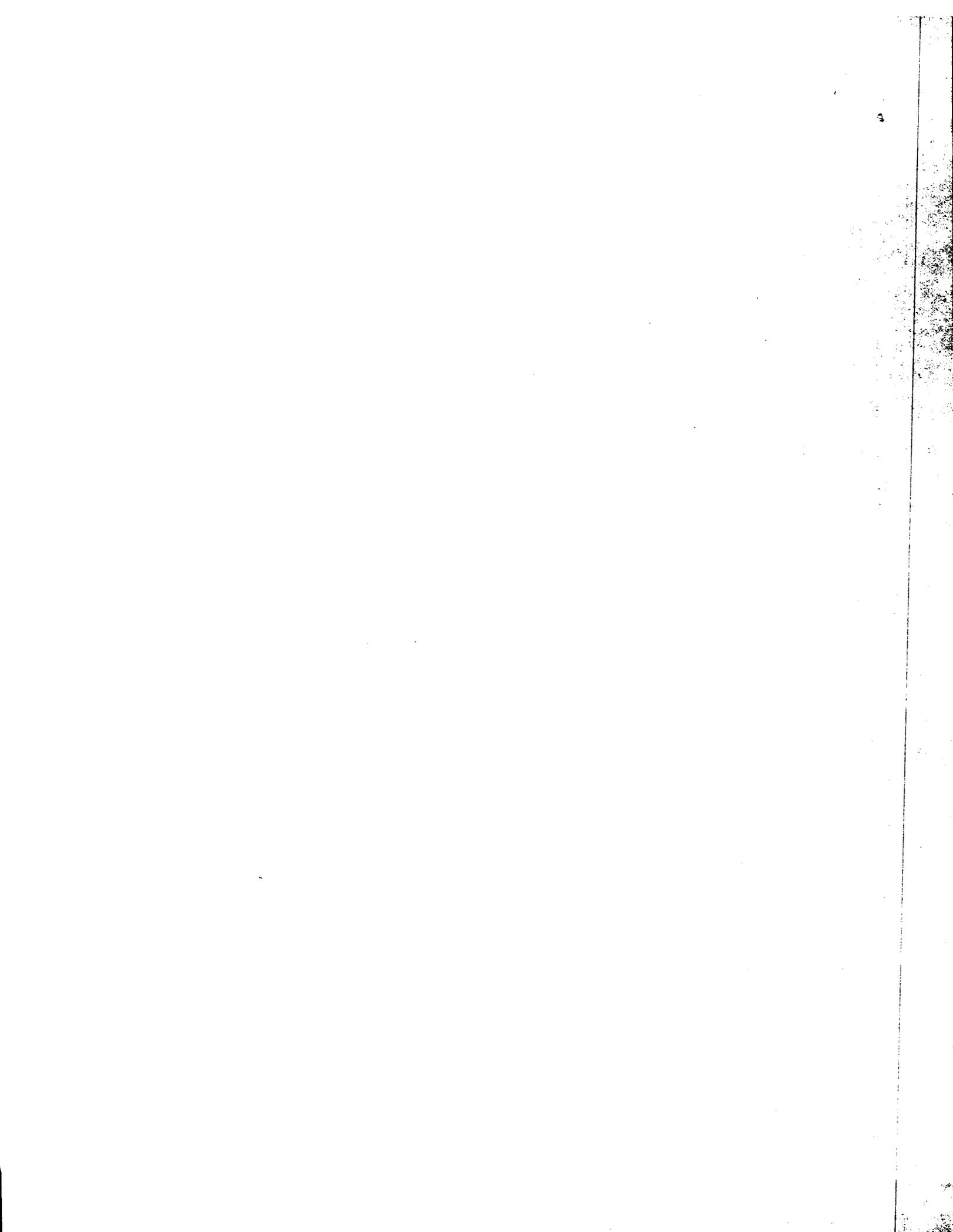
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This letter responds to the applicant's communication filed on July 21, 2003.

In the previous Office action, the applicant's proposed specimen was deemed unacceptable as evidence of actual trademark use because it appeared to be advertising. Invoices, announcements, order forms, bills of lading, leaflets, brochures, publicity releases and other printed advertising material generally are not acceptable specimens for goods. *In re Bright of America, Inc.*, 205 USPQ 63 (TTAB 1979); TMEP §§904.05 and 904.07. *See In re Ultraflight Inc.*, 221 USPQ 903 (TTAB 1984).

In response, the applicant has argued that the proposed specimen constitutes a display associated with the goods. The examining attorney has considered the applicant's arguments carefully but found them unpersuasive. Accordingly, the requirement for a specimen showing the mark used on the goods is maintained and made FINAL.

TMEP §904.06(a) makes clear the requirements for a "display associated with the goods" to be an acceptable specimen. Such a display is acceptable if: (1) it includes a picture of the relevant goods; (2) it shows the mark sufficiently near the picture of the goods to associate the mark with the goods; and (3) it includes the information necessary to order the goods, (e.g., a phone number, mailing address, or e-mail address). The materials submitted by the applicant fail to meet the first two requirements.



The applicant must submit a specimen showing the mark as it is used in commerce. 37 C.F.R. §2.56. Examples of acceptable specimens are tags, labels, instruction manuals, containers, and photographs that show the mark on the goods or packaging. The applicant must verify, with an affidavit or a declaration under 37 C.F.R. §2.20, that the applicant used the substitute specimen in commerce prior to filing the amendment to allege use. 37 C.F.R. §2.59(b)(1).

If an amendment of the dates-of-use clause is necessary in order to state the correct dates of first use, the applicant must verify the amendment with an affidavit or a declaration in accordance with 37 C.F.R. §2.20. 37 C.F.R. §2.71(c); TMEP §§903.05 and 1104.09(d).

The statement supporting use of the substitute specimen must read as follows:

The applicant used the substitute specimen in commerce prior to filing the amendment to allege use.

The applicant must sign this statement either in affidavit form or with a declaration under 37 C.F.R. §2.20. 37 C.F.R. §2.59(b)(1).

The following is a properly worded declaration under 37 C.F.R. §2.20. At the end of the response, the applicant should insert the declaration signed by a person authorized to sign under 37 C.F.R. §2.33(a).

The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. §1001, and that such willful false statements may jeopardize the validity of the application or any resulting registration, declares that the facts set forth in this application are true; all statements made of his/her own knowledge are true; and all statements made on information and belief are believed to be true.

(Signature)

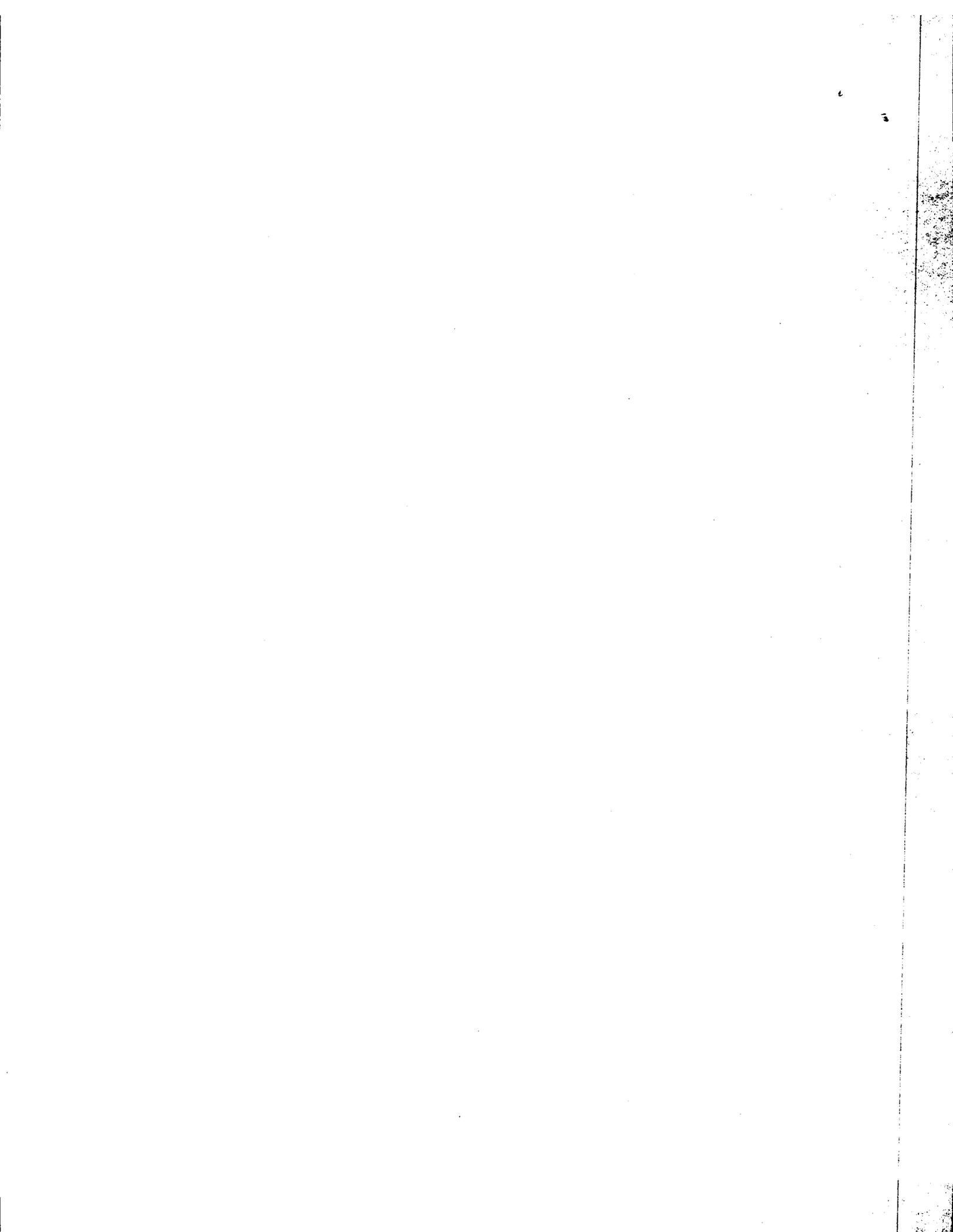
(Print or Type Name and Position)

(Date)

The requirement for an acceptable specimen and supporting declaration are maintained and made FINAL.

Please note that the only appropriate responses to a final action are either (1) compliance with the outstanding requirements, if feasible, or (2) filing of an appeal to the Trademark Trial and Appeal Board. 37 C.F.R. §2.64(a). If the applicant fails to respond within six months of the mailing date of this refusal, this Office will declare the application abandoned. 37 C.F.R. §2.65(a).

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How to respond to this Office Action:

To respond formally using the Office's Trademark Electronic Application System (TEAS), visit <http://www.uspto.gov/teas/index.html> and follow the instructions.

To respond formally via E-mail, visit <http://www.uspto.gov/web/trademarks/tmelecresp.htm> and follow the instructions.

To respond formally via regular mail, your response should be sent to the mailing Return Address listed above and include the serial number, law office and examining attorney's name on the upper right corner of each page of your response.

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

For general and other useful information about trademarks, you are encouraged to visit the Office's web site at <http://www.uspto.gov/main/trademarks.htm>

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

