

**To:** John M. Manion([rkmip@rkmiplaw.com](mailto:rkmip@rkmiplaw.com))  
**Subject:** U.S. Trademark Application Serial No. 97118699 - W WELLS - 1090.24552  
**Sent:** August 23, 2022 01:13:06 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.** 97118699

**Mark:** W WELLS

**Correspondence Address:**

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**Applicant:** The Wells Companies, Inc.

**Reference/Docket No.** 1090.24552

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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 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.

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:

- Identifications of Services
- Advisory - Partial Abandonment

#### Identifications of Services

The identifications of services are indefinite and must be clarified because additional detail is required for the "preconstruction" and "planning" services. The wording "consulting services in the field of commercial, industrial, governmental, utility, institutional, educational, recreational, healthcare, residential and religious building construction services," is misclassified in CLASS 42. Building construction related consulting related services are properly classified in INT. CLASS 37. *See* 37 C.F.R. §2.32(a)(6); TMEP §1402.01. Applicant must amend the identification to specify the common commercial or generic name of the services. *See* TMEP §1402.01. If the services have no common commercial or generic name, applicant must describe or explain the nature of the services using clear and succinct language. *See id.*

The following substitute wording is suggested, if appropriate: (Note that proposed changes have been placed in bold type. Some items require applicant to include more complete information. These have been designated with **braces{ }** and/or **bold** type. The information in the braces is suggested as an example for applicant to follow and should not be merely "cut and pasted."):

- International Class 037: Commercial, industrial, governmental, utility, institutional, educational, recreational, healthcare, residential and religious building preconstruction and construction services, **namely, building construction planning and building construction**; Commercial, industrial, governmental, utility, institutional, educational, recreational, healthcare, residential and religious building maintenance services; machinery installation and repair; **Construction** planning services in the field of commercial, industrial, governmental, utility, institutional, educational, recreational, healthcare, residential and religious building construction services; **consulting services in the field of commercial, industrial, governmental, utility, institutional, educational, recreational, healthcare, residential and religious building construction services**
- International Class 042: Architectural design and engineering services; conceptual design of commercial, industrial, governmental, utility, institutional, educational, recreational, healthcare, residential and religious buildings

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

The USPTO has the discretion to determine the degree of particularity needed to clearly identify goods and/or services covered by a mark. *In re SICPA Holding*, 2021 USPQ2d 613, at \*4 (TTAB 2021) (quoting *In re Omega SA*, 494 F.3d 1362, 1365, 83 USPQ2d 1541, 1543-44 (Fed. Cir. 2007)). Accordingly, the USPTO requires the description of goods and/or services in a U.S. application to be specific, definite, clear, accurate, and concise. *In re tapio GmbH*, 2020 USPQ2d 11387, at \*6 (TTAB 2020) (quoting *In re Cordua Rests., Inc.*, 823 F.3d 594, 605, 118 USPQ2d 1632, 1639 (Fed. Cir. 2016)); TMEP §1402.01.

#### Advisory - Partial Abandonment

If applicant does not respond to this Office action within the six-month period for response, the following goods and/or services in International Classes 37 and 42 will be deleted from the application: Commercial, industrial, governmental, utility, institutional, educational, recreational, healthcare, residential and religious building preconstruction and construction services; planning services in the field of commercial, industrial, governmental, utility, institutional, educational, recreational, healthcare, residential and religious building construction services (CLASS 37); Consulting services in the field of commercial, industrial, governmental, utility, institutional, educational, recreational, healthcare, residential and religious building construction services (CLASS 42). The application will then proceed with the following goods and/or services in International Classes 37 and 42 only: **Commercial, industrial, governmental, utility, institutional, educational, recreational, healthcare, residential and religious building maintenance services (CLASS 37); Architectural design and engineering services; conceptual design of commercial, industrial, governmental, utility, institutional, educational, recreational, healthcare, residential and religious buildings (CLASS 42)**. See 37 C.F.R. §2.65(a)-(a)(1); TMEP §718.02(a).

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. 97118699**

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.