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

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**UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)
BEFORE THE
TRADEMARK TRIAL AND APPEAL BOARD**

APPLICATION SERIAL NO. 77964445

MARK: UNITED STATES KUKKIWON

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77964445

EX PARTE APPEAL FROM:

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APPELLANT'S BRIEF

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APPLICATION AND REGISTRATION:

Application Serial Number 77964445 – At issue under this appeal.

Registration 3266647 – Prior registration on the Supplemental Register owned by applicant.

II. STATEMENT OF THE ISSUE PRESENTED FOR REVIEW

Whether the word “KUKKIWON,” which is a Korean word for “headquarters for national sport”, is generic for “Testing, analysis and evaluation of the goods and services of others for the purpose of certification.”

III. STANDARD OF REVIEW

Rule 1217 of the Trademark Trial and Appeal Board states that “[i]n determining an ex parte appeal, the Board reviews the appealed decision of the examining attorney to determine if it was correctly made.”

IV. STATEMENT OF THE CASE

A. Course of Proceedings and Disposition by the Examining Attorney

The following is a summary of the prosecution of the application at issue:

Item	Date	Summary
Application	3/22/2010	Mark: UNITED STATES KUKKIWON Class 042 Services: Testing, analysis and evaluation of the goods and services of others for the purpose of certification. Filing basis: 1(a) First use/first use in commerce: 7/15/2005 Translation: The English translation of KUKKIWON in the mark is headquarters for national sport. Prior registrations: The applicant claims ownership of U.S. Registration Number 3266647.
Office Action	6/23/2010	Section 2(e)(2) refusal Primarily geographically descriptive. Inadequate specimen.
Response to Office Action	12/23/2010	Acquired distinctiveness from 5 years of continuous use. Provided substitute specimen.
Office Action	1/13/2011	“[T]he applicant amended the application to claim acquired distinctiveness under Section 2(f) and thereby obviated the Section 2(e)(2) refusal.” “The applicant also submitted an acceptable substitute specimen.” New issue raised: Requiring disclaimer of KUKKIWON because it is generic in the context of applicant’s services.
Response to Office	3/22/2011	Trademark Office failed to meet burden of proof for genericness. Headquarters not a generic term, at most merely suggestive.

Action		If descriptive, then claiming acquired distinctiveness.
Final Office Action	6/12/2011	KUKKIWON is generic for applicant's services.

B. Statement of the Facts

Sang Lee was the first U.S. Olympic Head Coach for Taekwondo at the 1988 Seoul Olympic Games. From 1997 to 2004, Mr. Lee served as the President of the U.S. Taekwondo Union (currently known as USAT) which is the National Governing Body of Taekwondo in the United States under the U.S. Olympic Committee. Mr. Lee has also served on the Board of Directors of the U.S. Olympic Committee. His service has been instrumental to the development of taekwondo in the United States.

Mr. Lee offers a service whereby he tests other individuals' proficiency with and knowledge of the martial art and, if they meet certain strict requirements, he provides them with various levels of master certification. This certification ensures that the master instructor is fully qualified to teach taekwondo. The certification also helps the standardization of taekwondo in the United States. Mr. Lee (or his predecessor-in-interest) has been using the mark "UNITED STATES KUKKIWON" in connection with those services since July 2005.

In September of 2006, Mr. Lee was assigned a registration for the UNITED STATES KUKKIWON mark on the supplemental register (Registration #3266647) for "testing, analysis and evaluation of the goods and services of others for the purpose of certification." The original owner of that registration was Henry S. Kingwill.

In March 2010 Mr. Lee applied to obtain a registration on the principal register based on acquired distinctiveness stemming from the five years of continuous use in commerce.

Mr. Lee's application is now at issue. As noted above, the examiner initially raised no objection to the term KUKKIWON but noted only that UNITED STATES was geographically descriptive. In December of 2010, when Mr. Lee responded to the office action, the mark had been in use for over five years. The specimen submitted by Mr. Kingwill (as Mr. Lee's predecessor-in-interest) in connection with his application was used as evidence of the period of use.

On January 12, 2011, the examiner accepted the prior use as evidence of acquired distinctiveness for UNITED STATES, but then entered a further refusal based on his finding that KUKKIWON was generic for applicant's goods and services and seeking a disclaimer of that word.

Applicant responded in March of 2011. The examiner issued a final refusal on June 12, 2011.

V. SUMMARY OF ARGUMENTS

- A. The trademark office examiner erred when he ruled that the term KUKKIWON is a generic term for applicant's services and failed to meet the burden of proof for genericness.
- B. The word KUKKIWON is at most suggestive of the services and has acquired distinctiveness through 5 years of continuous use in commerce.

VI. ARGUMENT

A. Trademark Office Failed to Meet Its Burden of Proof for Genericness

According to the Trademark Manual of Examining Procedure, in order to determine that a mark is generic, the Trademark Office must first state the genus of the goods and services and then the Trademark Office bears the burden of proving that the term sought to be registered is understood by the relevant public primarily to refer to that genus of goods and services. (TMEP 1209.01(c)(i)) The case law in this area requires that the Trademark Office provide a record of evidence to demonstrate genericness.

- The Federal Circuit found that the Trademark Office had “no record evidence that the relevant public refers to the class of shop-at-home telephone mattress retailers as ‘1-888-M-A-T-R-E-S-S.’” In re Dial-A-Mattress Operating Corporation, 240 F.3d 1341, 1346 (Fed. Cir. 2001).
- In vacating and remanding, the Federal Circuit made a point of noting the administrative trademark judge's finding that “the Examining Attorney . . . failed to make of record any evidence whatsoever demonstrating that the unitary phrase SOCIETY FOR REPRODUCTIVE

MEDICINE has been used in a generic sense.” In re The American Fertility Society, 188 F.3d 1341, 1348 (Fed. Cir. 1999).

■ The Federal Circuit found that “the record does not show substantial evidence that ‘STEELBUILDING,’ in common usage, is a compound word to mean either “steel building” or “steel buildings.” In re Steelbuilding.com, 415 F.3d 1293, 1298 (Fed. Cir. 2005).

■ The Federal Circuit also found that CASH MANAGEMENT ACCOUNT was not generic as being used by Merrill Lynch and stated that “because the Patent and Trademark Office failed to sustain its burden of showing that appellant’s proposed trademark is generic, we hold that the factual determination by the Board, finding that the term CASH MANAGEMENT ACCOUNT as used by appellant is generic, is clearly erroneous.” In re Merrill Lynch, Pierce, Fenner, and Smith, Inc., 828 F.2d 1567,1571 (Fed. Cir. 1987).

■ The Federal Circuit also found that the mark FIRE CHIEF is not generic as used for a magazine devoted to fire fighting. The H. Marvin Ginn Corporation v. The International Association of Fire Chiefs, Inc., 782 F.2d 987 (Fed. Cir. 1986).

None of the materials provided by the Trademark Office show that the term KUKKIWON or its translation “headquarters for national sports” means “testing, analysis and evaluation of the goods and services of others for the purpose of certification” and none of those materials shows that the relevant public refers to or would understand the term to refer to the class of providing testing certification as KUKKIWON. Rather, the materials provided by the Trademark Office show only that the word KUKKIWON is used as a term in connection with martial arts under some unrelated circumstances. The examiner appears to have performed an internet search using the Google search engine and concluded that because the word KUKKIWON is used by people in the martial arts field, that it is generic for “testing, analysis and evaluation of the goods and services of others for the purpose of certification”. The examiner did not make any attempt to determine whether the uses on the various websites refer to Mr. Lee’s genus of goods and services.

Further, none of the materials provided by the Trademark Office contains a dictionary definition of the word KUKKIWON. See, e.g., American Fertility Society at 1346-1347 for references to the expectation of providing a dictionary definition.

In addition, the Trademark Office cannot look at the word KUKKIWON on its own but must look to the phrase as a whole. The Trademark Office provided no evidence that the phrase UNITED STATES KUKKIWON is understood by the general public as the generic phrase for applicant's testing and certification services. See, e.g., American Fertility Society at 1348 – 1349.

B. Headquarters Not a Generic Term

Clearly, “headquarters” is not a generic term in all instances as it is contained in over 200 registrations that have been issued and in only eight of those was the term “headquarters” disclaimed. The examiner submitted no evidence that the term “headquarters” is generic for applicant's services and thereby failed to meet the Trademark Office's burden of proof for genericness.

C. Acquired Distinctiveness

Applicant is the owner of U.S. Registration No. 3266647 on the Supplemental Register. Although marks registered on the Supplemental Register are not prima facie evidence under Trademark Rule 2.41(b), that registration is based on the Amendment to Allege Use that showed use in commerce commencing in July of 2005. That amendment is prima facie evidence of use for the required five-year period. See Section 2(f) of the Trademark Act and also 37 C.F.R. § 2.41(b) (2000).

In the context of applicant's goods and services, the term KUKKIWON is, at most, suggestive. The mark UNITED STATES KUKKIWON has become distinctive of the services through the applicant's substantially exclusive and continuous use of the mark in commerce for at least five years. While the Trademark Office has found use of the word KUUKIWON on the internet as having a generic meaning, applicant has shown that the use of the word in the context of applicant's mark and services is substantially exclusive in the United States. Applicant does not argue that KUKKIWON doesn't have a

generic meaning, it argues only that the generic meaning is not understood by the relevant public primarily to refer to applicant's genus of services

The fact that applicant disclaimed KUKKIWON in Registration No. 3266647 is neither evidence as to alleged genericness, nor does it preclude subsequent registration of the UNITED STATES KUKKIWON mark on the Principal Register based on acquired distinctiveness under 2(f). 15 U.S.C. §1056(b) expressly provides that “[n]o disclaimer ... shall prejudice or affect the applicant's or registrant's rights then existing or thereafter arising in the disclaimed matter, or his right of registration on another application if the disclaimed matter be or shall have become distinctive of his goods or services.” *Quaker Oil Corp. v. Quaker State Oil Refining Corp.*, 161 U.S.P.Q. 547 (TTAB 1969), *aff'd*, 453 F.2d 1296, 172 U.S.P.Q. 361 (C.C.P.A. 1972); *Victor Tool & Machine Corp. v. Sun Control Awnings, Inc.*, 299 F. Supp. 868, 162 U.S.P.Q. 389 (E.D. Mich. 1968), *aff'd*, 411 F.2d 792, 162 U.S.P.Q. 387 (6th Cir. 1969).

The five years of use through the existing Supplemental Register registration is additionally supported by the declaration dated March 22, 2010, which is attached to applicant's response to office action.

VII. CONCLUSION

The Trademark Office has failed to prove that the relevant public understands UNITED STATES KUKKIWON primarily to refer generically to testing and certification services. The mark UNITED STATES KUKKIWON has acquired distinctiveness through more than five years of exclusive and continuous use of the mark in commerce.

For those reasons, applicant believes that the registration should issue on the principal register without the requested disclaimer.

Respectfully submitted this 21st day of November, 2011.