

# NOTE TO THE FILE

SERIAL NUMBER: 88291615

DATE: 04/23/2019

NAME: jgagliardi

## NOTE:

### Searched:

☐ Google  
☐ Lexis/Nexis  
☐ OneLook  
☐ Wikipedia  
☐ Acronym Finder ☐ Protest evidence reviewed  
☐ Other:

### Checked:

☐ Geographic significance  
☐ Surname  
☐ Translation  
☐ ID with ID/CLASS mailbox

☐ Checked list of approved Canadian attorneys and agents

### Discussed file with

#### Attorney/Applicant via:

☐ phone ☐ Left message with Attorney/Applicant  
☒ email  
☐ Requested Law Library search for: ☒ Issued Examiner's Amendment and entered changes in TRADEUPS  
☐ **PRINT** ☐ **DO NOT PRINT** ☐ Added design code in TRADEUPS  
☐ Description of the mark ☐ Re-imaged standard character drawing  
☐ Translation statement ☐ Negative translation statement  
☐ Consent of living individual ☐ Contacted TM MADRID ID/CLASS about misclassified definite ID  
☐ Changed TRADEUPS to:  
☐ OTHER:

**From:** Cohen, Adam [mailto:Acohen@beckerlawyers.com]

**Sent:** Friday, April 19, 2019 12:55 PM

**To:** Gagliardi, Jeanine <Jeanine.Gagliardi@USPTO.GOV>; Cohen, Adam <Acohen@beckerlawyers.com>

**Cc:** Cohen, Adam <Acohen@beckerlawyers.com>; Matlock, Mark <MMatlock@beckerlawyers.com>; Farkas, Rachel <RFarkas@beckerlawyers.com>

**Subject:** RE: U.S. Trademark Application for BRAND LOBBYING (Serial No. 88291615) - clarification of applicant's entity type, disclaimer, amended identification of services

Jeanine:

Thank you very much for the email below. As a preliminary response, please see my comments to your email below in **RED**.  
Adam

**From:** Gagliardi, Jeanine [<mailto:Jeanine.Gagliardi@USPTO.GOV>]

**Sent:** Friday, April 19, 2019 9:25 AM

**To:** [acohen@beckerlawyers.com](mailto:acohen@beckerlawyers.com)

**Subject:** U.S. Trademark Application for BRAND LOBBYING (Serial No. 88291615) - clarification of applicant's entity type, disclaimer, amended identification of services

Dear Counsel,

I am examining the above-referenced trademark application. There are several issues, and I am writing to see if we can resolve them by agreement.

- (1) The applicant's name includes the designation "P.A.," but the entity type is set forth is a corporation. "P.A." generally identifies a professional association rather than a corporation. This inconsistency must be clarified. If the applicant is a professional association, I can amend the entity type if you would let me know whether it is incorporated or unincorporated and provide its state of organization. If the applicant is a corporation, please confirm that, in this case, corporation is the correct entity type.

The application is a professional services corporation. PLEASE SEE Section 621.12 of the Florida Statutes (emphasis added) which reads as follows:

**621.12 Identification with individual shareholders or individual members.—**

(1) The name of a corporation or limited liability company organized under this act may contain the last names of some or all of the individual shareholders or individual members and may contain the last names of retired or deceased former individual shareholders or individual members of the corporation, limited liability company, a predecessor corporation or limited liability company, or partnership.

(2) The name shall also contain:

- (a) The word "chartered"; or
- (b)

*1. In the case of a professional corporation, the words "professional association" or the abbreviation "P.A."; or*

*2. In the case of a professional limited liability company formed before January 1, 2014, the words "professional limited company" or "professional limited liability company," the abbreviation "P.L." or "P.L.L.C." or the designation "PL" or "PLLC," in lieu of the words "limited company" or "limited liability company," or the abbreviation "L.C." or "L.L.C." or the designation "LC" or "LLC" as otherwise required under s. 605.0112 or former s. 608.406.*

*3. In the case of a professional limited liability company formed on or after January 1, 2014, the words "professional limited liability company," the abbreviation "P.L.L.C." or the designation "PLLC," in lieu of the words "limited liability company," or the abbreviation "L.L.C." or the designation "LLC" as otherwise required under s. 605.0112.*

(3) In the case of a corporation, the use of the word "company," "corporation," or "incorporated" or any other word, abbreviation, affix, or prefix indicating that it is a corporation in the corporate name of a corporation organized under this act, other than the word "chartered" or the words "professional association" or the abbreviation "P.A.," is specifically prohibited.

(4) It shall be permissible, however, for the corporation or limited liability company to render professional services and to exercise its authorized powers under a name which is identical to its name or contains any one or more of the last names of any shareholder or member included in such name except that the word "chartered," the words "professional association," "professional limited company," or "professional limited liability company," the abbreviations "P.A.," "P.L.," or "P.L.L.C.," or the designation "PL" or "PLLC" may be omitted, provided that the corporation or limited liability company has first registered the name to be so used in the manner required for the registration of fictitious names."

- (2) The application includes a disclaimer of all of the wording in the mark. However, an entire mark may not be disclaimed. The wording LOBBYING must be disclaimed for lobbying services, but the wording BRAND does not appear to be descriptive of lobbying services. Accordingly, I would propose amending the disclaimer such that it is limited to LOBBYING.

Agreed. Thank you for your input.

- (3) The classification and identification of services must be amended. The classification and identification in the application are:

Class 045: Providing legal and advocacy lobbying services at the local, state and federal levels of government

The identification is overbroad because lobbying services are properly classified in International Class 035, and it is indefinite

because it does not specify the subject matter of the services.

I would propose the following amended identification (**changes in bold**):

**Class 035: Lobbying services, namely, promoting the interests of {indicate specific group, e.g., international businesses, real estate companies, nonprofit companies, etc.} at the local, state and federal levels of government in the fields of politics, legislation, and regulation**

Agreed.

Since the client provides lobbying services for a variety of client, we suggest using the following:

Class 035: Lobbying services, namely, promoting the interests of natural persons, partnerships, domestic or foreign limited partnerships, domestic or foreign limited liability companies, domestic or foreign corporations, trusts, estates, associations or other similar business entities at the local, state and federal levels of government in the fields of politics, legislation, and regulation.

Would you advise regarding the applicant's entity type and let me know if you agree to entry of the amended disclaimer and amended identification of services? If we are able to agree to amendments that resolve these issues by the end of the day on Wednesday, April 24, I can make the changes on my end so the application can proceed.

I look forward to hearing from you.

Very truly yours,  
Jeanine