

ESTTA Tracking number: **ESTTA201523**

Filing date: **03/28/2008**

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

Proceeding	78840980
Applicant	True Value Company
Correspondence Address	CHRISTOPHER J. SCHULTE MERCHANT & GOULD P.C. PO BOX 2910 MINNEAPOLIS, MN 55402-0910 UNITED STATES dockmpls@merchantgould.com, dmattessich@merchantgould.com
Submission	Reply Brief
Attachments	masele_20080328192108.pdf (4 pages)(192978 bytes)
Filer's Name	Danielle I. Mattessich
Filer's e-mail	dockmpls@merchantgould.com, dmattessich@merchantgould.com
Signature	/daniellemattessich/
Date	03/28/2008

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

APPLICATION SERIAL NO: 78/840980

FILING DATE: MARCH 20, 2006

APPLICANT: TRUE VALUE COMPANY

EX. ATTORNEY: K. HALMEN

MARK: MASTER ELECTRICIAN

DOCKET NO: 14972.0246US04

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being electronically filed with the Trademark Trial and Appeal Board via ESTTA, on March 28, 2008.

By: 

Danielle I. Mattessich

APPLICANT'S REPLY BRIEF

The Examining Attorney has argued in her brief that the mark MASTER ELECTRICIAN is merely descriptive with respect to the goods of this case based on the following logic --first, "Master Electricians" are a class of consumers. Second, master electricians use the items listed in the application. Therefore, because the above two facts are true, it necessarily follows that it is logical to conclude that the MASTER ELECTRICIAN identifies an intended user of the applicant's goods. The Examining Attorney argues that because she has presented evidence that connects master electricians to the goods in the application that the mark is therefore not suggestive, but descriptive.

Applicant respectfully submits that the Examining Attorney is taking an overly narrow view of this Board's holdings in "intended user" cases where the marks at issue could have easily fallen on either side of the subtle line between descriptive and suggestive marks. The dividing line in those cases was, of necessity, based on the evidence before the Board. As is the case in many distinctiveness determinations, evidence was required to come to any conclusions as to

whether marks like MOUNTAIN CAMPER for retail store services for outdoor equipment and apparel or MANICURIST by CUTEX for nail polish or WALL STREET ANALYST for investment software were only descriptive or had some suggestive qualities.

The Examining Attorney's restrictive analysis, however, would have the MANICURIST by CUTEX and WALL STREET ANALYST marks join the ranks of descriptive marks like MOUNTAIN CAMPER based solely on the assumption that professional manicurist *could* buy the nail polish product at issue or Wall Street Analysts *could* use the software analysis tool in that case. But even the MOUNTAIN CAMPER case involved more than an assumption based on the applicant's identification of goods. Rather, the only relevant evidence before the Board in that case was the applicant's catalogue which demonstrated that an "appreciable number of items" in its catalogue were "directed toward a mountain camper". *In re Camel Manufacturing Company, Inc.*, 222 USPQ 1031, 1032 (TTAB 1984).

Persuasive to the Board in *In re Camel Manufacturing* was the fact that applicant's catalogue copy called out the class of user for the goods – the trail boots and hiking staffs were useful "when crossing those treacherous mountain streams or climbing a steep terrain" and the tents were designated as "nylon mountain tents". *Id.* This meant that the **applicant**, through its own conduct, **directed** to who the goods were to be sold. The Examining Attorney has provided no similar evidence in this case. The only evidence in the record to whom the applicant **directs** its goods shows that they are not "master electricians". Rather, the evidence shows that entire sales scheme of applicant for the goods under this mark is to suggest to the do-it-yourself home repair enthusiast that they will be using a product that is fit for professional use.

But the Examining Attorney disagrees that the descriptiveness test in this case requires her to show that an "appreciable number or all" of applicant goods used in connection with this

mark are “directed” to master electricians, as was the express holding in *In re Camel Manufacturing*. In support of her argument she cites *In re Gentex Corporation*, 151 USPQ 435 (TTAB 1966) which held the mark PARADER for helmets to be descriptive of protective helmets. In that case the Board stated that a mark does not have to be descriptive of all intended uses of a product to be merely descriptive.

However, *In re Gentex* is consistent with the Board’s holding almost 20 years later in *In re Camel Manufacturing*. The evidence of record in *In re Gentex* also included advertising materials from the applicant with ad copy that stated “the GenTex PARADER is perfect topping for any parade.” The Board held that the “primary or intended” users of these hats would be “paraders”. Thus, both in 1966 and in 1984 the Board has held that not **all** of the applicant’s goods have to be directed to the intended user to be descriptive but rather the goods are directed to the goods’ “primary or intended” users, or, under the 1984 test, to “an appreciable number” of the goods’ intended users. As such, *In re Gentex* supports applicant’s position that the examining attorney was required to show that an appreciable number of the goods offered by Applicant under the mark in this case were directed to master electricians.

The Examining Attorney has pointed to no ad copy, articles, catalogues or any other evidence that demonstrates that Applicant has attempted to direct its goods to master electricians. A vague reference to a separate division of Applicant that generally serves the industrial and commercial segments does not show that the mark itself has been so directed to those consumers and, in any event, is completely overcome by the weight of the evidence submitted by Applicant showing otherwise.

Applicant respectfully submits that the Examining Attorney’s stringent position in this case is not necessary given the fact that the PTO has deemed scores of other marks to be

inherently distinctive and allowed to register on the Principal Register that also appear to identify possible intended users of their goods such as Sears's famous CRAFTSMAN mark for tools (*see, e.g.*, Reg. No. 1,391,401), HOMEMAKER for vacuum cleaners (Reg. No. 2,650,016), LUMBERJACK for skilletts (Reg. No. 3,265,131) and BEAUTICIAN'S CHOICE for cosmetics (Reg. No. 1,992,809). More specifically to the mark at issue, since 1963 the PTO has found Applicant's family of "MASTER" marks distinctive and registerable on the Principal Register – MASTER PLUMBER for flush tank floats (Reg. No. 751,518), MASTER MECHANIC for hand tools, etc. (Reg. No. 1,249,555) and MASTER ELECTRICIAN for electrical goods (Reg. No. 1,317,602). (See Applicant's Response to Office Action dated March 5, 2007).

As such, allowing Applicant's mark to proceed to publication in this case would not harm the consistency of the Principal Register, the Board's precedent or competitors. Permitting Applicant's mark to proceed to publication on the Principal Register, on the other hand, is the proper decision based on the law of descriptiveness and the Board's consistent and longstanding interpretation of what constitutes an intended user of the goods under §2(e)(1) of the Lanham Act. Applicant respectfully requests that this Board reverse the Examining Attorney's refusal.

Respectfully Submitted,

TRUE VALUE COMPANY

By its Attorneys,

Date:

March 28, 2008



Christopher Schulte
Danielle I. Mattessich
MERCHANT & GOULD P.C.
P.O. Box 2910
Minneapolis, MN 55402-0910
612-332-5300
612-332-9081