

From: Hiser, Charles

Sent: 11/25/2014 6:09:42 PM

To: TTAB EFiling

CC:

Subject: U.S. TRADEMARK APPLICATION NO. 85894991 - LOCKDOWN MAGNET - N/A - EXAMINER BRIEF

\*\*\*\*\*

Attachment Information:

Count: 1

Files: 85894991.doc

# UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

<b>U.S. APPLICATION SERIAL NO.</b> 85894991  <b>MARK:</b> LOCKDOWN MAGNET	
<b>CORRESPONDENT ADDRESS:</b> MATTHEW H SWYERS  THE TRADEMARK COMPANY  344 MAPLE AVE W STE 151  VIENNA, VA 22180-5612	<b>GENERAL TRADEMARK INFORMATION:</b>  <a href="http://www.uspto.gov/trademarks/index.jsp">http://www.uspto.gov/trademarks/index.jsp</a>  <b>TTAB INFORMATION:</b>  <a href="http://www.uspto.gov/trademarks/process/appeal/index.jsp">http://www.uspto.gov/trademarks/process/appeal/index.jsp</a>
<b>APPLICANT:</b> EBCO, Inc.	
<b>CORRESPONDENT'S REFERENCE/DOCKET NO:</b>  N/A  <b>CORRESPONDENT E-MAIL ADDRESS:</b>  admin@thetrademarkcompany.com	

## EXAMINING ATTORNEY'S APPEAL BRIEF

### INTRODUCTION

This is an appeal from the trademark examining attorney's final refusal to register EBCO Incorporated's (hereinafter "applicant") mark, LOCKDOWN MAGNET for "magnets" under Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1), on the grounds that the mark is merely descriptive of applicant's goods. It is respectfully requested that this refusal be affirmed.

### FACTS

On April 4, 2013, applicant filed an application to register the mark LOCKDOWN MAGNET for "magnets" based on intent-to-use the mark in commerce. Applicant offered a disclaimer of the generic term "MAGNET" with its application. On August 6, 2013, the examining attorney issued an initial Section 2(e)(1) refusal for the mark being merely descriptive of the goods, and also informed applicant of their option to amend to the Supplemental Register upon filing an allegation of use. Applicant responded to the Office Action refuting the Section 2(e)(1) refusal on February 6, 2014. On March 5, 2014, the examining attorney issued a final Section 2(e)(1) refusal. Applicant filed this appeal on July 29, 2014.

### ISSUES PRESENTED

The only issue on appeal is whether LOCKDOWN MAGNET is merely descriptive for the goods offered by Applicant within the meaning of Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1).

### ARGUMENT

#### 1. Applicant's Mark is Descriptive

A mark is merely descriptive if it describes an ingredient, quality, characteristic, function, feature, purpose, or use of an applicant's goods. TMEP §1209.01(b); *see, e.g., DuoProSS Meditech Corp.*

*v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 1251, 103 USPQ2d 1753, 1755 (Fed. Cir. 2012) (quoting *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 1173, 71 USPQ2d 1370, 1371 (Fed. Cir. 2004)); *In re Steelbuilding.com*, 415 F.3d 1293, 1297, 75 USPQ2d 1420, 1421 (Fed. Cir. 2005) (citing *Estate of P.D. Beckwith, Inc. v. Comm’r of Patents*, 252 U.S. 538, 543 (1920)).

The determination of whether a mark is merely descriptive is made in relation to an applicant’s goods and/or services, not in the abstract. *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 1254, 103 USPQ2d 1753, 1757 (Fed. Cir. 2012); *In re The Chamber of Commerce of the U.S.*, 675 F.3d 1297, 1300, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012); TMEP §1209.01(b); *see, e.g., In re Polo Int’l Inc.*, 51 USPQ2d 1061, 1062-63 (TTAB 1999) (finding DOC in DOC-CONTROL would refer to the “documents” managed by applicant’s software rather than the term “doctor” shown in a dictionary definition); *In re Digital Research Inc.*, 4 USPQ2d 1242, 1243-44 (TTAB 1987) (finding CONCURRENT PC-DOS and CONCURRENT DOS merely descriptive of “computer programs recorded on disk” where the relevant trade used the denomination “concurrent” as a descriptor of a particular type of operating system). “Whether consumers could guess what the product [or service] is from consideration of the mark alone is not the test.” *In re Am. Greetings Corp.*, 226 USPQ 365, 366 (TTAB 1985).

Applicant’s mark is composed to two terms: LOCKDOWN and MAGNET. As applicant noted in their appeal, the term MAGNET for “magnets” is generic and was voluntarily disclaimed by applicant from the beginning of the application process. The descriptive or generic significance of the term “MAGNET” is not disputed. Thus, the argument here is over the term LOCKDOWN and whether it is suggestive or descriptive of applicant’s magnets.

In the wake of terrible national tragedies that include school shootings the American public has come to identify the word LOCKDOWN with the actions taken to restrict movement of the general population in a building or campus in order to minimize casualties when there are rogue forces loose. In

both the initial and final Office actions, the examining attorney attached specific dictionary definitions that show that this understanding of the term LOCKDOWN is unique to Americans. *See final office action dated March 5, 2014* at pp. 2-3; *initial office action dated August 6, 2013* at pp. 2-3. The definition provided for LOCKDOWN is “a security measure in which those inside a building such as a prison, school or hospital are required to remain confined in it for a time.” *Id.* A lockdown can involve one or many individual actions that together aim to ensure security of the innocents trapped in a building. The way these security measures are enacted differ from lockdown plan to lockdown plan but general practices include turning off lights, locking doors, remaining quite, not drawing attention to oneself, and staying out of the way of security personnel. *See generally, final office action* pp. 5, 10, 12-13.

In the wake of such tragedies there has been a proliferation of devices that can be used to help implement a lockdown. These goods range from door jams, to window blinds, and they include a set of magnets that allow for a quick and effective way of “locking” a door as to not allow entry by malevolent actors. *See generally, final office action* pp. 4-21.

As stated above a mark is deemed descriptive if it describes “. . . a characteristic, . . . purpose, or use. . . of applicant’s goods” *See* TMEP §1209.01(b); *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd., supra*. Applicant’s mark is descriptive of a magnet with the sole advertised purpose of be used to help effectuate a lockdown proceeding. Applicant’s own website implies as much by noting that as a society we must protect our children and that their product is a way to ensure that classrooms are quickly secured should a threat arise. *Final office action* at 4. In fact applicant’s website states “for faster and safer school lockdowns using Lockdown Magnets” and is endorsed by a school security director “to expedite school security during lockdown drills and actual lockdowns.” *Id.*

Another key point to take into consideration here is that descriptive marks are not determined in the abstract; one does not have to guess at what the produce is or does in order for a mark to be

descriptive. The evidence of record shows exactly what a lockdown magnet looks like. *See final office action* at 19. These magnets are designed to be placed on door jams. They are not toys, nor are they to be used for science experiments or any other classroom activity beyond securing the room in an emergency. Thus, any argument that consumers would see LOCKDOWN as suggestive is quite far-fetched as concerned school administrators and other security personnel, presumably the main consumers of these goods, would instantaneously know what the sole purpose and use applicant's goods are, to secure their buildings.

Due to the unique understanding of the word LOCKDOWN among Americans, the fact that applicant advertises that the purpose of their goods is to be used during a lockdown proceeding, and that consumers are not required to guess as to what the product is or is used for when there is a determination of descriptiveness all coalesce to prove that applicant's mark is merely descriptive of the purpose of their goods, to lockdown a classroom.

## 2. Applicant's Arguments Are Unpersuasive

### a. The "Something More" Cases

Applicant spends a through amount of time recounting past precedent but spends relatively little time explaining how the line of cases that highlight the "something extra" doctrine apply to the mark at issue. Applicant mentions cases where the Board has held that consumers would have found the mark suggestive because consumers would have to engage in "mature thought or follow a multi-stage reasoning process." *Applicant's brief* at 9. The cases noted all tend to play off certain well-known English expressions or off the names of famous people. In this case applicant offers no evidence as to any specific way that LOCKDOWN MAGNET challenges consumers to engage in a higher order of thinking. There are two ways of looking at all of the cited cases, and marks therein, which separate them

from the mark at hand. First, many of the cases don't have a generic term within the mark, but rather use two descriptive terms whose juxtaposition cause something more. Or second, the marks that do use generic terms telescope the words, misspell or uniquely punctuate the word, or put them in reverse order, etc. all of which causes consumers to stop and pause. With regard to applicant's mark, the use of the word MAGNET here forces consumers to see LOCKDOWN as an adjective due to the mark's specific construction; this construction takes applicant's mark out of the realm of marks like SUGAR AND SPICE, LONGTONG, AND BRAKLEEN. *See applicant's brief* at 11-12.

b. The Application Of The Three Part Suggestive/Descriptive Test

Applicant also cites a three part test announced by the Board in order to determine the whether a mark is suggestive or descriptive. *See applicant's brief* at 12. The test includes: (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. *Id.*

As to the first element, due to the construction of applicant's mark and the specific meaning of LOCKDOWN in current American vernacular there are no real steps of imagination that need to be taken by consumers as applicant's mark describes the purpose/intended use of their product. Applicant argues that the connotations created by LOCKDOWN make it more suggestive than descriptive. Applicant offers no evidence to this point. Counsel also notes, when discussing connotation of LOCKDOWN, "[t]he terms 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;" LOCKDOWN isn't describing a complex system of safety measures, it is describing magnets, specifically magnets which have a sole function of, and were solely designed to be used to, lockdown a classroom. *Applicant's brief* at 13.

Applicant doesn't clearly apply the other two prongs in their analysis; however, the second prong of the test is competitor's need for the same or similar terms. As stated earlier and noted in the record, the term "lockdown" has become the word we use to describe the event and the specific actions taken to secure a building during a time of crisis. Applicant should not be able to monopolize this word in relation to goods that are specifically designed to be used during a lockdown proceeding. The last element of the test is current use of the same or similar terms by competitors. Evidence of record shows two of applicant's competitors using the term "lockdown magnet" in relation to identical goods; further, evidence shows the need of competitors to use the word "lockdown" for similarly situated safety devices designed to secure a room/building during an emergency. *See generally, final office action* at 5, 8, 10, 12-13, 16-17, 19. Not only do competitors need to use the term but they are also currently using it to describe their goods. Thus, as applicant's mark requires no imagination or higher thinking, and their competition is using, and requires, similar if not identical wording, applicant's arguments as to why their mark is suggestive are unpersuasive.

c. Comparing Apples and Oranges

Applicant introduces evidence regarding the use of LOCKDOWN on the Principal Register and implies that in past examination that the term has been deemed suggestive in the past. Applicant's attempt to show that LOCKDOWN is suggestive via the register falls flat because they are comparing magnets with goods and services like: non-medicated hair shampoo, book publishing, ticket reservation services, computer hardware and software, etc.; only one of the marks listed that even remotely come close to the goods at issue here refers to an entire system of electronic locking mechanisms and electronic door locks. Thus, this evidence is unpersuasive.

CONCLUSION

The record shows that the mark is merely descriptive of applicant's goods. Specifically, the mark immediately informs consumers of a purpose or function of the magnets, i.e., to lockdown a classroom. Accordingly, the Board is respectfully requested to affirm the refusal to register the mark under Section 2(e)(1) of the Trademark Act, 15 U.S.C. Section 1052(e)(1).

Respectfully submitted,

/Charles H Hiser IV/

Examining Attorney

Law Office 112

(571) 272-7526

charles.hiser@uspto.gov

Angela Wilson

Managing Attorney

Law Office 112