

Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	85644587
LAW OFFICE ASSIGNED	LAW OFFICE 101
MARK SECTION (no change)	
ARGUMENT(S)	
<p>A Request for Reconsideration of the Examiner's Final Office Action issued December 11, 2013 is respectfully requested for reasons explained below.</p> <p>It is also requested that the final rejection of Application Serial No. 85/644,587 (the '587 application) be withdrawn and that the application be suspended to allow the correction of the '587 application in view of a previously filed Request to Divide. The U.S. Patent and Trademark Office records do not show the processing of the Request to Divide. In addition, goods that were divided out (Class 9 goods) still show up in the U.S. Patent and Trademark Office records as being in the '587 application. Attached as Exhibit B is the TESS record of the '587 application that shows the Class 9 goods were left in the '587 application. The Class 9 goods were not addressed by the present Office Action in connection with the '587 application.</p> <p>A Notice of Appeal has also been filed to preserve the '587 application while these issues are sorted out.</p>	
REMARKS	
<p>I. <u>Request to Divide</u></p> <p>Applicant filed a Request to Divide on October 24, 2013 (copy attached as Exhibit A), requesting the present application be divided as follows:</p> <ol style="list-style-type: none">1. Parent application (the '587 application) retain the following goods and services:<ol style="list-style-type: none">a. <u>Class 19</u>: pre-fabricated non-metal buildings, namely equipment sheltersb. <u>Class 40</u>: custom fabrication of non-metal buildings2. The newly created child application retain the following goods and services:<ol style="list-style-type: none">a. <u>Class 9</u>: water level indicators	

- b. Class 19: non-metal drainage structures, namely, manholes and metering manholes; equipment for use in containing, treating or controlling the flow of water or waste water, namely, non-metal flumes, non-metal penstocks, non-metal water flow gates, non-metal water stop logs in the form of planks and water skimmers in the nature of fiber reinforced plastic structures used in conjunction with pipes or open channels to remove debris in sewers, storm drains and dams

- c. Class 40: custom fabrication and production of water or waste water containing and flow controlling equipment to the order and specification of others, including non-metal manholes and metering manholes, non-metal flumes, non-metal penstocks, non-metal water flow gates, non-metal water stop logs in the form of planks, water skimmers and water level indicators

A review of the U.S. Patent and Trademark Office database shows that Applicant's Request to Divide was never reviewed nor acted upon by the U.S. Patent and Trademark Office. Accordingly, Applicant requests that the Request to Divide be reviewed and the child application granted with the goods and services as described above in Classes 9, 19 and 40.

Applicant also requests that the final rejection be withdrawn and that the present '587 application be suspended so that the goods in Class 9 in this '587 application can be transferred to the child application.

II. Request for Reconsideration

The Examining Attorney has maintained his refusal of the present application alleging a likelihood of confusion with U.S. Registration No. 4,311,880 for the mark PLASTI-FAB.

Due to the differences in the goods and services, the channels of trade and the respective consumer sets, Applicant believes there is no likelihood of confusion and respectfully requests reconsideration in view of the prior amendment to the goods and services and the remarks set forth herein.

The Examiner's Office Action has not addressed the Class 9 goods which in the records in TESS indicate are still included in the '587 application. The final Office Action should be withdrawn for this reason as the Office Action did not address all of the goods in the '587 application.

III. Likelihood of Confusion with Registration No. 4,311,880

1. The Office Action does not address goods in Class 9. The Office Action neglected to address the goods in Class 9 which are "water level indicators" and are so far removed from the goods of the cited registration that no likelihood of confusion exists.

2. Peaceful coexistence of the two trademarks without any reported confusion further supports the argument that confusion is not likely. The length of time during and the conditions under which there has been concurrent use without evidence of actual confusion must be considered. *See du Pont, 476*

F.2d at 1361, 177 USPQ at 567.

Applicant's mark has been in use since 1973. The mark cited against Applicant's mark, has reportedly been in use since 1992. The very fact that these two marks have coexisted for over nineteen years with no known actual confusion indicates that there is certainly no likelihood of confusion. There is no better evidence of a lack of a likelihood of confusion than such long term coexistence without confusion.

3. Registrant's goods are explicitly significantly different from applicant's goods . The fact that Applicant's mark and the cited registration are both for goods in International Class 19 does not demonstrate that a likelihood of confusion would exist between the marks. As noted in Registrant's registration, the Registrant's goods are "prefabricated non-metal energy-efficient commercial and residential buildings." Applicant's goods were amended in its response on October 28, 2013 to read "pre-fabricated non-metal buildings, namely equipment shelters." Applicant's goods are very different from commercial and residential buildings. Applicant's equipment shelters are corrosion resistant equipment normally designed to be used for water and wastewater treatment and control. They are designed for quick installation and are used in various industries such as chemical feed, metering stations, waste-water treatment, fluoride systems and electrical and electronic switch gear.

In contrast, Registrant's goods are commercial and residential buildings. Commercial property can include office buildings, industrial property, medical centers, hotels, malls, retail stores, multifamily housing buildings, warehouses, and parking garages. All of these buildings are vastly different in look, size and use than Applicant's.

Accordingly, based on this factor as well, there does not appear to be a likelihood of confusion.

4. The respective consumer sets differ significantly further supporting finding of no likelihood of confusion. The segment of consumers that purchase merchandise with Applicant's mark are vastly different from the purchasers of the Registrant's commercial and residential buildings. Applicant's consumers are looking for a very specific product, namely, a fiberglass reinforced plastic (FRP) shelter. Commercial and residential buildings are buildings that are usually intended to generate a profit, either from capital gain or rental income.

The sophistication level of the consumers seeking to purchase a commercial or residential building are typically ones that exercise a heightened degree of care in making their purchases and are very unlikely to be confused as they are discerning consumers looking for very particular products. Applicant's consumers are also looking to purchase a very specific type of product in a specialized field and are focusing on very particularly marked product for a very specific purpose. Neither consumer sets will be easily confused. For this reason as well, there is no likelihood of confusion.

5. A likelihood of confusion is not probable here, and therefore registration of applicant's mark is appropriate. Likelihood of confusion must be probable, and not merely possible, in order to warrant rejection of registration on such grounds. *See McCarthy, supra*, Vol. 4, Section 23:3, pages 23-15-17 (December 2006) (citing *American Steel Foundries v. Robertson*, 269 U.S. 372 (1926)). Here, there are noteworthy differences in the goods at issue and extensive evidence of no likelihood confusion by coexistence of the two marks for the last thirty years without any actual confusion. Accordingly, it is clear that a likelihood of confusion is not probable.

Finally, the standard procedures for publication and opposition are setup for this various purpose: publication provides notice to the public that if a Registrant believes the applied for mark infringes in a registered mark, that Registrant can oppose the mark's registration.

III. Notice of Appeal

Applicant is filing a Notice of Appeal with the Trademark Trial and Appeal Board simultaneously. However, Applicant again notes that the U.S. Patent and Trademark Office database contains an error in the listing of the goods in Class 9 with respect to the present '587 application. The goods in Class 9 (water level indicators) were requested to be divided out into the child application on October 24, 2013. Thus, the Notice of Appeal should not include those goods; however, when Applicant went to submit the Notice of Appeal, the goods in Class 9 were shown as an option to appeal. Since those goods were not shown as being divided out, Applicant has included those goods in the appeal but again requests that the goods in Class 9 be divided out into the child application as originally requested.

V. Conclusion

In view of the above, the present '587 application should be:

1. Approved for publication or the final rejection be withdrawn and this application suspended while issues relating to the divisional application and Class 9 goods are addressed.
2. The divisional application be established to create a child application covering the goods and services in classes 9, 19 and 40 as set forth in the Request to Divide.

Further, upon grant of Request to Divide, the child application should be approved for publication.

EVIDENCE SECTION	
EVIDENCE FILE NAME(S)	
ORIGINAL PDF FILE	<u>evi_1-6713976194-174646448_ . Exhibit A - Request to Divide filed October 24_ 2013.pdf</u>
CONVERTED PDF FILE(S) (3 pages)	<u>\\TICRS\EXPORT16\IMAGEOUT16\856\445\85644587\xml12\RFR0002.JPG</u>
	<u>\\TICRS\EXPORT16\IMAGEOUT16\856\445\85644587\xml12\RFR0003.JPG</u>
	<u>\\TICRS\EXPORT16\IMAGEOUT16\856\445\85644587\xml12\RFR0004.JPG</u>
ORIGINAL PDF FILE	<u>evi_1-6713976194-174646448_ . Exhibit B - TESS Printout for App. SN 85644587.pdf</u>
CONVERTED PDF FILE(S) (2 pages)	<u>\\TICRS\EXPORT16\IMAGEOUT16\856\445\85644587\xml12\RFR0005.JPG</u>

	\\TICRS\EXPORT16\IMAGEOUT16\856\445\85644587\xml12\RFR0006.JPG
DESCRIPTION OF EVIDENCE FILE	Exhibit A - Request to Divide; Exhibit B - TESS Printout
SIGNATURE SECTION	
RESPONSE SIGNATURE	/David P. Petersen/
SIGNATORY'S NAME	David P. Petersen
SIGNATORY'S POSITION	Attorney of Record, Oregon State Bar member
SIGNATORY'S PHONE NUMBER	503-595-5300
DATE SIGNED	06/11/2014
AUTHORIZED SIGNATORY	YES
CONCURRENT APPEAL NOTICE FILED	NO
FILING INFORMATION SECTION	
SUBMIT DATE	Wed Jun 11 18:57:11 EDT 2014
TEAS STAMP	USPTO/RFR-67.139.76.194-2 0140611185711092551-85644 587-500801c63bdb83e369d2b 6cf5bbc21bea7079a02c95cde 977b2aee48ad53ddfad0-N/A- N/A-20140611174646448264

**Request for Reconsideration after Final Action
To the Commissioner for Trademarks:**

Application serial no. **85644587** has been amended as follows:

ARGUMENT(S)

In response to the substantive refusal(s), please note the following:

A Request for Reconsideration of the Examiner's Final Office Action issued December 11, 2013 is respectfully requested for reasons explained below.

It is also requested that the final rejection of Application Serial No. 85/644,587 (the '587 application) be withdrawn and that the application be suspended to allow the correction of the '587 application in view of a previously filed Request to Divide. The U.S. Patent and Trademark Office records do not show the processing of the Request to Divide. In addition, goods that were divided out (Class 9 goods) still show up in the U.S. Patent and Trademark Office records as being in the '587 application. Attached as Exhibit B is the TESS record of the '587 application that shows the Class 9 goods were left in the '587 application. The Class 9 goods were not addressed by the present Office Action in connection with the '587 application.

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REMARKS

I. Request to Divide

Applicant filed a Request to Divide on October 24, 2013 (copy attached as Exhibit A), requesting the present application be divided as follows:

1. Parent application (the '587 application) retain the following goods and services:
 - a. Class 19: pre-fabricated non-metal buildings, namely equipment shelters
 - b. Class 40: custom fabrication of non-metal buildings
2. The newly created child application retain the following goods and services:
 - a. Class 9: water level indicators
 - b. Class 19: non-metal drainage structures, namely, manholes and metering manholes; equipment for use in containing, treating or controlling the flow of water or waste water, namely, non-metal flumes, non-metal penstocks, non-metal water flow gates, non-metal water stop logs in the form of planks and water skimmers in the nature of fiber reinforced plastic structures used in conjunction with pipes or open channels to remove debris in sewers, storm drains and dams
 - c. Class 40: custom fabrication and production of water or waste water containing and flow controlling equipment to the order and specification of others, including non-metal manholes and metering manholes, non-metal flumes, non-metal penstocks, non-metal water flow gates, non-metal water stop logs in the form of planks, water skimmers and water level indicators

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2. The divisional application be established to create a child application covering the goods and services in classes 9, 19 and 40 as set forth in the Request to Divide.

Further, upon grant of Request to Divide, the child application should be approved for publication.

EVIDENCE

Evidence in the nature of Exhibit A - Request to Divide; Exhibit B - TESS Printout has been attached.

Original PDF file:

[evi_1-6713976194-174646448 . Exhibit A - Request to Divide filed October 24 2013.pdf](#)

Converted PDF file(s) (3 pages)

[Evidence-1](#)

[Evidence-2](#)

[Evidence-3](#)

Original PDF file:

[evi_1-6713976194-174646448 . Exhibit B - TESS Printout for App. SN 85644587.pdf](#)

Converted PDF file(s) (2 pages)

[Evidence-1](#)

[Evidence-2](#)

SIGNATURE(S)

Request for Reconsideration Signature

Signature: /David P. Petersen/ Date: 06/11/2014

Signatory's Name: David P. Petersen

Signatory's Position: Attorney of Record, Oregon State Bar member

Signatory's Phone Number: 503-595-5300

The signatory has confirmed that he/she is an attorney who is a member in good standing of the bar of the highest court of a U.S. state, which includes the District of Columbia, Puerto Rico, and other federal territories and possessions; and he/she is currently the applicant's attorney or an associate thereof; and to the best of his/her knowledge, if prior to his/her appointment another U.S. attorney or a Canadian attorney/agent not currently associated with his/her company/firm previously represented the applicant in this matter: (1) the applicant has filed or is concurrently filing a signed revocation of or substitute power of attorney with the USPTO; (2) the USPTO has granted the request of the prior representative to withdraw; (3) the applicant has filed a power of attorney appointing him/her in this matter; or (4) the applicant's appointed U.S. attorney or Canadian attorney/agent has filed a power of attorney appointing him/her as an associate attorney in this matter.

The applicant is not filing a Notice of Appeal in conjunction with this Request for Reconsideration.

Serial Number: 85644587

Internet Transmission Date: Wed Jun 11 18:57:11 EDT 2014

TEAS Stamp: USPTO/RFR-67.139.76.194-2014061118571109

2551-85644587-500801c63bdb83e369d2b6cf5b
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-N/A-N/A-20140611174646448264



Request to Divide Application

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	85644587
REGISTRATION NUMBER	
FORM TEXT	
<p>A Response to Office Action for Application Serial No. 85/644,587 is being electronically submitted separately. Please divide Application Serial No. 85/644,587 as follows:</p> <p>Parent Application ('587) will retain: "pre-fabricated non-metal buildings" in International Class 19 (first use anywhere and first use in interstate commerce dates are July 20, 1977); and "custom fabrication of pre-fabricated non-metal buildings" in International Class 40 (first use anywhere and first use in interstate commerce dates are July 20, 1977).</p> <p>Child Application (number not assigned yet) will list:</p> <p>Class 9: water level indicators</p> <p>Class 19: non-metal drainage structures, namely, manholes and metering manholes; equipment for use in containing, treating or controlling the flow of water or waste water, namely, non-metal flumes, non-metal penstocks, non-metal water flow gates, non-metal water stop logs in the form of planks and water skimmers in the nature of fiber reinforced plastic structures used in conjunction with pipes or open channels to remove debris in sewers, storm drains and dams</p> <p>Class 40: custom fabrication and production of water or waste water containing and flow controlling equipment to the order and specification of others, including non-metal manholes and metering manholes, non-metal flumes, non-metal penstocks, non-metal water flow gates, non-metal water stop logs in the form of planks, water skimmers, and water level indicators</p>	
PAYMENT SECTION	
NUMBER OF CLASSES	2
FEE PER CLASS	325
NUMBER OF New Applications	1
FEE PER New Application	100
TOTAL FEES DUE	750
SIGNATURE SECTION	

SUBMISSION SIGNATURE	/David P. Petersen/
SIGNATORY'S NAME	David P. Petersen
SIGNATORY'S POSITION	Attorney of record, Oregon bar member
SIGNATORY'S PHONE NUMBER	(503) 595-5300
DATE SIGNED	10/24/2013
AUTHORIZED SIGNATORY	YES
FILING INFORMATION SECTION	
TEAS STAMP	USPTO/RTD-10.112.151.172- 20131024161645018005-8564 4587-20131024141736162759 -DA-3095-2013102414173616 2759

Global Format; No Form Number (Rev 8/2009)
OMB No. 0651-0054 (Exp. 09/30/2014)

Request to Divide Application To the Commissioner for Trademarks:

The following is submitted for application serial number. **85644587** :

FORM INFORMATION

A Response to Office Action for Application Serial No. 85/644,587 is being electronically submitted separately. Please divide Application Serial No. 85/644,587 as follows:

Parent Application ('587) will retain: "pre-fabricated non-metal buildings" in International Class 19 (first use anywhere and first use in interstate commerce dates are July 20, 1977); and "custom fabrication of pre-fabricated non-metal buildings" in International Class 40 (first use anywhere and first use in interstate commerce dates are July 20, 1977).

Child Application (number not assigned yet) will list:

Class 9: water level indicators

Class 19: non-metal drainage structures, namely, manholes and metering manholes; equipment for use in containing, treating or controlling the flow of water or waste water, namely, non-metal flumes, non-metal penstocks, non-metal water flow gates, non-metal water stop logs in the form of planks and water skimmers in the nature of fiber reinforced plastic structures used in conjunction with pipes or open

channels to remove debris in sewers, storm drains and dams

Class 40: custom fabrication and production of water or waste water containing and flow controlling equipment to the order and specification of others, including non-metal manholes and metering manholes, non-metal flumes, non-metal penstocks, non-metal water flow gates, non-metal water stop logs in the form of planks, water skimmers, and water level indicators

FEE(S)

Fee(s) in the amount of \$750 is being submitted.

SIGNATURE(S)

Submission Signature

Signature: /David P. Petersen/ Date: 10/24/2013

Signatory's Name: David P. Petersen

Signatory's Position: Attorney of record, Oregon bar member

Signatory's Phone Number: (503) 595-5300

RAM Sale Number: 3095

RAM Accounting Date: 10/25/2013

Serial Number: 85644587

Internet Transmission Date:

TEAS Stamp: USPTO/RTD-10.112.151.172-201310241616450

18005-85644587-20131024141736162759-DA-3

095-20131024141736162759



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Record 1 out of 1

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PLASTI-FAB

Word Mark PLASTI-FAB
Goods and Services IC 009. US 021 023 026 036 038. G & S: Water level indicators
 IC 019. US 001 012 033 050. G & S: Prefabricated non-metal buildings, namely equipment shelters. FIRST USE: 19770720. FIRST USE IN COMMERCE: 19770720
 IC 040. US 100 103 106. G & S: Custom fabrication of non-metal buildings. FIRST USE: 19770720. FIRST USE IN COMMERCE: 19770720
Standard Characters Claimed
Mark Drawing Code (4) STANDARD CHARACTER MARK
Serial Number 85644587
Filing Date June 6, 2012
Current Basis 1A
Original Filing Basis 1A
Owner (APPLICANT) Plasti-Fab, Inc. CORPORATION OREGON PO Box 100 9665 SW Tualatin-Sherwood Rd Tualatin OREGON 97062
Attorney of Record David P. Petersen
Prior Registrations 0917042
Type of Mark TRADEMARK. SERVICE MARK
Register PRINCIPAL

Live/Dead Indicator LIVE

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