

UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 79/039874

MARK: TVDIGITAL



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GENERAL TRADEMARK INFORMATION:
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APPLICANT: Axel Springer AG

CORRESPONDENT'S REFERENCE/DOCKET
NO:

N/A

CORRESPONDENT E-MAIL ADDRESS:

REQUEST FOR RECONSIDERATION DENIED

ISSUE/MAILING DATE:

Applicant is requesting reconsideration of a final refusal issued/mailed April 29, 2008.

The examining attorney has reviewed the applicant's request for reconsideration. The substitute drawing page has been accepted and entered into the record. The following amended goods and services are acceptable: "printed matter and materials, namely, catalogues and leaflets, brochures, books and magazines all featuring analogue and digital television programming schedules; printed teaching and educational materials in the field of digital TV" in International Class 16; "data processing" in International Class 35; "telecommunication services, namely, broadcasting of radio and television programs; gathering and delivering of news and general information, namely, transmission of news via cable and satellite; transmission of sound and pictures via cable and satellite;; mobile telephone services, namely, voicemail services, and SMS and WAP services; sound, picture and data transmission via cable, satellite, computer and computer networks" in International Class 38; and "entertainment services, namely, organizing community sporting activities and providing continuing radio and television programs featuring news and entertainment; publication and editing of printed matter in particular newspapers and magazines; publishing of electronic books, electronic magazines and electronic newspapers" in International Class 41.

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 with respect to the final requirement for an acceptable identification of goods and services, since much of the proposed amended identification of goods and services remains unacceptable and no new facts or reasons have been presented that are significant and compelling with regard to the point at issue.

Accordingly, applicant's request for reconsideration is *denied*. The time for appeal runs from the date

the final action was issued/mailed. 37 C.F.R. Section 2.64(b); TMEP Section 715.03(c). As the applicant has already filed a timely notice of appeal, this application will be forwarded to the Trademark Trial and Appeal Board (TTAB).

The applicant is advised of the following specifics concerning the unacceptability of the identification of goods and services:

In the final Office action, the examining attorney indicated that there was certain wording in the proposed identification of goods and services that remained indefinite and required clarification. The applicant was advised that it could amend its identification in accordance with numerous suggested amendments provided by the examining attorney.

In its request for reconsideration, the applicant has proposed the following amendments to the identification of goods and services: "Paper and cardboard cartons, boxes, and containers; printed matter and materials, namely, catalogues and leaflets, brochures, books and magazines all featuring analogue and digital television programming schedules; printed teaching and educational materials in the field of digital TV" in International Class 16; "providing a database for collecting, compiling, processing, updating, selecting, evaluating and providing data reproduction services for third parties; data processing and data reproduction services" in International Class 35; "telecommunication services, namely, broadcasting of radio and television programs; gathering and delivering of news and general information, namely, transmission of news via cable and satellite; transmission of sound and pictures via cable and satellite; providing information concerning telecommunications and communication services in the fields of telecommunications access and communication by electronic computer terminals and television services; mobile telephone services, namely, voicemail services, and SMS and WAP services; sound, picture and data transmission via cable, satellite, computer and computer networks; providing multiple-user access to a global computer information network via the internet, other networks, namely, a global computer information network, and on-line internet and broadcasting services featuring, news and entertainment programs; providing access to electronic media transmission services and information via the internet, especially on-demand transmission services; electronic transmission of news and information, e-mail and mobile communications services, namely, voicemail services, and SMS and WAP services featuring transmission of news, information and pictures via computer, teletext services; transmitting information of all kinds of internet addresses, namely, web-messaging; providing information about telecommunications featuring electronic media transmission services and information via the internet" in International Class 38; and "educational and entertainment services, namely, organizing community sporting and casual activities, and providing continuing radio and television programs featuring news and entertainment programs and providing information related thereto; publication and editing of printed matter in particular newspapers and magazines; electronic publishing services for others, namely, on-line publication of electronic media, electronic text, graphics, and pictures with all featuring news and entertainment programs and sound information, as well as, language data available via computer networks; production of motion picture film, image and sound recordings, namely, production of motion pictures and films recorded on video tapes, and recording of audio and video tapes for others; online publishing of electronic books, electronic magazines and electronic newspapers, and image and sound recording works of others" in International Class 41.

The following goods and services in CAPITALIZED letters (with the exception of the acronyms "SMS" and "WAP") remain indefinite and require clarification. See TMEP §1402.01.

[1]

"PAPER AND CARDBOARD CARTONS, BOXES, AND CONTAINERS"; printed matter and materials, namely, catalogues and leaflets, brochures, books and magazines all featuring analogue and digital television programming schedules; printed teaching and educational materials in the field of

digital TV” in International Class 16.

AND

“PROVIDING A DATABASE FOR COLLECTING, COMPILING, PROCESSING, UPDATING, SELECTING, EVALUATING AND PROVIDING DATA REPRODUCTION SERVICES FOR

[2] THIRD PARTIES ; data processing and DATA REPRODUCTION SERVICES [3] ” in International Class 35.

AND

“Telecommunication services, namely, broadcasting of radio and television programs; gathering and delivering of news and general information, namely, transmission of news via cable and satellite; transmission of sound and pictures via cable and satellite; PROVIDING INFORMATION CONCERNING TELECOMMUNICATIONS AND COMMUNICATION SERVICES IN THE FIELDS OF TELECOMMUNICATIONS ACCESS AND COMMUNICATION BY ELECTRONIC

[4] COMPUTER TERMINALS AND TELEVISION SERVICES ; mobile telephone services, namely, voicemail services, and SMS and WAP services; sound, picture and data transmission via cable, satellite, computer and computer networks; PROVIDING MULTIPLE-USER ACCESS TO A GLOBAL COMPUTER INFORMATION NETWORK VIA THE INTERNET, OTHER NETWORKS, NAMELY, A GLOBAL COMPUTER INFORMATION NETWORK, AND ON-LINE INTERNET AND BROADCASTING SERVICES FEATURING, NEWS AND ENTERTAINMENT PROGRAMS; PROVIDING ACCESS TO ELECTRONIC MEDIA TRANSMISSION SERVICES AND INFORMATION VIA THE INTERNET, ESPECIALLY ON-DEMAND TRANSMISSION SERVICES; ELECTRONIC TRANSMISSION OF NEWS AND INFORMATION, E-MAIL AND MOBILE COMMUNICATIONS SERVICES, NAMELY, VOICEMAIL SERVICES, AND SMS AND WAP SERVICES FEATURING TRANSMISSION OF NEWS, INFORMATION AND PICTURES VIA COMPUTER, TELETEXT SERVICES; TRANSMITTING INFORMATION OF ALL KINDS OF INTERNET ADDRESSES, NAMELY, WEB-MESSAGING; PROVIDING INFORMATION ABOUT TELECOMMUNICATIONS FEATURING ELECTRONIC MEDIA TRANSMISSION SERVICES

[5] AND INFORMATION VIA THE INTERNET ” in International Class 38.

AND

[6] “EDUCATIONAL and entertainment services, namely, organizing community sporting and CASUAL activities, and providing continuing radio and television programs featuring news and entertainment programs AND PROVIDING INFORMATION RELATED THERETO; publication and editing of printed matter in particular newspapers and magazines; ELECTRONIC PUBLISHING

[7] SERVICES FOR OTHERS, NAMELY, ON-LINE PUBLICATION OF ELECTRONIC MEDIA, ELECTRONIC TEXT, GRAPHICS, AND PICTURES WITH ALL FEATURING NEWS AND ENTERTAINMENT PROGRAMS AND SOUND INFORMATION, AS WELL AS, LANGUAGE DATA AVAILABLE VIA COMPUTER NETWORKS; PRODUCTION OF MOTION PICTURE FILM, IMAGE AND SOUND RECORDINGS, NAMELY, PRODUCTION OF MOTION PICTURES AND FILMS RECORDED ON VIDEO TAPES, AND RECORDING OF AUDIO AND VIDEO TAPES FOR OTHERS; ONLINE publishing of electronic books, electronic magazines and electronic

newspapers, AND IMAGE AND SOUND RECORDING WORKS OF OTHERS ^[8] in International Class 41.

To follow are the examining attorney's suggestions concerning the applicant's identification of goods and services. Applicant may adopt the following identification, if accurate:

"Paper; cartons, boxes, and containers, all of cardboard; printed matter and materials, namely, catalogues and leaflets, brochures, books and magazines all featuring analogue and digital television programming schedules; printed teaching and educational materials in the field of digital TV" in International Class 16.

AND

"Management and compilation of computerized databases, namely, collecting, compiling, processing, updating, selecting and evaluating data for databases provided to third parties; data processing services" in International Class 35.

AND

"Telecommunication services, namely, broadcasting of radio and television programs; gathering and delivering of news and general information, namely, transmission of news via cable and satellite; transmission of sound and pictures via cable and satellite; providing telecommunications and communication services information on the subjects of telecommunications access, communication by electronic computer terminals, and television services; mobile telephone services, namely, voicemail services, and SMS and WAP services; sound, picture and data transmission via cable, satellite, computer and computer networks; mobile telephone communication services, namely, voice-mail services, SMS services, and WAP services; sound, picture and data transmission via cable, satellite, computer and computer networks; providing multiple-user access to area networks and global computer networks that provide information, news, entertainment programs, and on-line services; video-on-demand transmission services, namely, transmission of information and electronic media in the nature of sound and video on demand; providing e-mail services, namely, electronic transmission of e-mail for others; mobile telephone communication services that feature voicemail; transmission of news, information and pictures via computer; teletext services; web messaging services, namely, transmission of informational messages of all kinds to Internet addresses over electronic" in International Class 38.

AND

"Entertainment services, namely, organizing community sporting and cultural activities; entertainment services, namely, providing continuing radio and television programs featuring news and entertainment and providing entertainment information related thereto; publication and editing of printed matter in particular newspapers and magazines; electronic publishing services, namely, publication of text and graphic works of others on-line featuring the subjects of news and entertainment; production of motion pictures and sound recordings, namely production of movies and films recorded on video tapes; audio and video recording services; publishing of electronic books, electronic magazines and electronic newspapers" in International Class 41.

Identifications can be amended only to clarify or limit the goods and/or services; adding to or broadening the scope of the goods and/or services is not permitted. 37 C.F.R. §2.71(a); see TMEP §§1402.06 *et seq.*, 1402.07(a), 1904.02(b). In addition, for applications filed under Trademark Act Section 66(a), amendments to the identification are limited to goods and/or services in the international

class(es) designated in the application as filed. See TMEP §§1402.03(d), 1402.07(a).

Thus, applicant can only amend the identification to include goods and/or services that are (1) within the scope of the identification in the application as filed, and (2) classified in an international class designated in the application as filed.

For assistance with identifying and classifying goods and/or services in trademark applications, please see the online searchable *Manual of Acceptable Identifications of Goods and Services* at <http://tess2.uspto.gov/netahhtml/tidm.html>. See TMEP §1402.04.

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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.

[1]

The wording "paper and cardboard cartons, boxes, and containers" is ambiguous because it is unclear whether the relevant goods are "paper" on the one hand and "cartons, boxes and containers of cardboard" on the other or cartons, boxes and containers comprised of some type of paper and cardboard blend of materials.

[2]

The proposed amendment "providing a database for collecting, compiling, processing, updating, selecting, evaluating and providing data reproduction services for third parties" cannot be accepted because it exceeds the scope of the services set forth in the application at the time of filing: "services of a database, namely collecting, compiling, processing, updating, selecting, evaluating and providing of data and other information for third parties." See 37 C.F.R. §2.71(a). Identifications can be amended only to clarify or limit the goods and/or services, adding to or broadening the scope of the goods and/or services is not permitted. *Id.*; see TMEP §§1402.06 *et seq.*, 1402.07(a). It is also noted that provision of database services are classified according to the subject matter of the information provided. TMEP §1402.11(b). The following are examples of proper classification: "providing a database featuring information pertaining to purchasing an automobile" -- International Class 35; "providing a database featuring information regarding financing and insuring an automobile" -- International Class 36; and "providing a database featuring information regarding the repair and maintenance of automobiles" -- International Class 37. However, the international classification of goods and/or services in applications filed under Trademark Act Section 66(a) cannot be changed from the classification given to the goods and/or services by the International Bureau in the corresponding international registration. TMEP §§1401.03(d), 1904.02(b).

[3]

Generally, a trademark examining attorney will recommend acceptable substitute wording for unacceptable identifications of goods and/or services. In this case, however, because the nature of the goods and/or services is unclear from the application record, the trademark examining attorney is unable to suggest any alternative wording for "data reproduction." See TMEP §1402.01(e).

[4]

The services "providing information concerning telecommunications and communication services in the fields of

telecommunications access and communication by electronic computer terminals and television services” are ambiguous. Is the applicant providing telecommunications and communication services information in the fields of telecommunications access on the one hand and providing the wholly separate services “communication by electronic computer terminals” and “television services” (which is indefinite and possibly misclassified) on the other hand, or is the applicant providing telecommunications and communication services information concerning all of the foregoing?

[5] Please see suggested amendments with respect to all of the foregoing unacceptable services.

[6] The referenced services (i.e., organizing community sporting and casual activities are not considered educational.

[7] The applicant’s electronic publishing services must conform to the following:

<i>Hit No</i>	<i>Class</i>	<i>Description</i>	<i>Status</i>	<i>Effective Date</i>	<i>Type</i>	<i>Note</i>	<i>Trilateral</i>
1	041	Electronic publishing services, namely, publication of text and graphic works of others on {indicate format, e.g., CD, DVD, on-line} featuring {indicate specific subject matter}	M	01 Mar 02	S	<u>Y</u>	
2	041	Multimedia publishing of books, magazines, journals, software, games, music, and electronic publications	A	15 Feb 07	S	<u>Y</u>	
3	041	Online electronic publishing of books and periodicals	A	04 Oct 07	S	<u>Y</u>	T
4	041	Publishing and distribution of books, reviews and other printed matter as well as related electronic data carriers	D	24 Oct 06	S	<u>Y</u>	T
5	041	Publishing of electronic publications	A	20 Jul 04	S	<u>Y</u>	T

[8] Please see suggested amendments with respect to all of the foregoing unacceptable services