

Note To The File

Serial Number: 97711013
Date: 09/21/2023 11:24 am
Created by: Nathan Burcham

ESCALA

Changed

- Issued Examiner's Amendment and Entered Changes

Discussed file with Attorney/Applicant

- via E-Mail

From: Bethany Whelan <bwhelan@dority-manning.com>

Sent: Thursday, September 21, 2023 11:19 AM

To: Burcham, Nathan <Nathan.Burcham@uspto.gov>

Cc: Laura Hensel <lhensel@dority-manning.com>

Subject: RE: AGX-423-TM - Examiner's Amendment Due 9/20 by 5pm- : Trademark Application, ESCALA, Serial No. 97711013--Issues with Identification and Translation

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Dear Nathan,

Thank you again for your prompt response. I have spoken with the client, and they agree with your assessment. As such, we will select Option 2.

- Option 2: Please change the ID (consistent with the language above) and also add the Translation statement via Examiner's Amendment so that the application can proceed toward Publication very soon.

Please contact me with any further questions.

Best,

Bethany Whelan

Dority & Manning, P.A.

[\(864\) 271-1592](tel:(864)271-1592)

dority-manning.com

From: Burcham, Nathan <Nathan.Burcham@uspto.gov>

Sent: Thursday, September 21, 2023 1:54 PM

To: Bethany Whelan <bwhelan@dority-manning.com>

Cc: Laura Hensel <lhensel@dority-manning.com>

Subject: RE: AGX-423-TM - Examiner's Amendment Due 9/20 by 5pm- : Trademark Application, ESCALA, Serial No. 97711013--Issues with Identification and Translation

Thanks, Bethany.

Identification

I took another look and I am willing to accept your previously proposed wording for 007:

Semiconductor **substrate** processing equipment, namely, processing chambers for semiconductor substrates for carrying out materials removal processes and surface treatment processes~~various processes including~~ etch processes

Translation

For the translation, Spanish is the second most common language in the U.S., and it is literally the language used as the first example in TMEP 1207.01(b)(vi)(B) for when an ordinary American purchaser would stop and translate a common/modern foreign language in a mark. Applicant may not have been aware of the Spanish word “escala” when they came up with their branding, but that is not the standard for when a Translation is necessary for a trademark application. The TMEP states that an ordinary American purchaser would stop and translate this wording as Spanish wording, so the Translation statement needs to be added in this circumstance. See TMEP 809 and 1207.01(b)(vi)(B).

I already searched the word “SCALE” and did not find any conflicting marks for purposes of a likelihood of confusion determination. I hope applicant understands that adding a translation statement actually *broadens* (not narrows) the protection of their mark against future marks involving

the word “scale” that might be similar. It seems so strange to me that applicant would want to pay attorney fees to fight this particular issue when the TMEP seems so clear that a translation is required.

Next Steps

If applicant agrees to the translation now, the next step is for me to recommend Publication *asap*. If applicant does not agree to the translation, I think it could take years (and, I assume, lots of attorney fees) for the office actions, responses, and ultimately an appeal to conclude before Publication. And even then, I think the TTAB is highly likely to side with requiring a Translation.

Just to make sure I understand, please clarify which option applicant is choosing:

- Option 1: Please change the ID (consistent with the language above) via Examiner’s Amendment and issue an Office Action on the Translation issue. This option could take years to resolve if applicant does not change its position on the Translation issue.
- Option 2: Please change the ID (consistent with the language above) and also add the Translation statement via Examiner’s Amendment so that the application can proceed toward Publication very soon.

Thanks,

Nathan D. Burcham (he/him)

Trademark Examining Attorney, Law Office 301

U.S. Patent and Trademark Office

nathan.burcham@uspto.gov

571-270-0486

Please note that all relevant e-mail communications will be placed in the official application record. Although the trademark examining attorney may provide additional explanation pertaining to the application, the trademark examining attorney may not provide legal advice or statements about applicant’s rights. See TMEP §§705.02, 709.06.

From: Bethany Whelan <bwhelan@dority-manning.com>

Sent: Thursday, September 21, 2023 10:03 AM

To: Burcham, Nathan <Nathan.Burcham@uspto.gov>

Cc: Laura Hensel <lhensel@dority-manning.com>

Subject: RE: AGX-423-TM - Examiner's Amendment Due 9/20 by 5pm- : Trademark Application, ESCALA, Serial No. 97711013--Issues with Identification and Translation

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Hi Nathan,

Thank you for your prompt email. Regarding the goods and services, I'm not sure your proposal is acceptable as they would like to remove the word "etch". An etch process in and of itself is a material removal process and they would like to pursue such language. However, if removing "etch" is not possible then please advise.

Also, while I agree with your stance on the translation issue, unfortunately, the client is of the opinion that they have coined the term ESCALA. So, it seems an office action is inevitable.

Thank you again for your correspondence regarding this matter.

Best,

Bethany Whelan

Dority & Manning, P.A.

(864) 271-1592

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From: Burcham, Nathan <Nathan.Burcham@uspto.gov>

Sent: Thursday, September 21, 2023 11:44 AM

To: Bethany Whelan <bwhelan@dority-manning.com>

Cc: Laura Hensel <lhensel@dority-manning.com>

Subject: RE: AGX-423-TM - Examiner's Amendment Due 9/20 by 5pm- : Trademark Application, ESCALA, Serial No. 97711013--Issues with Identification and Translation

Thanks for the email, Bethany.

Identification

I don't think we can accept applicant's suggested wording as-is, but I have a small addition that I think will make it work.

Does applicant agree to this wording (newest wording **underlined**)?

- International Class 007: Semiconductor **substrate** processing equipment, namely, processing chambers for semiconductor substrates for carrying out **etch processes in the nature of materials removal processes and surface treatment processes**

Translation

Even if applicant did not intend to use a Spanish word as their mark, the letters they chose for the mark do form a common Spanish word according to multiple translation sources I found.

- [escala | translate Spanish to English - Cambridge Dictionary](#)
- [English Translation of "escala" | Collins Spanish-English Dictionary \(collinsdictionary.com\)](#)
- [Escala | Spanish to English Translation - SpanishDictionary.com](#)

If applicant does not agree to add a translation via Examiner's Amendment, I will plan to issue an Office Action requiring the translation statement. That will delay any potential publication of this trademark.

Does applicant agree to add the following translation statement?

The English translation of "ESCALA" in the mark is "SCALE".

Thanks,

Nathan D. Burcham (he/him)

Trademark Examining Attorney, Law Office 301

U.S. Patent and Trademark Office

nathan.burcham@uspto.gov

571-270-0486

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From: Bethany Whelan <bwhelan@dority-manning.com>

Sent: Thursday, September 21, 2023 8:12 AM

To: Burcham, Nathan <Nathan.Burcham@uspto.gov>

Cc: Laura Hensel <lhensel@dority-manning.com>

Subject: RE: AGX-423-TM - Examiner's Amendment Due 9/20 by 5pm- : Trademark Application, ESCALA, Serial No. 97711013--Issues with Identification and Translation

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Hi Nathan,

Thank you for providing the email below. Regarding the goods and services description, the client would propose the following amendment:

International Class 007: Semiconductor **substrate** processing equipment, namely, processing chambers for semiconductor substrates for carrying out materials removal processes and surface treatment processes~~various processes including~~ etch processes

Regarding translation for ESCALA, the client asserts that ESCALA is not derived from the Spanish word for scale and it is purely fanciful.

Please let me know if you have any questions. If you would like to discuss my cell is (859) 221-897.

Thanks,

Bethany Whelan

Dority & Manning, P.A.

[\(864\) 271-1592](tel:(864)271-1592)

dority-manning.com

From: Burcham, Nathan <Nathan.Burcham@uspto.gov>

Sent: Monday, September 18, 2023 6:33 PM

To: Docket Mailbox <docketing@dority-manning.com>; Laura Hensel <lhensel@dority-manning.com>; Sarah Duggan <sduggan@dority-manning.com>

Subject: Trademark Application, ESCALA, Serial No. 97711013--Issues with Identification and Translation

Dear Bethany A. Whelan,

Hello, my name is Nathan Burcham and I am an examining attorney with the U.S. Patent and Trademark Office. I am reviewing the trademark application for ESCALA, Serial No. 97711013, by owner MATTSON TECHNOLOGY, INC. I'd like to discuss the issue(s) below that can be resolved with applicant's agreement via email instead of an official Office action.

Please respond by 5pm EST on Wednesday, September 20, 2023.

1. Identification of Goods Amendment

The wording of the identification needs to be amended because it needs to be more specific. In particular, the overly inclusive wording "various processes" needs to be removed. Additionally, the type of semiconductor device/component should be specified.

I suggest amending the identification to (changes in **bold**):

International Class 007: Semiconductor **substrate** processing equipment, namely, processing chambers for semiconductor substrates for carrying out ~~various processes including~~ etch processes

Is this identification amendment acceptable to you?

1. Translation Statement

I found evidence that the word "ESCALA" in the applied-for mark is a Spanish word that translates as "Scale" in English. You must provide a translation statement of this foreign wording.

I suggest adding the following statement to the record:

The English translation of "ESCALA" in the mark is "SCALE".

Is the addition of this translation into your application acceptable to you?

Please respond regarding whether applicant agrees to the change(s) discussed above. If you agree, I can make the change(s) to the application on my end through Examiner's Amendment and continue processing the application. You do not need to take any further action in regards to any agreed change(s), and you will receive a copy of the changes once they are entered. For more information about the timeline of your application, please visit http://www.uspto.gov/trademarks/process/tm_timeline.jsp.

If you would prefer, I would be happy to discuss this over the telephone at the number listed below. If you have any questions, please let me know.

Thanks,

Nathan D. Burcham (he/him)

Trademark Examining Attorney, Law Office 301

U.S. Patent and Trademark Office

nathan.burcham@uspto.gov

571-270-0486

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