

**To:** Kyona McGhee([kyona@themcgheelawfirm.com](mailto:kyona@themcgheelawfirm.com))  
**Subject:** U.S. Trademark Application Serial No. 97119222 - ESTHI  
**Sent:** August 25, 2022 01:23:46 PM EDT  
**Sent As:** [tmng.notices@uspto.gov](mailto:tmng.notices@uspto.gov)

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**Attachments**

[90703411](#)

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

**U.S. Application Serial No.** 97119222

**Mark:** ESTHI

**Correspondence Address:**

KYONA MCGHEE  
THE MCGHEE LAW FIRM  
653 SAGINAW STREET SUITE 100  
FLINT MI 48502 UNITED STATES

**Applicant:** Esthi Queen LLC

**Reference/Docket No.** N/A

**Correspondence Email Address:** [kyona@themcgheelawfirm.com](mailto:kyona@themcgheelawfirm.com)

**NONFINAL OFFICE ACTION**

**The USPTO must receive applicant's response to this letter within six months of the issue date below or the application will be [abandoned](#).** Respond using the Trademark Electronic Application System (TEAS). A link to the appropriate TEAS response form appears at the end of this Office action.

**Issue date:** August 25, 2022

**INTRODUCTION**

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 THE USPTO DATABASE OF MARKS**

The trademark examining attorney has searched the USPTO database of registered and pending marks and has found no conflicting registered marks that would bar registration under Trademark Act Section 2(d). 15 U.S.C. §1052(d); TMEP §704.02. However, a mark in a prior-filed pending application may present a bar to registration of applicant's mark.

**SUMMARY OF ISSUES** the applicant must address:

- Specimen Refusal - Partial
- Amendment of the Identification of Goods and Services Required - Partial

Also contained herein is an advisory regarding a potential Section 2(d) Refusal for a likelihood of confusion with a prior-filed application

### **POTENTIAL SECTION 2(d) REFUSAL ADVISORY - PRIOR FILED APPLICATIONS**

The filing date of pending U.S. Application Serial No. 90703411 precedes applicant's filing date. See attached referenced application. If the mark in the referenced application registers, applicant's mark may be refused registration under Trademark Act Section 2(d) because of a likelihood of confusion between the two marks. See 15 U.S.C. §1052(d); 37 C.F.R. §2.83; TMEP §§1208 *et seq.* Therefore, upon receipt of applicant's response to this Office action, action on this application may be suspended pending final disposition of the earlier-filed referenced application.

In response to this Office action, applicant may present arguments in support of registration by addressing the issue of the potential conflict between applicant's mark and the mark in the referenced application. Applicant's election not to submit arguments at this time in no way limits applicant's right to address this issue later if a refusal under Section 2(d) issues.

Although the applicant is not required to respond to the issue of the prior pending application, the applicant must respond to the below refusal and requirement within six months of the mailing date of this Office action to avoid abandonment.

### **SPECIMEN REFUSAL - THIS PARTIAL REFUSAL APPLIES TO CLASS(ES) 35 ONLY**

**Specimen does not show use in specific class(es).** Registration is refused because the specimen does not show the applied-for mark as actually used in commerce in connection with any of the goods and/or services specified in International Class(es) 35. Trademark Act Sections 1 and 45, 15 U.S.C. §§1051, 1127; 37 C.F.R. §§2.34(a)(1)(iv), 2.56(a); *In re Keep A Breast Found.*, 123 USPQ2d 1869, 1876-79 (TTAB 2017); TMEP §§904, 904.07(a), 1301.04(d), (g)(i). An application based on Trademark Act Section 1(a) must include a specimen showing the applied-for mark as actually used in commerce for each international class of goods and/or 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); see *In re Gulf Coast Nutritionals, Inc.*, 106 USPQ2d 1243, 1247 (TTAB 2013).

Specifically, the specimen submitted appears to show the applied-for mark on bottles of cosmetics as well as associated with trainings but the specimen does not show the applied-for mark in connection

with retail store services as the specimen does not show the applied-for mark in connection with selling of the goods listed in the identification of services or an advertisement for the selling of goods. The identification of services specifies that the retail store services feature "skincare products such as eye serum, lip serum, skin cleansers, exfoliating scrub, hydrating masks, skin moisturizer, charcoal mask, beard oil; weight loss products including pills and collagen peptide; exfoliating gloves and acne treatments". The specimen submitted shows the applied-for mark in selling training courses. These are not included in the retail store services. Therefore, the specimen submitted does not show the applied-for mark in use in commerce in connection with Class 35 services listed in the identification of services.

**Examples of specimens.** Specimens for goods include a photograph of (1) the actual goods bearing the mark; (2) an actual container, packaging, tag or label for the goods bearing the mark; or (3) a point-of-sale display showing the mark directly associated with the goods. *See* 37 C.F.R. §2.56(b)(1), (c); TMEP §904.03(a)-(m). A webpage specimen submitted as a display associated with the goods must show the mark in association with a picture or textual description of the goods and include information necessary for ordering the goods. TMEP §904.03(i); *see* 37 C.F.R. §2.56(b)(1), (c).

Specimens for services must show a direct association between the mark and the services and include: (1) copies of advertising and marketing material, (2) a photograph of business signage or billboards, or (3) materials showing the mark in the sale, rendering, or advertising of the services. *See* 37 C.F.R. §2.56(b)(2), (c); TMEP §1301.04(a), (h)(iv)(C).

Any webpage printout or screenshot submitted as a specimen must include the webpage's URL and the date it was accessed or printed on the specimen itself, within the TEAS form that submits the specimen, or in a verified statement under 37 C.F.R. §2.20 or 28 U.S.C. §1746 in a later-filed response. *See* 37 C.F.R. §2.56(c); TMEP §§904.03(i), 1301.04(a).

**Response options.** 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 goods and/or services identified in the application or amendment to allege use. A “verified substitute specimen” is a specimen that is accompanied by the following statement made in a signed affidavit or supported by a declaration under 37 C.F.R. §2.20: “The substitute (or new, or originally submitted, if appropriate) specimen(s) was/were in use in commerce at least as early as the filing date of the application or prior to the filing of the amendment to allege use.” The substitute specimen cannot be accepted without this statement.
- (2) Amend the filing basis to [intent to use under Section 1\(b\)](#) (which includes withdrawing an amendment to allege use, if one was filed), as no specimen is required before publication. This option will later necessitate additional fee(s) and filing requirements, including a specimen.

For an overview of the response options referenced above and instructions on how to satisfy these options using the online Trademark Electronic Application System (TEAS) form, see the [Specimen webpage](#).

## **RESPONSE TO REFUSAL**

Although applicant's mark has been refused registration, applicant may respond to the refusal(s) by submitting evidence and arguments in support of registration.

## **REQUIREMENTS**

If applicant responds to the refusal, applicant must also respond to the requirement set forth below.

### **AMENDMENT OF THE IDENTIFICATION OF GOODS AND SERVICES REQUIRED - THIS PARTIAL REQUIREMENT APPLIES TO CLASS(ES) 35 ONLY**

The applicant's identification of goods and services is unacceptable, because it contains a significant amount of indefinite wording in Class 35 that requires further specification. *See* 37 C.F.R. §2.32(a)(6); TMEP §1402.01.

First, applicant must correct the punctuation in the identification in Class 35 to clarify the individual items in the list of goods and/or services. *See* 37 C.F.R. §2.32(a)(6); TMEP §1402.01(a). Proper punctuation in identifications is necessary to delineate explicitly each product or service within a list and to avoid ambiguity. Commas, semicolons, and apostrophes are the only punctuation that should be used in an identification of goods and/or services. TMEP §1402.01(a). An applicant should *not* use colons, periods, exclamation points, and question marks in an identification. *Id.* In addition, applicants should not use symbols in the identification such as asterisks (\*), at symbols (@), or carets. *Id.*

In general, **commas** should be used in an identification (1) to separate a series of related items identified within a particular category of goods or services, (2) before and after "namely," and (3) between each item in a list of goods or services following "namely" (e.g., personal care products, namely, body lotion, bar soap, shampoo). *Id.* **Semicolons** generally should be used to separate a series of distinct categories of goods or services within an international class (e.g., personal care products, namely, body lotion; deodorizers for pets; glass cleaners). *Id.*

Thus, applicant should replace the semi-colons with colons in the identification of goods or services. Please see below for suggested amendments.

Additionally, The wording "'such as" and "including"' in the identification of services in Class 35 is indefinite and must be deleted and replaced with a definite term, such as "namely," "consisting of," "particularly," or "in particular." *See* 37 C.F.R. §2.32(a)(6); TMEP §§1402.01, 1402.03(a). The identification must be specific and all-inclusive. This wording is an open-ended term (e.g., "including" and "such as") that is not acceptable because it fails to identify specific services. *See* TMEP §1402.03(a).

The current Identification in Class 35 reads:

On-line retail store services featuring skincare products such as eye serum, lip serum, skin cleansers, exfoliating scrub, hydrating masks, skin moisturizer, charcoal mask, beard oil; weight loss products including pills and collagen peptide; exfoliating gloves and acne treatments

The semi-colons are inappropriate to show items in a list and the overly broad wording "such as" and "including" must be deleted, therefore, the following amendment is suggested:

On-line retail store services featuring skincare products, ***namely, such as*** eye serum, lip serum, skin cleansers, exfoliating scrub, hydrating masks, skin moisturizer, charcoal mask, beard oil, weight loss products ***being including*** pills and collagen peptide, exfoliating gloves and acne treatments

The following guidelines are provided for amending the identification:

- Use common commercial or generic names for the goods whenever possible. If there is no common commercial or generic name, describe the product and intended consumer as well as the main purpose and intended uses of the goods (TMEP § 1402.01);
- Use “***namely***” after broad terms (e.g., “accessories,” “apparatus,” “components,” “devices,” “equipment,” “materials,” “parts,” “systems” or “products”) followed by a list of the specific goods, e.g., “accessories, namely, [list specific goods]” (TMEP §§ 1402.01, 1402.03(a));
- Remove parentheses and incorporate the parenthetical information into the description, if necessary. Parenthetical information is permitted only if it serves to explain or translate the matter immediately preceding the parenthetical phase, e.g., “obi (Japanese sash), (TMEP § 1402.12);
- Use commas (1) to separate a series of related items identified within a particular category of goods, (2) before and after “namely,” and (3) between each item in a list of goods (TMEP § 1402.01(a));
- Use semicolons to separate a distinct category of goods within an International Class (TMEP § 1402.01(a)).

### **Overall Identification**

Therefore, the applicant may adopt the following identification of services, if accurate (deletions shown ~~stricken~~ and additions are shown in **bold** and *italics*):

International Class 003: Non-medicated skin care preparations; Non-medicated skin care preparations, namely, eye serum, lip serum, skin cleansers, exfoliating scrub, hydrating masks, skin moisturizer, charcoal mask, beard oil

International Class 035: On-line retail store services featuring skincare products, ***namely, such as*** eye serum, lip serum, skin cleansers, exfoliating scrub, hydrating masks, skin moisturizer, charcoal mask, beard oil, weight loss products ***being including*** pills and collagen peptide, exfoliating gloves and acne treatments

International Class 041: Education services, namely, providing courses, seminars, and workshops in the field of skin care treatments and services; Educational services, namely, providing on-line courses in the field of skin care treatments and services; Arranging and conducting of courses of instruction in the field of skincare

Applicant’s goods and/or services may be clarified or limited, but may not be expanded beyond those originally itemized in the application or as acceptably amended. *See* 37 C.F.R. §2.71(a); TMEP §1402.06. Applicant may clarify or limit the identification by inserting qualifying language or deleting

items to result in a more specific identification; however, applicant may not substitute different goods and/or services or add goods and/or services not found or encompassed by those in the original application or as acceptably amended. *See* TMEP §1402.06(a)-(b). The scope of the goods and/or services sets the outer limit for any changes to the identification and is generally determined by the ordinary meaning of the wording in the identification. TMEP §§1402.06(b), 1402.07(a)-(b). Any acceptable changes to the goods and/or services will further limit scope, and once goods and/or services are deleted, they are not permitted to be reinserted. TMEP §1402.07(e).

For assistance with identifying and classifying goods and services in trademark applications, please see the USPTO's online searchable [U.S. Acceptable Identification of Goods and Services Manual](#). *See* TMEP §1402.04.

## **RESPONSE GUIDELINES**

Please call or email the assigned trademark examining attorney with questions about this Office action.

**How to respond.** [Click to file a response to this nonfinal Office action.](#)

/Sarah Hopkins/  
Sarah Hopkins  
Trademark Examining Attorney  
Law Office 123  
(571) 270-0942  
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## **RESPONSE GUIDANCE**

- **Missing the response deadline to this letter will cause the application to [abandon](#).** The response must be received by the USPTO before midnight **Eastern Time** of the last day of the response period. TEAS maintenance or [unforeseen circumstances](#) could affect an applicant's ability to timely respond.
- **[Responses signed by an unauthorized party](#)** are not accepted and can **cause the application to [abandon](#)**. If applicant does not have an attorney, the response must be signed by the individual applicant, all joint applicants, or someone with [legal authority to bind a juristic applicant](#). If applicant has an attorney, the response must be signed by the attorney.
- If needed, **find [contact information for the supervisor](#)** of the office or unit listed in the signature block.

**(4) STANDARD CHARACTER MARK**

ESTHIE ESTHETICIAN  
CONNECTION

**Mark Punctuated**

ESTHIE ESTHETICIAN CONNECTION

**Translation**

**Goods/Services**

- IC 035. US 100 101 102.G & S: Matching consumers with professionals in the field of esthetics and cosmetology; On-line retail store services featuring skincare products

**Mark Drawing Code**

(4) STANDARD CHARACTER MARK

**Design Code**

**Serial Number**

90703411

**Filing Date**

20210511

**Current Filing Basis**

1B

**Original Filing Basis**

1B

**Publication for Opposition Date**

20220315

**Registration Number**

**Date Registered**

**Owner**

(APPLICANT) Esthetician Connection, LLC LIMITED LIABILITY COMPANY NORTH CAROLINA 13016 Eastfield Road, STE 200-242 Huntersville NORTH CAROLINA 28078

**Priority Date**

**Disclaimer Statement**

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "ESTHETICIAN" APART FROM THE MARK AS SHOWN

**Description of Mark**

**Type of Mark**

SERVICE MARK

**Register**

PRINCIPAL

**Live Dead Indicator**

LIVE

**Attorney of Record**

Charles C. Clark



## United States Patent and Trademark Office (USPTO)

### USPTO OFFICIAL NOTICE

Office Action (Official Letter) has issued  
on August 25, 2022 for  
**U.S. Trademark Application Serial No. 97119222**

A USPTO examining attorney has reviewed your trademark application and issued an Office action. You must respond to this Office action in order to avoid your application abandoning. Follow the steps below.

- (1) **[Read the Office action](#)**. This email is NOT the Office action.
- (2) **Respond to the Office action by the 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. And all official USPTO correspondence will only be emailed from the domain “@uspto.gov.” 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.

User: Sarah Hopkins

Statistics for Case 97119222						
#	Search	Total Marks	Dead Marks	Live Viewed Docs	Live Viewed Images	Status/Search Duration
1	*sth*[bi,ti] not dead[ld]	2532	0	0	0	0:01
2	*{v}sth*[bi,ti] not dead[ld]	2268	0	0	0	0:02
3	*{v}sth{v}*[bi,ti] not dead[ld]	2096	0	0	0	0:14
4	{v}sth{v}*[bi,ti] not dead[ld]	330	0	330	330	0:15
5	*{v}sth{v}[bi,ti] not dead[ld]	48	0	48	48	0:14
6	1 and "003"[cc]	1520	0	0	0	0:00
7	2 and "003"[cc]	1436	0	0	0	0:00
8	3 and "003"[cc]	1332	0	0	0	0:13
9	1 and ("003" a b "200")[ic]	221	0	221	221	0:02
10	1 and ("005" a b "200")[ic]	141	0	141	141	0:01
11	1 and ("035" a b "200")[ic]	324	0	324	324	0:02
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26	e{"sz"}th*[bi,ti] not dead[ld]	317	0	317	317	0:00
27	25 and "003"[cc]	1165	0	0	0	0:00
28	25 and "005"[cc]	1189	0	0	0	0:00
29	esth*[bi,ti] not dead[ld]	312	0	312	312	0:01
30	ezth*[bi,ti] not dead[ld]	5	0	5	5	0:01
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Session started 08/25/2022 11:25 am

Session ended 08/25/2022 12:15 pm

Total search duration 102.00

Session duration 50 minutes 21 seconds

Adjacency Level 1

Near Level 1