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On August 21, 2008 Pamela S. Grapes
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK TRIAL AND APPEAL BOARD

In re Application of

InVue Security Products Inc.

Serial No. 77/006,342

Filed: September 25, 2006

Mark: PUCK

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Law Office 116

APPEAL BRIEF

Applicant's mark is PUCK. Applicant's goods are the following:

Theft deterrent devices and anti-shoplifting devices, namely, electronic article surveillance tags embodying electronic microcircuits in International Class 009.

The Examining Attorney has not found any conflicting mark which would bar registration under Trademark Act § 2(d), 15 U.S.C. §1052(d). TMEP §704.02.

The mark is, at a minimum, suggestive, if not arbitrary. The mark is not merely descriptive.



Table of Contents

Alphabetical Index of Cases Cited.....3

I. Background4

II. Statement of Facts Regarding Merely Descriptive Rejection.....5

III. Issue Presented.....7

IV. Summary.....14

Alphabetical Index of Cases Cited

- In re Abor Dev. Corp.*, 588 F.2d 811, 814, 200 USPQ 215, 218 (CCPA 1978)
- In re American Greetings Corp.*, 226 USPQ 365, 366 (TTAB 1985)
- In re Bed & Breakfast Registry*, 791 F.2d 157, 229 USPQ 818 (Fed. Cir. 1986)
- In re Bright-Crest, Ltd.*, 204 U.S.P.Q. 591(TTAB 1979)
- In re Dial A Mattress Operating Corp.*, 240 F.3d 1341, 1346, 57 USPQ 2d (Fed. Cir. 2001)
- In re Digital Research Inc.*, 4 USPQ2d 1242 (TTAB 1987)
- In re Gyulay*, 820 F.2d 1216,3 USPQ2d 1009 (Fed. Cir. 1987)
- In re MBNA American Bank, N.A.* 67 UPSQ2d 1778
- In re Methpath, Inc.*, 223 USPQ 88 (TTAB 1984)
- In re Oppedahl & Larson LLP*, 373 F.3d 1171, 1173, 71 USPQ2d 1370 (Fed. Cir. 2004)
- In re Polo Int'l Inc.*, 51 USPQ2d 1061 (TTAB 1999)
- Welding Services, Inc. v. Forman*, 509 F3d 1351 (11th Cir. 2007),

I. Background

Applicant filed the present trademark application for the mark PUCK on September 25, 2006. The Examining Attorney issued an Office action dated February 14, 2007. In the action, the Examiner indicated that a search of the Office records revealed no conflicting records, issued a merely descriptive rejection, required an amendment to the identification of goods and required Applicant to provide detailed information about the goods in question.

Applicant filed a timely response to the Office action on August 13, 2007. Applicant acknowledged the Office records search, responded to the merely descriptive rejection, amended the goods and provided detailed information.

The Examiner issued a Final Office action on October 26, 2007. Applicant filed a timely Notice of Appeal and Request for Reconsideration on April 28, 2008.

The original Applicant in this matter was Alpha Security Products, Inc. Via an assignment filed on November 21, 2007, Alpha Security Products, Inc. assigned the application to InVue Security Products Inc., recorded at Reel/Frame No. 003665/0387.

II. Statement of Facts Regarding Merely Descriptive Rejection

The only issue before the Trademark Trial and Appeal Board relates to the merely descriptiveness rejection; the Examiner accepted the amendment to the identification of goods and the information Applicant provided.¹ Accordingly, those matters will not be related hereinafter.

In the Office action of February 14, 2007, the Examiner stated that the grounds for the merely descriptive rejection under Trademark Act § 2(e), 15 USC § 1052(e) was that the documents which the Examiner attached as evidence allegedly demonstrated that product packaging, transmitters, and receivers are often puck-shaped and therefore the mark PUCK described a salient feature of Applicant's goods.

The evidence submitted by the Examiner consisted of a news article wherein the wording "puck" appeared: "The phone was wrapped in cable, which held an anti-theft alarm the size of a hockey puck." A cached press release which read: "Further, it automatically rotates a product to the customer facing position each time it is placed back on its display puck or post." A cached page from a product listing for Temperature Transmitter which read: "Smart Hockey Puck Transmitter, fits in connector head of thermocouple assembly." A product listing for a "Hockey-puck style transmitter."

In response, Applicant addressed the concerns of the Examiner in a written response filed on August 13, 2007. Applicant submitted numerous pages from the Applicant's website, www.alphaworld.com, as well as a page from the website of Derex, one of the sites used by the Examiner, and the dictionary definition of "puck."

¹ Office action dated October 26, 2007.

On October 27, 2007, in response to Applicant's submission, the Examiner issued the Final Office action refusing registration on the grounds that the mark is merely descriptive of the goods. In support of his position, the Examiner attached various pages as alleged evidence of the descriptive nature of Applicant's goods. The Examiner's position appears to be based on the fact that Applicant refers to its security devices as "PUCKS" and has marketed several items under this name.

On April 28, 2008, Applicant timely filed a Request for Reconsideration and Notice of Appeal.

III. Issue Presented

WHETHER APPLICANT'S INTENDED MARK, PUCK, WHEN USED IN CONNECTION WITH THE APPLICANT'S GOODS IS DESCRIPTIVE OF AN INGREDIENT, QUALITY, CHARACTERISTIC, FUNCTION, FEATURE, PURPOSE OR USE OF THE APPLICANT'S GOODS.

The proper test for determining whether a mark is merely descriptive under Trademark Act §2(e)(1), 15 USC §1052(e)(1) is whether the mark describes an ingredient, quality, characteristic, function, feature, purpose or use of the relevant goods. *In re Guylay*, 820 F2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987); *In re Bed & Breakfast Registry*, 791 F.2d 157, 229 USPQ 818 (Fed. Cir. 1986); *In re MetPath Inc.*, 223 USPQ 88 (TTAB 1984); *In re Bright-Crest, Ltd.*, 204 USPQ 591(TTAB 1979); TMEP §1209.01(b). In the present case, the Applicant's mark PUCK is, at a minimum, suggestive, if not arbitrary.

The Examiner conducted an extensive search and did not uncover any on-point references which tend to prove that PUCK is merely descriptive. Indeed, the most common attachments the Examiner cited are the Applicant's own web pages. No argument has been made that Applicant is using the wording PUCK in any sense other than as a trademark to identify the source of origin of the goods. The remaining attachments merely show that others use the wording puck to give the consumer an idea of the size of something, akin to comparing an item as being "bigger than a bread box."

Applicant respectfully distinguishes the attachments submitted by the Examiner as tending not to show merely descriptiveness of the mark PUCK as applied to Applicant's goods.

Attachments 1 and 2 are from a news article. The focus of the news article is a shopping spree in which one of the participants purchased a phone which was wrapped in cable, "which held an anti-theft alarm the size of a hockey puck." No mention is made of what the device was or whose product it depicted. As such, this is not relevant to the analysis herein.

Attachments 3 and 4 are cached pages from a site listed as MTI30 and is entitled, "MTI Introduces Interactive Merchandising Display Innovations at International CES 2006." The press release only references "puck" in referring to a "display puck or post" for holding merchandise. The reference to puck is interchangeable with post, apparently.

Attachment 5 is a page from Derex for a "Smart Hockey Puck" Transmitter, fits in connector head of thermocouple assembly. Programmable via the RCPW-210 configuration kits and your computer. Again, this product does not have any relation to the mark and goods at question herein. Thermocouple assemblies have nothing to do with Applicant's industry or field of goods.

Attachments 6 and 7 are from David Instruments and Calibration. The only reference to "puck" on these attachments is from "6-Unit—Hockey-puck style transmitter." Again, Applicant does not offer transmitters under the mark and this attachment does not have any relevance to Applicant's goods.

In the October 26, 2007 Final Office action, the Examiner referenced 27 attachments.

Attachments 1 through 12 are taken from Applicant's website, www.alphaworld.com. They show that Applicant consistently uses the mark PUCK as a trademark and not in a descriptive sense.

Attachments 13 through 16 are an archived news story, entitled "RFID Products transform PDAs into RFID reader and writers." The sentence containing "puck" is as follows: "USB RFID reader and antenna with hockey puck footprint packing and tethered USB interface plugs into any devices with USB port." This reference has no bearing on the use by Applicant of PUCK as a trademark.

Attachments 17 and 18 are the home page of Aurora Bar Code Technologies in which the page discusses "puck" as follows: "A sampling of RFID tags is shown in the pictures at the left. They can range from the size of a grain of rice to a hockey puck." Again, this has no relevance to Applicant's present situation. Other objects are often used to compare size so that the reader knows the dimensions of an item, such as "as big as a grapefruit or as small as an orange."

Attachments 19 through 26 are from the Wisconsin Technology Network and the page is entitled "RFID technology is opportunity for Wisconsin companies." On Attachment 25, the following reference appears: "Currently, others are selling these tags, which are about the size of a hockey puck, for about \$50." Again, this reference is a purely descriptive use bearing no relation to Applicant's goods.

Attachment 27 is a design patent summary. This also bears no relevance on Applicant's goods and use of the mark PUCK.

Registration of the mark PUCK for "theft deterrent devices and anti-shoplifting devices, namely, electronic article surveillance tags embodying electronic microcircuits"

would not inhibit competition in the sale of particular goods. The evidence adduced proves that no others would want to or have wanted to use the wording PUCK as a trademark for theft deterrent devices. TMEP §1209. Applicant respectfully submits that the mark is, at the least, suggestive, if not arbitrary and inherently distinctive. Because the mark PUCK does not describe an ingredient, quality, characteristic, function, feature, purpose or use, the mark is necessarily at least suggestive. The dictionary definition of the wording PUCK supports a finding that the mark is used suggestively, not merely descriptively.

Applicant respectfully submits that the Examining Attorney has not provided any evidence that demonstrates that the public attaches any importance to the word PUCK in the field of theft deterrent devices. PUCK does not have any dictionary meaning associated with theft deterrent devices.

Applicant submits that when one hears the term “puck,” one may think of a hockey puck. Clearly, Applicant’s goods have nothing, however, to do with sports equipment. The use of the term “puck” in relation to a security device necessarily causes the consumer to pause a moment in an attempt to relate the goods with the mark. This pause renders the mark suggestive, not merely descriptive. Moreover, no direct meaning can be inferred from the term PUCK as it relates to Applicant’s goods, which are not in the shape, style, weight or color of a hockey puck. Rather, the consumer is left with the suggestion that the goods are strong and durable, like a hockey puck. Hockey pucks, by their very nature, must be able to be hit across ice with great amounts of force from a hockey stick and still function as a durable piece of sporting equipment. If hockey pucks flew into bits and pieces, then the risk of injury to

hockey players and spectators would be great, considering the speed at which the puck flies and the game is played. Similarly, those suggestions are what make Applicant's mark PUCK a suggestive mark, at a minimum. Applicant's goods are likely to be significantly mistreated and abused by those who are attempting to steal the protected merchandise. As such, the Applicant's goods, namely the theft deterrent devices, must be extremely durable. Applicant also notes as a matter of course that the goods marketed under the mark PUCK are oblong in nature, not round as would be a hockey puck. The goods have a different weight than a hockey puck and have a different overall shape than a hockey puck.

The cases cited by the Examiner are also distinguishable. *In re Gyulay*, supra, depicted an applicant attempting to register the mark APPLE PIE for a potpourri that specifically smelled like apple pie. *In re Bed & Breakfast Registry*, supra, is distinguishable because the mark could only have one meaning, that being as a bed and breakfast registry. *In re Metpath*, supra, is distinguished because there the initials used, PAP, stood for prostatic acid phosphatase used for detecting prostate cancer and therefore told the consumer exactly what was intended. *In re Bright-Crest, Ltd.*, supra, is distinguished because the TTAB held that coaster cards meant postcards with a cork back that could be used as a coaster when the consumer removed a peel-off label. In *In re Dial A Mattress Operating Corp.*, 240 F.3d 1341, 1346, 57 USPQ 2d (Fed. Cir. 2001) was held in favor of the applicant when the court reversed the Board. In *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 1173, 71 USPQ2d 1370 (Fed. Cir. 2004) is distinguished because the applicant tried to register "patent.com" which reflected the nature of their business, patents and merely added the web address, .com. In *In re*

Abor Dev. Corp., 588 F.2d 811, 814, 200 USPQ 215, 218 (CCPA 1978) the applicant tried to register “gas badge” for a gas badge. In *In re Polo International Inc.*, 51 USPQ2d 1061 (TTAB 1999), the applicant tried to register “doc-control” for document control software. In *In re Digital Research Inc.*, 4 USPQ2d 1242 (TTAB 1987), the applicant was faced with different issue than the one presented herein.

In *Welding Services, Inc. v. Forman*, 509 F.3d 1351 (11th Cir. 2007), the court of appeals reaffirmed that “descriptive marks” identify a characteristic or quality of the service or product. “Suggestive marks” refer to some characteristic of the product that they are used to represent goods, but for which a leap of imagination is required to get from the mark to the product. Applicant respectfully submits that a leap of imagination is necessary to arrive at a conclusion as to the nature of Applicant’s goods.

Applicant notes that the present mark PUCK requires imagination, thought, and perception to determine how PUCK relates to theft deterrent devices and anti-shoplifting devices, namely, electronic article surveillance tags embodying electronic microcircuits. *In re MBNA America Bank N.A.*, 67 USPQ2d 1778. Applicant’s mark suggests that Applicant’s theft deterrent devices and anti-shoplifting devices, namely, electronic article surveillance tags embodying electronic microcircuits, are durable like a hockey puck, without being in the shape of a hockey puck.

The entire idea behind the wording PUCK for Applicant’s goods is suggestive in nature. Pucks do not convey any feature, quality or characteristic of the goods in any way. In fact, when one hears the wording PUCK, one is more likely to think of hockey than anything else. Hockey leaves the consumer thinking of a fast game where having control of the puck and scoring with the puck is the object of the game. The puck

symbolizes the power in the game. One in control of the puck is generally in control of the game. Every player seeks the puck and is constantly aware of its whereabouts. Possession of the puck is the key to the game- everyone wants it but only a few can have it at any one time. In a similar vein, the PUCK symbolizes the power in the retail environment. It protects the merchandise from thievery. Having a PUCK protecting the merchandise is a gold mine to the retailer. A PUCK is the key that every retailer wants to protect his merchandise. In the hard hitting world of retail merchandising, like hockey, the PUCK is what the retailer needs to protect his merchandise.

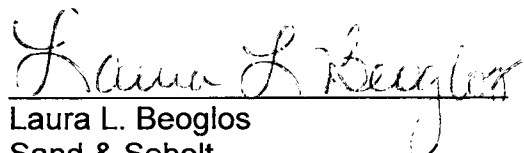
There is nothing similar between a sporting good and a security device. Applicant has taken a unique piece of sporting good equipment, a puck, known for its durability and desirability to the players, and used that word to evoke a positive image of its product. The PUCK is strong, durable and desirable to keep the devices it is designed to protect from theft.

IV. Summary

Applicant respectfully submits that after considering the mark under the tests that the mark requires thought and imagination, the words are not needed by competitors, the words have not been used by competitors, and the Applicant has not used the mark in describing the goods and has used the mark only as an indication of source.

PUCK is a suggestive, if not arbitrary, mark which is not merely descriptive. Accordingly, Applicant respectfully requests that the mark be allowed and publication of the application is hereby earnestly requested.

Respectfully submitted,



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