

To: Somya Kaushik(skaushik@chenowethlaw.com)
Subject: U.S. Trademark Application Serial No. 97028870 - ADORN SUPPLY CO.
Sent: January 23, 2023 07:07:07 AM EST
Sent As: tmng.notices@uspto.gov

Attachments

United States Patent and Trademark Office (USPTO)
Office Action (Official Letter) About Applicant's Trademark Application

U.S. Application Serial No. 97028870

Mark: ADORN SUPPLY CO.

Correspondence Address:

Somya Kaushik
CHENOWETH LAW GROUP, PC
510 SW FIFTH AVENUE, FOURTH FLOOR
PORTLAND OR 97204 UNITED STATES

Applicant: Sims, Allison

Reference/Docket No. N/A

Correspondence Email Address: skaushik@chenowethlaw.com

SUSPENSION NOTICE
No Response Required

Issue date: January 23, 2023

Pursuant to TMEP §716.01, applicant is advised of the following status of the application.

In an Office Action issued on June 25, 2022, the following issues were outstanding with this application:

- Section 2(d) - Likelihood of Confusion Refusal
- Disclaimer Required
- Amended Mark Description

On December 23, 2022, applicant responded to the Office Action. In the Response, applicant:

- Provided arguments against the Section 2(d) Refusal;
- Amended the identification;
- Disclaimed SUPPLY CO; and
- Amended the mark description.

The trademark examining attorney has thoroughly reviewed applicant's response and has determined the following:

1. Registration No. 4937571 has cancelled and no longer presents a bar to registration. The Section 2(d) Refusal with respect to Registration No. 6610605 is withdrawn. Registration maintenance documents are or were due to be filed for Registration No. 5054467 and action on this application is suspended to await disposition of Registration No. 5054467.
2. Applicant *satisfied* the disclaimer requirement;
3. Applicant *satisfied* the mark drawing requirement.

Preliminary Response to Applicant's Arguments

Applicant asserts that, when considered as a whole, the marks contain additional terms that distinguish them from each other. Applicant further asserts that the services are significantly different.

While marks must be compared in their entireties, a trademark examining attorney may weigh the individual components of a mark to determine its overall commercial impression. In this case, ADORN is the dominant wording in the applied-for mark and the registered mark. The additional wording is merely descriptive of applicant's and registrant's services, and therefore, is less significant in terms of affecting the commercial impression of the marks. Additionally, the services are related. In particular, wedding planners and event decorators often print 3D decorations for use at the event. Lastly, the fact that purchasers are sophisticated or knowledgeable in a particular field does not necessarily mean that they are sophisticated or knowledgeable in the field of trademarks or immune from source confusion. Accordingly, applicant's arguments are unpersuasive to overcome the refusal and the Section 2(d) Refusal is *maintained and continued*.

APPLICATION IS SUSPENDED

The application is suspended for the reason specified below. *See* 37 C.F.R. §2.67; TMEP §§716 *et seq.*

Application suspended until disposition of cited registration(s). Registration maintenance documents are or were due to be filed for the registration cited against applicant in a refusal based on Trademark Act Section 2(d). 15 U.S.C. §1052(d). If the maintenance documents are not timely filed and accepted by the USPTO, the cited registration will cancel and/or expire and will no longer bar registration of applicant's mark under Section 2(d). *See* 15 U.S.C. §§1058, 1059, 1141k. Action on this application is suspended for six months to await disposition of the cited registration; after which, the trademark examining attorney will determine whether to maintain or withdraw the Section 2(d) refusal. *See* 37 C.F.R. §2.67; TMEP §716.02(e).

Suspension process. The USPTO will periodically check this application to determine if it should remain suspended. *See* TMEP §716.04. As needed, the trademark examining attorney will issue a letter to applicant to inquire about the status of the reason for the suspension. TMEP §716.05.

No response required. Applicant may [file a response](#), but is not required to do so.

/Danielle Anderson/
Danielle Anderson
Trademark Examining Attorney
Law Office 113
(571) 272-6143
Danielle.Anderson@uspto.gov

United States Patent and Trademark Office (USPTO)

USPTO OFFICIAL NOTICE

Office Action (Official Letter) has issued
on January 23, 2023 for
U.S. Trademark Application Serial No. 97028870

A USPTO examining attorney has reviewed your trademark application and issued an Office action. You may be required to respond to this Office action. Follow the steps below.

- (1) **[Read the Office action.](#)** This email is NOT the Office action.
- (2) **Respond to the Office action, if a response is required.** Respond by deadline using the Trademark Electronic Application System (TEAS). Your response must be received by the USPTO on or before 11:59 p.m. **Eastern Time** of the last day of the response period. Otherwise, your application will be **[abandoned](#)**. See the Office action itself regarding how to respond.
- (3) **Direct general questions** about using USPTO electronic forms, the USPTO [website](#), the application process, the status of your application, and whether there are outstanding deadlines to the [Trademark Assistance Center \(TAC\)](#).

After reading the Office action, address any question(s) regarding the specific content to the USPTO examining attorney identified in the Office action.

GENERAL GUIDANCE

- **[Check the status of your application periodically](#)** in the [Trademark Status & Document Retrieval \(TSDR\)](#) database to avoid missing critical deadlines.
- **[Update your correspondence email address](#)** to ensure you receive important USPTO notices about your application.
- **[Beware of trademark-related scams.](#)** Protect yourself from people and companies that may try to take financial advantage of you. Private companies may call you and pretend to be the USPTO or may send you communications that resemble official USPTO documents to trick you. We will never request your credit card number or social security number over the phone. Verify the correspondence originated from us by using your Serial Number in our database, [TSDR](#), to confirm that it appears under the “Documents” tab, or contact the [Trademark Assistance Center](#).
- **[Hiring a U.S.-licensed attorney.](#)** If you do not have an attorney and are not required to

have one under the trademark rules, we encourage you to hire a U.S.-licensed attorney specializing in trademark law to help guide you through the registration process. The USPTO examining attorney is not your attorney and cannot give you legal advice, but rather works for and represents the USPTO in trademark matters.