

To: Kogan, Nataly (natalykogan@gmail.com)
Subject: TRADEMARK APPLICATION NO. 77095442 - WORK IT, MOM! - N/A
Sent: 5/15/2008 5:07:39 PM
Sent As: ECOM101@USPTO.GOV
Attachments:

UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 77/095442

MARK: WORK IT, MOM!

77095442

CORRESPONDENT ADDRESS:

KOGAN, NATALY
Work It, Mom! LLC
44 Pine Street
West Newton MA 02465

RESPOND TO THIS ACTION:

<http://www.uspto.gov/teas/eTEASpageD.htm>

GENERAL TRADEMARK INFORMATION:

<http://www.uspto.gov/main/trademarks.htm>

APPLICANT: Kogan, Nataly

CORRESPONDENT'S REFERENCE/DOCKET NO :

N/A

CORRESPONDENT E-MAIL ADDRESS:

natalykogan@gmail.com

OFFICE ACTION

TO AVOID ABANDONMENT, THE OFFICE MUST RECEIVE A PROPER RESPONSE TO THIS OFFICE ACTION WITHIN 6 MONTHS OF THE ISSUE/MAILING DATE.

ISSUE/MAILING DATE: 5/15/2008

This Office action is in response to applicant's communication filed on April 23, 2008.

Amendment to the Identification of Goods – International Class 9

The proposed amendment to the identification cannot be accepted because it refers to goods and/or services that are completely different from, and thus broader in scope than the goods and/or services set forth in the application at the time of filing. Although identifications of goods and/or services may be amended to clarify or limit the goods and/or services, additions to the identification or a broadening of the scope of the identification are not permitted. 37 C.F.R. §2.71(a); *see* TMEP §§1402.06 *et seq.*, 1402.07. Therefore, this wording must be deleted from the identification.

Specimen Required – International Class 9

The specimen is not acceptable because it does not show the applied-for mark used in connection with any of the goods in Class 9 specified in the statement of use. A statement of use must include a specimen showing the applied-for mark in use in commerce for each class of goods and/or services in the statement of use. Trademark Act Sections 1 and 45, 15 U.S.C. §§1051, 1127; 37 C.F.R. §§2.56, 2.88(b)(2); TMEP §§904, 904.07(a), 1109.09(b).

In the present case, the specimen is unacceptable because there is no mention of the software on the specimen. For downloadable computer software, an applicant may submit a specimen that shows use of the mark on an Internet website. Such a specimen is acceptable only if it provides sufficient information to enable the user to download or purchase the software from the website. If the website simply advertises the software without providing a way to download it, the specimen is unacceptable. *In re Osterberg*, 83 USPQ2d 1220 (TTAB 2007); *In re Dell Inc.*, 71 USPQ2d 1725 (TTAB 2004). TMEP §904.03(e). *See* regarding electronic displays as specimens for trademarks.

Therefore, applicant must submit the following:

- (1) A substitute specimen showing use of the mark for each class of goods and/or services in the statement of use; and
- (2) The following statement, verified with an affidavit or signed declaration under 37 C.F.R. §2.20: “**The substitute specimen was in use in commerce prior to the expiration of the time allowed applicant for filing a statement of use.**” 37 C.F.R. §2.59(b)(2); TMEP §904.05. If submitting a specimen requires an amendment to the dates of use, applicant must also verify the amended dates. 37 C.F.R. §2.71(c).

Examples of specimens for goods are tags, labels, instruction manuals, containers, photographs that show the mark on the goods or packaging, or displays associated with the goods at their point of sale. TMEP §§904.03 *et seq.* Examples of specimens for services are signs, photographs, brochures, website printouts or advertisements that show the mark used in the sale or advertising of the services. TMEP §§1301.04 *et seq.*

Pending a proper response, registration is refused because the specimen does not show the applied-for mark in use in commerce as a trademark or service mark for the identified goods or services. 15 U.S.C. §§1051, 1127; 37 C.F.R. §§2.56, 2.88; TMEP §§904, 904.07(a), 1109.09(b).

Applicant may not withdraw the statement of use. 37 C.F.R. §2.88(g); TMEP §1109.17.

The requirement for an acceptable Class 9 specimen is maintained and continued.

Request To Divide

Applicant can divide its application into two or more separate applications in accordance with 37 C.F.R. §2.87. *See* TMEP §§1110 *et seq.* (regarding requests to divide). A request to divide is used to divide out into a new application certain classes or specific goods and/or services that may have been refused registration, for example, and allow the remaining classes or goods and/or services to proceed toward registration.

Dividing an application requires a fee of \$100.00 for each new application created. 37 C.F.R. §2.6(a)(19). In addition, when dividing out some, but not all, of the goods and/or services within a class, the application filing fee of \$375 must be submitted for each new separate application created by the division. 37 C.F.R. §§2.6(a)(1)(i), 2.87(b); TMEP §1110.02. Any outstanding time period for action by the applicant at the time of division will apply to each new separate application created by the division. TMEP §1110.05.

A request to divide an application may be filed at any time after filing the application and before the date the application has been approved for publication, or, during an opposition, upon motion granted by the Trademark Trial and Appeal Board. In addition, a request to divide an application under Trademark Act Section 1(b) may be filed with a statement of use under 37 C.F.R. §2.88 or at any time between the filing of a statement of use and the date the mark is approved for registration. 37 C.F.R. §2.87(c); TMEP §1110.01.

To divide an application, an applicant should submit a request on paper in a separate document from any other amendment or response with the title “Request to Divide Application” at the top of the page. 37 C.F.R. §2.87(d). Applicant must specify the classes or goods and/or services that are to be divided out of the application, and submit all the fees. TMEP §1110. Currently, requests to divide cannot be filed electronically. TMEP §1110.02.

A request to divide must be signed by the applicant or an attorney who is authorized to practice before the Office under 37 C.F.R. §10.14. TMEP §1110. If the applicant has appointed an attorney, the attorney must personally sign the request to divide. If the applicant is not represented by an authorized attorney, the request to divide must be personally signed by the applicant or someone with legal authority to bind the applicant (i.e., a corporate officer of a corporate applicant, the equivalent of an officer for unincorporated organizations or limited liability company applicants, a general partner of a partnership applicant, each applicant for applications with multiple individual applicants). *Id.*

Partial Abandonment Advisory

If applicant does not respond to this Office action within the six-month period for response, then International Class 9 will be deleted from the application and the application will proceed forward for International Class 45 only. 37 C.F.R. §2.65(a).

If applicant has questions about its application or needs assistance in responding to this Office action, please telephone the assigned trademark examining attorney.

TEAS PLUS APPLICANTS MUST SUBMIT DOCUMENTS ELECTRONICALLY OR SUBMIT FEE: TEAS Plus applicants should submit the following documents using the Trademark Electronic Application System (TEAS) at <http://www.uspto.gov/teas/index.html>: (1) written responses to Office actions; (2) preliminary amendments; (3) changes of correspondence address; (4) changes of owner’s address; (5) appointments and revocations of attorney; (6) amendments to allege use; (7) statements of use; (8) requests for extension of time to file a statement of use, and (9) requests to delete a §1(b) basis. If any of these documents are filed on paper, they must be accompanied by a \$50 per

class fee. 37 C.F.R. §§2.6(a)(1)(iv) and 2.23(a)(i). Telephone responses will not incur an additional fee. NOTE: In addition to the above, applicant must also continue to accept correspondence from the Office via e-mail throughout the examination process in order to avoid the additional fee. 37 C.F.R. §2.23(a)(2).

/Barbara Rutland/
Trademark Examining Attorney
US Patent & Trademark Office
Law Office 101
571-272-9311

RESPOND TO THIS ACTION: If there are any questions about the Office action, please contact the assigned examining attorney. A response to this Office action should be filed using the form available at <http://www.uspto.gov/teas/eTEASpageD.htm>. If notification of this Office action was received via e-mail, no response using this form may be filed for 72 hours after receipt of the notification. **Do not attempt to respond by e-mail as the USPTO does not accept e-mailed responses.**

If responding by paper mail, please include the following information: the application serial number, the mark, the filing date and the name, title/position, telephone number and e-mail address of the person signing the response. Please use the following address: Commissioner for Trademarks, P.O. Box 1451, Alexandria, VA 22313-1451.

STATUS CHECK: Check the status of the application at least once every six months from the initial filing date using the USPTO Trademark Applications and Registrations Retrieval (TARR) online system at <http://tarr.uspto.gov>. When conducting an online status check, print and maintain a copy of the complete TARR screen. If the status of your application has not changed for more than six months, please contact the assigned examining attorney.

To: Kogan, Nataly (natalykogan@gmail.com)
Subject: TRADEMARK APPLICATION NO. 77095442 - WORK IT, MOM! - N/A
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Attachments:

IMPORTANT NOTICE
USPTO OFFICE ACTION HAS ISSUED ON 5/15/2008 FOR
APPLICATION SERIAL NO. 77095442

Please follow the instructions below to continue the prosecution of your application:

VIEW OFFICE ACTION: Click on this link http://tportal.uspto.gov/external/portal/tow?DDA=Y&serial_number=77095442&doc_type=OOA&mail_date=20080515 (or copy and paste this URL into the address field of your browser), or visit <http://tportal.uspto.gov/external/portal/tow> and enter the application serial number to [access](#) the Office action.

PLEASE NOTE: The Office action may not be immediately available but will be viewable within 24 hours of this notification.

RESPONSE MAY BE REQUIRED: You should carefully review the Office action to determine (1) if a response is required; (2) how to respond; and (3) the applicable [response time period](#). Your response deadline will be calculated from **5/15/2008**.

Do NOT hit "Reply" to this e-mail notification, or otherwise attempt to e-mail your response, as the USPTO does NOT accept e-mailed responses. Instead, the USPTO recommends that you respond online using the Trademark Electronic Application System response form at <http://www.uspto.gov/teas/eTEASpageD.htm>.

HELP: For *technical* assistance in accessing the Office action, please e-mail TDR@uspto.gov. Please contact the assigned examining attorney with questions about the Office action.

WARNING

- 1. The USPTO will NOT send a separate e-mail with the Office action attached.**
- 2. Failure to file any required response by the applicable deadline will result in the **ABANDONMENT** of your application.**