Trademark Assistance Center

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TO: Mike Bessler % David Walters
Name: Mike Bessler % David Walters
Company: 
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Date and time of transmission: Wednesday, November 03, 2004 11:27:24 AM
Number of pages including this cover sheet: 04
OFFICE ACTION

TO AVOID ABANDONMENT, WE MUST RECEIVE A PROPER RESPONSE TO THIS OFFICE ACTION WITHIN 6 MONTHS OF OUR MAILING OR E-MAILING DATE.

Serial Number 78/397067

The assigned examining attorney has reviewed the referenced application and determined the following.

Mark is Merely Descriptive of the Services

The examining attorney refuses registration on the Principal Register because the proposed mark merely describes the services. Trademark Act Section 2(e)(1), 15 U.S.C. Section 1052(e)(1); TMEP section 1209 et seq.

The proposed mark is merely descriptive because it consists of the merely descriptive term or terms MARXISTS, combined with the top-level domain (TLD) .ORG, and is therefore merely descriptive of applicant’s goods and/or services. Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1); TMEP §§1209.03(m) and 1215.04. MARXISTS is highly descriptive of the subject matter of the services. See the specimen of record for support.
Furthermore, the TLD, .ORG will be perceived by prospective customers as part of an Internet address, and, therefore, has no source identifying significance. In re Microsoft Corp., 68 USPQ2d 1195, 1203 (TTAB 2003) ("The combination of the specific term and TLD at issue, i.e., OFFICE and .NET, does not create any double entendre, incongruity, or any other basis upon which we can find the composite any more registrable than its separate elements"); In re CyberFinancial.Net Inc., 65 USPQ2d 1789 (TTAB 2002) ("The public would not understand BONDS.COM to have any meaning apart from the meaning of the individual terms combined"); In re Martin Container Inc., 65 USPQ2d 1058 (TTAB 2002) ("To the average customer seeking to buy or rent containers, "CONTAINER.COM" would immediately indicate a commercial web site on the Internet which provides containers.").

Accordingly, registration is denied on the Principal Register.

*Advisory Note*
Please note that the proposed mark appears to be highly descriptive, possibly even a generic name for the services. Marks comprised of generic terms combined with TLDs are not eligible for registration on the Supplemental Register, or on the Principal Register under Trademark Act §2(f), 15 U.S.C. §1052(f).

This applies to trademarks, service marks, collective marks and certification marks. Under these circumstances, the examining attorney cannot recommend an amendment to proceed under Trademark Act Section 2(f), 15 U.S.C. Section 1052(f), or an amendment to the Supplemental Register. TMEP sec. 1209.03(m)

No Conflicting Marks Noted
The examining attorney has searched the Office records and has found no similar registered or pending mark which would bar registration under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d). TMEP section 1105.01.

If the applicant chooses to respond to the refusal to register, the applicant must also respond to the following informalities.

Voluntary Disclaimer
Applicant is requested to request that the voluntary disclaimer of .ORG be withdrawn. The trademark examining attorney would not have required a disclaimer of this wording because it is part of a unitary mark.

While an applicant may voluntarily disclaim registrable matter, if applicant in this case entered the disclaimer under the mistaken belief that it would have been required, then applicant may withdraw the disclaimer. TMEP §1213.01(c).

NOTICE: TRADEMARK OPERATION RELOCATING OCTOBER AND NOVEMBER 2004

The Trademark Operation is relocating to Alexandria, Virginia, in October and November 2004. Effective October 4, 2004, all Trademark-related paper mail (except documents sent to the Assignment Services Division for recordation, certain documents filed under the Madrid Protocol, and requests for copies of trademark documents) must be sent to:

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451
Applicants, registration owners, attorneys and other Trademark customers are strongly encouraged to correspond with the USPTO online via the Trademark Electronic Application System (TEAS), at www.uspto.gov.

/Ysa de Jesus/
Trademark Attorney
Law Office 114
703 272 9449

How to respond to this Office Action:

You may respond formally using the Office's Trademark Electronic Application System (TEAS) Response to Office Action form (visit http://eteas.uspto.gov/V2.0/oa242/WIZARD.htm and follow the instructions therein, but you must wait until at least 72 hours after receipt if the office action issued via e-mail). PLEASE NOTE: Responses to Office Actions on applications filed under the Madrid Protocol (Section 66(a)) CANNOT currently be filed via TEAS.

To respond formally via regular mail, your response should be sent to the mailing Return Address listed above and include the serial number, law office and examining attorney’s name on the upper right corner of each page of your response.

To check the status of your application at any time, visit the Office’s Trademark Applications and Registrations Retrieval (TARR) system at http://tarr.uspto.gov/

For general and other useful information about trademarks, you are encouraged to visit the Office’s web site at http://www.uspto.gov/main/trademarks.htm

FOR INQUIRIES OR QUESTIONS ABOUT THIS OFFICE ACTION, PLEASE CONTACT THE ASSIGNED EXAMINING ATTORNEY.

[1] EXAMINATION GUIDE NO. 2-99. Marks Composed, In Whole Or In Part, Of Domain Names p.7 September 29, 1999. (See for example BANK.COM.COM for banking services is unregistrable on either the Principal or Supplemental Register)