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UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 76/561135

APPLICANT: James, Jesse

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**BEFORE THE
TRADEMARK TRIAL
AND APPEAL BOARD
ON APPEAL**

MARK: 3-O'S

CORRESPONDENT'S REFERENCE/DOCKET NO: 10238-00002

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4. Your telephone number and e-mail address.

Applicant:	Jesse James	:	BEFORE THE
Trademark:	3-O'S	:	TRADEMARK TRIAL
Serial No:	76/561135	:	AND
Attorney:	Anthony M. Keats Keats, McFarland & Wilson, LLP	:	APPEAL BOARD
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EXAMINING ATTORNEY'S APPEAL BRIEF

Applicant has appealed the Trademark Examining Attorney's final refusal to register the mark "3-O'S" on the ground that the mark is merely descriptive when used on the identified goods under Section 2(e)(1) of the Trademark Act, 15 U.S.C. Section 1052 (e)(1).

I. FACTS

Applicant has applied for registration on the Principal Register of the mark “3-O’S” for “automobile parts, namely car wheel rims” based upon applicant’s bona fide intention to use the mark in commerce. Registration was refused under Section 2(e)(1) of the Trademark Act, 15 U.S.C. Section 1052 (e)(1), because the mark is merely descriptive of the identified goods. This appeal follows the Examining Attorney's final refusal on this issue.

II. THE APPLICANT'S MARK IS MERELY DESCRIPTIVE WITHIN THE MEANING OF SECTION 2(e)(1) OF THE TRADEMARK ACT, 15 U.S.C. SECTION 1052 (e)(1).

A mark is merely descriptive under Trademark Act Section 2(e)(1), 15 U.S.C. 1052(e)(1), if it describes an ingredient, quality, characteristic, function, feature, purpose or use of the relevant goods or services. *In re MetPath Inc.*, 223 USPQ 88 (TTAB 1984); *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979). The question of whether or not a mark is merely descriptive must be determined not in the abstract, but rather in relation to the goods for which registration is sought, the context in which the mark is used in connection with those goods, and the possible significance that the mark would have, because of the context in which it is used, to the average purchaser of the goods in the market place. *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215 (CCPA 1978); *In re Broco*, 225 USPQ 227 (TTAB 1984). It is not necessary that a term describe all of the purposes, functions, characteristics or features of the goods to be merely descriptive. It is enough if the term describes one attribute of the goods. *In re H.U.D.D.L.E.*, 216 USPQ 358 (TTAB 1982); *In re MBAssociates*, 180 USPQ 338 (TTAB 1973).

A. APPLICANT'S MARK "3-O'S" IS DESCRIPTIVE IN THE CONTEXT OF THE IDENTIFIED GOODS

The mark "3-O'S" immediately conveys a specific, descriptive meaning within the context of the field of car wheel rims. The mark itself is comprised of the numeral "3" combined with the plural literal notation "O'S." The letter "O," apart from its significance as the fifteenth letter of the modern English alphabet, is also understood to indicate the number "0" or zero.¹ The numeric designation "3" combined with the character "O" indicates "30" or "thirty."

While the term "thirty" has other definitions, none are as relevant to the identified goods as the most widely understood meaning as the identity of a number between "twenty-nine" and "thirty-one." Other meanings in different contexts are not controlling on the issue of descriptiveness. *In re Bright-Crest, Ltd.*, 204 USPW 591 (TTAB 1979).

The significance of the term "3-O'S" must be considered in relation to the identified goods. The examining attorney previously submitted copies of pages from the World Wide Web advertising customized after-market car wheel rims in sizes ranging from twenty inches to thirty inches. One website shows a photograph of the massive size of the thirty inch rims with the caption "blingin 30 inch rims." <http://s87151159.onlinehome.us/gallery/Cars/30inch>. Additional submissions include bulletin board postings by auto enthusiasts discussing the range of sizes of car wheel rims, including thirty inch rims, popular songs referencing the size of car wheel rims in the lyrics, and other pages referring to various sizes of wheel rims by plural numbers in both numeric and literal notations – "twentys," "22s," "24s," "twenty-fours," and so on. An article published in the Detroit Free Press features a "wheel glossary" that explains the use of numbers to identify wheels by their diameter size in inches. "20s: If someone says they are riding on 20's, they are

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driving a vehicle with 20-inch wheels . . . 24s: 24-inch wheels. This is a size that is popular everywhere this summer.” http://www.freep.com/money/business/guide3_20030803.htm.

When the significance of the mark “3-O’S” is considered within the context in which it will be used, namely on “car wheel rims,” the average purchaser of such goods in the market place would immediately understand the mark’s reference to a specific characteristic of the goods – their diameter size in inches. Therefore, the mark is merely descriptive of the goods. *See In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215 (CCPA 1978);

The applicant submits that the term “3-O’S” is not a “novel spelling” of a merely descriptive term. “3-0’S [sic] (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.” Applicant’s Appeal Brief at p. 3. Despite the applicant’s intentions to use the term as a trademark, the term itself remains descriptive of the relevant goods. Furthermore, there is no correct way to pronounce a trademark. *Kabushiki Kaisha Hattori Tokeiten v. Scutto*, 228 USPQ 461 (TTAB 1985); *In re Great Lakes Canning, Inc.*, 227 USPQ 483 (TTAB 1985). While the mark may be pronounced “three-ohs,” it may also be pronounced “thirtys,” or even “three zeros.”

A mark that merely describes the form or shape of a product is descriptive under the Trademark Act. *In re H.U.D.D.L.E.*, 216 USPQ 358 (TTAB 1982) (TOOBS held merely descriptive of bathroom and kitchen fixtures in the shape of tubes); *Levi Strauss & Co. v. Plushbottom & Peabody, Ltd.* 212 USPQ 296 (TTAB 1981) (STRAIGHTS held merely descriptive for straight-legged jeans). A mark that merely describes the size or quantity of a product is also descriptive under Section 2(e)(1), 15 U.S.C. Section 1051(e)(1). *In re Bongrain International (American) Corp.*, 13 USPQ2d 1727 (Fed. Cir. 1990) (BABY BRIE affirmed as

merely descriptive for soft ripened cheese); *Domino's Pizza Inc. v. Little Caesar Enterprises Inc.*, 7 USPQ2d 13 (TTAB 1988) (SINGLE, DOUBLE, and TRIPLE held merely descriptive for pizza for consumption on or off premises).

The fact that an applicant may be the first or only user of a merely descriptive designation does not justify registration if the term projects descriptive significance. *In re National Shooting Sports Foundation, Inc.*, 219 USPQ 1018 (TTAB 1983); *In re International Glame Technology*, 1 USPQ2d 1587 (TTAB 1986). Lack of third party use is irrelevant if the term unequivocally projects descriptive connotation. *In re Tekdyne*, 33 USPQ2d 1949 (TTAB 1995). In the present case, the examining attorney has supplied examples of use of the numeric designation “30s” as well as the literal notation “thirtys” to refer to “car wheel rims.”

The applicant asserts that because terms are “typically easily and voluminously produced by the PTO’s database and the Internet and then offered into evidence (though this 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.” Applicant’s Appeal Brief p. 4. The applicant relies on the holding of the Court of Appeals for the Federal Circuit in *In re Merrill Lynch, Pierce, Fenner and Smith, Inc.*, 828 F.2d 1567, 1571 (Fed. Cir. 1987), in which the Court reversed the Trademark Trial and Appeal Board’s holding that “CASH MANAGEMENT ACCOUNT” was a generic phrase when used in connection with “stock brokerage services, administration of money market fund services, and providing loans against securities services.” This issue differs greatly from the present case, in which the issue is not whether the mark is generic, and thus incapable of identifying the applicant’s goods, but only whether the mark is merely descriptive of the goods. The examining attorney has the burden of proving that a term is generic by clear evidence. *Ibid.* When issuing a refusal under Section 2(e)(1) based upon the descriptiveness of a mark, the

examining attorney must support the refusal with appropriate evidence. TMEP Section 1209.02. Despite applicant's assertions as to the "inapposite" or "irrelevant" nature of the submitted evidence, the submissions are clearly relevant to establishing the significance and meaning that would be attributed to the term "3-O'S" by the relevant manufacturers, marketers and purchasers of car wheel rims.

B. THE SUBMITTED EVIDENCE OF RECORD IS SUFFICIENT TO ESTABLISH THE DESCRIPTIVENESS OF THE MARK UNDER SECTION 2(e)(1) TO THE EXTENT THAT THERE IS NOT DOUBT TO BE RESOLVED IN APPLICANT'S FAVOR

The applicant submits that if a 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. Applicant's Appeal Brief at p. 3, citing *Nife Inc. v. Gould-National Batteries, Inc.*, 128 USPQ 453, 454 (TTAB 1961). Even were the applicant to be the only manufacturer of thirty inch car wheel rims, a merely descriptive term used first or only by one party is no less descriptive because of its limited use, nor is it registrable if the relevant public will perceive the term as describing the goods. *In re Tekdyne*, 33 USPQ2d 1949 (TTAB 1995) ("The fact that applicant will, or intends to be, the first and/or only entity to use the term MICRO-RETRACTOR' for surgical clamps is not dispositive where, as here, such term unequivocally projects a merely descriptive connotation.")

The evidence of record shows that car wheel rims are sold in a variety of sizes. As explained on one website, "[w]heel rims are measured by a few dimensions. The most important are diameter, width, and offset." <http://www.minimopar.knizfamily.net/wheels.html>. Modification of car wheel rims is a very popular enhancement made by vehicle owners who seek to customize their automobiles. "A taller rim often is more noticeable and more dramatic."

http://www.advanceautoparts.com/howtos_tips/automeia_hm/ccr/ccr20030301wu.index. The trend for sport utility vehicles is for larger and larger sized wheel rims – “22, 24- and even 26 inch rims are now in vogue.” *Id.*

An article appearing in the Specialty Equipment Manufacturers’ Association (SEMA) newsletter refers to “the public’s taste for ever-larger rims (and the rubber to go with them) is fueling product development at a rapid rate. <http://www.sema.org/images/pdf/33054.pdf>. The Vice President for Sales & Marketing of Cragar, a specialty equipment manufacturer, comments that “[w]heels are getting absurdly large.” *Id.* Al Manes, President and founder of Colorado Custom views an industry challenge as “keep[ing] up with the proliferation of new sizes being created for the aftermarket.” *Id.* Clearly both the industry and the relevant purchasing public understand that wheel rims are referred to by their size, and would understand the term “3-O’S” as describing the goods.

The applicant argues that none of these references relate to the mark at issue, and that a applicant’s search of the Internet for the terms “3-O’S” and “thirty inch tires” and “3-O’S” and “thirty inch rims” resulted in no matches. Applicant’s Appeal Brief at p. 5, referencing Applicant’s Response to Office Action No. 1. The applicant concludes that substantial doubt exists “because the evidence does not support a finding that the applied-for mark *is used descriptively to refer to the goods at issue.*” Applicant’s Appeal Brief, p. 6, [emphasis added]. The applicant cites in example the findings of the Trademark Trial and Appeal Board in *In re Women’s Publ’g Co.*, 23 USPQ 2d 1876, 1877-78 (TTAB 1992), quoting “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 applicant’s mark.” Applicant’s Appeal Brief, p. 6. In *Women’s Publ’g*, the wording “DECORATING DIGEST” was found to be descriptive of “magazines,” but registrable on the Principal Register based upon applicant’s showing of acquired distinctiveness under Section 2(f),

15 U.S.C. Section 1052(f). No such claim of acquired distinctiveness has been made in the present case.

Regarding current practice for refusing registration of merely descriptive versus generic matter, the Trademark Trial and Appeal Board noted as follows:

The Examining Attorney's refusal that applicant's mark is "so highly descriptive that it is incapable of acting as a trademark" is not technically a statutory ground of refusal. Where an applicant seeks registration on the Principal Register, the Examining Attorney may refuse registration under Section 2(e)(1) of the Act, 15 USC 1052(e)(1), on the basis that the mark sought to be registered is generic (citations omitted). Alternatively, an Examining Attorney may refuse registration under the same section if he or she believes that the mark is merely descriptive and that applicant's showing of acquired distinctiveness is unpersuasive of registrability.

In re Women's Publishing Co. Inc., 23 USPQ2d 1876, 1877 n.2 (TTAB 1992)

Section 2(e)(1) of the Trademark Act prohibits registration of a mark that "when used on or in connection with the goods of the applicant is merely descriptive or deceptively misdescriptive of them." 15 U.S.C. Section 1052(e)(1). The examining attorney is not required to establish that the mark is already used to describe goods in trade, but only that the mark is itself merely descriptive when considered in relation to the identified goods. The evidentiary standard relied upon by the applicant applies to marks refused for being the common commercial or apt name for goods or services, i.e. generic matter.

The evidence of record establishes that (1) both the applicant's competitors and purchasers in the relevant marketplace refer to car wheel rims by their size, (2) that car wheel rims are being manufactured in ever larger sizes, and (3) that there are examples of thirty inch car wheel rims. As the applicant's identified goods are broad enough to include car wheel rims that are thirty inches in diameter, the mark "3-O'S" would immediately be understood to convey this characteristic of the goods, and hence the mark is merely descriptive.

III. CONCLUSION

The proposed trademark is merely descriptive of the identified goods under Section 2(e)(1), 15 U.S.C. Section 1052(e)(1). The refusal to registration under Section 2(e)(1) of the Trademark Act should be affirmed.

Respectfully submitted,

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