

To: Eyeo GmbH (khorman@sandw.com)
Subject: U.S. TRADEMARK APPLICATION NO. 85835917 - ADBLOCK PLUS - 23718.0006
Sent: 3/6/2014 10:50:03 AM
Sent As: ECOM101@USPTO.GOV
Attachments: [Attachment - 1](#)
[Attachment - 2](#)

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

U.S. APPLICATION SERIAL NO. 85835917

MARK: ADBLOCK PLUS

85835917

CORRESPONDENT ADDRESS:

Kimberly B. Herman
Sullivan & Worcester LLP
One Post Office Square
Boston MA 02109

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APPLICANT: Eyeo GmbH

CORRESPONDENT'S REFERENCE/DOCKET NO :

23718.0006

CORRESPONDENT E-MAIL ADDRESS:

khorman@sandw.com

OFFICE ACTION

STRICT DEADLINE TO RESPOND TO THIS LETTER

TO AVOID ABANDONMENT OF APPLICANT'S TRADEMARK APPLICATION, THE USPTO MUST RECEIVE APPLICANT'S COMPLETE RESPONSE TO THIS LETTER **WITHIN 6 MONTHS** OF THE ISSUE/MAILING DATE BELOW.

ISSUE/MAILING DATE: 3/6/2014

THIS IS A FINAL ACTION.

This letter responds to applicant's Petition to Revive and Response to Office Action communication filed on January 17, 2014.

This application has been reinstated by the Commissioner for Trademarks. The Office records have been searched again 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.

Upon reconsideration, the Section 2(d) likelihood of confusion refusal based on U.S. Registration No. 2422608 and the potential Section 2(d) likelihood of confusion refusal based on Application Serial Nos. 85159033, 85631864 and 85742426 is withdrawn. Furthermore, the disclaimer requirement regarding the word ADBLOCK is withdrawn *as to Classes 038, 042 and 045 only*. Also, the applicant's revised Class 038, 042 and 045 identifications of services and entity clarification statement have been entered.

However, the applicant must respond to the following FINAL refusal and requirements:

Registration Refused – Name Differs in U.S. Application and Foreign Registration – Section 44(e) Sole Basis – FINAL

Registration is refused under Trademark Act Section 44(e) because applicant was not the owner of the foreign registration on the filing date of the U.S. application. *See* 15 U.S.C. §1126(e); TMEP §1005.

In its response, applicant submitted a copy of an assignment and stated that the foreign registration was assigned from Wladimir Palant to Eyeo GmbH on December 10, 2012. However, the date of execution does not appear on the copy of the assignment submitted by applicant and therefore does not prove that the foreign registration was assigned to applicant on or before the filing date of the U.S. Application. If applicant submits a copy of the assignment showing the date of execution, then this refusal will be reconsidered.

In an application filed solely under Section 44(e), the applicant must be the owner of the foreign registration on the filing date of the U.S. application. TMEP §1005; *see* 37 C.F.R. §2.34(a)(3); *In re De Luxe, N.V.*, 990 F.2d 607, 609, 26 USPQ2d 1475, 1477 (Fed. Cir. 1993); *In re Tong Yang Cement Corp.*, 19 USPQ2d 1689, 1690-91 (TTAB 1991). However, in this case, the foreign registration specifies an owner other than the U.S. applicant. Specifically, the U.S. application sets forth the owner as Eyeo GmbH, while the foreign registration sets forth the owner as Wladimir Palant.

If applicant can prove the foreign registration was assigned to applicant on or before the filing date of the U.S. application, the Section 44(e) basis can remain in the application. *See* TMEP §1005. Applicant may establish ownership of the foreign registration by submitting (1) a copy of an assignment document, (2) certification from the foreign trademark office that reflects applicant's ownership of the foreign registration and the date of the assignment, or (3) a printout from the intellectual property's office website that shows the foreign registration was assigned to applicant on or before the filing date of the U.S. application. *See* TMEP §§1005, 1006.

If applicant did not own the foreign registration on or before the filing date of the U.S. application, applicant will have to amend to an acceptable basis, such as Section 1(a) or 1(b). *See* TMEP §§806.03, 1005. A foreign registration certificate is not required for a Section 1(a) or 1(b) basis. *See* 15 U.S.C. §1051(a)-(b); TMEP §806.01(a)-(b).

This refusal is made FINAL.

Identification of Goods – Clarification Required – Class 009 - FINAL

The wording “Computer programs for allowing users to filter or prevent the display of advertisements ... computer software for allowing users to filter or prevent the display of advertisements” in the Class 009 identification of goods is indefinite and must be clarified because the function/purpose of the programs remains unclear. *See* TMEP §1402.01. Applicant must clarify from what medium (e.g., in video game content, on the Internet) do the programs filter or prevent the display of advertisements.

An identification for computer software must specify the purpose or function of the software. *See* TMEP §1402.03(d). If the software is field-specific, the identification must also specify the field of use. *Id.* Clarification of the purpose, function, or field of use of the software is necessary for the USPTO to properly examine the application and make appropriate decisions concerning possible conflicts between the applicant’s mark and other marks. *See In re N.A.D. Inc.*, 57 USPQ2d 1872, 1874 (TTAB 2000).

Applicant may adopt the following identification of goods, if accurate:

“Computer programs for allowing users [*insert clarification of “to filter or prevent the display of advertisements,” e.g., to filter or prevent the display of advertisements on the Internet*]; parts and fittings for computer programs, namely subroutines, program modules, program generators, and help and interface programs which filter or prevent the display of advertisements; data recorded on data carriers, namely, pre-recorded magnetic data carriers featuring data for detection of computer viruses; computer software for allowing users [*insert clarification of “to filter or prevent the display of advertisements,” e.g., to filter or prevent the display of advertisements on the Internet*], in **International Class 009.**”

For assistance with identifying and classifying goods and/or 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.

Although identifications of goods and/or services may be amended 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.*, 1402.07. Therefore, applicant may not amend the identification to include goods and/or services that are not within the scope of the goods and/or services set forth in the present identification.

This requirement is made FINAL.

Disclaimer – Class 009 - FINAL

THIS REQUIREMENT APPLIES ONLY TO CLASS 009.

Applicant must disclaim the descriptive wording “ADBLOCK” for International Class 009 apart from the mark as shown because it merely describes the goods. *See* 15 U.S.C. §1056(a); TMEP §§1213, 1213.03(a).

The word “ad” is the short form of advertisement. The word “block” means to prevent movement through or past something, or to prevent something from happening or succeeding. *See attached online dictionary definitions of these words from the Cambridge Dictionaries Online.* This wording is merely descriptive because it describes a function or purpose of the goods – that is, the goods function to prevent advertisements from coming into view or prevent advertisements from moving or passing into view.

The applicant’s own amended Class 009 identification of goods provides evidence that this wording is

merely descriptive of the goods – the identification states that applicant’s software allows users to filter “or prevent the display of advertisements.” Applicant’s own wording in its identification makes it clear that the purpose or function of the software is to block ads from being displayed.

In its response, applicant argues that ADBLOCK is not merely descriptive because other meanings for the word “block” exist that are more common and expected than the meaning referring to an obstruction and the multiple meanings of the word “block” indicates that it is not merely descriptive of the goods but rather is suggestive.

The examining attorney has carefully considered this argument but finds it unpersuasive. Descriptiveness is considered in relation to the relevant goods and/or services. *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 1254, 103 USPQ2d 1753, 1757 (Fed. Cir. 2012). “That a term may have other meanings in different contexts is not controlling.” *In re Franklin Cnty. Historical Soc’y*, 104 USPQ2d 1085, 1087 (TTAB 2012) (citing *In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979)); TMEP §1209.03(e). Also, a mark is suggestive if some imagination, thought, or perception is needed to understand the nature of the goods and/or services described in the mark; whereas a descriptive term immediately and directly conveys some information about the goods and/or services. *See DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 1251-52, 103 USPQ2d 1753, 1755 (Fed. Cir. 2012) (quoting *In re Abcor Dev. Corp.*, 588 F.2d 811, 814, 200 USPQ 215, 218 (C.C.P.A. 1978)); *In re Steelbuilding.com*, 415 F.3d 1293, 1297, 75 USPQ2d 1420, 1422 (Fed. Cir. 2005); TMEP §1209.01(a). In this case, the wording ADBLOCK immediately and directly provides some information about the goods – namely, that the goods function to block ads from view. No imagination, thought or perception is needed in this case to understand the nature of the goods.

In its response, applicant states the term ADBLOCK is unitary and therefore not subject to a disclaimer requirement, and disclaimers are not required in compound marks which are made up of two or more distinct words that are represented by one word.

The examining attorney has carefully considered this argument but finds it unpersuasive. Generally, if the individual components of a mark retain their descriptive meaning in relation to the goods and/or services, the combination results in a composite mark that is itself descriptive and not registrable. *In re Phoseon Tech., Inc.*, 103 USPQ2d 1822, 1823 (TTAB 2012); TMEP §1209.03(d); *see, e.g., In re Petroglyph Games, Inc.*, 91 USPQ2d 1332, 1341 (TTAB 2009) (holding BATTLECAM merely descriptive of computer game software with a feature that involve battles and provides the player with the option to utilize various views of the battlefield); *In re Sun Microsystems, Inc.*, 59 USPQ2d 1084, 1085 (TTAB 2001) (holding AGENTBEANS merely descriptive of computer software for use in developing and deploying application programs on a global computer network).

Only where the combination of descriptive terms creates a unitary mark with a unique, incongruous, or otherwise nondescriptive meaning in relation to the goods and/or services is the combined mark registrable. *See In re Colonial Stores, Inc.*, 394 F.2d 549, 551, 157 USPQ 382, 384 (C.C.P.A. 1968); *In re Positec Grp. Ltd.*, 108 USPQ2d 1161, 1162-63 (TTAB 2013).

In this case, both the individual components and the composite result are descriptive of applicant’s goods and do not create a unique, incongruous, or nondescriptive meaning in relation to the goods. Specifically, the individual words AD and BLOCK merely describe a function or purpose of the goods – that is, the software is used to prevent the display of “advertisements” and the software is used to prevent advertisements from coming into view or prevent advertisements from moving or passing into view. Also, the composite ADBLOCK as a whole merely describes a function or purpose of the goods – that is, the

goods function to block ads from display.

In its response, applicant argues that ADBLOCK has a double meaning or a sound pattern that creates a separate commercial impression and therefore the disclaimer is not required.

The examining attorney has carefully considered this argument but finds it unpersuasive. A “double entendre” is an expression that has a double connotation or significance as applied to the goods and/or services. TMEP §1213.05(c); *see In re Colonial Stores Inc.*, 394 F.2d 549, 552-53, 157 USPQ 382, 384-85 (C.C.P.A. 1968) (finding SUGAR & SPICE a double entendre and not descriptive for bakery products because it evokes the nursery rhyme “sugar and spice and everything nice”).

A mark that comprises a “double entendre” will not be refused registration as merely descriptive if one of its meanings is not merely descriptive in relation to the goods and/or services. TMEP §1213.05(c). However, the multiple meanings that make an expression a “double entendre” must be well-recognized by the public and readily apparent from the mark itself. *See In re Brown-Forman Corp.*, 81 USPQ2d 1284, 1287 (TTAB 2006) (finding GALA ROUGE not a double entendre in relation to wines and affirming requirement to disclaim ROUGE); *In re The Place, Inc.*, 76 USPQ2d 1467, 1470-71 (TTAB 2005) (finding THE GREATEST BAR not a double entendre in relation to restaurant and bar services and affirming refusal to register based on descriptiveness of the mark); *In re Ethnic Home Lifestyles Corp.*, 70 USPQ2d 1156, 1158-59 (TTAB 2003) (finding ETHNIC ACCENTS not a double entendre in relation to television programs in the field of home décor and affirming refusal to register based on descriptiveness of the mark). In this case, applicant does fully explain what the multiple meanings of ADBLOCK are and does not provide evidence that these multiple meanings are well-recognized by the public and readily apparent from the mark itself.

The Office can require an applicant to disclaim an unregistrable part of a mark consisting of particular wording, symbols, numbers, design elements or combinations thereof. 15 U.S.C. §1056(a). Under Trademark Act Section 2(e), the Office can refuse registration of an entire mark if the entire mark is merely descriptive, deceptively misdescriptive, or primarily geographically descriptive of the goods. 15 U.S.C. §1052(e). Thus, the Office may require an applicant to disclaim a portion of a mark that, when used in connection with the goods or services, is merely descriptive, deceptively misdescriptive, primarily geographically descriptive, or otherwise unregistrable (e.g., generic). *See* TMEP §§1213, 1213.03.

Failure to comply with a disclaimer requirement can result in a refusal to register the entire mark. TMEP §1213.01(b).

A “disclaimer” is a statement that applicant does not claim exclusive rights to an unregistrable component of a mark. TMEP §1213. A disclaimer does not affect the appearance of the applied-for mark. *See* TMEP §1213.10.

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.

The following cases further explain the disclaimer requirement: *Dena Corp. v. Belvedere Int’l Inc.*, 950 F.2d 1555, 21 USPQ2d 1047 (Fed. Cir. 1991); *In re Brown-Forman Corp.*, 81 USPQ2d 1284 (TTAB 2006); *In re Kraft, Inc.*, 218 USPQ 571 (TTAB 1983).

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 “ADBLOCK” for International Class 009 apart from the mark as shown.

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

This requirement is made FINAL.

Proper Response to Final Office Action

If applicant does not respond within six months of the mailing date of this final Office action, the application will be abandoned. 15 U.S.C. §1062(b); 37 C.F.R. §2.65(a). Applicant may respond to this final Office action by:

- (1) Submitting a response that fully satisfies all outstanding requirements, if feasible; and/or
- (2) Filing an appeal to the Trademark Trial and Appeal Board, with an appeal fee of \$100 per class.

37 C.F.R. §§2.6(a)(18), 2.64(a); TBMP ch. 1200; TMEP §714.04.

In certain rare circumstances, a petition to the Director may be filed pursuant to 37 C.F.R. §2.63(b)(2) to review a final Office action that is limited to procedural issues. 37 C.F.R. §2.64(a); TMEP §714.04; *see* 37 C.F.R. §2.146(b); TBMP §1201.05; TMEP §1704 (explaining petitionable matters). The petition fee is \$100. 37 C.F.R. §2.6(a)(15).

/Andrew Rhim/
Andrew Rhim
Law Office 101
Phone (571) 272-9711
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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>.

FAST Examiner Application - [Case File 85835917]

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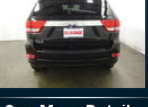



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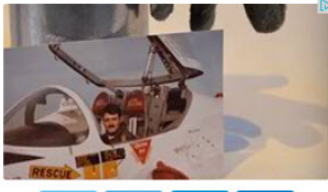
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English definition of "ad"

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FAST Examiner Application - [Case File 85835917]

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English definition of "block"

block

verb [T] (PREVENT) **US** /blɒk/

to prevent movement through or past something, or to prevent something from happening or succeeding:

A fallen tree blocked the road.

A large man in front of me blocked my view.

Earl scored 28 points and blocked five shots.

Congress blocked US aid to the government because of its segregation and human rights policies.

(Definition of block verb (PREVENT) from the Cambridge Academic Content Dictionary © Cambridge University Press)

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1:28 PM3/4/2014

To: Eyeo GmbH (kherman@sandw.com)
Subject: U.S. TRADEMARK APPLICATION NO. 85835917 - ADBLOCK PLUS - 23718.0006
Sent: 3/6/2014 10:50:03 AM
Sent As: ECOM101@USPTO.GOV
Attachments:

UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

**IMPORTANT NOTICE REGARDING YOUR
U.S. TRADEMARK APPLICATION**

USPTO OFFICE ACTION (OFFICIAL LETTER) HAS ISSUED
ON **3/6/2014** FOR U.S. APPLICATION SERIAL NO. 85835917

Please follow the instructions below:

(1) TO READ THE LETTER: Click on this [link](#) or go to <http://tsdr.uspto.gov>, enter the U.S. application serial number, and click on “Documents.”

The Office action may not be immediately viewable, to allow for necessary system updates of the application, but will be available within 24 hours of this e-mail notification.

(2) TIMELY RESPONSE IS REQUIRED: Please carefully review the Office action to determine (1) how to respond, and (2) the applicable response time period. Your response deadline will be calculated from **3/6/2014** (*or sooner if specified in the Office action*). For information regarding response time periods, see <http://www.uspto.gov/trademarks/process/status/responsetime.jsp>.

Do NOT hit “Reply” to this e-mail notification, or otherwise e-mail your response because the USPTO does NOT accept e-mails as responses to Office actions. Instead, the USPTO recommends that you respond online using the Trademark Electronic Application System (TEAS) response form located at http://www.uspto.gov/trademarks/teas/response_forms.jsp.

(3) QUESTIONS: For questions about the contents of the Office action itself, please contact the assigned trademark examining attorney. For *technical* assistance in accessing or viewing the Office action in the Trademark Status and Document Retrieval (TSDR) system, please e-mail TSDR@uspto.gov.

WARNING

Failure to file the required response by the applicable response deadline will result in the

ABANDONMENT of your application. For more information regarding abandonment, see <http://www.uspto.gov/trademarks/basics/abandon.jsp>.

PRIVATE COMPANY SOLICITATIONS REGARDING YOUR APPLICATION: Private companies **not** associated with the USPTO are using information provided in trademark applications to mail or e-mail trademark-related solicitations. These companies often use names that closely resemble the USPTO and their solicitations may look like an official government document. Many solicitations require that you pay “fees.”

Please carefully review all correspondence you receive regarding this application to make sure that you are responding to an official document from the USPTO rather than a private company solicitation. All official USPTO correspondence will be mailed only from the “United States Patent and Trademark Office” in Alexandria, VA; or sent by e-mail from the domain “@uspto.gov.” For more information on how to handle private company solicitations, see http://www.uspto.gov/trademarks/solicitation_warnings.jsp.