

I. Introduction

Applicant Pencil Learning Technologies, Inc. (“*PLT*” or “*Applicant*”) respectfully submits this Response to the Office Action issued June 2, 2020 (the “*Office Action*”) in connection with PLT’s pending application, Serial Number 88827152 (the “*Application*”), seeking registration of the mark **PENCIL** (the “*Mark*”). In the Office Action, the Examining Attorney refused registration based solely on a determination that there exists a likelihood of confusion between the Mark and two registered marks purportedly owned by Pencil Networks, Inc., a Delaware corporation having a principal place of business located in San Francisco, California (the “*Registrant*”). Registrant’s marks have U.S. registration numbers 4458725 (the “*725 Mark*”) and 4700443 (the “*443 Mark*”).

As set forth below, (1) the 725 Mark has been cancelled, (2) the Registrant no longer legally exists and has not conducted business operations since at least 2015 such that all trademark rights under Section 1127 of the Lanham Act should be deemed by the USPTO to be abandoned, and, in any event (like the 725 Mark), (3) the 443 Mark shall expire ministerially on its own on March 10, 2021. Accordingly, for administrative ease, PLG respectfully requests that the Examining Attorney delay review of this response until March 11, 2021 and then remove the Section 2(d) objections to registration of the Mark.

II. Argument

A. Request to Delay Review by USPTO Examining Attorney.

As explained in more detail below, in light of the fact that Registrant no longer exists as a matter of law, Applicant respectfully requests that the USPTO examining attorney refrain from taking action on this Application until after March 10, 2021. When Registrant (since it no longer legally exists) fails to file a Section 8 declaration related to the 443 Mark, both the 443 Mark and the 725 Mark shall be ministerially cancelled making the refusals stated in the Office Action moot. Applicant requests when ministerial cancellation of the 443 Mark occurs on March 10, 2021, the Section 2(d) objections to registration of the Mark be withdrawn such that a Notice of Allowance may be issued with respect to the Application.

B. Cancellation of 725 Mark Has Already Occurred.

The 725 Mark should not be an impediment to the registration of PLT’s Application since it was cancelled by the USPTO on August 7, 2020 (see the TSDR printout made on December 1, 2020 and attached hereto as Attachment 1). Therefore, the refusal stated in the Office Action should be withdrawn with respect to the 725 Mark.

C. Registrant No Longer Exists And, Therefore, Cannot Have Trademark Rights.

Cancellation of the 725 Mark for failure to file a Section 8 declaration was not surprising since it Registrant ceased conducting business operations more than three years ago. In fact, per the Good Standing Certificate dated December 1, 2020 issued by the Delaware Secretary of State

and attached hereto as Attachment 2 (the “*Delaware Certificate*”), Registrant ceased to exist as a matter of law as of May 19, 2015. Given that Registrant no longer exists and ceased conducting business operations more than three years ago, any trademark rights related to the 443 Mark have been abandoned (15 USC Section 1127; see, also, TMEP 1613.11 *citing Imperial Tobacco Ltd. v. Phillip Morris Inc.*, 899 F.2d 1575, 14 USPQ2d 1390 (Fed. Cir. 1990) and Stromgren Supports Inc. v. Bike Athletic Co., 43 USPQ2d 1100 (TTAB 1997)).¹

Applicant respectfully requests that the USPTO take judicial notice of the Delaware Certificate and the CA SOS Screenshot given each is a governmental record. Accordingly, based on the Delaware Certificate, the CA SOS Screenshot, and the California Bar Screenshot, the USPTO should infer that all rights Registrant has in the 443 Mark have been abandoned. (See, page 241 of U.S. Trademark Law Rules of Practice & Federal Statutes published by the USPTO on February 15, 2020 and currently available for review at <https://www.uspto.gov/sites/default/files/documents/tmlaw.pdf>).

While the 443 Mark may technically remain on the Principal Register until the USPTO automatically cancels the registration for failure to file the requisite Section 8 declaration, the Delaware Certificate is proof that any such filing cannot be legally made by the Registrant. In fact, Registrant abandoned all trademark rights on or around May 2015 when it ceased to exist. Therefore, the refusal stated in the Office Action also should be withdrawn with respect to the 443 Mark.

III. Conclusion

The refusals stated in the Office Action should be withdrawn in their entireties based on the fact that Registrant has ceased to legally exist for more than five years. As such, the automatic cancellation of the 725 Mark was to be expected and, while Registrant has no trademark rights of any kind given it no longer exists as a matter of law, the 443 Mark will be ministerially cancelled by no later than March 10, 2021. While the USPTO should infer abandonment of the 443 Mark given that Registrant no longer exists, Applicant respectfully requests that the examining attorney review this response on or after March 11, 2021 for administrative ease. When the 443 Mark is ministerially cancelled for failure of Registrant to file a Section 8 declaration, the refusals stated in the Office Action be withdrawn so that a Notice of Allowance may be issued with respect to the Application.

¹ As further support to the fact that Registrant no longer exists and/or no longer operates, Applicant has attached as Attachment 3 a screen-shot taken on December 1, 2020 of the California Secretary of State’s website (the “*CA SOS Screenshot*”) showing no record of Registrant ever registering to do business in the State of California despite listing on its trademark applications a principal place of business located in San Francisco, California. As additional supplementary support, Applicant has attached as Attachment 4 a screen-shot taken on December 1, 2020 of the State Bar of California showing that Registrant’s attorney of record is no longer an active member of the California Bar (the “*California Bar Screenshot*”); active clients normally engage with attorneys that are active members of their respective bars. Additionally, a search of both the Apple App store and the Google Play App store conducted on December 1, 2020 found no references to any Pencil application connected in any manner to Registrant.