

**To:** ONE MANHATTAN REAL ESTATE LLC ([trademarks@mshtechlaw.com](mailto:trademarks@mshtechlaw.com))  
**Subject:** U.S. TRADEMARK APPLICATION NO. 85714603 - ONE MANHATTAN REAL ESTATE - N/A  
**Sent:** 12/21/2012 4:31:22 PM  
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[Attachment - 2](#)  
[Attachment - 3](#)  
[Attachment - 4](#)

**UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)  
OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION**

**U.S. APPLICATION SERIAL NO.** 85714603

**MARK:** ONE MANHATTAN REAL ESTATE

**\*85714603\***

**CORRESPONDENT ADDRESS:**

MARCUS STEPHEN HARRIS  
MARCUS STEPHEN HARRIS LLC  
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CHICAGO, IL 60603

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**APPLICANT:** ONE MANHATTAN REAL ESTATE LLC

**CORRESPONDENT'S REFERENCE/DOCKET NO :**

N/A

**CORRESPONDENT E-MAIL ADDRESS:**

[trademarks@mshtechlaw.com](mailto:trademarks@mshtechlaw.com)

**OFFICE ACTION**

**STRICT DEADLINE TO RESPOND TO THIS LETTER**

TO AVOID ABANDONMENT OF APPLICANT'S TRADEMARK APPLICATION, THE USPTO MUST RECEIVE APPLICANT'S COMPLETE RESPONSE TO THIS LETTER **WITHIN 6 MONTHS** OF THE ISSUE/MAILING DATE BELOW.

**ISSUE/MAILING DATE:** **12/21/2012**

The referenced application has been reviewed by the assigned trademark examining attorney. Applicant must respond timely and completely to the issue(s) below. 15 U.S.C. §1062(b); 37 C.F.R. §§2.62(a), 2.65(a); TMEP §§711, 718.03.

## **SUMMARY OF ISSUES that applicant must address:**

- Identification & Classification of Services
- Disclaimer

### **Identification & Classification of services** TMEP §1402.11.

Applicant has submitted the following identification of services:

Real estate brokerage services; On-line computer database in the field of real estate

The wording “**On-line computer database in the field of real estate**” in the identification of services is unacceptable as indefinite. Applicant must specify the type(s) real estate services/topics that are covered by the database; this will determine the classification.

For example, if accurate, the applicant may amend this wording to:

- Providing an on-line computer database in the field of real estate marketing services, namely on-line services featuring tours of residential and commercial real estate, in International Class 035;
- Providing on-line computer database in the field of real estate listings, in International Class 036
- Providing on-line computer database in the field of real estate regarding selling and purchasing of real estate for others, in International Class 036;
- Providing on-line computer database in the field of real estate development, in International Class 037

An applicant may amend an identification of services only to clarify or limit the services; adding to or broadening the scope of the services is not permitted. 37 C.F.R. §2.71(a); *see* TMEP §§1402.06 *et seq.*, 1402.07 *et seq.*

For assistance with identifying and classifying goods and/or services in trademark applications, please see the USPTO’s online searchable *U.S. Acceptable Identification of Goods and Services Manual* at <http://tess2.uspto.gov/netathtml/tidm.html>. *See* TMEP §1402.04.

### **Multi-Class Application – Use Based – Information**

For an application with more than one international class, called a “multiple-class application,” an applicant must meet all the requirements below for those international classes based on use in commerce:

- (1) List goods and/or services by international class: Applicant must list the goods and/or services by international class.
- (2) Provide fees for all international classes: Applicant must submit an application filing fee for each international class of goods and/or services not covered by the fee(s) already paid (confirm current fee information at [http://www.uspto.gov/trademarks/tm\\_fee\\_info.jsp](http://www.uspto.gov/trademarks/tm_fee_info.jsp)).
- (3) Submit required statements and evidence: For each international class of goods and/or services, applicant must also submit the following:
  - (a) Dates of use: Dates of first use of the mark anywhere and dates of first use of the mark in commerce, or a statement that the dates of use in the initial application apply to

that class. The dates of use, both anywhere and in commerce, must be at least as early as the filing date of the application.

(b) **Specimen:** One specimen showing the mark in use in commerce for each international class of services. Applicant must have used the specimen in commerce at least as early as the filing date of the application. If a single specimen supports multiple international classes, applicant should indicate which classes the specimen supports. Examples of specimens for services are signs, photographs, brochures, website printouts, or advertisements that show the mark used in the actual sale or advertising of the services. See TMEP §§1301.04 *et seq.*

(c) **Statement:** The following statement: “**The specimen was in use in commerce on or in connection with the services listed in the application at least as early as the filing date of the application.**”

(d) **Verification:** Applicant must verify the statements in 3(a) and 3(c) (above) in an affidavit or signed declaration under 37 C.F.R. §2.20. Verification is not required where (1) the dates of use for the added class are stated to be the same as the dates of use specified in the initial application, and (2) the original specimens are acceptable for the added class(es).

See 15 U.S.C. §§1051(a), 1112, 1127; 37 C.F.R. §§2.32(a)(5), 2.34(a)(1), 2.56(a), 2.71(c), 2.86(a), 2.193(e)(1); TMEP §§1403.01, 1403.02(c).

With respect to the specimen requirement in 3(b) above in which a specimen is required for each international class of services, the specimen(s) of record is acceptable for International Classes 035 and 036 only. Applicant must submit additional specimens if different international classes are added to the application.

### **Disclaimer**

Applicant must disclaim the geographically descriptive wording “**MANHATTAN**” and the descriptive wording “**REAL ESTATE**” apart from the mark as shown because it merely describes an ingredient, quality, characteristic, function, feature, purpose, or use of applicant’s goods and/or services. See 15 U.S.C. §§1052(e)(1), 1056(a); *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, \_\_\_ F.3d \_\_\_, 103 USPQ2d 1753, 1755 (Fed. Cir. 2012) (quoting *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 1173, 71 USPQ2d 1370, 1371 (Fed. Cir. 2004)); *In re Steelbuilding.com*, 415 F.3d 1293, 1297, 75 USPQ2d 1420, 1421 (Fed. Cir. 2005); TMEP §§1213, 1213.03(a).

Applicant’s services include various real estate services that cover the Manhattan borough of New York City

See attached website, <http://www.onemanhattanre.com/>

A “disclaimer” is a statement in the application record that applicant does not claim exclusive rights to an unregistrable component of a mark; a disclaimer does not affect the appearance of the mark or physically remove disclaimed matter from the mark. TMEP §§1213, 1213.10. An unregistrable component of a mark includes wording and designs that are merely descriptive/generic/deceptively misdescriptive, primarily geographically descriptive of an applicant’s goods and/or services. 15 U.S.C. §1052(e); see TMEP §§1209.03(f), 1213.03 *et seq.* Such words or designs need to be freely available for other businesses to market comparable goods or services and should not become the proprietary domain of any

one party. *See Dena Corp. v. Belvedere Int'l, Inc.*, 950 F.2d 1555, 1560, 21 USPQ2d 1047, 1051 (Fed. Cir. 1991); *In re Aug. Storck KG*, 218 USPQ 823, 825 (TTAB 1983).

Applicant may submit the following standardized format for a disclaimer:

No claim is made to the exclusive right to use “**MANHATTAN REAL ESTATE**” apart from the mark as shown.

TMEP §1213.08(a)(i); *see In re Owatonna Tool Co.*, 231 USPQ 493 (Comm’r Pats. 1983).

### **Search**

The trademark examining attorney has searched the Office’s database of registered and pending marks and has found no conflicting marks that would bar registration under Trademark Act Section 2(d). TMEP §704.02; *see* 15 U.S.C. §1052(d).

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**All informal e-mail communications relevant to this application will be placed in the official application record.**

**WHO MUST SIGN THE RESPONSE:** It must be personally signed by an individual applicant or someone with legal authority to bind an applicant (i.e., a corporate officer, a general partner, all joint applicants). If an applicant is represented by an attorney, the attorney must sign the response.

**PERIODICALLY CHECK THE STATUS OF THE APPLICATION:** To ensure that applicant does not miss crucial deadlines or official notices, check the status of the application every three to four months using the Trademark Status and Document Retrieval (TSDR) system at <http://tsdr.uspto.gov/>. Please keep a copy of the TSDR status screen. If the status shows no change for more than six months, contact the Trademark Assistance Center by e-mail at [TrademarkAssistanceCenter@uspto.gov](mailto:TrademarkAssistanceCenter@uspto.gov) or call 1-800-786-9199. For more information on checking status, see <http://www.uspto.gov/trademarks/process/status/>.

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