

From: Moninghoff, Kim

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Subject: U.S. TRADEMARK APPLICATION NO. 86253879 - SMARTNEWS - 30815-00070 - 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. 86253879

MARK: SMARTNEWS



CORRESPONDENT ADDRESS:

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GENERAL TRADEMARK INFORMATION:

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

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APPLICANT: SmartNews, Inc.

CORRESPONDENT'S REFERENCE/DOCKET NO:

30815-00070

CORRESPONDENT E-MAIL ADDRESS:

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REQUEST FOR RECONSIDERATION DENIED

ISSUE/MAILING DATE: 8/21/2016

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 Section 2(d) refusal made final in the Office action dated February 16, 2016 is **maintained and continues to be final**. See TMEP §§715.03(a)(ii)(B), 715.04(a). The identification requirement made final in the Office action is **satisfied**. See TMEP §§715.03(a)(ii)(B), 715.04(a).

In the present case, applicant's request has not resolved all the outstanding issue, nor does it raise a new issue or provide any new or compelling evidence with regard to the outstanding issues 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.

The applicant has requested reconsideration of the Section 2(d) Refusal because "the component terms of the mark, specifically SMART and NEWS are relatively weak as evidenced by the numerous registrations that contain one or the other of these terms in the advertising space." The applicant has made of record a number of third-party registrations that each contain one of these terms combined with other matter.

However, none of these registrations contain both SMART and NEWS. Here, the applicant's mark is SMARTNEWS, and the registrant's mark is the nearly identical mark SMMARTNEWS. As stated in the Final Office action, the fact that third-party registrations contain one (but not both) of these terms does not demonstrate that the combination is weak and entitled to a narrow scope of protection.

Because 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).

ADVISORY – Partial Abandonment

The Section 2(d) refusal is limited to Class 35. Therefore, if the applicant fails to perfect the appeal, Class 35 will be deleted from the application and the application will then proceed with the goods and services in Classes 9, 36, 39, 41, 42, and 45. 37 C.F.R. §2.65(a); see 15 U.S.C. §1062(b).

/Kim Teresa Moninghoff/

Examining Attorney

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