

Request for Reconsideration

Ser. No. 85/654,087

Table of Contents

| | |
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| REFUSAL – International Class 42..... | 1 |
| A. Summary..... | 1 |
| B. Specimens Display Mark in Use for Recited SAAS Services..... | 2 |
| 1. The Explanation of the Substitute Specimen & Services Was Misunderstood..... | 2 |
| 2. The Scope of SAAS Encompasses Applicant’s Services..... | 3 |
| C. Conclusion..... | 5 |

The application was first refused registration for International Classes 09 and 42 on the ground that the submitted specimen (in the Statement of Use) was deficient. The refusal for Class 09 was withdrawn following submission of a substitute specimen, but the refusal for Class 42 was maintained on one of the earlier bases, and the requirement to provide a substitute specimen was made final.

Applicant asserts that the substitute specimen submitted was sufficient. Applicant shows that it demonstrates the mark's use used with recited goods and services.

Approval of the application for both classes is now proper, as Applicant has shown that its mark is being properly used with recited goods and services. Applicant thus requests reconsideration of the final refusal.

REFUSAL – International Class 42

Services:

Software as a service (SAAS) services featuring software for the management, transmission, storage and sharing of computer game programs and electronically stored computer game information across computer networks

A. Summary

The Examining Attorney maintained one reason for refusing registration for the Class 42 SAAS services: that the Substitute Specimen did not show Applicant's mark (SHIFT) in use in commerce in connection with any of those SAAS services. Rather, the conclusion was that the mark was instead shown to be used for Class 09 computer software.¹ The Examining Attorney based this conclusion upon two things: (1) statements about what constitutes SAAS that were taken from various internet websites;² and (2) a discussion of the Substitute Specimen and Applicant's explanation of that specimen:³

Specifically, there is no uniform resource locator (URL) or web browser border within the screen capture. The specimen only shows that applicant's software is used to download data or rewards which the user stores on its computer. "If the shift code submitted is valid, then the service bundles together a Reward, creates

- 1 In the first Office Action, the mark was asserted not to be used with the services but merely used with "gaming rewards." In addition, the specimen was asserted to be mere advertising lacking a direct association between the mark and the services. Neither reasoning was carried forward in the Final Action, and neither is therefor re-addressed here.
- 2 These websites were screen-captured and attached to that Final Action as Attachments 1-28.
- 3 An Examining Attorney may consider explanations offered by the applicant as to how the specimen is used when determining if a specimen shows acceptable service mark use. *In re Int'l Environmental Corp.*, 230 USPQ 688, 691, Ser. No. 73/402,456 (TTAB 1986).

an information packet, transmits that packet across computer networks (the Internet), and stores that packet on the local computer or game console in a “rewards memory location,” and updates the recorded list of “Entitled Rewards” for that user.” See Response. The software is not “rented,” as would normally be the case with SAAS, rather, the software applicant provides allows users to download data from the Internet so that the data can be stored on the user’s computer.

Final Action at p.2. Applicant submits that the reasoning stated has two flaws.

First, it is based upon an incorrect understanding of the specimen and of the services shown thereby. Second, the very statements about the nature of SAAS that were relied upon in the Final Action show that Applicant is rendering SAAS services in connection with the mark.

B. Specimens Display Mark in Use for Recited SAAS Services

The Original and Substitute Specimens show Applicant’s mark being used with recited SAAS services.

1. The Explanation of the Substitute Specimen & Services Was Misunderstood

One of the two bases for the conclusion that the mark was not used for the recited SAAS services was how Applicant’s system works. But the remarks in the Final Action reveal several misunderstandings. As correctly understood, the explanation Applicant provided in the Response (pp. 6-7 of the Argument) demonstrates that the mark was so used.

In arguing that the specimen showed use for Class 09 software, rather than SAAS, the Final Action states that the “specimen only shows that applicant’s software is used to download data or rewards which the user stores on its computer.”⁴ The “only” is incorrect; the specimen does show that software is downloaded, but it also shows server-side management and storage of the data.

A statement from the response is cited in support of this conclusion; the statement itself points out this error:

If the shift code submitted is valid, then the service bundles together a Reward, creates an information packet, transmits that packet across computer networks (the Internet), and stores that packet on the local computer or game console in a “rewards memory location,” and updates the recorded list of “Entitled Rewards” for that user. (Final Action)

4 In the same vein is the statement that “the software [application] ... allows users to download data from the Internet so that the data can be stored on the user’s computer.” (Final Action)

The service does not just provide software downloads, among other things, it also “updates the recorded list” for that user.

That process is carried out not on the PC, but server-side, and the list is stored server-side between sessions when the user is not logged-in:

Further, that service manages the list of Entitled Rewards, by recording the list of Rewards to which that user has previously established entitlement. Then it stores that list until that user has logged in again, and then transmits it back to the user across the Internet, as shown by the listing on Page07. That list of rewards is electronically stored, and is information about Borderlands 2. (Response, at p. 7)

The Response confirms elsewhere that the server-side software provides that list to the in-game screen:

Page07 shows the in-game screen by which the user and account-holder accesses the services provided by the server-side computer software. That service provides the display of the list of “Entitled Rewards” (listed under the title “My Rewards”) displayed on that screen.... (Response, at p. 6)

Next, the server-side storage and management of this data is further illustrated by a comparison of the Substitute Specimen and parts of the Original Specimen, including one page showing an internet browser screen.

Two pages of that Original Specimen demonstrate that part of the service. SOU006.jpg is a screen-capture from an internet browser screen⁵ that displays electronically-stored data about Borderlands 2 transmitted across the internet. This is the same information (the list) that is transmitted and displayed on the in-game screen. That relationship can be seen by comparing SOU0006.jpg and SOU007.jpg.⁶ Thus, the explanation provided in the Response demonstrated that the mark was used with recited SAAS services, and not just for the download of software.

2. The Scope of SAAS Encompasses Applicant’s Services

The other basis for the conclusion in the Final Action was based on statements about what constitutes SAAS—statements that were taken from and purportedly supported by various internet websites. Those website statements, however, do not support forcing SAAS into so narrow a box. Interpreted correctly, they demonstrate that SAAS does encompass the services provided by Applicant, and that the mark was used with recited SAAS services.

5 Statement of Use, Specimen Description (Sept. 05, 2013) (“the SHIFT website”).

6 Recall that SOU0007.jpg in the Original Specimen corresponds to the same in-game “My Rewards” display found as Page07, Page11 & Page12 in the Substitute Specimen. (Response, at p. 6) The last Borderlands 2 reward item shown on the list in SOU0006.jpg is “Welcome to Shift!” and is followed by explanatory text for that reward. The reward item list shown on SOU0007.jpg includes that same one, showing the explanatory text (for the highlighted item) on the right side.

First, the Final Action argues that the mark is not used with SAAS services because the “software is not ‘rented,’ as would normally be the case with SAAS....” (Final Action) But there are several reasons this does not support the Final Action. In the first instance, the specimens show that there is software in use that is neither purchased nor downloaded. The Response explains that

Page07 shows the in-game screen by which the user and account-holder accesses the services provided by the server-side computer software. That service provides the display of the list of “Entitled Rewards” (listed under the title “My Rewards”) displayed on that screen.... (Response, at p. 6)

In other words, the user receives services via software over the internet, software that it did not buy. Moreover, the Final Action concedes that “rental” is not the sole structure for providing SAAS services. The Final Action merely states that rental would “normally be the case,” not that it is required. Such a conclusion would, in any case, be contradicted by the cited documents.

The Final Action cites the Interoute.com page, which sets forth “Google, Twitter, Facebook” as “examples of SAAS, with users able to access services via any internet-enabled device.” (Attch. 1) The article also expressly calls out “internet enabled phones and tablets” as another way to access SAAS services. (Attch. 1-2) Yet it is common knowledge that such services are often accessed via downloaded software (“apps”) on such devices,⁷ which does not destroy the SAAS nature of the services provided.

Lastly, the Final Action itself states that SAAS includes purchased software: “Applications purchased and used online with files saved in the cloud rather than on individual computers.” (Final Action) Thus, even if one considers only the purchased software (the game), Applicant is providing SAAS via the server-side storage of the list discussed above, which is a file saved in the cloud.

Second, consistent with SAAS and the description in the cited documents, Applicant’s services provide cross-device compatibility and are accessible via internet enabled devices (in addition to PCs). Users of Applicant’s services can access the service in-game via a PC, an XBOX 360 and a PS3, if connected to the internet.⁸ The

7 Applicant requests judicial notice of such access via downloaded software, but also submits Exhibit 1 (“SaaS on Mobile Devices”), Exhibit 2 (“Mobile SaaS Apps for Android”), Exhibit 3 (“Choosing Between HTML5 and Native Mobile Apps”); Exhibit 4 (“Facebook – Android Apps on Google Play”) and Exhibit 5 (“Twitter – Android Apps on Google Play”). Exhibit 1 discusses the need for maintaining lists of supported apps for use with SAAS. Exhibit 2 discusses “Mobile SaaS Work Productivity Apps...”. Exhibit 3 states that the “majority of SaaS vendors will provide both a desktop and mobile application.” Exhibits 4 and 5 show that software “apps” are used to access both the Twitter and Facebook services. Evidence of the relevant public’s understanding of a term may be obtained from any competent source, including testimony, surveys, dictionaries, trade journals, newspapers, and other publications. See *In re Northland Aluminum Prods., Inc.*, 777 F.2d 1556, 1559, 227 USPQ 961 (Fed. Cir. 1985).

Interoute.com document calls out such capability as being characteristic of SAAS.
(Attch. 1-2)

Third, the Final Action argues that the mark is not used with SAAS services because the specimen—specifically the Substitute Specimen—is from in-game and lacks a URL or other indicia of being a captured on an internet browser screen:

[The specimen is unacceptable] because the specimen of use shows the mark on an “in game screen” that is not hosted online. Specifically, there is no uniform resource locator (URL) or web browser border within the screen capture. (Final Action)

Again, the documents relied upon in the Final Action do not support such a narrow box for SAAS. As a threshold point, as pointed out above, SOU006.jpg (from the Original Specimen) is a screen-capture from an internet browser screen displaying electronically-stored data about Borderlands 2 hosted online, and transmitted across the internet. Moreover, the key requirement is use online with cloud files, not the use of a browser window. As pointed out earlier, the cited documents show that SAAS services do not stop being SAAS just because they are accessed via something other than a browser. Software, such as “apps” on mobile devices, is just another way to access SAAS services. And the user accesses SAAS services, and the server-side software provides those services online. As the Response explained:

Further, that service manages the list of Entitled Rewards, by recording the list of Rewards to which that user has previously established entitlement. Then it stores that list until that user has logged in again, and then transmits it back to the user across the Internet, as shown by the listing on Page07. That list of rewards is electronically stored, and is information about Borderlands 2. (Response, at p. 7)

Thus, the absence of an internet browser would not preclude Applicant’s Substitute Specimen from showing the mark in use with the recited services.

Thus, the way that Applicant’s services are provided does fall within the scope of SAAS services.

C. Conclusion

The substitute specimen shows the mark used in commerce for recited SAAS service, for the reasons expressed above and in the first Response. Therefore, Applicant respectfully requests reconsideration of the final refusal to register the SAAS services, and requests that the requirement for a substitute specimen be withdrawn.

8 This is also shown by page SOU0008.jpg of the Original Specimen, which provides alphabetic codes for XBOX 360 & PS3 in addition to PC/MAC.