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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Chengdu AOBI Information Technology Co., Ltd.

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Serial No. 77723547

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Jeffrey M. Furr of Furr Law Firm for Chengdu AOBI Information Technology Co., Ltd.

Drew Leaser, Trademark Examining Attorney, Law Office 112 (Angela Bishop Wilson, Managing Attorney).

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Before Seeherman, Quinn and Lykos, Administrative Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Chengdu AOBI Information Technology Co., Ltd. has appealed from the final refusal of the trademark examining attorney to register IObit on the Supplemental Register for the following services, all in Class 42:

> 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."[1]

Registration was refused on a number of bases, most of which have now been resolved. Specifically, registration on the Principal Register was refused pursuant to Section 2(e)(1) of the Trademark Act, on the ground that the mark is merely descriptive of the identified goods. However, in its request for reconsideration filed August 27, 2010, applicant amended its application to the Supplemental Register and, as a result, on September 1, 2010, the examining attorney withdrew the refusal on that ground. The examining attorney also refused registration pursuant to Section 2(d), asserting that applicant's mark was likely to cause confusion with Registration No. 2557070. However, that registration was cancelled on January 10, 2011, subsequent to the filing of applicant's appeal brief but prior to the submission of the examining attorney's brief. The examining attorney pointed this out in his appeal brief, and specifically withdrew the refusal of registration based on Section 2(d).

Thus, the only remaining issue on appeal is pursuant to Sections 1 and 45 of the Trademark Act, 15 U.S.C.

[1] Application Serial No. 77723547, filed April 27, 2009, asserting first use and first use in commerce on May 5, 2005.

§§ 1051 and 1127, on the ground that applicant's specimens do not show use of the mark in connection with any of the services identified in the application. The examining attorney points out that applicant's application is based on Section 1(a) of the Act, use in commerce, and that a requirement for such an application is that it must include a specimen showing use of the mark. Section 45 of the Act defines "use in commerce" on services "when it is used or displayed in the sale or advertising of services and the services are rendered in commerce…." Trademark Rule 2.56(b) further provides that "a service mark specimen must show the mark as actually used in the sale or advertising of the services."

Applicant did not address this ground for refusal in its brief, which argued only against the refusal based on likelihood of confusion. Nor did applicant file a reply brief, despite the fact that the examining attorney's brief was devoted solely to the refusal based on the unacceptability of the specimens and their failure to show use for the identified services. In fact, even during the prosecution of the application applicant did not provide any argument regarding the acceptability of its specimens, addressing this point only by submitting substitute

specimens in its January 20, 2010 and August 27, 2010 responses.

Although we do not have the benefit of applicant's arguments, we do not treat the failure to submit such arguments as a concession of this ground for refusal. It is still the Office's burden to show that registration should be refused, and therefore we turn to a consideration of both the original and substitute specimens.

We begin with the specimen submitted by applicant with its August 27, 2010 request for reconsideration. Because applicant did not argue about the acceptability of the prior specimens, it appears that applicant accepted the examining attorney's view that the prior specimens did not show use of the mark for its identified services. At the very least, this specimen would appear to be the one that applicant considers the best example of service mark use. The specimen is a screenshot from applicant's website, www.iobit.com, with the following text:

> Distributing Our Products
> IObit
> We are open to various levels of cooperation. Currently our products are distributed on the Internet and through local stores in the U.S., Europe and Asia countries. If you are interested in exchanging links with us, or you would like to help us with physical distribution and promotion, in software compilations, or in other forms of business cooperation, kindly let us know!
> Contact: partner@iobit.com

> What We Do
> Our sincere commitment to all our customers is that we will continue delivering innovative system utilities that are as simple to use as they are powerful and reliable. We also promise that we will keep providing the first-class free software and online service, for personal or non-commerical use.
>
> We pursue the genuine ambition of becoming one of the world's top utility producers and Windows system service providers on the Internet.

The only mentions of services in this webpage are in the last two paragraphs—"we will keep providing the first-class free software and online service," and that the company has the ambition of becoming "one of the world's top utility producers and Windows system service providers." Such vague references to services are insufficient to show use of IObit for the services identified in applicant's application. In fact, we cannot determine from this specimen whether the "online service" refers to a separate service, or is merely part of the free software product. Nor is applicant's stated ambition to be a Windows system service provider an indication that applicant is providing a service now, and this statement certainly does not show that applicant is offering any of the services specified in the application.

As for the other specimens, although, as we have said, it appears that applicant is not asserting their

acceptability, we will discuss them briefly. The original application includes approximately 31 pages of "specimens." Four pages are from whois.net, and simpy show owner information for the domain name iobit.com; two pages are from Google Trends, showing daily unique visitors for iobit.com; while four pages are from alexa.com, also showing traffic details for iobit.com. These pages do not show IObit per se as a mark, let alone showing use of the mark for the services identified in the application. The other pages are from applicant's website, www.iobit.com. It is somewhat questionable whether, as used on these pages, consumers would perceive applicant's mark as IObit, as opposed to IObit.Com and a design. In any event, these pages discuss applicant's products, not the services identified in the application. See, for example:

> Most of our products are 100% freebies. Our paid products keep them the lowest priced on the market—and your satisfaction is always guaranteed.
>
> ...
>
> Smart Defrag The Most Efficient Free Defragmenter.
>
> ...
>
> SOFTPEDIA "100%" clean" IObit Software
>
> ...
>
> Advanced SystemCare PRO

> IObit SmartRAM monitors your system in the background and frees up memory whenever needed to increase the performance of your computer.
>
> ...
>
> Welcome to IObit Update
> Click 'Next>' to retrieve update information,
> click 'Cancel' to exit update program.

At most, it appears that applicant's products can be used to maintain Windows operating system and diagnose a system, but applicant is offering a product, not the service of computer programming, or computer software design, or conversion of data or documents from physical to electronic media, or data conversion of computer programs and data not physical conversions, or duplication of computer programs, or hosting of web sites, or installation of computer software, or maintenance of computer software, or research and development for new products for others, or research and development of computer software, or updating and maintenance of computer software. Therefore, these specimens do not show use of the mark for any of the identified services.

It does not appear that applicant believes otherwise, since, as noted above, it did not argue that the specimens submitted with the original application are acceptable, but simply submitted substitute specimens, consisting of six pages taken from what appear to be different websites. In

the Office action following such submission the examining attorney stated that the substitute specimens were not acceptable because, inter alia, they are illegible. Applicant did nothing to rectify this problem, such as by submitting larger specimens with its request for reconsideration. We agree with the examining attorney that the text on the specimens is, for the most part, too small to make out any but the very largest words, and therefore are unacceptable as specimens. We also point out that from the little we can glean from these pages, they appear to be press releases or articles that would not qualify as evidence of service mark use. Further, with respect to the first item, which appears to be an article from "Times Online," applicant itself, in identifying the specimen, states that "the client's software *product* bearing the brand name 'IOBIT' is introduced in some well known websites in the industry" (emphasis added). The only specimen that is legible is a disc which applicant identifies as "A sample *product* bearing the brand name 'IOBIT.'" (emphasis added). To state the obvious, applicant is seeking to register its mark for services, not products.

In sum, after carefully reviewing all of the specimens submitted by applicant, we agree with the examining

attorney that none is acceptable to show use of the mark IObit for any of the services identified in applicant's application.

Decision: The refusal of registration is affirmed.