

To: Dyson Limited (trademark-dc@mofo.com)
Subject: U.S. TRADEMARK APPLICATION NO. 85708119 - 42466-240970
Sent: 12/8/2014 7:59:54 AM
Sent As: ECOM116@USPTO.GOV
Attachments:

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

U.S. APPLICATION SERIAL NO. 85708119	
MARK:	*85708119*
CORRESPONDENT ADDRESS: JENNIFER LEE TAYLOR MORRISON & FOERSTER LLP 425 MARKET ST SAN FRANCISCO, CA 94105-2482	CLICK HERE TO RESPOND TO THIS LETTER: http://www.uspto.gov/trademarks/teas/response_forms.jsp VIEW YOUR APPLICATION FILE
APPLICANT: Dyson Limited	
CORRESPONDENT'S REFERENCE/DOCKET NO : 42466-240970 CORRESPONDENT E-MAIL ADDRESS: trademark-dc@mofo.com	

OFFICE ACTION

STRICT DEADLINE TO RESPOND TO THIS LETTER

TO AVOID ABANDONMENT OF APPLICANT'S TRADEMARK APPLICATION, THE USPTO MUST RECEIVE APPLICANT'S COMPLETE RESPONSE TO THIS LETTER **WITHIN 6 MONTHS** OF THE ISSUE/MAILING DATE BELOW.

ISSUE/MAILING DATE: 12/8/2014

CONTINUATION OF FINAL REFUSAL

The Board has remanded this case to the examining attorney. At issue is a determination of whether the mark consists of a non-distinctive product design and therefore cannot function as a mark under Sections 1, 2, and 45 of the Trademark Act, 15 U.S.C. §§ 1051, 1052, and 1127.

The examining attorney apologizes for any inconvenience caused by prior actions that were unclear.

Non-distinctive product configuration

As the Trademark Trial and Appeal Board has noted, marks consisting of product configuration are never inherently distinctive, and cannot be registered on the Principal Register absent a showing of acquired distinctiveness under Section 2(f) of the Trademark Act.

The applicant recognized this and filed this application pursuant to Section 2(f). The applicant has presented a wide variety of advertising materials, declarations, and the like, adequately establishing that the consuming public directly associates the configuration of the product with the applicant. The applicant's widespread and exclusive market penetration (aided, no doubt, through monopolistic rights granted by the utility patents referenced in the earlier Office actions) is well-documented. In short, the applicant's 2(f) evidence is sufficient to show acquired distinctiveness necessary to overcome any non-distinctive product design refusal under Sections 1, 2, and 45 of the Trademark Act.

Final Refusal under Section 2(e)(5) MAINTAINED

Notwithstanding this demonstrated goods-source connection, the applicant's 2(f) evidence is still insufficient to overcome the refusal under Section 2(e)(5). Configurations for goods which are purely functional in nature are not capable of source identification, even if the applicant is the first or sole user of the configuration, and even if the use of the configuration has been over an extended period. As the Section 2(f) claim has no bearing on this refusal on the basis of functionality, the refusal to register is maintained for the reasons stated previously.

Since there are no new issues to be addressed, this file will be returned immediately to the Board for resumption of the applicant's appeal.

/Doritt Carroll/
Trademark Examining Attorney
Law Office 116
571-272-9138
Doritt.Carroll@uspto.gov

TO RESPOND TO THIS LETTER: Go to http://www.uspto.gov/trademarks/teas/response_forms.jsp. Please wait 48-72 hours from the issue/ mailing date before using the Trademark Electronic Application System (TEAS), to allow for necessary system updates of the application. For *technical* assistance with online forms, e-mail TEAS@uspto.gov. For questions about the Office action itself, please contact the assigned trademark examining attorney. **E-mail communications will not be accepted as responses to Office actions; therefore, do not respond to this Office action by e-mail.**

All informal e-mail communications relevant to this application will be placed in the official application record.

WHO MUST SIGN THE RESPONSE: It must be personally signed by an individual applicant or someone with legal authority to bind an applicant (i.e., a corporate officer, a general partner, all joint applicants). If an applicant is represented by an attorney, the attorney must sign the response.

PERIODICALLY CHECK THE STATUS OF THE APPLICATION: To ensure that applicant does

not miss crucial deadlines or official notices, check the status of the application every three to four months using the Trademark Status and Document Retrieval (TSDR) system at <http://tsdr.uspto.gov/>. Please keep a copy of the TSDR status screen. If the status shows no change for more than six months, contact the Trademark Assistance Center by e-mail at TrademarkAssistanceCenter@uspto.gov or call 1-800-786-9199. For more information on checking status, see <http://www.uspto.gov/trademarks/process/status/>.

TO UPDATE CORRESPONDENCE/E-MAIL ADDRESS: Use the TEAS form at <http://www.uspto.gov/trademarks/teas/correspondence.jsp>.

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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

**IMPORTANT NOTICE REGARDING YOUR
U.S. TRADEMARK APPLICATION**

USPTO OFFICE ACTION (OFFICIAL LETTER) HAS ISSUED
ON **12/8/2014** FOR U.S. APPLICATION SERIAL NO. 85708119

Please follow the instructions below:

(1) **TO READ THE LETTER:** Click on this [link](#) or go to <http://tsdr.uspto.gov>, enter the U.S. application serial number, and click on “Documents.”

The Office action may not be immediately viewable, to allow for necessary system updates of the application, but will be available within 24 hours of this e-mail notification.

(2) **TIMELY RESPONSE IS REQUIRED:** Please carefully review the Office action to determine (1) how to respond, and (2) the applicable response time period. Your response deadline will be calculated from **12/8/2014** (*or sooner if specified in the Office action*). For information regarding response time periods, see <http://www.uspto.gov/trademarks/process/status/responsetime.jsp>.

Do NOT hit “Reply” to this e-mail notification, or otherwise e-mail your response because the USPTO does NOT accept e-mails as responses to Office actions. Instead, the USPTO recommends that you respond online using the Trademark Electronic Application System (TEAS) response form located at http://www.uspto.gov/trademarks/teas/response_forms.jsp.

(3) **QUESTIONS:** For questions about the contents of the Office action itself, please contact the assigned trademark examining attorney. For *technical* assistance in accessing or viewing the Office action in the Trademark Status and Document Retrieval (TSDR) system, please e-mail TSDR@uspto.gov.

WARNING

Failure to file the required response by the applicable response deadline will result in the ABANDONMENT of your application. For more information regarding abandonment, see

<http://www.uspto.gov/trademarks/basics/abandon.jsp>.

PRIVATE COMPANY SOLICITATIONS REGARDING YOUR APPLICATION: Private companies **not** associated with the USPTO are using information provided in trademark applications to mail or e-mail trademark-related solicitations. These companies often use names that closely resemble the USPTO and their solicitations may look like an official government document. Many solicitations require that you pay “fees.”

Please carefully review all correspondence you receive regarding this application to make sure that you are responding to an official document from the USPTO rather than a private company solicitation. All official USPTO correspondence will be mailed only from the “United States Patent and Trademark Office” in Alexandria, VA; or sent by e-mail from the domain “@uspto.gov.” For more information on how to handle private company solicitations, see http://www.uspto.gov/trademarks/solicitation_warnings.jsp.