

To: Cameron Mitchell(cameron@coppercanyonlaw.com)
Subject: U.S. Trademark Application Serial No. 97120517 - OUR EYES MATCH YOUR EYES - 01002
Sent: August 23, 2022 09:03:38 AM 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. 97120517

Mark: OUR EYES MATCH YOUR EYES

Correspondence Address:

CAMERON MITCHELL
COPPER CANYON LAW, LLC
43 EAST 1ST AVENUE
MESA AZ 85210 UNITED STATES

Applicant: The Eye Concern, Inc.

Reference/Docket No. 01002

Correspondence Email Address: cameron@coppercanyonlaw.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 23, 2022

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.

I. SEARCH OF THE OFFICE RECORDS

No Prior Conflicting Marks

The examining attorney has searched the Office records and has found no similar registered or pending mark which would bar registration under Trademark Act Section 2(d), 15 U.S.C. §1052(d). TMEP §704.02.

II. INFORMALITIES

Although there is no conflict with any prior registered or pending marks, the applicant must respond to the following issue(s).

Application Refused—Section 1(a)--Specimen Does Not Indicate Use in Relation to the Identified Goods

An application based on Trademark Act Section 1(a) must include a specimen showing the applied-for mark in use 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). The current specimen(s) do not demonstrate proper use of the proposed mark in relation to the goods specified in the application.

Section 45 of the Trademark Act requires use of the mark “on the goods, their containers or the displays associated therewith, or on the tags or labels affixed thereto”. 15 U.S.C. §1127; TMEP §§901.01, 904.03. Material that functions merely to tell the prospective purchaser about the goods, or to promote the sale of the goods, is not acceptable to support trademark use. Similarly, leaflets, handbills, brochures, advertising circulars and other printed advertising material or informational inserts are generally not acceptable to show trademark use. *In re MediaShare Corp.*, 43 USPQ2d 1304 (TTAB 1997); *In re Schiapparelli Searle*, 26 USPQ2d 1520 (TTAB 1993); *In re Drilco Industrial Inc.*, 15 USPQ2d 1671 (TTAB 1990); *In re ITT Rayonier Inc.*, 208 USPQ 86 (TTAB 1980); *In re Bright of America, Inc.*, 205 USPQ 63 (TTAB 1979); TMEP 904.04(b). However, an instruction sheet may be an acceptable specimen. *In re Ultraflight Inc.*, 221 USPQ 903 (TTAB 1984); TMEP §§904.04(b), (c), 1301.04.

In this case, the specimen consists of a partial copy of the applicant's webpage and a business card. Although the proposed mark is displayed on the specimen, the specimen is not acceptable to demonstrate use of the proposed mark with the goods listed in the application. Neither specimen shows the proposed mark used as a label for, or indicator of source of, the proposed goods. TMEP §§904.03, 904.04(b)-(c).

With respect to the webpage, the current specimen is deficient because it does not show a means for ordering the identified goods. A webpage or catalog display specimen (1) must show use of the mark directly associated with the goods and (2) such use must be of a point-of-sale nature. 37 C.F.R. §2.56(b)(1). This means that this type of display specimen must include the following:

- (1) A **picture or sufficient textual description of the goods**;
- (2) The **mark associated with the goods**; and
- (3) A **means for ordering the goods** such as a “shopping cart” button/link, an order form, or a telephone number for placing orders.

See *In re Sones*, 590 F.3d 1282, 1286-89, 93 USPQ2d 1118, 1122-24 (Fed. Cir. 2009); *In re Azteca Sys., Inc.*, 102 USPQ2d 1955, 1957-58 (TTAB 2012); *In re Dell Inc.*, 71 USPQ2d 1725, 1727 (TTAB 2004); *Lands' End v. Manbeck*, 797 F. Supp. 511, 514, 24 USPQ2d 1314, 1316 (E.D. Va. 1992); TMEP §904.03(h), (i)-.03(i)(D).

In this case, the webpage specimen does not show sufficient means for ordering the goods. Specifically, there is no "buy now" button or order form for the goods. Accordingly, the submitted webpage specimen is deemed to be mere advertising, which is not acceptable as a specimen for goods. See *In re Yarnell Ice Cream, LLC*, 2019 USPQ2d 265039, at *15-16 (TTAB 2019) (quoting *In re Siny Corp.*, 920 F.3d 1331, 1336, 2019 USPQ2d 127099, at *2-3 (Fed. Cir. 2019)); see also *Avakoff v. S. Pac. Co.*, 765 F.2d 1097, 1098, 226 USPQ 435, 436 (Fed. Cir. 1985); TMEP §904.04(b), (c).

With respect to the business card, not only is there no ordering information on the card for the eye prosthetic, but it seems to indicate that the proposed mark and person named on the card is providing ocularist/prosthetic eye fitting services, not producing the underlying good--the ocular prosthetic that is to be fitted. Accordingly, registration is refused because the specimens do not show the applied-for mark in use in commerce in connection with any of the goods specified 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); *In re Graystone Consulting Assocs., Inc.*, 115 USPQ2d 2035, 2037-38 (TTAB 2015); *In re Chengdu AOBi Info. Tech. Co.*, 111 USPQ2d 2080, 2081-82 (TTAB 2011); TMEP §§904, 904.07(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.

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). Leaflets, handbills, advertising circulars, and other advertising materials are generally not acceptable specimens for goods. See TMEP §§904.03 *et seq.* 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). **Please Note:** Any webpage printout or screenshot submitted as a specimen must include the webpage's URL and the date it was accessed or printed. 37 C.F.R. §2.56(c).

- (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](#).

Applicant's Response

There is no required format or form for responding to an Office action. For this application to proceed further, the applicant must explicitly address each refusal and/or requirement raised in this Office action. If the action includes a refusal, the applicant may provide arguments and/or evidence as to why the refusal should be withdrawn and the mark should register. The applicant may also have other options specified in this Office action for responding to a refusal and should consider those options carefully. To respond to requirements and certain refusal response options, the applicant should set forth in writing the required changes or statements. For more information and general tips on responding to USPTO Office actions, response options, and how to file a response online, please see “[Responding to Office Actions](#)” and the informational [video “Response to Office Action”](#) on the USPTO's website.

If the applicant does not respond to this Office action within six months of the issue/ mailing date, or responds by expressly abandoning the application, the application process will end and the trademark will fail to register. *See* 15 U.S.C. §1062(b); 37 C.F.R. §§2.65(a), 2.68(a); TMEP §§718.01, 718.02. Additionally, the USPTO will not refund the application filing fee, which is a required processing fee. *See* 37 C.F.R. §§2.6(a)(1)(i)-(iv), 2.209(a); TMEP §405.04. When an application has abandoned for failure to respond to an Office action, an applicant may timely file a petition to revive the application, which, if granted, would allow the application to return to active status. *See* 37 C.F.R. §2.66; TMEP §1714. The petition must be filed within two months of the date of issuance of the notice of abandonment and may be filed online via the Trademark Electronic Application System (TEAS). *See* 37 C.F.R. §§2.6(a)(15)(ii), 2.66(a)(1), (b)(1)

Responses to Office actions must be properly signed. *See* 37 C.F.R. §§2.62(b), 2.193(e)(2); TMEP §§712, 712.01. If an applicant is not represented by a U.S.-licensed attorney, the response must be signed by the individual applicant or someone with legal authority to bind a juristic applicant (e.g., a corporate officer or general partner). *See* 37 C.F.R. §2.193(e)(2)(ii); TMEP §§611.03(b), 611.06(b)-(h), 712.01. In the case of joint applicants, all must sign. 37 C.F.R. §2.193(e)(2)(ii); TMEP §611.06(a).

If an applicant is represented by a U.S.-licensed attorney authorized to practice before the USPTO, the attorney must sign the response. 37 C.F.R. §2.193(e)(2)(i); TMEP §712.01. The only attorneys who may sign responses are (1) attorneys in good standing with a bar of the highest court of any U.S. state or territory, or (2) Canadian trademark attorneys or agents reciprocally recognized by the USPTO's Office of Enrollment and Discipline (OED) to represent applicants located in Canada and who are working under a qualified U.S.-licensed attorney. *See* 37 C.F.R. §§2.17(a), 11.14(a), (c), (e); TMEP §602. Foreign attorneys, other than recognized Canadian trademark attorneys or agents, do not have authority to sign responses. *See* 37 C.F.R. §§2.17(e), 11.14(c)(1), (e); TMEP §602.03-.03(a). If an applicant is initially represented by an attorney, and then later retains another U.S.-licensed attorney from a different firm, the newly retained attorney may not sign responses until the applicant files a new power and/or revocation of attorney. *See* 37 C.F.R. §2.18(a)(7); TMEP §604.03. **Please Note:** In all cases, the signer must be identified by first and last name and title or position. 37 C.F.R. §2.193(d).

If the applicant has technical questions about the TEAS response to Office action form, applicant can review the electronic filing tips available online at <http://www.uspto.gov/teas/eFilingTips.htm> and email technical questions to TEAS@uspto.gov.

If the applicant or its appointed attorney has any questions or needs assistance in responding to this Office action, please telephone the assigned examining attorney.

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

/Michael Tanner/
Michael Tanner
Trademark Examining Attorney
Law Office 119
(571) 272-9706
michael.tanner@uspto.gov

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 23, 2022 for
U.S. Trademark Application Serial No. 97120517

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: Michael Tanner

Statistics for Case 97120517						
#	Search	Total Marks	Dead Marks	Live Viewed Docs	Live Viewed Images	Status/Search Duration
1	*eye{"sz"}*[bi,ti]	5257	0	0	0	0:00
2	*eye{"sz"0:1}*[bi,ti]	23960	0	0	0	0:01
3	*m{v}tch*[bi,ti]	8065	0	0	0	0:01
4	your[bi,ti]	95567	0	0	0	0:01
5	our[bi,ti]	16979	0	0	0	0:00
6	r[bi,ti]	33221	0	0	0	0:01
7	2 and (3 or 4 or 5 or 6)	759	0	195	195	0:02
8	3 and (4 or 5 or 6)	130	0	37	37	0:02
9	4 and (5 or 6)	3199	0	0	0	0:01
10	9 and "010"[cc]	1393	0	489	489	0:01
11	*match*[bi,ti]	7354	0	0	0	0:00
12	11 and "010"[cc]	2374	0	0	0	0:02
13	11 and ("010" "005" or "a" or "b" or "200")[ic]	195	0	89	89	0:07
14	(*our\$eye* or *r\$eye* or "r eyes" or "r eyez" or "our eyes" or "our eyez")[bi,ti]	1969	0	0	0	0:11
15	14 and "010"[cc]	512	0	195	195	0:02
16	(*your\$eye* or *ur\$eye* or "ur eyes" or "ur eyez" or "your eyes" or "your eyez")[bi,ti]	535	0	164	164	0:01
17	(15 or 16) and 3	2	0	1	1	0:00

Session started 08/23/2022 8:33 am

Session ended 08/23/2022 8:47 am

Total search duration 33.00

Session duration 13 minutes 41 seconds

Adjacency Level 1

Near Level 1