

Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	86345917
LAW OFFICE ASSIGNED	LAW OFFICE 105
MARK SECTION	
MARK FILE NAME	http://tmng-al.uspto.gov/resting2/api/img/86345917/large
LITERAL ELEMENT	STEELHEAD COMPOSITES
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 the mark consists of the word "STEELHEAD" in the form of a fanciful depiction of a fish with "COMPOSITES" appearing below in stylized lettering.
ARGUMENT(S)	
<p>In the Final Office Action, the Examining Attorney has stated that the following issues must be addressed. Issue #1: Section 2(d) refusal for likelihood of confusion in Classes 006 and 007. Issue #2: Specimen Refusal in Class 001; and Issue #3: Disclaimer Required. In response to Issue #1: Applicant has deleted IC 007 and amended the description of good for IC006 as follows: "Metal cylinder wrapped in a carbon composite material for compressed gas, sold empty; Metal storage tanks wrapped in carbon composite material." With regard to Issue #2, Applicant herewith has filed a divisional application and changed the filing basis to 1(b) - intend to use. With regard to Issue #3, Applicant has disclaimed the term "COMPOSITE." In view of the forgoing, Applicant respectfully requests reconsideration of refusal for registration.</p>	
GOODS AND/OR SERVICES SECTION (001)(current)	
INTERNATIONAL CLASS	001
DESCRIPTION	
Carbon composite materials consisting of a fibrous reinforcing structure made of carbon fibers and densified by a carbon matrix, for use in manufacturing; Inorganic polymeric composition for industrial metal substrates	
FILING BASIS	Section 1(a)

FIRST USE ANYWHERE DATE	At least as early as 12/31/2012
FIRST USE IN COMMERCE DATE	At least as early as 12/31/2012
GOODS AND/OR SERVICES SECTION (001)(proposed)	
INTERNATIONAL CLASS	001
DESCRIPTION	
Carbon composite materials consisting of a fibrous reinforcing structure made of carbon fibers and densified by a carbon matrix, for use in manufacturing; Inorganic polymeric composition for industrial metal substrates	
FILING BASIS	Section 1(b)
GOODS AND/OR SERVICES SECTION (006)(current)	
INTERNATIONAL CLASS	006
DESCRIPTION	
Liquefied gas storage tanks of metal; Metal cylinders for compressed gas or liquids, sold empty; Metal storage tanks	
FILING BASIS	Section 1(a)
FIRST USE ANYWHERE DATE	At least as early as 12/31/2012
FIRST USE IN COMMERCE DATE	At least as early as 12/31/2012
GOODS AND/OR SERVICES SECTION (006)(proposed)	
INTERNATIONAL CLASS	006
TRACKED TEXT DESCRIPTION	
Liquefied gas storage tanks of metal; Metal cylinder wrapped in a carbon composite material for compressed gas, sold empty; Metal cylinders for compressed gas or liquids, sold empty; Metal storage tanks wrapped in carbon composite material. ; Metal storage tanks	
FINAL DESCRIPTION	
Metal cylinder wrapped in a carbon composite material for compressed gas, sold empty; Metal storage tanks wrapped in carbon composite material.	
FILING BASIS	Section 1(a)
FIRST USE ANYWHERE DATE	At least as early as 12/31/2012
FIRST USE IN COMMERCE DATE	At least as early as 12/31/2012
GOODS AND/OR SERVICES SECTION (007)(class deleted)	
ADDITIONAL STATEMENTS SECTION	
DISCLAIMER	No claim is made to the exclusive right to use COMPOSITES apart from the mark as shown.
NEW CORRESPONDENCE SECTION	

NAME	Don D. Cha
FIRM NAME	Hamilton DeSanctis & Cha, LLP
DOCKET/REFERENCE NUMBER	SHC-TM000200
STREET	225 UNION BLVD STE 150
CITY	Lakewood
STATE	Colorado
ZIP/POSTAL CODE	80228
COUNTRY	United States
PHONE	(303) 500-3399
FAX	(720) 545-9888
EMAIL	DCha@HDCIPLaw.com
AUTHORIZED EMAIL COMMUNICATION	Yes
SIGNATURE SECTION	
DECLARATION SIGNATURE	/Don D. Cha/
SIGNATORY'S NAME	Don D. Cha
SIGNATORY'S POSITION	Attorney of Record, CO bar member
SIGNATORY'S PHONE NUMBER	(303) 500-3399
DATE SIGNED	07/20/2015
RESPONSE SIGNATURE	/Don D. Cha/
SIGNATORY'S NAME	Don D. Cha
SIGNATORY'S POSITION	Attorney of Record, CO bar member
SIGNATORY'S PHONE NUMBER	(303) 500-3399
DATE SIGNED	07/20/2015
AUTHORIZED SIGNATORY	YES
CONCURRENT APPEAL NOTICE FILED	YES
FILING INFORMATION SECTION	
SUBMIT DATE	Mon Jul 20 15:51:18 EDT 2015
TEAS STAMP	USPTO/RFR-70.91.169.17-20 150720155118380195-863459 17-540c57214d831bf70b39a7 d2da38da0302df1e5e7121ff6 ba4eef9cb13ce24f826-N/A-N

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

Application serial no. **86345917** STEELHEAD COMPOSITES (Stylized and/or with Design, see <http://tmng-al.uspto.gov/resting2/api/img/86345917/large>) has been amended as follows:

ARGUMENT(S)

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

In the Final Office Action, the Examining Attorney has stated that the following issues must be addressed. Issue #1: Section 2(d) refusal for likelihood of confusion in Classes 006 and 007. Issue #2: Specimen Refusal in Class 001; and Issue #3: Disclaimer Required. In response to Issue #1: Applicant has deleted IC 007 and amended the description of good for IC006 as follows: "Metal cylinder wrapped in a carbon composite material for compressed gas, sold empty; Metal storage tanks wrapped in carbon composite material." With regard to Issue #2, Applicant herewith has filed a divisional application and changed the filing basis to 1(b) - intend to use. With regard to Issue #3, Applicant has disclaimed the term "COMPOSITE." In view of the forgoing, Applicant respectfully requests reconsideration of refusal for registration.

CLASSIFICATION AND LISTING OF GOODS/SERVICES

Applicant hereby deletes the following class of goods/services from the application.

Class 007 for Hydraulic accumulators being parts of machines

Applicant proposes to amend the following class of goods/services in the application:

Current: Class 001 for Carbon composite materials consisting of a fibrous reinforcing structure made of carbon fibers and densified by a carbon matrix, for use in manufacturing; Inorganic polymeric composition for industrial metal substrates

Original Filing Basis:

Filing Basis: Section 1(a), Use in Commerce: The applicant is using the mark in commerce, or the applicant's related company or licensee is using the mark in commerce, on or in connection with the identified goods and/or services. 15 U.S.C. Section 1051(a), as amended. The mark was first used at least as early as 12/31/2012 and first used in commerce at least as early as 12/31/2012, and is now in use in such commerce.

Proposed: Class 001 for Carbon composite materials consisting of a fibrous reinforcing structure made of carbon fibers and densified by a carbon matrix, for use in manufacturing; Inorganic polymeric composition for industrial metal substrates

Deleted Filing Basis: 1(a)

Filing Basis: Section 1(b), Intent to Use: *For a trademark or service mark application:* As of the application filing date, the applicant had a bona fide intention, and was entitled, to use the mark in commerce on or in connection with the identified goods/services in the application. ***For a collective***

trademark, collective service mark, or collective membership mark application: As of the application filing date, the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce by members on or in connection with the identified goods/services/collective membership organization. **For a certification mark application:** As of the application filing date, the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce by authorized users in connection with the identified goods/services, and the applicant will not engage in the production or marketing of the goods/services to which the mark is applied, except to advertise or promote recognition of the certification program or of the goods/services that meet the certification standards of the applicant.

Applicant proposes to amend the following class of goods/services in the application:

Current: Class 006 for Liquefied gas storage tanks of metal; Metal cylinders for compressed gas or liquids, sold empty; Metal storage tanks

Original Filing Basis:

Filing Basis: Section 1(a), Use in Commerce: The applicant is using the mark in commerce, or the applicant's related company or licensee is using the mark in commerce, on or in connection with the identified goods and/or services. 15 U.S.C. Section 1051(a), as amended. The mark was first used at least as early as 12/31/2012 and first used in commerce at least as early as 12/31/2012 , and is now in use in such commerce.

Proposed:

Tracked Text Description: ~~Liquefied gas storage tanks of metal;~~ Metal cylinder wrapped in a carbon composite material for compressed gas, sold empty; ~~Metal cylinders for compressed gas or liquids, sold empty;~~ Metal storage tanks wrapped in carbon composite material.; ~~Metal storage tanks~~

Class 006 for Metal cylinder wrapped in a carbon composite material for compressed gas, sold empty; Metal storage tanks wrapped in carbon composite material.

Filing Basis: Section 1(a), Use in Commerce: The applicant is using the mark in commerce, or the applicant's related company or licensee is using the mark in commerce, on or in connection with the identified goods and/or services. 15 U.S.C. Section 1051(a), as amended. The mark was first used at least as early as 12/31/2012 and first used in commerce at least as early as 12/31/2012 , and is now in use in such commerce.

CORRESPONDENCE ADDRESS CHANGE

Applicant proposes to amend the following:

Proposed:

Don D. Cha of Hamilton DeSanctis & Cha, LLP, having an address of
225 UNION BLVD STE 150 Lakewood, Colorado 80228

United States

DCha@HDCIPLaw.com

(303) 500-3399

(720) 545-9888

The docket/reference number is SHC-TM000200 .

ADDITIONAL STATEMENTS

Disclaimer

No claim is made to the exclusive right to use COMPOSITES apart from the mark as shown.

SIGNATURE(S)
Declaration Signature

DECLARATION: The signatory being warned that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. § 1001, and that such willful false statements and the like may jeopardize the validity of the application or submission or any registration resulting therefrom, declares that, if the applicant submitted the application or allegation of use (AOU) unsigned, all statements in the application or AOU and this submission based on the signatory's own knowledge are true, and all statements in the application or AOU and this submission made on information and belief are believed to be true.

STATEMENTS FOR UNSIGNED SECTION 1(a) APPLICATION/AOU: If the applicant filed an unsigned application under 15 U.S.C. §1051(a) or AOU under 15 U.S.C. §1051(c), the signatory additionally believes that: the applicant is the owner of the mark sought to be registered; the mark is in use in commerce and was in use in commerce as of the filing date of the application or AOU on or in connection with the goods/services/collective membership organization in the application or AOU; the original specimen(s), if applicable, shows the mark in use in commerce as of the filing date of the application or AOU on or in connection with the goods/services/collective membership organization in the application or AOU; *for a collective trademark, collective service mark, collective membership mark application, or certification mark application*, the applicant is exercising legitimate control over the use of the mark in commerce and was exercising legitimate control over the use of the mark in commerce as of the filing date of the application or AOU; *for a certification mark application*, the applicant is not engaged in the production or marketing of the goods/services to which the mark is applied, except to advertise or promote recognition of the certification program or of the goods/services that meet the certification standards of the applicant. **To the best of the signatory's knowledge and belief, no other persons, except, if applicable, authorized users, members, and/or concurrent users, have the right to use the mark in commerce, either in the identical form or in such near resemblance as to be likely, when used on or in connection with the goods/services/collective membership organization of such other persons, to cause confusion or mistake, or to deceive.**

STATEMENTS FOR UNSIGNED SECTION 1(b)/SECTION 44 APPLICATION AND FOR SECTION 66(a) COLLECTIVE/CERTIFICATION MARK APPLICATION: If the applicant filed an unsigned application under 15 U.S.C. §§ 1051(b), 1126(d), and/or 1126(e), or filed a collective/certification mark application under 15 U.S.C. §1141f(a), the signatory additionally believes that: *for a trademark or service mark application*, the applicant is entitled to use the mark in commerce on or in connection with the goods/services specified in the application; the applicant has a bona fide intention to use the mark in commerce and had a bona fide intention to use the mark in commerce as of the application filing date; *for a collective trademark, collective service mark, collective membership mark, or certification mark application*, the applicant has a bona fide intention, and is entitled, to exercise legitimate control over the use of the mark in commerce and had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce as of the application filing date; the signatory is properly authorized to execute the declaration on behalf of the applicant; *for a certification mark application*, the applicant will not engage in the production or marketing of the goods/services to which the mark is applied, except to advertise or promote recognition of the certification program or of the goods/services that meet the certification standards of the applicant. **To the best of the signatory's knowledge and belief, no other persons, except, if applicable, authorized users, members, and/or concurrent users, have the right to use the mark in commerce, either in the identical form or in such near resemblance as to be likely, when used on or in connection with the goods/services/collective**

membership organization of such other persons, to cause confusion or mistake, or to deceive.

Signature: /Don D. Cha/ Date: 07/20/2015
Signatory's Name: Don D. Cha
Signatory's Position: Attorney of Record, CO bar member
Signatory's Phone Number: (303) 500-3399

Request for Reconsideration Signature

Signature: /Don D. Cha/ Date: 07/20/2015
Signatory's Name: Don D. Cha
Signatory's Position: Attorney of Record, CO bar member

Signatory's Phone Number: (303) 500-3399

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: Don D. Cha
Hamilton DeSanctis & Cha, LLP
225 UNION BLVD STE 150
Lakewood, Colorado 80228

Serial Number: 86345917
Internet Transmission Date: Mon Jul 20 15:51:18 EDT 2015
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N/A-N/A-20150720154349539538