

## **I. Introduction**

In the Office Action, the Examiner notes that the mark is not visible on the specimen and that, even if it were, the specimen would not be acceptable. In connection with this response, Applicant submits a substitute specimen depicting the full view of the user interface depicted on Applicant's original specimen. Applicant respectfully disagrees with the Examiner's position that this specimen does not show use of the mark in connection with the covered Class 36 services and submits that the refusal should be withdrawn based on the following arguments, evidence, and authority.

## **II. Applicant Provides Financial Risk Management Services.**

In the Office Action, the Examiner bases his refusal on the presumption that Applicant's specimen shows that "applicant creates technology that can be used for customers who provide financial risk management services, rather than providing those financial risk management services itself." This is incorrect.

Applicant does indeed provide financial risk management services itself under various trademarks, including BOOST. Applicant offers a comprehensive suite of fraud detection and prevention service solutions for ecommerce businesses. Applicant attaches a screenshot of its web page at <https://www.kount.com/fraud-detection-software/kount-complete> as evidence of same (note, for example, its offering of financial risk management services "for all types of online merchants and retailers).

Applicant expects this clarification will assist the Examiner in better understanding how the specimen demonstrates a direct association between the mark and the services.

## **III. Applicant's Specimen Meets the Elements of an Acceptable Service Mark Specimen.**

TMEP 1301.04(f) states that a service mark specimen must show the mark sought to be registered used in a manner that demonstrates a direct association between the mark and the services. Direct association is the minimum the specimen must show, and it may be established textually, contextually, or logically. *See In re Universal Oil Prods. Co.*, 476 F.2d 653, 655, 177 USPQ 456, 457 (C.C.P.A. 1973).

For specimens showing the mark used in rendering services, the services need not be explicitly referenced to establish the requisite direct association. *See* TMEP 1301.04(f)(ii) *and In re Metriplex, Inc.*, 23 USPQ2d 1315, 1316-17 (TTAB 1992) (noting that "the requirements specific to specimens which are advertising are not applicable" and finding the submitted specimens acceptable to show use of applicant's mark in connection with data transmission services because the specimens showed "the mark as it appears on a computer terminal in the course of applicant's rendering of the service" and noting that "purchasers and users of the service would recognize [applicant's mark], as it appears on the computer screen specimens, as a mark identifying the data transmission services which are accessed via the computer terminal").

Applicant's specimen shows the mark used in rendering Applicant's services, namely, providing financial risk management services for electronic funds transfer, credit and debit card and electronic check transactions via a global computer network, in Class 36. The specimen does not explicitly reference these services, but it need not do so if it shows the mark used in rendering services. Instead, like specimen in *Metriplex*, Applicant's specimen shows the mark as it appears on a user interface to a user seeking to engage with Applicant's financial risk management services. **The nature of the user who will encounter Applicant's mark as it appears in the specimen and the context of that encounter in the field of financial risk management services means that users of Applicant's service will and do recognize the mark as identifying Applicant's financial risk management services.**

#### **IV. Conclusion**

Considering Applicant's further explanations about the nature of its services and how the specimen shows those services being rendered in Parts II and III, respectively, Applicant respectfully submits that the specimen refusal with respect to BOOST should be withdrawn and requests that the Examiner approve the application for publication on the Principal Register.

**COMPLETE**

## Beat Fraud and Boost Sales with Kount's Comprehensive Solution



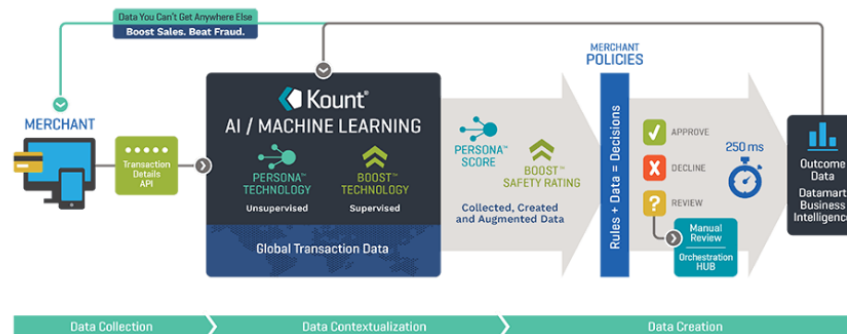
Kount pioneered the use of machine learning in reducing fraud, protecting online businesses, and increasing revenue. Kount Complete™ is the industry's most comprehensive, all-in-one solution relied upon by online merchants and payment service providers to identify and stop fraud in at every transaction.

### For All Types of Online Merchants and Retailers

Kount's advances in both proprietary techniques and patented technology include:

- Superior mobile fraud detection
- Advanced artificial intelligence
- Smart, multi-layer device fingerprinting
- IP proxy detection and geo-location
- Transaction and custom scoring
- Global order linking
- Business intelligence reporting
- Comprehensive order management

Because we develop and own our core technology stack, Kount delivers fast, accurate decisions in just a fraction of a second. But don't let the sophistication fool you. Kount was designed to be simple to implement and simple to use for easy fraud detection and dramatic improvements to bottom line profitability.



Transaction screening, artificial intelligence, auto-decisioning and workflow management are all part of the Kount Complete fraud management platform. Built with speed and accuracy in mind, the Kount solution provides an easy-to-use interface and is friction-free during the checkout process, reducing manual reviews and chargebacks all in less than 300ms.

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Data shows the recent holiday season will have the highest rate of fraud ever. CNP fraud losses are projected to increase by \$3.2 billion over the next 4 years. And mobile commerce – 2X more likely to involve fraud – is growing at least 30% a year. In the face of these trends, can you afford to do nothing to upgrade your fraud prevention process?

Before you do anything rash, Kount recommends you first get the facts so you clearly know where you DO and DON'T need help. That's where our eBook comes in. It reveals visible and hidden fraud costs that are killing your bottom line. Download the eBook now and discover:

- What are your largest fraud costs?
- Why are some brick-and-mortars more at risk than eCommerce retailers?
- Which 2 things should you change to generate the most impact?
- Why all fraud calculators are NOT created equal

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