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

Proceeding	85388236
Applicant	Pit Barrel Cooker Company LLC
Applied for Mark	PIT BARREL COOKER
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Applicant : Pit Barrel Cooker Company, LLC
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Serial No. : 85/388,236
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APPLICANT'S APPEAL BRIEF

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INTRODUCTION

Pit Barrel Cooker Company, LLC (hereinafter referred to as "Applicant") appeals the Examining Attorney's refusal to register the above-referenced mark on the basis that it is generic under Section 23 (c) of the Trademark Act, 15 U.S.C. §1091(c), and respectfully requests that the Trademark Trial and Appeal Board ("TTAB") reverse the Examining Attorney's final refusal. This Appeal Brief is timely filed within sixty days of the September 5, 2013 mailing from the TTAB notifying the Applicant that the appeal has been resumed.

DESCRIPTION OF THE RECORD

Applicant Pit Barrel Cooker seeks to register the mark "Pit Barrel Cooker" for "barbecues and grills" in International Class 11 by an application filed August 3, 2011 and provided Serial Number 85/388,236. The Examining Attorney has refused registration on the ground that the applied for mark is generic for the Applicant's goods. The Applicant filed a disclaimer of "COOKER" apart from the mark and attempted to register the mark on the Supplemental Register but this was denied by the Examining Attorney. The Applicant requests that the Trademark Trial and Appeal Board reverse this decision and allow the PIT BARREL COOKER trademark to be registered.

This Appeal is necessary and proper since the Examining Attorney incorrectly concluded that the Pit Barrel Cooker trademark was generic. The Examining Attorney bears the burden of proving that an applied for mark is generic, and in this instance the Examining Attorney failed to establish that the Pit Barrel Cooker trademark is generic. Based on the evidence of record, the Applicant submits that at the very least there is doubt as to whether the Pit Barrel Cooker trademark is generic and it is well established that this doubt must be resolved in favor of the Applicant.

In addition to the arguments raised in this Appeal brief, all of the arguments and evidence of the Applicant in support of the registration of Pit Barrel Cooker made of record in the Office action response filed on May 29, 2012, the Office action response filed on December 18, 2012 and the Final office action response/Request for Reconsideration filed on July 16, 2013 are incorporated by reference herein.

On July 16, 2013 the Applicant filed a Notice of Appeal which was concurrently filed with the Request for Reconsideration. On July 16, 2013 the TTAB issued a Notice instituting the appeal and suspending further action pending the Examining Attorney's review of the Request for Reconsideration.

On August 12, 2013, the Examining Attorney issued a Reconsideration Letter denying the Applicant's Request for Reconsideration and upholding the finality of the refusal.

On September 5, 2013, the TTAB notified the Applicant that the date for filing an appeal brief was sixty days or November 5, 2013.

ISSUE TO BE DECIDED ON APPEAL

Whether Applicant's trademark PIT BARREL COOKER is generic.

RECITATION OF THE FACTS

Applicant, Pit Barrel Cooker Company, LLC, designs and sells a specialized outdoor grill. The Applicant commenced use of Pit Barrel Cooker on January 25, 2010, and has consistently and continuously used the term as a trademark for Applicant's goods since that time.

The Applicant respectfully disagrees with the Examining Attorney's conclusion that the present mark is generic. In particular, the Applicant respectfully sets forth that the Examining Attorney has not provided sufficient evidence to support a finding of genericness.

ARGUMENT

It is well established that the Trademark Office bears the burden of establishing that a mark is generic. *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 1344, 57 U.S.P.Q.2d 1807, 1810 (Fed. Cir. 2001). The test for genericness is whether the primary significance" of the mark to actual or potential purchasers of the goods or services is as an indication of type of goods, rather than the source of the goods. *See, e.g., Magic Wand, Inc. v. RDB, Inc.*, 940 F.2d 638, 640-41 (Fed. Cir. 1991).

Determining whether a mark is generic is a two part inquiry: "First, what is the genus of the goods or services at issue? Second, is the term sought to be registered ... understood by the relevant public primarily to refer to that genus of goods or services?" *H. Marvin Ginn Corp. v. Int'l Assoc. of Fire Chiefs, Inc.*, 782 F.2d 987 (Fed. Cir.1986). In order to satisfy this burden, a "strong showing" is required to establish that a mark is generic rather than descriptive. *In re K-T Zoe Furniture, Inc.*, 16 F.3d 390, 393 (Fed. Cir. 1994). The Examining Attorney responsible for evaluating whether or not PIT BARREL COOKER may be registered on the Principal Register has not met this burden.

I. PIT BARREL COOKER IS NOT GENERIC

A. The Examining Attorney's Evidence Is Insufficient to Show That PIT BARREL COOKER is Generic

1. The Examiner Has Not Identified A Single Instance Of Generic Usage Of "PIT BARREL COOKER"

The entire record in this case does not show a single use of "PIT BARREL COOKER" for a barbecue or grill. The Examining Attorney's failure to identify any generic usage seriously undermines the Examiner's claim that the mark is generic. See *Books On Tape, Inc. v. Booktape Corp.*, 836 F.2d 519, 520 (C.A. Fed. 1987) ("The board held that petitioner had not and could not establish rights in BOOKS ON TAPE as a trademark, service mark, or trade name because the name is the generic designation for cassettes on which books are recorded. Considering the record as a whole, that finding is clearly erroneous. The board was reversed with a finding that there was no evidence that petitioner itself or others in the industry used "books on tape" generically."); *Zimmerman v. National Association of Realtors*, 70 USPQ2d 1425 (TTAB 2004); *Nobelle.com LLC v. Qwest Communications International Inc.*, 66 USPQ2d 1300 (TTAB 2003). If the "PIT BARREL COOKER" mark were in fact generic, then surely the Examining Attorney should have been able to produce numerous instances of such generic use.

**2. Other Manufacturers Do Not Use PIT BARREL COOKER To
Advertise Their Products To The Public**

The Examining Attorney mistakenly ignores the fact that other manufacturers do not use "Pit Barrel Cooker" when referring to their products. The evidence presented by the Examining Attorney is not sufficient to show that the *primary significance to the public* of the term is as an indication of the type of goods, rather than the source of the goods. See *Genesee Brewing Co., Inc. v. Stroh Brewing Co.*, 124 F.3d 137, 144, 43 U.S.P.Q.2d 1734 (2d Cir. 1997) (stating that the "primary significance test" has been adopted by the Supreme Court and means that a trademark "is not generic merely because it has some significance to the public as an indication of the nature or class of an article"). In the Office Action dated June 19, 2012, the Examining Attorney referenced various internet sites as evidence showing that the relevant public understands the designation "Pit Barrel" primarily to refer to barbecues and grills (see June 19, 2012 Office Action, pages 2-3). The Examining Attorney argues that the evidence attached to the Office Action consisting of an instruction on how to make your own "barrel type barbecue pit" is sufficient to demonstrate the understanding of the relevant public. The Examining Attorney's evidence always references the term 'pit' in combination with the term 'barbecue' or 'BBQ'. Applicant's mark does not contain the term 'barbecue' and therefore does require a consumer to engage in a mental thought

process to determine the type of goods involved. Further, the Examining Attorney attached a reference to a "competitor" for a Tejas Barbecue Pit Smoker. A smoker is a very different type of product than a grill or barbecue and should not be considered as a competent reference. Finally, the Tejas Barbecue Pit Smoker does not use the terms "PIT BARREL COOKER" to refer to the smoker.

The evidence presented by the Examining Attorney is clearly insufficient to show that the primary significance to the public of the terms "PIT BARREL COOKER" is a barbecue or grill. The references never use the terms "PIT" and "BARREL" together to refer to a barbecue or grill and in this case, there is no showing that the public uses "PIT BARREL COOKER" to refer broadly to barbecue grills. See *In re American Fertility Society*, 188 F.3d 1341, 51USPQ2d 1832 (Fed. Cir. 1999) (SOCIETY FOR REPRODUCTIVE MEDICINE held not generic for association services because there was no evidence of generic use of the term).

B. The Terms "PIT" And "BARREL" Are Not Generic For A Barbecue Or Grill.

The dictionary definition of "pit" and "barrel" under www.dictionary.reference.com is as follows:

Pit

1. A naturally formed or excavated hole or cavity in the ground;
2. A covered or concealed excavation in the ground, serving as a trap.

Barrel

1. A cylindrical wooden container with slightly bulging sides made of staves hooped together, and with flat parallel ends.

The terms PIT and BARREL used together do not form a generic term or common name for a barbecue or grill. The Examining Attorney claims that the terms used together form a common name for an "old fashioned pit made from a barrel". It is unclear what type of good this is but the term "PIT" defines an excavated hole and applicant's barbecues are not formed in the ground. Further, the examples given by the Trademark Attorney refer to "barbeque pits" and "barrels" but there is no showing of the terms used as a 'PIT BARREL COOKER'. The mark is at most suggestive, as demonstrated in the following marks that were found to be non-generic:

APPLE RAISIN CRISP General Mills, Inc. v. Kellogg Co. 824 R.2d 622, 3 USPQ 2d 1442 (8th Cir. 1987) for breakfast cereal.

CALIFORNIA COOLER California Cooler Inc. v. Loretto Winery, Ltd. 774 F.2d 1451, 227 USPQ 808 (9th Cir. 1985), a beverage or wine, sparkling water and fruit juice produced in California.

HONEY BAKED HAM Schmidt v. Quigg, 609 F. Supp 227, 226 USPQ 518 (E.D. Mich. 1985) for a honey glazed ham.

PARK 'N FLY Park 'N Fly Inc. v. Park & Fly, Inc. 489 F. Supp. 422, 204 USPQ 204 (D. Mass. 1979) for an airport parking area.

At most the mark PIT BARREL COOKER is suggestive of the goods offered but it is certainly not generic.

C. The Examiner Has Violated The Anti-Dissection Rule.

In lieu of providing evidence of generic use of "PIT BARREL COOKER" the Examining Attorney has repeatedly rested his conclusion that "PIT BARREL COOKER" is generic on the fact that "PIT", "BARREL" and "COOKER" are themselves generic so the combination of those terms must also be generic. In reaching that conclusion based solely on the separate elements of the mark, the Examining Attorney has violated the anti-dissection rule, which specifies that the commercial impression of a mark is derived from it as a whole, not from its elements separated and considered in detail. See *Estate of P.D. Beckwith, Inc. v. Commissioner of Patents*, 252 U.S. 539, 545-46 (1920). The Examining Attorney has failed to consider the mark in its entirety apart from its various elements. The Examining Attorney has not provided any evidence that "Pit Barrel Cooker" is generic when taken as a whole. Under the Examining Attorney's analysis,

any mark which consists of generic components would not be registerable.

Finally, applicant's mark "PIT BARREL COOKER" is a unitary mark. "A mark or portion of a mark is considered "unitary" when it creates a commercial impression separate and apart from any unregistrable component. That is, the elements are so merged together that they cannot be divided to be regarded as separable elements. If the matter that comprises the mark or relevant portion of the mark is unitary, no disclaimer of an element, whether descriptive, generic or otherwise, is required."

T.M.E.P. § 1213.05.

A phrase qualifies as unitary in the trademark sense only if "the whole is something more than the sum of its parts." *Dena Corp. v. Belvedere Int'l, Inc.*, 950 F.2d 1555, 1561, 21 USPQ2d 1047, 1052 (Fed. Cir. 1991). Even where it includes an otherwise unregistrable component, a unitary phrase as a whole will have "some degree of ingenuity in its phraseology as used in connection with the goods; or [say] something a little different from what might be expected to be said about the product; or [say] an expected thing in an unexpected way." *Ex parte Mooresville Mills, Inc.*, 102 USPQ 440, 441 (Comm'r Pats. 1954) (holding FROM FIBER TO FABRIC FOR THE STYLE CONSCIOUS MILLIONS for fabrics capable of registration on the Supplemental Register).

D. Doubts As To Whether Or Not A Mark Is Generic Must Be Resolved In Favor Of The Applicant.

The law is clear that any doubts as to whether a mark is generic must be resolved in favor of the Applicant. See *In re Bel Pease Sales Co.*, 1 U.S.P.Q.2d 1233, 1235 (T.T.A.B. 1986) (stating that because the TTAB had doubt about the evidence that a mark was generic, it elected "as we must, to resolve that doubt by publishing the mark and allowing any person who believes he would be damaged by the registration of the mark to file an opposition"); see also MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION, § 12:57 (stating that "[d]oubts are resolved in favor of the applicant when the generic status of a term is in doubt"). The proper course of action in such a case, as the TTAB has stated, is to resolve these doubts in favor of the Applicant and allow "any person who believes he might be damaged to file an opposition." See *In re Merrill Lynch*, 828 F.2d 1567, 1571 (Fed. Cir. 1987); *In re Bel Pease*, 1 U.S.P.Q.2d at 1235. As the TTAB explained in *In re Waverly Inc.*, 27 U.S.P.Q.2d 1620, 1624 (T.T.A.B. 1993), "[w]hen the mark is published for opposition, those in the industry can decide for themselves whether or not they believe that registration . . . will inhibit their right to compete with applicant." The same safeguard exists here. Applicant has clearly presented enough evidence that it is

entitled to have doubts as to the genericness of the mark resolved in its favor.

The Examining Attorney, meanwhile, has not presented evidence sufficient to show that the primary significance of PIT BARREL COOKER is as a generic term for barbecues and grills.

CONCLUSION

Based upon the foregoing arguments, Applicant respectfully submits that the refusal to register PIT BARREL COOKER was in error and Applicant's Mark is entitled to registration on the Principal Register. Applicant respectfully requests that the Trademark Trial and Appeal Board overturn the Examining Attorney's refusal to register PIT BARREL COOKER in order to ensure consistency in its examination procedures and allow Applicant's mark to be registered on the Principal Register.

Respectfully submitted,

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