

## Request for Reconsideration after Final Action

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

Input Field	Entered
<b>SERIAL NUMBER</b>	79122309
<b>LAW OFFICE ASSIGNED</b>	LAW OFFICE 110
<b>MARK SECTION (no change)</b>	
<b>GOODS AND/OR SERVICES SECTION (009)(current)</b>	
<b>INTERNATIONAL CLASS</b>	009
<b>DESCRIPTION</b>	
<p>Scientific instruments in the field of synthetic biology, namely biological measurement instruments, electrical conductors; electrical switches; electrical transformers; electrical accumulators; voltage regulators for electrical power, electrical controllers, apparatus for the recording, transmission and reproduction of sound and images; blank magnetic data carriers and blank recording discs, CDs and DVDs featuring data and software about synthetic biology, namely for analysis of biological material and for development of biological systems; calculating machines, hardware for data processing, computers; computer software for use in synthetic biology, namely for analysis of biological material and for development of biological systems</p>	
<b>GOODS AND/OR SERVICES SECTION (009)(proposed)</b>	
<b>INTERNATIONAL CLASS</b>	009
<b>TRACKED TEXT DESCRIPTION</b>	
<p><del>Scientific instruments in the field of synthetic biology, namely biological measurement instruments, electrical conductors;</del> <u>Scientific instruments in the field of synthetic biology, namely, equipment in the nature of detectors and analyzers of chemical and biological substances; electrical conductors;</u> electrical switches; electrical transformers; electrical accumulators; <del>blank magnetic data carriers and blank recording discs, CDs and DVDs featuring data and software about synthetic biology, namely for analysis of biological material and for development of biological systems;</del> voltage regulators for electrical power, electrical controllers, apparatus for the recording, transmission and reproduction of sound and images; <u>blank magnetic data carriers and blank recording discs;</u> <del>computer software for use in synthetic biology, namely for analysis of biological material and for development of biological systems;</del> <u>Digital materials, namely, CDs, DVDs and semi-conductor memories featuring data and software for use and application in the field of synthetic biology;</u> calculating machines, hardware for data processing, computers; <u>Computer software used for the detection, identification, collection, organization, analysis, integration and communication of scientific data and biological materials in the field of synthetic biology;</u> <u>computer software for the modelling and design of biological processes and systems in the field of synthetic biology</u></p>	

**FINAL DESCRIPTION**

Scientific instruments in the field of synthetic biology, namely, equipment in the nature of detectors and analyzers of chemical and biological substances; electrical conductors; electrical switches; electrical transformers; electrical accumulators; voltage regulators for electrical power, electrical controllers, apparatus for the recording, transmission and reproduction of sound and images; blank magnetic data carriers and blank recording discs; Digital materials, namely, CDs, DVDs and semi-conductor memories featuring data and software for use and application in the field of synthetic biology; calculating machines, hardware for data processing, computers; Computer software used for the detection, identification, collection, organization, analysis, integration and communication of scientific data and biological materials in the field of synthetic biology; computer software for the modelling and design of biological processes and systems in the field of synthetic biology

**GOODS AND/OR SERVICES SECTION (035)(no change)****GOODS AND/OR SERVICES SECTION (042)(current)**

INTERNATIONAL CLASS

042

**DESCRIPTION**

Scientific and technological services, namely research and design in the field of synthetic biology, namely installation and support services of computer hard- and software relating to analysis of biological material and for development of biological systems, research in the field of synthetic biology, design and development of computer hardware and software; in particular in the field of synthetic biology

**GOODS AND/OR SERVICES SECTION (042)(proposed)**

INTERNATIONAL CLASS

042

**TRACKED TEXT DESCRIPTION**

~~Scientific and technological services, namely research and design in the field of synthetic biology, namely installation and support services of computer hard- and software relating to analysis of biological material and for development of biological systems, research in the field of synthetic biology, design and development of computer hardware and software;~~ Scientific and technological services, namely research and design in the field of synthetic biology; development and implementation of software, hardware and technology solutions for the purpose of analysis of biological material and for development of biological systems in the field of synthetic biology; research in the field of synthetic biology, design and development of computer hardware and software; in particular in the field of synthetic biology

**FINAL DESCRIPTION**

Scientific and technological services, namely research and design in the field of synthetic biology; development and implementation of software, hardware and technology solutions for the purpose of analysis of biological material and for development of biological systems in the field of synthetic biology; research in the field of synthetic biology, design and development of computer hardware and software; in particular in the field of synthetic biology

**ADDITIONAL STATEMENTS SECTION**

This responds to the July 2, 2013 Final Rejection. Applicant appreciates the review of the application and appreciates the

**MISCELLANEOUS STATEMENT**

indication that the description of Class 35 is acceptable. In response to the Final Rejection, Applicant amends the descriptions of Goods and Services as indicated herein. Reconsideration of the application in view of the present amendments and remarks herein is respectfully requested. Class 9 - Regarding "Scientific instruments in the field of synthetic biology, namely biological measurement instruments," Applicant amends to "Scientific instruments in the field of synthetic biology, namely, equipment in the nature of detectors and analyzers of chemical and biological substances". Similar text has been recently approved in US Serial Number 77/615,699. Regarding "electrical switches; ellipses blank recording discs", a semicolon is added at the end of the text. Regarding "CDs and DVDs featuring data and software about synthetic biology, namely for analysis of biological material and for development of biological systems;", the description is amended to read "Digital materials, namely, CDs, DVDs and semi-conductor memories featuring data and software for use and application in the field of synthetic biology". The Manual of Acceptable Goods and Services accepts such a description with an identification of the "field", and the present field is "synthetic biology". Regarding "Computer software for use in synthetic biology, namely for analysis of biological material and for development of biological systems", Applicant amends to a description derived from US Serial Number 85/873,098 issued December 3, 2013 as registration number 4,445,185. Class 45 -- This description has been amended to conform to descriptions found in the Trademark Manual of Acceptable Identification of Goods and Services with an identification of the purpose of the services. In view of the foregoing, and the amendments to the descriptions of goods and services herein, it is respectfully submitted that the application is now in a condition for approval for publication. Indication to that effect is respectfully requested. If the foregoing does not place the application in a condition for publication, applicant respectfully requests a telephone call to the undersigned attorney to resolve any open matters.

**SIGNATURE SECTION**

<b>RESPONSE SIGNATURE</b>	/James A Henricks/
<b>SIGNATORY'S NAME</b>	James A. Henricks
<b>SIGNATORY'S POSITION</b>	Attorney of Record, California Bar Member
<b>SIGNATORY'S PHONE NUMBER</b>	310-563-1456
<b>DATE SIGNED</b>	12/23/2013
<b>AUTHORIZED SIGNATORY</b>	YES

CONCURRENT APPEAL NOTICE FILED	NO
<b>FILING INFORMATION SECTION</b>	
SUBMIT DATE	Mon Dec 23 16:12:29 EST 2013
TEAS STAMP	USPTO/RFR-108.235.137.31- 20131223161229210026-7912 2309-500dfa4e53a79851ca75 6f11f4787ac6369475489cb6c cf1eed289a98bd78709a-N/A -N/A-20131223154443336916

PTO Form 1930 (Rev 9/2007)  
OMB No. 0651-0050 (Exp. 05/31/2014)

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

Application serial no. **79122309** 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 009 for Scientific instruments in the field of synthetic biology, namely biological measurement instruments, electrical conductors; electrical switches; electrical transformers; electrical accumulators; voltage regulators for electrical power, electrical controllers, apparatus for the recording, transmission and reproduction of sound and images; blank magnetic data carriers and blank recording discs, CDs and DVDs featuring data and software about synthetic biology, namely for analysis of biological material and for development of biological systems; calculating machines, hardware for data processing, computers; computer software for use in synthetic biology, namely for analysis of biological material and for development of biological systems

Original Filing Basis:

**Filing Basis Section 66(a)**, Request for Extension of Protection to the United States. Section 66(a) of the Trademark Act, 15 U.S.C. §1141f.

**Proposed:**

**Tracked Text Description:** ~~Scientific instruments in the field of synthetic biology, namely biological measurement instruments, electrical conductors;~~ Scientific instruments in the field of synthetic biology, namely, equipment in the nature of detectors and analyzers of chemical and biological substances; electrical conductors; electrical switches; electrical transformers; electrical accumulators; ~~blank magnetic data carriers and blank recording discs, CDs and DVDs featuring data and software about synthetic biology, namely for analysis of biological material and for development of biological systems;~~ voltage regulators for electrical power, electrical controllers, apparatus for the recording, transmission and reproduction of sound and images; blank magnetic data carriers and blank recording discs; ~~computer software for use in synthetic biology, namely for analysis of biological material and for development of biological systems;~~ Digital materials, namely, CDs, DVDs and semi-conductor memories featuring data

[and software for use and application in the field of synthetic biology](#); calculating machines, hardware for data processing, computers; [Computer software used for the detection, identification, collection, organization, analysis, integration and communication of scientific data and biological materials in the field of synthetic biology](#); [computer software for the modelling and design of biological processes and systems in the field of synthetic biology](#)

Class 009 for Scientific instruments in the field of synthetic biology, namely, equipment in the nature of detectors and analyzers of chemical and biological substances; electrical conductors; electrical switches; electrical transformers; electrical accumulators; voltage regulators for electrical power, electrical controllers, apparatus for the recording, transmission and reproduction of sound and images; blank magnetic data carriers and blank recording discs; Digital materials, namely, CDs, DVDs and semi-conductor memories featuring data and software for use and application in the field of synthetic biology; calculating machines, hardware for data processing, computers; Computer software used for the detection, identification, collection, organization, analysis, integration and communication of scientific data and biological materials in the field of synthetic biology; computer software for the modelling and design of biological processes and systems in the field of synthetic biology

**Filing Basis Section 66(a)**, Request for Extension of Protection to the United States. Section 66(a) of the Trademark Act, 15 U.S.C. §1141f.

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

**Current:** Class 042 for Scientific and technological services, namely research and design in the field of synthetic biology, namely installation and support services of computer hard- and software relating to analysis of biological material and for development of biological systems, research in the field of synthetic biology, design and development of computer hardware and software; in particular in the field of synthetic biology

Original Filing Basis:

**Filing Basis Section 66(a)**, Request for Extension of Protection to the United States. Section 66(a) of the Trademark Act, 15 U.S.C. §1141f.

**Proposed:**

**Tracked Text Description:** ~~Scientific and technological services, namely research and design in the field of synthetic biology, namely installation and support services of computer hard- and software relating to analysis of biological material and for development of biological systems, research in the field of synthetic biology, design and development of computer hardware and software;~~ [Scientific and technological services, namely research and design in the field of synthetic biology](#); [development and implementation of software, hardware and technology solutions for the purpose of analysis of biological material and for development of biological systems in the field of synthetic biology](#); [research in the field of synthetic biology, design and development of computer hardware and software](#); in particular in the field of synthetic biology

Class 042 for Scientific and technological services, namely research and design in the field of synthetic biology; development and implementation of software, hardware and technology solutions for the purpose of analysis of biological material and for development of biological systems in the field of synthetic biology; research in the field of synthetic biology, design and development of computer hardware and software; in particular in the field of synthetic biology

**Filing Basis Section 66(a)**, Request for Extension of Protection to the United States. Section 66(a) of the Trademark Act, 15 U.S.C. §1141f.

## **ADDITIONAL STATEMENTS**

### **Miscellaneous Statement**

This responds to the July 2, 2013 Final Rejection. Applicant appreciates the review of the application and appreciates the indication that the description of Class 35 is acceptable. In response to the Final Rejection, Applicant amends the descriptions of Goods and Services as indicated herein. Reconsideration of the application in view of the present amendments and remarks herein is respectfully requested. Class 9 - Regarding "Scientific instruments in the field of synthetic biology, namely biological measurement instruments," Applicant amends to "Scientific instruments in the field of synthetic biology, namely, equipment in the nature of detectors and analyzers of chemical and biological substances". Similar text has been recently approved in US Serial Number 77/615,699. Regarding "electrical switches; ellipses blank recording discs", a semicolon is added at the end of the text. Regarding "CDs and DVDs featuring data and software about synthetic biology, namely for analysis of biological material and for development of biological systems;", the description is amended to read "Digital materials, namely, CDs, DVDs and semi-conductor memories featuring data and software for use and application in the field of synthetic biology". The Manual of Acceptable Goods and Services accepts such a description with an identification of the "field", and the present field is "synthetic biology". Regarding "Computer software for use in synthetic biology, namely for analysis of biological material and for development of biological systems", Applicant amends to a description derived from US Serial Number 85/873,098 issued December 3, 2013 as registration number 4,445,185. Class 45 -- This description has been amended to conform to descriptions found in the Trademark Manual of Acceptable Identification of Goods and Services with an identification of the purpose of the services. In view of the foregoing, and the amendments to the descriptions of goods and services herein, it is respectfully submitted that the application is now in a condition for approval for publication. Indication to that effect is respectfully requested. If the foregoing does not place the application in a condition for publication, applicant respectfully requests a telephone call to the undersigned attorney to resolve any open matters.

## **SIGNATURE(S)**

### **Request for Reconsideration Signature**

Signature: /James A Henricks/ Date: 12/23/2013

Signatory's Name: James A. Henricks

Signatory's Position: Attorney of Record, California Bar Member

Signatory's Phone Number: 310-563-1456

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 not filing a Notice of Appeal in conjunction with this Request for Reconsideration.

Serial Number: 79122309

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