

Note To The File

Serial Number: 88162674
Date: 02/01/2019 2:02 pm
Created by: Timothy Schimpf



Searched

- Google
- OneLook
- Applicant's website

Changed

- Re-imaged or Cropped Drawing

Contacted Applicant/Atty

- via Phone
- via E-Mail

From: Gordon, Zachary T. [mailto:zgordon@HowardandHoward.com]

Sent: Tuesday, January 29, 2019 7:16 PM

To: Schimpf, Timothy <Timothy.Schimpf@USPTO.GOV>

Cc: Haidle, Samuel <SHaidle@HowardandHoward.com>; Buntin, Stephanie S. <:ssb@h2law.com>; Louie, Solana <slouie@HowardandHoward.com>

Subject: RE: Trademark Applications for BANDIT and BANDIT THE BEAST, Serial Nos. 88162663, 88162667, 88162674, 88162677, and 88162670

Mr. Schimpf,

Thank you for your email. We will do our best to get back to you by January 31.

Kind regards,

Zac

Zachary T. Gordon
Attorney

3800 Howard Hughes #1000, Las Vegas, NV 89169

E: zgordon@HowardandHoward.com

D: 702.667.4817 F: 702.567.1568

NOTICE: Information contained in this transmission to the named addressee is proprietary information and is subject to attorney-client privilege and work product confidentiality. If the recipient of this transmission is not the named addressee, the recipient should immediately notify the sender and destroy the information transmitted without making any copy or distribution thereof.

ELECTRONIC SIGNATURE: Nothing contained in this communication is intended to constitute an electronic signature unless a specific statement to the contrary is included in this message.

COMMUNICATION: Please copy all Patent and Trademark instructions to IPDocket@h2law.com in order to ensure proper handling. In addition, please send all original documents for these matters to our head office in Royal Oak, MI.

From: Schimpf, Timothy <Timothy.Schimpf@USPTO.GOV>

Sent: Tuesday, January 29, 2019 9:57 AM

To: Gordon, Zachary T. <zgordon@HowardandHoward.com>

Cc: Haidle, Samuel <SHaidle@HowardandHoward.com>; Buntin, Stephanie S. <ssb@h2law.com>; Louie, Solana <slouie@HowardandHoward.com>

Subject: Trademark Applications for BANDIT and BANDIT THE BEAST, Serial Nos. 88162663, 88162667, 88162674, 88162677, and 88162670

Hello, my name is Tim Schimpf and I am an examining attorney with the U.S. Patent and Trademark Office. I am reviewing the trademark application for BANDIT and BANDIT THE BEAST, Serial Nos. 88162663, 88162667, 88162674, 88162677, and 88162670. There are a few issues I'd like to discuss with you about the applications.

Identification of Goods: The wording of the identifications need to be amended to specify the type of wood processing conducted by the machines. Based on applicant's prior registrations and applicant's website, I suggest amending the identifications to:

Serial Nos. 88162663, 88162667, 88162674, 88162677:

"Industrial machinery, namely, wood and brush chipping machines and tree stump cutters" in International Class 7.

Serial No. 88162670:

"Industrial machinery, namely, horizontal grinders used for shredding wood and other waste" in International Class 7.

Disclaimer for Serial No. 88162670: Applicant has identified waste processing services. The recycling symbol in the mark is a universal symbol indicating the goods involve recycling or are otherwise environmentally friendly. As this symbol is descriptive, applicant must provide a disclaimer statement. With applicant's permission, I will add the following statement to the record:

No claim is made to the exclusive right to use the recycling symbol apart from the mark as shown.

Advisory - Prior Pending Applications: U.S. Application Serial No. 87933451 for BANDIT and its co-pending application Serial No. 87933488 were filed before the current application for broad machinery goods that would include applicant's machinery. If the applications register, the current application may be refused registration under Trademark Act Section 2(d) because of a likelihood of confusion between the marks. I am aware of applicant's prior registration for machinery in Class 7, but these prior pending application may still cause confusion. But, if the prior application does not register, there will be no conflict with the current application. Applicant will need to wait until the prior application is resolved. This is an advisory statement only, applicant does not need to take any action at this time. If the above issues are resolved, the current application will be suspended pending the outcome of that prior application.

Please respond by **Thursday, January 31** as to whether applicant agrees to the amendments in #1 and #2. If applicant agrees, I can make the amendments through an examiner's amendment and suspend the application pending the result of the prior pending applications.

If you would prefer, I would be happy to discuss this over the telephone at the number listed below. If you have any questions, please let me know.

Timothy Schimpf

Examining Attorney, Law Office 113

United States Patent and Trademark Office

(571) 272-9072

timothy.schimpf@uspto.gov