



OFFICE ACTIONS, REJECTIONS & PIVOTING, OH MY!

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**I AM A
LAWYER.**

BUT I'M NOT YOUR LAWYER.

THE LEGAL DISCLAIMER.



First ask yourself

**CAN I HANDLE AN
OFFICE ACTION?**



WHAT IS AN OFFICE ACTION?

An office action is an official letter sent by the USPTO.

In it, an examining attorney (Examiner) lists any legal problems with your chosen trademark, as well as with the application itself.

You must resolve all legal problems in the office action before the Office can register your trademark

Thought for the Day

**ALWAYS START OUT
THE APPLICATION
THINKING ABOUT
ACTIONS**



TYPES OF OFFICE ACTIONS

- In a non-final OA , the applicant is entitled to reply and request reconsideration or further examination, with or without making an amendment. In a final office action, the applicant has two options for reply.



TYPES OF OFFICE ACTIONS

In a final OA, the applicant may appeal rejection of claims to the Board of Patent Appeals and Interferences [now called the Patent Trials and Appeals Board]. Otherwise, the applicant may file an amendment which complies with the requirements set forth in the office action. Reply to a final rejection must include cancellation of, or appeal from the rejection of, each rejected claim. If any claim stands allowed, the reply to a final rejection must comply with any requirements or objections as to form. Replies to final office actions must be in accordance with 37 C.F.R. 1.113-1.114



HOW TO UNDERSTAND & CATEGORIZE OFFICE ACTIONS

- They're not all the same - each Examiner is different
- During application - check out similar marks and their OA's
- Categorizing allows for identifying other similar marks that may have had potential issues
- When the OA comes back - you know where to look
- Don't reinvent the wheel- check out those

????

**WHY CAN'T I PROVIDE
ALL INFORMATION UP
FRONT AND
AVOID AN OA?**



MAIN TYPES

- Specimen Refusal
- Disclaimer Requirement
- Merely a surname
- Inquiry into significance of the wording of the mark
- Likelihood of confusion for existing Mark

FIND SAMPLE OFFICE ACTION RESPONSES

[TSDR](#) [ASSIGN Status](#) [TTAB Status](#) (Use the "Back" button of the Internet Browser to return to TESS)

Marketing Madness

| | |
|------------------------------------|---|
| Word Mark | MARKETING MADNESS |
| Goods and Services | IC 009. US 021 023 026 036 038. G & S: Downloadable templates for marketing. FIRST USE: 20130110. FIRST USE IN COMMERCE: 20130110 |
| Standard Characters Claimed | |
| Mark Drawing Code | (4) STANDARD CHARACTER MARK |
| Serial Number | 8862305 |
| Filing Date | September 15, 2019 |
| Current Basis | 1A |
| Original Filing Basis | 1A |
| Published for Opposition | April 14, 2020 |
| Registration Number | 6089222 |
| Registration Date | June 30, 2020 |
| Owner | (REGISTRANT) The Brenke Group, LLC LIMITED LIABILITY COMPANY VIRGINIA 1011 Charles Street Fredericksburg VIRGINIA 22401 |
| Attorney of Record | Rachel V. Brenke |
| Disclaimer | NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "MARKETING" APART FROM THE MARK AS SHOWN |
| Type of Mark | TRADEMARK |
| Register | PRINCIPAL |
| Live/Dead Indicator | LIVE |

FIND SAMPLE OFFICE ACTION RESPONSES

Trademark Status & Document Retrieval (TSDR) ?

SEARCH MULTI-SEARCH ?

US Serial, Registration, or Reference No. ▼ 88623039 Status Documents

Status results found

STATUS DOCUMENTS MAINTENANCE ? Download ▲ Print Preview

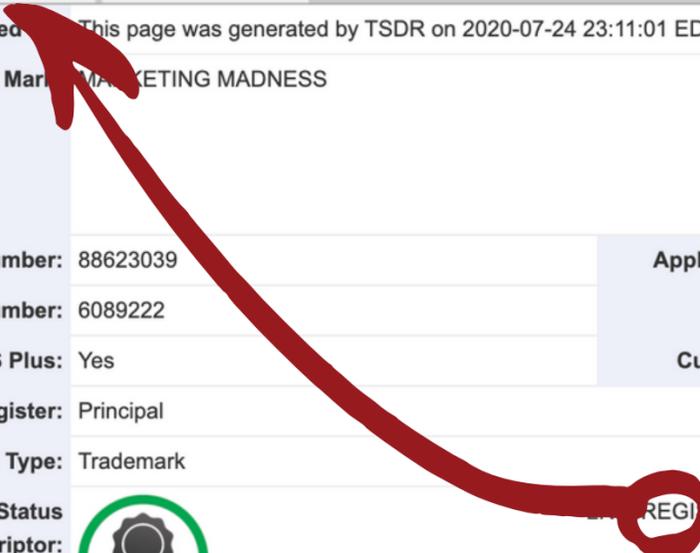
Generated: This page was generated by TSDR on 2020-07-24 23:11:01 EDT

Marketing Madness

Marketing Madness

| | | | |
|-------------------------------|--|--------------------------|---------------|
| US Serial Number: | 88623039 | Application Filing Date: | Sep. 19, 2019 |
| US Registration Number: | 6089222 | Registration Date: | Jun. 30, 2020 |
| Filed as TEAS Plus: | Yes | Currently TEAS Plus: | Yes |
| Register: | Principal | | |
| Mark Type: | Trademark | | |
| TM5 Common Status Descriptor: |  REGISTRATION/Issued and Active | | |
| Status: | Registered. The registration date is used to determine when post-registration maintenance documents are due. | | |
| Status Date: | Jun. 30, 2020 | | |
| Publication Date: | Apr. 14, 2020 | | |

▲ Mark Information Expand All



FIND SAMPLE OFFICE ACTION RESPONSES

▼ Trademark Documents Expand All

| Select All <input type="checkbox"/> | Create/Mail Date | Document Description | Document Type |
|-------------------------------------|------------------|---|---------------|
| <input type="checkbox"/> | Jun. 30, 2020 | Registration Certificate | PDF |
| <input type="checkbox"/> | Apr. 14, 2020 | OG Publication Confirmation | XML |
| <input type="checkbox"/> | Mar. 25, 2020 | Notice of Publication | XML |
| <input type="checkbox"/> | Mar. 25, 2020 | Notification Of Notice of Publication | XML |
| <input type="checkbox"/> | Mar. 11, 2020 | TRAM Snapshot of App at Pub for Oppostr | MULTI |
| <input type="checkbox"/> | Mar. 05, 2020 | Amendment and Mail Process Complete | MULTI |
| <input type="checkbox"/> | Mar. 03, 2020 | Specimen | JPEG |
| <input type="checkbox"/> | Mar. 03, 2020 | TEAS Request Reconsideration after FOA | MULTI |
| <input type="checkbox"/> | Feb. 24, 2020 | Offc Action Outgoing | XML |
| <input type="checkbox"/> | Jan. 25, 2020 | Amendment and Mail Process Complete | MULTI |
| <input type="checkbox"/> | Jan. 24, 2020 | Response to Office Action | MULTI |
| <input type="checkbox"/> | Jan. 24, 2020 | Specimen | JPEG |
| <input type="checkbox"/> | Jan. 08, 2020 | Change of Address | XML |
| <input type="checkbox"/> | Dec. 26, 2019 | Offc Action Outgoing | XML |
| <input type="checkbox"/> | Dec. 26, 2019 | XSearch Search Summary | XML |
| <input type="checkbox"/> | Sep. 19, 2019 | Drawing | JPEG |
| <input type="checkbox"/> | Sep. 19, 2019 | Specimen | JPEG |
| <input type="checkbox"/> | Sep. 19, 2019 | TEAS Plus New Application | MULTI |

▲ Proceedings Documents - Click to Load
▲ Assignments Documents - Click to Load



FIND SAMPLE OFFICE ACTION RESPONSES

USPTO TSDR Case Viewer 

Case Id
88623039

Document Description
12. Response to Office Action

Mail/Create Date
Jan. 24, 2020

Download PDF

Prev Doc 1 of 6 Next Page

| | |
|------------------------------------|---|
| FIRST USE IN COMMERCE DATE | At least as early as 01/10/2013 |
| STATEMENT TYPE | "The substitute (or new, or originally submitted, if appropriate) specimen(s) was/were in use in commerce at least as early as the filing date of the application" [for an application based on Section 1(a), Use in Commerce] OR "The substitute (or new, or originally submitted, if appropriate) specimen(s) was/were in use in commerce prior either to the filing of the Amendment to Allege Use or expiration of the filing deadline for filing a Statement of Use" [for an application based on Section 1(b) Intent-to-Use]. OR "The attached specimen is a true copy of the specimen that was originally submitted with the application, amendment to allege use, or statement of use" [for an illegible specimen]. |
| SPECIMEN FILE NAME(S) | |
| ORIGINAL PDF FILE | SPU0-50243196235-20200107093054238201 . Marketing Madness Specimens.pdf |
| CONVERTED PDF FILE(S) (3 pages) | \\TICRS\EXPORT17\IMAGEOUT17\886\230\88623039\xml5\ROA0002.JPG |
| | \\TICRS\EXPORT17\IMAGEOUT17\886\230\88623039\xml5\ROA0003.JPG |
| | \\TICRS\EXPORT17\IMAGEOUT17\886\230\88623039\xml5\ROA0004.JPG |
| ORIGINAL PDF FILE | SPU0-50243196235-20200107093054238201 . Marketing Madness Specimens 2.pdf |
| CONVERTED PDF FILE(S) (2 pages) | \\TICRS\EXPORT17\IMAGEOUT17\886\230\88623039\xml5\ROA0005.JPG |
| | \\TICRS\EXPORT17\IMAGEOUT17\886\230\88623039\xml5\ROA0006.JPG |
| SPECIMEN DESCRIPTION | Screenshots of the Marketing Madness course and its product purchase pages |
| ADDITIONAL STATEMENTS SECTION | |
| DISCLAIMER | No claim is made to the exclusive right to use MARKETING apart from the mark as shown. |
| SIGNATURE SECTION | |
| DECLARATION SIGNATURE | /Rachel Brenke/ |



#1 SPECIMEN REFUSAL

- Identify what the Examiner is wanting to see
- Try to avoid this issue by giving as many specimens as possible
- Can't always avoid specimen refusals as all Examiners are different
- Refer back to my "Marketing Madness" example



#2 DISCLAIMER REQUIREMENT

- If you are able to, simply respond and disclaim
- You *can* disclaim on the original application to avoid an OA



#3 MERELY A SURNAME

- Can't explain during initial app, must argue in OA response

#3 MERELY A SURNAME

- **Bowie Shoots**
- **Word mark** - pet photography services
- **End result:** Supplemental register and can apply for principal later



#3 MERELY A SURNAME

The USPTO argued that because “Bowie” was a surname and “shoots” pertained to the actions of a photographer, the mark was descriptive and couldn’t be trademarked. Result/Solution: first we submitted an argument for why this refusal was inappropriate - “Bowie” was not merely a surname but the name of the photographer’s dog, who had an online presence and moderate notoriety in social media circles.

Also argued that the evidence produced by the USPTO that “Bowie” was a popular surname was suspect (flaws in sources were not credible, etc). Also argued that the word “Bowie” can be used in conjunction with things other than a surname - namely, a knife. However, the USPTO rejected these arguments. After conferring with the client, we offered to transfer the application to the supplemental register, which the client was happy with.

The mark was approved for supplemental register and client was happy with the outcome.



#4 INQUIRY INTO SIGNIFICANCE OF THE WORDING OF THE MARK

- **Tango Mike Automotive Detailing**
- **Word mark** for a client with an auto detailing/body shop
- **Issue:** Section 2(d) Refusal – Likelihood of Confusion, and Inquiry into significance of the wording of the mark.
- The USPTO argued that the proposed word mark could not be registered due to a likelihood of confusion with a registered mark owned by “Mike’s car wash” and other variations of that word mark. We argued that Tango Mike is not the name of the client, but an expression broadly used in the military community meaning “thanks much,” and that would be widely understood by the general public (much of which was a military community, based on the shop’s location near Quantico) as not a detailing shop owned by somebody named Mike, but would recognize the phrase as military lingo.
- **Result/Solution:** Examiner accepted the argument and word mark was registered.

#4 LIKELIHOOD OF CONFUSION

- **XONANAXO Design mark**
- **Design mark** for a client with a knitting business
- There's another registered design mark in the same class with the literal elements "NA NA" featured, and there's another application that was filed prior to our client's which would also cause likelihood of confusion should it overcome its pending office action.
- **Result/Solution:** Because of multiple hoops to jump through, and in order to be cost-effective for our client, we identified an element of the design mark that doesn't have any literal elements in it and will re-submit so as to avoid increased cost. This mark will likely get approved because aside from the literal elements likelihood of confusion issue, there was nothing that would prevent the registration from being issued.

REMEMBER

**AN OFFICE ACTION IS
NOT ALWAYS A BAD
THING**

WHY?

- This is your opportunity to make the case the application doesn't allow for
- The OA may simply be an administrative step
- Your client may still be happy with results

But...

**WHAT IF I CAN'T
OVERCOME THE
REJECTION?**

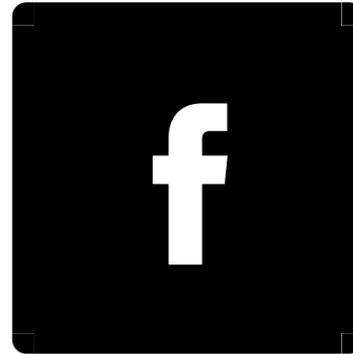


GOOD QUESTION

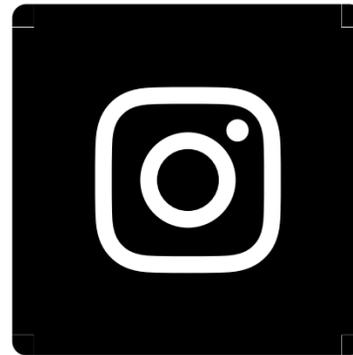
- Best effort with a thorough search completed
- Advising client now on risks + potential rebrand

FOLLOW ME

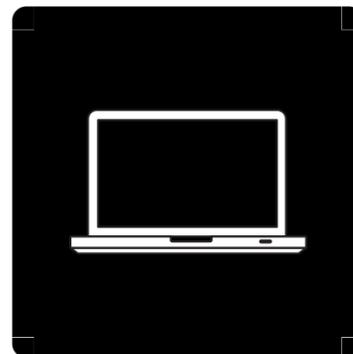
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