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

Proceeding	85984162
Applicant	Clear Image, Inc.
Applied for Mark	CLEARBAGS
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK TRIAL AND APPEAL BOARD

APPLICANT:	Clear Image Inc.)	
)	
MARK:	CLEARBAGS)	
)	
SERIAL NO.:	85/984,162)	
)	APPEAL REPLY BRIEF
FILED:	July 1, 2013)	
)	
EXAMINING)	
ATTORNEY:	John M. Wilke)	
)	
PARALEGAL:	Monique Hill-Tyson)	
)	

REPLY BRIEF

Applicant, Clear Image Inc., by and through its counsel, hereby submits this reply brief in response to Examining Attorney Wilke’s Opposition to Applicant’s Request for Remand filed March 1, 2019. Applicant respectfully submits that Applicant’s Request for Remand, filed August 8, 2018, was supported by good cause and with the intent to move the application towards publication. Applicant again requests that the Trademark Trial and Appeal Board (hereinafter referred to as the “Board”) remand the above referenced application to the

Examining Attorney pursuant to TBMP 1205.01 and 1209.4¹ for reconsideration of the amendment and request to divide filed August 8, 2018.

Good cause exists for remanding for consideration of the amendment. Prior requests to remand application have resulted in registration of several companion registrations including Registration Nos. 5609306, 5483330, and 5070852. Each registration was an attempt to get goods allowed, which followed by an amendment to the goods that was found acceptable and resulted in registration of different goods and services. Each request for remand was a different

¹Applicant acknowledges that a Request For Remand was previously filed on April 25, 2017. That remand was accepted and resulted in a published application. Applicant divided the application prior to publishing, which led to the application being back on appeal. Applicant believes that a request for remand will again result in a published application, if the request is granted, and that there is good cause to remand. Precedent for a second request for remand comes from TBMP 1205.01, which notably states:

The Board will also treat as a request for remand an amendment filed after the filing of a notice of appeal, even if filed within six months of the final action, if the examining attorney had previously acted on an amendment or request for reconsideration after the filing of the notice of appeal. Similarly, if the amendment is filed along with the applicant's appeal brief or thereafter, even if filed within six months of the final action, the Board will treat the submission as a request for remand. See TBMP § 1204. The amendment must accompany the request for remand. Both the request and the amendment should be submitted through ESTTA. The amendment should not be filed separately through TEAS.

Additionally, TBMP 1209.04 notably states:

However, if the examining attorney denies a request for reconsideration after the appeal is filed, a second request for reconsideration will be treated as a request for remand even if it is filed within six months of the final Office action.

Both of these sections indicate that a Request for Remand is the proper procedure when also amending an application, when filed within six months of the final action, and TBMP 1209.04 further specifies that a second request for reconsideration is treated as a request for remand. Applicant respectfully submits that it follows that it is proper to file this Request for Remand.

attempt to get goods allowed, and to argue that the mark should not be refused under Sections 2(e)1 and Section 23©. Applicant believed, and still asserts that the mark is not descriptive or generic and that, in the alternative, the mark has acquired distinctiveness as required under Section 2(f) to be registered on the Principal Register. The passage of more time has only increased the validity of this argument, thus necessitating multiple arguments and registrations. Though not successful, each resulted in different goods registering under the CLEARBAGS mark. Section 703 of the Trademark Manual of Examining Procedures states that such is allowable, in that multiple applications with identifications that are different are not duplicate applications and will not result in duplicate registrations.

Applicant's most recent Request for Remand was a good faith attempt to obviate a ground of refusal by amendment to the identification of goods, while rightfully maintaining the right to continue prosecution of the goods as originally written with a division of the application. The amendments "Reclosable bags with or without hang holes with a colored opaque block; decorative food bags with an opaque printed pattern" [Class 016] and "All-purpose carrying bags, all fabricated from an opaque printed patterned polymer and all for travel, and not as packaging, namely gusset bags, side gusset bags, flat bottom gusset bags, clear print gusset bags" [Class 018] were based on the original goods description and were not previously deleted by applicant by amendment. In a companion application, now Registration No. 5609306, divided from the parent application, similar but not the same goods were amended with prejudice to move the application forward. The goods "Reclosable bags with or without hang holes; decorative food bags" [Class 016] and "All-purpose carrying bags, all fabricated from a printed polymer and all for travel, and not as packaging, namely, gusset bags, side gusset bags, flat

bottom gusset bags, clear print gusset bags” are similar but are not the same goods. Under TMEP 703, “Applications/registrations with identifications that include some of the same goods/services, but also different goods/services, would not result in duplicate registrations.” The intended amendment to this application is different from the goods of the companion application, the goods are based from the original description of this application, and the goods have not been deleted by Applicant by amendment. Applicant is not attempting to re-insert goods into the application by this amendment, but is seeking to retain the rights to prosecute the goods currently recited as is allowed by a division of this application. Applicant therefore submits that the Request for Remand was proper and good cause exists to remand this application.

Furthermore, the amendments resolve issues of genericness and descriptiveness as opaque printed patterned, opaque printed block, and opaque printed patterned polymer goods are not see-through and are not described by the term CLEARBAGS. Therefore, the Request for Remand is proper.

In the alternative, if good cause is not found, even in view of the above arguments, Applicant respectfully requests and additional 60 days to prepare an appeal brief on all issues including the refusals based on Sections 2(e)1 and 23(c).

Good cause exists because Applicant intends to amend its identification of goods to obviate refusals, and the amendments were not previously deleted by Applicant by amendment in this or a companion application. By way of the previously submitted Request for Remand, and with the help of the Examining Attorney upon remand, Applicant believes the present application will be in condition for approval for publication. Accordingly, good cause exists and Applicant respectfully requests that the Board grant its request for remand.

Applicant expresses thanks for the attention provided to this reply brief. Any questions regarding this reply can be directed to the undersigned.

Respectfully submitted this 6th day of May, 2019.

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