

From: Chang, Betty

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Subject: U.S. Trademark Application Serial No. 79250083 - C - 2645LT190424 - 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.** 79250083

**Mark:** C

**Correspondence Address:**

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**Applicant:** Contentful GmbH

**Reference/Docket No.** 2645LT190424

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btaylor@stites.com

**REQUEST FOR RECONSIDERATION**  
**AFTER FINAL ACTION**  
**DENIED**

**Issue date:** **March 19, 2020**

**International Registration No.** 1445520

**Applicant's request for reconsideration is denied.** *See* 37 C.F.R. §2.63(b)(3). The trademark examining attorney has carefully reviewed applicant's request and determined the request did not:

(1) raise a new issue, (2) resolve the outstanding issue, (3) provide any new or compelling evidence with regard to the outstanding issue, or (4) present analysis and arguments that were persuasive or shed new light on the outstanding issue(s). TMEP §§715.03(a)(ii)(B), 715.04(a).

In the final Office action issued on September 3, 2019, applicant was required to adopt an acceptable identification of goods and services. In the request for reconsideration, applicant submitted an amended identification of goods and services.

Based on the response, the identification of goods and services is acceptable for Classes 9, 35 and 41. The request is denied with respect to the particular services specified below in Class 42.

### **Class 42 Identification of Services**

The wordings indicated below in the identification of services are indefinite and must be clarified. *See* 37 C.F.R. §2.32(a)(6); TMEP §1402.01. In particular, applicant must clarify the nature of the hosted content in the wording "IT services, namely, hosting content, applications and databases". Applicant must also clarify the nature of the computer systems that are subject of the implementation services in the wording "IT services, namely, research and development in the field of computer systems and content management, and implementation of computers and computer systems consisting of computer hardware, software, and software as a service". In particular, "software as a service" does not appear to be a customary or logical component of computer systems. In addition, applicant must specify the nature of the services in the wording "IT services, namely, content infrastructure services in the nature of computer software used and software as a service used for digital content management", which does not appear to specify any service relating to infrastructure.

If jurisdiction over the application is returned to the examining attorney, applicant may substitute the following wording, if accurate:

Class 9: Software, namely, downloadable graphical user interface software, downloadable computer software for content management, downloadable computer software for content delivery over the Internet to digital platforms such as websites and mobile applications; recorded computer software for content management and content delivery;

Class 35: Advertising, marketing and promotional services; business assistance, management and administrative services; business analysis, research and information services; consultancy and information in relation to the aforesaid services, included in this class

Class 41: Education services, namely, online and in-person education in the nature of workshops, webinars, seminars, and training in the field of content management software

Class 42: IT services, namely, development, programming and implementation of software; IT services, namely, development of computer hardware; IT services, namely, hosting **{specify type of content, e.g., digital, online, audio, video}** content, applications and databases; IT services, namely, software as a service (saas) featuring software for content management; IT services, namely, information technology consultancy and information; IT services, namely, computer system analysis and diagnostics; IT services, namely, research and development in the field of computer systems and content management, and implementation of computers and computer systems consisting of computer hardware ~~and software, and software as a service~~; IT services, namely, computer project management; IT services, namely, content infrastructure services in the nature of **installation, updating and maintenance of** computer software used ~~and software as a service used~~ for digital content management; IT services, namely, computer network configuration and design services; IT services, namely, data migration; IT services, namely, monitoring technological functions of computer systems via remote access; consultancy and information in relation to the aforesaid services, included in this class

(Suggested additions are underscored; suggested deletions are stricken.)

Applicant may amend the identification to clarify or limit the goods and/or services, but not to broaden or expand the goods and/or services beyond those in the original application or as acceptably amended. See 37 C.F.R. §2.71(a); TMEP §1402.06. Generally, any deleted goods and/or services may not later be reinserted. See TMEP §1402.07(e).

For assistance with identifying and classifying goods and services in trademark applications, please see the USPTO's online searchable [U.S. Acceptable Identification of Goods and Services Manual](#). See TMEP §1402.04.

The requirement for an acceptable identification of services made final in the Office action dated September 3, 2019 are **maintained and continued** with respect to the wordings discussed above.

See TMEP §§715.03(a)(ii)(B), 715.04(a).

In addition, the requirement for an acceptable identification of goods and services relative to all other goods and services is **satisfied**.

See TMEP §§715.03(a)(ii)(B), 715.04(a).

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

**If applicant has not filed an appeal** and time remains in the six-month response period, applicant has the remainder of that time to (1) [file another request for reconsideration](#) that complies with and/or overcomes any outstanding final requirement, and/or (2) [file a notice of appeal](#) to the Board. TMEP §715.03(a)(ii)(B). Filing 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(c).

/Betty Chang/

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