

From: Yard, John

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Subject: U.S. TRADEMARK APPLICATION NO. 86314423 - BURGESS - 507031.3000 - Request for Reconsideration Denied - Return to TTAB

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

U.S. APPLICATION SERIAL NO. 86314423

MARK: BURGESS



CORRESPONDENT ADDRESS:

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HOUSTON, TX 77002-4499

GENERAL TRADEMARK INFORMATION:

<http://www.uspto.gov/trademarks/index.jsp>

APPLICANT: Burgess Manufacturing, Ltd.

CORRESPONDENT'S REFERENCE/DOCKET NO:

507031.3000

CORRESPONDENT E-MAIL ADDRESS:

REQUEST FOR RECONSIDERATION DENIED

ISSUE/MAILING DATE:

The trademark examining attorney has carefully reviewed applicant's request for reconsideration and is denying the request for the reasons stated below. See 37 C.F.R. §2.63(b)(3); TMEP §§715.03(a)(ii)(B), 715.04(a). The following requirement(s) and/or refusal(s) made final in the Office action dated August 5, 2015 are maintained and continue to be final: Specimen refusal (as to class 37 services only). See TMEP §§715.03(a)(ii)(B), 715.04(a). See TMEP §§715.03(a)(ii)(B), 715.04(a).

In the present case, applicant's request has not resolved all the outstanding issue(s), nor does it raise a new issue or provide any new or compelling evidence with regard to the outstanding issue(s) in the final Office action. In addition, applicant's analysis and arguments are not persuasive nor do they shed new light on the issues.

The applicant's evidence and argument will be discussed briefly. Applicant has provided additional substitute specimens, properly supported by declaration, described by the applicant as follows: correspondence between applicant and its customer showing provision of manufacturing and repair services under the mark, and an engineering bulletin dated 11/1/2005 provided to customers with repair and maintenance advice.

Registration remains refused because 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 International Class(es) 37 in the application or amendment to allege use. Trademark Act Sections 1 and 45, 15 U.S.C. §§1051, 1127; 37 C.F.R. §§2.34(a)(1)(iv), 2.56(a); *In re Graystone Consulting Assocs., Inc.*, 115 USPQ2d 2035, 2037-38 (TTAB 2015); *In re Chengdu AOB Info. Tech. Co.*, 111 USPQ2d 2080, 2081-82 (TTAB 2011); TMEP §§904, 904.07(a), 1301.04(d), (g)(i). Specifically, the specimens do not show that the applicant is providing maintenance and repair of oil field equipment. At best, the specimens show that the applicant is providing information, consultation and/or advice relating to maintenance and repair of oil field equipment, however, such a service is not providing maintenance and repair of oil field equipment. Rather such a service is providing information or advice that allows the customer to repair and maintain their own oil field equipment.

Additionally, the substitute specimens merely consist of a series of email communications which do not appear to show the mark in the selling or advertising of the services. The specimen must show the mark as actually used by the applicant in selling or advertising the services. 37 C.F.R. §2.56(b)(2). TMEP § 1304.01(a).

Accordingly, for the foregoing reasons, the request for reconsideration is denied.

If applicant has already filed a timely notice of appeal with the Trademark Trial and Appeal Board, the Board will be notified to resume the appeal. See TMEP §715.04(a).

If no appeal has been filed and time remains in the six-month response period to the final Office action, applicant has the remainder of the response period to (1) comply with and/or overcome any outstanding final requirement(s) and/or refusal(s), and/or (2) file a notice of appeal to the Board. TMEP §715.03(a)(ii)(B); see 37 C.F.R. §2.63(b)(1)-(3). The filing of a request for reconsideration does not stay or extend the time for filing an appeal. 37 C.F.R. §2.63(b)(3); see TMEP §§715.03, 715.03(a)(ii)(B), (c).

Please feel free to contact the undersigned attorney if you wish to discuss this application.

/John S. Yard/

Trademark Examining Attorney

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