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BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

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Applicant	LumaSense Technologies Holdings, Inc.
Applied for Mark	SMARTDGA
Correspondence Address	JOHN W MONTGOMERY OSHA LIANG LLP 909 FANNIN ST , STE 3500 HOUSTON, TX 77010-1034 UNITED STATES docketing@oshaliang.com
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Filer's Name	John W. Montgomery
Filer's e-mail	docket@oshaliang.com, montgomery@oshaliang.com, har-gadon@oshaliang.com, penny@oshaliang.com, welsh@oshaliang.co,
Signature	/john w. montgomery/
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Serial No. 86004595

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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Serial No. 86004595

Mark: SmartDGA (and Design)

Applicant: LumaSense Technologies Holdings, Inc.

Examining Attorney: Jennifer D. Richardson
Law Office 113

EX PARTE APPEAL

APPLICANT'S REPLY BRIEF

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REPLY TO THE EXAMINING ATTORNEY'S APPEAL BRIEFReply to the Examining Attorney's Appeal Brief

The Examining Attorney argues extensively that the word portion of the mark is descriptive of a feature of the goods. It is respectfully submitted that this is a "boarder-line" cases of the mark being considered as merely descriptive, because of the nature of the coining of the combined terms of "Smart" with "DGA" together into a single word all claimed in a particular font (not standard characters) with a particular capitalization of the first letter, with intervening lower case letters and final a series of ending capital letters (i.e., in a unique manner to indicate to consumers trademark usage, and no showing that others in the field have used this combination mark to describe their products. Regardless, Applicant has acquiesced to disclaim the words portion apart from the entire combination of features of the word and color design mark.

The mark should be considered in its entirety. In particular, the disclaimer affords, greater weight given to the remaining combination of stylization, unique design shape in this field of goods, selected capitalization to indicate to consumers trademark usage, the unique color for the identified goods, and shading variations of the color for the design to further provide a unique and inherently distinctive three dimensional impression for the design. It might be seen that the word portion is, in effect, "hovering" over or balanced upon an apparent raised horizontal ridge line across the design. The entire combination mark should all be considered for the overall commercial impression, as being capable of distinguishing applicant's goods from the same or similar goods of others.

Initially, it should be noted that this is not a case where “standard characters” are claimed. To the contrary, stylization is claimed and must be considered for its commercial impression on the consuming public under the facts of this application. It is not a case involving mere geometric shaped tags, labels or ornamental background on clothing (or on other goods) where use of geometric figures is considered to be common and where use of such geometric shapes on clothing (or on other goods) may be considered by consumers as merely a common ornamental background according to the custom and as used by many others in the field of clothing goods (or in other fields of products where mere ornamentation might be an expectation of consumers). There is no showing of common use in the applicants’ field and here is no showing that ornamentation using geometric shapes is common on applicant’s goods.

The Examining Attorney argues that the words are descriptive and then dissects the mark to consider separately only a few selected component parts of the overall design. It is asserted by the Examining Attorney that the stylization of the font alone does not have an adequate impact to indicate trademark usage to the relevant consumer. In this discussion the Examining Attorney indicates that whether stylization will be considered to be distinctive is “subjective” among consumers. Thus, it is likely that depending upon the relevant consumers for the identified goods, the stylization of the lettering might subjectively provide a source indicating function. The Examining Attorney decides otherwise, without any other evidence, that Applicant’s stylization by itself would not be considered by the relevant consumers to indicate a trademark function. The Examining Attorney asserts that the stylization by itself will not rescue the mark. Essentially, the analysis is that in the subjective opinion of the Examining Attorney, the font and capitalization selected by applicant for its mark SmartDGA (and Design), would have insufficient impact upon

consumers to consider the mark as a whole to be Applicant's trademark, i.e., to distinguish Applicant's goods from those of others. A significant number of text books, articles, courses, seminars, other writings and other references on the subject of proper usage of trademarks, indicate that when using a term as a trademark one should capitalize the term, italicize the term, or otherwise change the font from surrounding words to help distinguish and established that the term is being used as a trademark. It is respectfully submitted that such advice is given as a general practice by many practicing trademark attorneys, a sufficient number of trademark users follow this common general advice, and such use has become a known practice when using trademark. It is at least a sufficiently common general practice that consumers are familiar and have become accustomed to considering capitalization or other forms of stylization of the letters of a term used in commerce to indicate that a term is a trademark. As such, consumers will have the commercial impression that the particular font and the capitalization of it indicate the term is used as a trademark. It will be subjectively considered to be a part of a trademark based upon the overall commercial impression in the context of the entire combination mark for applicant's goods. Applicant's use of both the combination of the word "Smart" and the terms "DGA" to produce a new term SmartDGA (with an initial capital and also internal and end capitals to provide the stylized term "SmartDGA") weighs in favor of finding distinctiveness of the entire mark. Thus, the stylization cannot be dismissed without consideration and by merely asserting the Examining Attorney's subjective determination. The expectation that consumers will consider these features as part of a trademark should also be considered in this instance. Moreover, each feature that weighs in favor of providing distinctiveness should be considered in combination with all of the other features that indicate a mark provides a

distinctive overall commercial impression and is capable of serving as a trademark to distinguish applicants goods from those of others.

Thus, the particular font, the combining of terms into a single term, and unique capitalization at the beginning of single combined term, lower case letters within the mark and capitalization at the end of the mark all have aspects that relevant consumers of applicant's goods will consider as distinguishing applicant's goods from similar goods of others. It is respectfully submitted that there is no showing by the Examining Attorney that others in applicant's field of goods either use the combined term, the particular font or the stylization combined into applicant's mark. Distinctiveness of those features alone need not end the inquiry, because there are also other features that provide distinctiveness to applicant's combination word and design mark.

The Examining Attorney also dismissed the distinctiveness of Applicants' design features as being merely a gold colored hexagon, almost entirely without consideration of any of the unique features of the design and without any substantive analysis of those features as to the commercial impression to the relevant consumers for the identified goods. The Examining Attorney has asserted that applicant's mark could not distinguish applicant's goods from those of others, because the word portion was consider descriptive, the stylization was subjectively not distinctive enough (according to the Examiner's subjective determination), and the design features would be considered merely a common background shape and a common color. Applicant strongly disagrees. A description of the mark as merely a gold colored hexagon does not make it either a common shape for use on these goods or a common color for use on these goods. The drawing of the mark must be considered in its entirety. The brief written description of the mark as proposed for adoption by the Examiner and as adopted to move the case forward does not control the analysis of

the distinctiveness of the design features. The brief description of the mark is for the purpose of providing a searching aid in the USPTO and it does not affect the determination of whether the mark as a whole is distinctive. Adoption of the description proposed by the Examining attorney does not change the concept that the drawing of the mark should be used for analysis of whether the mark is distinctive for applicant's goods.

It might also be noted that the determination of distinctiveness must be in the context of the identified goods. The basic statement of the legal principle under the Lanham Act is that "no trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature....," (35 U.S.C. Section 1052, Lanham Act Section 2, first paragraph), unless it has other defects listed in subsequent paragraphs, none of which are believed to apply in this case. In this case, none of the itemized deficiencies have been asserted as to the stylization and the design. Section 2(e)(1) descriptiveness is only applied to the word portions and the word portion by itself has been disclaimed such that descriptiveness under Section 2(e)(1) rejection does not apply to the combination of the stylization, the design shape, the color and the shading features, as applied to the indicated features. Discussion of whether the combinations of font, stylization, design features, color, and shading portions are sufficiently inherently distinctive to serve as a trademark must therefore be analyzed on the basis of Section 2, first paragraph, of the Lanham Act (i.e., whether the mark as a whole is capable of distinguishing applicant's goods from those of others.) The Examining Attorney's analysis falls short of establishing that the mark is not capable of functioning as a trademark. Note in this analysis the mark must be considered in light of the goods of Applicant and the similar goods of others such the stylization, shape of the design, color of the design, and the shading should all be

considered with respect whether the mark is capable of distinguishing applicant's goods from similar goods of others. The design is not descriptive of applicant's goods. There is no showing that other parties commonly use the features combined into applicant's mark for the types of goods identified in the application.

It is respectfully submitted that there was an inadequate consideration of all of these features by the Examining Attorney with respect to applicant's mark applied to the recited goods. Merely mentioning that applicant has asserted these feature and then dismissing them by the statement "[t]he shape, color and shading of the design in applicant's mark do not obviate refusal" is not the same thing as properly analyzing those features in the entire combination for determining the overall commercial impression for relevant consumers of applicant's goods. On the issue of the shape of the mark, the Examining Attorney cited case law that was specifically directed to shapes used on clothing or other apparel where the use of similar shapes was common. In the case of *In Re Benetton Group S.p.A.* Lexis 219; 48 USPQ 2d 1214 (TTAB 1998), as partially quoted by the Examining Attorney, the factual background was that the green rectangular design of the label at issue was a design that the applicant in that case admitted was already used by numerous others for the same goods, namely for clothing. The applicant in that case was trying to prove acquired distinctiveness and fell short. Others also used the same design and color for the same goods. The geometric rectangular shape with a green color was therefore commonly used in the same industry for the same type of goods. Moreover, the field of use was for clothing where it was determined that use of geometric shapes is commonly merely for ornamentation. This is what consumers of those types of goods expect. That case is distinguishable from the present situation on its facts.

The Examining Attorney's evidence of use of hexagons consisted of citing three instances where hexagons were shown to be part of the word and design marks and each use is also distinguishable from the present application. The cited hexagon containing marks were all differently shaped from applicant's mark. In two of the cited instances the differently shaped yellow hexagons are generally unilateral hexagons with rounded corners as a depiction of a honeycomb. Those marks are for honey goods. The third cited instance is a differently shaped hexagon apparently for a hotel sign. That mark has a black color hexagon with white lettering on it, for hotel services. None of these cited marks demonstrate that hexagon shapes are commonly used. And none shows that hexagon marks are commonly used for applicant's the goods as identified in the application. There are only very few of these cited by the Examining Attorney, the shapes are different from applicant's mark and the goods are completely different from applicant's goods.

The additional features applicant's mark, including the peculiarly elongated hexagon shape, the color variations and the shading to indicate three dimensional appearance with a horizontal ridge and sloping top and bottom areas away from the lettering, are all features that further demonstrate that the design is inherently distinctive, easily distinguishable from the trademark cited by the Examining Attorney and clearly those marks are not in applicant's filed of goods. Applicant's mark is unlike the green rectangular label in the *Benetton* case, *supra*, where numerous others in the same field of clothing used the same design shape and color, and where such geometric shapes are commonly used as ornamentation. Applicant's mark in contrast is not like others in the field and it is clearly capable of distinguishing applicant's goods from those of others. The particular gold color, the differently shaped elongated hexagon and the shading that provides a three dimensional ridge effect far from showing that a hexagon shape is a common background shape. There is also

simply no showing that any of the designs of the cited registration would be have been considered as merely background by consumers of honey and honey products or consumers of hotel services looking for a sign of a place to stay the night. To the contrary the honeycomb is suggestive of the goods and the sign at a hotel may be visible for miles before the words can be read by roadway travelers. These marks are in fact registered and the design features are capable of providing a trademark function in the combinations with words. The polygon marks cited by the Examining Attorney, therefore demonstrate the capability of the designs to serve to distinguish ones goods from those of others.

In the *Board of Trustees of the University of Alabama* 107 USPQ 2d, 2001, 2014 (TTAB 2013) as cited by the Examining Attorney, the TTAB recognizes the line of cases (not clothing cases as in *Benetton, supra*, and the *Board of Trustees for the University of Alabama, supra*), in which geometric shapes that are not merely standard shapes common used by others and as ornamentation for the goods involved can be considered as sufficiently distinctive to serve as trademarks. Factors to be considered include (1) whether the design is a common basic shape or design (2) whether the design is unique or unusual in the field in which it is used; (3) whether the design is a mere refinement of a commonly adopted and well-known form of ornamentation for the particular class of goods or services viewed by the public as a dress or ornamentation for the goods and services; or (4) whether the design is capable of creating a commercial impression distinct from any accompanying matter, if presented together with text or other matter.” *The Board of Trustees of the University of Alabama, supra*, citing *Wal-Mart Stores, Inc. v. Samara Brothers, Inc.* 529 US 205 54 U.S.P.Q. 2nd 1065 (2000).

As discussed above, the Examining Attorney did not properly apply these factors to the present design portion of the mark. A brief analysis will show that the factors are on balance in favor of inherent distinctiveness for the combination of design features of applicant's mark, generally as follows: (1) While some hexagons might be common shapes in world generally; the particular uniquely shaped hexagon as in the application is uncommon. (2) Applicant's design is unique and unusual in the field. There is no evidence of use of a similar design by others in applicant's field. (3) Applicant's design is not a mere refinement of a commonly adopted and well-known form of ornamentation for the particular class of goods or services viewed by the public as a dress or ornamentation for the goods and services. Geometric designs are not commonly used for ornamentation in the field of electric power transformers. (4) As discussed throughout applicant's briefs, the design is capable of creating a commercial impression distinct from any accompanying matter, even when presented together with text and other matter such as the color, the shading the stylized lettering the capitalization all of which also lend elements of distinctiveness.

By way a demonstration, attached is EXHIBIT A, showing the designs of two of the cited marks and applicant's mark with and without the word portions removed (the coloration and shading under the lettering was approximated by replacing the lettered areas with adjacent coloration using a Paint computer drawing and editing program.) The demonstration is not specifically provided as evidence of the way the design would actually look behind the lettering in any given case, but, rather it is to present one possible representation of the way consumers might subjectively interpret the design behind the lettering. Side-by-side viewing demonstrates that different commercial impressions may be made by the design portions of each of the cite marks and applicant's mark. The designs, the shapes, the coloration and the shading of the different marks

could easily be considered by consumers as distinctive alone or in combination with the word portions. The fundamental test, of course, should also consider the distinctiveness of the mark as a whole; considering design features, the coloration, the shading and in combination with stylized word portion and all in the context of the identified goods.

Summary of Applicant's Arguments in Reply

It is respectfully submitted that the designs appear to be and would be considered by consumers as parts of the marks. Moreover, two of the three cited hexagon shapes were generally equilateral hexagons having a gold color, with shading for roundedness and not for showing a "sharp" horizontal ridge line (actually the shape, the color and the roundedness of the corners and the shading of these equilateral hexagon marks, were those characteristic of a honey comb with rounded, rather than sharp corners). The other hexagon shaped mark was for a hotel sign that was dark or black not a gold color and it did not have the same shape. There is significantly less elongation for the Hampton Inn sign and here is no shading for depth. There was no evidence presented by the Examining Attorney showing any other marks or usages of hexagons with goods similar to Applicant's goods, using a substantially similar shape, a similar coloration, or a similar shading to indicate a three dimensional peak or ridge, or a similar incorporation of stylized lettering incorporated into the design used by any others for goods similar to Applicant's. The only use of the gold color with a hexagon of any shape was reference to products related to Honey with a honey comb shape and the coloration and shading of a honey comb as mentioned above. The relationship to applicant's goods is completely absent. With respect to the third cited "hexagon" for hotel chain

signage for the Hampton Inn, it is not the same shape, it is not the same color, the stylization of the letters is different, there is no surface texture shading, and the goods are completely different. Essentially there is no probative evidence that applicant's shape, coloration and shading are commonly used. There is absolutely no evidence of use by others of anything resembling applicant's design, shape, coloration, and shading for any goods related to those of applicant.

Conclusion

The Examining Attorney would seem to encourage the Board to adopt a rule that no polygon shape can distinguish one's goods from the goods of others, to be applied in every case without consideration of the identified goods and regardless of the complexity and overall commercial impression of the mark. This is not the law, as indicate in *Wal-Mart Stores, Inc. v Samara Brothers, Inc.*, supra. The law requires that the outlined circumstances be considered to determine whether the mark is inherently distinctive and as a basic precept the mark should be considered in its entirety to determine whether it is capable of distinguishing applicant's goods for those of others. The Examiner Attorney, in this case, effectively considered only whether applicant's mark might fall within a category of being a type of hexagon and that it includes the color gold. On that basis alone, the Examining Attorney concluded that the hexagon and the color gold are not distinctive. Of course, considering less than all of the features individually and not considering the combined impact in a meaningful way is not proper and does not provide the correct result. For all of the foregoing reasons applicant's combination word, stylization, design, color and

shaded mark is capable of distinguishing applicant's goods from those of others and should be registered on the Principal Register.

Request for Amendment During Appeal or in the Alternative Request for Suspension and Remand for entering of the Proposed Amendment

The Examining Attorney's Statement of Facts has brought to the attention of Applicant an inadvertent typographical error in the Identification of goods. The corrected identification should be:

"Early fault [fall] detector for electrical power distribution transformers; dissolved gas conditions monitor for electrical power transformers; on load tap changer condition monitor for electrical transformers; computer program for analyzing dissolved gas conditions data; computer program for comparing monitor instrument data to laboratory data"

The error was entirely an inadvertent typographical error and there was no deceptive intent in making the typographical error. The relevant consumers will understand that an "early ground fault detector for electrical power distribution transformers" is the accepted identification in the power transformer industry. There is no difference in the concepts of "ground fall detection" and "ground fault detection" in the minds of the relevant consumers as they would either read the word "fall" as a typographically erroneous attempt to state "ground fault" or they would consider the reference was to an electrical drop (i.e., an electrical "fall") due to a grounding of the type that can be detected early by Applicant's products. The error was not previously noticed (when the ID was recited in the Office Actions of record, the word "fall" was simply read as if it was "fault". It

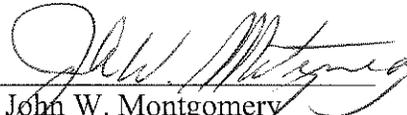
was not part of the issue that were the focus of the Office Actions. Moreover, the correct identification is exactly the same as the identification in the previously registered SmartDGA word only mark co-owned as Supplemental Registration Number 44161158, as follows:

“Early fault detector for electrical power distribution transformers; dissolved gas conditions monitor for electrical power transformers; on load tap changer condition monitor for electrical transformers; computer program for analyzing dissolved gas conditions data; computer program for comparing monitor instrument data to laboratory data”

It is respectfully submitted that the amended identification is a matter that should have no bearing on any issues on appeal. In particular, that correction will not impact the issue of whether the combined word and design mark (with the words disclaimed) is sufficiently distinctive to permit consumers from distinguishing goods of Applicant from the goods of others. The identification of goods was not previously objected to by the Examining Attorney. The descriptiveness of the term “SmartDGA,” as argued by the Examining Attorney, is with respect to the portion of the identification “...dissolved gas conditions monitor for electrical power transformers...” The term “SmartDGA” has been disclaimed apart from the mark as shown, and the examiner has not asserted the distinctive colored and shaded polygon design is descriptive of any goods covered. For all of those reasons it is respectfully submitted that the typographical error in the identification of goods should be corrected and the appeal should continue. In the alternative, Applicant respectfully request that the Appeal should be suspended and remanded pending consideration and entry of the amendment.

Dated: May 18, 2015

Respectfully submitted,

By 
John W. Montgomery
Registration No.: 31,124
OSHA LIANG LLP
909 Fannin Street, Suite 3500
Houston, Texas 77010
(713) 228-8600
(713) 228-8778 (Fax)
Attorney for Applicant

1899919

Exhibit A

