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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	TruServ Corporation	§	BEFORE THE
		§	
Proposed Mark:	WOOD CARE CENTER	§	TRADEMARK TRIAL
		§	
		§	
Serial No:	78/068851	§	AND
		§	
Attorneys:	Christopher J. Schulte	§	APPEAL BOARD
	Kristine M. Boylan	§	
		§	
Address:	Meagher & Geer	§	ON APPEAL
	33 S. Sixth Street, Ste. 4200	§	
	Minneapolis, MN 55402	§	

EXAMINING ATTORNEY'S APPEAL BRIEF COVER SHEET

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EXAMINING ATTORNEY'S APPEAL BRIEF

STATEMENT OF THE CASE

The applicant has appealed the Trademark Examining Attorney's final refusal to register the above-captioned mark on the Principal Register. Registration was refused on the ground that the proposed mark is merely descriptive of the services under Section 2(e)(1) of the Act, 15 U.S.C. § 1052(e)(1) because the wording immediately informs the potential users or purchasers of applicant's services of a significant feature of applicant's retail hardware store services, namely, that applicant's retail services provides a center (or central location) for wood care products. The Examining Attorney also determined that the evidence in support applicant's claim of acquired distinctiveness was insufficient to overcome the refusal under Section 2(e)(1).

FACTS

The applicant filed an application to register the wording WOOD CARE CENTER in connection with the following services in International Class 35:

“retail hardware store services featuring *wood care* and related products.” (emphasis added)

In the first Office Action, the Examining Attorney refused registration under Section 2(e)(1), 15 U.S.C. § 1052(e)(1), because the proposed mark merely describes a characteristic or function of applicant’s services, namely, that applicant’s hardware store services provide a “center” for its wood care products. In support of the refusal, the Examining Attorney provided dictionary definitions of the words in the proposed mark and a copy (from the USPTO database) of applicant’s registration for the same mark on the Supplemental Register for related goods.

In response to the first office action, Applicant claimed ownership of the above-mentioned prior registration and sought to amend the recitation of services to delete the wording “wood care”. Applicant argued that the proposed mark is not descriptive, but also submitted, in the alternative, that the proposed mark had acquired distinctiveness. Applicant thus requested registration based upon Section 2(f) of the Trademark Act. Applicant provided the following information to support its claim of acquired distinctiveness, along with a declaration from applicant’s “Paint Products, Store Fixtures and Decor Manager”:

- Applicant has used the proposed mark for *three* years;
- Photograph of signage for proposed mark in 247 retail stores;
- Retail “members” have purchased approximately \$569,000 worth of signage;
- Sales of wood treatment products in excess of \$200,000 per year since date of first use; and
- Average *overall* retail sales is over \$12 billion per year (*not* specific to sales of wood care products).

Based on the information provided, including the Declarant’s statement that the applicant does not track exact store sales of wood care products, the Examining Attorney maintained the refusal under Section 2(e)(1) and determined that applicant’s claim of acquired distinctiveness was

insufficient to overcome the refusal. The Examining Attorney invited applicant to submit additional evidence to support its claim under Section 2(f); offered registration on the Supplemental Register; and requested that applicant amend the recitation of services to be within the scope of the original identification.

In response to the Second Office Action, applicant again sought to amend the recitation of services to exclude reference to "wood care and related products," which would have been beyond the scope of the original identification. Applicant also essentially argued that secondary meaning as to the proposed mark should be inferred from evidence of applicant's overall sales.

In response to applicant's submission, the undersigned issued a Final Action, which maintained and made final the refusal under Section 2(e)(1). The Examining Attorney also stated that applicant's evidence of record did not establish that the proposed mark had acquired distinctiveness. Finally, the Examining Attorney maintained and made final the requirement for applicant to amend the recitation of services within the scope of the original identification. 37 C.F.R. § 2.71(a). In support of the final refusal under Section 2(e)(1), the Examining Attorney provided additional relevant evidence. In response to the Final Refusal, Applicant timely filed a Request for Reconsideration, which adopted the following recitation of services, as requested by the Examining Attorney:

"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 also filed its Notice of Appeal and Applicant's Brief. In the Denial of Request for Reconsideration, the Examining Attorney accepted the proposed amendment to the recitation of services, but denied applicant's request for reconsideration in connection with the refusal under Section 2(e)(1).

This Examiner's Statement addresses the basis for and the principal evidence in support of the refusal and the denial of the claim of acquired distinctiveness, and requests that the Trademark Trial and Appeal Board affirm the refusal under Section 2(e)(1).

ARGUMENT

A. Proposed Mark is Merely Descriptive under Section 2(e)(1)

The Examining Attorney refuses registration on the Principal Register under Trademark Act Section 2(e)(1), 15 U.S.C. Section 1052(e)(1), as amended, because the proposed mark is merely descriptive of applicant's retail hardware store services. A proposed mark is considered to be merely descriptive under Section 2(e)(1) of the Trademark Act, if it immediately describes an ingredient, quality, characteristic or feature thereof, or if it directly conveys information regarding the nature, function, purpose or use of the goods or services. *See In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987); *In re Bed & Breakfast Registry*, 791 F.2d 157, 229 USPQ 818 (Fed. Cir. 1986); *In re MetPath Inc.*, 223 USPQ 88 (TTAB 1984); *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979).

Further, in order to determine whether or not a mark is merely descriptive, the Examining Attorney must review the proposed mark in relation to the goods or services for which registration is sought, not in the abstract. This requires consideration of the context in which the mark is used and the possible significance that the mark would have to the average purchaser of the goods or services in the marketplace. *See In re Omaha National Corp.*, 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987); *In re Polo International Inc.*, 51 USPQ2d 1061 (TTAB 1999); *In re Digital Research Inc.*, 4 USPQ2d 1242, 1244 (TTAB 1987); *In re Venture Lending Associates*, 226 USPQ 285 (TTAB 1985); *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215, 217-218 (C.C.P.A. 1978).

Applicant's proposed mark, "WOOD CARE CENTER," is merely descriptive of the recited services because the wording immediately describes or informs the potential purchaser that applicant's retail hardware services comprise (in part) a *center* for its *wood care* products. Further, no incongruous or suggestive meaning can be inferred from the proposed mark, and applicant has failed to suggest any alternative meaning. A mark that combines descriptive terms is not registrable unless the composite creates a unitary mark with a unique, non-descriptive meaning or commercial impression. *In re Sun Microsystems Inc.*, 59 USPQ2d 1084 (TTAB 2001); *In re Putnam Publishing Co.*, 39 USPQ2d 2021 (TTAB 1996); *In re Copytele, Inc.*, 31 USPQ2d 1540 (TTAB 1994); *In re Lowrance Electronics*, 14 USPQ2d 1251 (TTAB 1989); *In re Digital Research Inc.*, 4 USPQ2d 1242 (TTAB 1987); and *In re Ampco Foods, Inc.*, 227 USPQ 331, 333 (TTAB 1985). For these reasons, the proposed mark is not registrable on the Principal Register under Section 2(e)(1).

The Examining Attorney's finding that the mark, as a whole, does not create a separate, non-descriptive meaning is supported by the record and the wording of the proposed mark itself. In addition, Applicant has not suggested, explained or provided evidence for what non-descriptive meaning or connotation the mark as a whole might evoke. When the Examining Attorney sets forth a *prima facie* case, the applicant cannot simply criticize the absence of additional evidence supporting the refusal and must come forward with evidence supporting its argument for registration. *In re Sun Microsystems, Inc.*, 59 USPQ2d 1084, 1085 (TTAB 2002), *citing In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009, 1010 (Fed. Cir. 1987). The applicant should articulate what such impression may be. 59 USPQ2d at 1088.

To support the refusal under Section 2(e)(1), the Examining Attorney emphasizes the following information and materials in the record.¹ These data show that the proposed mark is merely descriptive of a feature of applicant's retail hardware services because it comprises wording that states only that there exists a *center* or central location for *wood care* products in the store.

- Dictionary definitions of the wording in the proposed mark, which are attached to this Examining Attorney's first and final actions, show that the proposed mark is comprised of terms that merely describe a feature of the services.
- Nexis and Internet Evidence, and evidence from the USPTO database, as follows:
 - (i) The phrase "wood care" or "wood-care" is used frequently in connection with products that *protect* wood. See printouts from the Examining Attorney's search using the Nexis[®] database and a search engine on the Internet, which show such usage:

<http://www.wolmanc.com/woodcarebasics.asp>; <http://www.furnishmagazine.com> ("The experts from Murphy's Oil soap explain how to *protect* your wood from dust, wax, and water" at *Murphy's Wood Care Center.*);
<http://www.murphyoilsoap.com/cp/mos.class/caringforwood/woodfinishes.jsp>;
www.jordansfurniture.com/furniture_care/wood.asp; and
<http://www.arcata.com/arcatos/cos31/arc31178.cfm>.

- (ii) The phrases "wood care, "woodcare" or "wood-care" are used uniformly in the industry to describe products that are used to care for, preserve and restore wood. See printouts from the Examining Attorney's search using the Nexis[®] database and a search using a search engine on the Internet, which show such usage:

<http://www.woodcaresystems.com/>; <http://www.briwaxwoodcare.com/>;
<http://www.homefurnish.com/woodcare.htm>;
<http://www.atesscoinc.com/WoodCare/default.asp>;
<http://www.furniturestuff.com/Web%20Pages/WoodCare.asp>;
<http://westinteriorservices.com/woodcare.htm>;
<http://www.greatcleaners.com/web/department.asp?did=843&pdid=14>;
http://www.chaseproducts.com/products/champion/cleaning/ch_cleaning_wood.cfm;
<http://www.howardproducts.com/>; <http://www.timelesswoodcare.com/>;
http://www.epinions.com/hm..._Care_Kit_RCM_8/display_~latest_prices;
http://www.pledge.com/pledge.com/pledge_woodadvice.asp; and
<http://www.briwaxwoodcare.com/map.htm>.

¹ The Examining Attorney respectfully refers the Board to pages 4 and 5 of the Final Action, which contains a comprehensive list of evidence attached to that action.

(iii) Printouts from the USPTO X-Search database that show that the wording "center" or "care center" are uniformly disclaimed on the Principal Register, on the Principal Register under Section 2(f) or on the Supplemental Register.

(iv) The word "centers" is used in connection with other home improvement products, as well as woodcare products. See printout from the Examining Attorney's search using the Nexis® database.

- Applicant's specimen of use clearly shows that the wording "Wood Care Center" is used immediately adjacent to wood care products.

The Trademark Trial and Appeal Board has held that materials obtained through computerized text searching are competent evidence to show the descriptive use of terms under Trademark Act Section 2(e)(1), 15 U.S.C. Section 1052(e)(1). *In re National Data Corp.*, 222 USPQ 515, 517 n.3 (TTAB 1984).

Based on the evidence contained in the record, it is clear that the phrase "WOOD CARE CENTER" will be recognized by the purchasers of applicant's retail hardware services as a statement that the particular store has a specific location or *center* where wood care products may be found. Thus, in the context that the wording is used, the purchasers or user of applicant's services will immediately understand a significant feature of applicant's services. No imagination, thought, or perception is required to do so. *Stix Products, Inc. v. United Merchants & Mfrs., Inc.*, 295 F.Supp. 479, 160 USPQ U.S.P.Q. 777 (S.D.N.Y. 1968). See also *Park 'N Fly v. Dollar Park and Fly, Inc.*, 224 USPQ 327 (U.S. 1985). Further, it is not necessary that the wording describe all of the purposes, functions, characteristics or features of a product to be considered merely descriptive; it is enough if the term describes one significant function, attribute or property. *In re H.U.D.D.L.E.*, 216 USPQ 358 (TTAB 1982); *In re MBAssociates*, 180 USPQ 338 (TTAB 1973). For these reasons, the proposed mark is merely descriptive and registration therefor is correctly denied.

B. Evidence in the Record is Insufficient to Support Registration under Section 2(f)

The evidence of record also shows that applicant has not met its burden for registration to issue under Section 2(f) based on acquired distinctiveness.

Section 2(f) of the Trademark Act, 15 U.S.C. § 1052(f), provides for registration of a mark that is otherwise unregistrable under Section 2(e)(1) of the Act, when such a mark has become distinctive of applicant's services in commerce. Under Trademark Rule 2.41(a), 37 C.F.R. §2.41(a), an applicant may, in support of registrability, submit affidavits, declarations under 37 C.F.R. §2.20, depositions or other appropriate evidence showing the duration, extent and nature of the applicant's use of a mark in commerce, advertising expenditures in connection with such use, letters or statements from the trade and/or public, or other appropriate evidence tending to show that the mark distinguishes the goods or services.

Notably, the kind and amount of evidence necessary to establish that a mark has acquired distinctiveness in relation to goods or services necessarily depends on the nature of the mark and the circumstances surrounding the use of the mark in each case. *Yamaha Int'l Corp. v. Hoshino Gakki Co. Ltd.*, 840 F.2d 1572, 6 USPQ2d 1001 (Fed. Cir. 1988); *Roux Laboratories, Inc. v. Clairol Inc.*, 427 F.2d 823, 166 USPQ 34 (C.C.P.A. 1970); *In re Hehr Mfg. Co.*, 279 F.2d 526, 126 USPQ 381 (C.C.P.A. 1960); *In re Capital Formation Counselors*, 219 USPQ 916 (TTAB 1983). Typically, more evidence is required where a mark is so highly descriptive that purchasers seeing the matter in relation to the named goods or services would be less likely to believe that it indicates source in any one party. *See, e.g., In re Bongrain International Corp.*, 894 F.2d 1316, 13 USPQ2d 1727 (Fed. Cir. 1990); *In re Seaman & Associates, Inc.*, 1 USPQ2d 1657 (TTAB 1986); *In re Packaging Specialists, Inc.*, 221 USPQ 917 (TTAB 1984).

Finally, in considering a claim of acquired distinctiveness, the issue is whether acquired distinctiveness of the mark in relation to the goods or services has in fact been established in the

minds of the purchasing public. *In re Redken Laboratories, Inc.*, 170 USPQ 526 (TTAB 1971); *In re Fleet-Wing Corp.*, 122 USPQ 335 (TTAB 1959). Whether acquired distinctiveness has been established is a question of fact. See *In re Loew's Theatres, Inc.*, 769 F.2d 764, 769, 226 USPQ 865, 869 (Fed. Cir. 1985), and cases cited therein. The record must contain facts or evidence of acquired distinctiveness.

Applicant has failed to meet its burden to provide the required evidence of acquired distinctiveness. Applicant's alleged evidence of acquired distinctiveness is comprised primarily of the following data: (i) that applicant sells *overall* \$12 billion in products every year; (ii) that of the ~~\$12 billion~~ in overall products, applicant's purchasers have purchased only approximately \$200,000 annually in wood care products; (iii) that its participating member retail stores have spent on average only \$2,306 per store since 1999 for advertising materials regarding the "wood care center"; and (iv) that applicant had used the proposed mark for approximately two and one-half (2.5) years at the time the application was filed. There is no factual information in the record that shows advertising activity specifically promoting the proposed mark *as a service mark*, and there is no evidence in the record that shows that the purchasing public recognizes the proposed mark as a source identifier. Applicant's conjecture that "millions of ... customers have been exposed to ... in-store signage" is not substantiated and merely begs the question as to whether the proposed mark has acquired distinctiveness as a mark. Moreover, because applicant's proposed mark is comprised of highly descriptive and generic terms when used in connection with the recited services, applicant bears a higher burden to provide facts that show that the proposed mark has acquired distinctiveness. Again, applicant has not provided any such facts.

C. Summary

In support of the refusal under Section 2(e)(1), the record shows that the proposed mark describes a significant feature of applicant's retail hardware services. Moreover, there is no basis

in the record to support the notion that the purchasers of applicant's services would view the proposed mark in a manner different from a merely descriptive phrase about applicant's services; and there is no factual evidence of acquired distinctiveness. There is nothing incongruous or suggestive about the proposed mark, there is no rhyme or alliteration that would evoke a separate or distinct commercial impression, nor has applicant suggested any other particular meaning of the mark as a whole when considered in the context of applicant's services. Moreover, should registration issue for the proposed mark, such registration would likely encumber usage of the wording by other parties for similar services. See *In re Abcor Development*, 200 USPQ at 217,² cited with approval in *In re Universal Package Corporation*, 222 USPQ 344, 347 (TTAB 1984). Finally, applicant's intent that the proposed mark evoke a "niche department concept" does not mean that the wording functions as a source identifier. Applicant's mere intent that a term function as a service mark is not enough in and of itself, any more than attachment of the trademark symbol would be, to make a term a trademark. *In re Remington Products Inc.*, 3 USPQ2d 1714, 1715 (TTAB 1987).

Accordingly, for all of these reasons, applicant's mark is unregistrable under Section 2(e)(1) of the Act. Further, there is insufficient factual evidence to overcome the refusal and permit registration of the proposed mark under Section 2(f).

CONCLUSION

The proposed mark is used in a particular context, namely, by a retail hardware store that provides a central location for its sale of wood care products. Hence, when viewing the wording "WOOD CARE CENTER," the applicant's customers seeking wood care products will

²"The major reasons for not protecting merely descriptive marks are (1) to prevent the owner of a mark from inhibiting competition in the sale of particular goods; and (2) to maintain freedom of the public to use the language involved, thus avoiding the possibility of harassing infringement suits by the registrant against others who use the mark when advertising or describing their own products." *In re Abcor Development*, 200 USPQ at 217, citing *Armour & Co. v. Organon Inc.*, 245 F.2d 495, 498 and 500, 114 USPQ 334, 337 and 338 (1957).

immediately understand that they should go to that particular location to find wood care products. The wording does not function as a source identifier for applicant's recited services; and applicant has failed to suggest what other meaning could be attributed to the proposed mark. In addition, applicant has failed to provide sufficient evidence to show that the highly informational and descriptive wording has acquired distinctiveness and should be registered under Section 2(f). For these reasons, the wording "WOOD CARE CENTER" is merely descriptive of the proposed services. Accordingly, it is therefore respectfully requested that the refusal to register the proposed mark on the Principal Register based on Section 2(e)(1) of the Trademark Act be affirmed.

Respectfully submitted,

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