

To: Sangwon Kim(mail@revolutioniplaw.com)
Subject: U.S. Trademark Application Serial No. 97119297 - JEJUPASS - 2187-029
Sent: August 24, 2022 04:49:33 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. 97119297

Mark: JEJUPASS

Correspondence Address:

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Applicant: KAFLIX Co., Ltd.

Reference/Docket No. 2187-029

Correspondence Email Address: mail@revolutioniplaw.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 24, 2022

Introduction:

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

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).

Summary of Issues:

- Identification of Goods - Amendment Required;
- Multi-class Requirements;
- Color Claim and Mark Description - Amendment Required;
- Significance of Wording Inquiry; and
- Intent to Perfect.

Identification of Goods – Amendment Required:

The wording listed below from the identification of goods is indefinite and must be clarified for the reasons stated. *See* 37 C.F.R. §2.32(a)(6); TMEP §1402.01.

The wording “Downloadable digital video recordings” in the identification of goods is indefinite and must be clarified. *See* 37 C.F.R. §2.32(a)(6); TMEP §1402.01. Applicant must amend this wording to specify the common commercial or generic name of the goods. *See* TMEP §1402.01. If the goods have no common commercial or generic name, applicant must describe the product, its main purpose, and its intended uses. *See id.* Applicant may adopt the suggestions below, if accurate.

The wording “Downloadable computer security software” in the identification of goods is indefinite and must be clarified. *See* 37 C.F.R. §2.32(a)(6); TMEP §1402.01. Applicant must amend this wording to specify the common commercial or generic name of the goods. *See* TMEP §1402.01. If the goods have no common commercial or generic name, applicant must describe the product, its main purpose, and its intended uses. *See id.* Applicant may adopt the suggestions below, if accurate.

Applicant must clarify the wording “Downloadable mobile gift certificates” in the identification of goods in International Class 009 because it is indefinite and too broad. *See* 37 C.F.R. §2.32(a)(6); TMEP §§1402.01, 1402.03. This wording is indefinite and could identify goods in more than one international class. For example, "Gift certificates being non-magnetically encoded gift cards" are in International Class 016 and "Issuance of downloadable mobile gift certificates" are in International Class 036.

The wording “Downloadable video recordings” in the identification of goods is indefinite and must be clarified. *See* 37 C.F.R. §2.32(a)(6); TMEP §1402.01. Applicant must amend this wording to specify the common commercial or generic name of the goods. *See* TMEP §1402.01. If the goods have no common commercial or generic name, applicant must describe the product, its main purpose, and its intended uses. *See id.* Applicant may adopt the suggestions below, if accurate.

The wording “Downloadable image files” in the identification of goods is indefinite and must be clarified. *See* 37 C.F.R. §2.32(a)(6); TMEP §1402.01. Applicant must amend this wording to specify the common commercial or generic name of the goods. *See* TMEP §1402.01. If the goods have no common commercial or generic name, applicant must describe the product, its main purpose, and its

intended uses. *See id.* Applicant may adopt the suggestions below, if accurate.

Applicant must clarify the wording “Downloadable electronic gift certificates” in the identification of goods in International Class 009 because it is indefinite and too broad. *See* 37 C.F.R. §2.32(a)(6); TMEP §§1402.01, 1402.03. This wording is indefinite and could identify goods in more than one international class. For example, "Gift certificates being non-magnetically encoded gift cards" are in International Class 016 and "Issuance of downloadable electronic gift certificates" are in International Class 036.

Applicant must clarify the wording “Computer software for data processing” in the identification of goods in International Class 009 because it is indefinite and too broad. *See* 37 C.F.R. §2.32(a)(6); TMEP §§1402.01, 1402.03. This wording is indefinite and could identify goods in more than one international class. For example, "Downloadable computer software for data processing" are in International Class 009 and "Providing temporary use of online non-downloadable computer software for data processing" are in International Class 042.

Applicant must clarify the wording “Computer software for application and database integration” in the identification of goods in International Class 009 because it is indefinite and too broad. *See* 37 C.F.R. §2.32(a)(6); TMEP §§1402.01, 1402.03. This wording is indefinite and could identify goods in more than one international class. For example, "Downloadable computer software for application and database integration" are in International Class 009 and "Providing temporary use of online non-downloadable computer software for application and database integration" are in International Class 042.

Applicant must clarify the wording “Computer application software for cellphones” in the identification of goods in International Class 009 because it is indefinite and too broad. *See* 37 C.F.R. §2.32(a)(6); TMEP §§1402.01, 1402.03. This wording is indefinite and could identify goods in more than one international class. For example, "Downloadable computer application software for cellphones for data processing" are in International Class 009 and "Providing temporary use of online non-downloadable computer application software for cellphones for data processing" are in International Class 042.

Applicant must clarify the wording “Computer operating programmes” in the identification of goods in International Class 009 because it is indefinite and too broad. *See* 37 C.F.R. §2.32(a)(6); TMEP §§1402.01, 1402.03. This wording is indefinite and could identify goods in more than one international class. For example, "Downloadable computer operating programmes" are in International Class 009 and "Providing temporary use of online non-downloadable computer operating programmes" are in International Class 042.

Applicant must clarify the wording “Computer application software for mobile phones” in the identification of goods in International Class 009 because it is indefinite and too broad. *See* 37 C.F.R. §2.32(a)(6); TMEP §§1402.01, 1402.03. This wording is indefinite and could identify goods in more than one international class. For example, "Downloadable computer application software for mobile phones for data processing" are in International Class 009 and "Providing temporary use of online non-downloadable computer application software for mobile phones for data processing" are in International Class 042.

To address the above issues, applicant may adopt any or all of the following identifications, with the necessary information added, if accurate (proposed changes shown in **bold** typeface; proposed deletions shown in ~~strike through~~; instructions and comments to applicant set forth between curly

brackets {}):

International Class 009: Downloadable digital video recordings **featuring {specify subject matter, e.g., music, self-improvement, mathematics instruction}**; Downloadable musical sound recordings; Downloadable computer security software **for {specify the function of the programs, e.g., use in database management, use as a spreadsheet, word processing, etc. and, if software is content- or field-specific, the content or field of use}**; Downloadable database management software applications; **Consumer** coupons downloaded **from a global computer network**; ~~Downloadable mobile gift certificates~~; Downloadable video recordings **featuring {specify subject matter, e.g., music, self-improvement, mathematics instruction}**; Downloadable music files; Downloadable image files **containing {indicate content or subject matter}**; ~~Downloadable electronic gift certificates~~; Downloadable **image files containing** electronic photos **in the field of {indicate subject matter or field, e.g., automobiles, cats and dogs, etc.}**; Computer game software, downloadable; Downloadable computer game programs; **Downloadable** computer software for data processing; **Downloadable** computer software for application and database integration; **Downloadable** computer application software for mobile phones **for {specify the function of the programs, e.g., use in database management, use as a spreadsheet, word processing, etc. and, if software is content- or field-specific, the content or field of use}**; **Downloadable** computer operating programmed; **Downloadable** computer application software for cellphones **for {specify the function of the programs, e.g., use in database management, use as a spreadsheet, word processing, etc. and, if software is content- or field-specific, the content or field of use}**

International Class 036: **Issuance of** downloadable mobile gift certificates; **Issuance of** downloadable electronic gift certificates

International Class 042: **Providing temporary use of online non-downloadable** computer software for data processing; **Providing temporary use of online non-downloadable** computer software for application and database integration; Providing temporary use of online non-downloadable computer application software for mobile phones **for {specify the function of the programs, e.g., use in database management, use as a spreadsheet, word processing, etc. and, if software is content- or field-specific, the content or field of use}**; **Providing temporary use of online non-downloadable** computer operating programmed; **Providing temporary use of online non-downloadable** computer application software for cellphones **for {specify the function of the programs, e.g., use in database management, use as a spreadsheet, word processing, etc. and, if software is content- or field-specific, the content or field of use}**

Applicant may amend the identification to clarify or limit the goods, but not to broaden or expand the goods 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 may not later be reinserted. *See* TMEP §1402.07(e).

For assistance with identifying and classifying goods in trademark applications, please see the USPTO's online searchable [*U.S. Acceptable Identification of Goods and Services Manual*](#). *See* TMEP §1402.04.

Multi-class Requirements:

The application identifies goods and/or services in more than one international class; therefore, applicant must satisfy all the requirements below for each international class based on Trademark Act Section 44:

(1) **List the goods and/or services by their international class number** in consecutive numerical order, starting with the lowest numbered class.

(2) **Submit a filing fee for each international class** not covered by the fee(s) already paid (view the [USPTO's current fee schedule](#)). The application identifies goods and/or services that are classified in at least three (3) classes; however, applicant submitted a fee(s) sufficient for only one (1) class(es). Applicant must either submit the filing fees for the classes not covered by the submitted fees or restrict the application to the number of classes covered by the fees already paid.

See 37 C.F.R. §2.86(a); TMEP §§1403.01, 1403.02(c).

For an overview of the requirements for a Section 44 multiple-class application and how to satisfy the requirements online using the Trademark Electronic Application System (TEAS) form, see the [Multiple-class Application webpage](#).

Color Claim and Mark Description - Amendment Required:

Applicant submitted a color drawing with a color claim listing the colors in the mark; however, applicant did not provide a complete description specifying where each color appears in the literal and design elements in the mark. *See* 37 C.F.R. §§2.37, 2.52(b)(1); TMEP §807.07(a)-(a)(ii). Therefore, applicant must provide a corrected mark description identifying all the colors in the mark and where they appear. *See* TMEP §807.07(a)(ii).

Generic color names must be used to describe the colors in the mark, e.g., red, yellow, blue. TMEP §807.07(a)(i)-(ii). If black, white, and/or gray represent background, outlining, shading, and/or transparent areas and are not part of the mark, applicant must so specify in the description. *See* TMEP §807.07(d). The following color claim and description is suggested, if accurate:

Color Claim: The colors blue, red, tan, gray, and orange are claimed as a feature of the mark.

Description: The mark consists of the blue stylized wording "JEJUPASS" with a red dot following the final "S" below the image of a tan oval with the image of a blue sky with gray dots depicting stars above gray and blue mountains, orange land, and blue waves depicting the ocean. The color white represents background, outlining, shading, and/or transparent area and is not part of the mark.

Significance of Wording Inquiry:

To permit proper examination of the application, applicant must specify whether “JEJUPASS” in the mark has any meaning in a foreign language. If the wording has meaning in a foreign language, applicant must provide an English translation. *See* 37 C.F.R. §§2.32(a)(9), 2.61(b); TMEP §§809, 814. If the wording has no meaning in a foreign language, applicant must provide a statement to that effect. *See* 37 C.F.R. §§2.32(a)(9), 2.61(b); TMEP §§809, 814. To respond to this requirement for information, open the appropriate Trademark Electronic Application System (TEAS) response form and enter the serial number, answer “yes” to question 3, and provide the information on the “Additional Statement(s)” page in the “Translation” text box(es) in the form.

Applicant should provide an English translation. TMEP §809.03. Alternatively, if the wording has no meaning in a foreign language, applicant should provide the following statement: **The wording “JEJUPASS” has no meaning in a foreign language. *Id.***

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).

Intent to Perfect:

The application specifies Trademark Act Section 44(d) as the sole filing basis and indicates that applicant intends to rely on Section 44(e) as a basis for registration; however no copy of a foreign registration was provided. *See* 15 U.S.C. §1126(d), (e).

An application with a Section 44(e) basis must include a true copy, photocopy, certification, or certified copy of a foreign registration from an applicant’s country of origin. 15 U.S.C. §1126(e); 37 C.F.R. §2.34(a)(3)(ii); TMEP §§1004, 1004.01, 1016. In addition, the applicant’s country of origin must be a party to a convention or treaty relating to trademarks to which the United States is also a party, or must extend reciprocal registration rights to nationals of the United States by law. 15 U.S.C. §1126(b); TMEP §§1002.01, 1004.

Therefore, applicant must provide a copy of the foreign registration from applicant’s country of origin when it becomes available. TMEP §1003.04(a). A copy of a foreign registration must consist of a document issued to an applicant by, or certified by, the intellectual property office in applicant’s country of origin. TMEP §1004.01. If applicant’s country of origin does not issue registrations or Madrid Protocol certificates of extension of protection, the applicant may submit a copy of the Madrid Protocol international registration that shows that protection of the international registration has been extended to applicant’s country of origin. TMEP §1016. In addition, applicant must also provide an English translation if the foreign registration is not written in English. 37 C.F.R. §2.34(a)(3)(ii); TMEP §1004.01(a)-(b). The translation should be signed by the translator. TMEP §1004.01(b).

If the foreign registration is not yet available, applicant should inform the trademark examining attorney that the foreign application is still pending and request that the U.S. application be suspended until a copy of the foreign registration is available. TMEP §§716.02(b), 1003.04(a).

If applicant cannot satisfy the requirements of the Section 44(e) basis, applicant may amend the basis to Section 1(a) or 1(b), if applicant can satisfy the requirements for the new basis. *See* 15 U.S.C. §§1051(a)-(b), 1126(e); TMEP §806.03. Please note that, if the U.S. application satisfied the requirements of Section 44(d) as of the U.S. application filing date, applicant may retain the priority filing date under Section 44(d) without perfecting the Section 44(e) basis, provided there is a continuing valid basis for registration. *See* 37 C.F.R. §2.35(b)(3)-(4); TMEP §§806.02(f), 806.03(h).

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.

Assistance or Response Options:

Please call or email the assigned trademark examining attorney with questions about this Office action. Although an examining attorney cannot provide legal advice, the examining attorney can provide additional explanation about the refusal(s) and/or requirement(s) in this Office action. *See* TMEP §§705.02, 709.06.

The USPTO does not accept emails as responses to Office actions; however, emails can be used for informal communications and are included in the application record. *See* 37 C.F.R. §§2.62(c), 2.191; TMEP §§304.01-.02, 709.04-.05.

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

/Anna J. Oakes/
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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. 97119297

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: Anna Oakes

Statistics for Case 97119297						
#	Search	Total Marks	Dead Marks	Live Viewed Docs	Live Viewed Images	Status/Search Duration
1	97119303[sn]	1	0	1	1	0:00
2	KAFLIX[on]	4	0	4	4	0:00
3	*{"gj"}{v:2}{"gj":2}{v:2}{"p":2}{v:2}{"sz"}*[bi,ti] not dead[ld]	7	0	7	7	0:13
4	*{"gj"}{v:2}{"gj":2}{v}*[bi,ti] not dead[ld]	417675	0	0	0	0:16
5	*p{v:2}{"sz"}*[bi,ti] not dead[ld]	43844	0	0	0	0:26
6	4 and 5	2725	0	0	0	0:22
7	*pass*[bi,ti] not dead[ld]	6881	0	0	0	0:01
8	4 and 7	142	0	142	142	0:15
9	060104[dc] not dead[ld]	11368	0	0	0	0:01
10	060303[dc] not dead[ld]	6835	0	0	0	0:01
11	260317[dc] not dead[ld]	8579	0	0	0	0:01
12	260321[dc] not dead[ld]	23059	0	0	0	0:01
13	9 and 10 and 11 and 12	14	0	3	14	0:00
14	9 and 10	429	0	5	429	0:00
15	9 and 11	248	0	5	248	0:01
16	9 and 12	392	0	6	392	0:01
17	10 and 11	114	0	4	114	0:01
18	10 and 12	241	0	4	241	0:02
19	11 and 12	5404	0	0	0	0:00
20	*JE*[bi,ti] not dead[ld]	27030	0	0	0	0:01
21	*JU*[bi,ti] not dead[ld]	26564	0	0	0	0:01
22	*PASS*[bi,ti] not dead[ld]	6881	0	0	0	0:01
23	20 AND 21 AND 22	6	0	6	6	0:00
24	20 AND 21	358	0	358	358	0:01

Session started 08/24/2022 2:22 pm

Session ended 08/24/2022 3:14 pm

Total search duration 106.00

Session duration 52 minutes 23 seconds

Adjacency Level 1

Near Level 1