To:	Riverdale Global, LLC (cquinn@foxrothschild.com)
Subject:	U.S. TRADEMARK APPLICATION NO. 86337425 - RIVERDALE GLOBAL - 040526.60101
Sent:	12/4/2015 6:25:19 AM
Sent As:	ECOM112@USPTO.GOV
Attachments:	

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

U.S. APPLICATION SERIAL NO. 86337425

MARK: RIVERDALE GLOBAL

86337425

CORRESPONDENT ADDRESS:
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APPLICANT: Riverdale Global, LLC

CORRESPONDENT'S REFERENCE/DOCKET NO:
040526.60101
CORRESPONDENT E-MAIL ADDRESS:
cquinn@foxrothschild.com

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 SIX MONTHS** OF THE ISSUE/MAILING DATE BELOW.

ISSUE/MAILING DATE: 12/4/2015

The trademark examining attorney issued a final Office action on April 30, 2015. On October 30, 2015, applicant responded by filing a notice of appeal to the Trademark Trial and Appeal Board (Board) and a request for reconsideration of the issues presented in the final Office action. The Board then suspended the appeal and remanded the application to the trademark examining attorney for consideration of the request.

Applicant's request raises a new issue that must be addressed; therefore, this nonfinal Office action is

being issued to address the new issue. *See* TMEP §715.04(b). This nonfinal Office action supersedes the previously-issued final Office action.

Accordingly, applicant must respond to all requirement set forth below within six months of the date of issuance of this Office action. *See* 15 U.S.C. §1062(b); 37 C.F.R. §§2.62(a), 2.65(a). A response to this Office action should be filed with the trademark examining attorney, and not with the Board. Applicant should not respond by filing another appeal. TMEP §715.04(b). The appeal will remain suspended while the application is on remand. TMEP §715.04. **If applicant's response does not resolve all issues, the Board will be notified to resume the appeal. *Id.***

IDENTIFICATION OF SERVICES – FINAL

The recitation of services was refused as unacceptable for indefiniteness. The recitation of services submitted in response to the examining attorney's refusal is also unacceptable as indefinite.

Originally, applicant submitted the following Class 42 identification:

> Furnishing single pigment dispersion liquid color technology to others

In the initial Office Action (10/24/2014), the Examining Attorney made the following statement of record:

> The identification of services is indefinite and must be clarified because it is unclear to what service the applicant refers when it states that it "furnishes … "technology" to others: is that a retail or wholesale distributorship service, or the provision of online non-downloadable software for use in determining pigment combinations for paints, or is that the leasing of specialized equipment…? *See* TMEP §1402.01.

Furthermore, the Examining Attorney used clues from the applicant's identification to suggest the following amendments thereto:

International Class 35

> Furnishing single pigment dispersion liquid color technology to others, also known as, [specify the services actually being offered, e.g., retail distributorship services featuring single pigmentation dispersion liquid color machinery used to color match of paints, etc.]

International Class 37

> Furnishing single pigment dispersion liquid color technology to others, also known as, [specify the services actually being offered, e.g., leasing single pigment dispersion liquid color application equipment for use in the color matching of paints, etc.]

International Class 42

> Furnishing single pigment dispersion liquid color technology to others, also known as, [specify the services actually being offered, e.g., providing temporary use of on-line non-downloadable software for use in determining pigment combinations for

color matching of paints, etc.]

In response the applicant submitted the following amendment (changing the classification from Class 42 to 35):

> Furnishing single pigment dispersion liquid color technology to others, namely, sale of refillable containers of single pigment dispersion liquid color for commercial use, including loaning of liquid color metering equipment, as required

In that the amended identification remained indefinite, the Examining Attorney issued a Final Refusal (with partial refusal requirements) while formally making the following information of record:

> The recitation of services submitted in response to the examining attorney's refusal is also unacceptable as indefinite.
>
> The identification of services is indefinite and must be clarified because use of the term "sale" is unacceptable: to be a service, an activity must be primarily for the benefit of someone other than the applicant. *See In re Reichhold Chems., Inc.*, 167 USPQ 376, 377 (TTAB 1970). "Sales" or "selling" is not a service rendered for the benefit of others. *See* TMEP §§1301.01(a)(ii), 1402.11. Further, as the applicant has referenced a "loaning" aspect rather than the "rental" service suggested in the outgoing Office action (October 24, 2014), the reference is unacceptable: the "loan" does not amount to an offer of services rising to a level of "interstate commerce" and, as described, is merely an ancillary activity.
>
> The activities set forth as services in an application are reviewed using the following criteria to determine whether the services are registrable:
>
> (1) A service is a real activity, not an idea, concept, process, or system.
>
> (2) A service is performed primarily for the benefit of someone other than the applicant.
>
> (3) A service is an activity that is sufficiently separate and qualitatively different from an applicant's principal activity, i.e., it cannot be an activity that is merely incidental or necessary to an applicant's larger business.
>
> TMEP §1301.01(a); *see In re Canadian Pac. Ltd.*, 754 F.2d 992, 994-95, 224 USPQ 971, 973 (Fed. Cir. 1985); *In re Betz Paperchem, Inc.*, 222 USPQ 89, 90 (TTAB 1984); *In re Integrated Res., Inc.*, 218 USPQ 829, 831 (TTAB 1983); *In re Landmark Commc'ns, Inc.* , 204 USPQ 692, 695 (TTAB 1979).
>
> The loan of the "liquid color metering equipment, as required" is merely so that the consumer may better utilize the other goods and services for which protection is sought, and the "as necessary" component suggests that it does not constitute an activity that is sufficiently separate and qualitatively different from an applicant's principal activity. If the equipment were available for rent or lease, then such an activity would be protectable. Again, the examining attorney suggested such, but the applicant chose not to utilize such language. *See* TMEP §1402.01. Applicant may adopt the following identification, if accurate:
>
> **<u>International Class 35</u>**

> Furnishing single pigment dispersion liquid color technology to others, namely, retail store and wholesale distributorship services featuring refillable containers of single pigment dispersion liquid color for commercial use

> An applicant may only amend an identification to clarify or limit the services, but not to add to or broaden the scope of the services. 37 C.F.R. §2.71(a); *see* TMEP §§1402.06 *et seq.*, 1402.07.

On July 29, 2015, the applicant responded by Submitting a Request for Reconsideration that deleted Class 1 and amended the identification to the following:

> Furnishing single pigment dispersion liquid color technology to others by licensing third parties to use such technology; rental of refillable containers filled with single pigment dispersion liquid color for commercial use, including liquid color metering equipment when required

On August 7, 2015The Examining Attorney continued the Final Refusal, making the following statements of record:

> The identification of services is indefinite and must be clarified because "Furnishing single pigment dispersion liquid color technology to others by licensing third parties to use such technology" is not a service provided for others: licensing one's own equipment is an ancillary services provided for one's own company. Licensing one's own goods to another party is a typical business engagement contemplated by use of the goods or services in commerce. However, engaging in licensing services where the applicant the goods and services of other parties to each other is a Class 45 services. In other words, if the applicant licensed company "B's" goods and services to company "C," then the applicant would be engaged in "licensing services." See TMEP §1402.01.
>
> Furthermore, the identification of services is indefinite and must be clarified because it contains the open-ended wording "including." See TMEP §§1402.01, 1402.03(a). The identification must be specific and all-inclusive. Therefore, this wording should be deleted and replaced with "as well as."
>
> Finally, rental of "containers" is a Class 39 service; rental of pigment dispersion equipment is a Class 37 service. Please consult the USPTO's online ID Manual at http://tess2.uspto.gov/netahtml/tidm.html, which is continually updated in accordance with prevailing rules and policies, for guidance on writing identifications of goods and services. See TMEP §1402.04.
>
> Applicant may adopt the following identification, if accurate:
>
> **<u>International Class 37</u>**
>
> > Rental and leasing of refillable containers filled with single pigment dispersion liquid color, as well as liquid color metering equipment, all for commercial use

The paralegal working with applicant's attorney called the Examining Attorney to request proper acknowledgement of the time in which the applicant had to respond, as the Office action of "8/7/2015" omitted a reference to the applicant having "30 days or until the end of the response period, whichever

was greater, to respond to the outstanding issues." As such, on April 31, 2015, the Office action was reissued with the appropriate response time clause.

Despite the Examining Attorney's explicit information as to what constituted a protectable "service," a statement that the word "sale" could not be used, and information making clear that an identified service must "constitute an activity that is sufficiently separate and qualitatively different from an applicant's principal activity" to be protectable, the applicant filed an Appeal and Request for Reconsideration where the applicant submitted the following Class 35 identification (note that the amendment on Reconsideration incorporates wording from the April 20, 2015 amendment:

> Furnishing single pigment dispersion liquid color technology to others, namely, sale of refillable containers of single pigment dispersion liquid color via telephone or in-person sales, including color matching or color blending of the liquid color, if requested, all for commercial use

The applicant must now amend the identification to be compliant with Office requirements. In each previous Office action, the Examining Attorney made explicitly clear that "An applicant may only amend an identification to clarify or limit the services, but not to add to or broaden the scope of the services. 37 C.F.R. §2.71(a); *see* TMEP §§1402.06 *et seq.*, 1402.07." To that end, "color matching or color blending of the liquid color" reads as a separate service, as "custom blending" services fall within the scope of International Class 40. This reference is therefore beyond the scope of the original identification and must be deleted. Finally, the word "sale" is unacceptable.

Applicant may adopt the following identification, if accurate:

International Class 35

> Furnishing single pigment dispersion liquid color technology to others, namely, retail store and wholesale distributorship services featuring refillable containers of single pigment dispersion liquid color for commercial use, also accessible by phone

As noted in previous Office actions, an applicant may only amend an identification to clarify or limit the services, but not to add to or broaden the scope of the services. 37 C.F.R. §2.71(a); *see* TMEP §§1402.06 *et seq.*, 1402.07.

For the foregoing reason, the refusal based on an unacceptable recitation of services is maintained and made FINAL.

DELETION OF CLASS 1

Finally, on July 29, 2015 and in its Request for Reconsideration response to the Final Action, the applicant expressly and voluntarily amended the application to delete Class 1. The Examining Attorney notes TMEP §1402.06(a), which provides the following relevant information:

> Deletions from the identification of goods and services are also permitted. "Deletion" means the elimination of an existing item in an identification of goods and services in its entirety. If the applicant wishes to amend the identification of goods and services to delete one or more items, the examining attorney should accept the amendment, if it is timely and otherwise proper. **However, once the applicant has expressly amended the identification of goods and services to delete an item, it may not be reinserted in a later amendment.**

(emphasis added).

It is therefore improper for the applicant to request that the Examining Attorney "reinstate class 001." Consequently, Class 1 remains deleted and will remain deleted through the remainder of the prosecution process, with respect to the application at issue herein.

PROPER RESPONSE – FINAL OFFICE ACTION – PARTIAL REFUSAL/REQUIREMENTS

Applicant must respond within six months of the date of issuance of this final Office action or the following class to which the final requirements apply will be **deleted** from the application by Examiner's Amendment: **CLASS 35**. 37 C.F.R. §2.65(a); *see* 15 U.S.C. §1062(b).

As noted above, Class 1 cannot be reinstated, therefore the application will then proceed for the following class: **Class 2**, only.

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. §2.63(b)(1)-(2); 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. 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. 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. 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 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.

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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

IMPORTANT NOTICE REGARDING YOUR U.S. TRADEMARK APPLICATION

USPTO OFFICE ACTION (OFFICIAL LETTER) HAS ISSUED ON **12/4/2015** FOR U.S. APPLICATION SERIAL NO. 86337425

Please follow the instructions below:

(1) TO READ THE LETTER: Click on this link or go to http://tsdr.uspto.gov, enter the U.S. application serial number, and click on "Documents."

The Office action may not be immediately viewable, to allow for necessary system updates of the application, but will be available within 24 hours of this e-mail notification.

(2) TIMELY RESPONSE IS REQUIRED: Please carefully review the Office action to determine (1) how to respond, and (2) the applicable response time period. Your response deadline will be calculated from **12/4/2015** (*or sooner if specified in the Office action*). For information regarding response time periods, see http://www.uspto.gov/trademarks/process/status/responsetime.jsp.

Do NOT hit "Reply" to this e-mail notification, or otherwise e-mail your response because the USPTO does NOT accept e-mails as responses to Office actions. Instead, the USPTO recommends that you respond online using the Trademark Electronic Application System (TEAS) response form located at http://www.uspto.gov/trademarks/teas/response_forms.jsp.

(3) QUESTIONS: For questions about the contents of the Office action itself, please contact the assigned trademark examining attorney. For *technical* assistance in accessing or viewing the Office action in the Trademark Status and Document Retrieval (TSDR) system, please e-mail TSDR@uspto.gov.

WARNING

Failure to file the required response by the applicable response deadline will result in the

ABANDONMENT of your application. For more information regarding abandonment, see http://www.uspto.gov/trademarks/basics/abandon.jsp**.**

PRIVATE COMPANY SOLICITATIONS REGARDING YOUR APPLICATION: Private companies **not** associated with the USPTO are using information provided in trademark applications to mail or e-mail trademark-related solicitations. These companies often use names that closely resemble the USPTO and their solicitations may look like an official government document. Many solicitations require that you pay "fees."

Please carefully review all correspondence you receive regarding this application to make sure that you are responding to an official document from the USPTO rather than a private company solicitation. All official USPTO correspondence will be mailed only from the "United States Patent and Trademark Office" in Alexandria, VA; or sent by e-mail from the domain "@uspto.gov." For more information on how to handle private company solicitations, see http://www.uspto.gov/trademarks/solicitation_warnings.jsp.