

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**  
**Trademark Examining Operation**

IN RE: Application No. 88/929,088  
Mark: SMITH  
Applicant: Smith Sport Optics, Inc.  
Law Office: 114  
Examining Attorney: Edward Fennessy  
Attorney Docket No. 0851534-0121/01US6

**RESPONSE TO OFFICE ACTION**

Commissioner for Trademarks  
P.O. Box 1451  
Alexandria, VA 22313-1451

Dear Sir:

The Applicant, Smith Sport Optics, Inc., by and through its undersigned counsel, responds to the Office Action dated July 31, 2020, as follows:

**AMENDMENTS**

Kindly enter the following amendments, without prejudice:

1. Amend the identification of the goods in Class 9 as follows:  
  
--protective safety eyeglasses and protective safety goggles, corrective and cosmetic contact lenses.—
  
2. Amend the identification of the goods in Class 10 as follows:  
  
-- protective face masks and protective face shields for use by health care providers.--

**REMARKS**

Applicant notes that the Examiner has refused the application based on the position that the mark of the application is primarily a common surname.

Applicant, through its counsel, advises that the mark SMITH has been in use on similar goods for over 50 years. Applicant claims acquired distinctiveness of the mark, SMITH, under section 2(f) of the Trademark Act due to the length of use of the mark on Class 9 goods and Incontestability of existing registrations for the SMITH mark by the Applicant as evidenced as follows:

MARK	REG. NO.	DATE OF REG.	IDENTIFICATION OF GOODS	DATE OF FIRST USE ON GOODS
SMITH	1,189,158	02/09/1982	Class 9 - Sports Goggles	12/00/1969
SMITH	1,805,877	11/23/1993	<p>Class 9 - Spectacles; eyeglasses; sunglasses; face shields; goggle film advancement systems comprising clear plastic film for use with goggles to provide clear vision, apparatus for advancing said film and film replacement rolls; motorcycling goggles and replacement lenses therefor</p> <p>Class 21 - Cloths and sponges for wiping and defogging eyeglasses, goggles and ski lenses.</p> <p>Class 25 - T-shirts, hats and headbands</p> <p>Class 28 - Sport goggles for use in skiing and replacement lenses therefor; ski equipment; namely, ski goggle lenses used exclusively for skiing and other cold weather sports.</p>	<p>Cl. 9 – 12/00/1969</p> <p>Cl. 21 – 03/01/1999</p> <p>Cl. 25 – 1979</p> <p>Cl. 28 – 12/00/1969</p>

SMITH	5,049,436	09/27/2016	Cl. 9 - Sunglasses and spectacles; frames for sunglasses and spectacles; optical lenses; sunglass lenses; cases for sunglasses, spectacles, and goggles for sports; goggles for sports; replacement lenses for goggles for sports; sports helmets; cords and straps for sunglasses and spectacles; protective sports helmet accessories that attach to skiing, snowboarding, and motorcross helmets, namely, face masks; camera mounts and supports	12/00/1969
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Applicant contends that because of the extensive use and promotion of the SMITH mark for over 50 years, consumers directly associate the mark with the Applicant as the source of these goods. Furthermore, because the goods of the above-referenced registrations are so closely related to the goods of the instant application the consuming public would readily recognize the products as being associated and as coming from the same source.

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**CONCLUSION**

As the outstanding issues of the Office Action dated July 31, 2020 have been fully addressed, Applicant respectfully requests that the application be accepted for publication at an early date.

Respectfully submitted,

SCHNADER HARRISON SEGAL & LEWIS LLP



Dated: August 11, 2020

By: \_\_\_\_\_

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