

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

Applicant: MADETOORDER, INC.
Serial No.: 77/861,639
Mark: MADETOORDER

APPLICANT'S APPEAL BRIEF

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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Trademarks, P.O. Box 1451, Alexandria, Virginia 22313-1451 on the date shown below:

Raymond E. Roberts, Esq.; Reg. No. 38,597

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(Signature)

July 5, 2011

(Date)



07-11-2011

Applicant appeals the Trademark Examining Attorney's refusal to register the mark MADETOORDER under Trademark Act Section 2(e)(1) (Generic / Merely Descriptive), 15 U.S.C. §1052(e)(1); Section 2(f) claim asserted in the application, 15 U.S.C. §1052(f).

Appellant submits that these issues remain for consideration now:

Issue (1): Whether the mark is generic; and

Issue (2): Failing issue (1) and accepting that the mark is merely descriptive of

Applicant's services, whether the evidence submitted is insufficient to show that the mark has acquired distinctiveness.

I. Issue (1) — Generic

I(a). Applicable Law

A two-part test is used to determine whether a designation is generic:

- (1) What is the class or genus of goods or services at issue? and
- (2) Does the relevant public understand the designation primarily to refer to that class of goods or services?

H. Marvin Ginn Corp. v. International Ass'n of Fire Chiefs, Inc., 782 F.2d 987, 990, 228 USPQ 528, 530 (Fed. Cir. 1986).

[This conforms with the Applicable Law as stated by the Examining Attorney in both the first and second/final Office Actions. Applicant accepts this as the Applicable Law in this matter.]

I(b). Arguments Regarding Issue (1) — Generic

Applicant's mark is MADETOORDER, applied for here in International Class 42 for "[o]n-line design services for others in the field of personalized and custom design transfers, namely, text, pictures and graphics for imprinting on apparel." Accordingly, Applicant urges that Issue (1) is whether the relevant purchasing public understands MADETOORDER to be

primarily the common or class name for on-line design services for others in the field of personalized and custom design transfers, namely, text, pictures and graphics for imprinting on apparel.

With respect to the first part of the test, Applicant urges that the “class or genus of goods or services at issue” here is a class or genus of services, and specifically that this is on-line design services for others in the field of personalized and custom design transfers, namely, text, pictures and graphics for imprinting on apparel.

With respect to the second part of the test, Applicant urges that, in view of the above, this simplifies to asking: Does the relevant public understand MADETOORDER primarily to refer to a class or genus of on-line design services for others in the field of personalized and custom design transfers ... ?

While the phrase “make to order” is proper English grammar to describe a service, the phrase “made to order” is proper English grammar to describe goods. The term “made” is the past tense or past participle of “make” (thus, “[a] verb form indicating past or completed action or time that is used as a verbal adjective in phrases ...,” *see e.g.*, <http://www.answers.com/topic/past-participle>; this reference is of record, having been cited by the Examining Attorney and Applicant in the first Office Action and subsequent Response). Accordingly, essentially as a matter of definition in the English language, Applicant submits that the mark MADETOORDER is not descriptive of providing a service or services.

Turning next to the prosecution record, the Examining Attorney has stated the test; concluded that MADETOORDER is generic, without any indication that the test has been followed; and then supported this conclusion with strained and erroneous arguments that are largely irrelevant.

In the first Office Action the test is stated; a one-sentence statement of Applicant's services follows; a "definition" of MADETOORDER and two paragraphs of case law examples of generic designations follow; and then it is stated that Applicant's designation meets the test. Respectfully, this does not show application of the test, rather it rationalizes the conclusion.

Similarly, in the second and final Office Action the test is stated, followed by:

... evidence shows that the wording "MADE TO ORDER" in the mark means "made according to the specific requests of a particular person." *Macmillan Dictionary*, www.macmillandictionary.com. The proposed mark is essentially the apt name for the class or genus of applicant's "on-line design services for others." The relevant public would understand this designation to refer primarily to that class or genus of services because applicant's design services result in personalized and custom design transfers made according to the specific requests of others.

(wherein the definition is provided as attachments 1-2 in the Action).

However, while the above definition is correct as far as it goes, it is misapplied here. Applicant's on-line design services for others are not made according to the specific requests of a particular person. Services are not made, they are provided, and here Applicant provides on-line services for others to design personalized and custom design transfers, namely, text, pictures and graphics for imprinting on apparel. This bears directly on answering the second part of the test. The relevant public here is users of Applicant's services and this public does not understand the designation (MADETOORDER) to primarily to refer to services like those that Applicant provides.

It appears that the Examining Attorney's analysis here is based on a relevant public that imprints onto, or distributes, or receives apparel bearing design transfers. This is error. For example, a user of Applicant's design services might then have its design transfers made by a 3rd party, imprinted onto apparel by a 4th party, and the apparel distributed by a 5th party to a

myriad of 6th parties. Applicant's mark establishes secondary meaning (origin & quality) only for the design services it provides, not for anything for or by 3rd or onward parties.

It also appears that the Examining Attorney's analysis here has overlooked or disregarded the term "primarily" in the test. This is also error. The designation here is MADETOORDER, not DESIGNTOORDER. The terms "made" and "design" are not synonyms. Indeed, undersigned ventures to say that if one walked up to members of the relevant public on the street and asked "What does "MADETOORDER" designate?," that the answers would overwhelmingly not include the words "service" or "design."

Continuing with the prosecution record, the final Office Action states:

The examining attorney refers to the numerous attached printouts of websites from a www.google.com search showing the wording MADE TO ORDER is used [1] across a broad spectrum of services. For example, the website First2Print, www.first2print.com, describes the services as follows: "During typical [2] made-to-order services, First2Print works with its customers throughout the entire design process to engineer a final product assembled with textile." These printouts demonstrate that [3] MADE TO ORDER is a genus of services."

(curly bracket references added for discussion).

With respect to the website printouts, they comprise one dictionary website (discussed above), 12 websites that appear to have actually been found using a www.google.com search, and portions of Applicant's own website (discussed presently). All of these examples have been discussed in detail in Applicant's Response to the Second (Final) Office Action.

At [1] it can be seen that the printouts collectively are offered to answer something not at issue, and that the evidence and argument at [2] do not support the conclusion/finding at [3].

Whether "MADE TO ORDER" is used across a broad spectrum of services is not determinative, in contrast with whether it is generic for providing on-line design services such as Applicant's.

Of the 12 websites found by search, only the proffered First2Print example is argued in the second/final Office Action. This website is for a custom textiles (goods) manufacturer. As

implied at {2}, and seeable in more detail in the header of attachments 28-29 in the second/final Office Action, the Examining Attorney's evidence and argument relate to "made-to-order services," rather than "made to order," yet the conclusion/finding expressed at {3} is that this evidence and argument demonstrate "that MADE TO ORDER is a genus of services." As a matter of simple logic, this overall analysis is flawed. Moreover, the conclusion/finding here on its face is untenable, since it essentially can be paraphrased as "[t]he Examiner has made a finding of fact "that MADE TO ORDER is a genus of services."

Turning next to the portions of Applicant's own website cited in the second/final Office Action, these appear as attachments 50-51, 52-53, 54-55, and 56-57. With respect to these the Action states:

Applicant's website emphasizes its MADETOORDER services rather than its goods, e.g., "made-to-order solutions," "MadeToOrder is not just a name, it is a commitment" and "MadeToOrder solutions."

Applicant agrees with the finding of fact here, but has a quibble or three with the purported examples and their determinative value.

As a point of order, the "examples" listed are not true quotations. None show Applicant's website stating "made-to-order solutions." The only hyphenated use of "made-to-order" in the result printouts is in attachment 50, which states:

Everything we do is **made-to-order**,
tailored to you and your **goals**.
This is our **mission**. (all emphasis in the original)

If there is some point here that has bearing on whether Applicant's mark is generic, we simply do not see it and our respectful request for clarifying rationale has gone unanswered. Continuing, these search results also do not show Applicant's website stating "MadeToOrder is not just a name, it is a commitment." Attachment 50 contains the only apparently similar text, stating:

MadeToOrder™ ...

not just a name

it is a **commitment.** (all emphasis in the original)

Here as well, if there is some point that has bearing on whether Applicant's mark is generic, we simply do not see it and our respectful request for clarifying rationale here as well has gone unanswered. Continuing, these printouts also do not show Applicant's website stating "MadeToOrder solutions." Attachment 52 contains the only apparently similar text, just under a tab-heading labeled "Services," stating:

....creating "MadeToOrder" solutions (all emphasis in the original)

And at the bottom of this same page, stating:

Our commitment is to create 'MadeToOrder' solutions that send your brand out into the world ... (ellipsis added)

Here again, if there is some point here that has bearing on whether Applicant's mark is generic, our respectful request for clarifying rationale has simply gone unanswered.

II. Issue (2) — Merely Descriptive and Acquired Distinctiveness

[Note, while the prosecution has argued whether MADETOORDER is Merely Descriptive and has Acquired Distinctiveness as two distinct issues, in the interest of brevity Applicant here concedes that MADETOORDER is at least descriptive of Applicant's services and accepts that Acquired Distinctiveness should be determinative here.]

II(a). Applicable Law

Except as expressly excluded in subsections (a), (b), (c), (d), (e)(3), and (e)(5) of this section, nothing herein shall prevent the registration of a mark used by the applicant which has become distinctive of the applicant's goods in commerce. The Director may accept as prima facie evidence that the mark has become distinctive, as used on or in connection with the applicant's goods in commerce, proof of substantially exclusive and continuous use thereof as a mark by the

applicant in commerce for the five years before the date on which the claim of distinctiveness is made. ...

15 U.S.C. §1052(f).

Within the context of the Trademark Act, §2(f) may be described as follows:

[U]nlike the first five sections of 15 U.S.C. §1052 which define the grounds upon which a trademark registration is to be refused, Section 2(f) serves as an exception to a rejection under the provisions of one of the other sections, Section 2(e) (citation omitted). Section 2(f) permits registration of marks that, despite not qualifying for registration in light of Section 2(e), have nevertheless "become distinctive of the applicant's goods in commerce." Thus, "Section 2(f) is not a provision on which registration can be refused," ... but is a provision under which an applicant has a chance to prove that he is entitled to a federal trademark registration which would otherwise be refused.

Yamaha Int'l Corp. v. Hoshino Gakki Co. Ltd., 840 F.2d 1572, 1580, 6 USPQ2d 1001, 1007 (Fed. Cir. 1988), quoting *In re Capital Formation Counselors, Inc.*, 219 USPQ 916, 917 n.2 (TTAB 1983).

...

Three basic types of evidence may be used to establish acquired distinctiveness under §2(f):

- (1) A claim of ownership of one or more prior registrations on the Principal Register of the same mark for goods or services that are the same as or related to those named in the pending application (see 37 C.F.R. §2.41(b); TMEP §§1212.04 et seq.);
- (2) A statement verified by the applicant that the mark has become distinctive of the applicant's goods or services by reason of substantially exclusive and continuous use in commerce by the applicant for the five years before the date when the claim of distinctiveness is made (see 37 C.F.R. §2.41(b); TMEP §§1212.05 et seq.); and
- (3)

The applicant may submit one or any combination of these types of evidence

TMEP §1212 (Acquired Distinctiveness or Secondary Meaning)

The amount and character of evidence needed to establish acquired distinctiveness depends on the facts of each case and particularly on the nature of the mark sought to be registered. *Roux Labs., Inc. v. Clairol Inc.*, 427 F.2d 823, 829, 166 USPQ 34, 39 (C.C.P.A. 1970); see *In re Hehr Mfg. Co.*, 279 F.2d 526, 126 USPQ 381 (C.C.P.A. 1960); TMEP §1212.05(a). [sic] More evidence is generally required if purchasers seeing the applied-for mark in relation to the identified goods and/or services would be less likely to believe that it indicates

source in any one party. *See, e.g., In re Bongrain Int'l Corp.*, 894 F.2d 1316, 13 USPQ2d 1727; *In re Seaman & Assocs., Inc.*, 1 USPQ2d 1657 (TTAB 1986).

The above paragraph quotes the Applicable Law as stated by the Examining Attorney in the second/final Office Action. Except for apparent errors with respect to where this is cited and discussed in the TMEP, Applicant accepts this as the Applicable Law in this matter.

II(b). Arguments Regarding Issue (2) — Acquired Distinctiveness

The Examining Attorney has acknowledged Applicant's claim of acquired distinctiveness, and that the evidence provided in support of such claim is ownership of U.S. Registration No. 2,408,618 (reg. date: 2000-11-28) and at least five years' use in commerce (first use in commerce at least as early as 08/18/1999). *See e.g.*, first Office Action and application as filed.

However, the Examining Attorney has provided very little in the record to show, much less establish, that Applicant's claim of acquired distinctiveness is insufficient.

The first Office Action states only:

If the applied-for mark is ultimately determined to be merely descriptive and not generic, the Section 2(f) evidence is insufficient because purchasers would be less likely to believe that the proposed mark indicates source. The mark merely indicates that the services involve designs made in accordance with particular instructions or requirements, i.e., MADETOORDER.

In rebuttal, Applicant argued

Purchasers here would seemingly be more likely to equate the present mark with the owner of Reg. No. 2,408,618, because of its close similarity and long use in the relevant marketplace. Additionally, purchasers here would seemingly be more likely to equate the present mark with Applicant, because of the similarity with Applicant's corporation's name. In particular, the present mark indicates to purchasers (users) of Applicant's services the end result that those services provide, that is, that the purchasers-users will be able to themselves make designs for what they ultimately want made. [Possibly digressing, but hopefully helpful to grasp the concepts here: It is generally accepted that the role of a mark is

to primarily indicate source, and secondarily to indicate quality. For this to ever matter, however, a 'good' mark needs to indicate a particular source or quality of a solution. By way of an antidotal example, a past president of Black & Decker Corporation (now part of Stanley Black & Decker) once gathered his sales staff and told them 'our customers do not want 1/4" drill bits, they want 1/4" holes.' The point here being, consumers want solutions. The present mark indicates to purchasers-users that Applicant's services will help provide them with the solution they seek, that is, to what ultimately want made.]

Applicant's Response to first Office Action

The second/final Office Action states only:

If the applied-for mark is ultimately determined to be merely descriptive and not generic, the Section 2(f) evidence is insufficient because MADE TO ORDER is a genus of applicant's services and the relevant public would understand this designation to refer primarily to that genus of services.

Presuming for the sake of argument that the mark here is merely descriptive, little in the record shows the Applicable Law has been applied and that has been rebutted.

The first Office Action merely stated that "purchasers would be less likely to believe that the proposed mark indicates source." This ignores Applicant's evidence and, merely states the Examining Attorney's subjective belief. The second/final Office Action makes no mention of Appellant's rebuttal arguments, and states the Examining Attorney's conclusion that the evidence is insufficient. In addition to all before, however, this conclusion is circular and illogical. It essentially argues: if found distinctive rather than generic, the first prong of the generic test is met, so the second prong of the generic test is also met, so registration is refused because the mark has insufficient acquired distinctiveness.

Other than this, there is no explanation in the record why the character of the evidence, or why the nature of the present mark, or how the weight of that evidence are insufficient.

SUMMARY

For the reasons set forth herein, Applicant respectfully requests that the Trademark Examining Attorney's decision to refuse registration pursuant to 15 U.S.C. §1052(e)(1) be overturned and that Applicant's Section 2(f) claim asserted in the application, 15 U.S.C. §1052(f) be upheld.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Raymond E. Roberts', written in a cursive style.

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July 5, 2011 (being the first business day in the Office's calendar relative to July 3, 2011)