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**To:** Nintendo of America Inc. ([efiling@cojk.com](mailto:efiling@cojk.com))

**Subject:** TRADEMARK APPLICATION NO. 77427250 - WII REMOTE - NOAM-2-36755

**Sent:** 11/26/2008 12:17:36 PM

**Sent As:** ECOM113@USPTO.GOV

**Attachments:**

**UNITED STATES PATENT AND TRADEMARK OFFICE****SERIAL NO:** 77/427250**MARK:** WII REMOTE**\*77427250\*****CORRESPONDENT ADDRESS:**JERALD E. NAGAE, REG. NO. 29,418  
CHRISTENSEN O'CONNOR JOHNSON

KINDNESS

1420 FIFTH AVENUE, SUITE 2800  
SEATTLE, WA 98101-2347**GENERAL TRADEMARK INFORMATION:**<http://www.uspto.gov/main/trademarks.htm>**APPLICANT:** Nintendo of America Inc.**CORRESPONDENT'S REFERENCE/DOCKET****NO:**

NOAM-2-36755

**CORRESPONDENT E-MAIL ADDRESS:**[efiling@cojk.com](mailto:efiling@cojk.com)**NOTICE OF SUSPENSION****ISSUE/MAILING DATE: 11/26/2008**

**SUSPENSION PROCEDURE:** This suspension notice serves to suspend action on the application for the reason(s) specified below. No response is needed. However, if you wish to respond to this notice, you should use the "Response to Letter of Suspension" form found at <http://teasroa.uspto.gov/rsi/rsi>. The

Office will conduct periodic status checks to determine if suspension remains appropriate.

This responds to applicant's communication filed on November 20, 2008. The amendment to the description of goods is acceptable. Applicant did not respond to requirements to enter a disclaimer and provide product information. Therefore, the disclaimer and product information requirements are continued and maintained.

### **SUSPENSION PENDING DISPOSITION OF EARLIER-FILED APPLICATIONS**

Action on this application is suspended pending the disposition of:

- Application Serial No(s). **77136959, 77422025 and 78872928**

Since applicant's effective filing date is subsequent to the effective filing date of the above-identified application(s), the latter, if and when it registers, may be cited against this application in a refusal to register under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d). See 37 C.F.R. §2.83; TMEP §§1208 et seq. A copy of information relevant to this pending application(s) **was sent previously**.

Applicant may submit a request to remove the application from suspension to present arguments related to the potential conflict between the relevant application(s) or other arguments related to the ground for suspension. TMEP §716.03. Applicant's election not to present arguments during suspension will not affect the applicant's right to present arguments later should a refusal in fact issue. If a refusal does issue, applicant will be afforded 6 months from the mailing or e-mailing date of the Office action to submit a response. 15 U.S.C. §1062(b); 37 C.F.R. §2.62.

### **CONTINUATION OF DISCLAIMER REQUIREMENT**

Applicant must disclaim the descriptive wording "REMOTE" apart from the mark as shown because it merely a characteristic, feature, function, or use of applicant's goods. See 15 U.S.C. §1056(a); TMEP §§1213, 1213.03(a).

The Office can require an applicant to disclaim an unregistrable part of a mark consisting of particular wording, symbols, numbers, design elements or combinations thereof. 15 U.S.C. §1056(a). Under Trademark Act Section 2(e), the Office can refuse registration of an entire mark if the entire mark is merely descriptive, deceptively misdescriptive, or primarily geographically descriptive of the goods. 15 U.S.C. §1052(e). Thus, the Office may require an applicant to disclaim a portion of a mark that, when used in connection with the goods or services, is merely descriptive, deceptively misdescriptive, primarily geographically descriptive, or otherwise unregistrable (e.g., generic). See TMEP §§1213, 1213.03.

Failure to comply with a disclaimer requirement can result in a refusal to register the entire mark. TMEP §1213.01(b).

A "disclaimer" is a statement that applicant does not claim exclusive rights to an unregistrable component of a mark. TMEP §1213. A disclaimer does not affect the appearance of the applied-for mark. See TMEP §1213.10.

A disclaimer does not physically remove the disclaimed matter from the mark, but rather is a written

statement that applicant does not claim exclusive rights to the disclaimed wording and/or design separate and apart from the mark as shown in the drawing. TMEP §§1213, 1213.10.

Wording is merely descriptive under Section 2(e)(1) if it describes an ingredient, quality, characteristic, function, feature, purpose or use of the specified goods and/or services. TMEP §1209.01(b); *see In re Steelbuilding.com*, 415 F.3d 1293, 1297, 75 USPQ2d 1420, 1421 (Fed. Cir. 2005); *In re Gyulay*, 820 F.2d 1216, 1217-18, 3 USPQ2d 1009, 1010 (Fed. Cir. 1987). Moreover, a mark that identifies a group of users to whom an applicant directs its goods and/or services is also merely descriptive. TMEP §1209.03(i); *see In re Planalytics, Inc.*, 70 USPQ2d 1453, 1454 (TTAB 2004).

The word "REMOTE" is defined as "a remote control device." A "remote control" is defined as "a device used to control an apparatus or machine from a distance." See the attached definitions from the online version of the *American Heritage Dictionary*. See also the attached definitions from the *Merriam-Webster Online Dictionary*.

The applicant is providing "computer game controllers; electronic game controllers; video game controllers for video game machines." The term "remote" merely describes applicant's goods, which are devices used to control computer, video, and electronic games from a distance.

The computerized printing format for the Office's *Trademark Official Gazette* requires a standardized format for a disclaimer. TMEP §1213.08(a)(i). The following is the standard format used by the Office:

No claim is made to the exclusive right to use "REMOTE" apart from the mark as shown.

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

## **CONTINUATION OF REQUIREMENT FOR INFORMATION ABOUT GOODS**

To permit proper examination of the application, applicant must submit additional product information about the goods. *See* 37 C.F.R. §2.61(b); *In re DTI P'ship LLP*, 67 USPQ2d 1699, 1701-02 (TTAB 2003); TMEP §814. The requested product information should include fact sheets, instruction manuals, and/or advertisements. If these materials are unavailable, applicant should submit similar documentation for goods of the same type, explaining how its own product will differ. If the goods feature new technology and no competing goods are available, applicant must provide a detailed description of the goods.

The submitted factual information must make clear how the goods operate, their salient features, and their prospective customers and channels of trade. Conclusory statements regarding the goods will not satisfy this requirement.

Failure to respond to a request for information is an additional ground for refusing registration. *See In re DTI*, 67 USPQ2d at 1701-02. Merely stating that information about the goods is available on applicant's website is an inappropriate response to a request for additional information and is insufficient to make the relevant information of record. *See In re Planalytics, Inc.*, 70 USPQ2d 1453, 1457-58 (TTAB 2004).

/April A. Hesik/  
Examining Attorney

Law Office 113  
Phone: (571) 272-4735  
Fax: (571) 273-9113

**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.

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**NOTE:** Within any e-mail, please include your telephone number so we can talk to you directly, if necessary. Also, include the relevant serial number or registration number, if existing.