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Subject: U.S. TRADEMARK APPLICATION NO. 77723547 - IOBIT - N/A -  
EXAMINER BRIEF

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**UNITED STATES PATENT AND TRADEMARK OFFICE**

**APPLICATION SERIAL NO.** 77723547

**MARK:** IOBIT



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**GENERAL TRADEMARK INFORMATION:**

<http://www.uspto.gov/main/trademarks.htm>

**TTAB INFORMATION:**

<http://www.uspto.gov/web/offices/dcom/ttab/index.html>

**APPLICANT:** Chengdu AOBI Information  
Technology Co., ETC.

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

N/A

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**EXAMINING ATTORNEY'S APPEAL BRIEF**

**I. INTRODUCTION**

Applicant, Chengdu AOBI Information Technology Co., Ltd. (“Applicant”), has appealed the final refusal to register the proposed mark IOBIT for “Computer programming; Computer software design; Conversion of data or documents from physical to electronic media; Data conversion of computer programs and data, not physical conversion; Duplication of computer programs; Hosting of web sites; Installation of computer software; Maintenance of computer software; Research and development for new products for others; Research and development of computer software; Updating and maintenance of computer software” in International Class 42.

Registration is refused pursuant to Trademark Act Sections 1 and 45, 15 U.S.C. §§1051, 1127, on the ground that Applicant’s specimens of use do not show use of the applied-for mark in connection with any of the services specified in the application.

It is respectfully requested that this refusal be affirmed.

## **II. STATEMENT OF FACTS**

On March 20, 2009, Applicant filed a use-based application for “Computer programming; Computer software design; Conversion of data or documents from physical to electronic media; Data conversion of computer programs and data, not physical conversion; Duplication of computer programs; Hosting of web sites; Installation of computer software; Maintenance of computer software; Research and development for new products for others; Research and development of computer software; Updating and maintenance of computer software” in International Class 42.

On July 27, 2009, the undersigned examining attorney (“Examining Attorney”) refused registration under Trademark Act Section 2(d) on the ground that the applied-for mark was confusingly similar to the mark in U.S. Registration No. 2557070. Registration was also refused under Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1), on the ground that the applied-for mark was merely descriptive. Lastly, registration was refused under Trademark Act Sections 1 and 45 on the ground that the specimens of use were unacceptable because they did not show the applied-for mark used in commerce in connection with any of the services specified in the application.

On January 20, 2010, Applicant provided arguments against the Section 2(d) and Section 2(e)(1) refusals. Applicant also submitted substitute specimens of use.

On February 27, 2010, the Examining Attorney issued final refusals under Sections 2(d) and 2(e)(1). The refusal of Applicant’s specimens of use under Trademark Act Sections 1 and 45 was also made final.

On August 27, 2010, Applicant filed the present appeal with the Trademark Trial and Appeal Board (“Board”), and concurrently submitted a request for reconsideration of the final refusals and requirement. In the request for reconsideration, Applicant provided additional arguments against the Section 2(d) refusal and amended the present application to seek registration on the Supplemental Register in response to the Section 2(e)(1) refusal. Applicant also submitted an additional substitute specimen of use.

On September 1, 2010, the Examining Attorney withdrew the Section 2(e)(1) refusal. The Examining Attorney denied the request for reconsideration in connection with the Section 2(d) refusal based on the fact that the marks were confusingly similar and the services were closely related if not identical. The Examining Attorney also refused the substitute specimen for failure to show use of the applied-for mark with the services listed in the application.

On January 10, 2011, U.S. Registration No. 2557070 was cancelled. As such, this registration no longer presents a bar to the present application and is not an issue on appeal.

### **III. SECTIONS 1 & 45 REFUSAL – SPECIMENS DOES NOT SHOW USE**

An application based on Trademark Act Section 1(a) must include a specimen showing the applied-for mark in use in commerce for each class of services. 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). The specimens submitted by Applicant are not acceptable because they do not show the applied-for mark used in connection with any of the services specified in the application.

The specimens submitted with the original application were refused by the Examining Attorney because the specimens showed use of the mark in connection with goods, namely, computer software. The specimens did not show that Applicant was also using the applied-for mark “in the sale or advertising of the services” listed in the application. Trademark Act Section 45, 15 U.S.C. §1127; *see* 37 C.F.R. §2.56(b)(2); TMEP §1301.04. “While the nature of the services does not need to be specified in the specimens, there must be something which creates in the mind of the purchaser an association between the mark and the service activity.” *In re Adair*, 45 USPQ2d 1211, 1215 (TTAB 1997) (quoting *In re Johnson Controls Inc.*, 33 USPQ2d 1318, 1320 (TTAB 1994)). There must be sufficient reference to the services in the specimen to create this association. *In re Monograms Am., Inc.*, 51 USPQ2d 1317, 1318 (TTAB 1999); *see* TMEP §§1301.04 *et seq.* Though Applicant’s goods may provide several of the functions listed as services, this would not be appropriate to show that Applicant is also offering computer software services to third parties. For example, there is nothing evident from the specimens that Applicant offers “updating and maintenance of computer software” separately and apart from the goods that provide this function. Because Applicant’s specimens did not show the mark with reference to, or in association with, the services, the specimens failed to show service mark usage. *See In re DSM Pharms., Inc.*, 87 USPQ2d 1623, 1625-26 (TTAB 2008).

Applicant submitted substitute specimens with its January 20, 2010, response. These specimens were rejected by the Examining Attorney for various reasons. First, the specimens were illegible. TMEP §904.07(a). Second, some of the specimens appeared to be press releases, and press releases to news media, or printed articles resulting from

such releases, are not acceptable because they do not show use of the mark by Applicant in the rendering or advertising of the services. *See* TMEP §1301.04. Lastly, one of the specimens again appeared to show use of the mark on goods.

Applicant submitted an additional substitute specimen with its request for reconsideration on August 27, 2010. This substitute specimen was rejected by the Examining Attorney because there was nothing evident from the specimen that Applicant provided services to third parties. To be a service, an activity must be primarily for the benefit of someone other than Applicant. TMEP §1301.01(a)(ii). The substitute specimen appeared to show that Applicant designed its own software. If Applicant designs its own software, then these services are merely ancillary to Applicant's primary purpose of offering software goods. *See* TMEP §1301.01(a)(iii). As such, Applicant primarily benefits from these services, and therefore the substitute specimen did not show that Applicant was using the applied-for mark with any of the listed services.

Because Applicant's specimens of use do not show use of the applied-for mark with any of the services listed in the application, registration must be refused under Trademark Act Sections 1 and 45. 15 U.S.C. §§1051, 1127.

#### **IV. CONCLUSION**

For the foregoing reasons, the Examining Attorney respectfully requests that the refusal to register the applied-for mark for failure to submit an appropriate specimen of use as required under Trademark Act Sections 1 and 45, 15 U.S.C. §§1051, 1127, be affirmed.

Respectfully submitted,

/Drew Leaser/  
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