

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Moeller Precision Tool, LLC
Serial No.: 88300137
Filing Date: February 13, 2019
Mark: IRH
Class: 7
Attorney File No.: Examining Attorney
Jeane Yoo/Law Office 120

RESPONSE TO OFFICE ACTION

Applicant files this document in response to the Office Action issued April 26, 2019, in connection with the above-captioned U.S. trademark application. Applicant responds as follows:

1. Mark Identifies Model Number:

Applicant respectfully disagrees with the Office's refusal to register the IRH mark based on the suggestion that the mark "merely identifies a model designation" and/or it does not "function as a trademark to identify and distinguish applicant's goods from those of others and to indicate the source of applicant's goods". Applicant requests the Office reconsider its prior determination.

REMARKS

Applicant was, frankly, quite puzzled by the Office's refusal of the mark under Sections 1, 2, and 45 of the Trademark Act. Over the past two (2) years, the Office has issued, not one or two, but six (6) registrations to Applicant for: (1) very similar marks; (2) used with very similar goods; and (3) accepted very similar specimens when doing so. And, in none of those cases did the Office even mention a possible refusal under Sections 1, 2, and 45. For example, the Office issued Applicant a registration for MEC (Reg. No. 5,669,007) in Class 7 for "metalworking machine tools, namely, punches for use with punching machines." The Office also issued Applicant a registration for MRH (Reg. No. 5,632,865) in Class 7 for "machine tool holders". Other registrations included IEC, ISC, MDC, and MHC. Copies of the applicable certificates are included as **Exhibit A**. Give this history, the Office's refusal in this case is inconsistent and a tad unfair.

Several years ago the Office launch the "Consistency Initiative" to address "the occasional instances of inconsistent practice within the Office and to promote overall high quality examination." In fact, the first example cited in the Consistency Initiative document is for Non-ID-Related Requests and situations where

the “Office has acted inconsistently in its treatment of applicant’s pending applications/recent registration.” A copy of the Office’s Consistency Initiative is attached as **Exhibit B**.

This refusal is one of those occasional instances where the Office has acted inconsistently, especially in light of the fact that the Office had already issued to Applicant registrations for similar three-letter marks, used with similar goods, as documented by the similar types of specimen submitted in each case.

The Office is also kindly reminded that if a mark both identifies a model or grade designation and serves as a trademark, a refusal should not issue. *See Ex parte Eastman Kodak Co.*, 55 USPQ 361, 362 (Comm’r Pats. 1942). Applicant claims use of the applied-for-mark for nearly three (3) decades, and the Office has not supplemented its refusal with any evidence from competitor’s websites or other research indicating how the IRH mark is used in Applicant’s industry. *See TMEP 1202.16(b)(ii)*.

For the reasons stated above, Applicant respectfully requests that the Office withdraw its refusal and allow Serial No. 88300137 to proceed to Publication.