

Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	77545244
LAW OFFICE ASSIGNED	LAW OFFICE 104
MARK SECTION (no change)	
ARGUMENT(S)	
<p>In response to the Office Action mailed on March 10, 2014, please reconsider this application in view of the remarks provided herein. A Notice of Appeal is filed herewith.</p> <p>INTRODUCTION:</p> <p>Applicant expresses thanks for the previous indication that the Statement of Use for Class 009 is acceptable. However, in the Office Action, Applicant notes that the specimens submitted with the Statement of Use for Class 009 were not accepted. The reason given for not accepting the specimens for Class 009 was that the specimens purportedly showed that the "goods to which the proposed mark is applied are not 'goods in trade.'" The Office Action further defines "goods in trade" as "items that an applicant sells or transports in commerce for use by others." Applicant respectfully disagrees with this conclusion raised in the Office Action. Applicant respectfully asserts that the previously provided specimens, which were in use at least as early as the filing date of the Statement of Use, clearly show the mark used in connection with "electronic fact sheets" and "electronic information circulars" in the field of protecting computer networking products and solutions and fully satisfy all of the requirements for an acceptable specimen, as explained below.</p> <p>To be acceptable, a specimen must show the applied for mark used in commerce in the class of goods or services in question. The specimens submitted with the present Statement of Use included an "electronic fact sheet" and/or an "electronic information circular," providing facts and information relating to protecting computer networking products and solutions, as shown in Exhibit A which was also originally submitted as a specimen with the Statement of Use.</p> <p>The goods specified for Class 009 in this application include "downloadable electronic publications" namely, "electronic fact sheets" and "electronic information circulars" in the field of "protecting computer networking products and solutions." To determine if the specimens already submitted satisfy all of the statutory and regulatory requirements it is necessary to determine the meaning of the pertinent words in the marketplace and particularly in Applicant's industry. Applicant previously provided in the prior response accepted definitions of the pertinent terms, to show that the specimens submitted with the</p>	

Statement of Use are appropriate and should be accepted, but will now ask for additional consideration of the additional facts and points raised herein.

For the convenience of the Examining Attorney, Applicant has again included the definitions of pertinent terms recited in the Statement of Use, which includes "downloadable electronic publications" namely, "electronic fact sheets" and "electronic information circulars" in the field of "protecting computer networking products and solutions."

DEFINITIONS:

The term "electronic" is defined as "involving or concerned with the representation, storage, or transmission of information by electronic systems" (definition for "electronic" found at dictionary.reference.com, fourth definition, as of February 12, 2014).

The term "fact sheet" is defined as "a document itemizing the facts or pertinent information about something" (definition for "fact sheet" found at dictionary.reference.com, first definition, as of February 12, 2014).

The word "information" is defined as "knowledge communicated or received concerning a particular fact or circumstance" (definition for "information" found at dictionary.reference.com, first definition, as of February 12, 2014).

The word "circular" is defined as "addressed to a number of persons or intended for general circulation" (definition for "circular" found at dictionary.reference.com, eighth definition, as of February 12, 2014).

THE DEFINITIONS OF THE TERMS IN THE RECITATION OF GOODS REQUIRES ACCEPTANCE OF THE SPECIMENS:

Using accepted definitions for "fact sheet" and "information" and "circular," shown above, the description of services can be rewritten to read, "a document itemizing the facts or pertinent information, stored on, or transmitted by, an electronic system" and "knowledge communicated or received concerning a particular fact or circumstance addressed to a number of persons or intended for general circulation stored on, or transmitted by, an electronic system."

A typical consumer of network and security systems would understand "electronic fact sheet" and "electronic information circular" to mean a listing of facts and information about, or relating to, computer network and security systems. In this case, particularly the already submitted specimen shown in Exhibit A, is an electronic listing (with the present mark prominently placed at the top of the page

with the appropriate super-scripted "TM" designation shown) of suppliers and manufacturers and includes a variety of facts and information relating to the manufacturers and suppliers themselves and the computer security and network systems supplied and manufactured and clearly is a good in trade.

However, the Office Action argued that "the downloadable publications are merely advertisements for the applicant's core computer services which only provide information for potential customers to obtain applicant's computer services. The goods do not have independent value apart from obtaining applicant's core computer services advertised in the publications." Applicant respectfully disagrees with these unsupported conclusions.

Specifically, Exhibit A includes facts and information relating to each supplier and manufacturer and the computer network or computer security system supplied or manufactured. Contrary to the conclusions set forth in the Office Action, the information included in the fact sheet, Exhibit A, does not merely advertise Applicant's core computer services, but instead lists a variety of suppliers and manufactures with information about their distinct products. The listed suppliers and manufacturers are also listed with their own companies web address, which enables a customer or third party to directly contact these independent suppliers and manufacturers without purchasing Applicant's core goods/services.

For example, Exhibit A lists, for example,

- (1) Infoblox with their accompanying web address and describes their products and services as "automation technology that helps meet increasing network demands and complexities caused by mobile device proliferation, virtualization and cloud usage";
- (2) Celesitx with their accompanying web address and describes their company as "a leading provider of strong authentication, secure remote access and perimeter security";
- (3) Check Point with their accompanying web address and describes their company as "the worldwide leader in securing the Internet, provides customers with uncompromising protection against all types of threats, reduces security complexity and lowers total cost of ownership";
- (4) Gateprotect with their accompanying web address and describes their company as "a leading manufacturer of IT security solutions focused on Next Generation firewall products, managed security solutions and client encryption systems;" and,
- (5) Elfiq Networks with their accompanying web address and describes their products as "enables organizations to ensure business continuity and improve network performance through innovative link balancing technologies."

Thus, these facts and information can enable a customer or third party to determine the proper and acceptable supplier and computer network without contacting Applicant or purchasing any of Applicant's products or services. By enabling the third party to contact the independent supplier directly, the third party can make purchasing decisions without sampling or purchasing unnecessary computer network guides or supplier specifications, thus providing a consumer with significant value independent from the computer networks or security systems of the Applicant.

THE TRADEMARK MANUAL OF EXAMINING PROCEDURE REQUIRES ACCEPTANCE OF THE SPECIMENS:

The Trademark Manual of Examining Procedure (TMEP) sets forth factors in determining if an identified good comprises an independent good in trade in Section 1202.06, "Factors to consider include "whether [applicant's good]: (1) is simply the conduit or necessary tool useful only to obtain applicant's services; (2) is so inextricably tied to and associated with the service as to have no viable existence apart therefrom; and (3) is neither sold separately from nor has any independent value apart from the services." See TMEP §1202.06.

With regards to the factors to determine an independent good in trade, Exhibit A identifies Applicant's electronic listing of suppliers and manufacturers and includes a variety of facts and information relating to the manufacturers and suppliers themselves and the computer security and network systems supplied and manufactured, which is clearly (1) not a conduit useful only to obtain applicant's services because a third party could use the information in the electronic listing (Exhibit A) to contact and purchase products and services directly from the listed suppliers without purchasing any service from Applicant, (2) and is not tied to the Applicant's services because the third parties can contact and purchase products and services directly from the listed suppliers without purchasing any service from Applicant, and (3) is provided separately from any of Applicant's services and provides independent value to third parties by enabling third parties to contact the independent suppliers directly, and making purchasing decisions without sampling or purchasing unnecessary computer network guides or supplier specifications.

Thus, Applicant's goods include "downloadable electronic publications" namely, "electronic fact sheets" and "electronic information circulars" in the field of "protecting computer networking products and solutions" is clearly a registerable independent good in trade and the specimen correctly shows use of the mark.

Consequently, Applicant submits that the specimen of Exhibit A, already submitted, correctly shows use of the mark on sufficient goods in Class 009. As a result, Applicant requests that the specimens submitted with the Statement of Use be accepted in Class 009 and an indication of the same is respectfully requested.

CONCLUSION:

Applicant believes that all of the specimens now of record correctly show use of the mark in conjunction with the identification of the goods in this application, and are believed to satisfy all of the requirements raised in the Office Action. Thus, no further action by Applicant is believed necessary regarding the specimens and an indication that the Statement of Use has been fully accepted is respectfully requested. If further action is needed regarding the specimens, Applicant requests that the Examining Attorney provide further assistance on the matter and provides appreciation in advance for such guidance and assistance in view of this *bona fide* response Applicant addressing all of the issues raised in the Office Action.

In view of the foregoing, Applicant respectfully submits that the present mark is registrable on the Principal Register and full approval of the Statement of Use is respectfully requested. If any further issue remains after entry of this response, Applicant requests another action setting forth such issues, guidance on resolving such issues and the opportunity to address such issue.

EVIDENCE SECTION

EVIDENCE FILE NAME(S)

ORIGINAL PDF FILE	evi_671366082-20140910203240349001 . Exhibit A.pdf
CONVERTED PDF FILE(S) (1 page)	\\TICRS\EXPORT16\IMAGEOUT16\775\452\77545244\xml13\RFR0002.JPG
DESCRIPTION OF EVIDENCE FILE	The specimen submitted with the Statement of Use

SIGNATURE SECTION

RESPONSE SIGNATURE	/Grant R. Clayton/
SIGNATORY'S NAME	Grant R. Clayton
SIGNATORY'S POSITION	Attorney of Record, Utah Bar Member
SIGNATORY'S PHONE NUMBER	801-255-5335
DATE SIGNED	09/10/2014
AUTHORIZED SIGNATORY	YES
CONCURRENT APPEAL NOTICE FILED	NO

FILING INFORMATION SECTION

SUBMIT DATE	Wed Sep 10 21:20:33 EDT 2014
	USPTO/RFR-67.136.60.82-20 140910212033383421-775452

TEAS STAMP

44-500d8a02cc1641362cef59
b838add652528c46767544629
2e61996851ac0df6a32-N/A-N
/A-20140910211454087782

PTO Form 1960 (Rev 9/2007)
OMB No. 0651-0050 (Exp. 07/31/2017)

Request for Reconsideration after Final Action To the Commissioner for Trademarks:

Application serial no. **77545244** has been amended as follows:

ARGUMENT(S)

In response to the substantive refusal(s), please note the following:

In response to the Office Action mailed on March 10, 2014, please reconsider this application in view of the remarks provided herein. A Notice of Appeal is filed herewith.

INTRODUCTION:

Applicant expresses thanks for the previous indication that the Statement of Use for Class 009 is acceptable. However, in the Office Action, Applicant notes that the specimens submitted with the Statement of Use for Class 009 were not accepted. The reason given for not accepting the specimens for Class 009 was that the specimens purportedly showed that the "goods to which the proposed mark is applied are not 'goods in trade.'" The Office Action further defines "goods in trade" as "items that an applicant sells or transports in commerce for use by others." Applicant respectfully disagrees with this conclusion raised in the Office Action. Applicant respectfully asserts that the previously provided specimens, which were in use at least as early as the filing date of the Statement of Use, clearly show the mark used in connection with "electronic fact sheets" and "electronic information circulars" in the field of protecting computer networking products and solutions and fully satisfy all of the requirements for an acceptable specimen, as explained below.

To be acceptable, a specimen must show the applied for mark used in commerce in the class of goods or services in question. The specimens submitted with the present Statement of Use included an "electronic fact sheet" and/or an "electronic information circular," providing facts and information relating to protecting computer networking products and solutions, as shown in Exhibit A which was also originally submitted as a specimen with the Statement of Use.

The goods specified for Class 009 in this application include "downloadable electronic publications" namely, "electronic fact sheets" and "electronic information circulars" in the field of "protecting computer networking products and solutions." To determine if the specimens already submitted satisfy all of the

statutory and regulatory requirements it is necessary to determine the meaning of the pertinent words in the marketplace and particularly in Applicant's industry. Applicant previously provided in the prior response accepted definitions of the pertinent terms, to show that the specimens submitted with the Statement of Use are appropriate and should be accepted, but will now ask for additional consideration of the additional facts and points raised herein.

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However, the Office Action argued that "the downloadable publications are merely advertisements for the applicant's core computer services which only provide information for potential customers to obtain applicant's computer services. The goods do not have independent value apart from obtaining applicant's core computer services advertised in the publications." Applicant respectfully disagrees with these unsupported conclusions.

Specifically, Exhibit A includes facts and information relating to each supplier and manufacturer and the computer network or computer security system supplied or manufactured. Contrary to the conclusions set forth in the Office Action, the information included in the fact sheet, Exhibit A, does not merely advertise Applicant's core computer services, but instead lists a variety of suppliers and manufactures with information about their distinct products. The listed suppliers and manufacturers are also listed with their own companies web address, which enables a customer or third party to directly contact these independent suppliers and manufacturers without purchasing Applicant's core goods/services.

For example, Exhibit A lists, for example,

(1) Infoblox with their accompanying web address and describes their products and services as "automation technology that helps meet increasing network demands and complexities caused by mobile device proliferation, virtualization and cloud usage";

(2) Celesitx with their accompanying web address and describes their company as "a leading provider of strong authentication, secure remote access and perimeter security";

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With regards to the factors to determine an independent good in trade, Exhibit A identifies Applicant's electronic listing of suppliers and manufacturers and includes a variety of facts and information relating to the manufacturers and suppliers themselves and the computer security and network systems supplied and manufactured, which is clearly (1) not a conduit useful only to obtain applicant's services because a third party could use the information in the electronic listing (Exhibit A) to contact and purchase products and services directly from the listed suppliers without purchasing any service from Applicant, (2) and is not tied to the Applicant's services because the third parties can contact and purchase products and services directly from the listed suppliers without purchasing any service from Applicant, and (3) is provided separately from any of Applicant's services and provides independent value to third parties by enabling third parties to contact the independent suppliers directly, and making purchasing decisions without sampling or purchasing unnecessary computer network guides or supplier specifications.

Thus, Applicant's goods include "downloadable electronic publications" namely, "electronic fact sheets" and "electronic information circulars" in the field of "protecting computer networking products and solutions" is clearly a registerable independent good in trade and the specimen correctly shows use of the mark.

Consequently, Applicant submits that the specimen of Exhibit A, already submitted, correctly shows use of the mark on sufficient goods in Class 009. As a result, Applicant requests that the specimens submitted with the Statement of Use be accepted in Class 009 and an indication of the same is respectfully requested.

CONCLUSION:

Applicant believes that all of the specimens now of record correctly show use of the mark in conjunction with the identification of the goods in this application, and are believed to satisfy all of the requirements raised in the Office Action. Thus, no further action by Applicant is believed necessary regarding the specimens and an indication that the Statement of Use has been fully accepted is respectfully requested. If further action is needed regarding the specimens, Applicant requests that the Examining Attorney provide further assistance on the matter and provides appreciation in advance for such guidance and assistance in view of this *bona fide* response Applicant addressing all of the issues raised in the Office Action.

In view of the foregoing, Applicant respectfully submits that the present mark is registrable on the Principal Register and full approval of the Statement of Use is respectfully requested. If any further issue remains after entry of this response, Applicant requests another action setting forth such issues, guidance on resolving such issues and the opportunity to address such issue.

EVIDENCE

Evidence in the nature of The specimen submitted with the Statement of Use has been attached.

Original PDF file:

[evi_671366082-20140910203240349001 . Exhibit A.pdf](#)

Converted PDF file(s) (1 page)

[Evidence-1](#)

SIGNATURE(S)

Request for Reconsideration Signature

Signature: /Grant R. Clayton/ Date: 09/10/2014

Signatory's Name: Grant R. Clayton

Signatory's Position: Attorney of Record, Utah Bar Member

Signatory's Phone Number: 801-255-5335

The signatory has confirmed that he/she is an attorney who is a member in good standing of the bar of the highest court of a U.S. state, which includes the District of Columbia, Puerto Rico, and other federal territories and possessions; and he/she is currently the applicant's attorney or an associate thereof; and to the best of his/her knowledge, if prior to his/her appointment another U.S. attorney or a Canadian attorney/agent not currently associated with his/her company/firm previously represented the applicant in this matter: (1) the applicant has filed or is concurrently filing a signed revocation of or substitute power of attorney with the USPTO; (2) the USPTO has granted the request of the prior representative to withdraw; (3) the applicant has filed a power of attorney appointing him/her in this matter; or (4) the applicant's appointed U.S. attorney or Canadian attorney/agent has filed a power of attorney appointing him/her as an associate attorney in this matter.

The applicant is not filing a Notice of Appeal in conjunction with this Request for Reconsideration.

Serial Number: 77545244

Internet Transmission Date: Wed Sep 10 21:20:33 EDT 2014

TEAS Stamp: USPTO/RFR-67.136.60.82-20140910212033383

421-77545244-500d8a02cc1641362cef59b838a
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N/A-N/A-20140910211454087782



<http://www.juniper.net>

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<http://www.elfiq.com>

Elfiq Networks[®] enables organizations to ensure business continuity and improve network performance through innovative link balancing technologies.



<http://www.radware.com>

Radware is a global leader of application delivery and application security solutions for virtual and cloud data centers.



<http://www.infoblox.com>

Infoblox delivers automation technology that helps meet increasing network demands and complexities caused by mobile device proliferation, virtualization and cloud usage.



<http://www.celestix.com>

Celestix is a leading provider of strong authentication, secure remote access and perimeter security.



<http://www.netgear.com>

NETGEAR has been a worldwide provider of technologically advanced, branded networking products since 1996.



Check Point
SOFTWARE TECHNOLOGIES LTD.

<http://www.checkpoint.com>

Check Point, the worldwide leader in securing the Internet, provides customers with uncompromised protection against all types of threats, reduces security complexity and lowers total cost of ownership.



SonicWALL <http://www.sonicwall.com>

Control, manage and protect your network easily and automatically with intuitive security solutions.



<http://www.coyotepoint.com>

The recognized leader in proven and affordable load balancing and application delivery solutions.



<http://www.watchguard.com>

WatchGuard is a provider of Internet security solutions and network security appliances.



<http://www.airtightnetworks.com>

AirTight Networks offers enterprises the next generation of intelligent edge, secure, and flexible WLAN solutions.



<http://www.drobo.com>

Drobo. Different. Unique. The best storage experience for you AND your business.



<http://www.algosec.com>

AlgoSec enables security and operations teams to intelligently manage security policies across firewalls, routers, VPNs and related devices, increasing operational efficiency and improving risk mitigation for organizations worldwide.



Next Generation Firewalls

<http://www.gateprotect.com>

gateprotect is a leading manufacturer of IT Security solutions focused on Next Generation firewall products, Managed Security Solutions and client encryption systems.



<http://www.merunetworks.com>

Meru delivers high-performance wireless networks for enterprises that depend on mobility.