

189462-5011

TRADEMARK

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Drägerwerk AG & Co. KGaA : Trademark Law Office 120
Mark: X-PID : Trademark Attorney Grace Duffin
Serial No.: 88/328,097 :
Filed: March 6, 2019 :

ELECTRONICALLY FILED ON NOVEMBER 14, 2019

RESPONSE TO OFFICE ACTION

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451
S I R:

In response to the Office Action dated May 16, 2019, please reexamine the application in view of the remarks provided below.

REMARKS

A. Office Action

The applicant seeks to register the mark X-PID for “gas detection device in the nature of gas detectors for detecting the presence of gas” (as amended), in International Class 9. The Office Action has refused registration under Trademark Act Sections 1, 2, and 45, 15 U.S.C. §§1051-1052, 1127, because the applied-for mark X-PID as used on the filed specimen does not function as a trademark to indicate the source of the applicant’s goods and to identify and distinguish them from others. The Office Action alleges that the applied-for mark as shown on the specimen does not function as a trademark because the mark is so ingrained into the writing

on the back of the applicant's device, that a consumer will not pull it out and view it as a source identifier. The Office Action has also refused registration under Trademark Act Sections 1 and 45, 15 U.S.C. §§1051, 1127, because the specimen does not show the mark in the drawing in use in commerce. The Office Action alleges that the applied-for mark X-PID is displayed in the specimen as Dräger X-pid 000/95000. The Office Action provides that a substitute specimen of use showing the mark in the drawing in actual use will satisfy as a response to the Office Action. Alternatively, the Office Action provides that the applicant can request an amendment to its filing basis. The applicant respectfully submits that the applied-for mark X-PID is displayed in the filed specimens as depicted in the drawing and functions as a trademark.

B. Arguments

1. Mark X-PID Functions as a Source Identifier and Trademark

A designation functions as a mark depending on the commercial impression it makes to the relevant public. The question becomes: would the purchasers likely regard the mark as a source-indicator for the goods?

The applicant's product is a handheld gas detection device. The device is not conducive to a large printing of the mark X-PID on the product. On the back of the applicant's device, there is a place to indicate specific necessary product and safety regulatory requirements, including the product name. While the X-PID mark appears in small letters between the applicant's house mark/company name "Dräger" and the model designation "000/9500," the mark appears prominently in the upper left-hand corner, leading the user and purchaser of the product to see and read the product name first, and then take note of the necessary product and safety regulatory text. In addition, the applicant's mark appears twice on the product, on the back and on the front screen, further providing a user and purchaser of the product to know that they are using the X-PID gas detection product of Dräger. The applicant submits as Exhibit A hereto, as additional evidence that the applicant's X-PID designation functions as a trademark, product literature for its various X-PID gas detection devices. The product literature certainly provides that the X-PID mark would be considered a source-identifier by the relevant consumers.

2. Specimen Shows Use of X-PID Mark in Commerce

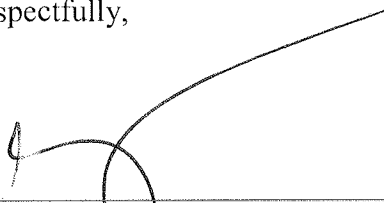
A specimen sometimes shows a possible model or grade designation that is not included on the drawing for the mark. Thus, the mark on the drawing and specimen will appear to disagree. TMEP § 1202.16(c)(iv). An Examining Attorney must refuse registration under §§ 1 and 45 if it is unclear whether the additional matter on the specimen with the mark is a model or grade designation. If the additional matter on the specimen is not part of the mark and is merely used as a model or grade designation, an applicant may respond to the refusal to register by providing: 1) a statement that the matter is merely a model or grade designation; and 2) evidence showing use of the proposed mark with other similar notations or evidence clearly showing that the matter is merely a model or grade designation. *In re Raychem Corp.*, 12 USPQ2d 1399, 1400 (TTAB 1989) (holding the mark TINEL-LOCK on the drawing page to agree with the wording TR06AI-TINEL-LOCK RING appearing on the specimen where the notation TR06AI was merely a part or stock number, as supported by a submitted brochure that explained that each letter and number in the notation represented a specific type, size, and feature of the part, and the term RING was generic for the goods); *In re Sansui Elec. Co.*, 194 USPQ 202, 203 (TTAB 1977) (holding the marks “QSE” and “QSD” on the drawing to agree with the wording “QSE-4” and “QSD-4” appearing on the specimens, where the notation “4” was merely a model number and the additional specimens showed use of the mark with various changing model numbers used to designate successive generations of equipment).

Here, the applicant’s mark X-PID appears with the applicant’s house mark and company name Dräger, along with a model designation of 000/9500. In the attached Exhibit A the product literature refers to “two product models for different requirements,” the 9000 and 9500. The applicant meets the first prong of the *Raychem* requirements concerning a model or grade designation. The applicant also meets the second prong of the *Raychem* requirements, with additional evidence showing use of the model or grade designation. In addition, the applicant uses model designations and its Dräger mark and name with other product names, for example, its Dräger X-am[®] 8000 gas detector. The applicant owns a registration for the X-AM mark for gas testing instruments, Registration No. 5,504,207. Attached hereto as Exhibit B are copies of the X-AM product literature, the TESS record for the X-AM registration, and the first page of the specimen of use.

C. Conclusion

For at least the reasons provided above, the mark X-PID functions as a trademark and serves as a source-identifier for the applicant goods, and the applicant's specimen, as filed, shows use of the applied-for mark in commerce. The Trademark Examining Attorney is invited to call the applicant's undersigned representative if any further amendment will expedite the prosecution of the application or if she has any suggestions or questions concerning the application or the present Response.

Respectfully,



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Dated: November 14, 2019

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