

U.S. Application No. 88/382947  
Mark: ALLSTEEL  
Applicant: Walter Surface Technologies Inc.  
SKGF Ref: 3167.0180000

## RESPONSE TO OFFICE ACTION

In an initial Office Action mailed June 25, 2019, the United States Patent and Trademark Office (PTO) preliminarily refused registration of Applicant's mark on the grounds that the mark is merely descriptive under Section 2(e)(1) of the Trademark Act. Additionally, the Examining Attorney has required Applicant to amend the description of goods to indicate that **all the goods are made of steel**.

As discussed below, Applicant's disagrees that its mark is merely descriptive of its goods, and especially not for those goods which are not made of steel. However, Applicant filed a Request to Divide in connection with this application on December 13, 2019 to move the goods made of steel to a new "child" application and also amended those goods to reflect their steel makeup, as required by the Examining Attorney. As Applicant specifies below, once the Request to Divide is processed, Applicant requests that the new "child" application for the steel-made goods be amended to the Supplemental Register, an option offered by the Examining Attorney. Accordingly, Applicant submits that the merely descriptive refusal will no longer apply to those goods and Applicant's arguments will focus only on the remaining goods.

### **1. Applicant amends its new "child" application, with steel-made goods, to the Supplemental Register and submits it should be in condition for registration.**

Because all of the goods are not made of steel, on December 13, 2019, Applicant filed a Request to Divide to move the goods that are made of steel, namely drill bits, wire brushes, and burrs to a new "child" application, and amended the description for these goods, as shown below, to specify their steel makeup:

**steel** drill bits, **steel** wire brushes and **steel** burrs for use with power tools **for cutting, drilling, grinding and finishing** in Class 7

Applicant notes that the PTO has not yet processed the Request to Divide; therefore, a new application number has not yet been assigned to the "child" application.

Applicant respectfully requests that the "child" application be amended to the Supplemental Register. Applicant's amendment to the Supplemental Register does not prejudice or otherwise affect Applicant's rights now existing or hereafter arising in the mark, or its right of registration on another application for the same mark.

Once the goods in the new "child" application have been amended as required by the Examining Attorney, and the "child" application is amended to the Supplemental Register -- and provided the Examining Attorney's new search reveals no intervening marks that would bar registration of Applicant's mark for these particular goods -- Applicant respectfully submits that the "child" application should be in condition to proceed to registration.

## 2. ALLSTEEL is not descriptive in relation to the goods in the “parent” application

Once the Request to Divide is processed, the subject application will be the “parent” application and it will cover the following goods as amended in the Request to Divide:

cutting discs, flap discs, abrasive plugs, cones, drums, belts and mounted points for use with power tools for cutting, drilling, grinding and finishing; grinding discs in Class 7

The determination of whether a mark is merely descriptive must be made in relation to the goods or services for which registration is sought, not in the abstract. *In re Chamber of Commerce*, 675 F.3d at 1300, 102 USPQ2d at 1219; *In re Bayer*, 488 F.3d at 964, 82 USPQ2d at 1831. This requires consideration of the context in which the mark is used or intended to be used in connection with those goods/services, and the possible significance that the mark would have to the average purchaser of the goods or services in the marketplace. See *In re Chamber of Commerce*, 675 F.3d at 1300, 102 USPQ2d at 1219; *In re Bayer*, 488 F.3d at 964, 82 USPQ2d at 1831; *In re Omaha Nat'l Corp.*, 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987); *In re Abcor Dev. Corp.*, 588 F.2d 811, 200 USPQ 215 (C.C.P.A. 1978); *In re Datapipe, Inc.*, 111 USPQ2d 1330 (TTAB 2014); *In re Venture Lending Assocs.*, 226 USPQ 285 (TTAB 1985).

The average purchaser of the goods in Applicant’s “parent” application is highly knowledgeable about these products. Users of these tools, which can be extremely dangerous if not used correctly, have a great deal of training and experience with these types of products. Consumers of these goods are also very knowledgeable about the makeup and application of the tools of their trade, and are very well aware that these products cannot be made of steel or they would not function in the way they are intended, i.e., on metal surfaces.

The mark ALLSTEEL may give some general information regarding certain attributes of Applicant’s goods, but as the terms ALL and STEEL are not merely descriptive as to the makeup of the goods, the mark as properly viewed in its entirety is at least suggestive when applied to Applicant’s goods.

Applicant attaches a representative sample of evidence of third party registrations, from the PTO’s Trademark Electronic Search System (“TESS”) with the term ALL in the registered mark combined with another arguably descriptive (or even generic) term, for arguably similar goods, in which the term ALL is not disclaimed, there is no 2(f) claim of acquired distinctiveness, and are all registered on the Principal Register. These registrations illustrate that, in similar instances, the term ALL has not been deemed to be merely descriptive – rather, these ALL-formative marks create a suggestive and unitary impression.

In particular, we draw the Examining Attorney’s attention to the registered mark ALL-WALL (Stylized), Reg. No. 5866102, covering “lubricants for drywall tools in the field of construction” in Class 4, registered on the Principal Register on September 24, 2019, despite the fact that the mark suggests the goods can be used for all walls. Similarly, ALL was not found to be merely descriptive in the following registrations and even arguably carried the mark where the mark is unitary.

- **ALL-WALL (Stylized)** – Reg. No. 5866102, registered September 24, 2019, owned by All-Wall Equipment Company, Inc.;

- **ALLCHEF.** – Reg. No. 5667481, registered January 29, 2019, owned by an individual named Alexandra Coculescu, covering “kitchen knives” in Class 8;
- **ALLSTRONG** – Reg. No. 5939647, owned by an individual named Steve Liu, generally covering vehicle parts, including suspension arms, shock absorbers, and gear shifting mechanisms in Class 12;
- **ALLSPA** – Reg. No. 5266250, registered August 15, 2017, owned by ETL, LLC, covering “showerheads” in Class 11;
- **ALLVAC** – Reg. No. 5082926, registered November 15, 2016, owned by Rocky Mountain Vacuum Brokers LLC, covering “vacuum cleaners” in Class 7;
- **ALLCOOL** – Reg. No. 4936647, registered April 12, 2016, owned by Allrich CNC, Ltd., covering “cooling units for industrial purposes” in Class 11.

Given that each of the above marks are comprised of the term ALL plus an arguably descriptive, if not generic term (e.g., ALLCHEF – Chefs use kitchen knives; ALLVAC for vacuum cleaners when VAC is a widely known abbreviation for vacuum cleaners; and ALLCOOL for cooling units that have the sole purpose of making spaces cool in temperature) and that each one is registered on the Principal Register, Applicant submits that its unitary mark ALLSTEEL is suggestive with respect to the applied-for goods.

Suggestive marks -- such as ALLSTEEL-- 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. *See In re George Weston Ltd.*, 228 USPQ 57 (TTAB 1985) (SPEEDI BAKE for frozen dough found to fall within the category of suggestive marks because it only vaguely suggests a desirable characteristic of frozen dough, namely, that it quickly and easily may be baked into bread); *In re The Noble Co.*, 225 USPQ 749 (TTAB 1985) (NOBURST for liquid antifreeze and rust inhibitor for hot-water-heating systems found to suggest a desired result of using the product rather than immediately informing the purchasing public of a characteristic, feature, function, or attribute); *In re Pennwalt Corp.*, 173 USPQ 317 (TTAB 1972) (DRI-FOOT held suggestive of anti-perspirant deodorant for feet in part because, in the singular, it is not the usual or normal manner in which the purpose of an anti-perspirant and deodorant for the feet would be described). The mark ALLSTEEL is, at least, suggestive about the goods, allowing the consumer to infer that the cutting and grinding tools at issue work on metal surfaces. Alternatively, some consumers could interpret the ALLSTEEL mark as suggesting something about strength and power of the products.

As a consumer encountering the mark would have to use "imagination, thought, or perception" to determine the nature of Applicant's goods covered by this application, Applicant submits that its ALLSTEEL mark, when applied to the goods in the “parent” application, simply does not fit the classic formulation of a merely descriptive mark, and therefore, any doubt regarding the mark's descriptiveness should be resolved on Applicant's behalf. *See In re Merrill Lynch, Pierce, Fenner & Smith Inc.*, 828 F.2d 1567, 1571, 4 USPQ2d 1141, 1143 (Fed. Cir. 1987).

In light of the foregoing, and recognizing that any doubts as to the mere descriptiveness of Applicant's mark must be resolved in its favor, Applicant respectfully requests that the Examining Attorney withdraw the Section 2(e)(1) refusal to register for the goods now identified in the "parent" application. *In re Micro Instrument Corp.*, 222 U.S.P.Q. 252, 255 (TTAB 1984).