

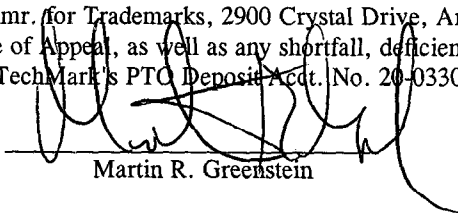
NEW APPEAL

TTAB

CERTIFICATE OF MAILING
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I hereby certify that this Document is being deposited with the United States Postal Service, First Class Mail, postage prepaid, on the date indicated below, addressed to the Asst. Commr. for Trademarks, 2900 Crystal Drive, Arlington, VA 22202-3513. Please charge the \$100 filing fee for this Notice of Appeal, as well as any shortfall, deficiency or additional fees in connection with this application at any time to TechMark's PTO Deposit Acct. No. 20-0330.

Date of Mailing: April 2, 2002


Martin R. Greenstein

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD



04-04-2002

U.S. Patent & TMO/TM Mail Rcpt Dt. #67

In re Application of:)
LightSurf Technologies, Inc.)
Serial No. 75/698,824)
Filed: May 6, 1999)
Trademark: WAVEFORCE)

Trademark Examining Attorney:
Mary E. Crawford, Law Office 102

NOTICE OF APPEAL
AND REQUEST TO REMAND

Box TTAB - FEE
Asst. Commr. for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

To the Trademark Trial and Appeal Board:

Applicant hereby appeals to the Trademark Trial and Appeal Board from the decision of the Trademark Examining Attorney dated October 3, 2001 finally refusing registration of the above-identified trademark. Applicant also notes that it has filed simultaneously herewith additional arguments and amendments to the goods (copy attached), in an attempt to resolve or limit the issues on appeal. Applicant requests that the Appeal be suspended and the case

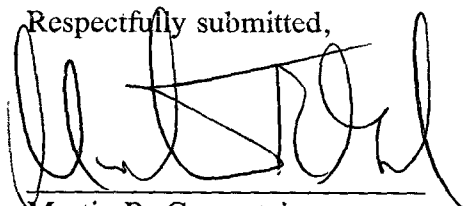
04/12/2002 TSMITH	00000073	200330	75687604	04/22/2002 NWILSON	00000003	200330	75698824
01 FC:378		100.00	CH	01 FC:378		100.00	CH
Adjustment date:	04/22/2002	NWILSON					
04/12/2002 TSMITH	00000073	200330	75687604				
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remanded to the Examining Attorney so that the Examining Attorney can consider these additional arguments and amendments.

Please charge the amount of \$100 for the appeal fee required pursuant to §2.6(m), as well as any shortfall, deficiency or additional fees in connection with this application at any time to TechMark's PTO Deposit Account No. 20-0330.

Dated: April 2, 2002

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Martin R. Greenstein', written over a horizontal line.

Martin R. Greenstein
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San Jose, CA 95113
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Attorneys for Applicant

TRADEMARK LAW OFFICE 102

Serial Number: 75/698824

Mark: WAVEFORCE

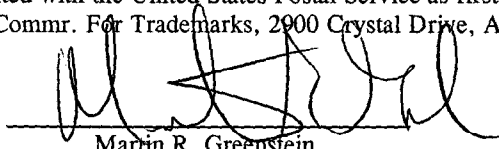
LO/102

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**of Response to Office Action ONLY **

CERTIFICATE OF MAILING

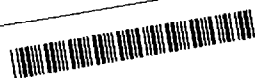
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Martin R. Greenstein

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: **LightSurf Technologies, Inc.**
Mark: **WAVEFORCE**
Serial No.: **75/698,824**
Int. Class: **9**
Trademark Examiner: **Mary E. Crawford, Law Office 102**



04-04-2002

U.S. Patent & TMO/TM Mail Rpt Dt. #67

AMENDMENT AND RESPONSE TO OFFICE ACTION

Box RESPONSE - NO FEE
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TIME OFFICE 102

This submission is filed in response to the Office Action designated as Action No. 102.

Please amend the application by deleting the present identification of goods and substituting the following:

Computers, computer network servers, microprocessors for digital cameras; computer software use in uploading ephotos to and downloading ephotos from computers over wired and wireless telecommunications links; wired or wireless computer communications terminals, handheld portable computer terminals and personal organizers, and global communications network web browser software, all for connecting to and exchanging information over local area, wide area, enterprise and global communications networks; computer software and server software for e-commerce or electronic commerce applications to allow users to perform electronic business applications and transactions; computer software used in conjunction with wired and wireless telecommunications links for the creation, enhancement, modification, transmission, reception, exchange, storage, and synchronization of information, messages, audio and video data and files, multimedia files, ephotos, photographic and graphic files and images, and wired or wireless e-mail messages that are with or without attached files and images, and instruction manuals sold as a unit therewith, all in Int. Class 9;

COMMENTS

Applicant has amended and rewritten the identification of goods to track exactly the language proposed by the Examining Attorney in the first and third Office Actions, and to eliminate the objected to references to digital cameras. Applicant has also included the language "microprocessors for use in digital cameras", which the Examining Attorney suggested in the third Office Action.

The only remaining issue is the use of the term "ephotos" in the identification of goods. Applicant respectfully disagrees with the Examining Attorney on this point, and notes that the use of the descriptive term "ephotos" has been accepted in numerous previously approved applications. Applicant notes the Examining refers to the fact that "the Office strives for consistency in its actions", but in fact, there is a specific rule on point, not merely an Office goal. Examination Guide No 1-01 of April 3, 2001 states "*If a companion application has been published for opposition or has registered, the examining attorney may presume that the classification and identification of goods or services in the companion application or registration are acceptable.*" See Examination Guide No. 1-01 of April 3, 2001, at: <http://www.uspto.gov/web/offices/tac/notices/guide1-01.htm>. Previously approved co-pending applications which include the descriptive term "ephotos" include Appln. No. 75/901,681 for the mark POINT, SHOOT, SHARE . . . INSTANTLY and Appln. No. 75/901,682 for the mark SURF THE LIGHT, as well as others.

Moreover, even though the marks INTERNET and INTRANET were still registered, the Office nonetheless approved use of the terms "Internet" and "Intranet" in identifications of goods and services, for their common, descriptive meaning. See Examination Guide No. 1-00

of August 3, 2000, "Use of the Words "Internet" or "Intranet" in Identifications of Goods and Services", at <http://www.uspto.gov/web/offices/tac/notices/guide1-00.htm>. The situation here is identical.

Finally, as noted earlier, Applicant is not using the term "ephotos" to identify digital cameras - the only goods in the registration on which the Examining Attorney bases her objection. Applicant clearly uses "ephotos" in a descriptive or generic sense to mean "ephotos" or digital photos. Agfa's Reg. No. 2,158,159 does not preclude use of the term ephotos for its ordinary descriptive meaning, which is exactly the way it is used in the identification of goods. See §33(b) 4, Lanham Act.

For the foregoing reasons, Applicant respectfully requests the Examiner to withdraw her objection to use of the descriptive term "ephotos" in the identification of goods.

Applicant has filed a Notice of Appeal and Request to Remand along with this Response, and attaches a copy for the Examining Attorney's convenience.

In view of the foregoing amendments and since the Examiner has previously found no similar registered or pending mark which would bar registration under the Trademark Act, this application, as amended, should now be found in condition for acceptance and publication.

Dated: April 2, 2002

Respectfully submitted,

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