
To: Benjamin P. Harbuck(trademarks.us@dentons.com)
Subject: U.S. Trademark Application Serial No. 79345163 - SHIMMER - 15800169-007
Sent: April 12, 2023 09:07:21 PM EDT
Sent As: tmng.notices@uspto.gov

Attachments

3466971

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

U.S. Application Serial No. 79345163

Mark: SHIMMER

Correspondence Address:

Benjamin P. Harbuck
Dentons US LLP
P.O. Box 1302
Chicago IL 60604 UNITED STATES

Applicant: IOTA Stiftung

Reference/Docket No. 15800169-007

Correspondence Email Address: trademarks.us@dentons.com

**NONFINAL OFFICE ACTION
Notice of Provisional Full Refusal**

International Registration No. 1672527

Issue date: April 12, 2023

Deadline for responding. The USPTO must receive applicant's response to this letter within six months of the issue date or the application will be abandoned. Respond using the 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. §§1141f(a), 1141h(c).

INTRODUCTION

This Office action is supplemental to and supersedes the previous Office action issued on July 18, 2022 in connection with this application. The assigned trademark examining attorney wishes to correct the record by addressing the issue(s) inadvertently omitted from the previous Office action. *See* TMEP §§706, 711.02. Specifically, the undersigned proposed applicant amend its Class 036 identification entry "financial services, namely for buying, selling and trading non-fungible tokens" to "financial services, namely, ~~for~~ buying, selling and trading **{describe items being traded, e.g., art images, music, video clips, etc.} authenticated by** non-fungible tokens". However, as discussed in greater detail in this superseding Office action, this proposed amendment does not describe services in Class 036.

Moreover, the undersigned failed to advise applicant that its use of the wording "downloadable e-wallets" in Class 009 is unacceptable because "EWALLETS" is a registered mark.

The trademark examining attorney apologizes for any inconvenience caused by the delay in raising this issue(s).

Applicant must address the issue(s) raised in this Office action, in addition to the one(s) raised in the previous Office action dated July 18, 2022. The following issue raised in the previous Office action is **maintained**: AMENDED IDENTIFICATION OF GOODS AND SERVICES REQUIRED.

Moreover, based on applicant's identification amendments, the following refusal and advisory have been **obviated**: (1) SECTION 2(d) REFUSAL – LIKELIHOOD OF CONFUSION IN PART and (2) ADVISORY: PRIOR-FILED APPLICATIONS.

Finally, the following requirements set forth in the July 18, 2022 Office action have been **satisfied**: (1) MARK DESCRIPTION AND AMENDED COLOR CLAIM REQUIRED; (2) CLARIFICATION OF FOREIGN ENTITY REQUIRED; (3) EMAIL ADDRESS REQUIRED; and (4) U.S.-LICENSED ATTORNEY REQUIRED. *See* TMEP §713.02.

SUMMARY OF ISSUES:

- AMENDED IDENTIFICATION OF GOODS AND SERVICES REQUIRED

AMENDED IDENTIFICATION OF GOODS AND SERVICES REQUIRED

The applicant's identification of goods and services contains a number of words that are indefinite and/or overbroad as it contains words that do not clearly identify goods and services within a class and/or could identify goods and services in more than one international class. *See* 37 C.F.R. §2.32(a)(6); TMEP §§ 1402.01, 1402.03. The proposed amendments set forth in this requirement, *infra*, address this overbroad and/or indefinite language.

Further, particular wording in the identification in the application is indefinite and must be clarified because it does not appear to describe any services in the identified international class(es). *See* 37 C.F.R. §2.32(a)(6); TMEP §§1402.01, 1904.02(c)(iii). Generally, a trademark examining attorney will recommend language to replace unacceptable wording in identifications of services. *See* TMEP §1402.01(e). However, in this case, the trademark examining attorney is unable to suggest alternative wording because the text that follows in International Class 036 is indefinite and does not appear to describe any services in that class:

- Applicant's amended entry for "financial services, namely, for buying, selling and trading . . . artworks, text, videos, audio and photographs authenticated by non-fungible tokens" does not appear to describe services in Class 036. Class 036 financial trading services involve trading of financial instruments, like cryptocurrencies, securities options, or currency. Instead, this language appears to describe Class 035 marketplace services for buyers and sellers of downloadable digital goods authenticated by non-fungible tokens or arranging of trading transactions of downloadable digital goods authenticated by non-fungible tokens.
- Applicant's amended entry for "decentralised finance services, namely, providing a platform for trading and exchanging digital tokens of value, cryptocurrencies and securities" does not appear to describe services in Class 036. Downloadable computer software platforms are classified in Class 009 and services of providing website platforms and providing online non-downloadable computer software platforms are classified in Class 042.

See TMEP §1904.02(c)(iii).

Applicant may respond by amending this wording to clarify the nature of the services; however, any amendment to the identification must identify services in International Class 036 and be within the scope of the wording in the initial application. *See* TMEP §§1402.01(c), 1402.07(a), 1904.02(c)(iii). The scope of the identification for purposes of permissible amendments is limited by the international class(es) assigned by the International Bureau of the World Intellectual Property Organization (International Bureau). 37 C.F.R. §2.85(f); TMEP §§1402.07(a), 1904.02(c). If an applicant amends to goods and/or services that are in a class other than that assigned by the International Bureau, the amendment will not be accepted because it would exceed the scope and those goods and/or services would no longer have a basis for registration under U.S. law. TMEP §§1402.01(c), 1904.02(c).

Alternatively, applicant may delete this unacceptable wording from the identification. *See* TMEP §1904.02(c)(iii)-(iv). However, once an application has been expressly amended to delete services, those items generally may not later be re-inserted. *See* TMEP §1402.07(e).

If applicant believes the classification assigned by the International Bureau was in error, applicant may contact the International Bureau and request correction of, or recordation of a limitation to, the international registration. TMEP §1904.02(c)(iii)-(iv), (e)(i)-(e)(ii). However, filing such a request with the International Bureau is not considered a formal response to this Office action. *See* TMEP §1904.02(c)(iv), (e)(iii). Applicant must also file a timely and complete response to this Office action, stating that applicant has filed a request for a correction or to record a limitation with the International Bureau that will resolve the outstanding issue. *See* 15 U.S.C. §1062(b); 37 C.F.R. §2.62(a); TMEP §§711, 718.03, 1904.02(c)(iii)-(iv), (e)(iii). The response should include (1) a copy of the request for correction or limitation filed with the International Bureau and (2) a request to suspend action on the application, which will normally be granted under such circumstances. *See* TMEP §§716.02(g), 1904.02(c)(iii)-(iv).

In addition, the wording "e-wallets" in the identification of goods in Class 009 is a plural and punctuated form of a registered mark not owned by applicant; accordingly, applicant must amend the identification to delete this wording and, if not already included in the identification, provide the common commercial or generic name of the goods. TMEP §1402.09; *see* 37 C.F.R. §2.32(a)(6); *Camloc Fastener Corp. v. Grant*, 119 USPQ 264, 264 n.1 (TTAB 1958). *See* attached U.S. Registration

No(s). 3466971.

Identifications of goods and/or services should generally be comprised of generic everyday wording for the goods and/or services, and exclude proprietary or potentially-proprietary wording, such as a registered term. *See* TMEP §§1402.01, 1402.09. The misspelling or phonetic equivalent of a registered mark should similarly be excluded, unless it is the common name of the goods and/or services. TMEP §1402.09. A registered mark indicates origin in one particular party and so may not be used to identify goods and/or services that originate in a party other than that registrant. TMEP §1402.09 (citing *Camloc Fastener Corp. v. Grant*, 119 USPQ at 264 n.1).

Applicant may replace such wording with the following, if appropriate: “electronic wallets.”

Finally, applicant should note that the USPTO has the discretion to determine the degree of particularity needed to clearly identify goods and services covered by a mark. *In re SICPA Holding*, 2021 USPQ2d 613, at *4 (TTAB 2021) (quoting *In re Omega SA*, 494 F.3d 1362, 1365, 83 USPQ2d 1541, 1543-44 (Fed. Cir. 2007)). Accordingly, the USPTO requires the description of goods and services in a U.S. application to be specific, definite, clear, accurate, and concise. *In re tapio GmbH*, 2020 USPQ2d 11387, at *6 (TTAB 2020) (quoting *In re Cordua Rests., Inc.*, 823 F.3d 594, 605, 118 USPQ2d 1632, 1639 (Fed. Circ. 2016)); TMEP §1402.01.

Applicant may adopt the following wording to address the errors identified above, if accurate (please note, proposed language to be added has been bolded and proposed language to remove has been struck through):

- **Class 009:** Downloadable and recorded computer software for processing transactions on a distributed ledger in the field of distributed ledger technology, cryptocurrencies, non-fungible tokens and other digital assets; Downloadable and recorded computer software for processing transactions on a distributed ledger in the field of decentralised finance; Downloadable and recorded computer software for buying and selling cryptocurrencies, non-fungible tokens and other digital assets; Downloadable and recorded computer software for creating and issuing cryptocurrencies, non-fungible tokens and other digital assets; ~~downloadable e-wallets being~~ downloadable computer software for use as an electronic wallet; Downloadable and recorded computer software for use as an electronic wallet for securing and storing cryptocurrencies, non-fungible tokens and other digital assets; Downloadable and recorded computer software for encryption; Downloadable and recorded computer software for use in processing transactions between connected devices in the internet of things ~~(IoT)~~ **(IOT)**; Downloadable and recorded computer software to enable secure financial transactions; Downloadable and recorded computer software for electronic commerce to allow users to perform electronic business transactions via a distributed ledger network; Downloadable and recorded computer software for performing secure cryptocurrency transactions
- **Class 036:** Virtual currency services, namely, virtual currency exchange services and virtual currency transfer services; electronic payment processing for virtual currencies; cryptocurrency services, namely, issuing virtual currency ~~or~~ and digital tokens of value for use by members of an online community via a global computer network; cryptocurrency services, namely, issuing of a peer-to-peer digital currency of value that incorporates cryptographic protocols, operates over the internet, and is used as a method of payment for goods and services; issuing of tokens of value, namely, issuing of stablecoins, stable tokens, tokenized fiat **currency**, tokenized assets, virtual currency and digital tokens of value using smart contracts, ~~asset-backed asset-~~

backed tokens, fiat-backed tokens and digital assets; electronic financial trading services, namely, digital currency, digital securities, digital tokens of value and cryptocurrency trading services; currency transfer services, namely, transfer of digital currency, digital securities, digital tokens of value and cryptocurrencies; financial services, namely, ~~for~~ buying, selling and trading securities, ~~artworks, text, videos, audio and photographs~~ authenticated by non-fungible tokens; ~~decentralised finance services, namely, providing a platform for trading and exchanging digital tokens of value, cryptocurrencies and securities~~

- Class 042: Development of distributed ledger technology software for cryptocurrencies, non-fungible tokens and other digital assets; technical advisory services in the ~~field~~ **field of** distributed ledger technology software for cryptocurrencies, non-fungible tokens and other digital assets; expert consultancy services in the field of distributed ledger technology software; Providing technology information in the field of design and development of distributed ledger technology software for cryptocurrencies, non-fungible tokens and other digital assets; computer programming services for electronic data security in the field of distributed ledger technology; programming of operating software for computer networks and servers in the field of distributed ledger technology; data security consultancy in the field of distributed ledger technology; design and development of electronic data security systems in the field of distributed ledger technology; data encryption and decoding services in the field of distributed ledger technology

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.

Amendment of Identification in a Section 66(a) Application Restricted by Scope. Applicant's goods and services may be clarified or limited, but may not be expanded beyond those originally itemized in the application or as acceptably narrowed. See 37 C.F.R. §2.71(a); TMEP §§1402.06, 1904.02(c)(iv). Applicant may clarify or limit the identification by inserting qualifying language or deleting items to result in a more specific identification; however, applicant may not substitute different goods and services or add goods and services not found or encompassed by those in the original application or as acceptably narrowed. See TMEP §1402.06(a)-(b). The scope of the goods and services sets the outer limit for any changes to the identification and is generally determined by the ordinary meaning of the wording in the identification. TMEP §§1402.06(b), 1402.07(a)-(b). Any acceptable changes to the goods and services will further limit scope, and once goods and services are deleted, they are not permitted to be reinserted. 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 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 services transferred from one existing class to another. 37 C.F.R. §2.85(d); TMEP §1401.03(d).

RESPONDING TO THIS OFFICE ACTION

For this application to proceed, applicant must explicitly address each refusal and/or requirement in this Office Action. For a refusal, applicant may provide written arguments and evidence against the refusal, and may have other response options if specified above. For a requirement, applicant should set forth the changes or statements. Please see "Responding to Office Actions" and the informational video

“Response to Office Action” for more information and tips on responding.

Please call or email the assigned trademark examining attorney with questions about this Office Action. Although an examining attorney cannot provide legal advice, the examining attorney can provide additional explanation about the refusal(s) and/or requirement(s) in this Office Action. *See* TMEP §§705.02, 709.06.

The USPTO does not accept emails as responses to Office Actions; however, emails can be used for informal communications and are included in the application record. *See* 37 C.F.R. §§2.62(c), 2.191; TMEP §§304.01-.02, 709.04-.05.

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

/Alberto Manca/
Alberto Manca
Trademark Examining Attorney
Law Office 108
(571) 272-5232
Alberto.Manca@uspto.gov

RESPONSE GUIDANCE

- **Missing the response deadline to this letter will cause the application to abandon.** The response must be received by the USPTO before midnight **Eastern Time** of the last day of the response period. TEAS 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.

Print: Wed Apr 12 2023

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(4) STANDARD CHARACTER MARK

EWALLET

Mark Punctuated
EWALLET

Translation

Goods/Services

- IC 009. US 021 023 026 036 038.G & S: COMPUTER SOFTWARE FOR PERSONAL INFORMATION MANAGEMENT. FIRST USE: 19971029. FIRST USE IN COMMERCE: 19971029

Mark Drawing Code
(4) STANDARD CHARACTER MARK

Design Code

Serial Number
77333087

Filing Date
20071119

Current Filing Basis
1A

Original Filing Basis
1A

Publication for Opposition Date
20080429

Registration Number
3466971

Date Registered
20080715

Owner
(REGISTRANT) Ilium Software, Inc. CORPORATION MICHIGAN 3759 Prospect Ann Arbor MICHIGAN 48105

Priority Date

Disclaimer Statement

Description of Mark

Type of Mark
TRADEMARK

Register
PRINCIPAL

Live Dead Indicator
LIVE

Attorney of Record
Christopher M. Taylor

United States Patent and Trademark Office (USPTO)

USPTO OFFICIAL NOTICE

Office Action (Official Letter) has issued
on April 12, 2023 for
U.S. Trademark Application Serial No. 79345163

A USPTO examining attorney has reviewed your trademark application and issued an Office action. You must respond to this Office action in order to avoid your application abandoning. Follow the steps below.

- (1) **Read the Office action.** This email is NOT the Office action.
- (2) **Respond to the Office action by the deadline** using the Trademark Electronic Application System (TEAS). Your response must be received by the USPTO on or before 11:59 p.m. **Eastern Time** of the last day of the response period. Otherwise, your application will be **abandoned**. See the Office action itself regarding how to respond.
- (3) **Direct general questions** about using USPTO electronic forms, the USPTO website, the application process, the status of your application, and whether there are outstanding deadlines to the Trademark Assistance Center (TAC).

After reading the Office action, address any question(s) regarding the specific content to the USPTO examining attorney identified in the Office action.

GENERAL GUIDANCE

- **Check the status of your application periodically** in the Trademark Status & Document Retrieval (TSDR) database to avoid missing critical deadlines.
- **Update your correspondence email address** to ensure you receive important USPTO notices about your application.
- **Beware of trademark-related scams.** Protect yourself from people and companies that may try to take financial advantage of you. Private companies may call you and pretend to be the USPTO or may send you communications that resemble official USPTO documents to trick you. We will never request your credit card number or social security number over the phone. Verify the correspondence originated from us by using your Serial Number in our database, TSDR, to confirm that it appears under the “Documents” tab, or contact the Trademark Assistance Center.
- **Hiring a U.S.-licensed attorney.** If you do not have an attorney and are not required to

have one under the trademark rules, we encourage you to hire a U.S.-licensed attorney specializing in trademark law to help guide you through the registration process. The USPTO examining attorney is not your attorney and cannot give you legal advice, but rather works for and represents the USPTO in trademark matters.