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**To:** Next IT ([setrademarks@klgates.com](mailto:setrademarks@klgates.com))  
**Subject:** U.S. TRADEMARK APPLICATION NO. 77438494 -  
ACTIVELAB - N/A  
**Sent:** 10/5/2009 9:34:37 AM  
**Sent As:** ECOM115@USPTO.GOV  
**Attachments:**

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**UNITED STATES PATENT AND TRADEMARK OFFICE**

**SERIAL NO:** 77/438494

**MARK:** ACTIVELAB



**CORRESPONDENT ADDRESS:**

Allen J. Baden  
K&L Gates LLP  
925 4th Avenue, Ste. 2900  
Seattle WA 98101

**GENERAL TRADEMARK INFORMATION:**  
<http://www.uspto.gov/main/trademarks.htm>

**APPLICANT:** Next IT

**CORRESPONDENT'S REFERENCE/DOCKET NO:**

N/A

**CORRESPONDENT E-MAIL ADDRESS:**

[setrademarks@klgates.com](mailto:setrademarks@klgates.com)

**REQUEST FOR RECONSIDERATION DENIED**

**ISSUE/MAILING DATE:** 10/5/2009

Applicant is requesting reconsideration of a final refusal issued/mailed March 7, 2009.

After careful consideration of the law and facts of the case, the examining attorney must deny the request for reconsideration and adhere to the final action as written since no new facts or reasons have been presented that are significant and compelling with regard to the point at issue.

For the following reasons, the requirement for an acceptable specimen of use in International Class 42 is **maintained and continued**.

**Requirement for Acceptable Specimen of Use Continued for International Class 42 ONLY**

**The following requirement is limited to the services identified in International Class 42 ONLY.**

The applicant submitted two copies of a nineteen page "ActiveAgent Product Suite Installation Process Overview," and a six page "ActiveAgent Implementation Guide," in connection with its September 9, 2009, request for reconsideration, which the applicant described as "Applicant's marketing brochures showing software promoted in connection with the mark ACTIVELAB." (emphasis added). The examining attorney has reviewed the submitted specimens and is unable to find any reference to computer programming services in the submitted specimens. If the examining attorney has overlooked some portion of the voluminous specimens of record that contains a discussion of the applicant's computer programming services and use of the proposed mark in connection therewith, the applicant is invited to provide the examining attorney with direction as to where to specifically look for this information.

The specimens of record consist of the aforementioned overviews and guides, as well as screenshots from the applicant's website. However, none of the submitted specimens reference "computer programming services" being marketed; based on the submitted specimens, and the applicant's description of those specimens, the proposed mark appears to refer to a software product. Programming services offered solely in connection with one's own software is an ancillary service to the software itself, i.e. all software must be written by someone. When the producer of software performs the computer programming services to develop the software that it will market and sell, the producer is only furthering its own commercial goals and is not performing services for the benefit of others. See §1301.01 et seq. Therefore, the applicant has not demonstrated that it is performing computer programming services for the benefit of others, but merely that it has developed its own software suite that it then markets to consumers.

Therefore, applicant must submit the following:

- (1) A substitute specimen showing the mark in use in commerce for computer programming services other than those necessary to develop the applicant's International Class 9 software; and
- (2) The following statement, verified with an affidavit or signed declaration under 37 C.F.R. §§2.20, 2.33: **"The substitute specimen was in use in commerce at least as early as the filing date of the application."** 37 C.F.R. §2.59(a); TMEP §904.05. If submitting a substitute specimen requires an amendment to the dates of use, applicant must also verify the amended dates. 37 C.F.R. §2.71(c); TMEP §904.05.

Examples of specimens for services are signs, photographs, brochures, website printouts or advertisements that show the mark used in the actual sale or advertising of the services. *See* TMEP §§1301.04 *et seq.*

If applicant cannot satisfy the above requirements, applicant may amend the application from a use in commerce basis under Section 1(a) to an intent to use basis under Section 1(b), for which no specimen is required. *See* TMEP §806.03(c). However, if applicant amends the basis to Section 1(b), registration will not be granted until applicant later amends the application back to use in commerce by filing an acceptable allegation of use with a proper specimen. *See* 15 U.S.C. §1051(c), (d); 37 C.F.R. §§2.76, 2.88; TMEP §1103.

To amend to Section 1(b), applicant must submit the following statement, verified with an affidavit or signed declaration under 37 C.F.R. §§2.20, 2.33: **“Applicant has had a bona fide intention to use the mark in commerce on or in connection with the services listed in the application as of the filing date of the application.”** 37 C.F.R. §2.34(a)(2); TMEP §806.01(b); *see* 15 U.S.C. §1051(b); 37 C.F.R. §2.35(b)(1).

Pending receipt of a proper specimen of use, registration is refused because the specimens of record do not show the applied-for mark in use in commerce as a service mark for the identified services in International Class 42. Trademark Act Sections 1 and 45, 15 U.S.C. §§1051, 1127; 37 C.F.R. §§2.34(a)(1)(iv), 2.56(a); TMEP §§904, 904.07(a).

Accordingly, the present application will be forwarded to the Trademark Trial and Appeal Board (TTAB) for further consideration of the issues discussed herein.

/Nicholas A Coleman/  
Examining Attorney  
Law Office 115  
Office: 571-272-4917  
Fax: 571-273-9115

**STATUS CHECK:** Check the status of the application at least once every six months from the initial filing date using the USPTO Trademark Applications and Registrations Retrieval (TARR) online system at <http://tarr.uspto.gov>. When conducting an online status check, print and maintain a copy of the complete TARR screen. If the status of your application has not changed for more than six months, please contact the assigned examining attorney.

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**IMPORTANT NOTICE REGARDING YOUR  
TRADEMARK APPLICATION**

**Your trademark application (Serial No. 77438494) has been reviewed. The examining attorney assigned by the United States Patent and Trademark Office (“USPTO”) has written a letter (an “Office action”) on 10/5/2009 to which you must respond (*unless the Office letter specifically states that no response is required*). Please follow these steps:**

1. Read the Office letter by clicking on this [link](http://tmportal.uspto.gov/external/portal/tow?DDA=Y&serial_number=77438494&doc_type=REC&mail_date=20091005) [http://tmportal.uspto.gov/external/portal/tow?DDA=Y&serial\\_number=77438494&doc\\_type=REC&mail\\_date=20091005](http://tmportal.uspto.gov/external/portal/tow?DDA=Y&serial_number=77438494&doc_type=REC&mail_date=20091005) **OR** go to <http://tmportal.uspto.gov/external/portal/tow> and enter your serial number to access the Office letter. If you have difficulty accessing the Office letter, contact [TDR@uspto.gov](mailto:TDR@uspto.gov).

**PLEASE NOTE:** The Office letter may not be immediately available but will be viewable within 24 hours of this e-mail notification.

2. Contact the examining attorney who reviewed your application if you have any questions about the content of the Office letter (contact information appears at the end thereof).

**3. Respond** within 6 months, calculated from 10/5/2009 (*or sooner if specified in the Office letter*), using the Trademark Electronic Application System (TEAS) Response to Office Action form. If you have difficulty using TEAS, contact [TEAS@uspto.gov](mailto:TEAS@uspto.gov).

**ALERT:**

**Failure to file any required response by the applicable deadline will result in the ABANDONMENT (loss) of your application.**

**Do NOT hit "Reply" to this e-mail notification, or otherwise attempt to e-mail your response, as the USPTO does NOT accept e-mailed responses.**