

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: The Ronald Reagan Presidential Foundation
Serial No.: 85/233,487
Filed: February 3, 2011
Mark: GUIDECAM
Examiner: Jennifer Vasquez
Law Office: 113

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

REQUEST FOR RECONSIDERATION IN RESPONSE TO FINAL OFFICE ACTION
DATED JUNE 14, 2012

The Ronald Reagan Presidential Foundation, the applicant in the above-identified application (“Applicant”), respectfully submits this request for reconsideration in response to the final Office Action dated June 14, 2012. In this Office Action, the Examining Attorney has made final: (i) the refusal to register based on the mark GUIDECAM being merely descriptive of Applicant’s designated goods and/or services; and (ii) the rejection of the Class 9 specimen based on the devices not being “goods in trade.”

As discussed more fully below, Applicant submits herewith an amendment to seek, in the alternative, registration of GUIDECAM based on acquired distinctiveness under the provisions of Section 2(f) of the Lanham Act. As to the “goods in trade” rejection of the Class 9 specimen, Applicant is simultaneously filing a Request to Divide pursuant to Trademark Board Manual of Procedure § 1205.02 to divide into two separate applications the Class 9 goods and the Class 39

services. If the Examining Attorney accepts the Applicant's claim of acquired distinctiveness, Applicant is proposing, in the alternative, to amend the filing basis in the application for the Class 9 goods to Section 1(b), thereby eliminating the basis for the "goods in trade" rejection.

Refusal to Register Based On Descriptiveness

Applicant seeks to register the mark GUIDECAM for the following goods and services: "wireless devices featuring software for facilitation of tours of museums; interactive wireless devices for capturing and uploading digital images for future use" in Class 9; and "providing self-guided tour services via wireless devices featuring prerecorded information about museum exhibits" in Class 39. In the June 14, 2012 Office Action, the Examining Attorney has made final her refusal to register under Trademark Act § 2(e)(1), 15 U.S.C. § 1052 (e)(1) asserting that the mark GUIDECAM "merely describes a feature of Applicant's goods and/or services." June 14, 2012 Office Action at p. 1.

Applicant maintains its position that the mark GUIDECAM is inherently distinctive as to its goods and services and, simultaneously herewith, has filed a Notice of Appeal. However, Applicant also believes that the GUIDECAM mark has acquired distinctiveness with respect to its goods and services pursuant to Trademark Act § 2(f), 15 U.S.C. § 1052(f). Thus, pursuant to Trademark Manual of Examining Procedure § 1212.02(c), with this Request for Reconsideration, Applicant hereby amends the application to seek, in the alternative, registration of GUIDECAM on the Principal Register pursuant to Section 2(f) of the Lanham Act, 15 U.S.C. § 1052(f). This alternative claim does not constitute a concession that the GUIDECAM mark is not inherently distinctive. TMEP § 1212.02(c). Accordingly, in the event GUIDECAM is not registered on the Principal Register under Section 2(f), Applicant preserves the right to appeal that GUIDECAM is

inherently distinctive. *See* TBMP § 1215 (stating that an applicant may present alternative positions on appeal).

As discussed in the declaration and as shown by evidence submitted herewith pursuant to 37 C.F.R. § 2.41, the GUIDECAM mark has become distinctive of Applicant's goods and services based upon: (i) Applicant's "substantially exclusive and continuous use" of GUIDECAM in commerce for such goods and services since at least as early as February, 2011; (ii) consumers' substantial exposure to the mark by virtue of Applicant's advertising and promotion efforts; and (iii) the success of those advertising and promotion efforts in obtaining recognition of GUIDECAM by consumers as evidenced by the substantial revenues generated for GUIDECAM goods and services in a relatively short period of time and unsolicited media attention to Applicant's GUIDECAM goods and services.

A. Substantially Exclusive and Continuous Use

Submitted herewith is a Declaration under 37 C.F.R. § 2.20 of Mr. John D. Heubusch, Executive Director of Applicant, with supporting exhibits. ("Heubusch Decl.") This Declaration sets forth facts supporting Applicant's entitlement to the provisions of Section 2(f), including its statement that Applicant has enjoyed substantially exclusive and continuous use of GUIDECAM for the designated goods and services since at least as early as February, 2011. Heubusch Decl. ¶¶ 2-3.

B. Consumers' Substantial Exposure to GUIDECAM Through Applicant's Advertising

As a result of Applicant's advertising and promotion efforts, there has been substantial consumer exposure to the GUIDECAM mark and the goods and services offered thereunder. Applicant's facility, the Ronald Reagan Presidential Library and Museum (the "Reagan

Library"), at which the GUIDECAM goods and services are offered, is visited by an average of approximately 1,000 people from across the country and around the world each day. Heubusch Decl. ¶ 4. According to a February 3, 2011 *Washington Times* article, the Reagan Library is the best-attended of the thirteen presidential libraries in the United States. Heubusch Decl. ¶ 5 and Exhibit C attached thereto.

Upon entering the Reagan Library, visitors are greeted with overhead video monitors that feature GUIDECAM information as well as a continuously playing video featuring a commercial for GUIDECAM. Heubusch Decl. ¶ 6. This commercial may be viewed on Applicant's website at the following link: <http://www.reaganfoundation.org/guidecam-tour.aspx>. *Id.* Still shots of this commercial and a transcription of the commercial are shown at Exhibit A of the Heubusch Declaration. *Id.* This commercial demonstrates the use of the GUIDECAM device, encourages the visitor to rent a GUIDECAM device and directs the visitor to the GUIDECAM display where the visitor can be assisted by the GUIDECAM team to rent the device and learn how to use the device. *Id.* As a result, this GUIDECAM commercial has been viewed at the Reagan Library by at least 500,000 people since the GUIDECAM goods and services became available at the Reagan Library in February 2011. Heubusch Decl. ¶ 7.

Applicant has invested at least \$80,000 in advertising and promoting goods and services under the GUIDECAM mark, via the Internet, the aforementioned commercial, and in other ways customary to the trade. Heubusch Decl. ¶ 8. For example, Exhibit D of the Heubusch Declaration is the relevant part of a 6 page paid newspaper advertising supplement run in the *Daily News*, a Los Angeles newspaper, shortly after the renovation of the Reagan Library and the

introduction of GUIDECAM. *Id.* This advertisement conveys to consumers how their experience at the Reagan Library can be enhanced by GUIDECAM goods and services.

Upgrade your visit to the Ronald Reagan Presidential Library and Museum with our one-of-a-kind GuideCam™! This special, patent-pending device, uses iOS and web technologies to provide a state-of-the-art audio tour of the Museum, featuring a still camera and video camera for you to capture your special moments that will last a life time.

Id. at Exhibit D.

A copy of pages from Applicant's website advertising the GUIDECAM goods and services is shown at Exhibit B of the Heubusch Declaration. Heubusch Decl. ¶ 9. In addition to the aforementioned commercial, the website also prominently features the goods, including a photograph of a display of the GUIDECAM devices at the Reagan Library. *Id.* This GUIDECAM display photograph is featured as one of the rotating banners at the top of Applicant's website homepage and, as a result, at least 1.3 million viewers have been exposed to GUIDECAM through the website homepage since GUIDECAM goods and services were first introduced at the Reagan Library in February 2011. *See Id.*

Additionally, over 85,000 people have viewed the detailed webpage shown at Heubusch Declaration Exhibit B advertising and describing the GUIDECAM goods and services or the GUIDECAM commercial online. *Id.* The website describes the experience to the consumer provided by GUIDECAM goods and services as follows:

Through the use of cutting edge technology, the newly renovated Ronald Reagan Presidential Library and Museum encourages interactivity through dozens of hands-on exhibits and through the use of our new, one-of-a-kind GuideCam™.

This special, patent-pending device provides a state-of-the-art audio tour of the Museum, featuring over 50 audio stops in the

voices of President and Mrs. Reagan. But the GuideCam™ is more than just an audio wand. The GuideCam™ is also a still camera and video camera. Take photos and video throughout your museum experience capturing your special moments that will last a life time. By the time you get home from your museum visit, all of your photos and video will be waiting for you in your email inbox! Share your photos and videos with your friends and family through email, FaceBook, YouTube and Twitter!

If you're visiting the Reagan Library, make sure to enhance your visit with the GuideCam™. You'll be glad you did!

Heubusch Decl., Exhibit B.

Finally, Heubusch Declaration Exhibit E displays a typical "rack card" advertisement featuring GUIDECAM as a part of the Reagan Library experience that is used to advertise GUIDECAM goods and services to tour groups and in local hotels and businesses. Heubusch Decl. ¶ 10. This "rack card" advertisement depicts the device and the GUIDECAM mark and provides pricing for the GUIDECAM audio/video tour. Heubusch Decl., Exhibit E.

C. Revenues and Media Coverage

The success of Applicant's advertising and promotion in obtaining recognition of the GUIDECAM mark by consumers of Applicant's goods and services is evidenced by the substantial revenues generated for GUIDECAM in a relatively short period of time and unsolicited media coverage. Approximately 100 visitors to the Reagan Library each day choose the GUIDECAM device and service as an alternative to a self-tour. Heubusch Decl. ¶ 11. As a result, to date, over 66,000 people have used the GUIDECAM goods and services, resulting in rental fees in excess of \$380,000 since February 2011. *Id.*

As a result of the Foundation's advertising and promotion of the GUIDECAM goods and services and the technological innovation that the device embodies, the GUIDECAM mark has

received unsolicited media attention. In the *Washington Times* article at Exhibit C of the Heubusch Declaration, the article discussed GUIDECAM as follows:

The museum is also a technological innovator. It's the first to employ the GuideCam, an Apple collaboration that looks like an iPhone but enables patrons to take photos and shoot video during their tour. When they're finished, they return the GuideCam, and before they've arrived home, their photos and video have been sent to their e-mail addresses.

The museum's patent on the device is pending, but the GuideCam is just one way of compelling the attention of museum viewers. ...

Heubusch Decl. ¶ 12.

In light of the above comments, Applicant respectfully asserts that GUIDECAM has acquired secondary meaning to support its alternative claim for registration under Section 2(f) of the Lanham Act, 15 U.S.C. § 1052(f).

Rejection of Class 9 Specimen Based on Devices Not Being “Goods in Trade”

In the June 14, 2012 Office Action, the Examining Attorney has made final her refusal to accept the specimen filed to show use of the mark for the goods designated in Class 9 asserting it does not show the applied-for mark in use in commerce. June 14, 2012 Office Action at p. 5. This “goods in trade” rejection has been made only with respect to the Class 9 goods. June 14, 2012 Office Action at p. 3. The Examining Attorney states that Applicant may withdraw the amendment to allege use and assert use at a later date when proper specimens become available. June 14, 2012 Office Action at p. 4.

Applicant maintains its position that the Class 9 specimens of record show use of the mark for goods in trade and, simultaneously herewith, has filed a Notice of Appeal. However, because this rejection applies only to the Class 9 goods – not the Class 39 services – Applicant is

simultaneously filing a Request to Divide pursuant to TBMP § 1205.02 to divide into two separate applications the Class 9 goods and the Class 39 services. If the Examining Attorney accepts Applicant's claim of acquired distinctiveness, Applicant proposes, in the alternative, to amend the filing basis in the application for the Class 9 goods to Section 1(b), thereby eliminating the basis for the "goods in trade" rejection. This alternative claim does not constitute a concession that the Class 9 specimen of record does not show use of the mark for "goods in trade" and, accordingly, Applicant preserves the right to present arguments with respect to same on appeal. *See* TBMP § 1215 (stating that an applicant may present alternative positions on appeal).

Amending the application for the Class 9 goods to seek registration on the basis of Section 1(b) does not preclude a claim of acquired distinctiveness under Section 2(f). TMEP § 1212.09(a). The Trademark Trial and Appeal Board has set forth the requirements for showing that a mark in an intent-to-use application has acquired distinctiveness:

The required showing is essentially two-fold. First, Applicant must establish, through appropriate submission, the acquired distinctiveness of the same mark in connection with the specified other goods and/or services in connection with which the mark is in use in commerce. . . . Second, Applicant must establish, through submission of relevant evidence rather than mere conjecture, a sufficient relationship between the goods or services in connection with which the mark has acquired distinctiveness and the goods or services recited in the intent-to-use application to warrant the conclusion that the previously created distinctiveness will transfer to the goods or services in the application upon use.

Id.

The showing necessary to establish relatedness will vary from case to case, depending on the nature of the goods or services involved and the language used to identify them. *Id.* at 1200-264. There is no absolute rule that applicant must submit extrinsic evidence to support its

contention that the goods are related in every case. *Id.* (citing *Kellogg Co. v. Gen. Mills, Inc.*, 82 USPQ2d 1766, 1771 (TTAB 2007) (deeming close relationship between cereal and food bars derived from cereal “self evident from the respective identifications of goods”)).

Applicant believes, based on the arguments and evidence of record, that it has made the showing of acquired distinctiveness with respect to the Class 39 services for which the GUIDECAM mark is in use. With respect to the second requirement, Applicant further believes that the inherent relatedness of its designated goods and services means that there is a strong likelihood that the service mark significance will transfer to the related devices. The language used to identify the goods and services in the applications alone shows their inherent relatedness. However, the arguments and evidence of record further show that both the goods and the services are an inherent part of the visitor’s experience at the Reagan Library. It would not be possible for Applicant to offer its “self-guided tour services via wireless devices” without the unique device. A visitor to the Reagan Library will not focus on the Trademark Law technicalities of whether he or she is receiving a good or a service. The consumer will only know that the presentation of GUIDECAM and use of the device will enhance his or her experience as he or she tours the Reagan Library.

In view of the relatedness of the GUIDECAM goods and services and the showing of acquired distinctiveness, at least with respect to services, the previously created distinctiveness will transfer to the goods at such a time as the Applicant files a specimen showing use of the mark for the devices that is acceptable to the Examining Attorney. Accordingly, Applicant has satisfied the requirements for showing that the mark in an intent-to-use application has acquired distinctiveness. Accordingly, if the Examining Attorney will accept the arguments above with

respect to acquired distinctiveness, Applicant proposes, in the alternative, to amend the application for the Class 9 goods to Section 1(b) thereby eliminating the “goods in trade” rejection with respect to the Class 9 goods.

Conclusion

In view of the foregoing, Applicant respectfully submits that its Class 9 and Class 39 applications for the mark GUIDECAM are in condition for publication. However, the Examining Attorney is requested to contact the undersigned by telephone, if a telephone conversation would expedite publication. Accordingly, Applicant respectfully requests that the applications be permitted to proceed to publication.

Dated: December 14, 2012

Respectfully submitted,

/s/ Linda M. Merritt

Linda M. Merritt
Attorney for Applicant
Fulbright & Jaworski L.L.P.
2200 Ross Avenue, Suite 2800
Dallas, Texas 75201-2784
Telephone: 214-855-8331
Telecopier: 214-855-8200