

THE UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark: EWHEELS
Serial No.: 87/115,280
Filing Date: July 25, 2016
Atty. Docket No.: 6372-T2

Examining Attorney: Tina L. Snapp
Law Office: 116

RESPONSE TO OFFICE ACTION

Commissioner For Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

Dear Commissioner:

This is in response to the Office Action mailed November 10, 2016. This response is subject to a reply period of 6 months, up to and including May 10, 2017, and is therefore considered timely filed.

The application has been refused registration on the basis that the mark is merely descriptive, pursuant to 15 U.S.C. § 1052(e)(1). Regardless of whether the mark actually is merely descriptive, the mark has acquired distinctiveness through significant and lengthy use over five years, as well as through industry penetration and widespread acceptance as a source indicator of Applicant's services. *See* 15 U.S.C. § 1052(f). Applicant here submits evidence regarding the acquired distinctiveness of the mark.

A. The Mark Has Been Used For Seven Years

The trademark has been used since at January 2010, now over seven years, which is well over the minimum five years of use generally required of descriptive marks. *See* Rubin Declaration, attached, ¶1. Five years of continuous use is considered sufficient evidence that a mark has acquired distinctiveness. *See* 15 U.S.C. § 1052(f) ("The 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."). Here, the mark has been used for two years more than this minimum. This, combined with the nature and extent of recognition of the mark across the United States, shows that the mark has become distinctive for the applied-for services.

B. The Goods with Which the Mark is Use Have Been Well Advertised

During this lengthy use of the mark, industry penetration has been substantial. Applicant has dealers and customers from all over the United States. This is, in part, due to Applicant's advertising provided under its trademark. The products provided under the trademark have been advertised through print and online media since 2010. Examples of online advertisements, in the form of Applicant's website, are provided in Exhibit 1. That exhibit shows screenshots of Applicant's website for the last eight years of use. The year the website was displayed is written at the top of each screenshot. The website has consistently displayed the EWHEELS logo and name, and has also provided information about how to purchase the goods offered under the trademark since 2010. In addition, dealers participate in an advertising program and each year spend over \$1,000,000 collectively in advertising campaigns. *See* Rubin Declaration, ¶3.

C. Applicant has Developed a Large Dealer Network

Through a very large online and brick-and-mortar dealer and retailer network, Applicant's products have been advertised and sold extensively throughout the US. This has further contributed to the market penetration and recognition by the public of the association among the mark, the Applicant, and the goods.

In addition to the consistent use and advertisement of the trademark on Applicant's website, Applicant advertises and sells through a variety of catalogs. Applicant's scooters, bearing the applied-for trademark, are advertised and sold in virtually every senior product catalog in the US, including Gold Violin, SpinLife, Support Plus, and Hammacher Schlemmer. Approximately 500,000 catalog copies are mailed each month containing Applicant's scooters and Applicant's mark. *See* Rubin Declaration, ¶4.

Parallel to these mail catalogs are online catalogs. Attached as Exhibit 2 are screenshots taken of the online sales catalogs for Gold Violin, SpinLife, Support Plus, and Hammacher Schlemmer. In each one, the Applicant's mark is either featured prominently in the item listing or on the scooter in the photograph. The marks are either highlighted in yellow or called out with red arrows.

Applicant also sells its products through over 800 more traditional e-commerce and medical retail websites. Attached Exhibit 3 includes screenshots of Applicant's goods sold under the applied-for

trademark at Walmart.com, Sears.com, Jet.com, Amazon.com, Ebay.com, Campingworld.com, CareMotion.com, ParentGiving.com, ProgressMobility.com, SaferWholesale.com, and MedMart.com.

Beyond online sales, Applicant has a large network of brick-and-mortar dealers. For the past three years, Applicant has added roughly 100 new dealers, and now has over 700 approved EWheels dealers in the US. *See* Rubin Declaration, ¶5. EWheels products are sold in over 400 Camping World stores across the US alone. *See* Rubin Declaration, ¶6. Dealers sell EWheels scooters and products directly to consumers. The scooters are not covered by insurance, Medicare, or Medicaid, and so customers purchase EWheels products at their own full expense from the dealers based on the design, performance, and name brand recognition.

D. Applicant has Participated in the Major Medical Trade Show for the Past Three Years

Each year since 2014, Applicant has participated in the MedTrade convention, the premiere home medical equipment conference and expo in the US. It has over 100,000 year attendees each year. Applicant hosts a very large booth with many of its scooter products on display. Attached Exhibit 4 illustrates some of the contracts for exhibitor space at those conventions (some information is redacted). As can be seen, in 2015, \$10,300 in exhibitor products were purchased, in 2016 almost \$14,000 in products were purchased, and for the 2017 show, over \$7,000 in products were purchased.

E. Sales Have Increased Steadily Each Year

Through the above-described activities, Applicant has seen tremendous growth and sales activity. Since 2010, over 30,000 scooter units have been sold, totaling over \$45,000,000 in revenue. In 2014, sales figures were \$3,724,025. In 2015, sales figures were \$5,807,000. In 2016, sales figures were \$11,631,774. Sales figures are forecast and on track for \$16,500,000 for 2017. *See* Rubin Declaration, ¶7. This is 400% growth in four years, and indicates that Applicant's products have gained strong traction in the home medical equipment market.

F. The Relevant Industry Exclusively Associates The Mark With Its Source

Within the medical equipment community, experts recognize and uniquely associate the mark, the Applicant, and the products Applicant provides under the mark. They attest to Applicant's

significance, leadership, and exclusivity, and also acknowledge the exclusive source-indicating function of the mark with respect to Applicant's products. They further note that customers appreciate the source-indicating function of the trademark. Advertising, quality, and performance have contributed to the recognition that EWHEELS has garnered in the mobility scooter and home medical equipment field.

The declarations attached in Exhibit 5 all state that the mark is directly and uniquely associated with the Applicant and the products provided under Applicant's mark. The declarations are from entities across the United States, including California, Nevada, Arizona, and Florida. Several of them have more than 15 years of retail experience in this industry. These individuals know the senior care industry both broadly and deeply.

The declarations further attest that customers frequently ask for EWHEELS products by name, indicating that consumers associate the trademark with a particular set of products from a particular source.

From the declarations and statements of these individuals, it is clear that the term EWHEELS has acquired distinctiveness within the industry and that it singularly, exclusively, and strongly indicates Applicant as the source of the products. Applicant submits that the evidence of recognition of the mark should be given great weight.

G. Identification of Goods

In the TEAS electronic response with which this is filed, the identification of goods is amended. Applicant amends the identification to: "Mobility scooters, electric scooters, electric bikes, and electric transport vehicles."

H. Earlier-Filed Pending Application

In the Office Action, pending U.S. Trademark App. No. 86/929,141 was identified as a potential basis for a refusal. That application has been abandoned and not revived. As such, Applicant submits that it is moot with respect to the registrability of this application.

I. Summary

Applicant believes the above explanations and the attached evidence reflect what is clearly known and unquestioned in the relevant industry: that EWHEELS has acquired distinctiveness for the goods provided by Applicant. Examiner's thorough and thoughtful consideration of this response is sincerely appreciated, and Applicant respectfully requests that Examiner withdraw the descriptiveness refusal. Should there be any questions or issues regarding this response, Examiner is invited to contact the undersigned attorney to address and resolve those questions or issues.

Respectfully submitted,

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May 9, 2017
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