

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

Mark: STUDEBAKER
Serial No.: 88067361
Filing Date: August 6, 2018
Applicant: Marino Andriani, LLC

RESPONSE

This is in response to the Office Action dated May 30, 2019.

Claim of Prior Registration

Applicant requests that the following claim be made of record:

“Applicant is the owner of prior active Registration No. 5871217 for the mark STUDEBAKER.”

2(f) Claim For Applicant’s Related Goods

The Examining Attorney has maintained his position that the subject mark is *primarily merely* a surname. But this is respectfully disputed. Even if “Studebaker” is a common surname, which Applicant does not readily accept, it is almost beyond question that its *primary* significance is *not* as a surname but as a brand. Studebaker is a historical brand and would transcend whatever surname significance it may have once had, if any. Consequently, it is not primarily or merely a surname.

Moreover, Applicant believes that its 2(f) claim of acquired secondary meaning, based on applicant’s prior Registrations for the same mark in Class 9 (Reg. Nos. 3509858 and 5871217) should be accepted in this instance. While the goods in the subject application are admittedly not

closely identical to the goods in the prior registrations, they are more similar and related than first meets the eye and such distinctiveness should transfer to the subject application.

The products in the subject application (detailed below) are electrically powered devices having switches to control voltage, with interior circuit boards housing the capacitors, resistors, chips and coils (with or without the possibility of an electronic or mechanical motor housed in the device). So too are the electric items in the subject registrations. They are all manufactured and designed for everyday use. The average household has dozens of electronic devices such as those covered by the application and the registrations.

Applicant's STUDEBAKER Registrations and Application	
<p>Registration No.: 5871217 Issued: October 1, 2019</p>	<p>Class 9: Phonographic record players and turntables being record players; CD players, clock radios, namely, radios incorporating clocks.</p> <p>Class 21: Record cleaning kits comprised of basins in the nature of receptacles, cleaning brushes, lint rollers, drying cloths, and liquid cleaning solution all for cleaning phonographic records.</p>
<p>Registration No.: 3509858 Issued: September 20, 2008</p>	<p>Class 9: Electronic products, namely, compact stereos, boom boxes, radios, and personal stereos.</p>
<p>Subject Application No.: 88067361</p>	<p>Class 7: Electric, hand-held kitchen appliances, namely, electric mixers and other items in the nature of electric juicers</p> <p>Class 11: Electric toasters; electric toaster ovens; electric popcorn poppers; electric, hand-held kitchen appliances, namely, toasters, popcorn makers in the nature of popcorn poppers, and sandwich makers</p>

Anecdotally, there are items that encompass attributes of both the prior registrations as well as the current application. For example, see the Timex combination appliance/timepiece below.

A miniature kitchen mixer and clock:



Amended Description of Goods

The Examining Attorney has requested further clarification to the identification of goods, which Applicant agrees to adopt, so that each class will read in its entirety as follows:

Class 7: Electric, hand-held kitchen appliances, namely, electric mixers and other items in the nature of electric juicers

Class 11: Electric toasters; electric toaster ovens; electric popcorn poppers; electric, hand-held kitchen appliances, namely, toasters, popcorn makers in the nature of popcorn poppers, and sandwich makers

Conclusion

Applicant requests that the refusal be withdrawn and that the subject application be accepted for publication.

Respectfully submitted,

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