

To: Insyde Software, Inc.(stephen.gentile@insyde.com)
Subject: U.S. Trademark Application Serial No. 97120700 - FORENSYCS
Sent: August 23, 2022 01:16:23 PM EDT
Sent As: tmng.notices@uspto.gov

Attachments

[AHD1.jpg](#)

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

U.S. Application Serial No. 97120700

Mark: FORENSYCS

Correspondence Address:

INSYDE SOFTWARE, INC.
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WESTBOROUGH MA 01581 UNITED STATES

Applicant: Insyde Software, Inc.

Reference/Docket No. N/A

Correspondence Email Address: stephen.gentile@insyde.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 23, 2022

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

SEARCH OF USPTO DATABASE OF MARKS

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

SUMMARY OF ISSUES:

1. Section 2(e)(1) Refusal - Merely Descriptive
2. Request for Information - Response Required
3. Advisory: Amendment to Supplemental Register Suggested But Not Permitted Until Acceptable AAU Is Filed
4. Advisory: Applicant May Wish To Seek Trademark Counsel

SECTION 2(e)(1) REFUSAL – MERELY DESCRIPTIVE

Registration is refused because the applied-for mark merely describes a feature, characteristic, purpose, function, and/or use of applicant's services. Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1); *see* TMEP §§1209.01(b), 1209.03 *et seq.*

A mark is merely descriptive if it describes an ingredient, quality, characteristic, function, feature, purpose, and/or use of an applicant's goods and/or services. TMEP §1209.01(b); *see, e.g., In re TriVita, Inc.*, 783 F.3d 872, 874, 114 USPQ2d 1574, 1575 (Fed. Cir. 2015) (quoting *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 1173, 71 USPQ2d 1370, 1371 (Fed. Cir. 2004)); *In re Steelbuilding.com*, 415 F.3d 1293, 1297, 75 USPQ2d 1420, 1421 (Fed. Cir. 2005) (citing *Estate of P.D. Beckwith, Inc. v. Comm'r of Patents*, 252 U.S. 538, 543 (1920)).

In the present case, the applied-for mark is FORENSYCS for "[c]omputer security threat analysis for protecting data" in International Class 042. Here, the wording FORENSYCS appears to be a novel or intentional misspelling of the wording *forensics*, which according to *The American Heritage Dictionary*, can be defined as "[t]he use of science and technology to investigate and establish facts...". *See* attached for dictionary definition.

A novel spelling or an intentional misspelling that is the phonetic equivalent of a merely descriptive word or term is also merely descriptive if purchasers would perceive the different spelling as the equivalent of the descriptive word or term. *See In re Quik-Print Copy Shop, Inc.*, 616 F.2d 523, 526 & n.9, 205 USPQ 505, 507 & n.9 (C.C.P.A. 1980) (holding "QUIK-PRINT," phonetic spelling of "quick-print," merely descriptive of printing and photocopying services); *In re Calphalon Corp.*, 122 USPQ2d 1153, 1163 (TTAB 2017) (holding "SHARPIN", phonetic spelling of "sharpen," merely descriptive of cutlery knife blocks with built-in sharpeners); *In re Carlson*, 91 USPQ2d 1198, 1203 (TTAB 2009) (holding "URBANHOUSING," phonetic spelling of "urban" and "housing," merely descriptive of real estate services); TMEP §1209.03(j).

As such, when the applied-for mark is considered in connection with the identified services, it is immediately descriptive. This is because it conveys, without any ambiguity, a feature, characteristic, purpose, function, and/or use of applicant's services, namely, forensic services in the form of computer security threat analysis for protecting data.

Therefore, for the reasons discussed above, the applied-for mark is refused registration on the Principal Register under Trademark Act Section 2(e)(1).

Although applicant's mark has been refused registration, applicant may respond to the refusal by submitting evidence and arguments in support of registration. However, if applicant responds to the refusal, applicant must also respond to the requirement set forth below.

REQUEST FOR INFORMATION - RESPONSE REQUIRED

Due to the descriptive nature of the applied-for mark, applicant must provide the following information and documentation regarding the services and wording appearing in the mark:

(1) Fact sheets, instruction manuals, brochures, advertisements and pertinent screenshots of applicant's website as it relates to the services in the application, including any materials using the terms in the applied-for mark. Merely stating that information about the services is available on applicant's website is insufficient to make the information of record.;

(2) If these materials are unavailable, applicant should submit similar documentation for services of the same type, explaining how its own services will differ. If the services feature new technology and information regarding competing services is not available, applicant must provide a detailed factual description of the services. Factual information about the services must make clear what the services are and how they are rendered, salient features, and prospective customers and channels of trade. Conclusory statements will not satisfy this requirement.; and

(3) Applicant must respond to the following questions:

- Do the identified services feature any type of forensics in any way, shape or form?
- Do the identified services involve any type of forensics in any way, shape or form?
- Do the identified services utilize any type of forensics in any way, shape or form?

See 37 C.F.R. §2.61(b); TMEP §§814, 1402.01(e).

If applicant submits webpage evidence to satisfy this requirement, applicant must provide (1) an image of the webpage, (2) the date it was accessed or printed, and (3) the complete URL address. *In re ADCO Indus.-Techs., L.P.*, 2020 USPQ2d 53786, at *2 (TTAB 2020) (citing *In re I-Coat Co.*, 126 USPQ2d 1730, 1733 (TTAB 2018)); TMEP §710.01(b). Providing only a website address or hyperlink to the webpage is not sufficient to make the materials of record. *In re ADCO Indus.-Techs., L.P.*, 2020 USPQ2d 53786, at *2 (citing *In re Olin Corp.*, 124 USPQ2d 1327, 1331 n.15 (TTAB 2017); *In re HSB Solomon Assocs., LLC*, 102 USPQ2d 1269, 1274 (TTAB 2012); TBMP §1208.03); TMEP §814.

Applicant has a duty to respond directly and completely to this requirement for information. *See In re Ocean Tech., Inc.*, 2019 USPQ2d 450686, at *2 (TTAB 2019) (citing *In re AOP LLC*, 107 USPQ2d 1644, 1651 (TTAB 2013)); TMEP §814. Failure to comply with a requirement for information is an independent ground for refusing registration. *In re SICPA Holding SA*, 2021 USPQ2d 613, at *6 (TTAB 2021) (citing *In re Cheezwhse.com, Inc.*, 85 USPQ2d 1917, 1919 (TTAB 2008); *In re DTI P'ship LLP*, 67 USPQ2d 1699, 1701-02 (TTAB 2003); TMEP §814).

ADVISORY: AMENDMENT TO SUPPLEMENTAL REGISTER SUGGESTED BUT NOT

PERMITTED UNTIL ACCEPTABLE AAU IS FILED

Although an amendment to the Supplemental Register would be an appropriate response to this refusal in an application based on Trademark Act Section 1(a) or 44, such a response is not appropriate in the present case. The instant application was filed under Section 1(b) and is not eligible for registration on the Supplemental Register until an acceptable amendment to allege use meeting the requirements of 37 C.F.R. §2.76 has been timely filed. 37 C.F.R. §2.47(d); TMEP §§816.02, 1102.03.

If applicant files an acceptable allegation of use and also amends to the Supplemental Register, the application effective filing date will be the date applicant met the minimum filing requirements under 37 C.F.R. §2.76(c) for an amendment to allege use. TMEP §§816.02, 1102.03; *see* 37 C.F.R. §2.75(b). In addition, the undersigned trademark examining attorney will conduct a new search of the USPTO records for conflicting marks based on the later application filing date. TMEP §§206.01, 1102.03.

Although registration on the Supplemental Register does not afford all the benefits of registration on the Principal Register, it does provide the following advantages to the registrant:

(1) Use of the registration symbol ® with the registered mark in connection with the designated goods and/or services, which provides public notice of the registration and potentially deters third parties from using confusingly similar marks.

(2) Inclusion of the registered mark in the USPTO's database of registered and pending marks, which will (a) make it easier for third parties to find it in trademark search reports, (b) provide public notice of the registration, and thus (c) potentially deter third parties from using confusingly similar marks.

(3) Use of the registration by a USPTO trademark examining attorney as a bar to registering confusingly similar marks in applications filed by third parties.

(4) Use of the registration as a basis to bring suit for trademark infringement in federal court, which, although more costly than state court, means judges with more trademark experience, often faster adjudications, and the opportunity to seek an injunction, actual damages, and attorneys' fees and costs.

(5) Use of the registration as a filing basis for a trademark application for registration in certain foreign countries, in accordance with international treaties.

See 15 U.S.C. §§1052(d), 1091, 1094; J. Thomas McCarthy, *McCarthy on Trademarks & Unfair Competition* §§19:33, 19:37 (rev. 4th ed. Supp. 2017).

ADVISORY: APPLICANT MAY WISH TO SEEK TRADEMARK COUNSEL

Because of the legal technicalities and strict deadlines of the trademark application process, applicant is encouraged to hire a private attorney who specializes in trademark matters to assist in this process. The assigned trademark examining attorney can provide only limited assistance explaining the content of an Office action and the application process. USPTO staff cannot provide legal advice or statements about an applicant's legal rights. TMEP §§705.02, 709.06. See [Hiring a U.S.-licensed trademark attorney](#) for more information.

RESPONSE GUIDELINES

For this application to proceed, applicant must explicitly address each refusal and/or requirement in this Office action. For a refusal, applicant may provide written arguments and evidence against the refusal, and may have other response options if specified above. For a requirement, applicant should set forth the changes or statements. Please see “[Responding to Office Actions](#)” and the informational [video “Response to Office Action”](#) for more information and tips on responding.

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

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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 23, 2022 for
U.S. Trademark Application Serial No. 97120700

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.

Note To The File

Serial Number: 97120700
Date: 08/23/2022 12:42 pm
Created by: Adetayo Adeyiga

FORENSYCS

Searched

- Google
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User: Adetayo Adeyiga

Statistics for Case 97120700						
#	Search	Total Marks	Dead Marks	Live Viewed Docs	Live Viewed Images	Status/Search Duration
1	*{"fh"}o{"u"0:1}r{v}n{"csz"}{"iey"}{"ckqx"}*[bi,ti] not dead[ld]	309	0	309	309	0:15
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3	*4*[bi,ti] not dead[ld]	22541	0	0	0	0:01
4	*n{"csz"}{"iey"}{"ckqx"}*[bi,ti] not dead[ld]	1524	0	0	0	0:02
5	(3 and 4)	8	0	8	8	0:01

Session started 08/23/2022 12:36 pm

Session ended 08/23/2022 12:40 pm

Total search duration 19.00

Session duration 3 minutes 53 seconds

Adjacency Level 1

Near Level 1