

## Request for Reconsideration after Final Action

**The table below presents the data as entered.**

Input Field	Entered
<b>SERIAL NUMBER</b>	86154770
<b>LAW OFFICE ASSIGNED</b>	LAW OFFICE 110
<b>MARK SECTION (no change)</b>	
<b>GOODS AND/OR SERVICES SECTION (current)</b>	
<b>INTERNATIONAL CLASS</b>	038
<b>DESCRIPTION</b>	
Telecommunications consultation; providing information about telecommunications; telecommunications benchmarking services for telecommunications; telecommunications benchmarking services, namely, providing information relating to the performance of telecommunications equipment providers, wireless tower operators and mobile device manufacturers; telecommunications benchmarking services, namely, providing wireless telecommunications information relating to network coverage and performance; providing a website featuring information in the fields of telecommunications equipment providers, wireless tower operators and mobile device industries	
<b>FILING BASIS</b>	Section 1(b)
<b>GOODS AND/OR SERVICES SECTION (proposed)</b>	
<b>INTERNATIONAL CLASS</b>	038
<b>TRACKED TEXT DESCRIPTION</b>	
Telecommunications consultation; providing information about telecommunications; <del>telecommunications benchmarking services for telecommunications</del> ; telecommunications benchmarking services, namely, providing wireless telecommunications information relating to network coverage and performance; <del>telecommunications benchmarking services, namely, providing information relating to the performance of telecommunications equipment providers, wireless tower operators and mobile device manufacturers</del> ; <u>providing an online website that provides data and information in the field of benchmarking, namely providing telecommunication information relating to network performance and coverage of wireless networks; providing information to consumers, businesses, wireless telecommunications providers, telecommunications equipment providers, wireless tower operators, and mobile device manufacturers about the performance and coverage of wireless networks and the performance of mobile devices</u> ; <del>providing a website featuring information in the fields of telecommunications equipment providers, wireless tower operators and mobile device industries</del>	

<b>FINAL DESCRIPTION</b>	
Telecommunications consultation; providing information about telecommunications; telecommunications benchmarking services, namely, providing wireless telecommunications information relating to network coverage and performance; providing an online website that provides data and information in the field of benchmarking, namely providing telecommunication information relating to network performance and coverage of wireless networks; providing information to consumers, businesses, wireless telecommunications providers, telecommunications equipment providers, wireless tower operators, and mobile device manufacturers about the performance and coverage of wireless networks and the performance of mobile devices	
<b>FILING BASIS</b>	Section 1(b)
<b>ADDITIONAL STATEMENTS SECTION</b>	
<b>MISCELLANEOUS STATEMENT</b>	Please see response text attached.
<b>MISCELLANEOUS FILE NAME(S)</b>	
<b>ORIGINAL PDF FILE</b>	<a href="#">mis-66192178162-20150501174325356494 . ROOTMETRICS Cl. 38 OAR.pdf</a>
<b>CONVERTED PDF FILE(S)</b> (3 pages)	<a href="#">\\TICRS\EXPORT16\IMAGEOUT16\861\547\86154770\xml7\RFR0002.JPG</a>
	<a href="#">\\TICRS\EXPORT16\IMAGEOUT16\861\547\86154770\xml7\RFR0003.JPG</a>
	<a href="#">\\TICRS\EXPORT16\IMAGEOUT16\861\547\86154770\xml7\RFR0004.JPG</a>
<b>SIGNATURE SECTION</b>	
<b>RESPONSE SIGNATURE</b>	/Alexander Montgomery/
<b>SIGNATORY'S NAME</b>	Alexander M. Montgomery
<b>SIGNATORY'S POSITION</b>	Associate Attorney, Perkins Coie LLP, Washington State Bar Member
<b>DATE SIGNED</b>	05/01/2015
<b>AUTHORIZED SIGNATORY</b>	YES
<b>CONCURRENT APPEAL NOTICE FILED</b>	YES
<b>FILING INFORMATION SECTION</b>	
<b>SUBMIT DATE</b>	Fri May 01 17:54:10 EDT 2015
<b>TEAS STAMP</b>	USPTO/RFR-66.192.178.162-20150501175410930346-86154770-530dcdffa927025dfe82264a33f7ca57db88de297a2c050879774941599221534-N/A-N/A-20150501174325356494

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

Application serial no. **86154770** has been amended as follows:

### **CLASSIFICATION AND LISTING OF GOODS/SERVICES**

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

**Current:** Class 038 for Telecommunications consultation; providing information about telecommunications; telecommunications benchmarking services for telecommunications; telecommunications benchmarking services, namely, providing information relating to the performance of telecommunications equipment providers, wireless tower operators and mobile device manufacturers; telecommunications benchmarking services, namely, providing wireless telecommunications information relating to network coverage and performance; providing a website featuring information in the fields of telecommunications equipment providers, wireless tower operators and mobile device industries

Original Filing Basis:

**Filing Basis: Section 1(b), Intent to Use:** The applicant has had a bona fide intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the identified goods and/or services as of the filing date of the application. (15 U.S.C. Section 1051(b)).

**Proposed:**

**Tracked Text Description:** Telecommunications consultation; providing information about telecommunications; ~~telecommunications benchmarking services for telecommunications;~~ telecommunications benchmarking services, namely, providing wireless telecommunications information relating to network coverage and performance; ~~telecommunications benchmarking services, namely, providing information relating to the performance of telecommunications equipment providers, wireless tower operators and mobile device manufacturers;~~ providing an online website that provides data and information in the field of benchmarking, namely providing telecommunication information relating to network performance and coverage of wireless networks; providing information to consumers, businesses, wireless telecommunications providers, telecommunications equipment providers, wireless tower operators, and mobile device manufacturers about the performance and coverage of wireless networks and the performance of mobile devices; ~~providing a website featuring information in the fields of telecommunications equipment providers, wireless tower operators and mobile device industries~~

Class 038 for Telecommunications consultation; providing information about telecommunications; telecommunications benchmarking services, namely, providing wireless telecommunications information relating to network coverage and performance; providing an online website that provides data and information in the field of benchmarking, namely providing telecommunication information relating to network performance and coverage of wireless networks; providing information to consumers, businesses, wireless telecommunications providers, telecommunications equipment providers, wireless tower operators, and mobile device manufacturers about the performance and coverage of wireless networks and the performance of mobile devices

**Filing Basis: Section 1(b), Intent to Use:** The applicant has a bona fide intention to use or use through

the applicant's related company or licensee the mark in commerce on or in connection with the identified goods and/or services as of the filing date of the application. (15 U.S.C. Section 1051(b)).

## **ADDITIONAL STATEMENTS**

### **Miscellaneous Statement**

Please see response text attached.

### **Original PDF file:**

[mis-66192178162-20150501174325356494 . ROOTMETRICS Cl. 38 OAR.pdf](#)

### **Converted PDF file(s) ( 3 pages)**

[Miscellaneous File1](#)

[Miscellaneous File2](#)

[Miscellaneous File3](#)

## **SIGNATURE(S)**

### **Request for Reconsideration Signature**

Signature: /Alexander Montgomery/ Date: 05/01/2015

Signatory's Name: Alexander M. Montgomery

Signatory's Position: Associate Attorney, Perkins Coie LLP, Washington State Bar Member

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: 86154770

Internet Transmission Date: Fri May 01 17:54:10 EDT 2015

TEAS Stamp: USPTO/RFR-66.192.178.162-201505011754109

30346-86154770-530dcdffa927025dfe82264a3

3f7ca57db88de297a2c050879774941599221534

-N/A-N/A-20150501174325356494

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant: Root Wireless, Inc.	LAW OFFICE 110
Serial No.: 86/154,770	
Filed: December 30, 2013	Examining Attorney: Ellen J.G. Perkins
Mark: ROOTMETRICS	
Class: 38	RESPONSE TO FINAL OFFICE ACTION

This correspondence ("Response") is filed in response to the Final Office Action issued on November 1, 2014 ("Action") refusing registration of the ROOTMETRICS trademark ("Mark") as set forth in U.S. Application No. 86/154,770 ("Application") by Root Wireless, Inc. ("Applicant"). In the Action, the Examining Attorney requested that Applicant further clarify its description of services.

Applicant has responded to the Examining Attorney's inquiries and requests and has amended its Application as set forth in this Response. Applicant respectfully requests that its amended Application be approved for publication.

**I. Description of Services**

At the request of the Examining Attorney, Applicant hereby amends its description in Class 38 to clarify the nature of Applicant's services. Additions are **bolded** below; items requested to be deleted and moved to Applicant's co-pending applications specified below are in *italicized-strikethrough*.

Class 38: Telecommunications consultation; providing information about telecommunications; ~~telecommunications benchmarking services for telecommunications; telecommunications benchmarking services, namely, providing information relating to the performance of telecommunications equipment providers, wireless tower operators and mobile device manufacturers;~~ telecommunications benchmarking services, namely, providing wireless telecommunications information relating to network coverage and performance; ~~providing a website featuring information in the fields of telecommunications equipment providers, wireless tower operators and mobile device industries~~

**II. Discussion**

Transfer of Services to Companion Application Pursuant to T.M.E.P. §1402.08

The Examining Attorney requests that Applicant clarify and reclassify the following items in Class 38:

Providing a website featuring **business** information in the fields of telecommunications equipment providers, wireless tower operators and mobile device industries; telecommunications benchmarking services for telecommunications **namely \_\_\_\_\_ (applicant must indicate the specific services being offered, i.e. providing business information and business data analysis)** in International Class 35.

Applicant accepts the Examining Attorney's proposal to reclassify the above items in Class 35 with the following clarifying amendments:

*Providing a website featuring information in the fields of telecommunications equipment providers, wireless tower operators and mobile device industries **for consumers, businesses, government, and media**; telecommunications benchmarking services for telecommunications, **namely providing business and consumer information and business and consumer data analysis**;*

Together, the two amended items above should read as follows:

Class 35: Providing a website featuring information in the fields of telecommunications equipment providers, wireless tower operators and mobile device industries for consumers, businesses, government, and media; telecommunications benchmarking services for telecommunications, namely providing business and consumer information and business and consumer data analysis

In accordance with the Examining Attorney's request, Applicant respectfully requests that these items as amended by the Applicant be moved from the Class 38 description above to Applicant's co-pending application for the ROOTMETRICS mark in Class 35 (Ser. No. 86/154,762) pursuant to T.M.E.P. § 1402.08.

Transfer of Services From Companion Application Pursuant to TMEP §1402.08

In the Final Office Action issued on November 2, 2014 for Applicant's co-pending application for the ROOTMETRICS mark in Class 35 (Ser. No. 86/154,762), the Examining Attorney requested that Applicant reclassify the following item in Class 38:

providing an online website that provides data and information in the field of benchmarking, namely providing telecommunication information relating to network performance of wireless networks; providing information to consumers, telecommunications equipment providers and wireless tower operators about the performance of wireless networks;

Applicant accepts the Examining Attorney's proposal to reclassify the above items in Class 38 with the following clarifying amendments:

providing an online website that provides data and information in the field of benchmarking, namely providing telecommunication information relating to network performance **and coverage** of wireless networks; providing information to consumers, **businesses, wireless telecommunications providers**, telecommunications equipment providers, ~~and~~ wireless tower operators, **and mobile device manufacturers** about the performance **and coverage** of wireless networks **and the performance of mobile devices**;

In accordance with the Examining Attorney's request, Applicant respectfully requests that these items as amended by the Applicant be moved from Applicant's co-pending application for the ROOTMETRICS mark in Class 35 (Ser. No. 86/154,762) to Applicant's Application for the ROOTMETRICS mark in Class 38 (Ser. No. 86/154,770) pursuant to T.M.E.P. § 1402.08.

#### Final Description of Applicant's Services in Class 38

After moving and amending the items noted above to and from Applicant's co-pending application for the ROOTMETRICS mark in Class 35 (Ser. No. 86/154,762), the final description of services in Class 38 should read as follows:

Class 38: Telecommunications consultation; providing information about telecommunications; telecommunications benchmarking services, namely, providing wireless telecommunications information relating to network coverage and performance; providing an online website that provides data and information in the field of benchmarking, namely providing telecommunication information relating to network performance and coverage of wireless networks; providing information to consumers, businesses, wireless telecommunications providers, telecommunications equipment providers, wireless tower operators, and mobile device manufacturers about the performance and coverage of wireless networks and the performance of mobile devices;

### **III. Conclusion**

The Applicant believes all of the proposed amendments in this Reponse clarify and narrow - and do not broaden - the covered services and that Applicant has addressed all outstanding issues raised by the Examiner in the Office Action. The Applicant therefore respectfully requests that the Application be passed on to publication. Should any questions remain with respect to the above, please contact Jason Howell or Alexander Montgomery.  
DATED: May 1, 2015.