From: Khan, Ahsen

Sent: 10/31/2014 5:47:10 PM

To: TTAB EFiling

CC:

Subject: U.S. TRADEMARK APPLICATION NO. 85699997 - THE HEAVY-DUTY HYBRID - T-1213 - EXAMINER BRIEF

****

Attachment Information:

Count: 1

Files: 85699997.doc

UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NO. 85699997 **MARK:** THE HEAVY-DUTY HYBRID	
CORRESPONDENT ADDRESS: DANIEL J. LONG BAE SYSTEMS PO BOX 868 NASHUA, NH 03061-0868	**GENERAL TRADEMARK INFORMATION:** http://www.uspto.gov/trademarks/index.jsp **TTAB INFORMATION:** http://www.uspto.gov/trademarks/process/appeal/index.jsp
APPLICANT: BAE Systems Controls Inc.	
CORRESPONDENT'S REFERENCE/DOCKET NO: T-1213 **CORRESPONDENT E-MAIL ADDRESS:**	

EXAMINING ATTORNEY'S APPEAL BRIEF

I. INTRODUCTION

Applicant, BAE Systems Controls Inc., (hereinafter "Applicant"), has appealed the final refusal to register the proposed mark THE HEAVY-DUTY HYBRID on the Supplemental Register for

"Parallel propulsion engines for heavy duty vocational trucks designed to address the needs of trucks with duty cycles that require higher operating speeds and less frequent stops" in Class 12. Registration is refused pursuant to Trademark Act Section 23(c), 15 U.S.C. § 1091(c), on the grounds that the term THE HEAVY-DUTY HYBRID is generic and incapable of acting as a source indicator for the goods originally described in the application since this is the operative description.

It is respectfully requested that this refusal be affirmed.

II. STATEMENT OF FACTS

On August 9, 2012 the Applicant filed for registration on the Supplemental Register for the standard character mark THE HEAVY-DUTY HYBRID for goods identified as "Parallel propulsion engines for heavy duty vocational trucks designed to address the needs of vehicles with duty cycles that require higher operating speeds and less frequent stops" in Class 12.

On October 16, 2012 a Letter of Protest indicating that the mark was potentially merely descriptive or generic was accepted.

On November 30, 2012 the initial Examining Attorney assigned to review the application refused registration on the Supplemental Register on the basis that the mark was generic under Trademark Act Section 23(c), 15 U.S.C. § 1091(c) and therefore incapable of functioning as a source indicator. The applicant was also required to submit additional information about the goods and indicate a filing basis.

On June 3, 2013 the applicant responded with arguments against the refusal under Trademark Act Section 23(c), 15 U.S.C. § 1091(c), amended its description of goods, indicated a 1(a) filing basis, and responded to the request for additional information.

On July 8, 2013 a non-final office action was sent refusing applicant's specimen and its proposed amendment to the description of goods. The refusal under Trademark Act Section 23(c), 15 U.S.C. § 1091(c) and the requirement for additional information were both continued and maintained.

On December 12, 2013 the applicant responded by providing a substitute specimen, amending its description of goods, providing additional information about the goods and submitting additional arguments against the refusal under Trademark Act Section 23(c), 15 U.S.C. § 1091(c).

On January 13, 2104 the application was re-assigned to the undersigned examining attorney (hereinafter the "Examining Attorney") and the refusal under Trademark Act Section 23(c), 15 U.S.C. § 1091(c) was made final. The requirement to withdraw the amended description of goods because the amendments were beyond the scope of the original description was also made final.

On May 7, 2014 the Applicant filed a Motion for Reconsideration which was denied on May 28, 2014.

On June 30, 2014 the applicant filed the present appeal with the Trademark Trial and Appeal Board ("Board").

III. ISSUES ON APPEAL

A. Whether the original description of the goods as "parallel propulsion engines for heavy duty vocational trucks designed to address the needs of vehicles with duty cycles that require higher operating speeds and less frequent stops" in Class 12 controls or applicant's amended description to "parallel propulsion engines including an electric motor, a generator, a controller, and a battery for heavy duty vocational vehicles designed to address the needs of vehicles with duty cycles that require lower operating speeds and more frequent stops" controls.

B. Whether the mark, HEAVY-DUTY HYBRID is capable of acting as a source indicator for the goods and should therefore be allowed on the Supplemental Register.

IV. ARGUMENT

A. Applicant's proposed amendment to the description of goods is outside the scope of the original description and cannot be accepted. The original description of goods therefore remains operative.

The original application set forth the description of goods as "parallel propulsion **engines** for heavy duty vocational **trucks** designed to address the needs of vehicles with duty cycles that require higher operating speeds and less frequent stops" in Class 12. Applicant proposed amending the description to "parallel propulsion **system**s including an electric motor, a generator, a controller, and a battery for heavy duty vocational vehicles designed to address the needs of vehicles with duty cycles that require higher operating speeds and less frequent stops" on June 3, 2013. This amendment was rejected on the basis that "systems" expanded the scope of the original description which was limited to "engines." Applicant then proposed amending the goods to "parallel propulsion **powertrains** including an electric motor, a generator, a controller, and a battery for heavy duty vocational vehicles designed to address the needs of vehicles with duty cycles that require lower operating speeds and more frequent stops" on December 12, 2013. This amendment was also rejected because powertrains consist of not only engines but transmissions and drive shafts. (See definition of powertrains attached to the Jan. 13, 2014 office action at 57). The applicant then reverted to a description consisting of "parallel propulsion engines including an electric motor, a generator, a controller, and a battery for heavy duty vocational **vehicles** designed to address the needs of vehicles with duty cycles that require lower operating speeds and more frequent stops."

Amending the goods to engines for use with "vocational vehicles" impermissibly expands the scope of the original description of goods because the term "vehicles[1]" is broad enough to encompass use of applicant's engines with cars, buses, etc. in addition to the trucks envisioned in the original description of goods.

Having established that the amendment exceeds the scope of the original description of goods, the original identification in the U.S. application remains operative for purposes of future amendment. *See* 37 C.F.R. §2.71(a); TMEP §1402.07(d).

B. The mark HEAVY-DUTY HYBRID when used in conjunction with the goods is generic and therefore incapable of acting as a source indicator. Consequently, the mark cannot be allowed to register on the Supplemental Register.

The applied for mark, THE HEAVY-DUTY HYBRID represents the generic term for the class or type of goods described in the application and is therefore incapable of indicating source for the goods. As such, the applied-for mark cannot be allowed to register on the Supplemental Register under Trademark Act Section 23(c), 15 U.S.C. § 1091(c).

Generic terms are common names that the relevant purchasing public understands primarily as describing the genus of applicant's goods. *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 1344, 57 USPQ2d 1807, 1810 (Fed. Cir. 2001); *H. Marvin Ginn Corp. v. Int'l Ass'n of Fire Chiefs, Inc.*, 782 F.2d 987, 989-90, 228 USPQ 528, 530 (Fed. Cir. 1986); see TMEP §1209.01(c). Generic terms are by definition incapable of indicating a particular source of goods, and cannot be registered as trademarks.

[1] The Examining Attorney request that the TTAB take judicial notice of the definition of vehicles as "a thing used for transporting people or goods, especially on land, such as a car, truck, or cart" as set forth in Oxford Dictionaries. TBMP 704.12.

In re Merrill Lynch, Pierce, Fenner, & Smith, Inc., 828 F.2d 1567, 1569, 4 USPQ2d 1141, 1142 (Fed. Cir. 1987); see TMEP §1209.01(c). Registering generic terms "would grant the owner of [a] mark a monopoly, since a competitor could not describe his goods as what they are." *In re Merrill Lynch, Pierce, Fenner, & Smith, Inc.*, 828 F.2d at 1569, 4 USPQ2d at 1142.

Determining whether a mark is generic requires a two-step inquiry:

(1) What is the genus of goods at issue?

(2) Does the relevant public understand the designation primarily to refer to that genus of goods?

In re 1800Mattress.com IP, LLC, 586 F.3d 1359, 1363, 92 USPQ2d 1682, 1684 (Fed. Cir. 2009) (quoting *H. Marvin Ginn Corp. v. Int'l Ass'n of Fire Chiefs, Inc.*, 782 F.2d 987, 989-90, 228 USPQ 528, 530 (Fed. Cir. 1986)); TMEP §1209.01(c)(i).

1. Applicant's goods are described, in part, as "parallel propulsion engines" and the broad category or class of goods is therefore "engines."

Regarding the first part of the inquiry, the genus of the goods is often defined by an applicant's identification of goods. *See In re Cordua Rests. LP*, 110 USPQ2d 1227, 1229 (TTAB 2014) (citing *Magic Wand Inc. v. RDB Inc.*, 940 F.2d 638, 640, 19 USPQ2d 1551, 1552 (Fed. Cir. 1991)).

In the present case, the goods are described as "Parallel propulsion engines for heavy duty vocational trucks designed to address the needs of trucks with duty cycles that require higher

operating speeds and less frequent stops" in Class 12, and thus the genus, is "engines for heavy duty vocational trucks."

Applicant argues that the goods consist of a "specific and unique type of engine or truck, known as parallel propulsion powertrains or vocational vehicles." Applicant's Appeal Br. at 1-2. The Examining Attorney notes that the applied-for mark is generic even under Applicant's interpretation of the class or genus of goods. Generally, an applied-for mark may be found generic where the identification is broadly worded and encompasses the narrower category of goods and/or services named in the mark. *See, e.g., In re Greenliant Sys. Ltd.*, 97 USPQ2d 1078, 1082 (TTAB 2010) (holding NANDRIVE generic for "electronic integrated circuits" because NAND drives were types of solid state flash drives, a subcategory of applicant's broadly worded "electronic integrated circuits"); *In re Wm. B. Coleman Co.*, 93 USPQ2d 2019, 2024-25 (TTAB 2010) (holding ELECTRIC CANDLE COMPANY generic for electric candles, a subcategory of applicant's broadly worded "lighting fixtures"); *In re CyberFinancial.Net Inc.*, 65 USPQ2d 1789, 1790 (TTAB 2002) (holding BONDS.NET generic for information and electronic commerce services regarding financial products because bonds were a subcategory of applicant's broadly worded "financial products")

Applicant's argument is also not persuasive because its interpretation of the goods at issue does not comport with the description of goods reflected in the application. As explained in the office action sent on January 13, 2014 and the final refusal sent on May 28, 2014 applicant's proposed amendments to change the description of goods from "parallel propulsion engines" to "parallel propulsion systems" or "parallel propulsion powertrains" were unacceptable because both amendments exceeded the scope of the original description of goods since both "systems" or "powertrains" can arguably include goods beyond just "engines." For example, a definition of powertrain was attached to

the Jan. 13, 2014 office action indicating that a powertrain includes a transmission, drive shaft, and axle. See Jan. 13, 2014 office action at 57.

Since the amendments were not accepted, the original identification remains operative. *See* 37 C.F.R. § 2.71(a); TMEP §1402.07(d). Accordingly, applicant's assertion that the goods consist of a powertrain is not accurate.

Having determined that the original description of goods remains in effect, the class or genus of goods at issue can most accurately be described as engines for heavy duty vocational trucks. Even if applicant's arguments based on its amended description of goods were accepted and the class or genus of goods were described as "powertrains or trucks," its argument that its goods consist of "special or unique" powertrains or trucks is still not relevant because, at best, the goods are still considered to be a subcategory of powertrains or trucks.

2. The term HEAVY-DUTY HYBRID refers to a category or type of engine and therefore represents the generic term for the goods and the relevant public would understand it as such.

For a mark that is a generic "compound term," a combination of two or more words, the evidence of record must show that each of the constituent words is generic, and that each word retains its generic meaning when combined such that the composite formed is generic and does not create a different, non-generic meaning. *See In re Gould Paper Corp.*, 834 F.2d 1017, 1018-19, 5 USPQ2d 1110, 1111-12 (Fed. Cir. 1987); *In re Wm. B. Coleman Co.*, 93 USPQ2d 2019, 2021 (TTAB 2010); TMEP §1209.01(c)(i). Here, the standard in Gould controls because the mark is a combination of the terms HEAVY-DUTY and HYBRID. Each term is a separable element within the mark that carries its own

connotation independent of the other term. The combination of these terms does not alter or change the meaning of the mark such that a new or unique phrase is created because consumers viewing the mark would immediately recognize that applicant's goods consist of hybrid engines for use with heavy-duty trucks.

The attached third party evidence shows that the wording "HEAVY-DUTY HYBRID" in the applied-for mark refers to a type of engine for use with a particular class of vehicles and thus this wording is essentially the apt or common name for a subcategory of the genus of the goods.

As the definitions from the American Heritage® Dictionary attached to the November 30, 2012 office action show the term "heavy-duty" is a term of art within the automotive industry that refers to a class of vehicles which are heavier and can pull more weight than light-duty or medium-duty vehicles and the term "hybrid" refers to vehicles powered by both an electric motor and an internal combustion engine. When combined, the term HEAVY-DUTY HYBRID would primarily be understood by the public as referring to the genus of goods, namely, hybrid engines for heavy duty vehicles.

In addition to the definitions referenced above, the evidence overwhelmingly indicates that the term HEAVY-DUTY is used to refer to class of vehicles or engines used with a particular class of vehicles. For example, the website from changingears.com attached to the Nov. 30, 2102 office action at pages 4-5 provides a classification of light, medium, and heavy duty trucks while the website from nap.edu indicates the term "heavy-duty" refers to a class of trucks with a gross weight greater than 26,000 pounds (See Nov. 30, 2012 Office Action at 6-7). The evidence further indicates that it is common within the automotive industry to refer to trucks beyond a particular gross weight as "heavy-duty." Parties such as Mobil, Lubrizol, or Cummins market automotive products designed for use with "heavy-duty trucks[2] " while websites within the automotive field such as knowledgemosaic.com describe heavy duty engines

[2]See letter denying Applicant's Motion for Reconsideration sent on May 28, 2014 at 4-5, 8-9, and 10-12).

as “any engine which the engine manufacturer could reasonably expect to be used for motive power in a heavy-duty vehicle.” (See Denial of Motion for Reconsideration sent on May 28, 2014 at 13-23). In light of this evidence, the term HEAVY-DUTY is used to refer to a class of trucks within a particular weight range.

The term HYBRID is used to refer to engines powered by both an electric motor and internal combustion. For example, the articles featured on ask.com, howstuffworks.com, vr-zone.com, and osvehicle.com all describe hybrid engines as a type of engine that is powered by both gas and electrical energy[3]. Additionally, the article from Wikipedia attached to the denial of Applicant’s Motion for Reconsideration defines a hybrid electric truck as one that uses a hybrid propulsion system rather than just a combustible engine[4]. Based on the foregoing evidence, the term HYBRID is used to refer to a subcategory of engines that features the use of both electric and gas power.

This evidence is probative because it illustrates that the individual terms HEAVY-DUTY and HYBRID are each generic in relation to the goods because the former is used to describe the class of trucks for which applicant’s goods are used while the latter describes the type of engine. Aside from being generic on an individual basis, the composite term HEAVY-DUTY HYBRID is also generic because each term retains its generic meaning even when combined with the other since the combination of these terms is often used to describe a class of vehicles powered by particular type of engine. For example, the website from fleetowner.com indicates Mitsubishi and Hino both offer heavy-duty hybrid engines for bus and trucks that combine diesel with either electric or natural gas power. (See Nov. 30, 2013 office action at 13-14). In addition to being commonly used within the automotive industry[5] to

[3] See Denial of Applicant’s Motion for Reconsideration sent May 28, 2014 at 46-48, 24-28, 31-33, and 34-39.
[4] See Denial of Applicant’s Motion for Reconsideration sent May 28, 2014 at 71-73.
[5]See for example the evidence from the Nov. 30, 2012 office action from PR Newswire stating that “Remy International, Inc. has completed a project with Benteler Engineering to develop a progressive concept heavy-duty hybrid truck for MAN” at 22-23, or from Macktrucks.com indicating Mack also offers a “heavy-duty hybrid electric

describe engines used with heavy duty trucks, the term HEAVY-DUTY HYBRID is also commonly used outside of the automotive industry to denote heavy-duty vehicles powered by a hybrid engine. For example, the California Environmental Protection Agency provides procedures for certifying "heavy-duty hybrid electric vehicles[6]" while the website from afdc.energy.gov discusses tax credits for "heavy-duty hybrid electric vehicles. (See Nov. 30, 2012 office action at 21). Even Coca-Cola describes its fleet of trucks as consisting of "heavy-duty hybrid trucks" (See Nov. 30, 2012 office action "Local in brief," The Atlanta Journal-Constitution (Atlanta, GA) July 8, 2011) while the Waste & Recycling News also refers to "heavy-duty hybrid vehicles" (See Nov. 30, 2012 office action "Hybrid trash trucks growing in popularity," Waste & Recycling News, August 8, 2011). The evidence discussed above as well as the plethora of additional evidence attached the previous office actions[7] all indicate that the term HEAVY-DUTY HYBRID is commonly used both within the automotive industry and outside of it to refer to a class of vehicles powered by a hybrid engine. Consequently, this term is used to refer to a genus or subcategory of applicant's goods and has become a generic reference for the goods.

Based on the foregoing, the individual terms HEAVY-DUTY and HYBRID appearing in the mark are both generic in relation to the goods because they refer to the class of vehicles for which applicant's goods are used and the type or category of engine. The combination of these two terms does not create any incongruity that would render the mark suggestive or even descriptive because both terms still retain their generic meanings when combined since consumers viewing the mark would immediately recognize the mark as referring to HEAVY-DUTY vehicles powered by HYBRID engines.

---

vehicle" at 19-20, or from Pike Research indicating that "sales of medium to heavy-duty hybrid trucks are poised to reach volumes of more than 100,000 per year by 2017" at 22-23

[6] See Nov. 30, 2012 office action at 15-16.

[7] See for example, the articles from the Telegraph Herald or the San Diego Union-Tribune attached to the Nov. 30, 2012 office action referring respectively to "heavy-duty hybrid buses" and "heavy-duty hybrid vehicles" or the websites attached to the Jan. 13, 2014 office action providing lists of "heavy-duty hybrid trucks" at 2-4 and 16-18 or the article attached to the Denial of Applicant's Motion for Reconsideration sent on May 28, 2014 from theautochannel.com discussing development of new "heavy-duty hybrid" technology for engines and "electric power system" that will use "automated manual transmission with a parallel-type "direct" hybrid system, incorporating an electric motor/generator" at 67-70.

Applicant argues that the relevant public in the present case does not consist of the general public but of highly sophisticated professional buyers for equipment manufacturers. See Applicant's Appeal Brief at 12. This argument was not found to be persuasive because the evidence above shows that the term HEAVY-DUTY HYBRID is a term used within the automotive industry to refer to a particular sub-category of heavy duty vehicles powered by hybrid engines. For example, the websites from Fleetowner.com and Macktrucks.com referenced above and attached to the Nov. 30, 2012 office action indicate that both Mitsubishi and Mack refer to a class of vehicle engines as being heavy-duty hybrid vehicles. Since applicant's customers presumably deal with other manufacturers in its field, it is logical to assume that they would encounter use of this term by parties such as Mitsubishi or Mack. Applicant's assertion without further support that its customers would perceive the term THE HEAVY-DUTY HYBRID as a unique source identifier for its goods is therefore contradicted by the evidence.

3. The addition of the article "THE" to the mark does not obviate its generic nature because "THE" is not capable of performing a source identifying function.

Applicant also argues that the addition of the article "THE" indicates that the mark is used as a unique source indicator for its goods based on the definition of "THE." As explained in the final refusal, Applicant's arguments relying on the addition of the word "THE" are not persuasive because at their core, they rely on the addition of a word that is typically incapable of indicating source to argue that the mark is not generic. This implies that "THE" is performing a source identifying function, despite applicant's contention that it does not.

The word "THE" cannot serve a source identifying function nor can it obviate the generic nature of a mark because adding the term "the" to a descriptive or generic term generally does not add any source-indicating significance or otherwise affect the term's descriptiveness or genericness. *See In re The Place Inc.*, 76 USPQ2d 1467, 1468 (TTAB 2005) (holding THE GREATEST BAR merely descriptive of restaurant and bar services; "the definite article THE . . . add[s] no source-indicating significance to the mark as a whole"); *Conde Nast Publ'ns Inc. v. Redbook Publ'g Co.*, 217 USPQ 356, 357, 360 (TTAB 1983) (holding THE MAGAZINE FOR YOUNG WOMEN a "common descriptive or 'generic' name of a class or type of magazine" and incapable of indicating source; "[t]he fact that the slogan also includes the article 'The' is insignificant. This word cannot serve as an indication of origin, even if applicant's magazine were the only magazine for young women."); *In re The Computer Store, Inc.*, 211 USPQ 72, 74-75 (TTAB 1981) (holding THE COMPUTER STORE merely descriptive of, and the common descriptive name for, computer-related services); *see also In re G. D. Searle & Co.*, 143 USPQ 220 (TTAB 1964), aff'd, 360 F.2d 1966, 149 USPQ 619 (C.C.P.A. 1966) (holding "THE PILL" a common descriptive name for pharmaceutical preparations in tablet form, and thus does not serve as an indicator of source or origin in applicant).

V. CONCLUSION

Applicant's proposed amendments changing the goods to propulsion powertrains and vocational vehicles are outside the scope of the original description of goods. Changing "engines" to "powertrains" expands the scope of the description to include transmissions and drive shafts since the term powertrains encompasses these items. Expanding the description to include vocational vehicles rather than vocational trucks also expands the scope of the original description to include cars or buses, etc. Both amendments are therefore unacceptable and the original description of goods should control.

The applicant's goods can broadly be described as engines for use with heavy duty vehicles and the applied-for mark THE HEAVY-DUTY HYBRID represents the generic term for the goods because it refers to a type of engine that operates on a combination of gasoline and electric power designed for use with a particular class of vehicles. The relevant purchasing public would therefore view the mark as representing the generic term for the type of engine sold by applicant and not as a source indicator. The addition of the word "THE" to the mark does not obviate the generic nature of the mark because it is well established that "THE" is not capable of performing a source indicating function. Consequently, it is respectfully requested that the refusal to register Applicant's mark under Trademark Act Section 23(c), 15 U.S.C. § 1091(c) be affirmed and that the refusal to accept applicant's amendment to its description of goods also be affirmed. *See* 37 C.F.R. §2.71(a); TMEP §1402.07(d).

Respectfully submitted,

/Ahsen Khan/

Trademark Attorney

USPTO

Law Office 113

(571) 272 4343

ahsen.khan@uspto.gov

Odette Bonnet

Managing Attorney

Law Office 113