

WPI-106-TM

Serial No. 76/469,860

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Williams Products, Inc.
Serial No. 76/469,860
Filed: November 25, 2002
Title: WILLIAMS PRODUCTS, INC.
Our File: WPI-106-TM

BRIEF ON APPEAL

Commissioner of Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

Sir:

In accordance with the provisions of 37 CFR section 2.142 please enter the following brief on appeal with the above identified matter.

STATUS OF APPLICATION

The Examiner has issued a final refusal to register for the above identified mark on January 22, 2004.

REFUSAL

The Examiner has refused registration alleging that the mark so resembles the marks shown in U.S. registration numbers:

1,090,001 for concrete form hardware;

381,837 for machine tools and holders;

517,355 for the same goods as those of registration number 3

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81,355, but with "Williams" in stylized form;
1,415,609 for substantially the same goods as those of the 1355 and 183
registered but with a style for the mark.

Applicant respectfully submits that the Examiner is in error.

ARGUMENT

First, it is submitted that the services covered by the mark sought to be registered are distinct from the goods of the cited registrations.

Secondly, the purchasers of the goods covered by the registrations appear to be raftsmen who would certainly discern the difference between a distributorship offering specific building supplies and a source of hardware items, e.g. bolt cutters, etc.

Furthermore, it is submitted that the Examiner has erred by failing to look to the mark as a whole. The present mark comprises a fanciful W enclosed within a rectangle, the rectangle being traversed by a horizontal bar with the words "Williams Products, Inc.", disposed below the fanciful W. The Examiner has focused strictly on the word Williams and alleged that the dominant portion of the mark while disregarding the rest of the mark.

It is contended that the initial perception of the mark sought to be registered is the fanciful W. It is the dominant portion of the mark, not "Williams Products, Inc."

Next, the Examiner has erred by not giving the appropriate weight to the fact that the word "Williams" is primarily a surname. Instead, the Examiner has opined that when people are calling for the product they are likely to refer to only the word portion of the mark, rather than an

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initial which merely stands for a word in the mark. Again, this is not the appropriate standard. The norm is consider the marks as to sound and appearance. The differences in appearance between applicant's mark and those of the prior cited registrations are apparent. Within the context the Examiner's disregard for "Williams" being primarily a surname is not understood. The Office has registered numerous marks including the word "Williams". Witness, for example, that in addition, to the four cited registrations a print out from the USPTO website shows a multitude of marks incorporating the word "Williams". It is inescapable that the word "Williams", alone, is inherently weak. As has been previously pointed out, under the guidelines of the Manual of Patent Examining Procedure, primarily surnames are not registerable unless they are

- (a)rare;
- (b)connected with applicants;
- (c)have recognized meaning other than as a surname and
- (d)whether or not the stylization of the lettering is distinctive enough to create a separated commercial impression.

The over 50 existing registrations establish the inherent weakness of the mark. Further, and as noted hereinabove, there is a highly stylized form associated with the unique word of applicants mark. This, it is submitted, creates a separate commercial impression from the other "Williams" registrations.

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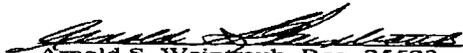
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Thus, it is submitted that the Examiner has erred and reversal of the Examiner i
respectfully submitted.

Respectfully submitted,


Arnold S. Weintraub, Reg. 25523
The Weintraub Group, P.L.C.
32000 Northwestern Highway, Suite 240
Farmington Hills, MI 48334
(248) 865-9430

Dated: Sept. 20, 2004

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CERTIFICATE OF FACSIMILE AND COVER LETTER

Commissioner for Trademarks
 Attn: Examiner, Rebecca L. Gilbert
 Law Office: 113
 Fax No.: (703) 746-8113
 2900 Crystal Drive
 Arlington, Virginia 22202-3513

DATE OF FACSIMILE TRANSMISSION: SEPTEMBER 20, 2004

Transmitted herewith is Applicant's BRIEF ON APPEAL; and CERTIFICATE OF FACSIMILE AND COVER LETTER for the above-identified mark.

 X No additional fee is required.

 Check in the amount of \$_____ is attached

 X Please also charge any additional fees which may be required and/or credit any overpayments to this Deposit Account No. 50-2815.

I hereby certify that this correspondence is being transmitted by facsimile to the United States Patent and Trademark Office to the fax number noted above on the date shown above.


 Rachel Snyder

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AMENDMENT

Commissioner of Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

Sir:

In response to the Office Action of January 22, 2004 and further in connection with the filing of a brief on appeal submitted contemporaneously herewith please amend the application as follows:

Change the identification of the services to:

--Distributorship services in the field of construction materials, including water stops, bearing pads, joint fillers, panel seals, joint seals and masonry accessories in International Class 35.--

Change the classification of the goods to International Class 35

REMARKS

In the above noted Office Action the Examiner has indicated that among Applicant's only options was to file an appeal. This has been done. In order to appropriately examine the mark for registration, it is believed that the above-identified changes to both to the identification of the

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services and the goods renders the mark in more appropriate consideration for determination as to the registerability thereof.

Accordingly, it is respectfully requested that the present amendment be entered into the record.

Respectfully submitted,


Arnold S. Weintraub, Reg. 25523
The Weintraub Group, P.L.C.
32000 Northwestern Highway, Suite 240
Farmington Hills, MI 48334
(248) 865-9430

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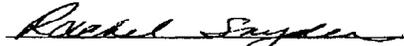
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