

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

APPLICATION SERIAL NO. 79118001

MARK: TOTAL COMPLIANCE

**\*79118001\***

**CORRESPONDENT ADDRESS:**

Total Compliance Ltd  
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UNITED KINGDOM

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APPLICANT: Total Compliance Ltd

CORRESPONDENT'S REFERENCE/DOCKET NO :

N/A

CORRESPONDENT E-MAIL ADDRESS:

**OFFICE ACTION**

**STRICT DEADLINE TO RESPOND TO THIS LETTER**

**INTERNATIONAL REGISTRATION NO. 1129529**

**STRICT DEADLINE TO RESPOND TO THIS NOTIFICATION:** TO AVOID ABANDONMENT OF THE REQUEST FOR EXTENSION OF PROTECTION OF THE INTERNATIONAL REGISTRATION ABOVE, THE USPTO MUST RECEIVE A COMPLETE RESPONSE TO THIS REFUSAL WITHIN 6 MONTHS OF THE "DATE ON WHICH THE NOTIFICATION WAS SENT TO WIPO (MAILING DATE)" LOCATED ON THE WIPO COVER LETTER ACCOMPANYING THIS NOTIFICATION.

The "Mailing Date" appearing on the WIPO cover letter may also be found through the USPTO's Trademark Status and Document Retrieval (TSDR) system at <http://tsdr.uspto.gov/>. Please enter the U.S. Application Serial Number for this application and select "Documents." The "Mailing Date" is the "Create/Mail Date" of the "IB-1rst Refusal Note."

This is a **PROVISIONAL FULL REFUSAL** of the request for extension of protection of the mark in the above-referenced U.S. application. See 15 U.S.C. §1141h(c).

**WHO IS PERMITTED TO RESPOND TO THIS PROVISIONAL FULL REFUSAL:** Applicant may respond directly to this provisional refusal Office action if applicant is not represented by an authorized attorney. See 37 C.F.R. §2.193(e)(2)(ii). Otherwise, applicant's authorized attorney must respond on applicant's behalf. See 37 C.F.R. §2.193(e)(2)(i). However, **the only attorneys who are authorized to sign responses and practice before the USPTO** in trademark matters are as follows:

- (1) **Attorneys in good standing with a bar of the highest court of any U.S. state**, the District of Columbia, Puerto Rico, and other federal territories and possessions of the United States.
- (2) **Canadian agents/attorneys** who represent applicants located in Canada and (a) are registered with the USPTO and in good standing as patent agents or (b) have been granted reciprocal recognition by the USPTO.

See 37 C.F.R. §§2.17(e), 2.62(b), 11.1, 11.5(b)(2), 11.14(a), (c); TMEP §§602, 712.03.

Foreign attorneys, other than authorized Canadian attorneys, are not permitted to represent applicants before the USPTO. See 37 C.F.R. §§2.17(e), 11.14(c), (e); TMEP §602.03-.03(b). That is, foreign attorneys may not file written communications, authorize an amendment to an application, or submit legal arguments in response to a requirement or refusal, among other things. See 37 C.F.R. §11.5(b)(2); TMEP §§602.03(c), 608.01. If applicant is represented by such a foreign attorney, applicant must respond directly to this provisional refusal Office action. See 37 C.F.R. §2.193(e)(2)(ii).

**DESIGNATION OF DOMESTIC REPRESENTATIVE:** The USPTO encourages applicants who do not reside in the United States to designate a domestic representative upon whom notices or process may be served. 15 U.S.C. §§1051(e), 1141h(d); 37 C.F.R. §2.24(a)(1)-(2); see TMEP §610.01.

## THE APPLICATION HAS BEEN PROVISIONALLY REFUSED AS SPECIFIED BELOW.

The referenced application has been reviewed by the assigned trademark examining attorney. 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.

### SECTION 2(d) REFUSAL – LIKELIHOOD OF CONFUSION

Registration of the applied-for mark is refused because of a likelihood of confusion with the mark in U.S. Registration No. 3352223. Trademark Act Section 2(d), 15 U.S.C. §1052(d); see TMEP §§1207.01 *et seq.* See the enclosed registration.

Trademark Act Section 2(d) bars registration of an applied-for mark that so resembles a registered mark that it is likely that a potential consumer would be confused or mistaken or deceived as to the source of the goods and/or services of the applicant and registrant. See 15 U.S.C. §1052(d). The court in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973) listed the principal factors to be considered when determining whether there is a likelihood of confusion under Section 2(d). See TMEP §1207.01. However, not all of the factors are necessarily relevant or of equal weight, and any one factor may be dominant in a given case, depending upon the evidence of record. *In re Majestic Distilling Co.*, 315 F.3d 1311, 1315, 65 USPQ2d 1201, 1204 (Fed. Cir. 2003); see *In re E. I. du Pont*, 476 F.2d at 1361-62, 177 USPQ at 567.

In this case, the following factors are the most relevant: similarity of the marks, similarity of the goods and/or services, and similarity of trade channels of the goods and/or services. See *In re Opus One, Inc.*, 60 USPQ2d 1812 (TTAB 2001); *In re Dakin's Miniatures Inc.*, 59 USPQ2d 1593 (TTAB 1999); *In re Azteca Rest. Enters., Inc.*, 50 USPQ2d 1209 (TTAB 1999); TMEP §§1207.01 *et seq.*

The registered mark is TOTAL COMPLIANCE NETWORK covering "Administration of employee drug testing programs; developing, implementing, and administering drug policy conformance programs for others; business consultation services in the field of drug policy conformance"; "Reviewing standards and practices of others to ensure conformance with drug policies, laws and regulations"; and "Employee drug testing".

The applicant's mark TOTAL COMPLIANCE and design is similar to the cited mark visually and phonetically, differing primarily by the absence of the disclaimed word "NETWORK" in the cited mark. The mere deletion of wording from a registered mark may not be sufficient to overcome a likelihood of confusion. See *In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257 (Fed. Cir. 2010); *In re Optica Int'l*, 196 USPQ 775, 778 (TTAB 1977); TMEP §1207.01(b)(ii)-(iii). Applicant's mark does not create a distinct commercial impression because it contains the same common wording as registrant's mark, and there is no other wording to distinguish it from registrant's mark.

The addition of a design element to the proposed mark also is insufficient to distinguish the marks. For a composite mark containing both words and a design, the word portion may be more likely to be impressed upon a purchaser's memory and to be used when requesting the goods and/or services. *In re Dakin's Miniatures, Inc.*, 59 USPQ2d 1593, 1596 (TTAB 1999); TMEP §1207.01(c)(ii); see *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908, 1911 (Fed. Cir. 2012) (citing *CBS Inc. v. Morrow*, 708 F.2d 1579, 1581-82, 218 USPQ 198, 200 (Fed. Cir. 1983)). Thus, although such marks must be compared in their entireties, the word portion is often considered the dominant feature and is accorded greater weight in determining whether marks are confusingly similar, even where the word portion has been disclaimed. *In re Viterra Inc.*, 671 F.3d at 1366, 101 USPQ2d at 1911 (Fed. Cir. 2012) (citing *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 1570-71, 218 USPQ2d 390, 395 (Fed. Cir. 1983)).

Moreover, the services of the respective parties are similar in kind and/or closely related. Analyzing the applicant's and registrant's goods and/or services for similarity and relatedness is based on the description of the goods and/or services set forth in the application and registration at issue, not on extrinsic evidence of actual use. See *Octocom Sys. Inc. v. Hous. Computers Servs. Inc.*, 918 F.2d 937, 942, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990); see also *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 1267, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002); *Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp. Inc.*, 648 F.2d 1335, 1337, 209 USPQ 986, 988 (C.C.P.A. 1981).

Absent restrictions in an application and/or registration, the identified goods and/or services are presumed to travel in the same channels of trade to the same class of purchasers. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d 1344, 1356, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011); *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d at 1268, 62 USPQ2d at 1005. Additionally, unrestricted and broad identifications are presumed to encompass all goods and/or services of the type described. See *In re Jump Designs*, 80 USPQ2d 1370, 1374 (TTAB 2006); *In re Linkvest S.A.*, 24 USPQ2d 1716, 1716 (TTAB 1992).

In this case, the identification set forth in the application and registration(s) has no restrictions as to nature, type, channels of trade, or classes of purchasers. Therefore, it is presumed that these goods and/or services travel in all normal channels of trade, and are available to the same class of purchasers. Further, the application uses broad wording to describe the services and this wording is presumed to encompass all goods and/or services of the type described, including those in registrant's more narrow identification.

For instance, applicant's various business, investigation, education and legal services must be presumed to encompass those concerning drug

policies or similar employee policies and compliance and record keeping issues relating thereto. Such services are likely to move in the same channels of trade to the same classes of purchasers as the registrant's services. For example, both the applicant's and registrant's products would likely be marketed to corporations, government agencies and other organizations. The refusal does not encompass those services which lack potential overlap with the cited registration, e.g., services in Classes 36 and 39, gambling services, advertising, etc.

Given the similarities of the marks and services, consumers are likely to conclude that the services are somehow related or emanate from the same source. Accordingly, because confusion is likely, registration is refused under Trademark Act Section 2(d) based on a likelihood of confusion.

Although applicant's mark has been refused registration, applicant may respond to the refusal(s) 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.

#### **DESCRIPTION OF MARK REQUIRED**

Applicant must submit an accurate and concise description of the literal and design elements in the mark. 37 C.F.R. §2.37; *see* TMEP §§808.01, 808.02. The following is suggested, if accurate:

**The mark consists of the wording "TOTAL COMPLIANCE" in stylized font to the right of a design of a circle within a square.**

#### **DISCLAIMER REQUIRED**

Applicant must disclaim the descriptive wording "COMPLIANCE" apart from the mark as shown because it merely describes the purpose or subject matter of the services. *See* 15 U.S.C. §1056(a); TMEP §§1213, 1213.03(a).

A disclaimer does not physically remove the disclaimed matter from the mark, but rather is a written statement that applicant does not claim exclusive rights to the disclaimed wording and/or design separate and apart from the mark as shown in the drawing. TMEP §§1213, 1213.10.

The Office can require an applicant to disclaim an unregistrable part of a mark consisting of particular wording, symbols, numbers, design elements, or combinations thereof. 15 U.S.C. §1056(a). Under Trademark Act Section 2(e), the Office can refuse registration of an entire mark if the entire mark is merely descriptive, deceptively misdescriptive, or primarily geographically descriptive of the goods and/or services. 15 U.S.C. §1052(e). Thus, the Office may require an applicant to disclaim a portion of a mark that, when used in connection with the goods and/or services, is merely descriptive, deceptively misdescriptive, primarily geographically descriptive, or otherwise unregistrable (e.g., generic). *See* TMEP §§1213, 1213.03.

Failure to comply with a disclaimer requirement can result in a refusal to register the entire mark. TMEP §1213.01(b).

In this case, the term "COMPLIANCE" refers to "conformity in fulfilling official requirements" (see attached online dictionary excerpt). Applicant has identified goods/services encompassing those relating to regulatory compliance or other types of compliance. This nature is reflected in the attached excerpt from applicant's website promoting use of applicant's services in achieving compliance efforts. As such, the referenced wording is merely descriptive because it states the nature of some or all of the applicant's services. *See In re Omaha National Corp.*, 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987); *In re Newport Fastener Co. Inc.*, 5 USPQ2d 1064, 1067 n. 4 (TTAB 1987); TMEP §1213.08(c).

A properly worded disclaimer should read as follows:

"No claim is made to the exclusive right to use "COMPLIANCE" apart from the mark as shown."

#### **IDENTIFICATION OF SERVICES**

The identification of services is indefinite and must be clarified. *See* TMEP §1402.01. Applicant must specify the common commercial or generic name for the services as indicated below, along with their subject matter, as warranted. If there is no common commercial or generic name, applicant must describe the service and intended consumer as well as its main purpose and intended uses. In particular:

##### Class 35:

1. "Organisation, operation and supervision of loyalty and incentive schemes" – The purpose and service nature of the services must be clarified within the scope of Class 35, e.g., "organisation, operation and supervision of loyalty and incentive schemes for others for commercial, promotional and/or advertising purposes".
2. "Trade fairs: opinion polling" – The nature of the services must be further clarified within Class 35. e.g., "Conducting, arranging and

organizing trade fairs for commercial and advertising purposes” and “Conducting public opinion polls”.

Class 36:

“Financial, banking and fiduciary services” – The nature of the “financial” and “fiduciary” services is indefinite and must be amended to specify the common commercial name of the individual services, e.g., “Financial advice and consultancy services” or “Fiduciary services, namely, fiduciary representative services”.

Class 39:

Acceptable as written.

Class 41:

1. “Gambling, betting, gaming and casino services, including such services provided on-line” – The nature of the “gaming” services must be clarified, e.g., “Gaming services in the nature of casino gaming”. The Office requires a degree of particularity necessary to identify clearly goods and/or services covered by a mark. See *In re Omega SA*, 494 F.3d 1362, 1365, 83 USPQ2d 1541, 1543-44 (Fed. Cir. 2007). Descriptions of goods and services in applications must be specific, explicit, clear and concise. TMEP §1402.01; see *In re Cardinal Labs., Inc.*, 149 USPQ 709, 711 (TTAB 1966); *Cal. Spray-Chem. Corp. v. Osmose Wood Pres. Co. of Am.*, 102 USPQ 321, 322 (Comm’r Pats. 1954).

2. “Education and training services” – The “education” services must be clarified to identify their format and subject matter. The “training” services must be clarified to indicate their subject matter, e.g., “Educational services, namely, providing (indicate form of educational activity, e.g., classes, seminars, workshops) and training in the field (specify subject matter, e.g., automobile repair, tax preparation)”.

Class 42:

The wording is ambiguous and could encompass services in other classes, e.g., “Storage services for archiving electronic data,” in Class 39. Applicant must clarify the particular services within the scope of Class 42, e.g., “Electronic data storage not relating to telecommunications, namely, recording data for others on optical, digital and magnetic media for electronic storage,” in Class 42.

Class 45:

“Licensing services” – The subject matter of the licensing services must be specified within the scope of Class 45, e.g., “licensing of intellectual property”.

Applicant may adopt the following identification, if accurate:

“Advertising; business management; business administration and business consultancy services; providing office functions; organisation, operation and supervision of loyalty and incentive schemes for others for commercial, promotional and/or advertising purposes; advertising services provided via the Internet; production of television and radio advertisements; accountancy; auctioneering; conducting, arranging and organizing trade fairs for commercial and advertising purposes; conducting public opinion polls; data processing services not relating to telecommunications; provision of business information, not relating to telecommunications; business services namely procuring qualified persons to act as directors for offshore and onshore companies; business consultancy services relating to facilitating the incorporation of offshore and onshore companies; information, advice and consultancy in respect of all the aforementioned services; shareholder record keeping services,” in Class 35.

“Financial advice and consultancy services, banking services and fiduciary services, namely, fiduciary representative services; offshore banking; information, advice and consultancy in respect of all the aforementioned services,” in Class 36.

“Arranging travel visas for persons travelling abroad,” in Class 39.

“Gambling services, betting services, gaming services in the nature of casino gaming and casino services, including such services provided on-line; Educational services, namely, providing (indicate form of educational activity, e.g., classes, seminars, workshops) and training in the field (specify subject matter, e.g., automobile repair, tax preparation); providing information, advice and consultancy in respect of all the aforementioned services,” in Class 41.

“Electronic data storage not relating to telecommunications, namely, recording data for others on optical, digital and magnetic media for electronic storage,” in Class 42.

“Legal services; licensing of intellectual property; detective agency services; providing information, advice and consultancy in

respect of all the aforementioned services,” in Class 45.

Please note that, while the identification of goods/services may be amended to clarify or limit the goods/services, adding to the goods or broadening the scope of the goods/services is not permitted. 37 C.F.R. §2.71(a); TMEP §1402.06. Therefore, applicant may not amend the identification to include goods/services that are not within the scope of the goods/services set forth in the present identification.

Moreover, the international classification of goods and/or services in applications filed under Trademark Act Section 66(a) cannot be changed from the classification given to the goods and/or services by the International Bureau of the World Intellectual Property Organization in the corresponding international registration. TMEP §§1401.03(d), 1401.04 and 1904.02(b).

For assistance with identifying goods and/or services in trademark applications, please see the online searchable Manual of Acceptable Identifications of Goods and Services at <http://tess2.uspto.gov/netathtml/tidm.html>.

If the applicant has any questions or needs assistance in responding to this Office action, please e-mail or telephone the assigned examining attorney.

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**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 Trademark Applications and Registrations Retrieval (TARR) at <http://tarr.uspto.gov/>. Please keep a copy of the complete TARR screen. If TARR shows no change for more than six months, call 1-800-786-9199. For more information on checking status, see <http://www.uspto.gov/trademarks/process/status/>.

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