

UNITED STATES PATENT AND TRADEMARK OFFICE**SERIAL NO:** 79/079862**MARK:** PANDA SECURITY***79079862*****CORRESPONDENT ADDRESS:**

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RESPOND TO THIS ACTION:**<http://www.uspto.gov/teas/eTEASpageD.htm>****GENERAL TRADEMARK INFORMATION:****<http://www.uspto.gov/main/trademarks.htm>**

APPLICANT: PANDA SECURITY,
S.L.

**CORRESPONDENT'S
REFERENCE/DOCKET NO:**

N/A

CORRESPONDENT E-MAIL ADDRESS:**OFFICE ACTION**

TO AVOID ABANDONMENT, THE OFFICE MUST RECEIVE A PROPER RESPONSE TO THIS OFFICE ACTION WITHIN 6 MONTHS OF THE ISSUE/MAILING DATE.

ISSUE/MAILING DATE:**INTERNATIONAL REGISTRATION NO. 1031331**

This is a **PROVISIONAL FULL REFUSAL** of the trademark and/or service mark in the above-referenced U.S. application. *See* 15 U.S.C. §1141h(c).

WHO IS PERMITTED TO RESPOND TO THIS PROVISIONAL FULL REFUSAL:

Applicant may respond directly to this provisional refusal Office action if applicant is not represented by an authorized attorney. *See* 37 C.F.R. §2.193(e)(2)(ii). Otherwise, applicant's authorized attorney must respond on applicant's behalf. *See* 37 C.F.R. §2.193(e)(2)(i). However, **the only attorneys who are authorized to sign responses and practice before the USPTO** in trademark matters are as follows:

(1) **Attorneys in good standing with a bar of the highest court of any U.S. state**, the District of Columbia, Puerto Rico, and other federal territories and possessions of the United States; and

(2) **Canadian agents/attorneys** who represent applicants located in Canada and (a) are registered with the USPTO and in good standing as patent agents or (b) have been granted reciprocal recognition by the USPTO.

See 37 C.F.R. §§2.17(e), 2.62(b), 11.1, 11.5(b)(2), 11.14(a), (c); TMEP §§602, 712.03.

Foreign attorneys, other than authorized Canadian attorneys, are not permitted to represent applicants before the USPTO. *See* 37 C.F.R. §§2.17(e), 11.14(c), (e); TMEP §602.03-.03(b). That is, foreign attorneys may not file written communications, authorize an amendment to an application, or submit legal arguments in response to a requirement or refusal, among other things. *See* 37 C.F.R. §11.5(b)(2); TMEP §§602.03(c), 608.01. If applicant is represented by such a foreign attorney, applicant must respond directly to this provisional refusal Office action. *See* 37 C.F.R. §2.193(e)(2)(ii).

THE APPLICATION HAS BEEN PROVISIONALLY REFUSED AS FOLLOWS:

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

SEARCH OF OFFICE'S DATABASE OF MARKS

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

PRIOR REGISTRATION

If applicant is the owner of U.S. Registration No. 2921210, then applicant must submit a claim of ownership. *See* 37 C.F.R. §2.36; TMEP §812. The following standard format is suggested:

Applicant is the owner of U.S. Registration No. 2921210.

DISCLAIMER REQUIRED

Applicant must disclaim the descriptive wording "**SECURITY**" apart from the mark as shown because it merely describes the purpose of applicant's goods and services. *See* 15 U.S.C. §1056(a); TMEP §§1213, 1213.03(a).

SECURITY is defined as, "protection against attack from without or subversion from within." The purpose of applicant's anti-malware and computer security programs as well as its computer threat prevention services is to provide protection against computer attacks from without or subversion from within. *See attached definition.*

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

No claim is made to the exclusive right to use "SECURITY**" apart from the mark as shown.**

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

A disclaimer does not physically remove the disclaimed matter from the mark, but rather is a written statement that applicant does not claim exclusive rights to the disclaimed wording and/or design separate and apart from the mark as shown in the drawing. TMEP §§1213, 1213.10.

REQUIREMENT: IDENTIFICATION OF GOODS & SERVICES

The identification of goods and services is indefinite and must be clarified. *See* TMEP §1402.01. Applicant must specify the common commercial or generic name for the goods and services. If there is no common commercial or generic name, applicant must describe the product and intended

consumer as well as its main purpose and intended uses.

An application must specify, in an explicit manner, the particular goods or 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. Generally, the terminology “**and/or**” and “or” is not sufficiently explicit language in identifications because it is not clear whether applicant is using the mark, or intends to use the mark, on all the identified goods or services. *See* TMEP §1402.03(a).

For example, “modems and/or monitors” could be read to mean “modems or monitors” and thus it is unclear which goods applicant intends to identify. Applicant could amend the identification to “modems” alone, or “monitors” alone, or “modems and monitors” if applicable. Therefore, applicant should replace “and/or” with “**and**” in the identification of goods or services, if appropriate, or rewrite the identification with the “and/or” deleted and the goods or services specified using definite and unambiguous language.

The identification of services for Class 042 contains parentheses. Generally, parentheses and brackets should *not* be used in identifications. Parenthetical information is permitted in identifications only 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 of the identification, e.g., “obi (Japanese sash).” TMEP §1402.12.

Therefore, applicant must remove the parentheses from the identification of goods and/or services and incorporate the parenthetical information into the description.

If accurate, applicant may adopt the following formulation for drafting an acceptable identification. **The suggested language has been bolded for applicant’s convenience.**

Class 009: Antivirus computer programmes; antivirus **computer** software and **computer** hardware; anti-malware computer programmes; anti-malware **computer** software and **computer** hardware; computer **security** programmes; computer **security** software and hardware; computer threat prevention computer programmes; computer threat prevention software and hardware

Class 042: [**Specify type of analysis, e.g. computer systems**] analysis for the installation of computer systems in connection with computer security, computer threat prevention, antivirus **and** anti-malware programmes; computer systems analysis in connection with computer security, computer threat prevention, antivirus **and** anti-malware programmes; design and development of computer systems in connection with computer security, computer threat prevention, antivirus **and** anti-malware programmes; design and development of computer hardware and software in connection with computer security, computer threat prevention, antivirus **and** anti-malware programmes; computer consulting in connection with computer security, computer threat prevention, antivirus **and** anti-malware programmes; rental of computers in connection with computer security, computer threat prevention, antivirus **and** anti-malware programmes; computer programming in connection with computer security, computer threat prevention, antivirus **and** anti-malware programmes; development of computer software in connection with computer security, computer threat prevention, antivirus **and** anti-malware programmes; installation of computer software in connection with computer security, computer threat prevention, antivirus **and** anti-malware programmes; rental of computer software in connection with computer security, computer threat prevention, antivirus **and** anti-malware programmes; maintenance of computer software in connection with computer security, computer threat prevention, antivirus **and** anti-malware programmes; updating of computer software in connection with computer security,

computer threat prevention, antivirus **and** anti-malware programmes; duplication of computer programmes in connection with computer security, computer threat prevention, antivirus **and** anti-malware programmes; conversion of data or documents from physical to electronic media in connection with computer security, computer threat prevention, antivirus **and** anti-malware programmes; **data** conversion of computer programmes and data in connection with computer security, computer threat prevention, antivirus **and** anti-malware programmes; database reconstruction in connection with computer security, computer threat prevention, antivirus **and** anti-malware programmes **for others**; web **site** creation and maintenance for third parties in connection with computer security, computer threat prevention, antivirus **and** anti-malware programmes; server hosting **of web sites** in connection with computer security, computer threat prevention, antivirus **and** anti-malware programmes; technical project studies **in the nature of [specify type of technical project studies, e.g. feasibility studies] in the fields of** computer security, computer threat prevention, antivirus **and** anti-malware programmes; **application service provider (ASP) featuring software for use in data protection** in connection with computer security, computer threat prevention, antivirus **and** anti-malware programmes; maintenance of **software in** computer systems in connection with computer security, computer threat prevention, antivirus **and** anti-malware programmes

Class 045: **Licensing** of computer software licenses in connection with computer security, computer threat prevention, antivirus **and** anti-malware programmes

TMEP §1402.01.

Advisories

Identifications can be amended only to clarify or limit the goods and/or services; adding to or broadening the scope of the goods and/or services is not permitted. 37 C.F.R. §2.71(a); *see* TMEP §1402.06 *et seq.* In addition, for applications filed under Trademark Act Section 66(a), amendments to the identification are limited to goods and/or services in the international class(es) designated in the application as filed. 37 C.F.R. §2.85(d); *see* TMEP §§1402.07(a), 1904.02(c).

Thus, applicant can only amend the identification to include goods and/or services that are (1) within the scope of the identification in the application as filed, and (2) classified in an international class designated in the application as filed.

The international classification of goods and/or services in applications filed under Trademark Act Section 66(a) cannot be changed from the classification given to the goods and/or services by the International Bureau in the corresponding international registration. 37 C.F.R. §2.85(d); TMEP §§1401.03(d), 1904.02(b).

For assistance with identifying and classifying goods and services in trademark applications, please see the online searchable *Manual of Acceptable Identifications of Goods and Services* at <http://tess2.uspto.gov/netahtml/tidm.html>. *See* TMEP §1402.04.

If applicant has questions about its application or this Office action, please contact the assigned trademark examining attorney at the telephone number below.

/Gilbert M. Swift/
Trademark Examining Attorney
Law Office 109
Tel. (571) 272-9028

RESPOND TO THIS ACTION: Applicant should file a response to this Office action online using the form at <http://www.uspto.gov/teas/eTEASpageD.htm>, waiting 48-72 hours if applicant received notification of the Office action via e-mail. For *technical* assistance with the form, please e-mail TEAS@uspto.gov. For questions about the Office action itself, please contact the assigned examining attorney. **Do not respond to this Office action by e-mail; the USPTO does not accept e-mailed responses.**

If responding by paper mail, please include the following information: the application serial number, the mark, the filing date and the name, title/position, telephone number and e-mail address of the person signing the response. Please use the following address: Commissioner for Trademarks, P.O. Box 1451, Alexandria, VA 22313-1451.

STATUS CHECK: Check the status of the application at least once every six months from the initial filing date using the USPTO Trademark Applications and Registrations Retrieval (TARR) online system at <http://tarr.uspto.gov>. When conducting an online status check, print and maintain a copy of the complete TARR screen. If the status of your application has not changed for more than six months, please contact the assigned examining attorney.

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Securities and Exchange Commission

Securities and Investment Board

securitization

▶ security

security blanket

security clearance

Security Council

security deposit

security guard

security kernel

security of tenure

security risk

security

security

se·cu·ri·ty

[sə kyōōrətee]

(plural se·cu·ri·ties)

noun

Definition:

1. state or feeling of safety:

the state or feeling of being safe and protected

2. freedom from worries of loss:

the assurance that something of value will not be taken away

• job security

3. something giving assurance:

something that provides a sense of protection against loss, attack, or harm

security risk

↓

Also available:
[World English Dictionary](#)
[Dictionnaire Français](#)

ORIGIN

- *the security of knowing that the vehicle has been thoroughly checked*

4. safety: protection against attack from without or subversion from within

- *a matter of national security*

5. precautions to maintain safety: precautions taken to keep somebody or something safe from crime, attack, or danger

- *security measures*

6. guards: people or an organization entrusted with the job of protecting somebody or something, especially a building or institution, against crime

- *If you don't leave, I'll call security.*

7. asset deposited to guarantee repayment: something pledged to guarantee fulfillment of an obligation, especially an asset guaranteeing repayment of a loan that becomes the property of the creditor if the loan is not repaid

8. guarantor: somebody who pledges to fulfill somebody else's obligation should that person fail to do so

9. financial instrument: a tradable document that shows evidence of debt or ownership, e.g. a stock certificate or bond

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DESIGN MARK

Serial Number
76473182

Status
REGISTERED

Word Mark
PANDA

Standard Character Mark
No

Registration Number
2921210

Date Registered
2005/01/25

Type of Mark
TRADEMARK

Register
PRINCIPAL

Mark Drawing Code
(1) TYPED DRAWING

Owner
PANDA SECURITY, S.L. SOCIEDAD LIMITADA SPAIN GRAN VIA DE DON DIEGO
LOPEZ DE HARO, 4 BILBAO (VIZCAYA) SPAIN 48001

Goods/Services
Class Status -- ACTIVE. IC 009. US 021 023 026 036 038. G & S:
anti-virus computer software. First Use: 1990/00/00. First Use In
Commerce: 1990/00/00.

Filing Date
2002/11/26

Examining Attorney
CATALDO, CAROLYN

Attorney of Record
Francie J. Duffin

PANDA