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

Proceeding	85894991
Applicant	EBCO, Inc.
Applied for Mark	LOCKDOWN MAGNET
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I. INTRODUCTION

COMES NOW the Applicant EBCO, Inc. (hereinafter “Applicant”), by counsel Matthew H. Swyers, Esq. of The Trademark Company, PLLC, and submits the instant Brief of the Applicant in support of its appeal of the Office’s refusal to register the instant trademark pursuant to Section 2(e)(1) of the Act.

II. STATEMENT OF THE CASE

Applicant applied to register the trademark LOCKDOWN MANAGEMENT on the Principal Register on or about April 4, 2013. The recited goods in the application are “magnets.”

On or about August 6, 2013 the Office conducted its initial review of the subject application. Within that context, the Office refused registration of the trademark under Section 2(e)(1) of the Act. On or about February 6, 2014 the Applicant, by counsel, presented arguments in support of registration. The Office, being unmoved by these arguments, issued a final refusal to register the trademark on March 5, 2014. The instant appeal now timely follows.

III. ARGUMENT

Refusal under Section 2(e)(1) of the Trademark Act of 1946

The Examining Attorney has refused registration based upon a finding that the mark is merely descriptive of the Applicant’s goods. Insofar as Applicant’s proposed mark is not merely descriptive of the goods identified in the application, Applicant respectfully submits that there is no basis to maintain the instant refusal and that registration of the Applicant’s mark is appropriate.

Matter that "merely describes" the goods or services on or in connection with which it is used is not registrable on the Principal Register. TMEP § 1209. As noted in *In re Abcor Development Corp.*, 588 F.2d 811, 813, 200 USPQ 215, 217 (C.C.P.A. 1978):

The major reasons for not protecting such 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.

To be refused registration on the Principal Register under §2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), a mark must be merely descriptive or deceptively misdescriptive of the goods or services to which it relates. TMEP § 1209.01(b). A mark is considered merely descriptive if it describes an ingredient, quality, characteristic, function, feature, purpose or use of the specified goods or services. *See In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987) (APPLE PIE held merely descriptive of potpourri); *In re Bed & Breakfast Registry*, 791 F.2d 157, 229 USPQ 818 (Fed. Cir. 1986) (BED & BREAKFAST REGISTRY held merely descriptive of lodging reservations services); *In re MetPath Inc.*, 223 USPQ 88 (TTAB 1984) (MALE-P.A.P. TEST held merely descriptive of clinical pathological immunoassay testing services for detecting and monitoring prostatic cancer); *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979) (COASTER-CARDS held merely descriptive of a coaster suitable for direct mailing).

The determination of whether or not a mark is merely descriptive must be made in relation to the goods or services for which registration is sought, not in the abstract. TMEP § 1209.01(b)(*emphasis added*). This requires consideration of the context in which the mark is used or intended to be used in connection with those goods or services, and the possible significance that the mark would have to the average purchaser of the goods or services in the marketplace. *Id. See also In re Omaha National Corp.*, 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987); *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215 (C.C.P.A. 1978); *In re Venture Lending Associates*, 226 USPQ 285 (TTAB 1985).

It is not necessary that a term 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 Oppedahl & Larson LLP*, 373 F.3d 1171, 1173, 71 USPQ2d1370, 1371 (Fed. Cir. 2004) ("A mark may be merely descriptive even if it does not describe the 'full scope and extent' of the applicant's goods or services," citing *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 1346, 57 USPQ2d 1807, 1812 (Fed. Cir. 2001)); *In re Gyulay*, 820 F.2d at 1218, 3 USPQ2d at 1010.

To be characterized as “descriptive,” a mark must immediately convey knowledge of the ingredients, qualities or characteristics of the goods or services. *In re Quik-Print Copy Shops Inc.*, 616 F.2d 523, 205 U.S.P.Q. 505, 507 (C.C.P.A. 1980) (emphasis added). In the context of the Lanham Act, “merely” descriptive means “only” descriptive. *Id.* at n. 7. Moreover, the mark must give some reasonably accurate or tolerably distinct knowledge of the essence of the service. If the information conveyed by the mark is indirect or vague, the mark is being used in a suggestive rather than a descriptive manner. See J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition*, §11:19 (Ed. 2000); *The Money Store v. Harris Corp. Finance, Inc.* 216 U.S.P.Q. 11, 18 (Cir. 1982) (“‘THE MONEY STORE’ conveys the idea of a commercial establishment whose service involves supplying money. The term does not, however, necessarily convey ‘the essence of the business, money lending.... Some imagination and perception are therefore required to identify the precise nature of the services’”); *In re Ralston Purina Company*, 191 U.S.P.Q. 237, 238 (T.T.A.B. 1976) (The term SUPER is not used to describe any real or specific item or characteristic or quality, but merely to connote a vague desirable characteristic or quality and therefore it need not be disclaimed from RALSTON SUPER SLUSH).

In determining whether a particular mark is merely descriptive of a product, a reviewing court must consider the mark in its entirety, with a view toward “what the purchasing public would think when confronted with the mark as a whole.” *In re Hutchinson Technology Inc.* 852 F.2d 552, 552-54 (Fed. Cir. 1988). To the extent that there may be doubt as to whether applicant’s mark is merely descriptive or suggestive of its goods, it is commonly accepted practice to resolve any doubt in the applicant’s favor and publish the mark for opposition. *In re Morton-Norwich Products, Inc.* 209 USPQ 791 (TTAB 1981); *In re Gourmet Bakers Inc.*, 173 USPQ 565 (TTAB 1972).

Applicant respectfully submits that the instant mark is suggestive of the Applicant’s goods and not merely descriptive as contended by the examining attorney.

If a consumer has to exercise “mature thought or follow a multi-stage reasoning process” to determine the characteristics of a product or service, then the mark is suggestive, not descriptive. *In re Tennis in the Round, Inc.* 199 U.S.P.Q. 496, 498 (TTAB 1978) (“This association of applicant’s mark with the phrase ‘theater-in-the-round’ creates an incongruity...,” thus TENNIS IN THE ROUND is not merely descriptive of tennis facilities.). *See also, Blisscraft of Hollywood v. United Plastics Co.* 294 F.2d. 694, 131 U.S.P.Q. 55 (2d. Cir. 1961) (POLY PITCHER not merely descriptive of polyethylene pitchers; suggestive of Molly Pitcher of Revolutionary time); *In re Colonial Stores, Inc.* 394 F.2d 549, 157 U.S.P.Q. 382 (C.C.P.A. 1968) (SUGAR & SPICE not merely descriptive of bakery products; suggestive of nursery rhyme); *Douglas Laboratories Corp. v. Copper Tan, Inc.* 210 F.2d 453, 100 U.S.P.Q. 237 (2d Cir. 1954), *cert. denied* 347 U.S. 968, 101 U.S.P.Q. 505 (1954) (finding COPPERTONE for sun tan oil suggestive, not descriptive); *In re Realistic Co.* 440 F.2d 1393, 169 U.S.P.Q. 610 (C.C.P.A. 1971) (finding CURV for permanent wave solution suggestive, not descriptive); and,

Colgate-Palmolive Co. v. House for Men, Inc. 143 U.S.P.Q. 159 (TTAB 1964) (finding RAPID-SHAVE for shaving cream suggestive, not descriptive).

In *Equine Technologies Inc. v. Equitechnology Inc.* 68 F.3d 542 (1st Cir. 1995), the court was required to determine whether the mark EQUINE TECHNOLOGIES was descriptive or suggestive when used in connection with high-tech hoof pads for horses. The court cited authorities indicating that the hallmark of the descriptive term is a specific identification of the marked good. *Id.* at 544. In holding the mark EQUINE TECHNOLOGIES suggestive rather than descriptive, the court noted that while there is no dispute that the term “equine” is descriptive of horses, the question is whether the mark, in its entirety, is merely descriptive of the plaintiff’s product — hoof pads for horses. *Id.* at 545. In this case, the court found that the mark itself does not convey information about the plaintiff’s products or its intended consumers. Rather, it requires imagination to connect the term “Equine Technologies” to hoof care products in general, and to the plaintiff’s product in particular.

In *Ex Parte Club Aluminum Products Co.* 105 USPQ 44 (Commissioner 1955), the mark COOK-N-LOOK was held registerable for transparent glass covers for cooking utensils. The mark was somewhat suggestive of a property the goods might have, but like Applicant’s mark, did not describe the goods per se:

The mark is a compound word mark which describes what one who uses the covers can do, i.e. look into the utensil to see the cooking process, but this does not make the mark descriptive of the covers. The necessity for analysis removes it from the category of mere descriptiveness.

Id.

In *Independent Nail & Packing Co. v. Stronghold Screw Products, Inc.* 205 F.2d 921, 925 (Cir. 1953), *cert. denied* 346 U.S. 491 (1953), the court held that STRONGHOLD as applied to ribbed nails was not descriptive, and stated that:

Although the word ‘stronghold’ is suggestive of one of the attributes of plaintiff’s nail with the annular thread, it is not descriptive of a nail, let alone that type of nail. A person unaware of the particular product of the manufacturer, upon seeing or hearing the name ‘stronghold’ would find it virtually impossible to identify the product to which it might have been applied.

Id.

In *Worthington Foods, Inc. v. Kellogg Co.* 732 F. Supp. 1417, 1435 (S.D. Ohio 1990), the court found that a multi-stage reasoning process was necessary before a consumer could understand the message conveyed by the mark HEARTWISE, that is, food which is healthful for the heart. The court also noted that assuming HEARTWISE meant “wise for one’s heart,” it might refer to a large number of goods or services such as running shoes, a treadmill, a calorie counter, or an Ann Landers newspaper column. The court held that HEARTWISE was a suggestive rather than descriptive mark as the consumer could not directly cull a message concerning the healthful characteristics of the goods simply from looking at the mark.

A brief review of other suggestive marks helps clarify this dichotomy:

- (1) SUGAR & SPICE for use on bakery products held suggestive not descriptive. *In re Colonial Stores, Inc.* 394 F.2d 549, 157 USPQ 382 (C.C.P.A. 1968).
- (2) 100 YEAR NITE-LITE for light with life expectancy of 500 years held suggestive not descriptive. *Donsky v. Bandwagon, Inc.* 193 USPQ 336 (D. Mass. 1976).
- (3) TENNIS IN THE ROUND held not descriptive of tennis facilities. *In re Tennis in the Round, Inc.* 199 USPQ 496 (TTAB 1978).
- (4) RAILROAD SALVAGE for sale of goods from bankruptcy liquidations and discontinued goods held suggestive. *Railroad Salvage of Conn., Inc. v. Railroad Salvage, Inc.* 561 F.Supp. 1014 (D.R.I. 1983).
- (5) UNDERNEATH IT ALL for undergarment products held suggestive in *Maidenform, Inc. v. Munsingwear, Inc.* 195 USPQ 297 (S.D.N.Y. 1977).
- (6) CITIBANK for urban banking services held suggestive in *Citibank, N.A. v. Citibanc Group, Inc.* 724 F.2d 1540 (11th Cir. 1984).

(7) CHARRED KEG for bourbon whiskey held suggestive, even though bourbon is an American-type whiskey that is made in part by aging carried out in new charred oaken containers. *In re Majestic Distilling Co., Inc.* 164 USPQ 386 (CCPA 1970).

(8) LONGTONG for barbecue tongs held suggestive in *Ex parte Nixdorff Krein Mfg Co.*, 115 USPQ 362 (Comm. Pat. 1957).

(9) BRAKLEEN for a brake parts cleaner was suggestive and not descriptive in *C.J. Webb, Inc.* 182 USPQ 63 (TTAB 1974).

(10) DRI-FOOT was held only suggestive of foot deodorant in *In re Pennwalt Corp.* 173 USPQ 317 (TTAB 1972).

(11) CHEW 'N CLEAN was held not to be descriptive for a dentrifice in *In re Colgate-Palmolive Company* 160 USPQ 733 (CCPA 1969).

(12) COPPERTONE was found not descriptive of a suntan preparation in *Douglas Lab Corp. v. Copper Tan, Inc.* 210 F.2d 453, 100 USPQ 237 (2d Cir. 1954), cert denied 347 U.S. 968 (1954).

In the present case, the “mental link” between the mark LOCKDOWN MAGNET and Applicant’s goods as recited in the application is neither immediate nor instantaneous.

The Trademark Trial and Appeal Board has adopted a three-part test to help determine whether a mark is descriptive or suggestive: (1) the degree of imagination necessary to understand the product; (2) a competitor’s need to use the same terms; and (3) competitors’ current use of the same or similar terms. *See No Nonsense Fashions, Inc. v. Consolidated Food Corp.*, 226 U.S.P.Q. 502 (TTAB 1985).

Under the degree of imagination test, the more imagination that is required by a consumer to get some direct description of the product or service from the mark, the more likely the term is suggestive and not merely descriptive. *See Railroad Salvage of Connecticut, Inc. v. Railroad Salvage, Inc.*, 561 Fed. 1014 (D.C.R.I. 1983). Since there is no instantaneous connection as to the nature of the services provided by the Applicant, it is far more likely that the

mark is suggestive than descriptive. *See Stix Products, Inc. v United Merchants and Manufacturers, Inc.*, 295 Fed. Supp. 479 (S.D.N.Y. 1968)

In the instant case, Applicant concedes the term MAGNET to be generic for the goods sold under the LOCKDOWN MAGNET mark, and voluntarily disclaimed the term at the time of application. However, Applicant disagrees with the Examining Attorney that LOCKDOWN is merely descriptive of Applicant’s goods.

When presented with the term LOCKDOWN in connection with magnets, the term conveys the idea of safety, or that of keeping someone or something confined inside of a particular room or building. The term does not, however, immediately convey or necessarily describe an object that is used to replace a door key for ease-of-use in school classrooms, as the Examining Attorney has cited. The board is reminded that if the information conveyed by the mark is indirect or vague, the mark is being used in a suggestive rather than a descriptive manner. *See J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition*, §11:19 (Ed. 2000.) Some imagination and perception are therefore required to identify the precise nature of the goods as sold under the LOCKDOWN MAGNET mark.

Moreover, an examination of registered marks on the Principal Register reveals that the term “LOCKDOWN” in relation to goods or services like those of the Applicant has consistently been treated as suggestive of the respective goods or services (*See Exhibit E* previously made of record in connection with Applicant’s Office Action Response):

Mark	Reg No.	Disclaimer	Goods
LOCKDOWN BROWSER	4416885	BROWSER	Class 09: browser software for use in enabling user access to selected resources via the Internet while restricting user access to other resources; browser software for use in controlling user access to Internet resources during tests, quizzes and other assessment activities.
LOCKDOWN	4287538	NONE	Class 09: Hygrometers; Class

			11:Firearm Vaults
LOCKDOWN	3939568	NONE	Class 09: Accounting Software.
RAINBOW SIX LOCKDOWN	3083349	NONE	Class 09: software and electronic games, namely, software games recorded on CD-ROM and digital video discs for computers; software games recorded on CD-ROMs, digital video discs, and cartridges for console; [and individual, portable gaming systems;] software games that are downloadable from a remote computer site; [and software games for mobile phones, personal digital assistants, and handheld computers
LOCDOWN by M MARKSUSA	4254964	NONE	Class 09:Access control programmable locking systems consisting of electronic cylindrical locksets, keypads, remote control units and electronic door locks; electronic door locks.
LOWEST PRICE LOCK DOWN	4383049	“LOWEST PRICE”	Class 41: Ticket reservation and booking services for entertainment and cultural events.
AC LOCK DOWN SECURITY	4300250	“AC” and “SECURITY”	Class 06: Metal Cages fro HVAC units.
LOCKDOWN PUBLISHING	4183902	“PUBLISHING	Class 41:Book Publishing
LOCKDOWN	4154615	NONE	Class 39:Electronic document storage services and document storage services.
LOCKDOWN SECURITY	3844153	“SECURITY”	Class 37: Installation of security and fire alarm systems; maintenance and repair of security and fire alarm systems.
CREDITGUARD LOCKDOWN YOUR IDENTITY	3619047	NONE	Class 45:Consultation in the field of data theft and identity theft
LOCKDOWN	3429295	NONE	Class 35: Computer networking hardware; Computer software for ensuring the security of computers and computer networks; LAN (local operating network) hardware; Network access server hardware; Network access server operating software; VPN (virtual private network) hardware; WAN (wide area network) hardware.
COLOUR LOCKDOWN TECHNOLOGY	4050303	NONE	Class 03;Non-medicated hair care preparations, namely, shampoos, hair conditioners.

As such, it is respectfully submitted that it would be inconsistent for the Office to deny registration of the Applicant’s mark by concluding that the term “LOCKDOWN” is merely

descriptive of the Applicant's goods where the above-referenced marks have been permitted to register on the Principal Register without disclaimers as to the term at issue.

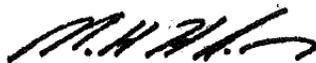
In view of the above arguments, Applicant believes that the proposed mark is entitled to registration on the Principal Register insofar as the term LOCKDOWN is suggestive of the goods listed in the application, and mental leaps are required to associate the instant mark with the applied for goods. However, if the Examining Attorney remains unsure, he is respectfully reminded that because of the thin line between suggestive and descriptive marks, it is the practice of the USPTO to resolve doubt in Applicant's favor and publish the mark for opposition. *See In re Morton-Norwich Products, Inc.* 209 U.S.P.Q. 791 (TTAB 1981); and *In re Grand Metropolitan Foodservice Inc.* 30 U.S.P.Q.2d 1974, 1976 (TTAB 1994).

Conclusion

WHEREFORE the Applicant EBCO, Inc. by counsel, respectfully requests that the refusals under Section 2(e)(1) of the Trademark Act of 1946 be withdrawn and the mark be allowed for publication on the Principal Register.

Respectfully submitted this 29th day of September 2014.

The Trademark Company, PLLC



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