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

Proceeding	76293326
Applicant	Prema Jyothi Light
Applied for Mark	SHIMMERING BALLERINAS & DANCERS
Correspondence Address	PREMA JYOTHI LIGHT 12000 E 16TH AVE #301 AURORA, CO 80010 UNITED STATES gloriously@india.com, gloriously@in.com, premajyothilight@shimmeringly.com
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Filer's Name	PREMA JYOTHI LIGHT
Filer's e-mail	gloriously@india.com, premajyothilight@shimmeringly.com, premajyothilight@love4truth.com
Signature	/ prema jyothi light /
Date	10/08/2013

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

NAME OF APPLICANT: Prema Jyothi Light

NAME OF TRADEMARK: SHIMMERING BALLERINAS & DANCERS

SERIAL NUMBER: 76293326

FILING DATE OF APPLICATION: First filed July 9, 2001
Later refiled July 31, 2001

DATE OF FINAL OFFICE ACTION: June 15, 2009

DATE OF THIS REQUEST FOR RECONSIDERATION: December 15, 2009

EXAMINING ATTORNEY: Paul F. Gast, Law Office 106

REQUEST FOR RECONSIDERATION

The following information is for entry into the TEAS form for Arguments in support of this REQUEST FOR RECONSIDERATION.

1. Introduction.

In accord with TMEP §§ 714.05 and 715.03, Applicant is hereby filing this timely REQUEST FOR RECONSIDERATION after Final Action dated June 15, 2009 with regard to her Trademark, SHIMMERING BALLERINAS & DANCERS.

2. Notice of Appeal Concurrently Being Filed with the TTAB.

Applicant is also concurrently filing a timely NOTICE OF APPEAL with the TTAB, with the required fee, in accordance with 15 USC §1062, but is requesting that the TTAB wait until after the Examining Attorney has had a chance to respond to this REQUEST FOR RECONSIDERATION, and until after Applicant has had a chance to respond to his response, in accord with TMEP § 715.04(b), before proceeding with the Appeal.

Applicant is filing the NOTICE OF APPEAL to preserve the right of filing an Appeal, by timely compliance with the time deadlines set forth in U.S.C. §1062(b); 37 C.F.R. §2.62.

3. First New Issue.

This REQUEST FOR RECONSIDERATION includes an amendment that presents a new issue, namely, a claim of acquired distinctiveness under 15 U.S.C. §1052(f).

In support whereof, Applicants states that this Mark has functioned as a Trademark, and has been in substantially exclusive and continuous use thereof as a Trademark by the Applicant in commerce for over five years before the present date, upon which this claim of distinctiveness, in the alternative, under 15 U.S.C. §1052(f), is hereby made.

In support of this new claim, new evidence as samples are being submitted, showing this very distinctive Mark in use before 2004.

The new evidence being submitted shows its visual distinctiveness, and claim is hereby made as to its acquired distinctiveness in the alternative, under 15 U.S.C. §1052(f).

This claim of acquired distinctiveness under 15 U.S.C. §1052(f) is made in the alternative, in accordance with TMEP §1212.02(c). Under this section, claiming acquired distinctiveness in the alternative, the alternative claim does not constitute a concession that the matter sought to be registered is not inherently distinctive.

This claim under 15 U.S.C. §1052(f) is also asserted in accordance with TMEP § 1212.02(h).

4. Second New Issue.

As a second issue, Applicant believes that the Final Action was premature, as delineated in TMEP § 714.06, and requests correction of this. In her RESPONSE TO OFFICE ACTION, she requested clarification on the issue regarding resubmission of the Mark in Standard Characters Format. She was extended an offer by the Examining Attorney, in his previous OFFICE ACTION, to resubmit the Mark in Standard Characters Format, albeit in an abbreviated form, and she therefore hoped that she could also offer resubmission of the entire Mark in Standard Characters Format.

As she stated in her RESPONSE TO OFFICE ACTION, she was requesting clarification on this so that she could submit the best possible specimens in support of her position that her Trademark does, in fact, function as a Trademark. Of course, she should be allowed to submit new specimens for this! But as she is a prolific writer and artist, with many creative works, she wanted to submit the most relevant and good examples.

Yet the Examining Attorney must have misunderstood her, and issued a Final Action without first clarifying the issue of resubmission in Standard Characters Format, and without thereby allowing her the opportunity to submit the relevant specimens which, as she stated, she thought were needed to show that her Trademark does, in fact function as a Trademark.

In all fairness, Applicant should have been permitted to submit further evidence of samples showing that the Mark does in fact serve as a Trademark. This was at issue and she specifically requested this.

As stated in TMEP § 714.05(a), “Generally, an amendment that is unacceptable raises a new issue requiring a nonfinal action, unless the amendment is a direct response to a previous requirement.”

The new issue was resubmission of the Mark in Standard Characters Format, not just in an abbreviated form, but for the entire Mark. The offered new drawing, or resubmission in Standard Characters Format, was “significantly different from material previously submitted”, within the meaning of TMEP § 714.05, and related to the Examining Attorney’s offer to allow Applicant to resubmit her Mark in Standard Characters Format, in an abbreviated form.

Therefore, a nonfinal Office Action should have been issued in response.

However, this is correctible. The same specimens which Applicant is submitting in support of her present claim of acquired distinctiveness, simultaneously demonstrate that her Trademark does, in fact, function as a Trademark. This should be clear upon review of the specimens.

5. New Specimens and New Clearer Drawings Are Being Submitted Separately.

Therefore, new specimens are being submitted in support of this REQUEST FOR RECONSIDERATION, and should be honestly and sincerely reviewed by the Examining Attorney, not only as evidence of acquired distinctiveness, but also as evidence that this Trademark does, in fact, function as a Trademark, as it does identify the source of Applicant’s goods to the public.

Applicant will also submit new clearer Drawings of the Mark, along with the specimens.

It was not Applicant’s fault that the PTO bureaucracy lost or misplaced the specimens which she sent earlier and which were entrusted into the care of the PTO, but which somehow were not properly conveyed to the Examining Attorney.

To prevent this from happening again, Applicant will be submitting the new specimens and drawings via TEAS online. She has to submit these separately due to technical difficulties with TEAS. Fortunately, she was told by a PTO supervisor by phone that as long as she timely submitted her REQUEST FOR RECONSIDERATION, and her timely NOTICE OF APPEAL to the TTAB with the required fee, the new specimens and drawings could follow a few days later.

She had to reply “No” in the spaces provided in the TEAS forms online, to whether she was attaching the new specimens and drawings, in order to be allowed to continue in the forms online. However, both new specimens and drawings are promptly forthcoming.

Applicant will notify the Examining Attorney as soon as she receives successful confirmation of receipt of her specimens and drawings via TEAS, so that he can look out for them. She may have to send them in more than one installment to be sure they all go through properly.

This evidence may be deemed “significantly different” from the samples earlier submitted, within the meaning of TMEP § 715.03, and therefore worthy of additional and new consideration.

The samples that are being submitted in support of acquired distinctiveness of the Mark, also simultaneously serve as evidence that the Mark is effectively in use as a Trademark. Applicant asks that the Examining Attorney withhold judgment on both of these issues until he has had a chance to review the new specimens.

5. Conclusions.

In conclusion, this Trademark has acquired distinctiveness, and does function as a Trademark. It may be larger than the usual trademark, and have more elements than the usual trademark, but it is, conclusively, and in its entirety, a Trademark. This should be clear from review of the new specimens.

In all honesty, this Trademark does function well as an identifying Trademark, and this Trademark needs to be registered.

A REQUEST FOR RECONSIDERATION is also being concurrently filed for the sister Trademark, SHIMMERING RAINFOREST. A NOTICE OF APPEAL is also being concurrently and timely filed, along with the required fee, for this sister Trademark, with the TTAB.

The Examining Attorney should not lightly dismiss Trademarks which have been in use for many years, and these applications for registration which have been in progress for so many years. The desire to brush aside Trademarks which have been pending for registration for so long, possibly due to annoyance, should not be greater than an allegiance to honesty and fairness in business, in creative work, and in accord with the shining high ideals of truth, justice, and protection of the innocent from the unscrupulous. Trademark protection can and should serve this purpose, here in the United States of America. God bless the USA!

Respectfully submitted,

/ Prema Jyothi Light /

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