

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

O'Reilly Automotive Stores, Inc.
Serial No. 88/418,267

Filing Date: May 7, 2019

For: POWER TORQUE

John S. Yard
Examining Attorney

Law Office 115

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

RESPONSE

This letter will respond to your Office Action with an issue date of June 22, 2019, concerning the above-referenced mark (the “Applied for Mark”) for the following goods and classes:

IC 007: Stands for hydraulic jacks; hydraulic jacks (collectively, the “Class 007 Goods”).

IC 008: Jack stands, namely, stands for hand jacks; hand jacks (collectively, the “Class 008 Goods”).

The Class 007 Goods, and the Class 008 Goods or any combination of them, are sometimes collectively referred to in this Response as the “POWER TORQUE Goods” and the application for the Applied for Mark is referred to as the “Application.”

OTHER POWER TORQUE REGISTRATIONS AND APPLICATIONS

BY THE APPLICANT.

O'Reilly Automotive Stores, Inc. (the "Applicant") is the owner of three registrations for the POWER TORQUE mark, namely Reg. No. 4511460 ("Reg. 460"), Reg. No. 4512730 ("Reg. 730") and Reg. No. 4762855 ("Reg. 855").

Reg. 460 includes goods in International Classes 7 and 12 as follows:

IC 007: Automotive engine parts, namely, flywheels and light-weight flywheels.

IC 012: Automotive parts, namely, multi-plate clutch assemblies and automotive clutch assemblies comprised of clutch discs, clutch plates, pressure plates, bearings, bushings, springs, and housing covers; clutch flywheels, light-weight clutch flywheels and flexplates; clutch components, namely, rods, pedals, master cylinders, slave cylinders, forks, hydraulic hoses, and cables; clutch conversion kits comprised of clutch pressure plates, clutch discs, bearings, bushings, master cylinders, slave cylinders, springs, housing covers, and cables.

Reg.460 has been registered on the UPSTO Principal Register for more than five (5) years and has been granted incontestability status under Section 15. Although exclusive rights to the word TORQUE were disclaimed under Reg. 460, it was **NOT** necessary for Applicant to rely upon a claim of acquired distinctiveness under Section 2(f) in order to obtain registration of this mark on the Principal Register.

Reg. 730 includes goods in International Class 8 as follows:

IC 008: Automotive and industrial hand operated tools, namely, ratchet wrenches, breaker bars, torque wrenches, socket wrenches; Industrial hand operated tools in the nature of socket accessories, namely, extensions, universal joints, size adapters, spark plug sockets, socket sets, wrenches, screwdrivers, pliers, hammers, hex keys, drill and torque bit sets, nut drivers, locking pliers, adjustable wrenches, torque wrenches; hand operated tools, namely, c-clamps, knives, lug wrenches, manual engine hoists, pry bars, scrapers, scissors, snips, punches, chisels, and gear pullers.

Reg. 730 has been registered on the UPSTO Principal Register for more than five (5) years and has been granted incontestability status under Section 15. Although exclusive rights to the word TORQUE were disclaimed under Reg. 730, it was **NOT** necessary for Applicant to rely

upon a claim of acquired distinctiveness under Section 2(f) in order to obtain registration of this mark on the Principal Register.

Reg. 855 includes goods in International Class 12, namely “Engines for land vehicles.”

Reg. 855 registered on the UPSTO Principal Register on June 30, 2015, so it is not yet eligible for a grant of incontestability status under Section 15. The correspondent attorney’s predecessor in interest on Reg. 855, for reasons unknown to the current correspondent attorney not only disclaimed exclusive rights to the word TORQUE under Reg. 730, but also asserted a claim of acquired distinctiveness under Section 2(f) in the process of obtaining registration of this mark on the Principal Register. The Applicant might not have made such a claim had it been advised by the current correspondent attorney. The Section 2(f) claim does not seem necessary in light of the absence of such claim in Reg. 460, Reg. 730 and App. 315 (as defined, below).

On February 19, 2019, the Applicant also applied to register the POWER TORQUE & Design mark (Application Ser. No. 88303315, hereafter “App. 315”) for the following goods in International Classes 007, 009, 012, and 017:

IC 007: electromagnetic solenoid valves.

IC 009: electric wire repair harnesses for automobiles.

IC 012: transmission mounts, motor mounts, torque struts, and engine mounts, all for motor vehicles; clutch components, namely, master cylinders, slave cylinders, cables, and flywheels; clutch kits comprised of flywheels, clutch discs, clutch plates, pressure plates, bearings, bushings, and housing covers; clutch release bearing; axle seal; axle shaft; axle kits comprised of a drive axle, wheel bearings, wheel seals, and attachment hardware; automatic transmission filter kits comprised of a transmission filter and a pan gasket.

IC 017: hydraulic hoses made of rubber and plastic.

The examination process for App. 315 has been completed and the mark was published for opposition for registration on the Principal Register. The examiner only required that exclusive rights to the word TORQUE be disclaimed. It was **NOT** necessary for Applicant to

rely upon a claim of acquired distinctiveness under Section 2(f) in order to obtain the examiner's approval of App. 315.

On February 15, 2019, the Applicant also applied to register the POWER TORQUE mark (Application Ser. No. 88303297, hereafter "App. 297") for the following goods in International Classes 007, 008, and 009:

IC 007: Electric power tools, namely, cordless power drills, cordless impact drivers, cordless impact wrenches

IC 008: Automotive and industrial hand operated tools, namely, ratchet wrenches, vise wrenches (locking pliers), socket wrenches, screw drivers, pliers, hex keys, nut drivers, adjustable wrenches, lug wrenches, and torque wrenches; hand operated tools in the nature of socket accessories, namely, socket sets, breaker bars, extensions, universal joints, spark plug sockets, and torque bit sets

IC 009: Batteries and battery chargers for cordless power tools

An office action was issued on App. 297 on March 12, 2019. The examiner initially refused registration under Section 2(e)(1), finding the mark to be merely descriptive of the identified goods. A response was submitted to that office action which was substantively similar to this one.

DISCLAIMER OF "TORQUE"

The Applicant hereby amends the Application to make the following disclaimer:

No claim is made to the exclusive right to use "TORQUE" apart from the mark as shown.

**AT WORST THE APPLIED FOR MARK IS SUGGESTIVE
AND IS NOT MERELY DESCRIPTIVE**

The Office Action concludes that the words POWER TORQUE are merely descriptive and that registration is refused under Section 2(e)(1), The Applicant respectfully disagrees and asserts that at worst such words are suggestive. A suggestive mark may be registered without proof that it has acquired a secondary meaning. TMEP §1209.01(a). While it is debatable as to

whether it was necessary to disclaim the word TORQUE, the Applicant has done so to make the Application consistent with the approach that has been taken in its previous registrations and App. 315. Therefore, the only issue is whether the word POWER is merely descriptive.

The TMEP section just cited states, “Suggestive marks are those that, when applied to the goods or services at issue, require imagination, thought, or perception to reach a conclusion as to the nature of those goods or services. Thus, a suggestive term differs from a descriptive term, which immediately tells something about the goods or services.” The section further notes that incongruity between the goods and the mark is a strong indication that a mark is suggestive. The Examiner noted in the Office Action that “applicant’s jacks are seen to be power operated and/or power assisted.” The Class 7 Goods include hydraulic jacks, but they are commonly not referred to, or thought of, as being power-operated as would be the case of power tools. The Class 8 Goods include hand jacks which would require quite a stretch of one’s imagination to be considered as being “power operated and/or power assisted.” Both classes of the POWER TORQUE Goods include jack stands which clearly are not power operated or power assisted. The inclusion of hand jacks and jack stands in the Application are incongruous with the word POWER in the sense the examiner is defining it (i.e. “the energy or motive force by which a physical system or machine is operated”), in that none of these goods are powered by an outside source.

It is far from certain that the purchasing public would perceive that the word POWER in the Applied for Mark has reference to manner in which the POWER TORQUE Goods are powered. They might just as easily perceive the word to have reference to the goods as being powerful as in being strong or tough. Where, as in this case, a proposed term has more than one dictionary meaning and there is at least one other meaning that would be suggestive of the goods

identified by that mark, the mark is not merely descriptive. See, The Institute National Des Appellations D'Origine v. Vitners Int'l Co., 22 USPQ 1190 (Fed Cir. 1992). The dictionary definition the examiner included with the Office Action shows that the word POWER has many meanings, including the two discussed above.

The term POWER is vague when it comes to the POWER TORQUE Goods. Without a mental pause (indeed a very long one), the typical consumer would have no way of knowing what goods would be covered by the mark. The fact that the Applied for Mark is part of a family of marks including Reg. 640, Reg. 730, Reg. 855 and the pending applications is further evidence of the wide range of automotive parts and tools covered by POWER TORQUE.

As will be discussed below, in the majority of instances involving the above-cited registrations comprising the POWER TORQUE family of marks, the USPTO has not found the mark to be merely descriptive. Therefore, it can hardly be said that the Applied for Mark is merely descriptive, rather than suggestive. When it is not clear that a mark is merely descriptive, then the question is to be resolved in favor of the applicant. In re Gourmet Bakers, Inc., 173 U.S.P.Q. 565, 565 (TTAB 1972) (noting that where “no easy applicable objective test” exists to determine whether a mark is merely descriptive or merely suggestive, the frequent manner of disposition is resolution in favor of the applicant on the theory that any person believed damaged by the registration would have the opportunity to oppose registration and present evidence usually not present in the ex parte application); In re Aid Labs., Inc., 221 U.S.P.Q. 1215, 1216 (TTAB 1983) (in deciding whether PEST PRUF for animal shampoo with insecticide is suggestive or merely descriptive, doubt is resolved in favor of applicant in holding the term merely suggestive of a possible end result of the use of applicant's goods).

As stated above, Reg. 460 and Reg. 730 are incontestable registrations. It is well settled law that a trademark infringer cannot defend itself on the grounds that the senior mark is merely descriptive, if the senior mark is protected by a trademark registration that has become incontestable. Park 'n Fly v. Dollar Park & Fly, 469 U.S. 189 (1985); Marketquest Grp., Inc v. BIC Corp, 316 F. Supp 3d 1234 (USDC SD CA, 2018). The Examiner's refusal to register the Applied for Mark, which is identical to the marks registered in the Reg. 460 and Reg. 730, and which covers the POWER TORQUE Goods, the same being closely related to those of Reg. 460 and Reg. 730 amounts to a collateral attack on the incontestable registration rights of the Applicant. Accordingly, such incontestable rights should be honored and the Section 2(e)(1) refusal should be withdrawn.

In addition, the weight of opinion of the examiners who have reviewed Applicant's previous applications for the POWER TORQUE mark, including the one for App. 315, is that POWER TORQUE is not merely descriptive.

CONCLUSION

The evidence and arguments presented in this Response show that the Applied for Mark, with the disclaimer of exclusive rights to the term TORQUE, is not merely descriptive and is entitled to registration on the Principal Register.

REMARKS

Now having responded to, and complied with, the matters noted by the Examining Attorney, the Applicant respectfully requests that this application be allowed for publication.

Respectfully submitted,

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