

U.S. Trademark Application No.: 88220223  
Mark: #CARBONFREE  
File No.: BGT-0038TM12

### **REMARKS**

In response to the Office Action dated October 16, 2019, please reconsider the application in view of the remarks provided in this Response.

In the Office Action, the Office noted that the following issues were satisfied and overcome, namely: (1) issues relating to the identification of the goods; and (2) issues relating to descriptiveness of Applicant's mark under 15 U.S.C. §1052(e)(1). In a previous 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 nature of the goods with which Applicant intends to use or is using the mark is not clear from the present record and additional information is required.

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

According to the October 16, 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 energy that does not release carbon emissions and other means of not releasing carbon emissions and conveys a common message about the environmentally friendly practices of the good or service. 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 and/or services 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 mark was filed as an intent-to-use application under 15 U.S.C. §1051(b). 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 issue 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 failure to function as a trademark issue until Applicant provides a suitable specimen of use.

***REQUIREMENT FOR INFORMATION RELATING TO  
APPLICANT’S GOODS IS ADDRESSED.***

According to the Office Action, the nature of the goods with which applicant intends to use or is using the mark is not clear from the present record and additional information is required. According to the Office Action, applicant must provide the following:

(1) A written statement explaining whether the goods do or will consist of all vehicles that will not produce carbon-containing gas.

**RESPONSE:** Applicant notes that it filed the current application under 15 U.S.C. §1051(b) under an intent-to-use filing basis and while Applicant intends to use the mark on all the goods identified, the full extent of Applicant’s use in the marketplace is not fully known to-date. Applicant’s identification of the goods for this application is as follows:

“Motor vehicles, namely, automobiles, cars, trucks, semi-trailer trucks, commercial vehicles and heavy duty vehicles; Structural parts for motor vehicles, namely, automobiles, cars, trucks, semi-trailer trucks, commercial vehicles and heavy duty vehicles; Automobiles; Structural parts for automobiles; Electric automobiles; Structural parts for electric automobiles; Electric automobile parts, namely, motors; Vehicles, namely, automobiles, cars, trucks, semitrailer trucks, commercial motor vehicles and heavy duty motor vehicles; Motor land vehicles; Apparatus for locomotion by land, namely, cars, trucks; Motor vehicle bodies, namely bodyworks for motor vehicles; Vehicle seats, upholstery for vehicles, steering wheels for vehicles, automobile wheel hubs; Vehicle wheels; Parts and fittings for motor land vehicles, namely, structural automobile parts and powertrain components; Anti-skid chains, roof-racks, shock absorbers, suspension springs, shock absorbing springs, stabilizer tow bars, suspension systems, all for vehicles; Brake calipers for land vehicles; Motor vehicles, namely, side-by-sides, UTVs (Utility Task Vehicles), ROVs (Recreational Off-Highway Vehicles), MOHUVs (Multipurpose Off-Highway Utility Vehicles) and structural parts therefor; Electric motor vehicles, namely, electric side-by-sides, electric UTVs (Utility Task Vehicles), electric ROVs (Recreational Off-Highway Vehicles), electric MOHUVs (Multipurpose Off-Highway Utility Vehicles); Motor vehicle body parts, namely, bodyworks for motor vehicles; Trim panels for motor vehicle bodies.”

Applicant's website (found at <https://nikolamotor.com/> see Exhibit A) includes statements that its hydrogen fuel cell electric sleeper semi-truck and its fully-electric and hydrogen fuel cell day cab are both available in North America.

(2) A sample of advertisements or promotional materials featuring the goods and/or a photograph of the identified goods, or if such materials are not available, applicant must submit samples of advertisements or promotional materials of similar goods.

**RESPONSE:** See for example Applicant's various web pages located at: <https://nikolamotor.com/motor> and <https://nikolamotor.com/powersports> (Exhibit A) that include promotional materials of similar goods as included in Applicant's identification of the goods. Further, see a recent press release published March 3, 2020 located at: [https://nikolamotor.com/press\\_releases/nikola-corporation-a-global-leader-in-zero-emissions-transportation-solutions-to-be-listed-on-nasdaq-through-a-merger-with-vectoiq-74](https://nikolamotor.com/press_releases/nikola-corporation-a-global-leader-in-zero-emissions-transportation-solutions-to-be-listed-on-nasdaq-through-a-merger-with-vectoiq-74) (Exhibit A).

(3) A written statement describing in detail the nature, purpose, and channels of trade of the goods.

**RESPONSE:** See <https://nikolamotor.com/> (Exhibit A). According to Applicant's website, Applicant "is a pioneer in electric heavy duty applications." Further, Applicant's website states that it "offers both pure electric and also hydrogen electric powertrains to cover class 8 in transportation." See <https://nikolamotor.com/motor> (Exhibit A). Still further, Applicant's website states that it currently designs electric Off Highway Vehicles (OHVs) and personal watercrafts for commercial and military markets. See <https://nikolamotor.com/powersports> (Exhibit A).

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.