

UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 79/032490

APPLICANT: Wikimedia Foundation, Inc.

79032490

CORRESPONDENT ADDRESS:
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 P.O. Box 1451
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CORRESPONDENT'S REFERENCE/DOCKET NO: N/A

CORRESPONDENT EMAIL ADDRESS:

Please provide in all correspondence:

1. Filing date, serial number, mark and applicant's name.
2. Date of this Office Action.
3. Examining Attorney's name and Law Office number.
4. Your telephone number and e-mail address.

OFFICE ACTION

RESPONSE TIME LIMIT: TO AVOID ABANDONMENT, THE OFFICE MUST RECEIVE A PROPER RESPONSE TO THIS OFFICE ACTION WITHIN 6 MONTHS OF THE MAILING OR E-MAILING DATE.

MAILING/E-MAILING DATE INFORMATION: If the mailing or e-mailing date of this Office action does not appear above, this information can be obtained by visiting the USPTO website at <http://tarr.uspto.gov/>, inserting the application serial number, and viewing the prosecution history for the mailing date of the most recently issued Office communication.

Serial Number 79/032490

INTERNATIONAL REGISTRATION NO. 0907474 .

This is a **PROVISIONAL FULL REFUSAL** of the trademark and/or service mark in the above-referenced U.S. application. 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, or applicant's attorney may respond on applicant's behalf. However, **the only attorneys who can 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, and**
- (2) **Canadian attorneys who have applied for and received reciprocal recognition** by the USPTO under 37 C.F.R. §10.14(c). Canadian attorneys can only represent Canadian applicants.

37 C.F.R. §10.14; TMEP §602.

Foreign attorneys are *not* permitted to practice before the USPTO, other than properly authorized Canadian attorneys. Preparing a paper, authorizing an amendment to an application, or submitting legal arguments in response to a requirement or refusal constitutes representation of a party in a trademark matter. *A response signed by an unauthorized foreign attorney is considered an incomplete response.* TMEP §§602, 602.03, 603.05.

THE APPLICATION HAS BEEN PROVISIONALLY REFUSED AS FOLLOWS:

The assigned trademark examining attorney has reviewed the referenced application and has determined the following:

Search Results

The Office records have been searched and no similar registered or pending mark has been found that would bar registration under Trademark Act Section 2(d), 15 U.S.C. §1052(d). TMEP §704.02.

However, the applicant must resolve the following issues.

Claim of Ownership

If applicant is the owner of U.S. Registration No. 3040722, then applicant must submit a claim of ownership. 37 C.F.R. §2.36; TMEP §812. The following standard format is suggested:

Applicant is the owner of U.S. Registration No. 3040722.

Identification of Goods/Services

The wording used to describe some of the applicant's goods/services needs clarification because it is indefinite. Applicant must clarify the identification of goods/services to specify the generic or common commercial name for the goods/services specified below, or provide other required information. If there is no generic or common commercial name, then applicant must describe the product and intended consumer as well as its main purpose and intended uses. Careful use of punctuation, especially commas and semicolons, helps to group related—or distinguish unrelated—goods and services. The applicant must be as complete and specific as possible, and avoid the use of indefinite words and phrases. If applicant chooses to use indefinite terms such as "accessories," "components," "devices," "equipment," "materials," "parts," "systems" and "products," then such terms must be followed by the word "namely" and a list of the specific goods and/or services identified by their generic or common commercial names and/or function. TMEP §§1402.01 and 1402.03(a).

The following goods/services were described insufficiently such that the accuracy of their classification could not be determined:

Applicant classified the following goods/services in Class 9:

- “Software and apparatus for downloading, transmitting, receiving, providing, publishing, extracting, encoding, decoding, reading, storing and organizing audiovisual, videographic and written data” is indefinite. The applicant must indicate that the goods accomplish their purposes “in conjunction with a global computer network” or some other medium.
- “[T]elecommunications apparatus and instruments” is indefinite. The applicant must specify the common commercial name for the apparatus and instruments, or describe their nature and purpose.
- “[M]ultimedia products for transmitting or containing audiovisual, videographic and written data” is indefinite. The applicant must specify the common commercial name for the products, or describe their nature and purpose.

Applicant classified the following goods/services in Class 35:

- “[S]ubscription services (for third parties)” is indefinite. The applicant must indicate what types of products/services are provided under subscription. For example, are the subscriptions to “information media packages,” “newspapers,” “telecommunication services,” and so forth. Also, the applicant must remove the parentheses in the identification. Generally, parentheses are not allowed in identifications, and the applicant must delete them. The information contained within the parentheses must be deleted or incorporated into the identification.
- The parentheses in the identification reading “dissemination of advertising material (tracts, prospectuses, printed matter, samples)” must be deleted. Generally, parentheses are not allowed in identifications, and the applicant must delete them. The information contained within the parentheses must be deleted or incorporated into the identification.

Applicant classified the following goods/services in Class 38:

- “[I]nformation on telecommunications” is unclear as a service. The applicant must indicate that it is “providing” such services.
- “[E]lectronic display services (telecommunications)” is unclear as a service. The applicant must fully explain what the services entail. Also, the applicant must remove the parentheses in the identification. Generally, parentheses are not allowed in identifications, and the applicant must delete them. The information contained within the parentheses must be deleted or incorporated into the identification.

Applicant classified the following goods/services in Class 41:

- “Education” is indefinite. The applicant must indicate what specific educational services or programs are provided (e.g., classes, seminars, etc.), and the field(s) of interest.
- “[P]roviding of training” is indefinite. The applicant must indicate what specific training services or programs are provided (e.g., classes, seminars, etc.), and the field(s) of interest.
- “[E]ntertainment” is indefinite. The applicant must indicate what specific entertainment services, programs, activities, and so forth, are provided.
- “[C]ultural activities” is indefinite. The applicant must indicate the nature of the specific activities being provided.
- “[P]roduction of films on videotapes or on all types of audiovisual or sound media” is indefinite. The applicant must be specific about either the nature of the films (e.g., “motion pictures”) or the types of media being produced (e.g., “DVDs”, “videocassettes,” etc.).
- “[A]rranging and conducting of colloquiums, conferences or conventions” is indefinite. The applicant must indicate the subject matter or field(s) of interest relevant to the events.
- “[O]rganization of exhibitions for cultural or educational purposes” is indefinite. The applicant must indicate the subject matter or field(s) of interest relevant to the events.
- “[D]esktop publishing” is indefinite. The applicant must specify that the services are provided “for others.”

The trademark examining attorney examines identifications of goods and services for acceptability in accordance with the Rules of Practice in Trademark Cases and USPTO policies and procedures in effect at the time registration is sought. Descriptions of goods and services found in earlier-filed applications and registrations are not always determinative on the issue of acceptability of such identifications in the present time. **For guidance on writing identifications for goods and/or services, please use the online searchable *Manual of Acceptable Identifications of Goods and Services* at <http://tess2.uspto.gov/netathtml/tidm.html>, which is frequently updated in accordance with prevailing rules and policies.** See TMEP §§702.03(a)(iv) and 1402.04.

If accurate, and inserting specific information where appropriate, the applicant may adopt any or all of the following acceptable identifications of goods/services:

- Class 9: Software and apparatus for downloading, transmitting, receiving, providing, publishing, extracting, encoding, decoding, reading, storing and organizing audiovisual, videographic, and written data, all in conjunction with a global computer network;

Telecommunication apparatus and instruments, namely, [**specify**]; Multimedia products for transmitting or containing audiovisual, videographic, and written data, namely, [**specify**]; and/or

- Class 35: Advertising; Business management; Business administration; Subscription services for third parties in the nature of [**specify**]; Dissemination of advertising material, namely, tracts, prospectuses, printed matter, and samples; Document reproduction; Computer file management; Public relations; and/or
- Class 38: Electronic transmission of data and documents via the Internet and other databases; Electronic transmission of audiovisual, videographic, or written files disseminated and downloadable via electronic communication networks; Providing information on telecommunications; Mobile radiotelephony services; Providing access to a global computer network; Telecommunication services, namely, electronic display of [**specify**]; Teleconferencing services; Electronic mail; and/or
- Class 41: Education services, namely, [**specify nature of activities and subject matter**]; providing of training in the nature of [**specify activities**] in the field of [**specify field**]; Entertainment in the nature of [**specify activities**]; Cultural activities in the nature of [**specify activities**]; Providing information on educational or entertainment events; Providing recreation facilities; Publication of books; Rental of books; Production of films on videotapes; Arranging and conducting of colloquiums, conferences, and conventions in the field of [**specify field**]; Organization of exhibitions for cultural or educational purposes in the field of [**specify field**]; Electronic publishing of on-line books and periodicals; Desktop publishing for others; and/or
- Class 42: Software design and development; development and updating of software; computer programming; conversion of computer data and programs; conversion of documents from a physical to an electronic medium.

The applicant may instead use different wording of its own choosing when amending the identification of goods/services. Please follow the guidelines discussed above to ensure specificity and accuracy. Also, please note that while the identification of goods/services may be clarified or limited by amendment, adding to the goods/services or broadening their scope beyond the current identification is not permitted. 37 C.F.R. §2.71(a); TMEP §1402.06. Therefore, applicant may not amend the identification to include goods/services that are not within the scope of the present identification.

To expedite prosecution of this application, applicant is encouraged to file its response to this Office action through the Trademark Electronic Application System (TEAS), available at <http://www.uspto.gov/teas/index.html>. If the applicant has questions about its application or needs assistance in responding to this Office action, please email or telephone the assigned trademark examining attorney directly at the number below.

/Cory Boone/
 Trademark Attorney
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HOW TO RESPOND TO THIS OFFICE ACTION:

- **ONLINE RESPONSE:** You may respond using the Office's Trademark Electronic Application System (TEAS) Response to Office action form available on our website at <http://www.uspto.gov/teas/index.html>. If the Office action issued via e-mail, you must wait 72 hours after receipt of the Office action to respond via TEAS. **NOTE: Do not respond by e-mail. THE USPTO WILL NOT ACCEPT AN E-MAILED RESPONSE.**
- **REGULAR MAIL RESPONSE:** To respond by regular mail, your response should be sent to the mailing return address above, and include the serial number, law office number, and examining attorney's name. **NOTE: The filing date of the response will be the date of**

receipt in the Office, not the postmarked date. To ensure your response is timely, use a certificate of mailing. 37 C.F.R. §2.197.

STATUS OF APPLICATION: To check the status of your application, visit the Office's Trademark Applications and Registrations Retrieval (TARR) system at <http://tarr.uspto.gov>.

VIEW APPLICATION DOCUMENTS ONLINE: Documents in the electronic file for pending applications can be viewed and downloaded online at <http://portal.uspto.gov/external/portal/tow>.

GENERAL TRADEMARK INFORMATION: For general information about trademarks, please visit the Office's website at <http://www.uspto.gov/main/trademarks.htm>

FOR INQUIRIES OR QUESTIONS ABOUT THIS OFFICE ACTION, PLEASE CONTACT THE ASSIGNED EXAMINING ATTORNEY SPECIFIED ABOVE.