

To: MITSUI KAGAKU KABUSHIKI KAISHA (ip@barclaydamon.com)
Subject: TRADEMARK REGISTRATION NO. 2178992 - VME - 3957-3092288
Sent: 05/01/18 09:08:40 AM
Sent As: PRG@uspto.gov
Attachments:

**UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)
OFFICE ACTION (OFFICIAL LETTER) ABOUT OWNER'S TRADEMARK REGISTRATION**

**U.S.
REGISTRATION
NO. 2178992**

75082515

**OWNER:
MITSUI KAGAKU
KABUSHIKI
KAISHA**

**CORRESPONDENT'S
ADDRESS:**

Jason S.
Nardiello
Barclay
Damon,
LLP
1270
Avenue
of the
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Suite 600
New
York NY
10020

MARK: VME

**CORRESPONDENT'S
REFERENCE/DOCKET NO.
3957-3092288**

**CORRESPONDENT'S EMAIL
ADDRESS:**

ip@barclaydamon.com

CLICK ON THE LINK BELOW TO RESPOND TO THIS LETTER AND SELECT FORM NUMBER 11:

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

POST REGISTRATION OFFICE ACTION

ISSUE/MAILING DATE: 5/1/2018
U.S. Registration Number **2178992**

The Combined Section 8 Affidavit & Section 9 Renewal Application was received on **April 27, 2018**. The Section 9 portion of the combined filing can be granted. However, the Section 8 portion is not accepted for the reason(s) set forth below.

Specimen

The specimen submitted with the Section 8 Affidavit is unacceptable because it consists of advertising material for goods and does not show use of the registered mark on the goods or on packaging for the goods. *See* TMEP §904.04(b)-(c).

Material that functions merely to tell prospective purchasers about the goods, or to promote the sale of the goods, is unacceptable to show trademark use. TMEP §904.04(b). Invoices, business cards, announcements, price lists, listings in trade directories, order forms, bills of lading, leaflets, brochures, advertising circulars and other printed advertising material, while normally acceptable for showing use in connection with services, generally are not acceptable specimens for showing trademark use in connection with goods. *See In re MediaShare Corp.*, 43 USPQ2d 1304, 1307 (TTAB 1997); *In re Schiapparelli Searle*, 26 USPQ2d 1520, 1522 (TTAB 1993); TMEP §904.04(b)-(c).

Therefore, the owner must submit the following:

- (1) A substitute specimen showing current use of the registered mark in commerce for each class of goods specified in the registration; 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 during the relevant period for filing the 10-year Section 8.**” 37 C.F.R. §2.161(g); TMEP §1604.12(c).

Examples of specimens for goods are tags, labels, instruction manuals, containers, photographs that show the mark on the actual goods or packaging, or displays associated with the actual goods at their point of sale. *See* TMEP §§904.03 *et seq.*

The following statement and declaration under 37 C.F.R. §2.20 can be used to verify the Section 8 Affidavit, if properly signed and dated:

The owner was using the mark in commerce on or in connection with the goods and/or services identified in the registration for which use of the mark in commerce is claimed, as evidenced by the submitted specimen, during the relevant period for filing the 10-year Section 8.

The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. §1001, and that such willful false statement may jeopardize the validity of this document, declares that s/he is properly authorized to execute this document on behalf of the owner, and all statements made of his/her own knowledge are true and that all statements made on information and belief are believed to be true.

Signature of Authorized Person

Type or Print Name

Date

The following persons are properly authorized to sign a Section 8 Affidavit on behalf of the owner:

- (1) A person with legal authority to bind the owner (e.g., a corporate officer or general partner);
 - (2) A person with firsthand knowledge of the facts and actual or implied authority to act on behalf of the owner; or
 - (3) An authorized attorney who has an actual written or verbal power of attorney or an implied power of attorney from the owner.
- 37 C.F.R. §§2.161(b), 2.193(e)(1); TMEP §1604.08(a).

RESPONSE TIME DEADLINE: A complete response must be received within 6 months from the issuance date of this Office action or prior to expiration of the 10th year anniversary date on **August 4, 2018**, whichever is later. The owner must respond to all inquiries set forth in this Office action to avoid cancellation of the registration. *If a response is not received, and there is no time remaining in the grace period to file a new affidavit, the registration will be cancelled in its entirety.* 37 C.F.R. §2.163(b)-(c); TMEP §§1604.16, 1604.17(a).

DEFICIENCY SURCHARGE INFORMATION: If the response to this Office action is received by the Office after **August 4, 2018**, a \$100 deficiency surcharge must be submitted if the response is submitted online using the Trademark Electronic Application System (“TEAS”) and a \$200 deficiency surcharge must be submitted if the response is submitted on paper. 37 C.F.R. §§2.6, 2.164(a)(1); TMEP §1604.17(a). (Note: This only applies when the response time deadline above falls after the 10th year anniversary date.)

ADVISORY: If a response to this Office action is not filed within the response deadline above, and time remains in the grace period, the owner may avoid cancellation of its registration by filing a new affidavit of use within the grace period. 37 C.F.R. §2.163(c). Additional fees are required to file a new affidavit during the grace period. 37 C.F.R. §2.161(d)(1)-(2). For more information about this, please contact the undersigned.

Please submit the following: Ownership – legal entity statement and fee, if submitted after: **August 4, 2018**. E-mail communications will not

be accepted as responses to Office actions; therefore, do not respond to this Office action by e-mail. Also, response instructions are noted below. You must notify the undersigned paralegal when the corrected document has been submitted for recordation. The filing of a document with the Assignment Division does not extend the time period for responding to this Office action.

McMillan, Michael
/Michael McMillan/
Trademark Specialist, Post Registration Unit
Michael.McMillan@uspto.gov
Dir: 571-272-9541
Fax: 571-273-9541

TO RESPOND TO THIS LETTER: Use the Trademark Electronic Application System (TEAS) Response to Post-Registration Office action **form number 11** at http://www.uspto.gov/trademarks/teas/reg_maintain.jsp. Please wait 48-72 hours from the issue/ mailing date before using TEAS, to allow for necessary system updates of the registration. For *technical* assistance with online forms, e-mail TEAS@uspto.gov. For questions about the Office action itself, please contact the assigned specialist. **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 registration will be placed in the official registration record.

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

CHECK THE STATUS OF THE REGISTRATION: To check the status of your registration at any time, visit the Office's Trademark Status and Document Retrieval (TSDR) system at <http://tsdr.uspto.gov/>. Please keep a copy of the TSDR status screen. For more information on checking status, see <http://www.uspto.gov/trademarks/process/status/>.

TO UPDATE CORRESPONDENCE/E-MAIL ADDRESS: Use the TEAS form at <http://www.uspto.gov/trademarks/teas/correspondence.jsp>.

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**IMPORTANT NOTICE
USPTO OFFICE ACTION HAS ISSUED ON 05/01/2018 FOR
REGISTRATION NO. 2178992**

Please follow the instructions below to continue the examination of your post registration filing:

VIEW OFFICE ACTION: Click on this link

<http://tsdr.uspto.gov/view.action?DDA=Y&sn=75082515&type=OOA&date=20180501>

(or copy and paste this URL into the address field of your browser), or visit <http://tsdr.uspto.gov/> and enter the registration 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.

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 tsdr@uspto.gov. Please contact the assigned examiner 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 may result in the cancellation and/or expiration of your registration.**