

U.S. Trademark Application No.: 88220216
Mark: ONECLEARWINNER
File No.: BGT-0037TM12

REMARKS

In response to the Office Action dated March 7, 2019, please enter the amendments to the identification of the goods and reconsider the application in view of the amendments and remarks provided in this Response.

In the Office Action, the Office noted that there were no conflicting marks found during a search of the Trademark Office's records that would bar registration under 15 U.S.C. §1052(d). The Office Action did, however, raise the following issues, namely: (1) the applied-for mark is a slogan or term that does not function as a trademark or service mark to indicate the source of applicant's goods and to identify and distinguish them from others; and (2) the identification of the goods was unacceptable because, according to the Trademark Office, the goods are indefinite.

ISSUE RELATING TO SECTIONS 1, 2, 3 and 45 REFUSAL - FAILURE TO FUNCTION AS A TRADEMARK - IS ADDRESSED.

According to the March 7, 2019 Office Action, Applicant's mark "is a slogan or term that does not function as a trademark or service mark to indicate the source of applicant's goods and to identify and distinguish them from others." According to the Trademark Office, the applied-for mark is a commonplace term, message, or expression widely used by a variety of sources that merely conveys an ordinary, familiar, well-recognized concept or sentiment.

The Office Action provides third party websites to support its position "that this term or expression is commonly used to refer to a good that would be of superior quality especially when comparing similar goods and conveys a common message regarding the quality of the goods and in the case of this mark would also convey the commercial impression of a social media tag. Because consumers are accustomed to seeing this term or expression commonly used in everyday speech by many different sources, they would not perceive it as a mark identifying the source of applicant's goods but rather as only conveying an informational message." Applicant respectfully traverses this refusal for the reasons that follow.

According to well-established trademark law the USPTO will not register an applied-for mark unless it functions as a mark. See 15 U.S.C. §§1051, 1052, 1053, 1127; *In re Bose Corp.*, 192 USPQ 213, 215 (C.C.P.A. 1976) ("Before there can be registration, there must be a trademark . . ."); *In re Int'l Spike, Inc.*, 196 USPQ 447, 449 (TTAB 1977) ("Registration presupposes the existence of a trademark to be registered."); TMEP §1202. That is, the mark must serve as an indicator of the source of the goods or services, identifying and distinguishing them from those of others. See 15 U.S.C. §1127; TMEP §1202.

The examining attorney must determine whether a mark functions as a trademark or service mark by reviewing the available evidence, ***including the specimen and any other materials of record***. See *In re Safariland Hunting Corp.*, 24 USPQ2d 1380, 1381 (TTAB 1992) (“Since the specimens of record show how the applied-for mark is actually used in commerce, ***we must primarily look to the specimens to see if the designation would be perceived as a source indicator.***”) (Emphasis Added).

According to TMEP 1202.04(b), *the size, location, dominance, and significance of the wording as it is used in connection with the goods or services should also be considered to determine if any of these elements further support the perception of the wording merely as an informational message rather than as indicating the source of goods or services.*

In this case, Applicant’s application is an intent-to-use application filed under Section 1(b) of the Trademark Act. As such, Applicant has not yet provided any specimens of use, such that it is impossible to analyze *the size, location, dominance, and significance of the wording as it is used in connection with the goods or services to determine if any of these elements further support the perception of the wording merely as an informational message rather than as indicating the source of goods or services*. Accordingly, Applicant submits that the Office Action is raising the issues of a failure to function as a mark prematurely since there is no evidence of how Applicant actually uses or will use the applied-for mark in connection with the goods sought to be registered. Applicant submits that Applicant’s mark may be perceived as indicating a single source for the identified goods, but that analysis depends upon Applicant’s use as demonstrated through a specimen – which has not yet been provided. For example, in the case of *In re The Hallicrafters Co.*, 153 USPQ 376 (TTAB 1967), the TTAB reversed the refusal to register QUALITY THROUGH CRAFTSMANSHIP for radio equipment, finding that the wording functioned as a mark because applicant extensively advertised the slogan and used it in the manner of a trademark on the goods. Thus, Applicant respectfully requests the Trademark Office to withdraw the issue until Applicant provides a suitable specimen of use.

ISSUE RELATING TO APPLICANT’S IDENTIFICATION OF THE GOODS IS ADDRESSED.

According to the Office Action, the terms “motor vehicles”; “vehicles, structural parts for motor vehicles”; “motor vehicle bodies”; “seats, upholstery, steering wheels, automobile wheel hubs”; “Anti-skid chains, roof-racks, shock absorbers, springs, stabilizer bars, suspensions, all for vehicles”; and “motor vehicle body parts, namely, bodyworks for motor vehicles” do not specify the exact nature of the goods. Accordingly, applicant has amended these terms to include further detail about the exact nature of the goods.

Applicant expresses appreciation to the Examining Attorney for the guidance provided in the Office Action relating to the identification of the goods. By this response, Applicant has amended the identification of the goods in this application by providing a more definite statement of the goods. The identification of the goods, as amended herein, is within the scope of the originally identified goods. Further, the identification of the goods, as amended herein, reflects terminology used in the marketplace, is acceptably definite, and satisfies the requirement raised in the Office Action. Thus, no further action by Applicant is believed to be necessary.

However, if any issue remains after entry of the amendments relating to the identification of the goods, Applicant respectfully requests an opportunity to address any such issue in another Office Action.

In view of the foregoing, Applicant respectfully submits that registration of the applied for mark on the Principal Register is appropriate and a finding of the same is respectfully requested. If any impediment to passing the applied for mark onto publication remains after entry of this Response and consideration of these remarks, the Examining Attorney is invited to initiate a telephone interview with the attorney of record.