

United States Patent and Trademark Office (USPTO)
Office Action (Official Letter) About Applicant's Trademark Application

U.S. Application Serial No. 79274456

Mark: IBIBLE

Correspondence Address:

Limited Liability C; Galina N. Andrushch
Business House «Lefortovo»,
Aviamotomaya street, 12, office 508
RU-111024 Moscow
RUSSIAN FED.

Applicant: SCREENLIFE LIMITED

Reference/Docket No. N/A

Correspondence Email Address:

NONFINAL OFFICE ACTION

International Registration No. 1504429

Notice of Provisional Full Refusal

Deadline for responding. The USPTO must receive applicant's response within six months of the "date on which the notification was sent to WIPO (mailing date)" located on the WIPO cover letter, or the U.S. application will be abandoned. To confirm the mailing date, go to the USPTO's Trademark Status and Document Retrieval (TSDR) database; select "US Serial, Registration, or Reference No.," enter the U.S. application serial number in the blank text box, and click on "Documents." The mailing date used to calculate the response deadline is the "Create/Mail Date" of the "1st Refusal Note."

Respond to this Office action using the USPTO's Trademark Electronic Application System (TEAS). A link to the appropriate TEAS response form appears at the end of this Office action.

Discussion of provisional full refusal. This is a provisional full refusal of the request for extension of protection to the United States of the international registration, known in the United States as a U.S. application based on Trademark Act Section 66(a). See 15 U.S.C. §§1141(f)(a), 1141h(c).

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.

SECTION 2(d) REFUSAL – LIKELIHOOD OF CONFUSION

Registration of the applied-for mark is refused because of a likelihood of confusion with the mark in U.S. Registration No. 3414119 Trademark Act Section 2(d), 15 U.S.C. §1052(d); see TMEP §§1207.01 *et seq.* See the attached registration.

Applicant has applied to register IBIBLE for recorded and downloadable media; electronic notice boards; audio interfaces; road signs, luminous or mechanical; interfaces for computers; electronic book readers; electronic agendas; compact discs [audio-video]; monitors [computer programs]; computer software, recorded; computer software platforms, recorded or downloadable; computer software applications, downloadable; computer programs, recorded; computer game software, downloadable; computer game software, recorded; computer programs, downloadable; computer operating programs, recorded; computer screen saver software, recorded or downloadable; electronic publications, downloadable; audiovisual teaching apparatus; integrated circuits; printed circuits; downloadable image files; downloadable music files; animated cartoons; chips [integrated circuits]; downloadable graphics for mobile phones; electronic interactive whiteboards; software; downloadable emoticons for mobile phones; compact discs [read-only memory]; screens [photography]; downloadable ring tones for mobile phones; printed matter; photographs [printed]; albums; almanacs; banners of paper; pamphlets; booklets; newspapers; magazines [periodicals]; periodicals; printed publications; calendars; catalogues; books; teaching materials [except apparatus]; musical greeting cards; greeting cards; postcards; prospectuses; manuals [handbooks]; instructional and teaching materials; posters; flyers; games and playthings; portable games and toys incorporating telecommunication functions; games; portable games with liquid crystal displays; advertising agency services; computerized file management; demonstration of goods; marketing research; marketing; targeted marketing; business management of performing artists; scriptwriting for advertising purposes; updating and maintenance of information in registries; updating and maintenance of data in computer databases; updating of advertising material; word processing; online retail services for downloadable and pre-recorded music and movies; online retail services for downloadable ring tones; online retail services for downloadable digital music; design of advertising materials; data search in computer files for others; providing business information via a web site; auctioneering; wholesale services for recorded and downloadable media, electronic notice boards, audio interfaces, road signs, luminous or mechanical, interfaces for computers, electronic book readers, electronic agendas, compact discs [audio-video], monitors [computer programs], computer software, recorded, computer software platforms, recorded or downloadable, computer software applications, downloadable, computer programs, recorded, computer game software, downloadable, computer game software, recorded, computer programs, downloadable, computer operating programs, recorded, computer screen saver software, recorded or downloadable, electronic publications, downloadable, audiovisual teaching apparatus, integrated circuits, printed circuits, downloadable image files, downloadable music files, animated cartoons, chips [integrated circuits], downloadable graphics for mobile phones, electronic interactive whiteboards,

software, downloadable emoticons for mobile phones, compact discs [read-only memory], screens [photography], downloadable ring tones for mobile phones, printed matter, photographs [printed], albums, almanacs, banners of paper, pamphlets, booklets, newspapers, magazines [periodicals], periodicals, printed publications, calendars, catalogues, books, teaching materials [except apparatus], musical greeting cards, greeting cards, postcards, prospectuses, manuals [handbooks], instructional and teaching materials, posters, flyers, games and playthings, portable games and toys incorporating telecommunication functions, games, portable games with liquid crystal displays; sales promotion for others; production of advertising films; publication of publicity texts; radio advertising; bill-posting; distribution of samples; dissemination of advertising matter; direct mail advertising; registration of written communications and data; writing of publicity texts; advertising; online advertising on a computer network; advertising by mail order; television advertising; telemarketing services; search engine optimization for sales promotion; procurement services for others [purchasing goods and services for other businesses]; marketing in the framework of software publishing; presentation of goods on communication media, for retail purposes; telecommunications; television broadcasting; cable television broadcasting; electronic bulletin board services [telecommunications services]; information about telecommunication; providing user access to global computer networks; providing access to databases; providing telecommunications connections to a global computer network; providing telecommunication channels for teleshopping services; video-on-demand transmission; message sending; computer aided transmission of messages and images; transmission of digital files; providing online forums; videoconferencing services; radio broadcasting; radio communications; transmission of electronic mail; communications by fiber optic networks; communications by cellular phones; communications by computer terminals; satellite transmission; teleconferencing services; streaming of data; wireless broadcasting; providing internet chatrooms; telecommunications routing and junction services; education; cultural activities; videotaping; production of music; publication of books; education information; film distribution; movie studio services; layout services, other than for advertising purposes; microfilming; videotape editing; production of radio and television programmes; screenplay writing; religious education; correspondence courses; practical training [demonstration]; providing recreation facilities; arranging and conducting of colloquiums; arranging and conducting of congresses; arranging and conducting of conferences; arranging and conducting of concerts; arranging and conducting of workshops [training]; arranging and conducting of seminars; arranging and conducting of symposiums; organization of competitions [education]; television entertainment; providing online videos, not downloadable; providing online music, not downloadable; providing television programs, not downloadable, via video-on-demand services; providing films, not downloadable, via video-on-demand services; providing online electronic publications, not downloadable; presentation of live performances; theatre productions; film production, other than advertising films; rental of videotapes; rental of sound recordings; rental of motion pictures; electronic desktop publishing; online publication of electronic books and journals; publication of texts, other than publicity texts; writing of texts; film directing, other than advertising films; music composition services; subtitling; video editing services for events; sound engineering services for events; game services provided online from a computer network; teaching; scriptwriting, other than for advertising purposes; photography; photographic reporting; production of shows; academies [education]; organization of exhibitions for cultural or educational purposes; presentation of variety shows; arranging and conducting of in-person educational forums; scientific and technological services and research and design relating thereto; design and development of computer hardware and software; graphic arts design; computer virus protection services; installation of computer software; research in the field of telecommunications technology; research and development of new products for others; scientific research; technological research; web site design consultancy; information technology [IT] consultancy; consultancy in the design and development of computer hardware; computer software consultancy; data security consultancy; updating of computer software; monitoring of computer systems to detect breakdowns; monitoring of computer systems for detecting unauthorized access or data breach; monitoring of computer systems by remote access; software as a service [SaaS]; maintenance of computer software; conversion of data or documents from physical to electronic media; providing information on computer technology and programming via a web site; providing search engines for the internet; platform as a service [PaaS]; conversion of computer programs and data, other than physical conversion; conducting technical project studies; computer system design; hosting computer sites [web sites]; development of computer platforms; computer software design; software development in the framework of software publishing; creating and designing website-based indexes of information for others [information technology services]; creating and maintaining web sites for others; computer programming; copying of computer programs; cloud computing; outsource service providers in the field of information technology; off-site data backup; computer technology consultancy; telecommunications technology consultancy; electronic data storage; graphic design of promotional materials; server hosting; online social networking services; spiritual consultancy; personal and social services rendered by others to meet the needs of individuals.” The registered mark is IBIBL® for “recorded audio discs featuring the recorded Bible; audio speaker enclosures; audio speakers; computer hardware and computer software programs for the integration of text, audio, graphics, still image and moving pictures into an interactive delivery for multimedia applications; digital audio players; digital audio tape players; digital audio tape recorders; digital flash memory cards, personal digital assistants (PDA), digital materials, in form of, namely, CDs, DVDs, downloadable audio files, featuring the recorded Bible; digital media in form of, namely, CDs, DVDs, downloadable audio files, digital flash cards, featuring the recorded Bible.”

Trademark Act Section 2(d) bars registration of an applied-for mark that is so similar to a registered mark that it is likely consumers would be confused, mistaken, or deceived as to the commercial source of the goods and/or services of the parties. *See* 15 U.S.C. §1052(d). Likelihood of confusion is determined on a case-by-case basis by applying the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973) (called the “*du Pont* factors”). *In re i.am.symbolic, llc*, 866 F.3d 1315, 1322, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017). Only those factors that are “relevant and of record” need be considered. *M2 Software, Inc. v. M2 Commc’ns, Inc.*, 450 F.3d 1378, 1382, 78 USPQ2d 1944, 1947 (Fed. Cir. 2006) (citing *Shen Mfg. Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 1241, 73 USPQ2d 1350, 1353 (Fed. Cir. 2004)); *see In re Inn at St. John’s, LLC*, 126 USPQ2d 1742, 1744 (TTAB 2018).

Although not all *du Pont* factors may be relevant, there are generally two key considerations in any likelihood of confusion analysis: (1) the similarities between the compared marks and (2) the relatedness of the compared goods and/or services. *See In re i.am.symbolic, llc*, 866 F.3d at 1322, 123 USPQ2d at 1747 (quoting *Herbko Int’l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1164-65, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002)); *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 1103, 192 USPQ 24, 29 (C.C.P.A. 1976) (“The fundamental inquiry mandated by [Section] 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods [or services] and differences in the marks.”); TMEP §1207.01.

In this case, the following factors are the most relevant: similarity of the marks, similarity and nature of the goods and/or services, and similarity of the trade channels of the goods and/or services. *See In re Viterra Inc.*, 671 F.3d 1358, 1361-62, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *In re Dakin’s Miniatures Inc.*, 59 USPQ2d 1593, 1595-96 (TTAB 1999); TMEP §§1207.01 *et seq.*

Comparison of the Marks

Marks are compared in their entireties for similarities in appearance, sound, connotation, and commercial impression. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 1321, 110 USPQ2d 1157, 1160 (Fed. Cir. 2014) (quoting *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 1371, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005)); TMEP §1207.01(b)-(b)(v). “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *In re Inn at St. John’s, LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018) (citing *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014)); TMEP §1207.01(b).

When comparing marks, “[t]he proper test is not a side-by-side comparison of the marks, but instead whether the marks are sufficiently similar in terms of their commercial impression such that [consumers] who encounter the marks would be likely to assume a connection between the parties.” *Cai v. Diamond Hong, Inc.*, ___ F.3d ___, 127 USPQ2d 1797, 1801 (Fed. Cir. 2018) (quoting *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1368, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012)); TMEP §1207.01(b). The proper focus is on the recollection of the average purchaser, who retains a general rather than specific impression of trademarks. *In re Inn at St. John’s, LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018) (citing *In re St. Helena Hosp.*, 774 F.3d 747, 750-51, 113 USPQ2d 1082, 1085 (Fed. Cir. 2014); *Geigy Chem. Corp. v. Atlas Chem. Indus., Inc.*, 438 F.2d 1005, 1007, 169 USPQ 39, 40 (CCPA 1971)); TMEP §1207.01(b).

In this case, the marks are identical in appearance, sound, and meaning, “and have the potential to be used . . . in exactly the same manner.” *In re i.am.symbolic, llc*, 116 USPQ2d 1406, 1411 (TTAB 2015), *aff’d*, 866 F.3d 1315, 123 USPQ2d 1744 (Fed. Cir. 2017). Additionally, because they are identical, these marks are likely to engender the same connotation and overall commercial impression when considered in connection with applicant’s and registrant’s respective goods and/or services. *Id.* Therefore, the marks are confusingly similar.

Comparison of the Goods/Services

The goods and/or services are compared to determine whether they are similar, commercially related, or travel in the same trade channels. See *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1369-71, 101 USPQ2d 1713, 1722-23 (Fed. Cir. 2012); *Herbko Int’l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1165, 64 USPQ2d 1375, 1381 (Fed. Cir. 2002); TMEP §§1207.01, 1207.01(a)(vi).

The compared goods and/or services need not be identical or even competitive to find a likelihood of confusion. See *On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 1086, 56 USPQ2d 1471, 1475 (Fed. Cir. 2000); *Recot, Inc. v. Becton*, 214 F.3d 1322, 1329, 54 USPQ2d 1894, 1898 (Fed. Cir. 2000); TMEP §1207.01(a)(i). They need only be “related in some manner and/or if the circumstances surrounding their marketing are such that they could give rise to the mistaken belief that [the goods and/or services] emanate from the same source.” *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1369, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012) (quoting *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1724 (TTAB 2007)); TMEP §1207.01(a)(i).

In this case, many of applicant’s goods and services are broadly identified so that the exact subject area or purpose is unknown; however, it can be presumed that applicant’s goods also feature religious texts or materials from the Bible and its other goods and services are used to support or complement these recorded and digital/online materials as applicant’s wording includes references to religion/religious education.

Here, because the marks are highly similar and the goods/services are presumed to be very closely related, if not legally identical in part, registration is refused under Section 2(d).

The overriding concern is not only to prevent buyer confusion as to the source of the goods and/or services, but to protect the registrant from adverse commercial impact due to use of a similar mark by a newcomer. See *In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993). Therefore, any doubt regarding a likelihood of confusion determination is resolved in favor of the registrant. TMEP §1207.01(d)(i); see *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1265, 62 USPQ2d 1001, 1003 (Fed. Cir. 2002); *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 464-65, 6 USPQ2d 1025, 1026 (Fed. Cir. 1988).

Although applicant’s mark has been refused registration, applicant may respond to the refusal(s) by submitting evidence and arguments in support of registration.

IDENTIFICATION OF GOODS/SERVICES

The identification of goods and/or services contains brackets. Generally, applicants should *not* use parentheses and brackets in identifications in their applications so as to avoid confusion with the USPTO’s practice of using parentheses and brackets in registrations to indicate goods and/or services that have been deleted from registrations or in an affidavit of incontestability to indicate goods and/or services not claimed. See TMEP §1402.12. The only exception is that parenthetical information is permitted in identifications in an application if it serves to explain or translate the matter immediately preceding the parenthetical phrase in such a way that it does not affect the clarity or scope of the identification, e.g., “fried tofu pieces (abura-age).” *Id.*

There are also a select few identifications taken straight from the Identification Manual which contain brackets and are acceptable under international treaty. Therefore, as shown below, applicant must remove the parentheses and brackets from the identification and incorporate any parenthetical or bracketed information into the description of the goods, not otherwise taken directly from the Manual.

In addition to the wording with brackets noted by the examiner below:

Class 009: The wording “recorded and downloadable media,” “compact discs [audio-video],” “monitors [computer programs],” “computer software, recorded,” “computer software platforms, recorded or downloadable,” “computer software applications, downloadable,” “computer programs, recorded,” “computer programs, downloadable,” “electronic publications, downloadable,” “audiovisual teaching apparatus,” “downloadable image files,” “animated cartoons,” “chips [integrated circuits],” “software,” “compact discs [read-only memory],” and “screens [photography]” in the identification of goods is indefinite and must be clarified because the exact nature of the goods is unknown. The identification for the various software is indefinite and

too broad and must be clarified to specify the purpose or function of the software and its content or field of use, if content- or field- specific. In the case of the electronic publications, applicant must specify the format and subject area.

Class 016: Applicant must clarify its “printed matter,” “albums,” “pamphlets,” “booklets,” “magazines [periodicals],” “periodicals,” “printed publications,” “catalogues,” “books,” “teaching materials [except apparatus],” “prospectuses,” “manuals [handbooks],” “instructional and teaching materials” and “flyers” as the subject area of the various printed periodicals and publications is unknown and applicant must specify its type of printed matter, albums, instructional and teaching material, e.g., printed calendars, photo albums, classroom posters, etc.

Class 028: Applicant must specify its “games and playthings” (“games” listed twice) by type, e.g., puzzles, card games, etc. and specify its type of “portable games and toys incorporating telecommunication functions,” e.g., portable handheld game consoles incorporating telecommunication functions, portable musical toys incorporating telecommunication functions, etc.

Class 035: Applicant must specify its “online retail services (listed three times) and “wholesale services” by type, e.g., online retail store services, wholesale ordering services, etc. Applicant is advised that under the newest Nice Agreement (1/1/20), “design of advertising materials” was deleted and replaced with “development of advertising concepts” as the wording could encompass graphic design services properly in Class 042. As applicant’s filing date predates this Nice change, applicant is not required to change this wording but may wish to do so. The wording “data search in computer files for others” is indefinite as the exact nature of the services is unknown and is overly broad as it may include public document retrieval, which is properly classified in International Class 042. Applicant must clarify its “registration of written communications and data” to specify the field, e.g., state vehicle registrations, ownership of securities, etc. Applicant must clarify its “procurement services for others [purchasing goods and services for other businesses]” by specifying the field of goods and services, e.g., office supplies and equipment, furniture, etc. Lastly, the wording “presentation of goods on communication media, for retail purposes” is unacceptable and has been replaced in the ID Manual with “providing television home shopping services in the field of general consumer merchandise.”

Class 038: Applicant must specify its “telecommunications” by type, e.g., wireless telephone services, electronic transmission of email, etc. Similar to above with the most recent Nice Agreement changes, the wording “information about telecommunication” has been replaced by “information about telecommunications.” Applicant must specify the function/purpose of the “providing online forums,” e.g., for transmission of messages among computer users, etc.

Class 041: Applicant must specify its “education” by format and subject area, e.g., classes in the field of math and science, etc. and specify its “cultural activities” by type, e.g., organization of cultural shows and events, etc. The wording “education information” has been replaced by the wording “providing information about education” in the latest Nice changes. Applicant must specify the format of its “religious education,” e.g., classes, seminars, etc. Applicant must specify the subject areas for its “correspondence courses,” “practical training [demonstration],” “arranging and conducting of colloquiums,” “arranging and conducting of congresses,” “arranging and conducting of conferences,” “arranging and conducting of workshops [training],” “arranging and conducting of symposiums,” “organization of competitions [education]” and/or indicating that the colloquiums, congresses, conferences, and symposiums are for “educational purposes.” Applicant must specify the nature of its “television entertainment,” e.g., providing ongoing television programs in the field of children’s entertainment, etc. Applicant must specify the subject area of its “providing online videos, not downloadable,” e.g., children’s entertainment, animated cartoons, etc. Applicant must specify the format and subject area for its “providing online electronic publications, not downloadable,” e.g., books in the field of music. Applicant must specify the type of live performances for its “presentation of live performances,” e.g., live theatrical or stage performances, etc. Applicant must specify that its “writing of texts” is in the nature of “publicity texts” and specify the subject area for its “teaching,” e.g., art, music, etc. Similar to the live performances, applicant must clarify the type of shows for its “production of shows,” e.g., theatrical, television, etc. Applicant must specify the format and subject area for its “academies [education],” e.g., providing classes and seminars in the field of music and art, etc. Lastly, applicant must specify the subject area for its “arranging and conducting of in-person educational forums,” e.g., math, science, etc.

Class 042: Applicant must specify its type of “scientific and technological services” and subject area, e.g., scientific testing and technological analysis in the field of automotive engineering, computer hardware, etc. and similarly specify its subject area for its “technological research,” e.g., in the field of engineering, software development, etc. Applicant must clarify that its “monitoring of computer systems by remote access” is “to ensure proper functioning.” Applicant must specify the function(s) of its “software as a service [SaaS]” and “platform as a service [PaaS]” as the exact nature of the services is unknown, e.g., software as a service [SaaS] services featuring software for word processing, editing digital images, etc. and platform as a service [PaaS] featuring computer software platforms for word processing, editing digital images, etc. Applicant must specify the subject area for its “conducting technical project studies,” e.g., in the field of engineering, computer software development, etc. Lastly, applicant must clarify its “cloud computing” as the exact nature of the services is unknown, e.g., cloud hosting provider services, cloud computing featuring software for word processing, editing digital images, etc.

Class 045: Applicant must clarify its “personal and social services rendered by others to meet the needs of individuals” as the exact kinds of services are unknown, e.g., personal shopping, personal care assistance comprised of bathing and grooming, etc.

See TMEP §1402.01.

Applicant may adopt the following amended identification, if accurate:

- Recorded and downloadable media, namely, {SPECIFY by type and subject area, e.g., e-books featuring children’s entertainment recorded on computer media and downloadable, multimedia files featuring poetry and music recorded on computer media and downloadable, etc.}; electronic notice boards; audio interfaces; road signs, luminous or mechanical; interfaces for computers; electronic book readers; electronic agendas; recorded compact discs featuring {SPECIFY audio-video content, e.g., music children’s entertainment, etc.}; recorded and downloadable computer programs for monitoring {SPECIFY item/process to be monitored, e.g., residential alarm systems, operation of home appliances, etc.}; computer software, recorded, for {SPECIFY function, e.g., word processing, editing digital images, etc.}; computer software platforms, recorded or downloadable, for {SPECIFY function, e.g., word processing, editing digital images, etc.};

computer software applications, downloadable for {SPECIFY function, e.g., word processing, editing digital images, etc.}; computer programs, recorded for {SPECIFY function, e.g., word processing, editing digital images, etc.}; computer game software, downloadable; computer game software, recorded; computer programs, downloadable for {SPECIFY function, e.g., word processing, editing digital images, etc.}; computer operating programs, recorded; computer screen saver software, recorded or downloadable; electronic publications, downloadable, namely, {SPECIFY by type and subject area, e.g., books and magazines in the field of sports and entertainment, etc.}; audiovisual teaching apparatus, namely, {SPECIFY by type, e.g., video projector, electronic sports training simulator, etc.}; integrated circuits; printed circuits; downloadable image files containing {SPECIFY field, e.g., appliance manuals, emoticons for mobile phones etc.}; downloadable music files; animated cartoons, namely, {SPECIFY format, e.g., downloadable cartoon strips, video disks and video tapes with recorded animated cartoons, etc.}; integrated circuit chips for encoding and decoding digital video and for digital video compression and decompression; downloadable graphics for mobile phones; electronic interactive whiteboards; recorded and downloadable software for {SPECIFY function, e.g., word processing, editing digital images, etc.}; downloadable emoticons for mobile phones; blank compact discs; screens adapted for photographic equipment and purposes; downloadable ring tones for mobile phones [INT. CLASS 009]

- Printed matter, namely, {SPECIFY by type, e.g., calendars, certificates, etc.}; printed photographs; {SPECIFY type, e.g., photo, stamp, etc.} albums; almanacs; banners of paper; pamphlets in the field of {SPECIFY subject area, e.g., sports and entertainment, etc.}; booklets in the field of {SPECIFY subject area, e.g., sports and entertainment, etc.}; newspapers; magazines in the field of {SPECIFY subject area, e.g., sports and entertainment, etc.}; printed periodicals in the field of {SPECIFY subject area, e.g., sports and entertainment, etc.}; printed publications, namely, {SPECIFY type and subject area, e.g., books and magazines in the field of sports and entertainment, etc.}; calendars; catalogues in the field of {SPECIFY subject area, e.g., clothing, musical recordings, etc.}; books in the field of {SPECIFY subject area, e.g., sports and entertainment, etc.}; teaching materials, namely, {SPECIFY by type, e.g., classroom posters, manuals for operating computers, etc.}; musical greeting cards; greeting cards; postcards; prospectuses in the field of {SPECIFY subject area, e.g., sports and entertainment, etc.}; manuals and handbooks in the field of {SPECIFY subject area, e.g., computers, home appliances, etc.}; instructional and teaching materials, namely, {SPECIFY by type, e.g., classroom posters, manuals for operating computers, etc.}; posters; informational flyers featuring {SPECIFY content, e.g., shopping sales, real estate open houses, etc.} [INT. CLASS 016]
- Games and playthings, namely, {SPECIFY by type, e.g., card games, puzzles, etc.}; portable handheld game consoles and portable musical toys incorporating telecommunication functions; games, namely, {SPECIFY by type, e.g., card games, board games, etc.}; portable games with liquid crystal displays [INT. CLASS 028]
- Advertising agency services; computerized file management; demonstration of goods; marketing research; marketing; targeted marketing; business management of performing artists; scriptwriting for advertising purposes; updating and maintenance of information in registries; updating and maintenance of data in computer databases; updating of advertising material; word processing; online retail store services for downloadable and pre-recorded music and movies; online retail store services for downloadable ring tones; online retail store services for downloadable digital music; development of advertising concepts; providing business information via a web site; auctioneering; wholesale ordering services for recorded and downloadable media, electronic notice boards, audio interfaces, road signs, luminous or mechanical, interfaces for computers, electronic book readers, electronic agendas, recorded compact discs, monitoring computer programs, computer software, recorded, computer software platforms, recorded or downloadable, computer software applications, downloadable, computer programs, recorded, computer game software, downloadable, computer game software, recorded, computer programs, downloadable, computer operating programs, recorded, computer screen saver software, recorded or downloadable, electronic publications, downloadable, audiovisual teaching apparatus, integrated circuits, printed circuits, downloadable image files, downloadable music files, animated cartoons, chips being integrated circuits, downloadable graphics for mobile phones, electronic interactive whiteboards, software, downloadable emoticons for mobile phones, blank compact discs, screens for photography, downloadable ring tones for mobile phones, printed matter, printed photographs, albums, almanacs, banners of paper, pamphlets, booklets, newspapers, magazines, periodicals, printed publications, calendars, catalogues, books, teaching materials, musical greeting cards, greeting cards, postcards, prospectuses, manuals and handbooks, instructional and teaching materials, posters, flyers, games and playthings, portable games and toys incorporating telecommunication functions, games, portable games with liquid crystal displays; sales promotion for others; production of advertising films; publication of publicity texts; radio advertising; bill-posting; distribution of samples; dissemination of advertising matter; direct mail advertising; registration of written communications and data in the field of {SPECIFY area, e.g., state vehicle registrations, ownership of securities, etc.}; writing of publicity texts; advertising; online advertising on a computer network; advertising by mail order; television advertising; telemarketing services; search engine optimization for sales promotion; procurement services for others, namely, purchasing goods and services for other businesses in the field of {SPECIFY area, e.g., office supplies and equipment, furniture, etc.}; marketing in the framework of software publishing; providing television home shopping services in the field of general consumer merchandise [INT. CLASS 035]
- Telecommunications, namely, {SPECIFY by type, e.g., wireless telephone services, electronic transmission of email, etc.}; television broadcasting; cable television broadcasting; electronic bulletin board services; providing information in the field of telecommunication; providing user access to global computer networks; providing access to databases; providing telecommunications connections to a global computer network; providing telecommunication channels for teleshopping services; video-on-demand transmission; message sending; computer aided transmission of messages and images; transmission of digital files; providing online forums for transmission of messages among computer users; videoconferencing services; radio broadcasting; radio communications; transmission of electronic mail; communications by fiber optic networks; communications by cellular phones; communications by computer terminals; satellite transmission; teleconferencing services; streaming of data; wireless broadcasting; providing internet chatrooms; telecommunications routing and junction services [INT. CLASS 038]
- Education, namely, {SPECIFY format and subject area, e.g., providing classes and seminars in the field of art and music, etc.}; cultural activities, namely, {SPECIFY type, e.g., organization of cultural shows and events, etc.}; videotaping; production of music; publication of books; providing information about education; film distribution; movie studio services; layout services, other than for advertising purposes; microfilming; videotape editing; production of radio and television programmes; screenplay writing; religious education, namely, {SPECIFY format, e.g., providing classes and seminars in the field of religion, etc.}; correspondence courses in the field of {SPECIFY subject area,

e.g., business, math, etc.}; practical training in the field of {SPECIFY subject area, e.g., computers, music, etc.}; providing recreation facilities; arranging and conducting of educational colloquiums; arranging and conducting of educational congresses; arranging and conducting of educational conferences; arranging and conducting of concerts; arranging and conducting of workshops and training in the field of {SPECIFY subject area, e.g., art, music, etc.}; arranging and conducting of seminars; arranging and conducting of educational symposiums; organization of educational competitions in the field of {SPECIFY subject area, e.g., spelling, geography, etc.}; television entertainment, namely, {SPECIFY type, e.g., providing ongoing television programs in the field of children's entertainment, television news shows, etc.}; providing online videos in the field of {SPECIFY subject area, e.g., children's entertainment, animated cartoons, etc.}, not downloadable; providing online music, not downloadable; providing television programs, not downloadable, via video-on-demand services; providing films, not downloadable, via video-on-demand services; providing online electronic publications, not downloadable, namely, {SPECIFY type and subject area, e.g., books and magazines in the field of art and music, etc.}; presentation of live {SPECIFY type, e.g. musical, stage, etc.} performances; theatre productions; film production, other than advertising films; rental of videotapes; rental of sound recordings; rental of motion pictures; electronic desktop publishing; online publication of electronic books and journals; publication of texts, other than publicity texts; writing of publicity texts; film directing, other than advertising films; music composition services; subtitling; video editing services for events; sound engineering services for events; game services provided online from a computer network; teaching in the field of {SPECIFY subject area, e.g., art, music, etc.}; scriptwriting, other than for advertising purposes; photography; photographic reporting; production of {SPECIFY type, e.g., theatrical, television, etc.} shows; academies, namely, providing {SPECIFY format and subject area, e.g., classes and seminars in the field of math and science, etc.}; organization of exhibitions for cultural or educational purposes; presentation of variety shows; arranging and conducting of in-person educational forums in the field of {SPECIFY subject area, e.g., math and science, etc.} [INT. CLASS 041]

- Scientific and technological services, namely, {SPECIFY by type and subject area, e.g., scientific testing and technological analysis in the field of engineering and software development, etc.} and research and design relating thereto; design and development of computer hardware and software; graphic arts design; computer virus protection services; installation of computer software; research in the field of telecommunications technology; research and development of new products for others; scientific research; technological research in the field of {SPECIFY subject area, e.g., software development, computer hardware, etc.}; web site design consultancy; information technology [IT] consultancy; consultancy in the design and development of computer hardware; computer software consultancy; data security consultancy; updating of computer software; monitoring of computer systems to detect breakdowns; monitoring of computer systems for detecting unauthorized access or data breach; monitoring of computer systems by remote access to ensure proper functioning; software as a service [SaaS], namely, {SPECIFY type, e.g., providing software for word processing and editing digital images, etc.}; maintenance of computer software; conversion of data or documents from physical to electronic media; providing information on computer technology and programming via a web site; providing search engines for the internet; platform as a service [PaaS], namely, {SPECIFY type, e.g., providing computer software platforms for word processing and editing digital images, etc.}; conversion of computer programs and data, other than physical conversion; conducting technical project studies in the field of {SPECIFY subject area, e.g., software development, engineering, etc.}; computer system design; hosting computer web sites; development of computer platforms; computer software design; software development in the framework of software publishing; creating and designing website-based indexes of information for others being information technology services; creating and maintaining web sites for others; computer programming; copying of computer programs; cloud computing, namely, {SPECIFY by type, e.g., cloud hosting provider services, cloud computing featuring software for word processing, editing digital images, etc.}; outsource service providers in the field of information technology; off-site data backup; computer technology consultancy; telecommunications technology consultancy; electronic data storage; graphic design of promotional materials; server hosting [INT. CLASS 042]
- Online social networking services; spiritual consultancy; personal and social services rendered by others to meet the needs of individuals, namely, {SPECIFY by type, e.g., personal shopping, personal care assistance comprised of bathing and grooming, etc.} [INT. CLASS 045]

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).

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.

U.S. COUNSEL REQUIRED

Applicant must be represented by a U.S.-licensed attorney at the USPTO to respond to or appeal the provisional refusal. An applicant whose domicile is located outside of the United States or its territories is foreign-domiciled and must be represented at the USPTO by an attorney who is an active member in good standing of the bar of the highest court of a U.S. state or territory. 37 C.F.R. §§2.11(a), 11.14; *Requirement of U.S.-Licensed Attorney for Foreign-Domiciled Trademark Applicants & Registrants*, Examination Guide 4-19, at I.A. (Rev. Sept. 2019). An individual applicant's domicile is the place a person resides and intends to be the person's principal home. 37 C.F.R. §2.2(o); Examination Guide 4-19, at I.A. A juristic entity's domicile is the principal place of business; i.e., headquarters, where a juristic entity applicant's senior executives or officers ordinarily direct and control the entity's activities. 37 C.F.R. §2.2(o); Examination Guide 4-19, at I.A. Because applicant is foreign-domiciled, applicant must appoint such a U.S.-licensed attorney qualified to practice under 37 C.F.R. §11.14 as its representative before the application may proceed to registration. 37 C.F.R. §2.11(a). See [Hiring a U.S.-licensed trademark attorney](#) for more information.

To appoint or designate a U.S.-licensed attorney. To appoint an attorney, applicant should submit a completed Trademark Electronic Application System (TEAS) [Revocation, Appointment, and/or Change of Address of Attorney/Domestic Representative](#) form. The newly-appointed attorney must submit a TEAS [Response to Examining Attorney Office Action](#) form indicating that an appointment of attorney has been made and address all other

refusals or requirements in this action, if any. Alternatively, if applicant retains an attorney before filing the response, the attorney can respond to this Office action by using the appropriate TEAS response form and provide his or her attorney information in the form and sign it as applicant's attorney. See 37 C.F.R. §2.17(b)(1)(ii).

PARIS PRIORITY ADVISORY

Applicant's U.S. application includes a claim of priority under Trademark Act Section 67. 15 U.S.C. §1141g; 37 C.F.R. §7.27. The foreign application that forms the basis for the priority claim was filed on March 15, 2019, and the filing date of the U.S. application filed under Section 66(a) is September 20, 2019. A claim of priority is accepted only if a Section 66(a) application is filed within six months of the filing date of the foreign application that forms the basis for the priority claim. 15 U.S.C. §1141g; 37 C.F.R. §7.27; TMEP §§806.01(e), 1904.01(e). Thus, in this case, the priority claim is not accepted because the Section 66(a) application was filed more than six months after the filing date of the foreign application that forms the basis for the priority claim. See TMEP §1904.01(e).

Applicant is encouraged to call or email the assigned trademark examining attorney below to resolve the issues in this Office action. Although the USPTO will not accept an email as a response to an Office action, an applicant can communicate by phone or email to agree to a proposed amendment to the application that will immediately place the application in condition for publication, registration, or suspension. See 37 C.F.R. §2.62(c); TMEP §707.

Note: An applicant may check the status of or view documents filed in an application or registration using the Trademark Status and Document Retrieval (TSDR) system. Enter the application serial number or registration number and click on "Status" or "Documents."

How to respond. Click to file a response to this nonfinal Office action.

Toby Bulloff
/Toby E. Bulloff/
Examining Attorney
Law Office 119
(571) 270-1531
toby.bulloff@uspto.gov

RESPONSE GUIDANCE

- **Missing the response deadline to this letter will cause the application to abandon.** A response or notice of appeal must be received by the USPTO before midnight **Eastern Time** of the last day of the response period. TEAS and ESTTA maintenance or unforeseen circumstances could affect an applicant's ability to timely respond.
- **Responses signed by an unauthorized party are not accepted and can **cause the application to abandon**.** If applicant does not have an attorney, the response must be signed by the individual applicant, all joint applicants, or someone with legal authority to bind a juristic applicant. If applicant has an attorney, the response must be signed by the attorney.
- If needed, **find contact information for the supervisor** of the office or unit listed in the signature block.

DESIGN MARK

Serial Number

77147046

Status

REGISTERED AND RENEWED

Word Mark

IBIBLE

Standard Character Mark

Yes

Registration Number

3414119

Date Registered

2008/04/22

Type of Mark

TRADEMARK

Register

PRINCIPAL

Mark Drawing Code

(4) STANDARD CHARACTER MARK

Owner

the story box PARTNERSHIP SINGAPORE 643 Bedok Reservoir Road #04-81
Singapore SINGAPORE 410643

Goods/Services

Class Status -- ACTIVE. IC 009. US 021 023 026 036 038. G & S:
Recorded audio discs featuring the recorded Bible; Audio speaker
enclosures; Audio speakers; computer hardware and computer software
programs for the integration of text, audio, graphics, still image and
moving pictures into an interactive delivery for multimedia
applications; digital audio players; digital audio tape players;
digital audio tape recorders; digital flash memory cards, personal
digital assistants (PDA), digital materials, in form of, namely, CDs,
DVDs, downloadable audio files, featuring the recorded Bible; digital
media in form of, namely, CDs, DVDs, downloadable audio files, digital
flash cards, featuring the recorded Bible. First Use: 2005/01/01.
First Use In Commerce: 2007/01/01.

Filing Date

2007/04/03

Examining Attorney

Print: Jan 8, 2020

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