

To: Leavitt Machinery and Rentals Inc. (trademarks@lanepowell.com)
Subject: U.S. TRADEMARK APPLICATION NO. 86406503 - NEED A LIFT? - 127517.13
Sent: 8/29/2016 1:50:31 PM
Sent As: ECOM115@USPTO.GOV
Attachments:

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

U.S. APPLICATION SERIAL NO. 86406503

MARK: NEED A LIFT

86406503

CORRESPONDENT ADDRESS:

FRANCES M JAGLA
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PORTLAND, OR 97204-3158

CLICK HERE TO RESPOND TO THIS LETTER:
http://www.uspto.gov/trademarks/teas/response_forms.jsp

[VIEW YOUR APPLICATION FILE](#)

APPLICANT: Leavitt Machinery and Rentals Inc.

ATTORNEY DOCKET NO: 127517.13

CORRESPONDENT E-MAIL ADDRESS:

trademarks@lanepowell.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 6 MONTHS** OF THE ISSUE/MAILING DATE BELOW.

ISSUE/MAILING DATE: 8/29/2016

THIS IS A FINAL ACTION.

This Office action is in response to applicant's communication filed on August 10, 2016.

Applicant's response refers to a PDF attachment, but nothing was attached. The issues raised in the February 11, 2016 office action are therefore made final.

Applicant Must Amend The Identification

The word "operational" in the identification of services remains indefinite and is likely misclassified. See 37 C.F.R. §2.32(a)(6); TMEP §1402.01. Training services in the operation of equipment is already present in the identification in Class 41. Therefore, applicant may simply delete that word from Class 37. Alternatively, it must provide definite and properly classified language that is within the scope of the original identification.

Applicant may adopt the following identification, if accurate:

"Wholesale and retail store services featuring new and used material handling equipment, building and construction equipment, replacement parts for material handling equipment and building and construction equipment, and attachments for material handling equipment and building and construction equipment; wholesale and retail services through direct solicitation by salespersons directed to end-users featuring new and used material handling equipment, building and construction equipment, replacement parts for material handling equipment and building and construction equipment, and attachments for material handling equipment and building and construction equipment," in International Class 35;

“Maintenance services for materials handling equipment and building and construction equipment,” in International Class 37;

“Financing services for material handling equipment, building and construction equipment, replacement parts for material handling equipment and building and construction equipment, and attachments for material handling equipment and building and construction equipment,” in International Class 36; and

Training services in the field of operation and maintenance of materials handling equipment and building and construction equipment,” in International Class 41.

The requirement for an acceptable, amended identification is *continued and now made final*.

Applicant’s services may be clarified or limited, but may not be expanded beyond those originally itemized in the application or as acceptably amended. *See* 37 C.F.R. §2.71(a); TMEP §1402.06. Applicant may clarify or limit the identification by inserting qualifying language or deleting items to result in a more specific identification; however, applicant may not substitute different services or add services not found or encompassed by those in the original application or as acceptably amended. *See* TMEP §1402.06(a)-(b). The scope of the services sets the outer limit for any changes to the identification and is generally determined by the ordinary meaning of the wording in the identification. TMEP §§1402.06(b), 1402.07(a)-(b). Any acceptable changes to the services will further limit scope, and once services are deleted, they are not permitted to be reinserted. TMEP §1402.07(e).

For assistance with identifying and classifying goods and services in trademark applications, please see the USPTO’s online searchable [U.S. Acceptable Identification of Goods and Services Manual](#). *See* TMEP §1402.04.

The Marks In The Drawing And Specimen Do Not Match

Registration is refused because the specimen does not show the applied-for mark in the drawing in use in commerce. Trademark Act Sections 1 and 45, 15 U.S.C. §§1051, 1127; 37 C.F.R. §§2.34(a)(1)(iv), 2.56(a); TMEP §§904, 904.07(a), 1301.04(g)(i). Specifically, the specimen displays the mark with a question mark that does not appear in the drawing.

The drawing shows the mark sought to be registered, and must be a substantially exact representation of the mark as used on or in connection with the goods and/or services, as shown by the specimen. 37 C.F.R. §2.51(a); TMEP §807.12(a). Because the mark in the drawing is not a substantially exact representation of the mark on the specimen, applicant has failed to provide the required evidence of use of the applied-for mark in commerce on or in connection with applicant’s goods and/or services. *See* TMEP §807.12(a).

An application based on Trademark Act Section 1(a) must include a specimen showing the applied-for mark in use in commerce for each international class of goods and/or services identified in the application or amendment to allege use. 15 U.S.C. §1051(a)(1); 37 C.F.R. §§2.34(a)(1)(iv), 2.56(a); TMEP §§904, 904.07(a).

Examples of specimens for services include advertising and marketing materials, brochures, photographs of business signage and billboards, and webpages that show the mark used in the actual sale, rendering, or advertising of the services. *See* TMEP §1301.04(a), (h)(iv)(C).

Regarding whether applicant may submit an amended drawing in response to this refusal, applicant is advised that the drawing of a mark can be amended only if the amendment does not materially alter the mark as originally filed. 37 C.F.R. §2.72(a)(2); *see* TMEP §§807.12(a), 807.14 *et seq.* In this case, amending the mark in the drawing to conform to the mark on the specimen would be a material alteration and would not be accepted, because the difference between the mark in the specimen and the drawing is significant and each mark creates a different commercial impression. Specifically, adding a question mark to the drawing would result in a material alteration. TMEP §807.14(c).

The case law cited by applicant supports the finding that the question mark in the specimen renders the marks not substantially exact, and that adding the question mark to the drawing would be a material alteration. *See In re Guitar Straps Online, LLC*, 103 USPQ2d 1745, 2012 WL 3561627, *4 (T.T.A.B. 2012).

Applicant may respond to this refusal by satisfying one of the following for each applicable international class:

- (1) Submit a different specimen (a verified “[substitute specimen](#)”) that (a) was in actual use in commerce at least as early as the filing date of the application or prior to the filing of an amendment to allege use and (b) shows the applied-for mark in actual use in commerce for the goods and/or services identified in the application or amendment to allege use.
- (2) Amend the filing basis to [intent to use under Section 1\(b\)](#), for which no specimen is required. This option will later necessitate additional fee(s) and filing requirements such as providing a specimen at a subsequent date.

For an overview of both response options referenced above and instructions on how to satisfy either option online using the Trademark Electronic Application System (TEAS) form, please go to http://www.uspto.gov/trademarks/law/J3_1.jsp.

This refusal is *continued and now made final*.

The Proposed Amendment To The Drawing Is Unacceptable

Applicant requested in its January 20, 2016 that the drawing of the mark be amended. The proposed amendment adds a question mark.

An amendment to a mark will not be accepted if the change would materially alter the mark in the initial application. 37 C.F.R. §2.72; TMEP §807.14. Determining whether a proposed amendment materially alters a mark involves comparing the proposed amended mark with the mark in the drawing filed with the original application. 37 C.F.R. §2.72; TMEP §807.14(d).

The test for material alteration is whether the modified mark retains what is the essence of the original mark; that is, whether the new and old forms create the impression of being essentially the same mark. *In re Hacot-Columbier*, 105 F.3d 616, 620, 41 USPQ2d 1523, 1526 (Fed. Cir. 1997) (quoting *Visa Int'l Serv. Ass'n v. Life Code Sys., Inc.*, 220 USPQ 740, 743 (TTAB 1983)); see *In re Nationwide Indus. Inc.*, 6 USPQ2d 1882, 1885 (TTAB 1988); TMEP §807.14. For example, if republication of the amended mark would be necessary to provide proper notice of the mark to third parties for opposition purposes, then the mark has been materially altered and the amendment is not permitted. *In re Hacot-Columbier*, 105 F.3d at 620, 41 USPQ2d at 1526 (quoting *Visa Int'l Serv. Ass'n v. Life Code Sys., Inc.*, 220 USPQ at 743-44). Also, the addition of an element that would require a further search may be a factor in determining material alteration. *In re Guitar Straps Online, LLC*, 103 USPQ2d 1745, 1747 (TTAB 2012); *In re Who? Vision Sys. Inc.*, 57 USPQ2d 1211, 1218 (TTAB 2000).

In the present case, the proposed amendment to the mark is refused because it would result in a material alteration of the mark depicted in the original application. TMEP §807.17; see 37 C.F.R. §2.72; *In re Who? Vision Sys., Inc.*, 57 USPQ2d 1211 (holding proposed amendment from “TACILESENSE” to “TACTILESENSE” to be material alteration due to the difference in meaning or connotation between the marks); *In re CTB Inc.*, 52 USPQ2d 1471 (TTAB 1999) (holding proposed amendment of TURBO and design to the typed word TURBO to be a material alteration due to the design being distinctive matter).

Specifically, the proposed amendment would materially alter the mark in the initial application because the addition of a question mark changes a statement into a question. TMEP §807.14(c).

Accordingly, the proposed amendment will not be entered; the original drawing of the mark remains operative. TMEP §807.17.

Applicant did not submit a response to this issue. The refusal to amend the drawing is *continued and now made final*.

Response Guidelines

Applicant must respond within six months of the date of issuance of this final Office action or the application will be abandoned. 15 U.S.C. §1062(b); 37 C.F.R. §2.65(a). 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).

Applicant is invited to contact the assigned examining attorney with any specific questions regarding the substance of this action.

/Katherine S. Chang/
Trademark Examining Attorney
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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 **8/29/2016** FOR U.S. APPLICATION SERIAL NO. 86406503

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 **8/29/2016** (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.