
To: INVENTIO AG (kstoffel@wolffsamson.com)
Subject: TRADEMARK APPLICATION NO. 78341405 - SCHINDLER - T/4309-61
Sent: 6/6/2006 11:14:21 AM
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Attachments:

UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 78/341405

APPLICANT: INVENTIO AG

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MARK: SCHINDLER

CORRESPONDENT'S REFERENCE/DOCKET NO: T/4309-61

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Please provide in all correspondence:

1. Filing date, serial number, mark and applicant's name.
2. Date of this Office Action.
3. Examining Attorney's name and Law Office number.
4. Your telephone number and e-mail address.

FINAL OFFICE ACTION MAINTAINED

RESPONSE TIME LIMIT: TO AVOID ABANDONMENT, THE OFFICE MUST RECEIVE A PROPER RESPONSE TO THIS OFFICE ACTION WITHIN 6 MONTHS OF THE MAILING OR E-MAILING DATE.

MAILING/E-MAILING DATE INFORMATION: If the mailing or e-mailing date of this Office action does not appear above, this information can be obtained by visiting the USPTO website at <http://tarr.uspto.gov/>, inserting the application serial number, and viewing the prosecution history for the mailing date of the most recently issued Office communication.

Serial Number 78/341405

The assigned examining attorney has reviewed the applicant's correspondence received on April 11, 2006, in the referenced application and determined the following. The amended recitation of

services in International Class 35 is acceptable. The claim of acquired distinctiveness under Section 2(f) of the Trademark Act is acceptable as to those services identified in International Class 45. However, the Section 2(f) claim based upon the applicant's prior registrations does not encompass all of the services identified in International Class 35. Therefore, the FINAL refusal to register the mark under Section 2(e)(4), 15 U.S.C. §1052(e)(4), is maintained with regard to the following identified services in International Class 35.

FINAL REFUSAL TO REGISTER THE MARK IS MAINTAINED

The FINAL refusal under Trademark Act Section 2(e)(4), 15 U.S.C. §1052(e)(4), is maintained for the reasons set forth below. 37 C.F.R. §2.64(a).

The examining attorney maintains the refusal to register the proposed mark on the Principal Register because the mark is primarily merely a surname. Trademark Act Section 2(e)(4), 15 U.S.C. Section 1052(e)(4); TMEP section 1211. The examining attorney must consider the primary significance of the mark to the purchasing public to determine whether a term is primarily merely a surname. *In re Kahan & Weisz Jewelry Mfg. Corp.*, 508 F.2d 831, 184 USPQ 421 (CCPA 1975). Please see the surname evidence of record.

The applicant has attempted to establish that, as a result of applicant's use of the mark on *other* goods or services, the mark has become distinctive of the services in the current intent-to-use application and that this previously created distinctiveness will transfer to the services in the intent-to-use application when use in commerce begins. *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 57 USPQ2d 1807, 1812 (Fed. Cir. 2001); TMEP §1212.09(a). The requirements for showing that a mark in an intent-to-use application has acquired distinctiveness dictates that (1) the applicant must establish that the same mark has acquired distinctiveness as to the other goods and/or services, by submitting evidence such as **ownership of a prior registration for the same mark for related goods and/or services**, a *prima facie* showing of acquired distinctiveness based on five years' use of the same mark with related goods and/or services, or actual evidence of acquired distinctiveness for the same mark with respect to the other goods and/or services; **and** (2) the applicant must **submit evidence to establish a sufficient relationship between the goods and/or services in connection with which the mark has acquired distinctiveness and the goods and/or services recited in the intent-to-use application** to warrant the conclusion that the previously created distinctiveness will transfer to the goods and/or services in the application upon use. *In re Rogers*, 53 USPQ2d 1741 (TTAB 1999).

In the applicant's April 11th correspondence, the applicant asserts that the mark has become distinctive of the relevant services in International Classes 35 and 45 based upon the applicant's ownership of numerous prior registrations. However, some of the services identified in International Class 35 in the current application differ and/or exceed those identified in the prior registrations. Specifically, the applicant has not previously registered the mark for the services identified in this application as "business management and business organizational consultation," "direct marketing advertising for others," "advertising agency services," "public relations," "publication and dissemination of publicity texts," "demonstration of goods and services for advertising purposes," "distribution of samples and direct mail advertising," "providing information about the goods and services of others via computer databases on the global computer network," "electronic processing of orders for others," "computerized tracking and tracing of packages in transit," "employment agencies," and "e-commerce services, namely, providing product information via electronic transmission for commercial or advertising purposes." As worded, the recitation of services in International Class 35 does not directly link any of these services with "elevators, escalators, and other vertical, horizontal

and inclined conveyor installations, master key systems, access control and security systems of buildings and public facilities.” The applicant has failed to establish that there is a “sufficient relationship” between the services in connection with which the mark has acquired distinctiveness and the above recited services in the current intent-to-use application. The examining attorney cannot find that the previously created distinctiveness transfers to these services.

Therefore, additional evidence is needed to support the claim of distinctiveness with regard to these services. Applicant's claim of ownership of the prior registrations alone is insufficient evidence of distinctiveness in this case. *See* TMEP §1212.04(a). *In re Loew's Theatres, Inc.*, 769 F.2d 764, 226 USPQ 865 (Fed. Cir. 1985). The applicant must establish acquired distinctiveness by a preponderance of the evidence. *Yamaha Int'l Corp. v. Hoshino Gakki Co.*, 840 F.2d 1572, 6 USPQ2d 1001 (Fed. Cir. 1988). This evidence may include specific dollar sales under the mark, advertising figures, samples of advertising, consumer or dealer statements of recognition of the mark, and any other evidence that establishes the distinctiveness of the mark as an indicator of source. *See In re Ideal Industries, Inc.*, 508 F.2d 1336, 184 USPQ 487 (C.C.P.A. 1975); *In re Instant Transactions Corp.*, 201 USPQ 957 (TTAB 1979). The Office will decide each case on its own merits.

Although the examining attorney has refused registration, the applicant may respond to the refusal to register by submitting evidence and arguments in support of registration. Please note that this application will be returned to the Trademark Trial and Appeal Board for further action on the applicant's appeal.

RESPONSE

Applicant may respond to this Office action using the Office's Trademark Electronic Application System (TEAS) at <http://www.uspto.gov/teas/index.html>. When using TEAS the data the applicant submits is directly uploaded into the Office's database, which reduces processing time and eliminates the possibility of data entry errors by the Office. Applicants are strongly encouraged to use TEAS to respond to Office actions. Applicants using TEAS should not submit a duplicate paper copy of the response.

STATUS OF APPLICATION

The Trademark Applications and Registrations Retrieval (TARR) database on the USPTO website at <http://tarr.uspto.gov> provides detailed, up to the minute information about the status and prosecution history of trademark applications and registrations. The TARR database is available 24 hours a day, 7 days a week. Status and status date information is also available via push-button telephone at (703) 305-8747 from 6:30 a.m. until midnight, Eastern Time, Monday through Friday.

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HOW TO RESPOND TO THIS OFFICE ACTION:

- **ONLINE RESPONSE:** You may respond using the Office's Trademark Electronic Application

System (TEAS) Response to Office action form available on our website at <http://www.uspto.gov/teas/index.html>. If the Office action issued via e-mail, you must wait 72 hours after receipt of the Office action to respond via TEAS. **NOTE: Do not respond by e-mail. THE USPTO WILL NOT ACCEPT AN E-MAILED RESPONSE.**

- **REGULAR MAIL RESPONSE:** To respond by regular mail, your response should be sent to the mailing return address above, and include the serial number, law office number, and examining attorney's name. **NOTE: The filing date of the response will be the date of receipt in the Office,** not the postmarked date. To ensure your response is timely, use a certificate of mailing. 37 C.F.R. §2.197.

STATUS OF APPLICATION: To check the status of your application, visit the Office's Trademark Applications and Registrations Retrieval (TARR) system at <http://tarr.uspto.gov>.

VIEW APPLICATION DOCUMENTS ONLINE: Documents in the electronic file for pending applications can be viewed and downloaded online at <http://portal.uspto.gov/external/portal/tow>.

GENERAL TRADEMARK INFORMATION: For general information about trademarks, please visit the Office's website at <http://www.uspto.gov/main/trademarks.htm>

FOR INQUIRIES OR QUESTIONS ABOUT THIS OFFICE ACTION, PLEASE CONTACT THE ASSIGNED EXAMINING ATTORNEY SPECIFIED ABOVE.