

Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	76706714
LAW OFFICE ASSIGNED	LAW OFFICE 112
MARK SECTION (current)	
STANDARD CHARACTERS	YES
USPTO-GENERATED IMAGE	YES
LITERAL ELEMENT	METAL PREP
MARK STATEMENT	The mark consists of standard characters, without claim to any particular font style, size or color.
MARK SECTION (proposed)	
MARK	METAL PREP
STANDARD CHARACTERS	YES
USPTO-GENERATED IMAGE	YES
LITERAL ELEMENT	METAL PREP
MARK STATEMENT	The mark consists of standard characters, without claim to any particular font style, size or color.
ARGUMENT(S)	
<u>Acknowledgment that Section 2(d) refusal has been withdrawn</u>	
Applicant acknowledges with appreciation that withdrawal of the Section 2(d) refusal, as previously asserted with respect to US Reg. 0324746 in light of the submitted consent agreement with the owner of this registration.	
<u>Section 2(e)(1) Refusal – Merely Descriptive</u>	
Registration of the mark has been refused based on the allegation that the applied-for-mark merely describes a function or purpose of Applicant’s services. Applicant respectfully traverses the rejection and for the reasons set out in its July 24, 2012 response maintains that the applied-for mark “METAL PREP”, as applied to cleaning and painting hot rolled steel coils, and slitting hot rolled steel coils, is not merely descriptive.	

Request for Registration on Supplemental Register

Applicant requests registration of the mark on the Supplemental Register. Applicant submits that amendment to the Supplemental Register is a procedurally acceptable response to the Section 2(e)(1) Refusal. See TMEP 816.04.

The mark is not generic

Although the application has not been rejected on the basis that the mark is “generic”, the Office Action makes a brief assertion that the mark “appears to be generic...and therefore incapable of functioning as a source-identifier for applicant’s services.” Applicant respectfully disagrees. There is no evidence of record to support that the relevant public by clear evidence would understand the mark to be generic (the common group or class name) for Applicant’s services. The mark “METAL PREP” is not a generic identifier (does not refer to a common class of services), and certainly is not a generic identifier for Applicant’s specialty services of cleaning and painting hot rolled steel coils, and slitting hot rolled steel coils. Furthermore, in the previous Office Action, Applicant’s applied-for mark was rejected under Section 2(d) grounds as being likely to cause confusion with US Reg. 0324746 (which Applicant overcame by consent). The rejection is further evidence that the Office recognized Applicant’s mark - not as a “generic” unprotectable term - but rather as a source-identifier of services and one that could potentially be confused with US Reg. 0324746. Further, as pointed out in the consent agreement with the owner of US Reg. 0324746, Applicant and/or its predecessors-in-interest has used the METAL PREP mark for over twenty years. As such, this mark has served, and continues to serve, as a source-identifier for Applicant’s specialty and high-tech services and is not a generic term for those services.

Conclusion

The present response is intended to fully address each of the issues raised by the Examining Attorney. Applicant’s attorney requests that the Examining Attorney contact the undersigned if further clarification is needed or if a telephone conference would be useful in resolving the issues pending in this matter. For the foregoing reasons, it appears that Applicant has complied with the outstanding requirements of the Examining Attorney and the present application is in condition for publication and such action is respectfully requested at the earliest possible date.

SIGNATURE SECTION

RESPONSE SIGNATURE	/Kay Lyn Schwartz/
SIGNATORY'S NAME	Kay Lyn Schwartz
SIGNATORY'S POSITION	Attorney of record
SIGNATORY'S PHONE NUMBER	2149994702
DATE SIGNED	04/11/2013
AUTHORIZED SIGNATORY	YES
CONCURRENT APPEAL NOTICE FILED	YES

FILING INFORMATION SECTION

SUBMIT DATE	Thu Apr 11 13:00:51 EDT 2013
	USPTO/RFR-72.37.249.60-20

TEAS STAMP

130411130051242309-767067
14-500d6417dd9e060b8a5afc
21918d18ced4e3ab084a76e2e
fe064dce6ebf74444-N/A-N/A
-20130411125922844426

PTO Form 1930 (Rev 9/2007)
OMB No. 0651-0050 (Exp. 05/31/2014)

Request for Reconsideration after Final Action To the Commissioner for Trademarks:

Application serial no. **76706714** has been amended as follows:

MARK

Applicant proposes to amend the mark as follows:

Current: METAL PREP (standard characters)

Proposed (USPTO generated image): METAL PREP (Standard Characters, see [mark](#))

The mark consists of standard characters, without claim to any particular font, style, size, or color.

ARGUMENT(S)

In response to the substantive refusal(s), please note the following:

Acknowledgment that Section 2(d) refusal has been withdrawn

Applicant acknowledges with appreciation that withdrawal of the Section 2(d) refusal, as previously asserted with respect to US Reg. 0324746 in light of the submitted consent agreement with the owner of this registration.

Section 2(e)(1) Refusal – Merely Descriptive

Registration of the mark has been refused based on the allegation that the applied-for mark merely describes a function or purpose of Applicant's services. Applicant respectfully traverses the rejection and for the reasons set out in its July 24, 2012 response maintains that the applied-for mark "METAL PREP", as applied to cleaning and painting hot rolled steel coils, and slitting hot rolled steel coils, is not merely descriptive.

Request for Registration on Supplemental Register

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Action makes a brief assertion that the mark “appears to be generic...and therefore incapable of functioning as a source-identifier for applicant’s services.” Applicant respectfully disagrees. There is no evidence of record to support that the relevant public by clear evidence would understand the mark to be generic (the common group or class name) for Applicant’s services. The mark “METAL PREP” is not a generic identifier (does not refer to a common class of services), and certainly is not a generic identifier for Applicant’s specialty services of cleaning and painting hot rolled steel coils, and slitting hot rolled steel coils. Furthermore, in the previous Office Action, Applicant’s applied-for mark was rejected under Section 2(d) grounds as being likely to cause confusion with US Reg. 0324746 (which Applicant overcame by consent). The rejection is further evidence that the Office recognized Applicant’s mark - not as a “generic” unprotectable term - but rather as a source-identifier of services and one that could potentially be confused with US Reg. 0324746. Further, as pointed out in the consent agreement with the owner of US Reg. 0324746, Applicant and/or its predecessors-in-interest has used the METAL PREP mark for over twenty years. As such, this mark has served, and continues to serve, as a source-identifier for Applicant’s specialty and high-tech services and is not a generic term for those services.

Conclusion

The present response is intended to fully address each of the issues raised by the Examining Attorney. Applicant’s attorney requests that the Examining Attorney contact the undersigned if further clarification is needed or if a telephone conference would be useful in resolving the issues pending in this matter. For the foregoing reasons, it appears that Applicant has complied with the outstanding requirements of the Examining Attorney and the present application is in condition for publication and such action is respectfully requested at the earliest possible date.

SIGNATURE(S)

Request for Reconsideration Signature

Signature: /Kay Lyn Schwartz/ Date: 04/11/2013

Signatory's Name: Kay Lyn Schwartz

Signatory's Position: Attorney of record

Signatory's Phone Number: 2149994702

The signatory has confirmed that he/she is an attorney who is a member in good standing of the bar of the highest court of a U.S. state, which includes the District of Columbia, Puerto Rico, and other federal territories and possessions; and he/she is currently the applicant's attorney or an associate thereof; and to the best of his/her knowledge, if prior to his/her appointment another U.S. attorney or a Canadian attorney/agent not currently associated with his/her company/firm previously represented the applicant in this matter: (1) the applicant has filed or is concurrently filing a signed revocation of or substitute power of attorney with the USPTO; (2) the USPTO has granted the request of the prior representative to withdraw; (3) the applicant has filed a power of attorney appointing him/her in this matter; or (4) the applicant's appointed U.S. attorney or Canadian attorney/agent has filed a power of attorney appointing him/her as an associate attorney in this matter.

The applicant is filing a Notice of Appeal in conjunction with this Request for Reconsideration.

Serial Number: 76706714

Internet Transmission Date: Thu Apr 11 13:00:51 EDT 2013

TEAS Stamp: USPTO/RFR-72.37.249.60-20130411130051242
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d18ced4e3ab084a76e2efe064dce6ebf74444-N/
A-N/A-20130411125922844426

METAL PREP