

To: Parodi, Fernando Diego (dsigalow@addmg.com)
Subject: U.S. TRADEMARK APPLICATION NO. 86475284 - BMC STRATEGIC INNOVATION - 122574
Sent: 3/30/2015 3:29:29 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. 86475284

MARK: BMC STRATEGIC INNOVATION

86475284

CORRESPONDENT ADDRESS:

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APPLICANT: Parodi, Fernando Diego

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

122574

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.

Identification of Services – Amendment Required

The identification of services in the application currently reads as follows: “Education, coaching and training services related to marketing, advertising, marketing studies, market research, business consulting, professional business consulting, business assistance, business advice and commercial information, business research, commercial assistance and consulting services in the fields of business management, business organization and business direction, commercial business management, brand positioning, providing information in the fields of business innovation process, business management and business opportunities, and business consulting for enterprises and industrial companies.”

This wording must be amended to clarify the nature of the services as follows.

(1) The beginning phrase – “Education, coaching and training services” – is acceptable with regard to the “coaching and training” but indefinite with regard to “education.” Applicant may amend to either of the following two formats to resolve this issue:

Education **services, namely**, coaching and training services related to . . .

Providing educational [specify types of such services – e.g., “workshops, classes and seminars”] as well as coaching and training services, **all** related to . . .

(2) With regard to the remainder of the identification, it appears that applicant attempted to list a number of topics for the educational services using wording that parallels the types of business services identified in applicant’s companion application in Class 35. However, this type of format is not entirely clear with regard to some of the listed topics, due to the fact that the wording appears to be referring not just to business-related topics but to specific types of Class 35 business services. For example, the listing includes “business consulting” – which as written would be understood as indicating that applicant is providing educational coaching and training **about consulting** (as opposed to providing coaching/training concerning the various business topics that applicant also provides consulting services in connection with, as separately listed in Class 35). Similarly, including “providing information in the fields of business innovation process, business management and business opportunities” would, in the context of the overall identification, be understood as indicating that applicant is providing coaching/training services **on the topic of providing information** in those fields.

The examining attorney is unclear as to whether this is what applicant intended by the way in which the topics are listed in the identification. If not, then the examining attorney suggests that the overall format of the identification be amended to more clearly and concisely identify the subject matter of the educational services, such as the following:

Education **services, namely**, coaching and training services related to marketing, advertising, business assistance, management and organization, brand positioning, and business innovation

The examining attorney believes that the above-suggested amendment identifies broad topics that encompass all of the wording in the current identification. If applicant does wish to retain more (or all) of the original longer listing of topics, then applicant may do so, but is strongly encouraged to reformat the reference to “providing information in the fields of business innovation process, business management and business opportunities” to “business information relating to innovation process, management and business opportunities.” In addition, if much or all of the original listing of topics is retained in the amended identification, then the examining attorney suggests that the introduction include the following phrase to clarify that the remainder of the wording is all referring to topics of the educational services:

Education services, namely, coaching and training services **related to the following business topics**:

Finally, please note that an applicant may only amend an identification to clarify or limit the services, but not to add to or broaden the scope of the services. 37 C.F.R. §2.71(a); *see* TMEP §§1402.06 *et seq.*, 1402.07.

Specimens Unacceptable – New Specimen Referencing Class 41 Services Required

The application includes specimens in the nature of pages from applicant’s website. However, the examining attorney was unable to find any reference on the specimens to educational services (including any references to coaching, training, seminars, etc.).

Registration is thus refused because the specimens do not show a direct association between the applied-for mark and the identified services; thus the specimens fail to show the applied-for mark in use in commerce for the Class 41 services identified in the application. Trademark Act

Sections 1 and 45, 15 U.S.C. §§1051, 1127; 37 C.F.R. §§2.34(a)(1)(iv), 2.56(a); TMEP §§904, 904.07(a), 1301.04(f)(ii), (g)(i).

Specimens consisting of advertising or promotional materials generally must show a direct association between the mark and the services for which registration is sought. *See In re Universal Oil Prods. Co.*, 476 F.2d 653, 655, 177 USPQ 456, 457 (C.C.P.A. 1973); *In re HSB Solomon Assocs.*, 102 USPQ2d 1269, 1274 (TTAB 2012); TMEP §1301.04(f)(ii). While the exact nature of the services does not need to be specified in the specimen, there must be something which creates in the mind of the purchaser an association between the mark and the service. *In re Adair*, 45 USPQ2d 1211, 1215 (TTAB 1997) (quoting *In re Johnson Controls Inc.*, 33 USPQ2d 1318, 1320 (TTAB 1994)); *see In re Osmotica Holdings, Corp.*, 95 USPQ2d 1666, 1668 (TTAB 2010).

In the present case, the specimens show the mark and clearly refer to applicant's business-related services (referring to "business growth," "strategic research," "business intelligence," etc.). However, all of the wording on these pages would be understood as referring to Class 35 business services, and not to the separate educational/training/coaching services that have been specifically identified in this application.

An application based on Trademark Act Section 1(a) must include a specimen showing the applied-for mark in use in commerce for each international class of services identified in the application or amendment to allege use. 15 U.S.C. §1051(a)(1); 37 C.F.R. §§2.34(a)(1)(iv), 2.56(a); TMEP §§904, 904.07(a).

Examples of specimens for services include advertising and marketing materials, brochures, photographs of business signage and billboards, and webpages that show the mark used in the actual sale, rendering, or advertising of the services. *See* TMEP §1301.04(a), (h)(iv)(C).

Applicant may respond to this refusal by satisfying one of the following for each applicable international class:

- (1) Submit a different specimen (a verified ["substitute" specimen](#)) that (a) was in actual use in commerce at least as early as the filing date of the application or prior to the filing of an amendment to allege use and (b) shows the mark in actual use in commerce for the services identified in the application or amendment to allege use.
- (2) Amend the filing basis to [intent to use under Section 1\(b\)](#), for which no specimen is required. This option will later necessitate additional fee(s) and filing requirements such as providing a specimen.

For an overview of *both* response options referenced above and instructions on how to satisfy either option online using the Trademark Electronic Application System (TEAS) form, please go to <http://www.uspto.gov/trademarks/law/specimen.jsp>.

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. And as reflected in the identification of services, applicant's coaching/training services are specifically tied to these business topics – thus making the phrase "STRATEGIC INNOVATION" equally descriptive of the Class 35 services in applicant's companion application as well as the Class 41 educational services in this present application.

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.

/Elizabeth A. Hughitt/

Examining Attorney
Law Office 111
U.S. Patent and Trademark Office
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TO RESPOND TO THIS LETTER: Go to http://www.uspto.gov/trademarks/teas/response_forms.jsp. Please wait 48-72 hours from the issue/mailed 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



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