

Magic and design - SN 88/342,265

Miscellaneous Statement

The further Office Action of the Patent and Trademark Office, dated October 24, 2019, has been carefully reviewed.

As the Office Action has been marked final, it would be appreciated if the Amendment can be taken up as early as possible.

1. Description of the Mark

In the application as filed, applicant described the instant mark the same way that the Office did in the 2012 registration of the same mark, registration 4215750. However, in response, the Patent and Trademark Office proposed a re-written description of the mark.

In an amendment, Applicant noted two errors in the proposed re-written description and corrected them. The Examiner has now noted a third in the proposed re-written description (use of "41" rather than the "47" that appears in the drawing). The Examiner requests that it, too, be corrected. Applicant has done so. The final description accordingly reads:

The mark consists of a stylized representation of a periodic table element comprised of a square with the numbering "47" in the upper-left corner and the numbering "107.86" in the lower-right corner. The stylized word "MAGIC" overlays the square with the lettering "AG" in the aforementioned word displayed in a different font.

As previously noted, if it should come time to determining whether there is a conflict between design marks, the Trademark Board's Long John Silver's case provides that the issue "must come down to a subjective 'eyeball' test." Long John Silver's, Inc. v. Lou Scharf Inc., 213 USPQ 263, 270 (TTAB 1982).

## 2. Description of Goods

Applicant appreciates the Examiner's efforts to help prepare a final description of goods for this application. To date, the Examiner has not accepted any class description of goods that appeared in applicant's First Amendment, except for the description of class 9, so that further amendment by applicant is appropriate for the remaining classes.

Applicant notes that a special rule for avoiding the reinvention of the wheel problem in the preparation of a final description of goods is directly embedded in the Trademark Manual, which prescribes the following to reduce the workload of Examiners and applicants:

"If a companion application [co-pending applications filed by the same applicant] has been published for opposition or has registered, the examining attorney may presume that the classification and identification of goods or services in the companion application or registration are acceptable, unless the identification or classification is clearly wrong. TMEP § 702.03(a)(iv)

The instant application is, in fact, a companion application, co-pending with applicant's US

application 88419635 (MAGIC - no design) which is being published for opposition on April 14, 2020.

Applicant has added the following phrase at the end of the description for each class of goods because the design of the instant mark (but not the mark of application 88419635) suggests the appearance of the entry for the element "silver" in the Periodic Table of Elements:

"all of the aforesaid goods made in significant part of silver"

This phrase appeared at the end of the description of goods for each class in the earlier Magic and design registration, number 4215750.

Accordingly, leaving the class 9 description as is, please amend the description of goods for the remaining classes to correspond to the description in the companion application 88419635, coupled with the above final phrase:

IC 001: Chemicals for use in industry and science; chemical products for use in connection technology; chemical agents for hardening, soldering and sintering metals; adhesives for industrial purposes, conductive adhesives for industrial purposes; conductive pastes for industrial purposes for further use in the manufacture of electronic components; all of the aforesaid goods made in significant part of silver.

IC 006: Metal pastes, namely, solder pastes; solder pastes; conductive pastes, namely, solder paste; all of the aforesaid goods made in significant part of silver.

IC 009: Electrical conductors, namely, metal paste for use in the manufacture of electronic devices; electric contact materials with a precious metal base for use in the manufacture of electronic devices, namely, electrical components in the nature of electric contactors; all the aforesaid goods made in significant part of silver

IC 014: Precious metals, precious metal alloys, and precious metal compounds, in particular for connection technology; precious metals; precious metal alloys and precious metal compounds in the form of powders and pastes made from these powders used in manufacturing, all for use in manufacturing electrical and electronic components; precious metal compounds in the form of powders and pastes made from these powders used in manufacturing, all for further manufacturing, but not for use in painting, decorating, printing, art or in manufacturing jewelry; all of the aforesaid goods made in significant part of silver.

### 3. Filing Basis

The purpose of submitting applicant's home (EU) registration with its first amendment was to convert the basis of the instant application to an application under section 44(e) of the trademark statute. Such submission had nothing to do with the identification of goods herein.

Please note that should the Examiner conclude that the documentation on file is insufficient to support such conversion, then the instant application should remain a 1(b) application.

Applicant reserves the right to update the basis by Petition once the application has passed through the publication stage.

In any event, applicant notes that it has already submitted with the First Amendment herein (a paper filing) and submits again with this Second Amendment:

1. "A true copy, a photocopy, a certification, or a certified copy of the registration in the country of origin of the applicant," as required by 15 U.S.C. §1126(e), namely a "true copy" of its home registration, number 009247231,

2. It has supplemented that submission with a printout from the EU Intellectual Property Office's website records showing that the current owner of that home registration is, in fact, Heraeus Deutschland GmbH & Co KG, the instant US applicant. (Page 2 of 4 of the EUTM "file information" for the registration, under the heading "Owners", and

3. With this Second Amendment, applicant is additionally submitting a copy of the Official letter dated February 3, 2015 from the European Patent and Trademark Office confirming the change in ownership of the above EU registration (009247231 -- the second one listed in the letter) on the records of the European Patent and Trademark Office to Heraeus Deutschland GmbH & Co KG, and a translation of such Official letter.

Applicant notes that the registration itself shows that the mark of the instant application has been

\* registered in applicant's home country and that

\* the registration is in full force and effect.

The website printout and the Official letter have been added merely to show that the current owner of the home registration is the US applicant herein.

See TMEP §1306.02(a)(iv) which indicates that a home country's intellectual property website printout can be used as a document helping to support a section 44(e) basis, although such a printout

"is not, by itself, sufficient to establish that the mark has been registered in that country and that the registration is in full force and effect." (emphasis added)

Here, both of these matters have already been satisfied by the filing of a true copy of the home registration.

#### 4. Multi-class Application

As finally amended, the description of goods has four classes. Applicant has already paid the filing fees for four classes.

As the Examiner has searched the Office records and concluded that there is no third party mark that conflicts, publication of the instant application with a section 44(e) basis is requested.

Should the Examiner conclude that the documents on file are insufficient to support conversion of this application to one based on section 44(e), then the application should be published as one under section 1(b).

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