

From: Carl, Fred

Sent: 10/12/2016 12:15:31 PM

To: TTAB EFiling

CC:

Subject: U.S. TRADEMARK APPLICATION NO. 86627769 - TOTAL CARB - N/A - Request for Reconsideration Denied - Return to TTAB

Attachment Information:

Count: 1

Files: 86627769.doc

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

U.S. APPLICATION SERIAL NO. 86627769

MARK: TOTAL CARB



CORRESPONDENT ADDRESS:

ERNESTO M. RUBI

CAREY RODRIGUEZ MILIAN GONYA LLP

1395 BRICKELL AVE STE 700

MIAMI, FL 33131-3354

GENERAL TRADEMARK INFORMATION:

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

[VIEW YOUR APPLICATION FILE](#)

APPLICANT: Jay Cutler Elite, LLC

CORRESPONDENT'S REFERENCE/DOCKET NO:

N/A

CORRESPONDENT E-MAIL ADDRESS:

mmartucci@careyrodriguez.com

REQUEST FOR RECONSIDERATION DENIED

ISSUE/MAILING DATE: 10/12/2016

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 refusal under Trademark Act Section 2(d), made final in the Office action dated March 21, 2016 is maintained and continues to be final. See TMEP §§715.03(a)(ii)(B), 715.04(a).

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

Regarding the evidence submitted with the request for reconsideration, applicant should note that the list of applications and registrations does not make these a part of the record. *In re Promo Ink*, 78 USPQ2d 1301, 1304 (TTAB 2006); TBMP §1208.02; TMEP §710.03.

To make third party registrations or applications part of the record, an applicant must submit copies of the registrations, **or the complete electronic equivalent** from the USPTO's automated systems, prior to appeal. *In re Jump Designs LLC*, 80 USPQ2d 1370, 1372-73 (TTAB 2006); *In re Ruffin Gaming*, 66 USPQ2d, 1924, 1925 n.3 (TTAB 2002); TBMP §1208.02; TMEP §710.03.

Additionally, in this case, applicant's list shows merely that there are trademark records in class 5 with the word TOTAL in the marks. Applicant's mark and the registered mark share the elements TOTAL CARB, not merely TOTAL. Also, the list does not show the goods on which these marks are used, which is relevant. Finally, the full records could disclose that all of these trademarks are owned by a single entity, however unlikely that might be. For these reasons, the list itself is of very limited relevance.

Accordingly, the request 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) overcome the outstanding final refusal, 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).

/Fred Carl III/

Trademark Examining Attorney

U.S. Pat. & Trademark Office

Law Office 108

571/272-8867 direct phone

571/273-8867 fax

fred.carl@uspto.gov*

*** Email correspondence cannot be accepted as a response to an outstanding action. TMEP §304.02.**