

PTO Form 1960 (Rev 9/2007)

OMB No. xxx-xxxx (Exp. x/xxxx)

## Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
<b>SERIAL NUMBER</b>	77094257
<b>LAW OFFICE ASSIGNED</b>	LAW OFFICE 104
<b>MARK SECTION (no change)</b>	
<b>ARGUMENT(S)</b>	
<p>The Examining Attorney has refused registration on the grounds that the mark is allegedly primarily merely a surname. For the reasons set forth below, Applicant respectfully requests reconsideration and withdrawal of the initial refusal. Applicant notes that due to a filing error, the response previously submitted by Applicant did not address the surname refusal. Therefore, Applicant requests that the Examining Attorney give full consideration to the arguments in this Request for Reconsideration.</p> <p>As noted by the Examining Attorney, there are four factors to be considered in determining whether or not a mark is "primarily merely a surname." The first is the rareness of the surname. The Examining Attorney has already conceded that PRINTZ "appears to be a relatively rare surname." Although this by itself does not indicate that the mark is not primarily a surname, it does weigh in favor of Applicant's position that consumers are unlikely to view the mark as primarily merely a surname.</p> <p>The second factor is "whether anyone connected with applicant uses the mark as a surname." Applicant hereby advises the Examining Attorney that nobody connected with Applicant has the surname PRINTZ. Therefore, this factor also favors Applicant.</p> <p>The third factor is "whether the term has any recognized meaning other than as a surname." The mark PRINTZ is likely to be interpreted as meaning "prints," since it is fairly common to replace the "s" in a plural noun with a "z," particularly in connection with the names of products targeted towards a young and/or urban demographic. Applicant notes that another PRINTZ mark has recently registered in connection with "customizable decorative protective covers for portable digital audio players and cellular telephones" (U.S. Reg. No. 3,180,957), and that this mark was not refused registration as a surname. Like this mark, Applicant's mark is far more likely to be viewed as an alternate spelling of "prints" than as a surname.</p> <p>In addition to the other recent PRINTZ mark, Applicant notes that there are many similar registered marks ending in a plural "z," such as VAULTZ for storage boxes (U.S. Reg. No. 3,336,431); SQUIRTZ for hand cleaners (U.S. Reg. No. 3,253,735); KNOTZ for massage apparatus (U.S. Reg. No. 3,187,044); BRATZ for dolls (U.S. Reg. No. 2,789,216); and others. Therefore, the third factor also favors Applicant.</p>	

The fourth factor is whether the mark "has the structure and pronunciation of a surname." Applicant respectfully disagrees with the Examining Attorney's contention that the mark has the structure and/or pronunciation of a surname. As discussed above, the mark has the structure and pronunciation of the word "prints," except that the final "s" is replaced with a "z," which customers are very accustomed to seeing in the marketplace.

The fifth factor, "whether the mark is sufficiently stylized to remove its primary significance from that of a surname" is not relevant since Applicant's mark is not stylized.

Therefore, all four of the relevant *Benthin* factors strongly demonstrate that Applicant's mark PRINTZ is not primarily merely a surname. Applicant thus requests reconsideration and withdrawal of the final refusal. Applicant is submitting a Notice of Appeal concurrently with this Request for Reconsideration.

#### GOODS AND/OR SERVICES SECTION (current)

INTERNATIONAL CLASS	025
DESCRIPTION	Shoe insoles
FILING BASIS	Section 1(a)
FIRST USE ANYWHERE DATE	At least as early as 08/30/2006
FIRST USE IN COMMERCE DATE	At least as early as 08/30/2006

#### GOODS AND/OR SERVICES SECTION (proposed)

INTERNATIONAL CLASS	025
DESCRIPTION	Shoe insoles
FILING BASIS	Section 1(a)
FIRST USE ANYWHERE DATE	At least as early as 08/30/2006
FIRST USE IN COMMERCE DATE	At least as early as 08/30/2006
STATEMENT TYPE	"The substitute specimen(s) was in use in commerce as of the filing date of the application."

#### SPECIMEN FILE NAME(S)

ORIGINAL PDF FILE	<a href="http://tgate/PDF/RFR/2008/04/18/20080418164321896401-77094257-002_001/SPU0-124123125-161550611_._PRINTZ_specimen.pdf">http://tgate/PDF/RFR/2008/04/18/20080418164321896401-77094257-002_001/SPU0-124123125-161550611_._PRINTZ_specimen.pdf</a>
CONVERTED PDF FILE(S) (1 page)	\\TICRS\EXPORT\IMAGEOUT\770\942\77094257\xml1\RFR0002.JPG
SPECIMEN DESCRIPTION	Photograph of product packaging

#### SIGNATURE SECTION

ORIGINAL	<a href="http://tgate/PDF/RFR/2008/04/18/20080418164321896401-77094257-002_002/HS_124123125-">http://tgate/PDF/RFR/2008/04/18/20080418164321896401-77094257-002_002/HS_124123125-</a>
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PDF FILE	161550611 _ _PRINTZ _declaration.pdf
CONVERTED PDF FILE(S) (2 pages)	\\TICRS\EXPORT\IMAGEOUT\770\942\77094257\xml1 \RFR0003.JPG
	\\TICRS\EXPORT\IMAGEOUT\770\942\77094257\xml1 \RFR0004.JPG
SIGNATORY'S NAME	Seth Richards
SIGNATORY'S POSITION	CEO
RESPONSE SIGNATURE	/Bryce J. Maynard/
SIGNATORY'S NAME	Bryce J. Maynard
SIGNATORY'S POSITION	Attorney for Applicant
DATE SIGNED	04/18/2008
AUTHORIZED SIGNATORY	YES
CONCURRENT APPEAL NOTICE FILED	YES
<b>FILING INFORMATION SECTION</b>	
SUBMIT DATE	Fri Apr 18 16:43:21 EDT 2008
TEAS STAMP	USPTO/RFR-12.4.123.125-20 080418164321896401-770942 57-42051a0259286d2d365546 cbdbe7ad2340-N/A-N/A-2008 0418161550611099

PTO Form 1960 (Rev 9/2007)

OMB No. xxx-xxxx (Exp. x/xxxx)

### Request for Reconsideration after Final Action

#### To the Commissioner for Trademarks:

Application serial no. 77094257 has been amended as follows:

#### ARGUMENT(S)

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

The Examining Attorney has refused registration on the grounds that the mark is allegedly primarily merely a surname. For the reasons set forth below, Applicant respectfully requests reconsideration and withdrawal of the initial refusal. Applicant notes that due to a filing error, the response previously submitted by Applicant did not address the surname refusal. Therefore, Applicant requests that the

Examining Attorney give full consideration to the arguments in this Request for Reconsideration.

As noted by the Examining Attorney, there are four factors to be considered in determining whether or not a mark is "primarily merely a surname." The first is the rareness of the surname. The Examining Attorney has already conceded that PRINTZ "appears to be a relatively rare surname." Although this by itself does not indicate that the mark is not primarily a surname, it does weigh in favor of Applicant's position that consumers are unlikely to view the mark as primarily merely a surname.

The second factor is "whether anyone connected with applicant uses the mark as a surname." Applicant hereby advises the Examining Attorney that nobody connected with Applicant has the surname PRINTZ. Therefore, this factor also favors Applicant.

The third factor is "whether the term has any recognized meaning other than as a surname." The mark PRINTZ is likely to be interpreted as meaning "prints," since it is fairly common to replace the "s" in a plural noun with a "z," particularly in connection with the names of products targeted towards a young and/or urban demographic. Applicant notes that another PRINTZ mark has recently registered in connection with "customizable decorative protective covers for portable digital audio players and cellular telephones" (U.S. Reg. No. 3,180,957), and that this mark was not refused registration as a surname. Like this mark, Applicant's mark is far more likely to be viewed as an alternate spelling of "prints" than as a surname.

In addition to the other recent PRINTZ mark, Applicant notes that there are many similar registered marks ending in a plural "z," such as VAULTZ for storage boxes (U.S. Reg. No. 3,336,431); SQUIRTZ for hand cleaners (U.S. Reg. No. 3,253,735); KNOTZ for massage apparatus (U.S. Reg. No. 3,187,044); BRATZ for dolls (U.S. Reg. No. 2,789,216); and others. Therefore, the third factor also favors Applicant.

The fourth factor is whether the mark "has the structure and pronunciation of a surname." Applicant respectfully disagrees with the Examining Attorney's contention that the mark has the structure and/or pronunciation of a surname. As discussed above, the mark has the structure and pronunciation of the word "prints," except that the final "s" is replaced with a "z," which customers are very accustomed to seeing in the marketplace.

The fifth factor, "whether the mark is sufficiently stylized to remove its primary significance from that of a surname" is not relevant since Applicant's mark is not stylized.

Therefore, all four of the relevant *Benthin* factors strongly demonstrate that Applicant's mark PRINTZ is not primarily merely a surname. Applicant thus requests reconsideration and withdrawal of the final refusal. Applicant is submitting a Notice of Appeal concurrently with this Request for Reconsideration.

#### **CLASSIFICATION AND LISTING OF GOODS/SERVICES**

**Applicant proposes to amend the following class of goods/services in the application:**

**Current:** Class 025 for Shoe insoles

**Original Filing Basis:**

**Filing Basis: Section 1(a), Use in Commerce:** The applicant is using the mark in commerce, or the applicant's related company or licensee is using the mark in commerce, on or in connection with the identified goods and/or services. 15 U.S.C. Section 1051(a), as amended. The mark was first used at least as early as 08/30/2006 and first used in commerce at least as early as 08/30/2006, and is now in use

in such commerce.

**Proposed:** Class 025 for Shoe insoles

**Filing Basis: Section 1(a), Use in Commerce:** The applicant is using the mark in commerce, or the applicant's related company or licensee is using the mark in commerce, on or in connection with the identified goods and/or services. 15 U.S.C. Section 1051(a), as amended. The mark was first used at least as early as 08/30/2006 and first used in commerce at least as early as 08/30/2006, and is now in use in such commerce.

Applicant hereby submits a new specimen for Class 025. The specimen(s) submitted consists of Photograph of product packaging.

For an application based on 1(a), Use in Commerce, "The substitute specimen(s) was in use in commerce as of the filing date of the application."

**Original PDF file:**

[http://tgate/PDF/RFR/2008/04/18/20080418164321896401-77094257-002\\_001/SPU0-124123125-161550611\\_.PRINTZ\\_specimen.pdf](http://tgate/PDF/RFR/2008/04/18/20080418164321896401-77094257-002_001/SPU0-124123125-161550611_.PRINTZ_specimen.pdf)

**Converted PDF file(s)** (1 page)

[Specimen File1](#)

**SIGNATURE(S)**

**Declaration Signature**

**Original PDF file:**

[http://tgate/PDF/RFR/2008/04/18/20080418164321896401-77094257-002\\_002/HS\\_124123125-161550611\\_.PRINTZ\\_declaration.pdf](http://tgate/PDF/RFR/2008/04/18/20080418164321896401-77094257-002_002/HS_124123125-161550611_.PRINTZ_declaration.pdf)

**Converted PDF file(s)** (2 pages)

[Signature File1](#)

[Signature File2](#)

Signatory's Name: Seth Richards

Signatory's Position: CEO

**Request for Reconsideration Signature**

Signature: /Bryce J. Maynard/ Date: 04/18/2008

Signatory's Name: Bryce J. Maynard

Signatory's Position: Attorney for Applicant

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: 77094257

Internet Transmission Date: Fri Apr 18 16:43:21 EDT 2008

TEAS Stamp: USPTO/RFR-12.4.123.125-20080418164321896

401-77094257-42051a0259286d2d365546cbdbe  
7ad2340-N/A-N/A-20080418161550611099



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of :  
Implus Footcare, LLC :  
Filed: January 30, 2007 :  
Serial No. 77/094,257 :  
Mark: PRINTZ :  
Attorney Docket: 0045259-000054 :

**DECLARATION**

Commissioner for Trademarks  
P.O. Box 1451  
Alexandria, Virginia 22313-1451

Commissioner:

Supplementing the application papers filed on January 30, 2007, 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 this document, the above-identified application or any registration resulting therefrom, declares that: they are authorized to execute this application; they believe they are the owner of the mark sought to be registered and/or to be entitled to use such mark in commerce; that the mark is in use in commerce and was in use in commerce in connection with the goods listed in the application as of the filing date of the application; or that they have a bona fide intention to use the mark in commerce and had a bona fide intention to use the mark in commerce as of the filing date of the application on or in connection with the goods listed in the application; to the best of their knowledge and belief, no

other person, firm, corporation or association has the right to use said mark in commerce, either in the identical form or in such near resemblance thereto as to be likely, when applied to the goods of such other person, to cause confusion, or to cause mistake, or to deceive; to the best of their knowledge and belief, the facts set forth in the application are true and were true as of the filing date thereof; and all statements made herein of their own knowledge are true and all statements made on information and belief are believed to be true.

**IMPLUS FOOTCARE, LLC**

By:   
Name: SETH RICHARDS  
Title: CEO  
Date: 7/24/08