

# IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

**Applicant:** Ford Motor Company

**Serial No.:** 90091478

**Filed:** August 4, 2020

**Mark:** BUILT WILD

**Class:** 35

**Atty. Docket No.:** 84296398

**Examining Attorney:** Ms. Roselle M. Herrera / Law Office 124

## RESPONSE TO OFFICE ACTION

Ford Motor Company (“Applicant”) respectfully responds to the Office Action issued on September 28, 2020 as follows. The Examining Attorney states that “Registration is refused because the applied-for mark identifies a promotional campaign that applicant licenses to its customers for use in their business; it does not identify applicant’s services and does not function as a service mark for applicant.” Applicant respectfully disagrees with the Examining Attorney regarding the function of mark for the reasons set forth below.

### **1. Applicant’s Specimen Shows Use of the Mark in Connection with the Promotional Services Listed in the Application.**

Applicant’s substitute specimen shows use of the mark in the “sale, performance, or rendering of the applicant’s promotional services – i.e. promoting the goods sold by an authorized dealer. See TMEP § 1301.04 (“[P]roper use in commerce...may be established by showing the mark used or displayed as a service mark in the sale of services, *which includes use in the course of rendering or performing the services...*”) (emphasis added). *See also In re Metriplex, Inv.* 23USPQ2d 1315 (TTAB 1992) (“indicating that a specimen that does not explicitly refer to the services may be acceptable if it shows use of the mark in the rendering, i.e. sale of the services”).

In this instance the substitute specimen shows the mark in the rendering of the designated services. As specified in the application, Applicant's mark covers the following services:

“Promoting the sales of goods and services of others in the automotive industry through the distribution and dissemination of promotional materials and product information in print, television and radio broadcast, and the Internet” in Class 35.

Accordingly, the Applicant develops and distributes advertisements and product information print which promote the services of the automotive dealerships and the sale of their vehicle inventory. In the automotive industry, certain states have laws that prohibit automobile manufacturers from selling directly to individual consumers, and require distribution through authorized independent dealers. The Applicant here must therefore sell vehicles to dealers, who then resell the vehicles to individual consumer. The websites and brochures designed and implemented by the Applicant provide valuable product information, but in most instances, the product cannot be purchased directly from Ford. The Applicant's website specifically directs potential car buyers to local dealers through the DEALERSHIP LOCATIONS functionality of the website, where they can ultimately purchase or lease goods from these third parties. These materials used in the course of rendering and performing the services of promoting the goods and services of others in the automotive industry, and clearly satisfy the requirements of TMEP section 1301.

## **2. Substitute Specimen**

In response to the Examiner's request for a substitute specimen, the Applicant submits the following:



## Meet the Broncos

The Bronco Family is vast, with a reach as far as you're willing to take it and a legacy that spans generations. And the tree keeps getting bigger. At its core, a wild spirit takes root, raring to take you outdoors, off-road, and to places you've never gone before.



### 2021 Bronco

There's a whole world out there just waiting to be discovered. To find it you have to break rules, push boundaries and climb over the barriers in your way. With its relentless toughness and durability, the all-new Bronco was built to carry outdoor enthusiasts to wherever the wilderness calls. Available in two- or four-door models.

Preproduction computer-generated image shown. Vehicle available beginning summer 2021.

[Learn More](#)

[Build & Price](#)



### 2021 Bronco Sport

Meet the latest in the family. The all-new Bronco Sport is your wilderness guide with four unique series engineered to match the way you experience the outdoors. Each, expertly equipped to get you out there — To the mountain ranges, the woodland trails, and the scenic shores. Your adventure begins in a Bronco Sport, and it never ends.

Preproduction computer-generated image shown.

[Learn More](#)

[Build & Price](#)

## The Legend Returns

Get out there and find your wild in America's original sports-utility vehicle. With a legacy that can't be broken, the entire Bronco family is designed, engineered, and built for adventure. So, get ready to mount up and get dirty because the one and only legend is making its long-awaited return. The Ford Bronco – Built Wild.



### Built Wild

Three all-new SUVs with 4x4 capabilities have been Built Wild for a thrilling off-road experience with the capability and confidence to take you deep into the extremes of outdoor adventure.



### Goes Over Any type of Terrain

G.O.A.T. was the original internal code name for the '66 Bronco project at Ford. The new Bronco lives up to this original idea as the archetype of an agile, sports-oriented offroad 4x4 – with all the capability and durability it takes to endure Bronco Built Wild™ Extreme Testing measures.

Always consult the Owner's Manual before off-road driving, know your terrain and trail difficulty, and use appropriate safety gear.

### 100% Bronco

The all-new Ford Bronco family has been tested under extremely grueling conditions to ensure

This substitute specimen is a screen print of a website advertising goods and services that are sold by independent dealers, and showing the use of the mark in the course of rendering

promotional services in connection with motor vehicle sales. This page specifically has DEALERSHIP LOCATIONS tab at the top right to connect the consumer with the third party. This specimen is submitted with the response, as an additional substitute specimen. We also submit as evidence a screenshot of a third-party dealer's website showing the mark in connection with motor vehicle sales. Applicant submits that the substitute specimen was in use in commerce at least as early as the filing date of the application, August 4, 2020.

Applicant respectfully requests that the Examining Attorney accept its substitute specimen as sufficiently showing use in commerce of the applied-for mark in connection with the applied-for services. Applicant believes that this response resolves the outstanding issues and places the application in condition for registration in class 35.

Should the Examining Attorney have further questions or require additional information, please let us know.

Respectfully submitted,

FORD MOTOR COMPANY

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