

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

U.S. APPLICATION SERIAL NO. 79169769

MARK:

79169769

CORRESPONDENT ADDRESS:

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CLICK HERE TO RESPOND TO THIS LETTER:

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

APPLICANT: Webzen, Inc.

CORRESPONDENT'S REFERENCE/DOCKET NO:

N/A

CORRESPONDENT E-MAIL ADDRESS:

OFFICE ACTION

STRICT DEADLINE TO RESPOND TO THIS LETTER

INTERNATIONAL REGISTRATION NO. 1258422

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

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

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

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

Refusal to Register: More than One Mark

Registration is refused because applicant seeks registration of more than one mark. Trademark Act Sections 1 and 45, 15 U.S.C. §§1051, 1127; 37 C.F.R. §2.52; TMEP §807.01. An applicant may apply for only one mark in a single application. 37 C.F.R. §2.52; TMEP §807.01; *see, e.g., In re Int'l Flavors & Fragrances Inc.*, 183 F.3d 1361, 1366, 51 USPQ2d 1513, 1516 (Fed. Cir. 1999); *In re Hayes*, 62 USPQ2d 1443, 1445-46 (TTAB 2002). A mark combining separate elements is registrable only if it is a single unitary mark engendering a unique and distinct commercial impression. *In re Supreme Steel Framing Sys. Ass'n, Inc.*, 105 USPQ2d 1385, 1387 (TTAB 2012) (citing *In re Walker-Horne Petroleum, Inc.*, 229 USPQ 773, 775 (TTAB 1985)).

In the present case, the application drawing shows the following 6 elements: an orange colored alien-like character; a primarily blue-colored character; a primarily white-colored character; a primarily red and purple colored character; a larger a differently depicted primarily blue character and a larger primarily red colored character. However, the attached evidence from applicant's website shows these elements spatially separated to such a degree that they each appear as separate and distinct marks.

Applicant may not amend the mark in the drawing to delete one or more of these separate elements because the mark in an application filed under Section 66(a) cannot be amended. TMEP §§807.12(c), 807.13(b), 1904.02(k); *see also* 37 C.F.R. §2.51(d).

Although applicant's mark has been refused registration, applicant may respond to the refusal by submitting evidence and arguments in support of registration. However, if applicant responds to the refusal, applicant must also respond to the requirements set forth below.

Identification of Goods and Services

International Class 009: Particular wording in the identification of goods is indefinite and must be clarified because it 1) does not specify the function of

some of the software, 2) does not specify the type and subject matter of the publications and 3) includes parenthetical wording which should generally not be used in an identification of goods. See TMEP §1402.01. Applicant may substitute the following wording, if accurate:

Computer **game** programs**; computer **game** application software for **use on** mobile phones; computer game software; computer software **for use in** _____ (specify function of software, e.g., word-processing, database management, etc.); computers; tablet computers; downloadable music files; video game cartridges; **video disks and video tapes with recorded** animated cartoons; downloadable electronic publications **in the nature of** _____ (specify type of publication, e.g., magazines, books, etc.) **in the field of** _____ (specify subject matter); downloadable electronic books **in the field of** _____ (specify subject matter); downloadable electronic newspapers; downloadable ring tones for mobile phones; downloadable image files **containing** _____ (specify subject matter)

International Class 041: Particular wording in the identification of services is indefinite and must be clarified because it 1) does not specify particular information that is provided, 2) does not specify the type and subject matter of the publications and 3) contains parenthetical information. See TMEP §1402.01. Applicant may substitute the following wording, if accurate:

Entertainment information; production of television programmes; provision of **on-line** information relating to **computer** games; game services provided on-line from a computer network; **holiday camp services****; games equipment rental; providing non-downloadable electronic publications, **namely,** _____ (specify type of publication) **in the field of** _____ (specify subject matter); **providing** on-line **non-downloadable** publications, **namely,** electronic books and journals in the field of _____ **; **providing** information **about** education; rental of stadium facilities; organization of sports competitions; news reporters services

**Parenthetical information was deleted.

An applicant may only amend an identification to clarify or limit the goods and services, but not to add to or broaden the scope of the goods and services. 37 C.F.R. §2.71(a); see TMEP §1904.02(c)(iv). In an application 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). 37 C.F.R. §2.85(f); TMEP §§1402.07(a), 1904.02(c). If an applicant amends an identification to a class other than that assigned by the International Bureau, the amendment will not be accepted because it will exceed the scope and those goods and services will no longer have a basis for registration under U.S. law. TMEP §§1402.01(c), 1904.02(c).

In addition, in a Section 66(a) application, an applicant may not change the classification of goods and services from that assigned by the International Bureau in the corresponding international registration. 37 C.F.R. §2.85(d); TMEP §§1401.03(d), 1402.01(c). Further, in a multiple-class Section 66(a) application, an applicant may not transfer goods and services from one existing international class to another. 37 C.F.R. §2.85(d); TMEP §§1401.03(d), 1402.01(c).

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* at <http://tess2.uspto.gov/netahtml/tidm.html>. See TMEP §1402.04.

Color Claim/Description of Mark Require Clarification

The drawing shows the mark in colors that differ from those specified in the color claim and mark description. Specifically, the drawing shows the mark in the colors red, orange, yellow, blue, white and black; however, the following colors appear in the color claim and mark description: red, blue and white. The colors in the drawing, color claim, and mark description must all agree. See 37 C.F.R. §2.52(b)(1); TMEP §§807.07(a) *et seq.*

In the present case, amending the mark drawing to agree with the color claim and mark description would not be considered a material alteration. However, any other amendments to the drawing will not be accepted if such changes would materially alter the mark. 37 C.F.R. §2.72; see TMEP §§807.07(c), 807.14 *et seq.*

Therefore, applicant must submit one of the following:

- (1) A substitute color drawing that shows the mark in the colors specified in the color claim and mark description. TMEP §807.07(c).
- (2) A corrected color claim and mark description that agrees with the colors shown on the drawing. Generic color names must be used to describe the colors in the mark, e.g., magenta, yellow, turquoise. TMEP §807.07(a)(i)-(ii). If black, white, and/or gray are not being claimed as a color feature of the mark, applicant must exclude them from the color claim and include in the mark description a statement that the colors black, white, and/or gray represent background, outlining, shading, and/or transparent areas and are not part of the mark. See TMEP §807.07(d). The following color claim and mark description are suggested:

Color claim: **“The colors red, yellow, orange, black and white are claimed as a feature of the mark.”**

Mark description: **“The mark consists of the following: a knight-like character wearing armor that is primarily red in color with areas of orange on the body, blue eyes with white eye balls and outlined in black.”**

NOTE: The contents of the color claim are dependent upon applicant's response to the refusal to register presented above. In addition, the examining attorney chose the first drawing in the sequence to determine the color claim and suggest a proper mark description.

Response Guidelines

For this application to proceed toward registration, applicant must explicitly address each refusal and/or requirement raised in this Office action. If the action includes a refusal, applicant may provide arguments and/or evidence as to why the refusal should be withdrawn and the mark should register. Applicant may also have other options for responding to a refusal and should consider such options carefully. To respond to requirements and certain refusal response options, applicant should set forth in writing the required changes or statements.

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

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

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

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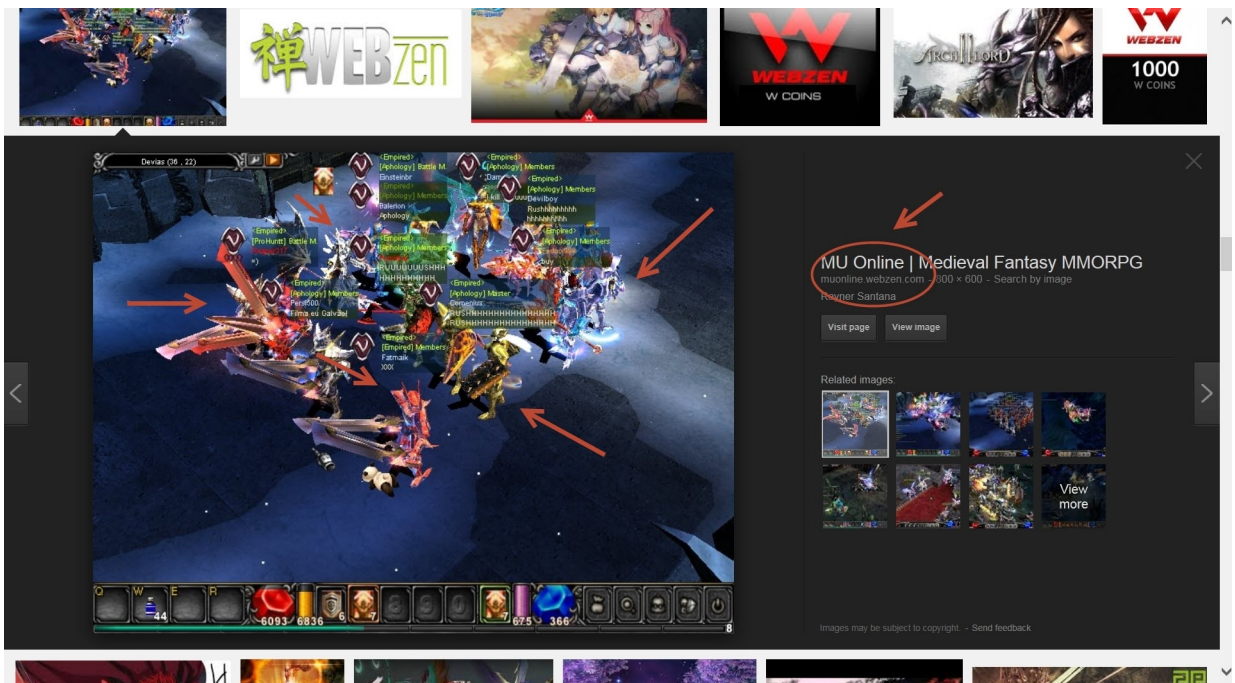
TO RESPOND TO THIS LETTER: Go to http://www.uspto.gov/trademarks/teas/response_forms.jsp. Please wait 48-72 hours from the issue/mailing date before using the Trademark Electronic Application System (TEAS), to allow for necessary system updates of the application. For *technical* assistance with online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

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

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

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

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



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