

## Response to Office Action

The table below presents the data as entered.

Input Field	Entered
<b>SERIAL NUMBER</b>	86081312
<b>LAW OFFICE ASSIGNED</b>	LAW OFFICE 103
<b>MARK SECTION (no change)</b>	
<b>ARGUMENT(S)</b>	
<p>In a non-final Office Action issued November 14, 2014, the Examining Attorney maintains the pending refusals under Section 2(e)(1) and Section 2(d).</p> <p><u>Acquired Distinctiveness</u></p> <p>Previously, in response to the Section 2(e)(1) refusal, applicant amended its application to seek registration under Section 2(f). The Examining Attorney rejected applicant's Section 2(f) claim, indicating in the refusal that applicant's claim is "based on five years' use in commerce." Applicant brings the Examining Attorney's attention to the fact that, while the template for submitting a Section 2(f) declaration specifies "five years' use," applicant actually began using the subject mark in 1997, more than 17 years ago. As such, applicant's Section 2(f) claim is not based on merely five years' use in commerce—which, in and of itself, can be <i>prima facie</i> evidence of acquired distinctiveness—but is based on more than three times that long.</p> <p>The first factor cited by the Examining Attorney in determining whether a proposed mark has acquired distinctiveness based on extrinsic evidence is the "length and exclusivity of the use of the mark in the United States by applicant." The length of use—more than 17 years—is extremely long and, as such, weighs heavily in favor of a finding of acquired distinctiveness.</p> <p>As such, applicant respectfully requests that the Examining Attorney reconsider and approve applicant's Section 2(f) claim.</p> <p><u>Likelihood of Confusion</u></p> <p>Applicant continues to disagree with the Examining Attorney that "American Surgical Specialties Company" is confusingly similar with "Surgical Specialties." In further support of applicant's position, applicant notes that it has used the SURGICAL SPECIALTIES mark for more than 17 years without any known instances of consumer confusion or mistake. As such, applicant believes that the realities of the marketplace support registration under Section 2(d).</p> <p>As such, applicant respectfully requests that the Examining Attorney reconsider and withdraw Section 2(d) refusal.</p> <p>Applicant believes the application is now in condition for allowance and requests that it be approved for publication. If questions remain, the Examining Attorney is invited to contact Applicant's counsel,</p>	

Kevin S. Costanza, by email at KevinC.Docketing@SeedIP.com or by telephone at (206) 622-4900.

### SIGNATURE SECTION

RESPONSE SIGNATURE /Kevin S. Costanza/

SIGNATORY'S NAME Kevin S. Costanza

SIGNATORY'S POSITION Attorney for Applicant, Washington State Bar Member

SIGNATORY'S PHONE NUMBER 206-622-4900

DATE SIGNED 05/12/2015

AUTHORIZED SIGNATORY YES

### FILING INFORMATION SECTION

SUBMIT DATE Tue May 12 15:08:56 EDT 2015

TEAS STAMP

USPTO/ROA-38.100.227.210-  
20150512150856365741-8608  
1312-530163c94bf92694d356  
d2654c28bc8f8b636a12eb131  
5161f564365a4f404db9-N/A-  
N/A-20150512135018839236

## Response to Office Action To the Commissioner for Trademarks:

Application serial no. **86081312** has been amended as follows:

### ARGUMENT(S)

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

In a non-final Office Action issued November 14, 2014, the Examining Attorney maintains the pending refusals under Section 2(e)(1) and Section 2(d).

### Acquired Distinctiveness

Previously, in response to the Section 2(e)(1) refusal, applicant amended its application to seek registration under Section 2(f). The Examining Attorney rejected applicant's Section 2(f) claim, indicating in the refusal that applicant's claim is "based on five years' use in commerce." Applicant brings the Examining Attorney's attention to the fact that, while the template for submitting a Section 2(f) declaration specifies "five years' use," applicant actually began using the subject mark in 1997, more than 17 years ago. As such, applicant's Section 2(f) claim is not based on merely five years' use in commerce—which, in and of itself, can be *prima facie* evidence of acquired distinctiveness—but is based

on more than three times that long.

The first factor cited by the Examining Attorney in determining whether a proposed mark has acquired distinctiveness based on extrinsic evidence is the “length and exclusivity of the use of the mark in the United States by applicant.” The length of use—more than 17 years—is extremely long and, as such, weighs heavily in favor of a finding of acquired distinctiveness.

As such, applicant respectfully requests that the Examining Attorney reconsider and approve applicant’s Section 2(f) claim.

### Likelihood of Confusion

Applicant continues to disagree with the Examining Attorney that “American Surgical Specialties Company” is confusingly similar with “Surgical Specialties.” In further support of applicant’s position, applicant notes that it has used the SURGICAL SPECIALTIES mark for more than 17 years without any known instances of consumer confusion or mistake. As such, applicant believes that the realities of the marketplace support registration under Section 2(d).

As such, applicant respectfully requests that the Examining Attorney reconsider and withdraw Section 2(d) refusal.

Applicant believes the application is now in condition for allowance and requests that it be approved for publication. If questions remain, the Examining Attorney is invited to contact Applicant’s counsel, Kevin S. Costanza, by email at KevinC.Docketing@SeedIP.com or by telephone at (206) 622-4900.

### **SIGNATURE(S)**

#### **Response Signature**

Signature: /Kevin S. Costanza/ Date: 05/12/2015

Signatory's Name: Kevin S. Costanza

Signatory's Position: Attorney for Applicant, Washington State Bar Member

Signatory's Phone Number: 206-622-4900

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.

Serial Number: 86081312

Internet Transmission Date: Tue May 12 15:08:56 EDT 2015

TEAS Stamp: USPTO/ROA-38.100.227.210-201505121508563

65741-86081312-530163c94bf92694d356d2654

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