

09/09/2003 TTAB

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to Commissioner For Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3513, on

September 5, 2003
(Date of Deposit)



09-08-2003
U.S. Patent & TMO/TM Mail Rept Dt. #22

Eric W. Gallender
Name of applicant, assignee, or
Registered Representative

Eric W. Gallender
Signature

September 5, 2003
Date of Signature

Reference No. 10856/92

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In re Application of:)
)
Tyco Electronics Logistics A.G.)
)
Serial No.: **76/249,724**)
)
Mark: **ROUND CELL**)
)
Filing Date: **May 1, 2001**)

Trademark Attorney:
Barney L. Charlon

Law Office 105

09-08-2003
10856-9

MOTION TO SUSPEND APPEAL AND TO REMAND

To: Box TTAB—No Fee
Commissioner for Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3513

Pursuant to Sections 1205 and 1213 of the Trademark Trial and Appeal Board Manual of Procedure, Applicant hereby moves the Board to suspend the above-captioned appeal and to remand the file to the Examining Attorney so that Applicant may submit, and the Examiner may consider, additional evidence of acquired distinctiveness.

09/09/2003TTAB

In a first Office Action dated August 3, 2001, , the Examiner refused registration under Section 2(e)(1) of the Lanham Act, 15 U.S.C. 1052(e)(1), because he believed the mark was merely descriptive of the identified goods. On November 19, 2001, Applicant responded to the refusal, asserting that the mark had acquired distinctiveness under Section 2(f) of the Lanham Act, 15 U.S.C. 1052(f). In support of its Section 2(f) claim, Applicant enclosed the Declaration of Gregory V. Bass, Jr., attesting that since 1984: (1) the mark has been in use in commerce exclusively and continuously in connection with the identified goods; (2) Applicant has sold 800,000 units under the mark; and (3) Applicant has expended approximately between \$700,000 and \$800,000 on advertising and promoting the identified goods under the mark.

In a second Office Action dated May 24, 2002, the Examiner rejected Applicant's Section 2(f) claim, asserting that Applicant had not established acquired distinctiveness by clear and convincing evidence. On November 25, 2002, Applicant responded by, among other things, attaching declarations of actual customers of Applicant who testified that they recognize the mark as an indicator of source for Applicant's goods.

In a third Office Action dated January 7, 2003, the Examiner maintained and made final the Section 2(e)(1) descriptiveness refusal. This appeal followed.

Shortly after the Examiner issued the third Action, counsel for Applicant contacted the Examiner to determine what additional evidence was necessary to overcome the Section 2(e)(1) refusal and to establish acquired distinctiveness. The Examiner stated that affidavits or declarations from Applicant's competitors testifying

09/09/2003TTAB

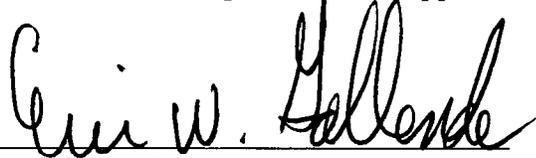
that the mark signifies goods originating with Applicant would be most persuasive. Accordingly, enclosed herewith for the Examiner's consideration is the Declaration of Charles K. McManus, an Executive Vice President at Enersys Inc., one of Applicant's competitors. In the enclosed Declaration, Mr. McManus testifies that when he encounters the mark in connection with the identified goods, he immediately recognizes Applicant to be the source of such products.

Based on the foregoing, Applicant respectfully requests that the Board suspend the appeal and remand the application to the Examining Attorney for further prosecution consistent herewith. Applicant also requests that the Board forward the enclosed Declaration to the Examiner for his review.

Respectfully submitted,

Tyco Electronics Logistics A.G., Applicant

Dated: September 5, 2003

By: 

Eric W. Gallender
Brinks, Hofer, Gilson & Lione
P.O. Box 10395
Chicago, Illinois 60610
Telephone: (312) 321-4200
Facsimile: (312) 321-4299

Attorneys for Applicant

09/09/2003TTAB

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to Commissioner For Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3513, on

September 5, 2003
(Date of Deposit)

Eric W. Gallender

Name of applicant, assignee, or Registered Representative

Eric W. Gallender

Signature

September 5, 2003
Date of Signature

TRADEMARK
Reference No. 10856/92

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)	
)	
Tyco Electronics Logistics A.G.)	Barney Charlton
)	Examining Attorney
Serial No.: 76/249,724)	
)	
Mark: ROUND CELL)	Law Office 105

DECLARATION OF CHARLES K. MCMANUS

Charles K. McManus declares and states as follows:

1. I am 56 years of age and reside in Chester County, Pennsylvania.

Unless otherwise noted, I have personal knowledge of all facts set forth in this declaration. If called upon as a witness, I could competently testify as to the following.

2. I am currently employed as Executive Vice President, Reserve Power - Americas and Global Marketing of Enersys Inc. located at 2366 Bernville Road,

Reading, Pennsylvania, 19605. I have been so employed for approximately the last six years. As Executive Vice President of Reserve Power, my duties and responsibilities include the following: supervising all marketing, sales and general management functions involved in connection with the operation of the Reserve Power business unit of Enersys Inc.

3. Enersys Inc. manufactures and markets, among other things, premium flooded lead-acid telecommunications batteries. Enersys Inc.'s batteries are sold to telecommunications companies, electric utilities, and manufacturers of uninterruptible power supplies ("UPS") and general industrial applications.

4. I am very familiar with Applicant's ROUND CELL premium flooded lead-acid telecommunications batteries. Specifically, Applicant's ROUND CELL premium flooded lead-acid telecommunications batteries have directly competed with products manufactured by companies that I have worked with since the 1970s.

5. In fact, Applicant's ROUND CELL telecommunications batteries are highly similar to and directly competitive with the telecommunications batteries manufactured and marketed by Enersys Inc.

6. When I encounter the wording ROUND CELL used in connection with telecommunications batteries, I immediately recognize Applicant to be the source of such products.

The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any registration resulting therefrom,

09/09/2003TTAB

declares that all statements made herein of his/her own knowledge are true and that all statements made on information and belief are believed to be true.

Dated: August 11, 2003

By: 

Name: Charles K. McManus
Title: Executive Vice President Reserve
Power – Americas and Global Marketing
of Enersys Inc.

TTAB

BRINKS
HOFER
GILSON
& LIONE

A PROFESSIONAL CORPORATION
INTELLECTUAL PROPERTY ATTORNEYS

NBC TOWER · SUITE 3600
455 N. CITYFRONT PLAZA DRIVE
CHICAGO, ILLINOIS 60611-5599
brinkshofer.com
FAX 312-321-4299
TELEPHONE 312-321-4200

SAN JOSE, CA
INDIANAPOLIS, IN
ANN ARBOR, MI
ARLINGTON, VA

09/09/2003 TTAB

Eric W. Gallender
(312) 321-4247
egallender@brinkshofer.com

September 5, 2003

BOX TTAB - NO FEE
Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

Re: Applicant: Tyco Electronics Logistics A.G.
Mark: ROUND CELL
Serial No.: 76/249,724
Filing Date: May 1, 2001
Our Reference No.: 10856/92



09-08-2003

U.S. Patent & TMOc/TM Mail Rcpt Dt. #22

Dear Sirs:

Enclosed for filing is a Motion to Suspend Appeal and to Remand for the above-identified application.

The Commissioner is hereby authorized to charge any fees which may be required, or credit any overpayment, to Deposit Account No. 23-1925. A duplicate copy of this letter is attached.

Very truly yours,

Eric W. Gallender

EWG/rr
Enclosure