

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of:

NIKE, Inc.

App. No.: 88/781482

Filed: January 31, 2020

For:



Atty Docket No.: 1104164.00095

Law Office: 103

Examining Attorney: Mark Sparacino

**RESPONSE TO OFFICE ACTION**

This response is submitted in reply to the office action mailed April 20, 2020. The Examining Attorney has required disclaimer of “SNEAKERS” on the ground that SNKRS [allegedly] is merely descriptive of its services.

Applicant respectfully submits that the grounds for refusal are, at least, premature, and for the reasons described herein, should not be applied to this application.

The Applicant’s application was filed as an intent to use application for the following services:

Int’l Class: 42

Providing a website that gives users the ability to review various print, photographic, graphic image, and audio and video content and utilize a custom template to provide input, likes, dislikes, edits, changes, modifications, opinions, suggestions, and comments and engage in social, business and community networking

Applicant has not yet filed its Amendment to Allege Use confirming use of the SNKRS mark in connection with the services identified above.

In making the refusal, the Examining Attorney concluded that Applicant's services will include providing a website relating to sneakers based on website excerpts he located. Citing only that evidence, he issued the refusal noted above.

Applicant acknowledges that its business includes, *inter alia*, providing footwear, including sneakers. However, as Applicant is still considering the types of uses of the SNKRS Mark that may fit in with the description of the services in this application, Applicant respectfully submits that the refusal is premature.

In asserting that the refusal is premature, Applicant acknowledges, as well, that it has other applications for the mark SNKRS which are co-pending, including Nos. 88/781470, 88/781464, and 88/781488. The '470 and '464 applications are use-based applications and the '488 application is an intent to use application for the same services as the instant application. The '470, '464, and '488 applications also have been assigned to the Examining Attorney in this case, and have mere descriptiveness and potential genericness grounds cited.

As the Examining Attorney will see, Applicant is today filing substantive responses in the '470 and '464 use-based applications. Those responses include claims for registration pursuant to Section 2(f) and an extensive evidence record to support the claim. Applicant hopes that after the Examining Attorney reviews those responses, he will withdraw the objections to the refusals and allow the applications to move forward to publication. Because Applicant has not yet filed an Amendment to Allege Use in this case, and given that the determination of the registrability of its mark may turn in part on how the Examining Attorney views the responses submitted in the '470 and '464 applications, Applicant respectfully requests that the Examining Attorney reconsider the refusal in this case at this time. If the Examining Attorney decides to maintain the

initial refusal in this application, then Applicant will prepare a supplemental response arguing against the refusal.

Please note that with this response Applicant is submitting an Associate Power of Attorney appointing Helen Hill Minsker and other attorneys from the law firm of Arnold & Porter Kaye Scholer LLP as additional attorneys who may represent it in this application. While the correspondence address remains the same for this application, the Examining Attorney also is authorized to communicate with the additional attorneys appointed to represent the Applicant.

Respectfully submitted,

ARNOLD & PORTER KAYE SCHOLER LLP  
*Attorneys for Applicant*

Date: October 20, 2020

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