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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	79083340
Applicant	Gilltec GmbH
Applied for Mark	APPLIQUATOR
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In re Application of: Gilltec GmbH
Serial Number: 79083340
International Reg. No.: 1040878
Filing Date: February 8, 2010
Mark: APPLIQUATOR
Law Office: 116
Examining Attorney: Alice Medina Benmaman

APPLICANT'S APPEAL BRIEF

This brief is in furtherance of the Notice of Appeal submitted April 5, 2012. Applicant respectfully appeals from the Examining Attorney's Final Office Action of October 13, 2011 and Denial of Request for Reconsideration dated May 18, 2012. The present appeal involves a single issue: whether the mark is merely descriptive under Trademark Act Section 2(e)(1). The Examining Attorney's ground of refusal is addressed below.

I. The mark is not descriptive

The Examining Attorney has refused registration under Section 2(e)(1) on the alleged basis that "the applied-for mark merely describes a feature or characteristic of applicant's goods" (Final Office Action dated October 13, 2011, page 2). In particular, the Examining Attorney asserts that "applicant's proposed mark, APPLIQUATOR, is a novel spelling of the word 'APPLICATOR,'" and that the word "applicator" is descriptive as applied to certain of Applicant's goods, namely "containers, cylinders, canisters filled with adhesives for industrial purposes," in International Class 001; "containers, cylinders, canisters filled with cosmetics, tooth bleaching preparations or dental bleaching gels," in International Class 003; "containers,

cylinders, canisters filled with dental cements, teeth filling material, dental adhesives, lacquer for dental purposes,” in International Class 005; and “Dental instruments for use in applying dental substances,” in International Class 010 (Final Office Action, page 2). The Examining Attorney further asserts that “[a] novel spelling or an intentional misspelling *that is the phonetic equivalent of a merely descriptive word or term* is also merely descriptive if purchasers would perceive the different spelling as the equivalent of the descriptive word or term” (Final Office Action, page, 3) (emphasis added). Applicant respectfully disagrees with each of the Examining Attorney’s contentions.

A. APPLIQUATOR is a coined term

The term APPLIQUATOR is a coined term that, to the best of Applicant’s knowledge, is not recognized in any known language, and has no recognized meaning outside of Applicant’s own usage. As such, the term APPLIQUATOR is not a novel spelling or an intentional misspelling of the word APPLICATOR.

B. Neither APPLIQUATOR nor APPLICATOR is descriptive

Neither APPLIQUATOR nor APPLICATOR is a descriptive term for the cited goods because none of the cited goods is an applicator or operates similarly to an applicator. Even “dental instruments for use in applying dental substances” cannot be characterized as “applicators”; as with other dental instruments such as forceps, probes, curettes, retractors, bone files, and scalpels, they are sophisticated and specialized dental instruments that have a unique function and special qualities. The fact that one of these instruments may be used to apply a substance to a tooth does not mean it primarily functions as an “applicator.”

C. APPLIQUATOR is not the phonetic equivalent of APPLICATOR

The Examining Attorney argues that the letters “QU” may be pronounced like a “K,” and because of that, the term APPLIQUATOR will be pronounced the same way as the word APPLICATOR, and “purchasers would perceive the proposed mark as the equivalent of ‘APPLICATOR’” (Office Action, page 3). As evidence, the Examining Attorney offered Internet website evidence from (1)

http://www.classzone.com/books/language_of_lit_gr08/spelling/spell_student_22.cfm, (2)

<http://www.say-it-in-english.com/BasicEnglish7.html>, and (3)

http://en.wikipedia.org/wiki/Hard_and_soft_C. However, while the evidence offered by the Examining Attorney demonstrates that, in some (but not all) circumstances, the letters QUE can be pronounced like a K, it also demonstrates that in the English language, the letters QUA are *invariably* pronounced like a KW, rather than like a K. For example, the evidence from www.classzone.com lists the words UNIQUE, CLIQUE, PLAQUE, MASQUERADE, CONQUER, and LACQUER as examples of QU pronounced like a K, but each of these words uses the letter combination QUE to produce the K sound. In contrast, each of the listed words using the QUA letter combination used in APPLIQUATOR (in addition to all of the other listed words using QUE and QUI), namely, ACQUAINTED, ADEQUATELY, QUAIN, and QUARANTINE, are pronounced with a KW sound (the lesson also notes that “[i]n most words, qu is pronounced /kw/”). Similarly, in the evidence from www.say-it-in-english.com, BISQUE, TOQUE, BRIQUETTE, and CROQUET are listed as examples of QU pronounced as a K, each of which uses the QUE letter combination. The sole example provided by the Examining Attorney of a word using the QUA letter combination from www.say-it-in-english.com is QUAKE, which is pronounced with a KW sound. The evidence from en.wikipedia.org provides

no examples of words in which the letter combination QUA is pronounced K rather than KW. Applicant thus respectfully submits that the evidence offered by the Examining Attorney not only fails to demonstrate that the QUA letter combination can be pronounced like a K, but in fact uniformly establishes that QUA is properly pronounced as KW.

As additional evidence, Applicant submitted with its response of April 5, 2012 Internet website evidence from http://en.wikipedia.org/wiki/English_orthography demonstrating that the QUA letter combination is properly pronounced like a KW under English language pronunciation rules (see page 12). While the proffered evidence uses the examples QUANTITY, QUAD, QUANGO, QUARTER, and QUART, the English language is replete with other examples of words using the QUA letter combination pronounced as KW, such as ANTIQUATE, AQUARIUM, AQUATIC, EQUAL, EQUATION, EQUATOR, LIQUATION, LOQUACIOUS, QUAALUDE, QUACK, QUAFF, QUAGMIRE, QUAIL, QUAKE, QUALIFY, QUALMS, QUANDARY, QUARK, QUARREL, QUARRY, QUARTZ, QUASAR, QUASH, QUASI, QUATERNARY, QUATRIN, QUAVERING, SQUABBLE, SQUAD, SQUALL, SQUALOR, SQUANDER, SQUARE, SQUASH, SQUATTER, and SQUAWK, to name but a few. Because the QUA letter combination is properly pronounced as KW, the proper English pronunciation of the coined term APPLIQUATOR is APPLIKWATOR, rather than APPLICATOR. As such, the term APPLIQUATOR is not the phonetic equivalent of the word APPLICATOR, would not be perceived by purchasers as the equivalent of the word APPLICATOR, and is not a novel spelling or an intentional misspelling of the word APPLICATOR, since the two words have distinct and dissimilar pronunciations. Thus, even if the word APPLICATOR was deemed to be descriptive or generic as applied to Applicant's goods (which Applicant does not believe to be the case), the

coined term APPLIQUATOR is not, and cannot, be the equivalent, phonetic or otherwise, of the word APPLICATOR.

As discussed above, all of the evidence in the record supports a single conclusion: the QUA letter combination in the term APPLIQUATOR is properly pronounced as KW, rather than as K. There is no evidence whatsoever in the record that establishes that the QUA letter combination in the term APPLIQUATOR is properly pronounced as K, rather than as KW. As such, Applicant respectfully submits that the term APPLIQUATOR (1) is a coined term that does not describe any feature or characteristic of Applicant's goods, (2) is not descriptive or generic as applied to the goods, (3) is properly pronounced APPLIKWATOR, (4) is not the equivalent, phonetic or otherwise, of the word APPLICATOR, and (5) is not a novel spelling or an intentional misspelling of the word APPLICATOR. Applicant therefore respectfully submits that refusal under Section 2(e)(1) was improper.

II. The descriptiveness refusal was improperly raised

The instant application was filed as a request for extension of protection based on International Registration No. 1040878. The examination of such requests for extension of protection is governed by Trademark Act Section 68(c) (15 U.S.C. § 1141h), which provides, in pertinent part:

(c) Notice to International Bureau.—

(1) Within 18 months after the date on which the International Bureau transmits to the Patent and Trademark Office a notification of a request for extension of protection, the Director shall transmit to the International Bureau any of the following that applies to such request:

(A) A notification of refusal based on an examination of the request for extension of protection.

(B) A notification of refusal based on the filing of an opposition to the request.

(C) A notification of the possibility that an opposition to the request may be filed after the end of that 18-month period.

(2) If the Director has sent a notification of the possibility of opposition under paragraph (1)(C), the Director shall, if applicable, transmit to the International Bureau a notification of refusal on the basis of the opposition, together with a statement of all the grounds for the opposition, within 7 months after the beginning of the opposition period or within 1 month after the end of the opposition period, whichever is earlier.

(3) If a notification of refusal of a request for extension of protection is transmitted under paragraph (1) or (2), no grounds for refusal of such request other than those set forth in such notification may be transmitted to the International Bureau by the Director after the expiration of the time periods set forth in paragraph (1) or (2), as the case may be.

(4) If a notification specified in paragraph (1) or (2) is not sent to the International Bureau within the time period set forth in such paragraph, with respect to a request for extension of protection, the request for extension of protection shall not be refused and the Director shall issue a certificate of extension of protection pursuant to the request.

Under Section 68(c)(1), the Trademark Office has eighteen months from the date of transmission of the request for extension of protection to notify the International Bureau of a refusal based on an examination of the request for extension of protection. Under Section 68(c)(3), if a notification of a refusal is sent to the International Bureau, no grounds for refusal other than those set forth in such notification may be transmitted to the International Bureau by the Director after the expiration of the eighteen month time period. Under Section 68(c)(4), if a notification of a refusal is not sent to the International Bureau within the eighteen month time period, then “the request for extension of protection shall not be refused and the Director shall issue a certificate of extension of protection pursuant to the request.” Further guidance is provided by TMEP § 1904.03(a), which states as follows:

If upon re-examination the examining attorney determines a new ground of refusal exists, a second Office action raising this new ground may be issued only if time remains in the 18-month period. In such a case, the examining attorney must contact the MPU upon issuance of the Office action, so that a notification of the new ground of refusal can be sent to the IB.

As explained below, Applicant respectfully submits that the Trademark Office has failed to comply with Section 68(c) and TMEP § 1904.03(a), and as such, the refusal under Section 2(e)(1) was improperly raised.

The instant application was filed as a request for extension of protection based on International Registration No. 1040878 on July 1, 2010. According to Section 68(c) and the TARR database, the date of automatic protection based on the expiration of the eighteen month period was January 1, 2012. A non-final first Office Action was sent to the International Bureau on July 14, 2010, which raised indefiniteness issues with the identification of goods, but did not raise any grounds for refusal under Section 2(e)(1). Following Applicant's response of October 29, 2010, the application was approved for publication on November 17, 2010. The application was then withdrawn from publication on December 20, 2010, and a second, non-final Office Action was mailed on March 21, 2011. The refusal under Section 2(e)(1) was raised for the first time in the second Office Action. However, the Trademark Office failed to notify the International Bureau of the second Office Action, which was sent directly to Applicant's counsel. Applicant responded on September 21, 2011, and the third, final Office Action was mailed to Applicant's counsel on October 13, 2011. As with the second Office Action, the Trademark Office failed to notify the International Bureau of the third Office Action, which made final the refusal under Section 2(e)(1). Because of this, the International Bureau was never notified of the grounds of refusal under Section 2(e)(1) prior to the January 1, 2012 date of automatic protection.

Under Section 68(c) and TMEP § 1904.03(a), the Trademark Office must notify the International Bureau of any grounds for refusal of a request for extension of protection within eighteen months

of the request, and if such a notification is sent to the International Bureau, no grounds for refusal other than those set forth in such notification may be transmitted to the International Bureau after the expiration of the eighteen month time period. Since the Trademark Office sent a notification of refusal to the International Bureau (the first Office Action) that did not raise the grounds of refusal under Section 2(e)(1), and did not sent any notification of refusal prior to January 1, 2012 that did raise the grounds of refusal under Section 2(e)(1) (the second and third Office Actions), the un-notified grounds of refusal under Section 2(e)(1) cannot properly be raised by the Trademark Office as a basis for refusal of a request for extension of protection under Section 68(c) and TMEP § 1904.03(a). Moreover, since the January 1, 2012 date of automatic protection has passed, the Trademark Office has no recourse under Section 68(c) other than to withdraw the refusal under Section 2(e)(1) and allow the application to proceed to the publication stage. Indeed, according to the official record of International Registration No. 1040878 at the World Intellectual Property Organization website, the examination period has been completed in the United States, and the International Bureau has no awareness or recognition of the Final Office Action of October 13, 2011 or the untimely-raised grounds of refusal under Section 2(e)(1). In view of the above, Applicant respectfully submits that the refusal under Section 2(e)(1) was improperly raised, in contravention of Section 68(c) and TMEP § 1904.03(a).

III. Conclusion

For the foregoing reasons, Applicant respectfully submits that the mark is not merely descriptive under Trademark Act Section 2(e)(1). Applicant therefore respectfully requests that the Board render a decision that the refusal should be withdrawn and the application advanced to registration.

Respectfully submitted,
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Date: July 20, 2012

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