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

Proceeding	77697117
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Appeal Brief

Serial No. 77/697,117 for RIGHT CHOICE PROMISE

Applicant appeals from the Examining Attorney's final refusal under Sections 1, 2, 3 and 45 of the Trademark Act, holding that Applicant's services do not identify registrable services as contemplated by the Trademark Act.

The sole issue before the Trademark Trial and Appeal Board, therefore, is whether or not Applicant's services, which are currently described as "*providing extended warranties on window fashions in the nature of a product replacement program*" constitute registrable services as contemplated by the Trademark Act.

The Examining Attorney's position is based primarily on her contention that Applicant's services are simply a warranty or a guarantee of its own goods, and that the product replacement program recited in Applicant's description of services is not separate from Applicant's principal business activities, but is instead incidental to Applicant's larger business.

Applicant refutes these contentions and submits that the services described in this application meet the three (3) criteria established in TMEP § 1301.01 for determining whether or not a service is a registrable service as contemplated by the Trademark Act.

Applicant provides some background information below and then submits comments regarding the three criteria referenced above, along with arguments in response to the Examining Attorney's contentions.

Background

Applicant is a manufacturer of custom-made window treatment products. It designs and assembles window treatments, but it is not in the business of installing them. Consumers either install the window treatments themselves, or they contract with the dealer from whom they purchased the treatments to install them.

As such, window treatments are a lot like carpets, doors, plumbing items, and other items installed in a home or dwelling, and which are sold in trade channels like Home Depot or Lowes. Window treatments are products that can be purchased on their own, with or without paying the dealer to get them installed.

Applicant's Services Meet Three Criteria for Determining a Service

TMEP § 1301.01 specifies and discusses three (3) criteria for determining what constitutes a service. They are as follows:

- (1) a service must be a real activity;
- (2) a service must be performed to the order of, or for the benefit of, someone other than the applicant; and
- (3) the activity performed must be qualitatively different from anything necessarily done in connection with the sale of the applicant's goods or the performance of another service.

Applicant submits that the services recited in the subject application meet all three of these criteria and that the arguments and evidence contained in this application support Applicant's assertion. Each are discussed in turn.

A service must be a real activity

Applicant submits that the installation of window treatments, as well as the removal and replacement of window treatments, are real activities. Services involving the removal and installation of window treatments are not just an idea, concept, process, or system.

Accordingly, Applicant submits that it has met the first criteria.

A service must be performed to the order or benefit of someone other than the Applicant

The product replacement program offered under Applicant's RIGHT CHOICE PROMISE trademark benefits Applicant's consumers by allowing them the opportunity to enjoy their new window treatments for a period of 21 days, and, subject to some restrictions, to then obtain replacement window treatments if not fully satisfied.

Consumers are benefitted because they are given the confidence to choose and select window treatments, and to pay for their installation, without fear that his/her investment would be wasted in the event that he/she is not satisfied. Consumers can obtain a product replacement if, for example, it turns out that they don't like the color of the treatment.

In this regard, the nominal fee paid by the consumer is paid to the dealer, not to Applicant, and it is the dealer who removes the previously-installed treatment and installs the replacement treatment.

Accordingly, Applicant submits that it has met the second criteria.

The activity performed must be qualitatively different from anything necessarily done in connection with the sale of the applicant's goods or the performance of another service

As explained above, Applicant is not in the business of installing window treatments. Applicant's business is the design, manufacture, and assembly of window treatments.

The fact that sellers of window treatments, including Applicant's own dealers, charge a separate fee for installing window treatments demonstrates that the replacement program described in this application – which requires both the removal of existing window treatments and the installation of new window treatments – is a service that is qualitatively different from Applicant's principal business activity.

Accordingly, Applicant submits that it has met the third criteria.

Arguments in Response to Contentions Made in the Office Actions

In response to the Examining Attorney's contention that Applicant's services are simply a warranty or a guarantee of its own goods, Applicant responds by directing the Board's attention to Applicant's initial Response to Office Action, filed Dec. 18, 2009.

In that response, Applicant explained how the product replacement program offered under its RIGHT CHOICE PROMISE trademark and its warranty program are separately described, separately promoted, and separately featured on its website. Indeed, the specimen submitted with the application-as-filed clearly makes a distinction between the product warranty and the product replacement program.

Applicant's warranty services cover things like defects in the products (e.g., the cord doesn't work), whereas Applicant's product replacement program offered under its RIGHT CHOICE PROMISE trademark has nothing to do with defects in the products. As indicated above, consumers can obtain a product replacement if they don't like the color or style of the treatment.

And, in response to the Examining Attorney's contention that the product replacement program is not separate from Applicant's principal business activities, but is instead incidental to Applicant's larger business, Applicant responds by directing the Board's attention to the arguments above and those in Applicant's Request for Reconsideration, filed July 25, 2010.

Window treatment products, on the one hand, and window treatment installation services, on the other, are typically billed and invoiced separately from one another. Applicant designs, manufactures, and sells window treatment products. It does not offer window treatment installation services.

As a consequence, the product replacement program described in this application is qualitatively different from Applicant's principal business activity.

Conclusion

Based on the foregoing, Applicant respectfully requests that the Trademark Trial and Appeal Board reverse the Examining Attorney's refusal to register under Sections 1, 2, 3, and 45 of the Trademark Act, and to approve this application for publication.

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