

## RESPONSE TO OFFICE ACTION

### I. Introduction

This responds to the non-final Office Action mailed March 14, 2019 concerning Application Ser. No. 88/223,698 for the mark HAMILTON NG911 (the “**Mark**”). The Examining Attorney has: (1) requested amendments to the identification of services and (2) refused registration of the Mark on the ground that the Mark is primarily merely a surname. Each of these issues is addressed in this response.

### II. Identification of Services

Please amend the identification of services as follows:

Class 38: Telephone, text, and video messaging services for public safety and emergency communications; telecommunication services, namely, transmission of local and long distance voice, data, video, graphics and text messages via telephone, satellite or internet transmission; ***providing managed network services, namely, providing access to an IP (Internet Protocol) network***; telecommunications services, namely, routing calls to emergency services providers and transmitting civic location information or geo-coordinates

The Examining Attorney has indicated that the original wording, “providing IP (Internet Protocol) network management services” was indefinite and must be clarified because the exact nature of the services is unknown. Per discussion between the Examining Attorney and Applicant’s counsel, Applicant believes the above amendment resolves the Examining Attorney’s concerns.

### III. Surname Refusal

#### *A. HAMILTON NG911 is not Primarily Merely a Surname*

Applicant disagrees that HAMILTON NG911 is primarily merely a surname. The Examining Attorney has summarily concluded that HAMILTON is a surname, and that the addition of the descriptive term NG911. The Examining attorney provided a few Internet

printouts purporting to show the surname significance of HAMILTON. This limited evidence is insufficient to demonstrate that the Mark is primarily merely a surname.

As a preliminary matter, Applicant notes that there are over 220 active applications and registrations for marks consisting of or comprising HAMILTON, a number of which are registered on the Principal Register without a disclaimer of the wording HAMILTON and without a claim of acquired distinctiveness. These include registrations for the word mark HAMILTON covering a variety of goods and services, such as: 1) horological and chronometric instruments, namely, watches; 2) various laboratory and special professional furniture; 3) metal casters, wheels, non-motorized floor trucks and structural parts therefor; and 4) laboratory and scientific equipment and design, research and development and consulting services, in addition to several registrations or allowed applications for HAMILTON combined with a descriptive (and disclaimed) wording, including HAMILTON SORTER, HAMILTON SCIENTIFIC, HAMILTON METALS, HAMILTON MALL, HAMILTON EGGS, and HAMILTON CASKETS. Registration certificates or TSDR information for these registrations and allowed applications are attached as composite **Exhibit A**. These registrations and allowed applications support that HAMILTON NG911 would not be viewed as primarily merely a surname, and should therefore be allowed to proceed to registration.


*B. "HAMILTON" as used in HAMILTON NG911 has Acquired Distinctiveness.*


While the Applicant disagrees that HAMILTON NG911 would be viewed as primarily merely a surname, in the interest of advancing prosecution of the Application the Applicant has also submitted a claim of acquired distinctiveness, in part, as to "HAMILTON" based on Applicant's ownership of Registration Nos. 3745242, 5566040, and 2071400.

i. The Mark has Become Distinctive Based on Prior Registrations for the Same Mark.

There are three basic types of evidence an Applicant can rely on to establish a claim of acquired distinctiveness in part. TMEP § 1212.02(f)(i). One is a claim of ownership of one or more active prior registrations on the Principal Register of the relevant portion of the mark for goods or services that are sufficiently similar to the goods or services in the pending application. *Id.*; 37 C.F.R. §2.41(a)(1). The previously-registered mark must be the legal equivalent of the relevant portion of the mark which is claimed to have acquired distinctiveness. TMEP § 1212.04(b). The registered mark is the legal equivalent when it creates the same, continuing commercial impression, such that consumers would consider them both the same mark. *Id.*

In this case, the wording “HAMILTON” in the mark has become distinctive of telecommunications and Internet-related services as evidenced by ownership of active U.S. Registration Nos. 3745242, 5566040, and 2071400 on the Principal Register for the same mark for sufficiently similar goods and/or services. Below is a summary of the relevant wording in the prior marks:

TM/AN/RN/Disclaimer	Selected Goods/Services
HAMILTON RN: 3745242	(Int'l Class: 38) providing local and long distance telephone service; providing electronic transmission of information to persons who are deaf or hearing impaired via the internet, telephones and wireless devices; telecommunications relay services, namely, providing telephone services, such as, internet relay, wireless relay or captioning; leasing of telecommunications equipment, namely, telephones, facsimiles and other communications equipment; internet service provider; providing internet telephony services; providing mobile internet access; consulting in the field of telecommunications
HAMILTON WIRELESS and Design  RN: 5566040 Disclaimer: "WIRELESS"	(Int'l Class: 38) providing multiple user wireless access to the internet; telecommunication services, namely, providing internet access via broadband optical or wireless networks; wireless broadband communication services; wireless electronic transmission of data

TM/AN/RN/Disclaimer	Selected Goods/Services
HAMILTON TELECOMMUNICATIONS and Design    RN: 2071400 Disclaimer: "TELECOMMUNICATIONS"	(Int'l Class: 38) telecommunications services, namely, providing local and long distance telephone service and relay service for the hearing impaired

“HAMILTON” is identical to the wording in the mark registered in Registration No. 3745242, and is incorporated in its entirety in the marks registered in Registration Nos. 5566040, and 2071400. Consumers would not perceive the differences in the generic or descriptive wording NG911, TELECOMMUNICATIONS, or WIRELESS as material in this case because the addition of descriptive or generic terms such as these typically does not alter the commercial impression of a mark. *See e.g.* 1207.01(b)(iii). Instead, consumers likely would view the wording as a whole as creating the same commercial impression. *See, e.g., In re Best Products Co.*, 231 U.S.P.Q. 988, 1986 WL 83753, at \*1 fn. 6 (T.T.A.B. 1986) (Applicant’s partial Section 2(f) claim as to “BEST” as used in BEST JEWELRY & Design was accepted based entirely on Applicant’s ownership of the registrations for BEST & Design and BEST PRODUCTS).

Similar to *In re Best Products Co.*, where the different generic or descriptive wording PRODUCTS in the prior registration did not preclude the transfer of acquired distinctiveness, Applicant’s use of and partial claim of acquired distinctiveness for “HAMILTON” in the applied-for mark is appropriate and should be accepted.

*ii. The Acquired Distinctiveness will Transfer.*

The Applicant must show that the acquired distinctiveness of a mark or portion of a mark will transfer to the goods or services in an intent-to-use application once use commences. *In re Rodgers* sets out the relevant test, which requires that the applicant show that: 1) the same mark

has acquired distinctiveness in connection with other goods and/or services; and 2) the goods or services with which there is an intent-to-use the mark are sufficiently related such that there is a high likelihood that the distinctiveness will transfer. 53 U.S.P.Q.2d 1741, 1744 (T.T.A.B. 1999); *see* TMEP §1212.09.

Based on Applicant's prior registrations for HAMILTON and HAMILTON-formative marks on the Principal Register, as discussed in more detail above, Applicant submits that it has met the first prong of the test.

With respect to the second prong of the test, the Applicant submits that the goods and services in the instant application are sufficiently related to Applicant's services covered by its prior registrations. It is self-evident that Applicant's services in the application are either identical or closely related to Applicant's telecommunications, telephone, and internet services covered by its prior registrations. The subject application covers *telecommunications services in the nature of transmission of local and long distance voice, data, video, graphics and text messages via telephone, satellite or internet transmission*, which encompasses services covered by the prior registrations such as *providing local and long distance telephone service; telecommunications relay services, namely, providing telephone services, such as, internet relay, wireless relay or captioning; providing internet telephony services; wireless broadband communication services; wireless electronic transmission of data; and telecommunications services, namely, providing local and long distance telephone service and relay service for the hearing impaired*. The other services are clearly closely related, as evidenced by the fact that many providers of telephone and/or internet services also provide various telecommunications services related to public safety and emergency communications (i.e., 911-related services). This can be seen in the examples from providers Pioneer Telephone, Cox, Xfinity, and Verizon

attached as composite **Exhibit B**. Further, as shown in the attached materials from the Federal Communications Commission (FCC), the FCC requires providers of these types of services, such as wireless carriers or providers of Voice-over-Internet Protocol telephone services, to provide public safety and emergency communications services to their customers in conjunction with providing their primary services. *See Exhibit C*.

In view of the foregoing, Applicant's services in the subject application are either identical to or clearly related to Applicant's registered telecommunications, telephone and internet services such that the acquired distinctiveness "HAMILTON" has obtained for these telecommunications, telephone and internet services will transfer to the services listed in the instant application once use commences. Applicant therefore respectfully submits that Applicant has met the second prong of the *Rodgers* test.

*iii. Conclusion.*

In view of the above, the "HAMILTON" element in the Mark has acquired distinctiveness based on Applicant's prior Registration Nos. 3745242, 5566040, and 2071400. As a result, HAMILTON NG911 is not primarily merely a surname, and Applicant therefore respectfully requests that the refusal on that basis be withdrawn.

**CONCLUSION**

Applicant believes that it has responded to all issues raised in the Office Action and respectfully requests that the application be passed to publication. However, should any questions arise with respect to the application or the issues addressed herein, please contact the undersigned.