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

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

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APPLICANT'S APPEAL BRIEF

Dated: October 8, 2003.

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APPLICANT'S APPEAL BRIEF

I. Statement of Issue.

Issue: Whether the Examiner's refusal to register the mark WOOD CARE CENTER on grounds that the mark is descriptive was proper.

II. Statement of Relevant Facts.

Applicant seeks registration of the word mark WOOD CARE CENTER for use in connection with:

> 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 in international class 35.

Applicant's Amendment to the Recitation of Services, dated June 6, 2003.

Applicant TruServ Corporation, a Fortune 500 company, is the nation's largest hardware cooperative. *(Dec. of David Vermilya at ¶ 2)* More than 6,000 independent True Value® retailers are located in every state of the nation and serve thousands of hardware consumers daily. *(Id.)* TruServ Corporation is organized to support its members' retail sales efforts. *(Id.)*

In doing so, TruServ is the nation's largest hardware cooperative with over $4 billion in wholesale sales, which supports $12 billion in retail sales. *(Id.)*

In January 1999, TruServ began to offer its members new programs to increase the prominence of its wood treatment and wood-related products under the trademark WOOD CARE CENTER. *(Dec. of David Vermilya at ¶ 4.)* The trademark is used on in-store signage in the wood treatment and wood-related section of the retail stores. *(Id.)* The mark is designed to draw attention to, and increase sales of, products such as paints, stains, protectants, sealants and finishes, as well as paint and stain accessories such as brushes and rollers. *(Id.)*

As of June 2003, 454 TruServ cooperative members use the mark WOOD CARE CENTER in their True Value® stores to designate the WOOD CARE CENTER department. *(Dec. of Tracy Polyak at ¶ 3.)* This amounts to more than $1 million of signage sent to the retail stores for use. *(See Dec. of David Vermilya at ¶ 5 and Dec. of Tracy Polyak at ¶ 3.)*

As a result, significant numbers of consumers – an estimated 1 million -- have been exposed to the mark by virtue of purchasing millions of dollars of wood care products in stores using the mark. *(Dec. of David Vermilya at ¶ 6-7).* TruServ manager David Vermilya estimated, based on the sales and revenue numbers, that millions of consumers around the nation have been exposed to the mark. *Id.*

III. <u>Procedural History and Evidence of Record</u>.

The Examiner initially refused registration of Applicant's mark, arguing that the mark WOOD CARE CENTER is descriptive. *(Office Action, dated Sept. 19, 2001.)* In support of the refusal, the Examiner attached three separate excerpts from the *American Heritage Dictionary* (regarding the term "wood", "care" and "center").

Applicant disagreed with the characterization of the mark as descriptive, submitting that the mark is not descriptive. *(Applicant's Response to Office Action, dated Mar. 19, 2002.)* In the

alternative, Applicant submitted that registration is appropriate under Section 2(f) of the Trademark Act, as the mark enjoys acquired distinctiveness through a secondary meaning. *(Id.)* In support of its argument that the mark has acquired distinctiveness through a secondary meaning, Applicant submitted evidence of long use of the mark along with large-scale expenditures in promoting and advertising services, namely, in the form of a Declaration from Dave Vermilya.

In the Second Office Action, the Examiner characterized Applicant's claim of acquired distinctiveness as insufficient to warrant proceeding. *(Office Action, dated April 19, 2002.)*

In Applicant's response to the Second Office Action, Applicant argued that the Examiner failed to correctly consider the evidence and did not accord it proper weight. *(Applicant's Response to Office Action, dated Oct. 16, 2002.)*

In the Final Refusal, the Examiner continued the descriptiveness refusal and produced evidence in the nature of media and dictionary usage of the phrase "wood care" to support the refusal, as well as evidence showing the historical treatment of the words wood, care and center on the Principal Register historically. *(Office Action, dated December 6, 2002.)*

Applicant submitted a Request for Reconsideration, arguing that the mark has secondary meaning either through its nature as a unitary mark or through a "niche department" concept. *(Request for Reconsideration, dated June 10, 2003).*

In the Denial of Applicant's Request for Reconsideration, the Examiner continued to characterize the mark WOOD CARE CENTER as descriptive and refused to accord it registration under Section 2(e)(1). *(Office Action, dated August 1, 2003.)*

IV. Argument.

A. Settled Law On The Dichotomy Between Descriptive and Suggestive Marks Dictates That A Section 2(e)(1) Refusal For Descriptiveness Is Improper For This Application.

1. Marks That An Examiner Refuses For Descriptiveness Are Routinely Deemed Suggestive By The Trademark Trial and Appeal Board.

The determination of mere descriptiveness must be made not in the abstract or on the basis of guesswork, but in relation to the goods or services for which registration is sought, the context in which the term or phrase is being used or is intended to be used on or in connection with those goods or services, and the impact that it is likely to make on the average purchaser of such goods or services. *In re Bright-Crest Ltd.*, 204 U.S.P.Q. 591, 593 (TTAB 1979).

There is often a very narrow line between terms which are merely descriptive and those which are suggestive, and the borderline between the two is hardly a clear one. *In re Atavio Inc*, 25 U.S.P.Q.2d 1361 (TTAB 1992), *cited in In re National Penn Bank*, Serial No. 75/696,025, 2002 TTAB LEXIS 180, *4 (February 21, 2002) (deciding that the application to register DIRECT INVEST for banking services should not be refused for descriptiveness).

In a case where when the goods are encountered in connection with a particular mark and a multistage reasoning process, or resort to imagination, is required in order to determine the attributes or characteristics of the product, the mark is suggestive rather than merely descriptive. *In re Abcor Development Corp.*, 588 F.2d 811, 813, 200 U.S.P.Q. 215, 218 (CCPA 1978); *In re Atavio Inc*, 25 U.S.P.Q.2d 1361, 1362 (TTAB 1992), *cited in In re Medical Technology Group, Inc.*, Serial No. 76/138,174, 2002 TTAB LEXIS 702, *5 (November 8, 2002) (reversing refusal to register INTEGRATED VASCULAR SYSTEMS for surgical and diagnostic instruments as the evidence showed it to be suggestive rather than descriptive).

Indeed, a mark is descriptive only in narrow circumstances. In order for an application to be properly refused on grounds of descriptiveness, the description must be exact and particular.

In re Pedia Pals, LLC, Serial No.76/037,531, 2002 TTAB LEXIS 670, *2 (October 18, 2002) (finding "that as applied to applicant's goods, the mark FACE GEAR for toy novelty items, namely disguises, simply does not describe with the required 'degree of particularity' any significant characteristic or feature of applicant's goods.") The mark must "directly convey immediate information" about the applicant's goods to which the subject trademark is affixed. *In re Kenneth H. Allman II*, Serial No. 75/762,516, 2001 TTAB LEXIS 747, *5 (October 3, 2001) (reversing refusal to register HOSPITALLINK as descriptive for computer services providing a searchable index of hospitals.)

WOOD CARE CENTER does not necessarily describe any particular item. The mark gives a vague impression that it relates to *some thing* which relates to wood. Instead, however, Applicant's WOOD CARE CENTER actually represents the services of selling products which are applied to color or protect wood surfaces. Thus, this mark does not make any description with particularity nor does it directly convey immediate information as to the services it represents. As a result, the mark should not be refused on grounds of descriptiveness.

2. This Precedent Favors Resolution In Applicant's Favor.

In an ex parte appeal where a descriptiveness refusal is at issue, the TTAB is to resolve any doubt about the descriptiveness of the term in the applicant's favor. *In re Mason Shoe Manufacturing Co.*, Serial No. 75/404,671, 2000 TTAB LEXIS 838, *6 (December 14, 2000) (resolving doubts in favor of applicant and reversing refusal to register SHOE MALL as descriptive for online retail services in the field of footwear); *In re Bliss & Laughlin Industries, Inc.*, 198 U.S.P.Q. 127, 128 (TTAB 1978); *In re The Rank Organisation Limited*, 222 U.S.P.Q. 324, 326 (TTAB 1984). Where there is any doubt in drawing the line of demarcation between a suggestive mark and a merely descriptive one, such doubt is to be resolved in applicant's favor. *In re Atavio Inc*, 25 U.S.P.Q.2d 1361, 1363 (TTAB 1992), *cited in In re Peavey Electronics*

Corp., Serial No. 75/355,174, 2000 TTAB LEXIS 160, *4 (March 10, 2000) (deciding that STAGE PACK is suggestive as it does not immediately describe with particularity the nature of the goods and reversing the refusal to register).

Given the presumption of resolving doubts in applicant's favor, this mark should be categorized as suggestive and allowed to proceed to publication. Once there, competitors or others will have the opportunity to pose an opposition. *In re Gourmet Bakers, Inc.*, 173 U.S.P.Q. 565, 565 (TTAB 1972), cited in *In re Platinum Technology, Inc.*, Serial No. 74/523,159, 1999 TTAB LEXIS 211, *8-9 (May 18, 1999) (stating that "we find this to be an extraordinarily close case which is replete with doubt" but that "[a]ccording to long standing Board practice, it is our policy to resolve doubts on the issue of descriptiveness in applicant's favor and pass the mark to publication for possible opposition.") As this tribunal stated:

> [T]he suggestive/descriptive dichotomy can require the drawing of fine lines and often involves a good measure of subjective judgment. Indeed, this case may well present such a challenge in making the necessary classification. At the very least, however, we have doubts about the "merely descriptive character of the mark before us and, unlike the situation in determining likelihood of confusion under Section 2(d) of the Trademark Act, it is clear that such doubts are to be resolved in favor of applicants.

In re Application of Shop-Vac Corp., 213 U.S.P.Q. 470, 472 (TTAB 1983), citing *In re Pennwalt Corp.*, 173 U.S.P.Q. 317 (TTAB 1972) ("DRI-FOOT" for anti-perspirant foot deodorant).

In this case, WOOD CARE CENTER provides the impression that it relates to goods which involve wood, a laminate or other wood imitation, but instead it actually represents the services of selling products which are applied to color or protect wood surfaces. As such, the mark is not descriptive because the relevant consumer must make a mental leap to determine the nature of the services offered.

3. The Examining Attorney Has Not Carried Its Burden To Support A Descriptiveness Refusal.

The Examining Attorney bears the burden of showing that a mark is merely descriptive of the relevant goods. *In re Merrill Lynch, Pierce, Fenner and Smith Inc.*, 828 F.2d 1567, 1571, 4 U.S.P.Q.2d 1141, 1143 (Fed. Cir. 1987).

In this case, the Examiner's evidence is insufficient to prove that WOOD CARE CENTER for retail hardware store services featuring wood care and related products should not proceed to publication on grounds that it is descriptive. The evidence does not clearly establish that the phrase WOOD CARE CENTER is commonly used to describe retail hardware store services featuring wood care and related products. *See e.g., In re YZ Enterprises, Inc.*, Serial No. 75/262,976, 2000 TTAB LEXIS 522, *5 (July 28, 2000) (reversing the refusal to register for descriptiveness and deciding that the evidence did not show that BRANTREATS immediately described biscuits, the nature of applicant's goods).

B. In The Alternative, The Application Should Be Allowed To Proceed On Grounds That The Mark Has Acquired Distinctiveness Through Secondary Meaning.

Evidence of long use of the mark along with large scale expenditures in promoting and advertising services under the mark are significant in the analysis. TMEP 1212.06(a), (b). Applicant's mark can be registered under an acquired distinctiveness theory if Applicant's use of the mark has caused the purchasing public to identify the mark with the source of the service. *In re Owens-Corning Fiberglass Corp.*, 774 F.2d 1116, 1125 (Fed. Cir. 1985).

1. Large Scale Expenditures In Promotions And Ads Lend To Secondary Meaning.

Evidence relating to the nature and extent of the public exposure achieved by the designation, including volume of sales, length of time of use and advertising and other promotional efforts, with commercial success, along with the amount of expenditures, all

measure the degree to which a mark has achieved secondary meaning. *In re FHP, Inc.*, Serial No.74/414.040, 1997 TTAB LEXIS 435, *20 (1997) (recognizing that the applicant's advertising and promotional evidence indicated that the designation "SENIOR PLAN" for health plans designed for senior citizens has acquired a de facto secondary meaning.); *Paper Cutter Inc. v. Fay's Drug Co. Inc.* 900 F.2d 558, 564-65, 14 U.S.P.Q.2d 1450, 1454 (2d. Cir. 1990). Courts recognize that the normal consequence of substantial publicity may be inferred. *President and Trustees of Colby College v. Colby College-New Hampshire*, 508 F.2d 804, 808 (1st Cir. 1975).

Here, millions of retail hardware consumers have been exposed to half a million dollars worth of in-store signage and have purchased at least $200,000 worth of product in the departments bearing the mark. Thus, the mark enjoys substantial publicity and the "normal consequence" of such publicity is the inference that consumers have come to associate the mark with one source. Accordingly, the mark has acquired distinctiveness and is eligible to be registered on that basis.

2. Length Of Use Is A Factor In The Secondary Meaning Analysis.

It is well-established that there is no fixed rule as to the length of time a symbol must be in use before it can achieve secondary meaning. *Jackson v. Universal International Pictures, Inc.*, 222 P.2d 433, 87 U.S.P.Q. 131 (1950); *California Crushed Fruit Corp. v. Taylor Beverage and Candy Co.* 38 F.2d 885, 885 (W.D. Wis. 1930).

Applicant has used its mark in commerce since January 1999 – nearly full four years of continuous and uninterrupted use. *See Declaration of David Vermilya* at ¶ 4. Applicant has used the mark in commerce for nearly four years, and will soon be entering its fifth year of use. When the evidence submitted by the Applicant is considered in its entirety and not merely by the non-exclusive time standard (*i.e.*, Applicant's evidence regarding its extensive advertising efforts and

the mind of the public when encountering the mark), the mark has acquired distinctiveness by secondary meaning. Therefore, the Applicant's mark is eligible to be registered.

3. This Particular Mark Quickly Developed Secondary Meaning By Virtue Of Its Use In A "Niche Department."

The proposed mark has acquired distinctiveness through secondary meaning to TruServ coop members and True Value store customers on the basis of a "niche department" concept. 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 at* ¶3. 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.

4. This 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 U.S.P.Q. 655 (TTAB 1968)(YOUR FINANCIAL SECURITY IS OUR BUSINESS for insurance planning services registrable), *In re*

David Crystal, Inc. 145 U.S.P.Q. 95 (TTAB 1965) (SPORTSWEAR FOR EVERWEAR registrable).

Applicant's mark WOOD CARE CENTER operates in a trademark sense and is unitary also 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.

V. <u>Conclusion</u>.

For these reasons, Applicant respectfully requests that this tribunal permit the application to proceed.

Dated: October 8, 2003

Respectfully submitted,

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Date of Deposit: October 8, 2003.

I hereby certify that this paper is being deposited with the United States Postal Service on the date indicated above and is addressed to BOX TTAB--NO FEE, Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA 22202-3513

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Mark: WOOD CARE CENTER
Serial No.: 78/068851
Filing Date: 6/13/01
Our Ref. No.: 54639-62

Dear Madam or Sir:

I enclose here for filing an original and two copies of Applicant's Appeal Brief. A copy of this brief is being provided to the Examining Attorney, Elizabeth J. Winter, in this matter.

Sincerely yours,

CHRISTOPHER J. SCHULTE
KRISTINE M. BOYLAN

CJS/KMB/lln/Enclosure/1079687
cc: Elizabeth J. Winter, Esq. (w/enclosure)