

To: BayesTree Intelligence Pvt. Ltd. (tm@mgmiller.legal)
Subject: U.S. Trademark Application Serial No. 88264092 - SAINAPSE - 00919-TM
Sent: February 18, 2020 09:56:30 PM
Sent As: ecom117@uspto.gov
Attachments:

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

U.S. Application

Serial No.

88264092

Mark:

SAINAPSE

Correspondence

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Applicant:

BayesTree
Intelligence Pvt.
Ltd.

Reference/Docket

No. 00919-TM

Correspondence

Email Address:

tm@mgmiller.legal

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: **February 18, 2020**

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.

Specimen Refusal

Webpage specimen does not include required URL and/or date printed/accessed. Registration is refused because the specimen is not acceptable as a webpage specimen; it lacks the required URL and/or date printed/accessed. *See* 37 C.F.R. §2.56(c); [Mandatory Electronic Filing & Specimen Requirements](#), Examination Guide 1-20, at V.B. (Rev. Feb. 2020). The specimen thus appears to be in the nature of a digital mockup that fails to show the applied-for mark in actual use 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), (c); *see* TMEP §§904, 904.03(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 and services identified in the statement of 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 webpage submitted as a specimen must include the URL and access or print date to show actual use in commerce. 37 C.F.R. §2.56(c). Because the webpage specimen lacks the associated URL and/or access or print date on it, within the TEAS form used to submit the specimen, or in a verified statement in a later-filed response, it is unacceptable to show use of the mark in commerce.

Please note that the webpage specimen for Class 9 would need to show the mark actually on the software screen in the webpage to be acceptable as well.

Examples of specimens. Specimens for goods include a photograph of (1) the actual goods bearing the mark; (2) an actual container, packaging, tag or label for the goods bearing the mark; or (3) a point-of-sale display showing the mark directly associated with the goods. *See* 37 C.F.R. §2.56(b)(1), (c); TMEP §904.03(a)-(m). A webpage specimen submitted as a display associated with the goods must show the mark in association with a picture or textual description of the goods and include information necessary for ordering the goods. TMEP §904.03(i); *see* 37 C.F.R. §2.56(b)(1), (c).

Specimens for services must show a direct association between the mark and the services and include: (1) copies of advertising and marketing material, (2) a photograph of business signage or billboards, or (3) materials showing the mark in the sale, rendering, or advertising of the services. *See* 37 C.F.R. §2.56(b)(2), (c); TMEP §1301.04(a), (h)(iv)(C).

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

- (1) Submit a verified statement, in a signed affidavit or supported by a declaration under 37 C.F.R. §2.20 or 28 U.S.C. §1746, specifying the URL of the original webpage specimen and the date it was accessed or printed.
- (2) Submit a different specimen (a verified “substitute” specimen) including the URL and date accessed/printed on it, that (a) was in actual use in commerce prior to the expiration of the deadline for filing the statement of use and (b) shows the mark in actual use in commerce for the goods and/or services identified in the statement of use. Applicant must also submit 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 prior to expiration of the filing deadline for filing a statement of use.”

Applicant may not withdraw the statement of use. *See* 37 C.F.R. §2.88(f); TMEP §1109.17.

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](#).

THIS PARTIAL REFUSAL APPLIES TO CLASS(ES) 9 ONLY

Specimen does not show use of the mark in commerce. Registration is refused because the specimen does not show the applied-for mark as actually used in commerce in International Class(es) 9. Trademark Act Sections 1 and 45, 15 U.S.C. §§1051, 1127; 37 C.F.R. §§2.34(a)(1)(iv), 2.56(a); TMEP §§904, 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).

Specifically, the purchase order and invoice pages of the specimen for Class 9 are between two parties and not in commerce. The scope of federal trademark jurisdiction is commerce that may be regulated by the United States Congress. TMEP §901.03. Types of commerce encompassed in this definition are interstate, territorial, and between the United States and a foreign country. *Id.* A purely intrastate use does not provide a basis for federal registration. *Id.* However, if intrastate use directly affects a type of commerce that Congress may regulate, this constitutes use in commerce within the meaning of the Trademark Act. *Id.* Use of a mark in a foreign country does not give rise to rights in the United States if the goods or services are not sold or rendered in the United States. *Id.*; *Buti v. Impresa Perosa S.R.L.*, 139 F.3d 98, 45 USPQ2d 1985 (2d Cir. 1998); *Mother’s Restaurants Inc. v. Mother’s Bakery, Inc.*, 498 F. Supp. 847, 210 USPQ 207 (W.D.N.Y. 1980); *Linville v. Rivard*, 41 USPQ2d 1731 (TTAB 1996), *aff’d*, 133 F.3d 1446, 45 USPQ2d 1374 (Fed. Cir. 1998); *Aktieselskabet af 21.November 2001 v. Fame Jeans Inc.*, 77 USPQ2d 1861 (TTAB 2006). Offering services via the Internet has been held to constitute use in commerce, since the services are available to a national and international audience who must use interstate telephone lines to access a website. *Id.*; *see Planned Parenthood Federation of America, Inc. v. Bucci*, 42 USPQ2d 1430 (S.D.N.Y. 1997), *aff’d*, 152 F.3d 920 (2d Cir. 1998) (Table), *cert. denied*, 525 U.S. 834

(1998).

Examples of specimens. Specimens for goods include a photograph of (1) the actual goods bearing the mark; (2) an actual container, packaging, tag or label for the goods bearing the mark; or (3) a point-of-sale display showing the mark directly associated with the goods. *See* 37 C.F.R. §2.56(b)(1), (c); TMEP §904.03(a)-(m). A webpage specimen submitted as a display associated with the goods must show the mark in association with a picture or textual description of the goods and include information necessary for ordering the goods. TMEP §904.03(i); *see* 37 C.F.R. §2.56(b)(1), (c). Any webpage printout or screenshot submitted as a specimen must include the webpage's URL and the date it was accessed or printed. 37 C.F.R. §2.56(c).

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 goods 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.

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](#).

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

/Tina H. Mai/
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RESPONSE GUIDANCE

- **Missing the response deadline to this letter will cause the application to [abandon](#).** A response or notice of appeal must be received by the USPTO before midnight **Eastern Time** of the last day of the response period. TEAS and ESTTA 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.

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United States Patent and Trademark Office (USPTO)

USPTO OFFICIAL NOTICE

Office Action (Official Letter) has issued
on **February 18, 2020** for
U.S. Trademark Application Serial No. 88264092

Your trademark application has been reviewed by a trademark examining attorney. As part of that review, the assigned attorney has issued an official letter that you must respond to by the specified deadline or your application will be [abandoned](#). Please follow the steps below.

- (1) [Read the official letter.](#)
- (2) **Direct questions** about the contents of the Office action to the assigned attorney below.

/Tina H. Mai/
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Direct questions about navigating USPTO electronic forms, the USPTO [website](#), the application process, the status of your application, and/or whether there are outstanding deadlines or documents related to your file to the [Trademark Assistance Center \(TAC\)](#).

(3) **Respond within 6 months** ([or earlier](#), if required in the Office action) from **February 18, 2020**, using the Trademark Electronic Application System (TEAS). The response must be received by the USPTO before midnight **Eastern Time** of the last day of the response period. See the Office action for more information about how to respond

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](#), if needed, to ensure you receive important USPTO notices about your application.
- [Beware of misleading notices sent by private companies about your application.](#) Private companies not associated with the USPTO use public information available in trademark registrations to mail and email trademark-related offers and notices – most of which require fees. All **official USPTO correspondence** will only be **emailed from the domain “@uspto.gov.”**