

UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)
OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION

U.S. APPLICATION SERIAL NO. 79210841

MARK: GAME GURU

79210841

CORRESPONDENT ADDRESS:

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http://www.uspto.gov/trademarks/teas/response_form.jsp

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CORRESPONDENT'S REFERENCE/DOCKET NO:

N/A

CORRESPONDENT E-MAIL ADDRESS:

OFFICE ACTION

INTERNATIONAL REGISTRATION NO. 1352172

STRICT DEADLINE TO RESPOND TO THIS NOTIFICATION: TO AVOID ABANDONMENT OF THE REQUEST FOR EXTENSION OF PROTECTION OF THE INTERNATIONAL REGISTRATION, THE USPTO MUST RECEIVE A COMPLETE RESPONSE TO THIS PROVISIONAL FULL REFUSAL NOTIFICATION **WITHIN 6 MONTHS** OF THE "DATE ON WHICH THE NOTIFICATION WAS SENT TO WIPO (MAILING DATE)" LOCATED ON THE WIPO COVER LETTER ACCOMPANYING THIS NOTIFICATION.

In addition to the Mailing Date appearing on the WIPO cover letter, a holder (hereafter "applicant") may confirm this Mailing Date using the USPTO's Trademark Status and Document Retrieval (TSDR) system at <http://tsdr.uspto.gov/>. To do so, enter the U.S. application serial number for this application and then select "Documents." The Mailing Date used to calculate the response deadline for this provisional full refusal is the "Create/Mail Date" of the "IB-1st Refusal Note."

This is a **PROVISIONAL FULL REFUSAL** of the request for extension of protection of the mark in the above-referenced U.S. application. See 15 U.S.C. §1141h(c). See below in this notification (hereafter "Office action") for details regarding the provisional full refusal.

The referenced application has been reviewed by the assigned trademark examining attorney. Applicant must respond timely and completely to the issue(s) below. 15 U.S.C. §1062(b); 37 C.F.R. §§2.62(a), 2.65(a); TMEP §§711, 718.03.

SEARCH RESULTS

The trademark examining attorney has searched the Office's database of registered and pending marks and has found no conflicting marks that would bar registration under Trademark Act Section 2(d). TMEP §704.02; see 15 U.S.C. §1052(d).

However, before examination may proceed, the applicant must address the following issues:

Summary of Issues:

- *Identification of Goods/Services Requires Amendment*
- *Disclaimer Required*

IDENTIFICATION OF GOODS/SERVICES REQUIRES AMENDMENT

Certain wording in the identification of goods and services must be clarified because it is too broad, indefinite and/or not sufficiently specific. See 37 C.F.R. §2.32(a)(6); TMEP §§1402.01, 1402.03. Please see the required amendments, set forth by class below.

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.

IMPORTANT: 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). Additionally, for applications filed under Trademark Act Section 66(a), the scope of the identification for purposes of permissible amendments is limited by the international class assigned by the International Bureau of the World Intellectual Property Organization (International Bureau); and the classification of goods and/or services may not be changed from that assigned by the International Bureau. 37 C.F.R. §2.85(d); TMEP §§1401.03(d), 1904.02(b). Further, in a multiple-class Section 66(a) application, classes may not be added or goods and/or services transferred from one existing class to another. 37 C.F.R. §2.85(d); TMEP §1401.03(d).

Finally, please pay particular attention to the use of semicolons between specific categories of services and the use of commas within a category of

service. An application must specify, in an explicit manner, “the particular goods and/or services on or in connection with which the applicant uses, or has a bona fide intention to use, the mark in commerce.” TMEP §1402.01; see 15 U.S.C. §1051(a)(2), (b)(2); 37 C.F.R. §2.32(a)(6). Therefore, proper punctuation in identifications of goods and/or services is necessary to delineate explicitly each product or service within a list and to avoid ambiguity. In general, **commas** should be used in an identification (1) to separate a series of related items identified within a particular category of goods or services, (2) before and after “namely,” and (3) between each item in a list of goods or services following “namely” (e.g., personal care products, namely, body lotion, non-medicated hand soap, shampoo). TMEP §1402.01(a). **Semicolons** generally should be used to separate a series of distinct categories of goods or services within an international class (e.g., personal care products, namely, body lotion; deodorizers for pets; glass cleaners). *Id.*

The examining attorney has properly placed this punctuation in the recommendations below, and the amended language is underlined while the additional information required from the applicant is in *{bracketed italics}*. Please note that any suggestions for clarification of goods/services provided by the examining attorney are limited to the existing class. As noted above, in a multiple-class Section 66(a) application, classes may not be added or goods and/or services transferred from one existing class to another. Further, some wording in the identification requires amendment for clarification due to word order, duplication, etc.

Class 9

3D spectacles; computer memory devices; **blank magnetic disks; electronic pens; visual display units, namely, {indicate nature of the goods properly in Class 9; e.g., digital signage display panels, flat panel display screens, LCD large-screen displays, LCD monitors, head-mounted video displays};** memory cards for video game machines; **blank integrated circuit cards and smart cards; compact discs, featuring audio-video content in the field of {indicate subject matter}; blank compact discs featuring read-only memory for sound or video recording;** computers; computer hardware; computer game software; joysticks for use with computers, other than for video games; computer keyboards; computer peripheral devices; **computer programs, namely, downloadable software featuring {specify the function of the software, e.g., use as a spreadsheet, word processing, etc. and, if software is content- or field-specific, the content or field of use}; downloadable software featuring {specify the function of the software, e.g., use as a spreadsheet, word processing, etc. and, if software is content- or field-specific, the content or field of use}; recorded computer programmes, featuring {specify the function of the software, e.g., use as a spreadsheet, word processing, etc. and, if software is content- or field-specific, the content or field of use}; programs, recorded;** laptop computers; mobile telephones; modems; **monitors, namely, {indicate type of monitor properly in Class 9; e.g., television monitors, computer monitors, alarm monitoring systems, LCD monitors}; computer programs, featuring {specify the function of the software, e.g., use as a spreadsheet, word processing, etc. and, if software is content- or field-specific, the content or field of use}; computer hardware, namely, monitors;** headphones; notebook computers; tablet computers; smartwatches; smartglasses; smartphones; **blank USB flash drives**

Class 28

Arcade video game machines; video game machines; jigsaw puzzles; joysticks for video games; **practical jokes novelties, namely, {indicate nature of the goods properly in Class 28; e.g., whoopee cushions, dispensers of stream material};** board games

Class 35

Business administration of consumer loyalty programs; compiling web indexes of information for commercial or advertising purposes; conducting market studies; opinion polling; providing business information via a web site; compilation of information into computer databases; compilation of statistics; **consumer advice shop services, namely, commercial information and advice for consumers; marketing services; marketing research;** provision of an on-line marketplace for buyers and sellers of goods and services; writing of curriculum vitae for others; writing of publicity texts; scriptwriting for advertising purposes; word processing; updating of advertising material; updating and maintenance of data in computer databases; web site traffic optimization; rental of advertising space; commercial information agency services; **business services, namely, outsourcing services; commercial intermediation services, namely, matching of potential private investors with entrepreneurs needing funding;** layout services for advertising purposes; news clipping services; advertising agency services; search engine optimization for sales promotion; **presentation of goods on communication media, for retail purposes, namely, providing television home shopping services in the field of general consumer merchandise;** publicity material rental; rental of advertising time on communication media; direct mail advertising; publication of publicity texts; advertising; pay per click advertising; advertising by mail order; on-line advertising on a computer network; dissemination of advertising matter; design of advertising materials; systemization of information into computer databases; sales promotion for others; production of advertising films; negotiation and conclusion of commercial transactions for third parties

Class 41

Videotaping; electronic desktop publishing; **providing on-line videos, not downloadable, featuring {indicate subject matter/content; e.g., music, instructional cooking videos}; providing on-line electronic publications, not downloadable, in the nature of {indicate specific nature of publication} in the field of {indicate subject matter of publication};** providing on-line music, not downloadable; **game services provided on-line from a computer network, namely, {indicate nature of services, properly in Class 41; e.g., providing an online computer game, providing online reviews of computer games, providing games of chance via the internet};** recreation information; entertainment information; **writing of texts, namely, {indicate nature of services, properly in Class 41; e.g., poem and lyric writing, screenplay writing, speech writing for non-advertising purposes};** layout services, other than for advertising purposes; providing amusement arcade services; **entertainment and education club services, namely, {indicate nature of the clubs properly in Class 41; e.g., night clubs, comedy clubs, chess clubs, video gaming clubs}; translation;** mobile library services; news reporters services; recording studio services; photographic reporting; music composition services; on-line publication of electronic books and journals; publication of books; publication of texts, other than publicity texts; **entertainment services, namely, {indicate nature of services, properly in Class 41; e.g., conducting contests, organizing social entertainment events, providing a website for online gambling, production and distribution of a game show, conducting on-line competitions in the field of entertainment, education, culture, sports, and other non-business and non-commercial fields};** production of music; film production, other than advertising films

Class 42

Computer system analysis; outsource service providers in the field of information technology; duplication of computer programs; providing information on computer technology and programming via a web site; providing search engines for the internet; installation of computer software; computer programming; conversion of data or documents from physical to electronic media; computer technology consultancy; **information technology (IT) consultancy**; computer software consultancy; consultancy in the design and development of computer hardware; web site design consultancy; monitoring of computer systems by remote access; maintenance of computer software; **software as a service (SaaS) featuring software for {specify the function of the programs, e.g., for use in database management, for service desk management, for accounting, etc., and, if software is content- or field-specific, the content or field of use}**; computer software design; rental of web servers; rental of computer software; **hosting computer sites and web sites on the internet**; computer system design; creating and maintaining web sites for others; server hosting; graphic arts design

DISCLAIMER REQUIRED

Applicant must disclaim the descriptive wording “GAME” apart from the mark as shown because, as evidenced by the applicant’s identification of goods and services; e.g., *computer game software; video game machines; game services provided on-line from a computer network*, it merely describes features or characteristics, and the intended use/purpose of the applicant’s goods and services. See 15 U.S.C. §1056(a); TMEP §§1213, 1213.03(a).

A “disclaimer” is a statement that applicant does not claim exclusive rights to an unregistrable component of a mark. TMEP §1213. A disclaimer does **not physically remove the disclaimed matter from the mark or otherwise affect the appearance of the applied-for mark**. See TMEP §1213.10.

The Office can require an applicant to disclaim an unregistrable part of a mark consisting of particular wording, symbols, numbers, design elements, or combinations thereof. 15 U.S.C. §1056(a). Under Trademark Act Section 2(e), the Office can refuse registration of an entire mark if the entire mark is merely descriptive, deceptively misdescriptive, or primarily geographically descriptive of the goods and/or services. 15 U.S.C. §1052(e). Thus, the Office may require an applicant to disclaim a portion of a mark that, when used in connection with the goods and/or services, is merely descriptive, deceptively misdescriptive, primarily geographically descriptive, or otherwise unregistrable (e.g., generic). See TMEP §§1213, 1213.03.

Failure to comply with a disclaimer requirement can result in a refusal to register the entire mark. TMEP §1213.01(b).

The computerized printing format for the Office’s *Trademark Official Gazette* requires a standardized format for a disclaimer. TMEP §1213.08(a)(i). The following is the standard format used by the Office:

No claim is made to the exclusive right to use “GAME” apart from the mark as shown.

TMEP §1213.08(a)(i); see *In re Owatonna Tool Co.*, 231 USPQ 493 (Comm’r Pats. 1983).

RESPONSE GUIDELINES

For this application to proceed further, applicant must explicitly address each refusal and/or requirement raised in this Office action. If the action includes a refusal, applicant may provide arguments and/or evidence as to why the refusal should be withdrawn and the mark should register. Applicant may also have other options specified in this Office action for responding to a refusal, and should consider those options carefully. To respond to requirements and certain refusal response options, applicant should set forth in writing the required changes or statements. For more information and general tips on responding to USPTO Office actions, response options, and how to file a response online, see “Responding to Office Actions” on the USPTO’s website.

WHO IS PERMITTED TO RESPOND TO THIS PROVISIONAL FULL REFUSAL: Any response to this provisional refusal must be personally signed by an individual applicant, all joint applicants, or someone with legal authority to bind a juristic applicant (e.g., a corporate officer or general partner). 37 C.F.R. §§2.62(b), 2.193(e)(2)(ii); TMEP §712.01. If applicant hires a qualified U.S. attorney to respond on his or her behalf, then the attorney must sign the response. 37 C.F.R. §§2.193(e)(2)(i), 11.18(a); TMEP §§611.03(b), 712.01. Qualified U.S. attorneys include those in good standing with a bar of the highest court of any U.S. state, the District of Columbia, Puerto Rico, and other U.S. commonwealths or U.S. territories. See 37 C.F.R. §§2.17(a), 2.62(b), 11.1, 11.14(a); TMEP §§602, 712.01. Additionally, for all responses, the proper signatory must personally sign the document or personally enter his or her electronic signature on the electronic filing. See 37 C.F.R. §2.193(a); TMEP §§611.01(b), 611.02. The name of the signatory must also be printed or typed immediately below or adjacent to the signature, or identified elsewhere in the filing. 37 C.F.R. §2.193(d); TMEP §611.01(b).

In general, foreign attorneys are not permitted to represent applicants before the USPTO (e.g., file written communications, authorize an amendment to an application, or submit legal arguments in response to a requirement or refusal). See 37 C.F.R. §11.14(c), (e); TMEP §§602.03-.03(b), 608.01.

DESIGNATION OF DOMESTIC REPRESENTATIVE: The USPTO encourages applicants who do not reside in the United States to designate a domestic representative upon whom any notice or process may be served. TMEP §610; see 15 U.S.C. §§1051(e), 1141h(d); 37 C.F.R. §2.24(a)(1)-(2). Such designations may be filed online at <http://www.uspto.gov/trademarks/teas/correspondence.jsp>.

If applicant does not respond to this Office action within six months of the date on which the USPTO sends this Office action to the International Bureau, or responds by expressly abandoning the application, the application process will end and the trademark will fail to register. See 15 U.S.C. §1062(b); 37 C.F.R. §§2.65(a), 2.68(a); TMEP §§711, 718.01, 718.02.

When an application has abandoned for failure to respond to an Office action, an applicant may timely file a petition to revive the application, which, if granted, would allow the application to return to active status. See 37 C.F.R. §2.66; TMEP §1714. The petition must be filed within two months of the date of issuance of the notice of abandonment and may be filed online via the Trademark Electronic Application System (TEAS) with a \$100 fee. See 37 C.F.R. §§2.6(a)(15)(ii), 2.66(b)(1).

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TO RESPOND TO THIS LETTER: Go to http://www.uspto.gov/trademarks/teas/response_form.jsp. Please wait 48-72 hours from the issue/ mailing date before using the Trademark Electronic Application System (TEAS), to allow for necessary system updates of the application. For *technical* assistance with online forms, e-mail TEAS@uspto.gov. For questions about the Office action itself, please contact the assigned trademark examining attorney. **E-mail communications will not be accepted as responses to Office actions; therefore, do not respond to this Office action by e-mail.**

All informal e-mail communications relevant to this application will be placed in the official application record.

WHO MUST SIGN THE RESPONSE: It must be personally signed by an individual applicant or someone with legal authority to bind an applicant (i.e., a corporate officer, a general partner, all joint applicants). If an applicant is represented by an attorney, the attorney must sign the response.

PERIODICALLY CHECK THE STATUS OF THE APPLICATION: To ensure that applicant does not miss crucial deadlines or official notices, check the status of the application every three to four months using the Trademark Status and Document Retrieval (TSDR) system at <http://tsdr.uspto.gov/>. Please keep a copy of the TSDR status screen. If the status shows no change for more than six months, contact the Trademark Assistance Center by e-mail at TrademarkAssistanceCenter@uspto.gov or call 1-800-786-9199. For more information on checking status, see <http://www.uspto.gov/trademarks/process/status/>.

TO UPDATE CORRESPONDENCE/E-MAIL ADDRESS: Use the TEAS form at <http://www.uspto.gov/trademarks/teas/correspondence.jsp>.