

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: JOPO GRIPS INCORPORATED

Serial No.: 87930284

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Mark: TWIST & DESIGN

Class: 28

Atty. Docket No.: PEJE0104TUS

Examining Attorney: Nelson B. Snyder III/ Law Office 107

RESPONSE TO OFFICIAL ACTION

The Applicant, JOPO GRIPS INCORPORATED, files this document in response to the Examiner's Office Action, dated September 19, 2018. The Applicant respectfully submits the following response and arguments in response.

A. Request for Amendment of the Identification of Goods

In accordance with the Examiner's request, the Applicant requests an amendment to enter the recommended clarification of goods as follows:

“Interchangeable thumb and finger grip inserts specially adapted for use with bowling ball thumb and finger holes” in International Class 28.

This is an appropriate clarification, and not an expansion of the original goods. As such, it is proper under 37 C.F.R. Section 2.7(a); TMEP Section 1402.

B. Amendment to Submit Substitute Drawing Page

Per the Examiner’s request, the Applicant submits with this response a Substitute Drawing page which complies with the request to remove the scanning lines on each side of the original drawing, since those lines are not part of the mark. The Substitute Drawing page complies with the requirements of TMEP Section 807 and TMEP Sections 807.04 and 808.01-2.

C. Request For Withdrawal of § 2(e)(1) Refusal

The Applicant submits that its mark TWIST & DESIGN can function as a trademark for its goods, and that the applied for mark is not “merely descriptive” of the designated goods, namely “Interchangeable thumb and finger grip inserts specially adapted for use with bowling ball thumb and finger holes.”

1. The Mark Does Not Merely Describe the Goods/Services with Particularity

Applicant’s mark “TWIST & DESIGN” does not merely describe Applicant’s thumb and finger grip inserts for bowling balls. A term or phrase is descriptive if it *immediately* describes a significant attribute of the goods or services in question. *See, In re Bright-Crest, Ltd.*, 204 U.S.P.Q. 591, 593 (TTAB 1979). It is unlikely that consumers would *immediately* know the nature of the applicant’s goods by the mark alone.

Applicant's mark requires thought, imagination, or perception to reach a conclusion as to the nature of Applicant's services. *See In re Hester Industries, Inc.*, 230 U.S.P.Q. 797, 798 (TTAB 1986). Here, the Applicant sells thumb and finger grip inserts for bowling balls under the mark. The proposed mark requires imagination and thought, and it is at most suggestive of the exact nature of the designated goods. *See, in re Tennis In The Round, Inc.*, 199 U.S.P.Q. 496,498 (TTAB 1978).

The law provides that in refusing registration of a mark as "merely descriptive," the Examining Attorney must find more than simply some connection between the mark and the services. The mark must literally, and with particularity, "describe" the services, as noted in *In re Colonial Stores, Inc.*, 157 U.S.P.Q. 382 (CCPA 1968) and *In re Quik-Print Copy Shops, Inc.*, 205 U.S.P.Q. 505, n.7 (CCPA 1980) ("merely" in "merely descriptive" means "only.")

The Trademark Trial and Appeal Board has consistently reversed the decisions of examining attorneys who refuse registration under Section 2(e)(1) in the absence of actual evidence linking the recognized meaning of the mark sought to be registered to the goods of the Applicant. *See, e.g., In re Intelligent Medical Systems Inc.*, 5 U.S.P.Q.2d 1674 (TTAB 1987) (reversing examining attorney's refusal to register "INTELLIGENT MEDICAL SYSTEMS").

The Examiner has indicated that the mark is not registrable because the inner portion of the grip insert is threaded to assist in the installation of the grip into custom drilled thumb or finger holes of a bowling ball. This does not make the mark TWIST & DESIGN "merely descriptive" of a thumb or finger grip insert for a bowling ball. When the bowler uses the installed grip insert, the product is stationary.

Even according to the definitions provided by the Examiner in the Oxford Dictionary, there are multiple alternate definitions of the term TWIST in the Oxford Dictionary, which include, inter alia:

- To form into a bent, curling or distorted shape
- To move one's body so that the shoulders and hips are facing in different directions
- To move in a wriggling or writhing fashion
- To injure (a joint) by wrenching it
- To distort or misrepresent the meaning of (words)
- To take or have a winding course
- To dance with a twisting movement
- A dance
- A paper packet with twisted ends
- A swindle
- A curled piece of citrus (like a twist of lemon or orange)
- A distorted shape
- And others

Specifically, the Board has held that a mark is registrable if it is broad and does not describe the goods or services with particularity. In a similar case, the mark THE MONEY SERVICE was found *suggestive* of financial services pertaining to the transfer of funds from remote location. Although, the mark suggested some form of monetary service, it did not “merely describe” applicant’s actual services with sufficient particularity. As the Board explained:

[the mark] suggests a number of things, but yet *falls short of describing Applicant’s services in any one degree of particularity*. To effect a readily understood connection between the Applicant’s mark and its services requires the actual or prospective customer to use thought, imagination and perhaps an exercise in extrapolation.

In re TMS Corp. of the Americas, 200 U.S.P.Q. 57, 59 (TTAB 1978) (emphasis added).

Consequently, the Board viewed the mark THE MONEY SERVICE as suggestive, rather than “impermissibly descriptive.”

Likewise, in the decision *In re Hester Industries, Inc.*, 230 U.S.P.Q. 797, 798 (TTAB 1986), the Board held that “THIGHSTIX” was suggestive when used in connection with shaped poultry thigh meat portions, and should be registered as part of the mark “DIXIE THIGHSTIX” without a disclaimer:

In this case, while the word “thigh” may describe a principal ingredient of the goods, we believe the term “stix” on this record is at most suggestive with regard to these goods and the combination, viewed as a whole, is more a suggestive term than a descriptive one.

In re Hester Industries, Inc., 230 U.S.P.Q. 797, 798 (TTAB 1986).

Furthermore, as in *In re Diet Tabs*, 231 U.S.P.Q. 587 (TTAB 1986), the Board reversed the decision of the Examining Attorney finding that the mark “DIET TABS” was at most suggestive when used in connection with vitamin-supplement tablets. In reaching its decision, the Board noted that the mark was open to numerous interpretations as to its precise meaning and thus did not describe the goods with the degree of particularity required for refusing registration under Section 2(e)(1).

Even though a mark may suggest something about the goods or services, the determining question is whether the mark is just as likely to conjure up some other suggestive connotation. The Court of Customs and Patent Appeals reversed a refusal to register the composite mark “SUGAR & SPICE” for bakery products:

. . . the terms “sugar” and “spice” used individually are well understood by the purchasing public. However, when combined and used on bakery goods, we think they may function as an indication of more than a mere description of the ingredients of the goods on which the mark is used, and, on the record made below, are not “merely descriptive” of such goods within the meaning of Section 2. On the record below, the mark clearly does not tell the potential purchasers only what the goods are, their function, their characteristics of their use, or of prime concern here, their ingredients.

In re Colonial Stores, Inc., 157 U.S.P.Q. 382, 385 (CCPA 1968).

In accord with these cases is *In re The House Store, Ltd.*, where the Board held that the dominant term “House” was a broad term suggesting a number of possibilities and was not generic or merely descriptive as applied to furniture and house ware store services. 21 U.S.P.Q. 92 (TTAB 1983).

Because Applicant’s mark creates a unique commercial impression, and because it does not immediately convey to consumers the exact nature of Applicant’s bowling grip inserts, Applicant’s mark is not merely descriptive. This mark does not describe Applicant’s goods with particularity. Applicant thus requests the Examining Attorney to withdraw the 2(e)(1) refusal.

2. Any Doubt Should Be Resolved In Favor of the Applicant

Finally, to the extent that the Examining Attorney views this as a close question, Applicant respectfully requests that the mark be allowed for registration on the foregoing grounds and in light of United States Patent and Trademark Office examining policy to resolve issues of doubt over whether a mark is merely descriptive or suggestive, in favor of the Applicant. See e.g., *In re Conducting System, Inc.*, 220 U.S.P.Q. 84 (TTAB 1983) (Doubts under Section 2(e) about the merely descriptive nature of a term are resolved in favor of the Applicant).

D. Request for Withdrawal of § 2(d) Refusal

The Examiner has cited to a registration for “TWIST ME SILLY” owned by King.com Limited (“King.com”) as a potential barrier under Section 2(d) of the Lanham Act. This three-word composite mark is clearly distinguishable from the Applicant’s single word mark and is not likely to be confused in the relevant marketplace. There are numerous registrations which

currently coexist with TWIST ME SILLY for overlapping Class 28 goods. TWIST ME SILLY has an entirely different commercial impression in the relevant marketplace. There is nothing “SILLY” about Applicant’s goods bearing its TWIST & DESIGN mark.

The Applicant submits that use of TWIST & DESIGN for the very narrow designation of thumb and finger grip inserts for bowling balls is not likely to be confused in the marketplace with King.com’s extensive list of Class 28 goods, or the unspecified “bowling apparatus and machinery” buried in the extensive designation in the cited application, namely:

IC 028. US 022 023 038 050. G & S: Christmas tree ornaments and decorations; coin operated amusement machines, automatic amusement machines; game apparatus, namely, bases, bats, and balls for playing indoor and out-door games; gymnastic apparatus; arcade video game machines; archery quivers, archery targets artificial snow for Christmas trees; ascenders; backgammon games; bags especially designed for skis and surfboards; balls for games; barbells; baseball gloves; batting gloves; bells for Christmas trees; billiard balls; billiard cue tips; billiard cues; billiard markers; billiard table cushions; billiard tables; bingo cards; bite indicators; bite sensors; board games; bob-sleighs; body boards; bodybuilding apparatus; **bowling apparatus and machinery**; bows for archery; boxing gloves; toy building blocks; building games; butterfly nets; camouflage screens; candle holders for Christmas trees; caps for toy pistols; chalk for billiard cues; checkerboards; checkers; chess games; chessboards; chips for gambling; Christmas tree stands; Christmas trees of synthetic material; clay pigeon traps; clay pigeons; climbers' harness; coin operated billiard tables; confetti; magic tricks in the nature of a conjuring apparatus; controllers for game consoles; cosques toy fireworks; counters for games; fishing creels; bags specially designed to hold cricket equipment; cups for dice; darts; dice; discuses for sports; divot repair tools; dolls; dolls' beds; dolls' clothes; dolls' feeding bottles; dolls' houses; dolls' rooms; dominoes; edges of skis; elbow guards for athletic use; electronic targets for games and sports; exercise machines; fairground amusement rides; fencing gloves; fencing masks; fencing weapons; fish hooks; fishing tackle; flippers for swimming; floats for fishing; flying discs. games, namely, action skill games, arcade games, balls for games or paddle ball games, boule games, card games, coin operated video games, dart games, dice games, electronic board games, hand held units for playing electronic games, educational game units for children in the nature of electronic games for teaching of children, handheld computer games, handheld units for playing electronic games other than those adapted for use with an external display screen or monitor, handheld electronic video games, namely, stand-alone video game machines, handheld games with liquid crystal displays, handheld pinball games, tabletop rod hockey game playing equipment, namely, hockey sticks, balls and nets sold as a set, Mah-jong games, manipulative games, musical games in the nature of board games with a musical component; mechanical games, namely, board games involving mechanical components, paddle ball games, party games, Pinball games, card games featuring quizzes, racing car games featuring model racing car bodies, ring toss games, role play games, action skill games, sports games kits composed of balls, sports whistles, and score books, target games, toy card games; gaming machines for gambling; football gloves, bowling gloves, hockey gloves, karate gloves, racquet ball gloves, weight lifting gloves; golf bags, with or without wheels; golf clubs; golf gloves; gut for fishing; guts for rackets; hang gliders; harness for sailboards; scuba equipment, namely, spearfishing harpoon guns; hockey sticks; horseshoe games; hunting game calls; ice skates; inline roller skates; jigsaw puzzles; kaleidoscopes; kite reels; kites; knee guards for athletic use; landing nets for anglers; lines for fishing. lures for hunting or fishing; machines for physical exercises; mah-jong; marbles for games; masts for sailboards; Men's athletic supporters; mobiles for children; nets for sports; ninepins; novelties for parties and dances in the nature of bugs in boxes, crackers, toy face masks, toy fake teeth, paper hats, streamers, vampire teeth, foam fingers; ornaments for Christmas trees, except illumination articles and confectionery; pachinkos; paintball guns; paintballs; paper party hats;

paragliders; parlor games; pinatas; play balloons; playing balls; playing cards; plush toys; poles for pole vaulting; portable games with liquid crystal displays; protective padding for playing cricket, field hockey, handball, skates, inline skates, skateboarding, roller skating, football, ice-hockey, roller hockey, volleyball, mountain biking, cycling, polo; punching bags; puppets; quoits; rackets; radio-controlled toy vehicles; baby rattles; reels for fishing; ring games; rocking horses; rods for fishing; roller skates; rollers for stationary exercise bicycles; rosin used by athletes; roulette wheels; sailboards; scale model kits; scale model vehicles; scent lures for hunting or fishing; toy scooters; scrapers for skis; scratch cards for playing lottery games; coverings for skis, namely, seal skins; shin guards for athletic use; shuttlecocks; skateboards; skating boots with skates attached; ski bindings; skis; skittles; playground slides, climbing slides, namely, playground slides, water slides; sling shots; slot machines; snow globes; snowboards; snow shoes; bubble making wand and solution sets; sole coverings for skis; spinning tops; spring boards; starting blocks for sports; stationary exercise bicycles; strings for rackets; stuffed toys; surf boards; surf skis; surfboard leashes; swimming belts; swimming jackets; swimming kick boards. inflatable swimming pools, play swimming pools, namely, paddling pools, play swimming pools; swings; tables for indoor football; tables for table tennis; targets; teddy bears; tennis ball throwing apparatus; tennis nets; theatrical masks; toy masks; toy pistols; toy vehicles; toys, namely, action figures, toy air pistols; bath toys, bathtub toys, battery-operated action toys, battery operated toys, namely, mechanical action toys, electric action toys, electronic action toys, electronic activity toys, namely, children's multiple activity toys, infant development toys, inflatable toys, mechanical action toys, miniature car models, model cars, multipart construction toys, musical toys, non-motorized toys for riding, pet toys, baby rattles, puzzles, punching toys, sandbox toys, stuffed toy animals, stuffed bean-filled toys, scale model cars, toy whistles, water toys, wooden toys, namely, positionable wooden figures for use in wooden puzzles; toys for domestic pets; trampolines; twirling batons; arcade, mobile and home video game machines; water wings; waterskis; wax for skis; weight lifting belts

The Applicant notes that the cited mark is based upon Section 44(e), and that King.com did not have to file evidence of use or specimens prior to registration. Attached as Exhibit A are excerpts for the cited registrant's websites advertising its TWIST ME SILLY computer games to show the commercial impression of that mark. To play the games, a person is instructed to electronically "TWIST" the figures in the computer games, however this did not require a disclaimer of any elements of the mark. There are additional references to an "Uncle Berry" animated character within the games which adds to the "SILLY" commercial impression. There is no evidence that the cited registrant makes use of TWIST ME SILLY in connection with any goods in connection with the sport of bowling.

The target audiences appear to be different. The King.com website and TWIST ME SILLY games target individuals who play online video games. King.com uses TWIST ME SILLY in connection with non-downloadable computer games purchased online. Applicant's goods cannot be used online. Applicant currently sells its bowling grip inserts bearing its TWIST & DESIGN

mark through authorized distributors who drill the holes and install the grips, and these goods would only be used by people involved in the actual sport of bowling. The Applicant submits that its non-identical mark used on these different goods create a much different commercial impression and do not present a likelihood of confusion in the relevant marketplace.

In addition, the TWIST ME SILLY registration does not entitle King.com to exclusive rights in the word TWIST for Class 28 goods. There are other Class 28 registrations which coexist with the cited mark and include TWIST components. A TESS search shows 56 live records for marks incorporating TWIST in Class 28. These include, but are not limited to the following, which coexist with the cited mark, and do not require a disclaimer of the term TWIST:

TWISTCAR -Toy ride-on cars operated by hand or foot
TWIST FACE -Golf clubs
TWIST'D -Manually-operated exercise equipment, namely, a hand-held exercise device...
TOYS WITH A TWIST -Children's toys...
YOGI TWIST -Action skill games
TWIST TIME -Indoor and outdoor games, [referencing target games, balls, bingo games, stacking games, etc
SPIRO-TWIST -Battery operated action toys
TWIST RESIST -Exercise machines
TREASURE TWIST -Computer programs for games
TWISTRACK -Flexible tracks for toy model trains
FINGER TWIST -Board games; parlour games; card games; puzzles; playing cards
DOUBLE TWIST -Equipment for playing casino table games...
TIKI TWIST -Card games and accessories therefor
THE UNCLASSY TWIST TO THE CLASSIC PARTY GAME -Tabletop game
BRAIN TWIST -Toys, namely, three dimensional puzzles
TWIST POPPER -toy in the nature of a manually operated tube that dispenses confetti and streamers.

Copies of the TESS records for these marks are attached as Exhibit B.

For each of these registrations, the applicants provided specimens of current use of the marks. According to the Trademark Manual of Examining Procedure, evidence of the number of third-party uses of similar marks on similar goods is to be considered since it is one of the factors

in determining likelihood of confusion under the *du Pont* factors. See TMEP Sec.1207.01(d)(iii), citing to *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973). This same Section of the TMEP also states, “[i]f the evidence establishes that the consuming public is exposed to third-party use of similar marks on similar goods, this evidence ‘is relevant to show that a mark is relatively weak and entitled to only a narrow scope of protection.’” TMEP Sec. 1207.01(d)(iii), citing to *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772*, 396 F.3d 1369, 1373, 73 USPQ2d 1689, 1693 (Fed. Cir. 2005).

Thus, there should be no likelihood of confusion between the Applicant’s TWIST & DESIGN mark and goods and King.com’s TWIST ME SILLY mark and goods in the relevant marketplace. The marks are clearly different and convey entirely different impressions. The goods and services are distinguishable, and Applicant’s goods are clearly identified and limited. The channels of trade and targeted purchasers are quite different. The market is also crowded with coexisting non-identical registered marks for Class 28 goods. The applicant submits that the cited mark should not block the application here.

E. Response to the Additional Information Request

The Examiner has further requested additional information and documentation regarding the design mark. Counsel addresses each inquiry below.

- (1) A written statement as to whether the mark design, or any feature(s) thereof, is or has been the subject of a design or utility patent or patent application, including expired patents and abandoned patent applications. Applicant must also provide copies of the patent and/or patent application documentation.

Applicant is the owner of US utility patent application no. 62/661381 for the product bearing the “TWIST & DESIGN” mark. Since this is a provisional utility patent application that has not published, it is still confidential and cannot be submitted here. The word TWIST does not appear in the patent application. Counsel is not sure what patent application documentation is appropriate to submit before the Trademark Office at this point in the confidential patent process/examination. Applicant can indicate that the mark TWIST & DESIGN includes a stylized rendition of a portion of its product which is used as a stylized letter “T” in the word TWIST.

- (2) Advertising, promotional, and/or explanatory materials concerning the applied-for mark design, particularly materials specifically related to the design feature(s) embodied therein.

The Applicant is collecting the requested materials and will supplement this response.

- (3) A written explanation and any evidence as to whether there are alternative designs available for the feature(s) embodied in the mark design, and whether such alternative designs are equally efficient and/or competitive. Applicant must also provide a written explanation and any documentation concerning similar designs used by competitors.

Applicant is aware that third parties produce and sell grips and inserts for bowling balls. Applicant is not aware of any third party who uses its identical product design, or uses the same stylized mark TWIST & DESIGN.

- (4) A written statement as to whether the design at issue results from a comparatively simple or inexpensive method of manufacture in relation to alternative designs for the product. Applicant must also provide information regarding the method and/or cost of manufacture relating to applicant’s goods.

Applicant’s TWIST & DESIGN mark does not correspond to a “method of manufacture.”

The patent application does not cover a method of manufacture, but rather a product.

F. **Conclusion**

The Applicant submits that the subject mark and application is in a form suitable for registration on the Principal Register and respectfully requests such action. Should the Examiner have further questions or require additional information, please contact undersigned counsel.

Respectfully submitted,

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