

## Response to Office Action

**The table below presents the data as entered.**

Input Field	Entered
<b>SERIAL NUMBER</b>	90131990
<b>LAW OFFICE ASSIGNED</b>	LAW OFFICE 107
<b>MARK SECTION (current)</b>	
<b>MARK FILE NAME</b>	<a href="https://tmng-al.uspto.gov/resting2/api/img/90131990/large">https://tmng-al.uspto.gov/resting2/api/img/90131990/large</a>
<b>LITERAL ELEMENT</b>	MISSOURI WOODWORKS
<b>STANDARD CHARACTERS</b>	NO
<b>USPTO-GENERATED IMAGE</b>	NO
<b>DESCRIPTION OF THE MARK (and Color Location, if applicable)</b>	The mark consists of a circular design around the state of Missouri. Above and following the circular design is the wording "MISSOURI WOODWORKS" in stylized lettering.
<b>MARK SECTION (proposed)</b>	
<b>MARK FILE NAME</b>	<a href="\\TICRS\EXPORT18\IMAGEOUT 18\901\319\90131990\xml6\ ROA0002.JPG">\\TICRS\EXPORT18\IMAGEOUT 18\901\319\90131990\xml6\ ROA0002.JPG</a>
<b>LITERAL ELEMENT</b>	MISSOURI WOODWORKS
<b>STANDARD CHARACTERS</b>	NO
<b>USPTO-GENERATED IMAGE</b>	NO
<b>COLOR MARK</b>	NO
<b>DESCRIPTION OF THE MARK (and Color Location, if applicable)</b>	The mark consists of a circular design consisting of two concentric circles around the state of Missouri and featuring a stylized background consisting of wood grain. Above the circular design is the wording "MISSOURI WOODWORKS" in stylized lettering.
<b>PIXEL COUNT ACCEPTABLE</b>	YES
<b>PIXEL COUNT</b>	864 x 864
<b>ARGUMENT(S)</b>	
Please refer to the Evidence section for Argument.	
<b>EVIDENCE SECTION</b>	
<b>EVIDENCE FILE NAME(S)</b>	
<b>ORIGINAL PDF FILE</b>	<a href="#">evi_75166176254-202105281_50312505775 . OARESP - Response to Office Action MISSOURI WOODWORKS.pdf</a>
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<b>DESCRIPTION OF EVIDENCE FILE</b>	Office Action Response and Supporting Exhibits 1 and 2
<b>ADDITIONAL STATEMENTS SECTION</b>	
<b>DISCLAIMER</b>	No claim is made to the exclusive right to use the outline of the state of Missouri and "MISSOURI WOODWORKS" apart from the mark as shown.
<b>ATTORNEY INFORMATION (current)</b>	
<b>NAME</b>	Janet Moreira
<b>ATTORNEY BAR MEMBERSHIP NUMBER</b>	XXX
<b>YEAR OF ADMISSION</b>	XXXX
<b>U.S. STATE/ COMMONWEALTH/ TERRITORY</b>	XX

<b>FIRM NAME</b>	MAVEN IP
<b>INTERNAL ADDRESS</b>	SUITE 65
<b>STREET</b>	9480 N.E. 2ND AVENUE
<b>CITY</b>	MIAMI SHORES
<b>STATE</b>	Florida
<b>POSTAL CODE</b>	33138
<b>COUNTRY/REGION/JURISDICTION/U.S. TERRITORY</b>	United States
<b>PHONE</b>	305-967-7450
<b>FAX</b>	305-967-7450
<b>EMAIL</b>	janet@mavenip.com
<b>ATTORNEY INFORMATION (proposed)</b>	
<b>NAME</b>	Janet Moreira
<b>ATTORNEY BAR MEMBERSHIP NUMBER</b>	XXX
<b>YEAR OF ADMISSION</b>	XXXX
<b>U.S. STATE/ COMMONWEALTH/ TERRITORY</b>	XX
<b>FIRM NAME</b>	MAVEN IP
<b>INTERNAL ADDRESS</b>	Ste. 65
<b>STREET</b>	9480 N.E. 2nd Avenue
<b>CITY</b>	Miami Shores
<b>STATE</b>	Florida
<b>POSTAL CODE</b>	33138
<b>COUNTRY/REGION/JURISDICTION/U.S. TERRITORY</b>	United States
<b>PHONE</b>	305-967-7450
<b>FAX</b>	305-967-7450
<b>EMAIL</b>	janet@mavenip.com
<b>OTHER APPOINTED ATTORNEY</b>	Gabriele Fougner
<b>CORRESPONDENCE INFORMATION (current)</b>	
<b>NAME</b>	JANET MOREIRA
<b>PRIMARY EMAIL ADDRESS FOR CORRESPONDENCE</b>	janet@mavenip.com
<b>SECONDARY EMAIL ADDRESS(ES) (COURTESY COPIES)</b>	trademarks@mavenip.com; barby@mavenip.com; christine@mavenip.com
<b>CORRESPONDENCE INFORMATION (proposed)</b>	
<b>NAME</b>	Janet Moreira
<b>PRIMARY EMAIL ADDRESS FOR CORRESPONDENCE</b>	janet@mavenip.com
<b>SECONDARY EMAIL ADDRESS(ES) (COURTESY COPIES)</b>	trademarks@mavenip.com; USPTO@dockettrak.com; gabriele@mavenip.com; juliana@mavenip.com
<b>SIGNATURE SECTION</b>	
<b>RESPONSE SIGNATURE</b>	/Janet Moreira/
<b>SIGNATORY'S NAME</b>	Janet Moreira

<b>SIGNATORY'S POSITION</b>	Attorney of record, Florida bar member
<b>SIGNATORY'S PHONE NUMBER</b>	3059677450
<b>DATE SIGNED</b>	05/28/2021
<b>ROLE OF AUTHORIZED SIGNATORY</b>	Authorized U.S.-Licensed Attorney
<b>SIGNATURE METHOD</b>	Sent to third party for signature
<b>FILING INFORMATION SECTION</b>	
<b>SUBMIT DATE</b>	Fri May 28 16:52:10 ET 2021
<b>TEAS STAMP</b>	USPTO/ROA-XX.XXX.XXX.XXX- 20210528165210734011-9013 1990-7808538223c76d23db87 ea678e1ebc5560aa2e8cbbda4 bb2c05377668ec7bf6d-N/A- N/A-20210528150312505775

PTO- 1957  
Approved for use through 11/30/2023. OMB 0651-0050  
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE  
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it contains a valid OMB control number

## Response to Office Action

### To the Commissioner for Trademarks:

Application serial no. **90131990** MISSOURI WOODWORKS (Stylized and/or with Design, see <https://tmng-al.uspto.gov/resting2/api/img/90131990/large>) has been amended as follows:

#### MARK

**Applicant proposes to amend the mark as follows:**

**Current:** MISSOURI WOODWORKS (Stylized and/or with Design, see <https://tmng-al.uspto.gov/resting2/api/img/90131990/large>)

**Proposed:** MISSOURI WOODWORKS (Stylized and/or with Design, see [mark](#))

The applicant is not claiming color as a feature of the mark.

The mark consists of a circular design consisting of two concentric circles around the state of Missouri and featuring a stylized background consisting of wood grain. Above the circular design is the wording "MISSOURI WOODWORKS" in stylized lettering.

#### ARGUMENT(S)

**In response to the substantive refusal(s), please note the following:**

Please refer to the Evidence section for Argument.

#### EVIDENCE

Evidence has been attached: Office Action Response and Supporting Exhibits 1 and 2

**Original PDF file:**

[evi\\_75166176254-202105281\\_50312505775\\_-\\_OARESP\\_-\\_Re\\_sponse\\_to\\_Office\\_Action\\_MISSOURI\\_WOODWORKS.pdf](#)

**Converted PDF file(s)** ( 14 pages) [Evidence-1Evidence-2Evidence-3Evidence-4Evidence-5Evidence-6Evidence-7Evidence-8Evidence-9Evidence-10Evidence-11Evidence-12Evidence-13Evidence-14](#)

**Original PDF file:**

[evi\\_75166176254-202105281\\_50312505775\\_-\\_Exhibit\\_1.pdf](#)

**Converted PDF file(s)** ( 3 pages) [Evidence-1Evidence-2Evidence-3](#)

**Original PDF file:**

[evi\\_75166176254-202105281\\_50312505775\\_-\\_Exhibit\\_2.pdf](#)

**Converted PDF file(s)** ( 12 pages) [Evidence-1Evidence-2Evidence-3Evidence-4Evidence-5Evidence-6Evidence-7Evidence-8Evidence-9Evidence-10Evidence-11Evidence-12](#)

#### ADDITIONAL STATEMENTS



**Disclaimer**

No claim is made to the exclusive right to use the outline of the state of Missouri and "MISSOURI WOODWORKS" apart from the mark as shown.

The owner's/holder's current attorney information: Janet Moreira. Janet Moreira of MAVEN IP, is a member of the XX bar, admitted to the bar in XXXX, bar membership no. XXX, is located at

SUITE 65  
9480 N.E. 2ND AVENUE  
MIAMI SHORES, Florida 33138  
United States  
The phone number is 305-967-7450.  
The fax number is 305-967-7450.  
The email address is janet@mavenip.com

The owner's/holder's proposed attorney information: Janet Moreira. Other appointed attorneys are Gabriele Fougner. Janet Moreira of MAVEN IP, is a member of the XX bar, admitted to the bar in XXXX, bar membership no. XXX, and the attorney(s) is located at

Ste. 65  
9480 N.E. 2nd Avenue  
Miami Shores, Florida 33138  
United States  
The phone number is 305-967-7450.  
The fax number is 305-967-7450.  
The email address is janet@mavenip.com

Janet Moreira submitted the following statement: The attorney of record is an active member in good standing of the bar of the highest court of a U.S. state, the District of Columbia, or any U.S. Commonwealth or territory.

**Correspondence Information (current):**

JANET MOREIRA  
PRIMARY EMAIL FOR CORRESPONDENCE: janet@mavenip.com  
SECONDARY EMAIL ADDRESS(ES) (COURTESY COPIES): trademarks@mavenip.com; barby@mavenip.com; christine@mavenip.com

**Correspondence Information (proposed):**

Janet Moreira  
PRIMARY EMAIL FOR CORRESPONDENCE: janet@mavenip.com  
SECONDARY EMAIL ADDRESS(ES) (COURTESY COPIES): trademarks@mavenip.com; USPTO@dockettrak.com;  
gabriele@mavenip.com; juliana@mavenip.com

**Requirement for Email and Electronic Filing:** I understand that a valid email address must be maintained by the owner/holder and the owner's/holder's attorney, if appointed, and that all official trademark correspondence must be submitted via the Trademark Electronic Application System (TEAS).

**SIGNATURE(S)****Response Signature**

Signature: /Janet Moreira/ Date: 05/28/2021  
Signatory's Name: Janet Moreira  
Signatory's Position: Attorney of record, Florida bar member

Signatory's Phone Number: 3059677450 Signature method: Sent to third party for signature

The signatory has confirmed that he/she is a U.S.-licensed attorney who is an active member in good standing of the bar of the highest court of a U.S. state (including the District of Columbia and any U.S. Commonwealth or territory); and he/she is currently the owner's/holder's attorney or an associate thereof; and to the best of his/her knowledge, if prior to his/her appointment another U.S.-licensed attorney not currently associated with his/her company/firm previously represented the owner/holder in this matter: the owner/holder has revoked their power of attorney by a signed revocation or substitute power of attorney with the USPTO; the USPTO has granted that attorney's withdrawal request; the owner/holder has filed a power of attorney appointing him/her in this matter; or the owner's/holder's appointed U.S.-licensed attorney has filed a power of attorney appointing him/her as an associate attorney in this matter.

Mailing Address: JANET MOREIRA  
MAVEN IP  
SUITE 65  
9480 N.E. 2ND AVENUE  
MIAMI SHORES, Florida 33138

Mailing Address: Janet Moreira  
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9480 N.E. 2nd Avenue  
Miami Shores, Florida 33138

Serial Number: 90131990

Internet Transmission Date: Fri May 28 16:52:10 ET 2021

TEAS Stamp: USPTO/ROA-XX.XXX.XXX.XXX-202105281652107

34011-90131990-7808538223c76d23db87ea678

e1ebc5560aa2e8cbbda4bb2c05377668ec7bfb6d

-N/A-N/A-20210528150312505775



**Trademarks**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant: MindBomb LLC



Mark:  
Serial No. 90131990  
Trademark  
Examining Attorney: Jimmy Stein  
Law Office: 107

**Response to Office Action**

Applicant MindBomb, LLC (“Applicant”) hereby responds to the Office Action dated December 21, 2020 issued by the United States Patent and Trademark Office (“USPTO”). The USPTO has initially refused to register Applicant’s mark, **MISSOURI WOODWORKS & Design**, subject of Application Serial No. 90131990 (sometimes referred to as “Applicant’s Mark”), on the following bases: (i) Specimen Refusal; (ii) Disclaimer Requirement; and (iii) Mark Description Requirement.

Applicant’s Mark was filed in connection with the following goods/services:

Class 021: Cheese boards; Cutting boards; Cutting boards for the kitchen; Lazy susans; Serving trays.

**I. AMENDMENT**

**A. Mark Description**

Applicant hereby amends its mark description as follows:

## Trademarks

The mark consists of a circular design **consisting of two concentric circles** around the state of Missouri **and featuring a stylized background consisting of wood grain**. Above the circular design is the wording "MISSOURI WOODWORKS" in stylized lettering.

### **B. Disclaimer**

Applicant hereby submits the following disclaimer:

No claim is made to the exclusive right to use the outline of the state of Missouri and "MISSOURI WOODWORKS" apart from the mark as shown.

## **II. RESPONSE**

### **A. Specimen Refusal**

The USPTO has refused Applicant's Mark on the basis that the mark shown on the drawing does not match the mark on the specimen submitted and cites TMEP § 801.12(a). The USPTO argues that the specimen displays the mark as MISSOURI WOODWORKS AN INNOVATIVE CUSTOM WORKSHOP (& Design) and the drawing displays the mark as MISSOURI WOODWORKS (& Design). In its application dated August 24, 2020, Applicant submitted the following drawing:



The mark displayed on the specimen, submitted in support of Applicant's application, is:

## Trademarks



and

The legal standard for evaluating whether a drawing matches a specimen is established in Section 2.51(a) of the Rules of Practice in Trademark Cases, authorized by 15 U.S. Code § 1123, which provides as follows:

In an application under section 1(a) of the Act, the drawing of the mark must be *a substantially exact representation* of the mark as used on or in connection with the goods and/or services.



(emphasis added).

“[T]he determination of whether a mark shown in the drawing is a substantially exact representation of the mark shown on the specimen is ‘*assuredly a subjective one.*’” *In re wTe Corp.*, 87 USPQ2d 1536, 1539 (TTAB 2008) (quoting *In re R.J. Reynolds Tobacco Co.*, 222 USPQ 552, 552 (TTAB 1984)) [precedential] (emphasis added). Indeed, “each case presents its own unique circumstances and requires a judgment as to that particular designation.” *In re 1175856 Ontario Ltd.*, 81 USPQ2d 1146, 1448 (TTAB 2006) [precedential].

An applicant has some latitude in selecting the mark it wants to register. TMEP §807.12(d); *In re 1175856 Ontario Ltd.*, 81 USPQ2d at 1448. It is well-settled that an applicant may seek to register any portion of a composite mark if that portion presents a separate and distinct


**Trademarks**

commercial impression that indicates source of the applicant’s goods/services and distinguishes them from the goods/services of others. *In re Chem. Dynamics Inc.*, 839 F.2d 1569, 5 USPQ2d 1828, 1829 (Fed. Cir. 1988). If the portion of the mark sought to be registered does not create a separate and distinct commercial impression, the result is an impermissible mutilation of the mark as used. *See In Re University of Miami*, 123 USPQ2d 1075 (TTAB 2017) [precedential] (the Board found that despite the appearance of the text, “the overall display on the specimens creates the separate and distinct commercial impression of a personified ibis). **See the following summary of cases where the TTAB reversed the USPTO’s refusals that the specimens were not substantially exact representations of application drawings and finding instead, that the specimens were acceptable.**

<b><u>Case</u></b>	<b><u>Drawing</u></b>	<b><u>Specimen</u></b>
<p><i>In Re University of Miami</i>, 123 USPQ2d 1075 (TTAB 2017) [precedential]</p>		



## Trademarks

<i>In re TBL Licensing LLC</i> , Serial No. 86684964 (TTAB September 25, 2017) [non-precedential] <sup>1</sup>		
<i>In re 1175856 Ontario Ltd.</i> , 81 USPQ2d 1146, 1448 (TTAB 2006) [precedential]		

<sup>1</sup> TMEP §705.05 states:

Prior to December 27, 2006, it was the policy of the Trademark Trial and Appeal Board that Board opinions not designated as precedential should not be cited and, if cited, were to be disregarded. *Gen. Mills Inc. v. Health Valley Foods*, 24 USPQ2d 1270, 1275 n.9 (TTAB 1992). **The Board has changed that policy.** In announcing the change, the Board stated that:

[T]he Board will henceforth permit citation to **any** TTAB disposition as follows:

The TTAB will continue its current practice of designating all final decisions as either precedential or not precedential. Unless specifically designated as precedential, an order on a motion should be considered not precedential.

The TTAB will continue its practice of considering precedential decisions as binding upon the TTAB.



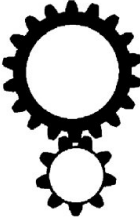





A decision designated as not precedential is not binding upon the TTAB but **may be cited for whatever persuasive value it might have.**

Citation to all TTAB decisions should be to the United States Patent Quarterly, if the decision appears therein; otherwise, to a USPTO public electronic database. If a non-precedential decision does not appear in the United States Patent Quarterly or the USPTO's public electronic databases, the citing party should append a copy of the decision to the motion or brief in which the decision is cited.

Decisions of other tribunals may be cited to the extent allowed and for the purposes permitted by the tribunal that issued the decision.



**Trademarks**

<p><i>In re Karsten Mfg. Corp.</i>, Serial No. 78347910 (TTAB 2005)<sup>2</sup></p>		
<p><i>In re Nat'l Inst. for Auto. Serv. Excellence</i>, 218 USPQ 744, 745 (TTAB 1983) [non-precedential]<sup>3</sup></p>		
<p><i>In re Schecter Bros. Modular Corp.</i> 182 USPQ 694, 695 (TTAB 1974)<sup>4</sup></p>		
<p><i>In re Sterno, Inc.</i>, 137 USPQ 328 (TTAB 1963) [non-precedential]<sup>5</sup></p>		

<sup>2</sup> In *Karsten*, the Board permitted registration of the mark as shown on the left, where the submitted specimen and actual use shown on the right contained overlaid word elements “G2” and “PING”.

<sup>3</sup> In *Auto*, the Board found the design of meshed gears "is distinctive in nature" and "creates a commercial impression separate and apart from the words superimposed thereon".

<sup>4</sup> In *Schecter*, the Board found that where specimens show mark consisting in part of "RAINAIRE" together with its shadow image, it is not a mutilation of mark to delete shadow image from drawing **since "RAINAIRE" creates the essential impression.**

<sup>5</sup> In *Sterno*, the Board found that the design of a bear with a can or container around its torso was separate from the word “STERNO” appearing on the label of the container.

## Trademarks

<i>In re Dempster Brothers, Inc.</i> , 132 USPQ 300 (TTAB 1961) [non-precedential]	DUMPMAS <sup>T</sup> ER	
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There are several cases that have come to this determination, especially as to composite marks, however no images exist to show the differences. See *In re Servel, Inc.*, 181 F.2d 192, 85 USPQ 257, 260 (CCPA 1950) (refusal to register the mark SERVEL as a mutilation of “SERVEL INKLINGS” **reversed**, where the specimen **displays an insignia between the words** “SERVEL” and “INKLINGS”) [precedential]; *In re Raychem Corp.*, 12 USPQ2d 1399, 1400 (TTAB 1989) (reversing the refusal to register TINEL-LOCK as mutilation of mark "TRO6AI-TINEL-LOCK-RING," noting that part or stock number does not usually function as a source identifier, and **the “fact that hyphens connect both the part number and the generic term to the mark does not, under the circumstances presented in this case, create a unitary expression such that ‘TINEL-LOCK’ has no significance by itself as a trademark.**”) [non-precedential]; *In re Sansui Electric Co., Ltd.*, 194 USPQ 202 (TTAB 1977) (Board allowed registration of QSE and QSD; specimens showed use as QSE-4 and QSD-4) [non-precedential].

Applicant submits that (1) MISSOURI WOODWORKS & Design is a trademark; and (2) that the MISSOURI WOODWORKS & Design mark is a separate and distinct mark without the wording AN INNOVATIVE CUSTOM WORKSHOP. Simply because Applicant sometimes includes the language AN INNOVATIVE, CUSTOM WORKSHOP and sometimes it does not, does not diminish Applicant’s Mark as a trademark, capable of distinguishing Applicant’s goods/services from others. In fact, unlike the many examples referenced above, the wording that is excluded from Applicant’s drawing is not intricately connected to the MISSOURI

## **Trademarks**

WOODWORKS & Design mark. The specimen is a substantially exact representation of the drawing and any text that is missing from the drawing is informational, non-distinctive, and/or immaterial. TMEP §§ 807.12(a), 807.14(a). Any variations between the mark depicted in the drawing and the mark depicted in the specimen are inconsequential and do not create a different overall commercial impression. The USPTO has not submitted any evidence that AN INNOVATIVE CUSTOM WORKSHOP is indicative of third-party source such that it would convey a different commercial impression from the drawing.

### **1. AN INNOVATIVE CUSTOM WORKSHOP Is Informational Matter**

It is well settled that “[e]xtraneous matter shown on the specimen that is not part of the mark (e.g., ... informational matter []) **may not** be shown on the drawing.” TMEP §807.12(a) (emphasis added). TMEP §1202.04. “Matter is merely informational and does not function as a mark when, based on its nature and the context of its use by the applicant and/or others in the marketplace, consumers would perceive it as merely conveying general information about the goods or services *or an informational message*, and not as a means to identify and distinguish the applicant’s goods/services from those of others.” TMEP §1202.04.

Similar to the case at bar is *TBL* and *Institut Nat. Des Appellations D’Origine v. Vintners Int’l Co.*, 958 F.2d 1574, 1582 (Fed. Cir. 1992) [precedential]. In *TBL*, after the USPTO found that the presence of the additional elements incorporated in the mark shown in the specimen of use, including the additional wording “TIMBERLAND” on the specimen that was not in the drawing, changed the mark, the Board reversed, reasoning that “[m]erchants often present a mark together with other matter.” *TBL*, Serial No. 86684964 (TTAB 2017).

## Trademarks

In *Institut*, the court found that the word “CALIFORNIA” was informational and therefore, the specimen reflecting the word was still a substantially exact representation of CHABLIS WITH A TWIST. *Institut*, 958 F.2d at 1582.

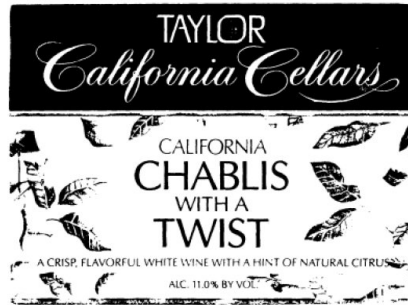


FIGURE 1

Just as in *TBL* and *Institut*, the wording in the case at bar, namely, AN INNOVATIVE, CUSTOM WOODSHOP is simply informational matter, in other words, an informational message used on marketing materials. It is not distinctive matter. In fact, the wording under the mark changes depending on the product being sold and advertised. See **Exhibit 1**. The wording AN INNOVATIVE, CUSTOM WOODSHOP (used when advertising Applicant’s goods/services under the MISSOURI WOODWORKS & Design mark is interchangeable with “CUTTING BOARD OIL” and “COMPLIMENTARY CARE KIT” (used to identify certain of Applicant’s products). See **Exhibit 1**. Just as the State where a wine was produced was informational and not part of the *Institut* applicant’s mark, all of the above phrases are information in that they tell consumers more about Applicant’s goods/services – the phrasing does not act as a source identifier and are not a part of Applicant’s composite mark.

## **Trademarks**

Merchants often present their marks with additional informational matter. See **Exhibit 2**.<sup>6</sup> In fact, the most common “message[s] [] ordinarily [] used in advertising [] in the relevant industry” (TMEP §1202.04) in this instance are a variation of “CUSTOM WOODSHOP” or “CUSTOM WOODWORKING” or “CLASSIC CRAFTSMANSHIP” or “FINE CUSTOM [type of good]” or “CUSTOM FINE [type of goods]” or “CUSTOM [type of GOOD] and FINE WOODWORKING”. See **Exhibit 2**. These phrases used, in close association with the respective seller’s marks, are informational matter ordinarily used in the woodworking industry to advertise and communicate with the consuming public about the goods and services being sold. Importantly, these messages are “not [] a means to identify and distinguish the [merchant]’s goods/services from those of others.” TMEP §1202.04. In fact, these words cannot be used to “identify and distinguish the applicant’s goods/services from those of others” because they all use the same words, and all such words need to be available to all merchants in the woodworking industry. *Id* (“Matter may be merely informational and fail to function as a source indicator for various reasons, including...[if] the matter is a common phrase or message that would ordinarily be used in advertising or in the relevant industry.”); *see also*, **Exhibit 2**.

---

<sup>6</sup> **Exhibit 2** consists of the following URLs, herein made of record, last assessed May 6, 2021:

- 1) <https://www.angelcitywoodshop.com/>
- 2) <https://thanelorbach.com/>
- 3) <https://www.martin-antique-restorations.com/>
- 4) <https://www.lewiswoodshop.com/>
- 5) <https://www.eldridgelumberyard.com/custom-woodshop>
- 6) <https://leidyswoodworking.com/>
- 7) <http://www.jimcardoncustoms.com/>
- 8) <http://lechnercw.com/custom-woodshop/waukesha/>
- 9) <http://www.cabinetsbycw.com/>
- 10) <https://www.the-woodshop.net/>
- 11) <https://www.macikwoodworking.com/>



## **Trademarks**

Importantly, while “[d]eletion of matter from the mark can result in a material alteration.... [i]nformational matter...*should* [] be deleted from the mark, unless it is truly part of a composite mark *and the removal of this matter would alter the overall commercial impression.*” TMEP §807.14(a). (emphasis added). This reasoning further supports reversal of the refusal here. Here, Applicant has deleted the informational material AN INNOVATIVE, CUSTOM WORKSHOP from the drawing; the deletion of the informational material does not alter the commercial impression of the mark; the matter AN INNOVATIVE, CUSTOM WORKSHOP is separable from the other elements; and the Applicant’s Mark is registerable matter. See TMEP §§1202.04. “The controlling question [in determining if deletion results in material alteration] is always whether the old and new forms of the mark create *essentially the same commercial impression.* See *Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 1370, 116 USPQ2d 1129, 1133-34 (Fed. Cir. 2015) [precedential] (emphasis added).

For the reasons discussed herein, AN INNOVATIVE, CUSTOM WOODSHOP is separable informational matter and deletion of such matter is appropriate. Applicant respectfully requests that the Examiner withdraw its refusal of Applicant’s specimen.

### **2. AN INNOVATIVE, CUSTOM WOODSHOP is Separable from the Other Elements in Applicant’s Mark**

To determine if an element of a mark is inseparable from the mark as a whole, namely, whether the mark is unitary, the USPTO must consider a number of factors, including “whether it is physically connected by lines or other design features; the relative location of the respective elements; and the meaning of the terminology as used on or in connection with the goods or

## Trademarks

services.” TMEP §1213.05 (citing *Dena Corp. v. Belvedere Int’l, Inc.*, 950 F.2d 1555, 1561, 21 USPQ2d 1047, 1052 (Fed. Cir. 1991) [precedential] at 1052).

In *Dena*, the Federal court found that the word element of the mark was not **physically** connected by lines or design with the design element. *Id.* The court distinguished the case from others, where the marks were “indivisible symbol[s] rather than two divisible [elements].” *Id.* (citing *B. Kuppenheimer & Co. v. Kayser-Roth Corp.*, 326 F.2d 820, 823 (C.C.P.A. 1964). The court reasoned that where elements were inextricably linked such that when one element was removed, it changed the other elements of the mark, then the elements were inseparable. For example, in the below mark, the word SUPPANTS would change if the two “P” letters along with the whole word KUPPENHEIMER was removed:

**“Kuppenheimer”  
SUPPANTS**

Here, AN INNOVATIVE, CUSTOM WORKSHOP, as that language appears on Applicant’s specimen, is not physically connected to Applicant’s Mark by lines or other design features, the location of the mark is at bottom of Applicant’s Mark, the wording AN INNOVATIVE, CUSTOM WORKSHOP is in a smaller, less distinct, non-bolded font, and the wording is descriptive and non-distinctive. Applicant’s Mark is not reliant on the wording AN INNOVATIVE, CUSTOM WORKSHOP and has a distinct meaning independent from this wording. Removal of this language does not disrupt Applicant’s Mark. Due to prominent and distinct design of Applicant’s Mark, the commercial impression in the drawing and the specimen are the same. See, e.g. *Dena*, 950 F.2d at 156 (“[n]othing melds [the word element of the mark] with the [] design to create a single indivisible symbol.”)

## Trademarks

For the reasons discussed herein, Applicant respectfully requests that the Examiner withdraw its refusal of Applicant's specimen.

### **3. The Mark Contains Registerable Source-Indicating Matter Apart from AN INNOVATIVE, CUSTOM WOODSHOP**

Applicant's Mark is registerable. "The critical inquiry in determining whether matter functions as a trademark or service mark is how the proposed mark would be perceived by the relevant public." TMEP §1202.04 (citing *D.C. One Wholesaler, Inc.*, 120 USPQ2d 1710, 1713 (TTAB 2016) [precedential]; *In re Phoseon Tech., Inc.*, 103 USPQ2d 1822, 1827 (TTAB 2012) (noting that the critical inquiry in determining whether a mark functions as a trademark is the "commercial impression it makes on the relevant public (e.g., whether the term sought to be registered would be perceived as a mark identifying the source of the goods)") [precedential]; *In re Eagle Crest, Inc.*, 96 USPQ2d 1229 [precedential]; *In re Remington Prods., Inc.*, 3 USPQ2d 1715 [non-precedential].

Section 45 of the Lanham Act, 15 U.S.C. §1127, defines trademark as follows:

The term "trademark" includes any word, name, symbol, or device, or any combination thereof—

- (1) used by a person, or
- (2) which a person has a bona fide intention to use in commerce and applies to register on the principal register established by this Act, to identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown.

Here, there is no question the mark is source-indicating and leaves a lasting commercial impression on the public. Here, upon seeing the **MISSOURI WOODWORKS & Design** mark, customers will see a deep connection to Missouri and a dedication to wood crafting. Applicant uses its mark on its goods, advertising and promotional material. See **Exhibit 1**. Applicant's Mark



## **Trademarks**

is a combination of words and symbols used by Applicant to identify and distinguish its goods and Applicant's Mark is **not** immoral, consisting of a governmental insignia, matter identifying an individual, confusingly similar to another mark registered within the USPTO, nor merely descriptive or deceptively misdescriptive as a whole of its goods/services or geographically descriptive or deceptively misdescriptive. 15 U.S.C. §1052.

Since Applicant's Mark is a trademark, as defined in the Lanham Act, and for the reasons discussed herein, Applicant respectfully requests that the Examiner withdraw its refusal of Applicant's specimen.

### **B. Conclusion**

Based on the foregoing, Applicant respectfully submits that its application should be approved to be published either without requiring a substitute specimen. Applicant's MISSOURI WOODWORKS & Design Mark contains separable elements and is source indicating without the informational matter contained in the specimen. If Applicant's arguments are found unpersuasive, Applicant requests the application be amended to an Intent-to-Use basis. For the foregoing reasons, Applicant respectfully requests that the USPTO reverse its initial refusal and allow the mark to proceed with the amendments herein described.

May 26, 2021

Respectfully submitted,

/s/ Janet C. Moreira

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# EXHIBIT 1





# EXHIBIT 2



# ANGEL CITY WOODSHOP

CUSTOM FURNITURE | FINE WOODWORKING



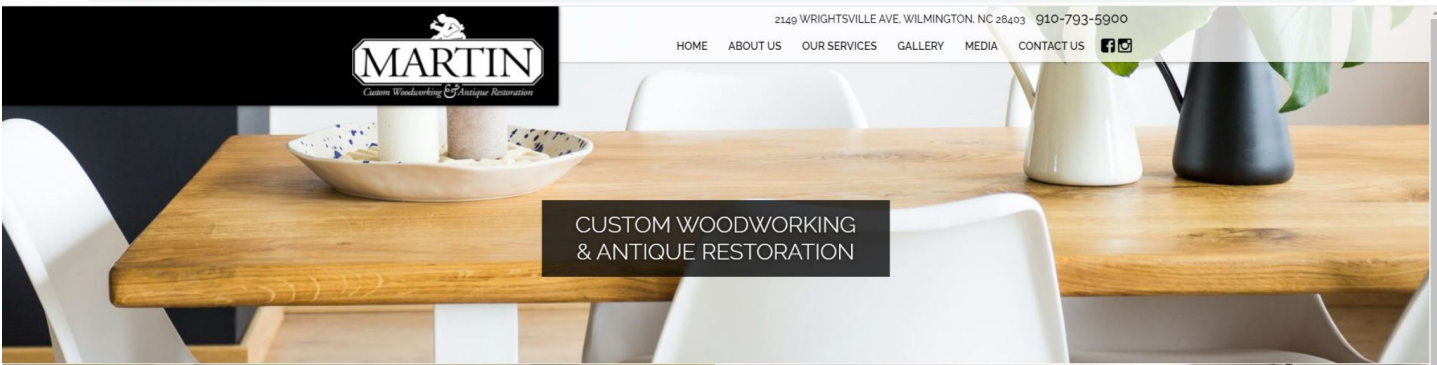
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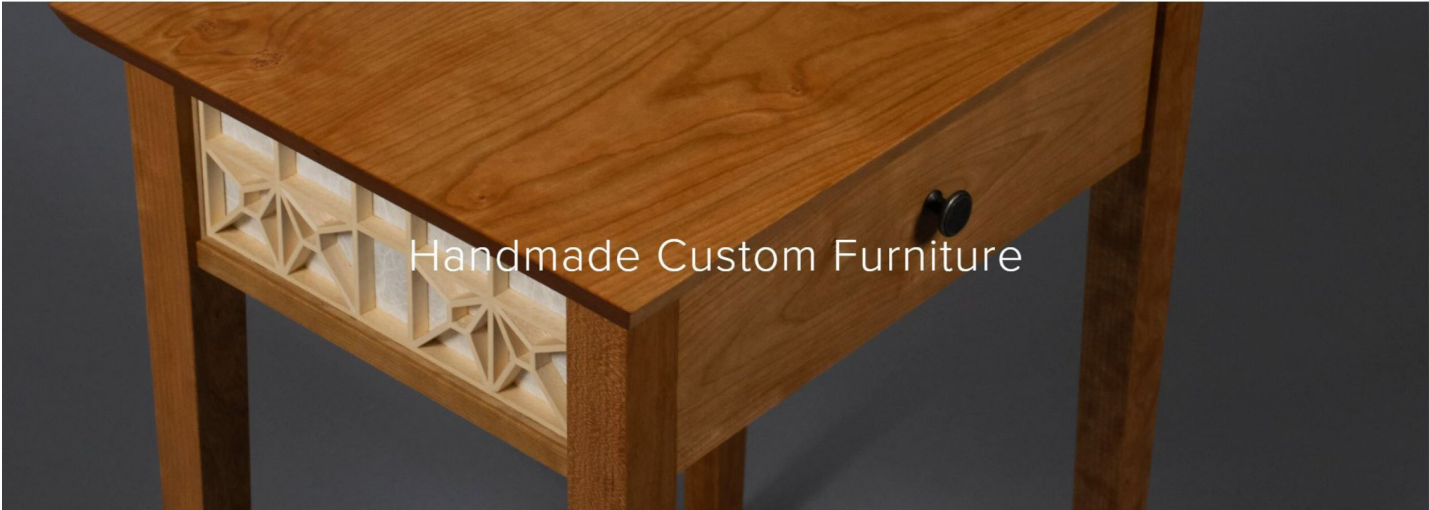


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**Jim Cardon**

Jim has over 30 years of woodworking experience. His career began as he worked alongside his father building homes at Cardon Construction, established in 1936. His father and grandfather were former home builders that built all cabinetry and trim work in the home.

Jim attended Utah Technical College, a 2 year course in cabinet making and mill work. His instructor, Ed Nowlten was a master craftsman from back east. He even had the handlebar mustache and was an amazing woodworker. He could build a spiral stairway. Jim's favorite type of project includes kitchens, custom cabinets, libraries, decks, etc.

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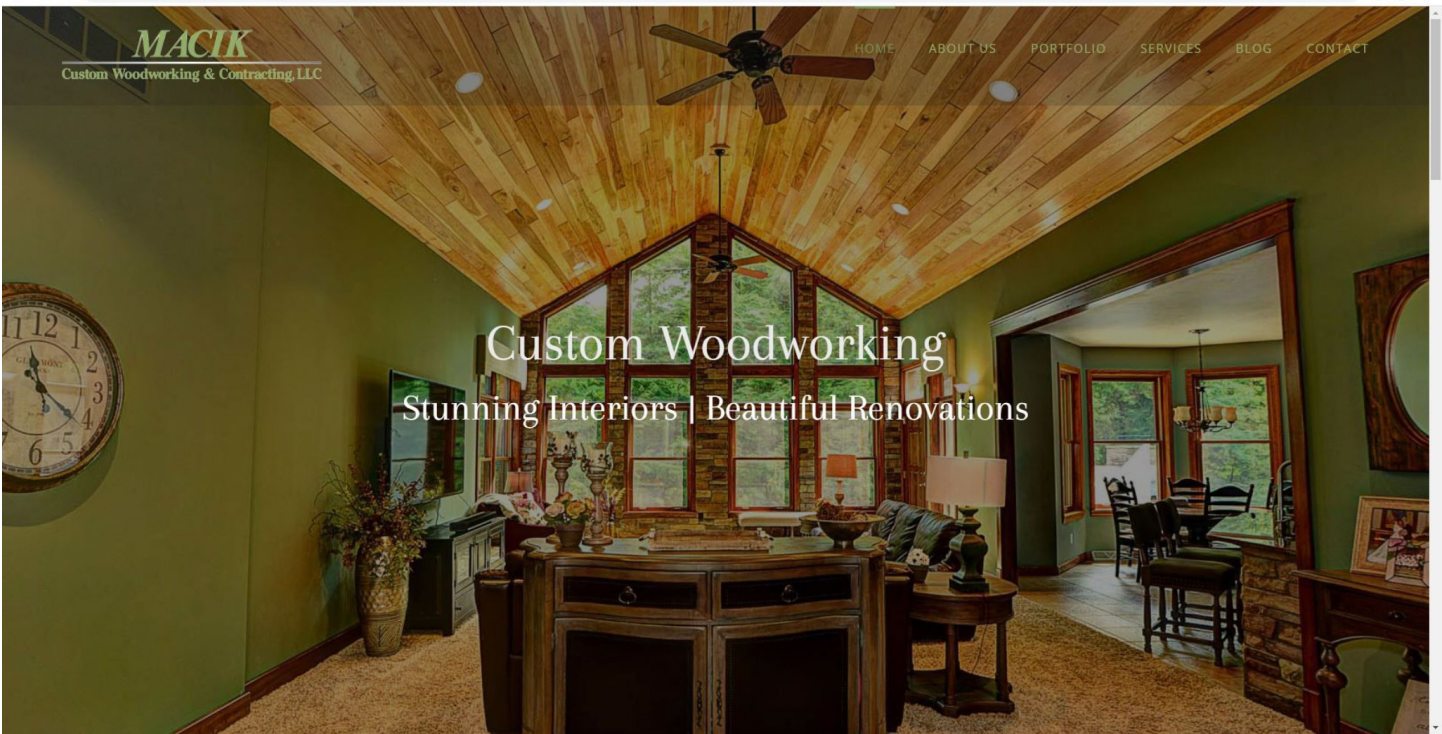
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