**To:** TheeTechnology, Inc.(richard@theedigital.com)

Subject: U.S. Trademark Application Serial No. 97118540 - E THEEDIGITAL

**Sent:** August 23, 2022 03:20:55 PM EDT

**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. 97118540

Mark: E THEEDIGITAL

Correspondence Address: THEETECHNOLOGY, INC. 7901 STRICKLAND RD, UNIT 112 RALEIGH NC 27615 UNITED STATES

**Applicant:** TheeTechnology, Inc.

Reference/Docket No. N/A

Correspondence Email Address: richard@theedigital.com

### NONFINAL OFFICE ACTION

The USPTO must receive applicant's response to this letter within <u>six months</u> of the issue date below or the application will be <u>abandoned</u>. 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 23, 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 OFFICE'S DATABASE OF MARKS

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

#### SUMMARY OF ISSUES:

- REFUSAL MARK DIFFERS ON DRAWING AND SPECIMEN
- REQUIREMENT CLASSIFICATION AND IDENTIFICATION OF SERVICES
- REQUIREMENT COLOR CLAIM AND MARK DESCRIPTION

#### REFUSAL - MARK DIFFERS ON DRAWING AND SPECIMEN

Mark shown on drawing does not match mark on specimen. Registration is refused because the specimen does not show the mark in the drawing in use in commerce, which is required in the application or amendment to allege use. Trademark Act Sections 1 and 45, 15 U.S.C. §§1051, 1127; 37 C.F.R. §§2.34(a)(1)(iv), 2.56(a); TMEP §§904, 904.07(a), 1301.04(g)(i). The mark appearing on the specimen and in the drawing must match; that is, the mark in the drawing "must be a substantially exact representation of the mark" on the specimen. See 37 C.F.R. §2.51(a)-(b); TMEP §807.12(a).

In this case, the specimen displays the mark as a blue square shape featuring a cut-out forming the letter "E". However, the drawing displays the mark as a blue square shape featuring a cut-out forming the letter "E" with the black wording "THEEDIGITAL" appearing to the right of the square shape. The mark on the specimen does not match the mark in the drawing because the mark in the specimen does not contain the black "THEEDIGITAL" wording. Applicant has thus failed to provide the required evidence of use of the mark in commerce. *See* TMEP §807.12(a).

**Response options.** Applicant may respond to this refusal by satisfying one of the following:

(1) **Submit a different specimen** (a verified "substitute" specimen) for each applicable international class that (a) shows the mark in the drawing in actual use in commerce for the goods and/or services in the application or amendment to allege use, and (b) 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.

**Examples of specimens.** 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)(1), (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).

(2) Submit a request to 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 such as providing a specimen.

The USPTO will not accept an amended drawing submitted in response to this refusal because the changes would materially alter the drawing of the mark in the original application or as previously acceptably amended. See 37 C.F.R. §2.72(a)-(b); TMEP §807.14. Specifically, the marks in the specimen does not include the black "THEEDIGITAL" wording. This wording is highly distinctive and contributes greatly the commercial impression of the mark. Deletion of distinctive matter from a mark results in a material alteration of the mark. See In re Dillard Dep't Stores, Inc., 33 USPQ2d 1052 (Comm'r Pats. 1993). For more information about drawings and instructions on how to satisfy these response options using the online Trademark Electronic Application System (TEAS) form, see the Drawing webpage.

Although applicant's mark has been refused registration, applicant may respond to the refusal(s) by submitting evidence and arguments in support of registration. However, if applicant responds to the refusal(s), applicant must also respond to the requirement(s) set forth below.

#### REQUIREMENT - CLASSIFICATION AND IDENTIFICATION OF SERVICES

The wording "Web Design" in the identification of services is indefinite and must be clarified because the specific type of web design service must be indicated for example, website design, homepage and webpage design, design of computer website design software. *See* 37 C.F.R. §2.32(a)(6); TMEP §1402.01.

The services "Digital Marketing Services" are classified incorrectly. Applicant must amend the application to classify the goods and/or services in International Class 35. See 37 C.F.R. §§2.32(a)(7), 2.85; TMEP §§1401.02(a), 1401.03(b).

Applicant should note that any wording in **bold**, in *italics*, <u>underlined</u> and/or in ALL CAPS below offers guidance and/or shows the changes being proposed for the identification of goods and/or services. If there is wording in the applicant's version of the identification of goods and/or services which should be removed, it will be shown with a line through it such as this: <u>strikethrough</u>. When making its amendments, applicant should enter them in standard font, not in **bold**, in *italics*, <u>underlined</u> or in ALL CAPS.

Applicant may substitute the following wording, if accurate:

## **Class 35**: **Digital marketing services**

<u>Class</u> 42: Web design services, namely, \_\_\_ {indicate particular services, e.g., website design, homepage and webpage design, design of computer website design software} and Digital Marketing Services

See TMEP §§1402.01, 1402.03.

An applicant may only amend an identification to clarify or limit the services, but not to add to or broaden the scope of the services. 37 C.F.R. §2.71(a); see TMEP §\$1402.06 et seq., 1402.07. Generally, any deleted services may not later be reinserted. See 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.

# <u>Advisory – Multiple Class Application</u>

The application references goods and/or services based on use in commerce in more than one international class; therefore, applicant must satisfy all the requirements below for each international class:

- (1) List the goods and/or services by their international class number in consecutive numerical order, starting with the lowest numbered class (for example, International Class 3: perfume; International Class 18: cosmetic bags sold empty).
- (2) Submit a filing fee for each international class not covered by the fee(s) already paid (view the USPTO's current fee schedule). Specifically, the application identifies goods and/or services based on use in commerce that are classified in at least 2 classes; however, applicant submitted a fee(s) sufficient for only 1 class(es). Applicant must either (a) submit the filing fees for the classes not covered by the submitted fees or (b) restrict the application to the number of classes covered by the fees already paid.
- (3) Submit verified dates of first use of the mark anywhere and in commerce for each international class. See more information about verified dates of use.
- (4) **Submit a specimen for each international class.** The current specimen is not acceptable for any international class. See more information about specimens.

**Examples of specimens.** 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).

(5) Submit a verified statement that "The specimen was in use in commerce on or in connection with the goods and/or services listed in the application at least as early as the filing date of the application." See more information about verification.

See 37 C.F.R. §2.86(a); TMEP §§1403.01, 1403.02(c).

For an overview of the requirements for a Section 1(a) multiple-class application and how to satisfy the requirements online using the Trademark Electronic Application System (TEAS) form, see the Multiple-class Application webpage.

REQUIREMENT - COLOR CLAIM AND MARK DESCRIPTION

Applicant must clarify whether color is a feature of the mark because, although the drawing shows the mark in color, the application does not state whether color is a feature of the mark. 37 C.F.R. §§2.37, 2.52(b)(1), 2.61(b); see TMEP §807.07(a)-(a)(ii). Applicant must also submit an amended description of the mark because the current one is incomplete and does not describe all the significant aspects of the mark, in particular the design element forming the letter "E". 37 C.F.R. §2.37; see TMEP §§808.01, 808.02. Descriptions must be accurate and identify all the literal and design elements in the mark. See 37 C.F.R. §2.37; TMEP §§808 et seq.

Applicant may respond to this requirement by satisfying one of the following:

- (1) If **color** is not a feature of the mark, applicant must submit a black-and-white drawing of the mark to replace the color drawing. See TMEP \$807.07(a)(i). However, any other amendments to the drawing will not be accepted if they materially alter the mark. 37 C.F.R. \$2.72; see TMEP \$\$807.14 et seq. Applicant must also submit a revised description of all literal and design elements in the mark, deleting any reference to color, if appropriate. 37 C.F.R. \$2.37; see TMEP \$\$808.01, 808.02. The following description is suggested, if accurate: The mark consists of a square shape that has a cutout forming the letter "E". To the right of the square shape is the stylized wording "THEEDIGITAL".
- (2) If **color** is a **feature of the mark**, applicant must submit a statement (a) listing all the colors that are claimed as a feature of the mark and (b) describing all the literal and design elements in the mark that specifies where each color appears in those elements. 37 C.F.R. §§2.37, 2.52(b)(1); TMEP §807.07(a)-(a)(ii). Generic color names must be used to describe the colors in the mark, e.g., red, yellow, blue. TMEP §807.07(a)(i)-(ii). If black, white, and/or gray represent background, outlining, shading, and/or transparent areas and are not part of the mark, applicant must so specify in the description. *See* TMEP §807.07(d). The following color claim and description are suggested, if accurate:

Color claim: The colors blue and black are claimed as a feature of the mark.

Description: The mark consists of a blue square shape that has a cut-out forming the letter "E". To the right of the square shape is the stylized black wording "THEEDIGITAL". The color white indicates transparent area and is not a part of the mark.

See TMEP §807.07(b).

# CONCLUSION

**Response guidelines**. For this application to proceed, applicant must explicitly address each refusal and/or requirement in this Office action. For a refusal, applicant may provide written arguments and evidence against the refusal, and may have other response options if specified above. For a requirement, applicant should set forth the changes or statements. Please see "Responding to Office Actions" and the informational video "Response to Office Action" for more information and tips on responding.

If applicant has questions regarding this Office action, please telephone or e-mail the assigned trademark examining attorney. All relevant e-mail communications will be placed in the official application record; however, an e-mail communication will not be accepted as a response to this Office action and will not extend the deadline for filing a proper response. *See* 37 C.F.R. §§2.62(c), 2.191; TMEP §§304.01-.02, 709.04-.05. Further, although the trademark examining attorney may provide additional explanation pertaining to the refusal(s) and/or requirement(s) in this Office action, the trademark examining attorney may not provide legal advice or statements about applicant's rights. *See* TMEP §§705.02, 709.06.

How to respond. Click to file a response to this nonfinal Office action.

/Stefan Oehrlein/ Trademark Examining Attorney Law Office 115 (571) 272-1308 stefan.oehrlein@uspto.gov

### RESPONSE GUIDANCE

- Missing the response deadline to this letter will cause the application to <u>abandon</u>. The response must be received by the USPTO before midnight **Eastern Time** of the last day of the response period. TEAS maintenance or <u>unforeseen circumstances</u> 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 23, 2022 for U.S. Trademark Application Serial No. 97118540

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 <u>abandoned</u>. See the Office action itself regarding how to respond.
- (3) **Direct general questions** about using USPTO electronic forms, the USPTO <u>website</u>, the application process, the status of your application, and whether there are outstanding deadlines to the <u>Trademark Assistance Center (TAC)</u>.

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

- <u>Check the status</u> of your application periodically in the <u>Trademark Status & Document Retrieval (TSDR)</u> database to avoid missing critical deadlines.
- <u>Update your correspondence email address</u> 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.

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(5 and 8) not (17 18 19 20 21 24 25 26 27 31)

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	004		1,	001		0.01	15)
18	645	0	11	645	0	0:01	((4 5 6) and 9) not
	0.10			0.0		0.01	(17)
19	267	0	15	267	0	0:01	((3) and 9) not (17
	201		10	20,		0.01	18)
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							15)) not (17 18 19 20)
22	908	0	10	908	0	0:01	7 and 21
23	578	0	13	578	0	0:01	21 not 22
24	473	0	12	473	0	0:01	( (11 12) and (13 14
							15)) not (17 18 19 20
							21)
25	98	0	10	98	0	0:01	( (13 and 14 )) not (17
							18 19 20 21 24)
26	114	0	15	114	0	0:01	( (11 and 12 )) not (17
							18 19 20 21 24 25)
27	98	0	9	98	0	0:01	( (15 and (13 14) ))
							not (17 18 19 20 21 24
							25 26)
28	0	0	0	0	0	0:01	( (10 and (260931[dc]
							not dead[ld]) )) not
							(17 18 19 20 21 24 25
							26 27)
29	1908	N/A	0	0	0	0:01	( (10 and (260921[dc]
							not dead[ld]) )) not
							(17 18 19 20 21 24 25
							26 27)
30		N/A	0	0		0:01	7 and 29
31	582	0	14	582	0	0:01	(4 5 6) and 30
32	2283	N/A	0	0	0	0:01	(4 and 8) not (17 18 19
							20 21 24 25 26 27 31)
33	1822	N/A	0	0	0	0:01	(5 and 8) not (17 18 19
							20 21 24 25 26 27 31)
34	0	0	0	0	0	0:01	(29 and 8) not (17 18
							19 20 21 24 25 26 27
							31)

Session started 8/23/2022 2:17:14 PM Current time 8/23/2022 2:36:20 PM Total search duration 0 minutes 42 seconds Session still in progress

Default NEAR limit= 1 ADJ limit= 1

#	Total	Dead	Live	Live	Printed	Status/	Search
	Marks	Marks	Viewed	Viewed		Search	
			Docs	Images		Duration	
01	1	0	1	1	0	0:01	97118540[SN]
02	1	0	1	1	0	0:01	TheeTechnology[on]
03	4086035	N/A	0	0	0	0:01	"042" [cc]
04	1195280	N/A	0	0	0	0:01	"035"[ic]("a" "B" "200")[ic]
05	979108	N/A	0	0	0	0:01	"042"[ic]("a" "B"
06	1563315	N/A	0	0	0	0:02	"200")[ic] "009"[ic]("a" "B"
07	296	N/A	0	0	0	0:01	"200")[ic] (*THEE* "the e")[bi,ti]
08	4731	N/A	0	0	0	0:02	not dead[1d]
							*D{V0:2}{"GJ"1:2}{V0:2}{ "T"1:2}{V0:2}L*[bi,ti] not dead[ld]
09	26	0	26	26	0	0:01	*eD{V0:2}{"GJ"1:2}{V0:2} {"T"1:2}{V0:2}L*[bi,ti] not dead[ld]
10	1	0	1	1	0	0:01	"e digital"[bi,ti] not dead[ld]
11	1	0	1	1	0	0:01	8 and 7
12	47	0	6	47	0	0:01	(4 and 7)
13	120	0	15	120	0	0:01	"the digital"[bi,ti]
14	2	0	2	2	0	0:01	not dead[1d]
							*thedigital*[bi,ti] not dead[ld]
15	14	0	14	13	0	0:01	(5 and 7) not (12)
16	21	0	21	20	0	0:01	(6 and 7) not (12 15)
17	67	0	67	66	0	0:02	(3 and 7) not (12 15 16)
18	147	0	14	147	0	0:01	(7) not (12 15 16 17)
19	1322	N/A	0	0	0	0:01	(4 and 8) not (7 13)
20	769376	N/A	0	0	0	0:02	*TH{"IYE"}*[bi,ti] not
21	352	N/A	1	1	0	0:01	dead[1d] 8 and 20
22	231	0	16	231	0	0:01	21 not (7 13)
23	548	N/A	0	1	0	0:01	21 1100 (7 15)
							<pre>(*th{"i"0:1}{"E"1:3}{"iy eah"0:1}d* *th{"E"1:2}{"IY"1:2}{"iy e"0:2}d* *th{"E"0:2}{"IY"1:2}{"iy e"1:2}d*)[bi,ti] not dead[ld]</pre>
24 25	541 4570	O N/A	14	541 0	0	0:01 0:01	23 not (7 13 22) digital[bi,ti] not
26	319459	N/A	0	0	0	0:03	dead[1d]
27	1466	N/A	0	0	0	0:01	not dead[1d] 8 and 26
28	1176	N/A	0	1	0	0:01	((4 5 6) and 27) not (7 13 22 24)
29	750	0	18	750	0	0:01	((4) and 27) not (7 13 22 24)
30	426	0	17	426	0	0:01	((5 6 ) and 27) not (7 13 22 24 29)
31	701251	N/A	0	5	0	0:03	
							<pre>(th("i"0:1){"E"1:3}{"iye ah"0:1) th("E"1:2}{"IY"1:2}{"iye "0:2} th("E"0:2){"IY"1:2}{"iye "1:2})[bi,ti] not dead[Id]</pre>
32	41	0	41	41	0	0:02	
							(th{"i"0:1}{"E"1:3}{"iye ah"0:1} th{"E"1:2}{"IY"1:2}{"iye "0:2} th{"E"0:2}{"IY"1:2}{"iye "1:2}}[fm] not dead[ld]
33	840	N/A	0	0	0	0:01	((5 ) and 8) not (7 13 22 24 29 30 32)
34	500	0	12	500	0	0:01	((4 ) and 8) not (7 13 22 24 29 30 32)
35	704	0	18	704	0	0:01	((5 ) and 8) not (7 13 22 24 29 30 32 34)

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Default NEAR limit= 1 ADJ limit= 1