

## Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	79137864
LAW OFFICE ASSIGNED	LAW OFFICE 107
MARK SECTION (no change)	
ARGUMENT(S)	
<p style="text-align: center;"><b><u>REQUEST FOR RECONSIDERATION</u></b></p> <p>This is in response to the Final Office Action dated October 30, 2014. After consideration and correspondence with applicant, counsel responds as follows.</p> <p style="text-align: center;"><b><u>REMARKS</u></b></p> <p>The Examining Attorney has continued the refusal to register under Section 2(e)(4) holding that the applied for mark is primarily merely a surname. Responsive thereto, applicant previously submitted a claim of acquired distinctiveness under 2(f) of the Trademark Act based on its prior U. S. Registration No. 3,324, 970 for the mark BENNINGER. The Examining Attorney has refused applicant's Section 2(f) claim on the basis that applicant's word mark application for BENNINGER under Serial No. 79/137,864 is not legally equivalent to the BENNINGER registration which forms the basis of applicant's Section 2(f) claim. The undersigned must respectfully disagree with the Examining Attorney that the registered mark and applied-for mark are not legal equivalents in this case.</p> <p>As the Examining Attorney notes in the Office Action, to be legal equivalents, "the applied-for mark must be indistinguishable from the previously-registered mark, <i>or create the same continuing commercial impression such that the consumer would consider them both to be the same mark.</i>" While the applicant's registered mark BENNINGER appears in a rectangular carrier background, it is simply a background with low level design significance. As mentioned, it is simply a carrier background and the primary commercial impression engendered by the mark is the word mark BENNINGER.</p> <p>Based on the foregoing, it is applicant's position that its applied-for BENNINGER mark and the noted registration should be viewed as "legally equivalent." See TMEP § 1212.04(b); <i>In re Best Products Co., Inc.</i>, 231 USPQ 988, 989 (TTAB 1986) ("[W]e infer in the instant case that the differences between the marks BEST &amp; Design and BEST JEWELRY &amp; Design, and between the identifications of services in their respective registrations, were deemed to be immaterial differences."); <i>In re Loew's Theatres, Inc.</i>, 223 USPQ 513, 514 (TTAB 1984), <i>affd.</i>, 769 F.2d 764, 226 USPQ 865 (Fed. Cir. 1985) ("We do not, however, agree with the Examining Attorney that a minor difference in the marks (i.e., here, merely that the mark of the existing</p>	

registration is in plural form) is a proper basis for excluding any consideration of this evidence under the rule."); *In re Flex-O-Glass, Inc.*, 194 USPQ 203, 205-06 (TTAB 1977) ("[P]ersons exposed to applicant's registered mark . . . would, upon encountering [applicant's yellow rectangle and red circle design] . . . , be likely to accept it as the same mark or as an inconsequential modification or modernization thereof . . . [A]pplicant may 'tack on' to its use of the mark in question, the use of the registered mark . . . and therefore may properly rely upon its registration in support of its claim of distinctiveness herein.").

It is respectfully requested the Examining Attorney withdraw the refusal to accept applicant's acquired distinctiveness claim and allow applicant's mark to proceed to publish for opposition purposes at the earliest possible date.

If further information is required, the Examining Attorney is encouraged to contact undersigned counsel by telephone to expedite the prosecution of the instant application.

### EVIDENCE SECTION

#### EVIDENCE FILE NAME(S)

<b>ORIGINAL PDF FILE</b>	<a href="#">evi_12411614-20150421153428819181_.S20727RequestforReconsiderationasfiled.pdf</a>
<b>CONVERTED PDF FILE(S) (2 pages)</b>	<a href="#">\\TICRS\EXPORT16\IMAGEOUT16\791\378\79137864\xml18\RFR0002.JPG</a>
	<a href="#">\\TICRS\EXPORT16\IMAGEOUT16\791\378\79137864\xml18\RFR0003.JPG</a>
<b>DESCRIPTION OF EVIDENCE FILE</b>	Executed copy of applicant's Request for Reconsideration

### SIGNATURE SECTION

<b>RESPONSE SIGNATURE</b>	/Jody H. Drake/
<b>SIGNATORY'S NAME</b>	Jody H. Drake
<b>SIGNATORY'S POSITION</b>	Attorney for applicant, DC bar member
<b>SIGNATORY'S PHONE NUMBER</b>	202.293.7060
<b>DATE SIGNED</b>	04/21/2015
<b>AUTHORIZED SIGNATORY</b>	YES
<b>CONCURRENT APPEAL NOTICE FILED</b>	NO

### FILING INFORMATION SECTION

<b>SUBMIT DATE</b>	Tue Apr 21 15:37:14 EDT 2015
	USPTO/RFR-12.4.116.14-201 50421153714445486-7913786

TEAS STAMP

4-53080fe7d46cd80ec45e95d  
6d79a518ce8f198271116c5a2  
53e878d159a5e66c3c-N/A-N/  
A-20150421153428819181

PTO Form 1960 (Rev 9/2007)  
OMB No. 0651-0050 (Exp. 07/31/2017)

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

Application serial no. **79137864** has been amended as follows:

### **ARGUMENT(S)**

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

#### **REQUEST FOR RECONSIDERATION**

This is in response to the Final Office Action dated October 30, 2014. After consideration and correspondence with applicant, counsel responds as follows.

#### **REMARKS**

The Examining Attorney has continued the refusal to register under Section 2(e)(4) holding that the applied for mark is primarily merely a surname. Responsive thereto, applicant previously submitted a claim of acquired distinctiveness under 2(f) of the Trademark Act based on its prior U. S. Registration No. 3,324, 970 for the mark BENNINGER. The Examining Attorney has refused applicant's Section 2(f) claim on the basis that applicant's word mark application for BENNINGER under Serial No. 79/137,864 is not legally equivalent to the BENNINGER registration which forms the basis of applicant's Section 2(f) claim. The undersigned must respectfully disagree with the Examining Attorney that the registered mark and applied-for mark are not legal equivalents in this case.

As the Examining Attorney notes in the Office Action, to be legal equivalents, "the applied-for mark must be indistinguishable from the previously-registered mark, *or create the same continuing commercial impression such that the consumer would consider them both to be the same mark.*" While the applicant's registered mark BENNINGER appears in a rectangular carrier background, it is simply a background with low level design significance. As mentioned, it is simply a carrier background and the primary commercial impression engendered by the mark is the word mark BENNINGER.

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(TTAB 1984), *affd*, 769 F.2d 764, 226 USPQ 865 (Fed. Cir. 1985) ("We do not, however, agree with the Examining Attorney that a minor difference in the marks (i.e., here, merely that the mark of the existing registration is in plural form) is a proper basis for excluding any consideration of this evidence under the rule."); *In re Flex-O-Glass, Inc.*, 194 USPQ 203, 205-06 (TTAB 1977) ("[P]ersons exposed to applicant's registered mark . . . would, upon encountering [applicant's yellow rectangle and red circle design] . . . , be likely to accept it as the same mark or as an inconsequential modification or modernization thereof . . . [A]pplicant may 'tack on' to its use of the mark in question, the use of the registered mark . . . and therefore may properly rely upon its registration in support of its claim of distinctiveness herein.").

It is respectfully requested the Examining Attorney withdraw the refusal to accept applicant's acquired distinctiveness claim and allow applicant's mark to proceed to publish for opposition purposes at the earliest possible date.

If further information is required, the Examining Attorney is encouraged to contact undersigned counsel by telephone to expedite the prosecution of the instant application.

#### **EVIDENCE**

Evidence in the nature of Executed copy of applicant's Request for Reconsideration has been attached.

#### **Original PDF file:**

[evi\\_12411614-20150421153428819181\\_.S20727RequestforReconsiderationasfiled.pdf](#)

**Converted PDF file(s)** ( 2 pages)

[Evidence-1](#)

[Evidence-2](#)

#### **SIGNATURE(S)**

#### **Request for Reconsideration Signature**

Signature: /Jody H. Drake/ Date: 04/21/2015

Signatory's Name: Jody H. Drake

Signatory's Position: Attorney for applicant, DC bar member

Signatory's Phone Number: 202.293.7060

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 not filing a Notice of Appeal in conjunction with this Request for Reconsideration.

Serial Number: 79137864

Internet Transmission Date: Tue Apr 21 15:37:14 EDT 2015

TEAS Stamp: USPTO/RFR-12.4.116.14-201504211537144454  
86-79137864-53080fe7d46cd80ec45e95d6d79a  
518ce8f198271116c5a253e878d159a5e66c3c-N  
/A-N/A-20150421153428819181

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re the Matter of

Benninger AG

Examiner: Aretha C. Somerville

U.S. Application No.: 79/137,864

Law Office 107

Date of Extension into US: August 13, 2013

Mark: BENNINGER

**BOX RESPONSES NO FEE**

Commissioner for Trademarks

P.O. Box 1451

Alexandria, VA 22313-1451

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Respectfully submitted,

Benninger AG



By: \_\_\_\_\_

Jody H. Drake  
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Washington, DC 20037-3218  
Telephone: (202) 293-7060

Dated: April 21, 2015