

To: Bomgar Corporation (sploen@ploen.com)
Subject: TRADEMARK APPLICATION NO. 77094814 - THE BOX THAT'S REVOL - ASI-607
Sent: 5/23/2008 2:40:09 PM
Sent As: ECOM116@USPTO.GOV
Attachments:

UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 77/094814

MARK: THE BOX THAT'S REVOL

77094814

CORRESPONDENT ADDRESS:

Sean Ploen
Ploen Law Firm, PC
100 South Fifth Street
Minneapolis MN 55402-1267

RESPOND TO THIS ACTION:

<http://www.uspto.gov/teas/eTEASpageD.htm>

GENERAL TRADEMARK INFORMATION:

<http://www.uspto.gov/main/trademarks.htm>

APPLICANT: Bomgar Corporation

CORRESPONDENT'S REFERENCE/DOCKET NO :

ASI-607

CORRESPONDENT E-MAIL ADDRESS:

sploen@ploen.com

OFFICE ACTION

TO AVOID ABANDONMENT, THE OFFICE MUST RECEIVE A PROPER RESPONSE TO THIS OFFICE ACTION WITHIN 6 MONTHS OF THE ISSUE/MAILING DATE.

ISSUE/MAILING DATE: 5/23/2008

The statement of use 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, 2.65(a); TMEP §§711, 718.03.

NEW SPECIMEN REQUIRED

The specimen is not acceptable because it consists of advertising material for goods. Section 45 of the Trademark Act requires use "on the goods or their containers or the displays associated therewith or on tags or labels affixed thereto." 15 U.S.C. §1127; *see* 37 C.F.R. §2.56(b)(1); TMEP §§904.04(b)-(c).

Material that functions merely to tell prospective purchasers about the goods, or to promote the sale of the goods, is unacceptable to show trademark use. Indeed, invoices, business cards, announcements, price lists, listings in trade directories, order forms, bills of lading, leaflets, brochures, publicity releases, advertising circulars and other printed advertising material, while normally acceptable for showing use in connection with services, generally are not acceptable specimens for showing trademark use in connection with goods. *See In re MediaShare Corp.*, 43 USPQ2d 1304, 1307 (TTAB 1997); *In re Schiapparelli Searle*, 26 USPQ2d 1520, 1522 (TTAB 1993); TMEP §§904.04(b)-(c).

A statement of use must include a specimen showing the applied-for mark in use in commerce for each class of goods in the statement of use. Trademark Act Sections 1 and 45, 15 U.S.C. §§1051, 1127; 37 C.F.R. §§2.56, 2.88(b)(2); TMEP §§904, 904.07(a), 1109.09(b).

Applicant may respond to this refusal by submitting the following:

- (1) A substitute specimen showing the mark in use in commerce each class of the goods specified in the statement of use; and

- (2) The following statement, verified with an affidavit or signed declaration under 37 C.F.R. §2.20: “**The substitute specimen was in use in commerce prior to the expiration of the time allowed applicant for filing a statement of use.**” 37 C.F.R. §2.59(b)(2); TMEP §904.05. If submitting a specimen requires an amendment to the dates of use, applicant must also verify the amended dates. 37 C.F.R. §2.71(c).

Examples of specimens for goods are tags, labels, instruction manuals, containers, photographs that show the mark on the goods or packaging, or displays associated with the goods at their point of sale. TMEP §§904.03 *et seq.* In addition, other types specimens accepted for software are a screen shot of the software while in use and for downloadable software, the webpage where the software is downloaded showing the mark where it says “click here to download.” TMEP §§904.03 *et seq.*

Pending a proper response, registration is refused because the specimen does not show the applied-for mark in use in commerce as a trademark. 15 U.S.C. §§1051, 1127; 37 C.F.R. §§2.56, 2.88; TMEP §§904, 904.07(a), 1109.09(b).

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

The following is a properly worded declaration under 37 C.F.R. §2.20. Applicant should add this declaration to the end of its response, properly signed and dated by a person authorized under 37 C.F.R. §2.33(a). TMEP §804.01(b).

The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. §1001, and that such willful false statements and the like may jeopardize the validity of the application or document or any resulting registration, declares that the facts set forth in the application are true; all statements made of his/her own knowledge are true; and all statements made on information and belief are believed to be true.

(Signature)

(Print or Type Name and Position)

(Date)

If applicant has questions about its application or needs assistance in responding to this Office action, please telephone the assigned trademark examining attorney.

/Ellen Awrich/
Trademark Examining Attorney
Law Office 116
571-272-9123
ellen.awrich@uspto.gov

RESPOND TO THIS ACTION: If there are any questions about the Office action, please contact the assigned examining attorney. A response to this Office action should be filed using the form available at <http://www.uspto.gov/teas/eTEASpageD.htm>. If notification of this Office action was received via e-mail, no response using this form may be filed for 72 hours after receipt of the notification. **Do not attempt to respond by e-mail as the USPTO does not accept e-mailed responses.**

If responding by paper mail, please include the following information: the application serial number, the mark, the filing date and the name, title/position, telephone number and e-mail address of the person signing the response. Please use the following address: Commissioner for Trademarks, P.O. Box 1451, Alexandria, VA 22313-1451.

STATUS CHECK: Check the status of the application at least once every six months from the initial filing date using the USPTO Trademark Applications and Registrations Retrieval (TARR) online system at <http://tarr.uspto.gov>. When conducting an online status check, print and maintain a copy of the complete TARR screen. If the status of your application has not changed for more than six months, please contact the

assigned examining attorney.

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IMPORTANT NOTICE
USPTO OFFICE ACTION HAS ISSUED ON 5/23/2008 FOR
APPLICATION SERIAL NO. 77094814

Please follow the instructions below to continue the prosecution of your application:

VIEW OFFICE ACTION: Click on this link http://tportal.uspto.gov/external/portal/tow?DDA=Y&serial_number=77094814&doc_type=OOA&mail_date=20080523 (or copy and paste this URL into the address field of your browser), or visit <http://tportal.uspto.gov/external/portal/tow> and enter the application serial number to [access](#) the Office action.

PLEASE NOTE: The Office action may not be immediately available but will be viewable within 24 hours of this notification.

RESPONSE MAY BE REQUIRED: You should carefully review the Office action to determine (1) if a response is required; (2) how to respond; and (3) the applicable [response time period](#). Your response deadline will be calculated from **5/23/2008**.

Do NOT hit "Reply" to this e-mail notification, or otherwise attempt to e-mail your response, as the USPTO does NOT accept e-mailed responses. Instead, the USPTO recommends that you respond online using the Trademark Electronic Application System response form at <http://www.uspto.gov/teas/eTEASpageD.htm>.

HELP: For *technical* assistance in accessing the Office action, please e-mail TDR@uspto.gov. Please contact the assigned examining attorney with questions about the Office action.

WARNING

- 1. The USPTO will NOT send a separate e-mail with the Office action attached.**
- 2. Failure to file any required response by the applicable deadline will result in the **ABANDONMENT** of your application.**