

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

U.S. Application Serial No. 79315082

Mark: FREE SHIFT

Correspondence Address:
TSUJIMOTO KIYOSHI
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Osaka 542-0064
JAPAN
Applicant: SHIMANO INC.

Reference/Docket No. N/A

Correspondence Email Address:

NONFINAL OFFICE ACTION

International Registration No. 1600886

Notice of Provisional Full Refusal

Deadline for responding. The USPTO must receive applicant's response **within six months of the "date on which the notification was sent to WIPO (mailing date)"** located on the WIPO cover letter, or the U.S. application will be abandoned (see <https://www.uspto.gov/trademarks-application-process/abandoned-applications> for information on abandonment). To confirm the mailing date, go to the USPTO's Trademark Status and Document Retrieval (TSDR) database at <https://tsdr.uspto.gov/>, select "US Serial, Registration, or Reference No.," enter the U.S. application serial number in the blank text box, and click on "Documents." The mailing date used to calculate the response deadline is the "Create/Mail Date" of the "1st Refusal Note."

Respond to this Office action using the USPTO's Trademark Electronic Application System (TEAS). A link to the appropriate TEAS response form appears at the end of this Office action.

Discussion of provisional full refusal. This is a provisional full refusal of the request for extension of protection to the United States of the international registration, known in the United States as a U.S. application based on Trademark Act Section 66(a). See 15 U.S.C. §§1141f(a), 1141h(c).

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:

- Section 2(e)(1) Refusal – Merely Descriptive
- Information Request
- Applicant Email Required
- U.S. Counsel Required

SEARCH OF USPTO DATABASE OF MARKS

The trademark examining attorney searched the USPTO database of registered and pending marks and found no conflicting marks that would bar registration under Trademark Act Section 2(d). 15 U.S.C. §1052(d); TMEP §704.02.

However, the applicant should note the following refusal and requirements:

SECTION 2(e)(1) REFUSAL - MERELY DESCRIPTIVE

The applied for mark is "PROSHIFT" in International Class 012 for "Bicycles, including electric bicycles; parts, fittings and accessories for bicycles, including electric bicycles, namely, hubs, derailleurs, cranks, crank sets, front chain wheels, electric motors for bicycles."

Registration is refused because the applied-for mark merely describes a feature and characteristic of applicant's goods. Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1); see TMEP §§1209.01(b), 1209.03 *et seq.*

A mark is merely descriptive if it describes an ingredient, quality, characteristic, function, feature, purpose, or use of an applicant's goods. TMEP §1209.01(b); see, e.g., *In re TriVita, Inc.*, 783 F.3d 872, 874, 114 USPQ2d 1574, 1575 (Fed. Cir. 2015) (quoting *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 1173, 71 USPQ2d 1370, 1371 (Fed. Cir. 2004)); *In re Steelbuilding.com*, 415 F.3d 1293, 1297, 75 USPQ2d 1420, 1421 (Fed. Cir. 2005) (citing *Estate of P.D. Beckwith, Inc. v. Comm'r of Patents*, 252 U.S. 538, 543 (1920)).

Generally, if the individual components of a mark retain their descriptive meaning in relation to the goods, the combination results in a composite mark that is itself descriptive and not registrable. *In re Fat Boys Water Sports LLC*, 118 USPQ2d 1511, 1516 (TTAB 2016) (citing *In re Tower Tech, Inc.*, 64 USPQ2d 1314, 1317-18 (TTAB 2002)); TMEP §1209.03(d); see, e.g., *In re Cannon Safe, Inc.*, 116 USPQ2d 1348, 1351 (TTAB 2015) (holding SMART SERIES merely descriptive of metal gun safes); *In re King Koil Licensing Co.*, 79 USPQ2d 1048, 1052 (TTAB 2006) (holding THE BREATHABLE MATTRESS merely descriptive of beds, mattresses, box springs, and pillows).

Only where the combination of descriptive terms creates a unitary mark with a unique, incongruous, or otherwise nondescriptive meaning in relation to the goods is the combined mark registrable. See *In re Colonial Stores, Inc.*, 394 F.2d 549, 551, 157 USPQ 382, 384 (C.C.P.A. 1968); *In re Positec Grp. Ltd.*, 108 USPQ2d 1161, 1162-63 (TTAB 2013).

In this case, both the individual components and the composite result are descriptive of applicant's goods and do not create a unique, incongruous, or nondescriptive meaning in relation to the goods and/or services.

"FREE" is defined in part as: "Unobstructed; clear."

- <https://www.ahdictionary.com/word/search.html?q=free>

"SHIFT" is defined in part as: "To change (gears), as in an automobile."

- <https://www.ahdictionary.com/word/search.html?q=shift>

Thus, the combined wording "FREE SHIFT" describes a mechanism used to change gears that operates in an unobstructed manner.

Further, the attached evidence from third-party websites shows others using the wording "FREE SHIFT" used in a descriptive manner with bicycles and their parts.

- <https://www.amazon.com/PEXMOR-Tricycle-Three-Wheeled-Adjustable-Recreation/dp/B08W9BTMHZ>
- <https://www.mountainbikers.bike/bikes/mountain-bikes/20a-aluminum-alloy-mountain-bike-with-front-suspension-26-inch-wheels-21-multiple-speed-dual-disc-brakes-outdoor-bicycle-adult-hybrid-road-bicycles-for-men-and-women-black-1675639/>

Based on the above, registration is refused under Trademark Act Section 2(e)(1).

Although applicant's mark has been refused registration, applicant may respond to the refusal by submitting evidence and arguments in support of registration. However, if applicant responds to the refusal, applicant must also respond to the requirements set forth below.

INFORMATION REQUEST

Due to the descriptive nature of the applied-for mark, applicant must provide the following information and documentation regarding the goods and wording appearing in the mark:

- (1) Fact sheets, instruction manuals, brochures, advertisements and pertinent screenshots of applicant's website as it relates to the goods and/or services in the application, including any materials using the terms in the applied-for mark. Merely stating that information about the goods and/or services is available on applicant's website is insufficient to make the information of record.;
- (2) If these materials are unavailable, applicant should submit similar documentation for goods of the same type, explaining how its own product or services will differ. If the goods feature new technology and information regarding competing goods is not available, applicant must provide a detailed factual description of the goods. Factual information about the goods must make clear how they operate, salient features, and prospective customers and channels of trade. Conclusory statements will not satisfy this requirement.; and
- (3) Applicant must respond to the following questions:
 - Do applicant's competitors use "FREE" to advertise similar goods? If so, please explain.
 - Do applicant's competitors use "SHIFT" to advertise similar goods? If so, please explain.
 - Do applicant's competitors use "FREE SHIFT" to advertise similar goods? If so, please explain.
 - What is the significance of "FREE" in connection with applicant's goods?
 - What is the significance of "SHIFT" in connection with applicant's goods?
 - What is the significance of "FREE SHIFT" in connection with applicant's goods?
 - Who is the typical consumer of applicant's goods?

See 37 C.F.R. §2.61(b); TMEP §§814, 1402.01(e).

Failure to comply with a request for information is grounds for refusing registration. *In re Harley*, 119 USPQ2d 1755, 1757-58 (TTAB 2016); TMEP §814.

APPLICANT EMAIL REQUIRED

Email address required. Applicant must provide applicant's email address, which is a requirement for a complete application. See 37 C.F.R. §2.32(a)(2); TMEP §803.05(b). This email address cannot be identical to the primary correspondence email address of a U.S.-licensed attorney retained to represent applicant in this application. See TMEP §803.05(b).

U.S. COUNSEL REQUIRED

Applicant is required to be represented by a U.S.-licensed attorney to respond to or appeal the provisional refusal because applicant's domicile is located outside of the United States and applicant does not appear to be represented by a qualified U.S. attorney. 37 C.F.R. §2.11(a); TMEP §601.01(a). An applicant whose domicile is located outside of the United States or its territories must be represented by an attorney who is an active member in good standing of the bar of the highest court of a U.S. state or territory. 37 C.F.R. §2.11(a); TMEP §§601, 601.01(a). In this case, applicant's domicile is identified in the application as Japan. For more information, see the U.S. Counsel webpage at <https://www.uspto.gov/trademark/laws-regulations/trademark-rule-requires-foreign-applicants-and-registrants-have-us> and Hiring a U.S.-licensed trademark attorney webpage at <https://www.uspto.gov/trademarks-getting-started/why-hire-private-trademark-attorney>.

To appoint a U.S.-licensed attorney in this application, applicant should submit a completed Trademark Electronic Application System (TEAS) Change Address or Representation form at <https://teas.uspto.gov/wma/ccr/car>. The newly-appointed attorney must submit a TEAS Response to Examining Attorney Office Action form at <https://teas.uspto.gov/office/roa/> indicating that an appointment of attorney has been made and address all other refusals or requirements in this action. Alternatively, if applicant retains an attorney before filing the response, the attorney can respond to this Office action by using the appropriate TEAS response form and provide his or her attorney information in the form and sign it as applicant's attorney. See 37 C.F.R. §2.17(b)(1)(ii); TMEP §604.01.

RESPONSE GUIDELINES

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.

Until applicant establishes its U.S. domicile, the assigned trademark examining attorney may not communicate with applicant by phone or email about this Office action or the application. See 37 C.F.R. §§2.11(a), 2.18(a)(1)-(2); TMEP §709.02, .04. If applicant appoints a qualified U.S.-licensed attorney, the USPTO will communicate only with that attorney and not the applicant. See 37 C.F.R. §2.18(a)(2); TMEP §609.01.

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

/Sarah E. Kunkleman/
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571-272-6151
sarah.kunkleman@uspto.gov

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.

https://www.amazon.com/PEXMOR-Tricycle-Three-Wheeled-Adjustable-Recreation/dp/B08W9BTMHZ
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Brand: PEXMOR

PEXMOR Adult Tricycle 7 Speed 24" Wheels Trike Cruise Bike, Three-Wheeled Bicycle with Front and Rear Basket Adjustable Height Seat for Recreation, Shopping, Picnic, Exercise Men's Women's Bike, Blue

★★★★☆ 14 ratings

Price: \$275.99

Coupon: ☐ Save an extra 5% when you apply this coupon. Terms

Pay \$23.00/month for 12 months, interest-free upon approval for the Amazon Rewards Visa Card

Bike Type	Tricycle
Age Range (Description)	Adult
Brand	PEXMOR
Wheel Size	24 Inches
Suspension Type	Rear, Front

\$275.99

\$49.99 delivery: Nov 18 - 24

Select delivery location

In Stock.

Qty: 1

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Return policy: Returnable until Jan 31, 2022

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



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About this item

-  **High-Carbon Steel Material**--This 3-wheeled bike is constructed from high-carbon steel with thicker frame tube for strength and durability. It can support rider and cargo combined weight up to 331 lbs.
-  **Large Basket with 7 Speed**--The tricycle has a foldable front basket and a 17.32"x 20.07"x 9.84" large rear basket, which can hold many vegetables, fruits, breads etc. 7-speed flywheel offers more fun in riding, shifters for effortless pedaling and shifting.
-  **Meet your different height needs**--This trike with adjustable height position and handlebar fits adult men and women of different height, letting your elders enjoy their riding around town, the beach or on a bike path.
-  **Enjoy Your Cycling**--This tricycle is ideal for an elder who hardly balance on a two wheels bike or walks for a little distance. You can ride it to shopping, picnic or exercise, which gives you the freedom and joy of cycling.
-  **Attention Note:** To ensure that the products you receive will not be damaged, we split the tricycle into 2 separate packages for delivery and may arrive in different time. You could contact us for another tracking number if another parcel arrives later than 3 days. One-year warranty on all defective or damaged parts.



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AOA Aluminum Alloy Mountain Bike with Front Suspension - 26 inch Wheels - 21 Multiple Speed - Dual Disc Brakes, Outdoor Bicycle, Adult Hybrid Road Bicicletas for Men and Women, Black

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AOA POWER Mountain Bike

2021 AOA Aluminum Alloy Mountain Bike with Front Suspension - 26 inch Wheels - 21 Multiple Speed - Dual Disc Brakes, Outdoor Bicycle, Adult Hybrid Road Bicicletas for Men and Women, Black

\$319.99



2021 AOA POWER Bike

【FREE PEDAL & bicycle SEAT】: This aluminum alloy mountain **Bike** is equipped with sturdy, durable pedal and comfortable **Bike** seat. The pedals are firm and not easy to fall off, and the seat is soft and durable, providing safe support for your long-term riding, ergonomics design reduce hip pressure, encrypted spoke (Three knife integrated wheel optional) design helps to ride more steadily and labor-saving

【POWERFUL DERAILLEUR & BRAKING SYSTEM】: With Shimano 51-7 finger shifter, 21 Speed derailleur, shifting properly or shifting rough, equipped with Cassette disc brake, double disc brake Front and Rear Disc Brakes and Quick Releases, help to keep you safe even in high speeds and down sloppy terrains. You will also have more control on when and where to stop, enjoy riding experience

【FREE SHIFT】: 26 inches mountain **Bike** with 21-speed trigger derailleur and Shimano 21 speed finger shifter, providing you a wide gear range, easy to have quick shifts. Freely variable speed according to terrain.

Mountain Bike by AOA POWER

: AOA Aluminum Alloy Mountain Bike with Front Suspension - 26 inch Wheels - 21 Multiple Speed - Dual Disc Brakes, Outdoor Bicycle, Adult Hybrid Road Bicicletas for Men and Women, Black

[AOA POWER Mountain Bikes »](#)

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2021 AOA Aluminum Alloy Mountain Bike with Front Suspension - 26 inch Wheels - 21 Multiple Speed - Dual Disc Brakes, Outdoor Bicycle, Adult Hybrid Road Bicicletas for Men and Women, Black Full Specification





Price \$319.99

Model luminum Alloy Mountain Bike with Front Suspension - 26 inch Wheels - 21 Multiple Speed - Dual Disc Brakes, Outdoor Bicycle, Adult Hybrid Road

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Model	Bicicletas for Men and Women, Black
Brand	AOA POWER
Year	2021
Features	<p>Freely variable speed according to terrain.You will also have more control on when and where to stop, enjoy riding experience. 【FREE SHIFT】 : 26 inches mountain Bike with 21-speed trigger derailleur and Shimano 21 speed finger shifter, providing you a wide gear range, easy to have quick shifts.</p> <p>【FREE PEDAL & bicycle SEAT】 : This aluminum alloy mountain Bike is equipped with sturdy, durable pedal and comfortable Bike seat.The pedals are firm and not easy to fall off, and the seat is soft and durable, providing safe support for your long-term riding, ergonomics design reduce hip pressure, encrypted spoke (Three knife integrated wheel optional) design helps to ride more steadily and labor-saving. 【POWERFUL DERAILLEUR & BRAKING SYSTEM】 : With Shimano 51-7 finger shifter, 21 Speed derailleur, shifting properly or shifting rough, equipped with Cassette disc brake, double disc brake Front and Rear Disc Brakes and Quick Releases, help to keep you safe even in high speeds and down sloppy terrains.</p>
Manufacturer	AOA

Related Mountain Bikes

			
\$966.14 DGAGD 24 inch Mountain Bike Bicycle Adult one-Wheel Variable Speed Three-Wheel Bicycle-Light Blue_27 Speed	\$779.84 DGAGD 24 inch Mountain Bike Adult Variable Speed Bicycle Light Road Racing six-Wheel-Blue_27 Speed	\$848.15 DGAGD 26 inch Mountain Bike Adult Variable Speed Bicycle Light Road Racing six-Wheel-Yellow_30 Speed	\$748.79 DGAGD 24 inch Mountain Bike Adult Variable Speed Bicycle Light Road Racing 40 Cutter Wheels-Blue_30 Speed
★★★★☆	★★★★☆	★★★★☆	★★★★☆

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THE USAGE PANEL

The Usage Panel is a group of nearly 200 prominent scholars, creative writers, journalists, diplomats, and others in occupations requiring mastery of language. Annual surveys have gauged the acceptability of particular usages and grammatical constructions.

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NEED HELP SOLVING A CROSSWORD

DICTIONARY

free ^{frē} (frē)

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adj. **frē·er**, **frē·est**

1.
 - a. Not imprisoned or confined: walked out of prison a free man; set the birds free.
 - b. Not controlled by obligation or the will of another: felt free to go.
2.
 - a. Not controlled by another country or political power; independent: a free nation.
 - b. Governed by consent and possessing or granting civil liberties: a free citizenry.
 - c. Not subject to arbitrary interference by a government: a free press.
 - d. Not enslaved.
3.
 - a. Not affected or restricted by a given condition or circumstance: a healthy animal, free of disease; people free from need.
 - b. Not subject to a given condition; exempt: income that is free of all taxes.
4.
 - a. Not bound by convention or the rules of form: a free artistic style.
 - b. Not literal or exact: a free translation.
5.
 - a. Costing nothing; gratuitous: a free meal.
 - b. Publicly supported: free education.
6.
 - a. Unobstructed; clear: a free lane on the highway.
 - b. Not occupied or used: a free locker; free energy.
 - c. Not taken up by scheduled activities: free time between classes.
7.
 - a. Immoderate in giving or spending; liberal or lavish: tourists who are free with their money.
 - b. Frank or unguarded in expression or manner; open or outspoken: She is very free with her opinions.
8. Given, made, or done of one's own accord; voluntary or spontaneous: a free act of the will; free choices.
9. Chemistry & Physics
 - a. Unconstrained; unconfined: free expansion.
 - b. Not fixed in position; capable of relatively unrestricted motion: a free electron.
 - c. Not chemically bound in a molecule: free oxygen.



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PUZZLE?

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- d.** Involving no collisions or interactions: a free path.
- e.** Empty or unoccupied: a free space; an atom with a free energy level.
- 10.** Nautical Favorable: a free wind.
- 11.** Not bound, fastened, or attached: the free end of a chain.
- 12.** Linguistics
 - a.** Being a form, especially a morpheme, that can stand as an independent word, such as boat or bring.
 - b.** Being a vowel in an open syllable, as the o in go.

adv.

- 1.** In a free manner; without restraint.
- 2.** Without charge.

tr.v. **freed, free-ing, frees**

- 1.** To make free, as from confinement or oppression: freed the slaves.
- 2.** To relieve of a burden, obligation, or restraint: a people who were at last freed from fear.
- 3.** To remove obstructions or entanglements from; clear: free a path through the jungle.
- 4.** To make available: Canceling the program freed up money for the new library.

n.

Sports

Freestyle.

Idiom:

for free Informal
Without charge.

[Middle English *fre*, from Old English *frēo*. V., from Middle English *freien*, from Old English *frēon*, to love, set free; see *prī-* in the Appendix of Indo-European roots.]

free *ly* adv.

free *ness* n.

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Indo-European & Semitic Roots Appendices

Thousands of entries in the dictionary include etymologies that trace their origins back to reconstructed proto-languages. You can obtain more information about these forms in our online appendices:

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The Usage Panel is a group of nearly 200 prominent scholars, creative writers, journalists, diplomats, and others in occupations requiring mastery of

shift (shift)

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v. **shift·ed**, **shift·ing**, **shifts**
v.tr.

1. To exchange (one thing) for another of the same class: shifted assignments among the students.
2. To move or transfer from one place or position to another.
3. To alter (position or place).
4. To change (gears), as in an automobile.
5. Linguistics To alter phonetically as part of a systematic historical change.

v.intr.

1. To change position, direction, place, or form.
2.
 - a. To provide for one's own needs; get along: "See me safe up: for my coming down, I can shift for myself" (Thomas More).
 - b. To get along by tricky or evasive means.
3. To change gears, as when driving an automobile.
4. Linguistics To be altered as part of a systematic historical change. Used of speech sounds.
5. To use a shift key.

n.

1. A change from one person or configuration to another; a substitution.
2.
 - a. A group of workers that relieve another on a regular schedule.
 - b. The working period of such a group: worked the night shift.
3.
 - a. A means to an end; an expedient.
 - b. A stratagem; a trick.
4. A change in direction: a shift in the wind.
5. A change in attitude, judgment, or emphasis.
6. A change in position, as:
 - a. Music A change of the hand position in playing the violin or a similar



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NEED HELP SOLVING A CROSSWORD PUZZLE?

Go to our [Crossword Puzzle Solver](#) and type in the letters that you know, and the Solver will produce a list of possible solutions.

- a.** Music A change of the hand position in playing the violin or a similar instrument.
 - b.** Football A rearrangement of players from one formation to another just prior to the snap of the ball.
 - c.** Baseball A rearrangement of one or more fielders for improved defense against a particular hitter.
 - d.** Geology See fault.
 - e.** Computers Movement of characters in a register to the left or right, as of the bits in a byte.
7. The act or an instance of using a shift key.
8. Physics A change in wavelength, causing a movement of a spectral band or line.
9. Linguistics
- a.** A systematic change of the phonetic or phonemic structure of a language.
 - b.** Functional shift.
- 10.
- a.** A loosely fitting dress that hangs straight from the shoulder; a chemise.
 - b.** A woman's undergarment; a slip or chemise.

[Middle English *shiften*, from Old English *sciftan*, to arrange, divide.]

shift *er n.*

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Indo-European & Semitic Roots Appendices

Thousands of entries in the dictionary include etymologies that trace their origins back to reconstructed proto-languages. You can obtain more information about these forms in our online appendices.

Indo-European Roots

Semitic Roots

The Indo-European appendix covers nearly half of the Indo-European roots that have left their mark on English words. A more complete treatment of Indo-European roots and the English words derived from them is available in our [Dictionary of Indo-European Roots](#).



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