

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Mark: **SEQUOIA**
App. No.: 87/884,368
App. Date: April 19, 2018
Applicant: Sequoia Waste Management Solutions, LLC
Examining Atty: Keyla Maria Gandara

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

REQUEST TO DIVIDE
PURSUANT TO 37 C.F.R. § 2.87 and TMEP 1110

Dear Sir:

Introduction

This paper is being filed by Applicant in response to the Office Action (“OA”) issued by the USPTO for this matter on August 16, 2018. Applicant has applied in United States Trademark Application No. 87/884,368 (the “368 Application”) for a SEQUOIA mark (“Applicant’s Mark”) intended for use in connection with the following goods of International Class 9:

“downloadable software applications for waste management; downloadable software applications for providing waste management information, resources, solutions, and guidance to others; downloadable software applications for management of waste receptacles, namely, commercial and industrial trash compactors; systems for management of commercial and industrial trash compactors consisting of computer software and computer hardware;”

and used in connection with the following services of International Class 40:

“providing technical information in the field of waste management; consulting services in the field of waste management; consulting services in the field of design, development, and planning of waste management systems for buildings; waste management services, namely, the monitoring, placement, and strategic collection management of commercial and industrial trash compactors.”

Request to Divide

Applicant requests that the '368 Application be divided into two applications, the parent '368 Application derived from the entirety of the International Class 9 goods described in the '368 Application, and a child application derived from the entirety of the International Class 40 goods described in the '368 Application. Applicant notes that the filing basis for the parent (Class 9) '368 Application will remain 1(b), as will the basis for the child (Class 40) application likewise remain 1(b).

Additionally, with respect to the **“Amendment to Identification & Classification of Goods and Services Required”** issue recited in the OA, Applicant responds as follows:

Amendment to Identification & Classification of Goods and Services

In the OA, the Examining Attorney proposed an amendment of Applicant's International Class 40 services as filed in the '368 Application to include a multiple service class designation, including the following amendment for a to-be-added (new) services description in International Class 42:

“Waste management services, namely, the electronic monitoring of commercial and industrial trash compactors using computers and sensors; consulting services in the field of design, development, and planning of waste management systems consisting of computer software and hardware, for buildings.”

Applicant appreciates the Examining Attorney's proposal and offers the following counterproposal. Applicant proposes to clarify Applicant's original identification of the International Class 40 services in the '368 Application by reclassifying the services in International Class 42, as well as clarifying and narrowing the description of the services in the requested child application as follows:

Current, Class 40: “providing technical information in the field of waste management; consulting services in the field of waste management; consulting

services in the field of design, development, and planning of waste management systems for buildings; waste management services, namely, the monitoring, placement, and strategic collection management of commercial and industrial trash compactors”

Proposed, Class 42: “waste management services, namely, the electronic monitoring of commercial and industrial trash compactors using computers and sensors; consulting services in the field of waste management, namely, the design, development, and planning of waste management systems consisting of commercial and industrial trash compactors; consulting services in the field of waste management, namely, the design, development, and planning of waste management systems consisting of computer software and hardware, for buildings; consulting services in the field of waste management, namely, the design, development, and planning of waste management systems consisting of floor plans and site plans to define the location of waste receptacles and travelways for access to and removal of waste receptacles, for buildings”

Applicant respectfully requests that this amendment to the description of services be accepted.

Conclusion

Also, provided herewith is a fee of \$100.00 for the divisional pursuant to 37 C.F.R. §2.6(a)(19)(ii). Applicant does not believe that a new application fee of \$275 pursuant to 37 C.F.R. §2.6(a)(1)(iii) is required because Applicant is requesting to divide out one or more entire classes from the application.

Applicant respectfully asserts that both of the parent application and the requested child application (upon its formation) are (or will be in the case of the child) in good condition for publication and requests that both applications be approved for publication by the Examining Attorney.

If the USPTO has any comments or questions regarding this matter that may be readily resolved with a phone call, please do not hesitate to contact the undersigned attorney.

Appl. No.: 87/884,368

Request to Divide and OA Response Dated: February 14, 2019

Dated: February 14, 2019

Respectfully submitted,

By: /Adam J. Fromm/
Adam J. Fromm (Reg. No. 59,563)
Clark Hill PLC
130 E. Randolph St., Suite 3900
Chicago, Illinois 60601
Tel: (312) 985-5908