From: Thompson, Heather

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Subject: U.S. TRADEMARK APPLICATION NO. 85849623 - PURO SOL - N/A - 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

U.S. APPLICATION SERIAL NO. 85849623 **MARK:** PURO SOL	
CORRESPONDENT ADDRESS: ARTURO PEREZ-GUERRERO LAW OFFICES OF ARTURO PEREZ-GUERRERO PO BOX 9024163 SAN JUAN, PR 00902-4163	**GENERAL TRADEMARK INFORMATION:** http://www.uspto.gov/trademarks/index.jsp VIEW YOUR APPLICATION FILE
APPLICANT: FABRICA DE JABON LA CORONA S.A. DE C.V.	
CORRESPONDENT'S REFERENCE/DOCKET NO: N/A **CORRESPONDENT E-MAIL ADDRESS:** arturo@perezguerrero.com	

REQUEST FOR RECONSIDERATION DENIED

ISSUE/MAILING DATE: 10/16/2014

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 refusal made final in the Office action dated March 31, 2014 is maintained and continue 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 the outstanding issue, nor does it raise a new issue or provide any new or compelling evidence with regard to the outstanding issue 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.

Specifically with regard to applicant's primary arguments in the September 30, 2014 Request for Reconsideration:

- **Consistent action vis á vis the withdrawal of previous cites**: applicant's assertion that examiner's withdrawal of citations involving marks for the foreign equivalent to SOL demands "*identical"* action be applied here ignores a critical fact. The term SOL in applicant's mark is more than simply a *foreign equivalent* to the cited mark; it is indeed the very same as the cited mark. The term SOL is most prominent in applicant's mark, both in size and overall impression. This directly conflicts with the cited mark SOL which appears in typed form (and thus may appear in any format).
- **SOL is suggestive in connection with laundry and cleaning goods; suggestive = weak:** Assuming *arguendo* that SOL is suggestive in this context, the following applies as noted previously: The Court of Appeals for the Federal Circuit and the Trademark Trial and Appeal Board have recognized that marks deemed "weak" or merely descriptive are still entitled to protection against the registration by a subsequent user of a similar mark for closely related goods and/or services. *In re Colonial Stores, Inc.*, 216 USPQ 793, 795 (TTAB 1982); TMEP §1207.01(b)(ix); s*ee King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 1401, 182 USPQ 108, 109 (C.C.P.A. 1974). This protection extends to marks registered on the Supplemental Register. TMEP §1207.01(b)(ix); *see, e.g.*, *In re Clorox Co.*, 578 F.2d 305, 307-08, 198 USPQ 337, 340 (C.C.P.A. 1978); *In re Hunke & Jochheim*, 185 USPQ 188 (TTAB 1975). Moreover, in earlier making of record a handful of third party registrations broadly spanning goods in IC 3 that include the term "sol" among other elements, applicant has not made a case for that term operating as either suggestive *or* weak. The cited mark is the ONLY registration in which SOL comprises the entirety of the mark and shares a nearly identification of goods with applicant.
- **Applicant's mark includes the term PURO which thereby distinguishes it from the cited mark:** Adding a term to a registered mark generally does not obviate the similarity between the compared marks, as in the present case, nor does it overcome a likelihood of confusion under Section 2(d). *See Coca-Cola Bottling Co. v. Jos. E. Seagram & Sons, Inc.*, 526 F.2d 556, 557, 188 USPQ 105, 106 (C.C.P.A. 1975) (finding BENGAL and BENGAL LANCER and design confusingly similar); *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266, 1269 (TTAB 2009) (finding TITAN and VANTAGE TITAN confusingly similar); *In re El Torito Rests., Inc.*, 9 USPQ2d 2002, 2004 (TTAB

1988) (finding MACHO and MACHO COMBOS confusingly similar); TMEP §1207.01(b)(iii). In the present case, the marks are identical in part. In the applicant's mark, the term Puro is visually far less prominent than the term Sol and thus renders SOL dominant.

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 refusal 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).

/Heather D. Thompson/

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