
To: Benjamin P. Harbuck(trademarks.us@dentons.com)
Subject: U.S. Trademark Application Serial No. 79345163 - SHIMMER - 15800169-007
Sent: December 13, 2023 11:27:33 AM EST
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Attachments

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

U.S. Application Serial No. 79345163

Mark: SHIMMER

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Applicant: IOTA Stiftung

Reference/Docket No. 15800169-007

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

International Registration No. 1672527

Issue date: December 13, 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 partial refusal. This is a provisional partial 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). This refusal **applies to only the following services in International Class 036:** "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 tokens, fiat-backed tokens and digital assets" and "currency transfer services, namely, transfer of digital currency, digital securities, digital tokens of value and cryptocurrencies".

INTRODUCTION

This application was approved for publication on November 6, 2023. *See* 37 C.F.R. §2.80. However, approval of the application has been withdrawn to address the issue(s) below. *See* TMEP §706.01.

The examining attorney has identified an additional entry in applicant's Class 036 identification requiring amendment, and therefore issues the instant superseding action. Specifically, applicant's identification language "currency transfer services, namely, transfer of digital currency, digital securities, digital tokens of value and cryptocurrencies" requires further amendment for the reasons detailed herein.

The trademark examining attorney apologizes for any inconvenience this may cause applicant.

Applicant must address the issue(s) raised in this Office action, in addition to the one(s) raised in the previous Office action dated April 12, 2023. The following issue(s) raised in the previous Office action is/are maintained: AMENDED IDENTIFICATION OF GOODS AND SERVICES REQUIRED.

SUMMARY OF ISSUES that applicant must now address:

- AMENDED IDENTIFICATION OF GOODS AND SERVICES REQUIRED IN PART

AMENDED IDENTIFICATION OF CLASS 036 SERVICES REQUIRED IN PART

Please note—The following requirement applies only to the following services in Class 036: "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"; "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 tokens, fiat-backed tokens and digital assets"; "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"; and "currency transfer services, namely, transfer of digital currency, digital securities, digital tokens of value and cryptocurrencies".

The applicant's identification of services in Class 036 contains a number of words that are indefinite and/or overbroad as it contains words that do not clearly identify services within a class and/or could identify 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.

Specifically, applicant's wording "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" is

not acceptable because it is ambiguous. *See* TMEP §1402.01. Per TMEP §1402.03(a), the goods or services listed after "namely" must further define the introductory wording that precedes "namely" using definite terms within the scope of the introductory wording. The introductory clause indicates the services are "cryptocurrency services," but "virtual currency" is broader than cryptocurrency. In addition, the term "digital token" is generally understood as a packet of data located on a blockchain, and is therefore not a type of cryptocurrency. Thus, the services "issuing virtual currency" and "[issuing] digital tokens of value" are not services within the scope of "cryptocurrency services". Finally, the wording "or and" is generally not accepted in identifications when (1) it is unclear whether applicant is using the mark, or intends to use the mark, on all the identified goods or services; (2) the nature of the goods and services is unclear; or (3) classification cannot be determined from such wording. *See* TMEP §1402.03(a). In this case, it is unclear whether applicant is using the mark, or intends to use the mark, on all the identified services.

An application must specify, in an explicit manner, the particular services on or in connection with which the applicant uses, or has a bona fide intention to use, the mark in commerce. *See* 15 U.S.C. §1051(a)(2), (b)(2); 37 C.F.R. §2.32(a)(6); TMEP §1402.01. Therefore, applicant should replace "or and" with "and" in the identification of services, if appropriate, or rewrite the identification with the "or and" deleted and the services specified using definite and unambiguous language.

Similarly, applicant's wording "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 tokens, fiat-backed tokens and digital assets" is ambiguous as the wording following "namely" does not further define the services of "issuing of tokens of value". *See* TMEP §1402.01 and §1402.03(a). While the wording "issuing of tokens of value" is definite in Class 036, this wording refers to issuing of vouchers that are exchangeable for goods and services. These services are different from the "issuing of stablecoins, stable tokens, tokenized fiat currency, tokenized assets, virtual currency . . . asset-backed tokens, fiat-backed tokens and digital assets", which is indefinite wording that could encompass computer technology services in class 042, and may not constitute registrable service activities.

Further, applicant's wording "currency transfer services, namely, transfer of digital currency, digital securities, digital tokens of value and cryptocurrencies" is ambiguous because "currency" is a method of payment while, as explained above, "digital tokens of value" are pre-paid vouchers that are exchangeable for goods/services in electronic form. In addition, the wording "digital securities" refers to fungible, negotiable financial instruments that represent some type of financial value, usually in the form of a stock, bond, or option. Therefore, there is a disconnect between the introductory wording "currency transfer services" and the wording "digital tokens of value" and "digital securities", as these two items are not currency. The ID must therefore be clarified.

Finally, the wording "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" is indefinite and may not constitute a registrable service activity. *See* TMEP §§1402.01, 1402.03. Issuing currencies as a method of payment is generally not considered a service for others. The additional wording, "incorporates cryptographic protocols . . ." is merely a definition of cryptocurrency. Therefore, applicant must clarify the ID and specify a definite service activity.

Generally, a trademark examining attorney will recommend language to replace unacceptable wording in identifications of goods and/or services. *See* TMEP §1402.01(e). However, in this case, the

trademark examining attorney is unable to suggest alternative wording for the Class 036 entries "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" and "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" because this wording is indefinite and, as stated, does not appear to describe any services in that class and/or registrable services. *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 registrable 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 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 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 goods and/or 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).

Applicant should note that the USPTO has the discretion to determine the degree of particularity needed to clearly identify 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 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 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); 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 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, buying, selling and trading securities, authenticated by non-fungible tokens
- Class 042: Development of distributed ledger technology software for cryptocurrencies, non-fungible tokens and other digital assets; technical advisory services in the 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 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 services or add 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 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 services will further limit scope, and once 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 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 services transferred from one existing class to another. 37 C.F.R. §2.85(d); TMEP §1401.03(d).

RESPONDING TO THIS OFFICE ACTION AND PARTIAL ABANDONMENT ADVISORY

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.

Failing to respond to this provisional refusal Office action will result in partial abandonment of the U.S. application. If applicant does not respond within the six-month period, the services identified above, to which this provisional refusal applies, will be **deleted from the application**. *See* 37 C.F.R. §2.65(a)-(a)(1); TMEP §718.02(a).

In such case, the application will then proceed only with the following goods and services

- 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 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); 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; electronic financial trading services, namely, digital currency, digital securities, digital tokens of value and cryptocurrency trading services; financial services, namely, buying, selling and trading securities,

authenticated by non-fungible tokens

- Class 042: Development of distributed ledger technology software for cryptocurrencies, non-fungible tokens and other digital assets; technical advisory services in the 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

Please call or email the assigned trademark examining attorney to resolve the issues in this Office action. Although the USPTO does not accept emails as responses to Office actions, communication by phone or email is permissible to agree to proposed amendments 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.

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

/Alberto Manca/
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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.

United States Patent and Trademark Office (USPTO)

USPTO OFFICIAL NOTICE

Office Action (Official Letter) has issued
on December 13, 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.