

UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Moeller Precision Tool, LLC
Serial No.: 88300238
Filing Date: February 13, 2019
Mark: MEO
Class: 7
Attorney File No.: Examining Attorney
Jeane Yoo/Law Office 120

RESPONSE TO OFFICE ACTION

Applicant files this response to the Office Action issued November 12, 2019, in connection with the above-captioned U.S. trademark application. Applicant responds as follows:

1. Section 1 and 45 Refusal – Marks Do Not Match:

Applicant respectfully disagrees with the Office’s refusal to register the MEO mark based on the finding that mark on the specimen does not match the mark in the drawing “because the specimen’s mark displays the mark with additional matter...that does not otherwise appear to be segregable or distinguishable from the actual applied-for-mark.” Applicant requests the Office reconsider its prior determination.

REMARKS

Applicant is quite puzzled by the Office’s “supplemental” refusal of the mark under Sections 1 and 45 of the Trademark Act. Over the past two (2) years, the Office has accepted, not one or two, but four (4) nearly identical specimens from the Applicant for: (1) very similar marks; and (2) used with very similar goods. And, in none of those cases did the Office even mention a possible refusal under Sections 1 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 specimen submitted and accepted by the Office is shown in **Exhibit A**.

The Office also issued Applicant a registration for MDC (Reg. No. 5,632,865) in Class 7 for “machine tool holders”. The specimen submitted and accepted by the Office is shown in **Exhibit A**.

The Office issued Applicant a registration for MHC (Reg. No. 5386712) in Class 7 for “punching dies”. The specimen submitted and accepted by the Office is shown in **Exhibit A**.

Finally, the Office issued Applicant a registration for ISC (Reg. No. 5632862) in Class 7 for “metalworking machine tools”. The specimen submitted and accepted by the Office is shown in **Exhibit A**.

Copies of the applicable Certificates of Registration are included as **Exhibit B**. 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 C**.

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 Applicant also cites TEMP, Section 807.12(d) to support its position that the specimen submitted in this case should be acceptable. Quoting from the TMEP, Section 807.12(d):

In a Sec. 1 application, an applicant has some latitude in selecting the mark it wants to register. The mere fact that two or more elements form a composite mark does not necessarily mean that those elements are inseparable for registration purposes. 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.

The determinative factor is whether or not the subject matter in question makes a separate and distinct commercial impression apart from the other element(s). Citations omitted.

In the present application, the Mark Applicant wants to register is MEO. On its own, and as used by the Applicant, MEO has a separate and distinct commercial impression apart from the other elements (a string of numbers) shown in the specimen. The fact that the specimen of record includes numbers after the MEO mark is, therefore, of no consequence.

Finally, Applicant responds by submitting additional specimens of use for the MEO mark.

For the reasons stated above, Applicant respectfully requests that the Office withdraw its refusal and allow Serial No. 88300238 to proceed to Publication.

EXHIBIT A

EXHIBIT B

EXHIBIT C