

From: Imam, Ameen

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To: TTAB EFiling

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Subject: U.S. TRADEMARK APPLICATION NO. 85592703 - WATERPROOFING IN A BOX - HAY3-T.e19 -
Request for Reconsideration Denied - Return to TTAB

Attachment Information:

Count: 1

Files: 85592703.doc

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

U.S. APPLICATION SERIAL NO. 85592703

MARK: WATERPROOFING IN A BOX



CORRESPONDENT ADDRESS:

HEMAVATHY PERUMAL

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1411 5TH ST STE 306

SANTA MONICA, CA 90401-2416

GENERAL TRADEMARK INFORMATION:

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

APPLICANT: Homer T. Hayward Lumber Company, Inc.

CORRESPONDENT'S REFERENCE/DOCKET NO:

HAY3-T.e19

CORRESPONDENT E-MAIL ADDRESS:

REQUEST FOR RECONSIDERATION DENIED

ISSUE/MAILING DATE:

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)(2)(B), (a)(2)(E), 715.04(a). The refusal(s) made final in the Office action dated March 1, 2013 is maintained and continues to be final. See TMEP §§715.03(a)(2)(B), (a)(2)(E), 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.

Applicant argues that its mark "has multiple meanings and therefore susceptible to multiple connotations." See Applicant's Request for Reconsideration. Applicant further argues that "imagination is required when there are multiple meanings" and that the mark is suggestive. See *Id.* However, applicant should note that descriptiveness is considered in relation to the relevant goods. *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 1254, 103 USPQ2d 1753, 1757 (Fed. Cir. 2012). "That a term may have other meanings in different contexts is not controlling." *In re Franklin Cnty. Historical Soc'y*, 104 USPQ2d 1085, 1087 (TTAB 2012) (citing *In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979)); TMEP §1209.03(e). In the present case, the applied-for mark is considered in relationship to applicant's goods for "waterproofing kits." Accordingly, the applied-for mark as a whole immediately conveys the idea that applicant provides goods for the act of waterproofing and that the goods are available in a container. For this reason, applicant's argument does not overcome the refusal.

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, (a)(2)(B), (a)(2)(E), (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)(2)(B), (c). However, if applicant has already filed a timely notice of appeal with the Board, the Board will be notified to resume the appeal. See TMEP §715.04(a).

/Ameen Imam/

Examining Attorney

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