

To: Parodi, Fernando Diego (dsigalow@addmg.com)
Subject: U.S. TRADEMARK APPLICATION NO. 86475241 - BMC STRATEGIC INNOVATION - 121548
Sent: 3/30/2015 3:28:49 PM
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**UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)
OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION**

U.S. APPLICATION SERIAL NO. 86475241

MARK: BMC STRATEGIC INNOVATION

86475241

CORRESPONDENT ADDRESS:

DAVID L. SIGALOW
ALLEN, DYER, DOPPELT, MILBRATH &
GILCHRI
255 S ORANGE AVE STE 1401
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APPLICANT: Parodi, Fernando Diego

**CORRESPONDENT'S REFERENCE/DOCKET
NO:**

121548

CORRESPONDENT E-MAIL ADDRESS:

dsigalow@addmg.com

OFFICE ACTION

STRICT DEADLINE TO RESPOND TO THIS LETTER

TO AVOID ABANDONMENT OF APPLICANT'S TRADEMARK APPLICATION, THE USPTO MUST RECEIVE APPLICANT'S COMPLETE RESPONSE TO THIS LETTER **WITHIN 6 MONTHS** OF THE ISSUE/MAILING DATE BELOW.

ISSUE/MAILING DATE: 3/30/2015

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(a), 2.65(a); TMEP §§711, 718.03.

Please note that the below disclaimer requirement may be resolved in an expedited manner by contacting the examining attorney.

Disclaimer Requirement

Applicant must disclaim the phrase “STRATEGIC INNOVATION” because it merely describes a key feature or characteristic of applicant’s services, and thus is an unregistrable component of the mark. See 15 U.S.C. §§1052(e)(1), 1056(a); *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 1251, 103 USPQ2d 1753, 1755 (Fed. Cir. 2012) (quoting *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 1173, 71 USPQ2d 1370, 1371 (Fed. Cir. 2004)); TMEP §§1213, 1213.03(a).

In this regard, please see the following attached evidence: (1) examples of third-party registrations and approved pending applications showing descriptive treatment of the same or equivalent wording; (2) dictionary definitions of the terms “strategic” and “innovation”; and (3) pages from applicant’s website. In particular, applicant’s website includes the following description of its mission (bold type added):

We firmly believe **innovation** is truly achieved when it translates into actionable **strategies** and new and long-lasting thinking models. We are proud of our huge capability to translate our sensitivity and creativity into essential value for the business.

Other references on applicant’s website make clear that applicant focuses on strategic marketing – i.e., providing clients with innovative ideas and tools to help their businesses grow. See the references to “**strategic** research,” “cultural interventions to develop in-house knowledge and **innovation** capabilities,” “developing customized and **innovative** tools that challenge the business boundaries to holistically improve the company’s performance,” etc.

An applicant may not claim exclusive rights to terms that others may need to use to describe their goods and/or services in the marketplace. See *Dena Corp. v. Belvedere Int’l, Inc.*, 950 F.2d 1555, 1560, 21 USPQ2d 1047, 1051 (Fed. Cir. 1991); *In re Aug. Storck KG*, 218 USPQ 823, 825 (TTAB 1983). A disclaimer of unregistrable matter does not affect the appearance of the mark; that is, a disclaimer does not physically remove the disclaimed matter from the mark. See *Schwarzkopf v. John H. Breck, Inc.*, 340 F.2d 978, 978, 144 USPQ 433, 433 (C.C.P.A. 1965); TMEP §1213.

If applicant does not provide the required disclaimer, the USPTO may refuse to register the entire mark. See *In re Stereotaxis Inc.*, 429 F.3d 1039, 1040-41, 77 USPQ2d 1087, 1088-89 (Fed. Cir. 2005); TMEP §1213.01(b).

Applicant should submit a disclaimer in the following standardized format:

No claim is made to the exclusive right to use “STRATEGIC INNOVATION” apart from the mark as shown.

For an overview of disclaimers and instructions on how to satisfy this disclaimer requirement online using the Trademark Electronic Application System (TEAS) form, please go to <http://www.uspto.gov/trademarks/law/disclaimer.jsp>.

Search of Office Database – No Conflicting Marks Noted

The trademark examining attorney has searched the Office’s database of registered and pending marks and has found no conflicting marks that would bar registration under Trademark Act Section 2(d). TMEP §704.02; see 15 U.S.C. §1052(d).

If applicant has questions regarding this Office action, please telephone or e-mail the assigned trademark examining attorney. All relevant e-mail communications will be placed in the official application record; however, an e-mail communication will not be accepted as a response to this Office action and will not extend the deadline for filing a proper response. See 37 C.F.R. §§2.62(c), 2.191; TMEP §§304.01-.02, 709.04-.05. Further, although the trademark examining attorney may provide additional explanation pertaining to the refusal(s) and/or requirement(s) in this Office action, the trademark examining attorney may not provide legal advice or statements about applicant’s rights. See TMEP §§705.02, 709.06.

Please note: The above issue may be resolved by an Examiner's Amendment, and applicant is encouraged to telephone or email the examining attorney to expedite processing of this application.

/Elizabeth A. Hughitt/

Examining Attorney
Law Office 111
U.S. Patent and Trademark Office
571 272 9384
beth.hughitt@uspto.gov

TO RESPOND TO THIS LETTER: Go to http://www.uspto.gov/trademarks/teas/response_forms.jsp. Please wait 48-72 hours from the issue/mailing date before using the Trademark Electronic Application System (TEAS), to allow for necessary system updates of the application. For *technical* assistance with online forms, e-mail TEAS@uspto.gov. For questions about the Office action itself, please contact the assigned trademark examining attorney. **E-mail communications will not be accepted as responses to Office actions; therefore, do not respond to this Office action by e-mail.**

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 the Trademark Status and Document Retrieval (TSDR) system at <http://tsdr.uspto.gov/>. Please keep a copy of the TSDR status screen. If the status shows no change for more than six months, contact the Trademark Assistance Center by e-mail at TrademarkAssistanceCenter@uspto.gov or call 1-800-786-9199. For more information on checking status, see <http://www.uspto.gov/trademarks/process/status/>.

TO UPDATE CORRESPONDENCE/E-MAIL ADDRESS: Use the TEAS form at <http://www.uspto.gov/trademarks/teas/correspondence.jsp>.

DESIGN MARK

Serial Number

85356787

Status

REGISTERED

Word Mark

DAVIS STRATEGIC INNOVATIONS

Standard Character Mark

Yes

Registration Number

4102006

Date Registered

2012/02/21

Type of Mark

SERVICE MARK

Register

PRINCIPAL

Mark Drawing Code

(4) STANDARD CHARACTER MARK

Owner

Davis Strategic Innovations Inc CORPORATION ALABAMA 6767 Old Madison Pike, Suite 285 Huntsville ALABAMA 35806

Goods/Services

Class Status -- ACTIVE. IC 042. US 100 101. G & S: Development of new technology for others in the field of software development, data source integration, modeling and simulation technology; Engineering services in the field of aerospace and defense industries; aerospace engineering; mechanical engineering; electrical engineering; computer systems design services; computer systems and telecommunication systems design services; Scientific and technological services, namely, basic and applied scientific research services in the field of national security. First Use: 2006/08/06. First Use In Commerce: 2006/08/06.

Name/Portrait Statement

The name(s), portrait(s), and/or signature(s) shown in the mark identifies Dr. Jim "Davis", whose consent(s) to register is made of record.

Section 2f Statement

Print: Mar 25, 2015

85356787

2(F) ENTIRE MARK

Filing Date

2011/06/27

Examining Attorney

YAO, GRETTA

Attorney of Record

Wendy Peterson



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