

To: Illinois Industrial Tool, Inc. (csheean@smbtrials.com)
Subject: TRADEMARK REGISTRATION NO. 3605472 - ILLINOIS INDUSTRIAL TOOL - 04514-0999
Sent: 04/26/19 08:00:29 PM
Sent As: PRG@uspto.gov
Attachments:

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

**U.S.
REGISTRATION
NO. 3605472**

77542361

**OWNER: Illinois
Industrial Tool, Inc.**

**CORRESPONDENT'S
ADDRESS:**

Christopher
T. Sheean
Swanson,
Martin &
Bell, LLP
330 N.
Wabash
Avenue
Suite 3300
CHICAGO,
IL 60611

**MARK: ILLINOIS INDUSTRIAL
TOOL**

**CORRESPONDENT'S
REFERENCE/DOCKET NO.
04514-0999**

**CORRESPONDENT'S EMAIL
ADDRESS:**
csheean@smbtrials.com

CLICK ON THE LINK BELOW TO RESPOND TO THIS LETTER AND SELECT FORM NUMBER 11:

http://www.uspto.gov/trademarks/teas/reg_maintain.jsp

POST REGISTRATION OFFICE ACTION

ISSUE/MAILING DATE: 4/26/2019
U.S. Registration Number 3605472

The Combined Section 8 Affidavit & Section 9 Renewal Application received on April 11, 2019, is otherwise acceptable; however, the owner of the registration must comply with an audit as explained below.

Registration Selected for Audit

The USPTO is performing random audits of US trademark registrations to assess and promote the accuracy and integrity of the trademark register. See 37 C.F.R. §§2.161(h), 7.37(h). This registration has been randomly selected for audit to determine whether the mark is in use with all of the goods identified in the registration.

Please note the audit applies only to International Classes 7, 8, 9, 17, and 22.

Detailed information regarding the audit program is provided on the following webpage – <https://www.uspto.gov/trademarks-maintaining-trademark-registration/post-registration-audit-program>.

To comply with the audit, you must submit proof of use of the registered mark for two additional goods per class. *Id.* **If proof of use for the goods identified is not available, the identified goods and any other goods not currently in use should be deleted from the registration.**

Therefore, the owner must submit the following:

(1) Proof of current use of the registered mark in commerce for the following goods:

“portable electric power generators” and “power-operated saws” in International Class 7;

“hand operated plumbing snakes” and “safety razors” in International Class 8;

“tape measures” and “welding helmets” in International Class 9;

“air hoses” and pipe joint tape” in International Class 17;

“shock cords not of metal” and “tarpaulins” in International Class 22; and

(2) The following statement, verified with an affidavit or signed declaration under 37 C.F.R. §2.20: “The owner was using the mark in commerce on or in connection with the goods identified in the registration for which use of the mark in commerce is claimed, as evidenced by the submitted proof of use, during the relevant period for filing the affidavit of use.” 37 C.F.R. §§2.161(h), 7.37(h).

Acceptable proof of use for goods includes photographs that show the mark on the actual goods or packaging, or photographs of displays associated with the actual goods at their point of sale. A tag or label that is not shown affixed to the goods is not acceptable proof of use. Similarly, a package that does not show or identify the goods therein is not acceptable proof of use.

Form Declaration

Please note that the below statement verifying proof of use is slightly different than the standard substitute specimen statement.

The following statement and declaration under 37 C.F.R. §2.20 can be used to verify the use of the mark as evidenced by the item(s) submitted as proof of use, if properly signed and dated:

The owner was using the mark in commerce on or in connection with the goods identified in the registration for which use of the mark in commerce is claimed, as evidenced by the submitted proof of use, during the relevant period for filing the affidavit of use.

The signatory being warned that willful false statements and the like 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 this submission, declares that the facts set forth above are true; all statements made of his/her own knowledge are true; and that all statements made on information and belief are believed to be true.

Signature of Authorized Person

Type or Print Name

Date

WARNING: If your response to this Office action does not meet the requirements of the audit, or includes a request to delete the goods identified for the audit, and goods remain in the registration without acceptable proof of use, a second Office action will issue requiring proof of

use for all remaining goods for which proof of use is not of record. *See* 37 C.F.R. §§2.161(h), 7.37(h). **Therefore, the owner should delete all goods for which proof of use cannot be provided.**

RESPONSE TIME DEADLINE: A complete response must be received within 6 months from the issuance date of this Office action. The owner must respond to all inquiries set forth in this Office action to avoid cancellation and/or expiration of the registration. *If a response is not received, the registration will cancel and/or expire in its entirety.* 37 C.F.R. §§2.163(b)-(c) and 2.184(b)(1); TMEP §§1604.16 and 1606.12.

Celia Abednego
/Celia C. Abednego/
Post Registration Division (on work project)
celia.abednego@uspto.gov (for inquiries only)
571-272-9492
571-273-9500 (fax)

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

CHECK THE STATUS OF THE REGISTRATION: To check the status of your registration at any time, visit the Office's Trademark Status and Document Retrieval (TSDR) system at <http://tsdr.uspto.gov/>. Please keep a copy of the TSDR status screen. For more information on checking status, see <http://www.uspto.gov/trademarks/process/status/>.

TO UPDATE CORRESPONDENCE/E-MAIL ADDRESS: Use the TEAS form at <http://www.uspto.gov/trademarks/teas/correspondence.jsp>.

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**IMPORTANT NOTICE
USPTO OFFICE ACTION HAS ISSUED ON 04/26/2019 FOR
REGISTRATION NO. 3605472**

Please follow the instructions below to continue the examination of your post registration filing:

VIEW OFFICE ACTION: Click on this link

<http://tsdr.uspto.gov/view.action?DDA=Y&sn=77542361&type=OOA&date=20190426>

(or copy and paste this URL into the address field of your browser), or visit <http://tsdr.uspto.gov/> and enter the registration 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.

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 tsdr@uspto.gov. Please contact the assigned examiner 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 may result in the cancellation and/or expiration of your registration.**