

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant: 180 Innovations LLC  
Serial No.: 88309321  
Mark: **FEVER ALARM**  
Ref. No.: T280853.US.01~ 500097-00032

Applicant hereby responds to the Office Action issued May 8, 2019, for the above application. The Examining Attorney refuses registration of the applied-for mark on the ground the mark is generic. In the alternative, the Examining Attorney contends the mark is descriptive and Applicant's 2(f) claim of acquired distinctiveness based on at least five years' use is insufficient. Applicant respectfully contends that the refusal is inconsistent with the USPTO's past treatment of identical applications and requests that the Examining Attorney withdraw the refusal and accept Applicant's claim of acquired distinctiveness.

**A. The Mark is Not Generic**

The mark **FEVER ALARM** is not generic of the applied for goods, namely, "An alert feature sold as a component of thermometers for medical purposes." A mark is generic only if "its primary significance to the relevant public is the class or category of goods or services on or in connection with which it is used." TMEP § 1209.01(c)(1).

The critical issue in genericness cases is whether members of the relevant public primarily use or understand the term sought to be protected to refer to the genus of goods or services in question. Determining whether a mark is generic therefore involves a two-step inquiry: First, what is the genus of goods or services at issue? Second, is the term sought to be registered or retained on the register understood by the relevant public primarily to refer to that genus of goods or services?

H. Marvin Ginn Corp. v. Int'l Ass'n of Fire Chiefs, Inc., 782 F.2d 987, 989-90 (Fed. Cir. 1986) (citations omitted) (reversing conclusion that FIRE CHIEF is generic for magazines distributed exclusively to fire departments).

"An examining attorney has the burden of proving that a mark is generic by *clear evidence*." TEMP § 1209(c)(i) (emphasis added). The "clear evidence" standard is "not a mere preponderance"; it is a "heightened burden" that can only be met with "substantial evidence." In re Nordic Naturals, Inc., 755 F.3d 1340, 1342-43 (Fed. Cir. 2009). Additionally, the breaking point between "descriptive terms and generic names is as fuzzy and undefinable as the line between descriptive marks and suggestive marks."

J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition, § 12:20 (citing *In re Merrill Lynch, Pierce, Fenner, and Smith, Inc.*, 828 F.2d 1567, 1569 (Fed. Cir. 1987)). Any doubts about whether a mark is generic must be resolved in favor of the applicant. In re Bel Paese Sales Co., 1 U.S.P.Q.2d 1233, 1236 (T.T.A.B. 1986).

1. Genus of Goods

“[A] proper genericness inquiry focuses on the description of [goods] set forth in the [application].” Magic Wand, Inc. v RDB, Inc., 940 F.2d 638, 640 (Fed. Circ. 1991); see also TMEP § 1209.01(c)(i) (“The genus of the goods . . . may be defined by an applicant’s identification of goods.”). Here, the primary commonly understood genus of goods covered by Applicant’s mark is, at its root, “components of thermometers.” The Examining Attorney does not appear to disagree with this conclusion.

2. FEVER ALARM is Primarily Understood as Referring to Applicant’s Mark

The wording FEVER ALARM is primarily understood as referring to Applicant’s mark. Applicant’s identical mark has been registered on the Supplemental Register for 20 years, since 1999 (registration no. 2,304,925), and was registered on the Principal Register (reg. no. 3,254,489) for over ten years, from 2007 to 2018. In fact, registration no. 3,254,489 achieved incontestability in 2012. Notably, the mark was never refused on genericness grounds. Moreover, it is clear that the public does not refer to “components of thermometers” as FEVER ALARM. The wording FEVER ALARM could perhaps be understood as describing a quality of a component of thermometers; but it is not understood as a generic equivalent of “components of thermometers.” Notably, the USPTO’s ID Manual does not contain any generic description for a good known as a “fever alarm,” and a search of the USPTO’s records did not reveal a single application or registration (live or dead) featuring the wording “fever alarm” in the description of goods and services (See Exhibit A). Neither of the dictionary definitions enclosed with the Office Action indicate that the terms FEVER or ALARM are synonymous with “components of thermometers” or of any product. Nor does the evidence attached to the Office Action constitute “substantial evidence” clearly showing that the mark is generic. As shown in Exhibit B, Applicant’s thermometers, many of which are sold under private labels, make up 70% of the market share for thermometers.

The third-party uses identified by the Examining Attorney constitute unauthorized use of Applicant’s longstanding trademark. Applicant is considering enforcement efforts against these users and thanks the Examining Attorney for bringing them to Applicant’s attention. It is well established that a trademark “owner is not required to act immediately against every possible infringing use.” Wallpaper

Mfrs., Ltd. v. Crown Wallcovering Corp., 680 F.2d 755, 766 (C.C.P.A. 1982); see also Engineered Mech. Servs. v. Applied Mech. Tech., Inc., 584 F. Supp. 1149, 1160 (M.D. La. 1984) (“The owner of a mark is not required to constantly monitor every nook and cranny of the entire nation and to fire both barrels of his shotgun instantly upon spotting a possible infringer. Lawyers and lawsuits come high and a financial decision must be made in every case as to whether the gain of prosecution is worth the candle.”); Ashland Licensing & Intellectual Property LLC and Valvoline Licensing and IP LLC v. Sunpoint Int’l Grp. USA Corp., No. 92057294, 2019 TTAB LEXIS 119, at \*75 (T.T.A.B. Apr. 26, 2019) (recognizing that the law does not “require each trademark owner to file a notice of opposition, petition for cancellation, or trademark infringement action on first notice and ask questions later”). Accordingly, a few unauthorized third-party infringements of Applicant’s mark should not be fatal to this application.

Accordingly, Applicant’s mark is not clearly generic. Applicant respectfully requests that the Examining Attorney withdraw the genericness refusal.

**B. Applicant Has Proven Secondary Meaning**

Applicant’s mark has acquired secondary meaning based on over 20 years of continuous use in commerce. Long-term use is an important factor in determining whether a mark has acquired distinctiveness. For example, in In re Uncle Sam Chem. Co., the Board concluded that the term SPRAYZON had acquired distinctiveness for cleaning products based on a declaration attesting to over 18 years of substantially exclusive and continuous use. 229 U.S.P.Q.233, 235 (T.T.A.B. 1986). Here, Applicant submitted a signed declaration at the time of filing the application confirming its long-term use of the mark and attesting to the fact that the mark has become distinctive based on its “substantially exclusive and continuous use.” Thus, the record contains sufficient evidence to grant Applicant’s 2(f) claim as is, without additional evidence.

Moreover, the USPTO previously granted Applicant’s 2(f) claim for an identical mark (Principal Register registration no. 3,254,489) based solely on a claim of at least five years’ use. The USPTO accepted this claim over 12 years ago, during which time Applicant has only continued to use and build distinctiveness in its mark. Additionally, the USPTO accepted a declaration of incontestability for registration no. 3,254,489. Applicant understands that this registration lapsed (unintentionally). But, if it were active, this current refusal would actually constitute an impermissible collateral attack on that registration. See In re AM. Sail Training Ass’n, 230 U.S.P.Q. 879 (T.T.A.B. 1986) (concluding that USPTO may not require disclaimer of a term that is also an incontestable, registered mark). This is at least persuasive evidence that the mark is capable of and has indeed acquired secondary meaning. Applicant

merely requests that the USPTO treat the current application similarly to Applicant's prior applications for identical marks.

\* \* \* \*

Based on the foregoing, Applicant respectfully requests that the Examining Attorney accept Applicant's claims of acquired distinctiveness and approve the application for publication.

## EXHIBIT A

Screenshot of search of USPTO ID Manual for “fever alarm”:

The screenshot shows the USPTO search interface. At the top, the USPTO logo and "UNITED STATES PATENT AND TRADEMARK OFFICE" are displayed. A search bar contains the text "fever alarm". Below the search bar, a message states "No records found for fever alarm". There are several filter buttons: "Search By all", "Status A, M, X, D", "NCL 11-2019", and "Search Fields description". Below these, there are dropdown menus for "Sort By" (set to "Relevance") and "Then By" (set to "(none)"). A table header is visible with columns: Term ID, Class, Description, Status, Effective Date, Type, and Notes. Below the header, the text "No records found" is displayed.

Screenshot of search of USPTO records for “fever alarm”

The screenshot shows the search criteria page. It includes a "View Search History" dropdown, "Records Returned" set to 100, and "Plurals" set to "Yes". The search term is "fever alarm" in the "Search Term" field. The "Field" is set to "Goods & Services" and the "Field" is set to "ALL". There are buttons for "Submit Query", "Clear Query", and "Logout". A note says "Please logout when you are done to release system resources allocated for you." At the bottom, there is a navigation bar with links: "TESS HOME", "NEW USER", "FREE FORM", "BROWSE DICT", "SEARCH OG", "TOP", and "HELP". Below the navigation bar, there is a footer with links: "HOME", "SITE INDEX", "SEARCH", "eBUSINESS", "HELP", and "PRIVACY POLICY".

Screenshot of search result screen for “fever alarm”

**No TESS records were found to match the criteria of your query.**

**Click on the ← BACK button in your browser to return to the previous TESS screen**

## EXHIBIT B



### A Choice of Top-Tier Products

As an industry leader in R&D, 180 Innovations supplies retailers with category-changing products under store brand names without sacrificing quality for price. Let our innovation, efficiency and responsiveness translate into ease of doing business, a choice of top-tier products, and increased customer loyalty to your brand.



Thermometers

With over 70% marketshare, 180 Innovations leads the private label thermometer business.

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Oral Care

We're also a leading supplier of ultrasonic tooth brushes to the private brand market in North America.

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Health

We've supplied almost every major chain and wholesaler with quality health products since 1979.

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Beauty

Next up—beauty products, starting with Dr. Lip Bang's Lip Freak. Made in the USA.

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