

To: Michelle K. Bray(michelle.bray@karglobal.com)
Subject: U.S. Trademark Application Serial No. 97120624 - BACKLOT CARS
Sent: August 24, 2022 11:31:49 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. 97120624

Mark: BACKLOT CARS

Correspondence Address:

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CARMEL IN 46032 UNITED STATES

Applicant: BacklotCars, Inc.

Reference/Docket No. N/A

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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 24, 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.

SUMMARY OF ISSUES:

- Sections 1 and 45 Refusal - Unacceptable Specimen (Limited to Class 9 only);
- Requirement - Identification of Goods and Services.

SEARCH OF USPTO'S DATABASE OF MARKS; NO CONFLICTING MARK(S) FOUND

The trademark examining attorney has searched the USPTO'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 refusal(s) and requirement(s) set forth below.

SECTIONS 1 AND 45 REFUSAL - UNACCEPTABLE SPECIMEN THIS PARTIAL REFUSAL APPLIES TO INTERNATIONAL CLASS 9 ONLY

Specimen is not an acceptable display for software. Registration is refused because the specimen in International Class 9 is not acceptable as a display associated with downloadable software and does not show the applied-for mark as actually used in commerce. Trademark Act Sections 1 and 45, 15 U.S.C. §§1051, 1127; 37 C.F.R. §§2.34(a)(1)(iv), 2.56(a), (b)(1); TMEP §§904, 904.03(e), (g), 904.07(a). An application based on Trademark Act Section 1(a) must include a specimen showing the applied-for mark as actually used in commerce for each international class of goods identified in the application or amendment to allege use. 15 U.S.C. §1051(a)(1); 37 C.F.R. §§2.34(a)(1)(iv), 2.56(a); TMEP §§904, 904.07(a).

A display specimen for downloadable software (1) must show use of the mark directly associated with the goods and (2) such use must be of a point-of-sale nature. 37 C.F.R. §2.56(b)(1). To show use of a point-of-sale nature, a specimen generally must provide sufficient information to enable the user to download or purchase the software from a website. *See* TMEP §904.03(e) (citing *In re Azteca Sys., Inc.*, 102 USPQ2d 1955, 1957 (TTAB 2012)).

In this case, the specimen does not provide the means to enable the user to download or purchase the software from the website. *See In re Sones*, 590 F.3d 1282, 1286-89, 93 USPQ2d 1118, 1122-24 (Fed. Cir. 2009); *In re Azteca Sys., Inc.*, 102 USPQ2d at 1957; TMEP §904.03(e), (i). Accordingly, such material is mere advertising, which is not acceptable as a specimen for goods. *See In re Yarnell Ice Cream, LLC*, 2019 USPQ2d 265039, at *15-16 (TTAB 2019) (quoting *In re Siny Corp.*, 920 F.3d 1331, 1336, 2019 USPQ2d 127099, at *2-3 (Fed. Cir. 2019)); *see also Avakoff v. S. Pac. Co.*, 765 F.2d 1097, 1098, 226 USPQ 435, 436 (Fed. Cir. 1985); TMEP §904.04(b), (c).

Examples of specimens. Specimens for downloadable software include instruction manuals or screen printouts from (1) webpages showing (a) the mark associated with the software and (b) ordering or purchasing information or information sufficient to download the software, (2) the actual program while running that shows the mark in the title bar, or (3) launch screens that show the mark in an introductory message box that appears after opening the program. *See* TMEP §904.03(e), (i), (j). Any webpage printout or screenshot submitted as a specimen must include the webpage's URL and the date it was accessed or printed on the specimen itself, within the TEAS form that submits the specimen, or in a verified statement under 37 C.F.R. §2.20 or 28 U.S.C. §1746 in a later-filed response. *See* 37 C.F.R. §2.56(c); TMEP §§904.03(i), 1301.04(a).

Response options. Applicant may respond to this refusal by satisfying one of the following for each applicable international class:

(1) Submit a different specimen (a verified “[substitute](#)” [specimen](#)) that (a) was in actual use in commerce at least as early as the filing date of the application or prior to the filing of an amendment to allege use and (b) shows the mark in actual use in commerce for the software identified in the application or amendment to allege use. A “verified substitute specimen” is a specimen that is accompanied by the following statement made in a signed affidavit or supported by a declaration under 37 C.F.R. §2.20: “The substitute (or new, or originally submitted, if appropriate) specimen(s) was/were in use in commerce at least as early as the filing date of the application or prior to the filing of the amendment to allege use.” The substitute specimen cannot be accepted without this statement.

(2) Amend the filing basis to [intent to use under Section 1\(b\)](#) (which includes withdrawing an amendment to allege use, if one was filed), as no specimen is required before publication. This option will later necessitate additional fee(s) and filing requirements, including a specimen.

Additionally, applicant may respond to the stated refusal by submitting evidence and arguments against the refusal. In addition, applicant may respond by doing one of the following:

(1) Deleting the class to which the refusal pertains;

(2) Filing a [Request to Divide Application form](#) (form #3) to divide out the goods and/or services that have not been refused registration, so that the mark may proceed toward publication for opposition in the classes to which the refusal does not pertain. *See* 37 C.F.R. §2.87. *See generally* TMEP §§1110 *et seq.* (regarding the requirements for filing a request to divide). If applicant files a request to divide, then to avoid abandonment, applicant must also file a timely response to all outstanding issues in this Office action, including the refusal. 37 C.F.R. §2.87(e)

For an overview of the response options referenced above and instructions on how to satisfy these options using the online Trademark Electronic Application System (TEAS) form, see the [Specimen webpage](#).

REQUIREMENT – IDENTIFICATION OF GOODS AND SERVICES

The goods in International Class 9 are acceptable as written. The services in International Class 36 and International Class 42 are also acceptable as written. Similarly, the wording "providing an online marketplace which connects sellers and buyers via an online platform for the wholesale remarketing and sale of motor vehicles" in International Class 35 is acceptable.

However, the remaining wording in International Class 35 must be clarified. Specifically, applicant has classified "providing business services, namely, preparing motor vehicle inspection reports for remarketed motor vehicles" in Class 35; however, it appears that the proper classification of the services is Class 42 as these services are closely related to motor vehicle inspections, a Class 42 service. Therefore, applicant may respond by (1) reclassifying these services in the proper international class, or (2) deleting “providing business services, namely, preparing motor vehicle inspection reports for remarketed motor vehicles” from the application. *See* 37 C.F.R. §§2.86(a), 6.1; TMEP §§1403.02 *et seq.*

The wording "providing web-based transportation services for transporting and tracking of goods, namely, motor vehicles" in indefinite and needs to be clarified because the exact nature of "web-based

transportation services" is unclear. Additionally, this wording is too broad and could include services in other international classes. *See* 37 C.F.R. §2.32(a)(6); TMEP §§1402.01, 1402.03. For example, this wording could encompass web-based transportation management logistics services to facilitate transporting and tracking of motor vehicles in Class 35 and providing a website featuring online non-downloadable software that enables users to arrange transport and tracking of motor vehicles in Class 42.

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.

Applicant may adopt the following identification, if accurate [changes are shown in **bold typeface**]:

CLASS 9 – “Providing a downloadable mobile application which connects sellers and buyers of motor vehicles facilitating the sale of motor vehicles;”

CLASS 35 – “Providing an online marketplace which connects sellers and buyers via an online platform for the wholesale re-marketing and sale of motor vehicles; Providing web-based transportation services for transporting motor vehicles, **namely, providing web-based transportation management logistics services to facilitate transporting and tracking of motor vehicles;**”

CLASS 36 – “Financial services, namely, automotive dealer financing;” and

CLASS 42 – “Providing temporary use of online non-downloadable software which connects sellers and buyers via an online platform for the wholesale re-marketing and sale of motor vehicles; **Motor vehicle inspection services, namely,** preparing motor vehicle inspection reports for re-marketed motor vehicles; Providing web-based transportation services, namely, **providing a website featuring online non-downloadable software that enables users to arrange** transport and tracking of motor vehicles.”

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).

PARTIAL ABANDONMENT ADVISORY

If applicant does not respond to this Office action within the six-month period for response, the following goods and services will be deleted from the application:

CLASS 9 - "Providing a downloadable mobile application which connects sellers and buyers of motor vehicles facilitating the sale of motor vehicles;" and

CLASS 35 - "Providing business services, namely, preparing motor vehicle inspection reports for remarketed motor vehicles; Providing web-based transportation services for transporting and tracking of goods, namely, motor vehicles."

The application will then proceed with the following services only:

CLASS 35 – “Providing an online marketplace which connects sellers and buyers via an online

platform for the wholesale re-marketing and sale of motor vehicles;”

CLASS 36 – “Financial services, namely, automotive dealer financing;” and

CLASS 42 – “Providing temporary use of online non-downloadable software which connects sellers and buyers via an online platform for the wholesale re-marketing and sale of motor vehicles.”

See 37 C.F.R. §2.65(a)-(a)(1); TMEP §718.02(a).

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 24, 2022 for
U.S. Trademark Application Serial No. 97120624

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: Miroslav Novakovic

Statistics for Case 97120624						
#	Search	Total Marks	Dead Marks	Live Viewed Docs	Live Viewed Images	Status/Search Duration
1	97120624[sn]	1	0	0	0	0:00
2	*ba{"ckqx"1:2}*[bi,ti] and live[ld]	15434	0	0	0	0:01
3	*lot*[bi,ti] and live[ld]	9558	0	0	0	0:01
4	*{"ckqx"1:2}ar*[bi,ti] and live[ld]	62499	0	0	0	0:01
5	*v{v0:2}h{v0:2}{"ckqx"1:2}{v0:2}l*[bi,ti] and live[ld]	1114	0	0	0	0:01
6	2 and 3	30	0	30	30	0:00
7	2 and 4	323	0	323	323	0:02
8	3 and 4	154	0	154	154	0:02
9	(2 3) AND 5	5	0	5	5	0:01
10	*ba{"ckqx"1:2}*[bi,ti] and live[ld] and *l{v1:2}t*[bi,ti] and live[ld] not 6	1277	0	0	0	0:04
11	*ba{"ckqx"1:2}*[bi,ti] and live[ld] and *l{v}t*[bi,ti] and live[ld] not 6	1249	0	25	26	0:01
12	(071111 Roads, streets, intersections, highways without lines or dividers)[dc] and live[ld]	1332	0	0	0	0:03
13	(261103 Incomplete rectangles)[dc] and live[ld]	3893	0	0	0	0:02
14	12 and 13	4	0	4	4	0:00
15	(12 13) and (2 3)	43	0	4	43	0:01

Session started 08/24/2022 8:14 pm

Session ended 08/24/2022 8:26 pm

Total search duration 20.00

Session duration 12 minutes 48 seconds

Adjacency Level 1

Near Level 1