

To: Michael R. Friscia(mfriscia@mccarter.com)
Subject: U.S. Trademark Application Serial No. 97119858 - CAREER BRAIN - 131841-00002
Sent: August 24, 2022 12:39:24 PM EDT
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Attachments

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

U.S. Application Serial No. 97119858

Mark: CAREER BRAIN

Correspondence Address:

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Applicant: York University

Reference/Docket No. 131841-00002

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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 24, 2022

The referenced application has been reviewed by the assigned trademark examining attorney. Applicant must respond timely and completely to the issues below. 15 U.S.C. §1062(b); 37 C.F.R. §§2.62(a), 2.65(a); TMEP §§711, 718.03.

SEARCH OF USPTO DATABASE OF MARKS

The trademark examining attorney searched the USPTO database of registered and pending marks and found no conflicting marks that would bar registration under Trademark Act Section 2(d). 15 U.S.C. §1052(d); TMEP §704.02.

SUMMARY OF ISSUES:

- Foreign Registration Certificate Required & Advisory regarding Dual Filing Bases
- Disclaimer Required
- Amendments to the Classification and Identification of Services Required

FOREIGN REGISTRATION CERTIFICATE REQUIRED & ADVISORY REGARDING DUAL FILING BASES

The application specifies both an intent to use basis under Trademark Act Section 1(b) and a claim of priority under Section 44(d) based on a foreign application. *See* 15 U.S.C. §§1051(b), 1126(d); 37 C.F.R. §2.34(a)(2), (a)(4). However, no copy of a foreign registration has been provided even though the application indicates applicant's intent to rely on Section 44(e) as an additional basis for registration. *See* 15 U.S.C. §1126(e).

An application with a Section 44(e) basis must include a true copy, photocopy, certification, or certified copy of a foreign registration from an applicant's country of origin. 15 U.S.C. §1126(e); 37 C.F.R. §2.34(a)(3)(ii); TMEP §§1004, 1004.01, 1016. In addition, an applicant's country of origin must be a party to a convention or treaty relating to trademarks to which the United States is also a party, or must extend reciprocal registration rights to nationals of the United States by law. 15 U.S.C. §1126(b); TMEP §§1002.01, 1004.

Therefore, applicant must provide a copy of the foreign registration from applicant's country of origin when it becomes available. TMEP §1003.04(a). A copy of a foreign registration must consist of a document issued to an applicant by, or certified by, the intellectual property office in applicant's country of origin. TMEP §1004.01. If applicant's country of origin does not issue registrations or Madrid Protocol certificates of extension of protection, applicant may submit a copy of the Madrid Protocol international registration that shows that protection of the international registration has been extended to applicant's country of origin. TMEP §1016. In addition, applicant must also provide an English translation if the foreign registration is not written in English. 37 C.F.R. §2.34(a)(3)(ii); TMEP §1004.01(a)-(b). The translation should be signed by the translator. TMEP §1004.01(b).

If the foreign registration has not yet issued, or applicant requires additional time to procure a copy of the foreign registration (and English translation, as appropriate), applicant should so inform the trademark examining attorney and request that the U.S. application be suspended until a copy of the foreign registration is available. TMEP §§716.02(b), 1003.04(b).

If applicant cannot satisfy the requirements of a Section 44(e) basis, applicant may request that the mark be approved for publication based solely on the Section 1(b) basis. *See* 15 U.S.C. §§1051(b), 1126(e); 37 C.F.R. §2.35(b)(1); TMEP §§806.02(f), 806.04(b), 1003.04(b). Although the mark may be approved for publication on the Section 1(b) basis, it will not register until an acceptable allegation of use has been filed. *See* 15 U.S.C. §1051(c)-(d); 37 C.F.R. §§2.76, 2.88; TMEP §1103. Please note that, if the U.S. application satisfied the requirements of Section 44(d) as of the U.S. application filing date, applicant may retain the priority filing date under Section 44(d) without perfecting the Section 44(e)

basis, provided there is a continuing valid basis for registration. *See* 37 C.F.R. §2.35(b)(3)-(4); TMEP §§806.02(f), 806.04(b).

Alternatively, applicant has the option to amend the application to rely solely on the Section 44(e) basis and request deletion of the Section 1(b) basis. *See* 37 C.F.R. §2.35(b)(1); TMEP §806.04. The foreign registration alone may serve as the basis for obtaining a U.S. registration. *See* 37 C.F.R. §2.34(a)(3); TMEP §806.01(d).

DISCLAIMER REQUIRED

Applicant must disclaim the wording “CAREER” because it is merely descriptive of a quality, characteristic, function, feature, purpose, or use of applicant’s services. *See* 15 U.S.C. §1052(e)(1); *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 1251, 103 USPQ2d 1753, 1755 (Fed. Cir. 2012); TMEP §§1213, 1213.03(a).

As stated in the identification of services in the application, applicant's services are for the purpose of providing "career placement, career planning, career counselling". As such, a characteristic, function, feature, purpose, and use of applicant’s services is for careers. Thus, the wording “CAREER” in the applied-for mark merely describes a characteristic, function, feature, purpose, and use of applicant’s services.

Applicant may respond to this issue by submitting a disclaimer in the following format:

No claim is made to the exclusive right to use “CAREER” apart from the mark as shown.

For an overview of disclaimers and instructions on how to provide one using the Trademark Electronic Application System (TEAS), see the [Disclaimer webpage](#).

AMENDMENTS TO THE CLASSIFICATION AND IDENTIFICATION OF SERVICES REQUIRED

Classification. The services appear to be classified incorrectly. In particular, the services in the present application appear to be a type of technology, incorporating automated artificial intelligence provided via a website. For example, the identification in the application states that the services are "automated AI-based [...], all via a website". The services of providing a web site featuring technology and/or non-downloadable software using artificial intelligence are classified in International Class 42. Accordingly, applicant must amend the application to classify the services in International Class 42. *See* 37 C.F.R. §§2.32(a)(7), 2.85; TMEP §§1401.02(a), 1401.03(b).

Identification. The identification of services is indefinite and must be clarified to further indicate that the services provided are clearly a web site featuring technology. *See* 37 C.F.R. §2.32(a)(6); TMEP §1402.01. Additionally, artificial intelligence is a type of software and should be identified as such. *See* 37 C.F.R. §2.32(a)(6); TMEP §1402.01. As a software, the purpose or function of the software must be specified. *See* 37 C.F.R. §2.32(a)(6); TMEP §§1402.03(d), 1402.11(a). See the bold text below for acceptable options for amendments.

Applicant may amend the identification to clarify or limit the services, but not to broaden or expand the

services beyond those in the original application or as acceptably amended. *See* 37 C.F.R. §2.71(a); TMEP §1402.06. Generally, any deleted services may not later be reinserted. *See* TMEP §1402.07(e).

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

Applicant may adopt the following identification, if accurate:

International Class **42**: Providing a **web site featuring non-downloadable software using artificial intelligence for conducting** automated AI-based job searching, career placement, career planning, career counselling, **and for conducting automated AI-based searching and counselling in** professional and skill development and educational advisory services **being advice concerning education options to pursue career opportunities**, all via the website

RESPONSE GUIDELINES

Please call or email the assigned trademark examining attorney with questions about this Office action. Although an examining attorney cannot provide legal advice, the examining attorney can provide additional explanation about the refusal(s) and/or requirement(s) in this Office action. *See* TMEP §§705.02, 709.06.

The USPTO does not accept emails as responses to Office actions; however, emails can be used for informal communications and are included in the application record. *See* 37 C.F.R. §§2.62(c), 2.191; TMEP §§304.01-.02, 709.04-.05.

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

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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.

United States Patent and Trademark Office (USPTO)

USPTO OFFICIAL NOTICE

Office Action (Official Letter) has issued
on August 24, 2022 for
U.S. Trademark Application Serial No. 97119858

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.