

To: Lehman, Shannon Daniel (dan@danlehman.com)
Subject: TRADEMARK APPLICATION NO. 78597683 - ALBINO - "BITE THE WHITE" - N/A
Sent: 10/25/2005 11:35:14 AM
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Attachments:

UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 78/597683

APPLICANT: Lehman, Shannon Daniel

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78597683

RETURN ADDRESS:
Commissioner for Trademarks
P.O. Box 1451
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MARK: ALBINO - "BITE THE WHITE"

CORRESPONDENT'S REFERENCE/DOCKET NO : N/A

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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.

Serial Number 78/597683

The assigned examining attorney has reviewed the referenced application and determined the following.

Search

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.

Mark does not Function as a Trademark: Improper Specimen of Use for Goods

The Examining Attorney refuses registration because the proposed mark does not function as a trademark. Trademark Act Sections 1, 2 and 45, 15 U.S.C. §§1051, 1052 and 1127. The proposed mark neither identifies and distinguishes the goods of the applicant from those of others nor indicates their source. *In Re Remington Products Inc.*, 3 USPQ2d 1714 (TTAB 1987). TMEP §§1202 *et seq.* Please note that the proposed mark does not function as a trademark because the specimen submitted with the application is unacceptable as evidence of actual trademark use; therefore, the proposed mark cannot identify and distinguish the applicant's goods from those of others nor indicate their source.

The specimen is unacceptable as evidence of actual trademark use because it is merely a screen shot of the applicant's mark rather than a copy of an actual specimen used in commerce. The applicant must submit a specimen showing the mark as it is actually used in commerce with the goods. Note also that invoices, announcements, order forms, bills of lading, leaflets, brochures, publicity releases and other advertising material generally are NOT acceptable specimens. *In re Bright of America, Inc.*, 205 USPQ 63 (TTAB 1979); TMEP §§904.05 and 904.07. *See In re Ultraflight Inc.*, 221 USPQ 903 (TTAB 1984).

The applicant must submit a specimen showing the mark as it is used in commerce. 37 C.F.R. Section 2.56. Examples of acceptable specimens are tags, labels, instruction manuals, containers, and photographs that show the mark on the goods or packaging. The applicant must verify, with an affidavit or a declaration under 37 C.F.R. Section 2.20, that the substitute specimen was in use in commerce at least as early as the filing date of the application. 37 C.F.R. Section 2.59(a); TMEP section 904.09.

The statement supporting use of the substitute specimen must read as follows:

The substitute specimen was in use in commerce at least as early as the filing date of the application.

The applicant must sign this statement either in affidavit form or with a declaration under 37 C.F.R. Section 2.20.

If an amendment of the dates-of-use clause is necessary in order to state the correct dates of first use, the applicant must verify the amendment with an affidavit or a declaration in accordance with 37 C.F.R. §2.20. 37 C.F.R. §2.71(c); TMEP §§903.05 and 1109.09(a).

Pending an adequate response to the above, the examining attorney refuses registration under Trademark Act Sections 1, 2 and 45, 15 U.S.C. §§1051, 1052 and 1127, because the record does not show use of the proposed mark as a trademark.

Note: An acceptable declaration of use would read as follows:

The substitute specimen submitted with this declaration was in use in commerce at least as early as the filing date of the application.

The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001, and that such willful false statements may jeopardize the validity of the application or any resulting registration, declares that the facts set forth in this application are true; 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)

NOTICE: Substitution of Basis

If the applicant cannot comply with the requirement for a specimen of use in commerce for the Section 1(a) basis asserted, the applicant may substitute a different basis for filing if the applicant can meet the requirements for the new basis.

In this case, the applicant may wish to amend the application to assert a Section 1(b) intent to use basis.

Note: In an application under Trademark Act Section 1(b), 44(d) or 44(e), 15 U.S.C. Section 1051(b), 1126(d) or 1126(e), the applicant must verify that it has a “bona fide intention to use the mark in commerce on or in connection with the goods or services listed in the application.” Therefore, if applicant wishes to amend to a Section 1(b) basis for registration, applicant must submit the following statement:

The 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 since the filing date of the application.

This statement must be verified with an affidavit or a declaration under 37 C.F.R. Section 2.20. 37 C.F.R. Section 2.71(d)(1). See declaration body above.

Although the examining attorney has refused registration, the applicant may respond to the refusal to register by submitting evidence and arguments in support of registration. If the applicant chooses to respond to the refusal to register, the applicant must also respond to the following informalities.

Significance of Term

The applicant must indicate what significance the wording "albino" has in the relevant trade or industry or as applied to the goods. The applicant must specifically state (1) whether there is a species or type of fish called an Albino; (2) whether the goods are designed in a way as to particularly catch Albino or color pigment free fish and (3) any other meaning albino has in relation to the goods. 37 C.F.R. Section 2.61(b).

Standard Character Claim

Applicant has submitted a standard character claim, however, the mark is in special form, therefore this claim is inappropriate and must be deleted. 37 C.F.R. §2.52(a).

Deletion from Drawing

The TM is not part of the mark, and the applicant should delete this from the drawing. NOTE that applicant must actually submit a new drawing without the TM as the trademark office cannot delete an element out of a special form drawing. TMEP sections 807.04 and 807.15.

Drawing

Applicant has submitted a color drawing and must clarify whether color is a feature of the proposed mark. Applicant initially states that color is NOT part of the mark, but then applicant describes the specimen's color. Note that describing the specimen color does not amount to a color claim or color description and note that it would be insufficient in any event because it fails to claim ALL of the colors in the mark, including black. 37 C.F.R. §2.52(b)(1); TMEP §807.07(b).

If color is a feature of the proposed mark, then applicant must submit (1) a statement that "the color(s) red, pink and black are claimed as a feature of the mark," and (2) a separate description of where the colors appear in the mark, i.e., "the color(s) [specify] appear in [specify]." Common color names should be used to describe the colors in the mark, e.g., red, yellow, blue. TMEP §§807.07(a)(i) and (a)(ii).

If color is *not* a feature of the mark, then applicant must submit a substitute black and white drawing of the proposed mark to replace the color drawing of record.

Identification of Goods

The identification of goods is unacceptable as indefinite and overly broad. The applicant must amend the identification to specify the commercial name of the goods. If there is no common commercial name for the product, the applicant must describe the product and its intended uses. TMEP section 1402.

The applicant may adopt the following identification if accurate:

[specify the type of sporting goods and classify accordingly, eg. fishing lines in class 28, fishing knives in **class 8**]; fishing tackle, namely, fishing lures, in International Class 28 [unless otherwise noted].

Please note that, while an application may be amended to clarify or limit the identification, additions to the identification are not permitted. 37 C.F.R. Section 2.71(b); TMEP section 1402.06. Therefore, the applicant may not amend to include any goods that are not within the scope of goods set forth in the present identification.

The Trademark Acceptable Identification of Goods and Services Manual can be found on the world wide web at:
[http://www.uspto.gov/web/offices/tac/doc/gsmannual/](http://www.uspto.gov/web/offices/tac/doc/gsmmanual/)

Classification

If the applicant adopts the suggested amendment to the identification of goods, the applicant must amend the classification to the International Class noted. 37 C.F.R. Sections 2.33(a)(1)(vi) and 2.85; TMEP sections 1401.

Additional Classes-note that applicant has paid for only 1 class of goods

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).

If the applicant has any questions or needs assistance in responding to this Office action, please telephone the assigned examining attorney. If the applicant has questions regarding the status of the application, the applicant should check the uspto.gov website.

Rebecca L. Gilbert
/Rebecca L. Gilbert/
Law Office 104
571-272-9431

HOW TO RESPOND TO THIS OFFICE ACTION:

- **ONLINE RESPONSE:** You may respond formally using the Office’s Trademark Electronic Application System (TEAS) Response to Office Action form (visit <http://www.uspto.gov/teas/index.html> and follow the instructions, but if the Office Action has been issued via email, you must wait 72 hours after receipt of the Office Action to respond via TEAS).
- **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 in your response.

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.