

To: Shaklee Corporation (ptotmdocket@klarquist.com)
Subject: U.S. Trademark Application Serial No. 87528703 - PERFORMANCE - 6592-98240-1
Sent: December 03, 2019 12:52:23 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. 87528703

Mark: PERFORMANCE

Correspondence Address:

KEVIN M HAYES
KLARQUIST SPARKMAN LLP
ONE WORLD TRADE CENTER STE 1600 121 SW S
ALMON ST
PORTLAND, OR 97204-2988
Applicant: Shaklee Corporation

Reference/Docket No. 6592-98240-1

Correspondence Email Address:

ptotmdocket@klarquist.com

FINAL OFFICE ACTION

Issue date: **December 03, 2019**

On September 24, 2018, the trademark examining attorney issued a final Office action that refused registration of the applied-for mark on the basis of Trademark Act Section 2(e)(1). Applicant appealed that decision to the Trademark Trial and Appeal Board.

On November 13, 2019, at the applicant's request, the Trademark Trial and Appeal Board remanded the present application to the trademark examining attorney for further consideration of additional evidence. The trademark examining attorney has carefully reviewed the additional evidence and determined that it did not resolve the outstanding issue. TMEP §§715.03(a)(ii)(B), 715.04(a).

Specifically, applicant has provided evidence that another trademark has registered without a disclaimer of the term PERFORMANCE.

It is well settled that each case must be decided on its own facts and the Trademark Trial and Appeal Board is not bound by prior decisions involving different records. *See In re Nett Designs, Inc.*, 236 F. 3d 1339, 1342, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001); *In re Datapipe, Inc.*, 111 USPQ2d 1330, 1336 (TTAB 2014); TMEP §1209.03(a). Here, the facts in the application and registration are different. The mark at issue differs from the recently registered mark, SHAKLEE PERFORMANCE, because the applied-for mark consists solely of the term PERFORMANCE.

Further, an applied-for mark that is merely descriptive does not become registrable simply because other seemingly similar marks appear on the register. *In re Scholastic Testing Serv., Inc.*, 196 USPQ at 519; TMEP §1209.03(a). This is particularly true where third-party registrations for supplements and related goods overwhelmingly treat the term PERFORMANCE as descriptive, and only a small minority of registrations do not.

Accordingly, the Section 2(e)(1) refusal is **maintained and continued**. *See* TMEP §§715.03(a)(ii)(B), 715.04(a).

Per the instructions in the remand, the Trademark Trial and Appeal Board will be notified to resume the appeal. *See* TMEP §715.04(a).

/Andrea B. Cornwell/
Andrea B. Cornwell
Examining Attorney
Law Office 115
571-272-4608

TEAS PLUS OR TEAS REDUCED FEE (TEAS RF) APPLICANTS – TO MAINTAIN LOWER FEE, ADDITIONAL REQUIREMENTS MUST BE MET, INCLUDING SUBMITTING DOCUMENTS ONLINE: Applicants who filed their application online using the lower-fee TEAS Plus or TEAS RF application form must (1) file certain documents online using TEAS, including responses to Office actions (see TMEP §§819.02(b), 820.02(b) for a complete list of these documents); (2) maintain a valid e-mail correspondence address; and (3) agree to receive correspondence from the USPTO by e-mail throughout the prosecution of the application. *See* 37 C.F.R. §§2.22(b), 2.23(b); TMEP §§819, 820. TEAS Plus or TEAS RF applicants who do not meet these requirements must submit an additional processing fee of \$125 per class of goods and/or services. 37 C.F.R. §§2.6(a)(1)(v), 2.22(c), 2.23(c); TMEP §§819.04, 820.04. However, in certain situations, TEAS Plus or TEAS RF applicants may respond to an Office action by authorizing an examiner’s amendment by telephone or e-mail without incurring this additional fee.

To: Shaklee Corporation (ptotmdocket@klarquist.com)
Subject: U.S. Trademark Application Serial No. 87528703 - PERFORMANCE - 6592-98240-1
Sent: December 03, 2019 12:52:24 PM
Sent As: ecom115@uspto.gov
Attachments:

United States Patent and Trademark Office (USPTO)

USPTO OFFICIAL NOTICE

Office Action (Official Letter) has issued
on **December 03, 2019** for
U.S. Trademark Application Serial No. 87528703

Your trademark application has been reviewed by a trademark examining attorney. As part of that review, the assigned attorney has issued an official letter that you must respond to by the specified deadline or your application will be [abandoned](#). Please follow the steps below.

(1) [Read the official letter](#).

(2) **Direct questions** about the contents of the Office action to the assigned attorney below.

/Andrea B. Cornwell/
Andrea B. Cornwell
Examining Attorney
Law Office 115
571-272-4608
andrea.cornwell@uspto.gov

Direct questions about navigating USPTO electronic forms, the USPTO [website](#), the application process, the status of your application, and/or whether there are outstanding deadlines or documents related to your file to the [Trademark Assistance Center \(TAC\)](#).

(3) **Respond within 6 months** (or earlier, if required in the Office action) from **December 03, 2019**, using the Trademark Electronic Application System (TEAS). The response must be received by the USPTO before midnight **Eastern Time** of the last day of the response period. See the Office action for more information about how to respond

GENERAL GUIDANCE

- [Check the status of your application periodically](#) in the [Trademark Status & Document Retrieval \(TSDR\)](#) database to avoid missing critical deadlines.
- [Update your correspondence email address](#), if needed, to ensure you receive important USPTO notices about your application.
- [Beware of misleading notices sent by private companies about your application](#). Private companies not associated with the USPTO use public information available in trademark registrations to mail and email trademark-related offers and notices – most of which require fees. All **official USPTO correspondence** will only be **emailed from the domain “@uspto.gov.”**