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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD



01-14-2002

U.S. Patent & TMO/c/TM Mail Rcpt Dt. #76

In re Trademark Application of )  
)  
Hughes Supply Management )  
Services, Inc. )  
)  
Serial No.: 75/907,894 )  
)  
Filed: February 2, 2000 )  
)  
For: OH-SO-SOFT )  
)

Trademark Attorney: Barbara Gaynor  
Law Office 104

M. EXP

Commissioner for Trademarks  
BOX TTAB/  
2900 Crystal Drive  
Arlington, Virginia 22202-3513

APPLICANT'S REQUEST FOR REMAND

Applicant, Hughes Supply Management Services, Inc., by and through its undersigned counsel, and pursuant to 37 C.F.R. §2.142(d) and TBMP §§1207.01 and 1207.02, hereby requests the Board to suspend Applicant's appeal and remand the present application for further examination, and as grounds therefore states as follows:

1. The subject application for the trademark OH-SO-SOFT was filed February 2, 2000 for a water-softening unit with accessory parts, including filters and protectors.
2. The first Office Action was issued June 26, 2000, in which the Examining Attorney refused registration citing the mark O-SO PURE, U.S. Registration No. 1,996,751, under Section 2(d) of the Trademark Act.

3. On December 26, 2000, the Applicant submitted a response to the first office action, pointing out the marks, when considered in their entireties, are not similar in sight, sound and meaning to support a refusal under Section 2(d) of the Trademark Act. Moreover, the Applicant's goods are different than the goods identified in the cited registration.

4. On February 2, 2001, the Examining Attorney issued a final office action, again refusing registration under Section 2(d) of the Trademark Act.

5. The Applicant filed its Notice of Appeal on August 21, 2001, and filed a brief in support of the appeal on October 22, 2001.

6. Applicant now seeks remand of the application in view of additional evidence not available during the prosecution of the present application, as set forth in the below memorandum of law.

7. In support of this Request for Remand, the Applicant submits the attached declaration of Richard F. Davis who explains that the Applicant has not experienced any instances of confusion since the Applicant began using the mark OH-SO-SOFT in February 2000. Since the date of first, almost two years ago, the Applicant has not experienced any instances of actual confusion with the cited registered mark for O-SO PURE.

#### **MEMORANDUM OF LAW**

Pursuant to 37 C.F.R. §2.142(d), an applicant may file a written request with the Trademark Trial and Appeals Board to suspend an appeal, and remand the application for further examination, if the Applicant wishes to introduce additional evidence after an

appeal has been filed. *See*, TBMP §§1207.01 and 1207.02. The request must be filed prior to the Board's final decision on appeal. TBMP §1207.02. In addition, the request must include a showing of good cause and be accompanied by the additional evidence the applicant seeks to introduce. *Id.*

The additional, and newly discovered evidence includes the Applicant's continued use of the mark OH-SO-SOFT for almost two years absent any confusion with the cited mark for O-SO PURE. The Applicant submits the attached declaration of Richard F. Davis, who is a general manager of several of the wholesale distributorship branches of the Applicant<sup>1</sup>. These Hughes Supply branches currently use the mark OH-SO-SOFT in connection with the sale of water softening units.

Mr. Davis states in his declaration that the Applicant began using mark OH-SO-SOFT in February 2000, soon after the present application was filed. Since the date of first use of the mark OH-SO-SOFT, in February 2000, the Applicant has not experienced any instance of confusion with the cited registration for O-SO PURE. Almost two years have elapsed since Applicant's date of first use of the mark, without any instance of actual confusion. Thus, Applicant has not experienced any confusion since the submission of its response over a year ago on December 26, 2000. The declaration of Mr. Davis strongly supports the Applicant's position that there is no likelihood of confusion between these two marks. This was evidence not originally considered by the Examining Attorney.

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<sup>1</sup> The term "Applicant" as used herein includes Hughes Supply Management Services, Inc., its licensees and assignees. Hughes Supply Management Services, Inc. licensed the mark to Hughes Supply, Inc. Hughes Supply, Inc, which employs Mr. Davis. Hughes Supply Management Services, Inc. has since assigned the OH-SO-SOFT mark to a related company Hughes Supply IP, Inc., which has licensed the OH-SO-SOFT mark to Hughes Supply, Inc.

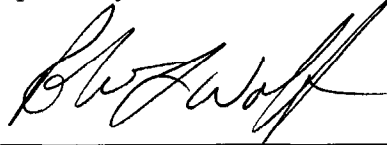
Good cause may take the form of a satisfactory explanation as to why evidence was not filed prior to appeal. *See*, TBMP §1207.02. Evidence that was not previously available may constitute good cause for remand. *See*, TBMP §1207.02. For good cause, Applicant submits that the evidence of Applicant's continued use, absent any actual confusion, for the one-year time period from December 26, 2000 (Applicant's response) to present, was not available during the prosecution of the Application.

Upon consideration of the Applicant's response filed December 26, 2000, the Examining Attorney issued a final office action on February 21, 2001. The only appropriate responses to a final action are either (1) compliance with the outstanding requirements if feasible, or (2) filing of an appeal to the Trademark Trial and Appeal Board. 37 C.F.R. § 2.64(a). The Applicant chose to file an appeal in response to the final office action, which appeal was filed on August 21, 2001.

Applicant is aware that additional evidence may be submitted after a final office action under a request for reconsideration pursuant to 37 C.F.R. § 2.64(b); however, this section does not obligate the Applicant to submit additional evidence under a request for reconsideration. The Rules of Practice in Trademark Cases permit the Applicant to submit the additional evidence under a Request for Remand filed pursuant to 37 C.F.R. § 2.142(d). Thus from the time period from December 26, 2000 (response to first office action) through August 21, 2001 (notice of appeal filed almost six months later), and through date of Mr. Davis declaration (more than a year after the response was filed), the evidence of absence of actual confusion was not available during prosecution of the application.

WHEREFORE, the Applicant respectfully requests the Board to suspend the appeal and remand the application to the Examining Attorney for further consideration of this additional evidence in the form of the declaration of Richard F. Davis.

Respectfully submitted,

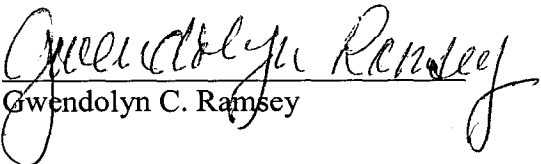


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**CERTIFICATE OF MAILING**

I HEREBY CERTIFY that this Request for Remand is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: BOX TTAB/FEE, Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3513, on this 9<sup>th</sup> day of January, 2002.

  
Gwendolyn C. Ramsey

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**DECLARATION OF RICHARD F. DAVIS**

1. My name is Richard F. Davis. I am a resident of Greensburg, Pennsylvania and I am over 18 years of age. I possess all my natural faculties. I have personal knowledge of the facts set forth in this declaration.

2. I have been employed with Hughes Supply, Inc. and/or its predecessor-in-interest regarding since 1976.

3. I am currently employed as the area manager of Hughes Supply, Inc. for its wholesale distributorship branches located in Greensburg, Pennsylvania; Bedford, Pennsylvania; Shippenville, Pennsylvania; and, Hartville, Ohio. These Hughes Supply branches offer water pump supplies for wholesale distribution, including sales to dealers, plumbing contractors, and water treatment specialists.

4. I was involved in the adoption and first use of the mark OH-SO-SOFT. The mark OH-SO-SOFT has been used in connection with water softening units since as early as February

2000, soon after the subject application was filed. Since that time, Hughes Supply, Inc. has sold approximately 1,500 units throughout the Midwest and eastern United States, including Ohio, West Virginia, Pennsylvania, New York, Indiana, Florida and Maryland.

5. I have been advised that the Trademark Office has refused registration of the mark OH-SO-SOFT trademark based on a prior registration of the mark O-SO PURE. I have never seen or heard of the mark O-SO PURE during the course of the advertising and the sale of products sold under the OH-SO-SOFT mark.

6. Since February, 2000, we have continuously used the OH-SO-SOFT trademark with the water softening units. During that time I have never experienced any instances of actual confusion between the OH-SO-SOFT and O-SO PURE trademarks. Nor has any other employee reported to me such instance of confusion.

7. I declare further that all statements made herein of my own knowledge are true and that all statements made on information and believe are believed to be true and further that these statements were made with the knowledge that willful false statement and the like are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of this application and any registration resulting therefrom.

Signed at Greensburg, PA this 8<sup>th</sup> day of January, 2002.

HUGHES SUPPLY, INC.

Richard F. Davis

Richard F. Davis  
Area Manager  
Hughes Supply, Inc.