

Response to Office Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	79209790
LAW OFFICE ASSIGNED	LAW OFFICE 115
MARK SECTION	
MARK	https://tmng-al.uspto.gov/resting2/api/img/79209790/large
LITERAL ELEMENT	SISTEMA ULTRA
STANDARD CHARACTERS	YES
USPTO-GENERATED IMAGE	YES
MARK STATEMENT	The mark consists of standard characters, without claim to any particular font style, size or color.
GOODS AND/OR SERVICES SECTION (current)	
INTERNATIONAL CLASS	021
DESCRIPTION	
Containers for domestic or kitchen purposes; household or kitchen utensils and containers (not of precious metal or coated therewith); containers of plastic for household use; lunch boxes; buckets; baskets for household purposes; baskets, not of metal, for household purposes; baskets for domestic use, not of precious metal; laundry baskets for domestic use; laundry baskets for household use; bottles; plastic bottles; plastic water bottles; water bottles; vacuum bottles; insulated bottles (flasks) for household or domestic use; cups; drinking cups; insulated cups; parts, fittings and accessories for the foregoing goods	
GOODS AND/OR SERVICES SECTION (proposed)	
INTERNATIONAL CLASS	021
TRACKED TEXT DESCRIPTION	
Containers for domestic or kitchen purposes; household or kitchen utensils and containers (not of precious metal or coated therewith); household or kitchen utensils and containers not of precious metal or coated therewith, namely kitchen containers, containers for household use, household containers for foods, trash containers for household use, compost containers for household use, non-metal recycling bins for household use, insulated containers for food or beverages, buckets, baskets for household purposes, laundry baskets, ice cube molds, or plastic freezer pop forms; containers of plastic for household use; storage containers of plastic for household use; lunch boxes; buckets; baskets for household purposes; baskets, not of metal, for household purposes; baskets for domestic use, not of precious metal; laundry baskets for domestic use; laundry baskets for household use; bottles; plastic bottles; plastic water bottles; water bottles; vacuum bottles; insulated bottles (flasks) for household or domestic use; bottles, sold empty; plastic bottles, namely plastic water bottles sold empty; plastic water bottles; water bottles, sold empty; water bottles; vacuum bottles; insulated bottles (flasks) for household or domestic use; insulated bottles in the nature of flasks for household or domestic use; insulated bottles (flasks) for household or domestic use; cups; drinking cups; insulated cups; parts, fittings and accessories for the foregoing goods, namely clips, lids or closures, or reusable straw-fit beverage lids for placement on jars or bottles; parts, fittings and accessories for the foregoing goods	
FINAL DESCRIPTION	
Containers for domestic or kitchen purposes; household or kitchen utensils and containers not of precious metal or coated therewith, namely kitchen containers, containers for household use, household containers for foods, trash containers for household use, compost containers for household use, non-metal recycling bins for household use, insulated containers for food or beverages, buckets, baskets for household purposes, laundry baskets, ice cube molds, or plastic freezer pop forms; storage containers of plastic for household use; lunch boxes; buckets; baskets for household purposes; baskets, not of metal, for household purposes; baskets for domestic use, not of precious metal; laundry baskets for domestic use; laundry baskets for household use; bottles, sold empty; plastic bottles, namely plastic water bottles sold empty; water bottles, sold empty; vacuum bottles; insulated	

bottles in the nature of flasks for household or domestic use; cups; drinking cups; insulated cups; parts, fittings and accessories for the foregoing goods, namely clips, lids or closures, or reusable straw-fitted beverage lids for placement on jars or bottles.

ADDITIONAL STATEMENTS SECTION

ACTIVE PRIOR REGISTRATION(S)	The applicant claims ownership of active prior U.S. Registration Number(s) 3089471, 4069370, and 5145344.
TRANSLATION	The English translation of SISTEMA in the mark is SYSTEM.
MISCELLANEOUS STATEMENT	
MISCELLANEOUS FILE NAME(S)	
ORIGINAL PDF FILE	mis-1223120410-20171222170835716568_71222_79209790_SISTEMA_ULTRA_Office_Action_Response_Argumen
CONVERTED PDF FILE(S) (3 pages)	\\TICRS\EXPORT17\IMAGEOUT17\792\097\79209790\xml8\ROA0002.JPG
	\\TICRS\EXPORT17\IMAGEOUT17\792\097\79209790\xml8\ROA0003.JPG
	\\TICRS\EXPORT17\IMAGEOUT17\792\097\79209790\xml8\ROA0004.JPG

NEW ATTORNEY SECTION

NAME	Joseph T. Kucala, Jr.
FIRM NAME	Norvell IP LLC
INDIVIDUAL ATTORNEY DOCKET/REFERENCE NUMBER	13519-47
OTHER APPOINTED ATTORNEY	Joseph V. Norvell; James M. McCarthy; Tom M. Monagan; J. Ryan Hinshaw; Christine A. Filarski; Sarah B. Kelleher; Christian S. Morgan; Monica M. Gutierrez
STREET	P.O. BOX 2461
CITY	Chicago
STATE	Illinois
ZIP/POSTAL CODE	60690
COUNTRY	United States
PHONE	888-315-0732
EMAIL	officeactions@norvellip.com
AUTHORIZED EMAIL COMMUNICATION	Yes

CORRESPONDENCE SECTION

ORIGINAL ADDRESS	AJ PARK State Insurance Tower, Level 22, Wellington 6011 NZ
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NEW CORRESPONDENCE SECTION

NAME	Joseph T. Kucala, Jr.
FIRM NAME	Norvell IP LLC
DOCKET/REFERENCE NUMBER	13519-47
STREET	P.O. BOX 2461

CITY	Chicago
STATE	Illinois
ZIP/POSTAL CODE	60690
COUNTRY	United States
PHONE	888-315-0732
EMAIL	officeactions@norvellip.com;jkucala@norvellip.com
AUTHORIZED EMAIL COMMUNICATION	Yes
SIGNATURE SECTION	
RESPONSE SIGNATURE	/Joseph T. Kucala, Jr./
SIGNATORY'S NAME	Joseph T. Kucala, Jr.
SIGNATORY'S POSITION	Attorney for Applicant
DATE SIGNED	12/22/2017
AUTHORIZED SIGNATORY	YES
FILING INFORMATION SECTION	
SUBMIT DATE	Fri Dec 22 17:15:39 EST 2017
TEAS STAMP	USPTO/ROA-XX.XXX.XXX.XX-2 0171222171539343437-79209 790-5109b35719af8ec54a224 3647666c0bf4c60a16523a792 1f5629d05d9f5d9904-N/A-N/ A-20171222170835716568

Under the Paperwork Reduction Act of 1995 no persons are required to respond to a collection of information unless it displays a valid OMB control number.
PTO Form 1957 (Rev 10/2011)
OMB No. 0651-0050 (Exp 09/20/2020)

Response to Office Action

To the Commissioner for Trademarks:

Application serial no. **79209790** SISTEMA ULTRA(Standard Characters, see <https://tmng-al.uspto.gov/resting2/api/img/79209790/large>) has been amended as follows:

CLASSIFICATION AND LISTING OF GOODS/SERVICES

Applicant proposes to amend the following class of goods/services in the application:

Current: Class 021 for Containers for domestic or kitchen purposes; household or kitchen utensils and containers (not of precious metal or coated therewith); containers of plastic for household use; lunch boxes; buckets; baskets for household purposes; baskets, not of metal, for household purposes; baskets for domestic use, not of precious metal; laundry baskets for domestic use; laundry baskets for household use; bottles; plastic bottles; plastic water bottles; water bottles; vacuum bottles; insulated bottles (flasks) for household or domestic use; cups; drinking cups; insulated cups; parts, fittings and accessories for the foregoing goods

Original Filing Basis:

Filing Basis Section 66(a) , Request for Extension of Protection to the United States. Section 66(a) of the Trademark Act, 15 U.S.C. §1141f.

Proposed:

Tracked Text Description: Containers for domestic or kitchen purposes; ~~household or kitchen utensils and containers (not of precious metal or coated therewith);~~ household or kitchen utensils and containers not of precious metal or coated therewith, namely kitchen containers, containers

for household use, household containers for foods, trash containers for household use, compost containers for household use, non-metal recycling bins for household use, insulated containers for food or beverages, buckets, baskets for household purposes, laundry baskets, ice cube molds, or plastic freezer pop forms; ~~containers of plastic for household use; storage containers of plastic for household use;~~ lunch boxes; buckets; baskets for household purposes; baskets, not of metal, for household purposes; baskets for domestic use, not of precious metal; laundry baskets for domestic use; laundry baskets for household use; ~~bottles; bottles, sold empty; plastic bottles; plastic bottles, namely plastic water bottles sold empty; plastic water bottles; water bottles, sold empty; water bottles;~~ vacuum bottles; insulated bottles in the nature of flasks for household or domestic use; ~~insulated bottles (flasks) for household or domestic use;~~ cups; drinking cups; insulated cups; parts, fittings and accessories for the foregoing goods, namely clips, lids or closures, or reusable straw-fitted beverage lids for placement on jars or bottles.; ~~parts, fittings and accessories for the foregoing goods~~

Class 021 for Containers for domestic or kitchen purposes; household or kitchen utensils and containers not of precious metal or coated therewith, namely kitchen containers, containers for household use, household containers for foods, trash containers for household use, compost containers for household use, non-metal recycling bins for household use, insulated containers for food or beverages, buckets, baskets for household purposes, laundry baskets, ice cube molds, or plastic freezer pop forms; storage containers of plastic for household use; lunch boxes; buckets; baskets for household purposes; baskets, not of metal, for household purposes; baskets for domestic use, not of precious metal; laundry baskets for domestic use; laundry baskets for household use; bottles, sold empty; plastic bottles, namely plastic water bottles sold empty; water bottles, sold empty; vacuum bottles; insulated bottles in the nature of flasks for household or domestic use; cups; drinking cups; insulated cups; parts, fittings and accessories for the foregoing goods, namely clips, lids or closures, or reusable straw-fitted beverage lids for placement on jars or bottles.

Filing Basis Section 66(a) , Request for Extension of Protection to the United States. Section 66(a) of the Trademark Act, 15 U.S.C. §1141f.

ATTORNEY ADDRESS

Applicant proposes to amend the following:

Proposed:

Joseph T. Kucala, Jr. of Norvell IP LLC, having an address of
P.O. BOX 2461 Chicago, Illinois 60690
United States
officeactions@norvellip.com
888-315-0732

The attorney docket/reference number is 13519-47 .

The Other Appointed Attorney(s): Joseph V. Norvell; James M. McCarthy; Tom M. Monagan; J. Ryan Hinshaw; Christine A. Filarski; Sarah B. Kelleher; Christian S. Morgan; Monica M. Gutierrez.

CORRESPONDENCE ADDRESS CHANGE

Applicant proposes to amend the following:

Current:

AJ PARK
State Insurance Tower,
Level 22,
Wellington 6011
NZ

Proposed:

Joseph T. Kucala, Jr. of Norvell IP LLC, having an address of
P.O. BOX 2461 Chicago, Illinois 60690
United States
officeactions@norvellip.com;jkucala@norvellip.com
888-315-0732

The docket/reference number is 13519-47 .

ADDITIONAL STATEMENTS

Claim of Active Prior Registration(s)

The applicant claims ownership of active prior U.S. Registration Number(s) 3089471, 4069370, and 5145344.

Translation

The English translation of SISTEMA in the mark is SYSTEM.

Miscellaneous Statement

Original PDF file:

[mis-1223120410-20171222170835716568 . 71222 79209790 SISTEMA ULTRA Office Action Response Argument.pdf](#)

Converted PDF file(s) (3 pages)

[Miscellaneous File1](#)

[Miscellaneous File2](#)

[Miscellaneous File3](#)

SIGNATURE(S)

Response Signature

Signature: /Joseph T. Kucala, Jr./ Date: 12/22/2017

Signatory's Name: Joseph T. Kucala, Jr.

Signatory's Position: Attorney for Applicant

The signatory has confirmed that he/she is an attorney who is a member in good standing of the bar of the highest court of a U.S. state, which includes the District of Columbia, Puerto Rico, and other federal territories and possessions; and he/she is currently the owner's/holder's attorney or an associate thereof; and to the best of his/her knowledge, if prior to his/her appointment another U.S. attorney or a Canadian attorney/agent not currently associated with his/her company/firm previously represented the owner/holder in this matter: (1) the owner/holder has filed or is concurrently filing a signed revocation of or substitute power of attorney with the USPTO; (2) the USPTO has granted the request of the prior representative to withdraw; (3) the owner/holder has filed a power of attorney appointing him/her in this matter; or (4) the owner's/holder's appointed U.S. attorney or Canadian attorney/agent has filed a power of attorney appointing him/her as an associate attorney in this matter.

Mailing Address: Joseph T. Kucala, Jr.

Norvell IP LLC

P.O. BOX 2461

Chicago, Illinois 60690

Serial Number: 79209790

Internet Transmission Date: Fri Dec 22 17:15:39 EST 2017

TEAS Stamp: USPTO/ROA-XX.XXX.XXX.XX-2017122217153934

3437-79209790-5109b35719af8ec54a22436476

66c0bf4c60a16523a7921f5629d05d9f5d9904-N

/A-N/A-20171222170835716568

In re Application of:	Sistema Plastics Limited	
Serial No.:	79/209,790	Examining Attorney:
Filed:	March 14, 2017	Daniel S. Brody
Mark	SISTEMA ULTRA	Law Office 115

**APPLICANT’S RESPONSE TO OFFICE ACTION IN SUPPORT OF
REGISTRATION FOR THE MARK SISTEMA ULTRA**

Dear Mr. Brody:

I. Introduction and Specification of Goods

The Examiner has issued a non-final Office Action for the mark SISTEMA ULTRA (Serial No. 79/209,790) (“Applicant’s Mark”) owned by Sistema Plastics Limited (the “Applicant”) in connection with the following goods (as amended herein):

Class 21: Containers for domestic or kitchen purposes; household or kitchen utensils and containers not of precious metal or coated therewith, namely kitchen containers, containers for household use, household containers for foods, trash containers for household use, compost containers for household use, non-metal recycling bins for household use, insulated containers for food or beverages, buckets, baskets for household purposes, laundry baskets, ice cube molds, or plastic freezer pop forms; storage containers of plastic for household use; lunch boxes; buckets; baskets for household purposes; baskets, not of metal, for household purposes; baskets for domestic use, not of precious metal; laundry baskets for domestic use; laundry baskets for household use; bottles, sold empty; plastic bottles, namely plastic water bottles sold empty; water bottles, sold empty; vacuum bottles; insulated bottles in the nature of flasks for household or domestic use; cups; drinking cups; insulated cups; parts, fittings and accessories for the foregoing goods, namely clips, lids or closures, or reusable straw-fitted beverage lids for placement on jars or bottles.

(“Applicant’s Goods”).

II. Argument

In the Office Action, the Examiner request Applicant to disclaim SISTEMA. The Applicant respectfully submits that a disclaimer is not required because the mark SISTEMA is distinctive and not merely descriptive of Applicant’s Goods. Further, Applicant notes that it owns several

U.S. Registrations for or including the mark SISTEMA in Class 21, none of which required a disclaimer of the term. Thus, there is no need for entry of a disclaimer in this insistence.

First, the mark SISTEMA is not descriptive of any element or nature of Applicant's Goods. Applicant's Goods are comprised of various forms and types of containers, bottles and household items. No qualities or functions of these goods are associated in any way with the word SISTEMA. Therefore, the mark SISTEMA is not merely descriptive of Applicant's Goods, supporting Applicant's position for withdrawal of the disclaimer.

Moreover, Applicant owns two U.S. Registrations for the mark SISTEMA (Reg. Nos. 3,089,471; 4,069,370) in Class 21 for goods highly related to Applicant's Goods. Applicant also owns several other U.S. Registrations for marks that include SISTEMA, including the mark SISTEMA TO GO (Reg. No. 5,145,344) in Class 21 for goods highly related to Applicant's Goods. During the prosecution of these applications, Applicant was not requested to disclaim for the word SISTEMA. The Trademark Examining Operation's Consistency Initiative calls for adherence to established trends in trademark examinations. See *In Re Shabby Chic Brands*, 122 U.S.P.Q.2d 1139 (T.T.A.B. Mar. 31, 2017). Here, the consistent, prior practice of the USPTO has been to not require disclaimer of the mark SISTEMA and doing so in this instance would diverge from this past practice and lead to inconsistent examinations.

III. Conclusion

Therefore, Applicant respectfully requests the Examiner withdraw the disclaimer requirement and approve Application Serial No. 79/209,790 for publication in the *Official Gazette*.

Respectfully submitted,
Sistema Plastics Limited

By: /s/ Joseph T. Kucala, Jr.
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Chicago, Illinois 60604
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Attorney for Applicant