

From: Bracey, Karen

Sent: 7/6/2013 6:59:07 PM

To: TTAB E Filing

CC:

Subject: U.S. TRADEMARK APPLICATION NO. 79100238 - Z - 03738-T0010A - Request for
Reconsideration Denied - Return to TTAB

Attachment Information:

Count: 1

Files: 79100238.doc

**UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)
OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION**

U.S. APPLICATION SERIAL NO. 79100238

MARK: Z



CORRESPONDENT ADDRESS:

WESLEY W WHITMYER JR

ST ONGE STEWARD JOHNSTON & REENS LLC

986 BEDFORD ST

STAMFORD, CT 06905-5619

GENERAL TRADEMARK INFORMATION:

<http://www.uspto.gov/trademarks/index.jsp>

APPLICANT: Netzsch-Feinmahltechnik GmbH

CORRESPONDENT'S REFERENCE/DOCKET NO:

03738-T0010A

CORRESPONDENT E-MAIL ADDRESS:

tm-pto@ssjr.com

REQUEST FOR RECONSIDERATION DENIED

ISSUE/MAILING DATE: 7/6/2013

INTERNATIONAL REGISTRATION NO. 1084748

The trademark examining attorney has carefully reviewed applicant's request for reconsideration and is denying the request for the reasons stated below. See 37 C.F.R. §2.64(b); TMEP §§715.03(a)(2)(B), (a)(2)(E), 715.04(a). The requirement(s) and/or refusal(s) made final in the Office action dated 12/14/2012 are maintained and continue to be final. See TMEP §§715.03(a)(2)(B), (a)(2)(E), 715.04(a).

In the present case, applicant's request has not resolved all the outstanding issue(s), nor does it raise a new issue or provide any new or compelling evidence with regard to the outstanding issue(s) in the final Office action. In addition, applicant's analysis and arguments are not persuasive nor do they shed new light on the issues. Accordingly, the request is denied.

The filing of a request for reconsideration does not extend the time for filing a proper response to a final Office action or an appeal with the Trademark Trial and Appeal Board (Board), which runs from the date the final Office action was issued/mailed. See 37 C.F.R. §2.64(b); TMEP §715.03, (a)(2)(B), (a)(2)(E), (c).

If time remains in the six-month response period to the final Office action, applicant has the remainder of the response period to comply with and/or overcome any outstanding final requirement(s) and/or refusal(s) and/or to file an appeal with the Board. TMEP §715.03(a)(2)(B), (c). However, if applicant has already filed a timely notice of appeal with the Board, the Board will be notified to resume the appeal when the time for responding to the final Office action has expired. See TMEP §715.04(a).

Evidence of Acquired Distinctiveness Insufficient

Registration was refused because the applied-for mark consists of a nondistinctive product design or nondistinctive features of a product design that is not registrable on the Principal Register without sufficient proof of acquired distinctiveness. Trademark Act Sections 1, 2, and 45, 15 U.S.C. §§1051-1052, 1127; *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 210, 213-14, 54 USPQ2d 1065, 1068-69 (2000); *In re Slokevage*, 441 F.3d 957, 961, 78 USPQ2d 1395, 1398 (Fed. Cir. 2006); see TMEP §1202.02(b)(i).

The applicant has submitted ten declarations from members of the relevant consuming public, namely, those who would use industrial stirring equipment or stands for such equipment, in support of the claim of acquired distinctiveness. For the reasons that follow, this evidence is unacceptable and the final refusal is maintained and continued.

As noted, if the applicant submits actual evidence to support a claim under Section 2(f), the **evidence must relate to the promotion and recognition of the specific configuration embodied in the applied-for mark** and not to the goods in general. See, e.g., *In re ic! berlin brillen GmbH*, 85 USPQ2d 2021, 2023 (TTAB 2008); *In re Edward Ski Prods. Inc.*, 49 USPQ2d 2001, 2005 (TTAB 1999); *In re Pingel Enter. Inc.*, 46 USPQ2d 1811, 1822 (TTAB 1998).

The examiner does not question that the declarations are from consumers who indeed are familiar with the applicant's goods and that the goods in question are highly specialized pieces of industrial equipment. The declarations are insufficient because they only support a determination that the industrial consumers recognize the applicant's goods. This recognition does not equate to distinctiveness. There is no statement, for example, that the relevant consumers look for the Z-shaped stand. The consumers might all agree that the applicant produces fine products but there is nothing to suggest that they recognize that the Z configuration is used as a trademark to indicate the source of the goods. Moreover, there is no indication that the applicant specifically marketed and promoted this Z-shape as being the trademark. As mentioned in the Final action, there is simply no evidence of any "look for" advertising or marketing with regard to the actual Z shape. Further, the examiner could not find any evidence during an online search of any mention of the claimed configuration or Z shape and it being used as a trademark. Using the term "Zeta" or "Zetabeads" is simply not enough to equate to acquired distinctiveness.

In determining whether the applied-for mark has acquired distinctiveness, the following factors are generally considered: (1) length and exclusivity of use of the mark in the United States by applicant; (2) the type, expense and amount of advertising of the mark in the United States; and (3) applicant's efforts in the United States to associate the mark with the source of the goods, such as in unsolicited media coverage and consumer studies. See *In re Steelbuilding.com*, 415 F.3d 1293, 1300, 75 USPQ2d 1420, 1424 (Fed. Cir. 2005). A showing of acquired distinctiveness need not consider all of these factors, and no single factor is determinative. *In re Steelbuilding.com*, 415 F.3d at 1300, 75 USPQ2d at 1424; see TMEP §§1212.06 *et seq.*

In establishing acquired distinctiveness, applicant may not rely on use other than use in commerce that may be regulated by the United States Congress. Use solely in a foreign country or between two foreign countries is not evidence of acquired distinctiveness in the United States. *In re Rogers*, 53 USPQ2d 1741, 1746 (TTAB 1999); TMEP §§1010, 1212.08.

The burden of proving that a mark has acquired distinctiveness is on the applicant. *Yamaha Int'l Corp. v. Yoshino Gakki Co.*, 840 F.2d 1572, 6 USPQ2d 1001, 1004 (Fed. Cir. 1988); *In re Meyer & Wenthe, Inc.*, 267 F.2d 945, 122 USPQ 372 (C.C.P.A. 1959); TMEP §1212.01. An applicant must establish that the **purchasing public has come to view the proposed mark as an indicator of origin.**

Allegations of sales and advertising expenditures do not per se establish that a term has acquired significance as a mark. An applicant must also provide the actual advertising material so that the examining attorney can determine how the term is used, the commercial impression created by such use, and the significance the term would have to prospective purchasers. TMEP §1212.06(b); see *In re Boston Beer Co.*, 198 F.3d 1370, 53 USPQ2d 1056 (Fed. Cir. 1999); *In re Packaging Specialists, Inc.*, 221 USPQ 917, 920 (TTAB 1984).

The ultimate test in determining acquisition of distinctiveness under Trademark Act Section 2(f) is not applicant's efforts, but applicant's success in educating the public to associate the claimed mark with a single source. TMEP §1212.06(b); see *In re Packaging Specialists*, 221 USPQ at 920; *In re Redken Labs., Inc.*, 170 USPQ 526 (TTAB 1971).

For the above reasons, the examiner finds the declarations submitted in support of a claim under Section 2(f) to be insufficient and this request for reconsideration is denied and the Final Refusal is maintained and continued.

If applicant has questions regarding this Office action, please telephone or e-mail the assigned trademark examining attorney. All relevant e-mail communications will be placed in the official application record; however, an e-mail communication will not be accepted as a response to this Office action and will not extend the deadline for filing a proper response. See 37 C.F.R. §2.191; TMEP §§304.01-.02, 709.04-.05. Further, although the trademark examining attorney may provide additional explanation pertaining to the refusal(s) and/or requirement(s) in this Office action, the trademark examining attorney may not provide legal advice or statements about applicant's rights. See TMEP §§705.02, 709.06.

/Karen Bracey/

Karen Bracey

Examining Attorney

Law Office 116

571-272-9132

karen.bracey@uspto.gov