

Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	78870261
LAW OFFICE ASSIGNED	LAW OFFICE 115
MARK SECTION (no change)	
ARGUMENT(S)	
<p>The Examining Attorney has maintained the refusal of registration on the basis that the mark is merely descriptive and, therefore, unregistrable on the Principal Register pursuant to Section 2(e) (1) of the Trademark Act. Applicant respectfully traverses this finding and asserts that mark PreFormed as used in connection with substrate is suggestive.</p> <p>Again, it is a well established that a mark is suggestive if a multi-stage reasoning process or the utilization of imagination, thought or perception is required in order to determine the attributes of the goods used in connection with the mark. <i>See, e.g., In re Abcor Development Corp.</i>, 200 USPQ 215 (CCAP 1978). Moreover, as pointed out before, "if the mental leap between the word and products attributes is not almost instantaneous, this strongly indicates suggestiveness, not direct descriptiveness." McCarthy, <i>McCarthy on Trademarks and Unfair Competition</i>, 4th Edition. Section 11:67 <i>citing Investacorp, Inc. v. Arabian Investment Banking Corp.</i>, 931 F.2d 1519 (11th Cir. 1991); <i>See, also No Nonsense Fashions, Inc. v. Consolidated Foods Corp.</i> 226 U.S.P.Q. 502 (TTAB 1995), <i>In re Stroh Brewery Co.</i>, 34 USPQ2d 1796 (TTAB 1994)(VIRGIN held <u>not</u> descriptive of a non-alcoholic malt beverage.)(emphasis added.)</p> <p>When viewed in connection with Applicant's goods, the mark "PreFormed" requires imagination and, therefore, is suggestive. Consumers, upon seeing Applicant's goods, would recognize that Applicant's goods are substrates to showers, tubs, and similar installations, but would be required to use <u>some</u> imagination to understand that Applicant's goods are structured to allow someone to create a finished part of a shower, tub, etc. Again, Applicant's goods are not the materials that one sees when looking at a finished shower, tub, or the like. Rather they are the materials underneath that make up only parts of and support such features in an entire shower, tub or a similar installation. Therefore, consumers will be required to use some thought when seeing the mark used in connection with Applicant's goods. If the term VIRGIN can be found suggestive for non-alcoholic beverages, then its mark is certainly suggestive and not merely descriptive. Applicant respectfully requests its mark be given the same treatment and allowed to register on the Principal Register.</p> <p style="text-align: center;">In the alternative, should the Examining Attorney maintain that Applicant's mark is merely</p>	

descriptive of its goods, Applicants submits that its mark, "PreFormed," has acquired distinctiveness. Applicant submits that consumers recognize "PreFormed" as a trademark substantially, exclusive of Applicant. Applicant herewith submits its statement that it has substantially exclusive and continuously used "PreFormed" as a mark for five years prior to this statement. In view of the foregoing, it is believed that the application is now in condition for registration on the Principal Register if it is necessary, and the same is respectfully requested.

Applicant believes that it has responded to all the outstanding issues raised in the Office Action, and the Application is now in position to proceed promptly onto publication. Notification of same is respectfully requested. If the Examining Attorney has any questions regarding the above application, she is encouraged to contact the undersigned attorney.

Respectfully submitted,

ADDITIONAL STATEMENTS SECTION

SECTION 2(f)	"The mark has become distinctive of the goods/services through the applicant's substantially exclusive and continuous use in commerce for at least the five years immediately before the date of this statement."
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SIGNATURE SECTION

DECLARATION SIGNATURE	/LisaKSchaffer/
SIGNATORY'S NAME	Lisa K. Schaffer
SIGNATORY'S POSITION	Vice President
DATE SIGNED	12/03/2007
RESPONSE SIGNATURE	/Sarah O. Graber/
SIGNATORY'S NAME	Sarah Otte Graber
SIGNATORY'S POSITION	Attorney for Applicant
DATE SIGNED	12/03/2007
AUTHORIZED SIGNATORY	YES
CONCURRENT APPEAL NOTICE FILED	YES

FILING INFORMATION SECTION

SUBMIT DATE	Mon Dec 03 15:47:44 EST 2007
TEAS STAMP	USPTO/RFR-216.68.126.18-2 0071203154744437667-78870 261-4101dd257b7b84642a79a bbbfd6688c4e8c-N/A-N/A-20 071203151735952808

Request for Reconsideration after Final Action

To the Commissioner for Trademarks:

Application serial no. **78870261** has been amended as follows:

ARGUMENT(S)

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

The Examining Attorney has maintained the refusal of registration on the basis that the mark is merely descriptive and, therefore, unregistrable on the Principal Register pursuant to Section 2(e)(1) of the Trademark Act. Applicant respectfully traverses this finding and asserts that mark PreFormed as used in connection with substrate is suggestive.

Again, it is a well established that a mark is suggestive if a multi-stage reasoning process or the utilization of imagination, thought or perception is required in order to determine the attributes of the goods used in connection with the mark. *See, e.g., In re Abcor Development Corp.*, 200 USPQ 215 (CCAP 1978). Moreover, as pointed out before, "if the mental leap between the word and products attributes is not almost instantaneous, this strongly indicates suggestiveness, not direct descriptiveness." McCarthy, *McCarthy on Trademarks and Unfair Competition*, 4th Edition. Section 11:67 *citing Investacorp, Inc. v. Arabian Investment Banking Corp.*, 931 F.2d 1519 (11th Cir. 1991); *See, also No Nonsense Fashions, Inc. v. Consolidated Foods Corp.* 226 U.S.P.Q. 502 (TTAB 1995), *In re Stroh Brewery Co.*, 34 USPQ2d 1796 (TTAB 1994)(VIRGIN held not descriptive of a non-alcoholic malt beverage.)(emphasis added.)

When viewed in connection with Applicant's goods, the mark "PreFormed" requires imagination and, therefore, is suggestive. Consumers, upon seeing Applicant's goods, would recognize that Applicant's goods are substrates to showers, tubs, and similar installations, but would be required to use some imagination to understand that Applicant's goods are structured to allow someone to create a finished part of a shower, tub, etc. Again, Applicant's goods are not the materials that one sees when looking at a finished shower, tub, or the like. Rather they are the materials underneath that make up only parts of and support such features in an entire shower, tub or a similar installation. Therefore, consumers will be required to use some thought when seeing the mark used in connection with Applicant's goods. If the term VIRGIN can be found suggestive for non-alcoholic beverages, then its mark is certainly suggestive and not merely descriptive. Applicant respectfully requests its mark be given the same treatment and allowed to register on the Principal Register.

In the alternative, should the Examining Attorney maintain that Applicant's mark is merely descriptive of its goods, Applicants submits that its mark, "PreFormed," has acquired distinctiveness. Applicant submits that consumers recognize "PreFormed" as a trademark substantially, exclusive of Applicant. Applicant herewith submits its statement that it has substantially exclusive and continuously used "PreFormed" as a mark for five years prior to this statement. In view of the foregoing, it is believed that the application is now in condition for registration on the Principal

Register if it is necessary, and the same is respectfully requested.

Applicant believes that it has responded to all the outstanding issues raised in the Office Action, and the Application is now in position to proceed promptly onto publication. Notification of same is respectfully requested. If the Examining Attorney has any questions regarding the above application, she is encouraged to contact the undersigned attorney.

Respectfully submitted,

ADDITIONAL STATEMENTS

Section 2(f), based on Use

"The mark has become distinctive of the goods/services through the applicant's substantially exclusive and continuous use in commerce for at least the five years immediately before the date of this statement."

SIGNATURE(S)

Declaration Signature

If the applicant is seeking registration under Section 1(b) and/or Section 44 of the Trademark Act, the applicant 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). 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 or services listed in the application as of the application filing date. 37 C.F.R. Secs. 2.34(a)(1)(i). 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. §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. §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: /LisaKSchaffer/ Date: 12/03/2007

Signatory's Name: Lisa K. Schaffer

Signatory's Position: Vice President

Request for Reconsideration Signature

Signature: /Sarah O. Graber/ Date: 12/03/2007

Signatory's Name: Sarah Otte Graber

Signatory's Position: Attorney for Applicant

The signatory has confirmed that he/she is either (1) an attorney who is a member in good standing of the bar of the highest court of a U.S. state; or (2) a Canadian attorney/agent who has been granted reciprocal recognition under 37 C.F.R. §10.14(c) by the USPTO's Office of Enrollment and Discipline.

He/she further confirms that (1) the applicant has not previously been represented in this matter by an authorized attorney; and (2) he/she is the applicant's attorney or an associate of that attorney.

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

Serial Number: 78870261

Internet Transmission Date: Mon Dec 03 15:47:44 EST 2007

TEAS Stamp: USPTO/RFR-216.68.126.18-2007120315474443

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