

**THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re: :  
: Trademark Attorney  
App. Ser. No. 88/127006 : Kevin G. Crennan  
: Law Office 113  
Applicant: American City Business Journal, Inc. :  
: Mark: HEMMINGS :  
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**RECITATION OF GOODS/SERVICES**

Applicant requests that the following language be substituted for the recitation of goods and services:

- Class 35: Arranging and conducting of auction sales; advertising and marketing services; Providing venues in the nature of trade exhibition facilities to showcase, sell and display the goods of others, namely, automobiles; Providing consumer product information in the fields of motor vehicles, cars, motorcycles, aviation, marine vessels, trucks, 4x4 trucks, classic and antique cars, automotive parts and accessories; automotive events in the nature of tradeshow and auctions; arranging, organizing and conducting events relating to motor vehicles, namely, tradeshow and auctions.
- Class 41: Providing current event information in the fields of motor vehicles, cars, motorcycles, aviation, marine vessels, trucks, 4x4 trucks, classic and antique cars, automotive parts and accessories; automotive events in the nature of automobile races; arranging, organizing and conducting events relating to motor vehicles, namely, automobile races; providing venues in the nature of museum facilities to showcase and display the goods of others, namely, automobiles;

**AMENDMENT**

Please add the following statements to the application:

THE MARK HAS BECOME DISTINCTIVE OF THE GOODS/SERVICES AS EVIDENCED BY THE OWNERSHIP ON THE PRINCIPAL REGISTER FOR THE "HEMMINGS" MARK FOR THE SAME OR RELATED GOODS OR SERVICES AS EVIDENCED BY OWNERSHIP OF U.S. REGISTRATION NOS. 4450202, 4446539, 4446537, 4446538, 3159611, 3163096, 2903767, 5204362, 5199511, 5199510 and 1059232. THE "HEMMINGS" MARK HAS

ALSO ACQUIRED DISTINCTIVENESS FOR THE SAME OR RELATED GOODS OR SERVICES THROUGH APPLICANT'S SUBSTANTIALLY EXCLUSIVE AND CONTINUOUS USE FOR AT LEAST THE LAST TEN (10) YEARS OF THE "HEMMINGS" MARK IN COMMERCE FOR THE SAME OR RELATED GOODS OR SERVICES AS SHOWN IN THE EVIDENCE SUBMITTED HEREIN.

#### REMARKS

The Examining Attorney has refused registration under Trademark Act Section 2(e)(4) holding that applicant's mark is primarily merely a surname. In order to overcome this refusal, Applicant is submitting these arguments to prove that the name "Hemmings" has acquired secondary meaning in the automotive and related industries and alternately, Applicant seeks registration under the provisions of Section 2(f) claiming acquired distinctiveness for the "Hemmings" mark in the instant application.

"Secondary meaning grows out of long association of the name with a business, and thereby becomes the name of the business as such; it is acquired when the name and the business becomes synonymous in the public mind; and submerges the primary meaning of the name as a word identifying a person in favor of its meaning as a word identifying a business." Visser v. Macres, 214 Cal. App. 2d 249 (4th Dist. 1963); Scarves by Vera Inc. v. Todo Imports, Ltd. 544 F2d 1167 (2d Cir. 1976). Thus is the case with "HEMMINGS" and that names' acquired recognition and reputation in the automotive and automobile related industries for many decades. The evidence cited herein supports that HEMMING'S long ago acquired secondary meaning as the brand/trademark for automotive publications, car parts, car shows and all the businesses behind the scenes and publicly visible in these industries. For over 50 years auto enthusiasts have turned to the HEMMING'S business products to satisfy their desire and need for information and materials needed to purchase, sell, maintain, rebuild, construct, design, engineer, and enjoy all things that have engines, and particularly automobiles and their parts and accessories. Internet

searches conducted on Google and Bing search engines for “Hemmings” reveal page after page of search results relating to Applicant’s HEMMING’S business. This is solid, uncontested evidence of secondary meaning that alone should overcome the 2 (e) (4) refusal.

The registrations for which applicant bases its Section 2(f) claim, namely, Registration Nos. 4450202, 4446539, 4446537, 4446538, 3159611, 3163096, 2903767, 5204362, 5199511, 5199510 and 1059232 encompass the mark HEMMING’S, and the identified goods include motor oil, license plates, and magazines about cars, automobiles and motorcycles. These goods are the same or substantially related to the goods and/or services in the instant application.

The Trademark Trial and Appeal Board has set forth the requirements for showing that a mark in an intent to use application has acquired distinctiveness. First, the applicant must establish through appropriate submission, acquired distinctiveness of the same mark in connection with specified other goods and/or services in connection with which the mark is in used in commerce. Second, Applicant must establish a sufficient relationship between the goods or services in connection with which the mark has acquired distinctiveness and the goods recited in the application to warrant the conclusion that the previously created distinctiveness will transfer to the goods or services in the application upon use. In re Rogers, 53 USPQ2d 1741, 1744 (TTAB 1999).

Applicant has asserted a claim of ownership for 11 of its registrations that contain the HEMMING’S mark. Most of these registrations have become incontestable. This claim of ownership for the HEMMING’S mark, for the same or related goods, clearly establishes the first element referenced above. See TMEP Section 1212.04.

The showing necessary to establish relatedness of the goods will vary from case to case, depending on the goods or services involved and the language used

to identify them. Applicant submits the fact that its claim of acquired distinctiveness for the HEMMING mark for registrations covering motor oil, license plates, magazines about cars, automobiles and motorcycles is more than sufficient to establish the relatedness necessary for the second element referenced above. In fact, applicant submits that the relatedness is self-evident from the respective identifications of goods in the registrations upon which Applicant's acquired distinctiveness is based and the identification of goods in the instant application. Kellogg Co. v. General Mills, Inc., 82 USPQ2d 1766, 1771 (TTAB 2007).

TMEP Section 1212.04(c) states that if the relatedness is self-evident, the Examining Attorney can generally accept the Section 2(f) claim without additional evidence. This is most likely to occur with ordinary consumer goods or services where the nature of the goods or services is commonly known and readily apparent. Clearly, the relatedness between motor oil, license plates, magazines about cars, automobiles and motorcycles on one side and “Arranging and conducting of auction sales; advertising and marketing services; Providing venues in the nature of trade exhibition facilities to showcase, sell and display the goods of others, namely, automobiles; Providing consumer product information in the fields of motor vehicles, cars, motorcycles, aviation, marine vessels, trucks, 4x4 trucks, classic and antique cars, automotive parts and accessories; automotive events in the nature of tradeshow and auctions; arranging, organizing and conducting events relating to motor vehicles, namely, tradeshow and auctions” and “Providing current event information in the fields of motor vehicles, cars, motorcycles, aviation, marine vessels, trucks, 4x4 trucks, classic and antique cars, automotive parts and accessories; automotive events in the nature of automobile races; arranging, organizing and conducting events relating to motor vehicles, namely, automobile races; providing venues in the

nature of museum facilities to showcase and display the goods of others, namely, automobiles” is commonly known and readily apparent as tradeshow, auctions and events in the field of motorcycles, cars and motor vehicles are closely connected and have the same purpose of providing information about motorcycles, motor vehicles, automobiles and cars as do the magazines about cars, automobiles and motorcycles.

Beyond the registrations, the “HEMMINGS” mark has acquired distinctiveness with the same or related goods and/or services through the Applicant’s substantially exclusive and continuous use of the mark in commerce that the U.S. Congress may lawfully regulate for the same or related goods or services, for at least the five years immediately before the date of this statement, and as early as 1962. In re Speer Filler Strip Company, 122 U.S.P.Q. (TTAB 1967) (long use of surname “TENNANT” as a mark for floor maintenance products resulted in a secondary meaning and it is entitled to be afforded protection as if it were a “strong” or “arbitrary” mark at the inception). Please see the attached Exhibit A that contains evidence collected from the Hemmings.com website through the Way Back Machine showing the long use of the “Hemmings” portion of the mark in connection with magazines featuring information about cars, trucks, motorcycles, car parts, car auctions, car events and car trade shows. The evidence shows that the “Hemmings” portion of the mark has become distinctive of the same or related goods and/or services.

In considering a claim of acquired distinctiveness, the issue is whether acquired distinctiveness of the mark in relation to the goods or services has in fact been established in the minds of the purchasing public, not whether the mark is capable of becoming distinctive. TMEP Section 1212.06.

There is no doubt that the surname HEMMING, one of the most famous trademarks in the automobile sales, magazine and parts industry, has acquired

distinctiveness and that distinctiveness has been established in the minds of the purchasing public. Attached hereto as Exhibit B are articles written by Forbes magazine and other third-party magazines and newspapers about the fame of HEMMINGGS and its influence on the automotive industry, including being a major source of information about cars, trucks, car parts, auto events, car shows, car auctions, car race, car services, motorcycles and the like. These materials underscore and tout the fame and unrivaled reputation of the “Hemmings” brand, as early as 1962.

In view of the above-identified arguments, Applicant requests that the HEMMINGGS mark be granted 2(f) designation based on earlier registrations and over five years use in commerce with the same or related goods or services, and evidence of acquired distinctiveness. Such favorable action is most earnestly solicited. In view of these arguments and amendments, Applicant contends that the instant application is now in condition to be passed to publication.

If further information is required regarding this response, the Examining Attorney is requested to contact the undersigned by telephone to facilitate the prosecution of the application.

Respectfully submitted,  
ADVANCE  
One World Trade Center  
New York, New York 10007  
(Attorneys for Applicant)

By: /s/ Natasa Colovic

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Natasa Colovic  
Dated: November 28, 2019  
Telephone: (212) 286-9310