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Subject:	U.S. Trademark Application Serial No. 90900931 - OZ - 2579.022 - Examiner Brief
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Attachments

United States Patent and Trademark Office (USPTO)

U.S. Application Serial No. 90900931

Mark: OZ

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Reference/Docket No. 2579.022

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EXAMINING ATTORNEY'S APPEAL BRIEF

The Office has reassigned this application to the undersigned trademark examining attorney. Applicant, Sheet Pile, LLC (hereinafter "Applicant"), has appealed the Trademark Examining Attorney's Final Refusal to register the trademark "OZ", U.S. Serial Number 90900931, on the Principal Register because the mark is descriptive under Trademark Act Section 2(e)(1). It is respectfully requested that this refusal be affirmed.

FACTS

Applicant seeks registration on the Principal Register for the applied-for mark "OZ" in standard

characters for "Piling sheets, of metal; sheet piles, of metal; profiled piling sections, of metal; connecting elements for sheet piles of metal, namely, metal sheet pile connectors in the nature of structural joint connectors; and metal connecting profiles and welding corners in the nature of structural joint connectors of metal for sheet piles of metal or plastic". The examining attorney has refused allowance of the mark on the Principal Register because the mark merely describes a feature or characteristic of applicant's goods as proscribed under Trademark Act Section 2(e)(1).

This appeal follows the trademark examining attorney's first refusal issued on June 8, 2022, by which the examining attorney refused the applied-for mark as merely descriptive in relation to Applicant's goods under Trademark Act Section 2(e)(1);

Applicant responded to the Office Action on November 11, 2022, arguing that the mark is not generic and should be allowed on the Supplemental Register upon the future submission of an allegation of use. No allegation of use was ever filed. The examining attorney maintained the descriptive refusal in a December 09, 2022, Final Office Action.

Applicant subsequently filed its Appeal Brief on May 6, 2023, arguing that its mark is not generic.

ISSUE ON APPEAL

The issue on appeal is whether the Applicant's applied-for mark is descriptive as proscribed under Trademark Act Section 2(e)(1). The trademark attorney notes that a generic refusal was never issued. The December 09, 2022, Final Office Action was a maintaining of the Trademark Act Section 2(e)(1) descriptiveness refusal. Applicant's May 6, 2023, brief solely argues that the applied for mark is not generic. This is the incorrect standard to apply as it addresses a refusal the examining attorney has not made. Applicant was merely informed in the May 8, 2022, Office Action and the December 09, 2022, Final Office Action that the applied for mark appeared to be generic, which was why a suggestion of proceeding under Trademark Act Section 2(f) or Supplemental Register could not be recommended.

ARGUMENT

1A) Summary of Applicable Law and Trademark Examining Attorney's Evidence with regard to whether the goods are registrable as contemplated by the Trademark Act

Section 2(e)(1)

Registration is refused because the applied-for mark merely describes a feature or characteristic of applicant's goods and/or services. Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1); *see* TMEP §§1209.01(b), 1209.03 *et seq.*

A mark is merely descriptive if it describes an ingredient, quality, characteristic, function, feature, purpose, or use of an applicant's goods and/or services. TMEP §1209.01(b); *see, e.g.*, *In re TriVita, Inc.*, 783 F.3d 872, 874, 114 USPQ2d 1574, 1575 (Fed. Cir. 2015) (quoting *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 1173, 71 USPQ2d 1370, 1371 (Fed. Cir. 2004)); *In re Steelbuilding.com*, 415 F.3d 1293, 1297, 75 USPQ2d 1420, 1421 (Fed. Cir. 2005) (citing *Estate of P.D. Beckwith, Inc. v. Comm'r of Patents*, 252 U.S. 538, 543 (1920)).

The determination of whether a mark is merely descriptive is made in relation to an applicant's goods and/or services, not in the abstract. *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 1254, 103 USPQ2d 1753, 1757 (Fed. Cir. 2012); *In re The Chamber of Commerce of the U.S.*, 675 F.3d 1297, 1300, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012); TMEP §1209.01(b). "Whether consumers could guess what the product [or service] is from consideration of the mark alone is not the test." *In re Am. Greetings Corp.*, 226 USPQ 365, 366 (TTAB 1985).

In the present case, applicant's goods are "piling sheets, of metal; sheet piles, of metal; profiled piling sections, of metal; connecting elements for sheet piles of metal, namely, metal sheet pile connectors in the nature of structural joint connectors; and metal connecting profiles and welding corners in the nature of structural joint connectors of metal for sheet piles of metal or plastic."

The wording "OZ" in the applied for mark describes the shape and form of sheet pile being a specific type of Z sheet pile. A Z-type sheet pile is called this because, "the single piles are shaped roughly like a horizontally stretched Z". *See evidence attached to 6/8/22 Office Action, TSDR pg. 7.* Next the "O" moniker is to indicate the piles are made of steel, a subcategory of the Z-type sheet pile. "OZ-type sheet pile is a combination of a steel tube and a Z-type sheet pile." *See evidence attached to 6/8/22 Office Action, TSDR pg. 15.* The evidence listed below demonstrates that "OZ" is a widely known and frequently used term in applicants industry describing the shape and form of applicant's applied for sheet pile goods. A term that describes the shape or form of a product is merely descriptive. *In re Metcal Inc.*, 1 USPQ2d 1334 (TTAB 1986) (holding SOLDER STRAP merely descriptive of self regulating heaters in the form of flexible bands or straps); *In re H.U.D.D.L.E.*, 216 USPQ 358 (TTAB

1982) (holding TOOBS merely descriptive of bathroom and kitchen fixtures in the shape of tubes).

Evidence of the relevant public's understanding of a term may be obtained from any competent source, including purchaser testimony, consumer surveys, dictionaries, research databases, Internet websites, newspapers, and other publications. *USPTO v. Booking.com B.V.*, 140 S. Ct. 2298, 2307 n.6, 2020 USPQ2d 10729, at *7 n.6 (2020); *Royal Crown Co. v. Coca-Cola Co.*, 892 F.3d 1358, 1366, 127 USPQ2d 1041, 1046 (Fed. Cir. 2016); TMEP §1209.01(c)(i); *see In re Consumer Prot. Firm PLLC*, 2021 USPQ2d 238, at *8-12 (TTAB 2021).

The evidence previously submitted by the trademark examining attorney to demonstrate that Applicant's applied-for mark is descriptive of the goods is as follows:

- Evidence from china-steelpiling.com discussing their "OZ sheet pile" products and the benefits and uses it provides. How they have "designed and supplied OZ sheet pile to projects in New Zealand, Antarctica, Afghanistan, Australia, Chile, China, Haiti, Kenya". This evidence demonstrates that competitors within applicant's sheet pile industry are using the term OZ to describe a specific type of sheet pile. *See evidence attached to 6/8/22 Office Action, TSDR pg. 4-6.*
- Evidence from jsteel.com.com discussing the specifications of their "OZ steel sheet piles" products. Going onto to state that their "OZ steel sheet piles are manufactured by ArcelorMittal's Oriental Sheet Piling factories in Malaysia and China". This evidence demonstrates that competitors within applicant's sheet pile industry are using the term OZ to describe a specific type of sheet pile. *See evidence attached to 6/8/22 Office Action, TSDR pg. 7-9.*
- Evidence from a retailer of applicant's applied for sheet pile goods, alibaba.com describing the sheet pile goods listed for sale as "OZ steel sheet piles". This evidence demonstrates that those within applicant's industry are using the term OZ to describe a specific type of sheet pile. *See evidence attached to 6/8/22 Office Action, TSDR pg. 10-11.*
- Evidence from sheet-piles.com discussing their "OZ steel pile" products and the benefits and uses it provides. This evidence demonstrates that competitors within applicant's sheet pile industry are using the term OZ to describe a specific type of sheet pile. *See evidence attached to 6/8/22 Office Action, TSDR pg. 12-14.*
- Evidence from reganindustrial.com blog post discussing the differences between types of sheet

piles. The blog post has a header directly discussing "OZ Type Sheet Pile" where it discusses how "OZ-type sheet pile is a combination of a steel tube and a Z-type sheet pile". This evidence demonstrates that those within applicant's industry are using the term OZ to describe a specific type of sheet pile. *See evidence attached to 6/8/22 Office Action, TSDR pg. 15-19.*

- Evidence from orientalsheetpiling.com discussing their "OZ series" of piling products and specifications. This evidence demonstrates that competitors within applicant's sheet pile industry are using the term OZ to describe a specific type of sheet pile. *See evidence attached to 12/9/22 Final Office Action, TSDR pg. 5-6.*
- Evidence from hiseamarine.com discussing their "OZ type steel sheet pile" products and the specifications and uses it provides. This evidence demonstrates that competitors within applicant's sheet pile industry are using the term OZ to describe a specific type of sheet pile. *See evidence attached to 12/9/22 Final Office Action, TSDR pg. 7-14.*
- Evidence from huaxinwx.com discussing their "OZ sheet piles" products, their specifications and the structural functions they fulfill. This evidence demonstrates that competitors within applicant's sheet pile industry are using the term OZ to describe a specific type of sheet pile. *See evidence attached to 12/9/22 Final Office Action, TSDR pg. 15-20.*
- Evidence from a retailer of applicant's applied for sheet pile goods, wxhy.com describing the sheet pile goods listed for sale as "OZ sheet pile". This evidence demonstrates that those within applicant's industry are using the term OZ to describe a specific type of sheet pile. *See evidence attached to 12/9/22 Final Office Action, TSDR pg. 21-23.*

In light of the extremely widespread use of "OZ" in the relevant sheet pile industry, Applicant cannot claim exclusive use of the wording. Two major reasons for not protecting descriptive marks are (1) to prevent the owner of a descriptive mark from inhibiting competition in the marketplace and (2) to avoid the possibility of costly infringement suits brought by the trademark or service mark owner. *In re Abcor Dev. Corp.*, 588 F.2d 811, 813, 200 USPQ 215, 217 (C.C.P.A. 1978); TMEP §1209. Businesses and competitors should be free to use descriptive language when describing their own goods and/or services to the public in advertising and marketing materials. *See In re Styleclick.com Inc.*, 58 USPQ2d 1523, 1527 (TTAB 2001).

In sum, the evidence of record demonstrates convincingly that the wording “OZ” in the applied-for

mark primarily describes a feature or characteristic of applicant's sheet pile goods, namely, the shape or form of these products.

1B) Response to Applicant's Argument and Rebuttal of Evidence

As a preliminary note, the arguments submitted by applicant in its Appeal Brief erroneously argue against a generic refusal which has not been made by the examining attorney. This is the incorrect standard to apply. The 6/8/22 Office Action and the 12/9/22 Office Action make only Trademark Act Section 2(e)(1) descriptive refusals with an advisory that applicant's mark also appears to be generic. Applicant makes no arguments in its Appeal Brief as to how its mark is not descriptive and focuses its entire brief on the moot issue of genericness. The examining attorney herein addresses any of applicant's arguments that could perceivable also be used to argue against a Trademark Act Section 2(e)(1) descriptive refusal.

Applicant begins its arguments by stating that "the common name for the good is sheet pile, steel sheet pile, or at most specific, Z piles". The examining attorney does not dispute that the goods are often referred to in these common names. However, as shown by the above evidence, "OZ" is used pervasively in applicant's industry to refer to a specific type of "sheet pile, steel sheet pile, or at most specific, Z piles" being a combination of a steel tube and a Z-type sheet pile. Just because there are other descriptive terms for applicant's goods, does not mean that the instant mark "OZ" is not descriptive. "A mark may be merely descriptive even if it does not describe the 'full scope and extent' of the applicant's goods or services." *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 1173, 71 USPQ2d 1370, 1371 (Fed. Cir. 2004) (citing *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 1346, 57 USPQ2d 1807, 1812 (Fed. Cir. 2001)); TMEP §1209.01(b). It is enough if a mark describes only one significant function, attribute, or property. *In re The Chamber of Commerce of the U.S.*, 675 F.3d 1297, 1300, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012); TMEP §1209.01(b); *see In re Oppedahl & Larson LLP*, 373 F.3d at 1173, 71 USPQ2d at 1371.

Applicant goes on to argue that the common name of the goods is "sheet pile" as it frequently appears in the examining attorney's evidence and thus the term OZ is not the common name of the good. This is the incorrect standard to apply. It is not necessary that "OZ" be the common name for

applied for goods. The term must merely describe an ingredient, quality, characteristic, function, feature, purpose, or use of an applicant's goods and/or services. TMEP §1209.01(b); *see, e.g.*, *In re TriVita, Inc.*, 783 F.3d 872, 874, 114 USPQ2d 1574, 1575 (Fed. Cir. 2015) (quoting *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 1173, 71 USPQ2d 1370, 1371 (Fed. Cir. 2004)); *In re Steelbuilding.com*, 415 F.3d 1293, 1297, 75 USPQ2d 1420, 1421 (Fed. Cir. 2005) (citing *Estate of P.D. Beckwith, Inc. v. Comm'r of Patents*, 252 U.S. 538, 543 (1920)). As the evidence clearly indicates, OZ does describe a type of sheet pile. The determination of whether a mark is merely descriptive is made in relation to an applicant's goods and/or services, not in the abstract. *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 1254, 103 USPQ2d 1753, 1757 (Fed. Cir. 2012); *In re The Chamber of Commerce of the U.S.*, 675 F.3d 1297, 1300, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012); TMEP §1209.01(b). "Whether consumers could guess what the product [or service] is from consideration of the mark alone is not the test." *In re Am. Greetings Corp.*, 226 USPQ 365, 366 (TTAB 1985).

Applicant next argues that its mark "OZ" is not generic because it fails the two-part inquiry used to determine whether a designation is generic. Applicant then goes on to argue how its mark is different from other marks held to be generic. These arguments are moot. The generic standard applied by applicant is the incorrect standard to apply to a descriptive refusal and has no applicability to the instant refusal.

CONCLUSION

For the foregoing reasons, the trademark examining attorney respectfully requests that the refusal to register the trademark "OZ" under Trademark Act Sections 2(e)(1) be affirmed.

Respectfully submitted,

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USPTO OFFICIAL NOTICE

Examining attorney's appeal brief has issued
on July 5, 2023 for
U.S. Trademark Application Serial No. 90900931

A USPTO examining attorney has issued an appeal brief. Follow the steps below.

(1) Read the appeal brief. This email is NOT the appeal brief.

(2) Submit reply brief within 20 days of July 5, 2023 , if you wish to do so. If submitted, a reply brief must be submitted using the Electronic System for Trademark Trials and Appeals (ESTTA) and received by the USPTO on or before 11:59 p.m. **Eastern Time** of the last day of the reply period.

(3) Direct questions about the appeal proceeding to the Trademark Trial and Appeal Board at 571-272-8500 or TTABInfo@uspto.gov.