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

Proceeding	87550193
Applicant	BASIC INDUSTRIES INTERNATIONAL, INC.
Applied for Mark	THE CRUSHER
Correspondence Address	BRIAN M.Z. REECE KNOBBE MARTENS OLSON & BEAR LLP 2040 MAIN STREET, 14TH FLOOR IRVINE, CA 92614 UNITED STATES efiling@knobbe.com 949-760-0404
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Filer's Name	Brian M.Z. Reece
Filer's email	efiling@knobbe.com, brian.reece@knobbe.com
Signature	/Brian M.Z. Reece/
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Applicant : Basic Industries International, Inc.
 Serial No. : 87/550,193
 Filed : July 31, 2017
 Mark : THE CRUSHER

I hereby certify that this correspondence and all marked attachments are being transmitted by electronic mail to the United States Patent and Trademark Office Trademark Trial and Appeal Board at <http://www.estta.uspto.gov> on:

August 19, 2019

(Date)

Brian Reece

Brian M.Z. Reece

APPLICANT’S APPEAL BRIEF

Assistant Commissioner for Trademarks
 P.O. Box 1451
 Arlington, VA 22313-1451

Dear Sir or Madam:

Applicant, Basic Industries International, Inc., hereby respectfully submits the following Appeal Brief in regards to the mark THE CRUSHER (the “Applicant’s Mark”), Application Serial No. 87/550,193.

I. INTRODUCTION

Pursuant to a Notice of Appeal timely filed on June 4, 2019, 15 U.S.C. § 1070, 37 C.F.R. § 2.141, TBMP § 1201 *et seq.*, and TMEP § 1501 *et seq.*, Applicant Basic Industries International, Inc. appeals the Examining Attorney’s final refusal to register Applicant’s mark THE CRUSHER (the “Application”). The Examining Attorney has refused registration of the Application on the basis that Applicant’s Mark is generic for Applicant’s goods under 15 U.S.C. §§ 1051, 1052, 1127. In the alternative, the Examining Attorney has refused registration of the Application on the basis that Applicant’s Mark is merely descriptive for Applicant’s goods under 15 U.S.C. § 1052(e)(1).

For the reasons previously submitted and now set forth herein, Applicant's Mark is not generic and Applicant's evidence of acquired distinctiveness is more than sufficient to show secondary meaning in Applicant's Mark for Applicant's goods. Therefore, Applicant respectfully requests that the Trademark Trial and Appeal Board reverse the refusal of the Examining Attorney.

II. RECITATION OF FACTS

Applicant seeks registration of the mark THE CRUSHER. The Application was filed July 31, 2017. In the first office action, issued November 2, 2017, the Examining Attorney refused registration of the Application under Section 2(e)(1) based on Applicant's Mark being merely descriptive for the goods.

In a response to the First Office Action submitted May 1, 2018, the Applicant responded by submitting a declaration by Applicant's counsel and evidence showing acquired distinctiveness for Applicant's Mark.

In the second office action, issued May 10, 2018 (the "Second Office Action"), the Examining Attorney added a new refusal asserting that Applicant's Mark is generic. The Examining Attorney continued the descriptiveness refusal only in the alternative.

In a response to the Second Office Action submitted November 12, 2018 ("Response to Second Office Action"), the Applicant responded by submitting arguments against the genericness refusal, a declaration by Applicant's president and evidence showing acquired distinctiveness for Applicant's Mark.

The Examining Attorney issued a final office action on December 4, 2018 (the "Final Office Action"), maintaining the genericness refusal and, in the alternative, the merely descriptive refusal.

The current identification of goods for Applicant's Mark is as follows:

Class 8: Hand operated can compactor

III. APPLICANT'S MARK IS NOT GENERIC BECAUSE RELEVANT CONSUMERS CONSIDER APPLICANT'S MARK TO BE A SOURCE INDICATOR FOR APPLICANT'S GOODS RATHER THAN A GENUS OF GOODS

The Examining Attorney has refused registration under sections 1, 2, and 45 of the Lanham Act, 15 U.S.C. §§1051, 1052, 1127 on the ground that Applicant's Mark is purportedly generic for Applicant's goods. However, there are a substantial number of resources demonstrating that Applicant's Mark functions as a trademark and that consumers consider Applicant's Mark to be an indicator of source.

A. Legal Standard

Determining whether a mark is generic requires a two-step inquiry: (1) What is the genus of goods and/or services at issue? (2) Does the relevant public understand the designation primarily to refer to that genus of goods and/or services? *In re Cordua Rests., Inc.*, 823 F.3d 594, 599, 118 USPQ2d 1632, 1634 (Fed. Cir. 2016) (citing *H. Marvin Ginn Corp. v. Int'l Ass'n of Fire Chiefs, Inc.*, 782 F.2d 987, 990, 228 USPQ 528, 530 (Fed. Cir. 1986)); TMEP §1209.01(c)(i).

B. The Burden is on the Examining Attorney to Prove a Term is Generic by Clear Evidence

The Examining Attorney has the burden of proving that a term is generic by clear evidence. *In re Nordic Naturals, Inc.*, 755 F.3d 1340, 1344, 111 USPQ2d 1495, 1498 (Fed. Cir. 2014). A mixture of uses for a mark, some of which may be generic, some not, is not sufficient to overcome the USPTO's burden to prove a term is generic by clear evidence. Further, evidence of generic use is offset by evidence of significant trademark use and recognition by third parties. *In*

re Merrill Lynch, Pierce, Fenner, and Smith, Inc., 828 F.2d 1567, 4USPQ2d 1141 (Fed. Cir. 1987) (finding that the NEXIS evidence relied upon to show CASH MANAGEMENT ACCOUNT was generic for brokerage services did not satisfy the USPTO’s burden to prove genericness by clear evidence because the evidence reflected a “mixture of usages,” with some publications showing third-party recognition of the applicant as the source of the services and some showing generic use). *Baroness Small Estates, Inc.*, 104 USPQ2d 1224, 1228 (TTAB 2012) (“A mixture of uses,” some generic, some not, was not sufficient to prove that a term is widely used as a generic name.); *In re America Online*, 77 USPQ2d 1618, 1623 (TTAB 2006) (“the evidence of generic use is offset by Applicant’s evidence that shows not only a significant amount of proper trademark use but also trademark recognition [by third parties]”); *Alcatraz Media, Inc. v. Watermark Cruises*, 107 USPQ2d 1750 (TTAB 2013)(A mixed record of use of a phrase both generically and as part of a trademark “fails to establish that the primary significance of ANNAPOLIS TOURS to the relevant public is guided tour services of cities, rather than a guided tour service of cities provided by a particular entity.”); TMEP §1209.01(c)(i).

C. The Examining Attorney has Not Properly Defined the Genus of Goods

The Examining Attorney has defined the genus of goods as a “crusher.” Applicant asserts that “crusher” is not the proper genus of goods and there is no legitimate basis to conclude “crusher” is the proper genus. First, the Examining Attorney selected “crusher” as the genus of goods because “the [applicant] identified the goods as a ‘crusher’ on its Amazon pages.” The Examining Attorney attached Applicant’s Amazon product pages as exhibits to the Second Office Action (see the first and second exhibits thereto). In those advertisements, THE CRUSHER is described as an “aluminium *can compactor*” (emphasis added). Thus, Applicant’s Amazon advertisements do not support defining the genus as “crushers.”

As recognized by the Examining Attorney, the genus of goods may be defined by the applicant's identification of goods. In the Application, Applicant identifies the goods as a "hand operated *can compactor*" (emphasis added). Furthermore, at least three registrations, Registration Nos. 3,427,755, 2,953,443, and 3,218,774, also use the identification of goods of "manually operated aluminium *can compactor*" (emphasis added), with two of those registrations being incontestable. Thus, the proper genus of goods is a "can compactor" and not a "crusher."

The most commonly understood meaning of a "crusher," is a stone crusher, which is a machine designed to reduce large rocks into smaller rocks, gravel or rock dust. If a consumer walked into a store and asked for a "crusher," the customer would not be lead directly to a hand operated can compactor. This is supported by online evidence. The Wikipedia page for "crusher" defines the term as "a machine designed to reduce large rocks into smaller rocks, gravel, or rock dust." Nowhere on the Wikipedia page are any references made to compacting cans. Wikipedia is an online encyclopaedia written collaboratively by the public. As such, Wikipedia's definitions reflect the public's general, common understanding of terms, events, concepts, and ideas. Therefore, the general consuming public considers "crusher" as referring to machines designed to reduce large rocks into smaller rocks, gravel or rock dust, rather than a can compactor product. Nowhere on the Wikipedia page is any reference made to "crushing cans." Response to Second Office Action, Exhibit A (printout of Wikipedia page for term "crusher").

Finally, defining the genus as "can compactor," is a logical extension of existing consumer understanding that a "compactor" is a device which compresses larger household waste into smaller dimensions. Consumers are familiar with the concept of a "trash compactor," which takes large quantities of trash and compacts the trash into a smaller size. Similarly, beverage cans are also a type of trash that can be "compacted" into a smaller size. Therefore, consumers naturally

logically refer to a product which reduces the size of trash as a “trash compactor” and a product which reduces the size of a can as a “can compactor.”

In sum, “crusher” is not the proper genus of goods and there is no legitimate basis to conclude “crusher” is the proper genus. As evidenced above, the proper genus of goods is “can compactor.”

D. Applicant’s Mark is Not Generic Because There is Significant Evidence that Third Parties Recognize Applicant’s Mark as a Source Identifier

Third parties use Applicant’s Mark only in reference to Applicant’s particular brand of can compactor products. For example, Applicant’s products are sold on a large number of online retailer sites. Applicant does not have full control over the text used to promote and sell Applicant’s can compactor products on those sites. Applicant also does not have full control on how customers use Applicant’s Mark. Oftentimes, customers will spell or format Applicant’s Mark incorrectly, particularly because of the casual nature of online reviews and submissions. However, Applicant’s can compactor products are almost always sold on webpages bearing Applicant’s Mark, THE CRUSHER, in prominent display alongside a picture of Applicant’s can compactor product, which also prominently bears Applicant’s Mark. The public cannot mistake that Applicant’s Mark, THE CRUSHER, refers to Applicant’s particular brand of can compactors. Consumer recognition that THE CRUSHER is a brand name is reinforced by the fact that every product sold also prominently bears THE CRUSHER mark. Response to Second Office Action, 6 (showing online listings for Applicant’s goods from ACE Hardware and Amazon.com prominently bearing Applicant’s Mark).

In addition, although some retailers and third-party sites use the phrase “can crusher” to describe Applicant’s can compactor product, such uses of the phrase “can crusher” are always used in connection with Applicant’s Mark, THE CRUSHER. Given that Applicant’s Mark, THE

CRUSHER, is always displayed in the heading and directly on the product itself, consumers can clearly see THE CRUSHER as Applicant's trademark for its particular brand of can compactors, which differentiates the product from any other brand of can compactors on the market.

Applicant submitted a declaration on behalf of Applicant's president, Ajay N. Thakkar, which details Applicant's widespread and continuous use and promotion of Applicant's Mark in connection with can compactors ("Applicant's Declaration"). The statements made in Applicant's Declaration are supported by evidence in the form of exhibits, and reference to Applicant's Declaration is made throughout this brief. Response to Second Office Action, Exhibit B (Ajay N. Thakkar Declaration).

Although there are a few instances in which Applicant's Mark is used incorrectly by consumers, Applicant has taken strong steps to educate consumers that its can compactor product is named THE CRUSHER. This is indicated by the fact that retailers of Applicant's products correctly refer to the mark as THE CRUSHER. Overall, some incorrect usage of Applicant's Mark by third parties does not diminish the fact that there is significant evidence that third parties and consumers recognize Applicant's Mark as a source identifier of Applicant's particular brand of can compactor. *In re Merrill Lynch, Pierce, Fenner, and Smith, Inc.*, 828 F.2d 1567, 4USPQ2d 1141 (Fed. Cir. 1987).

In sum, the Examining Attorney must prove that Applicant's Mark is a generic term by clear evidence. Like in *In Re Nordic Naturals*, the above evidence reflects at a minimum a "mixture of usages" of Applicant's Mark, with strong evidence showing third-party recognition of Applicant as the source of Applicant's goods. Therefore, Applicant's submitted evidence of a mixture of usages of Applicant's Mark indicates that the Examining Attorney has not met the burden to prove Applicant's Mark is generic by clear evidence.

IV. APPLICANT'S MARK HAS ACQUIRED DISTINCTIVENESS THROUGH OVER 33 YEARS OF SUBSTANTIALLY EXCLUSIVE USE

As an alternative refusal, the Examining Attorney has refused registration under 15 U.S.C. §1052(e)(1) on the ground that Applicant's Mark is purportedly merely descriptive of Applicant's goods. Applicant submits that Applicant's Mark has acquired distinctiveness through Applicant's longstanding and substantially exclusive and continuous use of the mark for over 33 years, and Applicant claimed acquired distinctiveness under Section 2(f) of the Trademark Act.

Applicant's Declaration, signed by Applicant's president, Ajay N. Thakkar, details Applicant's widespread and continuous use and promotion of Applicant's Mark in connection with can compactors. Response to Second Office Action, Exhibit B. Applicant's Declaration and the supporting exhibits demonstrate that Applicant's Mark has acquired distinctiveness.

Applicant first launched its product under Applicant's Mark in June 1984. Applicant has sold approximately 350,000 units of THE CRUSHER can compactor since May 2011, resulting in approximately \$3.15 million in sales. Since then, Applicant's Mark has gained substantial recognition in the marketplace due to its substantially exclusive and continuous use of THE CRUSHER mark in U.S. commerce in connection with the goods for over 33 years. Applicant has spent at least \$50,000 in advertising, marketing, and promoting its THE CRUSHER can compactor in the U.S. since 2011. For example, Applicant participated in a marketing and development agreement with Amazon between May 1, 2014 and April 30, 2017, for a period of three years. During this time, ten percent of all sales made through the Amazon platform were spent on marketing THE CRUSHER can compactor on Amazon.com. On Amazon alone, Applicant achieved over \$500,000 in gross sales for THE CRUSHER can compactor and spent over \$50,000 on marketing efforts.

Applicant's products are sold at a number of retailers including but not limited to ACE Hardware, Amazon, Arbitrage, Charlie Beans, DC Mach, Do It Best, Lee Valley Tools, Sears, and Walmart. On Amazon, Applicant's can compactor has over 2,300 customer reviews. Response to Second Office Action, Exhibit B, Exhibit C (printout of Amazon.com listing of Applicant's product sold under Applicant's Mark). Approximately 91% of customers gave the product a four or five star review, and approximately 75% of customers gave the product a five star review. Response to Second Office Action, Exhibit B.

Accordingly, in view of the length and extent of Applicant's promotional efforts and extensive sales, the public has come to recognize Applicant's Mark as indicating the source of Applicant's goods and has acquired distinctiveness in the minds of consumers. Indeed, Applicant has been using Applicant's Mark in connection with its goods since at least 1984. This extended length of time of over 33 years is over six times that required to establish a prima facie case of acquired distinctiveness under Section 2(f). *See* 15 U.S.C. § 1052(f) (providing "[t]he Director may accept as **prima facie evidence** that the mark has become distinctive, as used on or in connection with the applicant's goods in commerce, proof of substantially exclusive and continuous use thereof as a mark by the applicant in commerce for the **five years before the date on which the claim of distinctiveness is made**) (emphasis added); *see also* T.M.E.P. § 1212 (providing that acceptable evidence to show acquired distinctiveness under Section 2(f) includes "[a] statement verified by the applicant that the mark has become distinctive of the applicant's goods or services by reason of substantially exclusive and continuous use in commerce by the applicant for the five years before the date when the claim of distinctiveness is made.").

Accordingly, based on Applicant's extensive use of its mark in connection with its goods for over 33 years, Applicant's Mark has acquired distinctiveness and is therefore eligible for

registration on the Principal Register. This evidence is unrebutted by the Examining Attorney. Final Office Action (improperly dismissing Applicant's evidence of "high sales figures," "significant advertising expenditures," and "extensive sales and promotion.").

V. **CONCLUSION**

Applicant notes that to prove that a term is generic, the Examining Attorney must show by clear evidence that a term is understood by the relevant public as referring to a genus of goods. *In re Nordic Naturals, Inc.*, 755 F.3d 1340, 1344, 111 USPQ2d 1495, 1498 (Fed. Cir. 2014). When public use shows significant trademark use and recognition by third parties, along with some third party use generically, this mixed use is insufficient to show that a term is generic. *In re Merrill Lynch, Pierce, Fenner, and Smith, Inc.*, 828 F.2d 1567, 4USPQ2d 1141 (Fed. Cir. 1987).

Here, the Examining Attorney has not carried the burden of showing that Applicant's Mark is generic for the goods. Further, Applicant's substantially exclusive and continuous use of Applicant's Mark for over 33 years definitively establishes that Applicant has acquired distinctiveness in Applicant's Mark. By virtue of these facts, Applicant respectfully requests that the Board reverse the refusal to register Applicant's Mark.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

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By: /Brian M.Z. Reece/
Steven J. Nataupsky
Brian M.Z. Reece
Attorneys for Applicant
2040 Main Street, 14th Floor
Irvine, CA 92614
(949) 760-0404
efiling@knobbe.com