

INTELLECTUAL  
PROPERTY  
LAW



*presents*

## **TRADEMARK OFFICE COMES TO CALIFORNIA**

An Insider's Look at Trademark Examination

Tuesday and Thursday, June 13 & 15, 2023  
10:15 a.m. – 11:15 a.m.

MCLE: 1 Hour

Speakers:

Susan Hayash, Law Office Managing Attorney, USPTO

### **Conference Reference Materials**

*Points of view or opinions expressed in these pages are those of the speaker(s) and/or author(s). They have not been adopted or endorsed by the California Lawyers Association and do not constitute the official position or policy of the California Lawyers Association. Nothing contained herein is intended to address any specific legal inquiry, nor is it a substitute for independent legal research to original sources or obtaining separate legal advice regarding specific legal situations.*

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UNITED STATES  
PATENT AND TRADEMARK OFFICE



# A day in the life of a trademark examining attorney

Susan Hayash

Managing Attorney, Law Office 123



UNITED STATES  
PATENT AND TRADEMARK OFFICE ®

# A look at dockets – manager view

Recent Cases ▾

Find Serial Numbe Open Susan Hayash ▾

DOCKETS XSEARCH REPORTS

RESOURCES

- Resource Center
- ID Manual
- TMEP
- TSDR
- My Evidence
- Document Search
- Form Paragraphs

MY WORK

- Findings
- Request
- Appeal Briefs
- Writing Reviews

ATTORNEY WORK

- Staff Workload

MY DOCKET

- My Docket (2)
- Office Action Drafts
- My Other Cases

REPORTS

- Production Reports
- Law Office Findings

XSEARCH

- Search
- Strategy

Staff Workload My Docket Findings Docket

Staff Workload OK Coming Due Overdue Locked Case and No Clock Case count  Show new cases separately

Staff Name	In Docket	All Cases
Unassigned	412672	
All Law Offices	1804	60 45 91 1
LO123	1804	60 45 91 1
Agreda, Samantha	91	12
Allen, Bianca	104	1
Bayless-Davis, Mariah	67	11 5
Berger, Magdalena	47	3
Blakeslee, Richard	101	7 2
Buker, Rachel	74	1 2 2
Caysido, Rebecca	60	5 1
Cerda, Victor	81	12 3
Derby, Karen	93	
Frazier, Tamara	13	5
Grajeda, Hector	62	8
Hartnett, Megan	53	7
Hayash, Susan	23	2
Hopkins, Dean	23	
Hopkins, Sarah	101	2
Howell, Matthew	69	1
Hutchison, David	56	6
Johnson II, Collier	3	
LaMont, John	62	1 2
Lindemyer, Anghi	56	8

# A look at dockets – individual view

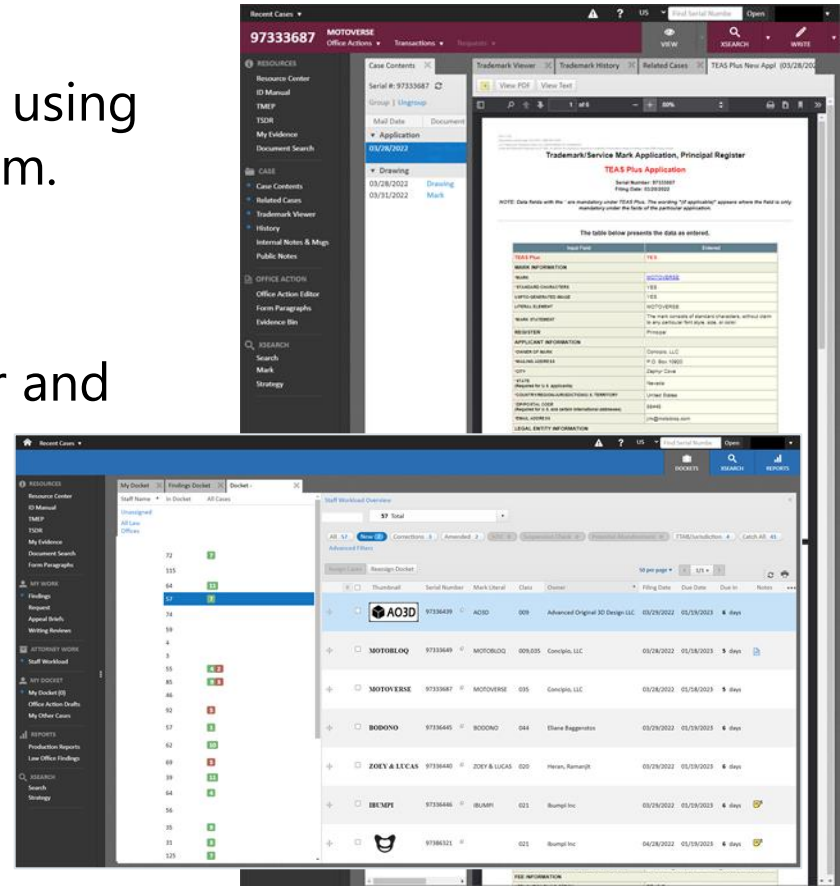
The screenshot displays a web application interface for managing legal dockets. The top navigation bar includes a home icon, 'Recent Cases', a search bar with 'Find Serial Number', and user information 'Open Susan Hayash'. Below this is a blue header with 'DOCKETS', 'XSEARCH', and 'REPORTS' buttons. The main content area has tabs for 'Staff Workload', 'My Docket', and 'Findings Docket'. A filter bar shows various case categories with counts: All (23), New (2), Corrections (0), Amended (1), SOU (0), Suspension Check (4), Potential Abandonment (1), TTAB/Jurisdiction (0), and Catch All (15). There are also options for '50 per page', '1/1' pagination, and a 'Pull Cases Into My Docket' button. The central table lists two cases:

Thumbnail	Serial Number	Mark Literal	Class	Owner	Filing Date	Due Date	Due In	Notes
<b>PSALM WEST</b>	97658214	PSALM WEST	016	Kimsaprincess Inc.	11/01/2022	05/18/2023	2 days	
<b>PSALM WEST</b>	97658240	PSALM WEST	020	Kimsaprincess Inc.	11/01/2022	05/18/2023	2 days	

The left sidebar contains a 'RESOURCES' menu with items like 'Resource Center', 'ID Manual', 'TMEP', 'TSDR', 'My Evidence', 'Document Search', and 'Form Paragraphs'. Below that is 'MY WORK' with 'Findings', 'Request', 'Appeal Briefs', and 'Writing Reviews'. 'ATTORNEY WORK' includes 'Staff Workload'. 'MY DOCKET' has 'My Docket (2)', 'Office Action Drafts', and 'My Other Cases'. 'REPORTS' includes 'Production Reports' and 'Law Office Findings'. 'XSEARCH' has 'Search' and 'Strategy'.

# Assigning and reviewing a file

- Examining attorney requests a file using the new TM Exam docketing system.
- To maintain consistency, TM Exam assigns co-pending applications (applications with the same owner and filed at or near the same time) to the same examining attorney.
- All work performed electronically within TM Exam and other applications.



# Database changes

TM EXAM DOCKET | 90007839 View | ASTRELL | TM E

90007839 ASTRELL

Office Actions | Transactions | Requests

Case Contents

Serial #: 90007839 Group | Ungroup

Mail Date | Document | Notes

Application

06/18/2020 TEAS Plus New Appl

Incoming

06/22/2021 Chg Add or Reprs Fom

Drawing

06/18/2020 Drawing

06/22/2020 Mark

Specimens

06/18/2020 Specimen

NEW APPLICATION

ASSIGNED TO EXAMINER 08/21/2020

6:29 pm

Elizabeth Jackson

Serial Number 90007839

Filed 06/18/2020

Register Principal

Current Basis 1(a)

Current Owner Yu Yulian

Current Contact Yue Niu ATTORNEY

Astell

Literal ASTRELL

Drawing Code 4-STANDARD CHARACTER MARK

Expand all | Collapse all

- Goods/Services 028 1 active class
- Mark Info Trademark, Name/Portrait/Translation
- Owner/Assignment Yu Yulian Check assignment Ownership History ✓ Email authorized
- Attorney Yue Niu (914) 863-1568 ✓ Email authorized
- Correspondence Yue Niu ✓ Email authorized
- Post Registration
- Location/Status LAW OFFICE 116; Managing Attorney: Elizabeth Jackson
- Foreign Application/Registration
- International Trademark Not Applicable
- Expungement/Reexamination
- E/R Petitioner Information
- E/R Petitioner Attorney Information

Trademark Viewer | Trademark History | Related Cases

Snapshots

NEW APPLICATION

ASSIGNED TO EXAMINER 08/21/2020

6:29 pm

Elizabeth Jackson

Serial Number 90007839

Filed 06/18/2020

Register Principal

Current Basis 1(a)

Current Owner Yu Yulian

Current Contact Yue Niu ATTORNEY

Astell

Literal ASTRELL

Drawing Code 4-STANDARD CHARACTER MARK

Expand all | Collapse all

Goods/Services 028 1 active class

Edit Check ID ID Manual

Class	Identification	Current Basis	Current Status	Use Anywhere
028	Ascenders being mountaineering equipment; Athletic protective elbow pads for skateboarding; Baseballs; Bath toys; Body-building apparatus; Children's multiple activity toys; Construction toys; Elbow guards for athletic use; Electric action toys; Exercise equipment, namely, chest expanders; Exercise equipment, namely, exercise bands; Flippers for swimming; Floats for fishing; Golf balls; Karate kick pads; Kettle bells; Knee guards for athletic use; Ornament hooks for Christmas trees; Paintball guns; Physical fitness equipment, namely, exercise bands; Play mats containing infant toys; Plush toys; Punching bags; Rods for fishing; Shin guards for athletic use; Sport balls; Stationary exercise bicycles; Swimming jackets; Toy LED light sticks <a href="#">Less</a>	1(a)	6 - Active	04/18/2020

# Searching

- USPTO maintains a searchable database of federally registered marks and pending applications.
  - Does not contain state trademark registrations, common law marks, business names, or domain names.
- Search tools
  - X-Search
  - Trademark Electronic Search System (TESS)

The screenshot displays the USPTO TM EXAM DOCKET search interface. The search query is `*malaysia* [b,t][not dead][d]`. The results table shows 22 hits, with the top result being a trademark for MALAYSIA AIRLINES.

#	Tag	Serial #	Filed	Status	Mark
12		86922363	20160228	*	HOUSE M
19		76528074	20030707	*	KAWAN
17		79180337	20151012	*	KING OF V
5		88353509	20190323	*	KOPITIAM
22		73625277	19861014	*	KWAN LO
10		87204713	20161016	*	LOVE MAI
11		86126812	20131122	V*	MALAYSIA
18		77179131	20070511	*	MALAYSIA
13		85347431	20110615	*	MALAYSIA
7		87531028	20170717	*	MALAYSIA
9		87204702	20161016	*	MAMAK -
8		87540951	20170724	*	MEETU M
2		97446857	20220607		MGB MAL
15		79339175	20211201		MSIA MAL
16		79245795	20180712	*	SENTOSA
3		90798032	20210628		THE TIGER



# Issuing office actions

- Examining Attorney will address any procedural or substantive issues identified in review.
- This can be done by office action, examiner's amendment (phone call/informal email), or priority action.
- The office strongly encourages phone or email resolution.

Select Office Action Type

What kind of office action do you want to create?

- Suspension Letter
- Non-Final Action
- Examiner's Amendment

97287551 BOSSI BOSSI BOSSI BOSSI  
Office Actions Transactions Requests VIEW RESEARCH WRITE

Form Paragraphs Chapters USPs Recommended Favorites

Insert Paragraphs Show Search Box Draggable Paragraphs

A. BASIS FOR FILING  
B. CLASSIFICATION OF GOODS/SERVICES  
C. IDENTIFICATION OF GOODS/SERVICES  
D. MULTIPLE-CLASS APPLICATIONS  
E. ATTORNEY/DOMICILE  
F. DATES-OF-USE CLAUSE  
G. DISCLAIMERS  
H. DISTINCTIVENESS/SUPPLEMENT REGISTER  
I. DRAWINGS  
J. SECTION 44 APPLICANTS  
K. SECTION 44 APPLICANTS  
L. INFORMALITIES AND OFFICE PROCEDURE  
M. MADRID APPLICANTS  
N. NAME, PORTRAIT, OR SIGNATURE OF AN INDIVIDUAL  
O. EXAMINER'S AMENDMENTS/PRIORITY ACTIONS  
P. PRIOR REGISTRATIONS  
Q. SUBSTANTIVE REFUSALS  
R. SEARCH PARAGRAPHS/DEFERRED ACTION PARAGRAPHS  
S. SPECIMENS  
T. TEAS PLUS  
U. USE OF MARK  
V. CLARIFICATION OF TYPES OF MARKS  
X. CERTIFICATION MARKS  
Y. COLLECTIVE MEMBERSHIP MARKS  
Z. COLLECTIVE MARKS FOR

Validation Errors 1 missing fields

Includes form paragraphs: L40-2 Q29-3 Q29-10 Q29-37-1 Q29-19-0 Q29-20 Q29-20 J21-2-1 J21-7-1 L17-1 L22 L17-1 L22 L17-1 A14 L52 L54 L57 FR-HTS2

FINAL OFFICE ACTION

**Response deadline.** File a request for reconsideration of this final Office action and/or a timely appeal to the Trademark Trial and Appeal Board (TTAB) within three months of the "Issue date" below to avoid abandonment of the application. Review the Office action and respond using one of the links below to the appropriate electronic forms in the "How to respond" section below.

**Request an extension.** For a fee, applicant may request one three-month extension of the response deadline prior to filing a response and/or an appeal. The request must be filed within three months of the "Issue date" below. If the extension request is granted, the USPTO must receive applicant's response and/or appeal within six months of the "Issue date" to avoid abandonment of the application.

**Issue date:** January 13, 2023

**Introduction**

This Office action is in response to applicant's communication filed on December 18, 2022.

In a previous Office action(s) dated December 17, 2022, the trademark examining attorney refused requirements of the applicant for mark based Trademark Act Section 2(d) for a likelihood of confusion with registered marks. In addition, applicant was required to satisfy the requirements to amend the color claim and mark description and clarify applicant's entity type. Additionally, applicant was advised that applicant may not amend the filing basis to use in commerce under Section 1(a) without filing an acceptable allegation of use.

The trademark examining now withdraws the Section 2(d) refusals with respect to the registered marks BOSSI (Reg. No. 2868264), BOSSI (Reg. No. 2839411), and BOSSI (Reg. No. 2839410). Additionally, applicant is advised that pending U.S. Application Serial No. 97134473 will not be the basis for a Section 2(d) refusal.

Further, the trademark examining attorney maintains and now makes FINAL the refusal(s) and/or requirement(s) in the summary of issues below. See 37 C.F.R. §2.63(b), TMEP §714.04.

**Summary of Issues MADE FINAL** that applicant must address,

- Section 2(d) - Likelihood of Confusion Refusals
- Amended Color Claim and Mark Description Required

# Issuing office actions

- Office actions are primarily sent by email notification with a link to TSDR (Trademark Status & Document Retrieval).
- The applicant or its attorney can submit written arguments as to why the refusal or requirement should be withdrawn using TEAS.
- If the examining attorney is not convinced by those arguments and repeats the refusal or requirement, an appeal can be taken to the Trademark Trial and Appeal Board.

The image shows two screenshots. The left screenshot is a browser view of the USPTO TSDR website. It displays the 'Trademark Status & Document Retrieval (TSDR)' search interface. A red box highlights a message: 'Due to high-volume usage, you may experience intermittent issues on the Trademark & Document Retrieval (TSDR) system between 6 - 8 a.m. ET. Refreshing your web browser resolves the issue. If you still need assistance accessing a document, email [teas@uspto.gov](mailto:teas@uspto.gov) include your serial number, the document you are looking for, and a screenshot of any messages you have received.' Below this, there is a search bar with 'US Serial, Registration, or Reference No.' and the value '87770775'. A table of documents is visible, with columns for 'Status', 'Created/Mod Date', and 'Document Description'. The right screenshot is an email from the USPTO. The subject is 'U.S. TRADEMARK APPLICATION NO. 87770775 - FAMILYAPP - 1604001-TM'. The email body contains the following text: 'UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO) OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION. U.S. APPLICATION SERIAL NO. 87770775. MARK: FAMILYAPP. CORRESPONDENT ADDRESS: DANIEL A. JANSER, III, FANBERG PERLE, 1807 CHAMPLAIN DRIVE, MANASSAS, VA 20108. APPLICANT: Family Fabric Inc. CORRESPONDENT'S REFERENCE/DOCKET NO.: 16-04001-TM. CORRESPONDENT'S E-MAIL ADDRESS: danj@fanperle.com. OFFICE ACTION. STRICT DEADLINE TO RESPOND TO THIS LETTER. TO AVOID ABANDONMENT OF APPLICANT'S TRADEMARK APPLICATION, THE USPTO MUST RECEIVE APPLICANT'S COMPLETE RESPONSE TO THIS LETTER WITHIN 6 MONTHS OF THE ISSUING DATE BELOW. A RESPONSE TRANSMITTED THROUGH THE TRADEMARK ELECTRONIC APPLICATION SYSTEM (TEAS) MUST BE RECEIVED BEFORE MIDNIGHT EASTERN TIME OF THE LAST DAY OF THE RESPONSE PERIOD. ISSUING MAILING DATE: 11/30/2018. THIS IS A FINAL ACTION. This Office action is in response to applicant's communication filed on November 9, 2018. The applicant (1) argued against the Section 2(e)(1) descriptiveness refusal, (2) amended the identification of goods; and (3) provided information about its goods. No (3) is acceptable. The product information provided by the applicant has been reviewed by the examining attorney. 1. Section 2(e)(1) Refusal - Descriptiveness. The refusal under Trademark Act Section 2(e)(1) is now made FINAL for the reasons set forth below. See 15 U.S.C. §1052(e)(1); 37 C.F.R. §2.63(b). A mark is merely descriptive if it describes an ingredient, quality, characteristic, function, feature, purpose, or use of an applicant's goods. TMPEP §1209.01(a); see, e.g., In re Pitkin, Inc., 783 F.2d 875, 174 USPQ2d 1574, 1575 (Fed. Cir. 2005) (quoting In re Oppenfeld & Larson LLP, 373 F.3d 1171, 71 USPQ2d 1376, 1378 (Fed. Cir. 2004)); In re ShredBuilding.com, 413 F.3d 1291, 1297, 75 USPQ2d 1430, 1421 (Fed. Cir. 2006) (citing Estate of P.D. Bachner, Inc. v. Comm'n of Patents, 232 U.S. 538, 544 (1920)). The applicant has applied to register FAMILYAPP (Standard Character) for "Downloadable mobile applications for posting, storing, organizing and sharing transactions, events, notes, updates, conversations, photos, videos and other family-related information within selected groups, namely, within family units, between authorized family units, and with connected service providers through controllable membership channels and exchanges employing conversational web tools and access to websites for advertising, coordinating network participation, programming interface connections and disseminating family care products and services." The applied for mark is a compound word mark consisting of the word "FAMILY" and the abbreviation "APP". "Family" is "A fundamental social group in society typically consisting of one or two parents and their children"; "The children of one of these groups"; and "A group of persons related by descent or marriage." See the excerpt from <https://www.uspto.gov/trademark/search.html?term=family> attached to the May 9, 2018 Office action. The applicant's goods are "Downloadable mobile applications for posting, storing, organizing and sharing transactions, events, notes, updates, conversations, photos, videos and other family-related information within selected groups, namely, within family units, between authorized family units, and with connected service providers through controllable membership channels and exchanges employing conversational web tools and access to websites for advertising, coordinating network participation, programming interface connections and disseminating family care products and services." [emphasis added]. Thus, the word "Family" describes the intended users of applicant's computer software application. *Wordings that describe an intended user or group of users of a product or service is merely descriptive.* E.g., In re Flamincio, Inc., 70 USPQ2d 1453 (TTAB 2004) (holding GABRIEL merely descriptive of intended user of risk management services in the field of pricing and purchasing natural gas); In re Comal Mfg. Co., 222 USPQ 1031 (TTAB 1984) (holding MOUNTAIN CAMPER merely descriptive of intended users of retail and mail order services in the field of outdoor equipment and apparel); see TMPEP §1209.01(c). An "app" is "A computer application." See the excerpt from <https://www.uspto.gov/trademark/search.html?term=app> attached to the May 9, 2018 Office action. "A computer application" is "A computer program designed for a specific task or use." See the excerpt from <https://www.uspto.gov/trademark/search.html?term=application> attached to the May 9 Office action. In this case, the word "app" is a generic name for the applicant's "Downloadable mobile applications" [emphasis added]. When descriptive terms are combined, the determination of whether the composite mark also has a descriptive significance turns upon the question of whether the combination of terms evokes a new and unique commercial impression. TMPEP §1209.01(b). If each component retains its descriptive significance in relation to the goods, as in the case here, the combination results in a composite that is itself descriptive. *Dispositi Medical Corp. v. Invisio Medical Device, Ltd.*, 695 F.3d 1247, 103 USPQ2d 1353 (Fed. Cir. 2012); *In re Oppenfeld & Larson LLP*, 373 F.3d 1171, 71 USPQ2d 1376 (Fed. Cir. 2004); *In re Gould Paper Corp.*, 834 F.2d 1017, 1018, 5 USPQ2d 1110, 1111-1112 (Fed. Cir. 1987). Moreover, where there is evidence that the composite mark itself has been used together to form a phrase that is descriptive of the goods, it is necessary to engage in an analysis of each individual component. *In re Silco Corp.*, 48 USPQ2d 1957, 1958 (TTAB 1998) (CARIFF MANAGEMENT merely descriptive of computer hardware and computer programs to control, reduce, and extend more efficient wide area network usage; TMPEP §1209.01(d)). The website excerpts attached to the May 9, 2018 Office action show that the term "family app" is used to describe a category of computer software applications specifically designed for use by families to manage and share family-related information, data, content, and/or media.

# Form paragraphs

The screenshot displays the USPTO Trademark Electronic Application System (TEAS) interface. The top navigation bar includes "Recent Cases", "ASTRELL", and the case number "90007839". The left sidebar contains a "Form Paragraphs" tab and a list of paragraphs from A to Z. The main content area shows a "Non-Final Action" form with a "Validation Errors" banner indicating "2 missing fields". A blue arrow points to a red box in the "SUMMARY OF ISSUES" section. The form text includes instructions on requesting an extension, the issue date of January 13, 2023, and contact information for Elizabeth Jackson.

Recent Cases ▾ ASTRELL 90007839 Office Actions ▾ Transactions ▾ Requests ▾

Form Paragraphs Evidence

Chapters USPs Recommended Favorites

Insert Paragraphs Insert

Show Search Box Draggable Paragraphs

- A. BASIS FOR FILING
- B. CLASSIFICATION OF GOODS/SERVICES
- C. IDENTIFICATION OF GOODS/SERVICES
- D. MULTIPLE-CLASS APPLICATIONS
- E. ATTORNEY/DOMICILE
- F. DATES-OF-USE CLAUSE
- G. DISCLAIMERS
- H. DISTINCTIVENESS/SUPPLEMENTAL REGISTER
- J. DRAWINGS
- K. SECTION 44 APPLICANTS
- L. INFORMALITIES AND OFFICE PROCEDURE
- M. MADRID APPLICANTS
- N. NAME, PORTRAIT, OR SIGNATURE OF AN INDIVIDUAL
- O. EXAMINER'S AMENDMENTS/PRIORITY ACTIONS
- P. PRIOR REGISTRATIONS
- Q. SUBSTANTIVE REFUSALS
- R. SEARCH PARAGRAPHS/DEFERRED ACTION PARAGRAPHS
- S. SPECIMENS
- T. TEAS PLUS
- V. USE OF MARK
- W. CLARIFICATION OF TYPES OF MARKS
- X. CERTIFICATION MARKS
- Y. COLLECTIVE MEMBERSHIP MARKS
- Z. COLLECTIVE MARKS FOR GOODS/SERVICES

Non-Final Action [90007839] Last Saved: 01/13/2023 11:10:04 am

Validation Errors • 2 missing fields

Includes form paragraphs: L39 L39-4 RU1 R6 L41 L54 FR-HTRES

File Edit Format Insert Review View

request an extension. For a ree. applicant may request one three-month extension or the response deadline prior to filing a response. The request must be filed within three months of the "Issue date" below. If the extension request is granted, the USPTO must receive applicant's response to this letter within six months of the "Issue date" to avoid abandonment of the application.

Issue date: January 13, 2023

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.

SUMMARY OF ISSUES:

- [Red Box]

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.

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

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. File a response form to this nonfinal Office action or file a request form for an extension of time to file a response.

Elizabeth Jackson/  
Elizabeth Jackson  
Managing Attorney  
Law Office 116  
(571) 272-6396  
Elizabeth.Jackson@USPTO.GOV

# User specified paragraphs (USPs)

The screenshot displays the USPTO Trademark Electronic Application System (TEAS) interface. At the top, the case number 90007839 is visible, along with the name ASTRELL and navigation options for Office Actions, Transactions, and Requests. The main document area shows a 'Non-Final Action' with a 'Validation Errors' banner indicating 2 missing fields. The document text includes a 'request an extension' section, an 'Issue date' of January 13, 2023, and a 'SUMMARY OF ISSUES' section with two redacted items. A 'SEARCH OF USPTO DATABASE OF MARKS' section follows, stating that no conflict was found. A blue arrow points from the 'Geographically Deceptive Misdescriptive' category in the 'My USPs' sidebar to the 'SUMMARY OF ISSUES' section. The sidebar also lists other categories like 'Statutory Refusals', 'Shared With Me', and 'Specimen Requirement'.

# Office action format

- Order of inclusion
  - Search clause
  - Substantive issues (if any)
  - Procedural issues (if any)
  - Advisories (if needed)
  - Evidence

# Attaching evidence

The screenshot shows a Microsoft Edge browser window with the URL <https://www.cnn.com>. The main content is a CNN article titled "Trump Organization fined \$1.6 million" with a sub-headline "A New York judge handed down the maximum possible penalty after two Trump entities were convicted last month of 17 felonies in a decade-long tax fraud scheme". A blue arrow points from the "Hello Elizabeth Jackson" pop-up window to the article. The pop-up window has a title bar "Hello Elizabeth Jackson" and a list of phone numbers with checkboxes:

- 88926764 LOSENGO
- 88930508 SPOTINI
- 90007833 REMANARS
- 90007839 ASTRELL
- 90007849 GASEDIN
- 90007857 ANDOWNS
- 90007876 INSETUDE

Below the list is a text input field "Enter serial numbers (separated by commas)", a "Validate serial number" button, and "Cancel" and "Upload" buttons. There is also a checkbox "Upload capture to My Evidence folder".

At the bottom of the browser window, there is a Microsoft Edge status bar showing "108.0.1462.42" and "11:20:50 AM 1/13/2023".



# Substantive grounds for refusal

- Possible grounds for refusal:
  - Likelihood of confusion
  - Merely descriptive
  - Geographically descriptive
  - Primarily merely a surname
  - False connection
  - Failure to function
  - Others



# Procedural grounds for refusal

- Possible grounds for refusal:
  - Identification/classification of goods/services
  - Disclaimers
  - Drawing issues
  - Specimen issues
  - Name/ownership issues
  - Other





# Approval for publication

- If the mark is **approved for publication**, and, if after publication, no one opposes the issuance of a registration, a registration will issue.
  - If the application was based on an **intent to use** the mark, the applicant must submit a **statement of use** before a registration is issued.
  - If an **opposition** was filed, it is considered by the Trademark Trial and Appeal Board.



# Deadlines

- Examining attorneys have seven days to take action on a new case.
- Section 1 and/or 44 applicants have three months to respond to any requirement or refusal addressed in an office action.
  - Applicants can request one 3-month extension per office action.
- If the applicant does not respond within the time period, the file is deemed abandoned.
- Once the applicant responds, the examining attorney has 21 days to take appropriate action.



# Production

- Depending on experience, examining attorneys must produce a certain number of actions per quarter.
- Examining attorneys receive credit for the first action taken and the final disposal of the case (approval or abandonment).
- Examining attorneys average over 1,000 first actions per year, or an average of five per day.
- Examining attorneys take action on about 2,300 cases per year and average about 12 cases per day.



# Examining attorney signatory authority

- **No signatory authority**
  - New attorneys must have all actions approved by a trainer.
- **Partial signatory authority**
  - About six months after starting, examining attorneys can autonomously issue all actions except publication/registration approvals and final refusals.
- **Probationary full signatory authority**
  - About one year after starting, examining attorneys can autonomously issue all actions except publication/registration approvals.
- **Full signatory authority**
  - Two years after starting, examining attorneys can autonomously issue all actions.



# Thank you!

**Susan Hayash**

Managing Attorney

[susan.hayash@uspto.gov](mailto:susan.hayash@uspto.gov)

571-272-9362

[www.uspto.gov](http://www.uspto.gov)