

From: Kenealy, Natalie

Sent: 8/24/2016 4:59:54 PM

To: TTAB EFiling

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Subject: U.S. TRADEMARK APPLICATION NO. 86207408 - PINPOINT - N/A - Request for Reconsideration Denied - Return to TTAB

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Files: 86207408.doc

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

U.S. APPLICATION SERIAL NO. 86207408

MARK: PINPOINT



CORRESPONDENT ADDRESS:

MATTHEW H SWYERS

THE TRADEMARK COMPANY

344 MAPLE AVE W STE 151

VIENNA, VA 22180-5612

GENERAL TRADEMARK INFORMATION:

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

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APPLICANT: TKLABS Inc.

CORRESPONDENT'S REFERENCE/DOCKET NO:

N/A

CORRESPONDENT E-MAIL ADDRESS:

admin@thetrademarkcompany.com

REQUEST FOR RECONSIDERATION DENIED

ISSUE/MAILING DATE: 8/24/2016

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. §2.63(b)(3); TMEP §§715.03(a)(ii)(B), 715.04(a). The following requirement(s) and/or refusal(s) made final in the Office action dated February 3, 2016, are maintained and continue to be final: the mark differs on the drawing and specimen and the specimens of record fail to show an association between the applied-for mark and the identified goods. See TMEP §§715.03(a)(ii)(B), 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.

Specifically, in the Request for Reconsideration the applicant provided substitute specimens in an effort to overcome the outstanding specimen refusals. Page 1 of the substitute specimens filed August 2, 2016, is identical to the originally filed specimen and remains unacceptable as previously discussed. Specifically, the mark differs between the specimen and the drawing with respect to this specimen because the specimen is advertising for goods. Page 2 of the substitute specimen also shows a different version of the applied-for mark than that which is shown in the drawing – without the grey areas shown in the drawing of the mark and described in the mark description and without the lines above and below the wording and design. Further, Page 2 is also in the nature of print advertising for goods, which is unacceptable to show use of the applied-for mark in commerce with the identified goods. Trademark Act Sections 1 and 45, 15 U.S.C. §§1051, 1127; 37 C.F.R. §§2.34(a)(1)(iv), 2.56(a); TMEP §§904, 904.07(a). Advertising materials are generally not acceptable as specimens to show use in commerce for goods. See *In re MediaShare Corp.*, 43 USPQ2d 1304, 1307 (TTAB 1997); *In re Schiapparelli Searle*, 26 USPQ2d 1520, 1522 (TTAB 1993); TMEP §904.04(b), (c).

Pages 3 – 4 of the substitute specimens appear to be in the nature of screenshots of a website, where Page 4 includes a drop down menu which indicates “Free Downloads.” Though these specimens do show the areas of grey as shown in the drawing of the mark, they do not show the lines above and below the wording that are shown in the drawing and claimed in the mark description. Thus they are closer to matching the mark as shown in the drawing, but continue to differ from the drawing. Further, these pages are in the nature of web advertising for goods. In limited circumstances websites may be acceptable to show the applied-for mark in use in commerce with goods. Specifically, webpages may be acceptable as specimens for goods when they include a picture or textual description of the goods associated with the mark and the means to order the goods. See *In re Sones*, 590 F.3d at 1286-89, 93 USPQ2d at 1122-24; *In re Azteca Sys., Inc.*, 102 USPQ2d at 1957; TMEP §§904.03(i) *et seq.* In this case, the specimens provided at Pages 3 and 4 do not show the means to order the goods. The applicant has identified goods of “Computer component testing and calibrating equipment; Computer hardware and software sold as a unit for testing of embedded computer systems.” There is nothing on Pages 3 – 4 of the substitute specimen which would enable a consumer to order or purchase these goods through this website. Page 4 includes an image of a drop down menu with the wording FREE DOWNLOADS. It appears that this is an attempt to provide ordering information. However, the applicant's goods do not include downloadable software. Thus, even if this FREE DOWNLOADS information could be construed as a means to purchase downloadable software (which is not conceded), it is not sufficient to provide means for ordering the goods identified in the application of “Computer component testing and calibrating equipment; Computer hardware and software sold as a unit for testing of embedded computer systems,” which do not include downloadable software but are rather directed to equipment and hardware and software sold as a unit. Thus the substitute specimens of record do not overcome

the outstanding specimen refusals which were made final in the February 3, 2016 Office action. The requirement for an acceptable specimen is maintained and continues to be final.

If applicant has already filed a timely notice of appeal with the Trademark Trial and Appeal Board, the Board will be notified to resume the appeal. *See* TMEP §715.04(a).

If no appeal has been filed and time remains in the six-month response period to the final Office action, applicant has the remainder of the response period to (1) comply with and/or overcome any outstanding final requirement(s) and/or refusal(s), and/or (2) file a notice of appeal to the Board. TMEP §715.03(a)(ii)(B); *see* 37 C.F.R. §2.63(b)(1)-(3). The filing of a request for reconsideration does not stay or extend the time for filing an appeal. 37 C.F.R. §2.63(b)(3); *see* TMEP §§715.03, 715.03(a)(ii)(B), (c).

/Natalie L. Kenealy/

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