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Subject: Max mark filing (sn: 76538741)

/Nakia D. Henry/
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Attachment Information:

Count: 3

Files: Max-request for remand.doc, Max Mark-Proposed office action.doc, Max specimen-attachment(A).doc

UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 76/538741

APPLICANT: Olin, Richard J.

CORRESPONDENT ADDRESS:

Janice W. Housey
Roberts Mlotkowski & Hobbes
P.O. Box 10064
McLean VA 22102



**BEFORE THE
TRADEMARK TRIAL
AND APPEAL BOARD
ON APPEAL**

MARK: MAX

CORRESPONDENT'S REFERENCE/DOCKET NO: 1900-008

CORRESPONDENT EMAIL ADDRESS:

jhousey@rmhlaw.com

Please provide in all correspondence:

1. Filing date, serial number, mark and applicant's name.
2. Date of this Office Action.
3. Examining Attorney's name and Law Office number.
4. Your telephone number and e-mail address.

**BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD ON
APPEAL**

**TRADEMARK EXAMINING-ATTORNEY'S REQUEST FOR
REMAND**

Please note that the undersigned recently has taken over the examination of the above-mentioned mark.

The undersigned examining-attorney seeks a remand from the Trademark Trial And Appeal Board that addresses (a) drawing refusal (b) recitation of services requirement, and (c) a substitute specimen requirement.

The trademark-examining attorney respectfully requests that the Trademark Trial and Appeal Board remand this case to the examining-attorney pursuant to 37 C.F.R. §2.142(d) for the reason(s) that follow:

- (1) The undersigned examining-attorney recently was assigned this matter for review.

- (2) On March 8, 2004, the previous examining-attorney issued a non-final office action that required (i) a clear drawing that satisfied the special-form drawing requirements and (ii) required a more definite identification, rather than the applicant's proposed recitation of services: "dental education services." The previous examining-attorney suggested to the applicant the recitation that follows: "dental education services, namely, providing courses of instruction, workshops, lectures and classes in the field of dentistry."

In this action, the previous examining-attorney failed to require a substitute specimen from the applicant that matches the drawing. The requirement is necessary because the drawing shows the tooth design with the word "Max" beneath the design, while the specimens do not include the word "Max" beneath the same design. An amendment to the drawing would constitute a material alteration.

- (3) Subsequently on September 1, 2004, applicant's newly assigned attorney, Ms. Janice W. Housey, submitted a response to the March 8, 2004 office action. Applicant's attorney amended applicant's recitation of services to "[p]roviding educational services, namely providing literature, dolls and toys designed to teach about and promote dental health; and providing printed and on-line educational materials in connection therewith."

In addition, applicant's attorney submitted a new drawing. The new drawing showed a tooth on its roots that faced right, wearing a black baseball hat that bore no design, *with the name "Max" beneath the design.* [Emphasis added.] This drawing did not match the submitted specimen, as the specimen is a depiction of a tooth on its roots that is facing left, wearing a baseball hat with a tooth on the front, and with no "Max" beneath the mark. *See the attached specimen.*

- (3) The previous examining-attorney erroneously failed to reject applicant's amendment to its recitation of services, as "providing literature, dolls and toys designed to teach about and promote dental health" are ***beyond the scope*** of the original proposed recitation of services ***in class 041***: "dental educational services."
- (5) The examining-attorney then mailed a final action, *as to the drawing*, on March 22, 2005. With this final action, applicant was provided the opportunity to (i) submit a new drawing of the mark

that agrees with the mark as it appears on the specimen and that is not a material alteration of the original mark; 37 C.F.R. §2.72(a); TMEP §§807.14 *et seq*; (ii) submit a substitute specimen that shows use of the mark as it presently appears on the drawing and is accompanied by a statement that "the substitute specimen was in use in commerce at least as early as the filing date of the application," verified with an affidavit or a signed declaration under 37 C.F.R. §2.20; 37 C.F.R. §§2.59(a) and 2.72(a); TMEP §904.09; or (iii) amend the application basis to intent-to-use under Section 1(b), and satisfy all the requirements for this new basis. TMEP §806.03(c).

- (6) Applicant's attorney submitted a new drawing and description of the mark on September 12, 2005. The submitted drawing showed a tooth on its roots, facing left and wearing a baseball hat with a tooth on the front, however the mark again included the name "Max." It should be noted that removal of the name "Max" would constitute an unacceptable material alteration. The submitted specimen includes a tooth resting on its roots that faces left and is wearing a *shaded* baseball cap with a tooth, with no "Max" beneath the design. Applicant's only options to overcome the drawing refusal would be to submit a specimen that matches the submitted drawing; change its basis to Intent to Use pursuant to 1(b); or abandon its application and/or resubmit its application.

Based on the foregoing, the undersigned examining-attorney respectfully requests this matter be remanded to the examining-attorney and seeks permission to mail the attached proposed office action to the applicant's attorney.

Respectfully submitted,

/Nakia D. Henry/
Trademark Attorney (Law Office 111)
Managing Attorney -Craig D. Taylor
Phone: (571) 272-7208
Fax: (571) 273-7208

UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 76/538741

APPLICANT: Olin, Richard J.

CORRESPONDENT ADDRESS:

Janice W. Housey
Roberts Mlotkowski & Hobbes
P.O. Box 10064
McLean VA 22102



RETURN ADDRESS:

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

MARK: MAX

CORRESPONDENT'S REFERENCE/DOCKET NO: 1900-008

CORRESPONDENT EMAIL ADDRESS:

jhousey@rmhlaw.com

Please provide in all correspondence:

1. Filing date, serial number, mark and applicant's name.
2. Date of this Office Action.
3. Examining Attorney's name and Law Office number.
4. Your telephone number and e-mail address.

OFFICE ACTION

RESPONSE TIME LIMIT: TO AVOID ABANDONMENT, THE OFFICE MUST RECEIVE A PROPER RESPONSE TO THIS OFFICE ACTION WITHIN 6 MONTHS OF THE MAILING OR E-MAILING DATE.

MAILING/E-MAILING DATE INFORMATION: If the mailing or e-mailing date of this Office action does not appear above, this information can be obtained by visiting the USPTO website at <http://tarr.uspto.gov/>, inserting the application serial number, and viewing the prosecution history for the mailing date of the most recently issued Office communication.

RE: Serial Number 76/538741

Please note that the assigned examining-attorney recently has been assigned the review of the above mark and determines as follows:

No Conflicting Marks

The Office records have been searched and no similar registered or pending mark has been found that would bar registration under Trademark Act Section 2(d), 15 U.S.C. §1052(d). TMEP §704.02.

Drawing and Specimen Requirement

The undersigned carefully has reviewed the arguments presented by the applicant and has been persuaded that the substitute drawing requirement is inappropriate in this case. As such, the drawing requirement hereby is withdrawn.

Please note, however that the mark as depicted on the drawing does not agree with the mark as it appears on the specimen, and clarification is required. 37 C.F.R. §2.51; TMEP §§807.12 and 807.12(a). In the present case, the drawing displays the mark as a tooth on its roots, facing left and wearing a baseball hat with a tooth on the front, *the name "Max." is beneath the tooth design*, and the specimen shows the mark as a tooth on its roots, facing left and wearing a *shaded* baseball hat with a tooth on the front, *with no "Max" beneath the design*. Applicant may not submit an amended drawing to conform to the display on the specimen because the character of the mark would be materially altered, i.e., the mark on the specimens creates a different commercial impression from the mark on the drawing. 37 C.F.R. §2.72(a); TMEP §§807.12, 807.12(a), 807.14 *et seq* and 904.09.

Therefore, applicant must do one of the following:

- (1) submit a substitute specimen showing use of the mark as it appears on the drawing, with a statement that "the substitute specimen was in use in commerce at least as early as the filing date of the application," verified with an affidavit or a signed declaration under 37 C.F.R. §2.20; 37 C.F.R. §§2.59(a) and 2.72(a); TMEP §904.09; or
- (2) amend the basis to Section 1(b) and satisfy all the requirements for this new basis. TMEP §806.03(c).

Recitation of Services

Applicant's recitation of services, "[p]roviding educational services, namely providing literature, dolls and toys designed to teach about and promote dental health; and providing printed and on-line educational materials in connection therewith" is unacceptable because it is beyond the scope of the original recitation of services. §1402.1. Applicant may adopt the following suggestion, *if accurate*.

Class 041: Providing dental education services, namely providing printed and on-line educational materials in connection with **courses of instruction, workshops, lectures and classes in the field of dentistry**.

Class 044: Providing online and printed information in the field of dental health.

For assistance with identifying and classifying goods and/or services in trademark applications, please see the online searchable *Manual of Acceptable Identifications of Goods and Services* at <http://tess2.uspto.gov/netathtml/tidm.html>.

Please note that, while the recitation of services may be amended to clarify or limit the goods/services, adding to the goods/services or broadening the scope of the goods/services is not permitted. 37 C.F.R. §2.71(a); TMEP §1402.06. Therefore, applicant may not amend the recitation to include services that are not within the scope of the services set forth in the present recitation.

Classification of Goods

If applicant adopts the suggested amendment of the goods and/or services, then applicant must amend the classification to International Classes 041 and 044. 37 C.F.R. §§2.32(a)(7) and 2.85; TMEP §§805 and 1401 *et seq.*

Multiple Class Requirements

If applicant prosecutes this application as a combined, or multiple-class application, then applicant must comply with each of the requirements below for those goods and/or services based on actual use in commerce under Trademark Act Section 1(a):

- (1) Applicant must list the goods/services by international class with the classes listed in ascending numerical order;
- (2) Applicant must submit a filing fee for each international class of goods and/or services not covered by the fee already paid (current fee information should be confirmed at <http://www.uspto.gov>); and
- (3) For each additional class of goods and/or services, applicant must submit:
 - (a) dates of first use of the mark anywhere and dates of first use of the mark in commerce, or a statement that the dates of use in the initial application apply to that class; the dates of use, both anywhere and in commerce, must be at least as early as the filing date of the application;
 - (b) one specimen showing use of the mark for each class of goods and/or services; the specimen must have been in use in commerce at least as early as the filing date of the application;
 - (c) a statement that "the specimen was in use in commerce on or in connection with the goods and/or services listed in the application at least as early as the filing date of the application;" and
 - (d) verification of the statements in 3(a) and 3(c) in an affidavit or a signed declaration under 37 C.F.R. §2.20. (NOTE: Verification is *not* required where (1) the dates of use

for the added class are stated to be the same as the dates of use specified in the initial application, or (2) the original specimens are acceptable for the added class.)

37 C.F.R. §§2.6, 2.34(a), 2.59, 2.71(c), and 2.86(a); TMEP §§810, 904.09, 1403.01 and 1403.02(c).

Please note that the specimen(s) of record would be acceptable for class(es) 041 and 044, if the specimen(s) displayed the mark as it appears on the drawing.

Description Required

Applicant's current mark description is "[t]he mark consists of The design portion of the mark is a "tooth" character with a cap on which has a tooth design on it." This description is not a complete description of the mark. 37 C.F.R. §2.37; TMEP §§808 *et seq.* The following is suggested:

The mark consists of the word "Max" below a caricature of a "tooth" that rests on its roots, wearing a {specify whether the baseball cap is gray, if color is claimed, otherwise leave do not insert any language here} baseball cap that includes a tooth design on the front.

If applicant has questions about its application or needs assistance in responding to this Office action, please telephone the assigned trademark examining attorney directly at the number below.

/Nakia D. Henry/
Trademark Attorney (Law Office 111)
United States Patent and Trademark Office
Phone: (571) 272-7208
Fax: (571) 273-7208

HOW TO RESPOND TO THIS OFFICE ACTION:

- **ONLINE RESPONSE:** You may respond using the Office's Trademark Electronic Application System (TEAS) Response to Office action form available on our website at <http://www.uspto.gov/teas/index.html>. If the Office action issued via e-mail, you must wait 72 hours after receipt of the Office action to respond via TEAS. **NOTE: Do not respond by e-mail. THE USPTO WILL NOT ACCEPT AN E-MAILED RESPONSE.**
- **REGULAR MAIL RESPONSE:** To respond by regular mail, your response should be sent to the mailing return address above, and include the serial number,

law office number, and examining attorney's name. **NOTE: The filing date of the response will be the *date of receipt in the Office*, not the postmarked date.**
To ensure your response is timely, use a certificate of mailing. 37 C.F.R. §2.197.

STATUS OF APPLICATION: To check the status of your application, visit the Office's Trademark Applications and Registrations Retrieval (TARR) system at <http://tarr.uspto.gov>.

VIEW APPLICATION DOCUMENTS ONLINE: Documents in the electronic file for pending applications can be viewed and downloaded online at <http://portal.uspto.gov/external/portal/tow>.

GENERAL TRADEMARK INFORMATION: For general information about trademarks, please visit the Office's website at <http://www.uspto.gov/main/trademarks.htm>

FOR INQUIRIES OR QUESTIONS ABOUT THIS OFFICE ACTION, PLEASE CONTACT THE ASSIGNED EXAMINING ATTORNEY SPECIFIED ABOVE.

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