

To: ADB Airfield Solutions, LLC (IP@bmsa.com)
Subject: U.S. TRADEMARK APPLICATION NO. 86388059 - AIRSIDE - 109709-0041
Sent: 12/23/2014 10:53:46 AM
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Attachments: [Attachment - 1](#)
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**UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)
OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION**

U.S. APPLICATION SERIAL NO. 86388059 MARK: AIRSIDE	*86388059*
CORRESPONDENT ADDRESS: LARRY B. DONOVAN BLACK, MCCUSKEY, SOUERS & ARBAUGH, LPA 220 MARKET AVE S STE 1000 CANTON, OH 44702-2171	CLICK HERE TO RESPOND TO THIS LETTER: http://www.uspto.gov/trademarks/teas/response_forms.jsp VIEW YOUR APPLICATION FILE
APPLICANT: ADB Airfield Solutions, LLC	
CORRESPONDENT'S REFERENCE/DOCKET NO : 109709-0041 CORRESPONDENT E-MAIL ADDRESS: IP@bmsa.com	

OFFICE ACTION

STRICT DEADLINE TO RESPOND TO THIS LETTER

TO AVOID ABANDONMENT OF APPLICANT'S TRADEMARK APPLICATION, THE USPTO MUST RECEIVE APPLICANT'S COMPLETE RESPONSE TO THIS LETTER **WITHIN 6 MONTHS** OF THE ISSUE/MAILING DATE BELOW.

ISSUE/MAILING DATE: 12/23/2014

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 Results

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

- Section 2(e)(1) refusal—mark is merely descriptive;
- Supplemental Register advisory;

- Identification of goods/services requirement;
- Multiple-class application requirements, if applicable.

Section 2(e)(1) Refusal—Mark Is Merely Descriptive

Registration is refused because the applied-for mark merely describes a feature of applicant's goods and/or services. Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1); *see* TMEP §§1209.01(b), 1209.03 *et seq.*

A mark is merely descriptive if it describes an ingredient, quality, characteristic, function, feature, purpose, or use of an applicant's goods and/or services. TMEP §1209.01(b); *see, e.g., DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 1251, 103 USPQ2d 1753, 1755 (Fed. Cir. 2012) (quoting *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 1173, 71 USPQ2d 1370, 1371 (Fed. Cir. 2004)); *In re Steelbuilding.com*, 415 F.3d 1293, 1297, 75 USPQ2d 1420, 1421 (Fed. Cir. 2005) (citing *Estate of P.D. Beckwith, Inc. v. Comm'r of Patents*, 252 U.S. 538, 543 (1920)).

In this case, applicant has applied to register the mark AIRSIDE for use in connection with "Computer software for tracking airport assets, management and maintenance; computer hardware mounted on a vehicle, scanning photometric readings on a runway and then providing reports; online tools and services for looking up spare parts information related to the airline industry."

The attached definition from *The American Heritage® Dictionary* shows that the word "AIRSIDE" means "The part of an airport directly involved in the arrival and departure of aircraft." See attachments from <https://www.ahdictionary.com/word/search.html?q=airside&submit.x=56&submit.y=22>.

The applicant's specimen of use indicates that its software, hardware, online services are for "airside assets tracking" and "airside asset management" at airports. See Specimen. Therefore, the mark merely describes the area of the airport where the computer software, hardware, and online tools and services will be used.

Furthermore, the attached evidence of third-party use shows that the term "AIRSIDE" is commonly used to describe software pertaining to the airside portion of airports and does not have an incongruous or otherwise non-descriptive meaning in relation to software for tracking and managing airport assets. See attachments from <http://www.simtra.com/software-products/airside-design-and-operations/> (offering "airside planning, design and operations software"); http://www.airport-suppliers.com/supplier/Transoft_Solutions/press_releases/ (offering "CAD Software for 3D Airside Design, Planning and Operations"); <http://www.ground-ops.com/airside-transport.aspx> (offering "Airside transfer and Crew movement software") (emphasis added in all).

Accordingly, because the mark is merely descriptive of a feature of the goods and services, registration is refused on the Principal Register under Section 2(e)(1).

Although applicant's mark has been refused registration, applicant may respond to the refusal(s) by submitting evidence and arguments in support of registration.

Supplemental Register (Advisory)

The applied-for mark has been refused registration on the Principal Register. Applicant may respond to the refusal by submitting evidence and arguments in support of registration and/or by amending the application to seek registration on the Supplemental Register. *See* 15 U.S.C. §1091; 37 C.F.R. §§2.47, 2.75(a); TMEP §§801.02(b), 816. Amending to the Supplemental Register does not preclude applicant from submitting evidence and arguments against the refusal(s). TMEP §816.04.

If applicant responds to the refusal(s), applicant must also respond to the requirement(s) set forth below.

Requirement for Additional Information

Due to the descriptive nature of the applied-for mark, applicant must provide the following information regarding the goods and/or services and wording appearing in the mark:

- (1) Fact sheets, instruction manuals, brochures, advertisements and pertinent screenshots of applicant's website as it relates to the goods and/or services. Merely stating that information about the goods and/or services is available on applicant's website is insufficient to make the information of record.

If these materials are unavailable, applicant should submit similar documentation for goods and services of the same type, explaining how its own product or services will differ. If the goods and/or services feature new technology and information regarding competing goods and/or services is not available, applicant must provide a detailed factual description of the goods and/or services. Factual

information about the goods must make clear how they operate, salient features, and prospective customers and channels of trade. For services, the factual information must make clear what the services are and how they are rendered, salient features, and prospective customers and channels of trade. Conclusory statements will not satisfy this requirement.; and

(2) Applicant must explain whether its goods and services pertain to the airside of airports.

See 37 C.F.R. §2.61(b); *In re AOP LLC*, 107 USPQ2d 1644, 1650-51 (TTAB 2013); *In re Cheezwhse.com, Inc.*, 85 USPQ2d 1917, 1919 (TTAB 2008); *In re Planalytics, Inc.*, 70 USPQ2d 1453, 1457-58 (TTAB 2004); TMEP §§814, 1402.01(e).

Failure to comply with a request for information can be grounds for refusing registration. *In re AOP LLC*, 107 USPQ2d at 1651; *In re DTI P'ship LLP*, 67 USPQ2d 1699, 1701-02 (TTAB 2003); TMEP §814.

Identification of Goods and/or Services

The identification of goods and services must be clarified in several respects. First, it is noted that the applicant has used identical language to describe goods or services that are in more than one designated international class. *See* TMEP §1401.05(c). A single product that has a plurality of uses may be classified in two or more international classes. TMEP §1401.05(c); *see Ex parte Schatz*, 87 USPQ 374, 375-76 (Comm'r Pats. 1950). However, using identical language to describe the goods in more than one international class is not permitted. TMEP §1401.05(c). Applicant must therefore amend the identification as noted below to ensure that the goods and services are not identical and are properly classified.

Specifically, the wording in International Class 9, the wording "Computer software for tracking airport assets, management and maintenance," while acceptable in International Class 9, must be amended by more clearly describing by function of the computer software. *See* TMEP §1402.01. An identification for computer software must specify the purpose or function of the software. *See* TMEP §1402.03(d). If the software is field-specific, the identification must also specify the field of use. *Id.* Clarification of the purpose, function, or field of use of the software is necessary for the USPTO to properly examine the application and make appropriate decisions concerning possible conflicts between the applicant's mark and other marks. *See In re N.A.D. Inc.*, 57 USPQ2d 1872, 1874 (TTAB 2000).

Similarly, the wording "computer hardware mounted on a vehicle, scanning photometric readings on a runway and then providing reports" is acceptable in International Class 9 but must be clarified by more clearly describing by function of the computer hardware, such as what it takes readings of the nature the reports provided. *See id.*

The wording "online tools and services for looking up spare parts information related to the airline industry" in International Class 9 is indefinite and too broad because it could refer to downloadable software, in Class 9; or online, downloadable software in Class 42. Moreover, to the extent that the "tools" include an online database, they would be classified according to the subject matter of the database, which in this case would be Class 37 if the databases pertain to airline parts.

In International Class 42, the wording "Computer software for tracking airport assets, management and maintenance" is overly broad because it could be classified in two international classes - as a product in International Class 9 or a service in International Class 42. Computer software is a product classified in International Class 9 if it is (1) recorded on media (such as CDs) or (2) downloadable and thus can be transferred or copied from a remote computer system for use on a long-term basis. However, on-line non-downloadable software is considered a computer service in International Class 42 because it is generally provided for use on a temporary basis. *See generally* TMEP §1402.11(a). Thus, applicant should either transfer this item to Class 9 or specify that the software is provided online and is non-downloadable. Further, applicant must clarify the function of the software as discussed above.

The wording "computer hardware mounted on a vehicle, scanning photometric readings on a runway and then providing reports" are classified incorrectly. Applicant must amend the application to classify the goods in International Class 9. *See* 37 C.F.R. §§2.32(a)(7), 2.85; TMEP §§1401.02(a), 1401.03(b). The function of the hardware must also be clarified as noted above.

The wording "online tools and services for looking up spare parts information related to the airline industry" in International Class 42 is too broad for the reasons stated above in connection with the use of this wording in Class 9. Applicant must clarify the nature of the online tools and services and classify the goods or services accordingly.

Applicant may substitute the following wording, if accurate:

International Class 9: Computer software for tracking airport assets and managing the maintenance schedules of airport assets; computer hardware mounted on a vehicle for scanning photometric readings of airport assets on a runway and then providing reports related to tracking, managing, and maintaining the airport assets

International Class 37: Providing an on-line computer database in the field of spare parts information related to the airline industry

International Class 42: Providing online, downloadable computer software for tracking airport assets and managing the maintenance schedules of airport assets; providing online non-downloadable software for looking up spare parts information related to the airline industry

An applicant may only amend an identification to clarify or limit the goods and/or services, but not to add to or broaden the scope of the goods and/or services. 37 C.F.R. §2.71(a); *see* TMEP §§1402.06 *et seq.*, 1402.07.

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* at <http://tess2.uspto.gov/netahhtml/tidm.html>. *See* TMEP §1402.04.

Multiple-Class Application 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 use in commerce under Section 1(a):

- (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 at http://www.uspto.gov/trademarks/tm_fee_info.jsp). The application identifies goods and/or services that are classified in at least three classes; however, applicant submitted a fee(s) sufficient for only two 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.
- (3) **Submit verified dates of first use of the mark** anywhere and in commerce **for each international class**.
- (4) **Submit a specimen for each international class**. The current specimen is acceptable for class(es) 9 and 42; and applicant needs a specimen for class(es) 37.

Examples of specimens for goods include tags, labels, instruction manuals, containers, and photographs that show the mark on the actual goods or packaging, or displays associated with the actual goods at their point of sale. Webpages may also be specimens for goods when they include a picture or textual description of the goods associated with the mark and the means to order the goods.

Examples of specimens for services include advertising and marketing materials, brochures, photographs of business signage and billboards, and website printouts that show the mark used in the actual sale, rendering, or advertising of the services.

- (5) **Submit a verified statement** that “**The specimen was in use in commerce on or in connection with the goods and/or services listed in the application at least as early as the filing date of the application.**”

See 15 U.S.C. §§1051(a), 1112; 37 C.F.R. §§ 2.32(a)(6)-(7), 2.34(a)(1), 2.86(a); TMEP §§904, 1403.01, 1403.02(c).

For an overview of the requirements for a Section 1(a) multiple-class application and how to satisfy the requirements online using the Trademark Electronic Application System (TEAS) form, please go to <http://www.uspto.gov/trademarks/law/multiclass.jsp>.

Response Guidelines

To expedite prosecution of the application, applicant is encouraged to file its response to this Office action online via the Trademark Electronic Application System (TEAS), which is available at <http://www.uspto.gov/trademarks/teas/index.jsp>. If applicant has technical questions about the TEAS response to Office action form, applicant can review the electronic filing tips available online at http://www.uspto.gov/trademarks/teas/e_filing_tips.jsp and email technical questions to TEAS@uspto.gov.

If applicant has questions regarding this Office action, please telephone or e-mail the assigned trademark examining attorney. All relevant e-mail communications will be placed in the official application record; however, an e-mail communication will not be accepted as a response to this Office action and will not extend the deadline for filing a proper response. *See* 37 C.F.R. §2.191; TMEP §§304.01-.02, 709.04-.05. Further, although the trademark examining attorney may provide additional explanation pertaining to the refusal(s) and/or requirement(s) in this Office action, the trademark examining attorney may not provide legal advice or statements about applicant's rights. *See* TMEP §§705.02, 709.06.

/April A. Hesik/
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TO RESPOND TO THIS LETTER: Go to http://www.uspto.gov/trademarks/teas/response_forms.jsp. Please wait 48-72 hours from the issue/ mailing date before using the Trademark Electronic Application System (TEAS), to allow for necessary system updates of the application. For *technical* assistance with online forms, e-mail TEAS@uspto.gov. For questions about the Office action itself, please contact the assigned trademark examining attorney. **E-mail communications will not be accepted as responses to Office actions; therefore, do not respond to this Office action by e-mail.**

All informal e-mail communications relevant to this application will be placed in the official application record.

WHO MUST SIGN THE RESPONSE: It must be personally signed by an individual applicant or someone with legal authority to bind an applicant (i.e., a corporate officer, a general partner, all joint applicants). If an applicant is represented by an attorney, the attorney must sign the response.

PERIODICALLY CHECK THE STATUS OF THE APPLICATION: To ensure that applicant does not miss crucial deadlines or official notices, check the status of the application every three to four months using the Trademark Status and Document Retrieval (TSDR) system at <http://tsdr.uspto.gov/>. Please keep a copy of the TSDR status screen. If the status shows no change for more than six months, contact the Trademark Assistance Center by e-mail at TrademarkAssistanceCenter@uspto.gov or call 1-800-786-9199. For more information on checking status, see <http://www.uspto.gov/trademarks/process/status/>.

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