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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	85571957
Applicant	Larry A. Donoso
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Submission	Applicants Request for Remand and Amendment
Attachments	20160301_RequestForRemand&Suspension_SirEyeSaacNewtonDesign.pdf(199524 bytes) 20151231_Submission of Original Specimens.pdf(326031 bytes)
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Signature	/John W. Goldschmidt, Jr./
Date	03/01/2016

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In re Application of:

Larry A. Donoso

Serial No.: 85/571,957

Filed: March 16, 2012

Mark: Design

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: **Examining**
: **Attorney:** Dezmona J. Mizelle-Howard
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**REQUEST FOR REMAND
AND
SUSPENSION OF PROCEEDINGS**

Pursuant to 37 C.F.R. § 2.142(d) of the Trademark Rules of Practice, and Section 1207.02 of the Trademark Trial and Appeal Board Manual of Procedure, TBMP § 1207.02, Applicant, Larry A. Donoso, by and through the undersigned counsel, hereby respectfully requests that the Trademark Trial and Appeal Board remand the file in the above-identified Application to the Examining Attorney for consideration of additional evidence filed with the United States Patent and Trademark Office on December 31, 2015, and suspend action on this Appeal pending such consideration.

Good cause and extraordinary circumstances in support of this Request are present inasmuch as the Examining Attorneys responsible for the instant Application granted and conducted a personal interview with Applicant, Dr. Larry A. Donoso, and the undersigned on September 1, 2015 at the United States Patent and Trademark Office in order to discuss and

attempt to resolve the outstanding issues connected with this and other co-pending applications now on appeal. In connection with this personal interview, and at the request of the Examining Attorneys, on December 31, 2015, Applicant presented the Examining Attorneys with additional information, including supplemental and clarifying specimens of use, related to this and the other co-pending applications in an effort to enable the Examining Attorneys reconsider the issues now on appeal. It is believed that further study of the original specimens by the Examining Attorneys, coupled with the personal interview previously conducted between Applicant and the Examining Attorneys, may lead to a resolution of the outstanding issues connected with this and the other co-pending applications without the necessity of pursuing the appeal.

As part of its December 31, 2015 submission, Applicant submitted to the Examining Attorneys a document entitled "Submission of Original Specimens" (a copy of which is being transmitted herewith), together with the original specimens referenced therein for the Examining Attorneys further consideration. Accordingly, granting this Request should enable the Examining Attorneys time to consider this additional information in connection with this and the other co-pending Applications in an attempt to resolve the outstanding issues related to this Application.

In this regard, the Trademark Trial and Appeal Board has already granted Applicant's request for remand and suspension of proceedings in a related Ex-Parte Appeal involving United States Trademark Application Serial No. 85/571,704.

Applicant wishes to thank the Examining Attorneys for the courtesies extended in considering this additional information in connection with this Application.

This Request is made in the interests of justice, not for the purposes of undue delay, and granting this request for remand should result in economies of time and expense to the Trademark Trial and Appeal Board as well as the Applicant in connection with this and other

pending Applications.

CONCLUSION

WHEREFORE, for the foregoing reasons, Applicant respectfully requests that the Trademark Trial and Appeal Board grant this request to remand the file in the above-identified Application to the Examining Attorney for consideration of additional evidence filed with the United States Patent and Trademark Office on December 31, 2015, and suspend action on this Appeal pending such consideration.

The Commissioner is hereby authorized to charge any deficiencies or credit any overpayment related to this submission to Deposit Account Number 50-5017.

Respectfully submitted,

/John W. Goldschmidt, Jr./

John W. Goldschmidt, Jr.

Registration No: 34,828

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Date: **March 1, 2016**

Attorneys for Applicant

U.S. Serial Nos. 85/571,704, 85/571,775, 85/571,812, 85/571,859, 85/571,896, 85/571,922, 85/571,928, 85/571,936, 85/571,957, 85/571,981, 85/573,537, 85/573,547, 85/573,562, 85/983,275

Attorney Docket Nos: 303.121006, 303.121003, 303.121004, 303.121019, 303.121015, 303.121018, 303.121017, 303.121011, 303.121007, 303.121009, 303.121010, 303.121012, 303.121013, 303.121016C

original specimens related to the above-identified Applications.

These specimens are being provided in their original form at the request of the Examiners for their closer inspection in connection with their consideration of the Statements of Use which have been submitted in each of the above-identified Applications.

In this regard, the following original Specimens are enclosed for the convenience and consideration by the Examining Attorneys (with each numbered Paragraph below corresponding to the equivalently numbered original Specimen enclosed herewith):

1. Brochure entitled "Meet the Oppys of Saurusville." Used in advertising, promoting and selling Applicant's Licensee's educational programs, goods, and services, including an offer to join Applicant's Licensee's "Oppy Club" which provides its members with Applicant's Licensee's educational programs and services. *See* page 4.
2. Printed pages from Applicant's Licensee's original website (formerly located at www.vision-research.org and now located in its current form at www.oppyclub.com), which includes a landing webpage entitled "Send Oppy a Message," which enables a user to join the Oppy Club. In addition to the educational and other materials available through the website, The Oppy Club itself, also provides Applicant's Licensee's educational programs and services.
3. A Story of the Month entitled "Meet the Oppys The Friendly, Caring, And Kind Dinosaurs" (Story #1) used in the promotion, sale and delivery of Applicant's Licensee's educational programs and services.
4. A Story of the Month entitled "From the Earth to the Moon" (Story #6) used in the promotion, sale and delivery of Applicant's Licensee's educational

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programs and services.

5. A Story of the Month entitled "Teamwork Makes Everyone a Winner" (Story #9) used in the promotion, sale and delivery of Applicant's Licensee's educational programs and services.
6. A Story of the Month entitled "Oppy, What Makes an Eye Chart?" (Story #12) used in the promotion, sale and delivery of Applicant's Licensee's educational programs and services.
7. A Story of the Month entitled "Oppy, Can Dinosaurs See In Color?" (Story #27) used in the promotion, sale and delivery of Applicant's Licensee's educational programs and services.
8. An advertising and promotional brochure entitled "The Oppy Family of Friendly, Caring, and Kind Dinosaurs," which is used in the sale and advertising of Applicants Licensees educational programs and services. Specifically, this Specimen is used in the promotion, sale and advertising of Applicant's Licensee's printed instructional course materials and educational newsletters (e.g. *Stories of the Month*) made available to consumers as part of Applicant's Licensee's educational programs. For example, this Specimen is shown to physicians for their consideration in deciding whether or not to make such educational materials and programs available to the physician's patients.
9. Brochure entitled "Philadelphia Retina Endowment Fund 2008 – Eyemagination is More than Knowledge" used in the advertising, promotion and sale of Applicant's Licensee's educational programs and services as is evident from the offer made to join Applicant's Licensee's "Oppy Club" which

U.S. Serial Nos. 85/571,704, 85/571,775, 85/571,812, 85/571,859, 85/571,896, 85/571,922, 85/571,928, 85/571,936, 85/571,957, 85/571,981, 85/573,537, 85/573,547, 85/573,562, 85/983,275

Attorney Docket Nos: 303.121006, 303.121003, 303.121004, 303.121019, 303.121015, 303.121018, 303.121017, 303.121011, 303.121007, 303.121009, 303.121010, 303.121012, 303.121013, 303.121016C

provides its members with Applicant's Licensee's educational programs and services. *See* pages 23 and 28. For example, this brochure is distributed to prospective members of Applicant's Licensee's "Oppy Club," as well as used in the promotion and sale of Applicant's Licensee's educational programs and services. *See e.g.* pages 24 through 28.

10. Brochure entitled "Philadelphia Retina Endowment Fund 2010 – Eyemagination is More than Knowledge" used in the advertising, promotion and sale of Applicant's Licensee's educational programs and services as is evident from the offer made to join Applicant's Licensee's "Oppy Club" which provides its members with Applicant's Licensee's educational programs and services. *See* pages 12 and 13. *See also e.g.* back cover, as well as pages 12 and 28.

11. Brochure entitled "Philadelphia Retina Endowment Fund – Annual Report 2012" used in the advertising, promotion and sale of Applicant's Licensee's educational programs and services as is evident from the offer made to join Applicant's Licensee's "Oppy Club" which provides its members with Applicant's Licensee's educational programs and services. *See* page 8. *See also e.g.* back cover, as well as pages 7 and 9.

12. Brochure entitled "PREF Philadelphia Retina Endowment Fund - Annual Report 2013" used in the advertising, promotion and sale of Applicant's Licensee's educational programs and services as is evident from the offer made to join Applicant's Licensee's "Oppy Club" which provides its members with Applicant's Licensee's educational programs and services. *See e.g.* pages 26

U.S. Serial Nos. 85/571,704, 85/571,775, 85/571,812, 85/571,859, 85/571,896, 85/571,922, 85/571,928, 85/571,936, 85/571,957, 85/571,981, 85/573,537, 85/573,547, 85/573,562, 85/983,275

Attorney Docket Nos: 303.121006, 303.121003, 303.121004, 303.121019, 303.121015, 303.121018, 303.121017, 303.121011, 303.121007, 303.121009, 303.121010, 303.121012, 303.121013, 303.121016C

through 32.

13. Marketing and educational piece entitled "2011 Calendar Philadelphia Retina Endowment Fund Meet The Oppy's - The Friendly, Caring and Kind Dinosaur" which is used in the sale and advertising of educational programs and services offered by Applicant's Licensee. Specifically, the piece comprises a calendar which includes educational subject matter throughout showing the use of certain of Applicant's marks on and in connection with the promotion, sale and rendering of the services to users and prospective users and purchasers of Applicant's Licensee's educational programs and services made available to consumers as part of Applicant's Licensee's educational programs. For example, this piece is distributed to members of Applicant's Licensee's "Oppy Club," as well as used in the promotion and sale of Applicant's Licensee's educational programs and services.

14. Marketing and educational piece entitled "2012 Calendar Philadelphia Retina Endowment Fund Meet The Oppy's - The Kind, Friendly, Caring and Concerned Dinosaurs" which is used in the sale and advertising of educational programs and services offered by Applicant's Licensee. Specifically, the piece comprises a calendar which includes educational subject matter throughout showing the use of certain of Applicant's marks on and in connection with the promotion, sale and rendering of the services to users and prospective users and purchasers of Applicant's Licensee's educational programs and services made available to consumers as part of Applicant's Licensee's educational programs. For example, this piece is distributed to members of Applicant's Licensee's

U.S. Serial Nos. 85/571,704, 85/571,775, 85/571,812, 85/571,859, 85/571,896, 85/571,922, 85/571,928, 85/571,936, 85/571,957, 85/571,981, 85/573,537, 85/573,547, 85/573,562, 85/983,275

Attorney Docket Nos: 303.121006, 303.121003, 303.121004, 303.121019, 303.121015, 303.121018, 303.121017, 303.121011, 303.121007, 303.121009, 303.121010, 303.121012, 303.121013, 303.121016C

"Oppy Club," as well as used in the promotion and sale of Applicant's Licensee's educational programs and services.

15. Marketing and educational piece entitled "2013 Calendar Philadelphia Retina Endowment Fund Meet The Oppy's - The Kind, Friendly, Caring and Concerned Dinosaurs" which is used in the sale and advertising of educational programs and services offered by Applicant's Licensee. Specifically, the piece comprises a calendar which includes educational subject matter throughout showing the use of certain of Applicant's marks on and in connection with the promotion, sale and rendering of the services to users and prospective users and purchasers of Applicant's Licensee's educational programs and services made available to consumers as part of Applicant's Licensee's educational programs. For example, this piece is distributed to members of Applicant's Licensee's "Oppy Club," as well as used in the promotion and sale of Applicant's Licensee's educational programs and services.

16. Marketing and promotional piece in the form of a coloring book which includes several of Applicant's marks used in the advertising, sale, and rendering of educational programs and services offered by Applicant's Licensee.

17. Brochure entitled "'Hi, I'm Oppy!' Welcome to the Oppy Club! – A Guide for Parents" used in advertising, promoting and selling Applicant's Licensee's educational programs, goods, and services, including an offer to join Applicant's Licensee's "Oppy Club" which provides its members with Applicant's Licensee's educational programs and services.

U.S. Serial Nos. 85/571,704, 85/571,775, 85/571,812, 85/571,859, 85/571,896, 85/571,922, 85/571,928, 85/571,936, 85/571,957, 85/571,981, 85/573,537, 85/573,547, 85/573,562, 85/983,275

Attorney Docket Nos: 303.121006, 303.121003, 303.121004, 303.121019, 303.121015, 303.121018, 303.121017, 303.121011, 303.121007, 303.121009, 303.121010, 303.121012, 303.121013, 303.121016C

In addition, and as a point of reference, Applicant is also concurrently submitting herewith original Specimens which have been accepted in the Registration of the following related Applications, and have resulted in the Federal Registration of the subject marks (with each numbered Paragraph below corresponding to the equivalently numbered original Specimen enclosed herewith):

A. Specimens Submitted in U.S. Registration No. 4,511,299 (Envelope A)

1. Brochure entitled "An Invitation to Join the Oppy Club" used in the advertising, promotion and sale of Applicant's Licensee's educational programs and services as is evident from the offer made to join Applicant's Licensee's "Oppy Club" which provides its members with Applicant's Licensee's educational programs and services. *See* page 4.
2. A Story of the Month entitled "Oppy, What Makes a Rainbow?" (Story #10) used in the promotion, sale and delivery of Applicant's Licensee's educational programs and services.
3. Marketing and promotional piece in the form of a coloring book which includes several of Applicant's marks used in the advertising, sale, and rendering of educational programs and services offered by Applicant's Licensee.

B. Specimens Submitted in U.S. Registration No. 4,511,300 (Envelope B)

1. Webpage from the www.vision-research.com website comprising advertising, promotional and educational materials. This specimen was also submitted as a Specimen of Use in connection with

U.S. Serial Nos. 85/571,704, 85/571,775, 85/571,812, 85/571,859, 85/571,896, 85/571,922, 85/571,928, 85/571,936, 85/571,957, 85/571,981, 85/573,537, 85/573,547, 85/573,562, 85/983,275

Attorney Docket Nos: 303.121006, 303.121003, 303.121004, 303.121019, 303.121015, 303.121018, 303.121017, 303.121011, 303.121007, 303.121009, 303.121010, 303.121012, 303.121013, 303.121016C

pending Application Serial No. 85/571,896 for a design mark which is depicted in the same page as the design which is the subject of this Registration. Applicant respectfully requests that the Examining Attorney also particularly reconsiders the acceptability of this specimen in connection with Application Serial No. 85/571,896.

C. Specimens Submitted in U.S. Registration No. 4,486,429 (Envelope C)

1. Educational newsletter entitled "The Professor EyeStein Series – EyeStein on Eye-Deas" which is used in the advertising, promotion, rendering and sale of Applicant's Licensee's educational programs and services , as well as extends an offer to readers to join Applicant's Licensee's "Oppy Club" which provides its members with access to additional educational programs, products and services. Applicant respectfully requests that the Examining Attorney also particularly reconsiders the acceptability of this specimen in connection with Application Serial No. 85/571,704 where the mark prominently appears in the header on page 1, and in the center of page 5.
2. Printed page from Applicant's Licensee's original website (formerly located at www.vision-research.org and now located in its current form at www.oppyclub.com), which comprises educational materials and access to a landing webpage entitled "Send Oppy a Message," which enables a user to join the Oppy Club. In addition to the

U.S. Serial Nos. 85/571,704, 85/571,775, 85/571,812, 85/571,859, 85/571,896, 85/571,922, 85/571,928, 85/571,936, 85/571,957, 85/571,981, 85/573,537, 85/573,547, 85/573,562, 85/983,275

Attorney Docket Nos: 303.121006, 303.121003, 303.121004, 303.121019, 303.121015, 303.121018, 303.121017, 303.121011, 303.121007, 303.121009, 303.121010, 303.121012, 303.121013, 303.121016C

educational and other materials available through the website, The Oppy Club itself, also provides Applicant's Licensee's educational programs and services. Applicant respectfully requests that the Examining Attorney also particularly reconsiders the acceptability of this specimen in connection with Application Serial No. 85/571,812 where the mark prominently appears in the header on each page of the website. This Original Specimen should also be considered with respect to each of Application Serial Nos. 85/571,704, 85/571,775, 85/571,859, 85/571,896, 85/571,922, 85/571,928, 85/571,936, 85/571,957, 85/571,981, 85/573,537, 85/573,547, and 85/573,562. *See also* original Specimen of the entire website submitted herewith and referred to in Paragraph 2 of page 2 herein.

3. A Story of the Month entitled "Oppy, What Makes a Rainbow?" (Story #10) used in the promotion, sale and delivery of Applicant's Licensee's educational programs and services. This Original Specimen should also be considered with respect to each of Application Serial Nos. 85/571,704, 85/571,775, 85/571,812, 85/571,896, 85/571,922, and 85/571,928.

D. Specimens Submitted in U.S. Registration No. 4,739,461 (Envelope D)

1. A Story of the Month entitled "Oppy, What is the Constitution of the United States of America?" (Story #L2) used in the promotion, sale and delivery of Applicant's Licensee's educational programs and services.
2. A Story of the Month entitled "'Dino-beach' . . . Where Oppy's friends

U.S. Serial Nos. 85/571,704, 85/571,775, 85/571,812, 85/571,859, 85/571,896, 85/571,922, 85/571,928, 85/571,936, 85/571,957, 85/571,981, 85/573,537, 85/573,547, 85/573,562, 85/983,275

Attorney Docket Nos: 303.121006, 303.121003, 303.121004, 303.121019, 303.121015, 303.121018, 303.121017, 303.121011, 303.121007, 303.121009, 303.121010, 303.121012, 303.121013, 303.121016C

- ‘Made Tracks’" (Story #2) used in the promotion, sale and delivery of Applicant’s Licensee's educational programs and services.
3. A Story of the Month entitled "From a Spec of Dust to the Pony Express!" (Story #3) used in the promotion, sale and delivery of Applicant’s Licensee's educational programs and services.
 4. A Story of the Month entitled "From English to IgPay AtinLay" (Story #4) used in the promotion, sale and delivery of Applicant’s Licensee's educational programs and services.
 5. A Story of the Month entitled "Why do Horses Wear Shoes?" (Story #5) used in the promotion, sale and delivery of Applicant’s Licensee's educational programs and services.
 6. A Story of the Month entitled "From the Earth to the Moon" (Story #6) used in the promotion, sale and delivery of Applicant’s Licensee's educational programs and services.
 7. A Story of the Month entitled "Oppy Visits the Four Corners Monument" (Story #8) used in the promotion, sale and delivery of Applicant’s Licensee's educational programs and services.
 8. A Story of the Month entitled "Teamwork Makes Everyone a Winner" (Story #9) used in the promotion, sale and delivery of Applicant’s Licensee's educational programs and services.
 9. A Story of the Month entitled "Oppy, What Makes a Rainbow Happen?" (Story #10) used in the promotion, sale and delivery of Applicant’s Licensee's educational programs and services.
 10. A Story of the Month entitled "Oppy, Can Canyons be Underground?"

U.S. Serial Nos. 85/571,704, 85/571,775, 85/571,812, 85/571,859, 85/571,896, 85/571,922, 85/571,928, 85/571,936, 85/571,957, 85/571,981, 85/573,537, 85/573,547, 85/573,562, 85/983,275

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(Story #11) used in the promotion, sale and delivery of Applicant's Licensee's educational programs and services.

11. A Story of the Month entitled "Oppy, What Makes an Eye Chart?"

(Story #12) used in the promotion, sale and delivery of Applicant's Licensee's educational programs and services.

12. Printed pages from Applicant's Licensee's website (located in its current form at www.oppyclub.com), which comprises educational materials and enables a user to join the Oppy Club. In addition to the educational and other materials available through the website, The Oppy Club itself, also provides Applicant's Licensee's educational programs and services. Applicant respectfully requests that the Examining Attorney also particularly reconsiders the acceptability of this specimen in connection with Application Serial No. 85/983,275 where the mark prominently on the webpage entitled "Official Merchandise of the OPPY Club."

Applicant wishes to thank the Examining Attorneys for the courtesies extended in considering this additional information in connection with this Application.

Request for Interview

Applicant respectfully requests the courtesy of a telephonic interview after the Examining Attorneys have had the opportunity to review and consider the original forms of the Specimens submitted herewith in connection with each of the above-captioned Applications.

U.S. Serial Nos. 85/571,704, 85/571,775, 85/571,812, 85/571,859, 85/571,896, 85/571,922, 85/571,928, 85/571,936, 85/571,957, 85/571,981, 85/573,537, 85/573,547, 85/573,562, 85/983,275

Attorney Docket Nos: 303.121006, 303.121003, 303.121004, 303.121019, 303.121015, 303.121018, 303.121017, 303.121011, 303.121007, 303.121009, 303.121010, 303.121012, 303.121013, 303.121016C

CONCLUSION

WHEREFORE, for the foregoing reasons, Applicant respectfully requests that the Trademark Trial and Appeal Board grant this request to extend the time for Applicant to file an Appeal Brief in the above-identified Application.

The Commissioner is hereby authorized to charge any deficiencies or credit any overpayment related to this submission to Deposit Account Number 50-5017.

Respectfully submitted,

/John W. Goldschmidt, Jr./

John W. Goldschmidt, Jr.

Registration No: 34,828

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Date: **December 31, 2015**

Attorneys for Applicant