

Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	79103101
LAW OFFICE ASSIGNED	LAW OFFICE 115
MARK SECTION (no change)	
ARGUMENT(S)	
<p><u>Refusal Under Section 2(d)</u></p> <p>The Examining Attorney maintained the refusal with respect to the registration of Applicant's Mark on the ground that the marks in U.S. Registration Nos. 3216689, 3219218, and 3219219 ("Registrant's Marks") are confusingly similar to Applicant's Mark. Applicant respectfully disagrees with the Examining Attorney, and requests reconsideration of the refusal to register.</p> <p>The standard for determining whether two marks are likely to be confused is set forth in <i>In re E.I. Du Pont de Nemours & Co.</i>, 177 USPQ 563 (CCPA 1973); see also TMEP § 1207.01. The <i>DuPont</i> case establishes a number of factors to be considered in the analysis of whether two marks are likely to be confused under Section 2(d) of the Lanham Act, 15 U.S.C. Section 1052(d). Each factor may play a more dominant or diminished role depending on the facts of each case. <i>DuPont</i>, 177 USPQ at 567. No single factor is dispositive. <i>Id.</i> The Examining Attorney need not consider all factors, but may consider those factors that are most relevant to the case at hand. See <i>In re Dixie Restaurants, Inc.</i>, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997); <i>Kimberly-Clark Corp. v. H. Douglas Enterprises, Ltd.</i>, 227 USPQ 541, 542 (Fed. Cir. 1985).</p> <p>The relevant <i>DuPont</i> factors in this case are: (1) the differences in the services offered under Applicant's and Registrant's Marks; (2) the differences in the respective channels of trade; and (3) the purchasing conditions and sophistication of the buyers.</p> <p>Under the Trademark Act a refusal to register based upon a likelihood of confusion requires that confusion as to the source of the goods be likely, not merely possible; as the Second Circuit has stated, "likelihood of confusion means a probability of confusion; it is not sufficient if confusion is merely 'possible.'" <i>Estee Lauder, Inc. v. The Gap, Inc.</i>, 42 USPQ2d 1228, 1232 (2nd Cir. 1997) (internal quotations omitted) quoting 3 J. McCarthy, <i>Trademarks and Unfair Competition</i>, § 23:2 (1996) (now at 4 McCarthy on Trademarks and Unfair Competition § 23.3 (4th ed. 2012). When the relevant <i>DuPont</i> factors are considered in relation to the Applicant's TMT SOMA mark, each factor weighs in favor of allowing Applicant's Mark to register.</p> <p>As noted previously, Applicant's goods are directed toward specific industries, in particular, the iron, steel and related industries. Where the goods or services are dissimilar or are completely unrelated, no</p>	

likelihood of confusion will be found even if the marks are very similar. See e.g. *Shen Mfg. Co., Inc. v. Ritz Hotel Ltd.*, 73 USPQ2d 1350 (Fed Cir. 2004) (RITZ for cooking classes and RITZ for kitchen textiles not related); *Aries Systems Corp. v. World Book Inc.*, 26 USPQ2d 1926 (TTAB 1993) (computer programs sold under KNOWLEDGE FINDER not similar to computer programs sold under INFORMATION FINDER); *Flow Technology Inc. v. Picciano*, 18 USPQ2d 1970 (TTAB 1991) (OMNITRAX for computer programs for video store management not likely to be confused with OMNITRAK for flowmeter calibrator); *Local Trademarks, Inc. v. Handy Boys, Inc.*, 16 USPQ2d 1156 (TTAB 1990) (confusion not likely between LITTLE PLUMBERS for liquid drain opener and the identical mark for advertising services marketed to plumbing contractors); *Quartz Radiation Corp. v. Comm/Scope Co.*, 1 USPQ2d 1668 (TTAB 1986) (QR for coaxial cable held not confusingly similar to QR for various products (e.g. lamps, tubes) relating to the photocopying field).

It is not enough that “a general term or overarching relationship can be found to encompass them both.”

In re W.W. Henry Co., 82 USPQ2d 1213 (TTAB 2007) (PATCH & GO for Portland cement and PATCH ‘N GO for chemical filler both used to repair surface, held unrelated). Thus, in order to support a likelihood of confusion the goods and services must be related and the circumstances must be such that consumers will be confused as to source. As noted in Applicant’s prior office action response, Applicant’s goods are not telephone hardware or software products as noted in the cited registrations. Merely because both parties offer electronic technological products does not mean that consumers will encounter the parties’ products in a contest giving rise to source confusion. Quite the contrary, due to the highly specialized nature of Applicant’s and registrant’s goods, there is little opportunity for consumers to encounter the products together at all, let alone in a context giving rise to source confusion.

Applicant’s goods and services are marketed and offered in a totally different channel of trade than the Registrant’s goods and services. As noted previously, Applicant’s goods are technological solutions for the iron and steel industries, and related businesses. Registrant’s goods and services are related to telephony hardware and services. Thus, the conditions and activities surrounding the marketing of Applicant’s and Registrant’s respective marks are such that they would not be encountered by the same persons under circumstances that could give rise to the mistaken belief that they originate from the same source. See 1207.01(a)(i); *In re Hal Leonard Publishing Corp. d/b/a Hal Leonard Books*, 15 USPQ2d 1574, 1575 (TTAB 1990); *In re Total Quality Group, Inc.*, 51 USPQ2d 1474, 1476 (TTAB 1999). The threshold significance of the trade channels is whether the same class of persons is exposed to the marks at issue under circumstances likely to result in confusion. *Jeanne-Marc, Inc. v. Cluett, Peabody & Co., Inc.*, 221 USPQ 58, 61 (TTAB 1984); *TCPIP Holding Co. v. Haar Communications*, 57 USPQ2d 1969 (2d Cir. 2001) (similar buyers targeted). In this instance, it is clear from the above that the respective offerings move in distinct channels of trade and are marketed to distinct classes of consumers. Since the connection between the respective trade channels and consumers is tenuous at best, confusion is unlikely.

The offerings of the Applicant and those of Registrant are highly specialized and sophisticated. Consumers of Registrant’s and Applicant’s goods will exercise a high degree of care in selecting the appropriate offerings necessary to meet their needs. The degree of consumer sophistication and conditions under which the sale is made is yet another *DuPont* factor that weighs in favor of Applicant. *DuPont*, 476 F.2d at 1361-1362, 177 U.S.P.Q. at 567. Where consumers exercise a higher degree of care any possibility of confusion is substantially mitigated. See *In re Vision Wheel, Inc.*, Serial Nos. 77498758 and 77498755 (T.T.A.B., July 28, 2010) (the Board found that there was no likelihood of confusion between V-TEC for custom wheels and V-TEC for car engines; conditions of sale lead to a high degree of care when making purchases). Further, a purchaser who has a “reasonably focused need” or “specific purpose” or plan for the product, will exercise a high degree of care in selecting the

product that meets his or her needs. See e.g. *Haydon Switch & Instr., Inc. v. Rexnord, Inc.*, 4 U.S.P.Q.2d 1510, 1517 (D. Conn. 1987) (specific products for specific industrial purpose); *G.H. Mumm & Cie v. Desnoes & Geddes, Ltd.*, 917 F.2d 1292, 16 U.S.P.Q.2d 1635, 1638 (Fed. Cir. 1990) (“focused need” for champagne); *Cliffs Notes, Inc. v. Bantam Doubleday Dell Publi’g Group, Inc.*, 886 F.2d 490, 496, 12 U.S.P.Q.2d 1289, 1293 (2d Cir. 1989) (reader of Cliffs Notes probably has specific book in mind).

Both Registrant’s and Applicant’s goods are offered to distinct classes of highly sophisticated consumer. In the case of Applicant’s goods, its customers are those who require technological solutions for iron and steel foundries and related enterprises. By comparison, Registrant’s customers are in the market for telephony hardware and software. Consumers of the respective goods at issue are highly sophisticated and will therefore exercise a high degree of care in selecting the appropriate product that meets their particular needs, thereby mitigating the possibility of consumer confusion even further.

In light of the foregoing, Applicant respectfully submits that its mark will not be encountered by the relevant consuming public in such manner to give rise to confusion with the marks of the cited Registrant. There is no overlap in the channels of trade in which the parties’ goods and services move, and the relevant respective consumers thereof are sophisticated and will not erroneously mistake or confuse the source of the respective goods and services. Consequently, Applicant respectfully submits that the refusal under Section 2(d) is inappropriate, and requests reconsideration of the refusal.

Disclaimer

The Examining Attorney has maintained the requirement that “TMT” be disclaimed apart from the mark as shown, asserting that TMT is an acronym for “thermo-mechanical treatment”, and thus descriptive since it was alleged Applicant’s goods could be used for this type of treatment and Applicant’s services could feature this type of treatment.

Applicant respectfully disagrees with the requirement, and requests reconsideration thereof. A disclaimer functions as a concession by Applicant that the disclaimed term lacks inherent distinctiveness, and thus is descriptive. TMEP §1213. Applicant submits that such is not the case in the instant application. In order for a mark, or an element thereof, to be “merely descriptive” for purposes of Section 2(e)(1) of the Trademark Act, the mark at issue must directly and immediately convey knowledge of the characteristics of a product or service. *In re MBNA America Bank, N.A.*, 67 USPQ2d 1778, 1780 (Fed. Cir. 2003); *Equine Technologies Inc. v. Equitechnology Inc.*, 36 USPQ 2d 1659, 1661 (1st Cir. 1995) (“A [mark] is descriptive if it forthwith conveys an immediate idea of the ingredients, qualities, or characteristics of the goods” at issue.”) (citations omitted); J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition*, 4th Ed. (2012), § 11:67 (“If the mental leap between the word and the product’s attributes is not almost instantaneous, this strongly indicates suggestiveness and not descriptiveness.”). In other words, a mark is not descriptive if it requires imagination, thought and perception to reach a conclusion as to the nature of goods or services with which it is used. *Equine Technologies Inc.*, 36 U.S.P.Q. 2d at 1661 (citations omitted); see *No Nonsense Fashions, Inc. v. Consolidated Foods Corp.*, 226 USPQ 502, 507 (TTAB 1985) (SHEER ELEGANCE for hosiery did not convey an “immediate notion” as to any particular characteristic, quality or ingredient; mark suggestive in a laudatory sense); *Plyboo America, Inc. v. Smith & Fong Co.*, 51 USPQ 2d at 1642 (PLYBOO not descriptive of plywood made of bamboo); *In re Shutts*, 217 USPQ 363, 365 (TTAB 1983). (SNO-RAKE held not merely descriptive of a snow removal hand tool). Any doubts in this regard are to be

resolved in favor of the Applicant. *Id.*

As noted previously, the “TMT” in Applicant’s mark is ambiguous and thus disclaimer is inappropriate. The Examining alleges TMT will be perceived as an acronym for “thermo-mechanical treatment” and is thus descriptive. However, mere use of TMT in the context of the mark TMT SOMA does not necessarily evoke this single definition. As demonstrated previously, TMT has various definitions; forty-nine separate results for TMT was revealed as an acronym. Consumers confronted with Applicant’s mark will not immediately appreciate the term TMT conveys the association proffered by the Examining Attorney. The mark may be perceived by consumers as referring to one of the other associations of the acronym TMT, thus creating an incongruity impressing a unitary association to consumers. *In re Corporate Fuel Partners, LLC*, 2010 TTAB LEXIS 368 (Aug. 27, 2010) (finding that consumers would view the phrase CORPORATE FUEL, for business management services, as a play on actual types of fuel); *In re Cohber Press, Inc.*, 2007 TTAB LEXIS 210, *7 (Nov. 15, 2007) (finding that ARCTIC ART for coated printing paper “has an alliterative cadence” that “conveys the commercial impression of ‘art’ of the ‘arctic’”); *In re Bijoux Int’l*, 2001 TTAB LEXIS 175 (Feb. 27, 2001) (finding that EXTREME SPORT, for sports bags, handbags, luggage, refers to a non-traditional type of sport and creates a commercial impression that is separate from that created by the word SPORT alone).

The touchstone for a mark, or element thereof, to be merely descriptive and thus requiring disclaimer is not merely the conveyance of some aspect of the underlying goods and services, but that the proposed mark element must immediately call to a consumer’s mind a significant characteristic, function or feature of a good or services. See *In re Disc Jockeys Inc.*, 23 USPQ2d 1715 (TTAB 1992). In light of the foregoing discussion, the mark TMT SOMA does not immediately identify any particular significant aspect of Applicant’s goods or services. The term TMT on its own is too broad of an acronym to immediately impart to a consumer any immediate aspect of the Applicant’s goods and services. Instead, in the context of Applicant’s goods and services, the term “TMT” is suggestive of any number of possible interpretations, particularly when combined with the arbitrary and unrelated “SOMA”. “A certain amount of creative imagination is required” to intuit the specific attributes of the goods from the mark. *In re Rank Organisation, Ltd.*, 222 U.S.P.Q. 324 (TTAB 1984) (LASER not descriptive of speakers designed and tested by use of laser holography; thought and imagination required to determine significance of “laser” in this context); *Hasbro, Inc. v. Manyard Toys, Ltd.*, 858 F.2d 70, 8 USPQ2d 1345, 1349 (9th Cir. 1988) (GUNG-HO for marine action figure not descriptive). It is doubtful a consumer will immediately appreciate the nature of the Applicant’s goods and services merely upon perception of the mark, which is required for meeting the “immediacy” of the commercial association.

Even assuming, arguendo, some information about features or functions of Applicant’s goods and services is conveyed by TMT, this information is not conveyed directly, nor is there an immediate association between the mark and any features or characteristics of the goods or services. Applicant notes that it is not fatal to a mark for it to identify the subject matter of the goods with which the mark is used, or to convey information concerning such goods. See *Dial-A-Mattress Operating Corp. v. Mattress Madness, Inc.*, 33 USPQ2d 1961, 1966 (E.D.N.Y. 1994) (DIAL-A-MATTRESS is an inherently distinctive mark for retail mattress sales); *In re Reynolds Metals Co.*, 178 USPQ 296, 297 (C.C.P.A. 1973) (BROWN-IN-BAG for bag product that browns meat in the oven is not merely descriptive). It is permissible for a mark to evoke some connection to the properties or functions of the goods with which it is used; it merely cannot immediately describe a significant attribute or aspect of the goods with which the mark is used. *Plyboo America*, 51 USPQ2d at 1640. In the instant case, the term TMT is not so clearly descriptive that an immediate descriptive association is conveyed. As suggested above, TMT does not clearly and unequivocally describe the relevant goods and services; rather, an ambiguous impression of the goods and services is conveyed, but nothing immediately descriptive thereof.

The wording TMT is so broad and incongruous that it cannot be considered to be immediately descriptive of the goods and services offered by the Applicant. When consumers see TMT SOMA, they are confronted with a unitary term that does not convey a significant characteristic, function or feature of the Applicant's goods or services. The meaning of the mark is therefore ambiguous; in other words, the expression has multiple connotations when used in connection with the goods and services and is therefore not descriptive. TMEP 1213.05(c); see *In re Colonial Stores Inc.*, 394 F.2d 549, 157 USPQ 382 (C.C.P.A. 1968) (SUGAR & SPICE for bakery products); *In re Tea and Sympathy, Inc.*, 88 USPQ2d 1062 (TTAB 2008) (THE FARMACY held registrable for retail store services featuring natural herbs and organic products and related health and information services relating to dietary supplements and nutrition); *In re Simmons Co.*, 189 USPQ 352 (TTAB 1976) (THE HARD LINE for mattresses and bed springs); *In re Delaware Punch Co.*, 186 USPQ 63 (TTAB 1975) (THE SOFT PUNCH for noncarbonated soft drink); *In re National Tea Co.*, 144 USPQ 286 (TTAB 1965) (NO BONES ABOUT IT for fresh pre-cooked ham).

In light of the foregoing, Applicant respectfully submits that disclaimer of TMT is inappropriate in the instant case. The mark, TMT SOMA, is a unitary term wherein disclaimer of individual words is not required. Applicant therefore respectfully requests reconsideration of the disclaimer requirement.

Identification of Goods

The Examining Attorney requires clarification and amendment to the goods in the application, specifically in Class 9. Applicant has amended the goods in Class 9 as requested by the Examining Attorney.

GOODS AND/OR SERVICES SECTION (007)(current)

INTERNATIONAL CLASS	007
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DESCRIPTION

Steel and metalworking machines and machine tools; motors, other than for land vehicles; machine coupling and transmission components except for land vehicles; machines and installations for the metallurgical and iron and steel industry, namely metal cutting and casting machines; equipment for iron and steelworks and metallurgical plants not included in other classes, namely electric welding machines, metalworking machine tools; pressure valves being parts of machines, namely back pressure valves; regulators being parts of machines; valves, namely valves as parts of machines; pressure reducers as parts of machines; exhaust valves as parts of machines; electromechanical pressure and gas flow regulators being parts of machines; hydraulic and pneumatic control mechanisms for machines, engines or motors; industrial manipulator machines, namely forging machines; apparatus, gates and electromechanical valves machines, namely gate valves as parts of machines; apparatus, gates and flow regulator valves machines, namely gate valves for flow regulator, all being parts of machines; hydraulic and pneumatic devices for opening or closing electromechanical valves and gates being parts of machines; hydraulic and pneumatic devices for opening or closing safety valves being parts of machines; sealing joints for electromechanical gates, valves and apparatus being parts of machines; driving chains other than for land vehicles, especially for gas flow control valves

GOODS AND/OR SERVICES SECTION (007)(proposed)

INTERNATIONAL CLASS	007
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DESCRIPTION

Steel and metalworking machines and machine tools; motors, other than for land vehicles; machine coupling and transmission components except for land vehicles; machines and installations for the metallurgical and iron and steel industry, namely metal cutting and casting machines; equipment for iron and steelworks and metallurgical plants not included in other classes, namely electric welding machines, metalworking machine tools; pressure valves being parts of machines, namely back pressure valves; regulators being parts of machines; valves, namely valves as parts of machines; pressure reducers as parts of machines; exhaust valves as parts of machines; electromechanical pressure and gas flow regulators being parts of machines; hydraulic and pneumatic control mechanisms for machines, engines or motors; industrial manipulator machines, namely forging machines; apparatus, gates and electromechanical valves machines, namely gate valves as parts of machines; apparatus, gates and flow regulator valves machines, namely gate valves for flow regulator, all being parts of machines; hydraulic and pneumatic devices for opening or closing electromechanical valves and gates being parts of machines; hydraulic and pneumatic devices for opening or closing safety valves being parts of machines; sealing joints for electromechanical gates, valves and apparatus being parts of machines; driving chains other than for land vehicles, especially for gas flow control valves

GOODS AND/OR SERVICES SECTION (009)(current)**INTERNATIONAL CLASS**

009

DESCRIPTION

Scientific, surveying, photographic, optical, weighing, measuring, signaling, checking supervision, and teaching apparatus and instruments, namely metallurgical microscopes, surveying chains, photographic cameras, optical lenses, weighing scales, measuring lasers, signal whistles and educational software in the field of engineering for the iron and steel industry, ferrous and non-ferrous metallurgical industry; apparatus for recording, transmission or reproduction of sound or images namely for the iron and steel industry, ferrous and non-ferrous metallurgical industry; blank magnetic data carriers, blank recording disks; automatic vending machines and mechanisms for coin-operated apparatus; cash registers, calculating machines, data processing equipment and computers namely for the iron and steel industry, ferrous and non-ferrous metallurgical industry; fire-extinguishers; installations and apparatus for controlling, measuring, regulating, weighing, metering for metallurgical and iron and steel installations, especially for valves, gates, safety valves and machines and apparatus for controlling gas flow rate, namely electronic controllers, flow meters, gas flow regulators and weighing scales; pressure probes, namely ultrasound probes, not for medical use; pressure indicators; pressure measuring apparatus, namely pressure gauges; sensors, especially gas flow sensors; electrical and electronic installations for remote control of industrial operations, and especially for valves, gates, safety valves and machines and apparatus for controlling gas flow rate, namely computer hardware and software for remote control of gas flow rate; gas testing instruments; electric and electronic monitoring apparatus, namely electronic flowmeter monitors; gas monitoring apparatus, namely sensors for detecting the presence of gas and measuring gas concentration; installations and apparatus for controlling, monitoring measuring, regulating, weighing, metering for blast furnace installations and for iron and steel installations, namely temperature controllers, electric meters; profilometers especially for the iron and steel industry and the ferrous and non-ferrous metal-working industry; probing installations and apparatus, namely probes for testing integrated circuits; gas probes, namely sensors for measuring gas concentration; video cameras; optical apparatus and instruments namely for the iron and steel industry, ferrous and non-ferrous metallurgical industry; optical scanners, optical glasses and frames; apparatus and instruments for measuring physical parameters, in particular, temperature, pressure and humidity, and for chemical analyses not included in other classes, namely temperatures sensors, pressure gauges, humidity measuring sensor and liquid chromatography apparatus; computer apparatus, namely computer

hardware and software, computer interface boards for controlling, regulating, simulating, viewing and monitoring parameters of industrial installations, environmental protection installations, energy production, distribution and transmission installations and machines and components thereof namely for the iron and steel industry, ferrous and non-ferrous metallurgical industry; computer programs, in particular for controlling, regulating, viewing and monitoring processes in industrial installations, in environmental engineering installations, power plants and machines and components thereof; computer programs for simulating and viewing industrial installations, in particular metallurgical installations, environmental engineering installations, power plants, machines and apparatus; optical fibers ; media for programmed and non-programmed data, namely prerecorded digital discs featuring software for engineering design; data transmitting antennas namely for the iron and steel industry, ferrous and non-ferrous metallurgical industry; optical data media, namely blank optical disk drives; transmitters of electronic signals namely for the iron and steel industry, ferrous and non-ferrous metallurgical industry; objectives lenses for cameras; optical lenses; processors being central processing units namely for the iron and steel industry, ferrous and non-ferrous metallurgical industry; chips being integrated circuits namely for the iron and steel industry, ferrous and non-ferrous metallurgical industry; printed circuits and integrated circuits namely for the iron and steel industry, ferrous and non-ferrous metallurgical industry; interfaces for computers namely for the iron and steel industry, ferrous and non-ferrous metallurgical industry; electric and electronic sensors namely for the iron and steel industry, ferrous and non-ferrous metallurgical industry; detectors, namely metal detectors, electronic ultrasound flaw detectors for the iron and steel industry, ferrous and non-ferrous metallurgical industry; pressure sensors; heat sensors; computer software, recorded, namely for automated manufacturing design for the iron and steel industry, ferrous and non-ferrous metallurgical industry; recorded computer programs for three-dimensional image recognition and processing; radar apparatus; electronic notice boards; water level, gradient, electrical loss, temperature and speed indicators

GOODS AND/OR SERVICES SECTION (009)(proposed)

INTERNATIONAL CLASS

009

TRACKED TEXT DESCRIPTION

Scientific, surveying, photographic, optical, weighing, measuring, signaling, checking supervision, and teaching apparatus and instruments, namely metallurgical microscopes, surveying chains, photographic cameras, optical lenses, weighing scales, measuring lasers, signal whistles and educational software in the field of engineering for the iron and steel industry, ferrous and non-ferrous metallurgical industry; apparatus for recording, transmission or reproduction of sound or images namely for the iron and steel industry, ferrous and non-ferrous metallurgical industry; blank magnetic data carriers, blank recording disks; automatic vending machines and mechanisms for coin-operated apparatus; cash registers, calculating machines, data processing equipment and computers namely for the iron and steel industry, ferrous and non-ferrous metallurgical industry; fire-extinguishers; installations and apparatus for controlling, measuring, regulating, weighing, metering for metallurgical and iron and steel installations, especially for valves, gates, safety valves and machines and apparatus for controlling gas flow rate, namely electronic controllers, flow meters, gas flow regulators and weighing scales; pressure probes, namely ultrasound probes, not for medical use; pressure indicators; pressure measuring apparatus, namely pressure gauges; sensors, especially gas flow sensors; ~~electrical and electronic installations for remote control of industrial operations, and especially for valves, gates, safety valves and machines and apparatus for controlling gas flow rate, namely computer hardware and software for remote control of gas flow rate;~~ electrical and electronic installations for remote control of industrial operations, and especially for valves, safety valves and machines and apparatus for controlling gas flow rate, namely computer hardware and software for remote control of gas flow rate; gas testing instruments; electric and electronic monitoring apparatus, namely electronic flowmeter monitors; gas monitoring apparatus,

namely sensors for detecting the presence of gas and measuring gas concentration; installations and apparatus for controlling, monitoring measuring, regulating, weighing, metering for blast furnace installations and for iron and steel installations, namely temperature controllers, electric meters; profilometers especially for the iron and steel industry and the ferrous and non-ferrous metal-working industry; probing installations and apparatus, namely probes for testing integrated circuits; gas probes, namely sensors for measuring gas concentration; video cameras; ~~optical apparatus and instruments namely for the iron and steel industry, ferrous and non-ferrous metallurgical industry;~~ optical apparatus and instruments namely for the iron and steel industry, ferrous and non-ferrous metallurgical industry, namely, optical scanners, optical glasses and frames; ~~optical scanners, optical glasses and frames;~~ apparatus and instruments for measuring physical parameters, in particular, temperature, pressure and humidity, and for chemical analyses not included in other classes, namely temperatures sensors, pressure gauges, humidity measuring sensor and liquid chromatography apparatus; computer apparatus, namely computer hardware and software, computer interface boards for controlling, regulating, simulating, viewing and monitoring parameters of industrial installations, environmental protection installations, energy production, distribution and transmission installations and machines and components thereof namely for the iron and steel industry, ferrous and non-ferrous metallurgical industry; computer programs, in particular for controlling, regulating, viewing and monitoring processes in industrial installations, in environmental engineering installations, power plants and machines and components thereof; computer programs for simulating and viewing industrial installations, in particular metallurgical installations, environmental engineering installations, power plants, machines and apparatus; optical fibers; media for programmed and non-programmed data, namely prerecorded digital discs featuring software for engineering design; data transmitting antennas namely for the iron and steel industry, ferrous and non-ferrous metallurgical industry; optical data media, namely blank optical disk drives; transmitters of electronic signals namely for the iron and steel industry, ferrous and non-ferrous metallurgical industry; objectives lenses for cameras; optical lenses; processors being central processing units namely for the iron and steel industry, ferrous and non-ferrous metallurgical industry; chips being integrated circuits namely for the iron and steel industry, ferrous and non-ferrous metallurgical industry; printed circuits and integrated circuits namely for the iron and steel industry, ferrous and non-ferrous metallurgical industry; interfaces for computers namely for the iron and steel industry, ferrous and non-ferrous metallurgical industry; electric and electronic sensors namely for the iron and steel industry, ferrous and non-ferrous metallurgical industry; detectors, namely metal detectors, electronic ultrasound flaw detectors for the iron and steel industry, ferrous and non-ferrous metallurgical industry; pressure sensors; heat sensors; computer software, recorded, namely for automated manufacturing design for the iron and steel industry, ferrous and non-ferrous metallurgical industry; recorded computer programs for three-dimensional image recognition and processing; radar apparatus; electronic notice boards; water level, gradient, electrical loss, temperature and speed indicators

FINAL DESCRIPTION

Scientific, surveying, photographic, optical, weighing, measuring, signaling, checking supervision, and teaching apparatus and instruments, namely metallurgical microscopes, surveying chains, photographic cameras, optical lenses, weighing scales, measuring lasers, signal whistles and educational software in the field of engineering for the iron and steel industry, ferrous and non-ferrous metallurgical industry; apparatus for recording, transmission or reproduction of sound or images namely for the iron and steel industry, ferrous and non-ferrous metallurgical industry; blank magnetic data carriers, blank recording disks; automatic vending machines and mechanisms for coin-operated apparatus; cash registers, calculating machines, data processing equipment and computers namely for the iron and steel industry, ferrous and non-ferrous metallurgical industry; fire-extinguishers; installations and apparatus for controlling, measuring, regulating, weighing, metering for metallurgical and iron and steel installations, especially for valves, gates, safety valves and machines and apparatus for controlling gas flow rate,

namely electronic controllers, flow meters, gas flow regulators and weighing scales; pressure probes, namely ultrasound probes, not for medical use; pressure indicators; pressure measuring apparatus, namely pressure gauges; sensors, especially gas flow sensors; electrical and electronic installations for remote control of industrial operations, and especially for valves, safety valves and machines and apparatus for controlling gas flow rate, namely computer hardware and software for remote control of gas flow rate; gas testing instruments; electric and electronic monitoring apparatus, namely electronic flowmeter monitors; gas monitoring apparatus, namely sensors for detecting the presence of gas and measuring gas concentration; installations and apparatus for controlling, monitoring measuring, regulating, weighing, metering for blast furnace installations and for iron and steel installations, namely temperature controllers, electric meters; profilometers especially for the iron and steel industry and the ferrous and non-ferrous metal-working industry; probing installations and apparatus, namely probes for testing integrated circuits; gas probes, namely sensors for measuring gas concentration; video cameras; optical apparatus and instruments namely for the iron and steel industry, ferrous and non-ferrous metallurgical industry, namely, optical scanners, optical glasses and frames; apparatus and instruments for measuring physical parameters, in particular, temperature, pressure and humidity, and for chemical analyses not included in other classes, namely temperatures sensors, pressure gauges, humidity measuring sensor and liquid chromatography apparatus; computer apparatus, namely computer hardware and software, computer interface boards for controlling, regulating, simulating, viewing and monitoring parameters of industrial installations, environmental protection installations, energy production, distribution and transmission installations and machines and components thereof namely for the iron and steel industry, ferrous and non-ferrous metallurgical industry; computer programs, in particular for controlling, regulating, viewing and monitoring processes in industrial installations, in environmental engineering installations, power plants and machines and components thereof; computer programs for simulating and viewing industrial installations, in particular metallurgical installations, environmental engineering installations, power plants, machines and apparatus; optical fibers ; media for programmed and non-programmed data, namely prerecorded digital discs featuring software for engineering design; data transmitting antennas namely for the iron and steel industry, ferrous and non-ferrous metallurgical industry; optical data media, namely blank optical disk drives; transmitters of electronic signals namely for the iron and steel industry, ferrous and non-ferrous metallurgical industry; objectives lenses for cameras; optical lenses; processors being central processing units namely for the iron and steel industry, ferrous and non-ferrous metallurgical industry; chips being integrated circuits namely for the iron and steel industry, ferrous and non-ferrous metallurgical industry; printed circuits and integrated circuits namely for the iron and steel industry, ferrous and non-ferrous metallurgical industry; interfaces for computers namely for the iron and steel industry, ferrous and non-ferrous metallurgical industry; electric and electronic sensors namely for the iron and steel industry, ferrous and non-ferrous metallurgical industry; detectors, namely metal detectors, electronic ultrasound flaw detectors for the iron and steel industry, ferrous and non-ferrous metallurgical industry; pressure sensors; heat sensors; computer software, recorded, namely for automated manufacturing design for the iron and steel industry, ferrous and non-ferrous metallurgical industry; recorded computer programs for three-dimensional image recognition and processing; radar apparatus; electronic notice boards; water level, gradient, electrical loss, temperature and speed indicators

GOODS AND/OR SERVICES SECTION (037)(no change)

GOODS AND/OR SERVICES SECTION (042)(no change)

SIGNATURE SECTION

RESPONSE SIGNATURE

/gapjr/

SIGNATORY'S NAME

George A. Pelletier, Jr.

SIGNATORY'S POSITION	Attorney of record; MA, CT Bar Member
SIGNATORY'S PHONE NUMBER	8602862929
DATE SIGNED	01/04/2013
AUTHORIZED SIGNATORY	YES
CONCURRENT APPEAL NOTICE FILED	YES
FILING INFORMATION SECTION	
SUBMIT DATE	Fri Jan 04 15:51:21 EST 2013
TEAS STAMP	USPTO/RFR-12.227.90.3-201 30104155121103798-7910310 1-490a61f8f5e473355a5203a e32cb04f7d2d-N/A-N/A-2013 0104154748910881

PTO Form 1930 (Rev 9/2007)
OMB No. 0651-0050 (Exp. 4/30/2009)

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

Application serial no. **79103101** has been amended as follows:

ARGUMENT(S)

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

Refusal Under Section 2(d)

The Examining Attorney maintained the refusal with respect to the registration of Applicant's Mark on the ground that the marks in U.S. Registration Nos. 3216689, 3219218, and 3219219 ("Registrant's Marks") are confusingly similar to Applicant's Mark. Applicant respectfully disagrees with the Examining Attorney, and requests reconsideration of the refusal to register.

The standard for determining whether two marks are likely to be confused is set forth in *In re E.I. Du Pont de Nemours & Co.*, 177 USPQ 563 (CCPA 1973); see also TMEP § 1207.01. The *DuPont* case establishes a number of factors to be considered in the analysis of whether two marks are likely to be confused under Section 2(d) of the Lanham Act, 15 U.S.C. Section 1052(d). Each factor may play a more dominant or diminished role depending on the facts of each case. *DuPont*, 177 USPQ at 567. No single factor is dispositive. *Id.* The Examining Attorney need not consider all factors, but may consider those factors that are most relevant to the case at hand. See *In re Dixie Restaurants, Inc.*, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997); *Kimberly-Clark Corp. v. H. Douglas Enterprises, Ltd.*, 227 USPQ 541, 542 (Fed. Cir. 1985).

The relevant *DuPont* factors in this case are: (1) the differences in the services offered under Applicant's and Registrant's Marks; (2) the differences in the respective channels of trade; and (3) the purchasing conditions and sophistication of the buyers.

Under the Trademark Act a refusal to register based upon a likelihood of confusion requires that confusion as to the source of the goods be likely, not merely possible; as the Second Circuit has stated, "likelihood of confusion means a probability of confusion; it is not sufficient if confusion is merely 'possible.'" *Estee Lauder, Inc. v. The Gap, Inc.*, 42 USPQ2d 1228, 1232 (2d Cir. 1997) (internal quotations omitted) quoting 3 J. McCarthy, *Trademarks and Unfair Competition*, § 23:2 (1996) (now at 4 McCarthy on Trademarks and Unfair Competition § 23.3 (4th ed. 2012)). When the relevant *DuPont* factors are considered in relation to the Applicant's TMT SOMA mark, each factor weighs in favor of allowing Applicant's Mark to register.

As noted previously, Applicant's goods are directed toward specific industries, in particular, the iron, steel and related industries. Where the goods or services are dissimilar or are completely unrelated, no likelihood of confusion will be found even if the marks are very similar. See e.g. *Shen Mfg. Co., Inc. v. Ritz Hotel Ltd.*, 73 USPQ2d 1350 (Fed Cir. 2004) (RITZ for cooking classes and RITZ for kitchen textiles not related); *Aries Systems Corp. v. World Book Inc.*, 26 USPQ2d 1926 (TTAB 1993) (computer programs sold under KNOWLEDGE FINDER not similar to computer programs sold under INFORMATION FINDER); *Flow Technology Inc. v. Picciano*, 18 USPQ2d 1970 (TTAB 1991) (OMNITRAX for computer programs for video store management not likely to be confused with OMNITRAK for flowmeter calibrator); *Local Trademarks, Inc. v. Handy Boys, Inc.*, 16 USPQ2d 1156 (TTAB 1990) (confusion not likely between LITTLE PLUMBERS for liquid drain opener and the identical mark for advertising services marketed to plumbing contractors); *Quartz Radiation Corp. v. Comm/Scope Co.*, 1 USPQ2d 1668 (TTAB 1986) (QR for coaxial cable held not confusingly similar to QR for various products (e.g. lamps, tubes) relating to the photocopying field).

It is not enough that "a general term or overarching relationship can be found to encompass them both." *In re W.W. Henry Co.*, 82 USPQ2d 1213 (TTAB 2007) (PATCH & GO for Portland cement and PATCH 'N GO for chemical filler both used to repair surface, held unrelated). Thus, in order to support a likelihood of confusion the goods and services must be related and the circumstances must be such that consumers will be confused as to source. As noted in Applicant's prior office action response, Applicant's goods are not telephone hardware or software products as noted in the cited registrations. Merely because both parties offer electronic technological products does not mean that consumers will encounter the parties' products in a contest giving rise to source confusion. Quite the contrary, due to the highly specialized nature of Applicant's and registrant's goods, there is little opportunity for consumers to encounter the products together at all, let alone in a context giving rise to source confusion.

Applicant's goods and services are marketed and offered in a totally different channel of trade than the Registrant's goods and services. As noted previously, Applicant's goods are technological solutions for the iron and steel industries, and related businesses. Registrant's goods and services are related to telephony hardware and services. Thus, the conditions and activities surrounding the marketing of Applicant's and Registrant's respective marks are such that they would not be encountered by the same persons under circumstances that could give rise to the mistaken belief that they originate from the same source. See 1207.01(a)(i); *In re Hal Leonard Publishing Corp. d/b/a Hal Leonard Books*, 15 USPQ2d 1574, 1575 (TTAB 1990); *In re Total Quality Group, Inc.*, 51 USPQ2d 1474, 1476 (TTAB 1999). The threshold significance of the trade channels is whether the same class of persons is exposed to the marks at issue under circumstances likely to result in confusion. *Jeanne-Marc, Inc. v. Cluett, Peabody & Co., Inc.*, 221 USPQ 58, 61 (TTAB 1984); *TCPIP Holding Co. v. Haar Communications*, 57 USPQ2d 1969 (2d Cir. 2001) (similar buyers targeted). In this instance, it is clear from the above that the respective offerings

move in distinct channels of trade and are marketed to distinct classes of consumers. Since the connection between the respective trade channels and consumers is tenuous at best, confusion is unlikely.

The offerings of the Applicant and those of Registrant are highly specialized and sophisticated. Consumers of Registrant's and Applicant's goods will exercise a high degree of care in selecting the appropriate offerings necessary to meet their needs. The degree of consumer sophistication and conditions under which the sale is made is yet another *DuPont* factor that weighs in favor of Applicant. *DuPont*, 476 F.2d at 1361-1362, 177 U.S.P.Q. at 567. Where consumers exercise a higher degree of care any possibility of confusion is substantially mitigated. See *In re Vision Wheel, Inc.*, Serial Nos. 77498758 and 77498755 (T.T.A.B., July 28, 2010) (the Board found that there was no likelihood of confusion between V-TEC for custom wheels and V-TEC for car engines; conditions of sale lead to a high degree of care when making purchases). Further, a purchaser who has a "reasonably focused need" or "specific purpose" or plan for the product, will exercise a high degree of care in selecting the product that meets his or her needs. See e.g. *Haydon Switch & Instr., Inc. v. Rexnord, Inc.*, 4 U.S.P.Q.2d 1510, 1517 (D. Conn. 1987) (specific products for specific industrial purpose); *G.H. Mumm & Cie v. Desnoes & Geddes, Ltd.*, 917 F.2d 1292, 16 U.S.P.Q.2d 1635, 1638 (Fed. Cir. 1990) ("focused need" for champagne); *Cliffs Notes, Inc. v. Bantam Doubleday Dell Publi'g Group, Inc.*, 886 F.2d 490, 496, 12 U.S.P.Q.2d 1289, 1293 (2d Cir. 1989) (reader of Cliffs Notes probably has specific book in mind).

Both Registrant's and Applicant's goods are offered to distinct classes of highly sophisticated consumer. In the case of Applicant's goods, its customers are those who require technological solutions for iron and steel foundries and related enterprises. By comparison, Registrant's customers are in the market for telephony hardware and software. Consumers of the respective goods at issue are highly sophisticated and will therefore exercise a high degree of care in selecting the appropriate product that meets their particular needs, thereby mitigating the possibility of consumer confusion even further.

In light of the foregoing, Applicant respectfully submits that its mark will not be encountered by the relevant consuming public in such manner to give rise to confusion with the marks of the cited Registrant. There is no overlap in the channels of trade in which the parties' goods and services move, and the relevant respective consumers thereof are sophisticated and will not erroneously mistake or confuse the source of the respective goods and services. Consequently, Applicant respectfully submits that the refusal under Section 2(d) is inappropriate, and requests reconsideration of the refusal.

Disclaimer

The Examining Attorney has maintained the requirement that "TMT" be disclaimed apart from the mark as shown, asserting that TMT is an acronym for "thermo-mechanical treatment", and thus descriptive since it was alleged Applicant's goods could be used for this type of treatment and Applicant's services could feature this type of treatment.

Applicant respectfully disagrees with the requirement, and requests reconsideration thereof. A disclaimer functions as a concession by Applicant that the disclaimed term lacks inherent distinctiveness, and thus is descriptive. TMEP §1213. Applicant submits that such is not the case in the instant application. In order for a mark, or an element thereof, to be "merely descriptive" for purposes of Section 2(e)(1) of the Trademark Act, the mark at issue must directly and immediately convey knowledge of the characteristics of a product or service. *In re MBNA America Bank, N.A.*, 67 USPQ2d 1778, 1780 (Fed. Cir. 2003); *Equine Technologies Inc. v. Equitechnology Inc.*, 36 USPQ 2d 1659, 1661 (1st Cir. 1995) ("A [mark] is descriptive if it forthwith conveys an immediate idea of the ingredients, qualities, or characteristics of the

goods” at issue.”) (citations omitted); J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition*, 4th Ed. (2012), § 11:67 (“If the mental leap between the word and the product’s attributes is not almost instantaneous, this strongly indicates suggestiveness and not descriptiveness.”). In other words, a mark is not descriptive if it requires imagination, thought and perception to reach a conclusion as to the nature of goods or services with which it is used. *Equine Technologies Inc.*, 36 U.S.P.Q. 2d at 1661 (citations omitted); see *No Nonsense Fashions, Inc. v. Consolidated Foods Corp.*, 226 USPQ 502, 507 (TTAB 1985) (SHEER ELEGANCE for hosiery did not convey an “immediate notion” as to any particular characteristic, quality or ingredient; mark suggestive in a laudatory sense); *Plyboo America, Inc. v. Smith & Fong Co.*, 51 USPQ 2d at 1642 (PLYBOO not descriptive of plywood made of bamboo); *In re Shutts*, 217 USPQ 363, 365 (TTAB 1983). (SNO-RAKE held not merely descriptive of a snow removal hand tool). Any doubts in this regard are to be resolved in favor of the Applicant. *Id.*

As noted previously, the “TMT” in Applicant’s mark is ambiguous and thus disclaimer is inappropriate. The Examining alleges TMT will be perceived as an acronym for “thermo-mechanical treatment” and is thus descriptive. However, mere use of TMT in the context of the mark TMT SOMA does not necessarily evoke this single definition. As demonstrated previously, TMT has various definitions; forty-nine separate results for TMT was revealed as an acronym. Consumers confronted with Applicant’s mark will not immediately appreciate the term TMT conveys the association proffered by the Examining Attorney. The mark may be perceived by consumers as referring to one of the other associations of the acronym TMT, thus creating an incongruity impressing a unitary association to consumers. *In re Corporate Fuel Partners, LLC*, 2010 TTAB LEXIS 368 (Aug. 27, 2010) (finding that consumers would view the phrase CORPORATE FUEL, for business management services, as a play on actual types of fuel); *In re Cohber Press, Inc.*, 2007 TTAB LEXIS 210, *7 (Nov. 15, 2007) (finding that ARCTIC ART for coated printing paper “has an alliterative cadence” that “conveys the commercial impression of ‘art’ of the ‘arctic’”); *In re Bijoux Int’l*, 2001 TTAB LEXIS 175 (Feb. 27, 2001) (finding that EXTREME SPORT, for sports bags, handbags, luggage, refers to a non-traditional type of sport and creates a commercial impression that is separate from that created by the word SPORT alone).

The touchstone for a mark, or element thereof, to be merely descriptive and thus requiring disclaimer is not merely the conveyance of some aspect of the underlying goods and services, but that the proposed mark element must immediately call to a consumer’s mind a significant characteristic, function or feature of a good or services. See *In re Disc Jockeys Inc.*, 23 USPQ2d 1715 (TTAB 1992). In light of the foregoing discussion, the mark TMT SOMA does not immediately identify any particular significant aspect of Applicant’s goods or services. The term TMT on its own is too broad of an acronym to immediately impart to a consumer any immediate aspect of the Applicant’s goods and services. Instead, in the context of Applicant’s goods and services, the term “TMT” is suggestive of any number of possible interpretations, particularly when combined with the arbitrary and unrelated “SOMA”. “A certain amount of creative imagination is required” to intuit the specific attributes of the goods from the mark. *In re Rank Organisation, Ltd.*, 222 U.S.P.Q. 324 (TTAB 1984) (LASER not descriptive of speakers designed and tested by use of laser holography; thought and imagination required to determine significance of “laser” in this context); *Hasbro, Inc. v. Manyard Toys, Ltd.*, 858 F.2d 70, 8 USPQ2d 1345, 1349 (9th Cir. 1988) (GUNG-HO for marine action figure not descriptive). It is doubtful a consumer will immediately appreciate the nature of the Applicant’s goods and services merely upon perception of the mark, which is required for meeting the “immediacy” of the commercial association.

Even assuming, arguendo, some information about features or functions of Applicant’s goods and services is conveyed by TMT, this information is not conveyed directly, nor is there an immediate association between the mark and any features or characteristics of the goods or services. Applicant notes that it is not fatal to a mark for it to identify the subject matter of the goods with which the mark is used, or to convey information concerning such goods. See *Dial-A-Mattress Operating Corp. v. Mattress*

Madness, Inc., 33 USPQ2d 1961, 1966 (E.D.N.Y. 1994) (DIAL-A-MATTRESS is an inherently distinctive mark for retail mattress sales); *In re Reynolds Metals Co.*, 178 USPQ 296, 297 (C.C.P.A. 1973) (BROWN-IN-BAG for bag product that browns meat in the oven is not merely descriptive). It is permissible for a mark to evoke some connection to the properties or functions of the goods with which it is used; it merely cannot immediately describe a significant attribute or aspect of the goods with which the mark is used. *Plyboo America*, 51 USPQ2d at 1640. In the instant case, the term TMT is not so clearly descriptive that an immediate descriptive association is conveyed. As suggested above, TMT does not clearly and unequivocally describe the relevant goods and services; rather, an ambiguous impression of the goods and services is conveyed, but nothing immediately descriptive thereof.

The wording TMT is so broad and incongruous that it cannot be considered to be immediately descriptive of the goods and services offered by the Applicant. When consumers see TMT SOMA, they are confronted with a unitary term that does not convey a significant characteristic, function or feature of the Applicant's goods or services. The meaning of the mark is therefore ambiguous; in other words, the expression has multiple connotations when used in connection with the goods and services and is therefore not descriptive. TMEP 1213.05(c); see *In re Colonial Stores Inc.*, 394 F.2d 549, 157 USPQ 382 (C.C.P.A. 1968) (SUGAR & SPICE for bakery products); *In re Tea and Sympathy, Inc.*, 88 USPQ2d 1062 (TTAB 2008) (THE FARMACY held registrable for retail store services featuring natural herbs and organic products and related health and information services relating to dietary supplements and nutrition); *In re Simmons Co.*, 189 USPQ 352 (TTAB 1976) (THE HARD LINE for mattresses and bed springs); *In re Delaware Punch Co.*, 186 USPQ 63 (TTAB 1975) (THE SOFT PUNCH for noncarbonated soft drink); *In re National Tea Co.*, 144 USPQ 286 (TTAB 1965) (NO BONES ABOUT IT for fresh pre-cooked ham).

In light of the foregoing, Applicant respectfully submits that disclaimer of TMT is inappropriate in the instant case. The mark, TMT SOMA, is a unitary term wherein disclaimer of individual words is not required. Applicant therefore respectfully requests reconsideration of the disclaimer requirement.

Identification of Goods

The Examining Attorney requires clarification and amendment to the goods in the application, specifically in Class 9. Applicant has amended the goods in Class 9 as requested by the Examining Attorney.

CLASSIFICATION AND LISTING OF GOODS/SERVICES

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

Current: Class 007 for Steel and metalworking machines and machine tools; motors, other than for land vehicles; machine coupling and transmission components except for land vehicles; machines and installations for the metallurgical and iron and steel industry, namely metal cutting and casting machines; equipment for iron and steelworks and metallurgical plants not included in other classes, namely electric welding machines, metalworking machine tools; pressure valves being parts of machines, namely back pressure valves; regulators being parts of machines; valves, namely valves as parts of machines; pressure reducers as parts of machines; exhaust valves as parts of machines; electromechanical pressure and gas flow regulators being parts of machines; hydraulic and pneumatic control mechanisms for machines, engines or motors; industrial manipulator machines, namely forging machines; apparatus, gates and electromechanical valves machines, namely gate valves as parts of machines; apparatus, gates and flow regulator valves machines, namely gate valves for flow regulator, all being parts of machines; hydraulic and pneumatic devices for opening or closing electromechanical valves and gates being parts of machines; hydraulic and pneumatic devices for opening or closing safety valves being parts of machines; sealing

joints for electromechanical gates, valves and apparatus being parts of machines; driving chains other than for land vehicles, especially for gas flow control valves

Original Filing Basis:

Filing Basis Section 66(a), Request for Extension of Protection to the United States. Section 66(a) of the Trademark Act, 15 U.S.C. §1141f.

Proposed: Class 007 for Steel and metalworking machines and machine tools; motors, other than for land vehicles; machine coupling and transmission components except for land vehicles; machines and installations for the metallurgical and iron and steel industry, namely metal cutting and casting machines; equipment for iron and steelworks and metallurgical plants not included in other classes, namely electric welding machines, metalworking machine tools; pressure valves being parts of machines, namely back pressure valves; regulators being parts of machines; valves, namely valves as parts of machines; pressure reducers as parts of machines; exhaust valves as parts of machines; electromechanical pressure and gas flow regulators being parts of machines; hydraulic and pneumatic control mechanisms for machines, engines or motors; industrial manipulator machines, namely forging machines; apparatus, gates and electromechanical valves machines, namely gate valves as parts of machines; apparatus, gates and flow regulator valves machines, namely gate valves for flow regulator, all being parts of machines; hydraulic and pneumatic devices for opening or closing electromechanical valves and gates being parts of machines; hydraulic and pneumatic devices for opening or closing safety valves being parts of machines; sealing joints for electromechanical gates, valves and apparatus being parts of machines; driving chains other than for land vehicles, especially for gas flow control valves

Filing Basis Section 66(a), Request for Extension of Protection to the United States. Section 66(a) of the Trademark Act, 15 U.S.C. §1141f.

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

Current: Class 009 for Scientific, surveying, photographic, optical, weighing, measuring, signaling, checking supervision, and teaching apparatus and instruments, namely metallurgical microscopes, surveying chains, photographic cameras, optical lenses, weighing scales, measuring lasers, signal whistles and educational software in the field of engineering for the iron and steel industry, ferrous and non-ferrous metallurgical industry; apparatus for recording, transmission or reproduction of sound or images namely for the iron and steel industry, ferrous and non-ferrous metallurgical industry; blank magnetic data carriers, blank recording disks; automatic vending machines and mechanisms for coin-operated apparatus; cash registers, calculating machines, data processing equipment and computers namely for the iron and steel industry, ferrous and non-ferrous metallurgical industry; fire-extinguishers; installations and apparatus for controlling, measuring, regulating, weighing, metering for metallurgical and iron and steel installations, especially for valves, gates, safety valves and machines and apparatus for controlling gas flow rate, namely electronic controllers, flow meters, gas flow regulators and weighing scales; pressure probes, namely ultrasound probes, not for medical use; pressure indicators; pressure measuring apparatus, namely pressure gauges; sensors, especially gas flow sensors; electrical and electronic installations for remote control of industrial operations, and especially for valves, gates, safety valves and machines and apparatus for controlling gas flow rate, namely computer hardware and software for remote control of gas flow rate; gas testing instruments; electric and electronic monitoring apparatus, namely electronic flowmeter monitors; gas monitoring apparatus, namely sensors for detecting the presence of gas and measuring gas concentration; installations and apparatus for controlling, monitoring measuring, regulating, weighing, metering for blast furnace installations and for iron and steel installations, namely temperature controllers, electric meters; profilometers especially for the iron and steel industry and the ferrous and non-ferrous metal-working industry; probing installations and apparatus, namely probes for testing integrated circuits; gas probes, namely sensors for measuring gas concentration; video cameras; optical apparatus and instruments namely for the iron and steel industry, ferrous and non-ferrous

metallurgical industry; optical scanners, optical glasses and frames; apparatus and instruments for measuring physical parameters, in particular, temperature, pressure and humidity, and for chemical analyses not included in other classes, namely temperatures sensors, pressure gauges, humidity measuring sensor and liquid chromatography apparatus; computer apparatus, namely computer hardware and software, computer interface boards for controlling, regulating, simulating, viewing and monitoring parameters of industrial installations, environmental protection installations, energy production, distribution and transmission installations and machines and components thereof namely for the iron and steel industry, ferrous and non-ferrous metallurgical industry; computer programs, in particular for controlling, regulating, viewing and monitoring processes in industrial installations, in environmental engineering installations, power plants and machines and components thereof; computer programs for simulating and viewing industrial installations, in particular metallurgical installations, environmental engineering installations, power plants, machines and apparatus; optical fibers ; media for programmed and non-programmed data, namely prerecorded digital discs featuring software for engineering design; data transmitting antennas namely for the iron and steel industry, ferrous and non-ferrous metallurgical industry; optical data media, namely blank optical disk drives; transmitters of electronic signals namely for the iron and steel industry, ferrous and non-ferrous metallurgical industry; objectives lenses for cameras; optical lenses; processors being central processing units namely for the iron and steel industry, ferrous and non-ferrous metallurgical industry; chips being integrated circuits namely for the iron and steel industry, ferrous and non-ferrous metallurgical industry; printed circuits and integrated circuits namely for the iron and steel industry, ferrous and non-ferrous metallurgical industry; interfaces for computers namely for the iron and steel industry, ferrous and non-ferrous metallurgical industry; electric and electronic sensors namely for the iron and steel industry, ferrous and non-ferrous metallurgical industry; detectors, namely metal detectors, electronic ultrasound flaw detectors for the iron and steel industry, ferrous and non-ferrous metallurgical industry; pressure sensors; heat sensors; computer software, recorded, namely for automated manufacturing design for the iron and steel industry, ferrous and non-ferrous metallurgical industry; recorded computer programs for three-dimensional image recognition and processing; radar apparatus; electronic notice boards; water level, gradient, electrical loss, temperature and speed indicators

Original Filing Basis:

Filing Basis Section 66(a), Request for Extension of Protection to the United States. Section 66(a) of the Trademark Act, 15 U.S.C. §1141f.

Proposed:

Tracked Text Description: Scientific, surveying, photographic, optical, weighing, measuring, signaling, checking supervision, and teaching apparatus and instruments, namely metallurgical microscopes, surveying chains, photographic cameras, optical lenses, weighing scales, measuring lasers, signal whistles and educational software in the field of engineering for the iron and steel industry, ferrous and non-ferrous metallurgical industry; apparatus for recording, transmission or reproduction of sound or images namely for the iron and steel industry, ferrous and non-ferrous metallurgical industry; blank magnetic data carriers, blank recording disks; automatic vending machines and mechanisms for coin-operated apparatus; cash registers, calculating machines, data processing equipment and computers namely for the iron and steel industry, ferrous and non-ferrous metallurgical industry; fire-extinguishers; installations and apparatus for controlling, measuring, regulating, weighing, metering for metallurgical and iron and steel installations, especially for valves, gates, safety valves and machines and apparatus for controlling gas flow rate, namely electronic controllers, flow meters, gas flow regulators and weighing scales; pressure probes, namely ultrasound probes, not for medical use; pressure indicators; pressure measuring apparatus, namely pressure gauges; sensors, especially gas flow sensors; ~~electrical and electronic installations for remote control of industrial operations, and especially for valves, gates, safety valves and machines and apparatus for controlling gas flow rate, namely computer hardware and software for remote control of gas~~

~~flow rate~~; [electrical and electronic installations for remote control of industrial operations, and especially for valves, safety valves and machines and apparatus for controlling gas flow rate, namely computer hardware and software for remote control of gas flow rate](#); gas testing instruments; electric and electronic monitoring apparatus, namely electronic flowmeter monitors; gas monitoring apparatus, namely sensors for detecting the presence of gas and measuring gas concentration; installations and apparatus for controlling, monitoring measuring, regulating, weighing, metering for blast furnace installations and for iron and steel installations, namely temperature controllers, electric meters; profilometers especially for the iron and steel industry and the ferrous and non-ferrous metal-working industry; probing installations and apparatus, namely probes for testing integrated circuits; gas probes, namely sensors for measuring gas concentration; video cameras; ~~optical apparatus and instruments namely for the iron and steel industry, ferrous and non-ferrous metallurgical industry~~; [optical apparatus and instruments namely for the iron and steel industry, ferrous and non-ferrous metallurgical industry, namely, optical scanners, optical glasses and frames](#); ~~optical scanners, optical glasses and frames~~; apparatus and instruments for measuring physical parameters, in particular, temperature, pressure and humidity, and for chemical analyses not included in other classes, namely temperatures sensors, pressure gauges, humidity measuring sensor and liquid chromatography apparatus; computer apparatus, namely computer hardware and software, computer interface boards for controlling, regulating, simulating, viewing and monitoring parameters of industrial installations, environmental protection installations, energy production, distribution and transmission installations and machines and components thereof namely for the iron and steel industry, ferrous and non-ferrous metallurgical industry; computer programs, in particular for controlling, regulating, viewing and monitoring processes in industrial installations, in environmental engineering installations, power plants and machines and components thereof; computer programs for simulating and viewing industrial installations, in particular metallurgical installations, environmental engineering installations, power plants, machines and apparatus; optical fibers; media for programmed and non-programmed data, namely prerecorded digital discs featuring software for engineering design; data transmitting antennas namely for the iron and steel industry, ferrous and non-ferrous metallurgical industry; optical data media, namely blank optical disk drives; transmitters of electronic signals namely for the iron and steel industry, ferrous and non-ferrous metallurgical industry; objectives lenses for cameras; optical lenses; processors being central processing units namely for the iron and steel industry, ferrous and non-ferrous metallurgical industry; chips being integrated circuits namely for the iron and steel industry, ferrous and non-ferrous metallurgical industry; printed circuits and integrated circuits namely for the iron and steel industry, ferrous and non-ferrous metallurgical industry; interfaces for computers namely for the iron and steel industry, ferrous and non-ferrous metallurgical industry; electric and electronic sensors namely for the iron and steel industry, ferrous and non-ferrous metallurgical industry; detectors, namely metal detectors, electronic ultrasound flaw detectors for the iron and steel industry, ferrous and non-ferrous metallurgical industry; pressure sensors; heat sensors; computer software, recorded, namely for automated manufacturing design for the iron and steel industry, ferrous and non-ferrous metallurgical industry; recorded computer programs for three-dimensional image recognition and processing; radar apparatus; electronic notice boards; water level, gradient, electrical loss, temperature and speed indicators

Class 009 for Scientific, surveying, photographic, optical, weighing, measuring, signaling, checking supervision, and teaching apparatus and instruments, namely metallurgical microscopes, surveying chains, photographic cameras, optical lenses, weighing scales, measuring lasers, signal whistles and educational software in the field of engineering for the iron and steel industry, ferrous and non-ferrous metallurgical industry; apparatus for recording, transmission or reproduction of sound or images namely for the iron and steel industry, ferrous and non-ferrous metallurgical industry; blank magnetic data carriers, blank recording disks; automatic vending machines and mechanisms for coin-operated apparatus; cash registers, calculating machines, data processing equipment and computers namely for the iron and steel industry, ferrous and non-ferrous metallurgical industry; fire-extinguishers; installations and apparatus for

controlling, measuring, regulating, weighing, metering for metallurgical and iron and steel installations, especially for valves, gates, safety valves and machines and apparatus for controlling gas flow rate, namely electronic controllers, flow meters, gas flow regulators and weighing scales; pressure probes, namely ultrasound probes, not for medical use; pressure indicators; pressure measuring apparatus, namely pressure gauges; sensors, especially gas flow sensors; electrical and electronic installations for remote control of industrial operations, and especially for valves, safety valves and machines and apparatus for controlling gas flow rate, namely computer hardware and software for remote control of gas flow rate; gas testing instruments; electric and electronic monitoring apparatus, namely electronic flowmeter monitors; gas monitoring apparatus, namely sensors for detecting the presence of gas and measuring gas concentration; installations and apparatus for controlling, monitoring measuring, regulating, weighing, metering for blast furnace installations and for iron and steel installations, namely temperature controllers, electric meters; profilometers especially for the iron and steel industry and the ferrous and non-ferrous metal-working industry; probing installations and apparatus, namely probes for testing integrated circuits; gas probes, namely sensors for measuring gas concentration; video cameras; optical apparatus and instruments namely for the iron and steel industry, ferrous and non-ferrous metallurgical industry, namely, optical scanners, optical glasses and frames; apparatus and instruments for measuring physical parameters, in particular, temperature, pressure and humidity, and for chemical analyses not included in other classes, namely temperatures sensors, pressure gauges, humidity measuring sensor and liquid chromatography apparatus; computer apparatus, namely computer hardware and software, computer interface boards for controlling, regulating, simulating, viewing and monitoring parameters of industrial installations, environmental protection installations, energy production, distribution and transmission installations and machines and components thereof namely for the iron and steel industry, ferrous and non-ferrous metallurgical industry; computer programs, in particular for controlling, regulating, viewing and monitoring processes in industrial installations, in environmental engineering installations, power plants and machines and components thereof; computer programs for simulating and viewing industrial installations, in particular metallurgical installations, environmental engineering installations, power plants, machines and apparatus; optical fibers ; media for programmed and non-programmed data, namely prerecorded digital discs featuring software for engineering design; data transmitting antennas namely for the iron and steel industry, ferrous and non-ferrous metallurgical industry; optical data media, namely blank optical disk drives; transmitters of electronic signals namely for the iron and steel industry, ferrous and non-ferrous metallurgical industry; objectives lenses for cameras; optical lenses; processors being central processing units namely for the iron and steel industry, ferrous and non-ferrous metallurgical industry; chips being integrated circuits namely for the iron and steel industry, ferrous and non-ferrous metallurgical industry; printed circuits and integrated circuits namely for the iron and steel industry, ferrous and non-ferrous metallurgical industry; interfaces for computers namely for the iron and steel industry, ferrous and non-ferrous metallurgical industry; electric and electronic sensors namely for the iron and steel industry, ferrous and non-ferrous metallurgical industry; detectors, namely metal detectors, electronic ultrasound flaw detectors for the iron and steel industry, ferrous and non-ferrous metallurgical industry; pressure sensors; heat sensors; computer software, recorded, namely for automated manufacturing design for the iron and steel industry, ferrous and non-ferrous metallurgical industry; recorded computer programs for three-dimensional image recognition and processing; radar apparatus; electronic notice boards; water level, gradient, electrical loss, temperature and speed indicators

Filing Basis Section 66(a), Request for Extension of Protection to the United States. Section 66(a) of the Trademark Act, 15 U.S.C. §1141f.

SIGNATURE(S)

Request for Reconsideration Signature

Signature: /gapjr/ Date: 01/04/2013

Signatory's Name: George A. Pelletier, Jr.

Signatory's Position: Attorney of record; MA, CT Bar Member

Signatory's Phone Number: 8602862929

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: 79103101

Internet Transmission Date: Fri Jan 04 15:51:21 EST 2013

TEAS Stamp: USPTO/RFR-12.227.90.3-201301041551211037

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