

Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	85937986
LAW OFFICE ASSIGNED	LAW OFFICE 112
MARK SECTION (no change)	
ARGUMENT(S)	
Please see the actual argument text attached within the Evidence section	
EVIDENCE SECTION	
EVIDENCE FILE NAME(S)	
ORIGINAL PDF FILE	evi_207250219132-20140929183736438556_.9548719_1.pdf
CONVERTED PDF FILE(S) (2 pages)	\\TICRS\EXPORT16\IMAGEOUT16\859\379\85937986\xml10\RFR0002.JPG
	\\TICRS\EXPORT16\IMAGEOUT16\859\379\85937986\xml10\RFR0003.JPG
ORIGINAL PDF FILE	evi_207250219132-20140929183736438556_.9548718_1.pdf
CONVERTED PDF FILE(S) (5 pages)	\\TICRS\EXPORT16\IMAGEOUT16\859\379\85937986\xml10\RFR0004.JPG
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	\\TICRS\EXPORT16\IMAGEOUT16\859\379\85937986\xml10\RFR0008.JPG
DESCRIPTION OF EVIDENCE FILE	arguments and Exhibit A, which includes status information regarding a relevant allowed application and registration certificate for a relevant registered mark.
SIGNATURE SECTION	
RESPONSE SIGNATURE	/Martha J. Engel/

SIGNATORY'S NAME	Martha J. Engel
SIGNATORY'S POSITION	Associate Attorney, Winthrop & Weinstine, MN Bar Member
DATE SIGNED	09/29/2014
AUTHORIZED SIGNATORY	YES
CONCURRENT APPEAL NOTICE FILED	YES
FILING INFORMATION SECTION	
SUBMIT DATE	Mon Sep 29 18:55:07 EDT 2014
TEAS STAMP	USPTO/RFR-207.250.219.132 -20140929185507166682-859 37986-5008771b639ef0c4dcb dde28344b118e94933e2f9f4e eab56665c3095d8f84c7-N/A- N/A-20140929183736438556

PTO Form 1960 (Rev 9/2007)
OMB No. 0651-0050 (Exp. 07/31/2017)

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

Application serial no. **85937986** has been amended as follows:

ARGUMENT(S)

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

Please see the actual argument text attached within the Evidence section

EVIDENCE

Evidence in the nature of arguments and Exhibit A, which includes status information regarding a relevant allowed application and registration certificate for a relevant registered mark. has been attached.

Original PDF file:

[evi_207250219132-20140929183736438556_.9548719_1.pdf](#)

Converted PDF file(s) (2 pages)

[Evidence-1](#)

[Evidence-2](#)

Original PDF file:

[evi_207250219132-20140929183736438556_.9548718_1.pdf](#)

Converted PDF file(s) (5 pages)

[Evidence-1](#)
[Evidence-2](#)
[Evidence-3](#)
[Evidence-4](#)
[Evidence-5](#)

SIGNATURE(S)

Request for Reconsideration Signature

Signature: /Martha J. Engel/ Date: 09/29/2014

Signatory's Name: Martha J. Engel

Signatory's Position: Associate Attorney, Winthrop & Weinstine, MN Bar Member

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 filing a Notice of Appeal in conjunction with this Request for Reconsideration.

Serial Number: 85937986

Internet Transmission Date: Mon Sep 29 18:55:07 EDT 2014

TEAS Stamp: USPTO/RFR-207.250.219.132-20140929185507

166682-85937986-5008771b639ef0c4dcbdde28

344b118e94933e2f9f4eeab56665c3095d8f84c7

-N/A-N/A-20140929183736438556

Applicant respectfully requests reconsideration of the refusal to register Applicant's mark POP DENTAL in view of U.S. Reg. No. 3,554,775 for POPBRUSH (the "Cited Mark").

1. Despite also beginning with the three letters POP-, Applicant has another allowed application for POP YOUR SMILE for the same goods that was not refused registration over the Cited Mark.

Applicant's application for POP YOUR SMILE, U.S. App. No. 85/937,991, which was allowed on July 22, 2014 for "toothbrushes; dental instruments, namely, attachments for use with electric toothbrushes in the nature of toothbrush heads for brushing and cleaning teeth and gums for home use." See Exhibit A. Like POP DENTAL, POP YOUR SMILE likewise begins with POP- and contains three syllables. The Applicant is entitled to the same treatment on all of its applications.

2. Even with the disclaimer of DENTAL, the mark as a whole must be considered when comparing to the Cited Mark, and such comparison reveals that the Cited Mark is sufficiently different in sight, sound and commercial impression such that a likelihood of confusion is not probable.

When considered in their entirety, POP DENTAL is not sufficiently similar to POPBRUSH in sight, sound, or commercial impression and a likelihood of confusion is not probable. Marks must be considered in their entireties in a determination of whether a likelihood of confusion exists between two marks. Even where there is a disclaimer or descriptive material, the mark must still be regarded as a whole. The Cited Mark must be compared with the Applicant's Mark in its entirety. With the disclaimed DENTAL, which still must be considered, POP DENTAL and POPBRUSH are clearly different in sight, sound and commercial impression as to not result in a likelihood of confusion between the two marks.

Although they share the common POP- prefix, "[t]he use of identical, even dominant, words in common does not automatically mean that two marks are similar," even on related goods. *Gen. Mills, Inc. v. Kellogg Co.*, 824 F.2d 622, 627, 3 U.S.P.Q.2d 1442, 1445 (8th Cir. 1987); see also *In re Coors Brewing Co.*, 343 F.3d 1340, 1344 (Fed. Cir. 2003); *Kellogg Co. v. Pack'em Enters., Inc.*, 951 F.2d 330 (Fed. Cir. 1991) (finding FROOTEE ICE for flavored ice bars not likely to cause confusion with FROOT LOOPS for breakfast cereal and related products); *Keebler Co. v. Murray Bakery Prods., Inc.*, 866 F.2d 1386 (Fed. Cir. 1989) (finding PECAN SHORTIES not likely to cause confusion with PECAN SANDIES). The Cited Mark, POPBRUSH, is a unitary mark. "A unitary mark has certain observable characteristics. Specifically, its elements are inseparable. In a unitary mark, these observable characteristics must combine to show that the mark has a distinct meaning of its own independent of the meaning of its constituent parts." *Dena Corp. v. Belvedere International, Inc.*, 950 F.2d 1555, 21 USPQ2d 1047, 1052 (Fed. Cir. 1991).

POP DENTAL is different than POPBRUSH in appearance, sound, and commercial impression. The Cited Mark is one compound word with two syllables beginning with POP- and ending with -BRUSH, and as a unitary mark the BRUSH is not disclaimed and must be

considered when reviewing the marks for similarity. Applicant's mark is two words with three syllables, and incorporates the additional wording of DENTAL, which cannot be ignored.

3. Marks also beginning with POP- have been allowed or registered for related goods to the goods on which the Cited Mark is registered.

The Trademark Office has previously allowed the registration and co-existence on the Principal Register of several marks likewise incorporating the term POP- for goods related to those claimed in the POPBRUSH registration. See Exhibit A.

The Cited Mark POPBRUSH is registered for "scrubbing brushes; manual toothbrushes; synthetic fibers for the manufacture of brushes, namely, toothbrushes, hair brushes and cleaning brushes; toothbrushes."

- POP YOUR SMILE, U.S. App. No. 85/937,991, which was allowed on July 22, 2014, applied for by Pop Dental LLC for "toothbrushes; dental instruments, namely, attachments for use with electric toothbrushes in the nature of toothbrush heads for brushing and cleaning teeth and gums for home use."
- POP UP, U.S. Reg. No. 4,590,629, owned by Tellier for among other goods "cleaning brushes for household use."

The Applicant believes that this application is entitled to the same treatment as these other marks.

4. Applicant is filing this response with a Notice of Appeal, and notes that a § 8 affidavit is due for the Cited Mark on December 30, 2014 and no such filing has yet been made.

Applicant notes that the Cited Mark is due for a § 8 filing on December 30, 2014. Applicant therefore respectfully requests that should the Examining Attorney deny this request for reconsideration of the final refusal, that action be suspended on this application until the grace period for filing the § 8 affidavit has passed. See TMEP § 716.02. Nevertheless, in order to preserve Applicant's rights in this application, Applicant submits a Notice of Appeal with this Request for Reconsideration.

EXHIBIT A

Generated on: This page was generated by TSDR on 2014-09-29 17:14:36 EDT

Mark: POP YOUR SMILE

POP YOUR SMILE

US Serial Number: 85937991

Application Filing Date: May 21, 2013

Register: Principal

Mark Type: Trademark

Status: Notice of Allowance (NOA) sent (issued) to the applicant. Applicant must file a Statement of Use or Extension Request within six months of the NOA issuance date.

Status Date: Jul. 22, 2014

Publication Date: May 27, 2014

Notice of Allowance Date: Jul. 22, 2014

Mark Information

Mark Literal Elements: POP YOUR SMILE

Standard Character Claim: Yes. The mark consists of standard characters without claim to any particular font style, size, or color.

Mark Drawing Type: 4 - STANDARD CHARACTER MARK

Goods and Services

Note: The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [.] indicate deleted goods/services;
- Double parenthesis ((.)) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- Asterisks * . * identify additional (new) wording in the goods/services.

For: Toothbrushes; dental instruments, namely, attachments for use with electric toothbrushes in the nature of toothbrush heads for brushing and cleaning teeth and gums for home use

International Class(es): 021 - Primary Class

U.S Class(es): 002, 013, 023, 029, 030, 033, 040, 050

Class Status: ACTIVE

Basis: 1(b)

Basis Information (Case Level)

Filed Use: No	Currently Use: No	Amended Use: No
Filed ITU: Yes	Currently ITU: Yes	Amended ITU: No
Filed 44D: No	Currently 44D: No	Amended 44D: No
Filed 44E: No	Currently 44E: No	Amended 44E: No
Filed 66A: No	Currently 66A: No	
Filed No Basis: No	Currently No Basis: No	

Current Owner(s) Information

Owner Name: Pop Dental L.L.C.

Owner Address: 11779 Boulder Bay Road
Eden Prairie, MINNESOTA 55344
UNITED STATES

Legal Entity Type: LIMITED LIABILITY COMPANY

State or Country Where Organized: MINNESOTA

Attorney/Correspondence Information

Attorney of Record

Attorney Name: Jeffrey R. Stone

Docket Number: 17590.NEW

Attorney Primary Email Address: trademark@winthrop.com

Attorney Email Authorized: Yes

Correspondent

Correspondent Name/Address: JEFFREY R. STONE
WINTHROP & WEINSTINE, P.A.
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UNITED STATES

Phone: 612-604-6534

Fax: 612-604-6985

Correspondent e-mail: trademark@winthrop.com jstone@winthrop.com dahl@winthrop.com

Correspondent e-mail Yes
Authorized:

Domestic Representative - Not Found

Prosecution History

Date	Description	Proceeding Number
Jul. 22, 2014	NOA E-MAILED - SOU REQUIRED FROM APPLICANT	
May 27, 2014	OFFICIAL GAZETTE PUBLICATION CONFIRMATION E-MAILED	
May 27, 2014	PUBLISHED FOR OPPOSITION	
May 07, 2014	NOTIFICATION OF NOTICE OF PUBLICATION E-MAILED	
Apr. 24, 2014	LAW OFFICE PUBLICATION REVIEW COMPLETED	77312
Apr. 24, 2014	ASSIGNED TO LIE	77312
Apr. 01, 2014	APPROVED FOR PUB - PRINCIPAL REGISTER	
Mar. 10, 2014	TEAS/EMAIL CORRESPONDENCE ENTERED	88889
Mar. 08, 2014	CORRESPONDENCE RECEIVED IN LAW OFFICE	88889
Mar. 08, 2014	TEAS RESPONSE TO OFFICE ACTION RECEIVED	
Sep. 10, 2013	NOTIFICATION OF NON-FINAL ACTION E-MAILED	6325
Sep. 10, 2013	NON-FINAL ACTION E-MAILED	6325
Sep. 10, 2013	NON-FINAL ACTION WRITTEN	81876
Sep. 05, 2013	ASSIGNED TO EXAMINER	81876
Jun. 01, 2013	NEW APPLICATION OFFICE SUPPLIED DATA ENTERED IN TRAM	
May 24, 2013	NEW APPLICATION ENTERED IN TRAM	

TM Staff and Location Information

TM Staff Information

TM Attorney: CROWLEY, PAUL C

Law Office Assigned: LAW OFFICE 112

File Location

Current Location: INTENT TO USE SECTION

Date in Location: Jul. 22, 2014

United States of America
United States Patent and Trademark Office

POP UP

Reg. No. 4,590,629

Registered Aug. 26, 2014

Int. Cls.: 8 and 21

TRADEMARK

PRINCIPAL REGISTER

TELLIER (FRANCE SOCIÉTÉ PAR ACTIONS SIMPLIFIÉE)
Z.I. DU VAL D'ARGENT,
21 RUE GUY MOQUET; F-95100 ARGENTEUIL
FRANCE

FOR: HAND-OPERATED HAND TOOLS AND IMPLEMENTS FOR THE KITCHEN, NAMELY, FRUIT AND VEGETABLE CORERS, CAN OPENERS, VEGETABLE SLICERS, VEGETABLE CHOPPERS, SPOONS, KNIVES, FORKS AND SHARPENING INSTRUMENTS, IN CLASS 8 (U.S. CLS. 23, 28 AND 44).

FOR: CONTAINERS FOR HOUSEHOLD OR KITCHEN USE; NON-ELECTRIC KITCHEN UTENSILS, NAMELY, GRATERS, MIXING SPOONS, COOKIE CUTTERS AND ICE CREAM SCOOPS; CLEANING BRUSHES FOR HOUSEHOLD USE; SPONGES FOR HOUSEHOLD PURPOSES; GLASS BEVERAGeware; BOWLS, DISHES, PANS, GLASS JARS AND GLASS STORAGE JARS; DRINKING GLASSES; VASES AND FLASKS; BOTTLES; CHOCOLATE AND PASTRY MOLDS, IN CLASS 21 (U.S. CLS. 2, 13, 23, 29, 30, 33, 40 AND 50).

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT, STYLE, SIZE, OR COLOR.

PRIORITY DATE OF 10-6-2011 IS CLAIMED.

OWNER OF INTERNATIONAL REGISTRATION 1116094 DATED 4-2-2012, EXPIRES 4-2-2022.

SER. NO. 79-112,973, FILED 4-2-2012.

EDWARD NELSON, EXAMINING ATTORNEY



Michelle K. Lee

Deputy Director of the United States
Patent and Trademark Office

**REQUIREMENTS TO MAINTAIN YOUR FEDERAL
TRADEMARK REGISTRATION**

**WARNING: YOUR REGISTRATION WILL BE CANCELLED IF YOU DO NOT FILE THE
DOCUMENTS BELOW DURING THE SPECIFIED TIME PERIODS.**

Requirements in the First Ten Years*
What and When to File:

First Filing Deadline: You must file a Declaration of Use (or Excusable Nonuse) between the 5th and 6th years after the registration date. See 15 U.S.C. §§1058, 1141k. If the declaration is accepted, the registration will continue in force for the remainder of the ten-year period, calculated from the registration date, unless cancelled by an order of the Commissioner for Trademarks or a federal court.

Second Filing Deadline: You must file a Declaration of Use (or Excusable Nonuse) and an Application for Renewal between the 9th and 10th years after the registration date.* See 15 U.S.C. §1059.

Requirements in Successive Ten-Year Periods*
What and When to File:

You must file a Declaration of Use (or Excusable Nonuse) and an Application for Renewal between every 9th and 10th-year period, calculated from the registration date.*

Grace Period Filings*

The above documents will be accepted as timely if filed within six months after the deadlines listed above with the payment of an additional fee.

**The United States Patent and Trademark Office (USPTO) will NOT send you any future notice or
reminder of these filing requirements.**

***ATTENTION MADRID PROTOCOL REGISTRANTS:** The holder of an international registration with an extension of protection to the United States under the Madrid Protocol must timely file the Declarations of Use (or Excusable Nonuse) referenced above directly with the USPTO. The time periods for filing are based on the U.S. registration date (not the international registration date). The deadlines and grace periods for the Declarations of Use (or Excusable Nonuse) are identical to those for nationally issued registrations. See 15 U.S.C. §§1058, 1141k. However, owners of international registrations do not file renewal applications at the USPTO. Instead, the holder must file a renewal of the underlying international registration at the International Bureau of the World Intellectual Property Organization, under Article 7 of the Madrid Protocol, before the expiration of each ten-year term of protection, calculated from the date of the international registration. See 15 U.S.C. §1141j. For more information and renewal forms for the international registration, see <http://www.wipo.int/madrid/en/>.

NOTE: Fees and requirements for maintaining registrations are subject to change. Please check the USPTO website for further information. With the exception of renewal applications for registered extensions of protection, you can file the registration maintenance documents referenced above online at <http://www.uspto.gov>.