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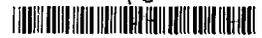
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ATTY. DOCKET NO. ATI-4.2.099/3402

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

APPLICANT : ATICO INTERNATIONAL USA INC.
MARK : SUPER ALKALINE
SERIAL NO. : 76/045,182
FILING DATE : May 10, 2000



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APPLICANT'S REPLY BRIEF

Applicant Atico International USA Inc. (“Atico”), respectfully submits this memorandum in reply to the Examining Attorney’s Appeal Brief, and in further support of Atico’s appeal of the Examining Attorney’s refusal to register the trademark “SUPER ALKALINE”.

ARGUMENT

I. THE EXAMINING ATTORNEY’S ARGUMENTS ARE UNPERSUASIVE

The Examining Attorney’s brief consists of little more than: (i) a re-hash of the descriptiveness and laudation boilerplate from his Office Actions; (ii) ultimately vain efforts to distinguish the authority cited by Atico; (iii) unavailing reliance on authority either already distinguished by Atico (because already cited in an Office Action), or distinguishable now; and (iv) conclusory statements of the alleged descriptiveness of Atico’s proposed mark SUPER ALKALINE.¹ This is insufficient to refute the merits of the instant appeal, clearly established in Atico’s Applicant’s Appeal Brief. The appeal should be sustained and the refusal to register the proposed mark SUPER ALKALINE reversed.

A. Atico’s Cited Authority is Relevant, and Supports Registration

The Examining Attorney’s attempt to distinguish this Board’s decision in *In re Ralston Purina Co.*, 191 USPQ 237 (TTAB 1976) is trumped by his own argument. (Examining Attorney’s Appeal Brief (“EB”) at 7-8). As the Examining Attorney notes, the mark RALSTON SUPER SLUSH was proffered in connection with a concentrate for making a slush type drink. (*Id.*). In reversing the refusal to register the mark, this Board specifically stated that “whether a term or word is merely descriptive must be decided in relation to the goods or services for which registration is sought, the context in which it is used, and the average purchasers of such goods or services.” 191 USPQ at

¹ The Examining Attorney’s “Preliminary Objection” is unrelated to the substance of the instant appeal, and need not be considered.

237-8, *cit. omit.*

As for the use of the formative SUPER in RALSTON SUPER SLUSH, the Board held:

As shown by the applicant and the Examiner the term “SUPER” has been held to be both descriptive and suggestive. The term “SUPER” can be descriptive: consider, for example, the difference in meaning of the terms “weapon” and “super weapon” in context of an arms race. On the other hand, consider the meaning of the term in modern day advertising where it is used as mere puffery and product manufacturers use it, not to describe size or other attributes of the product, but merely to connote a vague desirable characteristic or quality allegedly connected with the product. **The term “SUPER” is used in the present situation in the latter manner. It is not used to describe any real or specific item or characteristic or quality and is therefore not merely descriptive of the goods in connection with which it is used within the meaning of Section 2(e) (1).**

191 USPQ at 238; *emph. add.*

Atico’s use of the formative SUPER in the proposed mark SUPER ALKALINE is precisely the same. Notwithstanding the Examining Attorney’s conclusory statements to the contrary, *cf. infra*, it is clear that Atico’s use of the formative is “merely to connote a vaguely desirable characteristic or quality allegedly connected with the product.” In light of *Ralston Purina*, the refusal to register is improper and should be reversed.

The Examining Attorney’s effort to distinguish *Ralston Purina* on the basis that “[i]n this instance, the term SUPER is used to describe a real and specific item, namely an alkaline battery,” is curious and unavailing. (EB at 8). Applicant’s identified goods, *viz.*, are no more “real and specific” than is the drink concentrate at issue therein. The argument merely exists, without foundation, and without apparent relevance.

With respect to *In re Occidental Petroleum Corp.*, 167 USPQ 128 (TTAB 1970), the Board there, also reversing a refusal to register the mark SUPER IRON under 15 U.S.C. §1052(e)(1), stated:

The examiner bases his refusal on the fact that “super” is variously

defined as “having the (specified) ingredient present in a large or unusually large proportion” and “superfine or superior quality or grade”. It is therefore reasoned that applicant's mark means either that its soil supplement contains an unusually large proportion of iron or is of superior quality and is therefore merely descriptive of a quality or ingredient of the goods.

The difficulty with the above approach, however, is that it takes some roundabout reasoning to make a determination of what the mark actually describes. In our opinion, “SUPER IRON” merely suggests that the product contains a larger amount of iron than most soil supplements or that this iron, again an ingredient, is superior in quality to iron found in other soil supplements. **This, in our opinion, is distinguishable from the situation where the superlative term “super” is combined with the name of an applicant's goods.**

167 USPQ at 128; *emph. add.*

Again, it is the same with Atico's proposed mark SUPER ALKALINE. The Examining Attorney's bald assertion to the contrary notwithstanding, *cf. infra*, the proposed mark is not merely a combination of the superlative SUPER with the name of the identified goods, viz., batteries.

The Examining Attorney's comment on *Occidental Petroleum*, that the “roundabout reasoning” therein described is “most likely” based on the fact that the applicant's goods contain only 12% iron, is sheer conjecture. (EB at 7). The proffered extrapolation, that “[i]n this instance, roundabout reasoning is not needed,” is supported by the bald assertion just mentioned, and traversed herein, namely, “[t]he term SUPER is combined with the term ALKALINE, which is the name of the applicant's batteries as well as a dominant feature of the goods.” (*Id.*).

The Examining Attorney attempts to distinguish the clearly relevant *Occidental Petroleum* decision on the basis of conjecture and a facially unsupported and incorrect assertion. As with his efforts vis-à-vis *Ralston Purina*, this is insufficient. The case is relevant, and supports registration of Atico's proposed mark, SUPER ALKALINE.

B. The Examining Attorney's Conclusive Statements are not Proof

The Examining Attorney proffers a number of conclusory, unsupported statements in an effort to show that Atico's proposed mark SUPER ALKALINE, for use in connection with batteries, is merely descriptive. However, mere conclusory arguments do not constitute proof of descriptiveness. Ultimately, the Examining Attorney's statements are no more persuasive than his vain efforts to distinguish Atico's cited, relevant authority.

The Examining Attorney's assertion that "the word SUPER combined with the descriptive term ALKALINE results in a term that would be perceived as nothing more than the name of the goods modified by a laudatory adjective," is unsupported conjecture, and internally inconsistent. (EB at 6; *see also*, EB at 9). For the proposed mark to be "nothing more than the name of the goods modified by a laudatory objective," it would need to be on the order of SUPER BATTERY (SUPER BATTERIES) or SUPER ALKALINE BATTERY (SUPER ALKALINE BATTERIES). Of course, it is not. Additionally, the Examining Attorney's argument fails to take into consideration that the Trademark Office already has registered marks falling within his definition, *viz.*, SUPER ENERGY, ALKALINE PLUS, ULTRA ALKALINE.² Accordingly, the Examining Attorney's statement does not even mesh with Trademark Office practice.

The Examining Attorney's argument that "[t]he terms PLUS and ULTRA have different meanings that the term SUPER" is trumped by the commonly accepted dictionary definitions of the respective terms. (EB at 9-10).³ Specifically, compare the following definitions of the foregoing

² Reg. Nos. 2270106, 2360238 and 2385890, respectively.

³ Atico notes that the Examining Attorney, in support of this conclusory statement, attaches merely the most convenient of the dictionary definitions of ULTRA. Atico attaches herewith at Exhibit 1 the dictionary definitions of each of SUPER, PLUS and ULTRA, taken from the *American Heritage Dictionary of the English Language*, Third Edition, pp. 1801, 1394 and 1938, respectively.

terms, found in the *American Heritage Dictionary of the English Language*, Third Edition (*see* Exhibit 1, attached):

SUPER	2. Superior in size, quality, number, or degree. 3.a. Exceeding a norm. b. Excessive in degree or intensity.
PLUS	2. Added or extra.
ULTRA	3. Beyond the normal or proper degree; excessively.

As is apparent from the foregoing, the terms are reasonably equivalent to each other in meaning. The Examining Attorney's effort to discount the Trademark Office registration of ALKALINE PLUS and SUPER ALKALINE, both in connection with batteries, thus is mooted. (EB at 9-10). As noted in Atico's Brief, third-party registrations, while not dispositive, are persuasive. That the cited registrations here are persuasive – and perhaps especially so – is clear from the Examining Attorney's (ultimately fruitless) effort to discount same.

II. THE EXAMINING ATTORNEY'S CITED AUTHORITY IS DISTINGUISHABLE

Atico, in its Applicant's Appeal Brief, already has distinguished the following cases relied on by the Examining Attorney, and therefore need not revisit same: *In re Carter-Wallace, Inc.*, 222 USPQ 729 (TTAB 1984); *In re Consolidated Cigar Co.*, 35 USPQ2d 1290 (TTAB 1995); *Quaker State Oil Refining Corp. v. Quaker State Oil Corp.*, 172 USPQ 361 (CCPA 1972). (EB at 5, 7 and 8-9, respectively; *compare* Atico's Brief ("AB") at 6-7, 5-6 and 7-8, respectively). As for the additional authority cited by the Examining Attorney, it is clearly distinguishable and thus not relevant.

In re United States Steel Corp., 225 USPQ 750 (TTAB 1985)⁴, concerned the refusal to register

⁴ *See*, EB at 5, 8.

the mark SUPEROPE! in connection with wire rope. 225 USPQ at 751. The Board there agreed that “the combination of the word SUPER with the apt descriptive term ROPE results in a term which would be perceived as nothing more than the name of the goods modified by a laudatory adjective indicating the superior quality of appellant's wire rope.” *Id., cit. omit.* The Board specifically distinguished *Ralston Purina*, relevant here. *Id.* The Board explained its reasoning thus:

As we pointed out in *In re General Tire & Rubber Co.*, 194 USPQ 491, 494 (TTAB 1977), in discussing the inapplicability of the *Ralston Purina* reasoning to an attempt to register SUPER STEEL RADIAL for tires, “the context within which the word ‘SUPER’ is used has a great influence on which side of the vague and hazy, but legally determinative, suggestive/descriptive boundary the word falls in any particular case” and “[t]he goods on which the mark is used are also an important consideration.” Applying those contextual factors to the case before us, we find no error in the conclusion of the Examining-Attorney that, as applied to wire rope, and based on what we know concerning appellant's use of SUPEROPE in connection with those goods, the term is merely descriptive within the meaning of Section 2(e)(1).

Id. at 752.

The instant appeal is clearly distinguishable. In contrast to *United States Steel*, Atico is not seeking to register a mark consisting merely of the laudative SUPER and the name of the intended goods. Even *Occidental Petroleum*, discussed, *supra*, finds that sort of mark descriptive. However, with respect to the proposed mark here, it is obvious that the formative SUPER is used “not to describe size or other attributes of the product, but merely to connote a vague desirable characteristic or quality allegedly connected with the product.” *Ralston Purina, supra*, 191 USPQ at 238. This is diametrically opposed to the factual underpinning of *United States Steel*.

In re Samuel Moore & Co., 195 USPQ 237 (TTAB 1977)⁵, concerned the mark SUPERHOSE! for a hydraulic hose made of synthetic resinous material. Again, as opposed to *Occidental Petroleum*

⁵ See, EB at 6.

and *Ralston Purina* and Atico's proposed mark here, the mark there at issue was a combination of the laudative SUPER and the name of the intended goods.

In re Diamond National Corp., 133 USPQ 344 (TTAB 1962)⁶, concerning the mark SUPER CUSHION for egg cartons made of paperboard, held that the mark was descriptive at least partly because of a patent held by applicant for the egg carton, indicating "the egg cartons here involved are of special design and construction to impart a superior 'cushion effect' to the carton which protects and cushions each egg during transportation and storage." 133 USPQ at 344. There is no patent here, nor other objective basis for finding the proposed mark descriptive.

None of the cases cited by the Examining Attorney is sufficiently factually similar to the instant appeal to be relevant. The cases thus do not support the refusal to register the proposed mark SUPER ALKALINE.

⁶ See, EB at 8-9.

III. CONCLUSION

For the foregoing reasons, as well as for those reasons set forth in Applicant's Appeal Brief, the Examining Attorney's refusal to register the proposed mark SUPER ALKALINE should be reversed, and the mark permitted to register on the Principal Register.

Respectfully submitted,
Atico International USA Inc.

Date: February 27, 2002



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U.S. Patent & TMO/TM Mail Rcpt Dt. #7

Re: Applicant: Atico International USA, Inc.
Mark: SUPER ALKALINE
Serial No.: 76/045,182
Filed: May 10, 2000
Our Reference No.: ATI-4.2.009/3402

Dear Sir:

In connection with the above-identified Mark, enclosed please find:

1. An original (signed) and two (2) copies of Applicant's Reply Brief; and
2. Acknowledgment Postcard.

The Commissioner is hereby authorized to charge any additional filing fees to account no. 03-2317.

Respectfully submitted,

Peter T. Cobrin

Enclosures

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