

TRADEMARK LAW OFFICE 106

Serial Number: 76/013877

Mark: BASES PRODUCT ADVISOR

Please Place on Upper Right Corner

of Response to Office Action ONLY

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ATTY. DOCKET NO. BBU/62

02 JUN 04 AM 9:39
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APPEAL BOARD

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : BBI Marketing Services, Inc.
Serial No. : 76/013,877
Filed : March 30, 2000
Mark : BASES PRODUCT ADVISOR
Attorney : Sally Shih
Law Office : 106

BOX RESPONSES - NO FEE
Assistant Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

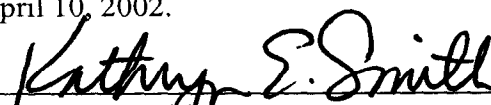
MEY

FILED
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U.S. PATENT & TRADEMARK OFFICE

Request for Reconsideration of Final Refusal
and
Response to Official Action Dated October 18, 2001

This letter is submitted in response to the Office Action dated October 18, 2001 concerning the above-referenced application. Applicant, by and through counsel, responds below to each of the issues raised by the Examiner.

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail, postage prepaid in an envelope addressed to: BOX RESPONSES - NO FEE, Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA 22202-3513 on: April 10, 2002.


Kathryn E. Smith

Simultaneous with the filing of this request for reconsideration and Office Action response, Applicant is filing a Notice of Ex Parte Appeal along with the appropriate fee to preserve its rights should the Examiner refuse Applicant's arguments herein.

I. DISCLAIMER

The Examining Attorney has maintained her requirement that the words "PRODUCT ADVISOR" be disclaimed from the subject mark. It is Applicant's contention that the terms "PRODUCT ADVISOR" are not "merely descriptive" of the services Applicant renders under the mark, i.e., market research services. It has been previously argued to the Examiner that Applicant's BASES mark is well-known within the market research industry. Furthermore, Applicant has generated a family of "BASES" containing marks, including the following marks:

- (1) BASES
Registration No. 1,206,443
Goods/Services: Marketing research services
Int.'l Class: 35
- (2) BASES LAUNCH CONTROL (Cancelled)
Registration No. 1,693,496
Goods/Services: Market research services
Int.'l Class: 35
- (3) BASES PRICE ADVISOR
Serial No. 76/033,606
Goods/Services: Market research services
Int.'l Class: 35
- (4) BASES BRAND ADVISOR
Serial No. 76/002,958
Goods/Services: Market research services
Int.'l Class: 35

- (5) BASES XRX
Registration No. 1,831,531
Goods/Services: Market research services
Int.'l Class: 35
- (6) BASES-BY-MAIL
Registration No. 1,823,126
Goods/Services: Market research services
Int.'l Class: 35
- (7) PRE-BASES
Registration No. 1,737,005
Goods/Services: Market research services
Int.'l Class: 35
- (8) BASES ATTVISOR
Registration No. 2,539,874
Goods/Services: Market research services
Int.'l Class: 35

Copies of each of the foregoing applications and registrations are enclosed for purposes of establishing a record in this case.

Through Applicant's development of the foregoing family of BASES marks, and the identity of the BASES brand, Applicant has established a favorable reputation among the relevant consuming public. Were Applicant to disclaim its rights to the terms "PRODUCT ADVISOR" in their entirety, any of Applicant's competitors could develop a competitive "PRODUCT ADVISOR" service, e.g., "Jones Product Advisor" which would effectively dilute the established value of Applicant's BASES brand of services.

Although Applicant believes its mark is entitled to registration on the Principal Register, to expedite this examination, Applicant requests that its application be amended to seek registration on the Supplemental Register in accordance with Section 23 of the Lanham

Act, 15 U.S.C. §1091. Pursuant to this amendment, all references in the application herein to the "Principal Register" should be amended to read "Supplemental Register," including the following reference:

Page 1, line 8 of the original application.

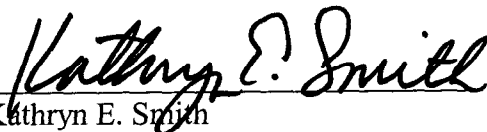
It is Applicant's understanding that its request to amend the application to the Supplemental Register is procedurally appropriate at this time, pursuant to 37 C.F.R. §2.75 and TMEP §1115.04. Applicant therefore respectfully requests its mark be registered on the Supplemental Register.

It is respectfully requested that the Examining Attorney reconsider her refusal in light of the foregoing arguments and amendment. It is further requested that Applicant's mark be allowed to proceed on to publication for registration on the Supplemental Trademark Register, and notification of same is respectfully requested. If the Examining Attorney requires any additional information, please contact the undersigned attorney.

If any charges or credits are necessary to complete this communication, please apply them to our Deposit Account no. 23-3000.

Respectfully submitted,

WOOD, HERRON & EVANS, L.L.P.


Kathryn E. Smith

Wood, Herron & Evans, L.L.P.
2700 Carew Tower
441 Vine Street
Cincinnati, OH 45202-2917
Voice: (513) 241-2324
Facsimile: (513) 421-7269



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Check Status (TARR contains current status, correspondence address and attorney of record for this mark. Use the "Back" button of the Internet Browser to return to TESS)

Typed Drawing

Word Mark BASES
Goods and Services IC 035. US 101. G & S: Marketing Research Services. FIRST USE: 19771001. FIRST USE IN COMMERCE: 19771122
Mark Drawing Code (1) TYPED DRAWING
Serial Number 73246843
Filing Date January 21, 1980
Published for Opposition June 1, 1982
Registration Number 1206443
Registration Date August 24, 1982
Owner (REGISTRANT) Burke Marketing Services, Inc. CORPORATION DELAWARE 1501 Madison Rd. Cincinnati OHIO 45206
Assignment Recorded ASSIGNMENT RECORDED
Attorney of Record JOHN D. POFFENBERGER
Type of Mark SERVICE MARK
Register PRINCIPAL
Affidavit Text SECT 15. SECT 8 (6-YR).
Live/Dead Indicator LIVE

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Typed Drawing

Word Mark	BASES LAUNCH CONTROL
Goods and Services	(CANCELLED) IC 035. US 101. G & S: market research services. FIRST USE: 19901100. FIRST USE IN COMMERCE: 19901100
Mark Drawing Code	(1) TYPED DRAWING
Serial Number	74129738
Filing Date	January 11, 1991
Filed ITU	FILED AS ITU
Published for Opposition	September 17, 1991
Registration Number	1693496
Registration Date	June 9, 1992
Owner	(REGISTRANT) BASES Burke Institute, Inc. CORPORATION DELAWARE 800 Broadway Cincinnati OHIO 45202
Assignment Recorded	ASSIGNMENT RECORDED
Attorney of Record	John D. Poffenberger
Type of Mark	SERVICE MARK
Register	PRINCIPAL
Live/Dead Indicator	DEAD
Cancellation Date	December 14, 1998

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Serial Number: 74129738

Registration Number: 1693496

Mark (words only): BASES LAUNCH CONTROL

Current Status: Registration canceled under Section 8.

Date of Status: 1998-12-14

Filing Date: 1991-01-11

Registration Date: 1992-06-09

Law Office Assigned: TMEO Law Office #15

CURRENT APPLICANT(S)/OWNER(S)

1. BASES Burke Institute, Inc.

Address:

BASES Burke Institute, Inc.
800 Broadway
Cincinnati, OH 45202
United States

Country of Citizenship: United States

Incorporated in State: Delaware

Legal Entity Type: Corporation

GOODS AND/OR SERVICES

market research services

International Class: 035

First Use Date: 19901100

First Use in Commerce Date: 19901100

Basis: 1(a)

ADDITIONAL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

1998-12-14 - Canceled Section 8 (6-year)

1992-06-09 - Registered - Principal Register

1992-04-09 - Allowed for Registration - Principal Register (SOU accepted)

1992-04-07 - Case file assigned to examining attorney

1992-04-07 - Case file assigned to examining attorney
1992-03-24 - Statement of use processing complete
1992-02-26 - Amendment to Use filed
1991-12-10 - Notice of allowance - mailed
1991-09-17 - Published for opposition
1991-08-16 - Notice of publication
1991-05-24 - Communication received from applicant
1991-05-23 - Approved for Pub - Principal Register (Initial exam)
1991-05-09 - Examiner's amendment mailed
1991-04-26 - Case file assigned to examining attorney
1991-04-26 - Case file assigned to examining attorney

CONTACT INFORMATION

Correspondent (Owner)

John D. Poffenberger (Attorney of record)

JOHN D. POFFENBERGER
WOOD, HERRON & EVANS
2700 CAREW TOWER
CINCINNATI, OH 45202
United States



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Typed Drawing

Word Mark BASES PRICE ADVISOR

Goods and Services IC 035. US 100 101 102. G & S: Market research services

Mark Drawing Code (1) TYPED DRAWING

Serial Number 76033606

Filing Date April 25, 2000

Filed ITU FILED AS ITU

Owner (APPLICANT) BBI Marketing Services, Inc. CORPORATION DELAWARE 50 E. RiverCenter Boulevard. Suite 1000 Covington KENTUCKY 41011

Attorney of Record Kathryn Evans Smith

Prior Registrations 1206443;1693496;1737005;1823126;1831531;AND OTHERS

Type of Mark SERVICE MARK

Register PRINCIPAL-2(F)

Live/Dead Indicator LIVE

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This page was generated by the TARR system on 04/10/2002 09:47:02 ET

Serial Number: 76033606

Registration Number: (NOT AVAILABLE)

Mark (words only): BASES PRICE ADVISOR

Current Status: A non-final action has been mailed. This is a letter from the examining attorney requesting additional information and/or making an initial refusal. However, no final determination as to the registrability of the mark has been made.

Date of Status: 2001-08-27

Filing Date: 2000-04-25

Registration Date: (DATE NOT AVAILABLE)

Law Office Assigned: TMEG Law Office 106

CURRENT APPLICANT(S)/OWNER(S)

1. BBI Marketing Services, Inc.

Address:

BBI Marketing Services, Inc.
50 E. RiverCenter Boulevard. Suite 1000
Covington, KY 41011
United States

State or Country of Incorporation: Delaware

Legal Entity Type: Corporation

GOODS AND/OR SERVICES

Market research services

International Class: 035

First Use Date:

First Use in Commerce Date:

Basis: 1(b)

ADDITIONAL INFORMATION

Prior Registration Number(s):

1206443

1693496

1737005
1823126
1831531

PROSECUTION HISTORY

2002-02-13 - Communication received from applicant
2001-08-27 - Non-final action mailed
2001-04-09 - Communication received from applicant
2000-10-06 - Non-final action mailed
2000-10-04 - Case file assigned to examining attorney
2000-09-28 - Case file assigned to examining attorney

CONTACT INFORMATION

Correspondent (Owner)

Kathryn Evans Smith (Attorney of record)

KATHRYN EVANS SMITH
WOOD, HERRON & EVANS, L.L.P.
2700 CAREW TOWER, 441 VINE STREET
CINCINNATI, OH 45202-2917
United States



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Typed Drawing

Word Mark	BASES BRAND ADVISOR
Goods and Services	IC 035. US 100 101 102. G & S: Market research services. FIRST USE: 19981200. FIRST USE IN COMMERCE: 19981200
Mark Drawing Code	(1) TYPED DRAWING
Serial Number	76002958
Filing Date	March 17, 2000
Supplemental Register Date	June 18, 2001
Owner	(APPLICANT) BBI MARKETING SERVICES, INC. CORPORATION DELAWARE 50 E. RiverCenter Boulevard, Suite 1000 Covington KENTUCKY 41011
Attorney of Record	Kathryn Evans Smith
Type of Mark	SERVICE MARK
Register	SUPPLEMENTAL
Live/Dead Indicator	LIVE

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Serial Number: 76002958

Registration Number: (NOT AVAILABLE)

Mark (words only): BASES BRAND ADVISOR

Current Status: Approved by the examining attorney for publication for opposition. This is NOT the beginning of the Opposition period. In approximately two months, please visit the web site to learn the actual date of publication for opposition in the Trademark Official Gazette.

Date of Status: 2001-11-23

Filing Date: 2000-03-17

Registration Date: (DATE NOT AVAILABLE)

Law Office Assigned: TMEG Law Office 106

CURRENT APPLICANT(S)/OWNER(S)

1. BBI MARKETING SERVICES, INC.

Address:

BBI MARKETING SERVICES, INC.
50 E. RiverCenter Boulevard, Suite 1000
Covington, KY 41011
United States

Country of Citizenship: United States

Incorporated in State: Delaware

Legal Entity Type: Corporation

GOODS AND/OR SERVICES

Market research services

International Class: 035

First Use Date: 19981200

First Use in Commerce Date: 19981200

Basis: 1(a)

ADDITIONAL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

2001-11-23 - Approved for Pub - Supplemental Register (Initial exam)

2001-10-26 - Jurisdiction restored to examiner

2001-10-26 - Ex parte appeal - Instituted

2000-12-19 - Final refusal mailed

2000-09-20 - Communication received from applicant

2000-09-08 - Non-final action mailed

2000-09-06 - Case file assigned to examining attorney

CONTACT INFORMATION

Correspondent (Owner)

Kathryn Evans Smith (Attorney of record)

KATHRYN EVANS SMITH
WOOD, HERRON & EVANS, L.L.P.
2700 CAREW TOWER
CINCINNATI, OHIO 45202
United States



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BASES XR

Word Mark BASES X
Goods and Services IC 035. US 101. G & S: market research services. FIRST USE: 19890100. FIRST USE IN COMMERCE: 19890600
Mark Drawing Code (3) DESIGN PLUS WORDS, LETTERS, AND/OR NUMBERS
Design Search Code 241717
Serial Number 74380071
Filing Date April 19, 1993
Published for Opposition January 25, 1994
Registration Number 1831531
Registration Date April 19, 1994
Owner (REGISTRANT) BBI MARKETING SERVICES, INC. CORPORATION DELAWARE 50 E. RiverCenter Boulevard, Suite 1000 Covington KENTUCKY 41011
Assignment Recorded ASSIGNMENT RECORDED
Attorney of Record John D. Poffenberger
Prior Registrations 1206443
Type of Mark SERVICE MARK
Register PRINCIPAL
Affidavit Text SECT 15. SECT 8 (6-YR).
Live/Dead Indicator LIVE

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Typed Drawing

Word Mark BASES-BY-MAIL
Goods and Services IC 035. US 101. G & S: market research services. FIRST USE: 19910300. FIRST USE IN COMMERCE: 19930400
Mark Drawing Code (1) TYPED DRAWING
Serial Number 74380070
Filing Date April 19, 1993
Published for Opposition November 30, 1993
Registration Number 1823126
Registration Date February 22, 1994
Owner (REGISTRANT) BBI MARKETING SERVICES, INC. CORPORATION DELAWARE 50 E. RiverCenter Boulevard, Suite 1000 Covington KENTUCKY 41011

(LAST LISTED OWNER) BBIO, INC. CORPORATION ASSIGNEE OF KENTUCKY 50 E. RIVERCENTER BOULEVARD SUITE 1000 COVINGTON KENTUCKY 41011
Assignment Recorded ASSIGNMENT RECORDED
Attorney of Record John D. Poffenberger
Prior Registrations 1206443
Type of Mark SERVICE MARK
Register PRINCIPAL
Affidavit Text SECT 15. SECT 8 (6-YR).
Live/Dead Indicator LIVE

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Typed Drawing

Word Mark PRE-BASES
Goods and Services IC 035. US 101. G & S: market research services. FIRST USE: 19890801. FIRST USE IN COMMERCE: 19890901
Mark Drawing Code (1) TYPED DRAWING
Serial Number 74262819
Filing Date April 6, 1992
Published for Opposition September 8, 1992
Registration Number 1737005
Registration Date December 1, 1992
Owner (REGISTRANT) BBI Marketing Services, Inc. CORPORATION DELAWARE 50 E. RiverCenter Boulevard, Suite 1000 Covington KENTUCKY 41011
Assignment Recorded ASSIGNMENT RECORDED
Attorney of Record John D. Poffenberger
Type of Mark SERVICE MARK
Register PRINCIPAL
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Typed Drawing

Word Mark	BASES ATTVISOR
Goods and Services	IC 035. US 100 101 102. G & S: market research services. FIRST USE: 20000929. FIRST USE IN COMMERCE: 20000929
Mark Drawing Code	(1) TYPED DRAWING
Serial Number	76161762
Filing Date	November 8, 2000
Published for Opposition	November 27, 2001
Registration Number	2539874
Registration Date	February 19, 2002
Owner	(REGISTRANT) BBI MARKETING SERVICES, INC. CORPORATION DELAWARE 50 E. RiverCenter Boulevard Suite 1000 Covington KENTUCKY 41011
Attorney of Record	Herbert C. Brinkman
Type of Mark	SERVICE MARK
Register	PRINCIPAL
Live/Dead Indicator	LIVE

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