

In response to the Office Action issued October 8, 2019 regarding Applicant’s U.S. Application Serial No. 88/275,183 for the METAL REMOVAL mark (“Applicant’s Mark”), Applicant respectfully submits the following arguments to address the Trademark Examining Attorney’s refusal of Class 7 based on an allegation that Applicant’s Mark generic.

In the Office Action, the Trademark Examining Attorney contends that the “applied-for mark is refused because the applied-for mark is generic for applicant’s goods.” Applicant respectfully disagrees with the Trademark Examining Attorney’s refusal because industrial consumers identify Applicant’s Mark as a brand name, and not a generic term. Further, Applicant is providing additional evidence that the relevant public understands that Applicant’s Mark is associated with Applicant’s goods.

The Goods Offered in Connection with Applicant’s Mark

By this Response, Applicant seeks to amend the description of the goods in its application to better clarify Applicant’s goods offered in connection with Applicant’s Mark, specifically, as follows:

Class 007: power operated ~~tools, namely,~~ end mills, burs being carbide tools, drills, routers and countersinks, all for industrial use

Applicant has herewith amended the description of goods to identify the class of consumer for Applicant’s goods.

Applicant’s Mark is Used and Registered Throughout the World

Applicant has made substantial exclusive and continuous use of the METAL REMOVAL mark throughout the world since at least as early as 1970. Applicant previously submitted advertising and catalogs associated with Applicant’s Mark. Applicant has sold a substantial amount of METAL REMOVAL branded tools and a table providing Applicant’s sales revenue for METAL REMOVAL branded tools is provided below.

Location	2017	2018	2019	YTD Feb. 2020
United States	\$2,960,533	\$1,928,604	\$1,385,083	\$770,733
Total Worldwide	\$4,366,199	\$3,504,533	\$2,636,586	\$1,701,498

Based on Applicant's significant sales figures for its METAL REMOVAL branded tools, the relevant public clearly understands that Applicant's Mark is associated with Applicant's goods, not to the class or genus of goods to which the identified goods belong.

Furthermore, Applicant has registrations for its METAL REMOVAL mark in the following jurisdictions throughout the world:

- Canada – Registration No. 733675
- Mexico – Registration No. 01198501735
- Germany – Registration No. DE2066345
- Italy – Registration No. 1524200
- Brazil – Registration No. 916824632
- France – Registration No. 93476974

Applicant's significant sales of its METAL REMOVAL branded end mills, burs being carbide tools, drills, routers and countersinks and Applicant's trademark registrations throughout the world for its METAL REMOVAL mark provide clear evidence that industrial consumers identify Applicant's Mark as a source identifier for Applicant's goods.

Applicant's Mark is Not Generic

A mark is a generic name if it refers to the class or category of goods and/or services on or in connection with which it is used. *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 57 USPQ2d 1807 (Fed. Cir. 2001). The test for determining whether a mark is generic is its primary significance to the relevant public. Section 14(3) of the Trademark Act; *In re American Fertility Society*, 188 F.3d 1341, 51 USPQ2d 1832 (Fed. Cir. 1999); *Magic Wand Inc. v. RDB Inc.*, 940 F.2d 638, 19 USPQ2d 1551 (Fed. Cir. 1991).

The first step of this test is determining the category or class of the goods or services at issue. *H. Marvin Ginn Corp. v. Int'l Ass'n of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528, 530 (Fed. Cir. 1986). In this case, the class of goods at issue are power end mills, burs being carbide tools, drills, routers and countersinks, all for industrial use. The second step is to determine whether the term sought to be registered is understood by the relevant public primarily to refer to the genus of goods. *Id.* The critical issue is to determine whether the record shows that members of the relevant public primarily use or understand the term sought to be registered to refer to the

category or class of goods. *Id.*; *In re Women's Publishing Co. Inc.*, 23 USPQ2d 1876, 1877 (TTAB 1992). Evidence of the relevant public's understanding of a term may be obtained from any competent source, including testimony, surveys, dictionaries, trade journals, newspapers, and other publications. *See In re Northland Aluminum Products, Inc.*, 777 F.2d 1556, 227 USPQ 961 (Fed. Cir. 1985).

Applicant's Mark is Not Used to Refer to the Genus of Goods at Issue Defined by the Examiner

The Examining Attorney argues that METAL REMOVAL is generic the relevant public would understand this designation to refer primarily to the genus of the goods because metal removal is a type or category of tool. Such a determination is again counter to the relevant two-part test for genericness. The Examining Attorney defines the genus at issue as “power operated tools, namely, end mills, burs being carbide tools, drills, routers and countersinks”, this genus includes power operated tools that may be used to cut a variety of materials, including wood, composites, earth materials, glass, metal or the like. The fact that power operated tools may be used to cut metal may render the term METAL REMOVAL descriptive of a characteristic of Applicant's goods, but it is not generic for power operated tools in general, and certainly not for end mills, burs being carbide tools, drills, routers and countersinks that may be used in a variety of cutting operations for a variety of materials.

Relevant Public's Understanding of Applicant's Mark

In applying the second step of the test, the Examining Attorney asserts that the relevant public would understand Applicant's mark to refer primarily to the class or genus of goods to which the identified goods belong. To reach this result, the Examining Attorney narrows the genus of goods to reflect a single use that is descriptive of one characteristic of Applicant's goods. The Examining Attorney properly established the genus at issue as “power operated tools, namely, end mills, burs being carbide tools, drills, routers and countersinks”, but then improperly created a subclass of “tools for removing metals”. It is well-established that creating a narrow subclass of a genus is improper. *In Re Bos. Beer Co. L.P.*, 47 U.S.P.Q.2d 1914 (T.T.A.B. 1998); *In re Steelbuilding.com*, 415 F.3d 1293, 1298 (Fed. Cir. 2005). The genus or category of goods is stated in the description of goods: “power operated tools, namely, end mills, burs being carbide tools, drills, routers and countersinks”, not “tools for removing metals” as used by the Examining Attorney for the second part of the test. The relevant public who purchase power operated tools

know that “power operated tools” may be used for a wide variety of cutting operations for a wide variety of materials. Accordingly, the evidence cited by the Examining Attorney establishes that Applicant’s Mark is, at most, descriptive of one possible characteristic of Applicant’s goods.

The Burden of Proof for Genericness Has Not Been Established

It must be established by clear evidence that a mark is generic and, thus, unregistrable. *In re Merrill Lynch, Pierce, Fenner and Smith, Inc.*, 828 F.2d 1567, 4 USPQ2d 1141 (Fed. Cir. 1987). “Doubt on the issue of genericness is resolved in favor of the applicant.” *In re DNI Holdings Ltd.*, 77 USPQ2d 1435, 1437 (TTAB 2005). The Federal Circuit has drawn a clear distinction between an apt name and a generic one: “AMERICAN BAR ASSOCIATE is certainly an apt name for a national association for lawyers; however, it is not used as a generic name for national associations of lawyers.” *In re American Fertility Society*, 188 F.3d 1341, 51 USPQ2d 1832 (Fed. Cir. 1999).

In this case, the Examining Attorney’s cited evidence fails to include a single instance of the designation METAL REMOVAL being used as the name for a class of power operated tools. In addition, the Examining Attorney did not cite any third party registrations which incorporate the terms METAL and/or REMOVAL in which such terms are disclaimed. Thus, the Examining Attorney’s evidence suggests that METAL REMOVAL is an apt name for power operated tools that may be used with metal workpieces, but not that Applicant’s Mark is generic for the recited goods. In further support of the position that Applicant’s Mark is not generic for its recited goods, but rather has acquired distinctiveness, Applicant submits that it has been providing its products under its METAL REMOVAL brand continuously since at least as early as 1970 with substantial sales in the United States and throughout the world. In support thereof, Applicant has previously submitted its catalogs from 1995, 2003 and 2005 which demonstrate Applicant’s use of METAL REMOVAL mark in connection with power operated tools. The pages of the catalogs clearly demonstrate that class of goods are power operated tools, and that the relevant public understands that METAL REMOVAL identifies Applicant as the source of the products sold under the METAL REMOVAL mark. Furthermore, Applicant’s previously submitted website clearly shows METAL REMOVAL listed as one of Applicant’s brands, the website further provides contact information for METAL REMOVAL distributors, and the website lists METAL REMOVAL branded power operated tools. Applicant’s continuous past and current

use of the METAL REMOVAL mark support the position that Applicant's Mark is not generic for its recited goods, but rather has acquired distinctiveness.

The Examining Attorney's Attached Evidence Confirms that Applicant's Mark is Descriptive

As previously discussed herein, the evidence cited by the Examining Attorney does not show that the designation is used or understood as the name for a class of such products. *In Re Bos. Beer Co. L.P.*, 47 U.S.P.Q.2d 1914. Rather, the evidence confirms that Applicant's Mark is descriptive of a characteristic of Applicant's goods. The Examining Attorney assertion that Applicant's own website uses Applicant's Mark generically is incorrect. Applicant's website does not refer to a class of "power operated end mills, burs being carbide tools, drills, routers and countersinks" as "metal removal", instead "metal removal rate" and "maximum metal removal" are used to describe the rate at which material and the amount of material that may be removed from a workpiece. Accordingly, Applicant's website confirms that METAL REMOVAL is an apt name for power operated tools that may be used with metal workpieces, but not that Applicant's Mark is generic for the recited goods.

The additional evidence cited by the Examining Attorney does not show that the designation is used or understood as the name for a class of such products. For example, Brook Cutting Tools lists solid carbide end mills, Applicant notes that a "Metal Removal" is not a name or type of tool listed, instead it lists different types of end mills. Applicant further notes that Brook Cutting Tools uses "metal removal rate" to describe the rate at which material may be removed from a workpiece by end mills. Similarly, there is no evidence on Champion that the relevant purchasing public refers to a class of "power operated tools" as "metal removal", instead "general metal removal work" is used to describe one of the many capabilities of the radius bur. Garr Tool additionally does not use "Metal Removal" as a name or type of tool, instead "metal removal rate" to describe the rate at which material may be removed from a workpiece by end mill. Furthermore, Mid Iowa Tools does not use "Metal Removal" for a name or type of tool, instead it refers to "metal removal applications" as a descriptive of one possible use for the class of products listed. Mid Iowa Tools uses end mills, shell mills, face mills, slotting cutters, form milling cutters, indexable drills, solid carbide, adaptations, taps and indexable inserts as the class or genus of goods. OSG Tool additionally does not use "Metal Removal" as a name or type of tool, instead "metal removal rate" to describe the rate at which material may be removed from a

workpiece by end mill. Summers Industrial does not use “Metal Removal” for a name or type of tool, instead it refers to “Cut, Saw, & Metal Removal” to describe one possible uses for the class of their drill bits, tap & die sets, end mills, countersinks, reamers, carbide cutting tools, saws, and routers.

Accordingly, the additional evidence cited by the Examining Attorney confirms that the relevant public understands that “end mills, burs being carbide tools, drills, routers and countersinks” are words naming types of power operated tools. In addition, the evidence cited by the Examining Attorney supports Applicant’s position that Applicant’s Mark is not used or understood by the relevant public as the name for a class of end mills, burs being carbide tools, drills, routers and countersinks.

Conclusion

In view of Applicant's arguments presented herein, it is submitted that Applicant’s Mark does not refer to a class or category of goods in connection with which it is used. Furthermore, the substantial doubt that arises from the Examining Attorney’s cited evidence and the Applicant’s continuous use of Applicant’s Mark for at least 48 years must be resolved in Applicant’s favor. Accordingly, withdrawal of the Generic Refusal and allowance of this Application are respectfully requested. If a telephone call will assist in the prosecution of this Application, the Examining Attorney is invited to call 412-694-7285.