

Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	86004595
LAW OFFICE ASSIGNED	LAW OFFICE 113
MARK SECTION (no change)	
ARGUMENT(S)	
<u>INTRODUCTION</u>	
<p>Applicant thanks the Examining Attorney for reconsidering Serial No. 86/004595. In the final office action issued on May 16, 2014, the Examining Attorney finally refused registration of Applicant's mark because the Examiner considers the mark to be merely descriptive of the goods. Applicant has submitted a disclaimer of the wording "SmartDGA." Applicant requests reconsideration and withdrawal of the final rejection, reaffirming the arguments made in the previous response, and in addition, submitting the following new arguments.</p>	
<u>ARGUMENTS</u>	
<u>MARK IS SUFFICIENTLY INHERENTLY DISTINCTIVE</u>	
<p>The design features of Applicant's mark create an impression on relevant purchasers that is separate and apart from the impression made by the words. The entire mark must be considered. It is not proper to separate parts and disregard a distinctive design feature uniquely combined with a stylized word portion. <i>In re Miller Brewing Co.</i>, 226 USPQ 666 (TTAB 1985). When observable characteristics of a mark show that the mark has a distinct meaning of its own, independent of its constituent elements, it is a unitary mark. <i>Dena Corp. v. Belvedere Intern., Inc.</i>, 950 F.2d 1555, 1561 (Fed. Cir. 1991). In this application, it is deemed improper to separate the word elements from the background elements and to consider them separately. For example, in the final office action, it is stated "the shaded elongated hexagon represents a common background shape that consumers are accustomed</p>	

to viewing as merely a background element in a mark, and not as a source indicator,” thereby evidencing the consideration of the mark in separate parts instead of the mark as a whole. Case law requires the mark to be considered as a whole. Moreover, there is no support for the assertion that relevant consumers of Applicant’s products are “accustomed to viewing” such a background. No similar backgrounds are shown for goods or services in this field or in any related fields. When considered as a whole, the mark has many elements that together create a distinct commercial impression. The mark consists of the words “SmartDGA” in a particularly stylized font (compared to any similar marks cited by the Examiner), on top of a distinctly-shaped hexagon. The hexagon is uniquely colored with shades of gold and is particularly shaded to represent a three dimensional shape appearing to project a “pyramid” from the page. Further, the hexagon is not descriptive of the goods or features therefor. The entire combination of the stylized words and unique colored background creates a distinct commercial impression. For the foregoing reasons, Applicant requests the Examiner withdraw the 2(e) refusal.

In the present application, the design features are at least as distinctive apart from the words as in other cases where the TTAB has found distinctiveness upon the design features. For example, despite the descriptive wording in “CONSTRUCT-A-CLOSET,” for components that are to be used in the construction of closets, the mark was allowed registration on the principal register, with a disclaimer, because of the sufficiently inherent distinctive design, despite being a simple white background with black lines extended horizontally from the ends of the “C” in “Clutter” and from the ends of the “C” in “Control.” See *In re Clutter Control Inc.*, 231 USPQ 588 (TTAB 1986). In addition, the descriptive mark “KAR AUCTION SERVICES,” despite being initially refused for descriptiveness, was allowed principal registration, with a disclaimer, by the Trademark Trial and Appeal Board because they found it to be sufficiently stylized to create an inherently distinctive display. The word “KAR” was in a different size font from “Auction Services” and there was a space between the letters “K” and “R,” giving an impression of a logo. See *In re Kar Auction Services, Inc.*, 2011 TTAB LEXIS 389. Again, as in the *Clutter Control* case, the “KAR AUCTION SERVICES” mark was a simple design with no color features. Applicant’s mark, in contrast, includes both stylization of the words, a uniquely shaped three-dimensional polygon, having a unique coloration (claimed as part of the mark), where the color variations create a unique image of depth to give the impression of three dimensions. The entire combination clearly gives an impression of a logo. See *In re Kar Auction Services, Inc.*

In the instant case, Applicant does not claim acquired distinctiveness. Instead, Applicant contends that the applied-for mark, in its entire combination, is sufficiently inherently distinctive to permit registration on the Principal Register. It is simply not proper to assert that Applicant's mark consists of "a gold polygon shape" and that this design element is not sufficiently distinct as to overcome the descriptiveness refusal. First, it should be recognized, based upon the cited cases, that even a simple polygon is sufficiently distinctive for registration when combined with stylized letters. Moreover, Applicant respectfully disagrees with the assertion that the mark is simply a gold polygon shape. The polygon is uniquely elongated horizontally, it is not merely an equilateral polygon, it has a unique shape of its own. In fact, as indicated in the drawing and the proposed description of the mark that is considered more specific than the description proposed by the examiner, the polygon is shaded a darker gold on both the top and bottom and lighter gold in the middle. The unique shading gives the impression that the shape is three dimensional and gives the commercial impression of three dimensional depth to the polygon. Down the horizontal middle of the horizontally elongated polygon is a stripe of a lighter shade of gold color, which gives the effect of light hitting the highest element of a three dimensional image. In this application, unlike other applications that might be considered, the color is specifically claimed as a feature of the mark. There is no showing of another mark claiming the same color in the identified field of goods. The shape, color and shading elements give a separate commercial impression from the letters alone and make the "SmartDGA" (and design) mark significantly more distinct than the minimally stylized, black and white marks in *Clutter Control* or *Kar Auction Services*, and numerous other registered marks on the Principal Register. Further, the word "SmartDGA" is presented in a stylized format, with the formative "Smart" appearing in both upper and lower case letters and the initials "DGA" appearing in all capital letters. The "SmartDGA" (and design) mark is claimed as stylized, and the design features in the combination are most certainly capable of catching the consumer's attention, and creating an overall commercial impression in a consumer's mind separate and apart from the words themselves. That is all that is required under the Trademark Act for registration. As the Trademark Act states, "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..." unless it has other defects, none of which apply in this case. Further, Applicant respectfully submits that the stylized font of the word portion, "SmartDGA," has a

distinct meaning of its own, and is now part of a family of trademarks, including Registration No. 4416158, and pending Serial Nos. 86004383, 86004595, 86004319, 86004413, developed by LumaSense Technologies Holdings, Inc. as a branding campaign for industrial goods in International Class 009. The “SmartDGA” mark is used consistently and purposefully by LumaSense Technologies Holdings, Inc. and consumers identify the stylized font with the word portion “SmartDGA” as the sole source indicator of LumaSense products for industrial goods in Class 009.

Again, a fair reading of the office action indicates that no consideration was given to the distinct color of Applicant’s mark, aside from requesting an amendment to the color claim in the first office action. Applicant specifically claims the colors gold and black, shows the exact colors in the drawing, and describes the mark as “a polygon shaded in gold containing the wording “SmartDGA” in stylized black font.” Simple observation of the applied-for mark shows that the mark is not merely a “shaded elongated hexagon.” It is a distinct gold color, shaded to create the effect of three dimensions with stylized lettering incorporated into the design. Indeed, the Principle Register is ripe with examples of far less distinctive polygons than Applicant’s. Applicant points to Registration No. 1914973, a simple red polygon with the word “RUBBERMAID” for outdoor furniture, and Registration No. 4236137, a red rectangle with the word “NETFLIX” for online movie rental services. Neither the “RUBBERMAID” nor the “NETFLIX” mark contains a design as complex as Applicant’s, despite the descriptive, or at the very least highly suggestive nature of the word portion of those other registered marks. The color gold has no relationship to the goods identified. For the foregoing reasons, Applicant respectfully argues that the distinct color of the mark weighs heavily against a finding that the mark is merely descriptive.

The final rejection cites the same two cases as the first office action, standing for the principle that merely descriptive marks are not registerable. However, neither case is applicable to the facts at hand. In the first case, *In re Bonni Keller Collections, Ltd.*, the applied-for mark consists merely of the words “LA LINGERIE,” for undergarments and retail store services, in stylized font with no distinctive background, no color and minimally-stylized lettering. 6 U.S.P.Q. 2d 1224 (TTAB 1987). The second case, *In re Sambado & Sons, Inc.*, the applied-for mark again consisted merely of the words “FRUTTA FRESCA” for fresh deciduous fruits, in minimally-stylized font, without a distinctive background and without color. 45 U.S.P.Q. 2d 1312 (TTAB 1997). For the reasons stated above, the cases cited in the office action are clearly distinguishable from the case at hand.

Therefore, Applicant respectfully submits, as others have successfully done in other cases approved for registration, that the "stylization of the words [and] the accompanying design features of the asserted mark create an impression on purchasers separate and apart from the impression made by the words themselves." *In re American Academy of Facial Plastic and Reconstructive Surgery*, 64 USPQ2d 1748, 1753 (TTAB 2002). On that basis, Applicant respectfully requests registration on the Principal Register.

CONCLUSION

After reconsidering Applicant's mark in light of the arguments outlined above, Applicant believes the application is in a condition for registration on the Principal Register. Accordingly, Applicant respectfully requests the basis for the refusal be withdrawn and that a notice of allowance be issued.

SIGNATURE SECTION

RESPONSE SIGNATURE	/john w. montgomery/
SIGNATORY'S NAME	John W. Montgomery
SIGNATORY'S POSITION	Attorney of Record, Texas State Bar
SIGNATORY'S PHONE NUMBER	713.228.8600
DATE SIGNED	11/14/2014
AUTHORIZED SIGNATORY	YES
CONCURRENT APPEAL NOTICE FILED	YES

FILING INFORMATION SECTION

SUBMIT DATE	Fri Nov 14 15:19:57 EST 2014
TEAS STAMP	USPTO/RFR-38.114.214.18-2 0141114151957396790-86004 595-500f0c5d9d770f57b2e8d 62b87f772ed4a5d3cc432c96a c03ed35d2ad1d1acb2-N/A-N/ A-20141114141714730119

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

Application serial no. **86004595** has been amended as follows:

ARGUMENT(S)

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

INTRODUCTION

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ARGUMENTS

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SIGNATURE(S)

Request for Reconsideration Signature

Signature: /john w. montgomery/ Date: 11/14/2014

Signatory's Name: John W. Montgomery

Signatory's Position: Attorney of Record, Texas State Bar

Signatory's Phone Number: 713.228.8600

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: 86004595

Internet Transmission Date: Fri Nov 14 15:19:57 EST 2014

TEAS Stamp: USPTO/RFR-38.114.214.18-2014111415195739

6790-86004595-500f0c5d9d770f57b2e8d62b87

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