

The subject Office Action raises two issues regarding the subject application. Applicant respectfully traverses as follows, and requests reconsideration based on the following arguments and attached supporting materials.

### **FIRST ISSUE: MARK ON DRAWING ALLEGEDLY DIFFERS FROM SPECIMEN OF USE**

Registration has been initially refused because the specimen allegedly does not show the applied-for mark in the drawing in use in commerce in International Class 10. Such initial position is based on the PTO determination that:

“The mark on the drawing is ADVANTAGE, and the mark on the specimen is M.C. ADVANTAGE SERIES.”

The PTO’s position is respectfully traversed, because the mark in the original drawing is a substantially exact representation of the mark on the original specimen. Therefore, Applicant has provided the required evidence of use of the applied-for mark in commerce on or in connection with Applicant’s goods.

The only two instances where the specimen utilizes the subject mark “ADVANTAGE” are repeated below.

**M.C. ADVANTAGE - SERIES LOW BEDS**

**MC ADVANTAGE SERIES - LOW BEDS**

Despite such fact, the PTO views the materials in context to say that the mark is in fact “M.C. ADVANTAGE SERIES.” In other words, **the PTO uses context** to make an assertion that the mark does **not** include the “- LOW BEDS” portion of the phrasing which appears on the specimen in proximity with the term “ADVANTAGE”. Note that in one instance, the phrasing appears “- SERIES LOW BEDS” and in another “SERIES – LOW BEDS.” Such fact supports the view that the PTO is being highly selective of its choices regarding “context.”

Respectfully, the use of context is appropriate, but the PTO is improperly interpreting the subject original specimen by only **partly** considering its **full context**.

Specifically, the abbreviated phrasing “M.C.” (or “mc”) otherwise appears a total of **seven times** on the two page specimen. Clearly, an ordinary consumer would recognize that “M.C.” (and “mc”) in such context is a division name, distinct from a series or specific product trademark with which it is combined. Similarly, when a customer encounters a “Chevrolet Impala”, they understand that “Chevrolet” is a division of General Motors, while “Impala” is the mark of a particular model.

Properly interpreted in complete context, Applicant submits that the original specimen of record properly supports use of the subject mark “ADVANTAGE” in commerce for the subject goods.

The PTO also takes the view that the subject piece is merely an advertisement. The original submissions of record establish that the materials, however referenced, are included with the subject goods as shipped in commerce. This means that the goods are already sold, and therefore the accompanying materials bearing the subject mark are in fact appropriate use as a mark, and not merely advertising.

Accordingly, reconsideration and withdrawal of such initial refusal grounds are requested.

### **SECOND ISSUE: ALLEGED EARLIER-FILED APPLICATION**

The subject Office Action reported clear search results insofar as registrations are concerned but noted an earlier filed application USSN 86/703,008. The subject Office Action further states in pertinent part:

“Applicant’s election not to submit arguments at this time in no way limits applicant’s right to address this issue later if a refusal under Section 2(d) issues.”

Accordingly, Applicant reserves at this time the possibility of submitting arguments should a refusal under Section 2(d) eventually issue, and otherwise requests suspension of the subject application pending completed action on such pending USSN 86/703,008.