

10/8/2020

To: IDOC24, Inc. (ipdocketingla@venable.com)
Subject: U.S. TRADEMARK APPLICATION NO. 87196946 - FIRST DERM - 133370.NEW
Sent: 1/18/2017 10:43:04 AM
Sent As: ECOM115@USPTO.GOV
Attachments: [Attachment - 1](#)
[Attachment - 2](#)
[Attachment - 3](#)
[Attachment - 4](#)

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

U.S. APPLICATION SERIAL NO. 87196946

MARK: FIRST DERM

87196946

CORRESPONDENT ADDRESS:

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APPLICANT: IDOC24, Inc.

CORRESPONDENT'S REFERENCE/DOCKET NO :

133370.NEW

CORRESPONDENT E-MAIL ADDRESS:

ipdocketingla@venable.com

OFFICE ACTION

STRICT DEADLINE TO RESPOND TO THIS LETTER

TO AVOID ABANDONMENT OF APPLICANT'S TRADEMARK APPLICATION, THE USPTO MUST RECEIVE APPLICANT'S COMPLETE RESPONSE TO THIS LETTER **WITHIN 6 MONTHS** OF THE ISSUE/MAILING DATE BELOW. A RESPONSE TRANSMITTED THROUGH THE TRADEMARK ELECTRONIC APPLICATION SYSTEM (TEAS) MUST BE RECEIVED BEFORE MIDNIGHT **EASTERN TIME** OF THE LAST DAY OF THE RESPONSE PERIOD.

ISSUE/MAILING DATE: 1/18/2017

The referenced application has been reviewed by the assigned trademark examining attorney. Applicant must respond timely and completely to the issues below. 15 U.S.C. §1062(b); 37 C.F.R. §§2.62(a), 2.65(a); TMEP §§711, 718.03.

Search Results

The trademark examining attorney has searched the Office's database of registered and pending marks and has found no conflicting marks that would bar registration under Trademark Act Section 2(d). TMEP §704.02; *see* 15 U.S.C. §1052(d).

Summary of Issues to be Addressed by Applicant

- Identification and Classification of Services
- Advisory: Combined Applications
- Disclaimer Required

Identification and Classification of Services

THE FOLLOWING REQUIREMENTS APPLY ONLY TO THE SERVICES CURRENTLY CLASSIFIED IN CLASS 41 IN THE APPLICATION:

Applicant has classified “providing a website featuring non-downloadable photographs and information regarding skin-related medical conditions affecting humans; providing a website for the purpose of transmitting photographs and data regarding skin-related medical conditions affecting humans to medical practitioners, receiving information regarding skin-related medical conditions affecting humans, and identifying dermatologists, pediatricians and medical clinics for the treatment of skin-related medical conditions affecting humans” in International Class 41; however, this identification includes services that could be properly classified in Classes 35, 41, 42 and 44. Providing a website featuring non-downloadable photographs is a Class 41 service, but providing information about medical conditions is a Class 44 service, and providing a website for transmitting photos, receiving information and other functions is likely a Class 42 and/or Class 35 service. Please see the identification suggestions with proper classification designations below in bold typeface.

Therefore, applicant may respond by (1) adding International Classes 42, 44 and/or 35 to the application and reclassifying these services in the proper international classes, or (2) deleting certain services from the application and reclassifying the specified services in the proper international classes. *See* 37 C.F.R. §§2.86(a), 6.1; TMEP §§1403.02 *et seq.* If applicant adds one or more international classes to the application, applicant must comply with the multiple-class requirements specified in this Office action.

The services “providing a website featuring...information regarding skin-related medical conditions affecting humans” are classified incorrectly. Applicant must amend the application to classify the services in International Class 44. *See* 37 C.F.R. §§2.32(a)(7), 2.85; TMEP §§1401.02(a), 1401.03(b). Classification of information services is based on the subject matter of the information provided, and “medical information” is properly classified in Class 44. TMEP §1402.11(b).

Next, the wording “providing a website for the purpose of transmitting photographs and data regarding skin-related medical conditions affecting humans to medical practitioners, receiving information regarding skin-related medical conditions affecting humans, and identifying dermatologists, pediatricians and medical clinics for the treatment of skin-related medical conditions affecting humans” requires clarification because it is indefinite as to the exact nature of the services, and too broad, since it could describe services in more than one international class. TMEP §§1402.01, 1402.03. This wording could describe providing a website featuring technology that enables users to transmit photos and data and to exchange information, and to search for health care providers in Class 42. Alternately, this wording could describe providing recommendations of healthcare service providers to consumers for commercial purposes in Class 35. Applicant must clarify this ambiguity.

The examining attorney suggests, and applicant may adopt, any or all of the following identification of services, if accurate:

The identification of goods in Class 9 is acceptable as written.

“Providing a website featuring recommendations of dermatologists, pediatricians and medical clinics for the treatment of skin-related medical conditions affecting humans to consumers for commercial purposes,” in International Class 35.

“Providing a website featuring non-downloadable photographs of skin related medical conditions affecting humans,” in International Class 41.

“Providing a website featuring technology that allows users to transmit photographs and data regarding skin-related medical conditions affecting humans to medical practitioners, exchange information regarding skin-related medical conditions affecting humans, and search for dermatologists, pediatricians and medical clinics for the treatment of skin-related medical conditions affecting humans,” in International Class 42.

“Providing a website featuring information regarding skin-related medical conditions affecting humans,” in International Class 44.

TMEP §1402.01.

Applicant may amend the identification to clarify or limit the services, but not to broaden or expand the services beyond those in the original application or as acceptably amended. *See* 37 C.F.R. §2.71(a); TMEP §1402.06. Generally, any deleted services may not later be reinserted. *See* TMEP §1402.07(e).

For assistance with identifying and classifying goods and services in trademark applications, please see the USPTO’s online searchable [U.S. Acceptable Identification of Goods and Services Manual](#). *See* TMEP §1402.04.

Advisory: Combined Applications

The application references services based on use in commerce in more than one international class; therefore, applicant must satisfy all the requirements below for each international class:

- (1) [List the goods and services by their international class number](#) in consecutive numerical order, starting with the lowest numbered class (for example, International Class 3: perfume; International Class 18: cosmetic bags sold empty).
- (2) [Submit a filing fee for each international class](#) not covered by the fee(s) already paid (view the [USPTO's current fee schedule](#)). Specifically, the application identifies goods and services based on use in commerce that may be classified in 5 classes; however, applicant submitted a fee sufficient for only 2 classes. Applicant must either (a) submit the filing fees for the classes not covered by the submitted fees or (b) restrict the application to the number of classes covered by the fees already paid.
- (3) [Submit verified dates of first use of the mark](#) anywhere and in commerce **for each international class**. [See more information about verified dates of use](#).
- (4) [Submit a specimen for each international class](#). The current specimen is acceptable for classes 9, 41, 42 and 44; and applicant needs a specimen for class 35, if it adds that class to the application.

Examples of specimens for services include advertising and marketing materials, brochures, photographs of business signage and billboards, and website printouts that show the mark used in the actual sale, rendering, or advertising of the services.

- (5) [Submit a verified statement](#) 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.**” [See more information about verification](#).

See 15 U.S.C. §§1051(a), 1112; 37 C.F.R. §§2.32(a)(6)-(7), 2.34(a)(1), 2.86(a); TMEP §§904, 1403.01, 1403.02(c).

See [an overview](#) of the requirements for a Section 1(a) multiple-class application and how to satisfy the requirements online using the Trademark Electronic Application System (TEAS) form.

Disclaimer Required

Applicant must disclaim the wording “DERM” because it merely describes a characteristic, function, feature, purpose, or use of applicant’s goods and services, and thus is an unregistrable component of the mark. See 15 U.S.C. §§1052(e)(1), 1056(a); *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 1251, 103 USPQ2d 1753, 1755 (Fed. Cir. 2012) (quoting *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 1173, 71 USPQ2d 1370, 1371 (Fed. Cir. 2004)); TMEP §§1213, 1213.03(a).

Please see the attached dictionary definition of “DERM,” which is “another term for dermis,” or the skin. See Exhibit 1 attached. Applicant’s goods and services pertain to skin-related medical conditions. As such, the term “DERM” in the mark merely describes a characteristic, function, feature, purpose, or use of applicant’s goods and services, and must be disclaimed.

An applicant may not claim exclusive rights to terms that others may need to use to describe their goods and services in the marketplace. See *Dena Corp. v. Belvedere Int’l, Inc.*, 950 F.2d 1555, 1560, 21 USPQ2d 1047, 1051 (Fed. Cir. 1991); *In re Aug. Storck KG*, 218 USPQ 823, 825 (TTAB 1983). A disclaimer of unregistrable matter does not affect the appearance of the mark; that is, a disclaimer does not physically remove the disclaimed matter from the mark. See *Schwarzkopf v. John H. Breck, Inc.*, 340 F.2d 978, 978, 144 USPQ 433, 433 (C.C.P.A. 1965); TMEP §1213.

If applicant does not provide the required disclaimer, the USPTO may refuse to register the entire mark. See *In re Stereotaxis Inc.*, 429 F.3d 1039, 1040-41, 77 USPQ2d 1087, 1088-89 (Fed. Cir. 2005); TMEP §1213.01(b).

Applicant should submit a disclaimer in the following standardized format:

No claim is made to the exclusive right to use “DERM” apart from the mark as shown.

For an overview of disclaimers and instructions on how to satisfy this disclaimer requirement online using the Trademark Electronic Application System (TEAS) form, please go to <http://www.uspto.gov/trademarks/law/disclaimer.jsp>.

Assistance

If applicant has any questions or needs assistance in responding to this Office Action, please telephone or email the undersigned examining attorney.

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.

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TO RESPOND TO THIS LETTER: Go to http://www.uspto.gov/trademarks/teas/response_forms.jsp. Please wait 48-72 hours from the issue/ mailing date before using the Trademark Electronic Application System (TEAS), to allow for necessary system updates of the application. For *technical* assistance with online forms, e-mail TEAS@uspto.gov. For questions about the Office action itself, please contact the assigned trademark examining attorney. **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 application will be placed in the official application record.

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

PERIODICALLY CHECK THE STATUS OF THE APPLICATION: To ensure that applicant does not miss crucial deadlines or official notices, check the status of the application every three to four months using the Trademark Status and Document Retrieval (TSDR) system at <http://tsdr.uspto.gov/>. Please keep a copy of the TSDR status screen. If the status shows no change for more than six months, contact the Trademark Assistance Center by e-mail at TrademarkAssistanceCenter@uspto.gov or call 1-800-786-9199. 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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Definition of *derm* in English:

derm



NOUN

another term for **dermis**

Example sentences

Pronunciation

derm /dɜːm/

WORD OF THE DAY

veridical

ADJECTIVE

2016 OXFORD DICTIONARIES
WORD OF THE YEAR

The Oxford Dictionaries Word of the Year 2016 is...



20 words from the 1920s

Bulk

BULK
APOTHECARY

Industry Leading
Prices On:

- Essential Oils
- Waxes & Butters
- Carrier Oils
- Plus Much More!



Quiz: ghost or cat?



Which Roald Dahl character are you?



11 words you perhaps didn't know
were portmanteaus

Monkeys and Apes

Which of the following is a type of monkey or ape?

- mandrill
- mandrake

NEXT

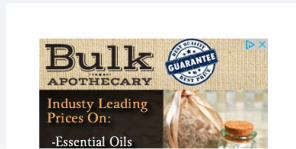
0/10

 TRENDING WORDS

Most popular in the world ▾

1. BF
2. translation
3. Hindi
4. bae
5. India

Further reading



5 tasty sandwich etymologies

Which Joe gave his name to 'sloppy joes'? We look at five interesting sandwiches and their lexical origins.

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-Carrier Oils
-Plus Much More!



6 punctuation marks you might be using incorrectly

We take a look at several popular, though confusing, punctuation marks.

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An A-Z of country name origins

From Afghanistan to Zimbabwe, discover surprising and intriguing language facts from around the globe.

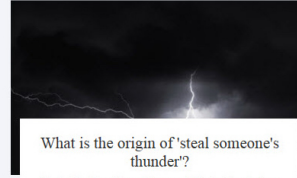
[READ MORE](#)



How brothers became buddies and bros

The definitions of 'buddy' and 'bro' in the OED have recently been revised. We explore their history and increase in popularity.

[READ MORE](#)



What is the origin of 'steal someone's thunder'?

Susie Dent explores the surprisingly literal story behind the phrase 'to steal someone's thunder'.

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To: IDOC24, Inc. (ipdocketingla@venable.com)
Subject: U.S. TRADEMARK APPLICATION NO. 87196946 - FIRST DERM - 133370.NEW
Sent: 1/18/2017 10:43:07 AM
Sent As: ECOM115@USPTO.GOV
Attachments:

UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

**IMPORTANT NOTICE REGARDING YOUR
U.S. TRADEMARK APPLICATION**

USPTO OFFICE ACTION (OFFICIAL LETTER) HAS ISSUED
ON **1/18/2017** FOR U.S. APPLICATION SERIAL NO. 87196946

Please follow the instructions below:

(1) TO READ THE LETTER: Click on this [link](#) or go to <http://tsdr.uspto.gov>, enter the U.S. application serial number, and click on "Documents."

The Office action may not be immediately viewable, to allow for necessary system updates of the application, but will be available within 24 hours of this e-mail notification.

(2) TIMELY RESPONSE IS REQUIRED: Please carefully review the Office action to determine (1) how to respond, and (2) the applicable response time period. Your response deadline will be calculated from **1/18/2017** (or sooner if specified in the Office action). A response transmitted through the Trademark Electronic Application System (TEAS) must be received before midnight **Eastern Time** of the last day of the response period. For information regarding response time periods, see <http://www.uspto.gov/trademarks/process/status/responsetime.jsp>.

Do NOT hit "Reply" to this e-mail notification, or otherwise e-mail your response because the USPTO does NOT accept e-mails as responses to Office actions. Instead, the USPTO recommends that you respond online using the TEAS response form located at http://www.uspto.gov/trademarks/teas/response_forms.jsp.

(3) QUESTIONS: For questions about the contents of the Office action itself, please contact the assigned trademark examining attorney. For *technical* assistance in accessing or viewing the Office action in the Trademark Status and Document Retrieval (TSDR) system, please e-mail TSDR@uspto.gov.

WARNING

Failure to file the required response by the applicable response deadline will result in the ABANDONMENT of your application. For more information regarding abandonment, see <http://www.uspto.gov/trademarks/basics/abandon.jsp>.

PRIVATE COMPANY SOLICITATIONS REGARDING YOUR APPLICATION: Private companies **not** associated with the USPTO are using information provided in trademark applications to mail or e-mail trademark-related solicitations. These companies often use names that closely resemble the USPTO and their solicitations may look like an official government document. Many solicitations require that you pay "fees."

Please carefully review all correspondence you receive regarding this application to make sure that you are responding to an official document from the USPTO rather than a private company solicitation. All official USPTO correspondence will be mailed only from the "United States Patent and Trademark Office" in Alexandria, VA; or sent by e-mail from the domain "@uspto.gov." For more information on how to handle private company solicitations, see http://www.uspto.gov/trademarks/solicitation_warnings.jsp.