

From: Wood, Caroline

Sent: 2/10/2014 9:48:30 AM

To: TTAB E Filing

CC:

Subject: U.S. TRADEMARK APPLICATION NO. 85794896 - ZRPICASSO - 12-436 - Request for
Reconsideration Denied - Return to TTAB - Message 1 of 4

Attachment Information:

Count: 6

Files: p1-1.jpg, p1-2.jpg, p2-1.jpg, p2-2.jpg, p3-1.jpg, 85794896.doc

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

U.S. APPLICATION SERIAL NO. 85794896

MARK: ZRPICASSO



CORRESPONDENT ADDRESS:

MARIO G CESTE

LAW OFFICES OF MARIO G CESTE LLC

PO BOX 82

WALLINGFORD, CT 06492-0082

GENERAL TRADEMARK INFORMATION:

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

APPLICANT: York Dental Laboratory Inc.

CORRESPONDENT'S REFERENCE/DOCKET NO:

12-436

CORRESPONDENT E-MAIL ADDRESS:

mgcpls@usa.net

REQUEST FOR RECONSIDERATION DENIED

ISSUE/MAILING DATE: 2/10/2014

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 Trademark Act Section 2(d) requirement(s) and/or refusal(s) with regard to Registration Nos. 4175515 and 4175517 made final in the Office action dated July 12, 2013 are maintained and continue to be final. See TMEP §§715.03(a)(2)(B), (a)(2)(E), 715.04(a). However, the examining attorney withdraws the Trademark Act Section 2(d) refusal with regard to Registration No. 3855619.

In its request for reconsideration, applicant has submitted printouts of a list of third-party registrations for marks containing the wording PICASSO to support the argument that this wording is weak, diluted, or so widely used that it should not be afforded a broad scope of protection. The weakness or dilution of a particular mark is generally determined in the context of the number and nature of similar marks *in use in the marketplace* in connection with *similar goods*. See *Nat'l Cable Television Ass'n, Inc. v. Am. Cinema Editors, Inc.*, 937 F.2d 1572, 1579-80, 19 USPQ2d 1424, 1430 (Fed. Cir. 1991); *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973).

Evidence of weakness or dilution consisting solely of third-party registrations, such as those submitted by applicant in this case, is generally entitled to little weight in determining the strength of a mark, because such registrations do not establish that the registered marks identified therein are in *actual use* in the marketplace or that consumers are accustomed to seeing them. See *AMF Inc. v. Am. Leisure Prods., Inc.*, 474 F.2d 1403, 1406, 177 USPQ 268, 269 (C.C.P.A. 1973); *In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1204 (TTAB 2009); *In re Thor Tech, Inc.*, 90 USPQ2d 1634, 1639 (TTAB 2009); *Richardson-Vicks Inc. v. Franklin Mint Corp.*, 216 USPQ 989, 992 (TTAB 1982). Furthermore, the goods listed in the third-party registrations submitted by applicant are different from those at issue and thus do not show that the relevant wording is commonly used in connection with the goods at issue. Because applicant's mark and the already registered marks use the same primary term and are found in the same trade channels, the proposed mark is likely to be confused with the already registered marks.

Applicant argues that the Examiner has not established with this evidence that [the goods] "they will be encountered by the same consumers under circumstances that would lead to the mistaken belief that the good originate from the same source". See Applicant's response dated January 12, 2014. However, the examining attorney attached to the Final Office action from the USPTO's X-Search database consisting of a number of third-party marks registered for use in connection with the same or similar goods as those of both applicant and registrant in this case. This evidence shows that the goods listed therein, namely, "dental crowns, dental implants" and "dental wax" are of a kind that may emanate from a single source under a single mark. Additionally, the examining attorney has attached evidence from www.google.com to this request for reconsideration showing that "dental crowns" and "dental

wax” are complimentary goods and are used together. Where evidence shows that the goods at issue have complementary uses, and thus are often used together or otherwise purchased by the same purchasers for the same or related purposes, such goods have generally been found to be sufficiently related such that confusion would be likely if they are marketed under the same or similar marks. *See In re Martin’s Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 1567, 223 USPQ 1289, 1290 (Fed. Cir. 1984) (holding bread and cheese to be related because they are often used in combination and noting that “[s]uch complementary use has long been recognized as a relevant consideration in determining a likelihood of confusion”); *Gen. Mills Inc. v. Fage Dairy Processing Indus.*, 100 USPQ2d 1584, 1597-98 (TTAB 2012) (holding yogurt products and ready-to-eat cereals to be related because they are complementary products given consumers’ longstanding behavior of mixing these types of breakfast foods and the fact that consumers are regularly exposed to yogurt and cereal combined as a food product). Because the marks are nearly identical applicant’s mark is the drawing “ZRPICASSO” and design, Registration Nos. 4175515 and 4175517 are for the marks “PICASSO,” stylized and “PICASSO,” and the goods are found in the same trade channels, are complimentary and are used together, there is a likelihood of confusion.

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.

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).

/Caroline E. Wood/

Examining Attorney

Law Office 110

571-272-9243

caroline.wood@uspto.gov

(responses are not accepted via e-mail)

FIND A
Dental Clinic in your area

COSMETIC DENTISTRY

- Smile Makeover
- Teeth Whitening
- Dental Veneers
- Dental Crowns
- Dental Bridges
- Dental Restorations
- Dental Implants
- Cerec dentistry
- Cosmetic Bonding
- Tooth Reshaping
- Full Mouth Reconstruction
- Cost of Cosmetic Dentistry

COSMETIC ORTHODONTICS

- Orthodontics
- Teeth Straightening
- Invisalign
- Inman Aligner
- 6 month smiles
- Damon Braces
- Lingual braces

GENERAL DENTISTRY

- General Dentistry
- Dental Hygiene
- Perio Protect

TOOTHPASTE GUIDE

- Toothpaste Index

What is the procedure for having a dental crown fitted?

The treatment consists of two stages:

Stage 1

This involves an initial consultation in which all the treatment options are discussed with you. Following this the dentist will then prepare your tooth for the crown.

You will be given a local anaesthetic before the start of the treatment.

The dentist will then clean the tooth to be capped; removing any signs of decay and will then reshape it using a small drill called a 'burr'. The aim is to achieve a tapered tooth which will enable the crown to fit snugly over it.

Once this is done the dentist will then make a mould using dental wax (putty) to take an impression of your teeth. This involves you biting into the wax to leave an imprint of your teeth. This mould is then sent to a dental laboratory where it will be used as a blueprint for your new crown.

This can take 2 to 3 weeks so during that time you will be given a temporary crown to wear.

Stage 2

In your second visit the dentist will remove the temporary crown before etching the surface of the tooth with a special type of acid which gives it a rough surface. This rough surface will enable the dental cement to form a strong bond between the tooth and the crown.

The dentist will then fit your new crown over your tooth and check its fitting and alignment. He or she will also check to see that it fits in well with your natural teeth.

Once you are both happy with this then your dentist will use dental cement to fix the crown in place.

DENTAL CROWN GUIDE INDEX:

- What is a dental crown?
- Am I suitable for a crown?
- What is a crown made from?
- How much is a crown?
- What is the procedure for having a crown fitted?
- How long does the procedure take?
- Does it hurt having a crown?
- What are the benefits of a crown?
- Can anything go wrong with a crown?
- Does a crown look different to natural teeth?
- How long does a crown last for?
- Is there an alternative to a crown?



- ▲ Toothpaste Intro
- ▲ What is Toothpaste?
- ▲ Why should you use toothpaste?
- ▲ Toothpaste and dental hygiene
- ▲ Types of Toothpaste
- ▲ Toothpaste FAQs
- ▲ Glossary
- MOUTHWASH GUIDE**
- ▲ Mouthwash Intro
- ▲ What is a Mouthwash?
- ▲ Why should you use a Mouthwash?
- ▲ Types of Mouthwash
- ▲ Mouthwash FAQs
- ▲ Glossary
- MFNC® GUIDES**
- ▲ Cosmetic Surgery
- ▲ Cosmetic Dentistry
- ▲ Weight Loss Surgery
- ▲ Laser Eye Surgery
- ▲ Laser Hair Removal
- ▲ Hair Transplant
- ▲ Health Insurance
- ▲ Life Insurance
- ▲ Family Health
- ▲ Medical Tourism
- ▲ Hair Loss
- ▲ Stop Smoking
- ▲ Dental Implant

HOSPITAL. Medic8.com
2013-14

The only hospital in Florida
ranked in all 10 pediatric specialties
for three consecutive years.

REQUEST APPOINTMENT



CAD/CAM Solutions

- Working Models
- Copings, Crowns & Bridges
- Partial Denture Frameworks
- Implant Drill Guides
- Direct Metal Dental Parts
- Oral Surgery
- Orthodontics

Latest News

- Dental prosthetics market on the rise, boosted by 3D printing
JULY 21, 2011
- Additive Efficiencies - Dental Lab Products Article
JULY 2011
- 3D Systems Introduces New VisiJet e-Stone Dental Print Material
MARCH 22, 2011

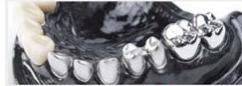
Copings, Crowns and Bridges

3D Systems offers two ways to create copings, crowns and bridges - via direct metal production or using a lost wax casting process.

With the ProJet® DP 3-D Production System, a scanner is used to scan your plaster model, and software is then used to model the wax-up. The ProJet DP makes the wax-ups, and these can be directly used to cast the alloy using a lost wax casting process. Popular production components include copings, bridges and full anatomy pressables.

With our Sinterstation® Pro DM125 SLM System, a scanner is also used but instead of building wax-ups, you are building directly in metal, using titanium and cobalt chrome.

Benefits include reduction, simplification, or even elimination of many of the traditional supply chain steps, resulting in immediate economical benefits.



MARCH 21, 2011

3D Systems Exhibits New Dental Solutions at IDS
MARCH 21, 2011

3D Systems Brings to Market New Dental Printer
FEBRUARY 23, 2011

LMT Article: How to Fabricate Anterior Pressed-to-Zirconia Restorations
FEB, 2011

■ Become a Reseller

Add a 3D Systems CAD/CAM Dental Printer to your line of offerings. Resellers Wanted, Apply Here

ProJet™ DP 3500 Professional 3D Printer

- Accurately consistently and economically manufacture precision dental wax-ups that are castable and pressable
- Simple to operate in-lab printer
- Compatible with most known 3D scanners in the industry



Download a PDF with Technical Specifications:

- English (pdf)
- Chinese (pdf)
- French (pdf)
- German (pdf)
- Italian (pdf)
- Japanese (pdf)
- Korean (pdf)
- Russian (pdf)
- Spanish (pdf)
- UK English (pdf)

Sinterstation® Pro DM125 SLM System

- Directly manufacture fully dense, end-use metal parts
- Excellent surface finish, feature detail and tight tolerances
- Directly build in titanium, cobalt chrome



Solution Providers

The following solution providers use ProJet DP Production System for Copings, Crowns and Bridges and can provide you with service. Please contact them to hear more about their solutions. Any open standard solution can also operate with the ProJet DP Production System.





**"late night opening and
Saturday appointments"**

CALL US **01606 44725**

[Home](#) [About us](#) [Treatments](#) [Patient Area](#) [Emergency](#) [Testimonials](#) [Newsletter](#) [Resources](#) [Contact us](#)



**NEW PATIENT CONSULTATION
Only £48 - [Start Here](#) >>>**

Already a Member?
MAKE AN ONLINE APPOINTMENT

Your email *

Your first name

Your surname

Date & time of appointment

First choice *

Second choice

Reason *
(e.g. routine check-up)

Who is your appointment with?

Your telephone *

SIGN UP

Crowns

You are here [Home](#) [Cosmetic Dentistry](#) [Crowns](#)

If you have badly broken teeth or weakening caused by decay, large fillings or worn down teeth, Dental crowns are the ideal solution to restore your teeth in a natural way. Dental crowns are commonly referred to to as a "Cap", because the crown protects the damaged tooth from further damage. A dental crown can recreate the original shape of your tooth as a natural tooth whilst improving its strength.

When do you need a Dental Crown?

- To strengthen a broken tooth that is decayed or cracked.
- If you have a tooth which is at risk of cracking.
- To improve the appearance of teeth that are a result of discoloured fillings.
- If you have a root filling, having a dental crown on the tooth will give it protection.
- To improve the cleanliness of a tooth.