

Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	85393359
LAW OFFICE ASSIGNED	LAW OFFICE 102
MARK SECTION (no change)	
ARGUMENT(S)	
<p style="text-align: center;"><u>RESPONSE TO FINAL OFFICE ACTION</u></p> <p>Reconsideration of the Final Office Action is requested.</p> <p>Refusal to register is based on the Examiner's unsupportable premise that Applicant's one word trademark "USAFLEX" is two words. The Examiner has broken a single word, as shown in Applicant's specimens, into two unrelated words, in violation of trademark precedents which do not give the Examiner basis or permission to separate a unitary trademark into parts the Examiner designates for purposes of finding each independent part separately descriptive. A mark must be viewed in its entirety. <i>See In re Hearst</i>, 25 U.S.P.Q. 2d 1238, 1239 (Fed. Cir. 1992); <i>Wet Seal, Inc. v. F.D. Mgmt., Inc.</i>, 82 U.S.P.Q. 2d 1629, 1638 (T.T.A.B. 2007).</p> <p>Applicant's one word mark, USAFLEX, has a distinctly different appearance than two separated words, USA and FLEX. When the entire one word mark is together, as shown in the specimen, its pronunciation would be as one word (yooz, uh, flex) not (you, ess, eh, flex) as the Examiner posits. One word shown is not automatically pronounced as two words.</p> <p>Applicant's mark is not geographically descriptive, since it is not essentially, entirely or primarily "USA" as would be needed to find that that is its primary significance. The unseparated part "FLEX" is equally important, because without the "FLEX" part, the entire trademark would both have a difference appearance and a different pronunciation. Conversely, while "FLEX" alone may have a dictionary meaning, "USAFLEX" does not have any meaning and there is no logical reason, for either geographic descriptiveness or functional descriptiveness, to combine "USA" and "FLEX" into one word. The test is whether the trademark being examined is merely descriptive and not whether it is capable of being divided any way an Examiner chooses to divide it, to create a previously non-existent two word descriptive term, by changing the trademark "USAFLEX" into two words separated only after the "A", and not separated elsewhere and then imagining that the arbitrarily selected two words is the meaning of the trademark when in fact it is one word.</p> <p>In the numerous precedent registrations cited by the Examiner, the word "FLEX" is separated from the other word. Yet, those trademarks are registered on the Principal Register. While one can say that a decision concerning registrability of one mark does not carry over to others, there may be more than ten</p>	

other marks where the word “FLEX” stands apart from the other word. Yet, all are registered on the Principal Register since none of these is a merely descriptive one word mark, and most disclaim the separate word “FLEX”. When numerous Examiners do not find an entire trademark of two words merely descriptive due to the presence of the word “FLEX”, this becomes significant precedent that is applicable to the Applicant’s mark, despite the dictionary meaning of the word “FLEX”. Unlike “TREK FLEX”, (Registration 2,553,403), or “WEB FLEX”, (Registration No. 2,644,106), or “PEDIPED FLEX”, (Registration 3,682,335), or “FLEX RIDE”, (Registration No. 3,962,389), or “ENERGY FLEX”, (Registration 3,929,740), etc., Applicant’s mark “USAFLEX”, even after the impermissible separation of Applicant’s mark into two words by the Examiner, shows no logical relationship between the Examiner’s selected two words “USA” and “FLEX”. Like nearly all of the specific references I just mentioned, there is no relationship between the impermissibly separated parts of Applicant’s mark. Yet, the references have been registered on the Principal Register. Applicant’s mark should be registerable there as well. Although it should not be necessary to disclaim part of a single word trademark, Applicant offers a disclaimer of “FLEX” apart from its entire mark as shown, as was done in nearly all of the precedent references.

As Applicant had previously pointed out, when “USA” is used as an integral part of a mark with other letters as in Applicant’s mark and in references Applicant has cited, the trademark is not geographically descriptive. Again, the precedents support registerability of Applicant’s single word mark when it is not impermissibly separated into two unrelated words.

As to the mark being merely descriptive, Applicant disagrees completely, but offers the disclaimer of “FLEX” even though “FLEX” is not a separate word but is an integral part of Applicant’s mark.

Applicant’s mark is registerable on the Principal Register, or else all others to which the Examiner refers also should not have been registered on the Principal Register.

SIGNATURE SECTION

RESPONSE SIGNATURE	/RCF/
SIGNATORY'S NAME	Robert C. Faber
SIGNATORY'S POSITION	Attorney for Applicant, New York bar member
SIGNATORY'S PHONE NUMBER	(212) 382-0700
DATE SIGNED	12/28/2012
AUTHORIZED SIGNATORY	YES
CONCURRENT APPEAL NOTICE FILED	YES

FILING INFORMATION SECTION

SUBMIT DATE	Fri Dec 28 11:00:12 EST 2012
TEAS STAMP	USPTO/RFR-216.195.203.66-20121228110012315754-85393359-490a6c26a8249597ff17c2d89b229ee9e25-N/A-N/A-20121228105554746456

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

Application serial no. **85393359** has been amended as follows:

ARGUMENT(S)

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

RESPONSE TO FINAL OFFICE ACTION

Reconsideration of the Final Office Action is requested.

Refusal to register is based on the Examiner's unsupportable premise that Applicant's one word trademark "USAFLEX" is two words. The Examiner has broken a single word, as shown in Applicant's specimens, into two unrelated words, in violation of trademark precedents which do not give the Examiner basis or permission to separate a unitary trademark into parts the Examiner designates for purposes of finding each independent part separately descriptive. A mark must be viewed in its entirety. *See In re Hearst*, 25 U.S.P.Q. 2d 1238, 1239 (Fed. Cir. 1992); *Wet Seal, Inc. v. F.D. Mgmt., Inc.*, 82 U.S.P.Q. 2d 1629, 1638 (T.T.A.B. 2007).

Applicant's one word mark, USAFLEX, has a distinctly different appearance than two separated words, USA and FLEX. When the entire one word mark is together, as shown in the specimen, its pronunciation would be as one word (yooz, uh, flex) not (you, ess, eh, flex) as the Examiner posits. One word shown is not automatically pronounced as two words.

Applicant's mark is not geographically descriptive, since it is not essentially, entirely or primarily "USA" as would be needed to find that that is its primary significance. The unseparated part "FLEX" is equally important, because without the "FLEX" part, the entire trademark would both have a difference appearance and a different pronunciation. Conversely, while "FLEX" alone may have a dictionary meaning, "USAFLEX" does not have any meaning and there is no logical reason, for either geographic descriptiveness or functional descriptiveness, to combine "USA" and "FLEX" into one word. The test is whether the trademark being examined is merely descriptive and not whether it is capable of being divided any way an Examiner chooses to divide it, to create a previously non-existent two word descriptive term, by changing the trademark "USAFLEX" into two words separated only after the "A", and not separated elsewhere and then imagining that the arbitrarily selected two words is the meaning of the trademark when in fact it is one word.

In the numerous precedent registrations cited by the Examiner, the word "FLEX" is separated from the other word. Yet, those trademarks are registered on the Principal Register. While one can say that a decision concerning registrability of one mark does not carry over to others, there may be more than ten other marks where the word "FLEX" stands apart from the other word. Yet, all are registered on the Principal Register since none of these is a merely descriptive one word mark, and most disclaim the separate word "FLEX". When numerous Examiners do not find an entire trademark of two words merely

descriptive due to the presence of the word "FLEX", this becomes significant precedent that is applicable to the Applicant's mark, despite the dictionary meaning of the word "FLEX". Unlike "TREK FLEX", (Registration 2,553,403), or "WEB FLEX", (Registration No. 2,644,106), or "PEDIPED FLEX", (Registration 3,682,335), or "FLEX RIDE", (Registration No. 3,962,389), or "ENERGY FLEX", (Registration 3,929,740), etc., Applicant's mark "USAFLEX", even after the impermissible separation of Applicant's mark into two words by the Examiner, shows no logical relationship between the Examiner's selected two words "USA" and "FLEX". Like nearly all of the specific references I just mentioned, there is no relationship between the impermissibly separated parts of Applicant's mark. Yet, the references have been registered on the Principal Register. Applicant's mark should be registerable there as well. Although it should not be necessary to disclaim part of a single word trademark, Applicant offers a disclaimer of "FLEX" apart from its entire mark as shown, as was done in nearly all of the precedent references.

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Applicant's mark is registerable on the Principal Register, or else all others to which the Examiner refers also should not have been registered on the Principal Register.

SIGNATURE(S)

Request for Reconsideration Signature

Signature: /RCF/ Date: 12/28/2012

Signatory's Name: Robert C. Faber

Signatory's Position: Attorney for Applicant, New York bar member

Signatory's Phone Number: (212) 382-0700

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: 85393359

Internet Transmission Date: Fri Dec 28 11:00:12 EST 2012

TEAS Stamp: USPTO/RFR-216.195.203.66-201212281100123
15754-85393359-490a6c26a8249597ff17c2d89
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