

**2(e)(4) SURNAME REFUSAL; 2(f) CLAIM**

As noted in the prior Response, Applicant is a law firm founded in 1903, and has over 200 attorneys with offices in Wisconsin and Minnesota. Its practice extends domestically across the United States, and internationally as well. The application claims ownership of prior registrations 4555335 (for DEWITT ROSS & STEVENS) and 4555348 (for DEWITT ROSS & STEVENS in stylized form), both covering the same services as the present application, with these registrations listing first use of the DEWITT ROSS & STEVENS mark in 1995. Prior to 1995, Applicant operated under the mark DEWITT PORTER. The firm has long been known colloquially among the public and within the legal profession as merely DEWITT, and as of January 1, 2019, it formally reorganized as DeWitt, LLP, dropping ROSS & STEVENS from its legal name and advertising, to reflect this.

To address the 2(e)(4) refusal, Applicant submitted a 2(f) claim of acquired distinctiveness based on at least five years' use of the mark. The Office Action responds:

However, the application indicates that the mark is not currently in use but will be used by applicant in the future. Thus, applicant needs to clarify whether applicant intends to claim acquired distinctiveness in his or her application or if applicant inadvertently included this claim of five years' use. See 37 C.F.R. §2.61(b); TMEP §814.

To address this issue, Applicant has filed an Allegation of Use concurrently with this Response, asserting use of the mark DEWITT in commerce as of at least 1995. As noted above, prior to January 1, 2019, Applicant used the mark DEWITT ROSS & STEVENS. As seen in Applicant's prior registration 4555348 (copy provided with this Response), the term DEWITT was emphasized within DEWITT ROSS & STEVENS, such that DEWITT presented a separate and distinct commercial impression. See TMEP 807.12(d) ("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").

Owing to Applicant's longstanding use of DEWITT, and longstanding recognition of Applicant as DEWITT, the previously presented §2(f) claim is respectfully submitted to obviate the §2(e)(4) refusal.

**§2(D) REFUSAL; REQUEST FOR SUSPENSION (37 CFR §2.67, TMEP 716 et seq.)**

The §2(d) refusal is applied to only a portion of the Applicant's class 35 services ("business acquisition and merger consultation, business planning"), and not to Applicant's remaining class 35 services ("commercial lobbying services"), nor to Applicant's class 45 legal services. The cited prior registration (4520056) encompasses "provision of online business and commercial information; market research and analysis; compilation and preparation of statistical information; business data retrieval services, namely, market research and business intelligence services" in class 035.

As noted in Applicant's prior Response, it appears Registrant has abandoned the DEWITT mark of US Reg. 4520056. From Applicant's research, in 2012, Registrant Argus Media Limited – which is a UK company -- acquired DeWitt & Company (a petrochemical information/research firm unrelated to Applicant). While Registrant used the DEWITT mark for a time in relation to at least some of the goods/services listed in its registration (but in the petrochemical field), Registrant began phasing out use of DEWITT in lieu of its "core" brand ARGUS. DEWITT now only appears on Registrant's website in discussions of its history, and does not appear in relation to Registrant's current provision of any of Registrant's class 35 services. It therefore appears that the registration is subject to cancellation on the ground of abandonment as per §14(3) of the Lanham Act (15 USC §1064(3)), and that Registrant is unlikely to file a Section 8 Declaration of Use due by its April 29, 2020 deadline to do so (or by October 29, 2020, if the grace period fee is paid).

Applicant's prior Response requested that the Examining Attorney exercise her discretion to suspend action

on the present application to allow time to determine whether Registrant would file a Section 8 Declaration of Use to maintain its registration, with suspension thereby avoiding the costs and burdens (both to Applicant and the TTAB) of the Applicant's filing of a cancellation petition. The Office Action responds:

[A]n application can only be suspended when a cited registration is within their Section 8 six-month grace period following the sixth year after the date of registration and before the trademark examining attorney is ready to issue a final refusal under Section 2(d). See TMEP § 716.02(e). Therefore, suspension is not proper in this case, because the trademark examining attorney is hereby issuing a subsequent non-final office action and the cited registration will not be within their Section 8 six-month grace period until April 30, 2020.

This Response is filed on April 15, 2020, roughly two weeks prior to the April 30, 2020 opening of Registrant's six-month grace period. By the time this Response is reviewed, the cited registration should be within its grace period, and thus suspension is appropriate.

However, if the cited registration is not in its grace period at the time this Response is reviewed and a Final Office Action is issued, then Applicant would soon thereafter file a Request for Reconsideration within the grace period – which would likewise lead to suspension under TMEP § 716.02(e):

[I]f the examining attorney is ready to issue a denial of a request for reconsideration of a final refusal of registration under §2(d), and the cited registration is in the grace period for filing a §8 or §71 affidavit or §9 renewal application, the examining attorney must suspend action. If the registrant timely files, and the USPTO accepts, the §8 or §71 affidavit and/or the cited registration is renewed, and the applicant has not filed an appeal, the examining attorney will remove the application from suspension and issue an "Examiner's Subsequent Final Refusal," thereby giving the applicant six months in which to file an appeal.

As the same result (i.e., suspension) arises in either case, it seems most efficient to simply suspend action on the present application now, whether the cited registration is in its grace period or not.

It is noted that should Registrant file a Section 8 Declaration of Use which maintains the cited registration for its class 35 services, the Examining Attorney is authorized to delete Applicant's class 35 services which give rise to the 2(d) refusal ("business acquisition and merger consultation, business planning") to expedite prosecution of the application.