

APPLICANT'S SUBSTANTIVE RESPONSE TO OFFICE ACTION

The following is the substantive response of the Applicant, Digital Dynamics, Inc., by Counsel, to the Office Action sent via email on October 11, 2013.

SEARCH OF OFFICE'S DATABASE OF MARKS

The search by the Office and the finding of no conflicting marks is noted.

SECTION 2e(1) REFUSAL

The Examining Attorney has refused registration of the proposed mark pursuant to Trademark Act Section 2(e)(1), 15 U.S.C. § 1052(e)(1), on the grounds that the applied-for mark merely describes the quality of applicant's goods and/or services. For the following reasons, the Applicant respectfully disagrees.

The Applicant notes that it seeks registration of its mark for various controller systems, controllers, control systems, embedded systems, interface modules, and control modules. In this respect, the Applicant submits that its mark does not merely describe the Applicant's goods but instead is suggestive of them.

TMEP 1209.01(b) states:

The determination of whether a mark is merely descriptive must be made in relation to the goods or services for which registration is sought, not in the abstract. In re Chamber of Commerce, 675 F.3d at 1300, 102 USPQ2d at 1219; In re Bayer, 488 F.3d at 964, 82 USPQ2d at 1831. This requires consideration of the context in which the mark is used or intended to be used in connection with those goods/services, and the possible significance that the mark would have to the average purchaser of the goods or services in the marketplace. See In re Chamber of Commerce, 675 F.3d at 1300, 102 USPQ2d at 1219; In re Bayer, 488 F.3d at 964, 82 USPQ2d at 1831; In re Omaha Nat'l Corp., 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987); In re Abcor Dev. Corp., 588 F.2d 811, 200 USPQ 215 (C.C.P.A. 1978); In re Venture Lending Assocs., 226 USPQ 285 (TTAB 1985).

The Applicant submits that the applied-for mark is intended for use with the goods as amended and is suggestive of the goods and not merely descriptive. As noted in TMEP 1209.01(b), the significance of the mark to the average purchaser of the goods should be considered. Because the purchaser of industrial equipment, semiconductor manufacturing equipment and controller systems is very sophisticated, such a purchaser does research and evaluation of the goods before making a purchase. The purchaser would not view the mark SUPERIOR as laudatory or descriptive of the goods, but suggestive. "Suggestive marks are those that, when applied to the goods or services at issue, require imagination, thought, or perception to reach a conclusion as to the nature of those goods or services. Thus, a suggestive term differs from a descriptive term, which immediately tells something about the goods or services." TMEP 1209.01(a). Accordingly, the Applicant respectfully submits that the applied-for mark is suggestive.

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Therefore, the Applicant respectfully requests that the Examining Attorney reconsider the refusal and allow the Applicant's mark to proceed to publication.

APPLICANT'S CO-PENDING APPLICATION

The Applicant informs the Examining Attorney of a co-pending application for an applied-for mark SUPERIOR (stylized) in application 86-077295.

CONCLUSION

In view of the above, the subject application is believed in condition for approval and publication, and action to that end is respectfully solicited. As such, the Applicant respectfully requests reconsideration of the instant trademark application.

If the Examining Attorney believes that a telephonic interview will help speed registration of the mark currently under consideration, the Examining Attorney is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,

Date: April 10, 2014

/Edward B. Weller/

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