

From: Somerville, Aretha

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To: TTAB E filing

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Subject: U.S. TRADEMARK APPLICATION NO. 79137864 - BENNINGER - S20727 - Request for  
Reconsideration Denied - Return to TTAB

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Attachment Information:

Count: 1

Files: 79137864.doc

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

**U.S. APPLICATION SERIAL NO.** 79137864

**MARK:** BENNINGER



**CORRESPONDENT ADDRESS:**

JODY H DRAKE

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2100 PENNSYLVANIA AVENUE NW

WASHINGTON, DC 20037

**GENERAL TRADEMARK INFORMATION:**

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

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**APPLICANT:** Benninger AG

**CORRESPONDENT'S REFERENCE/DOCKET NO:**

S20727

**CORRESPONDENT E-MAIL ADDRESS:**

tm@sughrue.com

**REQUEST FOR RECONSIDERATION DENIED**

**ISSUE/MAILING DATE:** 7/5/2015

**INTERNATIONAL REGISTRATION NO. 1180102**

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. §2.63(b)(3); TMEP §§715.03(a)(ii)(B), 715.04(a). The following requirement(s) and/or refusal(s) made final in the Office action dated

7/16/2014 are maintained and continue to be final: Section 2(e)(4) Surname refusal. See TMEP §§715.03(a)(ii)(B), 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 examining attorney maintains that the 2(f) claim of acquired distinctiveness based on ownership of applicant's prior registration for the mark, BENNINGER and design 3324970 is not acceptable. As with a claim of distinctiveness based on continuous exclusive use, a claim of ownership of prior registrations featuring the same wording is not automatically accepted as prima facie proof of distinctiveness. 37 C.F.R. §2.41(b); TMEP §§1212.03, 1212.04.

A proposed mark is the "same mark" as previously registered marks for the purpose of Trademark Rule 2.41(b) if it is the "legal equivalent" of such marks. A mark is the legal equivalent of another if it creates the same, continuing commercial impression such that the consumer would consider them both the same mark. Whether marks are legal equivalents is a question of law subject to our *de novo* review. No evidence need be entertained other than the visual or aural appearance of the marks themselves. *Van Dyne-Crotty, Inc. v. Wear-Guard Corp.*, 926 F.2d 1156, 1159,

17 USPQ2d 1866, 1868 (Fed. Cir. 1991). The applicant's marks are not the same as they contain strikingly visual differences. Both color and the design element in the prior registered marks are material and create a different commercial impression of the marks such that a new search would be required. Purchasers would be drawn to both the background design of the mark as well as the color of the mark. Therefore, the marks are not legally equivalent.

If applicant has already filed a timely notice of appeal with the Trademark Trial and Appeal Board, the Board will be notified to resume the appeal. See TMEP §715.04(a).

If no appeal has been filed and time remains in the six-month response period to the final Office action, applicant has the remainder of the response period to (1) comply with and/or overcome any

outstanding final requirement(s) and/or refusal(s), and/or (2) file a notice of appeal to the Board. TMEP §715.03(a)(ii)(B); *see* 37 C.F.R. §2.63(b)(1)-(3). The filing of a request for reconsideration does not stay or extend the time for filing an appeal. 37 C.F.R. §2.63(b)(3); *see* TMEP §§715.03, 715.03(a)(ii)(B), (c).

/Aretha C. Somerville/

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