

PTO Form 1957 (Rev 9/2005)

OMB No. 0651-0050 (Exp. 05/31/2014)

Response to Office Action

To the Commissioner for Trademarks:

Application serial no. **85881988** (Stylized and/or with Design, see [mark](#)) has been amended as follows:

MARK

Applicant proposes to amend the mark as follows:

Current: ONSITE HEALTH DIAGNOSTICS EMPLOYEE HEALTH INTELLIGENCE (Stylized and/or with Design, see [mark](#))

Color is not claimed as a feature of the mark.

The mark consists of a design element, the words "ONSITE HEALTH DIAGNOSTICS," and the words "Employee Health Intelligence." The design element is positioned to the left of all of the words and is comprised of a first curving triangular feature, a second curving triangular feature, and a third curving triangular feature that together form the perimeter of a generally circular pattern. The first curving triangular feature has a substantially straight, generally horizontal base, and has two curved sides extending from its base, turning clockwise, and coming together to form a vertex at about the 12 O'clock position of the generally circular pattern. This vertex of the first feature meets the base of the second feature. The second curving triangular feature has a substantially straight base that is slanted upward (as this base runs from left to right) at about 30 degrees relative to vertical, and has two curved sides extending from its base, turning clockwise, and coming together to form a vertex at about the 4 O'clock position of the generally circular pattern. This vertex of the second feature meets the base of the third feature. The third curving triangular feature has a substantially straight base that is slanted downward (as this base runs from left to right) at about 30 degrees relative to vertical, and has two curved sides extending from its base, turning clockwise, and coming together to form a vertex at about the 8 O'clock position of the generally circular pattern. This vertex of the third feature meets the base of the first feature. The words "ONSITE HEALTH DIAGNOSTICS" are positioned to the right of the design element, extend to the right and horizontally away from the general location of the design element, and vertically centered on approximately the horizontal diametral line (i.e., on approximately the horizontal center line) of the design element. The horizontal diametral line is shown in the drawing (as a broken line) and described herein for reference only; i.e., the horizontal diametral line is not a part of the mark and serves only to show the general position of the words "ONSITE HEALTH DIAGNOSTICS" relative to the design element. The words "Employee Health Intelligence" are positioned below the words "ONSITE HEALTH DIAGNOSTICS," and also extend to the right and horizontally away from the general location of the design element.

Proposed: ONSITE HEALTH DIAGNOSTICS EMPLOYEE HEALTH INTELLIGENCE (Stylized and/or with Design, see [mark](#))

The applicant is not claiming color as a feature of the mark.

The mark consists of the wording "ONSITE HEALTH DIAGNOSTICS" and "EMPLOYEE HEALTH INTELLIGENCE" to the right of a circle design created by three rounded triangular shapes.

ARGUMENT(S)

In response to the substantive refusal(s), please note the following:

The Applicant respectfully submits that the substitute specimen requirement should be withdrawn because the specimen shows the mark as it is used in the course of rendering or performing the services (as opposed to merely advertising the services). Regarding the substitute specimen requirement, the Examiner has initially refused registration based on an assertion that "the specimen does not show the applied-for mark in use in commerce as a trademark and/or service mark for the identified goods and/or services." More particularly, the Examiner has

stated the following:

The specimen does not show the applied-for mark in use in commerce in connection with any of the goods and/or services specified in the application, and therefore is not acceptable. Specifically, the specimen shows use of the mark in connection with a log in screen for biometric screening. However, applicant's services are identified as "Consulting services, namely, gathering, analyzing, auditing, and presenting employee health data for business purposes; information services, namely, providing on-line information in the field employee health data analysis for business purposes", none of which is referenced, even indirectly, in the specimen of record.

A service mark specimen consisting of advertising or promotional materials generally must show a direct association between the mark and the services for which registration is sought. See *In re Universal Oil Prods. Co.*, 476 F.2d 653, 655, 177 USPQ 456, 457 (C.C.P.A. 1973); *In re HSB Solomon Assocs.*, 102 USPQ2d 1269, 1274 (TTAB 2012); TMEP §1301.04(b). While the exact nature of the services does not need to be specified in the specimen, there must be something which creates in the mind of the purchaser an association between the mark and the service. *In re Adair*, 45 USPQ2d 1211, 1215 (TTAB 1997) (quoting *In re Johnson Controls Inc.*, 33 USPQ2d 1318, 1320 (TTAB 1994)); see *In re Osmotica Holdings, Corp.*, 95 USPQ2d 1666, 1668 (TTAB 2010).

However, the standards for advertising and promotional materials are not appropriate in this case. It is well settled that "[a] specimen that shows the mark as used in the course of *rendering or performing* the services [as opposed to advertising the services] is generally acceptable." TMEP §1301.04(b) (emphasis in original). The Examiner has characterized the Applicant's specimen as showing "use of the mark in connection with a log in screen for biometric screening." A bit more accurately, the specimen shows the Applicant's mark as it appears on a computer screen in connection with setting up and/or scheduling employee biometric screenings, which Applicant does in the course of gathering employee health data for business purposes. Further, as the Examiner has acknowledged, Applicant's recited consulting services include "gathering . . . employee health data for business." Thus, the specimen actually shows Applicant's use of the mark in the course of rendering or performing some of Applicant's services (as opposed merely advertising the services) and, accordingly, the specimen is sufficient and need not show a direct association between the mark and the services. See *In re Metriplex Inc.*, 23 USPQ2d 1315 (TTAB 1992) (computer printouts showing mark GLOBAL GATEWAY were acceptable to show use of mark to identify data transmission services accessed via computer, because they showed the mark as it appeared on computer terminal in the course of rendering the services). See also *In re Eagle Fence Rentals, Inc.*, 231 USPQ 228 (TTAB 1986) (photograph of rented fence was acceptable for rental of chain link fences, as it showed use of distinctive color scheme in the rendering services); *In re Red Robin Enterprises, Inc.*, 222 USPQ 911 (TTAB 1984) (photograph of costume worn by performer during performance of entertainment services was an acceptable specimen).

For at least the foregoing reasons, Applicant respectfully requests that the substitute specimen requirement and the refusal to register Applicant's mark be withdrawn.

CLASSIFICATION AND LISTING OF GOODS/SERVICES

Applicant proposes to amend the following class of goods/services in the application:

Current: Class 035 for Consulting services, namely, gathering, analyzing, auditing, and presenting employee health data for business purposes; information services, namely, providing on-line information in the field employee health data analysis for business purposes

Original Filing Basis:

Filing Basis: Section 1(a), Use in Commerce: The applicant is using the mark in commerce, or the applicant's related company or licensee is using the mark in commerce, on or in connection with the identified goods and/or services. 15 U.S.C. Section 1051(a), as amended. The mark was first used at least as early as 05/01/2012 and first used in commerce at least as early as 05/01/2012, and is now in use in such commerce.

Proposed:

Tracked Text Description: ~~Consulting services, namely, gathering, analyzing, auditing, and presenting employee health data for business purposes;~~ Consulting services, namely, gathering, analyzing, and auditing employee health data and preparing reports regarding employee health data for business purposes; information services, namely, providing on-line information in the field employee health data analysis for business purposes

Class 035 for Consulting services, namely, gathering, analyzing, and auditing employee health data and preparing reports regarding employee health data for business purposes; information services, namely, providing on-line information in the field employee health data analysis for business purposes

Filing Basis: Section 1(a), Use in Commerce: The applicant is using the mark in commerce, or the applicant's related company or licensee is using the mark in commerce, on or in connection with the identified goods and/or services. 15 U.S.C. Section 1051(a), as amended. The mark was first used at least as early as 05/01/2012 and first used in commerce at least as early as 05/01/2012, and is now in use in such commerce.

ADDITIONAL STATEMENTS

Disclaimer

No claim is made to the exclusive right to use HEALTH DIAGNOSTICS and EMPLOYEE HEALTH INTELLIGENCE apart from the mark as shown.

SIGNATURE(S)

Response Signature

Signature: /Gerald W. Roberts/ Date: 11/01/2013

Signatory's Name: Gerald W. Roberts

Signatory's Position: Attorney of record, Texas bar member

Signatory's Phone Number: 214-999-1335

The signatory has confirmed that he/she is an attorney who is a member in good standing of the bar of the highest court of a U.S. state, which includes the District of Columbia, Puerto Rico, and other federal territories and possessions; and he/she is currently the applicant's attorney or an associate thereof; and to the best of his/her knowledge, if prior to his/her appointment another U.S. attorney or a Canadian attorney/agent not currently associated with his/her company/firm previously represented the applicant in this matter: (1) the applicant has filed or is concurrently filing a signed revocation of or substitute power of attorney with the USPTO; (2) the USPTO has granted the request of the prior representative to withdraw; (3) the applicant has filed a power of attorney appointing him/her in this matter; or (4) the applicant's appointed U.S. attorney or Canadian attorney/agent has filed a power of attorney appointing him/her as an associate attorney in this matter.

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Original Mark:

<http://tess2.uspto.gov/ImageAgent/ImageAgentProxy?getImage=85881988>



Proposed Mark (Applicant-generated image):

108194108116-03193965720131031_ONSITE_HEALTH_DIAGNOSTICS__BW_drawing_.jpg



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