

Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	86186371
LAW OFFICE ASSIGNED	LAW OFFICE 104
MARK SECTION (no change)	
EVIDENCE SECTION	
EVIDENCE FILE NAME(S)	
ORIGINAL PDF FILE	evi_1746287197-20150115201316844002_argument_oa2.pdf
CONVERTED PDF FILE(S) (1 page)	\\TICRS\EXPORT16\IMAGEOUT16\861\863\86186371\xml7\RFR0002.JPG
DESCRIPTION OF EVIDENCE FILE	Argument in support of withdrawal of the finality of the Office Action and the issuance of a new Office Action setting a new response date
GOODS AND/OR SERVICES SECTION (035)(current)	
INTERNATIONAL CLASS	035
DESCRIPTION	
Business consulting services in the field of information assurance	
FILING BASIS	Section 1(a)
FIRST USE ANYWHERE DATE	At least as early as 06/01/2010
FIRST USE IN COMMERCE DATE	At least as early as 08/02/2010
GOODS AND/OR SERVICES SECTION (035)(proposed)	
INTERNATIONAL CLASS	035
DESCRIPTION	
Business consulting services in the field of information assurance	
FILING BASIS	Section 1(b)

GOODS AND/OR SERVICES SECTION (041)(current)

INTERNATIONAL CLASS	041
DESCRIPTION	
Continuing education services, namely, providing live and on-line continuing professional education seminars in the field of information, computer and internet security; providing continuing education courses in the field of computer and data forensics	
FILING BASIS	Section 1(a)
FIRST USE ANYWHERE DATE	At least as early as 06/01/2010
FIRST USE IN COMMERCE DATE	At least as early as 08/02/2010

GOODS AND/OR SERVICES SECTION (041)(proposed)

INTERNATIONAL CLASS	041
DESCRIPTION	
Continuing education services, namely, providing live and on-line continuing professional education seminars in the field of information, computer and internet security; providing continuing education courses in the field of computer and data forensics	
FILING BASIS	Section 1(b)

GOODS AND/OR SERVICES SECTION (042)(current)

INTERNATIONAL CLASS	042
DESCRIPTION	
Computer consultation in the field of computer security; Computer security consultancy in the field of scanning and penetration testing of computers and networks to assess information security vulnerability	
FILING BASIS	Section 1(a)
FIRST USE ANYWHERE DATE	At least as early as 06/01/2010
FIRST USE IN COMMERCE DATE	At least as early as 08/02/2010

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

INTERNATIONAL CLASS	042
DESCRIPTION	
Computer consultation in the field of computer security; Computer security consultancy in the field of scanning and penetration testing of computers and networks to assess information security vulnerability	
FILING BASIS	Section 1(b)

GOODS AND/OR SERVICES SECTION (045)(current)	
INTERNATIONAL CLASS	045
DESCRIPTION	
Litigation support services; Regulatory compliance consulting in the field of computer, internet, and information security; Security services, namely, providing security assessments of physical locations, information systems, and working environments	
FILING BASIS	Section 1(a)
FIRST USE ANYWHERE DATE	At least as early as 06/01/2010
FIRST USE IN COMMERCE DATE	At least as early as 08/02/2010
GOODS AND/OR SERVICES SECTION (045)(proposed)	
INTERNATIONAL CLASS	045
DESCRIPTION	
Litigation support services; Regulatory compliance consulting in the field of computer, internet, and information security; Security services, namely, providing security assessments of physical locations, information systems, and working environments	
FILING BASIS	Section 1(b)
ADDITIONAL STATEMENTS SECTION	
MISCELLANEOUS STATEMENT	Only in the alternative to acceptance of the amendment of the filing basis as entered and argued above, please amend the application to seek registration on the Principal Register (i.e. a change of the words "Supplemental Register" to "Principal Register.")
SIGNATURE SECTION	
DECLARATION SIGNATURE	/Douglas E. White/
SIGNATORY'S NAME	Douglas E. White
SIGNATORY'S POSITION	Attorney of record, California bar member
SIGNATORY'S PHONE NUMBER	925 255 3564
DATE SIGNED	01/15/2015
RESPONSE SIGNATURE	/Douglas E. White/
SIGNATORY'S NAME	Douglas E. White
SIGNATORY'S POSITION	Attorney of record, California bar member

SIGNATORY'S PHONE NUMBER	925 255 3564
DATE SIGNED	01/15/2015
AUTHORIZED SIGNATORY	YES
CONCURRENT APPEAL NOTICE FILED	YES
FILING INFORMATION SECTION	
SUBMIT DATE	Thu Jan 15 21:23:47 EST 2015
TEAS STAMP	USPTO/RFR-174.62.87.197-2 0150115212347444813-86186 371-500e010ebb1cf332e9a81 b2f8cdf6b24b35e384ac2f4d5 c81cdf9587521a8213e-N/A-N /A-20150115201316844002

PTO Form 1960 (Rev 9/2007)
OMB No. 0651-0050 (Exp. 07/31/2017)

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

Application serial no. **86186371** has been amended as follows:

EVIDENCE

Evidence in the nature of Argument in support of withdrawal of the finality of the Office Action and the issuance of a new Office Action setting a new response date has been attached.

Original PDF file:

[evi_1746287197-20150115201316844002_argument_oa2.pdf](#)

Converted PDF file(s) (1 page)

[Evidence-1](#)

CLASSIFICATION AND LISTING OF GOODS/SERVICES

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

Current: Class 035 for Business consulting services in the field of information assurance

Original Filing Basis:

Filing Basis: Section 1(a), Use in Commerce: The applicant is using the mark in commerce, or the applicant's related company or licensee is using the mark in commerce, on or in connection with the identified goods and/or services. 15 U.S.C. Section 1051(a), as amended. The mark was first used at least as early as 06/01/2010 and first used in commerce at least as early as 08/02/2010 , and is now in use in such commerce.

Proposed: Class 035 for Business consulting services in the field of information assurance

Deleted Filing Basis: 1(a)

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

Current: Class 041 for Continuing education services, namely, providing live and on-line continuing professional education seminars in the field of information, computer and internet security; providing continuing education courses in the field of computer and data forensics

Original Filing Basis:

Filing Basis: Section 1(a), Use in Commerce: The applicant is using the mark in commerce, or the applicant's related company or licensee is using the mark in commerce, on or in connection with the identified goods and/or services. 15 U.S.C. Section 1051(a), as amended. The mark was first used at least as early as 06/01/2010 and first used in commerce at least as early as 08/02/2010 , and is now in use in such commerce.

Proposed: Class 041 for Continuing education services, namely, providing live and on-line continuing professional education seminars in the field of information, computer and internet security; providing continuing education courses in the field of computer and data forensics

Deleted Filing Basis: 1(a)

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

Current: Class 042 for Computer consultation in the field of computer security; Computer security consultancy in the field of scanning and penetration testing of computers and networks to assess information security vulnerability

Original Filing Basis:

Filing Basis: Section 1(a), Use in Commerce: The applicant is using the mark in commerce, or the applicant's related company or licensee is using the mark in commerce, on or in connection with the identified goods and/or services. 15 U.S.C. Section 1051(a), as amended. The mark was first used at least as early as 06/01/2010 and first used in commerce at least as early as 08/02/2010 , and is now in use in such commerce.

Proposed: Class 042 for Computer consultation in the field of computer security; Computer security consultancy in the field of scanning and penetration testing of computers and networks to assess information security vulnerability

Deleted Filing Basis: 1(a)

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

Current: Class 045 for Litigation support services; Regulatory compliance consulting in the field of computer, internet, and information security; Security services, namely, providing security assessments of physical locations, information systems, and working environments

Original Filing Basis:

Filing Basis: Section 1(a), Use in Commerce: The applicant is using the mark in commerce, or the

applicant's related company or licensee is using the mark in commerce, on or in connection with the identified goods and/or services. 15 U.S.C. Section 1051(a), as amended. The mark was first used at least as early as 06/01/2010 and first used in commerce at least as early as 08/02/2010, and is now in use in such commerce.

Proposed: Class 045 for Litigation support services; Regulatory compliance consulting in the field of computer, internet, and information security; Security services, namely, providing security assessments of physical locations, information systems, and working environments

Deleted Filing Basis: 1(a)

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)).

ADDITIONAL STATEMENTS

Miscellaneous Statement

Only in the alternative to acceptance of the amendment of the filing basis as entered and argued above, please amend the application to seek registration on the Principal Register (i.e. a change of the words "Supplemental Register" to "Principal Register.")

SIGNATURE(S)

Declaration Signature

DECLARATION: The signatory being warned that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. Section 1001, and that such willful false statements and the like may jeopardize the validity of the application or submission or any registration resulting therefrom, declares that, if the applicant submitted the application or amendment to allege use (AAU) unsigned, all statements in the application or AAU and this submission based on the signatory's own knowledge are true, and all statements in the application or AAU and this submission made on information and belief are believed to be true.

STATEMENTS FOR UNSIGNED SECTION 1(a) APPLICATION/AAU: If the applicant filed an unsigned application under 15 U.S.C. Section 1051(a) or AAU under 15 U.S.C. Section 1051(c), the signatory additionally believes that: the applicant is the owner of the trademark/service mark sought to be registered; the applicant or the applicant's related company or licensee is using the mark in commerce and has been using the mark in commerce as of the filing date of the application or AAU on or in connection with the goods/services in the application or AAU, and such use by the applicant's related company or licensee inures to the benefit of the applicant; the original specimen(s), if applicable, shows the mark in use in commerce as of the filing date of the application or AAU on or in connection with the goods/services in the application or AAU; and to the best of the signatory's knowledge and belief, no other person has the right to use the mark in commerce, either in the identical form or in such near resemblance as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion or mistake, or to deceive.

STATEMENTS FOR UNSIGNED SECTION 1(b)/SECTION 44 APPLICATION: If the applicant filed an unsigned application under 15 U.S.C. Section 1051(b), Section 1126(d), and/or Section 1126(e), the signatory additionally believes that: the applicant is entitled to use the mark in commerce; the applicant has a bona fide intention and has had a bona fide intention as of the application filing date to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the goods/services in the application; and to the best of the signatory's knowledge and belief, no other person

has the right to use the mark in commerce, either in the identical form or in such near resemblance as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion or mistake, or to deceive.

Signature: /Douglas E. White/ Date: 01/15/2015
Signatory's Name: Douglas E. White
Signatory's Position: Attorney of record, California bar member
Signatory's Phone Number: 925 255 3564

Request for Reconsideration Signature

Signature: /Douglas E. White/ Date: 01/15/2015
Signatory's Name: Douglas E. White
Signatory's Position: Attorney of record, California bar member

Signatory's Phone Number: 925 255 3564

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: 86186371
Internet Transmission Date: Thu Jan 15 21:23:47 EST 2015
TEAS Stamp: USPTO/RFR-174.62.87.197-2015011521234744
4813-86186371-500e010ebb1cf332e9a81b2f8c
df6b24b35e384ac2f4d5c81cdf9587521a8213e-
N/A-N/A-20150115201316844002

The application has been rejected on the basis that the applied-for-mark fails to function as a trademark or service mark.

Such determination is made based on the specimen(s) and evidence of record. *See In re T.S. Designs, Inc.*, 95 USPQ2d 1669 (TTAB 2010) (informational based on the likely consumer perception of the phrase, when used on a clothing label, in connection with manufacturing information); *In re Aerospace Optics, Inc.*, 78 USPQ2d 1861 (TTAB 2006) (fails to function as a mark for illuminated pushbutton switches, where the mark is used in a manner that merely informs the potential purchaser of the multiple color feature of the goods, and the coloring and font in which the proposed mark is displayed are not sufficient to imbue the term with source-identifying significance or to set it apart from other informational wording).

For example, in the present case, the Examining Attorney has focused on such issues as whether the mark's presence on the specimen(s) of record herein gives the impression of an informational title for writing below, the lack of a TM symbol on the specimens(s), and the like.

By amendment herewith, applicant has changed the filing basis of the application to intent to use under Section 1(b). Accordingly, the present specimens of use are no longer under consideration and cannot be used to support the rejection.

Applicant is aware that specimens and a Section 1(a) filing basis are required for registration on the Supplemental Register, and that next the application will be rejected on that basis. However, it is submitted that this will be a new and separate ground of rejection requiring a new Office Action requiring an Amendment to Allege Use. In response thereto, applicant is confident it will be able to submit in an Amendment to Allege Use specimens that show use of the mark in a manner that functions as a trademark and service mark.

In the event it is ruled that the application may not be amended to seek registration under Section 1(b) at this point because it is for registration on the Supplemental Register, and *also* that therefore a new Office Action is not required, Applicant requests, *in the alternative*, amendment to seek registration on the Principal Register. *See* T.M.E.P. §§816.04 and 1212.02(c).

Applicant realizes that rejection on the Principal Register was made earlier on the grounds of mere descriptiveness, but Applicant has not argued the point, relying instead on a belief that the informational matter rejection would be dropped. Accordingly, a new rejection or at minimum a new final rejection, under Section 2(e) would be appropriate.

In either alternative, Applicant requests withdrawal of the final rejection and the issuance of a new Office Action.