

## Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
<b>SERIAL NUMBER</b>	85231933
<b>LAW OFFICE ASSIGNED</b>	LAW OFFICE 104
<b>MARK SECTION (no change)</b>	
<b>OWNER SECTION (current)</b>	
NAME	cross media
DBA/AKA/TA/Formerly	TA lightcast
STREET	11931 OVERLOOK MOUNTAIN DR
CITY	CHARLOTTE
STATE	North Carolina
ZIP/POSTAL CODE	28216-7775
COUNTRY	United States
PHONE	6784774243
EMAIL	AKISSSLINGER@MAC.COM
<b>OWNER SECTION (proposed)</b>	
NAME	LIGHTCAST, INC.
STREET	2215-B Renaissance Drive
CITY	Las Vegas
STATE	Nevada
ZIP/POSTAL CODE	89119
COUNTRY	United States
PHONE	6784774243
EMAIL	AKISSSLINGER@MAC.COM
<b>LEGAL ENTITY SECTION (current)</b>	
TYPE	corporation

<b>STATE/COUNTRY OF INCORPORATION</b>	North Carolina
<b>LEGAL ENTITY SECTION (proposed)</b>	
<b>TYPE</b>	corporation
<b>STATE/COUNTRY OF INCORPORATION</b>	Nevada
<b>ARGUMENT(S)</b>	
<p>The Applicant respectfully requests reconsideration of the Examiner’s Final Rejection in this pending trademark application. In particular, the Applicant requests that the Examiner reconsider the final rejection of the Applicant’s listing in Class 038 for “disseminating on demand video and audio content to targeted social media outlets for others.” The Examiner relies upon U.S. Registration 2,959,483 for “Lightcast” listing “telecommunication services, namely, local and long distance transmission of voice, data, graphics by means of telephone, telegraphic, cable, and satellite transmissions.”</p> <p>The Applicant respectfully argues that the Examiner has made a conclusion regarding the similarity of the respective listings of services without fully considering the significant differences in each. By placing its services in the context of data transmitted to social media outlets, the Applicant differentiates its services from the ‘483 registration. The ‘483 registration provides generalized telecommunication services in the form of overall data transmission. The ultimate destination of the data is of no consequence in the ‘483 listing because the services listed therein only involve the transport of the data, regardless of which end user picks up and decodes the signal. In regard to the ‘483 listing, all of the data transmitted is available to any node in a larger, generalized network.</p> <p>In contrast, the Applicant further amends its listing of services to note the dissemination of video and audio content to targeted social media outlets, meaning that the service involves choosing the ultimate destination of the data. The Applicant is not providing general telecommunications data transport services, but instead, the Applicant disseminates data to a particular target for others.</p> <p>The amendment herein emphasizes the different channels of trade in which consumers would encounter the Applicant’s mark as compared to the mark of the ‘483 registration. The ‘483 registration would be encountered by individuals and businesses requiring connection to a larger telecommunications infrastructure (i.e., people and businesses needing hardware and software connecting individuals to a larger telecommunications network). In contrast, the Applicant’s mark is not directed to those needing connection to a larger telecom infrastructure, but it is directed to businesses needing content delivered to a particular, targeted, and known destination. The “targeted” nature of the Applicant’s listing of services places the destination in the hands of the business “pushing” the data, as opposed to the ‘483 registration which simply makes the data generally available for recipients to choose as a destination on an ad hoc basis. The difference in the listing of services, therefore, lies in the fact that the Applicant’s mark will be promoted to those who have a need for video and audio content to end up in a targeted, previously defined location as opposed to the owners of the ‘483 registration who direct their mark to people and businesses who need a general connection to the infrastructure.</p> <p>In further regard to the rejection of the Applicant’s listing in Class 038, the Applicant asks the Examiner to reconsider whether the ‘483 registration for “Lightcast” is sufficiently distinctive for that class of services to merit rejecting the Applicant’s amended listing of services for “Lightcast” in Class 038. Records at the U.S. Trademark Office indicate that there is a trend toward allowing numerous marks to co-exist in Class 038 for similar services. The Applicant notes that other marks, including “Lightbox” (Ser. No. 85260337), “Lightband” (Reg. No.</p>	

3,535,058), and “Lightpath” (Reg. No. 2,092,807) all co-exist in Class 038 for the exact same services as those listed in the cited ‘483 registration. Accordingly, if any portion of the ‘483 registration is arguably distinctive, one would have to consider the “cast” portion of the ‘483 mark to be the distinctive part, which is difficult to understand given that “cast” is a commonly used root for broadcast services that would be classified in Class 038. The recently issued mark for “Let It Cast” (Reg. No. 4,072,761) in Class 038, which registered over the ‘483 application, indicates that the “cast” portion of the ‘483 mark is not particularly exclusive to the ‘483 registration either. Numerous marks, therefore, coexist in the marketplace with very similar phrases and words for identical services in Class 038. The market is sufficiently sophisticated to distinguish these marks for their respective services. The Applicant respectfully requests similar treatment.

Given that the Applicant has amended its listing of services to emphasize an entirely different channel of trade from the ‘483 registration, and the ‘483 registration cannot claim an exclusive, distinctive position in the realm of Class 038, the Applicant respectfully requests that the Examiner reconsider the final rejection.

In regard to Class 035, the Applicant requests reconsideration of the rejection based upon Reg. No. 3,645,389 (Litecast). The Applicant emphasizes that the literal spelling difference in the ‘389 mark versus the Applicant’s mark does matter in regard to commercial impression. In fact, the U.S. Trademark Office allowed the ‘389 registration to issue even in light of the mark “Lightscape Technologies” (Reg. No. 3,614,354, disclaiming the word “technologies”). This is particularly important when the ‘389 and ‘354 registrations had practically identical listings of services. By this standard, the difference in spelling between “Litecast” and “Lightcast” matters a great deal.

The U.S. Trademark has also determined that other marks such as “Lite-On Mobile” (Ser. No. 79/086,326) and “Air Lite” (Reg. No. 3,257,964) are also allowed to define their place in the market with the ‘389 Litecast mark when all of the marks are used in advertising services. Again, the Applicant requests a similar opportunity.

Finally, in regard to the ‘389 registration, the Applicant requests that the Examiner consider the listing of services and its direction of advertisements on social media websites. While it is true that the Examiner does not have to infer limitations into the listing of services within the ‘389 application (currently citing “advertising services”), there is nothing in the ‘389 registration to indicate that social media advertising is within the normal course and channels of trade for the ‘389 registration. Considering the registration as a whole, the ‘389 registration is clearly applicable to outdoor digital signage and display boards, suggesting that advertising on a social media website as claimed by the Applicant is not a “normal” channel of trade for advertising services within the ‘389 application.

Along the lines of the arguments above, the Applicant respectfully requests reconsideration of the final rejection in this case.

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

**GOODS AND/OR SERVICES SECTION (038)(current)**

**INTERNATIONAL CLASS**

038

**DESCRIPTION**

Providing telecommunications access to video on demand by disseminating video and audio content to selected broadcast service providers, namely, social media outlets

**FILING BASIS**

Section 1(b)

<b>GOODS AND/OR SERVICES SECTION (038)(proposed)</b>	
<b>INTERNATIONAL CLASS</b>	038
<b>TRACKED TEXT DESCRIPTION</b>	
<del>Providing telecommunications access to video on demand by disseminating video and audio content to selected broadcast service providers, namely, social media outlets;</del> <a href="#">Disseminating on demand video and audio content to social media outlets for others</a>	
<b>FINAL DESCRIPTION</b>	
Disseminating on demand video and audio content to social media outlets for others	
<b>FILING BASIS</b>	Section 1(b)
<b>SIGNATURE SECTION</b>	
<b>RESPONSE SIGNATURE</b>	/R. Brian Johnson/
<b>SIGNATORY'S NAME</b>	R. Brian Johnson
<b>SIGNATORY'S POSITION</b>	Attorney of Record, NC Bar Member
<b>SIGNATORY'S PHONE NUMBER</b>	704-945-6715
<b>DATE SIGNED</b>	02/28/2012
<b>AUTHORIZED SIGNATORY</b>	YES
<b>CONCURRENT APPEAL NOTICE FILED</b>	YES
<b>FILING INFORMATION SECTION</b>	
<b>SUBMIT DATE</b>	Tue Feb 28 19:28:58 EST 2012
<b>TEAS STAMP</b>	USPTO/RFR-166.82.113.234- 20120228192858664291-8523 1933-490dc306621259c1039b 542c6e994eab9c9-N/A-N/A-2 0120228191834381414

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

Application serial no. **85231933** has been amended as follows:

**ARGUMENT(S)**

**In response to the substantive refusal(s), please note the following:**

The Applicant respectfully requests reconsideration of the Examiner's Final Rejection in this pending trademark application. In particular, the Applicant requests that the Examiner reconsider the final rejection of the Applicant's listing in Class 038 for "disseminating on demand video and audio content to targeted social media outlets for others." The Examiner relies upon U.S. Registration 2,959,483 for "Lightcast" listing "telecommunication services, namely, local and long distance transmission of voice, data, graphics by means of telephone, telegraphic, cable, and satellite transmissions."

The Applicant respectfully argues that the Examiner has made a conclusion regarding the similarity of the respective listings of services without fully considering the significant differences in each. By placing its services in the context of data transmitted to social media outlets, the Applicant differentiates its services from the '483 registration. The '483 registration provides generalized telecommunication services in the form of overall data transmission. The ultimate destination of the data is of no consequence in the '483 listing because the services listed therein only involve the transport of the data, regardless of which end user picks up and decodes the signal. In regard to the '483 listing, all of the data transmitted is available to any node in a larger, generalized network.

In contrast, the Applicant further amends its listing of services to note the dissemination of video and audio content to targeted social media outlets, meaning that the service involves choosing the ultimate destination of the data. The Applicant is not providing general telecommunications data transport services, but instead, the Applicant disseminates data to a particular target for others. The amendment herein emphasizes the different channels of trade in which consumers would encounter the Applicant's mark as compared to the mark of the '483 registration. The '483 registration would be encountered by individuals and businesses requiring connection to a larger telecommunications infrastructure (i.e., people and businesses needing hardware and software connecting individuals to a larger telecommunications network). In contrast, the Applicant's mark is not directed to those needing connection to a larger telecom infrastructure, but it is directed to businesses needing content delivered to a particular, targeted, and known destination. The "targeted" nature of the Applicant's listing of services places the destination in the hands of the business "pushing" the data, as opposed to the '483 registration which simply makes the data generally available for recipients to choose as a destination on an ad hoc basis. The difference in the listing of services, therefore, lies in the fact that the Applicant's mark will be promoted to those who have a need for video and audio content to end up in a targeted, previously defined location as opposed to the owners of the '483 registration who direct their mark to people and businesses who need a general connection to the infrastructure.

In further regard to the rejection of the Applicant's listing in Class 038, the Applicant asks the Examiner to reconsider whether the '483 registration for "Lightcast" is sufficiently distinctive for that class of services to merit rejecting the Applicant's amended listing of services for "Lightcast" in Class 038. Records at the U.S. Trademark Office indicate that there is a trend toward allowing numerous marks to co-exist in Class 038 for similar services. The Applicant notes that other marks, including "Lightbox" (Ser. No. 85260337), "Lightband" (Reg. No. 3,535,058), and "Lightpath" (Reg. No. 2,092,807) all co-exist in Class 038 for the exact same services as those listed in the cited '483 registration. Accordingly, if any portion of the '483 registration is arguably distinctive, one would have to consider the "cast" portion of the '483 mark to be the distinctive part, which is difficult to understand given that "cast" is a commonly used root for broadcast services that would be classified in Class 038. The recently issued mark for "Let It Cast" (Reg. No. 4,072,761) in Class 038, which registered over the '483 application, indicates that the "cast" portion of the '483 mark is not particularly exclusive to the '483 registration either. Numerous marks, therefore, coexist in the marketplace with very similar phrases and words for identical services in Class 038. The market is sufficiently sophisticated to

distinguish these marks for their respective services. The Applicant respectfully requests similar treatment.

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The U.S. Trademark has also determined that other marks such as "Lite-On Mobile" (Ser. No. 79/086,326) and "Air Lite" (Reg. No. 3,257,964) are also allowed to define their place in the market with the '389 Litecast mark when all of the marks are used in advertising services. Again, the Applicant requests a similar opportunity.

Finally, in regard to the '389 registration, the Applicant requests that the Examiner consider the listing of services and its direction of advertisements on social media websites. While it is true that the Examiner does not have to infer limitations into the listing of services within the '389 application (currently citing "advertising services"), there is nothing in the '389 registration to indicate that social media advertising is within the normal course and channels of trade for the '389 registration. Considering the registration as a whole, the '389 registration is clearly applicable to outdoor digital signage and display boards, suggesting that advertising on a social media website as claimed by the Applicant is not a "normal" channel of trade for advertising services within the '389 application.

Along the lines of the arguments above, the Applicant respectfully requests reconsideration of the final rejection in this case.

## **CLASSIFICATION AND LISTING OF GOODS/SERVICES**

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

**Current:** Class 038 for Providing telecommunications access to video on demand by disseminating video and audio content to selected broadcast service providers, namely, social media outlets

Original Filing Basis:

**Filing Basis: Section 1(b), Intent to Use:** The applicant has had a bona fide intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the identified goods and/or services as of the filing date of the application. (15 U.S.C. Section 1051(b)).

**Proposed:**

**Tracked Text Description:** ~~Providing telecommunications access to video on demand by disseminating video and audio content to selected broadcast service providers, namely, social media outlets;~~

Disseminating on demand video and audio content to social media outlets for others

Class 038 for Disseminating on demand video and audio content to social media outlets for others

**Filing Basis: Section 1(b), Intent to Use:** The applicant has a bona fide intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the identified goods and/or services as of the filing date of the application. (15 U.S.C. Section 1051(b)).

**APPLICANT AND/OR ENTITY INFORMATION**

**Applicant proposes to amend the following:**

**Current:** cross media, TA lightcast, a corporation of North Carolina, having an address of  
11931 OVERLOOK MOUNTAIN DR  
CHARLOTTE, North Carolina 28216-7775  
United States

AKISSLINGER@MAC.COM  
6784774243

**Proposed:** LIGHTCAST, INC., a corporation of Nevada, having an address of  
2215-B Renaissance Drive  
Las Vegas, Nevada 89119  
United States

AKISSLINGER@MAC.COM  
6784774243

**SIGNATURE(S)**

**Request for Reconsideration Signature**

Signature: /R. Brian Johnson/ Date: 02/28/2012

Signatory's Name: R. Brian Johnson

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

Signatory's Phone Number: 704-945-6715

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 filing a Notice of Appeal in conjunction with this Request for Reconsideration.

Serial Number: 85231933

Internet Transmission Date: Tue Feb 28 19:28:58 EST 2012

TEAS Stamp: USPTO/RFR-166.82.113.234-201202281928586

64291-85231933-490dc306621259c1039b542c6

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