

AMENDMENT AND RESPONSE TO OFFICE ACTION

This Amendment and Response responds to the Office Action dated July 17, 2019, for the above-referenced trademark application.

Please amend the description of goods and services as follows:

“downloadable educational media, namely, technical reference and guidance documents, audio files and video recordings featuring educational seminars in the fields of energy-efficient and environmentally sustainable practices, in International Class 9;

educational services, namely, online conducting web-based education seminars, live education seminars, and field training in the fields of energy-efficient and environmentally sustainable practices and distribution of printed educational materials in connection therewith; educational services, namely, conducting educational presentations at trade shows in the fields of energy-efficient and environmentally sustainable practices and distribution of printed educational materials in connection therewith; educational services, namely, providing training to others in the fields of energy-efficient and environmentally sustainable practices in relation to perform the testing, analysis, and evaluation of energy-efficient and environmentally sustainable goods and services and distribution of printed educational materials in connection therewith; providing a web site featuring non-downloadable educational media, namely, audio files and video recordings featuring education seminars in the fields of energy-efficient and environmentally sustainable practices, in International Class 41; and

design and development of environmentally sustainable standards in the fields of building design, construction, facility management, and facility operations;

accreditation services, namely, evaluation and analysis of buildings to determine compliance with an established set of criteria for maintaining high performance and sustainable building practices, in International Class 42.”

REMARKS

The Examining Attorney refused registration of the Applicant’s above-referenced mark for a variety of reasons. The Applicant respectfully requests reconsideration in view of the below remarks.

I. Likelihood of Confusion. The Examining Attorney partially rejected the above-referenced mark on the grounds of a likelihood of confusion, as to Class 35 only, in view of Registration No. 5,196,586 for GBI SOURCE and Registration No. 5,196,588 for GBI, both owned by GB Group Limited. In addition, the Examining Attorney has also noted that Application No. 79/255,484 for GBI, owned by Yu Wenzhuo, precedes the Applicant’s filing date and if registers, the mark may form the basis of a likelihood of confusion rejection.

By this Amendment and Response, the Applicant has deleted International Class 35 from the application, rendering the rejection moot. In view of the deletion of International Class 35 from the application, the Applicant respectfully requests that the likelihood of confusion rejection be withdrawn.

II. Description of Services. The Examining Attorney objects to the description of services only for “educational services, namely, conducting web-based seminars, live seminars, video and audio seminars, field training, making educational presentations at trade shows and dissemination of printed educational materials in connection therewith in the field of energy-efficient and environmentally sustainable practices, and training others to perform the testing, analysis, and evaluation of the goods and services in the field of energy-efficient and environmentally sustainable practices” in International Class 41 and “design and development of environmentally sustainable standards in the field of building design, construction, facility

management, and facility operations” in International Class 42. By this Amendment and Response, the Applicant has amended the description of services in International Class 41 and International Class 42 as follows:

educational services, namely, online conducting web-based education seminars, live education seminars, and field training in the fields of energy-efficient and environmentally sustainable practices and distribution of printed educational materials in connection therewith; educational services, namely, conducting educational presentations at trade shows in the fields of energy-efficient and environmentally sustainable practices and distribution of printed educational materials in connection therewith; educational services, namely, providing training to others in the fields of energy-efficient and environmentally sustainable practices in relation to perform the testing, analysis, and evaluation of energy-efficient and environmentally sustainable goods and services and distribution of printed educational materials in connection therewith; providing a web site featuring non-downloadable educational media, namely, audio files and video recordings featuring education seminars in the fields of energy-efficient and environmentally sustainable practices, in International Class 41; and

design and development of environmentally sustainable standards in the fields of building design, construction, facility management, and facility operations; accreditation services, namely, evaluation and analysis of buildings to determine compliance with an established set of criteria for maintaining high performance and sustainable building practices, in International Class 42.”

In addition, the Applicant amends the description of goods and services to add International Class 9 for:

downloadable educational media, namely, technical reference and guidance documents, audio files and video recordings featuring educational seminars in the fields of energy-efficient and environmentally sustainable practices.

The Applicant submits herewith a specimen of use for International Class 9, and asserts that the specimen was in use in commerce on or in connection with the goods and/or services listed in the application at least as early as the filing date of the application.

The Applicant believes that these amendments sufficiently address the Examining Attorney's objections and respectfully request that the partial identification of services requirement objection be withdrawn.

III. Conclusion. The Applicant respectfully requests reconsideration of the instant application in view of this Amendment and Response. The Applicant believes that the application is in condition for publication and respectfully requests notification of the same.