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OMB No. 0651-0050 (Exp 07/31/2017)

Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	85983275
LAW OFFICE ASSIGNED	LAW OFFICE 110
MARK SECTION	
MARK FILE NAME	http://tmng-al.uspto.gov/resting2/api/img/85983275/large
STANDARD CHARACTERS	NO
USPTO-GENERATED IMAGE	NO
COLOR(S) CLAIMED (If applicable)	Color is not claimed as a feature of the mark.
DESCRIPTION OF THE MARK (and Color Location, if applicable)	The mark consists of a form of stylized opthalmosaurus having frizzy hair and wearing a lab coat, polka dotted bowtie, and eyeglasses.
ADDITIONAL STATEMENTS SECTION	
MISCELLANEOUS STATEMENT	Request for Reconsideration
MISCELLANEOUS FILE NAME(S)	
ORIGINAL PDF FILE	mis-75150131193-20160817234008533189_._20160817_RequestReconsiderationEyesteinDesignClass21.pdf
CONVERTED PDF FILE(S) (23 pages)	\\TICRS\EXPORT16\IMAGEOUT16\859\832\85983275\xml15\RFR0002.JPG
	\\TICRS\EXPORT16\IMAGEOUT16\859\832\85983275\xml15\RFR0003.JPG
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	\\TICRS\EXPORT16\IMAGEOUT16\859\832\85983275\xml15\RFR0024.JPG
CORRESPONDENCE SECTION	
ORIGINAL ADDRESS	JOHN W. GOLDSCHMIDT, JR. FERENCE & ASSOCIATES LLC 409 BROAD STREET PITTSBURGH Pennsylvania US 15143
NEW CORRESPONDENCE SECTION	
NAME	JOHN W. GOLDSCHMIDT, JR.
FIRM NAME	FERENCE & ASSOCIATES LLC
DOCKET/REFERENCE NUMBER	303.121016C
STREET	409 BROAD STREET
CITY	PITTSBURGH
STATE	Pennsylvania
ZIP/POSTAL CODE	15143
COUNTRY	United States
PHONE	(412) 241-8400
EMAIL	uspto@ferencelaw.com;jgoldschmidt@ferencelaw.com
SIGNATURE SECTION	
RESPONSE SIGNATURE	/John W. Goldschmidt, Jr./
SIGNATORY'S NAME	John W. Goldschmidt, Jr.
SIGNATORY'S POSITION	Attorney of Record Registration No. 34,828
SIGNATORY'S PHONE NUMBER	(412) 741-8400
DATE SIGNED	08/17/2016
AUTHORIZED SIGNATORY	YES
CONCURRENT APPEAL NOTICE FILED	YES
FILING INFORMATION SECTION	
SUBMIT DATE	Wed Aug 17 23:46:18 EDT 2016
TEAS STAMP	USPTO/RFR-XX.XXX.XXX.XXX- 20160817234618244910-8598 3275-550a836d1891dcc7176b f7b2eb97aa3902ce57866b6ae d18e30f2ae10e42f9a2c4a-N/ A-N/A-2016081723400853318

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OMB No. 0651-0050 (Exp 07/31/2017)

Request for Reconsideration after Final Action

To the Commissioner for Trademarks:

Application serial no. **85983275** (Stylized and/or with Design, see http://tmng-al.uspto.gov/resting2/api/img/85983275/large) has been amended as follows:

CORRESPONDENCE ADDRESS CHANGE
Applicant proposes to amend the following:
Current:
JOHN W. GOLDSCHMIDT, JR.
FERENCE & ASSOCIATES LLC
409 BROAD STREET
PITTSBURGH
Pennsylvania
US
15143

Proposed:
JOHN W. GOLDSCHMIDT, JR. of FERENCE & ASSOCIATES LLC, having an address of
409 BROAD STREET PITTSBURGH, Pennsylvania 15143
United States
uspto@ferencelaw.com;jgoldschmidt@ferencelaw.com
(412) 241-8400
The docket/reference number is 303.121016C .

ADDITIONAL STATEMENTS
Miscellaneous Statement
Request for Reconsideration

Original PDF file:
mis-75150131193-20160817234008533189_._20160817_RequestReconsiderationEyesteinDesignClass21.pdf
Converted PDF file(s) (23 pages)
Miscellaneous File1
Miscellaneous File2
Miscellaneous File3
Miscellaneous File4
Miscellaneous File5
Miscellaneous File6
Miscellaneous File7
Miscellaneous File8
Miscellaneous File9
Miscellaneous File10
Miscellaneous File11
Miscellaneous File12
Miscellaneous File13
Miscellaneous File14
Miscellaneous File15
Miscellaneous File16
Miscellaneous File17

Miscellaneous File18
Miscellaneous File19
Miscellaneous File20
Miscellaneous File21
Miscellaneous File22
Miscellaneous File23

SIGNATURE(S)
Request for Reconsideration Signature
Signature: /John W. Goldschmidt, Jr./ Date: 08/17/2016
Signatory's Name: John W. Goldschmidt, Jr.
Signatory's Position: Attorney of Record Registration No. 34,828

Signatory's Phone Number: (412) 741-8400

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 owner's/holder'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 owner/holder in this matter: (1) the owner/holder 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 owner/holder has filed a power of attorney appointing him/her in this matter; or (4) the owner's/holder'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.

Mailing Address: JOHN W. GOLDSCHMIDT, JR.
FERENCE & ASSOCIATES LLC
409 BROAD STREET
PITTSBURGH, Pennsylvania 15143

Serial Number: 85983275
Internet Transmission Date: Wed Aug 17 23:46:18 EDT 2016
TEAS Stamp: USPTO/RFR-XX.XXX.XXX.XXX-201608172346182
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4a-N/A-N/A-20160817234008533189

Attorney Docket No. 303.121016C **TRADEMARK**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	:	
	:	
Larry A. Donoso	:	**Law Office:** 110
	:	
Serial No.: 85/983,275	:	**Examining**
	:	**Attorney:** Dezmona J. Mizelle-Howard
Filed: March 16, 2012	:	
	:	
Mark: Design	:	

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

REQUEST FOR RECONSIDERATION

Sir:

In response to the Official Action dated February 17, 2016, and in view of the Remarks which follow and the evidence and remarks submitted in this Application to date, Applicant hereby requests reconsideration of the instant Application.

REMARKS

In view of the remarks which follow and the evidence submitted herewith, Applicant respectfully requests reconsideration of the above-identified Application.

1. *Request to Divide Application for International Class 18 Goods for Backpacks and Totebags*

Applicant notes, with appreciation, that the Examining Attorney has accepted the specimens submitted in connection with the International Class 18 goods, namely, "BACKPACKS AND TOTEBAGS."

In this regard, Applicant is submitting concurrently herewith a Request to Divide the instant Application to allow the International Class 18 goods to proceed directly to registration.

Accordingly, Applicant respectfully requests that a Certificate of Registration issue in connection with the International Class 18 goods.

2. *International Class 21 Goods for Cups and Water Bottles*

A. The Statement of Use

On November 20, 2014, Applicant submitted a Statement of Use in connection with the above-identified design mark for the following goods, together with the following specimens:

1. BACKPACKS AND TOTEBAGS in International Class 18

Specimen: Photograph of a backpack bearing Applicant's design mark (See Exhibit A)

2. CUPS AND WATER BOTTLES in International Class 21

Specimen: Photograph of a cup bearing Applicant's design mark (See Exhibit B)

B. <u>The First Official Action</u>

On December 24, 2014, the Examining Attorney issued an Official Action which accepted the specimen submitted in connection with the International Class 18 "backpack" goods (Exhibit A), however, rejected the equivalent specimen submitted in connection with the International Class 21 "cups" goods (Exhibit B).

Although there was no reason given for the acceptability of specimen submitted in connection with the International Class 18 "backpack" goods, the Examining Attorney rejected the International Class 21 "cups" goods because, in the Examining Attorney's view, "[t]he specimen does not show the applied-for mark in the drawing in use in commerce in International Class(es) 21."[1]

In its Request for Reconsideration dated June 24, 2015, Applicant traversed the Examining Attorney's rejection by pointing out that the specimen depicted, at the very least, a

[1] *Official Action* dated December 24, 2014 at 1. Inasmuch as the Examining Attorney did not articulate reasons for accepting the International Class 18 specimens comprising photograph of the backpack having Applicant's design affixed thereto, it is difficult to understand the distinction between affixing the same design to a cup to produce an acceptable specimen for International Class 21 goods.

"substantially exact representation" of Applicant's design mark which is the subject of the instant application.[2]

C. The Second Official Action

On July 15, 2015, the Examining Attorney issued an Official Action which continued the Examining Attorney's rejection of the International Class 21 "cups" specimen (See Exhibit B) albeit on different grounds. Specifically, in the Examining Attorney's view, the specimen identifies only a particular character and therefore does not function as a service mark.[3]

In its Supplemental Specimen Submission and Request for Reconsideration dated January 15, 2016, Applicant again traversed the Examining Attorney's rejection by (i) submitting a Supplemental Specimen depicting Applicant's design mark on another cup (See Exhibit C); and (ii) pointing out that the specimen evidenced Applicant's design mark as affixed to and prominently displayed on two different cups such that Applicant's design mark would be perceived as a mark.[4]

In further support of Applicant's contention that Applicant's design mark would be perceived as a mark, Applicant submitted further examples of similar (and in one case the exact same) specimens which had been accepted in related applications also owned by Applicant.[5]

Specifically, the following specimens of use were accepted in other related applications:

---

[2] *See* Applicant's *Request for Reconsideration* dated June 24, 2015 at 3-4.

[3] *See Official Action* dated July 15, 2015 at 1.

[4] *See* Applicant's *Supplemental Specimen Submission and Request for Reconsideration* dated January 15, 2016 at 3-4.

[5] *Id.* at 4 - 5.

1. **U.S. Trademark Registration No. 4,739,693** - Applicant's PROFESSOR EYESTEIN SAURUS mark for "cups and water bottles sold empty" in International Class 21.

   Acceptable Specimen (Exhibit D attached hereto): This specimen was accepted with the Statement of Use for U.S. Trademark Registration 4,739,693, which is a photograph of the same cup which has been rejected by the Examining Attorney as an acceptable specimen in the instant Application (Serial No. 85/983,275).

2. **U.S. Trademark Registration No. 3,420,762** - Applicant's "Oppy" Design mark for "cups" in International Class 21.

   Acceptable Specimen (Exhibit E attached hereto): Photograph of a cup accepted as the specimen in connection with the filing of the Section 8 & 15 Declaration.

3. **U.S. Trademark Registration No. 4,511,299** – Another of Applicant's "Oppy" Design mark for "cups and water bottles sold empty" in International Class 21.

   Acceptable Specimen (Exhibit F attached hereto): A brochure containing a photograph of a cup accepted as the specimen submitted with the Statement of Use.

Although the Examining Attorney did not indicate that there had been any consideration given to these significantly related Registrations, given the highly similar (and in one instance, identical) nature of the specimens submitted in these three related United States Trademark Applications which have matured to registration, Applicant respectfully submits that the specimen submitted in connection with the International Class 21 goods in the instant Application is, likewise, used on "specimens on displays associated with the goods, it in a manner that would be perceived as a mark," and, thus, is entitled to registration on the Principal Register.

In addition, Applicant submitted, without prejudice, with its Supplemental Specimen Submission and Request for Reconsideration dated January 15, 2016, a Supplemental Specimen which also bears Applicant's design mark affixed to a cup. Appropriate consideration is also respectfully requested.

D. <u>The Third and Current Official Action</u>

On February 17, 2016, the Examining Attorney issued a third Official Action which continued the Examining Attorney's rejection of the International Class 21 "cups" specimen (See Exhibit B) on similar grounds but without addressing any of Applicant's remarks or evidence presented in Applicant's January 15, 2016 Request for Reconsideration.[6]

In the Examining Attorney's view:

[6] In this regard, Applicant respectfully submits that the finality of the Official Action dated February 17, 2016, is premature because the Examining Attorney has not specifically and directly addressed Applicant's arguments made, evidence presented, and the Supplemental Specimen submitted in Applicant's Supplemental Specimen Submission and Request for Reconsideration dated January 15, 2016. Accordingly, Applicant respectfully requests that the finality of the Official Action dated February 17, 2016, be withdrawn.

> Registration is refused because the applied-for mark, as used on the specimen of record, identifies only a particular character in ***a creative work***; it does not function as a trademark to identify and distinguish applicant's goods from those of others and to indicate the source of applicant's goods.
>
> * ****
>
> In this case, the specimen shows the applied-for mark used only to identify a character and not as a trademark for applicant's goods because the mark is ***seen along with other designs on a cup***. ***The usage on the cup does not identify trademark use.***
>
> *****
>
> [I]n this case specimens fail to demonstrate the design mark as a service mark for applicant's goods. It appears to be a character on a mug, and cannot be pulled out to designate it as a trademark for cups. The character has blended so well with the other characters that it is impossible to discern which element is a trade mark.
>
> The specimens fail to demonstrate the design mark as a trademark for applicant's services.[7]

As an initial matter, Applicant respectfully submits that the specimens of record do not identify a character in "a creative work." To the contrary, Applicant's design mark does not appear in a "creative work," rather the mark is "affixed" to the goods, namely a cup. Moreover, and particularly with respect to the specimen originally submitted with Applicant's Statement of Use, Applicant's design mark appears alone and not "along with other designs on a cup."

Moreover, and particularly in view of numerous other related Registrations which have issued for design marks appearing on cups,[8] Applicant's use of Applicant's design mark as depicted in the specimens clearly is indicative of classic trademark usage.

---

[7] *Official Action* dated February 17, 2016, at 1.

[8] *See infra* at 5 – 6.

In addition, the Examining Attorney has refused registration because "the specimen does not show the applied-for mark in the drawing in use in commerce in International Class(es) 21."[9]

The Examining Attorney explains:

> Specifically, the specimen displays the mark as a design looking to the left; however, the drawing displays the mark as a design looking to the right and holding a pointer. In addition, there are ***other design elements*** integrally embedded into applicant's mark.
>
> *****
>
> Because the mark in the drawing is not a substantially exact representation of the mark on the specimen, applicant has failed to provide the required evidence of use of the applied-for mark in commerce on or in connection with applicant's goods and/or services.[10]

Applicant respectfully traverses this rejection inasmuch as the legal standard for an acceptable specimen is that the drawing must be a "***substantially*** exact representation" of the mark as used on or in connection with the goods or services shown in the specimen.[11] Thus, the drawing and the specimen need not be an "exact" representation, rather a "substantially exact" representation will do.

However, the Examining Attorney is of the view that a mirror images of the design as depicted in the drawing and the specimen are not "substantially exact." The Examining Attorney admits that the only differences between the depictions of the design in the drawing and the specimen are that one design looks to the left while the other design looks to the

---

[9] *Official Action* dated February 17, 2016, at 1.

[10] *Id* at 1-2.

[11] 37 C.F.R. §2.51(a); TMEP §807.12(a).

right and holds a pointer.[12] All other features of the design, such as for example, the frizzy hair, glasses, polka dotted tie, coat, posture, expression and body stance are all identical. Given such extreme similarities and few differences it seems altogether unlikely that a consumer would not garner the same commercial impression from Applicant's design mark as depicted in the drawing and the Specimen of record. Thus, the specimens depict at least a "substantially exact" representation of the design mark depicted in the drawing.

Accordingly, Applicant respectfully submits that Applicant's design mark which is the subject of the instant Application is acceptable under the Lanham Trademark Act.

3. Conditional Notice of Appeal

To the extent, and only to the extent, that the Examining Attorney does not withdraw the rejections to the International Class 21 goods for cups and water bottles, Applicant is concurrently submitting herewith a Notice of Appeal to resolve any remaining issues.

Request for Interview

Applicant respectfully requests the courtesy of a telephonic interview prior to a decision being rendered on Applicant's request for reconsideration should the Examining Attorney have any further questions with respect to the instant application.

[12] The Examining Attorney also makes reference to "other design elements integrally embedded into applicant's mark" but does not specify what those "other design elements" are.

Conclusion

In view of the foregoing, Applicant respectfully requests reconsideration of the instant application. Applicant further submits that this application is in condition for acceptance and respectfully requests early and favorable registration of Applicant's design mark.

Respectfully submitted,

/John W. Goldschmidt, Jr./
John W. Goldschmidt, Jr.
Registration No: 34,828
FERENCE & ASSOCIATES LLC
409 Broad Street
Pittsburgh, Pennsylvania 15143
Telephone: (412) 741-8400
Facsimile: (412) 741-9292

Attorneys for Applicant

Date: August 17, 2016

EXHIBIT A

EXHIBIT B

THE OPPY CLUB
E=mc²
PROFESSOR EYESTEIN SAURUS
WWW.OPPYCLUB.COM

EXHIBIT C

PROFCASTS

EXHIBIT D

THE OPPY CLUB
E=MC²
PROFESSOR EYESTEIN SAURUS
WWW.OPPYCLUB.COM

EXHIBIT E

OUR VISION
TO PRESERVE YOUR VISION

EXHIBIT F

What Joining the Oppy Club Provides.

A one year complimentary membership to the Oppy Club.This entitles a member to receive an Oppy Kit containing items that related to science, education, and health care such as a coloring book, ruler, back pack, water bottle, and an Oppy pad. The member will also receive an Oppy ID number which allows the member to log into the Oppy Club internet site, which is **www.vision-research.org**. The site contains many features of interest to children like the Story of the Month. For example, Horse- shoes is a story about different kinds of horseshoes - even within the eye. Each month a new story will be posted and acces- sible to Oppy Club members. By becoming a member of the Oppy Club the foundation will also re- ceive a donation from a corporate sponsor to continue research. It is the goal of the Oppy Club to keep the child interested in an environment in which the child will look forward to the return visit to the doctor.

Brochure Design: Joe Tenerelli Design

The Philadelphia Retina Endowment Fund
PO Box 53429
Philadelphia, PA 19105

The Philadelphia Retina Endowment Fund

An Invitation to Join the Oppy Club

"Hi, I'm Oppy,"
the Friendly, Caring and Concerned
Prehistoric Dinosaur.

The Oppy Club

Great Physicians Provide Great Care and Great Staffs Make for a Great Visit

Oppy Club Membership

Membership in the Oppy Club provides your child with the unique opportunity to explore and experience Science and the Arts through the eyes of Oppy, the Friendly, Caring and Concerned dinosaur.

> "It is our intention through the Oppy Club to enrich the experience children have with their health care provider and thereby help create a positive environment they may look forward to visiting for many years."

What We Do

Imagine what your life would be without the discovery by Pastuer, for example, of the process to pasteurize milk or without the discovery of vaccines to protect our children from infectious diseases like rabies or polio. It is the continuous process of research which makes possible these advancements that we often take for granted. Our laboratory and its associated laboratories are devoted to research of diseases of the eye with an emphasis on the retina. We welcome your interest and/or participation in our efforts to eradicate potentially serious eye conditions.

What We Don't Do

The Oppy Club is concerned with privacy issues and will not sell or distribute in any manner any information about its members. The Oppy Club will have no access to any medical information about a member. The Oppy Club exists to make the visit of a child to a physician office or hospital something to look forward to, but does not provide any form of patient care. We do not provide any political or religious information.

The Foundation

The Philadelphia Retina Endowment Fund is a non-profit medical research foundation which exists to support research and education in the prevention, diagnosis, and treatment of medical disorder of the eye. The Fund also operates the Henry and Corinne Bower Laboratory which is devoted primarily to research related to the retina of the eye. It also trains students and fellows for a career in medical research.

The Oppy Kit

The Oppy Club kit is a personalized voluntary gift to the patient and contains an explanation about the contents of the kit, the sponsor, the physician and staff. It is intended to make the visit an experience in which the patient wishes to return to. The items of the kit were determined by a survey of parents and do not contain food or candy, sharp or potentially dangerous object, religious or political material. The Oppy Club member receives a personalized membership card for future visits as well as a pass to the Oppy Club on the internet and other educational material such as a copy of Stories of the Month and timely topics and an Oppy coloring book featuring the Oppy family.

www.vision-research.org