

Argument

Ser. No. 85/654,087

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The application was refused registration for International Classes 09 and 42 on the ground that the submitted specimen (in the Statement of Use) was deficient.¹

Applicant asserts that the specimen submitted was sufficient. Applicant shows that the specimen is not merely advertising material—it demonstrates a plain means for downloading the Class 09 software goods. Applicant also shows that the specimen demonstrates the mark’s proper use in the course of rendering the Class 42 software as a service. And the mark, as used, specifically creates an association with those services. Finally, Applicant demonstrates that the mark is used with recited goods and services.

Applicant, at the Examining Attorney’s instruction, also submits a substitute specimen. The substitute specimen also shows that Applicant’s mark was in trademark use for recited goods and services as of the relevant deadline (*i.e.* before the deadline for filing the Statement of Use).

Approval of the application is now proper, as Applicant has shown that its mark is indeed being properly used with recited goods and services.

1. REFUSAL – International Class 09

Goods:

Computer 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 stated two reasons for refusing registration for the Class 9 software goods. First, the specimen was merely advertising material.² Second, the specimen did not show Applicant’s mark (SHIFT) in use in commerce in connection with any of those software goods, but rather merely served to advertise “gaming rewards and character customization codes.”

Applicant submits that the specimen did show trademark use. Applicant supplies below an explanation³ of how at least one of the pages of the specimen demonstrates a means to download the software goods. And Applicant has supplied an explanation to show the recited software goods being downloaded.

Moreover, Applicant submits a substitute specimen, with an explanation, demonstrating trademark use for the software goods.

1 The bases for refusal were that: (1) the specimen did not show use of Applicant’s mark with the recited goods or services; (2) as to the goods, the specimen was merely advertising material; and (3) as to the services, the specimen was advertising material and failed to make an association between that mark and the recited services.

2 The Examining Attorney did not expressly identify what part of the specimen (four separate items) was considered to be merely advertising material. Rather, the statement was that the “specimen consisted of advertising material.” As a matter of caution, however, and without conceding this refusal was made properly, Applicant will respond as though the basis for refusal applied to each of the four separate items comprising the specimen.

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).

B. Specimens Display Means to Download Software Goods & Create an Association Therebetween

The submitted specimen included at least one page that was not merely advertising material. That page, rather, showed a way to download the software goods and created an association between the goods and the mark. The substitute specimen does likewise.

1. Legal Standard

A specimen for a computer program or software need not be an actual tag, label on actual goods or packaging, as the Examining Attorney recognized. Rather, electronic specimens of use—in the form of a screen capture from within a piece of software—are acceptable. The key is the use of the mark on a display.

As the Court of Appeals for the Federal Circuit stated in *In re Sones*, using a mark in “in commerce” can be satisfied merely by placing the mark “in any manner on ... the displays associated therewith” where the mark serves “as an indicator of source.”⁴ *In re Sones* specifically concerned marks used on a website display associated with the goods in question, concluding that a picture of the goods was not a requirement to satisfy the statute.⁵ It also cited with approval an earlier TTAB decision about another form of electronic specimen: an infomercial.

That case—*In re Hydron Technologies, Inc.*—demonstrates that it is how the mark is associated with the goods that is important, and that acceptable electronic displays may take a variety of forms. The TTAB had approved a specimen comprising a television “infomercial” that showed the mark and displayed the goods “‘immediately before or immediately after’” the mark was displayed.⁶ In *Hydron Technologies*, the focus was not on the form of electronic specimen, which were “screen prints” (or what we would now call “screen captures”) from a video recording of the infomercial.⁷ Rather, the TTAB expressly noted that the important question was whether the mark was used in a way that created an association between the mark and the goods in the mind of a viewer.⁸ As pointed out in *Sones*, the specimen “‘must in some way evince that the mark is “associated” with the goods and serves as an indicator of source.’”⁹ In addition, an electronic display must also be in the nature of a point-of-sale display.

A specimen of this type is one in which an electronic display provides a means to acquire the goods in question. That means can take different forms. For instance, in *Hydron Technologies*, the infomercial provided a phone number at which customers could call and order the goods.¹⁰ The TMEP itself sets out guidance more pertinent here:

For intangible goods, such as downloadable computer software programs, buttons and links for downloading ... goods should be considered sufficient ordering information.

TMEP § 904.03(i)(C)(1). Thus, the TMEP explains, such interactive items as buttons or

4 *In re Sones*, 590 F.3d 1282, 1287, 1288 (Fed. Cir. 2009) (quoting 15 U.S.C. § 1127; internal quotations omitted).

5 *In re Sones*, *id.* at 1288.

6 *Id.* at 1286 (quoting *In re Hydron Techs., Inc.*, 51 USPQ2d 1531, 1534 (TTAB 1999)).

7 *In re Hydron Techs.*, 51 USPQ2d 1531, Ser. No. 74/617,867, slip. op. at 2.

8 *In re Hydron Techs.*, 51 USPQ2d 1531, Ser. No. 74/617,867, slip. op. at 11-12.

9 *In re Sones*, 590 F.3d at 1288.

10 *In re Sones*, *id.* at 1286 (quoting *Hydron Techs.*, 51 USPQ2d at 1534).

links, or “an online process to accept an order,” are acceptable. TMEP § 904.03(i)(C). Thus, in the case of an “interactive computer screen” with information about the product, a viable option is having the “option of completing the transaction by clicking on items.”¹¹

The TMEP also explains what kind of specimen can be used to show use: a copy of the display screen showing the trademark’s use—including a display created by a piece of software:

An acceptable specimen might be a photograph or printout of a display screen projecting the identifying trademark of a computer program

TMEP § 904.03(e). This is also consistent with the type of “display” approved in *Hydron Technologies*: video screen captures.

Thus, an electronic display that provides a means to download the computer software goods, and creates an association between the mark and the goods, plainly is not merely advertising material. See TMEP § 904.03(i)(C).

2. SHIFT “My Rewards” Page & the Substitute Specimen

The third page of the original specimen was a screen capture of an in-game screen that shows the SHIFT “My Rewards” page (identified in the Statement of Use as SOU0003.jpg). The substitute specimen includes Page01.pdf– Page06.pdf, each of which is a screen capture of an in-game screen.¹² Page01, Page05 & Page 06 correspond to the same in-game “My Rewards” display as in SOU0003.jpg. These screen captures show the electronic display providing a means to download the computer software goods.¹³

Page01 shows the in-game screen by which a user and account-holder can initiate the download of computer software. That screen displays the list of “Entitled Rewards” (listed under the title “My Rewards”), that is, the user sees those Rewards that the user is entitled to use. Page05 / Page 06 are the same screen, showing different rewards. Individual Rewards can be for granting one or more of the following: (i) a unique piece of gear (weapon type, grenade type, shield type, for example, the “Shotgun – Conference Call” shown on Page01); (ii) an arbitrary increase or decrease in the number of “Golden Keys” the user may use (Page06); and/or (iii) permission to use a particular head and or skin (Page05), all in the computer game in question (in the specimen, *Borderlands 2*®). Page01 also contains a “Shift Code” button. By clicking that button, the user is taken to Page02, another in-game screen.

On Page02, a user may attempt to add new Rewards to that user’s list of Entitled Rewards. That is done by the user entering an alphabetic code, and pressing the “Submit” button (as shown on Page03). If the Shift Code submitted is valid, then the user’s computer (or videogame console) receives a Reward, which is an information packet that has been transmitted across computer networks (the internet), and stored on the local computer or game console in a “rewards memory location.” That memory location is in volatile memory accessible to the computer game. Completion of that process is reflected by the “Code Redeemed” notice on Page04.

11 Cf. *In re Anpath Group, Inc.*, 95 USPQ2d 1377, Ser. No. 77/004,809, slip op. at 12 (TTAB 2010) (referring to items sold via a shopping cart).

12 The substitute specimen is submitted without acceding to the refusal based upon the original specimen.

13 To be more concise, this explanation will address both the original and substitute specimens together. As to the original specimen, of course, any reference to pages of the substitute specimen is merely for purposes of explaining what the original specimen showed.

That information packet contains the information defining the Rewards for the computer game to use. There are several different types of Rewards; the information defining a Reward for a unique piece of gear is formed of instructions in a game-specific computer language that instructs the game how to construct that unique piece of gear from various components in the game. Those components are such items as textures, which are computer game information. Once such instructions are available to the game, and a character is subsequently loaded, the game executes those instructions to make that unique item available to that character.

Those game-specific computer language instructions are computer game programs, and they manage a computer game program by controlling the existence of game content (the unique gear) and they manage access and use of already electronically stored computer game information, such as textures for that gear, that exist in the game prior to creation of that gear. Moreover, those instructions electronically store computer game information in the form of the defined unique piece of gear.

Note that on each of the pages of the substitute specimen, as well as SOU0003.jpg of the original specimen, the Applicant's mark is highly visible, plainly identifiable as an indicator of source, and closely associated with the downloaded software, as well as appearing in connection with the clickable button providing a means for downloading the software.

3. Analysis

Both the original specimen and the substitute specimen depict an interactive, clickable, button causing an online process to accept a request for, and causing the downloading of, computer software goods. And each of those specimens creates an association between the Applicant's mark and those software goods.

C. Specimens Display Mark in Use for Recited Software Goods

The submitted specimen, moreover, included at least one page in which Applicant's mark was being used with recited software goods. The substitute specimen does likewise.

1. SHIFT "My Rewards" Page & the Substitute Specimen

See para. B.2, above, for description and explanation.

2. Analysis

Both the original specimen and the substitute specimen reflect electronic displays that show a means for downloading computer software for the management of both electronically stored computer game information and computer game programs, and the storage of electronically stored computer game information, all across computer networks.

D. Conclusion

The specimen and the substitute specimen each show the mark used in commerce for recited goods. Each shows an association between recited software goods and Applicant's mark, and provides a means to download that software. Therefore the refusal to register the software goods should be withdrawn.

2. 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 stated two reasons for refusing registration for the Class 42 SAAS services. First, the specimen did not show Applicant's mark (SHIFT) in use in commerce in connection with any of those SAAS services, but rather was merely used with "gaming rewards" and not the recited services. Second, the specimen was mere advertising materials lacking a direct association between the mark and the recited services.¹⁴

Applicant submits that the specimen did show trademark use, and has supplied an explanation to show how the mark was used in the course of rendering the recited SAAS services. That being so, the specimen was not merely advertising materials. Applicant has, moreover, supplied an explanation of how those services were rendered in connection with the mark. Moreover, even if the specimen was merely advertising materials, it created a direct connection between the mark and the services.

And finally, Applicant submits a substitute specimen, with an explanation, demonstrating trademark use for the services.

B. Specimens Display Mark in the Course of Rendering SAAS Services & Create Direct Connection Therebetween

The submitted specimen included at least one page that was not merely advertising material. That page showed the mark being used in the course of rendering SAAS services and connecting those services and the mark. In the alternative, that page also created a direct connection between the mark and the services. The substitute specimen does likewise.

1. Legal Standard

First, there is a distinction between specimens that merely advertise services, and those that display the mark as used in the course of rendering or performing services.

In the former case, the specimen needs to show "an association between the mark and the [recited] services." TMEP § 1301.04(b). Such an association does not require that the specimen "specifically mention" the services recited in the application where the specimen is directed to potential consumers of those services, and the specimen "makes clear" that the applicant is seeking to provide those services.¹⁵ And explanations by the applicant about how the specimen is used can help show that the service mark use is

¹⁴ The Examining Attorney did not expressly identify what part of the specimen (four separate items) was considered to be merely advertising material or lacked a direct association between the mark and the recited services. The one reference to "advertising" in the reasoning of the Class 42 refusal is in reference to the Twitter page (specimen file name SOU0009.jpg). As a matter of caution, however, and without conceding this refusal was made properly, Applicant will respond as though the basis for refusal applied to each of the four separate items comprising the specimen.

¹⁵ *In re Int'l Environmental Corp.*, 230 USPQ 688, 691, Ser. No. 73/402,456 (TTAB 1986).

acceptable.¹⁶

But in the latter case—when the mark used in the course of rendering or performing the recited services—the specimen does not need to make any such association. TMEP § 1301.04(b). One TTAB case—*In re Metriplex, Inc.*—is instructive. In *Metriplex*, the services were rendered through a tangible item (a computer), meaning that the mark appeared on the screen (which the specimens showed) in the course of rendering the service. In such a case, the “direct association” requirement did not apply, and the TTAB reversed the refusal to register.¹⁷ Thus, a specimen showing the mark being used in that manner need not make an association between the services and the mark.

2. SHIFT “My Rewards” Page & the Substitute Specimen

The third page of the original specimen was a screen capture of an in-game screen that shows the SHIFT “My Rewards” page (identified in the Statement of Use as SOU0007.jpg). The substitute specimen includes Page07.pdf– Page12.pdf, each of which is a screen capture of an in-game screen.¹⁸ Page07, Page11 & Page 12 correspond to the same in-game “My Rewards” display as in SOU0007.jpg. These screen captures show the electronic display reflecting the mark being used in the course of rendering SAAS services.¹⁹

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; that is, the user only sees those Rewards that the user is entitled to use. Page11 / Page 12 are the same screen, showing different rewards. Individual Rewards can be for granting one or more of the following: (i) a unique piece of gear (weapon type, grenade type, shield type, for example, the “Shotgun – Conference Call” shown on Page07); (ii) an arbitrary increase or decrease in the number of “Golden Keys” the user may use (Page12); and/or (iii) permission to use a particular head and or skin (Page11), all in the computer game in question (in the specimen, *Borderlands 2*®). That service defines the various Rewards. Page07 also permits the user to access further services by clicking the “Shift Code” button on that page. Doing so causes the server-side software to take the user to Page08, another in-game screen.

On Page08, a user may attempt to add new Rewards to that user’s list of Entitled Rewards. That is done by the user entering an alphabetic code, and pressing the “Submit” button (as shown on Page09). This causes the service to manage verification of the status of the submitted “Shift Code” to determine (i) if it is valid for the particular user, platform, and software (here, a computer game) and, if so (ii) to what Reward the user is now entitled that is related to that Shift Code. 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 (as on Page07). That memory location is in volatile memory

¹⁶ *Id.*

¹⁷ *In re Metriplex Inc.*, 23 USPQ2d 1315, Ser. No. 73/836,597, at slip op. 2 (TTAB 1992).

¹⁸ The substitute specimen is submitted without acceding to the refusal based upon the original specimen.

¹⁹ To be more concise, this explanation will address both the original and substitute specimens together. As to the original specimen, of course, any reference to pages of the substitute specimen is merely for purposes of explaining what the original specimen showed.

accessible to the computer game. Completion of that process is reflected by the “Code Redeemed” notice on Page10.

That information packet contains the information defining the Rewards for the computer game to use. There are several different types of Rewards but the information defining them falls into two general categories: simple text strings that authorize access to some existing game resource, or instructions in a game-specific computer language that instructs the game how to construct a unique piece of gear from various components in the game. Once such instructions are available to the game, and a character is subsequently loaded, the game executes those instructions to make that unique item available to that character. Those text strings are electronically stored, and are information about Borderlands 2, and those game-specific computer language instructions are computer game programs.

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.

In the alternative, the specimens also create a direct connection between the mark and the services. First, each of the pages of the substitute specimen, as well as SOU0007.jpg of the original specimen, shows the Applicant’s mark as being highly visible, plainly identifiable as an indicator of source, and closely associated with the SAAS services, as well as appearing in connection with the clickable button providing access to some of those services. Second, both specimens are directed to players of the game (recall that they are in-game screens), who are the intended consumers of the SAAS services. Third, both specimens plainly evidence the Applicant’s willingness to provide those services to that intended consumer.

Even if there is no recitation of the services—which is not required—the specimens demonstrate that willingness and the nature of those services. For instance, Page07 & SOU0007.jpg each reflect that the user is “signed in” which is a plain reference to accessing a SAAS resource. The game itself does not require being signed in, and this is a different sign-in from the platform-specific services, such as Xbox Live or Steam. That list of Entitled Rewards is plainly computer game related and is managed by the service across computer networks, as suggested by the sign-in. The “Shift Code” button for beginning the process to be entitled to another Reward shown on that page is also an indication that the service will be transmitting and storing computer game-related information across computer networks. Referring to Page08–Page10, these screens further suggest the transmission and storage function nature of the services performed by the SAAS resource.

3. Analysis

Both the original specimen and the substitute specimen depict the Applicant’s mark on an electronic display screen in the course of rendering the SAAS service. Each of those specimens, moreover, is directed to in-game players who are potential consumers of those services, and show that the Applicant is offering to the player to provide those SAAS services.

C. Specimens Display Mark in Use for Recited SAAS Services

The submitted specimen also includes at least one page in which Applicant's mark is being used with recited services. The substitute specimen does likewise.

1. SHIFT "My Rewards" Page & the Substitute Specimen

See para. B.2, above, for description and explanation.

2. Analysis

Both the original specimen and the substitute specimen depict the Applicant's mark on an electronic display screen in connection with the SAAS service. That SAAS service is shown to be managing the electronically stored computer game information and computer game programs across computer networks by creating, recording and updating such information. It is shown to be transmitting and storing such information to the local machine across computer networks.

D. Conclusion

The specimen and the substitute specimen each show the mark used in commerce. Each shows Applicant's mark used in the course of rendering recited SAAS services, and in the alternative is advertising material that creates a direct connection between those services and the mark. Therefore the refusal to register the SAAS services should be withdrawn.