

To: METALAST Surface Technology, LLC (iptm@armstrongteasdale.com)
Subject: U.S. TRADEMARK APPLICATION NO. 86228245 - METALAST - 32963-00001
Sent: 6/25/2014 11:20:46 PM
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**UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)
OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION**

U.S. APPLICATION SERIAL NO. 86228245

MARK: METALAST

86228245

CORRESPONDENT ADDRESS:

TIFFANY L. SCHWARTZ
ARMSTRONG TEASDALE LLP
7700 FORSYTH BLVD STE 1800
SAINT LOUIS, MO 63105-1847

CLICK HERE TO RESPOND TO
<http://www.uspto.gov/trademarks/teas/r1>

APPLICANT: METALAST Surface Technology, LLC

CORRESPONDENT'S REFERENCE/DOCKET NO :
32963-00001

CORRESPONDENT E-MAIL ADDRESS:
iptm@armstrongteasdale.com

OFFICE ACTION

STRICT DEADLINE TO RESPOND TO THIS LETTER

TO AVOID ABANDONMENT OF APPLICANT'S TRADEMARK APPLICATION, THE USPTO MUST RECEIVE APPLICANT'S COMPLETE RESPONSE TO THIS LETTER **WITHIN 6 MONTHS** OF THE ISSUE/MAILING DATE BELOW.

ISSUE/MAILING DATE: **6/25/2014**

The referenced application has been reviewed by the assigned trademark examining attorney. Applicant

must respond timely and completely to the issue(s) below. 15 U.S.C. §1062(b); 37 C.F.R. §§2.62(a), 2.65(a); TMEP §§711, 718.03.

SECTION 2(D) REFUSAL

Registration of the applied-for mark is refused because of a likelihood of confusion with the marks in U.S. Registration Nos. 2097260, 2112804, 2963106 and 4128211. Trademark Act Section 2(d), 15 U.S.C. §1052(d); *see* TMEP §§1207.01 *et seq.* See the enclosed registrations.

Trademark Act Section 2(d) bars registration of an applied-for mark that so resembles a registered mark that it is likely that a potential consumer would be confused or mistaken or deceived as to the source of the goods and/or services of the applicant and registrant. *See* 15 U.S.C. §1052(d). The court in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973) listed the principal factors to be considered when determining whether there is a likelihood of confusion under Section 2(d). *See* TMEP §1207.01. However, not all of the factors are necessarily relevant or of equal weight, and any one factor may be dominant in a given case, depending upon the evidence of record. *In re Majestic Distilling Co.*, 315 F.3d 1311, 1315, 65 USPQ2d 1201, 1204 (Fed. Cir. 2003); *see In re E. I. du Pont*, 476 F.2d at 1361-62, 177 USPQ at 567.

In this case, the following factors are the most relevant: similarity of the marks, similarity of the goods and/or services, and similarity of trade channels of the goods and/or services. *See In re Opus One, Inc.*, 60 USPQ2d 1812 (TTAB 2001); *In re Dakin's Miniatures Inc.*, 59 USPQ2d 1593 (TTAB 1999); *In re Azteca Rest. Enters., Inc.*, 50 USPQ2d 1209 (TTAB 1999); TMEP §§1207.01 *et seq.*

In a likelihood of confusion determination, the marks are compared for similarities in their appearance, sound, meaning or connotation and commercial impression. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973); TMEP §1207.01(b). Similarity in any one of these elements may be sufficient to find a likelihood of confusion. *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988); *In re Lamson Oil Co.*, 6 USPQ2d 1041, 1043 (TTAB 1987); *see* TMEP §1207.01(b).

The applicant's mark is METALAST. The registrant's marks are each METALAST. The marks of the registrant are all identical to the applicant's mark in sound, appearance and commercial impression.

The goods and/or services of the parties need not be identical or directly competitive to find a likelihood of confusion. *See Safety-Kleen Corp. v. Dresser Indus., Inc.*, 518 F.2d 1399, 1404, 186 USPQ 476, 480 (C.C.P.A. 1975); TMEP §1207.01(a)(i). Rather, they need only be related in some manner, or the conditions surrounding their marketing are such that they would be encountered by the same purchasers under circumstances that would give rise to the mistaken belief that the goods and/or services come from a common source. *In re Total Quality Group, Inc.*, 51 USPQ2d 1474, 1476 (TTAB 1999); TMEP §1207.01(a)(i); *see, e.g., On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 1086-87, 56 USPQ2d 1471, 1475-76 (Fed. Cir. 2000); *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 1566-68, 223 USPQ 1289, 1290 (Fed. Cir. 1984).

The applicant's goods are chemicals for use in metal treatment. The registrant's goods/services include chemical for use in metal treatment, identified exactly as those of the registrant, other chemical for use in metal treatment overlapping and within the scope of applicant's goods, and collateral goods and services related directly thereto, namely, computer programs for use in metal treatment and metal treatment

services. These goods/services are largely identical and otherwise highly related goods/services that will be found in the metal treatment channel of trade. As such, consumer source confusion is likely to result.

Where the marks of the respective parties are identical or virtually identical, the relationship between the relevant goods and/or services need not be as close to support a finding of likelihood of confusion. *See In re Shell Oil Co.*, 992 F.2d 1204, 1207, 26 USPQ2d 1687, 1689 (Fed. Cir. 1993); *In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1202 (TTAB 2009); *In re Thor Tech, Inc.*, 90 USPQ2d 1634, 1636 (TTAB 2009); TMEP §1207.01(a).

Where the goods and/or services of an applicant and registrant are identical or virtually identical, the degree of similarity between the marks required to support a finding of likelihood of confusion is not as great as in the case of diverse goods and/or services. *See In re Viterra Inc.*, 671 F.3d 1358, 1363, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (citing *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 877, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992)); *In re Mighty Leaf Tea*, 601 F.3d 1342, 1348, 94 USPQ2d 1257, 1260 (Fed. Cir. 2010); TMEP §1207.01(b).

In sum, the identicalness of the marks and the relatedness if not identicalness of the goods/services and their channels of trade are such that consumer confusion as to source is likely to result. Registration is therefore refused under section 2(d) of the Trademark Act.

Although applicant's mark has been refused registration, applicant may respond to the refusal(s) by submitting evidence and arguments in support of registration.

Notwithstanding the foregoing substantive refusal, the applicant must further respond to the following requirement(s).

IDENTIFICATION AND CLASSIFICATION OF GOODS

The wording used to describe the goods is indefinite in part and must be clarified because they do not identify all of the goods with the requisite clarity and specificity. *See* TMEP §1402.01.

Additionally, the identification names goods capable of classification in more than one international class of goods. It is noted that a prior registration was accepted in 2005 with the same identification, however, it appears that some of the goods fall outside of international class 1. Previous decisions by examining attorneys in approving other marks are without evidentiary value and are not binding on the agency or the Board. *In re Nat'l Novice Hockey League, Inc.*, 222 USPQ 638, 641 (TTAB 1984). The identified colorants, dyes and sealants appear to fall within international class 2 while the identified cleaners appear to fall into international class 3. Therefore, the applicant may adopt any or all of the following identification of goods, if accurate.

International Class 1; Chemicals for use in metal treatment, consisting of cleaners, etchers, deoxidizers, electro polishers, anodizing additives, surfactants, acidifiers, basifiers, anodizing accelerators, fume suppressants, and anti-foaming agents.;

International Class 2; Corrosion inhibitants in the nature of a coating for use in metal treatment; Colorants and dyes for manufacture or treatment of metals; Coatings in the nature of industrial sealants for waterproofing and surface hardening for use in metal treatment;

International Class 3; Powder cleaners for metals and spray cleaners for metals, all for use in metal

treatment;

If applicant prosecutes this application as a combined, or multiple-class application, then applicant must comply with each of the requirements below for those goods and/or services based on actual use in commerce under Trademark Act Section 1(a):

- (1) Applicant must list the goods/services by international class;
- (2) Applicant must submit a filing fee for each international class of goods and/or services not covered by the fee already paid (current fee information should be confirmed at <http://www.uspto.gov>); and
- (3) For each additional international class of goods and/or services, applicant must submit:
 - a. Dates of first use of the mark anywhere and dates of first use of the mark in commerce, or a statement that the dates of use in the initial application apply to that class; and the dates of use, both anywhere and in commerce, must be at least as early as the filing date of the application;
 - b. One specimen showing use of the mark for each class of goods and/or services; and the specimen must have been in use in commerce at least as early as the filing date of the application. If a single specimen supports multiple classes, applicant should indicate which classes the specimen supports rather than providing multiple copies of the same specimen;
 - c. A statement that “the specimen was in use in commerce on or in connection with the goods and/or services listed in the application at least as early as the filing date of the application;” and
 - d. Verification of the statements in 3(a) and 3(c) (above) in an affidavit or a signed declaration under 37 C.F.R. §§2.20, 2.33. Verification is not required where (1) the dates of use for the added class are stated to be the same as the dates of use specified in the initial application, and (2) the original specimens are acceptable for the added class(es).

See 37 C.F.R. §§2.34(a)(1), 2.71(c), 2.86(a); TMEP §§1403.01, 1403.02(c).

The specimen(s) of record appears to be acceptable for International Class(es) 1, 2 and 3 provided applicant indicates the specimens are actually used for any identified additional classes of goods.

To the extent the suggested identification is incomplete or inaccurate, the applicant is further advised that the Trademark Acceptable Identification of Goods and Services Manual is accessible via the PTO website at <http://www.uspto.gov> by clicking “Trademarks” in the column menu on the left side of the page, and then selecting “Identification Manual” from the drop down menu.

Although identifications of goods may be amended to clarify or limit the goods, adding to or broadening the scope of the goods is not permitted. 37 C.F.R. §2.71(a); *see* TMEP §§1402.06 *et seq.*, 1402.07. Therefore, applicant may not amend the identification to include goods that are not within the scope of the goods set forth in the present identification.

Please feel free to contact the undersigned attorney if you wish to discuss this application.

/John S. Yard/
Trademark Examining Attorney
Law Office 115
(571) 272-9486
john.yard@uspto.gov

TO RESPOND TO THIS LETTER: Go to http://www.uspto.gov/trademarks/teas/response_forms.jsp. Please wait 48-72 hours from the issue/ mailing date before using the Trademark Electronic Application System (TEAS), to allow for necessary system updates of the application. For *technical* assistance with online forms, e-mail TEAS@uspto.gov. For questions about the Office action itself, please contact the assigned trademark examining attorney. **E-mail communications will not be accepted as responses to Office actions; therefore, do not respond to this Office action by e-mail.**

All informal e-mail communications relevant to this application will be placed in the official application record.

WHO MUST SIGN THE RESPONSE: It must be personally signed by an individual applicant or someone with legal authority to bind an applicant (i.e., a corporate officer, a general partner, all joint applicants). If an applicant is represented by an attorney, the attorney must sign the response.

PERIODICALLY CHECK THE STATUS OF THE APPLICATION: To ensure that applicant does not miss crucial deadlines or official notices, check the status of the application every three to four months using the Trademark Status and Document Retrieval (TSDR) system at <http://tsdr.uspto.gov/>. Please keep a copy of the TSDR status screen. If the status shows no change for more than six months, contact the Trademark Assistance Center by e-mail at TrademarkAssistanceCenter@uspto.gov or call 1-800-786-9199. For more information on checking status, see <http://www.uspto.gov/trademarks/process/status/>.

TO UPDATE CORRESPONDENCE/E-MAIL ADDRESS: Use the TEAS form at <http://www.uspto.gov/trademarks/teas/correspondence.jsp>.

TYPED DRAWING

Serial Number

75030598

Status

REGISTERED AND RENEWED

Word Mark

METALAST

Standard Character Mark

No

Registration Number

2112804

Date Registered

1997/11/11

Type of Mark

TRADEMARK

Register

PRINCIPAL

Mark Drawing Code

(1) TYPED DRAWING

Owner

SEMAS, DAVID M. INDIVIDUAL UNITED STATES P.O.BOX 618 GENOA NEVADA
89411

Goods/Services

Class Status -- ACTIVE. IC 001. US 001 005 006 010 026 046. G & S:
chemical surface treatment based on anodic oxidation for use in
imparting corrosion resistance, wear-resistance, hardness, and for
replacing surface conductivity of aluminum and aluminum alloy parts.
First Use: 1996/02/00. First Use In Commerce: 1996/02/00.

Filing Date

1995/11/30

Examining Attorney

FRAZIER, JEFFERY

Attorney of Record

Ian F. Burns

TYPED DRAWING

Serial Number

75139979

Status

REGISTERED AND RENEWED

Word Mark

METALAST

Standard Character Mark

No

Registration Number

2097260

Date Registered

1997/09/16

Type of Mark

SERVICE MARK

Register

PRINCIPAL

Mark Drawing Code

(1) TYPED DRAWING

Owner

SEMAS, DAVID M. INDIVIDUAL UNITED STATES P.O. BOX 618 GENOA NEVADA
89411

Goods/Services

Class Status -- ACTIVE. IC 040. US 100 103 106. G & S: metal
treatment. First Use: 1993/06/00. First Use In Commerce: 1993/06/00.

Filing Date

1996/07/23

Examining Attorney

BECK, LORETTA C.

Attorney of Record

Ian F. Burns

TYPED DRAWING

Serial Number

78267465

Status

SECTION 8 & 15-ACCEPTED AND ACKNOWLEDGED

Word Mark

METALAST

Standard Character Mark

No

Registration Number

2963106

Date Registered

2005/06/21

Type of Mark

TRADEMARK

Register

PRINCIPAL

Mark Drawing Code

(1) TYPED DRAWING

Owner

SEMAS, DAVID M. INDIVIDUAL UNITED STATES P.O. BOX 618 GENOA NEVADA
89411

Goods/Services

Class Status -- ACTIVE. IC 001. US 001 005 006 010 026 046. G & S:
Chemicals for use in metal treatment, consisting of cleaners, etchers,
deoxidizers, dyes, electrolytic colors, sealants, electro polishers,
anodizing additives, surfactants, acidifiers, basifiers, anodizing
accelerators, fume suppressants, and anti foaming agents. First Use:
1994/12/31. First Use In Commerce: 1994/12/31.

Goods/Services

Class Status -- ACTIVE. IC 009. US 021 023 026 036 038. G & S:
Computer hardware systems comprising central processing units,
computer monitors, computer input devices, namely, computer touch
screens and keyboards, and computer interface controllers; computer
software for controlling and monitoring metal treatment processes,
storing data related to metal treatment, and for creating process
verification reports. First Use: 1995/10/31. First Use In Commerce:
1995/10/31.

Print: Jun 24, 2014

78267485

Prior Registration(s)

2097260;2112804

Filing Date

2003/06/26

Examining Attorney

GASKINS, TONJA

Attorney of Record

Ian F. Burns, Esq.

DESIGN MARK

Serial Number

85358730

Status

REGISTERED

Word Mark

METALAST

Standard Character Mark

Yes

Registration Number

4128211

Date Registered

2012/04/17

Type of Mark

TRADEMARK

Register

PRINCIPAL

Mark Drawing Code

(4) STANDARD CHARACTER MARK

Owner

SEMAS, DAVID M. INDIVIDUAL UNITED STATES P.O. BOX 618 GENOA NEVADA
89411

Goods/Services

Class Status -- ACTIVE. IC 001. US 001 005 006 010 026 046. G & S:
Chemicals for use in metal treatment to prevent corrosion, consisting
of cleaners, etchers, deoxidizers, dyes, electrolytic colors,
sealants, electro polishers, anodizing additives, surfactants,
acidifiers, basifiers, anodizing accelerators, fume suppressants, and
anti foaming agents. First Use: 1994/12/31. First Use In Commerce:
1994/12/31.

Goods/Services

Class Status -- ACTIVE. IC 009. US 021 023 026 036 038. G & S:
Computer hardware systems comprising central processing units,
computer monitors, computer input devices, namely, computer touch
screens and keyboards, and computer interface controllers; computer
software for controlling and monitoring metal treatment processes,
storing data related to metal treatment, and for creating process
verification reports. First Use: 1995/10/31. First Use In Commerce:
1995/10/31.

Print: Jun 24, 2014

85358730

Prior Registration(s)

2097260;2112804;2963106

Filing Date

2011/06/28

Examining Attorney

RINKER, ANTHONY

Attorney of Record

Ian F. Burns

METALAST

To: METALAST Surface Technology, LLC (iptm@armstrongteasdale.com)
Subject: U.S. TRADEMARK APPLICATION NO. 86228245 - METALAST - 32963-00001
Sent: 6/25/2014 11:20:47 PM
Sent As: ECOM115@USPTO.GOV
Attachments:

UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

**IMPORTANT NOTICE REGARDING YOUR
U.S. TRADEMARK APPLICATION**

USPTO OFFICE ACTION (OFFICIAL LETTER) HAS ISSUED
ON **6/25/2014** FOR U.S. APPLICATION SERIAL NO. 86228245

Please follow the instructions below:

(1) TO READ THE LETTER: Click on this [link](#) or go to <http://tsdr.uspto.gov>, enter the U.S. application serial number, and click on “Documents.”

The Office action may not be immediately viewable, to allow for necessary system updates of the application, but will be available within 24 hours of this e-mail notification.

(2) TIMELY RESPONSE IS REQUIRED: Please carefully review the Office action to determine (1) how to respond, and (2) the applicable response time period. Your response deadline will be calculated from **6/25/2014** (*or sooner if specified in the Office action*). For information regarding response time periods, see <http://www.uspto.gov/trademarks/process/status/responsetime.jsp>.

Do NOT hit “Reply” to this e-mail notification, or otherwise e-mail your response because the USPTO does NOT accept e-mails as responses to Office actions. Instead, the USPTO recommends that you respond online using the Trademark Electronic Application System (TEAS) response form located at http://www.uspto.gov/trademarks/teas/response_forms.jsp.

(3) QUESTIONS: For questions about the contents of the Office action itself, please contact the assigned trademark examining attorney. For *technical* assistance in accessing or viewing the Office action in the Trademark Status and Document Retrieval (TSDR) system, please e-mail TSDR@uspto.gov.

WARNING

Failure to file the required response by the applicable response deadline will result in the

ABANDONMENT of your application. For more information regarding abandonment, see <http://www.uspto.gov/trademarks/basics/abandon.jsp>.

PRIVATE COMPANY SOLICITATIONS REGARDING YOUR APPLICATION: Private companies **not** associated with the USPTO are using information provided in trademark applications to mail or e-mail trademark-related solicitations. These companies often use names that closely resemble the USPTO and their solicitations may look like an official government document. Many solicitations require that you pay “fees.”

Please carefully review all correspondence you receive regarding this application to make sure that you are responding to an official document from the USPTO rather than a private company solicitation. All official USPTO correspondence will be mailed only from the “United States Patent and Trademark Office” in Alexandria, VA; or sent by e-mail from the domain “@uspto.gov.” For more information on how to handle private company solicitations, see http://www.uspto.gov/trademarks/solicitation_warnings.jsp.