

**To:** Raymond Rundelli([ipdocket@calfee.com](mailto:ipdocket@calfee.com))  
**Subject:** U.S. Trademark Application Serial No. 97120015 - CAP10 PARTNERS - 38226/04005  
**Sent:** August 23, 2022 03:17:46 PM EDT  
**Sent As:** [tmng.notices@uspto.gov](mailto:tmng.notices@uspto.gov)

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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.** 97120015

**Mark:** CAP10 PARTNERS

**Correspondence Address:**

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**Applicant:** CAP10 PARTNERS LLP

**Reference/Docket No.** 38226/04005

**Correspondence Email Address:** [ipdocket@calfee.com](mailto:ipdocket@calfee.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

**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 RESULTS FROM USPTO DATABASE FOR CONFLICTING MARKS

The trademark examining attorney has searched the USPTO database of registered and pending marks and has 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:

- Section 44(e) Refusal-- European Union Registration is Not from Applicant's Country of Origin
- Disclaimer Required
- Identification Amendment Required
- Clarification of Applicant's Entity Type Required

## SECTION 44(e) REFUSAL-- EUROPEAN UNION REGISTRATION IS NOT FROM APPLICANT'S COUNTRY OF ORIGIN

**Registration is refused under Trademark Act Section 44(e) because the European Union (EU) registration is not from applicant's country of origin.** *See* 15 U.S.C. §1126(e); 37 C.F.R. §2.34(a)(3)(ii); TMEP §1002.01. Under Section 44(c), "country of origin" is defined as the country in which an applicant (1) is domiciled, (2) has a bona fide and effective industrial or commercial establishment, or (3) is a national. 15 U.S.C. §1126(c); TMEP §1002.04.

Applicant submitted a trademark registration from the EU to support applicant's Section 44(e) basis. On or after January 1, 2021, EU trademark registrations ceased covering the United Kingdom (UK). *See [Agreement on the Withdrawal of the UK from the EU & the European Atomic Energy Cmty.](#)* arts. 54-61, Dec. 11, 2019, 2019 O.J. (C 384) 1. However, the U.S. application indicates that applicant is domiciled and/or incorporated or organized in the UK and is not domiciled or incorporated or organized in a country in the EU. Therefore, applicant must establish that, as of the date of issuance of the EU registration, one of the remaining countries in the EU is applicant's country of origin. *See* 15 U.S.C. §1126(c); TMEP §1002.04.

To overcome this refusal, applicant may provide the following written statement for the record: **"Applicant has had a bona fide and effective industrial or commercial establishment in the European Union as of the date of issuance of the foreign registration."** TMEP §1002.04. Alternatively, applicant may provide an active UK trademark registration for the same mark and goods or services. Further, if applicant cannot assert that an EU country is a country of origin or provide a UK trademark registration, applicant may delete the Section 44(e) basis and substitute Section 1(a) or 1(b), if applicant can satisfy all the requirements for the new basis. *See* 15 U.S.C. §§1051(a)-(b), 1126(e); 37 C.F.R. §2.35(b); TMEP §§806.03, 1002.01.

To amend an application to one based on a bona fide intention to use the mark in commerce under Trademark Act Section 1(b), an applicant must provide the following statement, **verified with an affidavit or signed declaration under 37 C.F.R. §2.20**: **"Applicant has a bona fide intention to use the mark in commerce and had a bona fide intention to use the mark in commerce as of the application filing date."** *See* 37 C.F.R. §2.34(a)(2).

For more information about Section 1(b) basis requirements, and instructions on how to satisfy them online using the Trademark Electronic Application System (TEAS) form, please go to the [Basis 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.

## DISCLAIMER REQUIRED

Applicant must disclaim the wording "PARTNERS" because it merely designates the legal character or family business structure of an entity and does not indicate the source of applicant's services. *See* 15 U.S.C. §§1051-1053, 1127; *In re Piano Factory Grp., Inc.*, 85 USPQ2d 1522, 1526 (TTAB 2006); *In re Patent & Trademark Servs., Inc.*, 49 USPQ2d 1537, 1539-40 (TTAB 1998); TMEP §1213.03(d).

Business type designations and abbreviations such as "Corporation," "Inc.," "Company," "LLC," and "Ltd." or family business designations such as "& Sons" or "Bros." must be disclaimed, because they merely indicate applicant's business type or structure and generally have no source-indicating capacity. TMEP §1213.03(d); *see, e.g., Goodyear's India Rubber Glove Mfg. Co. v. Goodyear Rubber Co.*, 128 U.S. 598, 602-03 (1888); *In re Piano Factory Grp., Inc.*, 85 USPQ2d at 1526; *In re Patent & Trademark Servs., Inc.*, 49 USPQ2d at 1539-40.

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

**No claim is made to the exclusive right to use "PARTNERS" 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](#).

Applicant must additionally respond to the requirement below.

## IDENTIFICATION AMENDMENT REQUIRED

Select entries in applicant's identification are indefinite because the wording is overly vague and the nature, use, or purpose of applicant's services is unclear. *See* TMEP §§1402.01, 1402.03. Other entries are indefinite because the wording describes services in multiple International Classes. *See* TMEP §§1402.01, 1402.03.

If accurate, applicant may adopt the following wording:

Class 36: Financial services, **namely, {indicate specific financial services, e.g., financial restructuring services, money lending, financial portfolio analysis services}**; financial management services; investment services, **namely, {indicate specific, e.g., capital investment services, investment advisory services, investment banking services}**; financial asset management services; hedge fund **investment** services; capital investment; debt advisory

services; factoring **agencies**; financial analysis; financial appraisals in responding to calls for tenders; financial appraisals in responding to requests for proposals; financial consultancy; financial research; providing financial information; financing services; investment of funds; lending against security, **namely, securities lending**; loans financing; mutual funds **services, namely, {indicate specific, e.g., mutual fund distribution, mutual fund brokerage, mutual fund investment}**; provident fund services, **namely, {indicate specific using common commercial name, e.g., individual retirement account services}**; business liquidation services, financial; debt collection agency services; financial evaluation **for insurance and banking purpose and of real estate**; financial sponsorship of **{indicate specific event or activity}**; financial valuation of intellectual property assets; organisation of monetary collections, **namely, {indicate specific using common commercial name, e.g., collection of money owed from settlements, debt collection agency services, collection of debts}**; trusteeship and fiduciary **representatives** services; providing advice, information and consultancy on the foregoing

Applicant's goods and/or services may be clarified or limited, but may not be expanded beyond those originally itemized in the U.S. 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 in or encompassed by those in the original U.S. 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). Additionally, for U.S. applications filed under Trademark Act Section 44(e), the scope of the identification for purposes of permissible amendments may not exceed the scope of the goods and/or services identified in the foreign registration. 37 C.F.R. §2.32(a)(6); *Marmark, Ltd. v. Nutrexp, S.A.*, 12 USPQ2d 1843, 1845 (TTAB 1989) (citing *In re Löwenbräu München*, 175 USPQ 178, 181 (TTAB 1972)); TMEP §§1012, 1402.01(b).

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.

Applicant must additionally respond to the requirement below.

## CLARIFICATION OF APPLICANT'S ENTITY TYPE REQUIRED

Applicant included the designation "LLP" in its name; however, the legal entity is set forth as company. A limited liability partnership (LLP) is separate and distinct from a company. TMEP §803.03(i). Applicant must clarify the inconsistency between the designation in applicant's name and the identified entity type. *See* 37 C.F.R. §§2.32(a)(3)(iii), 2.61(b); TMEP §803.03(b), (k).

If applicant is a limited liability partnership, applicant must specify only the state or country where the LLP is organized; the names of the partners of a limited liability partnership are not required. TMEP §803.03(k).

If, in response to the above request, applicant provides information indicating that it is not the owner of

the mark, registration will be refused because the application was void as filed. *See* 37 C.F.R. §2.71(d); TMEP §§803.06, 1201.02(b). An application must be filed by the party who owns or is entitled to use the mark as of the application filing date. *See* 37 C.F.R. §2.71(d); TMEP §1201.02(b).

**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 23, 2022 for  
**U.S. Trademark Application Serial No. 97120015**

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: Justine Burke

Statistics for Case 97120015						
#	Search	Total Marks	Dead Marks	Live Viewed Docs	Live Viewed Images	Status/Search Duration
1	97120015[sn]	1	0	1	1	0:00
2	"cap10 partners"[bi,ti]	1	0	1	1	0:00
3	"cap10 partners"[ow]	1	0	1	1	0:00
4	*{"ckqx"}{"a"1:2}P*[bi,ti] not dead[ld]	19554	0	1	1	0:01
5	("10" "1 0" *ten*)[bi,ti] not dead[ld]	23679	0	0	0	0:01
6	*partner*[bi,ti] not dead[ld]	6178	0	0	0	0:01
7	4 and 5 and 6	1	0	1	1	0:01
8	4 and (5 6)	621	0	0	0	0:02
9	4 and 5	127	0	127	127	0:02
10	*{"ckqx"}{"a"1:2}P\$ten*[bi,ti] not dead[ld]	8	0	8	8	0:00
11	*{"ckqx"}{"a"1:2}P\$10*[bi,ti] not dead[ld]	19554	0	0	0	0:14
12	5 and 6	51	0	51	51	0:01

Session started 08/23/2022 2:03 pm

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