

Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	85667978
LAW OFFICE ASSIGNED	LAW OFFICE 103
MARK SECTION (no change)	
EVIDENCE SECTION	
EVIDENCE FILE NAME(S)	
ORIGINAL PDF FILE	evi_1-9811913013-20140930175054052274_.RFR_final_9-30-14.pdf
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ORIGINAL PDF FILE	evi_9811913013-20140930175054052274_.Exhibit_A_Section_15_acknowledgement.pdf
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ORIGINAL PDF FILE	evi_9811913013-20140930175054052274_.Exhibit_B_prior_registration_2521314.pdf
CONVERTED PDF FILE(S) (5 pages)	\\TICRS\EXPORT16\IMAGEOUT16\856\679\85667978\xml17\RFR0009.JPG
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	\\TICRS\EXPORT16\IMAGEOUT16\856\679\85667978\xml17\RFR0013.JPG
ORIGINAL PDF FILE	evi_2-9811913013-20140930175054052274_. Exh. C - Second McClure Declaration.pdf
CONVERTED PDF FILE(S) (3 pages)	\\TICRS\EXPORT16\IMAGEOUT16\856\679\85667978\xml17\RFR0014.JPG
	\\TICRS\EXPORT16\IMAGEOUT16\856\679\85667978\xml17\RFR0015.JPG
	\\TICRS\EXPORT16\IMAGEOUT16\856\679\85667978\xml17\RFR0016.JPG
DESCRIPTION OF EVIDENCE FILE	1. Request for Reconsideration 2. Exhibit A - Registration No. 3666813, NOTICE OF ACCEPTANCE UNDER SECTION 8 and NOTICE OF ACKNOWLEDGEMENT UNDER SECTION 15 (true and correct copy) 3. Exhibit B - Registration No. 2521314, Trademark Status & Document Retrieval status report (true and correct copy) 4. Exhibit C - Declaration of Matt McClure (second)
GOODS AND/OR SERVICES SECTION (035)(class deleted)	
GOODS AND/OR SERVICES SECTION (042)(current)	
INTERNATIONAL CLASS	042
DESCRIPTION	
<p>Computer services, namely, designing, implementing and managing web sites for others; Providing temporary use of on-line non-downloadable computer software development tools for creating web sites and creating electronic bulletin boards for the transmission of messages among computer users; Computer web site consultation, namely, computer services, namely, designing and implementing web sites for others; Computer services, namely, redirecting electronic mail to changed personal electronic addresses; Hosting the web sites of others on a computer server for a global computer network; Spam filtering on a global computer information network, namely, filtering of unwanted electronic mail messages on a global computer information network; Computer services, namely, monitoring, testing, analyzing, and reporting on the Internet traffic control and content control of the web sites of others; Consultation services in the field of search engine optimization; Providing temporary use of non-downloadable software for use in creating e-commerce storefronts; Providing temporary use of non-downloadable software for design and development in the field of online electronic publishing of e-commerce websites; Information gathering and reporting services in the nature of quality control, for non-business purposes, namely, tracking, analyzing, and reporting on the performance and Internet traffic control and content control of the websites of others; Monitoring the websites of others to improve scalability and performance; E-commerce website design in the field of social networking; Web site design focused on implementing domain name identification addresses on a global computer network; Computer services, namely, integration of computer software into multiple systems and networks focusing on enterprise computer security</p>	
FILING BASIS	Section 1(a)
FIRST USE ANYWHERE DATE	At least as early as 06/27/2012
FIRST USE IN	

COMMERCE DATE	At least as early as 06/27/2012
GOODS AND/OR SERVICES SECTION (042)(proposed)	
INTERNATIONAL CLASS	042
TRACKED TEXT DESCRIPTION	
<p>Computer services, namely, designing, implementing and managing web sites for others; Providing temporary use of on-line non-downloadable computer software development tools for creating web sites and creating electronic bulletin boards for the transmission of messages among computer users; Computer web site consultation, namely, computer services, namely, designing and implementing web sites for others; Hosting the web sites of others on a computer server for a global computer network; Computer services, namely, redirecting electronic mail to changed personal electronic addresses; Spam filtering on a global computer information network, namely, filtering of unwanted electronic mail messages on a global computer information network; Computer services, namely, monitoring, testing, analyzing, and reporting on the Internet traffic control and content control of the web sites of others; Consultation services in the field of search engine optimization; Providing temporary use of non-downloadable software for use in creating e-commerce storefronts; Providing temporary use of non-downloadable software for design and development in the field of online electronic publishing of e-commerce websites; Information gathering and reporting services in the nature of quality control, for non-business purposes, namely, tracking, analyzing, and reporting on the performance and Internet traffic control and content control of the websites of others; Monitoring the websites of others to improve scalability and performance; E-commerce website design in the field of social networking; Web site design focused on implementing domain name identification addresses on a global computer network; Computer services, namely, integration of computer software into multiple systems and networks focusing on enterprise computer security</p>	
FINAL DESCRIPTION	
<p>Computer services, namely, designing, implementing and managing web sites for others; Computer web site consultation, namely, computer services, namely, designing and implementing web sites for others; Hosting the web sites of others on a computer server for a global computer network</p>	
FILING BASIS	Section 1(a)
FIRST USE ANYWHERE DATE	At least as early as 06/27/2012
FIRST USE IN COMMERCE DATE	At least as early as 06/27/2012
GOODS AND/OR SERVICES SECTION (045)(class deleted)	
SIGNATURE SECTION	
RESPONSE SIGNATURE	/steven c sereboff/
SIGNATORY'S NAME	Steven C. Sereboff
SIGNATORY'S POSITION	Attorney of record, CA bar member
SIGNATORY'S PHONE NUMBER	805-230-1356

DATE SIGNED	09/30/2014
AUTHORIZED SIGNATORY	YES
CONCURRENT APPEAL NOTICE FILED	YES
FILING INFORMATION SECTION	
SUBMIT DATE	Tue Sep 30 18:22:19 EDT 2014
TEAS STAMP	USPTO/RFR-98.119.130.13-2 0140930182219057542-85667 978-5000373cda27c7c07772d c8061bdc0d79d49a6373660a0 f41a32de78c5e53cc-N/A-N/A -20140930175054052274

PTO Form 1960 (Rev 9/2007)
OMB No. 0651-0050 (Exp. 07/31/2017)

Request for Reconsideration after Final Action To the Commissioner for Trademarks:

Application serial no. **85667978** has been amended as follows:

EVIDENCE

Evidence in the nature of 1. Request for Reconsideration 2. Exhibit A - Registration No. 3666813, NOTICE OF ACCEPTANCE UNDER SECTION 8 and NOTICE OF ACKNOWLEDGEMENT UNDER SECTION 15 (true and correct copy) 3. Exhibit B - Registration No. 2521314, Trademark Status & Document Retrieval status report (true and correct copy) 4. Exhibit C - Declaration of Matt McClure (second) has been attached.

Original PDF file:

[evi_1-9811913013-20140930175054052274 . RFR_final_9-30-14.pdf](#)

Converted PDF file(s) (5 pages)

[Evidence-1](#)

[Evidence-2](#)

[Evidence-3](#)

[Evidence-4](#)

[Evidence-5](#)

Original PDF file:

[evi_9811913013-20140930175054052274 . Exhibit_A_Section_15_acknowledgement.pdf](#)

Converted PDF file(s) (2 pages)

[Evidence-1](#)

[Evidence-2](#)

Original PDF file:

[evi_9811913013-20140930175054052274 . Exhibit B_prior registration 2521314.pdf](#)

Converted PDF file(s) (5 pages)

[Evidence-1](#)

[Evidence-2](#)

[Evidence-3](#)

[Evidence-4](#)

[Evidence-5](#)

Original PDF file:

[evi_2-9811913013-20140930175054052274 . Exh. C - Second McClure Declaration.pdf](#)

Converted PDF file(s) (3 pages)

[Evidence-1](#)

[Evidence-2](#)

[Evidence-3](#)

CLASSIFICATION AND LISTING OF GOODS/SERVICES

Applicant hereby deletes the following class of goods/services from the application.

Class 035 for Social media strategy and marketing consultancy focusing on helping clients create and extend their product and brand strategies by building virally engaging marketing solutions; Providing marketing consulting in the field of social media, namely, geo-positional marketing; Advertising and promotional services for others, namely, placing advertisements and promotional displays for others in electronic sites accessed via computer networks; Dissemination of advertising matter, namely, dissemination of advertising and graphically illustrated advertising; Promotion, advertising and marketing of on-line websites; Business monitoring services, namely, tracking web sites of others to provide details about user click traffic or visits to web sites and reporting services related thereto; Advertising services, namely, creating corporate logos for others; Computerized on-line retail store services in the field of software used for keyword tracking, revenue and profitability tracking, and performance and traffic monitoring

Applicant hereby deletes the following class of goods/services from the application.

Class 045 for Website security services, namely, monitoring of computer systems for security purposes; Domain name registration services; Computer security assurance and administration of digital keys and digital certificates, namely, public key infrastructure ("PKI") validation, authentication, and issuance; Computer security services in the nature of providing an internet trust center, namely, computer security assurance and administration of digital keys and digital certificates; Online social networking services for users interested in e-commerce website design

Applicant proposes to amend the following class of goods/services in the application:

Current: Class 042 for Computer services, namely, designing, implementing and managing web sites for others; Providing temporary use of on-line non-downloadable computer software development tools for creating web sites and creating electronic bulletin boards for the transmission of messages among computer users; Computer web site consultation, namely, computer services, namely, designing and implementing web sites for others; Computer services, namely, redirecting electronic mail to changed personal electronic addresses; Hosting the web sites of others on a computer server for a global computer network; Spam filtering on a global computer information network, namely, filtering of unwanted electronic mail messages on a global computer information network; Computer services, namely, monitoring, testing, analyzing, and reporting on the Internet traffic control and content control of the web sites of others; Consultation services in the field of search engine optimization; Providing temporary use of non-downloadable software for use in creating e-commerce storefronts; Providing temporary use of

non-downloadable software for design and development in the field of online electronic publishing of e-commerce websites; Information gathering and reporting services in the nature of quality control, for non-business purposes, namely, tracking, analyzing, and reporting on the performance and Internet traffic control and content control of the websites of others; Monitoring the websites of others to improve scalability and performance; E-commerce website design in the field of social networking; Web site design focused on implementing domain name identification addresses on a global computer network; Computer services, namely, integration of computer software into multiple systems and networks focusing on enterprise computer security

Original Filing Basis:

Filing Basis: Section 1(a), Use in Commerce: The applicant is using the mark in commerce, or the applicant's related company or licensee is using the mark in commerce, on or in connection with the identified goods and/or services. 15 U.S.C. Section 1051(a), as amended. The mark was first used at least as early as 06/27/2012 and first used in commerce at least as early as 06/27/2012 , and is now in use in such commerce.

Proposed:

Tracked Text Description: Computer services, namely, designing, implementing and managing web sites for others; ~~Providing temporary use of on-line non-downloadable computer software development tools for creating web sites and creating electronic bulletin boards for the transmission of messages among computer users~~; Computer web site consultation, namely, computer services, namely, designing and implementing web sites for others; Hosting the web sites of others on a computer server for a global computer network; ~~Computer services, namely, redirecting electronic mail to changed personal electronic addresses~~; ~~Spam filtering on a global computer information network, namely, filtering of unwanted electronic mail messages on a global computer information network~~; ~~Computer services, namely, monitoring, testing, analyzing, and reporting on the Internet traffic control and content control of the web sites of others~~; ~~Consultation services in the field of search engine optimization~~; ~~Providing temporary use of non-downloadable software for use in creating e-commerce storefronts~~; ~~Providing temporary use of non-downloadable software for design and development in the field of online electronic publishing of e-commerce websites~~; ~~Information gathering and reporting services in the nature of quality control, for non-business purposes, namely, tracking, analyzing, and reporting on the performance and Internet traffic control and content control of the websites of others~~; ~~Monitoring the websites of others to improve scalability and performance~~; ~~E-commerce website design in the field of social networking~~; ~~Web site design focused on implementing domain name identification addresses on a global computer network~~; ~~Computer services, namely, integration of computer software into multiple systems and networks focusing on enterprise computer security~~

Class 042 for Computer services, namely, designing, implementing and managing web sites for others; Computer web site consultation, namely, computer services, namely, designing and implementing web sites for others; Hosting the web sites of others on a computer server for a global computer network

Filing Basis: Section 1(a), Use in Commerce: The applicant is using the mark in commerce, or the applicant's related company or licensee is using the mark in commerce, on or in connection with the identified goods and/or services. 15 U.S.C. Section 1051(a), as amended. The mark was first used at least as early as 06/27/2012 and first used in commerce at least as early as 06/27/2012 , and is now in use in such commerce.

APPLICANT AND/OR ENTITY INFORMATION

Applicant proposes to amend the following:

Current: Web.com, Group, Inc., a corporation of Delaware, having an address of
12808 Gran Bay Parkway West
Jacksonville, Florida 32258
United States

Proposed: Web.com, Group, Inc., a corporation of Delaware, having an address of
12808 Gran Bay Parkway West
Jacksonville, Florida 32258
United States

SIGNATURE(S)

Request for Reconsideration Signature

Signature: /steven c sereboff/ Date: 09/30/2014

Signatory's Name: Steven C. Sereboff

Signatory's Position: Attorney of record, CA bar member

Signatory's Phone Number: 805-230-1356

The signatory has confirmed that he/she is an attorney who is a member in good standing of the bar of the highest court of a U.S. state, which includes the District of Columbia, Puerto Rico, and other federal territories and possessions; and he/she is currently the applicant's attorney or an associate thereof; and to the best of his/her knowledge, if prior to his/her appointment another U.S. attorney or a Canadian attorney/agent not currently associated with his/her company/firm previously represented the applicant in this matter: (1) the applicant has filed or is concurrently filing a signed revocation of or substitute power of attorney with the USPTO; (2) the USPTO has granted the request of the prior representative to withdraw; (3) the applicant has filed a power of attorney appointing him/her in this matter; or (4) the applicant's appointed U.S. attorney or Canadian attorney/agent has filed a power of attorney appointing him/her as an associate attorney in this matter.

The applicant is filing a Notice of Appeal in conjunction with this Request for Reconsideration.

Serial Number: 85667978

Internet Transmission Date: Tue Sep 30 18:22:19 EDT 2014

TEAS Stamp: USPTO/RFR-98.119.130.13-2014093018221905

7542-85667978-5000373cda27c7c07772dc8061

bdc0d79d49a6373660a0f41a32de78c5e53cc-N/

A-N/A-20140930175054052274

This Request for Reconsideration is submitted in response to a final Office Action dated March 31, 2014. The Examining Attorney refused registration of Applicant's WEB.COM (stylized) mark on the grounds of insufficiency of evidence of acquired distinctiveness submitted under Trademark Act Section 2(f) to overcome the descriptiveness objection, and descriptiveness under Trademark Act Section 2(e)(1).

Applicant Web.com Group, Inc. hereby incorporates by reference the entire contents of the Office Action responses submitted in this application on April 24, 2014 and November 15, 2013, including arguments, evidence, and all other attachments.

Insufficiency of Evidence under Section 2(f)

The application should be allowed under Section 2(f) because the prior registration is now incontestable, and the services identified in the application and the incontestable registration are the same. Additional evidence submitted herewith adds further undeniable proof that the mark is a trademark. The final Office Action states that the evidence of acquired distinctiveness submitted by Applicant is insufficient for two specific reasons: a) Applicant's prior registrations of the word mark WEB.COM "are not incontestable," and b) "there is no proof that as a result [of Applicant's marketing efforts and expenses and the industry articles about Applicant] general web service seeking consumers themselves would and do recognize WEB.COM to refer to only applicant." On the basis of Section 2(f) alone, the application should be allowed.

Applicant's Incontestable Registration of WEB.COM as a Standard Character Mark

As previously discussed by both Applicant and the Examining Attorney, Applicant is the owner of U.S. Registration No. 3,666,813 on the Principal Register for the standard character mark WEB.COM. The Trademark Office issued a Notice of Acknowledgement under Section 15 for that registration on September 8, 2014. *See* Exhibit A hereto. The Examining Attorney states, "the fact that applicant may have registered some services previously does not preclude the mark being generic in this case because these prior registrations are not incontestable so, in a new application such as the instant one, the application is still subject to being refused." With the acknowledgement of Applicant's Section 15 declaration for its standard character mark WEB.COM, this calculus changes, and the present application cannot be refused.

Under Trademark Rule 2.41(b), 37 C.F.R. §2.41(b), ownership by an applicant of one or more registrations of the same mark on the Principal Register is prima facie evidence of distinctiveness. In a claim of acquired distinctiveness based on a prior registration, the Examining Attorney must determine whether the goods or services named in the application are sufficiently similar to the goods and services named in the prior registration. Applicant maintains that the services listed in the present application are all related to the services in its incontestable prior registration and the Examining Attorney has not argued otherwise. However, to preclude any potential argument on this point, Applicant has in connection with this Request for Reconsideration deleted Classes 35 and 45, and has narrowed Class 42 to correspond with specific Class 42 services in its incontestable registration. This correspondence is shown below:

Registration No. 3,666,813: Class 42	Application Serial No. 85,667,978: Class 42
Computer site design; . . . Design and maintenance of computer sites for third parties; Design of home pages; Design, creation, hosting and maintenance of internet sites for third parties; . . .	Computer services, namely, designing, implementing and managing web sites for others; . . . Computer web site consultation, namely, computer services, namely, designing and implementing web sites for others . . .
Hosting the web sites of others on a computer server for a global computer network . . .	Hosting the web sites of others on a computer server for a global computer network . . .

With this narrowing of services in the present application, Applicant’s claim of distinctiveness under 37 C.F.R. §2.41(b) therefore rests squarely on an incontestable registration in which a determination was long ago made, on the basis of significant evidence, that the mark WEB.COM in standard characters had acquired distinctiveness for the services listed in that registration.¹

Additional Evidence Further Demonstrates Consumers’ Association of the Mark with Applicant

The record is already replete with proof of acquired distinctiveness. As set forth in Paragraph 3 of the First McClure Declaration² and demonstrated by Applicant’s U.S. Registration No. 2,521,314 for the mark WEB.COM [stylized in “typewriter” format], Applicant has continuously used its WEB.COM trademark since 1996 – **18 years of use as a trademark**. See Exhibit B hereto.

Of particular relevance to the Examining Attorney’s assertion that there is no proof of market recognition of Applicant’s mark are the page view statistics discussed in Paragraph 9 of the First McClure Declaration and evidenced by the annexes thereto:

- Between July 2011 and September 2013, the website was visited a total of 33,777,081 times by 21,441,694 unique visitors, accounting for 65,729,556 total page views.
- During this time period, the website was visited on average 1,251,033 times per month by 1,113,371 unique visitors, which amounted to an average of 2,434,428 total page views per month.

¹ The Examining Attorney discounted the “very minor stylization” and color claim of the mark in the present application as distinctive elements. For the purposes of Section 2(f), Applicant will accept that its stylized color mark in the present application creates the same commercial impression as its registered standard character mark, and therefore meets the “same mark” requirement of the rule.

² Declaration of Matt McClure submitted in Applicant’s November 14, 2013 Response to Office Action.

These statistics directly refute the Examining Attorney's contention that there is no proof that consumers seeking web services would and do recognize the WEB.COM mark as referring only to Applicant. Applicant's millions of customers and potential customers are looking at Applicant's web site millions of times per month. The only rational conclusion is that these millions of customers and potential customers understand that the WEB.COM mark prominently displayed on Applicant's website represents a specific source for the offered services.

Moreover, as discussed in the Second McClure Declaration,³ a recent survey conducted by Applicant demonstrated that a whopping 90% of owners or managers of larger businesses (21+ employees) were specifically aware of WEB.COM. A statistically significant 5% of all respondents named WEB.COM, without any prompting, as a national company that builds websites or helps to market businesses on the Internet. Respondents at companies with 11-20 employees showed an even higher awareness of the WEB.COM trademark – 8%.

The survey respondents also had excellent recall of where they have been exposed to WEB.COM advertising. 29% recalled seeing a TV advertisement for Web.com. 15% recalled hearing a radio advertisement for Web.com. 27% recalled seeing an online advertisement for Web.com. 20% were aware that Web.com is a PGA Golf Tour sponsor.

When given the opportunity to comment about their feelings for WEB.COM, survey respondents demonstrated their high regard for the quality of services associated with the mark. The survey also showed that among business owners, Web.com is rated highest for the attributes of:

- “is a company that provides services that meet my needs”
- “is a company that assists with search engine marketing or paid search”
- “is best suited for small business owners”

The survey also showed that among managers, Web.com is rated highest for the following attributes:

- “easy to work with” and
- “is a company that provides quality services”

In sum, a mountain of evidence lies before the Examining Attorney that WEB.COM has acquired secondary meaning and significant market recognition. The refusal under Section 2(f) should therefore be withdrawn.

Descriptiveness Refusal under Section 2(e)(1)

An independent basis for registrability is that Applicant's mark, in the format presented, is inherently distinctive. The Examining Attorney has refused registration of WEB.COM on the grounds that it “is merely descriptive of a feature, use and purpose of applicant's services.” The

³ Declaration of Matt McClure submitted herewith as Exhibit C.

refusal is premised upon ignoring the stylized mark as composite whole and over-generalizing the identification of services. The law however, requires considering the mark in its entirety and addressing the services actually recited in the application. Under the proper legal analysis, the mark is not descriptive of the recited services.

First, the Examining Attorney fails to address the commercial impression of WEB.COM as a composite mark. Most notably here, the .COM portion of the mark cannot be wholly ignored. TMEP §1209.03(m) instructs:

Thus, when examining domain-name marks, it is important to evaluate the commercial impression of the mark as a whole to determine whether the gTLD may be capable of source-indicating significance, and whether the composite mark conveys any distinctive source-identifying impression apart from its individual components. The examining attorney must introduce evidence as to the significance of the individual components, including the gTLD, but must also consider the significance of the composite to determine whether the addition of a gTLD has resulted in a mark that conveys a source-identifying impression. (emphasis added.)

See also Estate of Beckwith, Inc. v. Commissioner of Patents, 252 U.S. 538 (1920), in which the Supreme Court stated: “The commercial impression of a trademark is derived from it as a whole, not from its elements separated and considered in detail. For this reason it should be considered in its entirety.” *Id.* at 545-46. Here, the Examining Attorney failed to consider the significance of the stylized composite.

Moreover, it is not appropriate under emerging practice to discount entirely the TLD component of a mark. The Examining Attorney states, “The addition of .com in applicant’s mark has no source-identifying significance and does not alter the highly descriptive nature of the mark” This view is based on increasingly outdated guidelines that were formulated when the Internet landscape comprised a very small number of TLDs. Since the adoption of these guidelines, the Internet has been expanding to include hundreds of new TLDs. The Trademark Office has, in fact, drafted new guidelines for the registration of marks consisting solely of TLDs. *See* TMEP §1215.02(d). Thus, the Trademark Office itself recognizes that the exponential increase in available TLDs means that TLDs have greater source-identifying capabilities. Accordingly, more so than in the past, consumers will view WEB.COM as indicating a single source for the services at issue.

Second, the mark is web.com, not “merely WEB and a TLD” as the Examining Attorney states. Without any explanation, the Examining Attorney ignores the colors and stylization of Applicant’s mark. The stylization and color provide a fanciful impression, one that implies both friendliness and security. The red dot in the middle of the mark conveys balance and, like a rivet, the confidence that the Applicant is trustworthy. The Examining Attorney states, “Note also that the very minor stylization and color claim are not distinctive enough to alter the descriptive nature of the mark.” On what basis was this conclusion made? The record offers no authority or discussion concerning comparable marks having similar stylization and color. Absent any authority or evidence, this conclusion is merely conclusory and carries no weight. Given proper

and fair consideration, there can be no doubt that the stylization and colors enhance the distinctiveness of Applicant's mark.

A proper analysis also requires consideration of the services claimed. The Examining Attorney mischaracterizes the recited services simply as "general web service." Here again, the Examining Attorney ignores what is stated in the application. The services, as amended, are:

- computer services, namely, designing, implementing and managing web sites for others
- Computer web site consultation, namely, computer services, namely, designing and implementing web sites for others
- hosting the web sites of others on a computer server for a global computer network

Under a proper analysis, the Examining Attorney must consider whether the mark WEB.COM describes a feature, use, or purpose of any of these services.

WEB.COM does not describe any *feature* of any of these recited services.

WEB.COM does not describe any *use* of any of these recited services.

WEB.COM does not describe any *purpose* of any of these recited services.

Accordingly, taken as a whole, the stylized color mark WEB.COM is suggestive of the services claimed. The refusal under Section 2(e)(1) should therefore be withdrawn.

Exhibit A

From: TMOOfficialNotices@USPTO.GOV
Sent: Monday, September 8, 2014 11:01 PM
To: uspto@socalip.com
Cc: ssereboff@socalip.com ; ckopitzke@socalip.com ; nabeloe@socalip.com
Subject: Official USPTO Notice of Acceptance/Acknowledgement Sections 8 and 15: U.S. Trademark RN 3666813: WEB.COM: Docket/Reference No. W006-T05427

Serial Number: 78767491
Registration Number: 3666813
Registration Date: Aug 11, 2009
Mark: WEB.COM
Owner: WEB.COM GROUP, INC.

Sep 8, 2014

NOTICE OF ACCEPTANCE UNDER SECTION 8

The declaration of use or excusable nonuse filed for the above-identified registration meets the requirements of Section 8 of the Trademark Act, 15 U.S.C. §1058. **The Section 8 declaration is accepted.**

NOTICE OF ACKNOWLEDGEMENT UNDER SECTION 15

The declaration of incontestability filed for the above-identified registration meets the requirements of Section 15 of the Trademark Act, 15 U.S.C. §1065. **The Section 15 declaration is acknowledged.**

The registration will remain in force for the class(es) listed below for the remainder of the ten-year period, calculated from the registration date, unless canceled by an order of the Commissioner for Trademarks or a Federal Court.

Class(es):
042

TRADEMARK SPECIALIST
POST-REGISTRATION DIVISION
571-272-9500

REQUIREMENTS FOR MAINTAINING REGISTRATION

WARNING: Your registration will be canceled if you do not file the documents below during the specified time periods.

Requirements in the First Ten Years

What and When to File: You must file a declaration of use (or excusable nonuse) **and** an application for renewal between the 9th and 10th years after the registration date. See 15 U.S.C. §§1058, 1059.

Requirements in Successive Ten-Year Periods

What and When to File: You must file a declaration of use (or excusable nonuse) **and** an application for renewal between

every 9th and 10th-year period, calculated from the registration date. See 15 U.S.C. §§1058, 1059.

Grace Period Filings

The above documents will be considered as timely if filed within six months after the deadlines listed above with the payment of an additional fee.

*****The USPTO WILL NOT SEND ANY FURTHER NOTICE OR REMINDER OF THESE REQUIREMENTS. THE REGISTRANT SHOULD CONTACT THE USPTO ONE YEAR BEFORE THE EXPIRATION OF THE TIME PERIODS SHOWN ABOVE TO DETERMINE APPROPRIATE REQUIREMENTS AND FEES.*****

To view this notice and other documents for this application on-line, go to <http://tdr.uspto.gov/search.action?sn=78767491>.
NOTE: This notice will only be available on-line the next business day after receipt of this e-mail.

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Mark: WEB.COM

web . com

US Serial Number: 75463326

Application Filing Date: Apr. 03, 1998

US Registration Number: 2521314

Registration Date: Dec. 18, 2000

Register: Supplemental

Mark Type: Service Mark

Amended to Principal Register: No

Date Amended to Current Register: Apr. 07, 2000

Register:

Register:

Status: The registration has been renewed.

Status Date: Feb. 13, 2012

Mark Information

Mark Literal Elements: WEB.COM

Standard Character Claim: No

Mark Drawing Type: 5 - AN ILLUSTRATION DRAWING WITH WORD(S) /LETTER(S)/ NUMBER(S) INSTYLIZED FOR

Color(s) Claimed: Color is not claimed as a feature of the mark.

Related Properties Information

Claimed Ownership of US Registrations: [1645075](#), [1645076](#), [2118400](#)

Registrations:

Goods and Services

Note:

The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis ((...)) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and

- Asterisks *..* identify additional (new) wording in the goods/services.

For: DISSEMINATION OF ADVERTISING FOR OTHERS VIA AN ON-LINE ELECTRONIC COMMUNIC
COMPUTERIZED ON-LINE RETAIL SHOPPING SERVICES FEATURING ART AND COLLECTIBLE
BOOKS AND MAGAZINES, CLOTHING, CONSUMER ELECTRONICS, FOOD AND BEVERAGES,
FLOWERS AND GIFTS, HOME AND GARDEN PRODUCTS, VIDEO AND MUSIC RECORDINGS
EQUIPMENT, OFFICE FURNITURE AND SUPPLIES, PERSONAL CARE AND BEAUTY PRODUCTS]

International Class(es): 035 - Primary Class

U.S Class(es): 100, 101, 102

Class Status: ACTIVE

Basis: 1(a)

First Use: Jul. 1996

Use in Commerce: Jul. 1996

Basis Information (Case Level)

Filed Use: Yes

Currently Use: Yes

Filed ITU: No

Currently ITU: No

Filed 44D: No

Currently 44D: No

Filed 44E: No

Currently 44E: No

Filed 66A: No

Currently 66A: No

Filed No Basis: No

Currently No Basis: No

Current Owner(s) Information

Owner Name: WEB.COM GROUP, INC.

Owner Address: 12808 GRAN BAY PARKWAY WEST
JACKSONVILLE, FLORIDA 32258
UNITED STATES

Legal Entity Type: CORPORATION

State or Country Where Organized: DELAWARE

Attorney/Correspondence Information

Attorney of Record

Attorney Name: Brian J. Winterfeldt, Esq.

Attorney Primary Email Address: bjwtmteam@kattenlaw.com

Attorney Email Authorized: Yes

Correspondent

Correspondent Name/Address: Brian J. Winterfeldt, Esq.

Katten Muchin Rosenman LLP
2900 K Street NW - North Tower Ste. 200
Washington, DISTRICT OF COLUMBIA 20007
UNITED STATES

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bjwtmteam@kattenlaw.com
christopher.casavale@kattenlaw.com
debra.hughes@kattenlaw.com

Correspondent e-mail Yes
 Authorized:

Domestic Representative - Not Found

Prosecution History

Date	Description	Proceeding Number
Jul. 19, 2013	ATTORNEY REVOKED AND/OR APPOINTED	
Jul. 19, 2013	TEAS REVOKE/APPOINT ATTORNEY RECEIVED	
Jul. 17, 2013	TEAS CHANGE OF CORRESPONDENCE RECEIVED	
Nov. 14, 2012	AMENDMENT UNDER SECTION 7 - ISSUED	67603
Nov. 13, 2012	CASE ASSIGNED TO POST REGISTRATION PARALEGAL	67603
Nov. 12, 2012	TEAS SECTION 7 REQUEST RECEIVED	
Feb. 13, 2012	NOTICE OF ACCEPTANCE OF SEC. 8 & 9 - E-MAILED	
Feb. 13, 2012	REGISTERED AND RENEWED (FIRST RENEWAL - 10 YRS)	75461
Feb. 13, 2012	REGISTERED - SEC. 8 (10-YR) ACCEPTED/SEC. 9 GRANTED	75461
Feb. 11, 2012	CASE ASSIGNED TO POST REGISTRATION PARALEGAL	75461
Feb. 01, 2012	ASSIGNMENT OF OWNERSHIP NOT UPDATED AUTOMATICALLY	
Dec. 15, 2011	TEAS SECTION 8 & 9 RECEIVED	
Nov. 09, 2011	ASSIGNMENT OF OWNERSHIP NOT UPDATED AUTOMATICALLY	
Apr. 12, 2010	ATTORNEY REVOKED AND/OR APPOINTED	
Apr. 12, 2010	TEAS REVOKE/APPOINT ATTORNEY RECEIVED	
May 27, 2009	AUTOMATIC UPDATE OF ASSIGNMENT OF OWNERSHIP	
Jul. 21, 2008	REGISTERED - SEC. 8 (6-YR) ACCEPTED	61619
Jun. 25, 2008	AUTOMATIC UPDATE OF ASSIGNMENT OF OWNERSHIP	
Jun. 17, 2008	TEAS SECTION 8 RECEIVED	
Mar. 08, 2007	ATTORNEY REVOKED AND/OR APPOINTED	
Mar. 08, 2007	TEAS REVOKE/APPOINT ATTORNEY RECEIVED	
Jan. 12, 2007	CASE FILE IN TICRS	
Dec. 20, 2006	AUTOMATIC UPDATE OF ASSIGNMENT OF OWNERSHIP	
Dec. 18, 2001	REGISTERED-SUPPLEMENTAL REGISTER	
Feb. 05, 2001	APPROVED FOR REGISTRATION SUPPLEMENTAL REGISTER	
Feb. 05, 2001	ASSIGNED TO EXAMINER	77655
Jan. 30, 2001	ASSIGNED TO EXAMINER	69930

Jan. 30, 2001	ASSIGNED TO EXAMINER	77655
Dec. 20, 2000	PREVIOUS ALLOWANCE COUNT WITHDRAWN	
Oct. 20, 2000	APPROVED FOR REGISTRATION SUPPLEMENTAL REGISTER	
Jun. 13, 2000	ASSIGNED TO EXAMINER	77655
Apr. 07, 2000	CORRESPONDENCE RECEIVED IN LAW OFFICE	
Feb. 01, 2000	NON-FINAL ACTION MAILED	
May 14, 1999	CORRESPONDENCE RECEIVED IN LAW OFFICE	
Jan. 25, 1999	CORRESPONDENCE RECEIVED IN LAW OFFICE	
Nov. 02, 1998	UNRESPONSIVE/DUPLICATE PAPER RECEIVED	
Nov. 25, 1998	NON-FINAL ACTION MAILED	
Nov. 17, 1998	ASSIGNED TO EXAMINER	69930
Oct. 28, 1998	ASSIGNED TO EXAMINER	72148

Maintenance Filings or Post Registration Information

Affidavit of Continued Use: Section 8 - Accepted

Renewal Date: Dec. 18, 2011

Change in Registration: Yes

Amendment to a Registration/Renewal Certificate: In the statement, Columns 1 & 2, Class 35 should read as follows: DISSEMINATION OF ADVERT LINE ELECTRONIC COMMUNICATIONS NETWORK, all other services in Class 35 should be del

TM Staff and Location Information

TM Staff Information - None

File Location

Current Location: Not Found

Date in Location: Dec. 27, 2011

Assignment Abstract Of Title Information

Summary

Total Assignments: 7

Registrant: WEB SERVICE

Assignment 1 of 7

Assignment 2 of 7

Assignment 3 of 7

Assignment 4 of 7

Assignment 5 of 7

Assignment 6 of 7

Assignment 7 of 7

Proceedings - None recorded

Exhibit C

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Web.com Group, Inc.

Application no.: 85667978

Filed: July 3, 2012

Mark: WEB.COM (stylized)

DECLARATION OF MATT MCCLURE

I, Matt McClure, hereby declare that:

1. I am the same Matt McClure that made a declaration previously in this case, dated November 6, 2013.
2. The background facts about me have not changed since I made the previous declaration.
3. As before, I am authorized to make this declaration on behalf of applicant Web.com Group, Inc. ("Web.com") in support of its response to the Office Action issued on March 31, 2014 in the above identified application.
4. In early July 2014, an online survey was conducted on behalf of Web.com. The respondents to the survey were 474 small business owners or managers.
5. Among the survey respondents, 5% overall demonstrated awareness of the WEB.COM brand. Of these, respondents at companies with 11-20 employees showed the highest awareness of our brand – 8%. This was measured in response to the question, "Thinking of national companies that build websites or help market businesses on the Internet, what companies come to mind?"
6. When then asked if they specifically were aware of WEB.COM, a whopping 90% of larger businesses (21+ employees) owners or managers responded affirmatively. Overall, the rate of such aided awareness was 68%. Among participants wanting a website, aided awareness of our WEB.COM brand was 76%.
7. The survey also asked the respondents where they have been exposed to our advertising. Of those who were aware of Web.com:
 - a. 29% recalled seeing a TV advertisement for Web.com.
 - b. 15% recalled hearing a radio advertisement for Web.com.
 - c. 27% recalled seeing an online advertisement for Web.com.
 - d. 20% were aware that Web.com is a PGA Golf Tour sponsor.

8. The survey was highly accurate -- all of the statistics were reported at a 95% confidence level or higher.
9. The survey also showed that among business owners, Web.com is rated highest for the attributes of: "is a company that provides services that meet my needs," "is a company that assists with search engine marketing or paid search," and "is best suited for small business owners."
10. The survey also showed that among managers, Web.com is rated highest for the attributes of: "easy to work with" and "is a company that provides quality services."
11. Some relevant characteristics of the survey respondents:
 - a. Currently have/manage a website for business reasons or would want one in the next 12 months.
 - b. 25% businesses with 1 employee.
 - c. 36% businesses with 2-10 employees.
 - d. 22% businesses with 11-20 employees.
12. The survey contained a total of 27 questions and took about 10 - 12 minutes to complete.
13. The respondents were almost evenly split between women and men: 54%/46%.

14. The ages ranged as follows:

Age	Proportion of Respondents
< 35	38%
35-44	31%
45-54	29%
55-64	2%
65+	< 1%

15. The education ranged as follows:

Education	Proportion of Respondents
High School	10%
Some college	24%
2-year college degree	12%
4-year college degree	36%
Post-graduate study or degree	17%

16. The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001, and that such willful

false statements and the like may jeopardize the validity of the application or document or any resulting registration, declares that he is properly authorized to execute this declaration on behalf of the Applicant; and all statements made of his own knowledge are true and all statements made on information and belief are believed to be true.

WEB.COM GROUP, INC.

Date: September 30, 2014

By: /s/ Matt McClure
Matt McClure, Chief Legal
Officer and Secretary