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

Proceeding	91204081
Party	Defendant DealerCentric Solutions, Inc
Correspondence Address	J. MARK HOLLAND J. MARK HOLLAND & ASSOCIATES 3 SAN JOAQUIN PLZ STE 210 NEWPORT BEACH, CA 92660-5943 office@jmhlaw.com
Submission	Answer
Filer's Name	J. Mark Holland
Filer's e-mail	office@jmhlaw.com
Signature	/J. Mark Holland/
Date	04/09/2012
Attachments	Answer_to_Opposition_FINAL.pdf (4 pages)(102080 bytes)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of Serial No. 85/168,597 For the mark: DEALERCENTRIC Filing Date: November 03, 2010 International Classes: 9, 36, 42 DEALER DOT COM, INC. Opposer, v. DEALERCENTRIC SOLUTIONS, INC. Applicant.	Opposition No. 91204081 ANSWER TO OPPOSITION

Box Trademark Trial and Appeal Board
Assistant Commissioner for Trademarks
U.S. Patent & Trademark Office
P.O. Box 1451
Arlington, Virginia 22313-1451

Applicant DealerCentric Solutions, Inc. ("Applicant") hereby responds to the above-identified Opposition, in paragraphs numbered to correspond to those of the Opposition (except where Opposer misnumbered the last three paragraphs as repeats of "1, 2, and 3"):

1. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations of Paragraph 1, and therefore denies same.

2. Applicant admits that the information in Paragraph 2 accurately reflects the corresponding information that is attached as Exhibit A to the Opposition, and that Exhibit A appears to be a printout from the USPTO website regarding that same application. Otherwise, Applicant is without knowledge or information sufficient to

form a belief as to the truth of the allegations of Paragraph 2, and therefore denies same.

3. Admitted.

4. (misnumbered by Opposer as "1") Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations of Paragraph 4 ("1"), and therefore denies same.

5. (misnumbered by Opposer as "2") Applicant admits that the publicly available record on the USPTO website indicates that the Examining Attorney for Opposer's DEALER.COM application has refused registration based upon Applicant's DEALERCENTRIC application, as well on other bases (including approximately eight (8) other pending applications by third parties. Otherwise, Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations of Paragraph 5 ("2"), and therefore denies same.

6. (misnumbered by Opposer as "3") Applicant denies that Applicant's instant application should be refused registration, and otherwise is without knowledge or information sufficient to form a belief as to the truth of the allegations of Paragraph 6 ("3"), and therefore denies same.

Affirmative Defenses

1. Opposer's mark is generic and/or descriptive, and cannot be the basis for refusing Applicant's registration

Opposer selected a mark that consists of two generic and/or descriptive terms (DEALER and .COM) to which no one person can or should have exclusive rights. Having selected that mark (for whatever benefits Opposer perceived it to have), Opposer must also accept the limitations of that mark, as discussed below.

Opposer's mark (DEALER and .COM) is similar to the phrase SHREDDED WHEAT, which was denied protection in a seminal case on trademark genericity, Kellogg Co. v. National Biscuit Co., 305 U.S. 111 (1938). Kellogg had a direct impact on the structure of the Lanham Act (the main U.S. Trademark Law), is a common starting point for analysis in trademark opinions in lower courts, and has been called possibly "the Supreme Court's most versatile and influential trademark decision". G. Dinwoodie, The Story of Kellogg Co. v. National Biscuit Co: Breakfast with Brandeis, in Intellectual Property Stories (R. Dreyfuss & J. Ginsburg eds., 2005).

In Kellogg, the Supreme Court ruled that the Kellogg was not violating any trademark or unfair competition laws when it manufactured its own Shredded Wheat breakfast cereal,

which had originally been invented by the National Biscuit Company (later called Nabisco). Kellogg's version of the product was of an essentially identical shape, and was also marketed as "Shredded Wheat"; but Nabisco's patents had expired, and its trademark application for the term "Shredded Wheat" had been turned down as a descriptive, non-trademarkable term. Among other things, the Court held that:

> The plaintiff has no exclusive right to the use of the term 'Shredded Wheat' as a trade name [a trademark]. For that is the generic term of the article, which describes it with a fair degree of accuracy; and is the term by which the biscuit in pillow-shaped form is generally known by the public. Since the term is generic, the original maker of the product acquired no exclusive right to use it. As Kellogg Company had the right to make the article, it had, also, the right to use the term by which the public knows it. Kellogg, 305 U.S. 111, 116-7.

The Court dismissed a claim by Nabisco that Nabisco had spent millions of dollars advertising and had made millions of dollars of sales under its SHREDDED WHEAT trademark. The Court also noted Nabisco's argument that Kellogg had waited many years to use the words "Shredded Wheat," during which time Nabisco had been spending:

> "…more than $17,000,000 [in 1930's money] in making the name [Shredded Wheat] a household word and identifying the product with [Nabisco]. **Those facts are without legal significance. Kellogg Company's right was not one dependent upon diligent exercise. Like every other member of the public, [Kellogg] was, and remained, free to make shredded wheat when it chose to do so; and to call the product by its generic name**. The only obligation resting upon Kellogg Company was to identify its own product lest it be mistaken for that of the plaintiff." Kellogg, 305 U.S. 111, 119 (emphasis added).

Just as with the generic words SHREDDED WHEAT, competitors trying to serve automobile dealers have adopted, and should be able to continue to adopt, trademarks that include the generic word DEALER within their own trademarks. Apparently, this is what many others (in addition to Applicant) have done - examples include the multiple other applications on which Opposer's pending application for DEALER.COM has been refused.

WHEREFORE, Applicant respectfully prays that pending application U.S. Serial No. 85/168,597 for DEALERCENTRIC be allowed, and that this Opposition be denied.

Respectfully submitted,

Dated: 2012/04/09

/J. Mark Holland/

J. Mark Holland
J. MARK HOLLAND & ASSOCIATES
Attorney for Applicant DEALERCENTRIC SOLUTIONS, INC.

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