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

Proceeding	76293327
Applicant	Prema Jyothi Light
Applied for Mark	SHIMMERING RAINFOREST
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Submission	Applicants Request for Remand and Amendment
Attachments	SHIMMERING RAINFOREST AMENDED REQUEST FOR FURTHER REMAND.pdf (4 pages)(93967 bytes) SHIMMERING RAINFOREST REQ FOR RECONSIDERATION.pdf (4 pages)(93332 bytes) SHIMMERING RAINFOREST Denial of Reconsideration Letter.pdf (2 pages)(855211 bytes)
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Date	02/08/2010

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

NAME OF APPLICANT: Prema Jyothi Light

NAME OF TRADEMARK: SHIMMERING RAINFOREST

SERIAL NUMBER: 76293327

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

DATE OF FINAL OFFICE ACTION: June 15, 2009

DATE OF REQUEST FOR RECONSIDERATION AND NOTICE OF APPEAL: December 15, 2009

DATE OF LETTER DENYING RECONSIDERATION: January 28, 2010

DATE OF THIS REQUEST: February 8, 2010

EXAMINING ATTORNEY: Paul F. Gast, Esq., Law Office 106

**AMENDED REQUEST FOR FURTHER REMAND TO EXAMINING ATTORNEY
FOR FURTHER CONSIDERATION OF REQUEST FOR RECONSIDERATION**

The Request for Further Remand submitted earlier today is hereby Amended to include, as attachments, a copy of the previous Request for Reconsideration, submitted to the Examining Attorney on December 15, 2010, and the Examining Attorney's Denial, dated January 28, 2010, of that Request for Reconsideration. Both of these documents were submitted via TEAS, not ESTTA, so it might be helpful to the TTAB judges to have these documents immediately at hand, as attachments to this Amended Request for Further Remand via ESTTA.

The Request for Further Remand submitted earlier today is also hereby Amended to include a slightly longer accident recovery time, as it is not yet known exactly how long the recovery time will be, and any surgery could have complications. A single extension of time is better than multiple requests. So the request for extension of time due to accident recovery is amended from four months to five months.

In all other respects, this Amended Request for Further Remand is the same as the Request for Further Remand submitted via ESTTA earlier today.

Applicant Prema Light hereby requests that the TTAB remand this application back to the Examining Attorney for further consideration of her Request for Reconsideration, for the following reasons.

On December 15, 2009, Applicant Light submitted a timely Request for Reconsideration to the Examining Attorney, with new specimens in support thereof soon to follow. She simultaneously submitted a timely Notice of Appeal to the Examining Attorney's Final Action, to the TTAB, to preserve the right of appeal.

This was just about a week before the Christmas, Hannukah and New Year's holidays, and Applicant discovered that she had to reformat her specimens in order to submit them properly via 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, the new specimens and drawings could follow later. She was not given any specific deadline for this. She explained all this in her Request for Reconsideration, which was timely filed via TEAS.

She was in the process of reformatting her supporting drawings and specimens, when about a week after New Year's Day, on January 6, 2010, she had an unexpected accident. She was walking along an icy, snowy sidewalk, on crutches, in downtown Denver. It was snowing, and her crutches slipped on the ice and snow, causing a serious fall onto the hard sidewalk. She had to be ambulated to the nearest hospital emergency room, where she spent the next four hours. She suffered injuries to her already-injured feet, as well as painful injury to her knees, hands, neck and back. The medical and hospital costs for this single evening alone came to over three thousand dollars, and further surgery may be needed.

This has caused delays in her ability to complete the reformatting and submission of her supporting drawings and specimens for her Request for Reconsideration.

The Examining Attorney's letter of denial of her Request for Reconsideration, dated January 28, 2010, has reached her while she is still in recovery from this accident. She is therefore in need of more time to complete the reformatting and submission of the drawings and specimens, and requests an additional five months, until July 8, 2010, for submission of the reformatted drawings and specimens. Her hands were injured in the fall.

The specimens which she sent earlier, in support of her Trademark application, never were given to the Examining Attorney, and apparently were lost somewhere within the PTO. Therefore, it is Applicant Light's hope that if the drawings and specimens are submitted via TEAS rather than by surface mail, they will successfully reach the Examining Attorney for his consideration.

Secondly, according to TMEP § 715.04(b), **Examining Attorney's Action When New Issue or New Evidence is Presented and Notice of Appeal Has Been Filed:**

“If the request for reconsideration includes an amendment that presents a new issue, the examining attorney must issue a new nonfinal Office action with a six-month response clause.”

And further:

”When the examining attorney issues a new action, the Office action should explain that the applicant must respond to all requirements or refusals within six months of the mailing date of the action and that the appeal will remain suspended while the application is on remand.”

Applicant's Request for Reconsideration did present a New Issue, namely, a claim of acquired distinctiveness, in the alternative, under 15 U.S.C. §1052(f). According to TMEP § 1212.02(h), a § 2(f) claim of acquired distinctiveness is considered to be a New Issue.

Also, according to TMEP § 1212(c),

“When an applicant claims acquired distinctiveness in the alternative, the examining attorney should treat separately the questions of: (1) the underlying basis of refusal and; (2) assuming the matter is determined to be registrable, whether acquired distinctiveness has been established.”

However, in his letter dated January 28, 2010, denying Applicant's Request for Reconsideration, the Examining Attorney did not address this New Issue of acquired distinctiveness at all. This New Issue is separate from any other issues discussed in the Final Office Action dated June 15, 2009, and requires a separate, nonfinal response.

Applicant Light also submitted a second New Issue, namely whether the Final Office Action dated June 15, 2009, was Premature, as delineated in TMEP § 714.06. In her RESPONSE TO OFFICE ACTION, she had requested clarification on the issue regarding resubmission of the Mark in Standard Characters Format, so that she could select the best possible samples in support of her application.

However, this New Issue was also not addressed at all by the Examining Attorney's letter dated January 28, 2010. And, as a New Issue, again, in accordance with TMEP § 715.04(b), the proper response for the Examining Attorney would have been a nonfinal action with a six-month response clause.

For the above reasons, Applicant Light respectfully requests a further Remand of her Trademark application back to the Examining Attorney, for (1) an extension of time until July 8, 2010, to submit the reformatted specimens for his thoughtful review, due to accident and the resulting medical emergencies, and (2) for further consideration, proper evaluation, and

proper response to her Request for Reconsideration, which contained New Issues, in accord with the above-cited provisions of TMEP § 715.04(b), TMEP § 1212.02(h), and 15 U.S.C. §1052(f).

She also requests a response to this Request to her email address of (on record with ESTTA and also below), INSTEAD of her surface mail address, as her physical location may be changing soon.

Respectfully submitted,

/ Prema Jyothi Light /

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

NAME OF APPLICANT: Prema Jyothi Light

NAME OF TRADEMARK: SHIMMERING RAINFOREST

SERIAL NUMBER: 76293327

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 RAINFOREST.

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 has experienced some technical difficulties and computer glitches in sending the samples via TEAS, and apparently needs to reformat them again for successful online submission, but looks forward to resolving these unexpected technical problems promptly.

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 specimens 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.

6. 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 BALLERINAS & DANCERS. 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 /

Prema Jyothi Light

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To: Jyothi Light, Prema (gloriouslybrightfaithlight@inbox.com)
Subject: U.S. TRADEMARK APPLICATION NO. 76293327 - SHIMMERING RAINFOREST - N/A
Sent: 1/28/2010 9:38:20 PM
Sent As: ECOM106@USPTO.GOV
Attachments:

UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 76/293327

MARK: SHIMMERING RAINFOREST

76293327

CORRESPONDENT ADDRESS:
PREMA JYOTHI LIGHT
8601 W. CROSS DR. #F5-135
LITTLETON CO 80123

GENERAL TRADEMARK INFORMATION:
<http://www.uspto.gov/main/trademarks.htm>

APPLICANT: Jyothi Light, Prema

CORRESPONDENT'S REFERENCE/DOCKET NO:
N/A

CORRESPONDENT E-MAIL ADDRESS:
gloriouslybrightfaithlight@inbox.com

REQUEST FOR RECONSIDERATION DENIED

ISSUE/MAILING DATE: 1/28/2010

Applicant is requesting reconsideration of a final refusal issued/mailed December 15, 2009.

After careful consideration of the law and facts of the case, the examining attorney must deny the request for reconsideration and adhere to the final action as written since no new facts or reasons have been presented that are significant and compelling with regard to the point at issue. Applicant has stated that she would be submitting a separate showing of evidence that has not been supplied. However, no such showing was actually made of record. Therefore, the refusal is affirmed and the refusal under final refusal is continued.

(continued)

Denial of Reconsideration Letter, page 2 of 2

Accordingly, applicant's request for reconsideration is *denied*. The time for appeal runs from the date the final action was issued/mailed. 37 C.F.R. Section 2.64(b); TMEP Section 715.03(c). If applicant has already filed a timely notice of appeal, the application will be forwarded to the Trademark Trial and Appeal Board (TTAB).

/Paul F. Gast/
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