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Subject: TRADEMARK APPLICATION NO. 78840980 - MASTER ELECTRICIAN -  
14972.0246US

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# UNITED STATES PATENT AND TRADEMARK OFFICE

**SERIAL NO:** 78/840980

**MARK:** MASTER ELECTRICIAN



**CORRESPONDENT ADDRESS:**

CHRISTOPHER J. SCHULTE  
MERCHANT & GOULD P.C.  
PO BOX 2910  
MINNEAPOLIS, MN 55402-0910

**GENERAL TRADEMARK INFORMATION:**

<http://www.uspto.gov/main/trademarks.htm>

**TTAB INFORMATION:**

<http://www.uspto.gov/web/offices/dcom/ttab/index.html>

**APPLICANT:** True Value Company

**CORRESPONDENT'S REFERENCE/DOCKET NO:**

14972.0246US

**CORRESPONDENT E-MAIL ADDRESS:**

## EXAMINING ATTORNEY'S APPEAL BRIEF

### STATEMENT OF THE CASE

Applicant has appealed the Trademark Examining Attorney's final refusal to register the trademark MASTER ELECTRICIAN for "Cord storage, namely, non-metal electrical cord reels" in International Class 09 and "Lighting fixtures, namely, under cabinet and fluorescent lighting; lamp parts, namely, lamp shades, lamp bases, chimneys for oil lamps, filaments for electric lamps, lamp reflectors; portable task lights, namely, pen lights, flashlights; lighting fixtures, namely, work lights and security lighting" in International Class 11 on the ground that the mark is merely descriptive under Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1). It is respectfully requested that the refusal be affirmed.

## **STATEMENT OF FACTS**

Applicant filed the instant application on March 20, 2006, to register the mark MASTER ELECTRICIAN for “Under cabinet and fluorescent lighting; lamp parts; portable task lights; cord storage; work lights; security lighting” in International Class 11.

In the first office action dated September 5, 2006, registration was refused under §2(e)(1) on the ground that the mark merely describes the intended user of the goods identified in the application. Additionally, the examining attorney required the applicant to amend the identification and classification of goods.

On March 5, 2007, the applicant responded by arguing against the refusal to register under §2(e)(1) as being merely descriptive. The applicant also provided a claim of ownership and an amended identification and classification of goods.

On April 13, 2007, the refusal to register under §2(e)(1) was maintained and made FINAL. Additionally, the requirement for an amended identification and classification of goods was maintained and made FINAL with regards to the goods in Class 20.

On September 30, 2007, the applicant submitted a request for reconsideration and, again, argued against the refusal to register the mark under §2(e)(1). Additionally, the identification and classification issue was resolved as applicant submitted an acceptable amendment to the identification of goods.

On November 19, 2007, the request for reconsideration was denied and the refusal to register under §2(e)(1) was maintained and continued.

On January 21, 2008, the applicant filed its appeal brief and the file was forwarded to the examining attorney for statement on February 7, 2008.

### **ISSUE**

The issue on appeal is whether the mark, when used in connection with the identified goods, is merely descriptive under Trademark Act Section §2(e)(1), 15 U.S.C. §1052(e)(1).

### **ARGUMENTS**

#### **THE APPLICANT'S MARK IS MERELY DESCRIPTIVE WITHIN THE MEANING OF SECTION 2(e)(1) OF THE TRADEMARK ACT**

A mark is merely descriptive under Section 2(e)(1) if it describes an ingredient, quality, characteristic, function, feature, purpose or use of the specified goods and/or services. *In re Gyulay*, 820 F.2d 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). A mark that describes an intended user of a product or service is also

merely descriptive within the meaning of Section 2(e)(1). *See Hunter Publ'g Co. v. Caulfield Publ'g, Ltd.*, 1 USPQ2d 1996 (TTAB 1986); *In re Camel Mfg. Co.*, 222 USPQ 1031 (TTAB 1984).

For the purpose of a Section 2(e)(1) analysis, a term need not describe all of the purposes, functions, characteristics or features of the goods and/or services to be merely descriptive. *In re Dial-a-Mattress Operating Corp.*, 240 F.3d 1341, 1346, 57 U.S.P.Q.2d 1807 (Fed. Cir. 2001). It is enough if the term describes only one significant function, attribute or property. *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 1173, 71 USPQ2d 1370, 1371 (Fed. Cir. 2004) (“[A] mark may be merely descriptive even if it does not describe the ‘full scope and extent’ of the applicant’s goods or services.”) (quoting *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 1346, 57 USPQ2d 1807, 1812 (Fed. Cir. 2001)).

Moreover, the determination of whether a mark is merely descriptive is considered in relation to the identified goods and/or services, not in the abstract. *In re Abcor Dev. Corp.*, 588 F.2d 811, 814, 200 USPQ 215, 218 (CCPA 1978); *see, e.g., In re Polo Int'l Inc.*, 51 USPQ2d 1061 (TTAB 1999) (DOC in DOC-CONTROL would be understood to refer to the “documents” managed by applicant’s software, not “doctor” as shown in dictionary definition); *In re Digital Research Inc.*, 4 USPQ2d 1242 (TTAB 1987) (CONCURRENT PC-DOS found merely descriptive of “computer programs recorded on disk” where relevant trade uses the denomination “concurrent” as a descriptor of this particular type of operating system). “Whether consumers could guess what the product

is from consideration of the mark alone is not the test.” *In re Am. Greetings Corp.*, 226 USPQ 365, 366 (TTAB 1985); *see* TMEP §1209.01(b).

As shown below, the mark MASTER ELECTRICIAN merely describes the intended user of the goods and is therefore descriptive within the meaning of Trademark Act Section 2(e)(1).

**THE APPLICANT’S MARK, MASTER ELECTRICIAN, IDENTIFIES AN INTENDED USER OF THE APPLICANT’S GOODS**

The mark MASTER ELECTRICIAN is descriptive because it describes an intended user of the applicant’s goods. A mark that describes an intended user or group of users of a product or service is merely descriptive, within the meaning of Section 2(e)(1). *In re Planalytics, Inc.*, 70 USPQ2d 1453 (TTAB 2004) (GASBUYER merely describes intended user of risk management services in the field of pricing and purchasing natural gas); *Hunter Publishing Co. v. Caulfield Publishing Ltd.*, 1 USPQ2d 1996 (TTAB 1986) (SYSTEMS USER found merely descriptive of a trade journal directed toward users of large data processing systems; evidence sufficient to establish distinctiveness under §2(f)); *In re Camel Mfg. Co., Inc.*, 222 USPQ 1031 (TTAB 1984) (MOUNTAIN CAMPER merely describes intended users of retail and mail order services in the field of outdoor equipment and apparel); *In re Gentex Corp.*, 151 USPQ 435 (TTAB 1966) (PARADER merely describes intended users of protective helmets, namely, parade marchers).

Here, the applicant has applied to register the mark MASTER ELECTRICIAN for “Cord storage, namely, non-metal electrical cord reels”; “Lighting fixtures, namely, under cabinet and fluorescent lighting; lamp parts, namely, lamp shades, lamp bases, chimneys for oil lamps, filaments for electric lamps, lamp reflectors; portable task lights, namely, pen lights, flashlights; lighting fixtures, namely, work lights and security lighting”. The mark immediately describes the relevant goods, namely, that applicant’s goods are intended for use by individuals characterized as master electricians.

The examining attorney has provided evidence of the descriptive nature of the mark in the form of Internet website and Lexis-Nexis® evidence showing use of the term “master electrician” to describe a particular consumer group comprised of individuals with a particular level of skill and knowledge in the relevant trade. In addition, the examining attorney has provided Internet evidence in which the terms “master electrician” or “master electricians” appear in articles or websites in association with goods such as those of the applicant. The Internet and Lexis-Nexis® evidence supports a finding that the goods in the instant application would be used by master electricians, therefore making a MASTER ELECTRICIAN an intended user of the applicant’s goods.

**(A) THE TERM MASTER ELECTRICIAN IS COMMONLY USED TO  
DESCRIBE A CLASS OF INDIVIDUALS**

The examining attorney has attached Internet and Lexis-Nexis® evidence showing that the terms “master electrician” and “master electricians” are used to describe a particular consumer group. In particular, the evidence shows that MASTER ELECTRICIAN is a license obtained by highly skilled electricians.

The following are excerpts from Internet printouts, which were attached to the first office action dated September 5, 2006 and to the denial of the request for reconsideration dated November 19, 2007. These printouts show use of the term “master electrician” as identifying a class of individuals with a particular level of skill the relevant field.

The printout from [www.dllr.state.md.us](http://www.dllr.state.md.us):

“The State Board of **Master Electricians** issues one category of license, that of **Master Electrician**. For many counties in the State, the **Master Electricians** license is a prerequisite to obtaining the county electrical license.”

The printout from [www.dps.state.ia.us](http://www.dps.state.ia.us) illustrates how states offer various levels of electrician licensing, including that of “master electrician”:

“Electricians and Electrical Contractor Licensing...**Master Electrician** – Class A...**Master Electrician** – Class B...”

The printout from [permittingservices.montgomerycountymd.gov](http://permittingservices.montgomerycountymd.gov):

“When is a **master electrician’s** license required? A **Master Electrician’s** License is required when an electrical contractor wishes to obtain a permit to perform electrical work in Montgomery County.”

The following are excerpts from the Lexis-Nexis® articles, originally attached to the final office action dated April 13, 2007, which show use of “master electrician” to identify a specific class of consumers who are knowledgeable in the field of goods identified by the applicant:

“The final detail will be putting in **light fixtures**...Students said they enjoy getting to work on all aspects of the house. A **master electrician** and plumber are brought in during the project to supervise the students' work.” *Times Herald*, April 5, 2006

“Nick Shellman, TAG's easygoing **master electrician**, plugs in 200 **light fixtures** and programs each; he will run the show from a computer in the booth above the audience.” *The News Tribune*, April 6, 2003

“Tim Pruitt carries one of the globes for the new chandeliers up to Mitch Christofis as the two **master electricians** install **lighting** in the new courtroom.” *The Roanoke Times*, June 18, 1997

“The **lighting fixture** inventory was developed by South Coast **master electrician** Shamus McConney and includes a mix of units by Martin Professional, Vari-Lite, and ETC, as well as Wybron color ...” *Entertainment Design*, April 01, 2003

“Lee Griffith, a **master electrician**, wrote two separate grants to replace **light fixtures** in several buildings, including the library.” *Daily Press*, July 5, 1997

The above mentioned Internet and Lexis-Nexis® evidence supports the assertion that “master electrician” identifies a particular group of consumers. In particular, “master electrician” is commonly used to identify a class of individuals with a particular license and high level of skill and knowledge in the field of electrical work.

**(B) MASTER ELECTRICIANS USE THE GOODS IDENTIFIED BY THE APPLICANT**

As shown above, “master electrician” identifies a group of individuals. These individuals use the goods identified in the applicant’s identification and therefore constitute a group of intended users of the applicant’s goods. The examining attorney has attached Internet evidence indicating that the individuals identified as “master electricians” or “master electrician” use the goods identified in the applicant’s identification of goods.

The following are excerpts from the Internet websites, originally attached to the denial of the request for reconsideration dated November 19, 2007, which show use of “master electrician” in association with the goods named in the applicant’s identification of goods, namely “Cord storage, namely, non-metal electrical cord reels”; “Lighting fixtures, namely, under cabinet and fluorescent lighting; lamp parts, namely, lamp shades, lamp bases, chimneys for oil lamps, filaments for electric lamps, lamp reflectors; portable task lights, namely, pen lights, flashlights; lighting fixtures, namely, work lights and security lighting”.

The printout from [baltimore.craigslist.org](http://baltimore.craigslist.org) illustrates that the electrical services provided by master electricians include repairing and installing various installations and devices including “security lighting” and “specialty lighting”. The wording “master electricians” is used to identify the license held by the electricians who will perform such tasks. Because master electricians perform tasks related to lighting fixtures, they inevitably are users of such goods. In particular, the website states:

**“Master Electricians...**Prosper Electric is a family owned business. Specializing in residential repairs, trouble shooting, new circuit installation, ceiling fans, **security lighting, specialty lighting...**License info: Maryland”

The printout from [www.johnnyelectric.com](http://www.johnnyelectric.com) states that master electricians install lighting and wiring. Because the applicant’s identification includes goods such as lighting

fixtures, this is an indication that master electricians are users of the applicant's goods.

In particular, the website states:

“Call our experts for **lighting** installation and specialty wiring needs. Electric Services: Recessed **Lighting**...Outdoor **Lighting**...Custom **Lighting** Designs...From residential work on older homes to remodels or service, we do it all. No job is too big or too small for our **master electricians**.”

The printout from [www.tannelectric.com](http://www.tannelectric.com) is another example of how master electricians use goods such as those of the applicant. In particular, this website indicates that master electricians perform work related to lighting. In particular, the website states:

“Home: **Lighting**, wiring, computer and phone connections ... Restaurant: Outdoor signs, parking lot **lighting**, kitchen equipment, emergency power...Our licensed and **master electricians** are trained to deliver expert, cost-effective results.”

The printout from [www.technotetime.com](http://www.technotetime.com) provides gift ideas for professionals, including master electricians. Included in the list are goods such as those of the applicant, namely flashlights. Because these goods are suggested for use by master electricians, this is yet another example of master electricians being intended users of the applicant's goods. In particular, the website states:

“This Clipmate **flashlight** from Streamlight is one of those items that will certainly make your job a lot easier – and would make a nice gift for any electrical workman from the builders of the world’s most trust **flashlights**....Year-round gifts from TechNote for electrical trades professionals...electrical contractors, electricians, ...**master electricians**...”

The Internet evidence also indicates that the goods identified by the applicant are the subject matter of master electrician continuing education courses. This further indicates that master electricians use the goods in the completion of their work tasks. (see printout from [www.ceformaine.com](http://www.ceformaine.com), [www.ceforwisconsin.com](http://www.ceforwisconsin.com), [www.ceforminnesota.com](http://www.ceforminnesota.com))

Furthermore, electrical cord reels are clearly goods used by master electricians. In particular, electrical cord reels are used to store electrical cords. Electrical cords include power cords and electrical cords used for lighting. Therefore, electrical cord reels are the type of electrical products that would obviously be used by master electricians in the course of performing the electrical repairs and related electrical lighting services that are specifically mentioned in the supporting evidence.

The above referenced Lexis-Nexis® evidence, the printouts from the Internet, and similar additional evidence not specifically mentioned herein establish that the wording “master electrician” is commonly used in the relevant field to describe a class of highly skilled consumers. These consumers, namely “master electricians”, use “Cord storage, namely, non-metal electrical cord reels”; “Lighting fixtures, namely, under cabinet and

fluorescent lighting; lamp parts, namely, lamp shades, lamp bases, chimneys for oil lamps, filaments for electric lamps, lamp reflectors; portable task lights, namely, pen lights, flashlights; lighting fixtures, namely, work lights and security lighting” in performing their job related tasks. Therefore, the mark MASTER ELECTRICIAN is descriptive because it describes an intended user of the applicant’s goods.

**(C) MASTER ELECTRICIAN IDENTIFIES AN INTENDED USER OF THE APPLICANT’S GOODS**

As shown above, “master electrician” identifies a particular group of individuals with a high level of skill and knowledge in the field of electrical work. Additionally, the supporting evidence proves that master electricians use the goods identified in the applicant’s identification of goods. Therefore, it is logical to conclude that the MASTER ELECTRICIAN identifies an intended user of the applicant’s goods.

**THE FACTS OF *IN RE OMEGA RESEARCH, INC.* ARE DIFFERENT FROM THE FACTS HERE**

The applicant argues that that MASTER ELECTRICIAN is not descriptive of an appreciable number of intended users. In support of this, the applicant relies heavily on the Board’s decision in *In re Omega Research, Inc.*, 1997 TTAB LEXIS 215 (TTAB 1997). The applicant argues that the facts here are similar to those in *In re Omega Research, Inc.* because MASTER ELECTRICIAN, like WALL STREET ANALYST,

suggests a degree of quality and not an intended user of the goods or services.

Additionally, the applicant argues that the case here is similar to the *In re Omega Research, Inc.* decision because the examining attorney has not provided evidence that MASTER ELECTRICIAN identifies an intended user of the products.

While the basis for the refusal in this case may be the same as that in *In re Omega Research, Inc.*, the facts of the cases are different. In the *In re Omega Research, Inc.* decision, the examining attorney provided evidence that WALL STREET ANALYST(S) identifies a group of individuals. To do so, the examining attorney attached Nexis® evidence that merely included the words “Wall Street analyst” and dictionary definitions of “Wall Street” and “analyst”. However, the examining attorney in that case provided no evidence that indicated that Wall Street analysts use the goods identified by the applicant, namely “computer software to assist in making investment decisions”. For this reason, there was no link to the goods identified in the application that would suggest that a WALL STREET ANALYST would use the goods and could therefore be considered an intended user. In that case, the Board clearly made the correct decision because there was complete lack of evidence indicating that a WALL STREET ANALYST uses the goods identified in the application.

Here, the examining attorney has provided extensive evidence to show (1) that MASTER ELECTRICIAN is commonly used to identify a specific and identifiable group of consumers and (2) that the individuals identified as MASTER ELECTRICIAN(S) use the goods identified in the applicant’s application. Unlike the facts in the *In re Omega*

*Research, Inc.* decision, the examining attorney here has provided evidence to show that a MASTER ELECTRICIAN is an intended user of the products. In particular, multiple Internet printouts are provided which show that MASTER ELECTRICIAN(S) use the goods identified in the applicant's identification of goods. This type of evidence was omitted entirely in the *In re Omega Research, Inc.* case; therefore, the facts at hand are clearly differentiable.

Here, because the evidence so clearly connects master electricians to the identified goods, MASTER ELECTRICIAN is not suggestive of the quality of the goods. Instead, MASTER ELECTRICIAN merely tells purchasers that the goods would appeal to master electricians. The evidence, not solely arguments, in the case at hand supports a finding of descriptiveness because master electricians use the goods identified in the application and therefore constitute an intended user.

**THE OFFICE HAS MET ITS BURDEN OF PROOF IN ESTABLISHING THAT  
MASTER ELECTRICIANS ARE AN INTENDED USER OF THE APPLICANT'S  
GOODS**

To support a finding of descriptiveness here, the Office has the burden of showing that a MASTER ELECTRICIAN is an intended user of the applicant's goods, namely "Cord storage, namely, non-metal electrical cord reels"; "Lighting fixtures, namely, under cabinet and fluorescent lighting; lamp parts, namely, lamp shades, lamp bases, chimneys

for oil lamps, filaments for electric lamps, lamp reflectors; portable task lights, namely, pen lights, flashlights; lighting fixtures, namely, work lights and security lighting”.

The examining attorney has met its burden of proof in showing that the mark is descriptive through supplying relevant evidence that clearly indicates that a MASTER ELECTRICIAN is an intended user of the applicant’s goods. A showing that MASTER ELECTRICIANS constitute an appreciable number of consumers or that MASTER ELECTRICIANS are the target consumers is not necessary for a finding of descriptiveness. Furthermore, a mark need not describe all intended users of the goods to be deemed descriptive under Section 2(e)(1). See: *In re Gentex Corporation*, 151 USPQ 435 (TTAB 1966). Instead, the evidence must support a finding that a MASTER ELECTRICIAN constitutes an intended user of the goods. Such a finding is clearly supported here.

In *In re Camel*, 222 USPQ 1031 (TTAB 1984), the mark MOUNTAIN CAMPER was held to be descriptive of an intended user of the applicant’s services, namely “retail and mail order services in the field of outdoor equipment and apparel”. The Board held that the applicant’s services were directed towards campers in general and mountain campers in particular. The facts in *In re Camel* are similar to the facts here. In particular, the applicant here argues that its goods are targeted primarily towards do it yourself consumers, although a larger class of consumers may in fact use the goods. Similarly, the applicant in *In re Camel* argued that its services were directed to a much larger class of consumers than those who would be categorized as mountain campers. In finding that

MOUNTAIN CAMPER described an intended user of the services, the Board noted that the evidence clearly showed services that were directed towards mountain campers. A similar finding should be made based on the facts in the case at hand. In particular, the evidence here, like that in *In re Camel*, shows that the goods identified by the applicant are used by master electricians in the completion of their job-related tasks. Such evidence supports a holding that, like MOUNTAIN CAMPER, MASTER ELECTRICIAN is not suggestive, but instead merely tells applicant's purchasers that certain goods of the applicant appeal to MASTER ELECTRICIAN(S).

The applicant appears to argue that skilled workers, such as master electricians, are not the target consumers of the applicant. In support of this argument the applicant provides news articles indicating that do it yourself consumers shop at the applicant's retail stores.

In the denial of the request for reconsideration dated November 19, 2007, the examining attorney attached evidence from the applicant's website indicating that one of the applicant's "retail identities", namely Induserve Supply®, targets commercial and industrial customers. The applicant stated in its brief that Induserve Supply® is a separate division from the applicant's retail hardware store division and that the evidence does not support a finding that MASTER ELECTRICIANS are an intended user of the applicant's goods.

The examining attorney notes that the name of the applicant, "True Value Company", appears on the top and lower portion of the page of the applicant's website that identifies

Induserve Supply® as one of the applicant's "retail identities". This webpage also indicates that Induserve Supply® "supplies...commercial and industrial customers". It should be noted that the application was filed in the name of the "True Value Company" and not its retail hardware store division that supposedly targets only do it yourself consumers. Additionally, there are no limitations in the application to suggest that the goods identified as MASTER ELECTRICIAN are only sold through the applicant's retail hardware store. Because a MASTER ELECTRICIAN would fall within the category of commercial and industrial customers, the evidence is relevant in showing that the True Value Company does not solely target do it yourself consumers and that MASTER ELECTRICIANS are an intended user of the applicant's goods.

Nevertheless, it should be noted that master electricians do not necessarily purchase supplies solely through specialized professional or industrial suppliers. Because the applicant provides the specialized products required for the work of master electricians and because master electricians are not prohibited from shopping at "do it yourself" retail locations, it is not unreasonable to conclude that master electricians would purchase their supplies through retail stores such as those of the applicant. Therefore, by supplying the specialized products required for completion of tasks performed by master electricians, the applicant is targeting master electricians and master electricians constitute intended users of the applicant's goods.

Additionally, no limitations are included in the identification of goods that would indicate that the goods are for use solely by do it yourself consumers. The determination of

whether a mark is merely descriptive is considered in relation to the identified goods and/or services, not in the abstract. *In re Abcor Dev. Corp.*, 588 F.2d 811, 814, 200 USPQ 215, 218 (CCPA 1978); *see, e.g., In re Polo Int'l Inc.*, 51 USPQ2d 1061 (TTAB 1999) (DOC in DOC-CONTROL would be understood to refer to the “documents” managed by applicant’s software, not “doctor” as shown in dictionary definition); *In re Digital Research Inc.*, 4 USPQ2d 1242 (TTAB 1987) (CONCURRENT PC-DOS found merely descriptive of “computer programs recorded on disk” where relevant trade uses the denomination “concurrent” as a descriptor of this particular type of operating system). “Whether consumers could guess what the product is from consideration of the mark alone is not the test.” *In re Am. Greetings Corp.*, 226 USPQ 365, 366 (TTAB 1985); *see* TMEP §1209.01(b).

Furthermore, the presumption under Trademark Act Section 7(b), 15 U.S.C. §1057(b), is that the registrant is the owner of the mark and that use of the mark extends to all goods and/or services identified in the registration. The presumption also implies that the registrant operates in all normal channels of trade and reaches all classes of purchasers of the identified goods and/or services. *In re Melville Corp.*, 18 USPQ2d 1386, 1389 (TTAB 1991); *McDonald’s Corp. v. McKinley*, 13 USPQ2d 1895, 1899 (TTAB 1989); *RE/MAX of America, Inc. v. Realty Mart, Inc.*, 207 USPQ 960, 964-5 (TTAB 1980). This presumption further supports the proposition that applicant’s goods will be directed to the class of purchasers known as “MASTER ELECTRICIAN(S)” and is supported by the evidence of record.

Finally, the applicant argues that master electricians purchase their supplies and equipment through suppliers that specialize in supplying professional consumers. In light of the evidence of record, this argument is unpersuasive. There is no evidence of record that indicates that master electricians purchase supplies solely from specialized suppliers. While specialized suppliers certainly exist, evidence of such suppliers is not persuasive in showing that master electricians are not an intended user of the applicant's goods.

### **MASTER ELECTRICIAN NEEDS TO BE FREE FOR USE BY COMPETITORS**

The two major reasons for not protecting descriptive marks are: (1) to prevent the owner of a mark from inhibiting competition in the sale of particular goods or services; and (2) to avoid the possibility of costly infringement suits brought by the registrant. This thus enables businesses and competitors to have the freedom to use common descriptive language when merely describing their own goods or services to the public in advertising and marketing materials. *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215 (C.C.P.A. 1978); *In re Colonial Stores, Inc.*, 394 F.2d 549, 157 USPQ 382, 383 (C.C.P.A. 1968); *Armour & Co. v. Organon Inc.*, 245 F.2d 495, 114 USPQ 334, 337 (C.C.P.A. 1957); *In re Styleclick.com Inc.*, 58 USPQ2d 1523, 1526-1527 (TTAB 2001); *In re Styleclick.com Inc.*, 57 USPQ2d 1445, 1448 (TTAB 2000).

Here, MASTER ELECTRICIAN is commonly used to describe a class of individuals. These individuals use the goods identified in the applicant's application. Because the identified goods are essential to the work of master electricians, the term MASTER

ELECTRICIAN is needed to describe such goods and should therefore be free for use by competitors.

### **CONCLUSION**

The applicant's mark MASTER ELECTRICIAN is comprised of descriptive terms that will immediately, without the need for deliberation, imagination or forethought, convey to potential consumers, that a MASTER ELECTRICIAN is an intended user of the goods. A mark that describes an intended user of a product is merely descriptive under Trademark Section 2(e)(1). For the foregoing reasons, it is respectfully submitted that the refusal of registration be affirmed.

Respectfully submitted,

/Katy Halmen/  
Trademark Examining Attorney  
Law Office 109  
Phone: (571) 272-8911  
Fax: (571) 273-8911  
Dan Vavonese  
Managing Attorney  
Law Office - 109