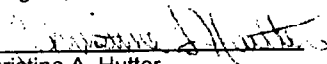


CERTIFICATE OF MAILING

I hereby certify that this **Amendment and Request for Reconsideration** is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA 22202-3514, on **October 1, 2003**.


Christine A. Hutter

TRADEMARK

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of : Don Hault
For the Mark : **RINGPROP**
Serial No. : 76/401,711
Filed : April 30, 2002
Examining Attorney : Tracy L. Fletcher
Law Office : 115
Last Office Action : April 2, 2003
Attorney Docket No. : CULZ 5 00004

Cleveland, Ohio 44114-2518
October 1, 2003

AMENDMENT AND REQUEST FOR RECONSIDERATION

Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3514

Dear Commissioner:

Responsive to the final Office Action dated April 2, 2003, kindly amend the above-identified application as follows:

1. Please amend the classification of goods to International Class 12.



10-03-2003

U.S. Patent & TMOtc/TM Mail Rcpt Dt. #58

REMARKS

Applicant respectfully requests reconsideration of the Examiner's April 2, 2003 final Office Action.

Classification

The Examiner made final the requirement that the goods are to be classified in International Class 12. Applicant concedes this requirement and has amended the application accordingly. By this amendment, Applicant has complied with the outstanding requirements of the Examiner and such an amendment is an appropriate response to a final action.

RINGPROP is Merely Suggestive

The Examiner made final the refusal to register RINGPROP under Section 2(e)(1). The Examiner has maintained the position that the mark is descriptive. The Examiner bases her refusal on the position that "PROP" is an abbreviation for propeller. She also relies on three Lexis-Nexis® story excerpts referencing "ring propellers" as a type of propeller. The Examiner asserts that Applicant does not dispute these facts and, accordingly, refuses registration under Section 2(e)(1).

To be refused registration under 15 U.S.C. § 1052(e)(1), a mark must be merely descriptive of the goods to which it relates. A mark is merely descriptive if it immediately conveys knowledge of the ingredients, qualities or characteristics of the goods. *In re Gyulay*, 3 USPQ2d 1009 (Fed. Cir. 1987); TMEP § 1209.01(b). If one must exercise

mature thought or follow a multi-stage reasoning process, the mark is merely suggestive. *In re Tennis in the Round, Inc.*, 199 USPQ 496 (TTAB 1978).

Applicant asserts that the mark RINGPROP, taken in its entirety, does not *immediately* convey knowledge of the ingredients, qualities, or characteristics of the goods. Instead, imagination, thought and perception are necessary to reach a conclusion as to the nature of the goods. At most, the mark is *merely suggestive* of the goods.

In this regard, the Examiner's own basis for asserting the mark to be descriptive consists of multi-stage reasoning or mental gymnastics that render the mark suggestive. The Examiner's reasoning requires a person to first determine that PROP can be short for PROPELLER. Next, the person must think back to whether he or she ever saw the words "ring" and "propeller" used together to describe marine propellers.¹ Finally, if the person is able to remember seeing "ring" and "propeller" used together, then, according to the Examiner's reasoning, he or she must put them together, abbreviate "propeller" to "prop" and somehow determine that RINGPROP describes a ringed marine propeller. The Examiner's lengthy cogitation alone should be sufficient to deem the mark suggestive.

During prosecution of a trademark application, it is acceptable to separate a compound mark and discuss the implications of each part thereof with respect to the question of descriptiveness as long as the ultimate determination is made on the basis of the mark in its entirety. *In re Hester Industries*, 230 USPQ 797, 799-80 (TTAB 1986)(THIGHSTIX for boneless chicken parts is suggestive rather than descriptive when

¹As will be discussed later, the Lexis-Nexis® excerpts relied upon by the Examiner are irrelevant and fail to show any third party use of "ring" and "propeller" to describe a marine propeller.

taken in its entirety). In spite of the Examiner's claims that RING and PROP taken separately may have descriptive overtones, when RINGPROP is taken in its entirety, it is merely suggestive of the goods.

Applicant acknowledges that one purpose behind the statutory prohibition against registration of merely descriptive terms is to prevent others from monopolizing such terms in relation to the goods. However, because RINGPROP is not merely descriptive of marine propellers, there would be no such breach of policy by allowing the Applicant to register RINGPROP for its "ringed marine propeller for inboard/outboard marine engines." Applicant contends that allowing the mark to register will not render it difficult for others selling similar goods to adequately describe their products.² Thus, registration will not inhibit competition. In this regard, the Examiner has not pointed to a single example of a third party use of RINGPROP to describe marine propellers.

Applicant notes that the CCPA was confronted with a similar factual situation in *In re Reynolds Metals Co.*, 178 USPQ 296 (CCPA 1973). There, the CCPA held that registration of "BROWN-IN-BAG" for transparent plastic bags was suggestive because it did not prevent competitors from informing consumers that goods may be browned in their bags. Similarly, the TTAB held that registration of "DRI-FOOT" could not preclude the use by competitors of the ordinary descriptive phrase "keeps feet dry" in connection with their products in *In re Pennwault Corp.*, 173 USPQ 318 (TTAB 1972). In the present case, Applicant's competitors will not be prevented from describing similar goods as "ringed marine propellers" or "propellers with rings."

²Competitors can appropriately reference their goods as "ringed marine propellers" or the like.

RINGPROP, when used in association with marine propellers, is at most suggestive. It requires imagination, thought and perception to reach a conclusion as to the nature of the goods. If one must exercise "mature thought or follow a multi-stage reasoning process" to determine the attributes of a product, then the term is at most suggestive and not descriptive. *In re Tennis in the Round, Inc.*, 199 USPQ 496 (TTAB 1978); *In re Nalco Chemical Company*, 228 USPQ 972 (TTAB 1986) ("VERI-CLEAN," as applied to chemical anti-fouling additives for use in refineries, is suggestive of a desired end result of use of the product); *In re C.J. Webb, Inc.*, 182 USPQ 63 (TTAB 1974); ("BRAK CLEAN," the phonetic equivalent of BRAKE CLEAN, is suggestive of a desired end result of brake cleaner). Applicant also relies on reasoning in *In re Shop-Vac Corp.*, 219 USPQ 470 (TTAB 1983) (WET/DRY BROOM is not merely descriptive of electric vacuum cleaners).

In the present situation, the occasional reference to propellers as "props," does not form a basis for refusing registration of RINGPROP. The Examiner failed to demonstrate a single use of RINGPROP (or even RING PROP) in connection with marine propellers. Even the three Lexis-Nexis® examples cited by the Examiner failed to establish that RINGPROP is descriptive. Indeed, the Examiner provided three Lexis-Nexis® articles, none of which support her position. Regarding the April 7, 1996 *Florida Times-Union* excerpt, the article is not referring to propellers but rather propeller guards or cages which surround a propeller. The guard or cage is placed outside the propeller. It is not a part of the propeller itself. This article is referring to "propeller guards or cages" in the form of a ring. Proper interpretation of the article will reveal that it is not concerned with a "ring propeller."

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