

From: Halmen, Katy

Sent: 3/10/2008 6:01:38 PM

To: TTAB EFiling

CC:

Subject: TRADEMARK APPLICATION NO. 78843127 - MASTER MECHANIC -
14972.0236US

Attachment Information:

Count: 1

Files: 78843127.doc

UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 78/843127

MARK: MASTER MECHANIC



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:

14972.0236US

CORRESPONDENT E-MAIL ADDRESS:

EXAMINING ATTORNEY'S APPEAL BRIEF

STATEMENT OF THE CASE

Applicant has appealed the Trademark Examining Attorney's final partial refusal to register the trademark MASTER MECHANIC with regards to the goods in International Class 08, namely "Hand tools, namely, planers, drills; tool pouches for attachment to buckets; tool pouches for attachment to tool belts; hammers; files; chisels; metal vises; hand tools, namely, clamps; hand saws, namely, hack saws, miter saws, wood saws; utility knives; pliers; hand tools, namely, bolt cutters and wire cutters; hand-operated shears; screwdrivers; hand tools, namely, taps, dies, hex keys; hand jacks; car care tools, namely, sockets and ratchets", 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 22, 2006, to register the mark MASTER MECHANIC for “Hand tools; tool pouches; hammers; files; chisels; vises; clamps; hand saws; utility knives; pliers; cutters; shears; screwdrivers; taps; dies; hex keys; jacks; hobby tools; car care tools” in International Class 08.

In the first office action dated September 7, 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 7, 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 of goods.

On April 26, 2007, the refusal to register under §2(e)(1) was maintained and made FINAL with regards to the goods in International Class 08.

On September 29, 2007, the applicant submitted a request for reconsideration and, again, argued against the refusal to register the mark under §2(e)(1).

On November 16, 2007, the request for reconsideration was denied and the partial refusal to register under §2(e)(1) was maintained and continued.

On January 28, 2008, the applicant filed its appeal brief and the file was forwarded to the examining attorney for statement on January 28, 2008.

ISSUE

The issue on appeal is whether the mark, when used in connection with the identified goods in Class 08, 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 MECHANIC 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 MECHANIC, IDENTIFIES AN INTENDED USER OF THE APPLICANT’S GOODS

The mark MASTER MECHANIC 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 MECHANIC for “Hand tools, namely, planers, drills; tool pouches for attachment to buckets; tool pouches for attachment to tool belts; hammers; files; chisels; metal vises; hand tools, namely, clamps; hand saws, namely, hack saws, miter saws, wood saws; utility knives; pliers; hand tools, namely, bolt cutters and wire cutters; hand-operated shears; screwdrivers; hand tools, namely, taps, dies, hex keys; hand jacks; car care tools, namely, sockets and ratchets”. The mark immediately describes the relevant goods, namely, that applicant’s goods are intended for use by individuals characterized as master mechanics.

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 mechanic” 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 and Lexis-Nexis® evidence in which the terms “master mechanic” or “master mechanics” appear on 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 mechanics, therefore making a MASTER MECHANIC an intended user of the applicant’s goods.

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

The examining attorney has attached Internet and Lexis-Nexis® evidence showing that the terms “master mechanic” and “master mechanics” are used to describe a particular consumer group. In particular, the evidence shows that MASTER MECHANIC is a highly skilled mechanic.

According to the definition from www.dictionary.com, attached (page 3) to the November 16, 2007 denial of the request for reconsideration, the term “master mechanic” is defined as “a mechanic, esp. one who is thoroughly skilled, in charge of other mechanics”.

Additionally, the following are excerpts from Internet printouts, which were attached to the first office action dated September 7, 2006. These printouts show use of the term “master mechanic” as identifying a class of individuals with a particular level of skill the relevant field.

The printout from www.onetcenter.org:

“Automotive **Master Mechanics**...Sample of reported job titles: ...ASE **Master Mechanic**....Knowledge: Mechanical – Knowledge of machines and **tools**, including their designs, uses, repair, and maintenance.”

The printout from www.lawrenceneighres.org:

“To become a City of Lawrence licensed **mechanical**, plumbing, or electrical journeyman or **master**, you are required to pass the appropriate Experior Certification Exam.”

The printout from www.gocolumbiamo.com:

“The board of mechanical examiners is herein empowered to provide for the following types of certificates: 1. **Master** mechanical heating, ventilation, air conditioning and refrigeration **mechanic**...”

The following are excerpts from the Lexis-Nexis® articles, originally attached to the final office action dated April 26, 2007, which show use of “master mechanic” to identify a specific class of consumers who are knowledgeable in the field of goods identified by the applicant:

“...While machinists and **master mechanics** may be able to sharpen **drill** bits by hand, the rest of us could use a little help.” *Hot Rod*, December 1993

“...easier for operators to run, but more complex for mechanics to fix,” adds Clyde H. Mooskian, a **master mechanic** with Modern Continental Construction Co. Inc., Cambridge, Mass. “We used to use **hammers**, now we use stethoscopes.” *Engineering News-Record*, February 10, 1997

“A **screwdriver** in the hands of a **master mechanic** is an Archimedes lever, however, and it can move the world.” *Financial Planning*, September 1, 2004

“He had worked at Casa Chrysler Jeep for more than eight years, had reached the title of **master mechanic** and was earning more than \$100,000 a year...His **tools**, valued at more than \$40,000, were left at the dealership, police say.” *Albuquerque Journal*, March 16, 2006

“The Millers arrived late Wednesday afternoon to assess the damage...Don was a **master mechanic**, and part of the loss includes **tools** and computers that helped him perform that work.” *Coshocton Tribune*, February 16, 2006

“If, like **master mechanics** in machine shops, the employee owned his or her own **tools**, none of this would be an issue.” *Market Watch*, October 20, 2005

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

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

As shown above, “master mechanic” 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. In addition to the Lexis-Nexis® evidence mentioned above, the examining attorney has attached Internet evidence indicating that the individuals identified as “master mechanics” or “master mechanic” use the goods identified in the applicant’s Class 08 identification of goods.

The following are excerpts from the Internet websites, originally attached to the denial of the request for reconsideration dated November 16, 2007 and to the first office action dated September 7, 2006, which show use of “master mechanic” in association with the goods named in the applicant’s identification of goods, namely “Hand tools, namely, planers, drills; tool pouches for attachment to buckets; tool pouches for attachment to tool belts; hammers; files; chisels; metal vises; hand tools, namely, clamps; hand saws, namely, hack saws, miter saws, wood saws; utility knives; pliers; hand tools, namely, bolt cutters and wire cutters; hand-operated shears; screwdrivers; hand tools, namely, taps, dies, hex keys; hand jacks; car care tools, namely, sockets and ratchets”.

The printout from online.onetcenter.org identifies specific tools needed by master mechanics in the performance of their job-related tasks. Included in the list of tools are goods such as those identified by the applicant. Because master mechanics use tools in their occupation such as those identified by the applicant, master mechanics are inevitably users of the goods identified in the application. In particular, the website states:

“Summary Report for: ... Automotive **Master Mechanics** ... Master mechanics repair virtually any part on the vehicle or specialize in the transmission system ... Tools used in this occupation: **Hammers – Ball peen hammers, brass hammers, claw hammers, plastic tip hammers**; ... Pullers – Ball joint separators, Bearing pullers, gear puller tools, slide **hammers**...”

The printout from www.northerntool.com shows use of the term “master mechanics” in connection with a tool set that includes many of the goods identified by the applicant. Because mechanics and master mechanics are identified as intended users of the tool set featured on the website, they would also be users of the identical goods provided by the applicant. In particular, the website states:

“Allen 305-Pc. **Master Mechanics** Tool Set ... Comprehensive tool set **for mechanics** includes 101 standard and deep well SAE **sockets** in 1/4in., 3/8in., 1/2in. and 3/4in. drive; 31 socket drive tools; 76 wrenches (combination, open end, crawfoot, flare nut, offset box end, ratcheting box end, adjustable, midget, plus 3/8in. and 1/2in. micrometer torque wrenches). Also includes 97 specialty tools, including pliers, **screwdrivers**, nut drivers, punches, **chisels, hammers, hex keys**, screw extractors and more.”

Similarly, the printout from www.amazon.com features a tool set, intended for professional use, that is described as a “master mechanics” set. This tool set also features goods such as those of the applicant. In particular, the website states:

“Williams WSC-162 162 PC **Master Mechanics** Set ... Includes: 26 Wrenches, 95 **sockets** and drive tools, 7 pliers, 15 **screwdrivers**, 1 **hammer**, 17 pc punch and **chisel** set, and a feeler gauge...162 pc **Master Mechanics** set for the professional user. The mechanics set is perfect for professional mechanics...”

The printout from www.fastenal.com is yet another example of tools such as those provided by the applicant being described with the wording “master mechanic” or “master mechanics”. In particular, the website states:

“CFT 9-33325 425 Piece Master Mechanics Tool Set ... 236 **SOCKETS** 22 **DRIVE TOOLS** 70 **WRENCHES** 31 **SCREWDRIVERS** AND **NUTDRIVERS** 66 **ADDITIONAL TOOLS** ¼ **DRIVE SOCKETS** 11 **SIX POINT STANDARD SOCKETS...**”

The printout from www.brandsplace.com uses “master mechanic” as a category to describe tool sets used by professionals. These tool sets, used in the performance of the various tasks of a master mechanic, contain tools such as those identified by the applicant. In particular, the website uses the following categorization:

“Home: Tools: **Master Mechanic** Tool Sets”

The above referenced Lexis-Nexis® evidence, the printouts from the Internet, and additional evidence not specifically mentioned herein establish that the wording “master mechanic” is commonly used in the relevant field to describe a class of highly skilled consumers. These consumers, namely “master mechanics”, use “Hand tools, namely, planers, drills; tool pouches for attachment to buckets; tool pouches for attachment to tool belts; hammers; files; chisels; metal vises; hand tools, namely, clamps; hand saws, namely, hack saws, miter saws, wood saws; utility knives; pliers; hand tools, namely, bolt cutters and wire cutters; hand-operated shears; screwdrivers; hand tools, namely, taps, dies, hex keys; hand jacks; car care tools, namely, sockets and ratchets” in performing their job related tasks. Furthermore, the attached evidence shows common use of the term “master mechanic” or “master mechanics” to describe the intended user(s) of goods such as those of the registrant. Therefore, the mark MASTER MECHANIC is descriptive because it describes an intended user of the applicant’s goods.

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

As shown above, “master mechanic” identifies a particular group of individuals with a high level of skill and knowledge in the field of mechanics. Additionally, the supporting evidence proves that master mechanics use the goods identified in the applicant’s

identification of goods. Therefore, it is logical to conclude that the MASTER MECHANIC 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 MECHANIC 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 MECHANIC, 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 MECHANIC 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 MECHANIC is commonly used to identify a specific and identifiable group of consumers and (2) that the individuals identified as MASTER MECHANIC(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 MECHANIC is an intended user of the products. In particular, multiple Internet printouts are provided which show that MASTER MECHANIC(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 mechanics to the identified goods, MASTER MECHANIC is not suggestive of the quality of the goods. Instead, MASTER MECHANIC merely tells purchasers that the goods would appeal to master mechanics. The evidence, not solely arguments, in the case at hand supports a finding of

descriptiveness because master mechanics 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 MECHANICS 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 MECHANIC is an intended user of the applicant's goods, namely "Hand tools, namely, planers, drills; tool pouches for attachment to buckets; tool pouches for attachment to tool belts; hammers; files; chisels; metal vises; hand tools, namely, clamps; hand saws, namely, hack saws, miter saws, wood saws; utility knives; pliers; hand tools, namely, bolt cutters and wire cutters; hand-operated shears; screwdrivers; hand tools, namely, taps, dies, hex keys; hand jacks; car care tools, namely, sockets and ratchets".

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 MECHANIC is an intended user of the applicant's goods. A showing that MASTER MECHANICS constitute an appreciable number of consumers or that MASTER MECHANICS 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 MECHANIC 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 mechanics in the completion of their job-related tasks. Such evidence supports a holding that, like MOUNTAIN CAMPER, MASTER MECHANIC is not suggestive, but instead merely tells applicant's purchasers that certain goods of the applicant appeal to MASTER MECHANIC(S).

The applicant appears to argue that skilled workers, such as master mechanics, 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 16, 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 MECHANICS 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 MECHANIC are only sold through the applicant's retail hardware store. Because a MASTER MECHANIC 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 MECHANICS are an intended user of the applicant's goods.

Nevertheless, it should be noted that master mechanics 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 mechanics and because master mechanics are not prohibited from shopping at "do it yourself" retail locations, it is not unreasonable to conclude that master mechanics 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 mechanics, the applicant is targeting master mechanics and master mechanics 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 MECHANIC(S)” and is supported by the evidence of record.

Finally, the applicant argues that master mechanics 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 mechanics purchase supplies solely from specialized suppliers. While specialized suppliers certainly exist, evidence of such suppliers is not persuasive in showing that master mechanics are not an intended user of the applicant’s goods.

MASTER MECHANIC 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 MECHANIC 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 mechanics, the term MASTER MECHANIC is needed to describe such goods and should therefore be free for use by competitors.

CONCLUSION

The applicant's mark MASTER MECHANIC is comprised of descriptive terms that will immediately, without the need for deliberation, imagination or forethought, convey to potential consumers, that a MASTER MECHANIC is an intended user of the goods in International Class 08. 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