

To: Boing! Designs, LLC (billh@ellihay.com)
Subject: TRADEMARK APPLICATION NO. 77587775 - SMALL GREETING, BIG - N/A
Sent: 1/15/2009 4:24:18 PM
Sent As: ECOM113@USPTO.GOV
Attachments:

UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 77/587775

MARK: SMALL GREETING, BIG

77587775

CORRESPONDENT ADDRESS:
BOING! DESIGNS, LLC
25159 NE BUTTEVILLE RD
AURORA, OR 97002-8534

RESPOND TO THIS ACTION:
<http://www.uspto.gov/teas/eTEASpageD.htm>

GENERAL TRADEMARK INFORMATION:
<http://www.uspto.gov/main/trademarks.htm>

APPLICANT: Boing! Designs, LLC

CORRESPONDENT'S REFERENCE/DOCKET NO :
N/A

CORRESPONDENT E-MAIL ADDRESS:
billh@ellihay.com

OFFICE ACTION

TO AVOID ABANDONMENT, THE OFFICE MUST RECEIVE A PROPER RESPONSE TO THIS OFFICE ACTION WITHIN 6 MONTHS OF THE ISSUE/MAILING DATE.

ISSUE/MAILING DATE: 1/15/2009

The referenced application has been reviewed by the assigned trademark examining attorney. The examining attorney has also reviewed applicant's preliminary response of November 24, 2008. Applicant must respond timely and completely to the issue(s) below. 15 U.S.C. §1062(b); 37 C.F.R. §§2.62, 2.65(a); TMEP §§711, 718.03.

NO CONFLICTING MARKS FOUND

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

DRAWING OF THE MARK

The drawing shows the mark as "Small Greeting, Big Meaning," however, the specimen of use displays the mark as "Small Greeting Big Meaning." The mark on the specimen disagrees with the mark on the drawing because there is no comma between "greeting" and "big."

The mark on the drawing 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); see 37 C.F.R. §2.72(a)(1).

Therefore, applicant must submit one of the following:

- (1) A new drawing of the mark that agrees with the mark on the specimen but does not materially alter the original mark. See 37 C.F.R. §2.72(a); TMEP §§807.12(a), 807.14 *et seq.*; or
- (2) A substitute specimen showing use in commerce of the mark on the drawing, and the following statement, verified with an affidavit or signed declaration under 37 C.F.R. §§2.20, 2.33: "The substitute specimen was in use in commerce at least as early as the filing

date of the application.” See 37 C.F.R. §2.59(a); TMEP §§807.12(a), 904.05. A properly worded declaration under 37 C.F.R. §2.20, with a supporting statement for a substitute specimen, is attached below. If submitting a specimen requires an amendment to the dates of use, applicant must also verify the amended dates. 37 C.F.R. §2.71(c); TMEP §904.05.

If applicant cannot satisfy one of the above requirements, applicant may amend the application from a use in commerce basis under Trademark Act Section 1(a) to an intent to use basis under Section 1(b), for which no specimen is required. See TMEP §806.03(c). However, if applicant amends the basis to Section 1(b), registration will not be granted until applicant later amends the application back to use in commerce by filing an acceptable allegation of use with a proper specimen. See 15 U.S.C. §1051(c)-(d); 37 C.F.R. §§2.76, 2.88; TMEP §1103.

To amend to Section 1(b), applicant must submit the following statement, verified with an affidavit or signed declaration under 37 C.F.R. §§2.20, 2.33: **“Applicant has had a bona fide intention to use the mark in commerce on or in connection with the goods or services listed in the application as of the filing date of the application.”** 37 C.F.R. §2.34(a)(2); TMEP §806.01(b); see 15 U.S.C. §1051(b); 37 C.F.R. §2.35(b)(1).

APPLICANT’S SUBSTITUTE SPECIMEN

The substitute specimen submitted with applicant’s preliminary response on November 24, 2008 contained the statement “The substitute specimen(s) was in use in commerce prior to the filing of the Amendment to Allege Use (AAU).” However, a statement in support of substitute specimens for a use-based application under Section 1(a) must indicate that the substitute specimen was in use in commerce at least as early as the filing date of the application.

Because applicant’s original application was filed as a use-based application under Trademark Act Section 1(a), the substitute specimen previously submitted was not properly supported and cannot be accepted into the application record. 37 C.F.R. §2.59(a); TMEP §904.05.

Additionally, applicant’s mark is SMALL GREETING, BIG MEANING. However, the substitute specimen of use submitted with applicant’s preliminary response of November 24, 2008 displays the mark as “SMALL GREETING BIG MEANING.” The mark on applicant’s substitute specimen of use disagrees with the mark on the drawing because there is no comma between “greeting” and “big.”

As explained above, the mark on the drawing 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); see 37 C.F.R. §2.72(a)(1).

TEAS PLUS APPLICANTS MUST SUBMIT DOCUMENTS ELECTRONICALLY OR SUBMIT FEE: TEAS Plus applicants should submit the following documents using the Trademark Electronic Application System (TEAS) at <http://www.uspto.gov/teas/index.html>: (1) written responses to Office actions; (2) preliminary amendments; (3) changes of correspondence address; (4) changes of owner’s address; (5) appointments and revocations of attorney; (6) amendments to allege use; (7) statements of use; (8) requests for extension of time to file a statement of use, and (9) requests to delete a §1(b) basis. If any of these documents are filed on paper, they must be accompanied by a \$50 per class fee. 37 C.F.R. §§2.6(a)(1)(iv) and 2.23(a)(i). Telephone responses will not incur an additional fee. NOTE: In addition to the above, applicant must also continue to accept correspondence from the Office via e-mail throughout the examination process in order to avoid the additional fee. 37 C.F.R. §2.23(a)(2).

/Amy L. Kertgate/
Law Office 113
Trademark Examining Attorney
Office: 571-272-1943

RESPOND TO THIS ACTION: Applicant should file a response to this Office action online using the form at <http://www.uspto.gov/teas/eTEASpageD.htm>, waiting 48-72 hours if applicant received notification of the Office action via e-mail. For technical assistance with the form, please e-mail TEAS@uspto.gov. For questions about the Office action itself, please contact the assigned examining attorney. **Do not respond to this Office action by e-mail; the USPTO does not accept e-mailed responses.**

If responding by paper mail, please include the following information: the application serial number, the mark, the filing date and the name, title/position, telephone number and e-mail address of the person signing the response. Please use the following address: Commissioner for Trademarks, P.O. Box 1451, Alexandria, VA 22313-1451.

STATUS CHECK: Check the status of the application at least once every six months from the initial filing date using the USPTO Trademark Applications and Registrations Retrieval (TARR) online system at <http://tarr.uspto.gov>. When conducting an online status check, print and maintain a copy of the complete TARR screen. If the status of your application has not changed for more than six months, please contact the

assigned examining attorney.

DECLARATION

The undersigned being warned that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. §1001, and that such willful false statements and the like may jeopardize the validity of the application or document or any registration resulting there from, declares *that the substitute specimen was in use in commerce at least as early as the filing date of the application*; all statements made of his/her own knowledge are true; and all statements made on information and belief are believed to be true.

(Signature)

(Print or Type Name and Position)

(Date)

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Subject: TRADEMARK APPLICATION NO. 77587775 - SMALL GREETING, BIG - N/A
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IMPORTANT NOTICE
USPTO OFFICE ACTION HAS ISSUED ON 1/15/2009 FOR
APPLICATION SERIAL NO. 77587775

Please follow the instructions below to continue the prosecution of your application:

VIEW OFFICE ACTION: Click on this link http://tportal.uspto.gov/external/portal/tow?DDA=Y&serial_number=77587775&doc_type=OOA&mail_date=20090115 (or copy and paste this URL into the address field of your browser), or visit <http://tportal.uspto.gov/external/portal/tow> and enter the application serial number to [access](#) the Office action.

PLEASE NOTE: The Office action may not be immediately available but will be viewable within 24 hours of this notification.

RESPONSE MAY BE REQUIRED: You should carefully review the Office action to determine (1) if a response is required; (2) how to respond; and (3) the applicable [response time period](#). Your response deadline will be calculated from **1/15/2009**.

Do NOT hit "Reply" to this e-mail notification, or otherwise attempt to e-mail your response, as the USPTO does NOT accept e-mailed responses. Instead, the USPTO recommends that you respond online using the Trademark Electronic Application System response form at <http://www.uspto.gov/teas/eTEASpageD.htm>.

HELP: For *technical* assistance in accessing the Office action, please e-mail TDR@uspto.gov. Please contact the assigned examining attorney with questions about the Office action.

WARNING

- 1. The USPTO will NOT send a separate e-mail with the Office action attached.**
- 2. Failure to file any required response by the applicable deadline will result in the **ABANDONMENT** of your application.**