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BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	76293326
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Applied for Mark	SHIMMERING BALLERINAS & DANCERS
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**In The United States Patent & Trademark Office
For Before the Trademark Trial & Appeal Board**

NAME OF APPLICANT: Prema Jyothi Light
NAME OF TRADEMARK: **SHIMMERING BALLERINAS & DANCERS**
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EXAMINING ATTORNEY: Linda Lavache, Esq., Law Office 106

APPLICANT’S REPLY BRIEF

I. Introduction.

This REPLY BRIEF for SHIMMERING BALLERINAS & DANCERS is in response to Examining Attorney Lavache’s CONSOLIDATED APPEAL BRIEF, filed August 05, 2013. A separate REPLY BRIEF is being concurrently filed for SHIMMERING RAINFOREST, with some differences.

II. Procedural Issues.

A. Examining Attorney Lavache issued a Final Office Action on 03-09-13, when she should have issued a Non-final Office Action. Examining Attorney Lavache expresses the view, on page 3 of her Reply Brief, that Applicant Light’s submission of “proposed amended drawings, specimens and other evidence” as Exhibits to the Appeal Brief was untimely. She “objects to the introduction of those Exhibits to the Appeal Brief that were not previously made part of the application record prior to resumption of the appeal proceeding on April 5, 2013”, because “The record in an application should be complete prior to the filing of an appeal.”

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However, this presumes that proper due procedure has been followed PRIOR to the filing of the Appeal, which is not so in this case. This has been a serious failure to follow due procedure prior to the filing of the Appeal, which needs to be hereby corrected.

Applicant Light was denied the opportunity to file a response to the Examining Attorney's objections to the New Issues in Applicant's RESPONSE TO OFFICE ACTION, dated 01-28-13, because the Examining Attorney mistakenly filed a FINAL OFFICE ACTION on 03-09-13, when she was required by TMEP §714.05(a), and TMEP § 807.17, to issue a Non-Final Office Action in response to New Issues. This is well-established due procedure, which gives the Applicant an opportunity to respond to the Examining Attorney's objections, and the Examining Attorney an opportunity to review these responses, and respond again, before the Appeal. To fail to follow this well-established due procedure was procedurally incorrect, and needs to be corrected.

At least three New Issues were at issue, requiring the issuance of a Non-Final Office Action.

- 1) Applicant's request, in her RESPONSE TO OFFICE ACTION dated 01-28-13, for registration of the Trademark in color, with the Trademark deemed inherently distinctive, or in conjunction with a claim for Acquired Distinctiveness, under U.S.C. §1052(f);
- 2) Applicant's request for Corrections of Typographical Errors in the Trademarks, and the Examining Attorney's objections to these, which she deems to be material alterations of the Trademark; and
- 3) The set of New Issues regarding Design Codes: whether new Design Codes were needed, for the color versions of the Trademarks, which leads to the issue of whether correct Design Codes were ever assigned for these Trademarks, by Examining Attorneys, in the first place. If incorrect or incomplete Design Codes had been assigned to these Trademarks earlier, by Examining Attorneys, then new Design Codes would need to be assigned, anyway. This set of New Issues was brought up and catalyzed, by Examining Attorney Lavache herself, in her FINAL OFFICE ACTION dated

03-09-13. But she shouldn't be introducing a New Issue like that in a Final Office Action, without giving the Applicant an opportunity to respond.

Applicant Light should have been given a chance to respond to all of these New Issues, before the resumption of the Appeal. Then the Record could be complete, before the resumption of the Appeal.

1. The New Issue of Registration of the Trademark in Color.

The request for registration of the Trademark in color is a valid and separate New Issue, not previously raised, and deserving of a Non-Final Office Action from the Examining Attorney. This had not been requested or proposed before. It is not something that can just be brushed over, as being similar to any other amendment previously proposed. Please note that all previous proposed amendments to the Drawing had been dropped, and were not at issue, before the Examining Attorney's Final Office Action.

Under federal law, 37 C.F.R. § 2.52 (b)(1) permits registration of a Trademark in colors, treats this as a separate and distinct Issue, and allows the applicants to "submit a claim that the color(s) is a feature of the mark."

The new color Drawing for this Trademark is clearly the same Trademark, but registration of the Trademark in color was a separate New Issue, and a time-honored category of request, under federal law.

Further, TMEP § 807.14(e)(i) Black-and-White Drawings, states:

"The amendment of a black-and-white special form drawing to one claiming a color(s) as a feature of the mark generally **does not constitute a material alteration.** (*Emphasis added.*) If a mark is initially depicted in a black-and-white special form drawing in which no color is claimed, the drawing is presumed to contemplate the use of the mark in any color, **without limitation.**" (*Emphasis added.*)

If the Examining Attorney wanted to newly claim that depicting the Trademark in color was a material alteration of the Trademark, then this was clearly a New Issue deserving of a Non-Final Office Action, giving the Applicant an opportunity to respond to her new objections, BEFORE the Appeal.

The New Issue of whether the Trademarks should be registered in their Color versions was enough of a New Issue to be specifically addressed at some length by the Examining Attorney in her APPEAL

BRIEF dated 08-05-13. Therefore, it was enough of a New Issue to require a Non-Final Office Action from the Examining Attorney, to allow the Applicant the opportunity to respond to her specific objections, before the resumption of the Appeal.

In her Final Office Action dated 03-09-13, on page 4, Ms. Lavache stated, “finally, applicant is advised that the proposed amended drawing submitted on January 28, 2013 does not create a new issue because the acceptability of proposed amendments to the drawing was already at issue.” THIS IS TOTALLY NOT TRUE. No other amendments to the Drawing were at issue at the time of this Final Office Action. All other amendments to the Drawing had been dropped by the Applicant. There were NO OUTSTANDING AMENDMENTS TO THE DRAWING AT ISSUE, AT THAT TIME, EXCEPT FOR THE NEW ISSUES. The acceptability of earlier amendments to the Drawing was no longer at issue, at all. She wasted her time arguing matters that had already been settled.

2. **The New Issue of Requested Corrections of Typographical Errors in the Trademark, some of which were made by the USPTO in its Online Records.**

The requested Corrections of Typographical Errors were also a New Issue, not previously raised, but important enough to be addressed by eighteen (18) pages of Applicant’s RESPONSE TO OFFICE ACTION dated 01-28-13. It was clearly a separate issue, and not an Issue previously raised before. Applicant Light was entitled, by provisions of the TMEP cited hereinabove, to an opportunity to respond to Examining Attorney Lavache’s newly-raised objections to these newly requested Corrections. In her Final Office Action, Ms. Lavache deemed these corrections to be material alterations of the Mark, and Applicant was never given an opportunity to respond to these new objections.

Failure to issue a Non-Final Office Action abrogated the Applicant’s right to respond.

If the Issue of whether the requested typographical corrections is enough of a separate New Issue to be specifically addressed in the Examining Attorney’s REPLY BRIEF dated 08-05-13, then it is enough of a New Issue to require a Non-Final Office Action, to allow Applicant to respond.

3. **The New Issue of Design Codes.**

Examining Attorney Lavache states on page 4 of her BRIEF that “In her appeal brief, applicant asserts, for the first time, that the design code assigned to her applications is incorrect.”

However, the issue of Design Codes was newly introduced by Ms. Lavache in her FINAL OFFICE ACTION, dated 03-09-13, on page 4. If Ms. Lavache had filed a proper Non-Final Office Action, Applicant Light would have had the opportunity to respond to Ms. Lavache’s new allegations regarding Design Codes. This was a New Issue raised by the Examining Attorney herself.

Therefore, Applicant Light had no alternative but to respond to this New Issue in her APPEAL BRIEF, because her right to respond earlier was abrogated by the mistaken issuance of a Final, rather than Non-Final, Office Action.

As things now stand, it is obvious that incorrect or incomplete Design Codes have been assigned to Applicant’s Trademarks. The fact that there is a light rectangular line around the entire Trademark is not the only design feature of the Trademark. If it were, it would make no difference what was INSIDE of the rectangle. Applicant Light has long referred to the present design as a “flag design”, simply because it resembles a flag! But, this refers to what is INSIDE the rectangle. If the Trademark were an EMPTY rectangle, then fine, call it a rectangle. But no one wants to register an EMPTY rectangle!

Applicant Light is a graphic designer, and her Trademarks have been well-designed. She did not just throw a few words into a rectangle. These are Special Form Drawings, not Standard Character drawings. And she is seeking registration of the color versions of her Trademarks, which are clearly the same Trademarks as the black-and-white versions, but in color.

B. **It is one responsibility of TTAB Judges to correct Examining Attorneys when they make major procedural mistakes.**

It is one responsibility of the TTAB Judges, to set Examining Attorneys straight when they make mistakes like these. If they do not do so, then the Examining Attorneys will continue to make these

mistakes with other Applicants, in other cases, with needless difficulties for all concerned, and with all of the resulting bad ripple effects.

The Examining Attorney's mistake in issuing the wrong kind of Office Action is causing ripple effect difficulties in the present case, which has prematurely come under review by the TTAB.

These difficulties could best be resolved by remanding the case to the Examining Attorney for issuance of a proper Non-Final Office Action, which allows the Applicant the opportunity to respond to the Examining Attorney's new objections to these three New Issues.

This would also help the Examining Attorney become more alert to the differences between Non-Final and Final Office Actions, which would benefit her, as well as other applicants, in other cases, and help assure that the cases which come under review by the TTAB are fully ready for that review.

C. **If the Board wishes to stand upon due procedure, then the Board should also observe due procedure.**

Any valid, proposed amendments to a Drawing constitute New Issues, as specifically provided for by TMEP §714.05(a), which specifically requires a Non-Final Office Action with a six-month response clause for this. TMEP §714.05(a) states:

“The following are examples of amendments that would **require** (*emphasis added*) a new nonfinal action: (1) Amendments to the drawing, unless the examining attorney had previously required that the drawing be amended or the amendment is acceptable and does not raise other issues.”

Examining Attorney Lavache tries to get out of this requirement by stating, on page 4 of her BRIEF:

“In this case, the examining attorney had previously raised issues regarding other drawing amendments proposed by applicant and required applicant to adopt a mark drawing that is not a material alteration of the original mark drawing. Therefore, applicant's most recent unacceptable proposed amendment to the mark drawing does not raise a new issue because the amendment of the mark drawing was already at issue.”

THIS IS TOTALLY NOT TRUE. No other Drawing amendments were at issue, at that time.

The other proposed amendments to the Drawing were completely different, proposed many years ago, and dropped. The proposed radial version of the Trademark was submitted on 03-06-02 (eleven

years ago), and dropped in Applicant's RESPONSE TO OFFICE ACTION, dated 01-28-13, on page 3.

The standard character version of the Trademark was first submitted on 12-16-08, in response to what she thought was an offer by Examining Attorney Gast to agree to register her Trademark in standard character form. When he disagreed, she dropped it. And that was five years ago. There were no other outstanding Drawing amendments on the table.

As Applicant clearly stated on page 3 of her RESPONSE TO OFFICE ACTION, dated 01-28-13: "Applicant is willing to accept registration of her Trademark in the flag design version of the Trademark."

Also, Examining Attorney Lavache had not previously required that the Drawing be amended. She never made a specific demand in this regard. She never "required applicant to adopt a mark drawing that is not a material alteration of the original mark drawing." This is a mistaken statement on page 4 of the Examining Attorney's BRIEF dated 03-09-13.

However, Examining Attorney Lavache correctly states, on page 4 of her BRIEF, "An unacceptable amendment to the drawing necessitates a new nonfinal Office action 'unless the examining attorney had previously required that the drawing be amended.'" But, she never "required that the drawing be amended." So, according to the rule which she herself cited, she should have issued a new, Non-Final Office Action.

The proposed new amendments to the Drawing were completely New Issues, at a time when no other proposed amendments to the Drawing were on the Table.

The other, formerly proposed amendments to the Drawing were completely different requests.

Any new proposed amendment to a Drawing must be considered on its own merits. Amendments to a Drawing cannot be all lumped together, like lumpy malto-meal breakfast cereal, especially if they are separated by long distances of time, such as decades. Proposed eleven years ago? Proposed five years ago? And both dropped.

It is worthy of note that “Notes to the File”, such as those posted in the Record by Examining Attorney Lavache on 04-27-12 and 04-28-12, are not Office Actions, or responses to, or communications to, an Applicant. In her “Note to the File” dated 04-28-12, Examining Attorney Lavache checked off a line called “Other”, with the comment, “Examining attorney processed applicant’s 04-25-2012 communication.” However, she never responded directly to Applicant Light, in response to Applicant’s filing titled, “NOTICE OF ERRORS IN U.S.P.T.O. ONLINE RECORDS FOR TRADEMARKS & REQUEST FOR CORRECTIONS,” dated 04-25-12.

Ms. Light’s concerns were never addressed or responded to by any communication from the Examining Attorney to the Applicant. And, Applicant’s requested Corrections to the Record were never made. Applicant never even noticed the “Notes to the File” in the online Records until months later, and she did not feel her concerns had been responded to, at all. To fail to directly respond to Applicant’s formally-filed pleading titled, “NOTICE OF ERRORS IN U.S.P.T.O. ONLINE RECORDS FOR TRADEMARKS & REQUEST FOR CORRECTIONS” was a mistake on the part of the Examining Attorney. “Notes to the File” are not a response to an Applicant, and not a request to the Applicant to do anything. (TTAB Judges are asked to please review these three short documents.)

Further, TMEP § 807.17, states:

If an applicant submits an amendment to the drawing and the examining attorney determines that the amendment is unacceptable, the examining attorney must issue an action refusing to accept the amendment and advising the applicant that the amendment will not be entered, and that the previous drawing remains the operative drawing. ... The applicant must respond to the Office action to avoid abandonment. If the applicant submits arguments in support of acceptance of the amendment and the examining attorney determines that the amendment is still unacceptable, the examining attorney must issue a final refusal of the amendment, if the application is otherwise in condition for final action.

The radial version of the Trademark had already been rejected by Examining Attorney Paul Gast, years ago.

The above citation from TMEP § 807.17 also clearly spells out the proper procedure for handling new amendments to a Drawing, which involves issuing a Non-Final Office Action to which the Applicant is entitled to respond. Then, if the Examining Attorney is still of the opinion that the amendment is unacceptable, a Final Action may issue. This is the proper due procedure.

Properly remanding the case back to the Examining Attorney for a Non-Final Office Action, in response to all of these New Issues, would solve these Procedural Problems, and would bring this case into accord with the clear and time-honored provisions of the TMEP.

D. In contradistinction, disregard for clear provisions of the TMEP, by the TTAB, would be noticed with concern by Court of Appeals Federal Circuit Judges, who would be later reviewing this case.

The impatience of the TTAB to get on with this case should not cause it to ignore or disregard clear and time-honored provisions of the TMEP. This would not be a good precedent to set for other cases either. All TTAB decisions are reviewed by thousands of people in the legal community across the USA, and a brush-aside of proper legal procedures could adversely affect the reputations of and scorecards for individual TTAB Judges.

As it is, failure to follow proper due procedure could be seen as a mistake by an Examining Attorney. However, failure to remand would be seen as a larger mistake by the TTAB Judges.

TMEP § 714.03 also states:

“Final action is appropriate when a clear issue has been developed between the examining attorney and the applicant, i.e., the examining attorney has previously raised all outstanding issues and the applicant has had an opportunity to respond to them.”

Ideally, the Board should remand the case back to the Examining Attorney, requiring her to issue a Non-Final Office Action in response to the New Issues, as is required by the hereinabove provisions of the TMEP. After the Applicant has the opportunity to properly respond to the Examining Attorney’s

objections, then a Final Office Action can be issued by the Examining Attorney; and then the Appeal could properly be resumed.

If the TTAB insists on disregarding the hereinabove-quoted provisions of the TMEP, and denying the Applicant the opportunity respond to the Examining Attorney's objections to three New Issues, BEFORE the resumption of the Appeal, at least the Board should be willing to review the evidence and EXHIBITS submitted AFTER the resumption of the Appeal.

At issue here is whether the clear provisions of federal law, as expressed in TMEP § 714.03, TMEP §714.03(a). and TMEP § 807.17, should be observed by the TTAB, or arbitrarily disregarded. Applicant respectfully and sincerely requests that these be observed.

III. Examining Attorney and Applicant Do Not Agree on Issues To Be Decided Upon Appeal.

In her APPEAL BRIEF, Applicant Light set forth eighteen (18) Issues on Appeal. On page 6 of her BRIEF, the Examining Attorney lists only two. They are only in agreement on one. So, there are now a total of nineteen (19) Issues before the TTAB for decision on Appeal.

However, if the TTAB remands the case back to the Examining Attorney, to set straight the hereinabove-described Procedural Error, of the issuance of a Final Office Action when a Non-Final Office Action was called for by the TMEP, then this is the only Issue before the Board at this time.

On page 6 of her BRIEF, Examining Attorney delineated her version of "ISSUES TO BE DECIDED ON APPEAL." She includes "whether applicant's mark, as used on the specimens of record, functions as a trademark". However, Applicant Lights Specimens of Record include all of the EXHIBITS to her APPEAL BRIEF. This is because the Examining Attorney improperly issued a Final Office Action when she should have issued a Non-Final Office Action, thus wrongly abrogating Applicant's right to respond to her objections by placing these Specimens on the Record earlier.

So this Issue cannot properly be decided until this Procedural Error is set straight.

But, if the TTAB wishes to disregard due process under the TMEP in this matter, at least it should also be willing to disregard the TMEP section which requires the Record to be complete prior to Appeal. While this would result in a faster TTAB ruling, it would result in a much more challengeable TTAB ruling, in the Court of Appeals, Federal Circuit, where this case would land next, and set a bad precedent for future TTAB cases also.

The second Issue to be decided on Appeal, according to Ms. Lavache, is whether “whether several proposed amendments to the original mark drawing constitute material alterations of the original applied-for mark.” However, this set of Issues would be in a much higher state of resolution if Applicant were able to respond to Ms. Lavache’s objections in a Response to a Non-Final Office Action, as some disagreements, such as some typographical corrections, could possibly even be resolved with phone calls between the Examining Attorney and Applicant, instead of taking up valuable TTAB time.

**IV. Applicant’s Trademarks Function Beautifully as Trademarks
to Identify the Source of Applicant’s Goods.**

On page 6 of her BRIEF, Examining Attorney Lavache claims that “The Applied-For Marks Fail to Function as Trademarks to Identify the Source of Applicant’s Goods”. Applicant disagrees.

1. The fact that Applicant’s Trademarks DO function as Trademarks is *res ipsa loquitur*, or “the thing speaks for itself”. Contrary to the Examining Attorney’s allegations on page 11, sales figures are not necessary to show that the public perceive them as Trademarks. Such “extrinsic evidence” is not required by law. It does not matter if the sales are large or small, or how many people buy the books or leaflets, but whether the Trademarks are recognizable and distinctive. They are! You can tell this simply by looking at them.

Just look at the Trademarks, color-splashed and bright with stars and stripes. You would recognize them if you saw them again. It is completely, and obviously, *res ipsa loquitur*.

2. The entire Trademark is bounded by a black box, with a unique design INSIDE THE RECTANGLE and an overall distinctive commercial impression. And, on the Specimens themselves, and the whole Trademark is referred to, in the paragraph below the Trademark, as the Trademark.

Not only do consumers view the whole Trademark as a Trademark, -- there is no way that consumers can avoid seeing the whole Trademark as a Trademark!

And, as the paragraph below the Trademark on the back pages of the leaflets clearly spells out, the Trademarks do clearly serve as a Source Indicator for Applicant's goods. The back page of every Specimen submitted in support of the RESPONSE TO OFFICE ACTION dated 01-28-13 (4-page leaflets featuring Zahralina and The Vanavasitos), as well as every Specimen submitted as an EXHIBIT to Applicant's APPEAL BRIEF, contains the distinctive and recognizable color Trademark, with the following paragraph below the Trademark:

“Be sure to look for this unique Shimmering Rainforest Trademark, above,
to assure you that you have publications & products with the genuine, original
Shimmering Rainforest Characters,
rather than knock-offs or plagiarized versions of them!
This beautiful family of characters appears in leaflets, booklets, books and a wide variety
of popular publications, to delight you, entertain you, inform you, and inspire you!
We are happy to have the privilege of serving you!
May God bless you and peace be with you!
Om Shanthi, Om Peace!
-- Prema Jyothi Light”

This Trademark clearly identifies the Source of Applicant's Goods. This is inescapably, crystal clear. The whole Trademark does function as a Trademark, to identify the Source of Applicant's Goods.

3. Since Examining Attorney Lavache is determined to assert that the proper Design Code for this

Trademark is just the overall rectangular box, then the Trademark is fairly perceived as everything inside this box. Therefore it is pointless to argue that the public would not regard the whole Trademark as the Trademark. Even Ms. Lavache regards everything in the box as the Trademark, or she would not be determined to describe it as the whole rectangle. The Trademark is not just the larger calligraphy within the box. The Trademark is the box, and everything in it.

4. On page 7 of her BRIEF, Examining Attorney Lavache states, “The Number of Literal Elements Contained Within the Applied-For Marks Suggests That They Would Not Be Perceived as Trademarks”.

Applicant disagrees. There is no limit on the number of words allowed in a Trademark, as this varies according to the Trademark. The number of words you take to say something, depends on what you have to say. “I love you, darling, will you marry me?” takes eight words, but “I love you, darling, but will you sign this prenuptial agreement so I can gyp you if we break up later?” takes twenty-one (21) words. If you want to convey the second sentiment, it may take a few more words!

5. Ms. Lavache herself correctly states, on page 7 of her BRIEF, “there is no absolute requirement that the mark be a certain length.” This is perfectly true.

6. Ms. Lavache’s opinion that fewer words make better Trademarks is simply an opinion, or a matter of preference on her part. Her quotation from McCarthy on Trademarks is also just Mr. McCarthy’s opinion, not federal law.

7. Applicant’s Trademarks are not just words, they are also distinctive designs. They are a combination of words in a distinctive flag design.

8. Applicant’s entire Trademarks are easily perceived as Trademarks, in their entirety. If you look at EXHIBITS A, B, C & D to APPLICANT’S APPEAL BRIEF, you can clearly see that each image is essentially the same distinctive Trademark.

9. On page 7 of her BRIEF, Examining Attorney Lavache states, “The Visual Display of the Matter Comprising the Applied-For Marks Suggests That They Would Not Be Perceived as Trademarks.”

Applicant disagrees. Examining Attorney Lavache complains that the smaller words are arranged in columns, but these columns also function as “word art”. The wider columns are wide stripes, and the smaller horizontal lines are horizontal stripes, in the flag design. They are wide stripes, each made up of small horizontal stripes, in a distinctive overall “flag design”, like Old Glory with its stars and stripes.

10. Examining Attorney Lavache complains that the smaller words present information, but ALL WORDS CONVEY INFORMATION. Even the word “information” conveys information!

“Informational matter” is generally deemed to be lists of generic terms, such as “onions, carrots, and tomatoes.”

11. When the terms in a Trademark are Fanciful, Arbitrary, or Incongruous terms, they are not considered merely generic or informational matter, and can be properly included as part of a fanciful, arbitrary and distinctive Trademark, such as Applicant’s Trademarks [TMEP § 1209.01(a)]. Even the fine print terms are all “fanciful and arbitrary,” and enrich the Trademarks by their fanciful quality.

12. Both of Applicant’s Trademarks are “inherently distinctive”. TMEP § 1209.01 states:

“Fanciful, arbitrary, and suggestive marks, often referred to as “inherently distinctive” marks, are registrable on the Principal Register **without proof of acquired distinctiveness.**” [*Emphasis added.*)]

Therefore, proof a acquired distinctiveness should not even be necessary. This Trademark is a obviously a fanciful Mark.

13. The Trademarks contain artfully designed word art, and the color version shows the bright distinctiveness of the Trademarks in full color. Remember, as stated in TMEP § 807.14(e)(i):

“The amendment of a black-and-white special form drawing to one claiming a color(s) as a feature of the mark generally does not constitute a material alteration. If a mark is initially depicted in a black-and-white special form drawing in which no color is claimed, the drawing is presumed to contemplate the use of the mark in any color, **without limitation.**” (*Emphasis added.*)

14. This Trademark has unique overall impact, and creates an overall Distinctive Commercial Impression, which is not dependent upon the exact words in small print. This is why typographical

corrections can be made in the small print without altering the Public Recognition of this unique Trademark, or the overall Distinctive Commercial Impression, in any way. This Trademark is recognizable, and people really like it. They can view it as a whole, or read the tiny type if they wish. It is as distinctive as a pretty flag.

15. On page 7 of her BRIEF, Examining Attorney Lavache states, “The Use of the Applied-For Marks on the Specimens Suggests That They Would Not Be Perceived as Trademarks”. And on pages 7 through 10, she complains that on some of the Specimens, the Trademarks appear on the same page as another sister Trademark, such as the SHIMMERING BALLERINAS & DANCERS Trademark on the same page with the SHIMMERING RAINFOREST Trademark. This is because some of the characters in some of the publications are members of more than one character family. This is understandable – even people are often members of more than one family.

16. However, though the SHIMMERING Trademarks are visually similar, and they are each perceived as Source Indicators for Applicant’s goods.

You may see an ad for a lunch that features a paper cup full of Pepsi, a GreatVegiburgers sandwich, and a Dunkin Donut. Even though you may have three trademarks on one page, each still serves as a separate Source Indicator. No one minds, and no one is confused. The public has no problem with this.

17. The Playbook is titled “Triple-Shimmering Playbook” because it contains characters from all three related character families. Many people are familiar with all three of the character families.

18. Please note that all of the Specimen leaflets in the EXHIBITS to the Applicant’s APPEAL BRIEF, each have only one Trademark on the back page of each Specimen.

19. On page 8 of her BRIEF, Examining Attorney Lavache complains that the Zahralina Specimen, filed on February 6, 2013. shows the color version of the Trademark, which she objects to. However, according to TMEP § 807.14(e)(i), quoted hereinabove, the black-and-white drawing is presumed to

contemplate the use of the mark in any color, without limitation”, so it should not matter if the Trademark is used in black-and-white. or in color, on the Specimens.

20. Then, also on page 8 of her BRIEF, Ms. Lavache continues to assert that the 4-page leaflet “appears to be a printer’s proof or mock-up of a leaflet”, when it is neither of these. She incorrectly states that “applicant admits in her appeal brief that this document is not an actual leaflet in use in commerce but is instead a mockup”. THIS IS TOTALLY UNTRUE. This Specimen is for an actual leaflet used in commerce. It is not a “mockup”.

The 4-page leaflets filed as Specimens are NOT printer’s proofs. These are actual leaflets used in commerce. This format shows where the folds occur in a leaflet which is one page, printed on both sides and folded in the middle. The pages are not four separate, loose pages. Applicant was simply trying to convey this by showing the pages in this format. It is hard to otherwise show this in an electronic submission. She was trying to show, not just the contents of the pages, but also the format of the leaflet. This is nowhere forbidden by the TMEP or federal law. This should be a perfectly acceptable.

With these leaflets, Applicant also had to remain within the very small file size permitted for TEAS filings. 11x17 color pages would have been too big a file size to send electronically, via TEAS. She had to reduce these to a much smaller size to comply with file size requirements for TEAS filings.

Also, Applicant was trying to submit all four pages of the leaflets on a single page to prevent more egregious and flagrant mishandling of her documents by staff members of the USPTO. She hoped that presenting the leaflets in this way would prevent them from “dropping off” pages of her Specimens, as they have done in the past. This was a response on her part to flagrant mishandling of her documents.

The Examining Attorney’s mistaken conclusion that these leaflets are printer’s proofs is a completely mistaken conjecture on her part, and without any validity. It is simply her unsubstantiated guess, and a mistaken guess. The Examining Attorney cannot justly reject the Specimens simply because she imagined that they were something which they were not.

21. However, Applicant also agreeably submitted a little different versions of the same flyers in different formats, as EXHIBITS to the APPEAL BRIEF. Please see EXHIBIT J (“Meet the Vanavisitos, The Very Special Rainforest Elephants”) to the APPLICANT’S APPEAL BRIEF for SHIMMERING RAINFOREST, and EXHIBIT J to the APPLICANT’S APPEAL BRIEF for SHIMMERING BALLERINAS (“Meet Zahralina Shimmerina, The Liltingly Lovely & Dazzling Ballerina & Dancer”).

These EXHIBITS show the leaflet pages in a different format, in support of the versions of the Trademark as specified in the Exhibit List in the APPEAL BRIEF, as described on the cover page for each Exhibit itself. Either way, no matter which format is used to convey them electronically, these are all bona fide actual leaflets used in commerce.

22. On page 9 of her BRIEF, Ms. Lavache complains that the copyright dates on the Specimens submitted in support of Applicant’s RESPONSE TO OFFICE ACTION show the year 2004 instead of a copyright date previous to the original Application. However, as explained in the ROA, this was because these were in support of a claim for Acquired Distinctiveness, in accord with TMEP § 1212.05:

“The Trademark Act previously required that the relevant five-year period precede the filing date of the application. The Trademark Law Revision Act of 1988, Pub. L. No. 100-667, 102 Stat. 3935 (1988), revised §2(f) of the Act to provide for a prima facie showing of acquired distinctiveness based on five years’ use running up to the date the claim is made. Under the revised provision, any five-year claim submitted on or after November 16, 1989, is subject to the new time period. This applies even if the application was filed prior to that date.”

Since the claim of Acquired Distinctiveness was first made in this case in 2009, Applicant looked for Specimens which would be in accord with TMEP § 1212.05. She also has many similar Specimens with a copyright date previous to the date of her original Application.

Examples of these are the Specimens filed as EXHIBIT L (Copyright Date 2000) and EXHIBIT N (Copyright Date 1982) to the Applicant’s APPEAL BRIEF for SHIMMERING RAINFOREST, and as EXHIBIT L (Copyright Date 2000) and EXHIBIT N (Copyright Date 1982) to the Applicant’s APPEAL BRIEF for SHIMMERING BALLERINAS & DANCERS.

V. Applicant's Trademarks, in Both Their Black-and-White and Color Versions, Have Acquired Distinctiveness Over Many Years of Use.

On page 11 of her BRIEF, Ms. Lavache questions whether Acquired Distinctiveness can be claimed because of her "failure to function refusal". That is, since she claims that Applicant's Trademarks somehow fail to function as Trademarks, in her opinion, they cannot Acquire Distinctiveness.

However, the "failure to function refusal" is obviously bogus. The bright, distinctive Trademarks appear on the back pages of the Specimens, and it is inescapably, crystal clear that they do function as easily recognizable, inherently distinctive, and fanciful Trademarks.

VI. Declaration of Use for Specimens for SHIMMERING BALLERINAS & DANCERS.

Applicant Light submitted a Declaration of Use, under 37 C.F.R. § 2.20, in her RESPONSE TO OFFICE ACTION, dated 01-28-13, for her color Trademarks. All of the Specimens submitted as EXHIBITS to Applicant's APPEAL BRIEF contained these color Trademarks on the back pages of the leaflets, along with the Specimens' copyright dates. Each EXHIBIT was separately filed, with cover pages, and with signed and dated filing confirmation, which may cover the same base as a signed declaration. If additional declarations are needed for the Specimens, the following Declaration is offered.

Please note that this DECLARATION would have been filed earlier, before resumption of the Appeal, if the Examining Attorney had filed a proper Non-Final Office Action, instead of a Final Office Action.

DECLARATION OF USE
FOR SPECIMENS FOR SHIMMERING BALLERINAS & DANCERS

In accord with 37 C.F.R. § 2.20, the undersigned Applicant, being aware that there are legal penalties for false statements, hereby declares that the below-described Specimens were in use in commerce as of the copyright dates below, before the filing date of the original Trademark Application.

- 1) “Meet Silverina Shimmerina, The Silvery Shimmerglowing Ballerina”, (Copyright date: 2000), in support of Trademark Drawing 03 as shown in Applicant’s APPEAL BRIEF, filed as EXHIBIT L to the APPEAL BRIEF dated 06-03-13.
- 2) “Meet Two Dizzy Dames: The Candy-Cane Twins: Swirlina, The Swirling Ballerina & Twirlina, The Twirling Ballerina”, (Copyright date: 1982), filed in support of Trademark Drawing 04 as shown in Applicant’s APPEAL BRIEF, filed as EXHIBIT N to the APPEAL BRIEF dated 06-03-13.

Applicant further declares that the following Specimens were filed especially in support of a claim for Acquired Distinctiveness, in accord with TMEP § 1212.05, affirming exclusive and continuous use of the Trademark in commerce for the five years preceding the date upon which the claim of Acquired Distinctiveness was first made (in 2009), even if the application was filed prior to that date.

- 3) “Meet Zahralina Shimmerina, The Liltingly Lovely & Dazzling Ballerina & Dancer” (Copyright date: 2004), filed in support of Trademark Drawing 04 as shown in Applicant’s APPEAL BRIEF, filed as EXHIBIT J to the APPEAL BRIEF dated 06-03-13.
- 4) “Meet Zahralina Shimmerina, The Liltingly Lovely & Dazzling Ballerina & Dancer” (different version), (Copyright date: 2004), filed in support of earlier Trademark Drawing with more typographical corrections, in support of the RESPONSE TO OFFICE ACTION dated 01-28-13.

Applicant Light confirms that all statements made of her own knowledge are true, and all statements made on information and belief are believed to be true.

This is verified by the Applicant on the date signed hereinbelow.

Date: August 23, 2013

Respectfully submitted,
/ *prema jyothi light* /
Prema Jyothi Light,
Applicant, *pro se*

VII. Earlier Proposed Amendments to the Drawing Were Dropped Before the Final Office Action, so the Examining Attorney’s Long Arguments Against Them in her APPEAL BRIEF Are Completely Moot.

On pages 11, 12, 13 and 14 of her APPEAL BRIEF, Examining Attorney Lavache goes into long arguments against earlier proposed amendments to the Mark, which were dropped before her Final Office Action. So, these arguments are moot. The only proposed amendments at issue here are the New Issues of the Trademark in color, and the requested typographical corrections.

As Applicant clearly stated on page 3 of her RESPONSE TO OFFICE ACTION, dated 01-28-13: “Applicant is willing to accept registration of her Trademark in the flag design version of the Trademark.” Only the flag design is at issue here, in color, and with a few typographical corrections in the fine print, which do not in any way alter the overall Commercial Impression of the Trademark at all.

XI. Applicant Light’s Requests for Registration of her Trademarks in Color, and for Typographical Corrections to the Fine Print in her Trademarks, Do Not Constitute Material Alterations of the Trademarks.

The proposed New Drawings for the color versions of the Trademarks are clearly and recognizably the same Trademarks as the black-and-white versions of the Trademarks, so there should be no problem accepting them. According to TMEP § 807.14(e)(i). the black-and-white versions of the Trademarks are “presumed to contemplate the use of the mark in any color, **without limitation.**”

(Emphasis added.)

There should also be no problem with granting Applicant Light’s requests for Typographical Corrections, as making these corrections of typographical errors does not in any way alter the overall Commercial Impression of the Marks, or diminish the recognizability of the Trademarks. As shown by

EXHIBIT C to the Applicant's APPEAL BRIEF, the uncorrected and corrected versions of the Trademarks convey essentially, and recognizably, the same overall and distinctive Commercial Impression.

According to TMEP § 807.14(e)(i),

“The amendment of the black-&-white drawing to one claiming a particular color as a feature of the mark is, therefore, a restriction or limitation of the applicant's rights.”

By seeking registration of the color versions of her Trademark, Applicant is therefore actually accepting some restriction of her rights. And as stated in TMEP § 807.14(e)(ii):

“In general, the addition, deletion or amendment of color features in a design mark does not result in a material alteration of the mark.

The background colors do not hinder the public recognition of the Trademark. It is clear that the Trademark is still basically the same Trademark, so there should be no problem in registering the color versions.

The original Drawing, and the color version, are recognizably the same Trademark. Please see EXHIBITS A, B, C & D to the Applicant's APPEAL BRIEFS. All of these versions of each Trademark are recognizable as the same Trademark at a glance. Anyone of normal intelligence can easily see this.

Both the color and the black-and-white Drawings for these Trademarks have been in use since long before the date of the original Application.

Therefore, registration should be granted to both of these Trademarks, which are not only “inherently distinctive,” but also have Acquired Distinctiveness over more than a decade of use, as evidenced by the EXHIBITS to the Applicant's APPEAL BRIEF.

IX. While Refusing to Make Applicant's Requested Typographical Corrections, USPTO Staff Members Have, So Far, Made a Total of Forty-Two (42) Typographical Errors in Typing the Literal Elements of Applicant's Two Trademarks into TSDR Online Records.

On page 4 of her BRIEF, Examining Attorney Lavache touched upon this without offering any explanation, just mentioning that she “has made corrections pursuant to these lists.” However, she states, “Applicant’s request to list each character name on a separate line in the “literal element” field or to place semi-colons between the character names cannot be accommodated.” Yet, of course it can. She may be unwilling to do this, and refusing to do this, but of course, it can be done! To fail to do so is to deliberately misrepresent the literal elements of this Trademark in TSDR. Applicant Light respectfully asks that this correction be authorized by the TTAB, in the interests of honesty, accuracy and truth.

X. A large number of document mishandling incidents have occurred in this case.

On page 5 of her BRIEF, Examining Attorney Lavache mentions the mishandling of documents and images on a single date. However, even this incident has not yet been fully set straight. Applicant Light is addressing this serious issue of dozens of incidents of Document Mishandling in this case, in a separate MOTION FOR CORRECTIONS TO THE RECORD, to be filed soon.

XI. The Petition Fee Issue is in Need of TTAB Review.

On page 5 of her BRIEF, Examining Attorney Lavache expresses her view that the Petition Fee should be per Trademark. However, this is not stated anywhere in federal law or in the TMEP.

This is a question which needs to be addressed by those knowledgeable about the TMEP and federal law, at a higher level, such as the TTAB, for the benefit of the wider public. It is not a decision which should just be arbitrarily made at the clerical level. If clerks are making this decision by arbitrary whim, rather than by being in accord with current federal law, this is something which should be set straight. If current federal law is remiss, perhaps this could be set straight later. But the current laws on

Petition Fees, as they are, nowhere forbid addressing two Trademarks with one Petition. The Petition Fee, as currently stated in federal law, is per Petition, not per Trademark.

XII. Conclusions.

Registration should be granted to both of these Trademarks, which are not only “inherently distinctive”, easily recognizable, and fanciful, but also have Acquired Distinctiveness in both color and black-and-white, over more than a decade of time, as evidenced by the EXHIBITS to the Applicant’s APPEAL BRIEF.

However, the case has been hampered by a clear Procedural Error on the part of the Examining Attorney, which fortunately is correctible. The best resolution to this Procedural Error would be a remand of the case back to Examining Attorney Lavache, for issuance of a Non-Final Office Action, so that the Applicant has the opportunity to respond to Ms. Lavache’s new objections to the two New Issues raised in Applicant’s RESPONSE TO OFFICE ACTION dated 01-28-13, and to the New Issue raised by Ms. Lavache herself in her Final Office Action, before resumption of the Appeal. This would bring the case into accord with clear and time-honored provisions of the TMEP, and set a good precedent for other cases.

However, in the alternative, Applicant Light would be glad to accept registration of both of her Trademarks in their color versions, with all requested typographical corrections made, which do not in any way alter the overall Distinctive Commercial Impression of the Trademarks.

XIII. Relief Requested.

WHEREFORE, Applicant Light hereby requests the following Relief:

- 1) Resolution of the Procedural error by remand of the case back to the Examining Attorney for issuance of a Non-Final Office Action;

- 2) Alternatively, acceptance by the TTAB of Applicant's Exhibits to her APPEAL BRIEF, and Declarations of Use, as these would have gone onto the Record earlier if Applicant had been properly allowed the opportunity to respond to the Examining Attorney's objections to New Issues; and
- 3) Registration of her Trademarks in their color versions, with all requested typographical errors corrected, and with corrected Design Codes, as delineated in Applicant's APPEAL BRIEFS;
- 4) And any such other and further relief as the Trademark Trial & Appeal Board deems just and proper.

Dated: August 23, 2013

Respectfully submitted,

/ Prema Jyothi Light /

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