

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark : SIM and Design  
Serial No. : 88/243,712  
Class : 044  
Applicant : SmileSIM, LLC  
Law Office : 111  
Examining Attorney : James Ringle, Esq.

Commissioner for Trademarks  
P.O. Box 1451  
Alexandria, VA 22313-1451

**RESPONSE TO OFFICE ACTION**

**I. INTRODUCTION**

Applicant SmileSIM, LLC (“SmileSIM”) has reviewed the Office Action, dated April 2, 2019, relating to its application to register its SIM and Design mark for:

dental imaging services; professional analysis of the face photographs of patients by processing and synthesizing data and information to determine the aesthetic ideal proportion of the patient's teeth and to help execute digital renderings of dental prostheses, implants, dental prototypes and provisional teeth for patients in International Class 44 .

In that Office Action, the Examining Attorney has raised the following issues:

- He advises that the specimen submitted with the application does not show the mark in the drawing in use in commerce in International Class 44;
- He requests that the identification of services for the application be amended, including the possible addition of new Classes;

- He asserts that the mark is merely descriptive;

In response, SmileSIM is providing a substitute specimen and is amending the identification of services as requested. As for the descriptiveness refusal, SmileSIM requests that its SIM and Design application be amended to the Supplemental Register.

## **II. SPECIMEN REJECTION**

In response to the Examiner's specimen rejection, Applicant is submitting a substitute specimen in the form of screen shot from its website which clearly shows the SIM and Design mark being used under the "How It Works" heading and in connection with the applied-for services. Applicant is also submitting a declaration in connection with this substitute specimen stating that the specimen was in use as of the filing date of this application.

## **III. SMILESIM AGREES TO AMEND ITS IDENTIFICATION OF SERVICES**

The Examining Attorney asserts a number of issues with SmileSIM's identification of services and suggests that it adopt the following amendments and additional Classes, if accurate:

Photographic computer imaging services, namely, imaging services designed to help execute digital renderings of dental prostheses, implants, dental prototypes and provisional teeth for dental patients so that patients may see the result of dental work prior to its execution in Class 41.

Graphic illustration services for others, namely, illustration services designed to help execute digital renderings of dental prostheses, implants, dental prototypes and provisional teeth for dental patients so that patients may see the result of dental work prior to its execution in Class 42.

Dental imaging services in Class 44.

As suggested by the Examining Attorney, SmileSIM agrees to amend its identification of services as set forth above.

Because the amended identification adds two Classes of services to SmileSIM's application, the Patent and Trademark Office is authorized to debit Hunton Andrews Kurth

LLP's deposit account, 50-0206, in the amount of \$550.00, to cover the fees for the two added Classes.

**IV. AMENDMENT TO SUPPLEMENTAL REGISTER**

Without conceding to the Examining Attorney's analysis or conclusion that the applied-for mark is merely descriptive, Applicant respectfully requests that the application be amended to the Supplemental Register.

**VII. CONCLUSION**

SmileSIM believes that its response resolves all of the issues that the Examining Attorney has raised in the non-final Office Action. SmileSIM respectfully requests that its application be approved for registration on the Supplemental Register in accordance with TMEP § 815.02.

Dated: October 1, 2019

Respectfully submitted,

/s/ Matthew Nigriny  
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