

To: McDonough Braungart Design Chemistry, LL ETC. (tmducket@oblon.com)
Subject: TRADEMARK APPLICATION NO. 77329669 - CRADLE TO CRADLE CER - 318507US43
Sent: 3/6/2008 9:19:00 PM
Sent As: ECOM109@USPTO.GOV
Attachments: Attachment - 1
Attachment - 2

UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 77/329669

MARK: CRADLE TO CRADLE CER

77329669

CORRESPONDENT ADDRESS:

BRIAN B. DARVILLE
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUST

RESPOND TO THIS ACTION:

<http://www.uspto.gov/teas/eTEASpageD.htm>

1940 DUKE ST
ALEXANDRIA, VA 22314-3451

GENERAL TRADEMARK INFORMATION:

<http://www.uspto.gov/main/trademarks.htm>

APPLICANT: McDonough Braungart Design Chemistry,
LL ETC.

CORRESPONDENT'S REFERENCE/DOCKET NO:

318507US43

CORRESPONDENT E-MAIL ADDRESS:

tmducket@oblon.com

OFFICE ACTION

TO AVOID ABANDONMENT, THE OFFICE MUST RECEIVE A PROPER RESPONSE TO THIS OFFICE ACTION WITHIN 6 MONTHS OF THE ISSUE/MAILING DATE.

ISSUE/MAILING DATE: 3/6/2008

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

Search Results

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. §1052(d). TMEP §704.02.

Applicant owns application Serial No. 77244387 for virtually the same mark for the same or some of the same goods and/or services to be certified by the certification mark. However, Trademark Act Section 14(5)(B), 15 U.S.C. §1064(5)(B), provides for cancellation of a certification mark if the registrant "engages in the production or marketing of any goods or services to which the certification mark is applied." See *cf. Midwest Plastic Fabricators, Inc. v. Underwriters Labs., Inc.*, 906 F.2d 1568, 15 USPQ2d 1359 (Fed. Cir. 1990).

Therefore, before the mark in this application can register, applicant must expressly abandon the prior-filed pending application Serial No. 77244387. TMEP §1306.05(b).

With respect to this certification mark application, the record must be clear and uncontradicted that the certification mark is no longer used as a trademark or service mark. See *cf. In re Florida Citrus Comm'n*, 160 USPQ 495 (TTAB 1968).

Certification Statement

Applicant must rewrite and resubmit the certification statement by deleting the wording "the Applicant" and substituting the wording "the Certifier." *In re National Association of Purchasing Management*, 228 USPQ 768, 769 n.2 (TTAB 1986). This amendment is necessary because the language will be printed on the registration certificate.

Non-use Statement

Applicant must add to the application record the statement that "applicant will not engage in the production or marketing of the goods or services to which the mark is applied." Trademark Act Section 4, 15 U.S.C. §1054; 37 C.F.R. §2.45(b); TMEP §1306.06(g)(v).

Signed Declaration

The application was not signed and verified, which are application requirements. 15 U.S.C. §§1051(a)-(b), 1126(d)-(e), 1141f(a); 37 C.F.R. §§2.33-2.34. Therefore, applicant must verify, in a signed affidavit or declaration under 37 C.F.R. §2.20, the following statement: **“Applicant has had a bona fide intention to exercise legitimate control over use of the certification mark in commerce as of the filing date, and the facts set forth in the application are true and correct.”** 37 C.F.R. §2.193(c)(1)(iii); TMEP §804.02.

If applicant responds to this Office action via TEAS, applicant may satisfy this requirement by adding the required statement (specified immediately above) to the TEAS response form, checking the box for a “signed declaration,” and properly signing the form by either (1) choosing an electronic signature consisting of any combination of letters, numbers, spaces and/or punctuation marks, preceded and followed by the forward slash (/) symbol (e.g., /johndoe/), and entering this in the signature block on the response form, or (2) attaching a JPG or PDF image of a declaration under 37 C.F.R. §2.20 (see declaration paragraph below) together with a pen-and-ink signature. TMEP §804.05.

If applicant responds to this Office action on paper, via regular mail, applicant may satisfy this requirement by providing the following declaration at the end of the response, properly signed and dated:

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 and the like may jeopardize the validity of the application or any resulting registration, declares that he/she is properly authorized to execute this application on behalf of the applicant; he/she believes the applicant to be entitled to use such mark in commerce; that *applicant has had a bona fide intention to exercise legitimate control over use of the certification mark in commerce as of the filing date; that the facts set forth in the application are true and correct*; that to the best of his/her knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive; and that all statements made of his/her own knowledge are true and all statements made on information and belief are believed to be true.

(Signature)

(Print or Type Name and Position)

(Date)

/James A. Rauen/
Trademark Examining Attorney
Law Office 109
571-272-9211

RESPOND TO THIS ACTION: If there are any questions about the Office action, please contact the assigned examining attorney. A response to this Office action should be filed using the form available at <http://www.uspto.gov/teas/eTEASpageD.htm>. If notification of this Office action was received via e-mail, no response using this form may be filed for 72 hours after receipt of the notification. **Do not attempt to respond by e-mail as the USPTO does not accept e-mailed responses.**

If responding by paper mail, please include the following information: the application serial number, the mark, the filing date and the name, title/position, telephone number and e-mail address of the person signing the response. Please use the following address: Commissioner for Trademarks, P.O. Box 1451, Alexandria, VA 22313-1451.

STATUS CHECK: Check the status of the application at least once every six months from the initial filing date using the USPTO Trademark Applications and Registrations Retrieval (TARR) online system at <http://tarr.uspto.gov>. When conducting an online status check, print and maintain a copy of the complete TARR screen. If the status of your application has not changed for more than six months, please contact the assigned examining attorney.

Print: Mar 3, 2008

77244387

DESIGN MARK

Serial Number

77244387

Status

NON-FINAL ACTION - MAILED

Word Mark

CRADLE TO CRADLE

Standard Character Mark

Yes

Type of Mark

TRADEMARK

Register

PRINCIPAL

Mark Drawing Code

(4) STANDARD CHARACTER MARK

Owner

McDonough Braungart Design Chemistry, LLC LTD LIAB CO VIRGINIA Suite
101 1001 East Market Street Charlottesville VIRGINIA 22902

Goods/Services

Class Status -- ACTIVE. IC 016. US 002 005 022 023 029 037 038 050.

G & S: Paper, cardboard and goods made from these materials, namely, greeting cards, annual reports, periodicals, books, advertising materials, coasters made of paper, collapsible boxes of paper, cushioning or padding made of paper for packing purposes, paper baby bibs; printed matter, namely, newsletters relating to sustainability or environmental issues; bookbinding material, namely, bookbinding tape, bookbinding, wire, bookbindings, cloth for bookbinding; photographs; stationery; adhesives for stationery or household purposes; printed instructional and teaching material relating to sustainability or environmental issues; plastic materials for packaging, namely, plastic bags, plastic bubble packs for wrapping, plastic envelopes for merchandise packaging.

Filing Date

2007/08/01

Examining Attorney

BRODY, DANIEL

Attorney of Record

Brian B. Darville

CRADLE TO CRADLE

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Subject: TRADEMARK APPLICATION NO. 77329669 - CRADLE TO CRADLE CER - 318507US43
Sent: 3/6/2008 9:19:02 PM
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Attachments:

IMPORTANT NOTICE
USPTO OFFICE ACTION HAS ISSUED ON 3/6/2008 FOR
APPLICATION SERIAL NO. 77329669

Please follow the instructions below to continue the prosecution of your application:

VIEW OFFICE ACTION: Click on this link http://tportal.uspto.gov/external/portal/tow?DDA=Y&serial_number=77329669&doc_type=OOA&mail_date=20080306 (or copy and paste this URL into the address field of your browser), or visit <http://tportal.uspto.gov/external/portal/tow> and enter the application serial number to [access](#) the Office action.

PLEASE NOTE: The Office action may not be immediately available but will be viewable within 24 hours of this notification.

RESPONSE MAY BE REQUIRED: You should carefully review the Office action to determine (1) if a response is required; (2) how to respond; and (3) the applicable [response time period](#). Your response deadline will be calculated from **3/6/2008**.

Do NOT hit "Reply" to this e-mail notification, or otherwise attempt to e-mail your response, as the USPTO does NOT accept e-mailed responses. Instead, the USPTO recommends that you respond online using the Trademark Electronic Application System response form at <http://www.uspto.gov/teas/eTEASpageD.htm>.

HELP: For *technical* assistance in accessing the Office action, please e-mail TDR@uspto.gov. Please contact the assigned examining attorney with questions about the Office action.

WARNING

- 1. The USPTO will NOT send a separate e-mail with the Office action attached.**
- 2. Failure to file any required response by the applicable deadline will result in the [ABANDONMENT](#) of your application.**