

To: Lerner, Brian D (blerner@californiaimmigration.us)
Subject: U.S. TRADEMARK APPLICATION NO. 87784398 - BDL LAW OFFICES OF BRIAN D. LERNER, - N/A
Sent: 5/24/2018 10:36:00 AM
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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. 87784398**

MARK: BDL LAW OFFICES
OF BRIAN D. LERNER,

87784398

**CORRESPONDENT
ADDRESS:**
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APPLICANT: Lerner, Brian D

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

N/A

**CORRESPONDENT E-MAIL
ADDRESS:**

blerner@californiaimmigration.us

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. A RESPONSE TRANSMITTED THROUGH THE TRADEMARK ELECTRONIC APPLICATION SYSTEM (TEAS) MUST BE RECEIVED BEFORE MIDNIGHT **EASTERN TIME** OF THE LAST DAY OF THE RESPONSE PERIOD.

ISSUE/MAILING DATE: 5/24/2018

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.

SEARCH OF OFFICE'S DATABASE OF MARKS

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).

SUMMARY OF ISSUES:

- Representation of American Flag
- Consent is Required
- Disclaimer is Required
- Entity Designation Requires Clarification
- Description of the Mark and Color Claim Require Amendment

REPRESENTATION OF AMERICAN FLAG

Registration is refused because the applied-for mark includes a representation of the flag of the United States. Trademark Act Section 2(b), 15 U.S.C. §1052(b); *see* TMEP §1204. Trademark Act Section 2(b) bars registration of marks that include the flag, coat of arms, or other insignia of the United States, any state or municipality of the United States, or any foreign nation. TMEP §1204.

The attached evidence from <https://www.britannica.com/topic/flag-of-the-United-States-of-America> shows the flag from the United States. The applied-for mark includes this particular designation. Thus, the applied-for mark includes the actual flag of the United States, in violation of Section 2(b).

Response Options

Applicant may respond to this refusal by submitting a substitute drawing showing the flag deleted from the drawing. *See* TMEP §§807.14(a), 1204.04(b). Deleting this unregistrable matter will only overcome the refusal if it is wholly separable from the applied-for mark and its removal does not materially alter the mark. *See* TMEP §807.14(a). Applicant should not delete any other matter from the mark drawing unless required elsewhere in this Office action.

Applicant must respond to the additional refusal set forth below.

CONSENT IS REQUIRED

Registration is refused because the applied-for mark consists of or comprises a name, portrait, or signature identifying a particular living individual whose written consent to register the mark is not of record. Trademark Act Section 2(c), 15 U.S.C. §1052(c); TMEP §1206; *see In re Nieves & Nieves LLC*, 113 USPQ2d 1639, 1649-50 (TTAB 2015); *In re Hoefflin*, 97 USPQ2d 1174, 1175-76 (TTAB 2010). The application indicates that the name shown in the mark identifies "Brian D. Lerner, whose consent is made of record." However, the consent was not provided and the application was not personally signed by Mr. Lerner (*see* TMEP §611.01(b)), so the consent cannot be presumed. *See* TMEP 1206.04(b).

The refusal under Section 2(c) will be withdrawn if applicant provides the following:

- (1) A written consent, personally signed by the individual whose name, signature, or portrait appears in the mark, authorizing applicant to register the identifying matter as a trademark and/or service mark with the USPTO; for example, an applicant may use, if applicable, the following: “I, Brian D. Lerner, consent to the use and registration of my name as a trademark and/or service mark with the USPTO.”

See TMEP §§813, 813.01(a), 1206.04(a).

Applicant is advised that the written consent must include a statement of the party’s consent to applicant’s registration, and not just the use, of the identifying matter as a trademark. See *Krause v. Krause Publ’ns, Inc.*, 76 USPQ2d 1904, 1912-13 (TTAB 2005); *In re New John Nissen Mannequins*, 227 USPQ 569, 571 (TTAB 1985); TMEP §1206.04(a).

Applicant must respond to the additional requirements set forth below.

DISCLAIMER IS REQUIRED

Applicant must disclaim the wording “LAW OFFICES” in the mark because it merely describes a feature 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. Invivo 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).

As demonstrated by the attached definition from the *Merriam-Webster Dictionary*, a “LAW OFFICE” is “an office maintained by a lawyer or a firm of lawyers for the practice of law. As demonstrated by applicant’s identification of services, applicant provides legal services in the field of Immigration Law. Thus, this wording merely describes a feature of applicant’s services.

Additionally, applicant must disclaim the wording “A PROFESSIONAL CORPORATION” because it designates the legal character or business structure of an entity and does not indicate the source of applicant’s services; thus, it is an unregistrable component of the mark. See 15 U.S.C. §§1051-1053, 1056(a), 1127; *In re Piano Factory Grp., Inc.*, 85 USPQ2d 1522, 1526 (TTAB 2006); *In re Patent & Trademark Servs., Inc.*, 49 USPQ2d 1537, 1539-40 (TTAB 1998); TMEP §1213.03(d).

Business type designations and abbreviations such as “Corporation,” “Inc.,” “Company,” “LLC,” and “Ltd.” must be disclaimed, because they merely indicate applicant’s business type or structure and generally have no source-indicating capacity. TMEP §1213.03(d); see, e.g., *Goodyear’s India Rubber Glove Mfg. Co. v. Goodyear Rubber Co.*, 128 U.S. 598, 602-03 (1888); *In re Piano Factory Grp., Inc.*, 85 USPQ2d at 1526; *In re Patent & Trademark Servs., Inc.*, 49 USPQ2d at 1539-40.

An applicant may not claim exclusive rights to an unregistrable component of a mark, such as matter that designates an applicant’s business type or structure. See 15 U.S.C. §1056(a); TMEP §1213.03(a), (b), (d). 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 “LAW OFFICES” and “A PROFESSIONAL CORPORATION” 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>.

Applicant must respond to the additional requirements set forth below.

ENTITY DESIGNATION REQUIRES CLARIFICATION

The name of an individual person appears in the section of the application intended for the trademark owner's name; however, the legal entity is set forth as a corporation. Applicant must clarify this inconsistency. TMEP §803.02(a); *see* 37 C.F.R. §§2.32(a)(2), (a)(3)(i)-(ii), 2.61(b).

If applicant is an individual, applicant must request that the legal entity be amended to "individual" and must indicate his or her country of citizenship. *See* TMEP §803.03(a). Alternatively, if applicant is a corporation, applicant must provide the legal name of the corporation and U.S. state or foreign country of incorporation or organization. *See* TMEP §803.03(c).

If, in response to the above request, applicant provides information indicating that it is not the owner of the mark, registration will be refused because the application was void as filed. *See* 37 C.F.R. §2.71(d); TMEP §§803.06, 1201.02(b). An application must be filed by the party who owns or is entitled to use the mark as of the application filing date. *See* 37 C.F.R. §2.71(d); TMEP §1201.02(b).

Applicant must respond to the additional requirements set forth below.

DESCRIPTION OF THE MARK AND COLOR CLAIM REQUIRE AMENDMENT

The applicant must submit a clear, comprehensive, accurate, and concise description of all elements in the mark, including the location of all colors claimed in the mark. 37 C.F.R. §2.37; *see* TMEP §§808.01, 808.02. Based on the current drawing of record, the following is suggested:

- Color Claim: **The colors red, white, blue, orange and gray are claimed as a feature of the mark.**
- Description of the Mark: **The mark consists of the initials "BDL" in shades of gray on top of an American flag with white stars on a blue background, red and white stripes and an orange stripe at the bottom of the flag. The wording "LAW OFFICES OF BRIAN D. LERNER A PROFESSIONAL CORPORATION" appear in white to the right of the flag. The initials, wording and flag are all on a rectangular background in shades of gray representing marbling.**

NOTE: If applicant amends the drawing to remove the American flag in response to the refusal under Trademark Action Section 2(b) set forth above, the following amended color claim and description of the mark are suggested, if accurate:

- Color Claim: **The colors gray and white are claimed as a feature of the mark.**
- Description of the Mark: **The mark consists of the initials "BDL" in shades of gray next to the wording "LAW OFFICES OF BRIAN D. LERNER A PROFESSIONAL CORPORATION" in white. The initials and wording are on a rectangular background in shades of gray representing marbling.**

RESPONDING TO THE OFFICE ACTION

For this application to proceed further, applicant must explicitly address each refusal and/or requirement raised in this Office action. If the action includes a refusal, applicant may provide arguments and/or evidence as to why the refusal should be withdrawn and the mark should register. Applicant may also have other options specified in this Office action for responding to a refusal and should consider those options carefully. To respond to requirements and certain refusal response options, applicant should set forth in writing the required changes or statements. For more information and general tips on responding to USPTO Office actions, response options, and how to file a response online, see "[Responding to Office Actions](#)" on the USPTO's website.

If applicant does not respond to this Office action within six months of the issue/ mailing date, or responds by expressly abandoning the application, the application process will end and the trademark will fail to register. *See* 15 U.S.C. §1062(b); 37 C.F.R. §§2.65(a), 2.68(a); TMEP §§718.01, 718.02. Additionally, the USPTO will not refund the application filing fee, which is a required processing fee. *See* 37 C.F.R. §§2.6(a)(1)(i)-(iv), 2.209(a); TMEP §405.04.

When an application has abandoned for failure to respond to an Office action, an applicant may timely file a petition to revive the application, which, if granted, would allow the application to return to active status. *See* 37 C.F.R. §2.66; TMEP §1714. The petition must be filed within two months of the date of issuance of the notice of abandonment and [may be filed online via the Trademark Electronic Application System](#).

(TEAS) with a \$100 fee. See 37 C.F.R. §§2.6(a)(15)(ii), 2.66(a)(1), (b)(1).

TEAS PLUS OR TEAS REDUCED FEE (TEAS RF) APPLICANTS – TO MAINTAIN LOWER FEE, ADDITIONAL REQUIREMENTS MUST BE MET, INCLUDING SUBMITTING DOCUMENTS ONLINE: Applicants who filed their application online using the lower-fee TEAS Plus or TEAS RF application form must (1) file certain documents online using TEAS, including responses to Office actions (see TMEP §§819.02(b), 820.02(b) for a complete list of these documents); (2) maintain a valid e-mail correspondence address; and (3) agree to receive correspondence from the USPTO by e-mail throughout the prosecution of the application. See 37 C.F.R. §§2.22(b), 2.23(b); TMEP §§819, 820. TEAS Plus or TEAS RF applicants who do not meet these requirements must submit an additional processing fee of \$125 per class of goods and/or services. 37 C.F.R. §§2.6(a)(1)(v), 2.22(c), 2.23(c); TMEP §§819.04, 820.04. However, in certain situations, TEAS Plus or TEAS RF applicants may respond to an Office action by authorizing an examiner’s amendment by telephone or e-mail without incurring this additional fee.

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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/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/>.

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