

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Mark: GERBER RESERVE
Serial No.: 88/641,422
Filing Date: October 3, 2019
Applicant: Fiskars Brands, Inc.
Examining Attorney: Cassondra Anderson, Law Office 103

RESPONSE TO OFFICE ACTION

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

Commissioner:

This communication responds to the Office Action issued on November 21, 2019, concerning the above-referenced intent-to-use application (the “**Application**”).

REMARKS

The Examining Attorney refused registration of the GERBER RESERVE mark (the “**Applied-For Mark**”) in Class 8 for the following goods:

- Class 8: Sport knives; hunting knives; fixed blade knives; fishing knives; filleting knives; folding knives; pocket knives; hand-operated knife to aid in skinning an animal; side arms, not including firearms, namely, hunting knives; working knives; blades for any of the foregoing knives; and knife sheaths

(the “**Applied-For Goods**”). The Examining Attorney alleges that the Applied-For Mark is primarily merely a surname and not entitled to registration on the Principal Register. Applicant respectfully disagrees with the Examining Attorney and asserts that the Applied-For Mark is entitled to registration on the Principal Register. Applicant’s arguments and response in support of its position follow.

AMENDMENT

The Examining Attorney alleges that the GERBER component in the Applied-For Mark will be perceived as primarily merely a surname, making the Applied-For Mark as a whole not entitled to registration. As part of its response, Applicant is amending the Application to claim acquired distinctiveness in part as to the GERBER component in the Applied-For Mark based on Applicant's ownership of active US registrations for, and more than five years use of, the GERBER mark with the same, similar, or related goods. Applicant is filing the amendment on the electronic response form submitted simultaneously herewith.

PRIMARILY MERELY A SURNAME

I. GERBER in the Applied-For Mark Has Acquired Distinctiveness Based on Applicant's Ownership of Active US Registrations for, and More than Five Years Use of, the GERBER Mark.

A mark that is allegedly primarily merely a surname may be registered on the Principal Register upon a showing of acquired distinctiveness. 15 U.S.C. § 1052(f). Acquired distinctiveness claims are generally limited to marks in use-based applications. *See* TMEP § 1212.09(a). However, marks in an intent-to-use application may also claim acquired distinctiveness in certain circumstances. *Id.* The specific test as set out by the Trademark Trial and Appeal Board is as follows: an intent-to-use applicant must prove (1) acquired distinctiveness of the same mark in connection with other goods and services with which the mark is in use in commerce by appropriate evidence, such as the "ownership of an active prior registration for the same mark for sufficiently similar or related goods or services" and "five years' use of the same mark with related goods or services." *Id.* The intent-to-use applicant must also prove that (2) the goods or services with which there is an intent-to-use the mark are sufficiently related such that there is a high likelihood that the distinctiveness will transfer. *Id.*

Acquired distinctiveness claims may also apply to a portion of a mark, and the standards for establishing acquired distinctiveness are the same regardless of whether the claim applies to the entire mark or a portion of it. *Id.* at § 1212.02(f)(i).

Applicant owns at least the 5 prior, active US registrations on the Principal Register detailed in the chart below for the GERBER mark, some of which are based on a claim of acquired distinctiveness. These registrations are hereinafter collectively referred to as the “**Prior Registrations**,” and USPTO records evidencing them are attached hereto as **Exhibit A**.

<u>Mark</u>	<u>Reg. No. & Reg. Date</u>	<u>Goods & Class</u>	<u>First-Use in Commerce</u>
GERBER	0512677 July 26, 1949	Class 6: kitchen cutlery, namely, boning knives	December 1940
GERBER	1745540 January 12, 1993	Class 8: kitchen and table cutlery; namely, steak knives, chef knives, butcher knives, bread knives, utility knives, peeling knives, paring knives, boning knives, filleting knives, slicing knives, knife sharpening steels; hunting, survival, and sports knives, and scissors; sheaths and manually operated sharpeners for knives and scissors.	January 1973
GERBER	2955051 May 24, 2005	Class 8: Hand tools, namely spades, axes, hand saws, and hatchets Class 11: flashlights and key chain flashlights	January 1999 for Class 8 April 2004 for Class 11
GERBER & Design	4481628 Feb 11, 2014	Class 8: Multi-function hand tools comprising all, or a combination of a knife blade, pliers, screwdrivers, bottle opener, can opener, scissors, wire cutter, file, saw blade, nail puller, wire stripper, ruler; sport knives, hunting knives, fishing knives and camping knives; hand tools, namely, spades, shovels, axes, hand saws, hatchets, pruners, machetes, wire cutters, scissors, knife sharpeners; and sheaths for knives and multi-function hand tools. Class 11: Flashlights; tactical flashlights; keychain flashlights; red LED flashlights for illumination	Sept 2011 for all Classes

		purposes; outdoor portable lighting products, namely, headlamps Class 13: Gun cleaning kits comprising wiping rods, cleaning patches, cleaning solution, cleaning brushes, scraper, cleaning picks, lubricant, flashlight, and multi-function hand tool having pliers, knife blade, screwdrivers, can opener, scissors, wire cutter, file, and wire stripper.	
GERBER	2279229 Sept 21, 1999	Class 8: multi-function hand tools comprising all, or a combination of the following, blunt nose pliers, screwdrivers, bottle openers, lanyard rings, and drop point blades.	January 1992

Applicant’s ownership of the Prior Registrations and continuous use of the GERBER mark for more than five years, as evidenced in the Prior Registrations, is sufficient to establish that the GERBER component in the Applied-For Mark has acquired distinctiveness under the above-described test.

As for the first prong of the test, the GERBER component in the Applied-For Mark and the previously registered GERBER marks in the Prior Registrations are undoubtedly the “same mark” because they are *identical* and create the *exact same* commercial impression. *See Id.* at § 1212.04(b).

As for prong (2) of the test, Applicant must show that the goods in the intent-to-use application are sufficiently similar or related to the goods for which the relevant portion of the mark already has distinctiveness, and that there is a strong likelihood that the distinctiveness will transfer. TMEP § 1212.09(a). The showing necessary to satisfy this element will vary case-by-case, and there is no absolute rule that Applicant must submit extrinsic evidence to support its case. *Id.* The language used to identify the services in the application can be sufficient. *See id.*; *Kellogg Co. v. Gen. Mills, Inc.*, 82 USPQ2d 1766, 1771 (TTAB 2007) (deeming close relationship between cereal and food bars derived from cereal "self evident from the respective

identifications of goods"). In this case, at least some of the Applied-For Goods are *exactly the same* as the goods covered by the Prior Registrations, as illustrated by the chart below. If distinctiveness can transfer between goods that are sufficiently similar or related, then it is axiomatic that distinctiveness can transfer here between goods that are exactly the same.

<u>Side-By-Side Comparison Between Some of the Applied-For Goods and the Prior Registrations</u>	
Applied-For Goods	Prior Registrations
1. Sport knives; 2. hunting knives; 3. fishing knives; 4. filleting knives; 5. knife sheath	1. sports knives 2. hunting knives 3. fishing knives 4. fileting knives 5. sheaths for knives

As for the other Applied-For Goods, they are undoubtedly sufficiently similar or related to the goods covered by the Prior Registrations such that distinctiveness will transfer. For example “fixed blade knives,” “folding knives,” “pocket knives,” “working knives,” and “hand-operated knife to aid in the skinning of an animal” may also be used in connection with at least the outdoors, camping, hunting, and fishing, making them at least highly similar or related to the sporting, hunting, and fishing knives covered by the Prior Registrations. And of course, the knife blades covered by the Application are similar or related to the various knives in the Prior Registrations because knife blades are used with knives.

In view of the above, Applicant submits that the GERBER component in the Applied-For Mark has acquired distinctiveness as evidenced by Applicant’s active prior US registrations for, and more than five years use of, the identical GERBER mark for identical, similar, or related goods, which will transfer to the GERBER component in the Applied-For Mark. Applicant

respectfully believes that this entitles the Applied-For Mark as a whole to registration on the Principal Register.

DISCLAIMER

The Examiner asserts that the term RESERVE is generic or descriptive in relation to the goods and therefore must be disclaimed. Applicant respectfully disagrees with the Examiner's assertion that RESERVE is generic or descriptive in relation to the goods, but in an effort to economically conclude prosecution, Applicant agrees to disclaim the exclusive right to use "RESERVE" apart from the Applied-For Mark as a whole and is entering the disclaimer on the electronic response form submitted herewith.

CONCLUSION

Applicant believes it has responded to all issues raised in the Office Action and respectfully requests that the Examining Attorney withdraw the refusal and allow the Application to proceed. Should any questions arise regarding the application or the issues addressed herein, please contact the undersigned.

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Respectfully submitted,
FOLEY & LARDNER LLP

Date: January 8, 2010

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