

To: Jackson III, Curtis J. (clarus@robinskaplan.com)
Subject: U.S. Trademark Application Serial No. 88409703 - FOFTY - 110273.0006
Sent: December 12, 2019 11:09:09 AM
Sent As: ecom106@uspto.gov
Attachments:

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

U.S. Application Serial
No. 88409703

Mark: FOFTY

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Applicant: Jackson III,
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Reference/Docket No.
110273.0006

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NONFINAL OFFICE ACTION

The USPTO must receive applicant's response to this letter within six months of the issue date below or the application will be [abandoned](#). Respond using the Trademark Electronic Application System (TEAS). A link to the appropriate TEAS response form appears at the end of this Office action.

Issue date: **December 12, 2019**

INTRODUCTION

This Office action is supplemental to and supersedes the previous Office action issued on June 19, 2019 in connection with this application. Based on information and/or documentation in applicant's response, the trademark examining attorney now issues the following new requirement: domicile of applicant required. *See* TMEP §§706, 711.02.

In a previous Office action dated June 19, 2019, the trademark examining attorney refused registration of the applied-for mark based on a prior-filed application and required applicant to consent to the use of applicant's name in the applied-for mark. Based on applicant's response, the consent requirement has been satisfied. *See* TMEP §713.02. However, the refusal based on a prior-filed application is maintained and continued. *See id.*

The following is a SUMMARY OF ISSUES that applicant must address:

- Prior-filed Application
- NEW ISSUE: Applicant's Domicile Address Required

- NEW ISSUE: Domicile Waiver Advisory

PRIOR-FILED APPLICATION

The trademark examining attorney hereby maintains and continues the refusal to register the applied-for mark based on a potentially conflicting pending application.

Applicant was previously provided information regarding pending U.S. Application Serial No. 88406987, which may present a bar to registration of applicant's mark based on a likelihood of confusion under Trademark Act Section 2(d). *See* 15 U.S.C. §1052(d); 37 C.F.R. §2.83; TMEP §§1208 *et seq.* In response, applicant argues that the prior-filed application is not entitled to registration, as the applicant in this case is the senior user and the individual to which both marks refer.

Though these arguments may be made in opposition to registration of the prior-filed application, they do not provide a basis for the examining attorney to approve the instant application while the prior-filed application remains pending. *See* TMEP §716.02(c).

The trademark examining attorney has thus found applicant's arguments unpersuasive and still believes there may be a likelihood of confusion between applicant's mark and the mark in the cited prior-pending application, should it register. Therefore, upon receipt of applicant's response resolving the following requirement, action on this application will be suspended pending the disposition of U.S. Application Serial No. 88406987. 37 C.F.R. §2.83(c); TMEP §§716.02(c), 1208.02(c).

APPLICANT'S DOMICILE ADDRESS REQUIRED

Applicant must provide applicant's domicile address. All applications must include the applicant's domicile address, and domicile dictates whether an applicant is required to have an attorney who is an active member in good standing of the bar of the highest court of a U.S. state or territory represent the applicant at the USPTO. *See* 37 C.F.R. §§2.2(o)-(p), 2.11(a), 2.189; *Requirement of U.S.-Licensed Attorney for Foreign-Domiciled Trademark Applicants & Registrants*, Examination Guide 4-19, at I.A. (Rev. Sept. 2019).

An individual applicant's domicile is the place a person resides and intends to be the person's principal home. 37 C.F.R. §2.2(o); Examination Guide 4-19, at I.A. A juristic entity's domicile is the principal place of business, i.e. headquarters, where a juristic entity applicant's senior executives or officers ordinarily direct and control the entity's activities. 37 C.F.R. §2.2(o); Examination Guide 4-19, at I.A. An applicant whose domicile is located outside of the United States or its territories is foreign-domiciled and must be represented at the USPTO by a U.S.-licensed attorney qualified to practice before the USPTO under 37 C.F.R. §11.14. 37 C.F.R. §2.11(a).

The application record lists applicant as an individual. The application submitted on April 30, 2019 specifies applicant's domicile as "c/o" or in "care of" another party's address. Applicant's response filed on November 27, 2019 maintains the same address, but omits the "c/o" wording. Thus, the record still indicates that the address of record is in "care of" another party.

In most cases, an address that is listed as "c/o" or in "care of" another party's address is not acceptable as a domicile address because it does not identify the location of the place applicant resides and intends to be applicant's principal home. *See* 37 C.F.R. §§2.2(o)-(p), 2.189; Examination Guide 4-19, at I.A.3. Thus, applicant must provide its domicile street address. *See* 37 C.F.R. §2.189. Alternatively, an applicant may demonstrate that the listed address is, in fact, the applicant's domicile. Examination Guide 4-19, at I.A.3.

ADVISORY: PETITION TO WAIVE DOMICILE REQUIREMENT

In certain situations, individual applicants may seek a waiver of the requirement to make public their domicile addresses by filing a Petition to the Director. *See* 37 C.F.R. §2.146(a)(5) and TMEP §1708. In such cases, when filing the application maintenance document, the applicant may enter "Petition" in the street address field of the TEAS form and separately file a petition to waive the requirement to make public the domicile address. If a petition is granted, the applicant must also provide an address where mail can be received. Applicant may contact the Petitions Office by email at TMPetitionQuestion@uspto.gov or by phone at 571-272-8950 for more information. Filing a petition does not extend the time for responding to an outstanding Office action or other statutory deadline.

COMMUNICATION

Please call or email the assigned trademark examining attorney with questions about this Office action. Although the trademark examining attorney cannot provide legal advice or statements about applicant's rights, the trademark examining attorney can provide applicant with additional explanation about the requirement in this Office action. *See* TMEP §§705.02, 709.06. Although the USPTO does not accept emails as responses to Office actions, emails can be used for informal communications and will be included in the application record. *See* 37 C.F.R. §§2.62(c), 2.191; TMEP §§304.01-.02, 709.04-.05.

Response guidelines. For this application to proceed, applicant must explicitly address each requirement in this Office action. For a requirement, applicant should set forth the changes or statements. Please see "[Responding to Office Actions](#)" and the informational [video "Response to Office Action"](#) for more information and tips on responding.

Applicant must respond to all issues raised in this Office action and the previous June 19, 2019 Office action, within six (6) months of the date of issuance of this Office action. 37 C.F.R. §2.62(a); *see* TMEP §711.02. If applicant does not respond within this time limit, the application will be abandoned. 37 C.F.R. §2.65(a).

TEAS PLUS OR TEAS REDUCED FEE (TEAS RF) APPLICANTS – TO MAINTAIN LOWER FEE, ADDITIONAL REQUIREMENTS MUST BE MET, INCLUDING SUBMITTING DOCUMENTS ONLINE: Applicants who filed their application online using the lower-fee TEAS Plus or TEAS RF application form must (1) file certain documents online using TEAS, including responses to Office actions (see TMEP §§819.02(b), 820.02(b) for a complete list of these documents); (2) maintain a valid e-mail correspondence address; and (3) agree to receive correspondence from the USPTO by e-mail throughout the prosecution of the application. *See* 37 C.F.R. §§2.22(b), 2.23(b); TMEP §§819, 820. TEAS Plus or TEAS RF applicants who do not meet these requirements must submit an additional processing fee of \$125 per class of goods and/or services. 37 C.F.R. §§2.6(a)(1)(v), 2.22(c), 2.23(c); TMEP §§819.04, 820.04. However, in certain situations, TEAS Plus or TEAS RF applicants may respond to an Office action by authorizing an examiner’s amendment by telephone or e-mail without incurring this additional fee.

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

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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.

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United States Patent and Trademark Office (USPTO)

USPTO OFFICIAL NOTICE

Office Action (Official Letter) has issued
on **December 12, 2019** for
U.S. Trademark Application Serial No. 88409703

Your trademark application has been reviewed by a trademark examining attorney. As part of that review, the assigned attorney has issued an official letter that you must respond to by the specified deadline or your application will be [abandoned](#). Please follow the steps below.

(1) [Read the official letter](#).

(2) **Direct questions** about the contents of the Office action to the assigned attorney below.

/Matthew Ruskin/
Matthew Ruskin
Examining Attorney
Law Office 106
571-272-3466
matthew.ruskin@uspto.gov

Direct questions about navigating USPTO electronic forms, the USPTO [website](#), the application process, the status of your application, and/or whether there are outstanding deadlines or documents related to your file to the [Trademark Assistance Center \(TAC\)](#).

(3) **Respond within 6 months** (or earlier, if required in the Office action) from **December 12, 2019**, using the Trademark Electronic Application System (TEAS). The response must be received by the USPTO before midnight **Eastern Time** of the last day of the response period. See the Office action for more information about how to respond

GENERAL GUIDANCE

- [Check the status of your application periodically](#) in the [Trademark Status & Document Retrieval \(TSDR\)](#) database to avoid missing critical deadlines.
- [Update your correspondence email address](#), if needed, to ensure you receive important USPTO notices about your application.
- [Beware of misleading notices sent by private companies about your application](#). Private companies not associated with the USPTO use public information available in trademark registrations to mail and email trademark-related offers and notices – most of which require fees. All **official USPTO correspondence** will only be **emailed from the domain “@uspto.gov.”**