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Subject: U.S. TRADEMARK APPLICATION NO. 85747739 - MOBILE SEARCH - N/A - Request for
Reconsideration Denied - Return to TTAB

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

U.S. APPLICATION SERIAL NO. 85747739

MARK: MOBILE SEARCH



CORRESPONDENT ADDRESS:

INTERNET PROMISE GROUP LLC

2390 CRENSHAW BLVD STE 239

TORRANCE, CA 90501-3300

GENERAL TRADEMARK INFORMATION:

<http://www.uspto.gov/trademarks/index.jsp>

APPLICANT: Internet Promise Group LLC

CORRESPONDENT'S REFERENCE/DOCKET NO:

N/A

CORRESPONDENT E-MAIL ADDRESS:

chand@InternetPromise.com

REQUEST FOR RECONSIDERATION DENIED

ISSUE/MAILING DATE: 1/27/2014

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 refusal made final in the Office action dated 6/29/2013 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.

The applicant should note the following:

Registration is refused because the applied-for mark merely describes the purpose and function of applicant's goods. Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1); see TMEP §§1209.01(b), 1209.03 *et seq.*

A mark is merely descriptive if it describes an ingredient, quality, characteristic, function, feature, purpose, or use of an applicant's goods. TMEP §1209.01(b); see, e.g., *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, ___ F.3d ___, 103 USPQ2d 1753, 1755 (Fed. Cir. 2012) (quoting *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 1173, 71 USPQ2d 1370, 1371 (Fed. Cir. 2004)); *In re Steelbuilding.com*, 415 F.3d 1293, 1297, 75 USPQ2d 1420, 1421 (Fed. Cir. 2005) (citing *Estate of P.D. Beckwith, Inc. v. Comm'r of Patents*, 252 U.S. 538, 543 (1920)).

The determination of whether a mark is merely descriptive is made in relation to an applicant's goods, **not in the abstract**. *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, ___ F.3d ___, 103 USPQ2d 1753, 1757 (Fed. Cir. 2012); *In re The Chamber of Commerce of the U.S.*, 675 F.3d 1297, 1300, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012); TMEP §1209.01(b); see, e.g., *In re Polo Int'l Inc.*, 51 USPQ2d 1061, 1062-63 (TTAB 1999) (finding DOC in DOC-CONTROL would refer to the "documents" managed by applicant's software rather than the term "doctor" shown in a dictionary definition); *In re Digital Research Inc.*, 4 USPQ2d 1242, 1243-44 (TTAB 1987) (finding CONCURRENT PC-DOS and CONCURRENT DOS merely descriptive of "computer programs recorded on disk" where the relevant trade used the denomination "concurrent" as a descriptor of a particular type of operating system).

“Whether consumers could guess what the product [or service] is from consideration of the mark alone is not the test.” *In re Am. Greetings Corp.*, 226 USPQ 365, 366 (TTAB 1985).

“A mark may be merely descriptive even if it does not describe the ‘full scope and extent’ of the applicant’s goods or services.” *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 1173, 71 USPQ2d 1370, 1371 (Fed. Cir. 2004) (citing *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 1346, 57 USPQ2d 1807, 1812 (Fed. Cir. 2001)); TMEP §1209.01(b). It is enough if a mark describes only one significant function, attribute, or property. *In re The Chamber of Commerce of the U.S.*, 675 F.3d 1297, 1300, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012); TMEP §1209.01(b); see *In re Oppedahl & Larson LLP*, 373 F.3d at 1173, 71 USPQ2d at 1371.

Descriptiveness is considered in relation to the relevant goods. **The fact that a term may have different meanings in other contexts is not controlling on the question of descriptiveness.** *In re Chopper Indus.*, 222 USPQ 258, 259 (TTAB 1984); *In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979); TMEP §1209.03(e).

The applicant has argued that “mobile” generally applies to the “items that are mobile” and that “search” is generic in an unspecified manner and does not imply use with a mobile device. The examining attorney has already found this argument unpersuasive and provided evidence and arguments in support of this position. Further, in the response to the final Office action, the applicant states for the record that the mark cannot be merely descriptive, “because it does not convey an ingredient, quality, characteristic, function, feature, purpose, or use of an applicant’s goods and/or services and therefore is not merely descriptive.”

The Request for Reconsideration also includes amendments to the identification: the applicant has voluntarily amended its identification of goods. This amendment is unacceptable. As of the issuance of the final Office action, the identification of goods was acceptable and amendments thereto may only be made to narrow scope of the goods for which protection is sought, or to clarify indefinite references. However, the proposed amendment seeks to broaden the protection from “computer software in smart phone” to “computer software application for use in computing and communication devices,” effectively broadening protection from “smart phones” to “personal computers, personal digital assistants, e-book readers, tablet PCs, laptops, pagers, various GPS devices and more. Further, the amendment seeks to broaden the function by amending from “a hybrid **search** interface” to “a hybrid interface.”

TMEP § 1402.07(e), states the following in relevant part:

Once an applicant amends the identification of goods and/or services in a manner that is acceptable to the examining attorney, the amendment replaces all previous identifications and restricts the scope of goods/services to that of the amended language. Further amendments that would add to or expand the scope of the recited goods or services, as amended, will not be permitted. *In re Swen Sonic Corp.*, 21 USPQ2d 1794 (TTAB 1991); *In re M.V Et Associes*, 21 USPQ2d 1628 (Comm'r Pats. 1991). This includes amendments to the identification submitted in an amendment to allege use, a statement of use, or a request for an extension of time to file a statement of use. 37 C.F.R. §§2.88(i)(2) and 2.89(f).

The examining attorney contends that the list of impermissible submission of amendments referenced in Section 1402.07(e) tacitly includes amendments to identifications that are submitted in Requests for Reconsideration. *See also*, TMEP § 1402.06(a).

In other words, amendments to the identification that go beyond the scope of a definite identification already made of record are impermissible and therefore do not raise a new issue.

Neither applicant's proposed amendment of the identification, nor the Applicant's response to the final Office action raise new issues: the applicant's interpretation of the meaning or lack of meaning to be attributed to the asserted mark ignores its own use of the terms to describe its own goods, as well as the dictionary and Internet evidence made of record in support of the refusal. Moreover, the applicant has failed to submit evidence or case law to support its contention that the words are not descriptive in the context of the goods for which it seeks protection.

Accordingly, the request is denied.

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).

/Ronald E. Aikens/

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