

THIS OPINION IS NOT A
PRECEDENT OF THE T.T.A.B.

Hearing:
March 3, 2011

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Great Neck Saw Manufacturers, Inc.

Serial No. 76679933

Joseph J. Previto of Collard & Roe, P.C. for Great Neck Saw
Manufacturers, Inc.

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113 (Odette Bonnet, Managing Attorney).

Before Quinn, Bergsman and Ritchie,
Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

Great Neck Saw Manufacturers, Inc. (applicant), on
July 26, 2007, filed an application to register LOCKBACK in
standard characters for goods ultimately identified as "a
foldable utility knife comprising a handle and a blade with
the blade holder having a removable blade and being
foldable within the handle," in International Class 8. The
application was filed under Section 1(a) of the Trademark
Act of 1946, 15 U.S.C. §1051(a), claiming June 2003 as its
dates of first use anywhere and in commerce. Applicant

claimed ownership of Registration No. 2980151 on the Supplemental Register for the mark LOCK BACK, in standard character form, for "folding utility knife, folding carpet knife," in Class 8.

In response to a Section 2(e)(1) mere descriptiveness refusal, applicant filed an amendment adding a claim of acquired distinctiveness and seeking registration under the provisions of Section 2(f). Upon applicant's amendment seeking registration under the provisions of Section 2(f), the examining attorney refused registration under Section 23 of the Trademark Act, 15 U.S.C. § 1091, on the ground that applicant's proposed mark is generic and, as such, unregistrable. Trademark Manual of Examining Procedure ("TMEP") §1209.02(a)(ii) (7th ed. 2010) (when an applicant amends its application to assert acquired distinctiveness under Section 2(f) in response to a Section 2(e)(1) descriptiveness refusal, if the examining attorney determines that the designation is a generic name for the applicant's goods, the examining attorney should refuse registration on the ground that the mark is generic and stating that the claim of acquired distinctiveness is insufficient to overcome the refusal).

Applicant appealed the refusal to register its mark LOCKBACK on the ground that it is generic and that the

mark has not acquired distinctiveness. The appeal is fully briefed and an oral hearing was conducted on March 3, 2011.

There are two preliminary issues. First, applicant argues that the registration of its mark on the Supplemental Register is "a precedent set by the United States Patent and Trademark Office which the Examiner cannot ignore and abrogate" and the registration on the Supplemental Register "clearly proves that the Patent and Trademark Office has already decided that the mark is not generic and is capable of distinguishing applicant's goods from those of others."¹ However, applicant is advised that a registration issued on the Supplemental Register is not entitled to the presumptions of Section 7(b) of the statute. It does not constitute prima facie evidence of the validity of the registered mark and of the registration of the mark. In fact, it is not prima facie evidence of anything except that the registration issued. *In re Medical Disposables Co.*, 25 USPQ2d 1801, 1805 (TTAB 1992). Accordingly, applicant's ownership of Supplemental Registration No. 2980151 has no probative value. *See In re Nett Designs, Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001) ("The Board must decide each case on its own merits ... Even if some prior registrations had some

¹ Applicant's Brief, p. 2.

characteristics similar to Nett Designs' application, the PTO's allowance of such prior registrations does not bind the Board or this court").

The second issue involves applicant's argument that the district court in the Eastern District of New York has held that LOCK BACK is a valid trademark. Applicant submitted a copy of a consent judgment resolving *Great Neck Saw Manufacturers, Inc. v. United General Supply Co., Inc.*, Civil Action No. 2:06-cv-03691. The parties entered a separate agreement to settle the litigation and to support entry of judgment. The consent judgment provided that Registration No. 2980151 is "valid and enforceable throughout the United States." However, no issues were actually litigated or judicially resolved following a trial in that civil action. Thus, it cannot be said that a court of competent jurisdiction made a finding of fact that Registration No. 2980151 is valid and enforceable. *Cf. Chromalloy American Corporation v. Kenneth Gordon (New Orleans), Ltd.*, 736 F.2d 694, 222 USPQ 187, 189 (Fed. Cir. 1984). In *Chromalloy*, Judge Nies noted that a consent decree cannot dictate the decision of the PTO.

[A] consent given in a decree should be treated as any other contractual consent. A consent cannot *dictate* the decision which the PTO must make on the issue of likelihood of confusion. It

is simply a factor to be taken into consideration. *In re E. I. DuPont deNemours*, 476 F.2d 1357, 1362, 117 USPQ 563, 568 (CCPA 1973); *In re Continental Baking Co.*, 390 F.2d 747, 156 USPQ 514 (CCPA 1968); *accord, Selva & Sons, Inc. v. Nina Footwear, Inc.*, 705 F.2d 1316, 1324, 217 USPQ 641, 647 (Fed.Cir. 1983). Regardless of what private arrangement may exist between parties, no one has a right to a registration contrary to the statute. *Danskin, Inc. v. Dan River, Inc.*, 498 F.2d 1386, 182 USPQ 370 (CCPA 1974), relied on by appellant, did not overrule this general principle.

Id. at 191 n.4. Accordingly, the consent judgment submitted by applicant is probative only of the fact that United General Supply Co., Inc. agreed that applicant's Supplemental Registration No. 2980151 is valid and enforceable to settle a trademark infringement action with applicant.

Whether LOCKBACK is generic?

When a proposed mark is refused registration as generic, the examining attorney has the burden of proving genericness by "clear evidence" thereof. *See In re Hotels.com*, 573 F.3d 1300, 91 USPQ2d 1532, 1533 (Fed. Cir. 2009); *In re Merrill Lynch, Pierce, Fenner & Smith, Inc.*, 828 F.2d 1567, 4 USPQ2d 1141, 1143 (Fed. Cir. 1987); and *In re Gould Paper Corp.*, 834 F.2d 1017, 5 USPQ2d 1110, 1111 (Fed. Cir. 1987).

The critical issue is to determine whether the record shows that members of the relevant public primarily use or understand the term sought to be registered to refer to the category or class of goods in question. *H. Marvin Ginn Corp. v. International Ass'n of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528, 530 (Fed. Cir. 1986); *In re Women's Publishing Co. Inc.*, 23 USPQ2d 1876, 1877 (TTAB 1992). Making this determination "involves a two-step inquiry: First, what is the genus of goods or services at issue? Second, is the term sought to be registered ... understood by the relevant public primarily to refer to that genus of goods or services?" *Ginn*, 228 USPQ at 530. Evidence of the public's understanding of a term may be obtained from any competent source, including testimony, surveys, dictionaries, trade journals, newspapers and other publications. See *Merrill Lynch*, 4 USPQ2d at 1143; *In re Northland Aluminum Products, Inc.*, 777 F.2d 1556, 227 USPQ 961, 963 (Fed. Cir. 1985).

We begin by finding that the genus of goods at issue in this case is adequately defined by applicant's original identification of goods, namely, a folding utility knife and a folding carpet knife. *Magic Wand Inc. v. RDB Inc.*, 940 F.2d 638, 19 USPQ2d 1551, 1552 (Fed. Cir. 1991) ("[A] proper genericness inquiry focuses on the description of

[goods or] services set forth in the [application or] certificate of registration"). Folding utility and carpet knives encompass applicant's description of goods as amended: "a foldable utility knife comprising a handle and a blade with the blade holder having a removable blade and being foldable within the handle." In other words, while the broad category of goods in the present case may be folding utility and carpet knives, there is a narrower category of foldable utility knives comprising a handle and a blade with the blade holder having a removable blade and being foldable within the handle within that broad category. See *In re Wm. B. Coleman Co.*, 93 USPQ2d 2019 (TTAB 2010) (lighting fixtures is a generic term for electric candles); *In re Reed Elsevier Properties, Inc.*, 77 USPQ2d 1649, 1656 (TTAB 2005), *aff'd* 482 F.3d 1376, 82 USPQ2d 1378 (Fed. Cir. 2007) ("the genus of services is providing a web site with a database of information covering the identified topics of law, legal news and legal services and that includes information about lawyers and information from lawyers"); *In re CyberFinancial.Net Inc.*, 65 USPQ2d 1789 (TTAB 2002) (BONDS.COM is generic for "providing information regarding financial products and services via a global computer network and providing electronic commerce services via a global computer network

... with respect to taxable and tax exempt debt instruments" because the services encompass information about bonds); *In re Web Communications*, 49 USPQ2d 1478, 1479 (TTAB 1998) (consulting services include assisting customers in communications through the Internet); *In re Analog Devices, Inc.*, 6 USPQ2d 1808, 1810 (TTAB 1988), *aff'd*, 871 F.2d 1097, 10 USPQ2d 1879 (Fed. Cir. 1989) (unpublished) (registration is properly refused if the subject matter for registration is generic of any one of the goods for which registration is sought); *Cf. In re Stereotaxis Inc.*, 429 F.3d 1039, 77 USPQ2d 1087, 1089 (Fed. Cir. 2005), quoting, *Application of Richardson Ink Co.*, 511 F.2d 559, 185 USPQ 46, 48 (CCPA 1975) ("Our predecessor court...has stated that registration should be refused if the mark is descriptive of any of the goods for which registration is sought").

Turning to the second inquiry, the public's understanding of the term, the relevant public consists of the ordinary consumer interested in purchasing a folding utility knife.

As noted above, the evidentiary burden of establishing that a term is generic rests with the USPTO and the showing must be based on clear evidence. *Merrill Lynch*, 4 USPQ2d at 1143. Based on the record described below, we find that

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there is clear evidence to support a finding that the relevant public, when it considers LOCKBACK in connection with folding utility knives, would readily understand the term to identify a type of folding utility knife.

Applicant's specimen, shown below, is the packaging for its folding utility knife.



The term "Lockback" is used to describe the type of utility knife (*i.e.*, "Folding Lockback Utility Knife"). The term "Lockback" is not set off from the other words with which it is used. "Lockback" is displayed in the same size, font, and style as "Folding" and "Utility Knife." As displayed on the package, consumers would perceive

SHEFFIELD as a trademark, but not "Lockback." In this regard, applicant's use of the federal registration symbol does not transform "Lockback" into a trademark. See *In re Aerospace Optics Inc.*, 78 USPQ2d 1861, 1864 (TTAB 2006); *In re Brass-Craft Manufacturing Co.*, 49 USPQ2d 1849, 1853 (TTAB 1998); *In re Remington Products Inc.*, 3 USPQ2d 1714, 1715 (TTAB 1987) (mere use of the "TM" indicator cannot transform an otherwise unregistrable term into a trademark).

The advertising materials that applicant submitted in its November 30, 2007 response do not show LOCKBACK used as a trademark. Excerpts from "advertisements and promotional materials" are displayed below. In the excerpt directly below, "Lock Back" is not set apart from the other text. "Lock-Back" would be perceived as describing the type of utility knife, not as a trademark.

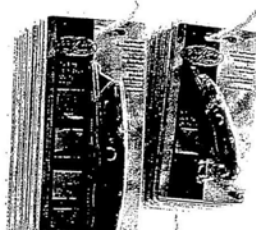


In the excerpt shown below, applicant uses the term "Mini Lock Back Utility Knife With Key Chain" to describe its small lock back utility knife.

2 pc Keychain Tool Kit

12120

- Mini Lock Back Utility Knife With Key Chain
- Mini 9-in-1 Multi Function Pliers



Because there is nothing that sets the term "Lock Back" apart from any other text, consumers would perceive "Lock Back" as identifying the type of utility knife (i.e., a small lock back utility knife), not as a trademark (i.e., a "Lock Back" brand utility knife).

In the excerpt shown below, applicant uses the term "Folding Lockback Utility Knives" to describe the type of product.

Folding Lockback Utility Knives

Sheffield™ *Folding Lockback Utility Knives* offer the ultimate design for all cutting jobs around the house or outside. This series of folding knives is the most popular addition to the Sheffield™ family. They feature stainless steel and lightweight aluminum construction for strength and durability. From the Carpet Knife to the Mini Lockback, all Sheffield™ Utility Knives feature the quick change blade mechanism to ensure a perfect cut every time. They are easy to open with one hand and easy to carry with their convenient belt clips. All Sheffield™ *Folding Lockback Utility Knives* have a Limited Lifetime Warranty.

Consumers will read applicant's advertising text as SHEFFIELD brand folding lockback utility knives.

Under the heading LOCKBACK UTILITY KNIVES applicant advertises numerous types of "Lockback" utility knives (e.g., Folding Lockback Utility Knife, Premium Lockback Utility Knife, Black Lockback Utility Knife, etc.). The first word (i.e., Folding, Premium, and Black) appear to be in a different color than "Lockback Utility Knife").² Thus, the term "Lockback Utility Knife" will be perceived as describing the type of knife.

Finally, under the heading SHEFFIELD TOOL SETS, applicant advertises its SHEFFIELD Premium One Hand Opening Lockback Knife, SHEFFIELD Premium Folding Lockback Utility Knife, SHEFFIELD Folding Lockback Utility Knife, and the SHEFFIELD 2 Piece Ultra Light Lockback Knife Set. Thus, the term "Lockback" is used to describe the type of utility knife.

The examining attorney submitted the following evidence:

1. An excerpt from the Buck Knives website (buckknives.com) regarding "Types of Knives." The website

² The copy of the catalog in the record is in black and white and the first words appear in a different shade.

defines a "lockback" as "a type of folding knife that locks open."³

2. Nine third-party registrations and one application (notice of allowance) using the term "lockback" knives in the description of goods.⁴ The registrations and application show that at least ten entities perceive the term "lockback" as a generic designation for a type of knife.

3. An excerpt from the Rafter KK website (raterkk.com) regarding "Custom Folding Knives."⁵ The excerpt contains the following passage: "The Pair of double-bladed, lock-back pocket knives that are pictured here ... were both taken to Canada on a bear hunt." One of the knives was identified as a "Kiowa Double Back-Lock Folders."

4. In the February 5, 2008 Office Action, the examining attorney submitted excerpts from three websites advertising the sale of MAXAM "lockback knives." The CKBPRODUCTS.com website identifies "Lockback Knives" as a type of knife in its category of products.

³ November 8, 2007 Office Action.

⁴ February 5, 2008 and August 22, 2008 Office Actions. Examining attorneys are required to use generic wording in the description of goods. It is inappropriate to use a registered mark to identify a product. TMEP §1402.09 (7th ed. 2010).

⁵ *Id.*

5. The 888 Knives R Us website (888knivesrus.com) identifies "Lockback Knives" as a category of products.⁶ This website advertises for the sale of "lockback knives" by different manufacturers. For example,

- a. Spyderco⁷
- b. Kershaw⁸
- c. Puma⁹
- d. Bear & Son
- e. Browning
- f. Ka Bar¹⁰
- g. Gerber¹¹
- h. Buck¹²
- i. Bocker
- j. Cold Steel
- k. Fallkniven

⁶ August 22, 2008 Office Action.

⁷ Spyderco lockback knives are also advertised for sale on the and OnlyKnives website (onlyknives.com). (August 22, 2008 Office Action).

⁸ Kershaw lockback knives are also advertised for sale on the Knifestuff website (knifestuff.com). (August 22, 2008 Office Action).

⁹ Puma lockback knives are also advertised for sale on the Bass Pro Shops website (basspro.com). (August 22, 2008).

¹⁰ Ka Bar lockback knives are also advertised for sale on the Knife Shop website (knifeshoponline.com). (August 22, 2008 Office Action).

¹¹ Gerber lockback knives are also advertised for sale on eBay (ebay.com) and the Southern Tackle and Knife sales website (southerntackle.com). (August 22, 2008 Office Action).

¹² Buck lockback knives are also advertised for sale on the Fox Quality Knives website (foxqualityknives.com). (August 22, 2008 Office Action)

1. Remington

6. Other websites attached to the August 28, 2008 website advertise the sale of Tiger, Schrade, Kutmaster, W. R. Case & Sons, Case Hammerhead, Shark Tooth, Mako, Samurai and Jeep "lockback knives."

7. A copy of Patent No. 4173068 for a "Bolster-actuated lockback knife."¹³ The claim is for "a lockback knife having a handle formed with a knife blade receiving recess." The inventor describes a "lockback knife" as employing "a means for locking one or more blades in an extended position for improved safety."

The examples of retailers identifying "lockback" as a category of knives and competitors' use of the term "lockback" as the name of their goods is persuasive evidence that the relevant consumers perceive the term as generic. *Continental Airlines Inc. v. United Airlines Inc.*, 53 USPQ2d 1385, 1395 (TTAB 1999). Indeed, even applicant represents its products as "lockback" knives on its packaging and in its advertising (SHEFFIELD Folding Lockback Utility Knife).

In view of the foregoing, we find that the examining attorney has met her burden of establishing that LOCKBACK

¹³ August 22, 2008.

is generic and incapable of registration for "a foldable utility knife comprising a handle and a blade with the blade holder having a removable blade and being foldable within the handle."

Whether LOCKBACK has acquired distinctiveness?

In the event that our finding of genericness is ultimately reversed on appeal, for the sake of completeness, we now turn to the issue of whether LOCKBACK has acquired distinctiveness. To support its claim of acquired distinctiveness, applicant submitted the declaration of Robert Jacoff, applicant's Executive Vice President. Mr. Jacoff attested to the following facts:

1. Applicant has been using LOCKBACK as a trademark for folding knives since November 1, 2003;
2. Applicant has sold more than 6 million LOCKBACK knives generating revenues in excess of \$25 million;
3. Applicant has spent more than \$175,000 promoting the sale of LOCKBACK knives throughout the United States.

Applicant's evidence is not sufficient to persuade us that LOCKBACK has acquired distinctiveness. First, applicant's use of the term

LOCKBACK is not substantially exclusive. The examining attorney submitted evidence that 22 third parties use "Lockback" to describe a type of knife. Second, applicant's expenditure of \$175,000 promoting the sale of LOCKBACK knives is not impressive. That is approximately \$44,000 per year calculated from the date of first use to the date the declaration was executed. Applicant did not put its advertising expenditures in to context by comparing it to what its competitors spend promoting comparable products. Furthermore, the promotional materials submitted by applicant feature the mark SHEFFIELD much more prominently than the term "Lockback." Accordingly, it is not clear that consumers recognize "Lockback" as pointing uniquely and exclusively to applicant as the source of the knives. Finally, while applicant claimed that it has sold 6 million knives, it did not submit any evidence regarding its market share which would allow us to make an inference as to consumer recognition by putting this number in context. Nor did applicant submit any direct evidence of consumer recognition such as customer testimonials or media stories regarding applicant's LOCKBACK knives.

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To put the matter simply, a good deal more evidence than that offered here is necessary to establish that applicant's mark LOCKBACK has acquired distinctiveness.

Decision: The refusal to register is affirmed.