

From: Keeley, Alison

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Subject: U.S. TRADEMARK APPLICATION NO. 79173602 - HURLINGHAM POLO - N/A - Request for Reconsideration Denied - Return to TTAB

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

**U.S. APPLICATION SERIAL NO.** 79173602

**MARK:** HURLINGHAM POLO



**CORRESPONDENT ADDRESS:**

WILLIAM C WRIGHT

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NEW YORK, NY 10165

**GENERAL TRADEMARK INFORMATION:**

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

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**APPLICANT:** The Hurlingham Polo Association

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

N/A

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mail@ipcounselors.com

**REQUEST FOR RECONSIDERATION DENIED**

**ISSUE/MAILING DATE:** 11/1/2016

**INTERNATIONAL REGISTRATION NO. 1267472**

This Notice is in response to the applicant's Request for Reconsideration, dated October 27, 2016.

In the previous Office Action, dated April 29, 2016, the examining attorney:

- Made Final the Partial Section 2(d) Refusal due to a Likelihood of Confusion with the mark in U.S. Registration No. 3797268.

In the Response, applicant:

- Provided an Argument against the Section 2(d) Refusal.

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 refusal made final in the Office action dated April 29, 2016 is maintained and continues to be final:

- Section 2(d) Refusal – Likelihood of Confusion – Partial Refusal

*See* TMEP §§715.03(a)(ii)(B), 715.04(a).

In the present case, applicant's request has not resolved the outstanding issue, nor does it raise a new issue or provide any new or compelling evidence with regard to the outstanding issue 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.

Specifically, the Request for Reconsideration simply stated "Applicant believes that it has prior rights and therefore requests that the Examiner withdraw the citation." Applicant provided no other argument or evidence in the Request for Reconsideration.

Applicant's claim of priority of use is not relevant to this ex parte proceeding. *See In re Calgon Corp.*, 435 F.2d 596, 168 USPQ 278 (C.C.P.A. 1971). Trademark Act Section 7(b), 15 U.S.C. §1057(b), provides that a certificate of registration on the Principal Register is prima facie evidence of the validity of the registration, of the registrant's ownership of the mark, and of the registrant's exclusive right to use the mark in commerce on or in connection with the goods and/or services specified in the certificate. During ex parte prosecution, the trademark examining attorney has no authority to review or to decide on matters that constitute a collateral attack on the cited registration. TMEP §1207.01(d)(iv).

Therefore, as applicant's claim of prior rights is not relevant for the instant proceeding, this claim is not persuasive, nor does it raise a new issue or provide any new or compelling evidence. The examining attorney has no authority to review or decide on matters such as a claim of prior rights in an ex parte prosecution.

Therefore, the Request for Reconsideration is ***denied***.

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).

/Alison Keeley/

Examining Attorney

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