

Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	77691841
LAW OFFICE ASSIGNED	LAW OFFICE 106
MARK SECTION	
MARK	http://tmng-al.uspto.gov/resting2/api/img/77691841/large
LITERAL ELEMENT	BEAVER
STANDARD CHARACTERS	YES
USPTO-GENERATED IMAGE	YES
MARK STATEMENT	The mark consists of standard characters, without claim to any particular font style, size or color.
ARGUMENT(S)	
<p>It appears that there are no Section 2(d) refusals raised to the goods in classes 12, 16, 18 and 21, and the services in class 37.</p> <p>The Examining Attorney has maintained the refusal to register the goods in class 25 because she states that applicant's mark, when used on or in connection with the identified goods, so resembles the mark in U.S. Registration No. 1183052 as to be likely to cause confusion, to cause mistake or to deceive. Applicant respectfully traverses this rejection and requests reconsideration on this point.</p> <p>The applicant's mark is distinct from the mark of the registrant. The registrant's mark is "BEAVER BRAND HATS & Design." It should be noted that the registration includes a disclaimer, "No claim is made to exclusive use of the words, "Beaver", "Brand", or "Hats" apart from the mark as shown." Clearly, the registrant's rights extend only to the unique and particular design of a patch shown in the registration. The registrant has disclaimed his rights in the term BEAVER. While the examiner claims that the word portion is often considered to be the dominant feature, even when the term is disclaimed, it should be noted that the word part of the registrant's mark, "BEAVER BRAND HATS," would not be considered similar to the applicant's BEAVER mark given the context in which the applicant's mark is marketed and sold.</p> <p>The Examining Attorney states that applicant's application covers related goods that will travel in the same channels of trade as the registrants' goods. The description of goods in class 25 makes it clear that applicant's clothing, footwear and headgear travel in a different channel of trade than the goods of the registrant. Applicant's goods will be provided only in association with the promotion and sales of the aircraft, the famous aircraft with the name BEAVER. Accordingly, the goods will not be provided at traditional retail stores where the goods of the registrant may be provided, but only at places related to the places where the BEAVER aircraft is sold, and other promotional events and places to market the aircraft and its parts.</p> <p>Applicant submits that the differences in the methods of sale of the products of the registrant and the applicant, together with the differences in the marks themselves, will ensure that there will be no confusion as to source if the applicant's trademark is allowed to register. It is respectfully requested that the Examining Attorney reconsider the rejection of record, in light of the information provided about the applicant's goods and the comments above.</p>	
GOODS AND/OR SERVICES SECTION (012)(no change)	
GOODS AND/OR SERVICES SECTION (016)(current)	
INTERNATIONAL CLASS	016
DESCRIPTION	
promotional items, namely, pens, coasters of paper, all provided for the promotion and sales of aircraft	

FILING BASIS	Section 1(b)
FILING BASIS	Section 44(e)
GOODS AND/OR SERVICES SECTION (016)(proposed)	
INTERNATIONAL CLASS	016
DESCRIPTION	
promotional items, namely, pens, coasters of paper, all provided for the promotion and sales of aircraft	
FILING BASIS	Section 1(b)
GOODS AND/OR SERVICES SECTION (018)(current)	
INTERNATIONAL CLASS	018
DESCRIPTION	luggage, namely, travel bags and trunks
FILING BASIS	Section 1(b)
FILING BASIS	Section 44(e)
GOODS AND/OR SERVICES SECTION (018)(proposed)	
INTERNATIONAL CLASS	018
DESCRIPTION	luggage, namely, travel bags and trunks
FILING BASIS	Section 1(b)
GOODS AND/OR SERVICES SECTION (021)(current)	
INTERNATIONAL CLASS	021
DESCRIPTION	
promotional items, namely, mugs, cups, coasters not of paper and not being table linen, and bottle openers	
FILING BASIS	Section 1(b)
FILING BASIS	Section 44(e)
GOODS AND/OR SERVICES SECTION (021)(proposed)	
INTERNATIONAL CLASS	021
DESCRIPTION	
promotional items, namely, mugs, cups, coasters not of paper and not being table linen, and bottle openers	
FILING BASIS	Section 1(b)
GOODS AND/OR SERVICES SECTION (025)(current)	
INTERNATIONAL CLASS	025
DESCRIPTION	
clothing, namely, shirts and jackets; footwear, namely, shoes and boots; headgear, namely, caps, tuques and hats, all provided for the promotion and sales of aircraft	
FILING BASIS	Section 1(b)
FILING BASIS	Section 44(e)
GOODS AND/OR SERVICES SECTION (025)(proposed)	
INTERNATIONAL CLASS	025
DESCRIPTION	
clothing, namely, shirts and jackets; footwear, namely, shoes and boots; headgear, namely, caps, tuques and hats, all provided for the promotion and sales of aircraft	

FILING BASIS	Section 1(b)
GOODS AND/OR SERVICES SECTION (037)(no change)	
SIGNATURE SECTION	
DECLARATION SIGNATURE	The filing Attorney has elected not to submit the signed declaration, believing no supporting declaration is required under the <i>Trademark Rules of Practice</i> .
RESPONSE SIGNATURE	/barbara a. barakat/
SIGNATORY'S NAME	Barbara A. Barakat
SIGNATORY'S POSITION	Attorney of record
SIGNATORY'S PHONE NUMBER	617 526 6154
DATE SIGNED	02/18/2016
AUTHORIZED SIGNATORY	YES
CONCURRENT APPEAL NOTICE FILED	YES
FILING INFORMATION SECTION	
SUBMIT DATE	Thu Feb 18 09:22:41 EST 2016
TEAS STAMP	USPTO/RFR-XX.XXX.XXX.XX-2 0160218092241750362-77691 841-5507adba69ced75d6f1d1 c685a0c5ecf5f98f4a057ca5f 659c06eb247f15fa6db-N/A-N /A-20160218091930454518

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OMB No. 0651-0050 (Exp 07/31/2017)

Request for Reconsideration after Final Action

To the Commissioner for Trademarks:

Application serial no. **77691841** BEAVER(Standard Characters, see <http://tmng-al.uspto.gov/resting2/api/img/77691841/large>) has been amended as follows:

ARGUMENT(S)

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

It appears that there are no Section 2(d) refusals raised to the goods in classes 12, 16, 18 and 21, and the services in class 37.

The Examining Attorney has maintained the refusal to register the goods in class 25 because she states that applicant's mark, when used on or in connection with the identified goods, so resembles the mark in U.S. Registration No. 1183052 as to be likely to cause confusion, to cause mistake or to deceive. Applicant respectfully traverses this rejection and requests reconsideration on this point.

The applicant's mark is distinct from the mark of the registrant. The registrant's mark is "BEAVER BRAND HATS & Design." It should be noted that the registration includes a disclaimer, "No claim is made to exclusive use of the words, "Beaver", "Brand", or "Hats" apart from the mark as shown." Clearly, the registrant's rights extend only to the unique and particular design of a patch shown in the registration. The registrant has disclaimed his rights in the term BEAVER. While the examiner claims that the word portion is often considered to be the dominant feature, even when the term is disclaimed, it should be noted that the word part of the registrant's mark, "BEAVER BRAND HATS," would not be considered similar to the applicant's BEAVER mark given the context in which the applicant's mark is marketed and sold.

The Examining Attorney states that applicant's application covers related goods that will travel in the same channels of trade as the registrants' goods. The description of goods in class 25 makes it clear that applicant's clothing, footwear and headgear travel in a different channel of trade

than the goods of the registrant. Applicant's goods will be provided only in association with the promotion and sales of the aircraft, the famous aircraft with the name BEAVER. Accordingly, the goods will not be provided at traditional retail stores where the goods of the registrant may be provided, but only at places related to the places where the BEAVER aircraft is sold, and other promotional events and places to market the aircraft and its parts.

Applicant submits that the differences in the methods of sale of the products of the registrant and the applicant, together with the differences in the marks themselves, will ensure that there will be no confusion as to source if the applicant's trademark is allowed to register. It is respectfully requested that the Examining Attorney reconsider the rejection of record, in light of the information provided about the applicant's goods and the comments above.

CLASSIFICATION AND LISTING OF GOODS/SERVICES

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

Current: Class 016 for promotional items, namely, pens, coasters of paper, all provided for the promotion and sales of aircraft
Original Filing Basis:

Filing Basis: Section 1(b), Intent to Use: *For a trademark or service mark application:* As of the application filing date, the applicant had a bona fide intention, and was entitled, to use the mark in commerce on or in connection with the identified goods/services in the application. ***For a collective trademark, collective service mark, or collective membership mark application:*** As of the application filing date, the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce by members on or in connection with the identified goods/services/collective membership organization. ***For a certification mark application:*** As of the application filing date, the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce by authorized users in connection with the identified goods/services, and the applicant will not engage in the production or marketing of the goods/services to which the mark is applied, except to advertise or promote recognition of the certification program or of the goods/services that meet the certification standards of the applicant.

Proposed: Class 016 for promotional items, namely, pens, coasters of paper, all provided for the promotion and sales of aircraft
Deleted Filing Basis: 44(e)

Filing Basis: Section 1(b), Intent to Use: *For a trademark or service mark application:* As of the application filing date, the applicant had a bona fide intention, and was entitled, to use the mark in commerce on or in connection with the identified goods/services in the application. ***For a collective trademark, collective service mark, or collective membership mark application:*** As of the application filing date, the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce by members on or in connection with the identified goods/services/collective membership organization. ***For a certification mark application:*** As of the application filing date, the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce by authorized users in connection with the identified goods/services, and the applicant will not engage in the production or marketing of the goods/services to which the mark is applied, except to advertise or promote recognition of the certification program or of the goods/services that meet the certification standards of the applicant.

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

Current: Class 018 for luggage, namely, travel bags and trunks
Original Filing Basis:

Filing Basis: Section 1(b), Intent to Use: *For a trademark or service mark application:* As of the application filing date, the applicant had a bona fide intention, and was entitled, to use the mark in commerce on or in connection with the identified goods/services in the application. ***For a collective trademark, collective service mark, or collective membership mark application:*** As of the application filing date, the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce by members on or in connection with the identified goods/services/collective membership organization. ***For a certification mark application:*** As of the application filing date, the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce by authorized users in connection with the identified goods/services, and the applicant will not engage in the production or marketing of the goods/services to which the mark is applied, except to advertise or promote recognition of the certification program or of the goods/services that meet the certification standards of the applicant.

Proposed: Class 018 for luggage, namely, travel bags and trunks
Deleted Filing Basis: 44(e)

Filing Basis: Section 1(b), Intent to Use: *For a trademark or service mark application:* As of the application filing date, the applicant had a bona fide intention, and was entitled, to use the mark in commerce on or in connection with the identified goods/services in the application. ***For a collective trademark, collective service mark, or collective membership mark application:*** As of the application filing date, the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce by members on or in connection with the identified goods/services/collective membership organization. ***For a certification mark application:*** As of the application filing date, the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce by authorized users in

connection with the identified goods/services, and the applicant will not engage in the production or marketing of the goods/services to which the mark is applied, except to advertise or promote recognition of the certification program or of the goods/services that meet the certification standards of the applicant.

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

Current: Class 021 for promotional items, namely, mugs, cups, coasters not of paper and not being table linen, and bottle openers

Original Filing Basis:

Filing Basis: Section 1(b), Intent to Use: *For a trademark or service mark application:* As of the application filing date, the applicant had a bona fide intention, and was entitled, to use the mark in commerce on or in connection with the identified goods/services in the application. ***For a collective trademark, collective service mark, or collective membership mark application:*** As of the application filing date, the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce by members on or in connection with the identified goods/services/collective membership organization. ***For a certification mark application:*** As of the application filing date, the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce by authorized users in connection with the identified goods/services, and the applicant will not engage in the production or marketing of the goods/services to which the mark is applied, except to advertise or promote recognition of the certification program or of the goods/services that meet the certification standards of the applicant.

Proposed: Class 021 for promotional items, namely, mugs, cups, coasters not of paper and not being table linen, and bottle openers

Deleted Filing Basis: 44(e)

Filing Basis: Section 1(b), Intent to Use: *For a trademark or service mark application:* As of the application filing date, the applicant had a bona fide intention, and was entitled, to use the mark in commerce on or in connection with the identified goods/services in the application. ***For a collective trademark, collective service mark, or collective membership mark application:*** As of the application filing date, the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce by members on or in connection with the identified goods/services/collective membership organization. ***For a certification mark application:*** As of the application filing date, the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce by authorized users in connection with the identified goods/services, and the applicant will not engage in the production or marketing of the goods/services to which the mark is applied, except to advertise or promote recognition of the certification program or of the goods/services that meet the certification standards of the applicant.

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

Current: Class 025 for clothing, namely, shirts and jackets; footwear, namely, shoes and boots; headgear, namely, caps, tuques and hats, all provided for the promotion and sales of aircraft

Original Filing Basis:

Filing Basis: Section 1(b), Intent to Use: *For a trademark or service mark application:* As of the application filing date, the applicant had a bona fide intention, and was entitled, to use the mark in commerce on or in connection with the identified goods/services in the application. ***For a collective trademark, collective service mark, or collective membership mark application:*** As of the application filing date, the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce by members on or in connection with the identified goods/services/collective membership organization. ***For a certification mark application:*** As of the application filing date, the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce by authorized users in connection with the identified goods/services, and the applicant will not engage in the production or marketing of the goods/services to which the mark is applied, except to advertise or promote recognition of the certification program or of the goods/services that meet the certification standards of the applicant.

Proposed: Class 025 for clothing, namely, shirts and jackets; footwear, namely, shoes and boots; headgear, namely, caps, tuques and hats, all provided for the promotion and sales of aircraft

Deleted Filing Basis: 44(e)

Filing Basis: Section 1(b), Intent to Use: *For a trademark or service mark application:* As of the application filing date, the applicant had a bona fide intention, and was entitled, to use the mark in commerce on or in connection with the identified goods/services in the application. ***For a collective trademark, collective service mark, or collective membership mark application:*** As of the application filing date, the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce by members on or in connection with the identified goods/services/collective membership organization. ***For a certification mark application:*** As of the application filing date, the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce by authorized users in connection with the identified goods/services, and the applicant will not engage in the production or marketing of the goods/services to which the mark is applied, except to advertise or promote recognition of the certification program or of the goods/services that meet the certification standards of the applicant.

SIGNATURE(S)

Declaration Signature

The filing Attorney has elected not to submit the signed declaration, believing no supporting declaration is required under the *Trademark Rules of Practice*.

Request for Reconsideration Signature

Signature: /barbara a. barakat/ Date: 02/18/2016

Signatory's Name: Barbara A. Barakat

Signatory's Position: Attorney of record

Signatory's Phone Number: 617 526 6154

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 owner's/holder'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 owner/holder in this matter: (1) the owner/holder 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 owner/holder has filed a power of attorney appointing him/her in this matter; or (4) the owner's/holder'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: 77691841

Internet Transmission Date: Thu Feb 18 09:22:41 EST 2016

TEAS Stamp: USPTO/RFR-XX.XXX.XXX.XX-2016021809224175

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