

PTO Form (Rev 4/2000)

OMB No. 0651-.... (Exp. 08/31/2004)

## Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
<b>SERIAL NUMBER</b>	77872681
<b>LAW OFFICE ASSIGNED</b>	LAW OFFICE 107
<b>MARK SECTION (no change)</b>	
<b>ARGUMENT(S)</b>	
<p>Applicant respectfully requests reconsideration of the final refusal on the basis that the applied-for mark is primarily merely a surname. Applicant respectfully submits that the surname refusal is overcome by Applicant's claim of acquired distinctiveness under Section 2(f) by reason of: (1) use for more than five years of the same mark in connection with the same goods; and (2) Applicant's ownership of prior U.S. Reg. No. 4,004,326 for the same mark and in connection with the same goods. Applicant did not previously submit a claim of acquired distinctiveness based on ownership of U.S. Reg. No. 4,004,326, as this registration was just recently issued on August 2, 2011.</p> <p>In the Final Office Action, dated March 29, 2011, it is asserted that the design of the applied-for mark is non-distinctive such that the applied-for mark "does not create a separate commercial impression over and above that made by the surname itself." In other words, the applied-for mark does not create a separate commercial impression from the UNDERHILL word mark itself. Applicant thus respectfully submits that the applied-for mark is the "same mark" as the UNDERHILL word mark, for which Applicant has submitted a claim of acquired distinctiveness based on at least five years' use of the UNDERHILL word mark in connection with the same goods. In addition, Applicant owns a prior U.S. Reg. No. 4,004,623 for the same mark and in connection with the same goods.</p> <p>A proposed mark is the "same mark as a previously registered mark for purpose of 37 CFR § 2.41(b)" if it is the "legal equivalent" of such a mark. <i>Id.</i> at § 1212.04(b). "A mark is the legal equivalent of another if it creates the same, continuing commercial impression such that the consumer would consider them both the same mark." <i>Id.</i></p> <p>As the design of the applied-for mark is asserted to not have any significance above and over that of the UNDERHILL word itself, Applicant respectfully submits that the declaration as to the use of the UNDERHILL word mark for more than 5 years is sufficient to establish secondary meaning of the applied-for mark.</p> <p>In addition, Applicant further submits a claim of distinctiveness under Section 2(f) with evidence of ownership of prior U.S. Reg. No. 4,004,326 for the same mark and in connection with the same goods. "Trademark Rule 2.41(b), 37 CFR § 2.41(b), provides that the examining attorney may accept, as prima facie evidence of acquired distinctiveness, ownership by the applicant of one or more prior registrations of the <i>same mark</i> on the Principal Register." TMEP § 1212.04 (emphasis added).</p> <p>Applicant respectfully requests reconsideration of the final refusal in view of the foregoing considerations.</p>	
<b>ADDITIONAL STATEMENTS SECTION</b>	

SECTION 2(f)	The mark has become distinctive of the goods/services as evidenced by the ownership on the Principal Register for the same mark for related goods or services of U.S. Registration No(s). 4004326.
<b>SIGNATURE SECTION</b>	
DECLARATION SIGNATURE	/michelleckim/
SIGNATORY'S NAME	Michelle C. Kim
SIGNATORY'S POSITION	Attorney of record, CA bar member
DATE SIGNED	09/29/2011
RESPONSE SIGNATURE	/michelleckim/
SIGNATORY'S NAME	Michelle C. Kim
SIGNATORY'S POSITION	Attorney of record, CA bar member
DATE SIGNED	09/29/2011
AUTHORIZED SIGNATORY	YES
CONCURRENT APPEAL NOTICE FILED	YES
<b>FILING INFORMATION SECTION</b>	
SUBMIT DATE	Thu Sep 29 16:16:56 EDT 2011
TEAS STAMP	USPTO/RFR-38.104.110.126- 20110929161656997050-7787 2681-480f96fdd4e6dafc4c2d eeda3a496869ae-N/A-N/A-20 110929160943512428

PTO Form (Rev 4/2000)

OMB No. 0651-.... (Exp. 08/31/2004)

### Request for Reconsideration after Final Action

#### To the Commissioner for Trademarks:

Application serial no. **77872681** has been amended as follows:

#### ARGUMENT(S)

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

Applicant respectfully requests reconsideration of the final refusal on the basis that the applied-for mark is primarily merely a surname. Applicant respectfully submits that the surname refusal is

overcome by Applicant's claim of acquired distinctiveness under Section 2(f) by reason of: (1) use for more than five years of the same mark in connection with the same goods; and (2) Applicant's ownership of prior U.S. Reg. No. 4,004,326 for the same mark and in connection with the same goods. Applicant did not previously submit a claim of acquired distinctiveness based on ownership of U.S. Reg. No. 4,004,326, as this registration was just recently issued on August 2, 2011.

In the Final Office Action, dated March 29, 2011, it is asserted that the design of the applied-for mark is non-distinctive such that the applied-for mark "does not create a separate commercial impression over and above that made by the surname itself." In other words, the applied-for mark does not create a separate commercial impression from the UNDERHILL word mark itself. Applicant thus respectfully submits that the applied-for mark is the "same mark" as the UNDERHILL word mark, for which Applicant has submitted a claim of acquired distinctiveness based on at least five years' use of the UNDERHILL word mark in connection with the same goods. In addition, Applicant owns a prior U.S. Reg. No. 4,004,623 for the same mark and in connection with the same goods.

A proposed mark is the "same mark as a previously registered mark for purpose of 37 CFR § 2.41(b)" if it is the "legal equivalent" of such a mark. *Id.* at § 1212.04(b). "A mark is the legal equivalent of another if it creates the same, continuing commercial impression such that the consumer would consider them both the same mark." *Id.*

As the design of the applied-for mark is asserted to not have any significance above and over that of the UNDERHILL word itself, Applicant respectfully submits that the declaration as to the use of the UNDERHILL word mark for more than 5 years is sufficient to establish secondary meaning of the applied-for mark.

In addition, Applicant further submits a claim of distinctiveness under Section 2(f) with evidence of ownership of prior U.S. Reg. No. 4,004,326 for the same mark and in connection with the same goods. "Trademark Rule 2.41(b), 37 CFR § 2.41(b), provides that the examining attorney may accept, as prima facie evidence of acquired distinctiveness, ownership by the applicant of one or more prior registrations of the *same mark* on the Principal Register." TMEP § 1212.04 (emphasis added).

Applicant respectfully requests reconsideration of the final refusal in view of the foregoing considerations.

#### **ADDITIONAL STATEMENTS**

##### **Section 2(f), based on Prior Registration(s)**

The mark has become distinctive of the goods/services as evidenced by the ownership on the Principal Register for the same mark for related goods or services of U.S. Registration No(s). 4004326.

#### **SIGNATURE(S)**

##### **Declaration Signature**

If the applicant is seeking registration under Section 1(b) and/or Section 44 of the Trademark Act, the applicant has had a bona fide intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the identified goods and/or services as of the filing date of the application. 37 C.F.R. Secs. 2.34(a)(2)(i); 2.34(a)(3)(i); and 2.34(a)(4)(ii); and/or the applicant has had a bona fide intention to exercise legitimate control over the use of the mark in commerce by its members. 37 C.F.R. Sec. 2.44. If the applicant is seeking registration under Section 1(a) of the Trademark Act, the mark was in use in commerce on or in connection with the goods and/or services listed in the application as of the application filing date or as of the date of any submitted allegation of use. 37 C.F.R. Secs. 2.34(a)(1)(i); and/or the applicant has exercised legitimate control over the use of the mark in commerce by its members. 37 C.F.R. Sec. 2.44. The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. Section 1001, and that such willful false statements may jeopardize the validity of the application or any resulting registration, declares that he/she is properly authorized to execute this application on behalf of the applicant; he/she believes the applicant to be the owner of the trademark/service mark

sought to be registered, or, if the application is being filed under 15 U.S.C. Section 1051(b), he/she believes applicant to be entitled to use such mark in commerce; to the best of his/her knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive; that if the original application was submitted unsigned, that all statements in the original application and this submission made of the declaration signer's knowledge are true; and all statements in the original application and this submission made on information and belief are believed to be true.

Signature: /michellekim/ Date: 09/29/2011  
Signatory's Name: Michelle C. Kim  
Signatory's Position: Attorney of record, CA bar member

**Request for Reconsideration Signature**

Signature: /michellekim/ Date: 09/29/2011  
Signatory's Name: Michelle C. Kim  
Signatory's Position: Attorney of record, CA bar member

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: 77872681  
Internet Transmission Date: Thu Sep 29 16:16:56 EDT 2011  
TEAS Stamp: USPTO/RFR-38.104.110.126-201109291616569  
97050-77872681-480f96fdd4e6dafc4c2deeda3  
a496869ae-N/A-N/A-20110929160943512428