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

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| Proceeding | 76561135 |
| Applicant | JAMES, JESSE |
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| Submission | Please replace the brief filed earlier today with this brief as the earlier filed brief did not contain an alphabetical index of cases. Thank you. |
| Attachments | Appeal Brief - 3-0s.pdf (8 pages) |
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| Date | 09/26/2005 |

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

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| In re Application of Jesse James |) International Class 012 |
| |) |
| Serial Number: 76/561135 |) Examining Attorney: Jennifer D. Chicoski |
| |) |
| Filed: November 20, 2002 |) Law Office: 115 |
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| Mark: 3-0'S |) Telephone: 571-272-9142 |
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**APPLICANT'S BRIEF IN SUPPORT
OF APPROVAL FOR REGISTRATION IN
INTERNATIONAL CLASS 012**

INDEX OF CITED CASES

1. Andrew J. McPartland, Inc. v. Montgomery Ward & Co., Inc., 164 F.2d 603, 76 U.S.P.Q. 97 (C.C.P.A. 1947).
2. C-Thru Ruler Co. v. Needleman, 190 U.S.P.Q. 93 (E.D. Pa 1976).
3. In re American Standard, Inc., 223 U.S.P.Q. 353 (T.T.A.B. 1984).
4. In re Bliss & Laughlin Indus., Inc., 198 U.S.P.Q. 127 (T.T.A.B. 1978).
5. In re George Weston Ltd., 228 U.S.P.Q. 57 (T.T.A.B. 1985).
6. In re Gourmet Bakers, Inc., 173 U.S.P.Q. 565 (T.T.A.B. 1972).
7. In re Grand Metropolitan Food Serv., Inc., 30 U.S.P.Q.2d 1974 (T.T.A.B. 1994).
8. In re Hercules Fasteners, Inc., 203 F.2d 753, 97 U.S.P.Q. 355 (C.C.P.A. 1953).
9. In re Hospital Supply Corp., 219 U.S.P.Q. 949 (T.T.A.B. 1983).
10. In re Merrill Lynch, Pierce, Fenner, and Smith, Inc., 828 F.2d 1567, 1571 (Fed. Cir. 1987).
11. In re Northland Aluminum Products, Inc., 777 F.2d 1556, 227 U.S.P.Q. 961 (Fed. Cir. 1985).
12. In re Societe Generale Des Eaux Minerales De Vittel S.A., 824 F.2d 957 (Fed. Cir.1987).
13. In re State Chem. Mfg., Co., 255 U.S.P.Q. 687 (T.T.A.B. 1985).
14. In re Women's Publ'g Co., 23 U.S.P.Q.2d 1876 (T.T.A.B. 1992).
15. Nife Inc. v. Gould-National Batteries, Inc., 128 U.S.P.Q. 453 (T.T.A.B. 1961).

DESCRIPTION OF THE RECORD

The evidence of record in this case consists of Applicant's application for registration in International Class 012, Office Action No. 1, Applicant's Response to Office Action No. 1, and Office Action No. 2.

ISSUE PRESENTED

Whether Applicant's mark 3-0'S, when used in connection with automotive parts, namely, car wheel rims in International Class 012, is "merely descriptive" of such goods.

INTRODUCTION

Applicant seeks to register the mark 3-0'S for "automotive parts, namely, car wheel rims." In addition to the arguments set forth in Applicant's Response to Office Action No. 1, Applicant respectfully submits the following arguments in response to Office Action No. 2, in which the Examining Attorney made FINAL her refusal to approve Applicant's mark for publication.

ARGUMENT

II. 3-0'S is Not a "Novel Spelling" for Tire Rims Consisting of Thirty or More Inches.

In Office Action No. 2, the Examining Attorney argues that Applicant's mark, 3-0'S, should be refused registration because it amounts to a "novel spelling of a merely descriptive term", i.e., tire rims of thirty inches or more in diameter. The Examining Attorney's argument is misplaced.

3-0'S is not a "novel spelling" such as those identified in Office Action No. 2, which were refused registration. For example, the Examining Attorney identified KWIXTART for "quick start",¹ FASTIE for "fast tie",² C-THRU for "see-through",³ and FOM for "foam."⁴

¹ Andrew J. McPartland, Inc. v. Montgomery Ward & Co., Inc., 164 F.2d 603, 76 USPQ 97 (CCPA 1947).

² In re Hercules Fasteners, Inc., 203 F.2d 753, 97 USPQ 355 (CCPA 1953).

³ C-Thru Ruler Co. v. Needleman, 190 USPQ 93 (E.D. Pa 1976).

⁴ In re State Chem. Mfg., Co., 255 USPQ 687 (TTAB 1985).

To the contrary, as set forth in Applicant's response to Office Action No. 1, 3-0'S (phonetically, "three-ohs") is an abbreviation, contraction, foreshortening or whimsical alternative spelling for tire rims equal to or greater than thirty inches in diameter. As such, Applicant intends to use its mark in conformity with established trademark law. See, e.g., Nife Inc. v. Gould-National Batteries, Inc., 128 U.S.P.Q. 453, 454 (T.T.A.B. 1961) (NICAD properly used as a trademark in lieu of the complete words in connection with the sale of nickel cadmium batteries).

III. The Evidence is Insufficient to Find Applicant's Mark to be Descriptive.

It is undisputed that the burden is on the Examining Attorney to demonstrate that a term is descriptive because it is in common use by the relevant purchasing public in lieu of the ordinary words used to refer to the product in question. See Nife, 128 U.S.P.Q. at 454; In re American Standard, Inc., 223 U.S.P.Q. 353, 355 (T.T.A.B. 1984).

If such term is not commonly used by the relevant purchasing public in lieu of the complete words used to refer to the product in question, then the term cannot be merely descriptive. Nife, 128 U.S.P.Q. at 454 (without any evidence that any entity "has ever utilized the designation 'NICAD' in the advertising of nickel cadmium storage batteries...[whether] oral or written in connection with the sale of such goods", the term "NICAD" could not be found to be merely descriptive).

In Office Action No. 1, the Examining Attorney stipulated that tire rims of thirty inches or more are "not standard equipment" for automobiles. Accordingly, it is not surprising that Office Action No. 1 consisted of *no evidence* of the use of the term "3-0'S" (pronounced "three-ohs") to refer to tire rims of *thirty* inches or more by the relevant consumers or the relevant trade.

Moreover, in Office Action No. 2, the Examining Attorney offered *only a single document* as evidence of the alleged descriptiveness of the applied-for mark out of the billions of documents available on the World Wide Web. This single document consists of an informal electronic bulletin board message posted by a single user in which the term "30's" *not* "3-0'S" is used a single time. See Office Action No. 2, Attachment #1.

Contrary to the Examining Attorney's assertion in Office Action No. 2 that "applicant's use of the hyphen between the numeral '3' and the '0' does not create a significant distinction that results in a term with a separate non-descriptive meaning apart from the numeric designation "30s" without the hyphen," applicant respectfully disagrees. Whereas the term "30's" can mean any number between 30 and 39, the term "3-0'S" carries the additional suggestive connotation of three circles, or three "O"s, which can refer to dragsters or funny cars with three wheels.

Significantly, the Examining Attorney has offered no other acceptable evidence, including direct consumer testimony, dictionary listings, newspapers, trade journals and other publications, to support her assertion that the applied-for mark, 3-0'S, is descriptive. See In re Northland Aluminum Products, Inc., 777 F.2d 1556, 1559, 227 U.S.P.Q. 961, 963 (Fed. Cir. 1985) (setting forth these acceptable forms of evidence).

The lack of evidence of record offered by the Examining Attorney to support her refusal to approve Applicant's mark for publication is especially momentous in light of prior findings that even a causal reference to a term is easily unearthed by the PTO with little effort. See, e.g., In re Societe Generale Des Eaux Minerales De Vittel S.A., 824 F.2d 957, 958 (Fed. Cir. 1987) ("[i]t is indeed remarkable to see the thoroughness with which NEXIS can regurgitate a [term] casually mentioned in the news").

Because terms are typically easily and voluminously produced by the PTO's database and the Internet and then offered into evidence (though this is not the case here), the Federal Circuit

has often required a statistically significant number of such references in order to find a mark to be descriptive, and has reversed the Board when such evidence is not present. See, e.g., In re Merrill Lynch, Pierce, Fenner, and Smith, Inc., 828 F.2d 1567, 1571 (Fed. Cir. 1987) (holding that “the mixture of usages unearthed by the NEXIS computerized retrieval service [do] not show, by clear evidence, that the [relevant] community views and uses the term ...as a generic, common descriptive term for the [Applicant's] services.”).

The dearth of evidence of record to establish that the applied-for mark would be commonly recognized by relevant consumers and the trade as being descriptive is further supported by Applicant's Internet searches, identified in Office Action No. 1, which produced *no Web matches* based on the terms (1) “3-O'S ” and “thirty inch tires”, and (2) “3-O'S ” and “thirty inch rims.” See Applicant's response to Office Action No. 1.

Moreover, the Board should find that the Examining Attorney's citation in Office Action No. 2 to “copies of articles from the Detroit Free Press, Specialty Equipment Manufacturers Association, and Virginian-Pilot discussing the latest trends in car wheel rims” are inapposite because such “trends” must be considered in the abstract and have no bearing on the instant application or the applied-for mark. Significantly, none of these articles discuss or even use the term “3-0'S” and are thus irrelevant to support a finding that the applied-for mark is descriptive in connection with the applied-for goods. Similarly, the Examining Attorney's reference in Office Action No. 2 to the use of “20's”, “22's” and “24's” is likewise irrelevant and inapplicable to the applied-for mark because such references do not involve Applicant's mark and because such terms refer to standard tire rims sizes, which the Examining Attorney concedes are not present in this application. See Office Action No. 1.

Accordingly, the evidence of record is clearly insufficient to establish that the applied-for mark is descriptive, or that it is in use (1) by the relevant consumers, (2) in the relevant trade, or (3) by Applicant's potential competitors. See, e.g., In re Women's Publ'g Co., 23 U.S.P.Q.2d 1876, 1877-78 (T.T.A.B. 1992) ("there is of record no evidence that competitors use these words [the Applicant's mark] to describe their [goods]," thus supporting the approval for publication of the applicant's mark).

IV. Any Doubt as to the Registrability of Applicant's Mark
Must be Resolved in Applicant's Favor.

Any "[d]oubts concerning the descriptiveness of a mark are to be resolved in favor of the applicant." James E. Hawes, TRADEMARK REGISTRATION PRACTICE, § 7:3 at 7-8 (West Group 2003); In re Grand Metropolitan Food Serv., Inc., 30 U.S.P.Q.2d 1974 (T.T.A.B. 1994); In re George Weston Ltd., 228 U.S.P.Q. 57 (T.T.A.B. 1985); In re Gourmet Bakers, Inc., 173 U.S.P.Q. 565 (T.T.A.B. 1972).

This basic precept of trademark law exists "on the theory that any person who believes that he would be damaged by the registration will have an opportunity ... to oppose the registration of the mark and to present evidence, usually not present in the ex parte application, to that effect.'" In re Merrill Lynch, Pierce, Fenner, and Smith, Inc., 828 F.2d 1567, 1571 (Fed. Cir. 1987), citing In re Gourmet Bakers, Inc., 173 U.S.P.Q. 565.

Here, substantial doubt exists as to the descriptiveness of Applicant's mark 3-0'S because the evidence does not support a finding that the applied-for mark is used descriptively to refer to the goods at issue.

Where insufficient probative evidence has been adduced by the Examining Attorney, it is incumbent on the Board to approve the cited mark for publication. See In re American Standard, Inc., 223 U.S.P.Q. at 355 ("We know what the mark's shorthand references signify but have

nothing probative of whether they would be understood that way in the trade. At best, we are left with conjecture and doubts which, under prevailing case law, require resolution in Section 2(e)(1) cases in favor of applicants.”), citing In re Bliss & Laughlin Indus., Inc., 198 U.S.P.Q. 127 (T.T.A.B. 1978); In re Hospital Supply Corp., 219 U.S.P.Q. 949, 951 (T.T.A.B. 1983); see also In re Merrill Lynch, 828 F.2d at 1571 (“[i]t is incumbent on the Board to balance the evidence of public understanding of the mark against the degree of descriptiveness encumbering the mark, and to resolve reasonable doubt in favor of the applicant, in accordance with practice and precedent.”).

V. Conclusion

For the reasons set forth herein, Applicant respectfully requests that its mark, 3-0’S, be approved for publication

Respectfully submitted,
Keats McFarland & Wilson LLP

/s/

Dated: September 26, 2005

By: _____
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