

Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	77686473
LAW OFFICE ASSIGNED	LAW OFFICE 102
MARK SECTION (no change)	
ARGUMENT(S)	
<u>RESPONSE TO OFFICE ACTION</u>	

The Examining Attorney has maintained his refusal of the Applicant's registration under Section 2(e)(1) stating that the mark is merely descriptive.

Section 2(e)(1) Descriptive Refusal

The Examining Attorney refused registration of the above mark on the Principal Register because the proposed mark merely describes the goods. The fact is the Applicant has combined the words "CLASSIC" with "DEFERRED" and "ANNUITIES" to create a unique compound term that is only suggestive of the Applicant's goods.

Mark is not Merely Descriptive

According to Section 1209.01(b) of the Trademark Manual of Examining Procedure of the Patent and Trademark Office, "to be refused registration on the Principal Register under §2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), a mark must be merely descriptive or deceptively misdescriptive of the goods or services to which it relates. A mark is considered merely descriptive if it describes an ingredient, quality, characteristic, function, feature, purpose or use of the specified goods or services." The test for determining whether a mark is merely descriptive is whether it immediately conveys information concerning a quality, characteristic, function, ingredient, attribute or feature of the product or service in connection with which it is used, or intended to be used.

Suggestive marks are those that require imagination, thought or perception to reach a conclusion as to the nature of the goods or services. Thus, a suggestive term differs from a descriptive term, which immediately tells something about the goods or services. Suggestive marks, like fanciful and arbitrary marks, can be registered on the principal Register without proof of secondary meaning.

Applicant's mark, CLASSIC DEFERRED ANNUITIES, conjures up many different possible goods. It is only suggestive of issuance and administration of annuities. The consuming public would require imagination, thought and perception to conclude that Applicant's mark is related to the goods described. The concept of mere descriptiveness "must relate to general and readily recognizable word formulations and meanings, either in a popular or technical usage context, and should not penalize coinage of hitherto unused and somewhat incongruous word combinations whose import would not be grasped without some measure of imagination and 'mental pause.'"

It is well established that a mark will not be deemed descriptive if a multi-stage reasoning process or the use of imagination, thought or perception is required to discern the nature or attributes of the goods or services associated with the mark. While the term 'deferred annuities' may have some significance in the annuity market pairing that term with the term "CLASSIC" changes the attributes of the mark so that it is not descriptive.

Furthermore, if the question of descriptiveness is a close one, doubt is to be resolved in the Applicant's favor. As such, the fact that the Applicant has applied a suggestive and imaginative twist to a product name that rises above the level of mere descriptiveness leads one to conclude Applicant's mark is entitled to registration on the principal register.

Combinations of Words May not be Merely Descriptive

Combinations of merely descriptive components have been found registrable if the juxtaposition of the words is inventive or evokes a unique commercial impression, or if the term has a bizarre or incongruous meaning as applied to the goods. See *In re Colonial Stores Inc.*, 394 F.2d 549, 157 USPQ 382 (C.C.P.A. 1968). Further, as set forth in *In re TBG Inc.*, 229 USPQ 759 (TTAB 1986), where SHOWROOM

ONLINE was held not merely descriptive of computerized interior furnishings product information service, classic deferred annuities is not merely descriptive of an annuity.

The Applicant has combined the words "Classic" with "Deferred" and "Annuities" to create a unique compound term that is only suggestive of the Applicant's goods. Therefore, the combination of these terms result in a unique and suggestive mark requiring thought, perception, and imagination on the part of the consumer to understand the nature of the Applicant's goods. The Applicant has applied a suggestive and imaginative twist to a product name that rises above the level of mere descriptiveness and whose use would hardly remove a desired descriptive characterization from the trade repertoire of other makers and sellers of the goods. At the end of the day, if the question of descriptiveness is a close one, doubt is to be resolved in the Applicant's favor.

Applicant's mark is only suggestive of the nature of the goods under the mark, and is therefore entitled to registration on the Principal Register.

SIGNATURE SECTION

DECLARATION SIGNATURE	/jgh/
SIGNATORY'S NAME	Jaye G. Heybl
SIGNATORY'S POSITION	Attorney of record, CA state bar member
DATE SIGNED	06/30/2010
RESPONSE SIGNATURE	/jgh/
SIGNATORY'S NAME	Jaye G. Heybl
SIGNATORY'S POSITION	Attorney of record, CA state bar member
DATE SIGNED	06/30/2010
AUTHORIZED SIGNATORY	YES
CONCURRENT APPEAL NOTICE FILED	YES

FILING INFORMATION SECTION

SUBMIT DATE	Wed Jun 30 17:13:55 EDT 2010
TEAS STAMP	USPTO/RFR-96.31.249.254-2 0100630171355033504-77686 473-460293e9db95c54158d7a

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

Application serial no. **77686473** has been amended as follows:

ARGUMENT(S)

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

RESPONSE TO OFFICE ACTION

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Section 2(e)(1) Descriptive Refusal

The Examining Attorney refused registration of the above mark on the Principal Register because the proposed mark merely describes the goods. The fact is the Applicant has combined the words "CLASSIC" with "DEFERRED" and "ANNUITIES" to create a unique compound term that is only suggestive of the Applicant's goods.

Mark is not Merely Descriptive

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It is well established that a mark will not be deemed descriptive if a multi-stage reasoning process or the use of imagination, thought or perception is required to discern the nature or attributes of the goods or services associated with the mark. While the term 'deferred annuities' may have some significance in the annuity market pairing that term with the term "CLASSIC" changes the attributes of the mark so that it is not descriptive.

Furthermore, if the question of descriptiveness is a close one, doubt is to be resolved in the Applicant's favor. As such, the fact that the Applicant has applied a suggestive and imaginative twist to a product name that rises above the level of mere descriptiveness leads one to conclude Applicant's mark is entitled to registration on the principal register.

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Applicant's mark is only suggestive of the nature of the goods under the mark, and is therefore entitled to registration on the Principal Register.

SIGNATURE(S)

Declaration Signature

If the applicant is seeking registration under Section 1(b) and/or Section 44 of the Trademark Act, the applicant has had a bona fide intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the identified goods and/or services as of the filing date of the application. 37 C.F.R. Secs. 2.34(a)(2)(i); 2.34 (a)(3)(i); and 2.34(a)(4)(ii); and/or the applicant has had a bona fide intention to exercise legitimate control over the use of the mark in commerce by its members. 37 C.F. R. Sec. 2.44. If the applicant is seeking registration under Section 1(a) of the Trademark Act, the mark was in use in commerce on or in connection with the goods and/or services listed in the application as of the application filing date or as of the date of any submitted allegation of use. 37 C.F.R. Secs. 2.34(a)(1)(i); and/or the applicant has exercised legitimate control over the use of the mark in commerce by its members. 37 C.F.R. Sec. 244. The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. Section 1001, and that such willful false statements may jeopardize the validity of the application or any resulting registration, declares that he/she is properly authorized to execute this application on behalf of the applicant; he/she believes the applicant to be the owner of the trademark/service mark sought to be registered, or, if the application is being filed under 15 U.S.C. Section 1051(b), he/she believes applicant to be entitled to use such mark in commerce; to the best of his/her knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive; that if the original application was submitted unsigned, that all statements in the original application and this

submission made of the declaration signer's knowledge are true; and all statements in the original application and this submission made on information and belief are believed to be true.

Signature: /jgh/ Date: 06/30/2010

Signatory's Name: Jaye G. Heybl

Signatory's Position: Attorney of record, CA state bar member

Request for Reconsideration Signature

Signature: /jgh/ Date: 06/30/2010

Signatory's Name: Jaye G. Heybl

Signatory's Position: Attorney of record, CA state bar member

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: 77686473

Internet Transmission Date: Wed Jun 30 17:13:55 EDT 2010

TEAS Stamp: USPTO/RFR-96.31.249.254-2010063017135503

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