

ESTTA Tracking number: **ESTTA714630**

Filing date: **12/15/2015**

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

Proceeding	79149213
Applicant	Tetra GmbH
Applied for Mark	TETRA
Correspondence Address	LISA M WILLIS WILLIAM H BREWSTER KILPATRICK TOWNSEND & STOCKTON LLP 1100 PEACHTREE STREET N E, SUITE 2800 ATLANTA, GA 30309 UNITED STATES tmadmin@kilpatricktownsend.com, mrafter@kilpatricktownsend.com, lwil- lis@kilpatricktownsend.com
Submission	Applicants Request for Remand and Amendment
Attachments	Motion to Remand and Amend Application.pdf(16690 bytes )
Filer's Name	Jaclyn T. Shanks
Filer's e-mail	jshanks@kilpatricktownsend.com, mrafter@kilpatricktownsend.com, lwil- lis@kilpatricktownsend.com, nedwards@kilpatricktownsend.com
Signature	/Jaclyn T. Shanks/
Date	12/15/2015

## **MOTION TO REMAND AND AMEND APPLICATION**

Applicant Tetra GmbH (hereinafter “Applicant”), by and through counsel Kilpatrick Townsend & Stockton LLP, and pursuant to TBMP §1209.04, respectfully moves the Trademark Trial and Appeal Board (hereinafter “Board”) for an order remanding the instant Application to the examination level so that the Applicant may make of record the proposed amendments suggested by Examining Attorney Sara N. Benjamin. In support of the instant motion, Applicant provides as follows:

### **ARGUMENT**

On March 10, 2015, a final Office Action was issued in connection with Application Serial No. 79/149,213 (the “Application”) refusing registration of Applicant’s mark under Section 2(d) based on a likelihood of confusion with U.S. Registration Nos. 2,659,347, 2,771,093, 3,088,310, 3,629,692, 4,036,994, and 4,192,392. On September 11, 2015, Applicant timely filed a Notice of Appeal and Request for Reconsideration, including a partial claim of acquired distinctiveness under Section 2(f) based on evidence of use. On October 21, 2015, the Examining Attorney issued a Reconsideration Letter in which she withdrew the Section 2(d) refusal and accepted Applicant’s partial 2(f) claim (as well as Applicant’s request for the removal of the disclaimer of TETRA). However, the Examining Attorney ultimately denied Applicant’s Request for Reconsideration, inviting Applicant to amend the identification of goods in Classes 11 and 21. According to the Board’s resumption order dated October 22, 2015 for this proceeding, Applicant’s appeal brief is currently due by December 22, 2015.

As mentioned above, in the context of responding to Applicant’s Request for Reconsideration of the Application, the Examining Attorney invited Applicant to amend the instant Application with respect to the identification of goods in Classes 11 and 21. Applicant

now respectfully requests that its Application be amended as outlined below and as originally suggested by the Examining Attorney:

International Class 11: Lighting, heating and aerating apparatus to be used in indoor aquaria, terraria and garden ponds, namely, aquarium lights, terrarium lights and lights to be used in garden ponds, water heaters to be used in indoor aquaria, terraria and garden ponds, electric heaters to be used in terraria, water treatment units for aerating and circulating water in indoor aquaria, terraria and garden ponds; automatic temperature regulators to be used in indoor aquaria, terraria and garden ponds; air filters, water filters to be used in indoor aquaria, terraria and garden ponds; heating apparatus with integrated thermostats for use in indoor aquaria and terraria, namely, water heaters with integrated thermostats to be used in indoor aquaria, terraria and garden ponds, electric heaters to be used in terraria; electrical water filters and systems composed thereof and of water filters, water filter cartridges, water filter pads and water pumps for use in indoor aquaria, terraria and garden ponds; UV light bulbs for use in indoor aquaria, terraria and garden ponds; string lights for use in garden ponds; water filter and systems composed thereof and of water filters, water filter cartridges, water filter pads and water pumps for use in indoor aquaria, garden ponds and terraria; fountain filtration sets comprised of water filters, water filter cartridges, water pumps; filter pads in the nature of replacement pads for water filters for use in water filters in indoor aquaria, terraria and garden ponds; artificial waterfalls and fountains

International Class 21: Planting baskets for use in garden ponds; decoration material, namely, artificial landscapes, artificial plants, flowers and water lilies for aquarium and terrarium landscapes; ornaments, for use in indoor aquaria, terraria; decoration material, namely, ornaments of plastic and resin; decoration material, namely, basking platforms for use in terraria; indoor aquarium bowls; aquaria and tanks for fish keeping; artificial reefs to be used as decorative material in indoor aquaria

Applicant respectfully requests that the Board remand the Application to Trademark Examining Attorney, Ms. Sara N. Benjamin, in Law Office 110, for consideration of the amendments suggested by Ms. Benjamin, and suspend proceedings with respect to the appeal pending the Board's decision on the request for remand.

Good cause exists for a remand of the Application for amendment because Applicant believes that the Examining Attorney's suggested amendments will resolve all outstanding impediments to registration. Applicant further believes that, with the amendments outlined

above, the Examining Attorney should withdraw the refusal of registration and allow the Application to pass to registration. Prompt action to that end is earnestly solicited.

Applicant respectfully requests the suspension of further proceedings in connection with Applicant's ex parte appeal, including taking off the calendar the deadline for Applicant to file its appeal brief, for consideration by the Examining Attorney of the amendment mentioned above. If the amendment succeeds in placing the Application in condition for publication, then the appeal will be moot. In that case, the suspension of proceedings would avoid not only the time and effort involved for Applicant to prepare and file an appeal brief, but also the time and effort for the Board and the Examining Attorney to read the appeal brief and for the Examining Attorney to prepare and file a brief in response. If the Examining Attorney does not accept her own suggested amendments to the Application, then proceedings with respect to the appeal may be resumed and the due date for Applicant's appeal brief may be reset without any prejudice to the Board.

### **CONCLUSION**

WHEREFORE it is respectfully submitted that good cause exists and/or the TBMP provides that the instant request be granted and the Application be remanded to the Examining Attorney for further consideration of the Application with the proposed amendments to the identification of goods in Classes 11 and 21.

Respectfully submitted this 15th day of December, 2015

*/Jaclyn T. Shanks/*

---

Michael W. Rafter, Esq.  
Jaclyn T. Shanks, Esq.  
Kilpatrick Townsend & Stockton LLP  
1100 Peachtree Street NE, Suite 2800  
Atlanta, Georgia 30309  
*Attorneys for Applicant*