

To: NORDBY CONSTRUCTION CO (bkoegel@emklawyers.com)
Subject: U.S. Trademark Application Serial No. 97120848 - CANNABUILD - N/A
Sent: August 26, 2022 04:36:59 PM
Sent As: ecom107@uspto.gov
Attachments:

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

U.S. Application Serial No. 97120848

Mark: CANNABUILD

Correspondence Address:

Benjamin David Koegel
ELGUINDY MEYER KOEGEL
2990 LAVA RIDGE CT, # 205, 2990 LAVA RID
2990 LAVA RIDGE CT, # 205, 2990 LAVA RID
ROSEVILLE CA 95661

Applicant: NORDBY CONSTRUCTION CO

Reference/Docket No. N/A

Correspondence Email Address:

bkoegel@emklawyers.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 26, 2022**

This Office action is supplemental to and supersedes the previous Office action issued on 8/26/22 in connection with this application. The assigned trademark examining attorney inadvertently omitted a requirement relevant to the mark in the subject application. *See* TMEP §§706, 711.02. Specifically, it was overlooked that applicant submitted a voluntary disclaimer in the application.

Applicant must address all issue(s) raised in this Office action, in addition to the issues raised in the Office action dated 8/26/22, sent earlier in the day.

The following is a SUMMARY OF ISSUES that applicant must address:

- NEW ISSUE: Disclaimer
- Section 2(d) refusal
- Drawing/specimen matching refusal
- Potential disclaimer required

Applicant must respond to all issues raised in this Office action and the previous Office action, within six (6) months of the date of issuance of this Office action. 37 C.F.R. §2.62(a); *see* TMEP §711.02. If applicant does not respond within this time limit, the application will be abandoned. 37 C.F.R. §2.65(a).

VOLUNTARY DISCLAIMER – Advisory

Applicant has disclaimed the entire applied-for mark; however, an entire mark may not be disclaimed. TMEP §1213.06; *see* 15 U.S.C. §1056(a); *In re Dena Corp. v. Belvedere Int'l Inc.*, 950 F.2d 1555, 1560, 21 USPQ2d 1047, 1051 (Fed. Cir. 1991); *In re JT Tobacconists*, 59 USPQ2d 1080, 1081 n.1 (TTAB 2001). If the applied-for mark is not registrable as a whole, a disclaimer will not make it registrable. TMEP §1213.06. Accordingly, the disclaimer of “CANNABUILD” is not accepted and will not be entered into the USPTO’s database. *See* TMEP §714.05(a).

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

/med/
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RESPONSE GUIDANCE

- **Missing the response deadline to this letter will cause the application to [abandon](#).** A response or notice of appeal must be received by the USPTO before midnight **Eastern Time** of the last day of the response period. TEAS and ESTTA 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.

To: NORDBY CONSTRUCTION CO (bkoegel@emklawyers.com)
Subject: U.S. Trademark Application Serial No. 97120848 - CANNABUILD - N/A
Sent: August 26, 2022 04:37:01 PM
Sent As: ecom107@uspto.gov
Attachments:

United States Patent and Trademark Office (USPTO)

USPTO OFFICIAL NOTICE

Office Action (Official Letter) has issued
on **August 26, 2022** for

U.S. Trademark Application Serial No. 97120848

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.

To: NORDBY CONSTRUCTION CO (bkoegel@emklawyers.com)
Subject: U.S. Trademark Application Serial No. 97120848 - CANNABUILD - N/A
Sent: August 26, 2022 04:29:46 PM
Sent As: ecom107@uspto.gov
Attachments: [Attachment - 1](#)
[Attachment - 2](#)
[Attachment - 3](#)
[Attachment - 4](#)
[Attachment - 5](#)

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Office Action (Official Letter) About Applicant's Trademark Application

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Issue date: **August 26, 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, 2.65(a); TMEP §§711, 718.03.

SECTION 2(d) REFUSAL – LIKELIHOOD OF CONFUSION

Registration of the applied-for mark is refused because of a likelihood of confusion with the marks in U.S. Registration Nos. 5640449 and 5809895. Trademark Act Section 2(d), 15 U.S.C. §1052(d); *see* TMEP §§1207.01 *et seq.* See the attached registrations.

Trademark Act Section 2(d) bars registration of an applied-for mark that is so similar to a registered mark that it is likely consumers would be confused, mistaken, or deceived as to the commercial source of the goods and/or services of the parties. *See* 15 U.S.C. §1052(d). Likelihood of confusion is determined on a case-by-case basis by applying the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973) (called the “*du Pont* factors”). *In re i.am.symbolic, llc*, 866 F.3d 1315, 1322, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017). Any evidence of record related to those factors need be considered; however, “not all of the *DuPont* factors are relevant or of similar weight in every case.” *In re Guild Mortg. Co.*, 912 F.3d 1376, 1379, 129 USPQ2d 1160, 1162 (Fed. Cir. 2019) (quoting *In re Dixie Rests., Inc.*, 105 F.3d 1405, 1406, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997)).

Although not all *du Pont* factors may be relevant, there are generally two key considerations in any likelihood of confusion analysis: (1) the similarities between the compared marks and (2) the relatedness of the compared goods and/or services. See *In re i.am.symbolic, llc*, 866 F.3d at 1322, 123 USPQ2d at 1747 (quoting *Herbko Int'l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1164-65, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002)); *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 1103, 192 USPQ 24, 29 (C.C.P.A. 1976) (“The fundamental inquiry mandated by [Section] 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods [or services] and differences in the marks.”); TMEP §1207.01.

Comparison of the Marks

Marks are compared in their entireties for similarities in appearance, sound, connotation, and commercial impression. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 1321, 110 USPQ2d 1157, 1160 (Fed. Cir. 2014) (quoting *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 1371, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005)); TMEP §1207.01(b)-(b)(v). “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *In re Inn at St. John’s, LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018) (citing *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014)), *aff’d per curiam*, 777 F. App’x 516, 2019 BL 343921 (Fed. Cir. 2019); TMEP §1207.01(b).

Applicant’s mark is CANNABUILD. The registered mark is CANNATECH BUILDERS, in standard character form and stylized form.

The marks have similar commercial impressions since both start with “CANNA” and end with a form of the word “BUILD.”

It has been held that marks may be confusingly similar in appearance despite the addition, deletion, or substitution of letters or words. See, e.g., *Weiss Assocs. Inc. v. HRL Assocs. Inc.*, 902 F.2d 1546, 14 USPQ2d 1840 (Fed. Cir. 1990) (finding TMM confusingly similar to TMS); *Canadian Imperial Bank of Commerce v. Wells Fargo Bank, N.A.*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987) (affirming Board’s holding that source confusion is likely where COMMASH and COMMUNICASH are used in connection with identical banking services); *Ava Enters. v. Audio Boss USA, Inc.*, 77 USPQ2d 1783 (TTAB 2006) (finding AUDIO BSS USA and design similar in appearance to BOSS AUDIO SYSTEMS (stylized)); *In re Lamson Oil Co.*, 6 USPQ2d 1041 (TTAB 1987) (finding TRUCOOL and TURCOOL confusingly similar in appearance); *In re Pix of Am., Inc.*, 225 USPQ 691 (TTAB 1985) (finding NEWPORTS and NEWPORT to be essentially identical in appearance); *In re Pellerin Milnor Corp.*, 221 USPQ 558 (TTAB 1983) (finding MILTRON and MILLTRONICS (stylized) to be highly similar in appearance); *In re BASF A.G.*, 189 USPQ 424 (TTAB 1975) (finding difference between marks LUTEX and LUTEXAL insufficient to avoid source confusion).

Comparison of the Services/Trade Channels

The compared goods and/or services need not be identical or even competitive to find a likelihood of confusion. See *On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 1086, 56 USPQ2d 1471, 1475 (Fed. Cir. 2000); *Recot, Inc. v. Becton*, 214 F.3d 1322, 1329, 54 USPQ2d 1894, 1898 (Fed. Cir. 2000); TMEP §1207.01(a)(i). They need only be “related in some manner and/or if the circumstances surrounding their marketing are such that they could give rise to the mistaken belief that [the goods and/or services] emanate from the same source.” *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1369, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012) (quoting *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1724 (TTAB 2007)); TMEP §1207.01(a)(i).

Applicant indicates the following services: “Construction of cannabis-related structures for businesses; Construction services, namely, planning, laying out and custom construction of commercial buildings; Advisory services relating to the construction of buildings; Consultancy and information services relating to construction; Consultancy relating to the construction of buildings; Consultancy services relating to the construction of buildings.”

The services of the parties are highly related, if not identical. Registrant provides “Building construction,” and “Planning and construction of technical grow facilities.” Both parties provide construction of buildings, and registrant’s “technical grow facilities” could be in the nature of “cannabis-related structures for businesses,” as stated by applicant – that is, buildings for growing cannabis.

Although applicant’s mark has been refused registration, applicant may respond to the refusal(s) by submitting evidence and arguments in support of registration.

If applicant chooses to respond to the refusal(s) to register, then applicant must also respond to the requirement(s) set forth below.

REFUSAL – MARK DIFFERS ON DRAWING & SPECIMEN

Mark shown on drawing does not match mark on specimen. Registration is refused because the specimen does not show the mark in the drawing in use in commerce, which is required 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); TMEP §§904, 904.07(a), 1301.04(g)(i). The mark appearing on the specimen and in the drawing must match; that is, the mark in the drawing “must be a substantially exact representation of the mark” on the specimen. See 37 C.F.R.

§2.51(a)-(b); TMEP §807.12(a).

In this case, the specimen displays the mark as CANNA BUILD (as two words). However, the drawing displays the mark as CANNABUILD (as a unitary mark). Applicant has thus failed to provide the required evidence of use of the mark in commerce. *See* TMEP §807.12(a).

Response options. Applicant may respond to this refusal by satisfying one of the following:

- (1) **Submit a [new drawing of the mark](#)** that shows the mark on the specimen and, if appropriate, an amendment of the description and/or color claim that agrees with the new drawing. *See* 37 C.F.R. §2.72(a)-(b). Applicant may amend the mark in the drawing to match the mark on the specimen but may not make any other changes or amendments that would materially alter the drawing of the mark. *See* 37 C.F.R. §2.72(a)-(b); TMEP §807.14.
- (2) **Submit a different specimen** (a verified [“substitute” specimen](#)) for each applicable international class that (a) shows the mark in the drawing in actual use in commerce for the goods and/or services in the application or amendment to allege use, and (b) 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.

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). 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).

Specimens for services must show a direct association between the mark and the services and include: (1) copies of advertising and marketing material, (2) a photograph of business signage or billboards, or (3) materials showing the mark in the sale, rendering, or advertising of the services. *See* 37 C.F.R. §2.56(b)(1), (c); TMEP §1301.04(a), (h)(iv)(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).

For more information about drawings and instructions on how to satisfy these response options using the online Trademark Electronic Application System (TEAS) form, see the [Drawing webpage](#).

DISCLAIMER REQUIRED – if mark is amended to “CANNA BUILD”

Applicant must disclaim the wording “BUILD” because it is merely descriptive of an ingredient, quality, characteristic, function, feature, purpose, or use of applicant’s goods and/or 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).

The word “BUILD” merely indicates the purpose of applicant’s services – to build cannabis-related structures for businesses.

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

No claim is made to the exclusive right to use “BUILD” 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](#).

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

/med/
Michelle E. Dubois
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RESPONSE GUIDANCE

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Print: Aug 26, 2022

87608404

DESIGN MARK

Serial Number

87608404

Status

REGISTERED

Word Mark

CANNATECH BUILDERS

Standard Character Mark

Yes

Registration Number

5640449

Date Registered

2019/01/01

Type of Mark

SERVICE MARK

Register

PRINCIPAL

Mark Drawing Code

(4) STANDARD CHARACTER MARK

Owner

MC CONSTRUCTORS INC. CORPORATION CALIFORNIA 3601 PASEO DEL CAMPO PALOS
VERDES ESTATES CALIFORNIA 90274

Goods/Services

Class Status -- ACTIVE. IC 037. US 100 103 106. G & S: Building
construction. First Use: 2017/06/21. First Use In Commerce:
2017/06/21.

Disclaimer Statement

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "BUILDERS" APART FROM
THE MARK AS SHOWN.

Filing Date

2017/09/14

Examining Attorney

STRUCK, ROBERT

Attorney of Record

Joshua A. Schaul

Cannatech Builders

Print: Aug 26, 2022

87621160

DESIGN MARK

Serial Number

87621160

Status

REGISTERED

Word Mark

CB CANNATECH BUILDERS

Standard Character Mark

No

Registration Number

5809895

Date Registered

2019/07/23

Type of Mark

SERVICE MARK

Register

PRINCIPAL

Mark Drawing Code

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

Owner

MC CONSTRUCTORS INC. CORPORATION CALIFORNIA 3601 PASEO DEL CAMPO PALOS
VERDES ESTATES CALIFORNIA 90274

Goods/Services

Class Status -- ACTIVE. IC 037. US 100 103 106. G & S: Planning
and construction of technical grow facilities. First Use: 2017/06/21.
First Use In Commerce: 2017/06/21.

Disclaimer Statement

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "BUILDERS" APART FROM
THE MARK AS SHOWN.

Description of Mark

The mark consists of the stylized letters "c" and "b" with the words
"CANNATECH BUILDERS" centered below.

Colors Claimed

Color is not claimed as a feature of the mark.

Filing Date

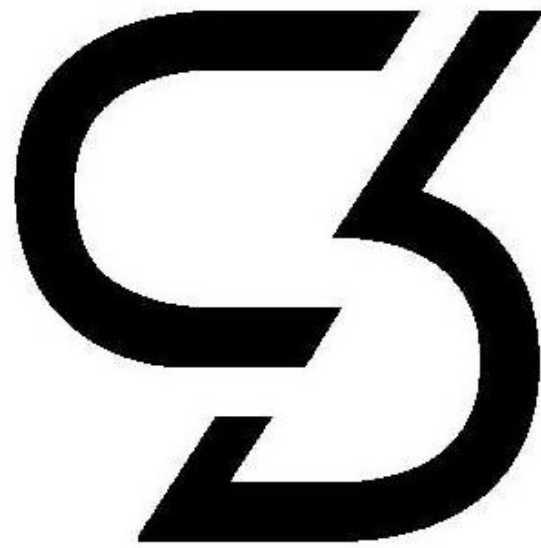
2017/09/25

Print: Aug 26, 2022

87621160

Examining Attorney
STRUCK, ROBERT

Attorney of Record
Joshua A. Schaul



CANNATECH
BUILDERS

To: NORDBY CONSTRUCTION CO (bkoegel@emklawyers.com)
Subject: U.S. Trademark Application Serial No. 97120848 - CANNABUILD - N/A
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- [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.