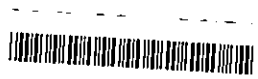
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In re: Application of Sno-Wizard Manufacturing, Inc.
Serial No.: 76/059,333
Mark: SNOBALL for ice-shaving machines for sale to retail businesses selling shaved-ice confections
Filing Date: May 30, 2000

October 21, 2003



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APPLICANT'S APPEAL BRIEF

Applicant hereby submits this appeal brief in support of its appeal to the Trademark Trial and Appeal Board from the final refusal of the examining attorney dated November 19, 2002.

For ease of reference to the several decisions of the examining attorney in this application, Applicant sets forth the following naming convention which will be used throughout this brief:

Date of Decision	**Reference**
December 29, 2000	First Office Action
October 25, 2001	Second Office Action
August 12, 2002	Third Office Action
November 19, 2002	Fourth Office Action
August 14, 2003	Fifth Office Action

The Fourth Office Action issued a final refusal on four grounds:

1. The name in the mark represents the descriptive and generic designation of the goods;

2. Applicant's showing of acquired distinctiveness under Section 2(f) is insufficient; and, a generic mark may not be registered under the acquired distinctiveness standard;

3. The mark fails to function as a mark in the specimens of record; and,

4. The specimen of record is unacceptable because it does not depict the mark in trademark fashion.

Each ground for refusal will be discussed in turn.

I. Descriptive/Generic Refusal

The Second Office Action refused registration on the basis of genericness. In particular, the Second Office Action stated that "the proposed mark is incapable of identifying applicant's goods and distinguishing them from those of others because it is highly descriptive or generic." The Fourth Office Action continued the refusal and rendered it final, stating that "the name in the mark represents the descriptive and generic designation of the goods" and "Applicant's mark SNOBALL for snowball making machines is viewed as an apt proper designation for its goods."

Applicant respectfully suggests the genericness rejection is not well taken, as (1) the proper legal standard was not applied in determining the genericness rejection; and (2) even applying the proper legal standard, the evidence cited in the Second Office Action and the Fourth Office Action does not support a determination of genericness. Both of these points will be addressed below.

A. Proper Legal Standard Not Applied

1. Two-Step Marvin Ginn Test Not Applied

As Applicant set forth in its response to the Second Office Action, the U.S. Court of Appeals for the Federal Circuit (the "Federal Circuit") promulgated the test for genericness in *H. Marvin*

Ginn Corp. v. International Ass'n of Fire Chiefs, Inc., 782 F.2d 987, 228 USPQ 528 (Fed. Cir. 1986). The *Marvin Ginn* test was recently affirmed in *In re American Fertility Soc'y*, 188 F.3d 1341, 51 USPQ2d 1832 (Fed. Cir. 1999) and *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 57 USPQ2d 1807 (Fed. Cir. 2001). As explained by the Federal Circuit, the *Marvin Ginn* test comprises two components:

> Determining whether a mark is generic therefore involves a two-step inquiry: First, what is the genus of goods or services at issue? Second, is the term sought to be registered or retained on the register understood by the relevant public primarily to refer to that genus of goods or services?

See Marvin Ginn, 782 F.2d at 990, 228 USPQ at 530. In *American Fertility*, the court reiterated that "the correct legal test for genericness, as set forth in *Marvin Ginn*, requires evidence of the genus of goods or services at issue and the understanding by the general public that the mark refers primarily to that genus of goods or services." *See American Fertility,* 188 F.3d at 1347. The court continued by stating that "the PTO must be able to satisfy both elements of the test as set forth in the controlling precedent of *Marvin Ginn*." *Id.*

Rather than relying upon the "controlling precedent" of *Marvin Ginn* and its progeny, however, the Second Office Action relied upon four cases — three of which predate *Marvin Ginn* — to support the descriptive/generic refusal: *In re Gould Paper Corp.*, 834 F.2d 1017, 5 USPQ2d 1110 (Fed. Cir. 1987); *In re Hask Toiletries, Inc.*, 223 USPQ 1254 (TTAB 1984); *In re Armour & Co.*, 220 USPQ 76 (TTAB 1983); and *In re Cosmetic Factory, Inc.*, 208 USPQ 443 (TTAB 1983). In each of these four cases, a refusal to register the proposed mark on the Supplemental Register was affirmed on the basis that the proposed mark was the generic name for the goods or services. However, Applicant respectfully suggests that these four cases do not present the proper legal

standard for determining the genericness of a proposed mark; rather, as indicated above, the proper legal standard is set forth in the "controlling precedent" of *Marvin Ginn* and its progeny.

Based upon the language of the Second Office Action and the Fourth Office Action, Applicant respectfully submits that the U.S. Patent and Trademark Office ("USPTO") did not apply the requisite two-step process before issuing the refusal. In particular, the Second Office Action did not fairly apprise Applicant of the answer to the first *Marvin Ginn* question, to-wit: what is the genus of the goods at issue? The Fourth Office Action, after questioning Applicant's reliance on *American Fertility*,[1] merely offered a conclusory statement that "the genus of the goods is 'snowball machines,'" and attached printouts from five web sites. As Applicant will explain in Section B below, these five printouts failed to support a determination of genericness.

Neither the Second Office Action nor the Fourth Office Action applied the proper two-step *Marvin Ginn* test for determining whether Applicant's mark is generic. The Second Office Action did not in any way whatsoever answer the first *Marvin Ginn* question by naming or describing the genus of Applicant's goods; and, the Fourth Office Action provided insufficient support for its conclusory statement that "the genus of the goods is 'snowball machines.'" Accordingly, for this reason alone, the genericness rejection is not well taken and should be withdrawn.

2. In re Gould Test Not Applicable

Furthermore, the Second Office Action cited *In re Gould Paper Corp.*, 834 F.2d 1017, 5 USPQ2d 1110 (Fed. Cir. 1987) in support of the genericness rejection of Applicant's mark.

[1] The Fourth Office Action stated: "Applicant appears to believe that the only standard for a generic determination was set forth in [*American Fertility*]. Legally, there are various ways establishing genericness [*sic*]." However, the Fourth Office Action provided no other methods of establishing genericness nor any support for the proposition that there are multiple methods of establishing genericness.

However, as Applicant set forth in its response to the Second Office Action, the Federal Circuit has explicitly limited the holding of *Gould* to marks consisting of compound terms formed by the union of words:

> The *In re Gould* test is applicable only to "compound terms formed by the union of words" where the public understands the individual terms to be generic for a genus of goods or services, and the joining of the individual terms into one compound word lends "no additional meaning to the term."

In re Dial-A-Mattress Operating Corp., 240 F.3d 1341, 1345 (Fed. Cir. 2001) (citing *American Fertility,* 188 F.3d at 1348-49). *See also American Fertility* at 1348 ("*Gould* is limited, on its facts, language, and holding, to compound terms formed by the union of words.")

As explained by *American Fertility* and *Dial-A-Mattress*, *Gould* applies when: 1) the proposed mark consists of compound terms formed by the union of words where the public understands the individual terms to be generic for a genus of goods or services, and 2) the joining of the individual terms into one compound word lends no additional meaning to the term. Neither of these two prongs applies to Applicant's SNOBALL mark.

The first *Gould* prong is inapplicable because Applicant's SNOBALL mark does not consist of the compound terms "snow" and "ball" in which each term is generic for a genus of goods or services. First, the constituent SNO of Applicant's mark does not contain the letter W. Second, the constituent SNO does not have the meaning of "snow," to-wit: frozen precipitation that falls in soft white flakes (see dictionary definition of the word "snow" in Exhibit D-1 attached to Applicant's response to the Second Office Action); similarly, the constituent BALL does not mean a spherical object (see dictionary definition of the word "ball" in Exhibit D-2 attached to Applicant's response to the Second Office Action). Applicant's SNOBALL mark is not used on a ball of snow; rather,

it is used on an ice-shaving machine. In contrast, the mark at issue in *Gould* was SCREENWIPE, for antistatic wipes used to clean computer and television screens. The constituents of this mark, SCREEN and WIPE, were each understood to have their generic meanings. Because the constituents SNO and BALL are not understood to have their generic meanings when used in Applicant's SNOBALL mark, the first *Gould* prong is inapplicable.

In view of the inapplicability of the first *Gould* prong, it is unnecessary to discuss the second *Gould* prong. Nevertheless, in an abundance of caution, Applicant observes that, for the following reasons, the second *Gould* prong is similarly inapplicable.

The second *Gould* prong is inapplicable to Applicant's mark because the compound word SNOBALL does not have the same meaning as its constituents SNO and BALL. As stated above, the product to which Applicant's mark is applied is not a ball of snow, rather, it is an ice-shaving machine. The mark SNOBALL does not have the meaning of a ball of snow. In contrast, the composite mark SCREENWIPE in *Gould* had the same meaning as its constituents, to-wit: a wipe for screens. As such, the second *Gould* prong is inapplicable in the present case.

Therefore, the *Gould* test is plainly inapplicable to Applicant's mark as applied to ice-shaving machines, to-wit: SNOBALL is not a compound term formed by the union of words having a generic meaning, and the joining of the individual terms SNO and BALL into one compound word does lend additional meaning to the term. A legal determination of genericness that relies upon the *Gould* test, which is inappropriate for Applicant's mark, cannot be sustained. For this additional reason, the genericness rejection is not well taken and should be withdrawn.

B. Evidence Does Not Support Genericness Rejection

Given the lack of an answer to the first *Marvin Ginn* question, it is premature to review the

evidence cited in the Second Office Action and the Fourth Office Action. In order to determine whether the evidence supports the genericness rejection, the evidence must be probative of the answer to the two-step *Marvin Ginn* inquiry. Without such answer, it is difficult to know whether or not the evidence supports the genericness rejection.

Nevertheless, in the unlikely event that the Second Office Action and the Fourth Office Action are interpreted as complying with the two-step *Marvin Ginn* inquiry or other controlling precedent (an interpretation which Applicant respectfully denies); and, in any event, to affirmatively demonstrate that SNOBALL is not a generic term as applied to ice-shaving machines, Applicant sets forth hereinafter ample reasons why the evidence cannot possibly support a genericness rejection.

1. Evidentiary Standard

In reiterating the validity of the *Marvin Ginn* test for genericness, *American Fertility* also established the appropriate evidentiary standard. The court stated that the level of proof required to support a claim of genericness is "a substantial showing by the Examining Attorney that the matter is in fact generic . . . based on clear evidence of generic use." *American Fertility,* 188 F.3d at 1346 (emphasis added) (quoting *In re Merrill Lynch, Pierce, Fenner & Smith, Inc.*, 828 F.2d 1567, 1571; 4 USPQ2d 1141, 1143 (Fed. Cir. 1987)). As described more fully in Sections B-3 through B-7 below, Applicant respectfully suggests that neither the eleven references (comprising twenty-seven pages) appended to the Second Office Action nor the five references (comprising seventeen pages) appended to the Fourth Office Action constitute either a "substantial showing" or "clear evidence" of generic use.

2. The Cited References: No Substantial Showing of Genericness

The Second Office Action presented eleven references retrieved from the LEXIS/NEXIS

database and printouts from various web sites, and the Fourth Office Action presented five references retrieved from various web sites (the "Cited References"). Before reviewing each of the Cited References, Applicant respectfully submits that, in general, the Cited References neither individually nor as a group make out a "substantial showing" that the term SNOBALL is generic for ice-shaving machines. No "substantial showing" can be made since none of the Cited References can be said to show "clear evidence of generic use." Further, no "substantial showing" can be made since none of the Cited References show that the term SNOBALL is understood by the relevant public to primarily refer to the genus of goods at issue in the present case.

For ease of nomenclature, the twenty-seven pages of Cited References attached to the Second Office Action are identified by Reference Nos. 1 through 11. The seventeen pages of Cited References attached to the Fourth Office Action are identified by Reference Nos. 12 through 17. Hereinafter, each Cited Reference will be identified by number.

In responding to the Cited References, Applicant hereby reserves its rights to challenge at a later date the authenticity, veracity, and reliability of each Cited Reference. Applicant in no way admits the authenticity, veracity, and reliability of each Cited Reference.

3. Certain References Depict the Mark
Used in Connection With the Product, Not the Machine

It is axiomatic that a trademark must be evaluated in relation to the goods or services with which it is associated. *See e.g., In re National Data Corp.*, 753 F.2d 1056, 1058; 224 USPQ 749, 750-51 (Fed. Cir. 1985) ("The basic principle . . . is that marks must be compared in their entireties and must be considered in connection with the particular goods or services for which they are used"). Indeed, the initial inquiry under the *Marvin Ginn* test, as stated in Section A-1 above, is the

identification of the genus of goods or services.

It follows, then, that evidence of usage of a mark on goods or services other than the goods or services for which registration is sought has no probative value as to whether such term is generic for the field of interest. To illustrate this concept, consider the term "chair." Use of the term "chair" for a piece of furniture consisting of a seat, legs, back, and arms is generic. However, use of the term "chair" as a brand name for a line of baseball caps or cigarettes is arbitrary (i.e., a common word used in an unfamiliar way) and certainly not generic. Accordingly, evidence of usage of the term "chair" on baseball caps or cigarettes has no probative value as to whether the term "chair" is generic for a piece of furniture consisting of a seat, legs, back, and arms.

Applicant respectfully directs the Board's attention to the distinction between the snow ball product and the ice-shaving machines used to create the product. The snow ball product is a sweet-tasting confection comprised of flavored syrup poured over a mound of finely shaved ice. In contrast, an ice-shaving machine is an apparatus used to convert a solid block of ice into finely shaved ice suitable for consumption as a snow ball. As stated in its application, applicant seeks registration for the SNOBALL mark applied to an "ice-shaving machine."

Two of the Cited References illustrate this distinction between the snow ball product and the ice-shaving machine. First, Reference No. 8, a printout from the Yahoo! Groups web site, states: "This list will interest anyone involved in the snoball, snowcone, or shaved-ice business." Second, Reference No. 10, a printout from the Smitty's Sno-Balls web site, proclaims: "This Whole Web Site Is Here Only To Help Any One That Is Interested In The SnowBall, Snow Cone And Or Shaved Ice Business." By separately referring to the "snow ball" and "shaved ice" businesses, these two references demonstrate that the snow ball product is distinct from the ice-shaving machine that

assists in creating the product.

Applicant respectfully suggests that several additional Cited References depict the mark used in connection with the snow ball product, not the ice-shaving machine. These references are as follows:

- Reference No. 4, an article by Edward J. Branley titled "About Sno-Balls," describes the various sizes and toppings available, the myriad flavors of syrup that can be poured over the shaved ice, and the neighborhood character of snow ball stands. This article does not mention the ice-shaving machine used to create the snow ball product.

- Reference No. 7, a Chattanooga Times article, describes a concession stand in Tennessee that serves snow balls in addition to hot dogs and other take-out food. Again, this article does not mention the ice-shaving machine used to create the snow ball product.

- Reference No. 8, the Yahoo! Groups web page mentioned above, uses the term "snoball" to refer to the product and uses the term "shaved-ice" to refer to the machine.

- Reference No. 10, the Smitty's Sno-Balls web page mentioned above, uses the term "SnowBall" to refer to the product and uses the term "shaved ice" to refer to the machine.

- Reference No. 11, a Smitty's Snowballs web page, contains various phrases such as "Sno-Balls are made with shaved ice ..."; "So after 7+ years of making Sno-balls ..."; and " ... everything there is to know about the Sno-Ball business." This usage of Sno-ball plainly refers to the product, not the ice-shaving machine.

- Reference No. 13, a printout from the <www.erskine.com> site, states, "I use my trailer every day and sell about 75,000 snoballs per year." Again, this usage of "snoball" plainly refers to the product, not the ice-shaving machine.

- Reference No. 15, a printout from the <www.sno-ball.com> site, states "Mobile units can also sell snow balls." Again, this usage of "snow ball" plainly refers to the product, not the ice-shaving machine.

- Reference No. 16, a printout from the <www.jaysshaveice.com> site, refers to going "to a local snowball stand for a snowball." Again, this usage of "snowball" plainly refers to the product, not to the ice-shaving machine.

To summarize, Reference Nos. 4, 7, 8, 10, 11, 13, 15, and 16 depict usage of the term "snoball," "snow ball," or "snowball" to refer to the snow ball product (purchased at the retail level

by consumers of shaved-ice confections), not the ice-shaving machine used in creating the product (purchased by retail businesses selling shaved-ice confections). These references do not depict usage of Applicant's SNOBALL mark as the generic designation for a type of ice-shaving machine.

4. Certain References Depict Usage of SNOBALL as a Product Mark in Conjunction with the SNOWIZARD House Mark

Two of the Cited References depict Applicant's own usage of the SNOBALL mark as a product mark in conjunction with the SNOWIZARD house mark. Reference No. 1, a printout from Applicant's web site describing the history of Applicant's company, refers to the "SnoWizard SnoBall Machine." Reference No. 3 is a picture of Applicant's machine from an unidentified web site. The front of the machine bears the label "SnoWizard SNOBALL MACHINE." This usage depicts the use of a well-known house mark (SNOWIZARD) in connection with a well-known product mark (SNOBALL).

Applicant owns two registrations for the SNOWIZARD mark (Registration No. 2,544,216 for ice-shaving machines; Registration No. 2,555,060 for flavorings and syrups); additionally, Sno-Wizard Manufacturing, Inc. is Applicant's name. In Reference Nos.1 and 3, Applicant uses the SNOWIZARD mark as a house mark and the SNOBALL mark as a product mark. The usage of the SNOWIZARD house mark does not detract from the trademark function of the SNOBALL product mark. *See Kellogg Co. v. General Foods Corp.*, 166 USPQ 281 (TTAB 1970).

In *Kellogg*, the TTAB held that use of the house mark KELLOGG did not detract from the trademark function of the product mark POP-TARTS. *Kellogg*, 166 USPQ at 282. The Board noted that the two marks, KELLOGG and POP-TARTS, were displayed in different scripts and different sizes such that the two marks created separate commercial impressions. *Id.* at 282-83. In the present

case, Reference 3 clearly shows that the mark SNOWIZARD appears in large, italic type, whereas the mark SNOBALL appears in smaller block lettering. Therefore, just as in *Kellogg*, the presence of the SNOWIZARD house mark does not detract from the trademark function of the SNOBALL product mark.

Accordingly, Reference Nos. 1 and 3 do not constitute evidence of generic use of the SNOBALL mark as applied to ice-shaving machines. Moreover, References Nos. 1 and 3 evidence the use of SNOBALL as Applicant's trademark.

5. Certain References Depict Improper Usage by Users Other Than the Relevant Public

Two of the Cited References depict improper usage of the mark SNOBALL by individuals other than the relevant public. Reference No. 5 is an article from *New Orleans CityBusiness* magazine containing a single reference to "snoball machines." Reference No. 6 is a second article from *New Orleans CityBusiness* magazine containing numerous references to snoballs (the product) and two references to "snoball machines."

To prove genericness, the second prong of the *Marvin Ginn* test requires evidence that "the term sought to be registered ... [is] understood by the relevant public primarily to refer to that genus of goods or services." *American Fertility*, 188 F.3d at 1344 (emphasis added). Applicant respectfully asserts that, in the present case, the "relevant public" is manufacturers, distributors, and purchasers of ice-shaving machines for use in the purchaser's retail business. The nature of ice-shaving machines is that they are generally purchased and used not by individual consumers for use in the home, but by commercial enterprises that use the ice-shaving machines to produce the snow ball product for sale to individual consumers. See, e.g., Reference Nos. 8 and 10, as well as the references in Exhibit H (attached to Applicant's response to the Fourth Office Action), all of which

reflect use of an ice-shaving machine by a commercial enterprise to produce the snow ball product for sale to individual consumers.

It is well-established that a mark may have a generic meaning to one class of purchasers and a trademark meaning to a different class of purchasers. For example, in *Bayer Co. v. United Drug Co.*, 272 F. 505 (S.D.N.Y. 1921), Judge Learned Hand acknowledged that the term ASPIRIN was recognized as a trademark by manufacturing chemists, physicians, and retail druggists but was recognized as a generic term to the general consuming public. *Bayer*, 272 F. at 510.

In accord with *Bayer*, Applicant amended its identification of goods to indicate that the channel of trade for which Applicant seeks registration is ice-shaving machines for sale to retail businesses selling shaved ice confections. As such, the usage of the manufacturers, distributors, and purchasers of ice-shaving machines is properly determinative of how the term SNOBALL is understood by the relevant public. One court emphasized the importance of the usage by persons in the trade:

> It seems elementary that one must find out how people in the trade and the purchasers use the terms with respect to the involved goods in order to determine whether or not they are descriptive.

In re Merrill Lynch, Pierce, Fenner & Smith, 828 F.2d 1567, 1569-70 (Fed. Cir. 1987), quoting *In re Automatic Radio Manufacturing Co.*, 404 F.2d 1391, 1396 (C.C.P.A. 1969).

Therefore, Applicant respectfully suggests that improper use of the term "snoball machine" by authors of magazine articles (Reference Nos. 5 and 6) is not evidence that the relevant public understands the term "snoball machine" to refer primarily to the genus of goods at issue, because magazine authors are not manufacturers, distributors, and purchasers of ice-shaving machines. Furthermore, these references reflect isolated usage that does not constitute a "substantial showing."

6. Resale Reference Depicts Usage of the SNOBALL Mark as a Brand

Reference No. 9 is an advertisement on the e-Bay web site, apparently placed by an unidentified individual, for the resale of a used "snoball machine." Applicant respectfully suggests that this Reference depicts brand usage rather than generic usage, because Applicant's ice shaving machine is known throughout the industry as a SNOBALL brand machine; the advertiser is simply referring to Applicant's machine by its most convenient designation.

Consider the following situation: the owner of a Ford Mustang automobile, wishing to sell the vehicle, places a classified advertisement in the newspaper that reads "Mustang for sale." In such a case, the owner's reference to the automobile as a "Mustang" does not indicate that "Mustang" is the generic term for this vehicle. Rather, the owner is referring to the vehicle by its most convenient designation and one that will readily be recognized by prospective purchasers. Similarly, in the present case, the e-Bay advertiser is referring to Applicant's machine by its most convenient designation and one that will readily be recognized by prospective purchasers. Therefore, Reference No. 9 does not constitute evidence of generic usage of the mark SNOBALL for ice-shaving machines. Moreover, Reference No. 9 is poignant evidence of a respect and recognition of SNOBALL as Applicant's brand of ice-shaving machine.

One respected trademark commentator describes this phenomenon as follows:

> The fact that buyers often call for or order a product by a term does not necessarily evidence that that term is a "generic name." For example, if at a lunch counter one says, "I'll have a cheeseburger and a COKE." Or if a new car buyer brags to a neighbor, "I've just been polishing up my new FORD!" Does the neighbor respond, "FORD? A FORD what?" The generic names "cola" and "car" are understood and so, dropped in common speech. Such usage does not evidence genericness of COKE or FORD — quite the contrary. It shows that these terms are such strong, well-known trademarks that they need no generic name to convey the message. The generic name is understood by all and dropped off.

See J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition*, § 12.02[3][c] at p. 12-17 (3rd ed. 1996). Similarly, Judge Nies recognized and acknowledged this phenomenon:

> [T]hat purchasers call for a particular product by the name given it by its producer or source does not negate its function as a mark. Such a given name is a proper name, like the name of an individual, not a generic name, so long as the public uses it to identify the product of a single source. It is the normal way the public uses a mark which is applied by a manufacturer or a merchant to a particular product, and . . . trademark concepts do not require the condemnation of normal commercial language.

See In re DC Comics, Inc., 689 F.2d 1042, 1054 (CCPA 1982) (Nies, J., specially concurring).

As further examples of the propensity of consumers to refer to products by their well-known brand names, Applicant respectfully submitted Exhibits F and G as attachments to its response to the Second Office Action. Exhibits F-1, F-2, and F-3 are three examples of e-Bay advertisements for Ford Mustang automobiles. In each advertisement, the seller has described the product as a "Ford Mustang" rather than as a "Mustang-brand automobile." Such usage does not constitute evidence that Mustang is the generic name for this type of automobile; on the contrary, this usage indicates that Mustang is a well-known, readily recognizable trademark for a type of automobile manufactured by Ford Motor Company.

Additionally, Exhibits G-1, G-2, and G-3 are three examples of e-Bay advertisements for Dell laptop computers. In each advertisement, the seller has described the product as a "Dell laptop," rather than as a "Dell-brand laptop computer." Again, such usage does constitute evidence that "Dell Laptop" is the generic name for this type of computer; on the contrary, this usage indicates that Dell is a well-known, readily recognizable trademark for a type of computer manufactured by Dell Computer Corporation.

Applicant observes that the Fourth Office Action completely disregarded Exhibits F and G

("Applicant has submitted a lengthy submission to support its belief that SNOBALL functions as a mark. Some of the attachments, such as those from the FORD MUSTANG EBAY site is [*sic*] tangential at best to the present issue and will not be addressed.") Applicant respectfully suggests that this complete disregard for Exhibits F and G suggests an examination that did not appreciate a well-established principle of trademark law, and that, therefore, resulted in a refusal not well taken.

In view of this authority, Applicant respectfully submits that Reference No. 9 does not constitute evidence that the mark SNOBALL is a generic designation for a type of ice shaving machine. To the contrary, Reference No. 9 evidences a respect and recognition of SNOBALL as Applicant's brand of ice shaving machine.

7. The Distinction Between the Terms "Snow Ball" and "SNOBALL"

The prevailing usage among the relevant public (to-wit: manufacturers, distributors, and purchasers of ice-shaving machines) reflects a careful and respected distinction between the terms "snow ball" and "snoball." The former term is used to refer to any ice-shaving machine; the latter term is not so used. As will be described more fully below, by their advertisements Applicant's competitors recognize that SNOBALL is Applicant's proprietary mark for its brand of ice-shaving machine. As such, Applicant's competitors have purposefully avoided using the term SNOBALL, relying instead on the term "Snow Ball." Because of this distinction, it is inaccurate to assert that Applicant's SNOBALL mark is the generic designation for an ice-shaving machine; the term SNOBALL is simply not used in this manner.

As evidence of this distinction between the terms "snow ball" and "snoball," Applicant respectfully submitted Exhibits B-1 through B-23, copies of the Yellow Pages for the New Orleans area (the "Yellow Pages") for the years 1980 through the current date, in its response to the Second

Office Action. For the previous fourteen years (1988 through the present), the classified (topical) heading containing the listings of Applicant and its competitors has been titled "Snow Ball Machines." Prior to 1988, the title "Snow Making Machines" was used. Of note, the title "Snoball Machines" has never been used since at least 1980 in the New Orleans Yellow Pages.

Further, as indicated in Exhibit C-1 attached to Applicant's response to the Second Office Action, affidavit of Ronald Sciortino, the ice-shaving machine manufacturers listed in these Yellow Pages listings represent at least 70% of the total sales, by volume, of ice-shaving machines in the United States. Thus, these Yellow Pages listings demonstrate that the members of the relevant public (to-wit: manufacturers, distributors, and purchasers of ice-shaving machines) recognize that "Snow Ball Machines", not SNOBALL machines, is the generic term for the genus of goods at issue.

Furthermore, Exhibits C-2 and C-3, affidavits of Ronald Sciortino, provide additional evidence that Applicant's competitors recognize that SNOBALL is Applicant's proprietary mark for its brand of ice-shaving machine. Affidavit C-2 addresses a matter that occurred when Applicant's competitor, Southern Snow Manufacturing, Inc., began using an advertisement in the New Orleans Yellow Pages which did not respect Applicant's SNOBALL brand for ice-shaving machines. After Applicant's complaining letter to the Yellow Pages, Southern Snow Manufacturing, Inc. ceased use of the term SNOBALL in its New Orleans Yellow Page advertisements and, since that time, has used the term "snow ball" in such advertisements. Similarly, as reflected in Affidavit C-3, another competitor of Applicant, Eisenmann Products Company, used an advertisement in the New Orleans Yellow Pages which did not respect Applicant's SNOBALL brand for ice-shaving machines and, after Applicant's attorney sent a complaining letter, the competitor changed the text of its Yellow Page advertisements from "snoball" to "snow ball." These actions reflect a recognition

in the ice shaving machine industry that SNOBALL is Applicant's well recognized brand.

Finally, Reference No. 12, a printout from the <www.allamericanhotdog.com> site, and Reference No. 14, a printout from the <www.loudoncounty.com> site, provide additional evidence of the distinction between the terms "snow ball" and "snoball." Both References use the term "snowball machine." This usage demonstrates yet again a deliberate and careful avoidance of Applicant's SNOBALL brand name for ice-shaving machines.

8. Applicant's Evidence of Non-Generic Usage

In its response to the Fourth Office Action, Applicant submitted, as Exhibit H, eight examples in support of its contention that SNOBALL is not a generic term for Applicant's ice-shaving machine. Applicant observes that the Fifth Office Action did not mention this evidence, and respectfully asserts that such omission suggests an examination that did not consider all the available evidence; and that, therefore, resulted in a refusal not well taken

These references in Exhibit H fall into two categories: first, those referring to Applicant's product (or a similar product) as an "ice-shaving machine," and second, those demonstrating that ice-shaving machines are used for purposes other than making snow balls or shaved-ice confections.

Exhibit H-1 is a letter from the Colorado Department of Health that refers to Applicant's "ice-shaving machine." Exhibit H-2 is a print-out from the Royal Hawaiian Ice web site that refers to a "block ice shaver," a "block ice shaving machine," a "cube ice shaver," and a "hand ice shaver." Exhibit H-3 is an entry in an online travel journal that states, "We waited on line a good ten minutes for our turn to order in front of the ancient looking ice shaving machine." Exhibit H-4 is a printout from the Torani Shaved Ice web site that states, "Even if you don't own an ice-shaving machine, you can serve delicious shaved ice . . . ." Exhibit H-5 is a print-out from the web site of Rental

Management magazine stating that "customers usually need to rent an ice-shaving machine as well as the component for holding processed ice . . . ." Finally, Exhibit H-6 is a print-out from the web site of AAA Traveler Magazine describing the experience of obtaining relief from the heat in New Orleans by purchasing a snow ball. This reference states:

> In the Crescent City, you'll find relief from the heat at a snowball stand, where a clear block of ice is put into an ice shaving machine that whirs and chops before spilling cool, fluffy icy blasts into a cup.[2]

Collectively, Exhibits H-1 through H-6 demonstrate that Applicant's mark SNOBALL is **not** a generic term for an ice-shaving machine.

Additionally, Exhibits H-7 (a print-out from the ABC Ice House web site) and Exhibit H-8 (a print-out describing Missouri City's 18th annual Snow Fest) demonstrate that ice-shaving machines are used for purposes other than making snow balls or shaved ice confections. Both these Exhibits demonstrate that ice-shaving machines may also be used to create ersatz snow for children to frolic in at festivals or for a holiday decoration. Accordingly, Applicant's mark SNOBALL is in no way generic for these uses of the ice-shaving machine, because the machine produces ersatz snow rather than a shaved-ice confection.

Conclusion as to Descriptive/Generic Refusal

In view of the foregoing, Applicant respectfully suggests the genericness rejection is not well taken, as (1) the proper legal standard was not applied in determining the genericness rejection; and (2) even applying the proper legal standard, the sixteen references cited in the Second Office Action and the Fourth Office Action constitute neither "clear evidence of generic use" nor a "substantial

[2] This reference also highlights the distinction between the snow ball product and the ice-shaving machine used in creating the product. See Section B-3 above.

showing," and therefore fail to support the genericness rejection.

II. Refusal of Claim of Acquired Distinctiveness

The refusal of the claim of acquired distinctiveness is not well taken. As shown by the substantial evidence submitted by Applicant showing respected recognition of Applicant's SNOBALL brand in the industry, Applicant respectfully submits that the SNOBALL brand has acquired distinctiveness.

Applicant initially observes that its burden of proving acquired distinctiveness is not by clear and convincing evidence. Rather, Applicant's burden is met when the PTO is "satisfied that the applicant has presented a prima facie case of acquired distinctiveness." *Yamaha International Corp. v. Hoshino Gakki Co.*, 840 F.2d 1572, 1576 (Fed. Cir. 1988) (emphasis added), *citing In re Capital Formation Counselors, Inc.*, 219 USPQ 916, 919 (TTAB 1983) ("an applicant need not conclusively establish distinctiveness but need only establish a prima facie case" in order to warrant publication of mark for opposition); *In re Industrial Washing Machine Corp.*, 201 USPQ 953, 956 (TTAB 1979) ("a prima facie showing of distinctiveness is all that is necessary for the publication of the application").

In view of a "prima facie" evidentiary burden, Applicant respectfully asserts that the affidavits of Ronald Sciortino (Exhibits C-2 and C-3), coupled with Mr. Sciortino's affidavit of June 27, 2001, provide the requisite quantum of evidence necessary to establish a prima facie case of acquired distinctiveness. Exhibit C-2 reflects that Applicant's competitor, Southern Snow Manufacturing, Inc. ("Southern Snow"), in response to policing actions by Applicant with regard to Southern Snow's Yellow Pages advertisement, replaced its usage of the term "sno ball" with "snow ball." Furthermore, since that time, Southern Snow has never used the term "sno ball" in its New

Orleans Yellow Pages advertisements.

Similarly, Exhibit C-3 reflects that another competitor of Applicant, Eisenmann Products Company ("Eisenmann"), in response to policing actions by Applicant with regard to Eisenmann's Yellow Pages advertisement, replaced its usage of the term "snoball" with "snow ball." Furthermore, since that time, Eisenmann has never used the term "sno ball" in its New Orleans Yellow Pages advertisements.

Collectively, these two affidavits indicate a recognition in the ice shaving machine industry that SNOBALL is Applicant's well-recognized brand name for Applicant's ice shaving machine. To Applicant's knowledge, none of its primary competitors use the mark SNOBALL to indicate the competitor's brand of ice shaving machines. Furthermore, by their actions Applicant's competitors acknowledge that SNOBALL is Applicant's proprietary mark and have deliberately avoided use of Applicant's mark.

Applicant respectfully emphasizes that the most persuasive evidence of acquired distinctiveness resides in the deliberate and careful avoidance at the wholesale level (i.e., retail businesses selling shaved-ice confections) of Applicant's SNOBALL brand name for ice-shaving machines. Applicant's competitors and other users in the trade consistently include the letter W when referring to a snow ball machine or a snowball machine. The present record is devoid of any evidence of generic usage of the term SNOBALL machine at the wholesale level. As such, the absence of the letter W (as in SNOBALL) at the wholesale level indicates Applicant's brand name for its ice-shaving machines.

Based upon the foregoing, Applicant respectfully asserts that it has established a prima facie case that the SNOBALL mark has become distinctive of its ice shaving machines in commerce,

particularly "ice-shaving machines for sale to retail businesses selling shaved ice confections." The evidence of record indicates that since at least the late 1980s, manufacturers, distributors, and purchasers of ice shaving machines perceive that the SNOBALL mark designates a single source (namely, Applicant) of ice-shaving machines. Accordingly, Applicant respectfully suggests that the refusal of the claim of acquired distinctiveness is not well taken and should be reversed.

III. Failure to Function as a Mark

In the Second Office Action, the USPTO refused registration on the basis that the proposed mark does not function as a trademark, stating that "[s]pecifically, the applicant's proposed mark is the generic designation for a type of ice shaving machine, and as such does not indicate source." Applicant respectfully refers to its argument above that the genericness refusal is not well taken and that all of the evidence shows brand usage.

IV. Specimen is Unacceptable as Evidence of Actual Trademark Use

In the Second Office Action, the USPTO refused registration on the basis that the specimen is unacceptable as evidence of actual trademark use, stating that "[t]he applicant's specimen uses the applicant's mark generically. The applicant's specimen shows an ice-shaving machine, which on its side is written 'SnoWizard snoball machine.' The use of 'snoball machine' is an indication of a type of machine, like an ice-shaving machine."

As stated in Section B-4 above, the usage of SNOBALL is as a product mark in conjunction with the SNOWIZARD house mark. This usage of the SNOWIZARD house mark in no way negates or diminishes the trademark function of the SNOBALL product mark. As in *Kellogg, supra*, the presence of the SNOWIZARD house mark does not detract from the trademark function of the SNOBALL product mark.

CONCLUSION

In conclusion, as stated in *American Fertility*, the burden of proof is upon the USPTO to demonstrate that a mark is generic. In doing so, the USPTO must comply with the proper legal standard; specifically, it must conduct the *Marvin Ginn* two-step inquiry. Further, it must satisfy a heavy evidentiary burden: "a substantial showing that the term is in fact generic . . . based on clear evidence of generic use."

Applicant respectfully submits that neither the Second Office Action, the Fourth Office Action, nor the Fifth Office Action applied the proper legal standard. First, the USPTO did not conduct the appropriate two-step inquiry. In particular, the USPTO did not first determine the genus of the goods listed in the application.

Second, the references cited by the USPTO do not satisfy the requisite burden of proof. Such references do not contain any evidence (much less "clear evidence of generic use" culminating in a "substantial showing") that the relevant public perceives the term "SNOBALL" to primarily refer to the genus of the goods listed in the application.

Given the apparent application of an improper legal test and for the above-stated reasons, Applicant respectfully requests the Board to reverse the genericness refusal, reverse the refusal to accept the claim that SNOBALL has acquired distinctiveness, reverse the refusal to recognize that SNOBALL functions as a mark, and reverse the refusal to accept the specimen previously submitted. Accordingly, Applicant requests registration of Applicant's mark upon the Principal Register. In view of the foregoing, Applicant believes the application to be in condition, and the mark ready, for publication for opposition and thereafter registration on the Principal Register, which action is respectfully requested.

To the extent any fees are required to file or process this request, please charge our Deposit Account No. 03-0937.

Respectfully submitted,

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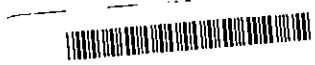
October 21, 2003



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In re:	Application of Sno-Wizard Manufacturing, Inc.
Serial No.:	76/059,333
Mark:	SNOBALL
Our File No.:	12589

Dear Sirs:

The following papers are enclosed:

1. Applicant's Appeal Brief; and
2. Postage-paid post card to be returned to our firm as filing confirmation.

To the extent additional fees are required to file or process this application, please charge our Deposit Account No. 03-0937.

Very truly yours,

Theodore S. Owers III

Theodore (Todd) S. Owers, III

Enclosures

cc: Mr. Ronald S. Sciortino