

Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	87958992
LAW OFFICE ASSIGNED	LAW OFFICE 109
MARK SECTION	
MARK	https://tmng-al.uspto.gov/resting2/api/img/87958992/large
LITERAL ELEMENT	BOTCON
STANDARD CHARACTERS	YES
USPTO-GENERATED IMAGE	YES
MARK STATEMENT	The mark consists of standard characters, without claim to any particular font style, size or color.
EVIDENCE SECTION	
EVIDENCE FILE NAME(S)	
ORIGINAL PDF FILE	evi_38104125154-20191113193909860466_.BOTCON_RRFA_11-13-19.pdf
CONVERTED PDF FILE(S) (2 pages)	\\TICRS\EXPORT17\IMAGEOUT17\879\589\87958992\xml7\RFR0002.JPG
	\\TICRS\EXPORT17\IMAGEOUT17\879\589\87958992\xml7\RFR0003.JPG
GOODS AND/OR SERVICES SECTION (028)(current)	
INTERNATIONAL CLASS	028
DESCRIPTION	
Toys, namely, toy action figures, toy figures, and plush toys; memorabilia, namely, memorabilia related to robots, and modeled toy figurines; collectible toy figures	
FILING BASIS	Section 1(b)
GOODS AND/OR SERVICES SECTION (028)(proposed)	
INTERNATIONAL CLASS	028
TRACKED TEXT DESCRIPTION	
Toys, namely, toy action figures, toy figures, and plush toys; memorabilia, namely, memorabilia related to robots, and modeled toy figurines; memorabilia, namely, toy action figures related to robots, and modeled toy figurines ; collectible toy figures	
FINAL DESCRIPTION	
Toys, namely, toy action figures, toy figures, and plush toys; memorabilia, namely, toy action figures related to robots, and modeled toy figurines; collectible toy figures	
FILING BASIS	Section 1(b)
GOODS AND/OR SERVICES SECTION (035)(no change)	
GOODS AND/OR SERVICES SECTION (041)(no change)	
ATTORNEY SECTION (current)	

NAME	Erin S. Hennessy
ATTORNEY BAR MEMBERSHIP NUMBER	NOT SPECIFIED
YEAR OF ADMISSION	NOT SPECIFIED
U.S. STATE/ COMMONWEALTH/ TERRITORY	NOT SPECIFIED
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AUTHORIZED TO COMMUNICATE VIA EMAIL	Yes

ATTORNEY SECTION (proposed)

NAME	Erin S. Hennessy
ATTORNEY BAR MEMBERSHIP NUMBER	XXX
YEAR OF ADMISSION	XXXX
U.S. STATE/ COMMONWEALTH/ TERRITORY	XX
FIRM NAME	BRACEWELL LLP
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CORRESPONDENCE SECTION (current)

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AUTHORIZED TO COMMUNICATE VIA EMAIL	Yes
CORRESPONDENCE SECTION (proposed)	
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AUTHORIZED TO COMMUNICATE VIA EMAIL	Yes
SIGNATURE SECTION	
RESPONSE SIGNATURE	/S. Annie Allison/
SIGNATORY'S NAME	S. Annie Allison
SIGNATORY'S POSITION	Associate Attorney, Bracewell, LLP, WA Bar Member
DATE SIGNED	11/13/2019
AUTHORIZED SIGNATORY	YES
CONCURRENT APPEAL NOTICE FILED	YES
FILING INFORMATION SECTION	
SUBMIT DATE	Wed Nov 13 19:47:31 EST 2019
TEAS STAMP	USPTO/RFR-XX.XXX.XXX.XXX- 20191113194731466390-8795 8992-700c289f6322af6c4c35 620b97c1a2c7a2138869cb855 d18be9ece33e453bde30eb-N/ A-N/A-2019111319390986046 6

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PTO Form 1960 (Rev 10/2011)

OMB No. 0651-0050 (Exp 09/20/2020)

Request for Reconsideration after Final Action

To the Commissioner for Trademarks:

Application serial no. **87958992** BOTCON(Standard Characters, see <https://tmng-al.uspto.gov/resting2/api/img/87958992/large>) has been amended as follows:

EVIDENCE

Original PDF file:

[evi_38104125154-20191113193909860466_-_BOTCON_RRFA_11-13-19.pdf](#)

Converted PDF file(s) (2 pages)

[Evidence-1](#)

[Evidence-2](#)

CLASSIFICATION AND LISTING OF GOODS/SERVICES

Applicant proposes to amend the following class of goods/services in the application:

Current: Class 028 for Toys, namely, toy action figures, toy figures, and plush toys; memorabilia, namely, memorabilia related to robots, and modeled toy figurines; collectible toy figures

Original Filing Basis:

Filing Basis: Section 1(b), Intent to Use: *For a trademark or service mark application:* As of the application filing date, the applicant had a bona fide intention, and was entitled, to use the mark in commerce on or in connection with the identified goods/services in the application. ***For a collective trademark, collective service mark, or collective membership mark application:*** As of the application filing date, the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce by members on or in connection with the identified goods/services/collective membership organization. ***For a certification mark application:*** As of the application filing date, the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce by authorized users in connection with the identified goods/services, and the applicant will not engage in the production or marketing of the goods/services to which the mark is applied, except to advertise or promote recognition of the certification program or of the goods/services that meet the certification standards of the applicant.

Proposed:

Tracked Text Description: Toys, namely, toy action figures, toy figures, and plush toys; ~~memorabilia, namely, memorabilia related to robots, and modeled toy figurines;~~ [memorabilia, namely, toy action figures related to robots, and modeled toy figurines;](#) collectible toy figures

Class 028 for Toys, namely, toy action figures, toy figures, and plush toys; memorabilia, namely, toy action figures related to robots, and modeled toy figurines; collectible toy figures

Filing Basis: Section 1(b), Intent to Use: *For a trademark or service mark application:* As of the application filing date, the applicant had a bona fide intention, and was entitled, to use the mark in commerce on or in connection with the identified goods/services in the application. ***For a collective trademark, collective service mark, or collective membership mark application:*** As of the application filing date, the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce by members on or in connection with the identified goods/services/collective membership organization. ***For a certification mark application:*** As of the application filing date, the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce by authorized users in connection with the identified goods/services, and the applicant will not engage in the production or marketing of the goods/services to which the mark is applied, except to advertise or promote recognition of the certification program or of the goods/services that meet the certification standards of the applicant.

The applicant's current attorney information: Erin S. Hennessy. Erin S. Hennessy of BRACEWELL LLP, is located at

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The phone number is 206-204-6200.

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The applicants proposed attorney information: Erin S. Hennessy. Erin S. Hennessy of BRACEWELL LLP, is a member of the XX bar, admitted to the bar in XXXX, bar membership no. XXX, is located at

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Erin S. Hennessy submitted the following statement: The attorney of record is an active member in good standing of the bar of the highest court of a U.S. state, the District of Columbia, or any U.S. Commonwealth or territory.

The applicant's current correspondence information: ERIN S. HENNESSY. ERIN S. HENNESSY of BRACEWELL LLP, is located at

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The applicants proposed correspondence information: Erin S. Hennessy. Erin S. Hennessy of BRACEWELL LLP, is located at

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SIGNATURE(S)

Request for Reconsideration Signature

Signature: /S. Annie Allison/ Date: 11/13/2019

Signatory's Name: S. Annie Allison

Signatory's Position: Associate Attorney, Bracewell, LLP, WA Bar Member

The signatory has confirmed that he/she is a U.S.-licensed attorney who is an active member in good standing of the bar of the highest court of a U.S. state (including the District of Columbia and any U.S. Commonwealth or territory); and he/she is currently the owner's/holder's attorney or an associate thereof; and to the best of his/her knowledge, if prior to his/her appointment another U.S.-licensed attorney not currently associated with his/her company/firm previously represented the owner/holder in this matter: the owner/holder has revoked their power of attorney by a signed revocation or substitute power of attorney with the USPTO; the USPTO has granted that attorney's withdrawal request; the owner/holder has filed a power of attorney appointing him/her in this matter; or the owner's/holder's appointed U.S.-licensed attorney 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.

Mailing Address: ERIN S. HENNESSY
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Serial Number: 87958992

Internet Transmission Date: Wed Nov 13 19:47:31 EST 2019

TEAS Stamp: USPTO/RFR-XX.XXX.XXX.XXX-201911131947314

66390-87958992-700c289f6322af6c4c35620b9

7c1a2c7a2138869cb855d18be9ece33e453bde30

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RE: BOTCON (Serial No. 87/958,992)

Applicant responds herein to the Office Action issued on May 13, 2019, regarding Applicant's mark, BOTCON ("Applicant's Mark"), and addresses the examiner's partial refusal to register Applicant's Mark based on descriptiveness.

I. Applicant's Mark is Not Merely Descriptive.

The Examining Attorney states that Applicant's Mark is merely descriptive of Applicant's services in Class 35 and Class 41 and, therefore, refuses registration these services. Applicant respectfully disagrees and submits that, for the reasons provided below, the term BOTCON is not merely descriptive, but is, rather, suggestive of the services covered in the application and that, as such, the Examining Attorney's refusal should be withdrawn.

The Examining Attorney argues that Applicant's Mark will be interpreted by relevant consumers to mean "robot convention." In support of his position, the Examining Attorney provides dictionary references for the root words of Applicant's Mark, "BOT" and "CON," and then combines those definitions in order to come up with a understanding of Applicant's relevant services in Classes 35 and 41. Applicant notes that the dictionary references provided by the Examining Attorney contain multiple meanings and that the Examining Attorney had to use clever and creative thought processes and multi-stage reasoning in order to arrive at such a conclusion which goes against a finding that the term BOTCON is descriptive of Applicant's services¹.

Applicant's Mark is subject to the "anti-dissection" rule and its meaning should not be derived "from its elements separated and considered in detail." See *Estate of P.D. Beckwith, Inc. v. Comm'r of Patents*, 252 U.S. 538, 545-46 (1920); see also 2 McCarthy on Trademarks and Unfair Competition § 11:27 (5th ed.). For example, in *Citibank, N.A. v. Citibanc Group, Inc.*, the Eleventh Circuit held that the mark CITIBANC was not descriptive but was suggestive of a "modern or urban bank." 724 F.2d 1540, 1545 (11th Cir. 1984). Individually, the terms "city" or "citi" and "bank" are arguably descriptive. Yet when combined as a single mark, the court construed the combined terms to be suggestive — requiring some degree of thought or perception to reach a conclusion as to the nature of the covered goods or services. Likewise, the word BOTCON is suggestive of Applicant's goods and services.

Applicant submits that the coined term BOTCON is a unitary mark that is not merely descriptive of the covered services. A mark comprising a combination of merely descriptive components is registrable if the combination of terms creates a unitary mark with a non-descriptive meaning, or if the composite has an incongruous meaning as applied to the goods or services. See *In re Colonial Stores Inc.*, 394 F.2d 549, 157 USPQ 382 (CCPA 1968) (SUGAR & SPICE for "bakery products"); *In re Shutts*, 217 USPQ 363 (TTAB 1983) (SNO-RAKE for "a snow removal hand tool having a handle with a snow-removing head at one end, the head being of solid uninterrupted construction without prongs").

¹ "[I]f one must exercise mature thought or follow a multi-stage reasoning process in order to determine what product or service characteristics the term indicates, the term is suggestive rather than merely descriptive." *In re Tennis in the Round, Inc.*, 199 USPQ 496, 497 (TTAB 1978).

Customers cannot make any instantaneous association of the meaning of Applicant's Mark because the coined term "BOTCON" is a fictionalized, made-up word.

Based on the foregoing, as well as the positions maintained in its earlier response to the Examiner's Office Action dated April 9, 2019, Applicant requests that the Examining Attorney withdraw his descriptiveness refusal for Classes 35 and 41 and that the subject application be moved forward to publication.