

**To:** Peter J. Phillips([info@lmiplaw.com](mailto:info@lmiplaw.com))  
**Subject:** U.S. Trademark Application Serial No. 97118617 - - PF-17-TM  
**Sent:** August 28, 2022 04:59:21 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.** 97118617

**Mark:**

**Correspondence Address:**

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NEW YORK NY 10004 UNITED STATES

**Applicant:** Pfingst & Company, Inc.

**Reference/Docket No.** PF-17-TM

**Correspondence Email Address:** [info@lmiplaw.com](mailto:info@lmiplaw.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 28, 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 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:

- A. Specimen Refusal -- Specimens Do Not Show Use in Classes 8, 9, and 10
- B. Amended Identification of Goods Required
- C. Multiple-Class Application Requirements
- D. Amended Mark Description Required

### A. SPECIMEN REFUSAL -- SPECIMENS DO NOT SHOW USE IN CLASSES 8, 9, AND 10

**Specimen does not show use of the mark in commerce.** Registration is refused because the specimens do not show the applied-for mark as actually used in commerce in International Classes 8, 9, and 10. 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). 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).

Specifically, the submitted specimens depict the applied-for mark on empty packaging. The name of the product is not listed on the packages; rather, only part numbers are provided. Because the nature and proper classification of the goods cannot be discerned from the submitted packaging, the specimens are not acceptable to show use of the mark in commerce in International Classes 8, 9, and 10.

**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). 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](#).

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.

## **B. AMENDED IDENTIFICATION OF GOODS REQUIRED**

A written application must specify the particular goods and/or services on or in connection with which the applicant uses, or has a bona fide intention to use, the mark in commerce. 15 U.S.C. §§1051(a)(2), 1051(b)(2); 37 C.F.R. §2.32(a)(6). To “specify” means to name in an explicit manner. TMEP §1402.01. An identification that fails to identify the goods and services with specificity is indefinite, either because the nature of the goods or services is not clear or because the wording is so broad that it may include goods or services in more than one class. *Id.* The applicant must identify the goods and services specifically to provide public notice and to enable the USPTO to classify the goods and services properly and to reach informed judgments concerning likelihood of confusion under 15 U.S.C. §1052(d). *Id.*

### **International Class 8**

The following entries in the identification of goods in International Class 8 require further clarification:

- hand tools, namely, burs, twist drills, mandrels, cutters, and mounted and unmounted stones for use in the fields of wood carving and metalworking by hobbyists
- bur storage blocks for use in the fields of wood carving and metalworking by hobbyists

The wording "hand tools, namely, burs, twist drills, mandrels, cutters, and mounted and unmounted stones for use in the fields of wood carving and metalworking by hobbyists" is indefinite because some of the listed tools, such as burs, appear to commonly be power-operated tools. Class 8 includes hand-operated tools and implements. Motor-driven tools, such as power tools, are usually in Class 7. A "hand held" tool may be in either class.

The reference to "mandrels" appears to be misclassified. "Metal mandrels, not being parts of machines" are in International Class 6, and mandrels in the nature of "machine parts" are in International Class 7. *See* ID Manual, Term ID Nos. 006-1041, 007-1547.

In addition, the nature of of applicant's "mounted and unmounted stones for use in the fields of wood carving and metalworking by hobbyists" is unclear. Applicant must specify the common commercial or generic name of the stones. *See* TMEP §1402.01. If the goods have no common commercial or generic

name, applicant must describe the product, its main purpose, and its intended uses. *See id.*

The wording "bur storage blocks for use in the fields of wood carving and metalworking by hobbyists" is overbroad because it could identify goods in more than one international class. Storage blocks specially adapted to hold power-operated burs are in Class 7, while storage blocks specially adapted to hold hand-operated burs would be in Class 8.

### **International Class 9**

The following entries in the identification of goods in International Class 9 require further clarification and/or are misclassified:

- hand tools, namely, burs, twist drills, mandrels, cutters, mounted and unmounted stones for use in the field of jewelry, bur gauges for use in the field of jewelry
- bur storage blocks for use in the field of jewelry

The entry for "hand tools, namely, burs, twist drills, mandrels, cutters, and mounted and unmounted stones for use in the fields of wood carving and metalworking by hobbyists" requires clarification because it is indefinite in part and misclassified in part. Bur gauges are properly classified in International Class 9 because of their measuring function. However, applicant must provide additional detail to clarify the nature of these goods. If the remainder of applicant's tools are power-operated, they belong in International Class 7. If the tools are hand-operated, they belong in International Class 8.

The nature of applicant's "mounted and unmounted stones for use in the field of jewelry" is unclear. Applicant must specify the common commercial or generic name of the stones. *See* TMEP §1402.01. If the goods have no common commercial or generic name, applicant must describe the product, its main purpose, and its intended uses. *See id.*

The entry for "bur storage blocks for use in the field of jewelry" is misclassified. As noted above, storage blocks for power-operated burs are in Class 7, while storage blocks for hand-operated burs are in Class 8.

### **International Class 10**

The nature of applicant's "mounted and unmounted stones for use in the fields of dentistry, podiatry, and pedicure" is unclear. Applicant must specify the common commercial or generic name of the stones. *See* TMEP §1402.01. If the goods have no common commercial or generic name, applicant must describe the product, its main purpose, and its intended uses. *See id.*

For each instance requiring additional clarification, the examining attorney has provided an example of an acceptable amendment below. If the suggestions below are not accurate, applicant is encouraged to use the USPTO's online Identification Manual (see ID Manual link below) to search for acceptable wording to properly identify the intended goods.

**EXAMPLE IDENTIFICATION OF GOODS:** The following is an example of an acceptable identification of goods that applicant may adopt, if accurate (additions in **bold** and deletions in ~~strikethrough~~).

## Class 6

**Metal mandrels, not being parts of machines**

## Class 7

**Hand-held, power-operated tools for use in the fields of wood carving and metalworking by hobbyists, namely, burs being rotary cutting tools, twist drills being power drill bits, mandrels being machine parts, and cutters being rotary cutting tools, ~~and mounted and unmounted stones for use in the fields of wood carving and metalworking by hobbyists~~; Hand-held, power-operated tools for use in the field of jewelry, namely, burs being rotary cutting tools, twist drills being power drill bits, mandrels being machine parts, and cutters in the nature of rotary cutting tools; Bur storage blocks for use in the fields of wood carving and metalworking by hobbyists in the nature of bur storage holders specially adapted to hold power-operated burs; Bur storage blocks for use in the field of jewelry in the nature of bur storage holders specially adapted to hold power-operated burs**

## Class 8

**Hand-held, hand-operated tools for use in the fields of wood carving and metalworking by hobbyists, namely, burs being rotary cutting tools, twist drills being drill bits for hand drills, ~~mandrels~~, cutters in the nature of rotary cutting tools, and mounted and unmounted stones in the nature of files being hand-operated tools for smoothing surfaces of metal ~~for use in the fields of wood carving and metalworking by hobbyists~~; Hand-held, hand-operated tools for use in the field of jewelry, namely, burs being rotary cutting tools, twist drills being drill bits for hand drills, ~~mandrels~~, cutters in the nature of rotary cutting tools, and mounted and unmounted stones in the nature of files being hand-operated tools for smoothing surfaces of metal; Bur storage blocks for use in the fields of wood carving and metalworking by hobbyists in the nature of bur storage holders specially adapted to hold hand-operated burs; Bur storage blocks for use in the field of jewelry in the nature of bur storage holders specially adapted to hold hand-operated burs**

## Class 9

~~hand tools, namely, burs, twist drills, mandrels, cutters, mounted and unmounted stones for use in the field of jewelry;~~ Bur gauges for use in the field of jewelry **for measuring the diameter of burs; ~~bur storage blocks for use in the field of jewelry~~**

## Class 10

**Hand tools for use in the fields of dentistry, podiatry, and pedicure, namely, burs, twist drills, ~~mandrels~~, and cutters being rotary cutting tools, ~~and mounted and unmounted stones for use in the fields of dentistry, podiatry, and pedicure~~; Bur storage blocks for use in the fields of dentistry, podiatry, and pedicure in the nature of bur storage holders specially adapted to hold dental, podiatry, and pedicure burs**

SCOPE ADVISORY: 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).

ONLINE ID MANUAL: 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.

For information on how to identify the goods and services in an application, applicant is encouraged to view the [USPTO's Trademark Information Network Video](#) Number 6, "Goods and Services."

## C. MULTIPLE-CLASS APPLICATION REQUIREMENTS

The application references goods based on use in commerce in more than one international class; therefore, applicant must satisfy all the requirements below for each international class:

(1) **List the goods and/or services by their international class number** in consecutive numerical order, starting with the lowest numbered class (for example, International Class 3: perfume; International Class 18: cosmetic bags sold empty).

(2) **Submit a filing fee for each international class** not covered by the fee(s) already paid (view the [USPTO's current fee schedule](#)). Specifically, the application identifies goods and/or services based on use in commerce that are classified in at least **five** classes; however, applicant submitted a fee sufficient for only **three** classes. Applicant must either (a) submit the filing fees for the classes not covered by the submitted fees or (b) restrict the application to the number of classes covered by the fees already paid.

(3) **Submit verified dates of first use of the mark** anywhere and in commerce **for each international class**. [See more information about verified dates of use](#).

(4) **Submit a specimen for each international class**. The current specimen is not acceptable for any international class. [See more information about specimens](#).

**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)(2), (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).



(5) **Submit a verified statement** that “The specimen was in use in commerce on or in connection with the goods and/or services listed in the application at least as early as the filing date of the application.” [See more information about verification.](#)

*See* 37 C.F.R. §2.86(a); TMEP §§1403.01, 1403.02(c).

For an overview of the requirements for a Section 1(a) multiple-class application and how to satisfy the requirements online using the Trademark Electronic Application System (TEAS) form, see the [Multiple-class Application webpage](#).

#### **D. AMENDED MARK DESCRIPTION REQUIRED**

Applicant must submit an amended description of the mark because the current one uses vague language that does not accurately describe the mark. 37 C.F.R. §2.37; *see* TMEP §§808.01, 808.02. Descriptions must be accurate and identify all the literal and design elements in the mark. *See* 37 C.F.R. §2.37; TMEP §808.02. In this case, the description is vague because it does not clearly describe the design elements in the mark.

The following description is suggested, if accurate: **The mark consists of a stylized design of a marabou stork wearing eyeglasses and holding a rod under its wing. The rod tapers to a small circle at one end, and short straight lines extend outward from the circle in all directions.**

#### **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.

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 28, 2022 for  
**U.S. Trademark Application Serial No. 97118617**

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.