

**UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)  
OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION**

<b>U.S. APPLICATION SERIAL NO.</b> 76713198  <b>MARK:</b> V	<b>*76713198*</b>
<b>CORRESPONDENT ADDRESS:</b> MORRIS I POLLACK 19 EBERHARDT ROAD EAST HANOVER, NJ 07936-3051	<b>CLICK HERE TO RESPOND TO THIS I</b> <a href="http://www.uspto.gov/trademarks/teas/response">http://www.uspto.gov/trademarks/teas/response</a>
<b>APPLICANT:</b> VALMARC CORPORATION	
<b>CORRESPONDENT'S REFERENCE/DOCKET NO :</b> V-TM-143 <b>CORRESPONDENT E-MAIL ADDRESS:</b>	

**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:**

**THIS IS A FINAL ACTION.**

**THE OFFICE HAS REASSIGNED THIS APPLICATION TO THE UNDERSIGNED TRADEMARK EXAMINING ATTORNEY.**

**INTRODUCTION TO FINAL OFFICE ACTION**

This Final Office Action is written in response to applicant's "Response to Office Action" (hereinafter "Response") dated November 3, 2014.

In her last Office Action, the examining attorney raised the following refusal(s), requirement(s) and/or advisories: Requirement for a definite identification of services, requirement for an acceptable mark description; requirement for an acceptable specimen of use.

In its Response, applicant amended its mark description, provided an amended identification of services

and provided an additional specimen of use. The requirement for a definite identification of services and acceptable mark description are herein satisfied. TMEP §§713.02, 714.04. However, for the reasons provided, below, the substitute specimen of use is unacceptable. Therefore, the refusal to register the applied-for mark because applicant has failed to provide evidence of use of the mark in commerce is now made final. Trademark Act Sections 1 and 45, 15 U.S.C. §§1051, 1127; 37 C.F.R. §§2.34(a)(1)(iv), 2.56(a), 2.64(a); TMEP §§904, 904.07, 1301.04(g)(i).

## **FINAL: REQUIREMENT FOR AN ACCEPTABLE SPECIMEN OF USE**

Applicant's specimen of use is unacceptable for the following reasons.

### **1.) Unverified Specimen of Use**

The refusal to register the applied-for mark due to the substitute specimen not showing the mark in use in commerce is now made final because applicant failed to respond to that refusal by providing a properly verified specimen. Trademark Act Sections 1 and 45, 15 U.S.C. §§1051, 1127; 37 C.F.R. §§2.34(a)(1)(iv), 2.56(a), 2.64(a); TMEP §§904, 904.07(a), 1301.04(g)(i).

Applicant was previously refused registration and required to submit a verified substitute specimen to show use of the applied-for mark in commerce because the specimen does not show the applied-for mark in use in commerce in connection with any of the services specified in the amendment to allege use. A statement of use must include a specimen showing the applied-for mark in use in commerce for each class of goods and/or services specified in the statement of use. 15 U.S.C. §1051(d)(1); 37 C.F.R. §§2.56(a), 2.88(b)(2); TMEP §§904, 1109.09(b).

In response to each refused international class, applicant provided a substitute specimen(s) that appears to show use of the applied-for mark in commerce but is not verified. The USPTO cannot accept such specimen as a proper specimen of record until a verification is provided. *See* 37 C.F.R. §§2.59(b)(2), 2.88(b); *In re Adair*, 45 USPQ2d 1211, 1212 n.2 (TTAB 1997).

Examples of specimens for services include advertising and marketing materials, brochures, photographs of business signage and billboards, and webpages that show the mark used in the actual sale, rendering, or advertising of the services. *See* TMEP §1301.04(a), (h)(iv)(C).

Applicant may respond to this final specimen refusal by satisfying one of the following for each applicable international class:

- (1) Submit [verification](#) of the previously submitted substitute specimen, attesting that it was in actual use in commerce prior to the expiration of the deadline for filing the statement of use.
- (2) Submit a different and properly verified specimen (a verified [“substitute” specimen](#)) that (a) was in actual use in commerce prior to the expiration of the deadline for filing the statement of use and (b) shows the mark in actual use in commerce for the goods and/or services identified in the statement of use.

For an overview of *both* response options referenced above and instructions on how to satisfy either option online using the Trademark Electronic Application System (TEAS) form, please go to <http://www.uspto.gov/trademarks/law/S39.jsp>.

## **2.) Matching: Specimen –Mark Disagreement**

Registration is refused because the specimen does not show the applied-for mark in the drawing in use in commerce. Trademark Act Sections 1 and 45, 15 U.S.C. §§1051, 1127; 37 C.F.R. §§2.34(a)(1)(iv), 2.56(a); TMEP §§904, 904.07(a), 1301.04(g)(i).

Specifically, the specimen displays the mark as a design of a data matrix code with a “V” pointing to the right; however, the drawing displays the mark as the design of a data matrix code with a “V” point downward.

The drawing shows the mark sought to be registered, and must be a substantially exact representation of the mark as used on or in connection with the goods and/or services, as shown by the specimen. 37 C.F.R. §2.51(a); TMEP §807.12(a). Because the mark in the drawing is not a substantially exact representation of the mark on the specimen, applicant has failed to provide the required evidence of use of the applied-for mark in commerce on or in connection with applicant’s goods and/or services. *See* TMEP §807.12(a).

An application based on Trademark Act Section 1(a) must include a specimen showing the applied-for mark in use in commerce for each international class of goods and/or services identified in the application or amendment to allege use. 15 U.S.C. §1051(a)(1); 37 C.F.R. §§2.34(a)(1)(iv), 2.56(a); TMEP §§904, 904.07(a).

Examples of specimens for goods include tags, labels, instruction manuals, containers, photographs that show the mark on the actual goods or packaging, and displays associated with the actual goods at their point of sale. *See* TMEP §§904.03 *et seq.* 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. TMEP §904.03(i). Examples of specimens for services include advertising and marketing materials, brochures, photographs of business signage and billboards, and webpages that show the mark used in the actual sale, rendering, or advertising of the services. *See* TMEP §1301.04(a), (h)(iv)(C).

Regarding whether applicant may submit an amended drawing in response to this refusal, applicant is advised that the drawing of a mark can be amended only if the amendment does not materially alter the mark as originally filed. 37 C.F.R. §2.72(a)(2); *see* TMEP §§807.12(a), 807.14 *et seq.* In this case, amending the mark in the drawing to conform to the mark on the specimen would be a material alteration and would not be accepted, because the difference between the mark in the specimen and the drawing is significant and each mark creates a different commercial impression. Specifically, the “V” in the specimen is pointing toward the right; thus, the “V” appears as mathematical symbol known as greater than. *See*, <http://www.mathsisfun.com/equal-less-greater.html>. The “V” in the mark appears simply as the letter “V.” Given their different meanings, these elements carry entirely different commercial impressions.

Applicant may respond to this refusal by satisfying one of the following for each applicable international class:

- (1) Submit a different specimen (a verified “substitute” specimen) that (a) was in actual use in commerce at least as early as the filing date of the application or prior to the filing of an amendment to allege use and (b) shows the applied-for mark in actual use in commerce for the goods and/or services identified in the application or amendment to allege use.

(2) Amend the filing basis to [intent to use under Section 1\(b\)](#), for which no specimen is required. This option will later necessitate additional fee(s) and filing requirements such as providing a specimen at a subsequent date.

For an overview of *both* response options referenced above and instructions on how to satisfy either option online using the Trademark Electronic Application System (TEAS) form, please go to [http://www.uspto.gov/trademarks/law/J3\\_1.jsp](http://www.uspto.gov/trademarks/law/J3_1.jsp).

### **3.) The Specimen is Illegible**

Registration is refused because the specimen is illegible, and thus does not clearly show the applied-for mark in use in commerce for each international class. Trademark Act Sections 1 and 45, 15 U.S.C. §§1051, 1127; 37 C.F.R. §§2.34(a)(1)(iv), 2.56(a); TMEP §§904, 904.07(a), 1301.04(g)(i). An application based on Trademark Act Section 1(a) must include a specimen showing the applied-for mark in use in commerce for each international class of goods and/or services identified in the application or amendment to allege use. 15 U.S.C. §1051(a)(1); 37 C.F.R. §§2.34(a)(1)(iv), 2.56(a); TMEP §§904, 904.07(a).

Examples of specimens for goods include tags, labels, instruction manuals, containers, photographs that show the mark on the actual goods or packaging, and displays associated with the actual goods at their point of sale. *See* TMEP §§904.03 *et seq.* 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. TMEP §904.03(i). Examples of specimens for services include advertising and marketing materials, brochures, photographs of business signage and billboards, and webpages that show the mark used in the actual sale, rendering, or advertising of the services. *See* TMEP §1301.04(a), (h)(iv)(C).

Applicant may respond to this refusal by satisfying one of the following for each applicable international class:

- (1) Submit a [true, unaltered copy of the originally submitted specimen](#) that is clear and readable, with a statement by the person who transmitted it that it is a true copy of the specimen that was originally submitted.
- (2) Submit a different specimen (a verified [“substitute” specimen](#)) that (a) was in actual use in commerce at least as early as the filing date of the application or prior to the filing of an amendment to allege use and (b) shows the mark in actual use in commerce for the goods and/or services identified in the application or amendment to allege use.
- (3) Amend the filing basis to [intent to use under Section 1\(b\)](#), for which no specimen is required. This option will later necessitate additional fee(s) and filing requirements such as providing a specimen.

For an overview of *all* the response options referenced above and instructions on how to satisfy these options online using the Trademark Electronic Application System (TEAS) form, please go to <http://www.uspto.gov/trademarks/law/S5.jsp>.

## **RESPONSE TO FINAL OFFICE ACTION**

Applicant must respond within six months of the date of issuance of this final Office action or the application will be abandoned. 15 U.S.C. §1062(b); 37 C.F.R. §2.65(a). Applicant may respond by providing one or both of the following:

- (1) A response that fully satisfies all outstanding requirements and/or resolves all outstanding refusals.
- (2) An appeal to the Trademark Trial and Appeal Board, with the appeal fee of \$100 per class.

37 C.F.R. §2.64(a); TMEP §714.04; *see* 37 C.F.R. §2.6(a)(18); TBMP ch. 1200.

In certain rare circumstances, an applicant may respond by filing a petition to the Director pursuant to 37 C.F.R. §2.63(b)(2) to review procedural issues. 37 C.F.R. §2.64(a); TMEP §714.04; *see* 37 C.F.R. §2.146(b); TBMP §1201.05; TMEP §1704 (explaining petitionable matters). The petition fee is \$100. 37 C.F.R. §2.6(a)(15).

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**TO RESPOND TO THIS LETTER:** Go to [http://www.uspto.gov/trademarks/teas/response\\_forms.jsp](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](mailto: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](mailto:TrademarkAssistanceCenter@uspto.gov) or call 1-800-786-9199. For more information on checking status, see <http://www.uspto.gov/trademarks/process/status/>.

**TO UPDATE CORRESPONDENCE/E-MAIL ADDRESS:** Use the TEAS form at <http://www.uspto.gov/trademarks/teas/correspondence.jsp>.

