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**To:** Gungner, David J. (e9pxbkwmrp1u5o3@pacbell.net)  
**Subject:** TRADEMARK APPLICATION NO. 78093634 - MISSING A RIB, XY INSTEAD OF XX - N/A  
**Sent:** 11/16/2006 2:37:06 PM  
**Sent As:** ECOM116@USPTO.GOV  
**Attachments:**

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**UNITED STATES PATENT AND TRADEMARK OFFICE**

**SERIAL NO:** 78/093634

**APPLICANT:** Gungner, David J.

**CORRESPONDENT ADDRESS:**  
david gungner  
Post Office Area 3302  
Los Angeles County CA 90408-3302

**RETURN ADDRESS:**  
Commissioner for Trademarks  
P.O. Box 1451  
Alexandria, VA 22313-1451

**MARK:** MISSING A RIB, XY INSTEAD OF XX

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

**CORRESPONDENT EMAIL ADDRESS:**  
e9pxbkwmrp1u5o3@pacbell.net

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.

**FINAL OFFICE ACTION**

**MAILING/E-MAILING DATE INFORMATION:** If the mailing or e-mailing date of this Office action does not appear above, this information can be obtained by visiting the USPTO website at <http://tarr.uspto.gov/>, inserting the application serial number, and viewing the prosecution history for the mailing date of the most recently issued Office communication.

Serial Number 78/093634

This letter responds to applicant's communication filed on September 30, 2006.

Applicant has requested a refund. Under 35 U.S.C. §42(d) and 37 C.F.R. §2.209, only money paid by mistake or in excess (when a fee is not required by statute or rule, or is not required in the amount paid) may be refunded. A mere change of purpose after the payment of money does not entitle a party to a refund. TMEP §405.04.

**FINAL Refusal – Does Not Function as a Trademark**

For the reasons set forth below, the refusal is now made FINAL under Trademark Act Sections 1, 2 and 45, 15 U.S.C. §§1051, 1052 and 1127, for failure to function as a trademark as used on the specimen(s) of record. 37 C.F.R. §2.64(a).

Applicant has failed to submit a substitute specimen showing use as a trademark, and a statement that “the substitute specimen was in use in commerce at least as early as the application filing date,” verified with a notarized affidavit or a signed declaration under 37 C.F.R. §2.20. 37 C.F.R. §2.59(a); TMEP §904.09.

The specimen of record consists of a photocopy of a five-dollar bill and a box with the wording “facsimile message information” that includes the subject line “Re: TRADEMARK APPLICATION NO. 78093634...” and other miscellaneous information. The mark appears between the copy of the five-dollar bill and the box containing “facsimile message information.” The examining attorney is named as the “recipient [sic].” See applicant’s July 28, 2004 response. The mark does not function as a trademark on the specimen because it would not be perceived as a source identifier for the goods but rather as a facsimile cover sheet addressed to the examining attorney.

The specimen of record, along with any other relevant evidence submitted with the application, is reviewed and analyzed in order to determine whether a term is being properly used as a trademark. *In re Bose Corp.*, 546 F.2d 893, 192 USPQ 213 (C.C.P.A. 1976); *In re Volvo Cars of North America*, 46 USPQ2d 1455 (TTAB 1998). Not all words, designs, symbols or slogans used in the sale or advertising of goods or services function as marks, even if they may have been adopted with the intent to do so. A designation cannot be registered unless ordinary purchasers would regard it as a source-indicator for the goods. *In re Manco, Inc.*, 24 USPQ2d 1938 (TTAB 1992); TMEP §§1202 *et seq.*

Applicant should also note the following additional ground for final refusal.

**FINAL Refusal – Goods in Trade**

For the reasons set forth below, the refusal is now made FINAL under Trademark Act Sections 1, 2 and 45, 15 U.S.C. §§1051, 1052 and 1127, because the identified goods to which the proposed mark is applied are not “goods in trade.”

The proposed mark is not being used to identify goods that travel in commerce. Specifically, the application lists the following goods as the subject matter to which the proposed mark will be applied: Facsimile transmission paper. Such goods, submitted as applicant’s specimen, are items commonly used to run a business on a daily basis, i.e., to send messages through facsimile transmission.

Incidental items that an applicant uses in conducting its daily business (such as letterhead, invoices and business forms), as opposed to items sold or transported in commerce for use *by others*, are not “goods in trade.” See *In re Shareholders Data Corp.*, 495 F.2d 1360, 181 USPQ 722 (C.C.P.A. 1974) (reports not goods in trade, where applicant is not engaged in the sale of reports, but solely in furnishing financial reporting services, and reports are merely conduit through which services are rendered); *In re Compute-Her-Look, Inc.*, 176 USPQ 445 (TTAB 1972) (reports and printouts not goods in trade, where they are merely the means by which the results of a beauty analysis service is transmitted and have no viable existence separate and apart from the service); *Ex parte Bank of America National Trust and Savings Association*, 118 USPQ 165 (Comm’r Pats. 1958) (mark not registrable for passbooks, checks and other printed forms, where forms are used only as necessary tools in the performance of banking services, and the applicant is not engaged in printing or selling forms as commodities in trade); See

TMEP §§1202.06 *et seq.* As shown on the specimen of record, the mark is not used on “facsimile transmission paper” as goods that travel in commerce, but rather on facsimile messages.

The application file will be returned to the Trademark Trial and Appeal Board for resumption of the appeal.

/Cynthia Sloan/  
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Law Office 116  
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**HOW TO RESPOND TO THIS OFFICE ACTION:**

- **ONLINE RESPONSE:** You may respond using the Office’s Trademark Electronic Application System (TEAS) Response to Office action form available on our website at <http://www.uspto.gov/teas/index.html>. If the Office action issued via e-mail, you must wait 72 hours after receipt of the Office action to respond via TEAS. **NOTE: Do not respond by e-mail. THE USPTO WILL NOT ACCEPT AN E-MAILED RESPONSE.**
- **REGULAR MAIL RESPONSE:** To respond by regular mail, your response should be sent to the mailing return address above, and include the serial number, law office number, and examining attorney’s name. **NOTE: The filing date of the response will be the *date of receipt in the Office*, not the postmarked date.** To ensure your response is timely, use a certificate of mailing. 37 C.F.R. §2.197.

**STATUS OF APPLICATION:** To check the status of your application, visit the Office’s Trademark Applications and Registrations Retrieval (TARR) system at <http://tarr.uspto.gov>.

**VIEW APPLICATION DOCUMENTS ONLINE:** Documents in the electronic file for pending applications can be viewed and downloaded online at <http://portal.uspto.gov/external/portal/tow>.

**GENERAL TRADEMARK INFORMATION:** For general information about trademarks, please visit the Office’s website at <http://www.uspto.gov/main/trademarks.htm>

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