

PTO Form 1930 (Rev 9/2007)

OMB No. 0651-0050 (Exp. 4/30/2009)

Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	77334679
LAW OFFICE ASSIGNED	LAW OFFICE 114
MARK SECTION (no change)	
ARGUMENT(S)	
<p>I. <u>Introduction</u></p> <p>Applicant has applied to register the mark TRIM A HOME for “electric Christmas lights and lighted Christmas ornaments, which are lighted either electrically or are battery-operated; electric Christmas tree lighted ornaments; outdoor lighted Christmas ornaments” in Class 11; “Christmas pillows; Christmas figurines of plastic” in Class 20; “textile fabric tablecloths, textile placemats, fabric table runners, fabric napkins, potholders and oven mitts, and Christmas towel sets” in Class 24; “artificial Christmas trees, Christmas tree ornaments, Christmas plush toys, and Christmas decorations; fabric and rush Christmas tree skirts and Christmas stockings, namely, stockings made of fabric for the purpose of holding treats and gifts” in Class 28.</p> <p>The Examining Attorney has refused registration on the grounds that the mark TRIM A HOME is merely descriptive of the identified goods and, in the latest Office Action dated October 8, 2009, the Examining Attorney has made his refusal final, further stating “that the applied-for mark may be generic in connection with the identified goods.” The Examining Attorney has also taken the position that Applicant’s specimens of use in Class 20 are unacceptable as “[n]either of Applicant’s Class 20 specimens shows the applied-for mark in use in commerce.” Finally, the Examining Attorney has requested that Applicant provide information regarding the use of the mark by a related company. Applicant respectfully disagrees with each of the above bases for rejection for the reasons set forth below.</p> <p>Applicant has filed a Notice of Appeal of the Examining Attorney’s bases for rejection to the Trademark Trial and Appeal Board (“TTAB”) contemporaneously with this Request for Reconsideration.</p> <p>II. <u>Section 2(e)(1): The Mark Is Not Merely Descriptive, Much Less Generic</u></p> <p>Applicant disagrees with the Examining Attorney’s position that its TRIM A HOME mark is merely descriptive or generic for the following reasons:</p>	

- (A) Applicant's TRIM A HOME mark does not merely describe any of Applicant's applied-for goods;
- (B) The Examining Attorney fails to meet the burden of proving that the applied-for mark is merely descriptive;
- (C) The new evidence presented by the Examining Attorney fails to demonstrate that Applicant's TRIM A HOME mark is merely descriptive, much less generic, of Applicant's goods;
- (D) Any doubt of descriptiveness must be resolved in favor of Applicant; and
- (E) Even if the Examining Attorney has proven that Applicant's TRIM A HOME mark is descriptive, he has certainly not met his higher burden of proving that Applicant's mark is generic.

Applicant's prior arguments regarding the descriptiveness issue, submitted in Applicant's responses dated February 19, 2009 and September 9, 2009, are already of record. Applicant incorporates those arguments herein by reference, but for the sake of brevity does not repeat them in their entirety.

A. Applicant's TRIM A HOME Mark Does Not Merely Describe Any of Applicant's Applied-For Goods

The Examining Attorney argues that the term TRIM A HOME merely describes Applicant's goods because "the word 'trim' . . . means 'to decorate' [and the] word 'home' refers to a residence or house [such that] the combined wording 'trim a home' describes the function or purpose of Applicant's goods, namely, decorative items that are used to decorate or 'trim' a residence or 'home.'"

The terms "trim" and "home," however, do not describe Applicant's various applied-for goods. Rather, at most, those terms merely suggest a potential action that consumers might perform with Applicant's goods. Even assuming that these terms describe the act of decorating a home (which Applicant respectfully asserts it does not), Applicant's mark would, in effect, be at least one step removed from descriptive. Applicant provides a variety of products that can be used as decorations for homes. However, Applicant is not providing home decorating services under the mark TRIM A HOME.

In order to reach the conclusion that Applicant's TRIM A HOME mark has a relationship with Applicant's goods, a consumer could first have to associate the phrase "trim a home" with the art of decorating a home, to the exclusion of other possible meanings of that phrase (e.g., "trimming" a "home's" lawn or bushes, for example, or resurfacing a home's exterior wood paneling, also known as "trim"). He/she would next have to associate the *act* of decorating a home with *products* used to decorate a home. Finally, he/she would have to associate the genus of all types of products that could be used for decorating a home with Applicant's specific holiday-themed products. Thus, the TRIM A HOME mark is at most suggestive of Applicant's products and does not merely describe those products because multiple mental steps are required to ascertain the goods being offered under the mark.

B. The Examining Attorney's Evidence Fails to Meet the Burden of Proving That The Applied-For Mark is Merely Descriptive

It is well settled that the Trademark Office maintains the burden of establishing that a mark is primarily merely descriptive. TMEP §1209.01. In this instance, Applicant respectfully submits that the Examining Attorney has failed to establish that Applicant's mark, as a whole, primarily merely describes the applied-for goods. As Applicant has noted above, the mark TRIM A HOME does not describe Applicant's goods themselves, but rather merely suggests an action that could be taken with those products. Although the Examining Attorney has previously attached some web articles demonstrating that some parties have used 'trim a home' in connection with decorative workshops or departments, this evidence is insufficient to establish descriptiveness since 'trim a home' is not **immediately recognized by consumers** as being descriptive of Applicant's goods. Moreover, **none** of the Examining Attorney's evidence entailed proprietary or descriptive use of 'trim a home' in connection with holiday-themed goods themselves. At most, such evidence shows that third parties may use the phrase "trim a home" in association with holiday-themed retail services. It does not, however, show use as a descriptive term for any of the **products** sold by those retailers.

As Applicant has noted in its prior responses, the Office previously allowed registration of Applicant's identical mark on the Principal Register for similar goods without disclaimer or resort to a Section 2(f) declaration. This allowance is clear evidence that the Trademark Office does not believe consumers would view TRIM A HOME descriptively.

C. The New Evidence Presented by the Examining Attorney in the Latest Office Action Fails to Demonstrate that Applicant's TRIM A HOME Mark is Merely Descriptive of Applicant's Goods

While the Examining Attorney has attached additional articles to the October 8, 2009 Office Action, in the form of printouts appearing to show selected results from a LexisNexis search, a careful examination of that evidence reveals that it fails to show that Applicant's TRIM A HOME mark is merely descriptive, much less generic, for Applicant's identified goods. As the TTAB has noted, the critical issue in determining whether a term is the common descriptive name for goods is whether **the relevant public** primarily uses or understands the term to refer to the category of goods applicant sells under that term. *In re Homes & Land Publishing Corp.*, 24 USPQ2d 1717, 1717-18 (TTAB 1992). However, as described below, the articles relied on by the Examining Attorney fail to demonstrate that the public primarily uses or understands the term "trim a home" to refer to Applicant's goods.

Again, the Examining Attorney has relied upon excerpts from approximately twelve (12) articles or items uncovered in the Examining Attorney's LexisNexis search, out of a total of 139 items which were apparently uncovered by that search. And again, Applicant notes that the Examining Attorney has not complied with the requirements of the TMEP with regard to reliance on such evidence. In relying on such evidence, an Examining Attorney "should include a citation to the research service, indicating the service, the library and the file searched, and the date of the search." TMEP §710.01(a). Additionally, the Examining Attorney should indicate that the portion of the search results placed into the record constitutes a representative sample of what the entire search revealed. *Id.* See also *In re Homes & Land Publishing*, 24 USPQ2d at 1718 ("[W]hen introducing only a portion of the reported articles, the Examining Attorney should indicate whether the ones submitted constitute a representative sample of the whole of the search results."). Moreover, the Examining Attorney likewise failed to include "a clear record of the specific search that was conducted, indicating the libraries or files that were searched and the date of the search," or an "electronic record or printout summarizing the search." TMEP 1211.02(b)(ii). Without this evidence, Applicant is unable to effectively respond to the Examining Attorney's search or show that the articles submitted are not representative of the search as a whole. Because the Examining Attorney has not complied with these requirements, Applicant respectfully submits that the LexisNexis search materials attached to the October 8, 2009 Office Action

are not properly part of the record, and accordingly cannot support the rejection of Applicant's TRIM A HOME mark.

However, assuming *arguendo* that the LexisNexis search materials attached to the October 8, 2009 Office Action are properly part of the record, a careful examination of those materials reveals that they do not support the Examining Attorney's descriptiveness and/or genericness rejections. At the outset, Applicant notes that two of the twelve excerpts cited by the Examining Attorney (Ref. Nos. 72 and 80) involve or refer to the use of TRIM A HOME by Applicant or Applicant's related companies operating under the "Kmart" name. Accordingly, these references undermine, rather than support, the Examining Attorney's position. See *In re Merrill Lynch, Pierce, Fenner and Smith Inc.*, 4 USPQ2d 1141, 1143-44 (Fed. Cir. 1987) (noting that the evidence before the Board showed recognition in a substantial number of publications that the applicant was the source of the services in question, and therefore "does not clearly place [applicant's] mark in the category of a generic or common descriptive term").^[1]

Moreover, at least one reference from the Examining Attorney's LexisNexis search shows the phrase "trim a home" used in direct quotations from representatives of retail stores who were interviewed for the articles in question, not by members of the public. (Ref. No. 76) Applicant respectfully submits that such usage is analogous to use in a trade journal, and likewise does not reflect public understanding of the term "trim a home." See *In re Joint-Stock Company "Baik"*, 84 USPQ2d at 1922 (noting that articles from trade papers which "appear to have limited readership" do not support a finding of descriptiveness).

Applicant further notes that at least six (6) of the references from the Examining Attorney's LexisNexis search, while showing the phrase "trim a home" appearing in a newspaper article, do not identify any goods or services with which the phrase "trim a home" is associated (Ref. Nos. 71, 76, 77, 79, 88, 89 as well as the Examining Attorney's "blog" evidence), and are therefore of no relevance whatsoever. See *In re Industrial Business Services, Inc.*, 2001 WL 831221, *3 (TTAB 2001) (noting that the mere appearance of the term "industrial building services" in a newspaper article "sheds absolutely no light on what these services might be [and] is of no probative value"). As the TTAB has noted in a similar situation, "providing relevant excerpts is imperative." *In re Couture*, 60 USPQ2d at 1318 n.2 (noting that excerpted articles indicating uses of the searched words in relation to Amtrak services, or car sales, or computer software, are of limited probative value in relation to telephone services).

Thus, after carefully examining all of the cited LexisNexis search references from the Examining Attorney's LexisNexis search, it becomes readily apparent that those references do not support the Examining Attorney's position that "trim a home" is merely descriptive or "may be generic in connection with the identified goods." Moreover, Applicant reminds the Examining Attorney that its predecessor, Kmart Properties, Inc., previously owned a registration for the identical TRIM A HOME mark in association with substantially identical goods, U.S. Reg. No. 1,764,356 (see Exhibit A to Applicant's February 19, 2009 response), which included dates of first use in commerce for such goods as early as 1988. In contrast, all of the evidence cited by the Examining Attorney dates from 1994 and later, and therefore clearly postdates Applicant's own trademark use of TRIM A HOME by many years. See *In re Merrill Lynch*, 4 USPQ2d at 1143 ("The mixture of usages unearthed by the NEXIS computerized retrieval service does not show, by clear evidence, that the financial community views and uses the term CASH MANAGEMENT ACCOUNT as a generic, common descriptive term for the brokerage services to which Merrill Lynch first applied the term.").

For the reasons set forth above, the additional evidence cited by the Examining Attorney fails to

demonstrate that Applicant's TRIM A HOME mark is merely descriptive, much less generic, for Applicant's goods. Accordingly, Applicant requests that the Examining Attorney withdraw his refusal of Applicant's TRIM A HOME mark under §2(c)(1), on the basis that the mark is merely descriptive and/or generic for Applicant's goods.

D. Any Doubt as to Descriptiveness Should Be Resolved in Applicant's Favor

Doubt as to whether marks are descriptive is to be resolved in favor of the Applicant. As McCarthy states:

Because the line between merely descriptive and only suggestive terms is 'so nebulous,' the Trademark Board takes the position that doubt is resolved in favor of the applicant on the assumption that competitors have the opportunity to oppose the registration once published and to present evidence that is usually not present in ex parte examination.

McCarthy, § 11.51 at 100-101; *see also In re Merrill Lynch*, 4 U.S.P.Q.2d at 1144 ("It is incumbent on the Board ... to resolve reasonable doubt in favor of the applicant, in accordance with practice and precedent").

Applicant respectfully submits--particularly in light of the Office's previous allowance and registration of Applicant's identical mark on the Principal Register for similar goods--that Applicant's arguments and evidence cast serious doubt on the Examining Attorney's position that Applicant's TRIM A HOME mark is merely descriptive of Applicant's goods. As such, in accordance with practice and precedent, those doubts should be resolved in favor of Applicant.

E. Even if the Examining Attorney Had Demonstrated that Applicant's TRIM A HOME Mark is Descriptive, He Has Not Met the Higher Burden of Demonstrating that Applicant's Mark is Generic

Even assuming that the Examining Attorney had met the burden of proving that Applicant's mark is descriptive (which Applicant disputes), he has certainly failed to meet "the burden of proving that [the mark] is generic by clear evidence." TMEP § 1209.01(c)(i). "Generic terms are terms that the relevant purchasing public understands primarily *as the common or class name for the goods.*" TMEP § 1209.01(c).

The Examining Attorney has not met the clear burden of establishing that the words "TRIM A HOME" are understood by the relevant purchasing public as the "common or class name" for Christmas decorations in Classes 11, 20 or 28, or for textile and fabric products in Class 24. In fact, the Examining Attorney has not submitted any evidence that these words are understood by the relevant purchasing public to mean anything at all. Rather, the Examining Attorney has merely submitted articles in which the words "TRIM A HOME" appear in a variety of contexts, and asserted that the appearance of these words in the articles alone establishes that "TRIM A HOME" is understood by the relevant purchasing public as the generic name for all of Applicant's goods. Such "evidence" without more, is certainly insufficient to meet the "clear" evidentiary burden required by a determination that a mark is generic. *In re Digital Oilfield, Inc.*, 2008 TTAB LEXIS 83, *14-*20 (April 17, 2008) (holding that the Examining Attorney failed to meet "the heavy burden the USPTO faces in establishing that a mark is generic" where "the overwhelming majority of the excerpted materials refer to a 'digital oilfield' as [relating to] various technologies for use in the oil and gas exploration and production process itself [while] the remaining excerpted materials *refer ambiguously to a 'digital oilfield' without defining the nature or category of such goods and/or services*") (emphasis added).

III. Applicant Claims, in the Alternative, Acquired Distinctiveness Under § 2(f)

Should the Examining Attorney not regard the above arguments as persuasive to overcome the descriptiveness rejection, Applicant hereby claims in the alternative that its TRIM A HOME mark has acquired distinctiveness under Section 2(f) of the Trademark Act, by reason of substantially exclusive and continuous use in commerce by the Applicant for the previous five years. TMEP § 1212. As Applicant previously noted, its predecessor and related company, Kmart, used the mark in commerce as early as 1988, and such use by either Kmart or Applicant has been substantially exclusive and continuous for at least the last five years. Moreover, as noted above, while certain articles cited by the Examining Attorney may show use of the term "Trim A Home" in association with retail services provided by other merchants, they do not show any use of "Trim A Home" as a *trademark* for any of Applicant's goods. Thus, Applicant believes that its use of TRIM A HOME as a trademark for such goods has been and remains substantially exclusive. TMEP § 1212.05(b).

Accordingly, Applicant requests that the Examining Attorney allow, for publication on the Principal Register, Applicant's mark based on acquired distinctiveness under § 2(f). Alternatively, if the Examining Attorney refuses to accept Applicant's § 2(f) claim as conclusive evidence of acquired distinctiveness, Applicant respectfully requests that its § 2(f) claim be entered into the record for purposes of consideration on appeal to the TTAB.

IV. Applicant Submits Herewith a New Specimen of Use for Class 20

The Examining Attorney has maintained his position that Applicant's previously-submitted specimen in Class 20 does not show use of the TRIM A HOME mark in connection with pillows or figurines in Class 20. In response thereto, Applicant submits herewith a substitute specimen of use showing the mark used on a tag for a Christmas pillow product. The substitute specimen was in use in commerce at least as early as the filing date of the application.

V. The Examining Attorney's Position That Applicant Must "Explain" How the Mark is Used by a Related Company is Unfounded

Finally, the Examining Attorney included an "advisory" note in the October 8, 2009 Office Action, stating:

"Applicant has noted in its response that another entity is using the proposed mark as depicted in the specimens of record and that this entity is 'under common ownership with Applicant.' Applicant is advised that, if the mark is not being used by the applicant on any substitute specimen submitted but is being used by one or more related companies whose use as depicted in any substitute specimen inures to the benefit of the Applicant under Trademark Act Section 5, then these facts must be disclosed in the application. Such disclosure must indicate that another party may have ownership rights in the applied-for mark, then Applicant must explain: (1) the relationship between Applicant and the party designated by that name; (2) whether that party has any rights in the mark; and (3) how applicant controls any use of the mark by that party." (citing TMEP §§ 1201.03, 1201.04.)

Fortunately, these facts *were* disclosed in the application, when Applicant used identical language for each of the Classes filed, noting that "The Applicant is using the mark in commerce, or the *Applicant's related company or licensee* is using the mark in commerce, or the Applicant's

predecessor in interest used the mark in commerce, on or in connection with the identified goods and/or services.” (See application, emphasis added.) Moreover, the Examining Attorney’s requests for information about the relationship between Applicant and its related company are improper, as noted by the Trademark Manual of Examining Procedure. Indeed, “[w]here the application states that use of the mark is by a related company [as it does here,] the USPTO *does not require an explanation of how the applicant controls the use of the mark.*” TMEP § 1201.03(b) (entitled: “No Explanation of Applicant’s Control Over Use of Mark by Related Companies Required”) (emphasis added); TMEP § 1201.04. “Similarly, the USPTO does not inquire about the relationship between the applicant and other parties named on the specimen or elsewhere in the record, *except when the reference to another party clearly contradicts the applicant’s verified statement that it is the owner of the mark.*” TMEP § 1201.03(b) (emphasis added). Applicant has maintained from the outset of this prosecution that its related company, Kmart, is using the mark in commerce, and has not made any statement that contradicts its claim of ownership of the mark. Thus, the Examining Attorney’s requests for additional information regarding use of the mark by Applicant’s related company are improper, and Applicant need not respond thereto.

VI. Conclusion

In light of the foregoing, Applicant respectfully submits that all of the bases for rejection of its TRIM A HOME mark have been overcome, and that this application is in a *prima facie* condition for allowance. Accordingly, Applicant respectfully requests that the Examining Attorney withdraw the refusal to register Applicant’s TRIM A HOME mark, and allow this application to pass to publication towards registration.

Should anything further be required, a telephone call to the undersigned at (312) 456-8400 is respectfully solicited.

[1] Applicant has identified the references from the Examining Attorney’s LexisNexis search by the result number listed at the top of the first page of each reference (e.g. “72 of 139”).

GOODS AND/OR SERVICES SECTION (011)(no change)

GOODS AND/OR SERVICES SECTION (020)(current)

INTERNATIONAL CLASS	020
DESCRIPTION	Christmas pillows; Christmas figurines of plastic
FILING BASIS	Section 1(a)
FIRST USE ANYWHERE DATE	At least as early as 09/00/1988
FIRST USE IN COMMERCE DATE	At least as early as 09/00/1988

GOODS AND/OR SERVICES SECTION (020)(proposed)

INTERNATIONAL CLASS	020
DESCRIPTION	Christmas pillows; Christmas figurines of plastic
FILING BASIS	Section 1(a)
FIRST USE ANYWHERE DATE	At least as early as 09/00/1988

FIRST USE IN COMMERCE DATE	At least as early as 09/00/1988
STATEMENT TYPE	"The substitute (or new, if appropriate) specimen(s) was/were in use in commerce at least as early as the filing date of the application" [for an application based on Section 1(a), Use in Commerce] OR "The substitute (or new, if appropriate) specimen(s) was/were in use in commerce prior either to the filing of the Amendment to Allege Use or expiration of the filing deadline for filing a Statement of Use" [for an application based on Section 1(b) Intent-to-Use].
SPECIMEN FILE NAME(S)	\\TICRS\EXPORT10\IMAGEOUT 10\773\346\77334679\xml1\ RFR0002.JPG
SPECIMEN DESCRIPTION	a tag bearing the mark used in association with a Christmas pillow product.
GOODS AND/OR SERVICES SECTION (024)(no change)	
GOODS AND/OR SERVICES SECTION (028)(no change)	
ADDITIONAL STATEMENTS SECTION	
SECTION 2(D)	The mark has become distinctive of the goods/services through the applicant's substantially exclusive and continuous use in commerce for at least the five years immediately before the date of this statement.
SIGNATURE SECTION	
DECLARATION SIGNATURE	/Mark R. Galis/
SIGNATORY'S NAME	Mark R. Galis
SIGNATORY'S POSITION	Attorney of record, Illinois bar member
DATE SIGNED	04/08/2010
RESPONSE SIGNATURE	/Mark R. Galis/
SIGNATORY'S NAME	Mark R. Galis
SIGNATORY'S POSITION	Attorney of record, Illinois bar member
DATE SIGNED	04/08/2010
AUTHORIZED SIGNATORY	YES
CONCURRENT APPEAL NOTICE FILED	YES
FILING INFORMATION SECTION	
SUBMIT DATE	Thu Apr 08 17:29:46 EDT 2010
TEAS STAMP	USPTO/RFR-66.151.14.170-2 0100408172946620525-77334

679-4601d781c94fcfbc23945 57c90e15cfdee-N/A-N/A-201 00408172353538207

PTO Form 1930 (Rev 9/2007)

OMB No. 0651-0050 (Exp. 4/30/2009)

Request for Reconsideration after Final Action

To the Commissioner for Trademarks:

Application serial no. 77334679 has been amended as follows:

ARGUMENT(S)

In response to the substantive refusal(s), please note the following:

I. Introduction

Applicant has applied to register the mark TRIM A HOME for “electric Christmas lights and lighted Christmas ornaments, which are lighted either electrically or are battery-operated; electric Christmas tree lighted ornaments; outdoor lighted Christmas ornaments” in Class 11; “Christmas pillows; Christmas figurines of plastic” in Class 20; “textile fabric tablecloths, textile placemats, fabric table runners, fabric napkins, potholders and oven mitts, and Christmas towel sets” in Class 24; “artificial Christmas trees, Christmas tree ornaments, Christmas plush toys, and Christmas decorations; fabric and rush Christmas tree skirts and Christmas stockings, namely, stockings made of fabric for the purpose of holding treats and gifts” in Class 28.

The Examining Attorney has refused registration on the grounds that the mark TRIM A HOME is merely descriptive of the identified goods and, in the latest Office Action dated October 8, 2009, the Examining Attorney has made his refusal final, further stating “that the applied-for mark may be generic in connection with the identified goods.” The Examining Attorney has also taken the position that Applicant’s specimens of use in Class 20 are unacceptable as “[n]either of Applicant’s Class 20 specimens shows the applied-for mark in use in commerce.” Finally, the Examining Attorney has requested that Applicant provide information regarding the use of the mark by a related company. Applicant respectfully disagrees with each of the above bases for rejection for the reasons set forth below.

Applicant has filed a Notice of Appeal of the Examining Attorney’s bases for rejection to the Trademark Trial and Appeal Board (“TTAB”) contemporaneously with this Request for Reconsideration.

II. Section 2(e)(1): The Mark Is Not Merely Descriptive, Much Less Generic

Applicant disagrees with the Examining Attorney’s position that its TRIM A HOME mark is merely descriptive or generic for the following reasons:

(A) Applicant’s TRIM A HOME mark does not merely describe any of Applicant’s applied-for

goods;

(B) The Examining Attorney fails to meet the burden of proving that the applied-for mark is merely descriptive;

(C) The new evidence presented by the Examining Attorney fails to demonstrate that Applicant's TRIM A HOME mark is merely descriptive, much less generic, of Applicant's goods;

(D) Any doubt of descriptiveness must be resolved in favor of Applicant; and

(E) Even if the Examining Attorney has proven that Applicant's TRIM A HOME mark is descriptive, he has certainly not met his higher burden of proving that Applicant's mark is generic.

Applicant's prior arguments regarding the descriptiveness issue, submitted in Applicant's responses dated February 19, 2009 and September 9, 2009, are already of record. Applicant incorporates those arguments herein by reference, but for the sake of brevity does not repeat them in their entirety.

A. Applicant's TRIM A HOME Mark Does Not Merely Describe Any of Applicant's Applied-For Goods

The Examining Attorney argues that the term TRIM A HOME merely describes Applicant's goods because "the word 'trim' . . . means 'to decorate' [and the] word 'home' refers to a residence or house [such that] the combined wording 'trim a home' describes the function or purpose of Applicant's goods, namely, decorative items that are used to decorate or 'trim' a residence or 'home.'"

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In order to reach the conclusion that Applicant's TRIM A HOME mark has a relationship with Applicant's goods, a consumer could first have to associate the phrase "trim a home" with the art of decorating a home, to the exclusion of other possible meanings of that phrase (e.g., "trimming" a "home's" lawn or bushes, for example, or resurfacing a home's exterior wood paneling, also known as "trim"). He/she would next have to associate the *act* of decorating a home with *products* used to decorate a home. Finally, he/she would have to associate the genus of all types of products that could be used for decorating a home with Applicant's specific holiday-themed products. Thus, the TRIM A HOME mark is at most suggestive of Applicant's products and does not merely describe those products because multiple mental steps are required to ascertain the goods being offered under the mark.

B. The Examining Attorney's Evidence Fails to Meet the Burden of Proving That The Applied-For Mark is Merely Descriptive

It is well settled that the Trademark Office maintains the burden of establishing that a mark is primarily merely descriptive. TMEP §1209.01. In this instance, Applicant respectfully submits that the Examining Attorney has failed to establish that Applicant's mark, as a whole, primarily merely describes the applied-for goods. As Applicant has noted above, the mark TRIM A HOME does not describe

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Again, the Examining Attorney has relied upon excerpts from approximately twelve (12) articles or items uncovered in the Examining Attorney's LexisNexis search, out of a total of 139 items which were apparently uncovered by that search. And again, Applicant notes that the Examining Attorney has not complied with the requirements of the TMEP with regard to reliance on such evidence. In relying on such evidence, an Examining Attorney "should include a citation to the research service, indicating the service, the library and the file searched, and the date of the search." TMEP §710.01(a). Additionally, the Examining Attorney should indicate that the portion of the search results placed into the record constitutes a representative sample of what the entire search revealed. *Id.* See also *In re Homes & Land Publishing*, 24 USPQ2d at 1718 ("[W]hen introducing only a portion of the reported articles, the Examining Attorney should indicate whether the ones submitted constitute a representative sample of the whole of the search results."). Moreover, the Examining Attorney likewise failed to include "a clear record of the specific search that was conducted, indicating the libraries or files that were searched and the date of the search," or an "electronic record or printout summarizing the search." TMEP 1211.02(b)(ii). Without this evidence, Applicant is unable to effectively respond to the Examining Attorney's search or show that the articles submitted are not representative of the search as a whole. Because the Examining Attorney has not complied with these requirements, Applicant respectfully submits that the LexisNexis search materials attached to the October 8, 2009 Office Action are not properly part of the record, and accordingly cannot support the rejection of Applicant's TRIM A HOME mark.

However, assuming *arguendo* that the LexisNexis search materials attached to the October 8, 2009 Office Action are properly part of the record, a careful examination of those materials reveals that they do not support the Examining Attorney's descriptiveness and/or genericness rejections. At the

outset, Applicant notes that two of the twelve excerpts cited by the Examining Attorney (Ref. Nos. ^[1] 72 and 80) involve or refer to the use of TRIM A HOME by Applicant or Applicant's related companies operating under the "Kmart" name. Accordingly, these references undermine, rather than support, the Examining Attorney's position. See *In re Merrill Lynch, Pierce, Fenner and Smith Inc.*, 4 USPQ2d 1141, 1143-44 (Fed. Cir. 1987) (noting that the evidence before the Board showed recognition in a substantial number of publications that the applicant was the source of the services in question, and therefore "does not clearly place [applicant's] mark in the category of a generic or common descriptive term").

Moreover, at least one reference from the Examining Attorney's LexisNexis search shows the phrase "trim a home" used in direct quotations from representatives of retail stores who were interviewed for the articles in question, not by members of the public. (Ref. No. 76) Applicant respectfully submits that such usage is analogous to use in a trade journal, and likewise does not reflect public understanding of the term "trim a home." See *In re Joint-Stock Company "Baik,"* 84 USPQ2d at 1922 (noting that articles from trade papers which "appear to have limited readership" do not support a finding of descriptiveness).

Applicant further notes that at least six (6) of the references from the Examining Attorney's LexisNexis search, while showing the phrase "trim a home" appearing in a newspaper article, do not identify any goods or services with which the phrase "trim a home" is associated (Ref. Nos. 71, 76, 77, 79, 88, 89 as well as the Examining Attorney's "blog" evidence), and are therefore of no relevance whatsoever. See *In re Industrial Business Services, Inc.*, 2001 WI. 831221, *3 (TTAB 2001) (noting that the mere appearance of the term "industrial building services" in a newspaper article "sheds absolutely no light on what these services might be [and] is of no probative value"). As the TTAB has noted in a similar situation, "providing relevant excerpts is imperative." *In re Couture*, 60 USPQ2d at 1318 n.2 (noting that excerpted articles indicating uses of the searched words in relation to Amtrak services, or car sales, or computer software, are of limited probative value in relation to telephone services).

Thus, after carefully examining all of the cited LexisNexis search references from the Examining Attorney's LexisNexis search, it becomes readily apparent that those references do not support the Examining Attorney's position that "trim a home" is merely descriptive or "may be generic in connection with the identified goods." Moreover, Applicant reminds the Examining Attorney that its predecessor, Kmart Properties, Inc., previously owned a registration for the identical TRIM A HOME mark in association with substantially identical goods, U.S. Reg. No. 1,764,356 (see Exhibit A to Applicant's February 19, 2009 response), which included dates of first use in commerce for such goods as early as 1988. In contrast, all of the evidence cited by the Examining Attorney dates from 1994 and later, and therefore clearly postdates Applicant's own trademark use of TRIM A HOME by many years. See *In re Merrill Lynch*, 4 USPQ2d at 1143 ("The mixture of usages unearthed by the NEXIS computerized retrieval service does not show, by clear evidence, that the financial community views and uses the term CASH MANAGEMENT ACCOUNT as a generic, common descriptive term for the brokerage services to which Merrill Lynch first applied the term.").

For the reasons set forth above, the additional evidence cited by the Examining Attorney fails to demonstrate that Applicant's TRIM A HOME mark is merely descriptive, much less generic, for Applicant's goods. Accordingly, Applicant requests that the Examining Attorney withdraw his refusal of Applicant's TRIM A HOME mark under §2(e)(1), on the basis that the mark is merely descriptive and/or generic for Applicant's goods.

D. Any Doubt as to Descriptiveness Should Be Resolved in Applicant's Favor

Doubt as to whether marks are descriptive is to be resolved in favor of the Applicant. As McCarthy

states:

Because the line between merely descriptive and only suggestive terms is 'so nebulous,' the Trademark Board takes the position that doubt is resolved in favor of the applicant on the assumption that competitors have the opportunity to oppose the registration once published and to present evidence that is usually not present in ex parte examination.

McCarthy, § 11.51 at 100-101; *see also In re Merrill Lynch*, 4 U.S.P.Q.2d at 1144 ("It is incumbent on the Board ... to resolve reasonable doubt in favor of the applicant, in accordance with practice and precedent").

Applicant respectfully submits--particularly in light of the Office's previous allowance and registration of Applicant's identical mark on the Principal Register for similar goods--that Applicant's arguments and evidence cast serious doubt on the Examining Attorney's position that Applicant's TRIM A HOME mark is merely descriptive of Applicant's goods. As such, in accordance with practice and precedent, those doubts should be resolved in favor of Applicant.

E. Even if the Examining Attorney Had Demonstrated that Applicant's TRIM A HOME Mark is Descriptive, He Has Not Met the Higher Burden of Demonstrating that Applicant's Mark is Generic

Even assuming that the Examining Attorney had met the burden of proving that Applicant's mark is descriptive (which Applicant disputes), he has certainly failed to meet "the burden of proving that [the mark] is generic by clear evidence." TMEP § 1209.01(c)(i). "Generic terms are terms that the relevant purchasing public understands primarily *as the common or class name for the goods*." TMEP § 1209.01(c).

The Examining Attorney has not met the clear burden of establishing that the words "TRIM A HOME" are understood by the relevant purchasing public as the "common or class name" for Christmas decorations in Classes 11, 20 or 28, or for textile and fabric products in Class 24. In fact, the Examining Attorney has not submitted any evidence that these words are understood by the relevant purchasing public to mean anything at all. Rather, the Examining Attorney has merely submitted articles in which the words "TRIM A HOME" appear in a variety of contexts, and asserted that the appearance of these words in the articles alone establishes that "TRIM A HOME" is understood by the relevant purchasing public as the generic name for all of Applicant's goods. Such "evidence" without more, is certainly insufficient to meet the "clear" evidentiary burden required by a determination that a mark is generic. *In re Digital Oilfield, Inc.*, 2008 TTAB LEXIS 83, *14-*20 (April 17, 2008) (holding that the Examining Attorney failed to meet "the heavy burden the USPTO faces in establishing that a mark is generic" where "the overwhelming majority of the excerpted materials refer to a 'digital oilfield' as [relating to] various technologies for use in the oil and gas exploration and production process itself [while] the remaining excerpted materials *refer ambiguously to a 'digital oilfield' without defining the nature or category of such goods and/or services*") (emphasis added).

III. Applicant Claims, in the Alternative, Acquired Distinctiveness Under § 2(f)

Should the Examining Attorney not regard the above arguments as persuasive to overcome the descriptiveness rejection, Applicant hereby claims in the alternative that its TRIM A HOME mark has acquired distinctiveness under Section 2(f) of the Trademark Act, by reason of substantially exclusive and continuous use in commerce by the Applicant for the previous five years. TMEP § 1212. As

Applicant previously noted, its predecessor and related company, Kmart, used the mark in commerce as early as 1988, and such use by either Kmart or Applicant has been substantially exclusive and continuous for at least the last five years. Moreover, as noted above, while certain articles cited by the Examining Attorney may show use of the term "Trim A Home" in association with retail services provided by other merchants, they do not show any use of "Trim A Home" as a *trademark* for any of Applicant's goods. Thus, Applicant believes that its use of TRIM A HOME as a trademark for such goods has been and remains substantially exclusive. TMEP § 1212.05(b).

Accordingly, Applicant requests that the Examining Attorney allow, for publication on the Principal Register, Applicant's mark based on acquired distinctiveness under § 2(f). Alternatively, if the Examining Attorney refuses to accept Applicant's § 2(f) claim as conclusive evidence of acquired distinctiveness, Applicant respectfully requests that its § 2(f) claim be entered into the record for purposes of consideration on appeal to the TTAB.

IV. Applicant Submits Herewith a New Specimen of Use for Class 20

The Examining Attorney has maintained his position that Applicant's previously-submitted specimen in Class 20 does not show use of the TRIM A HOME mark in connection with pillows or figurines in Class 20. In response thereto, Applicant submits herewith a substitute specimen of use showing the mark used on a tag for a Christmas pillow product. The substitute specimen was in use in commerce at least as early as the filing date of the application.

V. The Examining Attorney's Position That Applicant Must "Explain" How the Mark is Used by a Related Company is Unfounded

Finally, the Examining Attorney included an "advisory" note in the October 8, 2009 Office Action, stating:

"Applicant has noted in its response that another entity is using the proposed mark as depicted in the specimens of record and that this entity is 'under common ownership with Applicant.' Applicant is advised that, if the mark is not being used by the applicant on any substitute specimen submitted but is being used by one or more related companies whose use as depicted in any substitute specimen inures to the benefit of the Applicant under Trademark Act Section 5, then these facts must be disclosed in the application. Such disclosure must indicate that another party may have ownership rights in the applied-for mark, then Applicant must explain: (1) the relationship between Applicant and the party designated by that name; (2) whether that party has any rights in the mark; and (3) how applicant controls any use of the mark by that party." (citing TMEP §§ 1201.03, 1201.04.)

Fortunately, these facts *were* disclosed in the application, when Applicant used identical language for each of the Classes filed, noting that "The Applicant is using the mark in commerce, or the *Applicant's related company or licensee* is using the mark in commerce, or the Applicant's predecessor in interest used the mark in commerce, on or in connection with the identified goods and/or services." (See application, emphasis added.) Moreover, the Examining Attorney's requests for information about the relationship between Applicant and its related company are improper, as noted by the Trademark Manual of Examining Procedure. Indeed, "[w]here the application states that use of the mark is by a related company [as it does here,] the USPTO *does not require an explanation of how the applicant controls the use of the mark.*" TMEP § 1201.03(b) (entitled: "No Explanation of Applicant's Control Over Use of Mark by Related Companies Required") (emphasis added); TMEP § 1201.04. "Similarly, the USPTO does not inquire about the relationship between the applicant and other parties named on the specimen or elsewhere in the record, *except when the reference to another party clearly contradicts the*

applicant's verified statement that it is the owner of the mark." TMEP § 1201.03(b) (emphasis added). Applicant has maintained from the outset of this prosecution that its related company, Kmart, is using the mark in commerce, and has not made any statement that contradicts its claim of ownership of the mark. Thus, the Examining Attorney's requests for additional information regarding use of the mark by Applicant's related company are improper, and Applicant need not respond thereto.

VI. Conclusion

In light of the foregoing, Applicant respectfully submits that all of the bases for rejection of its TRIM A HOME mark have been overcome, and that this application is in a *prima facie* condition for allowance. Accordingly, Applicant respectfully requests that the Examining Attorney withdraw the refusal to register Applicant's TRIM A HOME mark, and allow this application to pass to publication towards registration.

Should anything further be required, a telephone call to the undersigned at (312) 456-8400 is respectfully solicited.

[1] Applicant has identified the references from the Examining Attorney's LexisNexis search by the result number listed at the top of the first page of each reference (e.g. "72 of 139").

CLASSIFICATION AND LISTING OF GOODS/SERVICES

Applicant proposes to amend the following class of goods/services in the application:

Current: Class 020 for Christmas pillows; Christmas figurines of plastic

Original Filing Basis:

Filing Basis: Section 1(a), Use in Commerce: The applicant is using the mark in commerce, or the applicant's related company or licensee is using the mark in commerce, on or in connection with the identified goods and/or services. 15 U.S.C. Section 1051(a), as amended. The mark was first used at least as early as 09/00/1988 and first used in commerce at least as early as 09/00/1988, and is now in use in such commerce.

Proposed: Class 020 for Christmas pillows; Christmas figurines of plastic

Filing Basis: Section 1(a), Use in Commerce: The applicant is using the mark in commerce, or the applicant's related company or licensee is using the mark in commerce, on or in connection with the identified goods and/or services. 15 U.S.C. Section 1051(a), as amended. The mark was first used at least as early as 09/00/1988 and first used in commerce at least as early as 09/00/1988, and is now in use in such commerce.

Applicant hereby submits a new specimen for Class 020. The specimen(s) submitted consists of a tag bearing the mark used in association with a Christmas pillow product..

"The substitute (or new, if appropriate) specimen(s) was/were in use in commerce at least as early as the filing date of the application" [for an application based on Section 1(a), Use in Commerce] OR "The substitute (or new, if appropriate) specimen(s) was/were in use in commerce prior either to the filing of the Amendment to Allege Use or expiration of the filing deadline for filing a Statement of Use" [for an application based on Section 1(b) Intent-to-Use].

Specimen File1

ADDITIONAL STATEMENTS

Section 2(f), based on Use

The mark has become distinctive of the goods/services through the applicant's substantially exclusive and

continuous use in commerce for at least the five years immediately before the date of this statement.

SIGNATURE(S)**Declaration Signature**

If the applicant is seeking registration under Section 1(b) and/or Section 44 of the Trademark Act, the applicant has had a bona fide intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the identified goods and/or services as of the filing date of the application. 37 C.F.R. Secs. 2.34(a)(2)(i); 2.34 (a)(3)(i); and 2.34(a)(4)(ii); and/or the applicant has had a bona fide intention to exercise legitimate control over the use of the mark in commerce by its members. 37 C.F. R. Sec. 2.44. If the applicant is seeking registration under Section 1(a) of the Trademark Act, the mark was in use in commerce on or in connection with the goods and/or services listed in the application as of the application filing date or as of the date of any submitted allegation of use. 37 C.F.R. Secs. 2.34(a)(1)(i); and/or the applicant has exercised legitimate control over the use of the mark in commerce by its members. 37 C.F.R. Sec. 244. The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. Section 1001, and that such willful false statements may jeopardize the validity of the application or any resulting registration, declares that he/she is properly authorized to execute this application on behalf of the applicant; he/she believes the applicant to be the owner of the trademark/service mark sought to be registered, or, if the application is being filed under 15 U.S.C. Section 1051(b), he/she believes applicant to be entitled to use such mark in commerce; to the best of his/her knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive; that if the original application was submitted unsigned, that all statements in the original application and this submission made of the declaration signer's knowledge are true; and all statements in the original application and this submission made on information and belief are believed to be true.

Signature: /Mark R. Galis/ Date: 04/08/2010

Signatory's Name: Mark R. Galis

Signatory's Position: Attorney of record, Illinois bar member

Request for Reconsideration Signature

Signature: /Mark R. Galis/ Date: 04/08/2010

Signatory's Name: Mark R. Galis

Signatory's Position: Attorney of record, Illinois bar member

The signatory has confirmed that he/she is an attorney who is a member in good standing of the bar of the highest court of a U.S. state, which includes the District of Columbia, Puerto Rico, and other federal territories and possessions; and he/she is currently the applicant's attorney or an associate thereof; and to the best of his/her knowledge, if prior to his/her appointment another U.S. attorney or a Canadian attorney/agent not currently associated with his/her company/firm previously represented the applicant in this matter: (1) the applicant has filed or is concurrently filing a signed revocation of or substitute power of attorney with the USPTO; (2) the USPTO has granted the request of the prior representative to withdraw; (3) the applicant has filed a power of attorney appointing him/her in this matter; or (4) the applicant's appointed U.S. attorney or Canadian attorney/agent has filed a power of attorney appointing him/her as an associate attorney in this matter.

The applicant is filing a Notice of Appeal in conjunction with this Request for Reconsideration.

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