

To: Jess M. Collen(trademark@collenip.com)
Subject: U.S. Trademark Application Serial No. 97118872 - YSL - BX964
Sent: August 22, 2022 09:41:11 AM EDT
Sent As: tmng.notices@uspto.gov

Attachments

[90732604](#)

**United States Patent and Trademark Office (USPTO)
Office Action (Official Letter) About Applicant's Trademark Application**

U.S. Application Serial No. 97118872

Mark: YSL

Correspondence Address:

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Applicant: Yves Saint Laurent

Reference/Docket No. BX964

Correspondence Email Address: trademark@collenip.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 22, 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.

SEARCH OF USPTO DATABASE OF MARKS

The trademark examining attorney has searched the USPTO database of registered and pending marks and has determined the following. 15 U.S.C. §1052(d); TMEP §704.02.

SUMMARY OF ISSUES:

- Potential Refusal-Likelihood of Confusion
- Unsigned Application
- Identification
- Section 44- Option to Delete Section 1(b) Basis

POTENTIAL REFUSAL-LIKELIHOOD OF CONFUSION

The filing date of pending U.S. Application Serial No. 97032604 precedes applicant's filing date. See attached referenced application. If the mark in the referenced application registers, applicant's mark may be refused registration under Trademark Act Section 2(d) because of a likelihood of confusion between the two marks. *See* 15 U.S.C. §1052(d); 37 C.F.R. §2.83; TMEP §§1208 *et seq.* Therefore, upon receipt of applicant's response to this Office action, action on this application may be suspended pending final disposition of the earlier-filed referenced application.

In response to this Office action, applicant may present arguments in support of registration by addressing the issue of the potential conflict between applicant's mark and the mark in the referenced application. Applicant's election not to submit arguments at this time in no way limits applicant's right to address this issue later if a refusal under Section 2(d) issues.

Common Ownership Information

If the mark(s) in the potentially conflicting prior-filed application(s) has been assigned to applicant, applicant may provide evidence of ownership of the mark(s) to avoid a possible refusal under Trademark Act Section 2(d) based on a likelihood of confusion. *See* 15 U.S.C. §1052(d); TMEP §812.01.

Applicant may provide evidence of ownership of the mark(s) by satisfying one of the following:

- (1) Record the assignment with the USPTO's Assignment Recordation Branch (ownership transfer documents such as assignments can be filed online at <http://etas.uspto.gov>) and promptly notify the trademark examining attorney that the assignment has been duly recorded;
- (2) Submit copies of documents evidencing the chain of title; or
- (3) Submit the following statement, verified with an affidavit or signed declaration under 37 C.F.R. §2.20: **"Applicant is the owner of Application Serial No(s). 97032604."** To provide this statement using the Trademark Electronic Application System (TEAS), use the **"Response to Office Action"** form; answer "yes" to wizard questions #3 and #9; then, continuing on to the next portion of the form, in the "Additional Statement(s)" section, check the box for "Miscellaneous Statement" and write in the free form text field for the "Miscellaneous Statement" that "Applicant is the owner of

Application Serial No(s). 97032604,” inserting the relevant application serial number(s); and follow the instructions within the form for signing. The form must be signed twice; a signature is required both in the “Declaration Signature” section and in the “Response Signature” section.

TMEP §812.01; *see* 15 U.S.C. §1060; 37 C.F.R. §§2.193(e)(1), 3.25, 3.73(a)-(b); TMEP §502.02(a).

Recording a document with the Assignment Recordation Branch does not constitute a response to an Office action. TMEP §503.01(d).

Applicant must respond to the requirement(s) set forth below.

UNSIGNED APPLICATION

The application was unsigned, resulting in the application not being properly verified. *See* TMEP §804. Applicant must properly sign and therefore verify the application in an affidavit or signed declaration under 37 C.F.R. §2.20. *See* 37 C.F.R. §§2.2(n), 2.33(a)-(c), 2.34(a)(1)(i), (a)(2), (a)(3)(i), (a)(4)(ii); TMEP §804.02.

The following statements must be verified: That 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; that applicant believes applicant is entitled to use the mark in commerce on or in connection with the goods or services specified in the application; that applicant believes applicant is the owner of the mark; that the mark is in use in commerce and was in use in commerce as of the application filing date; that to the best of the signatory’s knowledge and belief, no other persons, except, if applicable, concurrent users, have the right to use the mark in commerce, either in the identical form or in such near resemblance as to be likely, when used on or in connection with the goods/services of such other persons, to cause confusion or mistake, or to deceive; that the specimen shows the mark as used on or in connection with the goods or services as of the application filing date; and that the facts set forth in the application are true. 37 C.F.R. §§2.33(b), (c), 2.34(a)(1)(i), (a)(2), (a)(3)(i), (a)(4)(ii), 2.59(a).

For more information about the verified statement and instructions on providing one using the online Trademark Electronic Application System (TEAS) response form, see the [Verified statement](#) webpage.

IDENTIFICATION REQUIREMENT

The identification of "retail store services and online retail store services of tablets" is indefinite and must be clarified because to describe the services by common commercial name and to describe the featured goods by common commercial name. *See* 37 C.F.R. §2.32(a)(6); TMEP §1402.01.

Applicant may adopt the following wording, if accurate:

Class 35: Retail store services and online retail store services **featuring** eyewear, accessories for telephones and **tablet computers**, jewellery, horological instruments, bags and small leatherware, namely, wallets, purses, card wallets, money holders, briefcases, purses, key cases, luggage tags, clothing, footwear, headwear, hosiery, connected clothing, smart clothing, connected footwear, smart footwear; arranging, conducting and promoting special events for commercial and advertising purposes; Advertising and organization of fashion shows for promotional purposes; Shop window dressing; Sample distribution

Note that bolding, italics, and the like are used only to highlight suggested changes to the original language.

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.

SECTION 44- OPTION TO DELETE SECTION 1(B) BASIS

The application specifies both an intent to use basis under Trademark Act Section 1(b) and reliance on a foreign registration(s) under Section 44(e). *See* 15 U.S.C. §§1051(b), 1126(e); 37 C.F.R. §2.34(a)(2)-(3). However, the foreign registration alone may serve as a basis for obtaining a U.S. registration. *See* 37 C.F.R. §2.34(a)(3); TMEP §806.01(d). If applicant wants to rely solely on the foreign registration under Section 44(e) as the basis, applicant can request deletion of the Section 1(b) basis. *See* 37 C.F.R. §2.35(b)(1); TMEP §806.04.

Unless applicant indicates otherwise, the USPTO will presume that applicant is relying on both Sections 1(b) and 44(e). Thus, although the mark may be approved for publication, it will not register until an acceptable allegation of use has been filed for the goods and/or services based on Section 1(b).

RESPONSE GUIDELINES

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.

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.

Because of the legal technicalities and strict deadlines of the trademark application process, applicant is encouraged to hire a private attorney who specializes in trademark matters to assist in this process. The assigned trademark examining attorney can provide only limited assistance explaining the content of an Office action and the application process. USPTO staff cannot provide legal advice or statements about an applicant's legal rights. TMEP §§705.02, 709.06. *See* [Hiring a U.S.-licensed trademark attorney](#) for more information.

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

/Joanna Shanoski/
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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.

(5) WORDS, LETTERS, AND/OR NUMBERS IN STYLIZED FORM



Mark Punctuated

YSL

Translation

Goods/Services

- IC 004. US 001 006 015.G & S: perfumed candles. FIRST USE: 20171100. FIRST USE IN COMMERCE: 20171100
- IC 008. US 023 028 044.G & S: Electric hand-held device used for blending cosmetic products to achieve a customised cosmetic product for application
- IC 009. US 021 023 026 036 038.G & S: Downloadable mobile applications and software for beauty analysis, namely, enabling users to obtain personalized beauty analysis and advice, and providing customizable cosmetic and skincare product recommendations
- IC 018. US 001 002 003 022 041.G & S: Toiletry and makeup bags, sold empty
- IC 021. US 002 013 023 029 030 033 040 050.G & S: Cosmetic brushes; make-up removing appliances; cosmetic sponges, namely, sponges used for applying makeup; applicators for cosmetic products, namely, electrical applicators for applying cosmetics to the skin; sponges, namely, bath sponges, body sponges; powder puffs; powder compacts sold empty; powder cases, namely, powder compacts, sold empty; vaporizers for perfume, sold empty; cosmetic containers in the nature of household containers for storing and organizing cosmetics

Mark Drawing Code

(5) WORDS, LETTERS, AND/OR NUMBERS IN STYLIZED FORM

Design Code

Serial Number

90732604

Filing Date

20210525

Current Filing Basis

1A;1B

Original Filing Basis

1A;1B

Publication for Opposition Date

20220920

Registration Number**Date Registered****Owner**

(APPLICANT) YVES SAINT LAURENT PARFUMS société par actions simplifiée (sas) FRANCE 37-39 rue de Bellechasse Paris FRANCE 75007

Priority Date**Disclaimer Statement****Description of Mark**

The mark consists of the letters Y S L arranged in vertical formation in a stylized font.

Type of Mark

TRADEMARK

Register

PRINCIPAL

Live Dead Indicator

LIVE

Attorney of Record

Dyan Finguerra-DuCharme

United States Patent and Trademark Office (USPTO)

USPTO OFFICIAL NOTICE

Office Action (Official Letter) has issued
on August 22, 2022 for
U.S. Trademark Application Serial No. 97118872

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.