

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

In re Application of:

Applicant : TruServ Corporation
Mark : WOOD CARE CENTER
Serial Number : 78/068851
Filed : June 13, 2001



06-10-2003

U.S. Patent & TMOfc/TM Mail RcptDt. #22

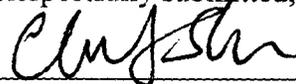
BOX TTAB -- FEE
Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

NOTICE OF APPEAL

Applicant, by its undersigned attorneys, hereby appeals from the Final Office Action dated December 6, 2002 to the Trademark Trial and Appeal Board. Applicant will submit a brief in support of this appeal in due course.

FEE: Please charge the required fee of \$100.00 to Deposit Account No. 500603 maintained by TruServ Corporation.

Respectfully submitted,



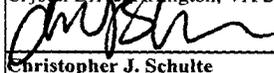
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06/16/2003 KGIBBONS 00000001 500603 78068851

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Date of Deposit: June 6, 2003.

I hereby certify that this paper and fee are being deposited with the United States Postal Service on the date indicated above and is addressed to BOX TTAB-- FEE, Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA 22202-3513


Christopher J. Schulte

Date of Signature June 6, 2003.

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June 6, 2003

Elizabeth J. Winter, Examining Attorney
Law Office 113
BOX RESPONSE – NO FEE
Assistant Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513



06-10-2003

U.S. Patent & TMO/c/TM Mail Rcpt Dt. #22

Re: Response to Office Action dated 9/19/01
Applicant: TruServ Corporation
Mark: WOOD CARE CENTER
Serial No. 78/068851
Filing Date: 6/13/01
Our Ref. No.: 54639-62

Dear Ms. Winter:

This is in response to the Final Office Action for the above-referenced mark dated December 6, 2002 in which the Examining Attorney issued a final refusal. Applicant respectfully requests reconsideration based on the following additional evidence and arguments.

Applicant submits new arguments along with this request which demonstrate that Applicant's mark should be allowed to proceed to registration. In particular, Applicant submits that because this mark is in substantial use nationwide as part of a niche department, the mark has acquired distinctiveness through secondary meaning. Accordingly, Applicant requests registration of the mark.

ARGUMENT

RECITATION OF SERVICES

In the Final Office Action, the Examining Attorney indicated that applicant may adopt the following recitation:

Retail hardware store services featuring wood care and related products, namely, paints, stains, protectants, sealants and finishes, and paint and stain accessories including brushes and rollers for the treatment of home remodeling and building materials.

Applicant adopts the amendment.

DESCRIPTIVENESS OF THE MARK

1. *The Mark Quickly Develops Secondary Meaning By Virtue Of Its Use In The Niche Department Concept*

On the basis of the niche department concept, the proposed mark has acquired distinctiveness through secondary meaning to True Value store customers. The mark WOOD CARE CENTER is used as part of the niche department concept in approximately 454 stores across the nation. *See Declaration of Tracy Polyak*. The mark is unique; customers recognize the mark as an indicator of the specialized department in their local True Value store. It uniformly functions as part of the Platinum Paint Shop[®], which is a larger niche department identified by the registered trademark Platinum Paint Shop[®]. Because niche departments give rise to increased consumer attention and recognition, the use of WOOD CARE CENTER as a source indicator for the niche departments in Applicant's True Value brand of hardware stores naturally gives rise to a more immediate recognition by the consumer of the WOOD CARE CENTER mark. WOOD CARE CENTER has secondary meaning.

2. *The Mark Is A Unitary Slogan and Therefore Distinctive.*

Applicant's mark is a plurality of words, or a slogan, which can function as a mark to identify goods and services. *McCarthy, McCarthy on Trademarks and Unfair Competition*, §7:19 (4th Ed. 2001). Slogans used in a trademark sense are considered unitary by the PTO. TMEP 1213.06(b)(i). And the Board has stated that slogans may be "ingenious, clever, catchy, trite, dull, nonsensical and the like" but nevertheless can be registrable even if not a work of art. *In re Joseph Bancroft & Sons Co.*, 129 U.S.P.Q. 329 (TTAB 1961)(THE TEST IS IN THE TOUCH for clothing registrable); *see also In re Sottile*, 156 USPQ 655 (TTAB 1968)(YOUR FINANCIAL SECURITY IS OUR BUSINESS for insurance planning services registrable), *In re David Crystal, Inc.* 145 USPQ 95 (TTAB 1965) (SPORTSWEAR FOR EVERWEAR registrable).

Applicant's mark WOOD CARE CENTER operates in a trademark sense and is unitary because of its sound pattern. The PTO considers a mark made up of relatively descriptive elements to nevertheless be distinctive if the mark as a whole uses rhyme, alliteration or **some other sound pattern** to create a distinctive impression. TMEP 1213.06(b)(iv). As the Board held in *In re Kraft, Inc.*, 218 U.S.P.Q. 571 (TTAB 1983), the mark "LIGHT N' LIVELY" as a whole "has an alliterative lilting cadence which encourages persons encountering it to perceive it as a whole." *Id.* at 573. The Board held the words related more to each other than directly to the goods they represent so as to form a unit. Therefore consumers were not likely to break the mark down to its component elements but would regard it as a unitary slogan. On these grounds the Board held the mark suggestive and registrable.

The mark WOOD CARE CENTER, likewise, uses alliteration and thus has a distinctive sound. The mark has inherent distinctiveness that consumers remember.

CONCLUSION

Applicant has provided additional arguments which it requests the Examining Attorney to consider. Applicant respectfully submits that its mark is entitled to registration on the Principal Register and requests the Examining Attorney to lift her refusal and allow the mark to proceed to publication for opposition.

Respectfully Submitted,



**CHRISTOPHER J. SCHULTE
KRISTINE M. BOYLAN**

CJS/KMB/ln/1050430

CERTIFICATE OF MAILING
UNDER 37 CFR 1.8

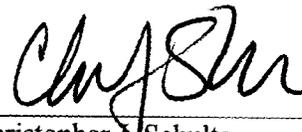
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**Elizabeth J. Winter, Examining Attorney
Law Office 113
Commissioner for Trademarks
BOX RESPONSE - NO FEE
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Date: June 6, 2003.

Name/Signature: _____


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Dear Madam or Sir:

I enclose here for filing the following documents:

- 1) Notice of Appeal; and
- 2) A courtesy copy of the Request for Reconsideration filed with the examining attorney today.

Please let me know if you have any questions regarding these documents.

Sincerely yours,

**CHRISTOPHER J. SCHULTE
KRISTINE M. BOYLAN**

03 JUN 23 AM 9:31
TRU-SERV CORPORATION AND
WOOD CARE CENTER

CJS/KMB/lln/Enclosures/1050572
cc: Susan M. Radde, Esq. (w/enclosures)