

Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	86070388
LAW OFFICE ASSIGNED	LAW OFFICE 119
MARK SECTION (no change)	
ARGUMENT(S)	
Please see the actual argument text attached within the Evidence section.	
EVIDENCE SECTION	
EVIDENCE FILE NAME(S)	
ORIGINAL PDF FILE	evi_1-747511107-20141219220343107868_.ROA-86070388-SHIFT-ACADEMY-12-19-2014.pdf
CONVERTED PDF FILE(S) (6 pages)	\\TICRS\EXPORT16\IMAGEOUT16\860\703\86070388\xml6\RFR0002.JPG
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DESCRIPTION OF EVIDENCE FILE	Request for Reconsideration after Final Action attached.
GOODS AND/OR SERVICES SECTION (current)	
INTERNATIONAL CLASS	041
DESCRIPTION	
Education services, namely, providing lectures, classes, seminars, retreats, workshops, training sessions, non-downloadable information, non-downloadable webinars, podcasts, blogs, and webcasts for businesses, business professionals, business owners and corporate executives, on the subjects of business development, marketing, communication, promotion, advertising and social media and distributing course materials therewith; Non-downloadable electronic publications in the nature of	

journals and magazines for businesses, business professionals, business owners and corporate executives on the subjects of business development, marketing, communication, promotion, advertising, digital media and social media; Educational services, namely, providing courses of instruction at the higher education level for businesses, business professionals, business owners and corporate executives on the subjects of business development, marketing, communication, promotion, advertising, digital media and social media; Providing educational instruction, training and courses for businesses, business professionals, business owners and corporate executives on the subjects of business development, marketing, communication, promotion, advertising, digital media and social media via electronic means with the assistance of computer application software, digital tools and apps for computers, tablet computers, interactive whiteboards, mobile devices and handheld devices; Non-downloadable electronic publications in the nature of journals, magazines, podcasts, newspapers, newsletters, guides, manuals and books for businesses, business professionals, business owners and corporate executives on the subjects of business development, marketing, communication, promotion, advertising, digital media and social media

FILING BASIS	Section 1(b)
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GOODS AND/OR SERVICES SECTION (proposed)

INTERNATIONAL CLASS	041
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TRACKED TEXT DESCRIPTION

~~Education services, namely, providing lectures, classes, seminars, retreats, workshops, training sessions, non-downloadable information, non-downloadable webinars, podcasts, blogs, and webcasts for businesses, business professionals, business owners and corporate executives, on the subjects of business development, marketing, communication, promotion, advertising and social media and distributing course materials therewith; Education services, namely, providing lectures, classes, seminars, retreats, workshops, training sessions, non-downloadable webinars, podcasts, blogs, and webcasts for businesses, business professionals, business owners and corporate executives, on the subjects of business development, marketing, communication, promotion, advertising and social media and distributing course materials therewith; Non-downloadable electronic publications in the nature of journals and magazines for businesses, business professionals, business owners and corporate executives on the subjects of business development, marketing, communication, promotion, advertising, digital media and social media; and specifically excluding, educational seminars, workshops and discussion groups in the fields of vocation and avocation development, civic activities, family issues, life-long learning about personal discovery and personal development issues, life planning, namely, personal and professional goal setting, plan implementation for personal development and specifically excluding, software application service provider services that host computer application software for purposes of providing a platform for developing learning software applications that are accessed online; Educational services, namely, providing courses of instruction at the higher education level for businesses, business professionals, business owners and corporate executives on the subjects of business development, marketing, communication, promotion, advertising, digital media and social media; Providing educational instruction, training and courses for businesses, business professionals, business owners and corporate executives on the subjects of business development, marketing, communication, promotion, advertising, digital media and social media via electronic means with the assistance of computer application software, digital tools and apps for computers, tablet computers, interactive whiteboards, mobile devices and handheld devices; Non-downloadable electronic publications in the nature of journals, magazines, podcasts, newspapers, newsletters, guides, manuals and books for businesses, business professionals, business owners and corporate executives on the subjects of business~~

~~development, marketing, communication, promotion, advertising, digital media and social media~~

FINAL DESCRIPTION

Education services, namely, providing lectures, classes, seminars, retreats, workshops, training sessions, non-downloadable webinars, podcasts, blogs, and webcasts for businesses, business professionals, business owners and corporate executives, on the subjects of business development, marketing, communication, promotion, advertising and social media and distributing course materials therewith; and specifically excluding, educational seminars, workshops and discussion groups in the fields of vocation and avocation development, civic activities, family issues, life-long learning about personal discovery and personal development issues, life planning, namely, personal and professional goal setting, plan implementation for personal development and specifically excluding, software application service provider services that host computer application software for purposes of providing a platform for developing learning software applications that are accessed online

FILING BASIS Section 1(b)

SIGNATURE SECTION

RESPONSE SIGNATURE /michelle l grenier esq/

SIGNATORY'S NAME Michelle L. Grenier, Esq.

SIGNATORY'S POSITION Attorney of Record, Massachusetts bar member

SIGNATORY'S PHONE NUMBER 617-728-9800

DATE SIGNED 12/19/2014

AUTHORIZED SIGNATORY YES

CONCURRENT APPEAL NOTICE FILED NO

FILING INFORMATION SECTION

SUBMIT DATE Fri Dec 19 23:45:17 EST 2014

TEAS STAMP
USPTO/RFR-74.75.11.107-20
141219234517272361-860703
88-5001d7b4857d6a3df5edb3
7d2ff58da47780759c5489776
fe102bcf85c7cdf-N/A-N/A-2
0141219220343107868

Request for Reconsideration after Final Action

To the Commissioner for Trademarks:

Application serial no. **86070388** has been amended as follows:

ARGUMENT(S)

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

Please see the actual argument text attached within the Evidence section.

EVIDENCE

Evidence in the nature of Request for Reconsideration after Final Action attached. has been attached.

Original PDF file:

[evi_1-747511107-20141219220343107868_.ROA-86070388-SHIFT-ACADEMY-12-19-2014.pdf](#)

Converted PDF file(s) (6 pages)

[Evidence-1](#)

[Evidence-2](#)

[Evidence-3](#)

[Evidence-4](#)

[Evidence-5](#)

[Evidence-6](#)

CLASSIFICATION AND LISTING OF GOODS/SERVICES

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

Current: Class 041 for Education services, namely, providing lectures, classes, seminars, retreats, workshops, training sessions, non-downloadable information, non-downloadable webinars, podcasts, blogs, and webcasts for businesses, business professionals, business owners and corporate executives, on the subjects of business development, marketing, communication, promotion, advertising and social media and distributing course materials therewith; Non-downloadable electronic publications in the nature of journals and magazines for businesses, business professionals, business owners and corporate executives on the subjects of business development, marketing, communication, promotion, advertising, digital media and social media; Educational services, namely, providing courses of instruction at the higher education level for businesses, business professionals, business owners and corporate executives on the subjects of business development, marketing, communication, promotion, advertising, digital media and social media; Providing educational instruction, training and courses for businesses, business professionals, business owners and corporate executives on the subjects of business development, marketing, communication, promotion, advertising, digital media and social media via electronic means with the assistance of computer application software, digital tools and apps for computers, tablet computers, interactive whiteboards, mobile devices and handheld devices; Non-downloadable electronic publications in the nature of journals, magazines, podcasts, newspapers, newsletters, guides, manuals and books for businesses, business professionals, business owners and corporate executives on the subjects of business development, marketing, communication, promotion, advertising, digital media and social media

Original Filing Basis:

Filing Basis: Section 1(b), Intent to Use: The applicant has had a bona fide intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the identified goods and/or services as of the filing date of the application. (15 U.S.C. Section 1051(b)).

Proposed:

Tracked Text Description: ~~Education services, namely, providing lectures, classes, seminars, retreats, workshops, training sessions, non-downloadable information, non-downloadable webinars, podcasts,~~

~~blogs, and webcasts for businesses, business professionals, business owners and corporate executives, on the subjects of business development, marketing, communication, promotion, advertising and social media and distributing course materials therewith; Education services, namely, providing lectures, classes, seminars, retreats, workshops, training sessions, non-downloadable webinars, podcasts, blogs, and webcasts for businesses, business professionals, business owners and corporate executives, on the subjects of business development, marketing, communication, promotion, advertising and social media and distributing course materials therewith; Non-downloadable electronic publications in the nature of journals and magazines for businesses, business professionals, business owners and corporate executives on the subjects of business development, marketing, communication, promotion, advertising, digital media and social media; and specifically excluding, educational seminars, workshops and discussion groups in the fields of vocation and avocation development, civic activities, family issues, life-long learning about personal discovery and personal development issues, life planning, namely, personal and professional goal setting, plan implementation for personal development and specifically excluding, software application service provider services that host computer application software for purposes of providing a platform for developing learning software applications that are accessed online; Educational services, namely, providing courses of instruction at the higher education level for businesses, business professionals, business owners and corporate executives on the subjects of business development, marketing, communication, promotion, advertising, digital media and social media; Providing educational instruction, training and courses for businesses, business professionals, business owners and corporate executives on the subjects of business development, marketing, communication, promotion, advertising, digital media and social media via electronic means with the assistance of computer application software, digital tools and apps for computers, tablet computers, interactive whiteboards, mobile devices and handheld devices; Non-downloadable electronic publications in the nature of journals, magazines, podcasts, newspapers, newsletters, guides, manuals and books for businesses, business professionals, business owners and corporate executives on the subjects of business development, marketing, communication, promotion, advertising, digital media and social media~~

Class 041 for Education services, namely, providing lectures, classes, seminars, retreats, workshops, training sessions, non-downloadable webinars, podcasts, blogs, and webcasts for businesses, business professionals, business owners and corporate executives, on the subjects of business development, marketing, communication, promotion, advertising and social media and distributing course materials therewith; and specifically excluding, educational seminars, workshops and discussion groups in the fields of vocation and avocation development, civic activities, family issues, life-long learning about personal discovery and personal development issues, life planning, namely, personal and professional goal setting, plan implementation for personal development and specifically excluding, software application service provider services that host computer application software for purposes of providing a platform for developing learning software applications that are accessed online

Filing Basis: Section 1(b), Intent to Use: The applicant has a bona fide intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the identified goods and/or services as of the filing date of the application. (15 U.S.C. Section 1051(b)).

SIGNATURE(S)

Request for Reconsideration Signature

Signature: /michelle l grenier esq/ Date: 12/19/2014

Signatory's Name: Michelle L. Grenier, Esq.

Signatory's Position: Attorney of Record, Massachusetts bar member

Signatory's Phone Number: 617-728-9800

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.

The applicant is not filing a Notice of Appeal in conjunction with this Request for Reconsideration.

Serial Number: 86070388

Internet Transmission Date: Fri Dec 19 23:45:17 EST 2014

TEAS Stamp: USPTO/RFR-74.75.11.107-20141219234517272

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58da47780759c5489776fe102bcf85c7cdf-N/A-

N/A-20141219220343107868

Trademark Law Office: 117
Serial No. 86070388
Mark: SHIFT ACADEMY

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: ORBIT, LLC (the “Applicant”)
Serial No. 86070388
Filed: September 20, 2013
Mark: SHIFT ACADEMY
Law Office: 117

REQUEST FOR RECONSIDERATION AFTER FINAL ACTION

Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3514

Dear Madam/Sir:

With regard to the Final Office Action dated June 19, 2014, please consider the above-identified trademark application in view of the response thereto, as set forth below.

REMARKS

IDENTIFICATION OF SERVICES IN CLASS 41

Class 41. In the recent Office Action the Examining Attorney indicated that the Identification of Services in Class 41 is indefinite. The Applicant amends the Identification of Services in Class 41 as set forth below:

New Proposed Identification of Services for Class 41:

Education services, namely, providing lectures, classes, seminars, retreats, workshops, training sessions, non-downloadable webinars, podcasts, blogs, and webcasts for businesses, business professionals, business owners and corporate executives, on the subjects of business development, marketing, communication, promotion, advertising and social media and distributing course materials therewith; and specifically excluding, educational seminars, workshops and discussion groups in the fields of vocation and avocation development, civic activities, family issues, life-long learning about personal discovery and personal development issues, life planning, namely, personal and professional goal setting, plan implementation for personal development and specifically excluding, software application service provider services that host computer application software for purposes of providing a platform for developing learning software applications that are accessed online. in Class 41.

CONCLUSION

IDENTIFICATION OF SERVICES

Applicant requests that Class 41 Identification of Services in the Application be amended as set forth in the electronic portion of this Response to Office Action, a copy of which is set forth above.

REMARKS

SECTION 2(d) REFUSAL

In the recent Office Action the Examining Attorney indicated a Section 2(d) Refusal pertaining to prior Registration Nos. 3953218 and 3376582 for marks that consist

of the term “SHIFT” (hereinafter collectively referred to as the “Registered Marks” the owners of each such Registered Mark referred collectively herein as the “Registrant”). The Applicant respectfully disagrees and submits that the Section 2(d) Refusal should be withdrawn in view of the applicable facts, the amendment to Applicant’s Application set forth herein and the following discussion. The Applicant reasserts its arguments set forth in Response to Office Action dated June 2, 2014 and submits the following additional arguments.

1. **Channels of Trade: platform for software developers to develop software versus educating business executives in business strategies and social media, etc.**

The Applicant submits that it is helpful in this case to analyze what exactly the Registrant’s services are.

Reg. No. 3953218. The Applicant submits that it is helpful in this case to analyze what exactly the Registrant’s services are. That is, the services set forth in Reg. No. 3953218 are essentially the following:

- (a) software application service provider services
- (b) that host computer application software
- (c) for the purpose of providing a platform
- (d) for developing online accessible learning software applications

And as such it is clear that **the channels of trade** for these services are:

- (i) software developers
- (ii) that are seeking a platform and
- (iii) software application *service providers*
- (iv) that *host application software*
- (v) that *help developers develop* learning software applications
- (vi) that can be accessed online.

Reg. No. 3376582. The services set forth in Reg. No. 3376582 are essentially the following:

- (a) educational seminars, workshops and discussion groups

- (b) in the fields of vocation and avocation development, civic activities, family issues, life-long learning about personal discovery and personal development issues, and life planning,
- (c) assistance with personal goal setting for personal and professional aspects of individual lives.

And as such it is clear that **the channels of trade** for these services are:

- (i) individuals that are seeking help with their personal lives (for example, at during midlife, work or other life transitions, family issues, etc.);
- (ii) and assistance with goal setting for personal and professional aspects of their lives as individuals.

In contrast, the Applicant's services are educational services for business executives about business not personal individual needs and not software development platform services.

Also in contrast, the channels of trade of Applicant's services are:

- (A) business executives
- (B) seeking to be educated in business strategies, social media, etc.

The Applicant's customers and members of its target market are not seeking computer services that provide a platform of developing software. Thus, the channels of trade of the Applicant's services and the services set forth in Registration No. 3953218 are clearly not the same and sufficiently distinguished to the extent that there is no likelihood of confusion; they are not similar or related and the activities surrounding their marketing are such that there is no likelihood of confusion by consumers and they are not commercially related.

2. Meaning, connotation, commercial impression and appearance: to move versus a place to study change.

Consumers are thinking *to move* in one instance (SHIFT alone) and *a place of studying change* in the other instance (SHIFT ACADEMY). To move and a place of

studying change are so different that there is no likelihood of confusion between the marks. Notwithstanding the disclaimer of the term ACADEMY, the addition of the term ACADEMY sufficiently distinguishes the Applicant's Mark from the Registered Marks and creates an overall commercial impression that sufficiently distinguishes the Applicant's mark from the Registered marks. To ignore the term ACADEMY and its distinguishing effect on the mark would be unjust.

CONCLUSION
SECTION 2(d) REFUSAL

In light of the foregoing, Applicant respectfully requests that the Section 2(d) Refusal in the current Office Action be withdrawn for the present Application and that, along with the foregoing Remarks, the Applicant respectfully requests that mark be passed on to publication.

CONCLUSION

In sum, the Applicant respectfully requests the following:

- (a) the Section 2(d) Refusals in the current Office Action be withdrawn;
- (b) the Class 41 Identification of Goods be amended as set forth in the electronic portion of this Application, a copy of which is set forth above; and
- (c) that Applicant's mark be passed on to publication.

If any impediment to passing this mark onto publication remains, after consideration of the amendment and remarks set forth above, the Examining Attorney is encouraged to contact Michelle L. Grenier, Esq., the Attorney of Record for this Application, to discuss.

Dated: December 19, 2014

Respectfully submitted,

/michelle l. grenier esq./

Michelle L. Grenier, Esq.
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