

**To:** Patric J. Rawlins([docketing@procopio.com](mailto:docketing@procopio.com))  
**Subject:** U.S. Trademark Application Serial No. 97119737 - LPI EDUCATING CALIFORNIA'S LEGAL SUPPORT PROFESSIONALS - 93002304US01  
**Sent:** August 24, 2022 03:09:19 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.** 97119737

**Mark:** LPI EDUCATING CALIFORNIA'S LEGAL SUPPORT PROFESSIONALS

**Correspondence Address:**

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SAN DIEGO CA 92101 UNITED STATES

**Applicant:** Legal Professionals, Incorporated

**Reference/Docket No.** 93002304US01

**Correspondence Email Address:** [docketing@procopio.com](mailto:docketing@procopio.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 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.

**DATABASE SEARCH**

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:

- **Specimen Refusal, as to class 016 ONLY**
- **Amended Identification of Services Required, as to class 041 ONLY**
- **Disclaimer Required**

**SPECIMEN REFUSAL**

*Applies to class 016 ONLY*

**Specimen is not an acceptable webpage display.** Registration is refused because the specimen in International Class 016 is not acceptable as a display associated with the goods and does not show the applied-for mark as actually used in commerce. Trademark Act Sections 1 and 45, 15 U.S.C. §§1051, 1127; 37 C.F.R. §2.56(a), (b)(1); *see* TMEP §§904, 904.03(g)-(i), 904.07(a). 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 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).

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 specimen does not show sufficient means for ordering the goods. Specifically, the specimen shows the mark on the webpage along side a picture and textual description of the goods. However, there appears to be no way to purchase the good from the website. Thus, the specimen does not constitute a point of sale display and is not acceptable for the class 016 goods.

Accordingly, such material is 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).

**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). As specified above, 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). 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 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](#).

**Applicant should also note the following additional requirements.**

### **AMENDED IDENTIFICATION OF SERVICES REQUIRED**

*Applies to class 041 ONLY*

The wording “providing and conducting workshops and seminars directed to legal professionals and others in the legal field” in the identification of services is indefinite and must be clarified because the field of the educational series is not stated. *See* 37 C.F.R. §2.32(a)(6); TMEP §1402.01. Applicant must state the specific field or field of the educational services, e.g. law.

Applicant may substitute the following wording, if accurate:

Class 009: Downloadable electronic publications for legal professionals in the nature of magazines, manuals and handbooks

Class 016: Printed publications, namely, books and manuals for legal professionals and others in the legal field

Class 035: Association services, namely, promoting the interests of legal professionals and others in the legal field

Class 041: Educational services, namely, providing and conducting workshops and seminars **in the field of {state fields of services, e.g. law, business administration, etc.}** directed to legal professionals and others in the legal field

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

### **DISCLAIMER REQUIRED**

Applicant must disclaim the wording “EDUCATING CALIFORNIA'S LEGAL SUPPORT PROFESSIONALS” because it is merely descriptive of an ingredient, quality, characteristic, function, feature, purpose, or use of applicant's goods and 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).

First, applicant's identification includes "educational services". Thus, "EDUCATING" describes a function of applicant's services and must be disclaimed.

Second, applicant is located in California. Thus, "CALIFORNIA'S" describes the geographical scope of the goods and services and also must be described.

Third, applicant's goods and services are specifically aimed at "legal professionals". Thus, "LEGAL SUPPORT PROFESSIONALS" describes the intended audience for applicant's goods and services and also must be disclaimed.

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

**No claim is made to the exclusive right to use “EDUCATING CALIFORNIA'S LEGAL SUPPORT PROFESSIONALS” 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](#).

### **RESPONDING TO THIS OFFICE ACTION**

**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.

**Assistance.** 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.

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. 97119737**

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: Carolyn Detmer

Statistics for Case 97119737						
#	Search	Total Marks	Dead Marks	Live Viewed Docs	Live Viewed Images	Status/Search Duration
1	97119737[sn]	1	0	1	1	0:01
2	"Legal Professionals"[on]	9	3	6	6	0:00
3	("l p i" "l pi" "lp i" *lpi*)[bi,ti] not dead[ld]	2159	0	0	0	0:01
4	*d{v}{ "ckqx" }{v}t*[bi,ti] and live[ld]	7520	0	0	0	0:01
5	*{"ckqx"}{v}l{"iey"}f{v}rn{v}*[bi,ti] and live[ld]	3596	0	0	0	0:13
6	*{"ckqx"}{v}l{"iey"}ph{v}rn{v}*[bi,ti] and live[ld]	0	0	0	0	0:23
7	*l{v}{ "gj" }{v}l*[bi,ti] and live[ld]	2552	0	0	0	0:07
8	*{"scz"}{v}{ "p":2 }{v}rt*[bi,ti] and live[ld]	2735	0	0	0	0:01
9	*pro*[bi,ti] and live[ld]	84175	0	0	0	0:01
10	3 and (4 5 7 8 9)	127	0	127	127	0:15
11	4 and (5 7 8 9)	591	0	0	0	0:15
12	5 and (7 8 9)	105	0	105	105	0:15
13	7 and (8 9)	124	0	124	124	0:02
14	8 and 9	148	0	148	148	0:01
15	11 not (10 12 13 14)	580	0	580	580	0:16
16	(011711 maps of states not TX)[dc] and live[ld]	2567	0	3	5	0:02
17	(170502 scales)[dc] and live[ld]	1277	0	7	11	0:01
18	16 and 17	15	0	4	15	0:01
19	3 and "009"[cc]	1125	0	0	0	0:00
20	3 and "009"	1132	0	0	0	0:00
21	3 and ("009" "016" "035" "041" a b "200")[ic]	876	0	0	0	0:01
22	3 and ("009" "016" "041" a b "200")[ic]	540	0	0	0	0:01
23	3 and ("035" a b "200")[ic]	424	0	424	424	0:01
24	22 not 23	452	0	452	452	0:01

Session started 08/24/2022 2:34 pm

Session ended 08/24/2022 2:57 pm

Total search duration 120.00

Session duration 22 minutes 45 seconds

Adjacency Level 1

Near Level 1