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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. 88738760

Mark: INTELLIGENCE FOR YOUR BUILT

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Reference/Docket No. N/A

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REQUEST FOR RECONSIDERATION
AFTER FINAL ACTION
DENIED

Issue date: **March 12, 2021**

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 all the outstanding issue(s), (3) provide any new or compelling

evidence with regard to the outstanding issue(s), 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).

Accordingly, the following requirement(s) and/or refusal(s) made final in the Office action dated 8/3/20 are **maintained and continued**: Identification.

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

Identification

The requirement for an acceptable identification is continued. Applicant has provided a revised identification that includes wording beyond the scope of the original identification, and that includes unclear and indefinite goods/services.

Particular wording in the proposed amendment to the identification is not acceptable because it exceeds the scope of the identification in the application. See 37 C.F.R. §§2.32(a)(6), 2.71(a); TMEP §§805, 1402.06 *et seq.*, 1402.07. Applicant's goods and/or services may be clarified or limited, but may not be expanded beyond those originally itemized in the application or as acceptably amended. See 37 C.F.R. §2.71(a); TMEP §1402.06. Therefore, the original identification in the application, and any previously accepted amendments, remain operative for purposes of future amendment. See 37 C.F.R. §2.71(a); TMEP §1402.07(d).

The "Downloadable computer software for managing, monitoring, prioritizing, tracking, collecting and analyzing information, data, and tasks in the field of real estate property maintenance and management," listed in both Class 9 and 42, remains beyond the scope of the original identification, which was limited to software for real estate property maintenance and management. Applicant has changed the software's function from maintenance and management to a wide range of other functions. The software for biomed engineering management, namely, for entering, tracking, storing and reporting information relating to equipment and other physical assets and to services delivered by biomed engineering management departments in Classes 9 and 42 is beyond the scope of the original software for biomed engineering management as applicant has changed the function of the software from management of engineering services to a wide range of functions that include overly broad "equipment and other physical assets."

The wording "Downloadable computer software for real estate and facilities management, namely, software for site management, project management, construction, and design and remodeling of real estate and facilities; Downloadable computer software for biomed engineering management, namely for entering, tracking, storing and reporting information relating to equipment and other physical assets and to services delivered by biomed engineering management departments; Downloadable computer software for managing, monitoring, prioritizing, tracking, collecting and analyzing information, data, and

tasks in the field of real estate property maintenance and management; Downloadable computer software for financial investment and project planning relating to buildings, real property, and physical assets; Downloadable computer software for resource scheduling and management to book rooms and associated resources, manage workspaces, common areas, hot desks;” “Asset management services, namely, reporting on service histories, utilization of physical assets, end of product life information and replacement costs all related to building fixtures and physical assets at industrial process facilities;” and “Software as a service (SAAS) services featuring software for real estate and facilities management, namely, software for site evaluation and selection, site management, construction, design and remodeling, and facilities assessment; Software as a service (SAAS) services featuring software for real estate and facilities management, namely, software for capital and project planning and capital and maintenance cost estimation, relating to buildings, real property, and physical assets; Software as a service (SAAS) services featuring software for real estate and facilities management, namely, for physical assets management, equipment and inventory management, equipment monitoring, and real estate and equipment lease management; Software as a service (SAAS) services featuring software for biomed engineering management, namely, for entering, tracking, storing and reporting information relating to equipment and other physical assets and to services delivered by biomed engineering management departments; Downloadable computer software for managing, monitoring, prioritizing, tracking, collecting and analyzing information, data, and tasks in the field of real estate property maintenance and management;” in the identification remains unacceptable as indefinite and must be clarified because it is unclear, or beyond the scope of the original identification. See 37 C.F.R. §2.32(a)(6); TMEP §1402.01.

The “Downloadable computer software for real estate and facilities management, namely, software for site management, project management, construction, and design and remodeling of real estate and facilities;” remains unacceptable as the software function is unclear. For instance, software for construction is unclear. The “Downloadable computer software for financial investment and project planning relating to buildings, real property, and physical assets” must be further clarified as the function of the software is overly broad and indefinite. The “Downloadable computer software for resource scheduling and management to book rooms and associated resources, manage workspaces, common areas, hot desks;” must be further clarified as the function of the software is overly broad and indefinite. For instance, software for resource scheduling of associated resources is overly broad and does not actually convey what the software is used to schedule. The type of rooms and common areas should be further clarified, and hot desks is indefinite. The type of assets being managed must be further clarified.

The “Software as a service (SAAS) services featuring software for real estate and facilities management, namely, software for site evaluation and selection, site management, construction, design and remodeling, and facilities assessment;” remains unacceptable, as the software function is unclear. For instance, software for construction is unclear. The “Software as a service (SAAS) services featuring software for real estate and facilities management, namely, software for capital and project planning and capital and maintenance cost estimation, relating to buildings, real property, and physical assets;” must be further clarified as the function of the software is overly broad and indefinite. The “Software as

a service (SAAS) services featuring software for real estate and facilities management, namely, for physical assets management, equipment and inventory management, equipment monitoring, and real estate and equipment lease management;” must be further clarified as the function of the software is overly broad and indefinite, and the type of equipment and physical assets must be further clarified. Applicant may substitute the following wording, if accurate:

Class 9 –

Downloadable computer software for managing maintenance and repair schedules of physical assets and for tracking location of physical assets; Downloadable computer software for real estate and facilities management, namely, software for use in managing the design and remodeling of real estate facilities; Downloadable electronic publications in the nature of training manuals in the field of real estate facilities management for use in planning, physical assets management, site management, project management, property maintenance and management; Downloadable computer software in the field of healthcare for patient support services and fulfillment of clinician requests, namely, software for providing logistical support concerning delivery of medical supplies and equipment, and for providing logistical support concerning patient transport, and courier services, all in the field of healthcare; Downloadable computer software for use in reporting, organizing, and managing reports on energy, water, waste, greenhouse gases, carbon emissions, and other consumable natural resources; Downloadable computer software for managing environmental and energy management programs; Computer hardware; Downloadable computer software for facilities assessment and management, namely, software to analyze and control building environment, building access and security systems; Downloadable computer software for use in financially investing in projects relating to buildings and real property assets; Downloadable computer software for managing and reporting on the asset lifecycle through engineering document management in the fields of industrial process facilities; Downloadable computer software for use in scheduling and management, namely, software for use in booking conference rooms, workspaces, and office common areas; Downloadable computer software for scheduling, routing and dispatch of work orders and managing parts inventory and technician communication;

Class 35 –

Business management consultancy and physical assets management services for government and commercial businesses;

Class 42 –

Database development services; Providing temporary non-downloadable software for database management, managing maintenance and repair schedules of physical assets, tracking location of physical assets, and equipment and inventory management of physical assets; Application service provider (ASP) services featuring software to store, manage, track, analyze and report data; Application service provider (ASP) services featuring software for facility and real property assessment; Application

service provider (ASP) services, namely, hosting, managing, developing, analyzing, and maintaining applications, software, and web site of others in the fields of healthcare, benefit programs, employee productivity, and, risk management; Hosting the websites of others; Computer software consultancy services; Technical support services, namely, troubleshooting in the nature of diagnosing computer software problems; Information technology consulting services; Customizing computer software; Platform as a service (PAAS) featuring computer software platforms to automate and centralize operational logistics, efficiency and productivity of healthcare systems; Providing temporary on-line use of non-downloadable software for use in management of energy, water, waste, greenhouse gases, carbon emissions, other consumable natural resources, and energy management programs; Technical, architectural, and engineering consulting services in the real estate financing industry, namely, property and land condition surveying; Software as a service (SAAS) services featuring software for managing and reporting on the asset lifecycle through engineering document management in the fields of industrial process facilities; Software as a service (SAAS) services featuring software for use in managing and booking conference rooms workspaces, common areas, and hot desks; Software as a service (SAAS) services featuring software for performing field surveys and reporting on compliance issues with applicable regulations; Software as a service (SAAS) services featuring software in the field of healthcare for patient support services and fulfillment of clinician requests, namely, software for providing logistical support concerning delivery of medical supplies and equipment, and for providing logistical support concerning patient transport and courier services, all in the field of healthcare; Software as a service (SAAS) services featuring software for scheduling, routing and dispatch of work orders and managing parts inventory and technician communication; Software as a service (SAAS) services featuring software for the full lifecycle of facilities maintenance management, namely, software for logging work orders, assigning them to the appropriate workers, ensuring compliance, and handling budgets and invoicing.

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(s) and/or refusal(s), 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).

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