

From: Gilbert, Rebecca

Sent: 12/8/2014 2:07:34 PM

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Subject: U.S. TRADEMARK APPLICATION NO. 85667978 - WEB.COM - N/A - Request for Reconsideration Denied - Return to TTAB - Message 1 of 10

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Attachment Information:

Count: 21

Files: web-01.jpg, web-02.jpg, web-28.jpg, web-29.jpg, web-30.jpg, web2-1.jpg, web2-2.jpg, web2-3.jpg, web2-4.jpg, web2-5.jpg, web2-6.jpg, web2-7.jpg, web2-8.jpg, web4-1.jpg, web4-2.jpg, web6-1.jpg, web6-2.jpg, web6-3.jpg, web6-4.jpg, web8-1.jpg, 85667978.doc

**UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)  
OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION**

<b>U.S. APPLICATION SERIAL NO.</b> 85667978  <b>MARK:</b> WEB.COM	
<b>CORRESPONDENT ADDRESS:</b> STEVEN SEREBOFF  SOCAL IP LAW GROUP LLP  310 N WESTLAKE BLVD., SUITE 120  WESTLAKE VILLAGE, CA 91362	<b>GENERAL TRADEMARK INFORMATION:</b>  <a href="http://www.uspto.gov/trademarks/index.jsp">http://www.uspto.gov/trademarks/index.jsp</a>  <a href="#">VIEW YOUR APPLICATION FILE</a>
<b>APPLICANT:</b> Web.com, Group, Inc.	
<b>CORRESPONDENT'S REFERENCE/DOCKET NO:</b>  N/A  <b>CORRESPONDENT E-MAIL ADDRESS:</b>  uspto@socalip.com	

**REQUEST FOR RECONSIDERATION DENIED**

**ISSUE/MAILING DATE:** 12/8/2014

The trademark examining attorney has carefully reviewed applicant's request for reconsideration and is denying the request for the reasons stated below. See 37 C.F.R. §2.64(b); TMEP §§715.03(a)(2)(B), (a)(2)(E), 715.04(a). The requirement(s) and/or refusal(s) made final in the Office action dated March 31, 2014 are maintained and continue to be final. See TMEP §§715.03(a)(2)(B), (a)(2)(E), 715.04(a).

In the present case, applicant's request has not resolved all the outstanding issue(s), nor does it raise a new issue or provide any new or compelling evidence with regard to the outstanding issue(s) in the final Office action. In addition, applicant's analysis and arguments are not persuasive nor do they shed new light on the issues. Accordingly, the request is denied.

Note that while the amended recitation of services is acceptable, it does not obviate the refusals.

Further, applicant's prior registration does not overcome the issues because the effect of incontestability applies only where the identical part of the applied-for mark would not be considered generic. TMEP Section 1216.02. Here, applicant's mark is generic and so the effect of incontestability does not apply in this case. A mark which is generic is not protected by an Affidavit of Incontestability.

See the attached additional evidence showing that the word "WEB" is used generically by those in the trade for the described services. WEB is equally generic for the described services as the word applicant uses in its identification, web site. Adding .com and color to this generic term does not alter its generic nature. The non-source-identifying generic top-level domain (gTLD) ".com" merely indicates an Internet address for use by commercial, for-profit organizations. See, e.g., *In re 1800Mattress.com IP LLC*, 586 F.3d 1359, 1364, 92 USPQ2d 1682, 1685 (Fed. Cir. 2009); *In re Hotels.com, L.P.*, 573 F.3d 1300, 1301, 1304, 91 USPQ2d 1532, 1533, 1535 (Fed. Cir. 2009); *In re Oppedahl & Larsen LLP*, 373 F.3d 1171, 1175-77, 71 USPQ2d 1370, 1373-74 (Fed. Cir. 2004); see also TMEP §§1209.03(m), 1215.01. The color cannot carry this generic mark.

The filing of a request for reconsideration does not extend the time for filing a proper response to a final Office action or an appeal with the Trademark Trial and Appeal Board (Board), which runs from the date the final Office action was issued/mailed. See 37 C.F.R. §2.64(b); TMEP §715.03, (a)(2)(B), (a)(2)(E), (c).

If time remains in the six-month response period to the final Office action, applicant has the remainder of the response period to comply with and/or overcome any outstanding final requirement(s) and/or refusal(s) and/or to file an appeal with the Board. TMEP

§715.03(a)(2)(B), (c). However, if applicant has already filed a timely notice of appeal with the Board, the Board will be notified to resume the appeal. *See* TMEP §715.04(a).

/Rebecca Gilbert/

Rebecca Gilbert

Examining Attorney

Law Office 103

571-272-9431

rebecca.gilbert@uspto.gov

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— CATHY BARROW



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More than just web page design - we build long-lasting website development partnerships to help our clients grow their business. We take care of your website, so you can focus on what you do best - your business.

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A professional e-commerce website for an online computer and accessories store. The demo shows a clean, modern interface with a navigation menu, product listings, and a shopping cart. The text on the page reads: "A professional e-commerce website for an online computer and accessories store. Try selling your products online with our shopping cart software and you may soon find yourself saving on office rent fees."

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123WebDesign Online advertising, marketing and SEO team will be posting regular articles on the subject of e-commerce web design, online business development and online marketing strategy in the Resources section of our Clients Corner.

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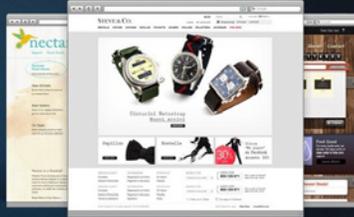
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