

  
WINTHROP WEINSTINE  
ATTORNEYS AND COUNSELORS AT LAW

February 18, 2009

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

RE: Request for Reconsideration  
Serial No. 77/236,089  
Filed: July 23, 2007  
For the Mark: BIOPETE  
Our File: 11364.10

Dear Commissioner:

Enclosed for filing in connection with the above-identified matter please find:

1. Request for Reconsideration including Exhibits 1 - 38; and
2. Return receipt postcard.

Very truly yours,

WINTHROP & WEINSTINE, P.A.



Michael T. Olsen

MTO/ame  
Enclosures

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02-23-2009

U.S. Patent & TM Office Mail Stop #30

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant: Advanced Extrusion, Inc.

Our Ref.: 11364.10

Serial No.: 77/236,089

Examiner: Asmat Khan

Filed: July 23, 2007

Law Office: 114

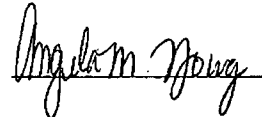
Mark: BIOPETE

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CERTIFICATE OF MAILING 37 C.F.R. 1.8

I hereby certify that this correspondence is being deposited with the U.S. Postal Service as First Class Mail in an envelope addressed to: Commissioner for Trademarks, P.O. Box 1451, Arlington, VA 22313-1451, on the date below:

Date: February 18, 2009



**REQUEST FOR RECONSIDERATION**

On August 18, 2008, the Examining Attorney issued a final refusal to register Applicant's distinctive BIOPETE mark on the ground that when used on or in connection with the identified goods, merely describes Applicant's goods. There is no competitive need to use Applicant's mark to identify goods related to those goods identified in Applicant's application. Therefore, Applicant respectfully requests that the Examining Attorney reconsider his position, withdraw the refusal to register Applicant's mark, and issue the Notice of Publication.

- I. THE TRADEMARK OFFICE HAS CONSISTENTLY HELD THAT MARKS COMBINING BIO WITH ANOTHER TERM ARE SUGGESTIVE

The Examining Attorney maintained the registration refusal based on the assumption that the terms BIO and PETE are barely descriptive because the identification of goods description contains the term "biodegradable" and "polyethylene trephthalate." (See Final Office Action.) However, there are several marks registered on the principal register that contain the term BIO that

are registered for product descriptions that are identified as "biodegradable" including the following that are registered on the Principal Register:

Exhibit No.	Mark	Status	Goods/Services	Owner
1	BIO FABRICPEGS	Registered	Biodegradable plastic pegs for use in securing landscape fabric to the ground	Easy Gardener Products, Inc.
2	POLYBIOETHYLENE	Registered	Biodegradable plastic bags for general use	AMKO Plastics Inc.
3	BIOMAX	Registered	High-density polyethylene plastic containers for medical waste for use in hospital operations rooms	Covidien AG
4	BIO-STAKE	Registered	Biodegradable non-metal stakes used in the ground to hold down or hold up items, particularly for use in staking down soil erosion control mats	North American Green, Inc.
5	BIO SOLVE	Registered	Water soluble petroleum neutralizing and dispersing agent that renders petroleum based spills non-flammable and biodegradable	Westford Chemical Corporation, The
6	BIO-SOFT	Registered	Biodegradable Detergents for Industrial and Household Use	Stepan Chemical Company
7	BIOTAK	Registered	Biodegradable adhesive labels; Biodegradable and compostable adhesive for stationery purposes	Berkshire Labels Ltd
8	BIO-FLEX	Registered	Chemical preparations for scientific purposes; unprocessed plastics, unprocessed plastics from regrowing raw products in the nature of native polymers, Biodegradable unprocessed plastics, unprocessed plastics from regrowing natural sources, Biodegradable plastics from	FKuR Kunststoff GmbH

			regrowing raw products in the form of pellets, compounds of polymers, namely, polymer alloy compositions used for blown films, extruded sheets and/or profiles or containers, foamed and/or molded and/or thermoformed products; native polymers, namely, polymer resins used in the manufacture of resin or fiber composites; chemical processing agents in form of master batches, namely, plasticizers, blowing agents, release agents, coloring agents, foam control agents, crosslinking agents	
9	BIOGEOCHEMIX	Registered	Chemicals for treating industrial and hazardous wastes, namely, proprietary biodegradable mixtures of solid inorganic and organic amendments designed to promote the anaerobic biodegradation, transformation and detoxification of organic and inorganic contaminants in solid, industrial and hazardous wastes in the environment	Geovation Engineering, P.C.
10	ENVIRO-BIO	Registered	Biodegradable microorganisms, enzymes, and nutrients therefor for use in the breakdown of waste water	Buckland Enterprises, Inc.
11	BIO-TERGE	Registered	Biodegradable Detergents for Industrial and Household Use	Stepan Company

12	BIOQUEST	Registered	Combination of biodegradable ingredients consisting of surfactant, enzymes and a natural water softener sold in a laundry detergent	Alticor Inc.
13.	BIOPROGRESS	Registered	Disposable diapers, absorbent disposable diapers for babies and pets, paper and cellulose disposable diapers, biodegradable disposable diapers	BioProgress Technology International, Inc.

(Attached as Exhibits 1 – 13 are true and correct copies of the certificates of registration for the marks identified in the chart.) The Examining Attorney will note that none of the above identified marks were required to disclaim the term BIO or claim distinctiveness as it concerns the term BIO.

The Examining Attorney will further note that the Trademark Office has also registered marks containing the term BIO that are much more descriptive than Applicant's mark. For example, BIO FABRICPEGS was registered for biodegradable plastic pegs or securing fabric, BIO-STAKE was registered for biodegradable non-metal stakes, and BIO SOLVE was registered in connection with a biodegradable solution. (*See, supra*, Exhibits 1,4, and 5.) The above registrations clearly establish that the Trademark Office considers the term BIO worthy of being registered on the principal register when such term is combined with other terms even highly descriptive terms despite the fact that the identification of goods for such marks include the term biodegradable in the identification of goods description.

Additionally, the Trademark Office has registered several marks that contain the term PET in connection with goods that include the term "polyethylene" in the identification of goods description. The following marks are registered on the Principal Register:

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