

Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	86081312
LAW OFFICE ASSIGNED	LAW OFFICE 103
MARK SECTION (no change)	
ARGUMENT(S)	
<p>In the Office Action issued May 20, 2014, the Examining Attorney continues and makes final the refusals under Section 2(e)(1) and Section 2(d). The applicant has filed a notice of appeal with this request for reconsideration, and has requested that the Board suspend the appeal and remand the application to the Examining Attorney for reconsideration.</p> <p>The Examining Attorney continues and makes final the refusal under Section 2(e)(1) on grounds that the mark is merely descriptive. Since the Office Action issued, applicant submitted an Amendment to Allege Use and a specimen, which have been accepted and entered into the record. As indicated therein, the applicant has been using SURGICAL SPECIALTIES as a mark in connection with the marketing and sale of medical devices since at least as early as 1997. During that seventeen (17) year time period, consumers have grown to recognize SURGICAL SPECIALTIES as an indicator of the source of origin of the associated medical devices. Accordingly, the mark has acquired distinctiveness or secondary meaning, and is registrable on the Principal Register under Section 2(f). Accordingly, applicant respectfully requests that the Examining Attorney reconsider and withdraw the refusal under Section 2(e)(1).</p> <p>The applicant continues to disagree that the “Surgical Specialties” mark is confusingly similar under Section 2(d) with the “American Surgical” mark. The marks are noticeably different in appearance, sound and meaning and, despite the Examining Attorney’s claim, the dominant portion of the cited mark is not “American Surgical Specialties Company.” As one example, the word “Company” cannot reasonably be asserted as a dominant portion of any mark. Similarly, the term “Surgical Specialties Company” has been disclaimed in the cited registration. This disclaimer supports the position that “American Surgical” (as evidenced by the registrant’s logo) is the dominant portion of the cited mark. To properly compare the two marks, the term “Surgical Specialties” should be compared with, in essence, “American Surgical.” While the mark must be viewed in its entirety, the dominant portion of the mark carries the most weight in the mind of the consuming public. The public will perceive the cited mark as “American Surgical,” and “American Surgical” is not confusingly similar to “Surgical Specialties.” This assertion is consistent with the fact that the two marks have coexisted in the marketplace for many years.</p> <p>Applicant believes the application is now in condition for allowance and requests that it be approved for publication. If questions remain, the Examining Attorney is invited to contact Applicant's counsel,</p>	

Kevin S. Costanza, by email at KevinC.Docketing@SeedIP.com or by telephone at (206) 622-4900.

ADDITIONAL STATEMENTS SECTION

SECTION 2(f) Claim of Acquired Distinctiveness, based on Use	The mark has become distinctive of the goods/services through the applicant's substantially exclusive and continuous use in commerce that the U.S. Congress may lawfully regulate for at least the five years immediately before the date of this statement.
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SIGNATURE SECTION

DECLARATION SIGNATURE	/Kevin S. Costanza/
SIGNATORY'S NAME	Kevin S. Costanza
SIGNATORY'S POSITION	Attorney for Applicant, Washington State Bar Member
SIGNATORY'S PHONE NUMBER	206-622-4900
DATE SIGNED	11/06/2014
RESPONSE SIGNATURE	/Kevin S. Costanza/
SIGNATORY'S NAME	Kevin S. Costanza
SIGNATORY'S POSITION	Attorney of record, Washington bar member
SIGNATORY'S PHONE NUMBER	206-622-4900
DATE SIGNED	11/06/2014
AUTHORIZED SIGNATORY	YES
CONCURRENT APPEAL NOTICE FILED	NO

FILING INFORMATION SECTION

SUBMIT DATE	Thu Nov 06 14:48:01 EST 2014
TEAS STAMP	USPTO/RFR-38.100.227.210- 20141106144801024736-8608 1312-5007d5830a8a7ac785e2 0112df5b6ab984f2c63119d73 fcae06e4d4c3956c15c1-N/A- N/A-20141106133607173638

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

Application serial no. **86081312** has been amended as follows:

ARGUMENT(S)

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

In the Office Action issued May 20, 2014, the Examining Attorney continues and makes final the refusals under Section 2(e)(1) and Section 2(d). The applicant has filed a notice of appeal with this request for reconsideration, and has requested that the Board suspend the appeal and remand the application to the Examining Attorney for reconsideration.

The Examining Attorney continues and makes final the refusal under Section 2(e)(1) on grounds that the mark is merely descriptive. Since the Office Action issued, applicant submitted an Amendment to Allege Use and a specimen, which have been accepted and entered into the record. As indicated therein, the applicant has been using SURGICAL SPECIALTIES as a mark in connection with the marketing and sale of medical devices since at least as early as 1997. During that seventeen (17) year time period, consumers have grown to recognize SURGICAL SPECIALTIES as an indicator of the source of origin of the associated medical devices. Accordingly, the mark has acquired distinctiveness or secondary meaning, and is registrable on the Principal Register under Section 2(f). Accordingly, applicant respectfully requests that the Examining Attorney reconsider and withdraw the refusal under Section 2(e)(1).

The applicant continues to disagree that the “Surgical Specialties” mark is confusingly similar under Section 2(d) with the “American Surgical” mark. The marks are noticeably different in appearance, sound and meaning and, despite the Examining Attorney’s claim, the dominant portion of the cited mark is not “American Surgical Specialties Company.” As one example, the word “Company” cannot reasonably be asserted as a dominant portion of any mark. Similarly, the term “Surgical Specialties Company” has been disclaimed in the cited registration. This disclaimer supports the position that “American Surgical” (as evidenced by the registrant’s logo) is the dominant portion of the cited mark. To properly compare the two marks, the term “Surgical Specialties” should be compared with, in essence, “American Surgical.” While the mark must be viewed in its entirety, the dominant portion of the mark carries the most weight in the mind of the consuming public. The public will perceive the cited mark as “American Surgical,” and “American Surgical” is not confusingly similar to “Surgical Specialties.” This assertion is consistent with the fact that the two marks have coexisted in the marketplace for many years.

Applicant believes the application is now in condition for allowance and requests that it be approved for publication. If questions remain, the Examining Attorney is invited to contact Applicant's counsel, Kevin S. Costanza, by email at KevinC.Docketing@SeedIP.com or by telephone at (206) 622-4900.

ADDITIONAL STATEMENTS

Section 2(f) Claim of Acquired Distinctiveness, based on Use

The mark has become distinctive of the goods/services through the applicant's substantially exclusive and continuous use in commerce that the U.S. Congress may lawfully regulate for at least the five years immediately before the date of this statement.

SIGNATURE(S)

Declaration Signature

DECLARATION: The signatory being warned that willful false statements and the like are punishable by

fine or imprisonment, or both, under 18 U.S.C. Section 1001, and that such willful false statements and the like may jeopardize the validity of the application or submission or any registration resulting therefrom, declares that, if the applicant submitted the application or amendment to allege use (AAU) unsigned, all statements in the application or AAU and this submission based on the signatory's own knowledge are true, and all statements in the application or AAU and this submission made on information and belief are believed to be true.

STATEMENTS FOR UNSIGNED SECTION 1(a) APPLICATION/AAU: If the applicant filed an unsigned application under 15 U.S.C. Section 1051(a) or AAU under 15 U.S.C. Section 1051(c), the signatory additionally believes that: the applicant is the owner of the trademark/service mark sought to be registered; the applicant or the applicant's related company or licensee is using the mark in commerce and has been using the mark in commerce as of the filing date of the application or AAU on or in connection with the goods/services in the application or AAU, and such use by the applicant's related company or licensee inures to the benefit of the applicant; the original specimen(s), if applicable, shows the mark in use in commerce as of the filing date of the application or AAU on or in connection with the goods/services in the application or AAU; and to the best of the signatory's knowledge and belief, no other person has the right to use the mark in commerce, either in the identical form or in such near resemblance as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion or mistake, or to deceive.

STATEMENTS FOR UNSIGNED SECTION 1(b)/SECTION 44 APPLICATION: If the applicant filed an unsigned application under 15 U.S.C. Section 1051(b), Section 1126(d), and/or Section 1126(e), the signatory additionally believes that: the applicant is entitled to use the mark in commerce; the applicant has a bona fide intention and has had a bona fide intention as of the application filing date to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the goods/services in the application; and to the best of the signatory's knowledge and belief, no other person has the right to use the mark in commerce, either in the identical form or in such near resemblance as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion or mistake, or to deceive.

Signature: /Kevin S. Costanza/ Date: 11/06/2014
Signatory's Name: Kevin S. Costanza
Signatory's Position: Attorney for Applicant, Washington State Bar Member
Signatory's Phone Number: 206-622-4900

Request for Reconsideration Signature

Signature: /Kevin S. Costanza/ Date: 11/06/2014
Signatory's Name: Kevin S. Costanza
Signatory's Position: Attorney of record, Washington bar member

Signatory's Phone Number: 206-622-4900

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 not filing a Notice of Appeal in conjunction with this Request for Reconsideration.

Serial Number: 86081312

Internet Transmission Date: Thu Nov 06 14:48:01 EST 2014

TEAS Stamp: USPTO/RFR-38.100.227.210-201411061448010

24736-86081312-5007d5830a8a7ac785e20112d

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