From: Rinker, Anthony

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Subject: U.S. TRADEMARK APPLICATION NO. 85262439 - SOLEMATES - 06096-004T - 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

APPLICATION SERIAL NO. 85262439

MARK: SOLEMATES

CORRESPONDENT ADDRESS:
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GENERAL TRADEMARK INFORMATION:
http://www.uspto.gov/main/trademarks.htm

APPLICANT: SoleMates, LLC

CORRESPONDENT'S REFERENCE/DOCKET NO:
06096-004T
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REQUEST FOR RECONSIDERATION DENIED

ISSUE/MAILING DATE: 7/10/2012

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. §2.64(b); TMEP §§715.03(a), 715.04(a). The requirement(s) and/or refusal(s) made final in the Office action dated 01/09/2012 are maintained and continue to be final. *See* TMEP §§715.03(a), 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.

Specifically, applicant's assertions and evidence that the terms SOULEMATE or SOLE MATES are generic terms in the context of jewelry are simply incorrect and irrelevant, respectively. Quite simply, neither term is generic or diluted in the context of jewelry. Generic terms are common names that the relevant purchasing public understands primarily as describing the genus of applicant's goods and/or services. *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 1344, 57 USPQ2d 1807, 1810 (Fed. Cir. 2001); *H. Marvin Ginn Corp. v. Int'l Ass'n of Fire Chiefs, Inc.*, 782 F.2d 987, 989-90, 228 USPQ 528, 530 (Fed. Cir. 1986); *see* TMEP §1209.01(c). Generic terms are by definition incapable of indicating a particular source of goods and/or services, and cannot

be registered as trademarks and/or service marks. *In re Merrill Lynch, Pierce, Fenner, & Smith, Inc.*, 828 F.2d 1567, 1569, 4 USPQ2d 1141, 1142 (Fed. Cir. 1987); *see* TMEP §1209.01(c). Registering generic terms "would grant the owner of [a] mark a monopoly, since a competitor could not describe his goods as what they are." *In re Merrill Lynch, Pierce, Fenner, & Smith, Inc.*, 828 F.2d at 1569, 4 USPQ2d at 1142. In this case, the genus of goods is jewelry. SOULMATE or SOLE MATES simply is not a genus of jewelry.

Moreover, of all of the registered marks on the Trademark Register for jewelry goods, only 3 registrations use these terms in the context of jewelry goods. The cited registrations, "SOLE MATES," 2935370, "SOULMATE," 3306078, and "SOULMATE. BECOME ONE. AGAIN." 3502298, respectively. Therefore, the terms SOLE MATES and SOULMATE are very strong in the context of jewelry goods.

Accordingly, the request is denied.

The filing of a request for reconsideration does not extend the time for filing a proper response to a final Office action or an appeal with the Trademark Trial and Appeal Board (Board), which runs from the date the final Office action was issued/mailed. *See* 37 C.F.R. §2.64(b); TMEP §§715.03, 715.03(a), (c).

If time remains in the six-month response period to the final Office action, applicant has the remainder of the response period to comply with and/or overcome any outstanding final requirement(s) and/or refusal(s) and/or to file an appeal with the Board. TMEP §715.03(a), (c). However, if applicant has already filed a timely notice of appeal with the Board, the Board will be notified to resume the appeal when the time for responding to the final Office action has expired. *See* TMEP §715.04(a).

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