

Response to Office Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	97120686
LAW OFFICE ASSIGNED	LAW OFFICE 122
MARK SECTION	
MARK FILE NAME	https://tmng-al.uspto.gov/resting2/api/img/97120686/large
LITERAL ELEMENT	C
STANDARD CHARACTERS	NO
USPTO-GENERATED IMAGE	NO
GOODS AND/OR SERVICES SECTION (009) (current)	
INTERNATIONAL CLASS	009
DESCRIPTION	
Downloadable software application featuring a software suite for the automation and validation of the compliance of information technology across multiple information technology frameworks with various types of security regulations and thresholds; Downloadable software application featuring software for the automation and validation of the compliance of information technology with security regulations and thresholds in the financial industry	
FILING BASIS	Section 1(b)
GOODS AND/OR SERVICES SECTION (009) (proposed)	
INTERNATIONAL CLASS	009
TRACKED TEXT DESCRIPTION	
Downloadable software application featuring a software suite for the automation and validation of the compliance of information technology across multiple information technology frameworks with various types of security regulations and thresholds; Downloadable computer application software for the automation and validation of the compliance of information technology across multiple information technology frameworks with various types of security regulations and thresholds; Downloadable software application featuring software for the automation and validation of the compliance of information technology with security regulations and thresholds in the financial industry; Downloadable computer application software for the automation and validation of the compliance of information technology with security regulations and thresholds in the financial industry	
FINAL DESCRIPTION	
Downloadable computer application software for the automation and validation of the compliance of information technology across multiple information technology frameworks with various types of security regulations and thresholds; Downloadable computer application software for the automation and validation of the compliance of information technology with security regulations and thresholds in the financial industry	
WEBPAGE URL	None Provided
WEBPAGE DATE OF ACCESS	None Provided
FILING BASIS	Section 1(b)
GOODS AND/OR SERVICES SECTION (042) (current)	
INTERNATIONAL CLASS	042

DESCRIPTION	
Providing online non-downloadable software featuring a software suite for the automation and validation of the compliance of information technology across multiple information technology frameworks with various types of security regulations and thresholds; Software as a Service (SaaS) services featuring a software suite for the automation and validation of the compliance of information technology across multiple information technology frameworks with various types of security regulations and thresholds; Providing online non-downloadable software featuring software for the automation and validation of the compliance of information technology with security regulations and thresholds in the financial industry; SaaS services featuring software for the automation and validation of the compliance of information technology with security regulations and thresholds in the financial industry	
FILING BASIS	Section 1(b)
GOODS AND/OR SERVICES SECTION (042) (proposed)	
INTERNATIONAL CLASS	042
TRACKED TEXT DESCRIPTION	
Providing online non-downloadable software featuring a software suite for the automation and validation of the compliance of information technology across multiple information technology frameworks with various types of security regulations and thresholds; Providing online non-downloadable software for the automation and validation of the compliance of information technology across multiple information technology frameworks with various types of security regulations and thresholds; Software as a Service (SaaS) services featuring a software suite for the automation and validation of the compliance of information technology across multiple information technology frameworks with various types of security regulations and thresholds; Software as a Service (SaaS) services featuring software for the automation and validation of the compliance of information technology across multiple information technology frameworks with various types of security regulations and thresholds; Providing online non-downloadable software featuring software for the automation and validation of the compliance of information technology with security regulations and thresholds in the financial industry; Providing online non-downloadable software for the automation and validation of the compliance of information technology with security regulations and thresholds in the financial industry; SaaS services featuring software for the automation and validation of the compliance of information technology with security regulations and thresholds in the financial industry; Software as a service (SaaS) services featuring software for the automation and validation of the compliance of information technology with security regulations and thresholds in the financial industry	
FINAL DESCRIPTION	
Providing online non-downloadable software for the automation and validation of the compliance of information technology across multiple information technology frameworks with various types of security regulations and thresholds; Software as a Service (SaaS) services featuring software for the automation and validation of the compliance of information technology across multiple information technology frameworks with various types of security regulations and thresholds; Providing online non-downloadable software for the automation and validation of the compliance of information technology with security regulations and thresholds in the financial industry; Software as a service (SaaS) services featuring software for the automation and validation of the compliance of information technology with security regulations and thresholds in the financial industry	
WEBPAGE URL	None Provided
WEBPAGE DATE OF ACCESS	None Provided
FILING BASIS	Section 1(b)
CORRESPONDENCE INFORMATION (current)	
NAME	Rajesh Fotedar
PRIMARY EMAIL ADDRESS FOR CORRESPONDENCE	rfotedar@cognitionip.com
SECONDARY EMAIL ADDRESS(ES) (COURTESY COPIES)	tm-notifications@cognitionip.com
DOCKET/REFERENCE NUMBER	3867-032363
CORRESPONDENCE INFORMATION (proposed)	
NAME	Rajesh Fotedar
PRIMARY EMAIL ADDRESS FOR CORRESPONDENCE	rfotedar@cognitionip.com
SECONDARY EMAIL ADDRESS(ES) (COURTESY COPIES)	tm-notifications@cognitionip.com
DOCKET/REFERENCE NUMBER	3867-032363
SIGNATURE SECTION	

RESPONSE SIGNATURE	/rf/
SIGNATORY'S NAME	Rajesh Fotedar
SIGNATORY'S POSITION	Attorney of record
DATE SIGNED	08/25/2022
ROLE OF AUTHORIZED SIGNATORY	Authorized U.S.-Licensed Attorney
SIGNATURE METHOD	Signed directly within the form
FILING INFORMATION SECTION	
SUBMIT DATE	Thu Aug 25 17:54:13 ET 2022
TEAS STAMP	USPTO/ROA-XX.XXX.XXX.XX-2 0220825175413540063-97120 686-8005b817166de3bb9297b ddbed0f492ebde8880181fc4c ec979fd50cf47d58e84e2-N/A -N/A-20220825175157204510

Response to Office Action

To the Commissioner for Trademarks:

Application serial no. **97120686** C (Stylized and/or with Design, see <https://tmng-al.uspto.gov/resting2/api/img/97120686/large>) has been amended as follows:

CLASSIFICATION AND LISTING OF GOODS/SERVICES

Applicant proposes to amend the following:

Current:

Class 009 for Downloadable software application featuring a software suite for the automation and validation of the compliance of information technology across multiple information technology frameworks with various types of security regulations and thresholds; Downloadable software application featuring software for the automation and validation of the compliance of information technology with security regulations and thresholds in the financial industry

Filing Basis: Section 1(b), Intent to Use: *For a trademark or service mark application:* The applicant believes the applicant is entitled to use the mark in commerce on or in connection with the goods or services specified in the application; the applicant has a bona fide intention to use the mark in commerce and had a bona fide intention to use the mark in commerce as of the application filing date. ***For a collective trademark, collective service mark, collective membership mark, or certification mark application:*** The applicant has a bona fide intention, and is entitled, to exercise legitimate control over the use of the mark in commerce and had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce as of the application filing date. ***For a certification mark application:*** The applicant will not engage in the production or marketing of the goods/services to which the mark is applied, except to advertise or promote recognition of the certification program or of the goods/services that meet the certification standards of the applicant.

Proposed:

Tracked Text Description: ~~Downloadable software application featuring a software suite for the automation and validation of the compliance of information technology across multiple information technology frameworks with various types of security regulations and thresholds;~~ Downloadable computer application software for the automation and validation of the compliance of information technology across multiple information technology frameworks with various types of security regulations and thresholds; ~~Downloadable software application featuring software for the automation and validation of the compliance of information technology with security regulations and thresholds in the financial industry;~~ Downloadable computer application software for the automation and validation of the compliance of information technology with

Class 009 for Downloadable computer application software for the automation and validation of the compliance of information technology across multiple information technology frameworks with various types of security regulations and thresholds; Downloadable computer application software for the automation and validation of the compliance of information technology with security regulations and thresholds in the financial industry

Filing Basis: Section 1(b), Intent to Use: *For a trademark or service mark application:* The applicant believes the applicant is entitled to use the mark in commerce on or in connection with the goods or services specified in the application; the applicant has a bona fide intention to use the mark in commerce and had a bona fide intention to use the mark in commerce as of the application filing date. ***For a collective trademark, collective service mark, collective membership mark, or certification mark application:*** The applicant has a bona fide intention, and is entitled, to exercise legitimate control over the use of the mark in commerce and had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce as of the application filing date. ***For a certification mark application:*** The applicant will not engage in the production or marketing of the goods/services to which the mark is applied, except to advertise or promote recognition of the certification program or of the goods/services that meet the certification standards of the applicant.

Webpage URL: None Provided

Webpage Date of Access: None Provided

Applicant proposes to amend the following:

Current:

Class 042 for Providing online non-downloadable software featuring a software suite for the automation and validation of the compliance of information technology across multiple information technology frameworks with various types of security regulations and thresholds; Software as a Service (SaaS) services featuring a software suite for the automation and validation of the compliance of information technology across multiple information technology frameworks with various types of security regulations and thresholds; Providing online non-downloadable software featuring software for the automation and validation of the compliance of information technology with security regulations and thresholds in the financial industry; SaaS services featuring software for the automation and validation of the compliance of information technology with security regulations and thresholds in the financial industry

Filing Basis: Section 1(b), Intent to Use: *For a trademark or service mark application:* The applicant believes the applicant is entitled to use the mark in commerce on or in connection with the goods or services specified in the application; the applicant has a bona fide intention to use the mark in commerce and had a bona fide intention to use the mark in commerce as of the application filing date. ***For a collective trademark, collective service mark, collective membership mark, or certification mark application:*** The applicant has a bona fide intention, and is entitled, to exercise legitimate control over the use of the mark in commerce and had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce as of the application filing date. ***For a certification mark application:*** The applicant will not engage in the production or marketing of the goods/services to which the mark is applied, except to advertise or promote recognition of the certification program or of the goods/services that meet the certification standards of the applicant.

Proposed:

Tracked Text Description: ~~Providing online non-downloadable software featuring a software suite for the automation and validation of the compliance of information technology across multiple information technology frameworks with various types of security regulations and thresholds;~~ [Providing online non-downloadable software for the automation and validation of the compliance of information technology across multiple information technology frameworks with various types of security regulations and thresholds;](#) ~~Software as a Service (SaaS) services featuring a software suite for the automation and validation of the compliance of information technology across multiple information technology frameworks with various types of security regulations and thresholds;~~ [Software as a Service \(SaaS\) services featuring software for the automation and validation of the compliance of information technology across multiple information technology frameworks with various types of security regulations and thresholds;](#) ~~Providing online non-downloadable software featuring software for the automation and validation of the compliance of information technology with security regulations and thresholds in the financial industry;~~ [Providing online non-downloadable software for the automation and validation of the compliance of information technology with security regulations and thresholds in the financial industry;](#) ~~SaaS services featuring software for the automation and validation of the compliance of information technology with security regulations and thresholds in the financial industry;~~ [Software as a service \(SaaS\) services featuring software for the automation and validation of the compliance of information technology with security regulations and thresholds in the financial industry](#)

Class 042 for Providing online non-downloadable software for the automation and validation of the compliance of information technology across multiple information technology frameworks with various types of security regulations and thresholds; Software as a Service (SaaS) services featuring software for the automation and validation of the compliance of information technology across multiple information technology frameworks with various types of security regulations and thresholds; Providing online non-downloadable software for the automation and validation of the compliance of information technology with security regulations and thresholds in the financial industry; Software as a service (SaaS) services featuring software for the automation and validation of the compliance of information technology with security regulations and

thresholds in the financial industry

Filing Basis: Section 1(b), Intent to Use: *For a trademark or service mark application:* The applicant believes the applicant is entitled to use the mark in commerce on or in connection with the goods or services specified in the application; the applicant has a bona fide intention to use the mark in commerce and had a bona fide intention to use the mark in commerce as of the application filing date. ***For a collective trademark, collective service mark, collective membership mark, or certification mark application:*** The applicant has a bona fide intention, and is entitled, to exercise legitimate control over the use of the mark in commerce and had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce as of the application filing date. ***For a certification mark application:*** The applicant will not engage in the production or marketing of the goods/services to which the mark is applied, except to advertise or promote recognition of the certification program or of the goods/services that meet the certification standards of the applicant.

Webpage URL: None Provided

Webpage Date of Access: None Provided

Correspondence Information (current):

Rajesh Fotedar

PRIMARY EMAIL FOR CORRESPONDENCE: rfotedar@cognitionip.com

SECONDARY EMAIL ADDRESS(ES) (COURTESY COPIES): tm-notifications@cognitionip.com

The docket/reference number is 3867-032363.

Correspondence Information (proposed):

Rajesh Fotedar

PRIMARY EMAIL FOR CORRESPONDENCE: rfotedar@cognitionip.com

SECONDARY EMAIL ADDRESS(ES) (COURTESY COPIES): tm-notifications@cognitionip.com

The docket/reference number is 3867-032363.

Requirement for Email and Electronic Filing: I understand that a valid email address must be maintained by the owner/holder and the owner's/holder's attorney, if appointed, and that all official trademark correspondence must be submitted via the Trademark Electronic Application System (TEAS).

SIGNATURE(S)

Response Signature

Signature: /rf/ Date: 08/25/2022

Signatory's Name: Rajesh Fotedar

Signatory's Position: Attorney of record

Signature method: Signed directly within the form

The signatory has confirmed that he/she is a U.S.-licensed attorney who is an active member in good standing of the bar of the highest court of a U.S. state (including the District of Columbia and any U.S. Commonwealth or territory); and he/she is currently the owner's/holder's attorney or an associate thereof; and to the best of his/her knowledge, if prior to his/her appointment another U.S.-licensed attorney not currently associated with his/her company/firm previously represented the owner/holder in this matter: the owner/holder has revoked their power of attorney by a signed revocation or substitute power of attorney with the USPTO; the USPTO has granted that attorney's withdrawal request; the owner/holder has filed a power of attorney appointing him/her in this matter; or the owner's/holder's appointed U.S.-licensed attorney has filed a power of attorney appointing him/her as an associate attorney in this matter.

Mailing Address: Rajesh Fotedar

Cognition IP, P.C.

201 Mission St., Suite 1200

San Francisco, California 94105

Mailing Address: Rajesh Fotedar

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Serial Number: 97120686

Internet Transmission Date: Thu Aug 25 17:54:13 ET 2022

TEAS Stamp: USPTO/ROA-XX.XXX.XXX.XX-2022082517541354

0063-97120686-8005b817166de3bb9297bddbed

0f492ebde8880181fc4cec979fd50cf47d58e84e
2-N/A-N/A-20220825175157204510

To: Rajesh Fotedar(rfotedar@cognitionip.com)
Subject: U.S. Trademark Application Serial No. 97120686 - C - 3867-032363
Sent: August 25, 2022 04:26:44 PM EDT
Sent As: tmng.notices@uspto.gov

Attachments

**United States Patent and Trademark Office (USPTO)
Office Action (Official Letter) About Applicant's Trademark Application**

U.S. Application Serial No. 97120686

Mark: C

Correspondence Address:

Rajesh Fotedar
Cognition IP, P.C.
201 Mission St., Suite 1200
San Francisco CA 94105 UNITED STATES

Applicant: InfoSec Toolkit Inc.

Reference/Docket No. 3867-032363

Correspondence Email Address: rfotedar@cognitionip.com

NONFINAL OFFICE ACTION

The USPTO must receive applicant's response to this letter within six months of the issue date below or the application will be [abandoned](#). Respond using the Trademark Electronic Application System (TEAS). A link to the appropriate TEAS response form appears at the end of this Office action.

Issue date: August 25, 2022

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

SUMMARY OF ISSUES:

- Identification of Goods and Services Requirement

SEARCH OF OFFICE'S DATABASE OF MARKS

The trademark examining attorney has searched the Office's database of registered and pending marks and has found no conflicting marks that would bar registration under Trademark Act Section 2(d). TMEP §704.02; *see* 15 U.S.C. §1052(d).

However, applicant must respond to the following requirement.

IDENTIFICATION OF GOODS AND SERVICES REQUIREMENT

The identification of goods and services is indefinite and must be clarified because it does not sufficiently specify the nature of the goods and services in order to enable proper classification. *See* 37 C.F.R. §2.32(a)(6); TMEP §1402.01.

Particularly, with respect to the downloadable software identified in International Class 009, applicant need not specify that the downloadable software features a software suite. Rather, the identification only needs to specify the purpose, use and/or function of the software identified. Moreover, for the "SAAS" services referenced in International Class 042, applicant must clarify the meaning of the acronym "Saas" included in the identification of services.

Applicant may adopt the following wording, if accurate:

International Class 009: “Downloadable **computer application software** for the automation and validation of the compliance of information technology across multiple information technology frameworks with various types of security regulations and thresholds; Downloadable **computer application software for** the automation and validation of the compliance of information technology with security regulations and thresholds in the financial industry”;

International Class 042: “Providing **online non-downloadable software for** the automation and validation of the compliance of information technology across multiple information technology frameworks with various types of security regulations and thresholds; Software as a Service (SaaS) services **featuring software for** the automation and validation of the compliance of information technology across multiple information technology frameworks with various types of security regulations and thresholds; Providing online non-downloadable **software for** the automation and validation of the compliance of information technology with security regulations and thresholds in the financial industry; **Software as a service** (SaaS) services featuring software for the automation and validation of the compliance of information technology with security regulations and thresholds in the financial industry”.

Applicant may amend the identification to clarify or limit the goods and services, but not to broaden or expand the goods and services beyond those in the original application or as acceptably amended. *See* 37 C.F.R. §2.71(a); TMEP §1402.06. Generally, any deleted goods and services may not later be reinserted. *See* TMEP §1402.07(e).

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*](#). *See* TMEP §1402.04.

How to respond. [Click to file a response to this nonfinal Office action.](#)

/Obieze Mmeje/
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RESPONSE GUIDANCE

- **Missing the response deadline to this letter will cause the application to [abandon](#).** The response must be received by the USPTO before midnight **Eastern Time** of the last day of the response period. TEAS maintenance or [unforeseen circumstances](#) could affect an applicant's ability to timely respond.
- **[Responses signed by an unauthorized party](#)** are not accepted and can **cause the application to [abandon](#)**. If applicant does not have an attorney, the response must be signed by the individual applicant, all joint applicants, or someone with [legal authority to bind a juristic applicant](#). If applicant has an attorney, the response must be signed by the attorney.
- If needed, **find [contact information for the supervisor](#)** of the office or unit listed in the signature block.

United States Patent and Trademark Office (USPTO)

USPTO OFFICIAL NOTICE

Office Action (Official Letter) has issued
on August 25, 2022 for
U.S. Trademark Application Serial No. 97120686

A USPTO examining attorney has reviewed your trademark application and issued an Office action. You must respond to this Office action in order to avoid your application abandoning. Follow the steps below.

- (1) **[Read the Office action](#)**. This email is NOT the Office action.
- (2) **Respond to the Office action by the deadline** using the Trademark Electronic Application System (TEAS). Your response must be received by the USPTO on or before 11:59 p.m. **Eastern Time** of the last day of the response period. Otherwise, your application will be **[abandoned](#)**. See the Office action itself regarding how to respond.
- (3) **Direct general questions** about using USPTO electronic forms, the USPTO **[website](#)**, the application process, the status of your application, and whether there are outstanding deadlines to the **[Trademark Assistance Center \(TAC\)](#)**.

After reading the Office action, address any question(s) regarding the specific content to the USPTO examining attorney identified in the Office action.

GENERAL GUIDANCE

- **[Check the status](#) of your application periodically** in the **[Trademark Status & Document Retrieval \(TSDR\)](#)** database to avoid missing critical deadlines.
- **[Update your correspondence email address](#)** to ensure you receive important USPTO notices about your application.
- **[Beware of trademark-related scams](#)**. Protect yourself from people and companies that may try to take financial advantage of you. Private companies may call you and pretend to be the USPTO or may send you communications that resemble official USPTO documents to trick you. We will never request your credit card number or social security number over the phone. And all official USPTO correspondence will only be emailed from the domain “@uspto.gov.” Verify the correspondence originated from us by using your Serial Number in our database, **[TSDR](#)**, to confirm that it appears under the “Documents” tab, or contact the **[Trademark Assistance Center](#)**.

- **Hiring a U.S.-licensed attorney.** If you do not have an attorney and are not required to have one under the trademark rules, we encourage you to hire a U.S.-licensed attorney specializing in trademark law to help guide you through the registration process. The USPTO examining attorney is not your attorney and cannot give you legal advice, but rather works for and represents the USPTO in trademark matters.

User: Obieze Mmeje

Statistics for Case 97120686						
#	Search	Total Marks	Dead Marks	Live Viewed Docs	Live Viewed Images	Status/Search Duration
1	C[bi,ti] not dead[ld]	14748	0	0	0	0:01
2	C[fm]	4299	0	0	0	0:00
3	2 and ("009" a b 200)[ic]	830	0	0	0	0:01
4	3 not dead[ld]	432	0	3	400	0:01
5	2 and ("042" a b 200)[ic]	663	0	0	0	0:01
6	5 not dead[ld]	358	0	3	358	0:01
7	1 and ("009" "042" a b 200)[ic]	3301	0	0	0	0:01
8	(241925 usb symbol)[dc] not dead[ld]	160	0	0	0	0:02
9	(260121 circles that are totally or partially shaded)[dc] not dead[ld]	114713	0	0	0	0:02
10	8 and 9	39	0	2	39	0:00
11	7 and (8 9)	330	0	1	330	0:01
12	8 and "009"[cc]	139	0	3	139	0:00
13	8 not 12	21	0	1	21	0:00

Session started 08/25/2022 3:57 pm

Session ended 08/25/2022 4:11 pm

Total search duration 11.00

Session duration 13 minutes 36 seconds

Adjacency Level 1

Near Level 1