

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Application Serial No. 88/299,991
Filing Date February 13, 2019
Applicant Mohr and Associates
Examining Attorney..... Tracy Myers
Law Office 128
Counsel of Record..... Shamus T. O'Doherty
Attorney's Docket No. 45061-28
Mark: MDT

RESPONSE TO OFFICE ACTION

In response to the Office Action dated May 1, 2019, Applicant respectfully submits the following remarks and argument in support of allowing the Application to proceed to publication. This argument will focus on the Specimen Refusal issued by Examiner, while the remaining issues in the Office Action will be addressed in the electronic form Response submitted herewith. This Response relies upon and incorporates the facts provided in the Declaration of Charles Mohr, Ph.D, PE filed herewith. For the reasons indicated herein, favorable action with respect to this Response is respectfully requested.

REMARKS

In the Office Action dated May 1, 2019, the Examining Attorney initially refused the Application arguing that the specimen of use submitted was unacceptable because it did not show the mark as presented in the drawing. The mark as applied for, and presented in the drawing, is the standard characters MDT. The Examiner argues the specimen submitted, a photograph of a product label placed directly on the good, displays the marks MDT-2, but not MDT. The Examiner argues the “-2” element is “inseparable.”

Applicant, by and through its attorney of record, respectfully disagree. As is made clear in the Declaration of Charles Mohr, Ph.D, PE submitted herewith, the “-2” element is a model number which changes depending on which model of the good is being referenced,

while the MDT mark is consistently used in commerce and recognizable to the consumer as the source identifier.

Applicant contends that guidance requires Examiners to grant “some latitude” to an applicant “in selecting the mark it wants to register.” TMEP § 807.12(d). Pursuant to applicable law, an applicant may apply to register any element of a composite mark if that element presents, or will present, a separate and distinct commercial impression apart from any other matter with which the mark is or will be used on the specimen. See, *In re Univ. of Miami*, 123 USPQ2d 1075, 1079 (TTAB 2017).

In relation to model numbers specifically, case law has repeatedly held that specimens which contain model number designations in addition to the applied for mark are acceptable to prove use in commerce. See, *In re Raychem Corp.*, 12 USPQ2d 1399, 1400 (TTAB 1989)(specimen which displayed TR06AI-TINEL-LOCK-RING was acceptable for the mark TINEL-LOCK); *In re Sansui Elec. Co.*, 194 USPQ 202, 203 (TTAB 1977)(specimens which displayed QSE-4 and QSD-4 were acceptable for the marks QSE and QSD). “Even when a part number is joined by a hyphen to other matter which does serve a trademark function, the trademark is registrable without showing the part number as well in the drawing.” *Raychem* at 1400; see also *In re Sansui Electric Co., Ltd.* at 202.

As to the part number and generic term the Board stated that neither is:

... essential to the commercial impression created by the mark as shown in the specimens. Prospective purchasers of these highly technical goods would readily recognize both the part number and the name of the goods as such, and would therefore look only to the trademark ‘TINELLOCK’ for source identification. The fact that hyphens connect both the part number and the generic term to the mark does not, under the circumstances presented by this case, create a unitary expression such that ‘TINEL-LOCK’ has no significance by itself as a trademark.

Id. at 1400.

As is apparent from the detailed goods description, the Applicant's goods are also highly technical and prospective purchasers are highly educated in both the name of the good, the applied for mark, and the model number. Therefore, Applicant respectfully requests the Examining Attorney reconsider and withdraw her original specimen refusal in light of the argument and additional information presented herein (and in the Declaration of Charles Mohr, Ph.D, PE) allowing the Application to appropriately proceed to publication.