

Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	77697117
LAW OFFICE ASSIGNED	LAW OFFICE 107

MARK SECTION (no change)

ARGUMENT(S)

The Office Action maintains and makes final a refusal on grounds that Applicant's product replacement program does not constitute a service as contemplated by the Trademark Act.

Applicant respectfully disagrees and requests reconsideration of this refusal based on the following arguments, evidence, and authority. **Applicant's services and services description meet the requirements of the TMEP.**

Applicant initially notes that it has amended its services description to read as follows:

- “ **providing extended warranties on window fashions in the nature of a product replacement plan**” in Class 36.

This amended language should be accepted because it follows the USPTO's ID Manual, which includes an entry in Class 36 for “*providing extended warranties on ...[specify items]*” See attached copy of an excerpt from the USPTO's ID Manual showing various entries for “warranty services.”

Moreover, Applicant's product replacement plan services are “qualitatively different” from anything normally done in the Applicant's industry, and Applicant's incorporation of the term “extended” into its services description, as amended herein, highlights and recognizes that fact. See TMEP Section 1301.01(b)(ii) (“**For the “warranty” service to be considered a separate service, the identification of services should include the word “extended” or other similar terminology (i.e., words that recognize the fact that the service is “qualitatively different” from anything normally done in connection with the sale of the applicant's goods/services) .**”)

In this regard, Applicant's window fashions are goods that are installed into the window frame, and, as a result, are **goods that cannot be easily exchanged**. And, because many consumers do not install window fashions by themselves (but instead purchase installation services as part of the purchase of the window fashions), returning the products necessarily requires more time and expense than just returning a boxed item to the store.

Applicant's replacement program involves sending an installer to the home where the window fashions have been installed to remove the original window fashions and to install the replacement ones. Based on Applicant's understanding of its own industry, **this is not industry practice.**

And, it must be emphasized that this **replacement** program is different from Applicant's **warranty** program. The **warranty** program covers defects in materials, workmanship, and failure to operate, whereas the **replacement** program covers instances where the consumers in not satisfied with the look and appearance of the window fashions. Applicant's own advertising bears out this difference in that it separately promotes the warranty and replacement programs. This is significant in the analysis. In re Orion Research Inc., 669 F.2d 689, 205 USPQ 688 (C.C.P.A. 1980) (guarantee of repair or replacement of applicant's goods **that is not separately offered, promoted, or charged** for is not a service); In re Lenox, Inc., 228 USPQ 966 (TTAB 1986) (lifetime warranty **that is not separately offered, promoted, or charged** for is not a service).

Applicant's services are separately promoted and are qualitatively different from anything normally done in connection with the sale of Applicant's goods.

Accordingly, and based on the foregoing evidence and arguments, Applicant respectfully requests the Examiner to withdraw the refusal and to approve Applicant's mark for publication.

EVIDENCE SECTION

EVIDENCE FILE NAME(S)	
ORIGINAL PDF FILE	evi_2162058535-133413570_._ID_Manual_entries_for_warranty_services.pdf
CONVERTED PDF FILE(S) (1 page)	\\TICRS\EXPORT11\IMAGEOUT11\776\971\77697117\xml1\RFR0002.JPG
DESCRIPTION OF EVIDENCE FILE	excerpts from the USPTO's ID Manual
GOODS AND/OR SERVICES SECTION (class deleted)	
INTERNATIONAL CLASS	035
DESCRIPTION	Product replacement program
FILING BASIS	Section 1(a)
FIRST USE ANYWHERE DATE	At least as early as 10/01/2008
FIRST USE IN COMMERCE DATE	At least as early as 10/01/2008
GOODS AND/OR SERVICES SECTION (class added) Original Class (035)	
INTERNATIONAL CLASS	036

DESCRIPTION

providing extended warranties on window fashions in the nature of a product replacement program

FILING BASIS Section 1(a)

FIRST USE ANYWHERE DATE At least as early as 10/01/2008

FIRST USE IN COMMERCE DATE At least as early as 10/01/2008

SIGNATURE SECTION

RESPONSE SIGNATURE /Andrew Roppel/

SIGNATORY'S NAME Andrew Roppel

SIGNATORY'S POSITION Attorney for Applicant

DATE SIGNED 07/25/2010

AUTHORIZED SIGNATORY YES

CONCURRENT APPEAL NOTICE FILED YES

FILING INFORMATION SECTION

SUBMIT DATE Sun Jul 25 13:49:35 EDT 2010

TEAS STAMP USPTO/RFR-216.205.85.35-2
0100725134935955974-77697
117-4705e51a3d18c27595854
2acab54f1e4f0-N/A-N/A-201
00725133413570721

USPTO
07/25/2010 13:49:35 EDT

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

Application serial no. 77697117 has been amended as follows:

ARGUMENT(S)

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

The Office Action maintains and makes final a refusal on grounds that Applicant's product replacement program does not constitute a service as contemplated by the Trademark Act.

Applicant respectfully disagrees and requests reconsideration of this refusal based on the following arguments, evidence, and authority. **Applicant's services and services description meet the requirements of the TMEP.**

Applicant initially notes that it has amended its services description to read as follows:

- **“providing extended warranties on window fashions in the nature of a product replacement plan”** in Class 36.

This amended language should be accepted because it follows the USPTO's ID Manual, which includes an entry in Class 36 for **“providing extended warranties on ...[specify items]”** See attached copy of an excerpt from the USPTO's ID Manual showing various entries for “warranty services.”

Moreover, Applicant's product replacement plan services are “qualitatively different” from anything normally done in the Applicant's industry, and Applicant's incorporation of the term “extended” into its services description, as amended herein, highlights and recognizes that fact. See TMEP Section 1301.01(b)(ii) (**“For the “warranty” service to be considered a separate service, the identification of services should include the word “extended” or other similar terminology (i.e., words that recognize the fact that the service is “qualitatively different” from anything normally done in connection with the sale of the applicant's goods/services) .**)

In this regard, Applicant's window fashions are goods that are installed into the window frame, and, as a result, are **goods that cannot be easily exchanged**. And, because many consumers do not install window fashions by themselves (but instead purchase installation services as part of the purchase of the window fashions), returning the products necessarily requires more time and expense than just returning a boxed item to the store.

Applicant's replacement program involves sending an installer to the home where the window fashions have been installed to remove the original window fashions and to install the replacement ones. Based on Applicant's understanding of its own industry, **this is not industry practice**.

And, it must be emphasized that this **replacement** program is different from Applicant's **warranty** program. The **warranty** program covers defects in materials, workmanship, and failure to operate, whereas the **replacement** program covers instances where the consumers are not satisfied with the look and appearance of the window fashions. Applicant's own advertising bears out this difference in that it separately promotes the warranty and replacement programs. This is significant in the analysis. In re Orion Research Inc., 669 F.2d 689, 205 USPQ 688 (C.C.P.A. 1980) (guarantee of repair or replacement of applicant's goods **that is not separately offered, promoted, or charged** for is not a service); In re Lenox, Inc., 228 USPQ 966 (TTAB 1986) (lifetime warranty **that is not separately offered, promoted, or charged** for is not a service).

Applicant's services are separately promoted and are qualitatively different from anything normally done in connection with the sale of Applicant's goods.

Accordingly, and based on the foregoing evidence and arguments, Applicant respectfully requests the Examiner to withdraw the refusal and to approve Applicant's mark for publication.

EVIDENCE

Evidence in the nature of excerpts from the USPTO's ID Manual has been attached.

Original PDF file:

evi_2162058535-133413570_._ID_Manual_entries_for_warranty_services.pdf

Converted PDF file(s) (1 page)

Evidence-1

CLASSIFICATION AND LISTING OF GOODS/SERVICES

Applicant hereby deletes the following class of goods/services from the application.

Class 035 for Product replacement program

Applicant hereby adds the following class of goods/services to the application:

New: Class 036 (Original Class: 035) for providing extended warranties on window fashions in the nature of a product replacement program

Filing Basis: Section 1(a), Use in Commerce: The mark was first used at least as early as 10/01/2008 and first used in commerce at least as early as 10/01/2008, and is now in use in such commerce.

SIGNATURE(S)

Request for Reconsideration Signature

Signature: /Andrew Roppel/ Date: 07/25/2010

Signatory's Name: Andrew Roppel

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: 77697117

Internet Transmission Date: Sun Jul 25 13:49:35 EDT 2010

TEAS Stamp: USPTO/RFR-216.205.85.35-2010072513493595

5974-77697117-4705e51a3d18c275958542acab

54f1e4f0-N/A-N/A-20100725133413570721



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Trademarks > Trademark Acceptable Identification of Goods & Services

Trademark ID Manual



Refine Search: WARRANTY

Documents: 1 - 9 of 9

Hit No.	Class	Description	Status	Effective Date	Type	Note	Trilateral
1	035	Home warranty services, namely, arranging for repairs and replacement of major home systems, appliances and parts thereof provided by others pursuant to service agreements	A	28 May 09	S	N	
2	035	Processing warranty registration documents for others	A	06 Aug 01	S	N	
3	036	Extended warranty services, namely, service contracts	A	27 May 10	S	N	
4	036	Insurance services, namely, underwriting extended warranty contracts in the field of {indicate specific field, e.g. automobiles, stores}	A	02 Apr 91	S	N	
5	036	Providing extended warranties on {specify items}	A	02 Apr 91	S	Y	
6	036	Providing home warranty administration	A	19 Apr 07	S	N	
7	036	Providing warranties on goods manufactured by others, namely, {specify items being warrantied}	A	23 Jul 09	S	N	
8	036	Underwriting warranty programs in the field of {indicate specific field, e.g. appliances, automobiles}	A	02 Apr 91	S	N	
9	036	Warranty claims administration services, namely, processing warranty claims for {indicate field of warranty}	A	01 Sep 95	S	N	

Refined Search: WARRANTY

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