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**UNITED STATES PATENT AND TRADEMARK OFFICE**

**SERIAL NO:** 76/679933

**MARK:** LOCK BACK

**CORRESPONDENT ADDRESS:**

JOSEPH J. PREVITO  
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**GENERAL TRADEMARK INFORMATION:**

<http://www.uspto.gov/main/trademarks.htm>

**TTAB INFORMATION:**

<http://www.uspto.gov/web/offices/dcom/ttab/index.html>

**APPLICANT:** Great Neck Saw Manufacturers, Inc.

**CORRESPONDENT'S REFERENCE/DOCKET NO:**

N/A

**CORRESPONDENT E-MAIL ADDRESS:**

**EXAMINING ATTORNEY'S APPEAL BRIEF**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**  
**BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**  
**ON APPEAL**

**Applicant:** Great Neck Saw Manufacturers, Inc.

**Trademark:** LOCKBACK

**Serial No.:** 76679933

**Attorney:** Joseph J. Previto

**Address:** Collard & Roe, P.C.  
1077 Northern Boulevard  
Roslyn, NY 11576-1614

**EXAMINING ATTORNEY'S APPEAL BRIEF**

**INTRODUCTION**

The applicant has appealed the examining attorney's final refusal to register the proposed mark, LOCKBACK, for "[a] foldable utility knife comprising a handle and a blade holder with the blade holder having a removable blade and being foldable within the handle." Registration was refused on the Principal Register pursuant to Section 2(e)(1) of the Trademark Act, 15 U.S.C. Section 1052(e)(1), on the ground that the mark sought to be registered is generic as applied to the goods.

## STATEMENT OF FACTS

On July 26, 2007, the applicant filed an application under Section 1(a) of the Trademark Act to register the mark LOCK BACK for “folding utility knife” and “folding carpet knife.” On November 8, 2007, the examining attorney issued an Office action refusing registration pursuant to Section 2(e)(1) of the Trademark Act, issuing an advisory with respect to the Supplemental Register, requiring the applicant to submit a specimen that matches the drawing or to amend the drawing to match the specimen and requiring the applicant to submit a standard character claim. On November 30, 2007, the applicant submitted a claim of acquired distinctiveness based on the evidence pursuant to Section 2(f) of the Trademark Act,<sup>1</sup> presented arguments in response to the descriptiveness refusal and submitted a new drawing.

On February 5, 2008, the examining attorney issued an Office action indicating that the evidence submitted by the applicant is insufficient to establish acquired distinctiveness, maintaining the descriptiveness refusal and the requirements with respect to the drawing-specimen disagreement and the standard character claim and withdrawing the advisory with respect to the Supplemental Register. On July 28, 2008, the applicant submitted a claim of acquired distinctiveness based on five years’ use pursuant to Section 2(f) of the Trademark Act, submitted a standard character claim and a new drawing and presented arguments as to the sufficiency of its previous claim of acquired distinctiveness.

On August 22, 2008, the examining attorney issued an Office action continuing the Section 2(e)(1) refusal notwithstanding the claim of acquired distinctiveness on the

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<sup>1</sup> In its response, applicant indicated that the claim of acquired distinctiveness was submitted in accordance with the examining attorney’s suggestion. However, it must be noted that the examining attorney did not advise applicant to submit a claim of acquired distinctiveness.

ground that the mark is generic as applied to the goods and indicating that the evidence of acquired distinctiveness remains insufficient due to the highly descriptive nature of the mark. On February 23, 2009, the applicant amended the recitation of goods and presented additional arguments with respect to its claim of acquired distinctiveness. On March 17, 2009, the examining attorney issued a final refusal to register under Section 2(e)(1) of the Trademark Act on the ground that the mark is generic as applied to the goods and maintained that the applicant's evidence in support of its claim of acquired distinctiveness remains insufficient.

On September 16, 2009, the applicant filed a Notice of Appeal. On November 12, 2009, the applicant filed its appeal brief. On November 16, 2009, the applicant's brief was forwarded to the examining attorney.

### ISSUES

The issues on appeal are: 1) whether the proposed mark LOCKBACK<sup>2</sup> is generic as applied to “[a] foldable utility knife comprising a handle and a blade holder with the blade holder having a removable blade and being foldable within the handle” pursuant to Section 2(e)(1) of the Trademark Act, 15 U.S.C. Section 1052(e)(1) and 2) in the alternative, if the proposed mark LOCKBACK is not generic as applied to the goods, whether the statement of five years' use and the evidence submitted by the applicant are sufficient to support a claim of acquired distinctiveness pursuant to Section 2(f) of the Trademark Act, 15 U.S.C. Section 1052(f).

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<sup>2</sup> In its appeal brief, applicant indicates that the applied-for mark is LOCK BACK. However, in response to the examining attorney's requirement with respect to the drawing-specimen disagreement, applicant amended the drawing to LOCKBACK in the response dated July 28, 2008. Therefore, the correct mark is LOCKBACK.

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