



Registration No. 2633150

RESPONSE TO POST-REGISTRATION OFFICE ACTION

This communication is in response to the Trademark Specialist's Post-Registration Office Action, dated January 27, 2014. Registrant responds as follows:

The Trademark Specialist has determined that the specimen submitted on April 5, 2013 in connection with Registrant's Section 8 Declaration for International Class 18 is unacceptable because it "consists of advertising material for goods and does not show use of the registered mark on the goods or on packaging for the goods." The Trademark Specialist has also determined that the substitute specimens submitted on October 28, 2013 in connection with Registrant's response to the post-registration office action are unacceptable because the specimens do not show the registered mark "on the goods themselves."

Registrant respectfully submits that each of the specimens submitted in connection with the International Class 18 goods consisted of point-of-sale displays associated with the goods offered for sale. The specimen submitted on April 5, 2013 shows the registered mark as used on Registrant's webpage at and through which the International Class 18 goods could be viewed and immediately purchased on that webpage. *See* TMEP § 904.03(i); *In re Sones*, 590 F.3d 1282, 93 U.S.P.Q.2d 1118 (Fed. Cir. 2009). The substitute specimens submitted on October 28, 2014 consist of (1) two photographs showing the registered mark prominently used on point-of-purchase displays associated with the sale of the International Class 18 goods; and (2) a screenshot of Registrant's website showing the registered mark prominently used as a point-of-

purchase display associated with the sale of the International Class 18 goods via Registrant's website.

In the January 27, 2014 post-registration office action, the Trademark Specialist states that “[t]he point of purchase display sign would be acceptable for International Class 35 retail services,” and rejects the specimens because they do not show the registered mark “on the goods themselves.” Registrant respectfully disagrees that a point of purchase display is acceptable only for International Class 35 retail services, and not for the goods themselves. It is well-settled that displays associated with sale of goods are appropriate specimens for the goods themselves. TMEP 904.03 (citing 37 C.F.R. § 2.56(b)(1)) (“A trademark specimen should be a label, tag, or container for the goods, *or a display associated with the goods.*”) (emphasis added). A display is an appropriate specimen provided that the display is “associated directly with the goods offered for sale” and “bear[s] the trademark prominently.” TMEP § 904.03(g). “However, it is not necessary that the display be in close proximity to the goods.” *Id.* For that reason, “point-of-sale material such as banners, shelf-talkers, window displays, menus, and similar devices” are appropriate specimens for goods. *Id.* Accordingly, Registrant maintains that the specimens submitted in connection with the Section 8 Declaration and in response to the post-registration office action were appropriate point-of-purchase displays.

Notwithstanding the foregoing, Registrant herewith submits two substitute specimens, which consist of the following: (1) a photograph of a gym bag bearing the Registrant's mark; and (2) a screenshot of Registrant's website showing the registered mark prominently used as a point-of-purchase display associated with the sale of the International Class 18 goods via Registrant's website. As shown in this screenshot, Registrant's website provides a link for ordering the International Class 18 goods.

In connection with the foregoing substitute specimens, Registrant submits the following statement:

The substitute specimen was in use in commerce during the relevant period for filing the 10-year Section 8.

37 C.F.R. § 2.161(g); TMEP § 1604.12(c).

Declaration

The owner was using the mark in commerce on or in connection with the goods and/or services identified in the registration for which use of the mark in commerce is claimed, as evidenced by the submitted specimen, during the relevant period for filing the 10-year Section 8.

The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. § 1001, and that such willful false statements may jeopardize the validity of this document, declares that s/he is properly authorized to execute this document on behalf of the owner, and all statements made of his/her own knowledge are true and that all statements made on information and belief are believed to be true.



Kimberly Griffin
24 Hour Fitness USA, Inc.
Vice-President and Corporate Counsel

5 / 8 / 14

Date