

UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)
OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION

U.S. APPLICATION SERIAL NO. 79232532

MARK: LEARN TO DARE

79232532

CORRESPONDENT ADDRESS:

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http://www.uspto.gov/trademarks/teas/response_form.jsp

APPLICANT: Etablissement d'enseignement supérieur c ETC.

CORRESPONDENT'S REFERENCE/DOCKET NO:

N/A

CORRESPONDENT E-MAIL ADDRESS:

OFFICE ACTION

STRICT DEADLINE TO RESPOND TO THIS LETTER

INTERNATIONAL REGISTRATION NO. 1402868

STRICT DEADLINE TO RESPOND TO THIS NOTIFICATION: TO AVOID ABANDONMENT OF THE REQUEST FOR EXTENSION OF PROTECTION OF THE INTERNATIONAL REGISTRATION, THE USPTO MUST RECEIVE A COMPLETE RESPONSE TO THIS PROVISIONAL FULL REFUSAL NOTIFICATION **WITHIN 6 MONTHS** OF THE "DATE ON WHICH THE NOTIFICATION WAS SENT TO WIPO (MAILING DATE)" LOCATED ON THE WIPO COVER LETTER ACCOMPANYING THIS NOTIFICATION.

In addition to the Mailing Date appearing on the WIPO cover letter, a holder (hereafter "applicant") may confirm this Mailing Date using the USPTO's Trademark Status and Document Retrieval (TSDR) system at <http://tsdr.uspto.gov/>. To do so, enter the U.S. application serial number for this application and then select "Documents." The Mailing Date used to calculate the response deadline for this provisional full refusal is the "Create/Mail Date" of the "IB-1st Refusal Note."

This is a **PROVISIONAL FULL REFUSAL** of the request for extension of protection of the mark in the above-referenced U.S. application. See 15 U.S.C. §1141h(c). See below in this notification (hereafter "Office action") for details regarding the provisional full refusal.

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 Office's database of registered and pending marks and has found no conflicting marks that would bar registration under Trademark Act Section 2(d). TMEP §704.02; see 15 U.S.C. §1052(d).

SUMMARY OF ISSUES

- Entity Indefinite
- Identification of Goods and Services

ENTITY INFORMATION OMITTED

The application identifies applicant as an EESC which is not acceptable as an entity designation in the United States because there is no clear U.S. equivalent legal entity and the entity designation does not appear in Appendix D of the *Trademark Manual of Examining Procedure*. See TMEP §803.03(i). Applicant must indicate the U.S. equivalent of its legal entity or provide a description of the nature of the foreign entity. See 37 C.F.R. §§2.32(a)(3), 2.61(b); TMEP §803.03(i).

IDENTIFICATION OF GOODS

The Trademark Act requires that a trademark or service mark application must include a "**specification** of ... the goods [or services]" in connection with which the mark is being used or will be used. 15 U.S.C. §1051(a)(2) (emphasis added), (b)(2) (emphasis added); see 15 U.S.C. §1053. Specifically, a complete application must include a "list of the **particular** goods or services on or in connection with which the applicant uses or intends to use the mark." 37 C.F.R. §2.32(a)(6) (emphasis added). This requirement for a specification of the particular goods and/or services applies to applications filed under all statutory bases. See 15 U.S.C. §§1051(a)(2), 1051(b)(2), 1053, 1126(d)-(e), 1141f; 37 C.F.R. §2.32(a)(6); TMEP §§1402.01, 1402.01(b)-(c).

Several entries in the identification of goods and services in applicant's 66(a) application are overbroad (including goods or services in multiple classes) and/or indefinite (ambiguous as to the specificity of the product), and require further clarification. The original language of applicant's identification is listed in the left column, the particular issue in the middle, and the Examiner's suggested language for amending the identification to comply with the degree of particularity required is listed in the right hand column.

Original Wording	Reason Unacceptable	Suggested Wording
<i>International Class 9:</i>		<i>International Class 9:</i>
Teaching apparatus and instruments	Applicant must specify with greater particularity the type of goods provided.	Teaching apparatus and instruments, namely, calculators
digital recording media	Applicant must specify the type of media, e.g., CDs, and indicate whether they are sold blank or pre-recorded. If pre-recorded, applicant must specify the subject of the recordings.	Digital recording media, namely, CDs sold blank.
data processing equipment	Applicant must specify with greater particularity the type of "equipment"	data processing equipment, namely, couplers
computers	Acceptable as written	computers
electronic tablets	Applicant must specify with greater particularity the type of "tablets"	Electronic tablet computers
smartphones	Acceptable as written	smartphones
electronic book readers	Acceptable as written	electronic book readers
game software	Acceptable as written	game software
software (recorded programs)	Applicant must remove the parenthetical wording and identify the function of the software, as well as the field of use, if applicable	Software for word processing
smartwatches	Acceptable as written	smartwatches
<i>International Class 16:</i>		<i>International Class 16</i>
Printing products (printed matter)	Applicant must incorporate the parenthetical wording into the identification. Additionally, applicant must identify with particularity the goods provided and the subject matter, if applicable	Printed matter in the nature of worksheets in the field of math
office requisites (except furniture)	Applicant must remove the parenthetical wording and indicate the exact type of goods provided	Office requisites, namely, staplers
instructional or teaching material (except apparatus)	Applicant must incorporate the parenthetical wording into the identification and specify with particularity the nature of the teaching material, e.g., workbooks, as well as their subject matter, e.g., math	instructional or teaching material, namely, workbooks in the field of math
paper	Acceptable as written	paper
cardboard	Acceptable as written	cardboard
boxes made of cardboard or paper	Acceptable as written	boxes made of cardboard or paper
posters	Acceptable as written	posters
cards	Applicant must clarify the type of cards provided in Class 16	Note cards
books	Applicant must specify the subject matter of these goods.	Books in the field of art
newspapers	Acceptable as written	newspapers
prospectuses	Applicant must specify the subject matter of these goods.	Prospectuses in the field of real estate
pamphlets	Applicant must specify the subject matter of these goods.	pamphlets in the field of real estate
bags (envelopes, pouches) of paper or plastics, for packaging	Applicant must incorporate the parenthetical wording.	Bags in the form of envelopes and pouches of paper or plastic for packaging
<i>International Class 35:</i>		<i>International Class 35:</i>

Advertising	Applicant must amend this wording to indicate that these are advertising services provided to others, to ensure that these are registrable services	Advertising services for others
commercial business management	Acceptable as written	commercial business management
commercial administration	Applicant must amend this wording to specify what is being administered.	Commercial administration of the licensing of toll-free vanity telephone numbers
dissemination of advertising material (leaflets, prospectuses, printed matter, samples)	Applicant must incorporate the parenthetical wording into the identification	dissemination of advertising material for others in the nature of leaflets, prospectuses, printed matter, samples
business management and organization consultancy	Acceptable as written	business management and organization consultancy
online advertising on a computer network	Acceptable as written	online advertising on a computer network
rental of advertising time on all communication media	Acceptable as written	rental of advertising time on all communication media
publication of advertising texts	Acceptable as written	publication of advertising texts
rental of advertising space	Acceptable as written	rental of advertising space
dissemination of advertisements	Acceptable as written	dissemination of advertisements
advice regarding communication (advertising)	Applicant must more clearly specify the nature of the services and incorporate the parenthetical wording.	advice regarding communication, namely, consulting in the field of advertising
public relations	Acceptable as written	public relations
advice regarding communication (public relations)	Applicant must more clearly specify the nature of the services and incorporate the parenthetical wording.	advice regarding communication, namely, consulting in the field of public relations
<i>International Class 41:</i>		<i>International Class 41:</i>
Education	Applicant must specify the means (e.g., courses, workshops, seminars) and the field (e.g., math, art, literature)	Education services, namely, courses in the field of literature
training	Applicant must specify the field of training.	Training in the field of math
sporting and cultural activities	Applicant must more clearly identify the type of activities provided, e.g., competitions in the field of sports	sporting and cultural activities, namely, competitions in the field of sports
information relating to education	Applicant must more clearly identify what type of information is provided	information relating to education, namely, providing information about educational opportunities online
vocational retraining	Applicant should specify the field of education, e.g., plumbing	vocational retraining in the field of plumbing
publication of books	Acceptable as written	publication of books
book lending	Acceptable as written	book lending
provision of non-downloadable films via video-on-demand services	Acceptable as written	provision of non-downloadable films via video-on-demand services
motion picture production	Acceptable as written	motion picture production
organization of competitions (education or entertainment)	Applicant must specify the type of competitions and incorporate or remove the parenthetical wording into the identification.	organization of competitions in the field of soccer

organization and conducting of colloquiums	Applicant must specify the subject of this event.	organization and conducting of colloquiums in the field of art
organization and conducting of conferences	Applicant must specify the subject of this event.	organization and conducting of conferences in the field of art
organization and conducting of congresses	Applicant must specify the subject of this event.	organization and conducting of congresses in the field of art
organization of exhibitions for cultural or educational purposes	Acceptable as written	organization of exhibitions for cultural or educational purposes
electronic publication of books and journals online.	Acceptable as written	electronic publication of books and journals online.

Applicant may adopt the following, if accurate:

International Class 9: Teaching apparatus and instruments, **namely, calculators**; Digital recording media, **namely, CDs sold blank**; data processing equipment, **namely, couplers**; computers; Electronic **tablet computers**; smartphones; electronic book readers; game software; **Software for word processing**; smartwatches

International Class 16: Printed matter in the nature of **worksheets in the field of math**; Office requisites, **namely, staplers**; instructional or teaching material, **namely, workbooks in the field of math**; paper; cardboard; boxes made of cardboard or paper; posters; **Note cards**; Books **in the field of art**; newspapers; Prospectuses **in the field of real estate**; pamphlets **in the field of real estate**; Bags **in the form of envelopes and pouches of paper or plastic for packaging**;

International Class 35: Advertising **services for others**; commercial business management; Commercial administration of the **licensing of toll-free vanity telephone numbers**; dissemination of advertising material for others in the nature of leaflets, prospectuses, printed matter, samples; business management and organization consultancy; online advertising on a computer network; rental of advertising time on all communication media; publication of advertising texts; rental of advertising space; dissemination of advertisements; advice regarding communication, **namely, consulting in the field of advertising**; public relations; advice regarding communication, **namely, consulting in the field of public relations**

International Class 41: Education services, namely, courses in the field of literature Training **in the field of math**; sporting and cultural activities, **namely, competitions in the field of sports**; information relating to education, **namely, providing information about educational opportunities online**; vocational retraining **in the field of plumbing**; publication of books; book lending; provision of non-downloadable films via video-on-demand services; motion picture production; organization of competitions **in the field of soccer**; organization and conducting of colloquiums **in the field of art**; organization and conducting of conferences **in the field of art**; organization and conducting of congresses **in the field of art**; organization of exhibitions for cultural or educational purposes; electronic publication of books and journals online

Applicant's goods and/or services may be clarified or limited, but may not be expanded beyond those originally itemized in the application or as acceptably narrowed. See 37 C.F.R. §2.71(a); TMEP §§1402.06, 1904.02(c)(iv). Applicant may clarify or limit the identification by inserting qualifying language or deleting items to result in a more specific identification; however, applicant may not substitute different goods and/or services or add goods and/or services not found or encompassed by those in the original application or as acceptably narrowed. See TMEP §1402.06(a)-(b). The scope of the goods and/or services sets the outer limit for any changes to the identification and is generally determined by the ordinary meaning of the wording in the identification. TMEP §§1402.06(b), 1402.07(a)-(b). Any acceptable changes to the goods and/or services will further limit scope, and once goods and/or services are deleted, they are not permitted to be reinserted. TMEP §1402.07(e). Additionally, for applications filed under Trademark Act Section 66(a), the scope of the identification for purposes of permissible amendments is limited by the international class assigned by the International Bureau of the World Intellectual Property Organization (International Bureau); and the classification of goods and/or services may not be changed from that assigned by the International Bureau. 37 C.F.R. §2.85(d); TMEP §§1401.03(d), 1904.02(b). Further, in a multiple-class Section 66(a) application, classes may not be added or goods and/or services transferred from one existing class to another. 37 C.F.R. §2.85(d); TMEP §1401.03(d).

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.

APPLICANT MAY WISH TO SEEK TRADEMARK COUNSEL

Because of the legal technicalities and strict deadlines involved in the USPTO application process, applicant may wish to hire a qualified U.S. attorney specializing in trademark matters to represent applicant in this process and provide legal advice. Although the undersigned trademark examining attorney is permitted to help an applicant understand the contents of an Office action as well as the application process in general, no USPTO attorney or staff is permitted to give an applicant legal advice or statements about an applicant's legal rights. TMEP §§705.02, 709.06. For attorney referral information, applicant may consult the [American Bar Association's Consumers' Guide to Legal Help](#) or an online directory of legal professionals, such as [FindLaw®](#). The USPTO, however, may not assist an applicant in the selection of an attorney. 37 C.F.R. §2.11.

Please note that foreign attorneys, other than authorized Canadian attorneys, are not permitted to represent applicants before the USPTO (e.g., file written communications, authorize an amendment to an application, or submit legal arguments in response to a requirement or refusal). See 37 C.F.R. §§2.17(e), 11.14(c), (e); TMEP §602.03-.03(c).

RESPONDING TO OFFICE ACTIONS

For this application to proceed further, applicant must explicitly address each refusal and/or requirement raised in this Office action. If the action includes a refusal, applicant may provide arguments and/or evidence as to why the refusal should be withdrawn and the mark should register. Applicant may also have other options specified in this Office action for responding to a refusal, and should consider those options carefully. To respond to requirements and certain refusal response options, applicant should set forth in writing the required changes or statements. For more information and general tips on responding to USPTO Office actions, response options, and how to file a response online, see "Responding to Office Actions" on the USPTO's website.

If applicant does not respond to this Office action within six months of the date on which the USPTO sends this Office action to the International Bureau, or responds by expressly abandoning the application, the application process will end and the trademark will fail to register. *See* 15 U.S.C. §1062(b); 37 C.F.R. §§2.65(a), 2.68(a); TMEP §§711, 718.01, 718.02.

When an application has abandoned for failure to respond to an Office action, an applicant may timely file a petition to revive the application, which, if granted, would allow the application to return to active status. *See* 37 C.F.R. §2.66; TMEP §1714. The petition must be filed within two months of the date of issuance of the notice of abandonment and may be filed online via the Trademark Electronic Application System (TEAS) with a \$100 fee. *See* 37 C.F.R. §§2.6(a)(15)(ii), 2.66(a)(1), (b)(1).

If applicant has questions regarding this Office action, please telephone or e-mail the assigned trademark examining attorney. All relevant e-mail communications will be placed in the official application record; however, an e-mail communication will not be accepted as a response to this Office action and will not extend the deadline for filing a proper response. *See* 37 C.F.R. §§2.62(c), 2.191; TMEP §§304.01-.02, 709.04-.05. Further, although the trademark examining attorney may provide additional explanation pertaining to the refusal(s) and/or requirement(s) in this Office action, the trademark examining attorney may not provide legal advice or statements about applicant's rights. *See* TMEP §§705.02, 709.06.

WHO IS PERMITTED TO RESPOND TO THIS PROVISIONAL FULL REFUSAL: Any response to this provisional refusal must be personally signed by an individual applicant, all joint applicants, or someone with legal authority to bind a juristic applicant (e.g., a corporate officer or general partner). 37 C.F.R. §§2.62(b), 2.193(e)(2)(ii); TMEP §712.01. If applicant hires a qualified U.S. attorney to respond on his or her behalf, then the attorney must sign the response. 37 C.F.R. §§2.193(e)(2)(i), 11.18(a); TMEP §§611.03(b), 712.01. Qualified U.S. attorneys include those in good standing with a bar of the highest court of any U.S. state, the District of Columbia, Puerto Rico, and other U.S. commonwealths or U.S. territories. *See* 37 C.F.R. §§2.17(a), 2.62(b), 11.1, 11.14(a); TMEP §§602, 712.01. Additionally, for all responses, the proper signatory must personally sign the document or personally enter his or her electronic signature on the electronic filing. *See* 37 C.F.R. §2.193(a); TMEP §§611.01(b), 611.02. The name of the signatory must also be printed or typed immediately below or adjacent to the signature, or identified elsewhere in the filing. 37 C.F.R. §2.193(d); TMEP §611.01(b).

In general, foreign attorneys are not permitted to represent applicants before the USPTO (e.g., file written communications, authorize an amendment to an application, or submit legal arguments in response to a requirement or refusal). *See* 37 C.F.R. §11.14(c), (e); TMEP §§602.03-.03(b), 608.01.

DESIGNATION OF DOMESTIC REPRESENTATIVE: The USPTO encourages applicants who do not reside in the United States to designate a domestic representative upon whom any notice or process may be served. TMEP §610; *see* 15 U.S.C. §§1051(e), 1141h(d); 37 C.F.R. §2.24(a)(1)-(2). Such designations may be filed online at <http://www.uspto.gov/trademarks/teas/correspondence.jsp>.

/Diane Collopy/
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TO RESPOND TO THIS LETTER: Go to http://www.uspto.gov/trademarks/teas/response_forms.jsp. Please wait 48-72 hours from the issue/mailed date before using the Trademark Electronic Application System (TEAS), to allow for necessary system updates of the application. For *technical* assistance with online forms, e-mail TEAS@uspto.gov. For questions about the Office action itself, please contact the assigned trademark examining attorney. **E-mail communications will not be accepted as responses to Office actions; therefore, do not respond to this Office action by e-mail.**

All informal e-mail communications relevant to this application will be placed in the official application record.

WHO MUST SIGN THE RESPONSE: It must be personally signed by an individual applicant or someone with legal authority to bind an applicant (i.e., a corporate officer, a general partner, all joint applicants). If an applicant is represented by an attorney, the attorney must sign the response.

PERIODICALLY CHECK THE STATUS OF THE APPLICATION: To ensure that applicant does not miss crucial deadlines or official notices, check the status of the application every three to four months using the Trademark Status and Document Retrieval (TSDR) system at <http://tsdr.uspto.gov/>. Please keep a copy of the TSDR status screen. If the status shows no change for more than six months, contact the Trademark Assistance Center by e-mail at TrademarkAssistanceCenter@uspto.gov or call 1-800-786-9199. For more information on checking status, see <http://www.uspto.gov/trademarks/process/status/>.

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