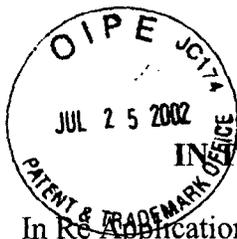


TTAB

Serial No. 74/599,060  
Atty Docket No.:000939.44379



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:

Atomic Energy of Canada Limited	)	Examining Attorney
U.S. Serial No.: 74/599060	)	Won T. Oh
Filing Date: November 14, 1994	)	Law Office 104
Mark: CHEMIC	)	



07-25-2002  
U.S. Patent & TMO/TM Mail Rcpt Dt. #26

REQUEST FOR RECONSIDERATION

Attn.: BOX RESPONSES – NO FEE

Assistant Commissioner for Trademarks  
2900 Crystal Drive  
Arlington, Virginia 22202

Dear Sir:

This responds to an Office action mailed on January 31, 2002.

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JUL 25 11:41 AM '02  
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OFFICE 104

REMARKS

Reconsideration of the above-mentioned office action dated January 31, 2002, is respectfully requested. The Examining Attorney has raised an issue with respect to the nature of the services for which the mark is used on the basis that the wording in the specimen of use submitted identifies a process.

It is well settled that a mark may be used to describe both a process and a service. See, e.g., *In re Universal Oil Products Co.*, 177 USPQ 456 (CCPA 1973) and *In re Hughes Aircraft Co.*, 222 USPQ 263 (TTAB 1984), as well as *In re Produits Chimiques Ugine Kuhlmann Societe Anonyme*, 190 USPQ 305 (TTAB 1976), *In re United Merchants & Mfrs., Inc.*, 124 USPQ 11

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(TTAB 1959) and *In re Stafford Printers, Inc.*, 153 USPQ 428 (TTAB 1967). The critical issue is whether the specimens show use of the mark as both a service mark and a mark for a process.

It is clear from the specimen submitted (another copy of which is attached as Attachment A) that the mark CHEMIC refers to the service of removing contaminants and remediation services performed for others by the Applicant AECL as well as the process. It reads "AECL's proven CHEMIC technology effectively removes a wide range of contaminants....The CHEMIC process permits treatment of waste solutions....CHEMIC technology is available for purchase or license. AECL also offers alternatives such as third party involvement for on-site set-up and operation." The specimen enclosed provides information on how the applicant can be contacted to order the service as well as it is an advertisement which refers to the service. All of this makes it clear that CHEMIC is a service mark for the service of performing Applicant's process i.e. the removal and treatment of contaminants and remediation services. Applicant respectfully submits that this dual use of the mark falls into the same category of acceptable usage of a mark as a service mark that the TTAB found persuasive in *Stafford Printing, supra* and *United Merchants, supra*.

In *Stafford*, the Board explained the process/service dichotomy as follows:

And what is a process? A process, inter alia, is a particular method or system of doing something, producing something or a system used in a manufacturing operation or other technical operation. . . . By its very meaning, 'process' can encompass a service. That the term 'process' is used on specimens does not ipso facto mean that an arbitrary mark used in conjunction therewith designates a process and not more. *Stafford, supra*, 153 USPQ at 429.

In *Stafford*, the issue was whether "Staffordblend" was registrable as a service mark for the printing of textiles, when the specimens (tags) submitted included the language "printed by STAFFORDBLEND process". The Board held that the applicant rendered the service of

printing textiles using the Staffordblend process; that Applicant was the only entity to perform this particular process of printing; and that based on that one specimen, Applicant had demonstrated service mark usage of the mark Staffordblend for those services. In *United Merchants, supra*, a similar conclusion was reached when the Board concluded that Fort Reputation functioned as both the name of a textile finish and as a service mark for the finishing of textiles.

The specimen Applicant has submitted makes it abundantly clear that Applicant is actually performing the services recited in the application, and that it does so under the service mark CHEMIC.

**NO CONFLICTING MARKS**

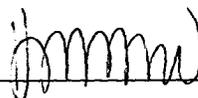
Applicant notes that the Examining Attorney has searched the office records and has found no prior registered or pending marks that would bar registration of Applicant's mark on the ground of likelihood of confusion. With the submission of this response, it is believed that all objections of the Examining Attorney have been resolved.

Publication is respectfully solicited.

Respectfully submitted,

**Atomic Energy of Canada Limited**

Date: July 24/2002

By: 

Holly M. Ford  
Banner & Witcoff, Ltd.  
1001 G Street NW  
Washington, DC 20001-4597  
Tel.: 202-508-9100  
Attorneys for Applicant

# **ATTACHMENT A**

# CHEMIC™

## Groundwater Remediation Technology

**A**ECL's proven CHEMIC™ technology effectively removes a wide range of contaminants, including low levels of radio-activity, heavy metals, and trace amounts of organics. Portable, simple to operate and control, CHEMIC technology can be applied to the remediation of contaminated groundwater or landfill leachates, to clean pond water, to recover dilute concentrations of metals and radionuclides, to process mixed waste streams, or to remove contaminants from soil leaching activities.

The CHEMIC process is based on chemical reaction or sorption of the contaminants to convert the contaminants from dissolved to filterable solids. Resulting effluent is clean, and can meet different discharge standards including the drinking water limit. The process minimizes the secondary waste volume produced.

To date, over 2.3 million US gallons of contaminated groundwater have been successfully treated with CHEMIC technology at a flow rate of up to 2.5 US gallons per minute.

### Wide-ranging Customer Benefits

- The CHEMIC process is suitable for continuous operation and demands less space than conventional systems. It reaches steady-state quickly and its modular construction provides the convenience of trailer-mounted portability.
- It can be readily adapted to a broad range of volume throughputs.



- It is simple to operate and control.
- It can process aqueous solutions to produce water suitable for discharge or reuse.
- The CHEMIC process permits treatment of waste solutions containing a variety of radioactive and hazardous species, and uses common, low-cost chemicals and other waste by-products for cost-effectiveness.
- Secondary waste is reduced to a very small volume (typically 1/1000<sup>th</sup> the volume of the original process feed).
- Secondary waste can also be solidified for disposal or further treated to extract valuable metals the client might wish to recover.



**AECL**  
Atomic Energy  
of Canada Limited

**EACL**  
Énergie atomique  
du Canada limitée