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Subject: U.S. TRADEMARK APPLICATION NO. 77861639 - MADETOORDER -
65008.200101 - EXAMINER BRIEF

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Count: 3

Files: Exhibit_A_1.jpg, Exhibit_A_2.jpg, 77861639.doc

UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

APPLICATION SERIAL NO. 77861639

MARK: MADETOORDER



CORRESPONDENT ADDRESS:

RAYMOND E ROBERTS
PATENT VENTURE GROUP
10788 CIVIC CENTER DR STE 215
RANCHO CUCAMONGA, CA 91730-3805

GENERAL TRADEMARK INFORMATION:

<http://www.uspto.gov/main/trademarks.htm>

TTAB INFORMATION:

<http://www.uspto.gov/web/offices/dcom/ttab/index.html>

APPLICANT: MADETOORDER, INC.

CORRESPONDENT'S REFERENCE/DOCKET NO:

65008.200101

CORRESPONDENT E-MAIL ADDRESS:

tfiler@ipvglaw.com

EXAMINING ATTORNEY'S APPEAL BRIEF

STATEMENT OF THE CASE

Applicant has appealed the Trademark Examining Attorney's¹ final refusal to register the proposed mark MADETOORDER because the term is generic when applied to the identified services under Trademark Act §2(e)(1), 15 U.S.C. §1052(e)(1). Applicant also appealed the Trademark Examining Attorney's alternative refusal to register the proposed mark pursuant to Section 2(f) of the Trademark Act because it is merely descriptive under Trademark Act §2(e)(1) and the application record lacks sufficient evidence of acquired distinctiveness.

FACTS

Applicant filed an application on October 30, 2009 to register MADETOORDER (in standard characters) for "on-line design services for others in the field of personalized

¹ The original examining attorney, Cynthia Sloan, retired from the USPTO during the course of this appeal. The file has been reassigned to the undersigned examining attorney.

and custom design transfers, namely, text, pictures and graphics for imprinting on apparel.” The application was accompanied by a claim of acquired distinctiveness pursuant to Trademark Act §2(f).

In the first Office action dated April 12, 2010, registration was refused under Trademark Act §2(e)(1) on the ground that the mark was generic when used in connection with the identified services. Alternatively, the mark was refused under Trademark Act §2(e)(1) on the ground that the mark was merely descriptive of the identified services and that the submitted evidence of acquired distinctiveness was insufficient.

On October 11, 2010 applicant responded arguing that the mark is not generic in connection with the identified services and that the evidence submitted was sufficient to show that the mark had acquired distinctiveness.

On the November 3, 2010 the Examining Attorney issued a final action to refuse registration of the mark under Trademark Act §2(e)(1) because the mark is generic. Alternatively, the mark was refused under Trademark Act §2(e)(1) as merely descriptive and the Examining Attorney concluded that the evidence submitted to show acquired distinctiveness was insufficient.

On February 25, 2011 applicant filed a request for reconsideration arguing that the mark is not generic under Trademark Act §2(e)(1) and that the evidence submitted in support of acquired distinctiveness was sufficient to overcome any descriptiveness finding.

On March 17, 2011 the request for reconsideration was denied and this appeal ensued.

ISSUES

The issues on appeal are: 1) whether the proposed mark MADETOORDER is generic as applied to the identified services under Trademark Act §2(e)(1), 15 U.S.C. §1052(e)(1) and alternatively, 2) if MADETOORDER is theoretically capable of functioning as trademark, whether the evidence submitted is sufficient to establish acquired distinctiveness pursuant to Trademark Act §2(f), 15 U.S.C. §1052(f).

ARGUMENT

I. MADETOORDER IS GENERIC AS APPLIED TO THE IDENTIFIED SERVICES AND THEREFORE IS INCAPABLE OF FUNCTIONING AS A TRADEMARK FOR THE SERVICES.

The Examining Attorney has refused registration of MADETOORDER because it is generic under Trademark Act §2(e)(1) for the identified services. Generic terms are terms that the relevant purchasing public understands primarily as the common or class name for the services. TMEP §1209.01(c); *see In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 1344, 57 USPQ2d 1907, 1810 (Fed. Cir. 2001); *In re American Fertility Society*, 188 F.3d 1341, 1346, 51 USPQ2d 1832, 1836 (Fed. Cir. 1999). Such terms are incapable of functioning as trademarks denoting source, and are not registrable on the Principal Register under a claim of acquired distinctiveness.

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

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

TMEP §1209.01(c)(i); *In re 1800Matress.com IP LLC*, 586 F. 3d 1359, 1363, 92 USPQ2d 1682, 1684 (Fed. Cir. 2009) (quoting *H. Marvin Ginn Corp.*, 782 F.2d at 990, 228 USPQ at 530).

The Examining Attorney notes that a word or term that is the name of a key characteristic or features of the services can be generic for the services and thus, incapable of distinguishing a source. A term does not need to be the name of the services to be found incapable of serving as an indicator of origin. *In re Sun Oil Co.*, 426 F.2d 401, 165 USPQ 718 (C.C.P.A. 1970).

A. GENUS OF SERVICES AT ISSUE

The genus of the services at issue is the most fundamental aspect of the services claimed by applicant, a *custom design service*. While the services listed in applicant's identification, to wit, "on-line design services for others in the field of personalized and custom design transfers, namely, text, pictures and graphics for imprinting on apparel," are somewhat more narrowly worded, the claimed services fall squarely within the wider genus defined by the Examining Attorney.

Applicant's website indicates that its services are not standardized procedures but rather are created in a personalized manner according to what a customer needs. Specifically, the following excerpts indicate the bespoke nature of applicant's services.

"Everything we do is MadeToOrder. What we mean by that is that we create and support the services that work best for your culture."

See Office action dated November 3, 2010, TICRS p. 53.

“Everything we do is made-to-order, tailored to you and your goals.”

See Office action dated November 3, 2010, TIGRS p. 51.

“We are experts in delivering cost-effective, high perceived value, customized, MadeToOrder programs, products, service and technologies that often exceed our clients’ requirements...”

See Office action dated November 3, 2010, TIGRS p. 55.

“MadeToOrder is not just a name, it is a commitment. All of our offerings, programs and products, to artwork, to technology, to shipping and billing are tailored to support our individual clients’ goals.”

See Office action dated November 3, 2010, TIGRS p. 56.

Each of these excerpts demonstrates that applicant’s services are not standard, “off-the-shelf” procedures but are rather tailored to the needs and specifications of customers.

The services are provided on a custom basis. “Custom design services” is therefore the correct genus to be considered.

B. THE GENERAL PUBLIC RECOGNIZES “MADETOORDER” TO REFER PRIMARILY TO CUSTOM SERVICES, INCLUDING CUSTOM DESIGN.

Any competent source, including dictionary excerpts, research databases, newspapers and other publications, may serve as evidence to show the relevant purchasing public’s understanding of the wording at issue. TMEP §1209.01(c)(i); *see In re Merrill Lynch, Pierce, Fenner & Smith, Inc.*, 828 F.2d at 1570, 4 USPQ2d at 1143. An applicant’s website and the websites of others are also competent sources of evidence to show genericness. TMEP §1209.01(c)(i); *see In re Reed Elsevier Props. Inc.*, 482 F.3d 1367, 1379, 82 USPQ2d 1387, 1380 (Fed. Cir. 2007). The Examining Attorney has provided many sources of evidence that the term “made-to-order” is a recognized genus of services.

“Made-to-order” is defined as “made in accordance with particular instruction or requirements; custom-made.” *See* definition included in Office action dated April 12, 2010, TICRS p. 2. This definition demonstrates that the proposed mark is essentially the name or feature of the class of applicant’s customized services.

That applicant has removed the hyphens from the traditional spelling is of no moment; a slight misspelling of a word will not turn a descriptive or generic word into a non-descriptive mark. *See C-Thru Ruler Co. v. Needleman*, 190 USPQ 93 (E.D. Pa. 1976); *In re Carlson*, 91 USPQ2d 1198 (TTAB 2009); *In re Ginc UK Ltd.*, 90 USPQ2d 1472 (TTAB 2007); *In re Hubbard Milling Co.*, 6 USPQ2d 1239 (TTAB 1987).

Numerous pieces of submitted evidence further demonstrate that the relevant public understands “made-to-order” primarily to refer to customized services similar to those of applicant.

The following excerpts exhibit this type of generic use:

Sylvie P offers pattern making and made-to-order services for any type of garment and sizes: sportswear, formal, bridal, lingerie Men, Women and children.
See Office action dated November 3, 2010, TICRS p. 18.

Did we say made to order? We sure did. In fact, many of the vendors that work with the Majestical Roof offer up made to order services.
See Office action dated November 3, 2010, TICRS p. 21.

During typical made-to-order services First2Print works with its customers throughout the entire design process to engineer a final product assembled with textile.
See Office action dated November 3, 2010, TICRS p. 29.

A vital part of the T-Shirts Plus family are the owners who operate stores in high profile community location providing valuable made to order services for spots teams and groups.

See Office action dated November 3, 2010, TIGRS p. 33.

Movies Made In Minnesota Custom Design Transfers: Fiolex Font – Custom Transfer. Custom transfers are made to order and are not eligible for return.

See Office action dated November 3, 2010, TIGRS p. 37.

With a made-to-order design philosophy, we work with clients to develop brands and identity materials, and to craft the finest design for printed pieces, brochures, logos, advertising, and online and electronic media.

See Office action dated November 3, 2010, TIGRS p. 50.

Each of these excerpts shows third parties using the phrase “made to order” to designate a feature of its services. The evidence demonstrates that “made to order” services are those which are performed on a custom basis. As noted above, a term need not identify the totality of an applicant’s services in order to be considered generic; terms which identify key characteristics of an applicant’s services may also be generic.

In its brief, applicant argues that the phrase “made to order” can only refer to customized goods and not services. Specifically, applicant argues that “made” is a past participle of “make,” indicating that the action was completed and therefore can only apply to goods. The evidence of record does not support applicant’s position and shows use of the phrase “made to order” in conjunction with a customized service and not only with the resulting goods.

Applicant also argues that its services cannot be made to order, but rather applicant merely “provides on-line services for others to design personalized and custom design transfers.” *See* applicant’s appeal brief p. 4. Applicant appears to argue that its services

are, in fact, standardized and that the resulting products are what are actually customized. However, this position is not supported by the description of applicant's services on its website, which clearly establish that its own services are customized. The following excerpts are displayed on applicant's website.

"Everything we do is made-to-order. What we mean by that is that we create and support the services that work best for your culture."

See Office action dated November 3, 2010, TIGRS p. 51.

"MadeToOrder is not just a name, it is a commitment. All of our offerings, programs and products, to artwork, to technology, to shipping and billing are tailored to support our individual clients' goals."

See Office action dated November 3, 2010, TIGRS p. 56.

Finally, applicant argues that "made to order" is not the "primary" name to refer to the feature or characteristic of the services, and accordingly does not meet requirement that the relevant public understand the designation primarily to refer to that class or genus of the services. *See* applicant's appeal brief p. 5. The Examining Attorney respectfully disagrees. The evidence demonstrates that "made to order" is used by numerous third parties to designate the name of the genus to which applicant's services belong. Moreover, applicant's recitation of services states that the online design services are personalized. The following excerpts exhibit third parties using "made to order" to designate customized services.

"Manufacturing and made-to-order services are now available at Mademoiselle Madness."

See Office action dated March 17, 2011, TIGRS p. 5.

"Typically, various boutiques who have relationships with shoemakers that provide made-to-order services will measure your feet and then match your measurement to a show last that matches the width and length of your feet."

See Office action dated March 17, 2011, TIGRS p. 10.

"Made to order, design services available"

See Office action dated April 12, 2010, TICRS p. 6.

“With their made-to-order design philosophy, Courtney and Amy work with clients to develop brands and identity materials, and to craft the finest design for printed pieces, brochures, logos, advertising and online and electronic media.”

See Office action dated April 12, 2010, TICRS p. 59.

The evidence of record demonstrates that the general public recognizes “made to order” to refer primarily to personalized and custom design services. Further, the evidence demonstrates that “made to order,” as applied to applicant’s identified services, is generic and is incapable of functioning as a trademark.

II. ALTERNATIVELY, IF MADETOORDER IS NOT GENERIC AS APPLIED TO THE SERVICES, THE EVIDENCE SUBMITTED IN SUPPORT OF THE CLAIM OF 2(f) ACQUIRED DISTINCTIVENESS IS INSUFFICIENT TO ESTABLISH DISTINCTIVENESS.

Alternatively, if the proposed mark is determined not to be generic, the Examining Attorney refused registration because the mark is merely descriptive of applicant’s services and because the evidence submitted is insufficient to demonstrate acquired distinctiveness. Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1); *see* TMEP §§1209.01(b), 1209.03.

The application at hand was filed with a claim of acquired distinctiveness. The claim was never withdrawn. For procedural purposes, a claim of distinctiveness under §2(f) may be construed as conceding that the matter to which it pertains is not inherently distinctive and, thus, not registrable on the Principal Register absent proof of acquired distinctiveness. Once an applicant has claimed that matter has acquired distinctiveness under §2(f), the issue to be determined is not whether the matter is inherently distinctive but, rather, whether it has acquired distinctiveness. *See, e.g., Yamaha Int’l Corp. v.*

Hoshino Gakki Co. Ltd., 840 F.2d 1572, 1577, 6 USPQ2d 1001, 1005 (Fed. Cir. 1988); *In re Cabot Corp.*, 15 USPQ2d 1224, 1229 (TTAB 1990); *In re Professional Learning Centers, Inc.*, 230 USPQ 70, 71 (TTAB 1986); *In re Chopper Industries*, 222 USPQ 258, 259 (TTAB 1984). Furthermore, applicant concedes in its brief that its mark is descriptive. *See* applicant's brief p. 7.

In the original application filing, applicant asserted acquired distinctiveness based on two pieces of evidence: an allegation of substantially exclusive and continuous use for a period of five years preceding the date of the allegation; and a claim of ownership of Registration No. 2408618 (MADE TO ORDER.COM, in a stylized presentation, for the identical services).

The Examining Attorney rejected this evidence out of hand, finding it insufficient to demonstrate that the standard-character wording MADETOORDER had acquired distinctiveness. Applicant accurately notes that the Examining Attorney did not provide any meaningful analysis of the evidence and did not suggest any methods for remedying the evidentiary shortfall. Examining attorneys are exhorted to fully explain their actions and decision-making process, and the Office actions issued in application did not meet this standard. The discussions regarding applicant's claim of acquired distinctiveness were terse and provided little guidance. However, the Examining Attorney made quite clear in each Office action that the evidence in support of the claim of acquired distinctiveness was insufficient. Indeed, given the nature of the refusal on the grounds of genericness, the Examining Attorney explicitly stated that no amount of evidence in

support of registration would be sufficient to overcome the refusal. *See* Office Action dated November 3, 2010, TIGRS page 1, *citing In re Bongrain*, 894 F.2d at 1317 n.4, 13 USPQ2d at 1728 n.4; TMEP §1212.02(i).

While under normal circumstances it now would be incumbent upon the Examining Attorney to provide an analysis of the evidentiary value of the prior registration, such analysis is now moot. Registration No. 2408618 expired on November 28, 2010. *See* Exhibit A, *attached*. A claim of acquired distinctiveness under Trademark Act Section 2(f) cannot be based on a registration that is cancelled or expired. TMEP §1212.04(d); *see In re BankAmerica Corp.*, 229 USPQ 852, 853 (TTAB 1986); *Unitec Indus., Inc. v. Cumberland Corp.*, 176 USPQ 62 (TTAB 1972).

Applicant's prior registration having expired, the sole remaining evidence in support of applicant's claim of acquired distinctiveness is the allegation of at least five years use in commerce. Trademark Act §2(f) states that reliance on such a claim "may" be acceptable to demonstrate acquired distinctiveness; Trademark Rule 2.41(b), 37 C.F.R. §2.41(b), further cautions that such evidence is acceptable only in "appropriate cases."

Whether a claim of five years' use will be deemed acceptable to establish that the mark has acquired distinctiveness depends largely on the nature of the mark in relation specified services. TMEP 1212.05(a); *see In re Kalmbach Publ'g Co.*, 14 USPQ2d 1490 (TTAB 1989). When asserting a Trademark Act Section 2(f) claim, the burden of proving that a mark has acquired distinctiveness is on the applicant. *Yamaha Int'l Corp.*

v. Yoshino Gakki Co., 840 F.2d 1572, 1578-79, 6 USPQ2d 1001, 1004 (Fed. Cir. 1988); *In re Meyer & Wenthe, Inc.*, 267 F.2d 945, 948, 122 USPQ 372, 375 (C.C.P.A. 1959); TMEP §1212.01. In this case, applicant has not met its burden. The applied-for-mark is, if not generic, is at least highly descriptive of applicant's services. As earlier indicated, "made to order" is a feature or characteristic of the services that applicant offers. The following excerpts from applicant's website show this.

"...everything we do is MadeToOrder. What we mean by that is that we create and support the services that work best for your culture."

See Office Action dated November 3, 2010, TICRS p. 53.

"MadeToOrder is not just a name, it is a commitment. All of our offerings, programs and products, to artwork, to technology, to shipping and billing are tailored to support our individual clients' goals.

See Office action dated November 3, 2010, TICRS p. 56.

Further, as earlier indicated, the term "made-to-order" is used by many third parties with regard to the same genus of services. The phrase is not used exclusively by applicant.

Although the Examining Attorney did not suggest types of evidence that could demonstrate acquired distinctiveness, the inadequacy of the submitted 2(f) evidence was repeated in every Office action.

Aside from the statutory claim of years of use and the now-expired registration, applicant has not submitted any other evidence to demonstrate that the proposed mark has acquired distinctiveness in the relevant marketplace. Applicant has *not* submitted any evidence of specific dollar sales under the mark, consumer or dealer statements of recognition of the mark as a source identifier, affidavits nor any other evidence that establishes the distinctiveness of the mark as an indicator or source. *See* 37 C.F.R. §2.41(a); *In re Ideal*

Indus., Inc., 508 F.2d 1336, 184 USPQ 487 (C.C.P.A. 1975); *In re Ideal Indus., Inc.*, 508 F.2d 1336, 184 USPQ 487 (CCPA 1975); *In re Instant Transaction Corp.*, 201 USPQ 957 (TTAB 1979); TMEP §1212.06. Excerpts from applicant's own website do not in themselves demonstrate that the proposed mark has acquired distinctiveness; at best, such advertising merely demonstrates use in commerce.

Given the highly descriptive nature of the proposed mark, applicant has simply not met its evidentiary burden to show that the wording has acquired distinctiveness. Absent such evidence, registration has been properly refused under Section 2(e)(1) of the Act, on the grounds that the proposed mark is merely descriptive of the claimed services.

CONCLUSION

The Examining Attorney has demonstrated that there is a genus of services known as custom design services, that applicant's services fall within the scope of this genus, and that the term "made-to-order" is a known and recognized designation for such custom design services. Applicant's proposed mark MADETOORDER is therefore generic as applied to the claimed services and the refusal to register under Trademark Act §2(e)(1), 15 U.S.C. §1052(e)(1) should be affirmed. Alternatively, the Examining Attorney has demonstrated that the wording "made-to-order" is merely descriptive of the claimed services, and that the evidence provided by applicant to establish acquired distinctiveness is insufficient. Absent sufficient evidence, the Examining Attorney's refusal to register the proposed mark pursuant to Section 2(f) of the Act should also be affirmed.

Respectfully submitted,
/Michael W. Baird/AC/
Managing Attorney, Law Office 116
571-272-9487
michael.baird@uspto.gov (informal queries
only)

Print: Aug 16, 2011

76874448

DESIGN MARK

Serial Number

75874448

Status

EXPIRED

Word Mark

MADETOORDER.COM

Standard Character Mark

No

Registration Number

2408618

Date Registered

2000/11/28

Type of Mark

SERVICE MARK

Register

PRINCIPAL

Mark Drawing Code

(5) WORDS, LETTERS, AND/OR NUMBERS IN STYLIZED FORM

Owner

TEN PARTNERS, INC. DBA MADETOORDER CORPORATION 1244 A QUARRY LANE
PLEASANTON CALIFORNIA 94566

Goods/Services

Class Status -- EXPIRED. IC 042. US 100 101. G & S: on-line design
services for other in the field of personalized and custom design
transfers, namely, text, pictures and graphics for imprinting on
apparel. First Use: 1999/08/09. First Use In Commerce: 1999/08/18.

Disclaimer Statement

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MARK AS SHOWN.

Filing Date

1999/12/17

Examining Attorney

MEIER, SHARON

Attorney of Record

TEAN ABRAMOWICZ

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