

## Response to Office Action

The table below presents the data as entered.

Input Field	Entered
<b>SERIAL NUMBER</b>	85299672
<b>LAW OFFICE ASSIGNED</b>	LAW OFFICE 101
<b>MARK SECTION</b>	
<b>MARK</b>	http://tess2.uspto.gov/ImageAgent/ImageAgentProxy?getImage=85299672
<b>LITERAL ELEMENT</b>	STRATTON
<b>STANDARD CHARACTERS</b>	YES
<b>USPTO-GENERATED IMAGE</b>	YES
<b>MARK STATEMENT</b>	The mark consists of standard characters, without claim to any particular font style, size or color.

### ARGUMENT(S)

In response to the Office Action dated August 22<sup>nd</sup>, 2011, Applicant AS IP Holdco, LLC (“Applicant”) respectfully submits the following remarks:

The Examining Attorney has rejected the application on the grounds that the mark is primarily merely a surname. Applicant respectfully disagrees with the Examining Attorney’s conclusion that STRATTON is primarily merely a surname.

Whether or not a mark is primarily merely a surname depends on the “primary significance of the mark to the purchasing public.” *In re Kahan & Weisz*, 184 U.S.P.Q 421-22 (1975). The mark sought to be registered must be considered on a case by case basis. *In re Etablissements Darty et Fils*, 225 U.S.P.Q 652 (1985). In evaluating a surname one must consider the following factors in determining whether a term is primarily merely a surname:

1. Whether the surname is rare;
2. Whether anyone connected with Applicant has the involved term of the surname;
3. Whether the term has any recognized meaning other than as a surname; and
4. Whether the term has the “look and feel” of a surname.

See *In re Benthin Management GmbH*, 37 USPQ 2d 1332(TTAB 1995); TMEP 1211.01 .

All of the above factors weigh in the Applicant’s favor in this case, and therefore, the Examining Attorney can not meet the significant burden of proof he must meet to justify the surname refusal.

First, while the Examining Attorney’s evidence attached to the Office Action establishes that Stratton may be a surname, the number uncovered is statistically insignificant, as there are over 311 million residents of the United States. The Applicant asserts that the mark STRATTON would not be understood as primarily merely a surname by the consuming public.

Second, Stratton is not the surname of anyone connected with the Applicant.

Third, the term Stratton has recognized meanings other than as a surname. In evaluating

a surname one must consider whether the term has any recognized meaning other than a surname. Marks having significance other than as a surname have been held *not* “primarily merely” a surname, and allowed registration on the Principal Register without proof of secondary meaning. In re Colt Industries Operating Corp., 195 U.S.P.Q. 75 (T.T.A.B. 1977).

Applicant submits that the mark STRATTON would not be understood as primarily merely a surname by the consuming public because it does have recognized meanings other than as a surname. First, Stratton is a top North American resort for skiing, snowboarding, golf, and lots of family winter vacation fun. Second, the term Stratton has geographic significance. Stratton is not only the name of a town in Vermont, but also the name of a town in Nebraska and Colorado. Third, the term Stratton is the name of the world’s largest manufacturer of uniform hats. Fourth, a review of the USPTO’s

web-site reveals active trademark registrations for STRATTON in connection with a variety of goods

including “cosmetic powder compacts and lipstick holders” (Reg. 924551), “men’s and women’s jewelry” (Reg. 1565590) and “office chairs” (Reg. 3454341).

Finally, the term STRATTON does not have the look or feel of a surname. This term does not have the appearance of a surname and does not sound, especially to the American ear, like a surname.

Clearly, STRATTON is an arbitrary term used by Applicant to identify their goods. As demonstrated, the primary significance of the mark to the relevant consuming public can not be held as a surname. The Trademark Office, therefore, can not meet the burden of proof necessary to justify a surname refusal in this case and Applicant’s mark should be allowed for registration.

In view of the foregoing, the Applicant believes the application is in condition for publication. Such action is solicited. If questions remain, Applicant requests the Examining Attorney to contact counsel of record, Maria M. Chiclana by email at [chiclanam@americanstandard.com](mailto:chiclanam@americanstandard.com).

**SIGNATURE SECTION**

RESPONSE SIGNATURE	/mchiclana/
SIGNATORY'S NAME	Maria Chiclana
SIGNATORY'S POSITION	Senior Vice President and General Counsel
DATE SIGNED	02/22/2012
AUTHORIZED SIGNATORY	YES

**FILING INFORMATION SECTION**

SUBMIT DATE	Wed Feb 22 12:39:37 EST 2012
TEAS STAMP	USPTO/ROA-XX.XX.XX.XX-201 20222123937459996-8529967 2-490cbae4c9c9dce1e6a64cd c4599aa57c78-N/A-N/A-2012 0222121708236692

## Response to Office Action

### To the Commissioner for Trademarks:

Application serial no. **85299672** STRATTON(Standard Characters, see <http://tess2.uspto.gov/ImageAgent/ImageAgentProxy?getImage=85299672>) has been amended as follows:

#### ARGUMENT(S)

##### In response to the substantive refusal(s), please note the following:

In response to the Office Action dated August 22<sup>nd</sup>, 2011, Applicant AS IP Holdco, LLC (“Applicant”) respectfully submits the following remarks:

The Examining Attorney has rejected the application on the grounds that the mark is primarily merely a surname. Applicant respectfully disagrees with the Examining Attorney’s conclusion that STRATTON is primarily merely a surname.

Whether or not a mark is primarily merely a surname depends on the “primary significance of the mark to the purchasing public.” In re Kahan & Weisz, 184 U.S.P.Q 421-22 (1975). The mark sought to be registered must be considered on a case by case basis. In re Etablissements Darty et Fils, 225 U.S.P.Q 652 (1985). In evaluating a surname one must consider the following factors in determining whether a term is primarily merely a surname:

1. Whether the surname is rare;
2. Whether anyone connected with Applicant has the involved term of the surname;
3. Whether the term has any recognized meaning other than as a surname; and
4. Whether the term has the “look and feel” of a surname.

See In re Benthin Management GmbH, 37 USPQ 2d 1332(TTAB 1995); TMEP 1211.01 .

All of the above factors weigh in the Applicant’s favor in this case, and therefore, the Examining Attorney can not meet the significant burden of proof he must meet to justify the surname refusal.

First, while the Examining Attorney’s evidence attached to the Office Action establishes that Stratton may be a surname, the number uncovered is statistically insignificant, as there are over 311 million residents of the United States. The Applicant asserts that the mark STRATTON would not be understood as primarily merely a surname by the consuming public.

Second, Stratton is not the surname of anyone connected with the Applicant.

Third, the term Stratton has recognized meanings other than as a surname. In evaluating a surname one must consider whether the term has any recognized meaning other than a surname. Marks having significance other than as a surname have been held *not* “primarily merely” a surname, and allowed registration on the Principal Register without proof of secondary meaning. In re Colt Industries Operating Corp., 195 U.S.P.Q. 75 (T.T.A.B. 1977).

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including "cosmetic powder compacts and lipstick holders" (Reg. 924551), "men's and women's jewelry" (Reg. 1565590) and "office chairs" (Reg. 3454341).

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In view of the foregoing, the Applicant believes the application is in condition for publication. Such action is solicited. If questions remain, Applicant requests the Examining Attorney to contact counsel of record, Maria M. Chiclana by email at [chiclanam@americanstandard.com](mailto:chiclanam@americanstandard.com).

**SIGNATURE(S)**

**Response Signature**

Signature: /mchiclana/ Date: 02/22/2012

Signatory's Name: Maria Chiclana

Signatory's Position: Senior Vice President and General Counsel

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 applicant'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 applicant in this matter: (1) the applicant 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 applicant has filed a power of attorney appointing him/her in this matter; or (4) the applicant'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.

Serial Number: 85299672

Internet Transmission Date: Wed Feb 22 12:39:37 EST 2012

TEAS Stamp: USPTO/ROA-XX.XX.XX.XX-201202221239374599

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