


IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT: Facebook, Inc. )  
)  
MARK: ) Xheneta Ademi  
  
) Examining Attorney  
SERIAL NO.: 88/250,308 ) Law Office 122  
)  
CLASSES: 9, 35, 36, 38, 41, 42, 45 )  
)  
FILING DATE: January 4, 2019 )

**RESPONSE TO OFFICE ACTION**

Applicant has received and reviewed the Office Action dated September 9, 2019, from Examining Attorney Xheneta Ademi, Law Office 122, regarding the above-referenced application and has carefully considered its contents. Therein, the Examining Attorney has objected to Facebook, Inc.’s (“Applicant”) application (the “Applicant’s Mark”) as presenting a phantom mark, and requesting further clarification of services in the International Class 42.

Applicant hereby responds to the issues raised by the Examining Attorney.

**I. THE “PHANTOM MARK” REFUSAL SHOULD BE WITHDRAWN**

The Examining Attorney has refused registration of Applicant’s Mark on the ground that Applicant seeks registration of more than one mark. Specifically, the Examining Attorney has objected that the dotted lines showing the circular shape of the background and positioning of the stylized letter “F” within Applicant’s Mark constitute a significant changeable or “phantom” element.

Applicant respectfully disagrees that its mark contains a phantom element. Rather, Applicant seeks to register a single design mark that projects a unitary and consistent commercial impression. Applicant's Mark is a logo for Applicant's well-known social networking services, that is comprised of a highly recognizable letter "F" design super imposed in a specific place on a circular background. While the dotted lines are not claimed as a part of the mark, they serve to show the positioning of the letter "F" within the circular background. The overall commercial impression created by Applicant's Mark, however, is fixed and definite, notwithstanding the use of dotted lines to indicate the circular shape of the background and positioning of the distinctive, stylized "F" within. This approach, using dotted lines to show positioning, is commonly used, particularly with regard to trade dress, without the creation of a phantom mark and is no different in the instant case. *See* T.M.E.P. §1202.02(c)(i) and T.M.E.P. §1207.01(c)(iv) ("In some cases, where the position of the mark... is a feature of the mark, the applicant will submit a drawing that shows the placement of the mark by surrounding the mark with a proportionately accurate broken-line representation of the... advertising on which the mark appears.").

Contrary to the case law cited by the Examining Attorney, the dotted lines in Applicant's Mark do not represent an integral portion of the mark. *C.f. In re Int'l Flavors & Fragrances Inc.*, 183 F.3d 1361, 51 USPQ2d 1513, 1514 at fn. 1 (Fed. Cir. 1999) ("A 'phantom' trademark is one in which an *integral* portion of the mark is generally represented by a blank or dashed line acting as a place holder for a generic term or symbol that changes, depending on use of the mark.") (emphasis added). Here, the dotted lines are used merely to show positioning within a circular background, which is not a part of Applicant's Mark itself.

Accordingly, Applicant requests that the Examining Attorney withdraw its objection with regard to the inclusion of a phantom element and allow Applicant's Mark to proceed to publication.

To the extent the Examining Attorney believes it would be necessary to amend the description of Applicant's Mark and/or the design codes associated with the Application in order to further clarify the nature of the mark, Applicant proposes the following amendments (italicized):

Description: "The mark consists of a stylized letter "F" appearing inside of a two-dimensional shape. The shape shown by the broken lines is not a part of the mark and it serves only to show the position of the mark. *The circular shape shown by the dotted lines is not subject to change, and the position of the stylized letter "F" is fixed within this shape.*"

Design codes: "~~26.01.05—Circles made of broken or dotted lines~~ *30.01.06 – Stylized Letter F; 30.05.01 – Single letter standing alone.*"

Alternatively, if the Examining Attorney does not accept the foregoing explanation or proposed amendments, Applicant requests an opportunity to submit an amended drawing of Applicant's Mark.

### **III. AMENDMENT TO THE IDENTIFICATION OF GOODS AND SERVICES**

As stated in the corresponding section of this response to the Office Action regarding the identification of goods and services, Applicant agrees to the Examiner's proposed amendments in Class 42, namely: "**User verification services, namely, providing *user authentication of personal identification information using single sign-on technology for online software applications***".

#### IV. CONCLUSION

Having fully responded to the matters raised in the Office Action, Applicant respectfully requests the Examining Attorney's objections be withdrawn, and that Applicant's application be passed to publication in due course.

Dated: March 6, 2020

Respectfully submitted,

/Ana-Claudia Roderick/  
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