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

Proceeding	85926813
Applicant	Lawrence Foods, Inc.
Applied for Mark	SWEET SUCCESS
Correspondence Address	ALAIN VILLENEUVE VEDDER PRICE PC 222 N LASALLE ST , STE 2400 CHICAGO, IL 60601 UNITED STATES
Submission	Appeal Brief
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Filer's Name	Alain Villeneuve
Filer's e-mail	avilleneuve@vedderprice.com, ipdocket@vedderprice.com, vhas-kett@vedderprice.com
Signature	/Alain Villeneuve/
Date	09/10/2015

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

In re Application of)	
)	
Lawrence Foods, Inc.)	Trademark Examining Attorney: David A. Hoffman
)	
Serial No.: 85/926,813)	Law Office: 107
)	
Filed: May 8, 2013)	
)	
Mark: SWEET SUCCESS)	
)	

Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

APPELLANT'S APPEAL BRIEF

Appellant, Lawrence Foods, Inc., submits this Brief pursuant to a timely notice of appeal filed under 37 C.F.R. §2.141 under §2.142. Appellant disputes the Examining Attorney's final assertion that "instructional handbooks" and/or "handbooks" cannot be considered "goods in trade," that these handbooks are not "goods in trade" for which protection can be given. Finally, Appellant has already provided four (4) different valid specimens for these goods and disagree with the conclusion that a fifth new specimen is somehow needed. The above refusals are the only refusal outstanding in the pending application. All other matters having been resolved. Appellant requests that this Board reverse the refusal allow this mark to fully register.

From: Hoffman, David

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Subject: U.S. TRADEMARK APPLICATION NO. 85926813 - SWEET SUCCESS - 37414000061 - EXAMINER BRIEF

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

Proceeding	85926813
Applicant	Lawrence Foods, Inc.
Applied for Mark	SWEET SUCCESS
Correspondence Address	ALAIN VILLENEUVE VEDDER PRICE PC 222 N LASALLE ST, STE 2600 CHICAGO, IL 60601 UNITED STATES avilleneuve@vedderprice.com, ipdocket@vedderprice.com, vhas-kett@vedderprice.com
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Filer's Name	Alain Villeneuve
Filer's e-mail	avilleneuve@vedderprice.com
Signature	/Alain Villeneuve/
Date	12/04/2015

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

In re Application of)	
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APPELLANT'S REPLY BRIEF

First, Appellant wishes to thank the Examiner for its work during this prosecution and this appeal. Appellant is rather disturbed as it feels from the Examiner's response that some wrongful adversarial impressions may have been conveyed. Nothing is further from the truth. Appellant's litigation and prosecution, if at time appears zealous is intended to be respectful and kind. The public service of the Office and the Examiner is noted and appreciated.

Having said so, what is also key is how there is really no disagreement if the expression SWEET SUCCESS is a good and valid mark available to Appellant in the statutory class it desires. The only issues at hand are technical. Unlike what the Examiner suggests, there was no fraud committed and a timely specimen was submitted. The original specimen (given in time) was part of the Appellant's handbook and remains today part of the handbook given to its customers and instore bakers to help generate more sales of its products. The fact that several new cover pages were produced after the statutory deadline to help the Examiner understand the

nature of the handbook should not be relevant to the analysis. That being said, in the event a new filing is required, Appellant will kindly do so to.

The need for an appeal truly arose once this Examiner argued that a large portion of Appellant's portfolio is in fact invalid. By claiming it's practice of using these handbooks to generate work (and not internally) is somehow not protectable, a serious shadow has been cast on multiple other marks now in use for decades. For example, if Appellant faces a competitor who also offers the same bakers handbooks using a confusingly similar to its four existing marks, this infringer would simply dismiss the claim of infringement claiming the mark as a whole cannot function. For this reason, this Board must find that use of handbooks, created by a trademark owner given to clients for use in a client facility to help generate revenues is the proper use of a handbook.

The use of these types of tools is nothing new. The law prevents a beer company from seeking and securing a registration on internal guides it uses within its own structure. For example, a handbook produced by its Quality Control given to beer tank operators, even if given a brand is simply not a use in commerce. But the law allows the same beer company to brand an app on how to best select its beers at a bar as long as it releases the app to the beer buyers. After all, the goal of trademark law is to prevent consumer confusion. Here the consumer of Appellant is the instore-baker who buys its products. These handbooks are given to these people and if a competitor also selling the same goods offer a different handbook to the instore baker, confusion can arise. Applicant understands the Examiner does not make the distinction between a client-handed handbook and an internal handbook simply because part of the handbook is formed with part of marketing brochures. As explained, this Appellant is not a large corporation and the handbook is formed of many available information including newly generated information.

Clearly catalogs can be trademarked as long as the mark is secured for catalogs and not for the goods within the book. Here the handbooks of Appellant serve as catalogs.

Appellant herein reaffirms all of the arguments presented below during this long prosecution. These arguments are incorporated therein. The mark SWEET SUCCESS, like Appellant's four fully registered marks must be registered. Appellant believes that the Board should overturn the rejection and allow this mark.

Respectfully submitted,

VEDDER PRICE P.C.

Dated: December 4, 2015

222 N. LaSalle St., Suite 2600
Chicago, Illinois 60601
(312) 609-7745

/Alain Villeneuve/

Alain Villeneuve, Reg. No. 63,228

UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NO. 85926813

MARK: SWEET SUCCESS



CORRESPONDENT ADDRESS:

ALAIN VILLENEUVE

VEDDER PRICE PC

222 N LASALLE ST STE 2600

CHICAGO, IL 60601

GENERAL TRADEMARK INFORMATION:

<http://www.uspto.gov/trademarks/index.jsp>

TTAB INFORMATION:

<http://www.uspto.gov/trademarks/process/appeal/index.jsp>

APPLICANT: Lawrence Foods, Inc.

CORRESPONDENT'S REFERENCE/DOCKET NO:

37414000061

CORRESPONDENT E-MAIL ADDRESS:

avilleneuve@vedderprice.com

EXAMINING ATTORNEY'S APPEAL BRIEF

I. INTRODUCTION

The applicant Lawrence Foods, Inc., has appealed the trademark examining attorney's final refusal to register the mark SWEET SUCCESS (in standard characters) for "Instruction handbook of

merchandising ideas and cost control instruction for bakery goods and products.” Registration was refused on the grounds that the proposed mark is not applied to “goods in trade,” and that the specimens fail to show the applied-for mark in use in commerce for the goods specified in the statement of use under Trademark Act Sections 1 and 45, 15 U.S.C. §§1051, 1127; 37 C.F.R. §§2.56(a), 2.88(b)(2).

II. **FACTS**

On 05/15/13, the applicant applied to register the mark SWEET SUCCESS (in standard characters) for “Instruction handbook of merchandising ideas and cost control instruction for bakery goods and products.”

On 08/20/13, the examining attorney approved the application for publication, and the application was published for opposition on 10/01/13. The Notice of Allowance issued on 11/26/13, and applicant filed its Statement of Use (“SOU”) on 03/04/14, identifying the specimen as “materials showing the mark in use.” *See Applicant’s Statement of Use* dated 03/04/14 at p. 1.

On 04/21/14, the examining attorney issued a non-final Office action refusing the specimen of use on the grounds that the mark as used on the specimen, disagreed with the mark on the drawing page, under §§1 and 45 of the Trademark Act, 15 U.S.C. §§1051, and 1127. Specifically, the specimen showed use of the mark as “WE CREATE SWEET SUCCESS,” while the mark appeared solely as “SWEET SUCCESS” in the drawing page.

In its response dated 04/25/14, the applicant provided a substitute specimen, which consisted of the identical page submitted with the Statement of Use, with the exception of the wording WE CREATE. As the submission of this substitute specimen did not raise a new issue pursuant to TMEP §904.07(a)(i), a Final refusal was issued on 05/27/14. The examining attorney concluded that the substitute specimen comprised mere advertising, and nevertheless, failed to show use as a “handbook” as described in the identification of goods.

On 07/01/14, the applicant filed a Request for Reconsideration (RFR) of the Final action by submitting a substitute specimen identified as “The actual handbook showing the mark in use.” The examining attorney denied the RFR on 07/28/14 because the substitute specimen failed to show use in connection with the specified goods.¹

On 10/20/14, the applicant filed a second RFR of the Final action by submitting additional substitute specimens. Thereafter, the examining attorney issued a non-final Office action dated 11/17/14, because the substitute specimens raised a new issue regarding the legitimacy and timeliness of applicant’s specimen. The examining attorney further argued that the applicant’s specimens of record did not constitute “goods in trade.”

¹ In view of the substitute specimen, the examining attorney advised the applicant that its “sales manuals” are not considered “goods in trade.” However, the examining attorney did not believe a non-final refusal was appropriate because the submission of applicant’s substitute specimen did not appear to raise a new issue.

On 05/14/15, the applicant filed a third RFR, presenting arguments that the specimens of record should be acceptable, and that as a whole, the specimens on record properly show use of the mark with the recited goods. The examining attorney considered applicant's responsive arguments and found them to be unpersuasive. Accordingly, the examining attorney denied the RFR on 07/01/15, with a full explanation as to why each of the submitted specimens was unacceptable. Applicant filed its Appeal brief on 09/10/15, and this appeal ensued. The examining attorney now submits his brief within the statutory sixty-day period.

III. ISSUE

The issue in dispute is whether the proposed mark, SWEET SUCCESS, is being used in connection with "goods in trade," and if so, whether the specimens of use show acceptable use of the proposed mark with the goods identified in the application.

IV. ARGUMENT

A. THE PROPOSED MARK IS NOT APPLIED TO "GOODS IN TRADE" PURSUANT TO 1, 2 and 45 OF THE TRADEMARK ACT, 15 U.S.C. §§1051-1052, 1127.

Registration is refused because the proposed mark, SWEET SUCCESS, is not being used in conjunction with "goods in trade."

TMEP §1202.06(b) notes the following:

[i]f the specimen, identification of goods, or other evidence in the record indicate that the applicant uses the proposed mark only on items incidental to conducting its own business, as opposed to items intended to be used by others, the examining attorney must refuse registration on the Principal Register under §§1, 2, and 45 of the Trademark Act, 15 U.S.C. §§1051, 1052, and 1127, on the ground that the proposed mark is not used on “goods in trade.”

The applicant claims use of the proposed mark SWEET SUCCESS in connection with an “Instruction handbook of merchandising ideas and cost control instruction for bakery goods and products.”

The identification of goods, specimens of use, and statements made by the applicant, clearly demonstrate that the handbooks are merely the conduit for handling, managing and ordering applicant’s own bulk goods. The handbooks are not available to the general public who are not purchasing applicant’s goods, and as will be demonstrated below, are incidental to conducting applicant’s business.

The specimens that have been properly verified include the following:

1. An image of a binder showing the trademark LAWRENCE FOODS on the cover;
2. The index page of said binder, which is entitled SALES MANUAL; and,
3. The page showing the proposed mark SWEET SUCCESS, which is entitled “ROLL OUT THE BERRIES!”

See Appellant’s Appeal Brief at p. 7.

No other specimens were evaluated by the examining attorney in coming to its final determination.

Further, while the applicant takes the position that various pages from other handbooks demonstrate acceptable use, these pages were not properly verified, and consequently not made of record. The Appellant has identified such materials as “four different pages of one of its handbooks,” but not necessarily the handbook in this case. *See Appellant’s Appeal Brief* at pp. 4-5. Nonetheless, none of these pages show use of the proposed mark SWEET SUCCESS. Accordingly, if considered, they should be afforded little weight in this analysis.

When determining whether an applicant’s goods are independent goods in trade, or merely incidental to the applicant’s primary business², factors to consider include whether:

- (1) The goods are simply the conduit or necessary tool useful only to obtain applicant’s services
- (2) The goods are so inextricably tied to and associated with applicant’s services as to have no viable existence apart from them
- (3) The goods are neither sold separately from nor have any independent value apart from applicant’s services

In re Thomas White Int’l, Ltd., 106 USPQ2d 1158, 1161-62 (TTAB 2013) (citing *Lens.com, Inc. v. 1-800 Contacts, Inc.*, 686 F.3d at 1382, 103 USPQ2d at 1676); TMEP §1202.06. None of these factors is necessarily dispositive. *Lens.com, Inc. v. 1-800 Contacts, Inc.*, 686 F.3d at 1382, 103 USPQ2d at 1676; TMEP §1202.06.

² Applicant’s primary business is the manufacture and wholesale sale of bulk icings and fruit filings. Applicant owns registrations for both these goods and services, as set forth below.

It is the examining attorney's position that applicant's "instruction handbooks" are not independent goods in trade because the submitted specimens show the proposed mark in use solely in connection with the promotion, handling, and/or selling of applicant's primary goods, i.e., bulk foods such as icings and glazes. In other words, the applicant is not engaged in the sale of handbooks, but rather furnishes them to the customer as a means for managing, handling, and/or ordering applicant's primary goods.

According to the applicant, its primary business is the manufacture and sale of fruit fillings and icings in bulk containers to be used by in-store bakeries to prepare baked goods. *See Applicant's Third Request for Reconsideration* at p. 1 dated 05/14/15. *See also Appellant's Appeal Brief* at pp. 5-6. Applicant manufactures these goods, and provides them through wholesale sales to bakeries.

With respect to the first factor, it is clear from viewing the specimens of record that applicant's handbooks are used to order applicant's icing products. As explained by the examining attorney in the refusal dated 05/27/14, the specimen did not appear to be a handbook, but merely promotional material for ordering applicant's strawberry glaze product. In support of this position, the examining attorney further noted that the bottom of the page entitled "Roll Out the Berries!," directs the consumer to "Call today for a sample and more product information!"

In addition to the call to order, the specimen also identifies various reasons why the product is desirable, in an attempt to sell the product. For example, the applicant provides information regarding strawberry consumption, with the inference that such goods are seasonally popular. The applicant also notes that

the color of the product “tantalizes the eye and taste buds.” Further, the page describes various uses of the product, warns the customer to “order early to make sure to take advantage of special seasonal allowances,” and identifies the item numbers for the various sized bulk containers of product.

From the perspective of the relevant consumer, i.e., bakery owners and managers, the proposed mark appearing at the upper right corner of this information sheet would not be perceived as a source indicator for manuals, but a source indicator for the goods and/or wholesale services of applicant. The consumer would view this page as an informational reference page or mere advertising for applicant’s primary goods and services.

As to the second factor, the specimens, along with statements made by the applicant during examination, all demonstrate that the handbook has no viable existence apart from the handling, managing, and/or ordering of applicant’s own goods.

The applicant has previously noted that the function of its handbook is to “guide bakers in the selection, purchase, management, and recipe process of its product.” *See Applicant’s Third Request for Reconsideration* at p. 2 dated 05/14/15. In its response dated 10/20/14, the applicant stated that the handbook is provided to its customers “to help its employees manage the flow of goods” and even refers to it as a “tool” for new employees of customer (grocery store) to “manage the difficult daily task[s].” More recently, the applicant notes that “The handbooks [sic] is a new type of goods which was added around 1981 to help clients with newly discovered needs and arguably to leverage these needs to further increase sales.” *See Appellant’s Appeal Brief* at p. 5.

While applicant would lead the Office to believe that such “tools” are for the benefit of anyone, the above statements and record reflect otherwise, and the benefit remains with the applicant. The applicant claims that the handbook has independent value because it acts as a tool for any baker who happens across the manual, and not simply bakeries ordering applicant’s glaze products. See *Appellant’s Appeal Brief* at pp.11-12, and 16. This argument is tenuous, at best, and the applicant has improperly based its position on pages from “other” handbooks of applicants that have not been made of record. The applicant is expecting the Office to presume that certain information is included in the handbook that does not otherwise appear in the specimen record. Accordingly, the Board should accord little weight to these pages and focus solely on the properly verified specimens.

Although some handbooks may have independent value apart from their primary goods, that is not the case here. No information exists on the submitted specimens that would act as tool independent of the applicant’s primary goods. The specimen does include other information; however, the purpose of this information is not for cost control or merchandising, as applicant argues, but to incentivize the purchase of applicant’s own goods. As applicant describes it, the “instruction handbook is designed to create merchandising ideas and concepts to drive sales” of its own product. See *Appellant’s Appeal Brief* at p. 12.

Moreover, the fact that applicant’s handbook has some utility will not automatically render them “goods in trade.” In *In re MGA Entertainment, Inc.*, 84 USPQ2d 1743, Serial No. 76603323 (TTAB August 17, 2007)[not-precedential], the Board found that despite applicant’s arguments that the boxes served as

storage containers for the toys when not in use and as carrying cases for the toys, there was no evidence that the boxes were labeled for such use, were advertised or promoted as having such utility, nor that children actually used the boxes in the manner argued.

Similarly, in this case, the applicant argues that the submitted specimens have utility to any in-store baker, and that the manuals are not simply the conduit, or inextricably tied to their primary goods. However, as in *MGA Entertainment*, the applicant has provided no evidence that the manuals are used by anyone other than the bakery who purchases applicant's products. Further, all of the information shown in the specimen pages appears to be for the purpose of purchasing applicant's primary goods. Applicant's argument that utility exists otherwise is not based on the facts or evidence in the record, and should not be considered.

With respect to the third factor, the applicant has admitted that the goods are not sold, but given to the bakery at some point after purchasing applicant's goods. *See Appellant's Appeal Brief* at p. 13. The reason such goods are not sold independently is because they have no value to anyone who is not ordering the applicant's goods. This is particularly true because most of the information in the manual refers to applicant's primary goods.

In addition to the above, the specimen entitled "Sales Manual" and dated April 2013, fails to show use of proposed mark anywhere on the page. The only other information appearing on this page specifically refers to price and product lists, presentations, guides and sell sheets. However, the nature of the presentations, guides and sell sheets is unknown without further explanation. It can only be assumed

from the cover page of the handbook that the products and prices listed in the handbook refer to the applicant's own goods.

Moreover, contrary to applicant's position that the manuals have utility outside of the sales of applicant's goods, the "IMPORTANT" note appearing in the lower left corner warns the user that the information contained in the manual is proprietary to Lawrence Food, Inc. and "SHALL NOT BE DISCLOSED TO OTHERS, DUPLICATED, USED DIRECTLY OR INDIRECTLY IN ANY WAY DETRIMENTAL TO THE INTEREST OF LAWRENCE FOODS, INC." This statement appears to undercut applicant's argument as it warns the user not to allow others to use the manual for fear of giving up proprietary information.

Even making the assumption that the "four different pages of one of its handbooks" were properly entered into record, the function of these handbook pages would not be for the benefit of others, but solely for the benefit of the applicant in selling its goods. *See Appellant's Appeal Brief* at pp. 8-11, showing reproductions of these pages.

The first unverified page appears to be a recipe for making "Raspberry Lemonade Bars," and identifies not only the item numbers associated with applicant's primary goods, but also how to prepare the food. Below the recipe is a "cost calculator" for determining the cost per ounce of applicant's goods. While this particular page has a utility to the bakery, the utility is directly related to products that applicant sells to the bakery, and is not a recipe that can be used by anyone who comes across the binder. The fact remains that the recipe specifically identifies applicant's own goods, which is reinforced by the item numbers and/or the ® symbol next to the

product name. The calculator is not a cost control device, but simply a method for determining the cost per ounce of the final bakery product, which is made from applicant's goods. The purpose of such calculator is to determine whether the bakery wants to purchase the ingredients, and perhaps, how much to sell each item for. Nevertheless, the calculator would be useless for other goods not manufactured by the applicant because it refers to applicant's specific products.

The second and third unverified pages are entitled "Spring Ideas" and "Halloween Ideas." Each page refers to a particular type of bakery item, and generally describes how to assemble each dessert. However, while it may appear that these instructions can be used by anyone to make a similar design, without applicant's own goods, the product cannot be completed as shown therein. The materials even refer to applicant's goods in the assembly instructions, wherein it directs the baker to "Drizzle Dip-N-Dry down from top edge of cake and string across top," and "Dip chocolate cupcake in melted dark chocolate Spread-N-Ice to cover top of paper liner." Without these particular branded products of applicant, the assembly cannot be finished. Moreover, none of the four pages show the proposed mark SWEET SUCCESS.

In view of the foregoing, the record clearly reflects that applicant's handbook is the conduit necessary to order applicant's goods/services, is inextricably tied to the icings and glazes as they specifically refer to such goods, are not sold separately, and have no independent value apart from the purpose of ordering or preparing the applicant's own goods.

B. THE MARK AS USED ON THE SPECIMENS OF RECORD FAIL TO FUNCTION AS A TRADEMARK FOR THE APPLICANT'S GOODS

In the alternative, the examining attorney refuses registration because the specimen of record does not show the applied-for mark in use in commerce in connection with the goods specified in International Class 016 in the statement of use. Trademark Act Sections 1 and 45, 15 U.S.C. §§1051, 1127; 37 C.F.R. §§2.34(a)(1)(iv), 2.56(a); *In re Chengdu AOBI Info. Tech. Co.*, 111 USPQ2d 2080, 2081-82 (TTAB 2011); TMEP §§904, 904.07(a), 1301.04(d), (g)(i).

Specifically, the applicant shows use of the mark SWEET SUCCESS on a one-page insert from applicant's handbooks. According to the applicant, various pages of the handbook are re-printed on a regular basis to coincide with the current product line. *See Applicant's Office Action Response* dated 10/20/14 at p. 4. While it is applicant's position that the insert is considered an "instructional handbook," the examiner disagrees." The attached evidence from *Collinsdictionary.com* defines "handbook" as follows: ³

- *a compact reference book on some subject; manual of facts or instructions*
- *guidebook*

Assuming applicant's insert is one of the "quick reference guides" identified in the manual index, the only instruction that appears on the page is for ordering the product. The page specifically instructs the customer to "Call today for a sample and more product information!" and "order early to make sure to take advantage of special seasonal allowances." In addition, the various information listed on the page reinforces its sole purposes, i.e., to act as advertising for the sale of its own products and services.

³ The Examining Attorney respectfully requests that judicial notice be taken of the attached dictionary definition. The Trademark Trial and Appeal Board may take judicial notice of dictionary definitions that (1) are available in a printed format, (2) are the electronic equivalent of a print reference work, or (3) have regular fixed editions. See TBMP §1208.04; *see In re Dietrich*, 91 USPQ2d 1622, 1631 n.15 (TTAB 2009) (taking judicial notice of definition from *Merriam-Webster Online Dictionary* at www.merriam-webster.com); *In re Petroglyph Games Inc.*, 91 USPQ2d 1332, 1334 n.1 (TTAB 2009) (taking judicial notice of definition from *Dictionary.com* because it was from *The Random House Unabridged Dictionary*); *In re Red Bull GmbH*, 78 USPQ2d 1375, 1378 (TTAB 2006) (taking judicial notice of definition from *Encarta Dictionary* because it was readily available in specifically denoted editions via the Internet and CD-ROM); TMEP §710.01(c); see also Fed. R. Evid. 201; 37 C.F.R. §2.122(a).

In reality, applicant's self-described "handbook" consists of two pages from a "sales manual," as shown on the index page of the specimen. As set forth by the applicant, "The book helps associate Applicant with the numerous products (i.e., containers) sold and often stocked in the back of the store." See *Applicant's Second Request for Reconsideration* at p. 12. What applicant has not stated is that the products referred to in the "handbook" are strictly its own goods, and not the goods of others. Indeed, it would be imprudent to include the branded goods of other manufacturers in an instruction handbook produced by the applicant.

In view of the foregoing, relevant consumers would not view this specimen as a "handbook," but rather, mere advertising for applicant's primary goods. The requirement should, for that reason, be affirmed.

C. APPLICANT'S SPECIMEN SUBMITTED 10/20/14 WAS DIGITALLY ALTERED AND CREATED AFTER THE DEADLINE FOR SUBMITTING THE STATEMENT OF USE.

Registration was also refused because the specimens submitted 10/20/14 appear to have been digitally created or altered to submit as a specimen in the statement of use, and thus do not show the applied-for mark in use in commerce. Trademark Act Sections 1 and 45, 15 U.S.C. §§1051, 1127; 37 C.F.R. §§2.34(a)(1)(iv), 2.56(a); TMEP §§904, 904.07(a), 1301.04(g)(i). See also *Appellant's Appeal Brief* at p. 8.

An image that has been digitally created or altered to show the applied-for mark on or in connection with applicant's goods and/or services usually has not been disseminated to the public, and thus does

not show actual use of the mark in commerce. See 15 U.S.C. §1127; TMEP §§904.04(a), 904.07(a); cf. *In re Chica, Inc.*, 84 USPQ2d 1845, 1848 (TTAB 2007) (holding that “a mere drawing of the goods with an illustration of how the mark may be displayed” was not an acceptable specimen because it did not show actual use in commerce); *In re The Signal Cos.*, 228 USPQ 956, 957-58 n.4 (TTAB 1986) (noting that a printer’s proof of an advertisement would not be an acceptable specimen because it does not show actual use in commerce).

As can be seen, the applicant simply added the language “& SWEET SUCCESS® INSTRUCTIONAL HANDBOOK FOR CUSTOMERS” in order to overcome the requirements and/or refusals set forth in the previous actions. However, it is likely that this altered image has not been disseminated to public, and does not show actual use in commerce.

Nevertheless, even assuming the image was not altered for purposes of showing use, it remains unacceptable because it was created after the deadline for filing a Statement of Use. The Notice of Allowance issued on 11/26/13, requiring a specimen to show use by 5/26/14. Applicant did not file an extension of time to extend this deadline. In viewing the specimen of use filed 10/27/14, the image shows a date of “October 2014” at the bottom of the page, which indicates that the page was not created until five months post SOU deadline. For this reason, AND the reason stated above, the specimen cannot be accepted.

D. OTHER CONSIDERATIONS RAISED BY APPELLANT

The applicant fervently points to several prior registrations owned by the applicant in connection with identical goods. However, trademark examining attorneys are not bound by the actions of past examining attorneys in prior registrations, even if the registrations have some characteristics similar to the application at issue; each case is decided on its own merits. *In re Manwin/RK Collateral Trust*, 111 USPQ2d 1311, 1315 (TTAB 2014) (citing *In re Nett Designs, Inc.*, 236 F.3d 1339, 1342, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001)).

V. CONCLUSION

For the foregoing reasons, the refusals to register under Trademark Act Sections 1, 2 and 45, 15 U.S.C. §§1051-1052, 1127; TMEP §1202.06(b) and Trademark Act Sections 1 and 45, 15 U.S.C. §§1051, 1127; 37 C.F.R. §§2.56(a), 2.88(b)(2); TMEP §§904, 1109.09(b) should be affirmed.

Respectfully submitted,

/David A. Hoffman/

Examining Attorney

Law Office 107

(Ph) 571-272-8805

(Fx) 571-273-8805

Email: david.hoffman@uspto.gov

J. Leslie Bishop

Managing Attorney

Law Office 107

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handbook (ˈhændˌbʊk)

► Definitions

noun

1. a compact reference book on some subject; manual of facts or instructions
2. [guidebook \(sense 1\)](#)
3. (US) a book in which bets are recorded, as on horse races

Word Frequency ●●●●●

WE RECOMMEND



Brooks Brothers

[Collins Word of the Year](#)



► Word Origin

U: handboc; trans. of L. [manuale](#) (see [manual](#)); modern senses init. by Ger. [handbuch](#)

► Synonyms

► [guidebook](#), Baedeker, [guide](#), instruction book, [manual](#)

[View thesaurus entry](#)

► Translations for 'handbook'

American English: [handbooks](#) A handbook is a book that gives you advice and instructions about a particular subject, tool, or machine... a handbook on growing vegetables. handbooks

Arabic: دليل	Brazilian Portuguese: manual
Chinese: 手册	Croatian: priručnik
Czech: příručka	Danish: håndbog
Dutch: handboek	European Spanish: manual
Finnish: käsikirja	French: manuel
German: Handbuch Handbücher	Greek: εγχειρίδιο
Italian: manuale	Japanese: ハンドブック
Korean: 안내서	Norwegian: håndbok
Polish: podręcznik przewodnik	Portuguese: manual
Romanian: manual manuale	Russian: справочник
Spanish: manual	Swedish: handbok håndbócker
Thai: คู่มือ	Turkish: referans kitabı
Ukrainian: довідник	Vietnamese: sổ tay hướng dẫn

► Example Sentences Including 'handbook'

I wrote the brochures they sent to clients, wrote the This is Data Associates' handbook they give

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["Hoverboards," "pastebin" and "Norwegian option"](#)

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Related Terms

1 results

► [guidebook](#) (sense 1)

[Browse nearby words](#)

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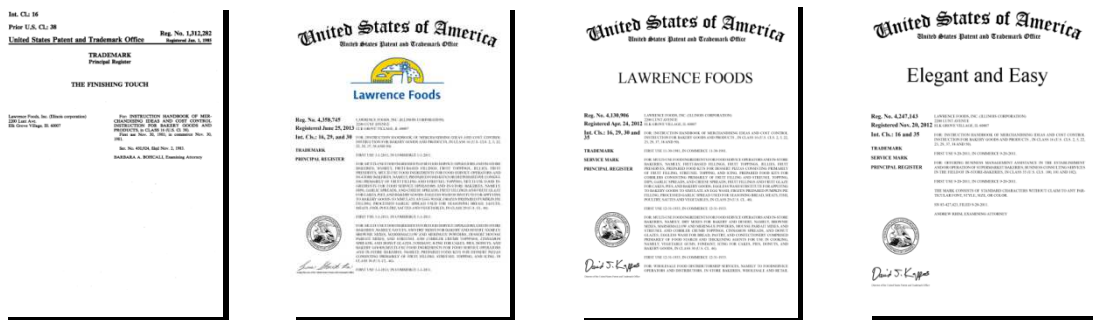
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EVIDENCE ON APPEAL

APPELLANT'S EVIDENCE

1. Appellant's Four Issued Certificates for these Goods

Appellant already owns four fully registered marks for the identical goods at issue in this appeal. Each of these certificates was introduced as Exhibit A to Appellant's May 14, 2015 response. These certificates are reproduced below:



Appellant's Four Issued Registrations

a. THE FINISHING TOUCH®

On January 1, 1985, Appellant registered U.S. Reg. No. 1,312,282 for the mark THE FINISHING TOUCH® in International Class 016 for instruction handbook of merchandising ideas and cost control instruction for bakery goods and products. This mark was renewed twice (2005 and 2015) and is still in full force.

b. LAWRENCE FOODS®

On April 24, 2012, Appellant registered U.S. Reg. No. 4,130,906 for the mark LAWRENCE FOODS in International Class 016 also for instruction handbook of merchandising ideas and cost control instruction for bakery goods and products. This mark is still in full force.

c. ELEGANT AND EASY®

On November 20, 2012, Appellant registered U.S. Reg. No. 4,247,143 for the mark ELEGANT AND EASY in International Class 016 for Instruction Handbook of Merchandising Ideas and Cost Control Instruction for Bakery Goods and Products. This mark is still in full force.

d. LAWRENCE FOODS & DESIGN®

On June 25, 2013, Appellant registered U.S. Reg. No. 4,358,745 for the mark LAWRENCE FOODS & DESIGN in multiple classes. One of these classes is International Class 016 for instruction handbook of merchandising ideas and cost control instruction for bakery goods and products. This mark is still in full force.

2. *Appellant's Business Model Evidence*

In an effort to explain to the Examiner the nature of Appellant's business and the associated role played by Appellant's multiple instruction handbooks, evidence was introduced.

a. *Four Pages From Appellant's Handbook*

As part of the Third Request for Reconsideration filed on May 14, 2015, Appellant introduced four different pages of one of its handbooks. These pages are reproduced below:



POMOLENE®, GLAZE 'N GLOSS®, and DIP N DRY®

d. Evidence of the Marketplace

As part of the Second Request for Reconsideration filed on October 20, 2014, Appellant introduced data from the internet giving context to in-store bakery volumes and an image of a display. This evidence is reproduced below:

In-Store Bakery Goods Market Exceeds \$13 Billion

Posted by Kristen Cloud | Date: January 08, 2014 | in: National, Perishables |
Leave a comment | 37 Views




Grocery retailing's reliance on in-house bakeries, combined with higher price points, has allowed the in-house baked goods market to experience dollar sales increase every year since 2008. Packaged Facts expects these gains to continue through 2017 and beyond despite challenges due to economic conditions and health and diet concerns. Consumer spending is not likely to surge over the next few years, and more consumers will look to reduce bread and sugar in their diets. Nonetheless, the sandwich remains a staple of American-style on-the-go eating, and most consumers will still want to indulge at least occasionally in sweet baked affordable indulgences. Desserts should continue to drive overall growth with similar sizes, portion control, and on-the-go products leading the way. Breads and rolls as a whole should lag, but artisan and higher quality breads, as well as different varieties of rolls, should stand out on the shelves. Commodity breakfast bakery products will be challenged to remain compelling as consumers seek out these products in various other outlets, including foodservice.



3. Appellant's Multiple Specimens

Appellant entered four specimens. The first on March 4, 2014 illustrating the mark SWEET SUCCESS on the upper right corner of the page from the handbook. On April 25, 2014, in an effort to get allowance, the Appellant changed the page and submitted the same specimen and removed two words which preceded the mark. Both specimens are reproduced below:




We Create Sweet Success® | Family-Owned Since 1890
Imagination • Agility • Passion

Roll Out the Berries!

Spring is in the air, and that means strawberries!

This perennial consumer favorite returns to the scene bursting with flavor... and possibilities!

- Strawberries are the first fruit to ripen in the spring... a traditional seasonal harbinger.
- Did you know that Strawberry is very popular on dessert menus, showing up on 32% of all menus!
- 94% of United States households consume strawberries and over 53% of kids (7 – 9) picked strawberries are their favorite fruit.



Strawberry Glaze Shines On!


- Ready-to-use, and eager to please, this glaze adds the perfect finishing touch: its bright red color and sweet strawberry flavor tantalizes the eye and taste buds.
- Great for use on pies, tarts, shortcakes, even as an economical filling!
- Order early to make sure to take advantage of special seasonal allowances.

Item #	GTIN	Description	Net Wt	Gross Wt	Pack
147902	10089763479022	Strawberry Glaze	24	26	12/28 Sleeves
147402	10089763474020	Strawberry Glaze	20	21.5	2 GL PL
147406	10089763474065	Strawberry Glaze	45	50	6/150 Cans
121447	10089763214470	Strawberry Glaze	32	35	4/75 GL PL

Call today for a sample and more product information!

Lawrence Foods MAJOR #Finishing Touch® In Supreme

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Sweet Success® From Our Family Since 1890
Imagination • Agility • Passion

Roll Out the Berries!

Spring is in the air, and that means strawberries!

This perennial consumer favorite returns to the scene bursting with flavor... and possibilities!

- Strawberries are the first fruit to ripen in the spring... a traditional seasonal harbinger.
- Did you know that Strawberry is very popular on dessert menus, showing up on 32% of all menus!
- 94% of United States households consume strawberries and over 53% of kids (7 – 9) picked strawberries are their favorite fruit.



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- Order early to make sure to take advantage of special seasonal allowances.

Item #	GTIN	Description	Net Wt	Gross Wt	Pack
147902	10089763479022	Strawberry Glaze	24.0	26.0	12/28 Sleeves
147402	10089763474020	Strawberry Glaze	20.0	21.5	2 GL PL
147406	10089763474065	Strawberry Glaze	45.0	50.0	6/150 Cans
121447	10089763214470	Strawberry Glaze	32.0	35.0	4/75 GL PL

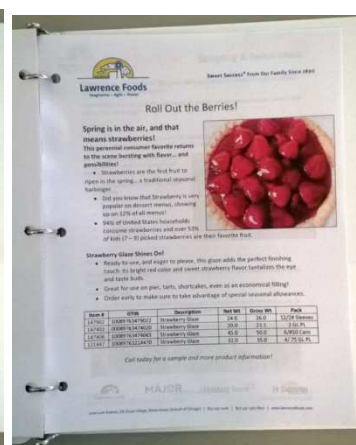
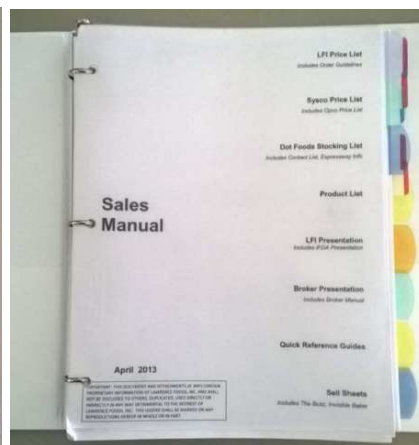
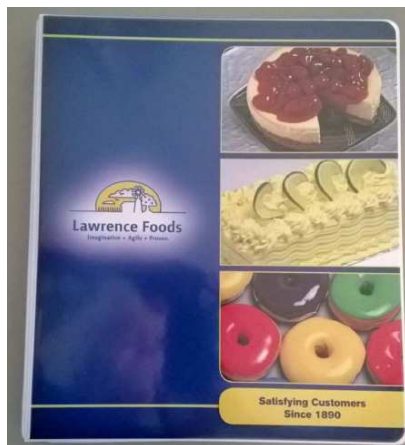
Call today for a sample and more product information!

Lawrence Foods MAJOR #Finishing Touch® In Supreme

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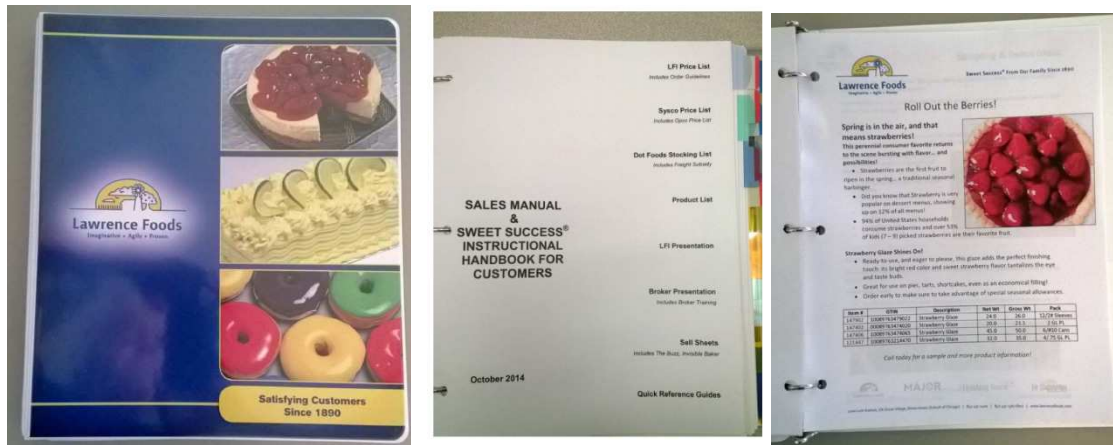
March 4, 2014 & April 25, 2014 Specimens A / B

Rejecting the two first specimens, on July 1, 2014, the Appellant introduced pictures of the first specimens in the handbook, a picture of the cover of the handbook, and of the first page.



July 1, 2014 Specimen C

The Examiner rejected once again the specimen on a new technicality and on October 20, 2014, applicant made a change to the middle page and submitted a fourth time the same specimen.



October 20, 2014 Specimen D

THE OFFICE'S EVIDENCE

The only evidence entered into the Record by the Examiner dates from the 4th Office Action dated July 1, 2015. In this latest action, the Examiner made a new ground of rejection while the rejection is final and offered a page from the MacMillan Dictionary to define “handbook” in an effort to explain that Appellant’s specimen did not illustrate a “handbook.”



Only Evidence of the Examiner

DESCRIPTION OF THE RECORD

On November 26, 2013, U.S. Application No. 85/926,813 was allowed.

On March 4, 2014, Appellant enters a statement of use along with Specimen #A.

On April 21, 2014, the Examiner rejected Specimen A based on the fact the mark as used was “WE CREATE SWEET SUCCESS®” and not simply “SWEET SUCCESS®.” The Applicant was invited to enter a “substitute specimen” but refused that the Appellant withdraw the declaration of use, and the Examiner made a strange advisory rejection that the mark is the title of a single work and could also be rejected on this new ground.

On April 24, 2014, while Appellant strongly disagreed with the Examiner who should not dictate how Appellant conducts its business, a new Specimen B was entered in which the two words “WE CREATE” were removed.

On May 27, 2014, the Examiner issued a final rejection. The examiner wrote: “However, the specimen does not appear to be a handbook but promotional materials for ordering

strawberry glaze.” The Examiner concluded the specimen [Specimens A & B] was “not view this specimen as a handbook.”

On July 1, 2014, in response, the Appellant provided pages from the handbook which included its cover, one of the index pages and the Specimen B already provided with punch holes into the handbook. This new specimen is referred to herein as Specimen C.

On July 28, 2014, Specimen C was once again rejected by the Examiner. In the rejection, the Examiner wrote: “However, even assuming the ‘sales manual’ specimen was acceptable for ‘instruction handbooks,’ ‘sales manuals’ are not considered “goods in trade.”

On October 20, 2014, while disagreeing with the Examiner’s entire pointless logic, the Appellant entered the fourth and last specimen (Specimen D) in which the title of the index page was altered from “Sales Manual” to “Sales Manual & Sweet Success® Instructional Handbook for Customers” to lift any ambiguity in the mind of the Examiner (which is absent from the mind of the Appellant and its customers).

On November 17, 2014, the Examiner maintained the rejection based on a failure to function as “goods in trade” and also took issue with the timing of the amended specimen.

On May 14, 2015, the Appellant made a passionate plea trying to explain this Appellant owned multiple other marks for these same goods, and that use of handbooks was a long established practice by the Appellant and this industry. The plea was unsuccessful.

On July 1, 2015, the Office doubled-down on its refusal and even issued an impermissible new rejection at a final stage. Now the entire set of specimens (A, B, C, and D) are said to fail to show use, and cannot function as goods in trade.

THE ISSUES ON APPEAL

Issue #1: Do the Specimens Show use on identified goods?

Issue #2: Are Appellant's instruction handbooks "goods in trade"?

Issue #3: Is one or more of the four specimens already provided sufficient?

ARGUMENT

Appellant's Unique Recitation of Goods

For the last 30+ years, Appellant has owned and filed for multiple marks, each time for the same recitation of goods in Class 016. This recitation reads: "Instruction handbook of merchandising ideas and cost control instruction for bakery goods and products." It is difficult to conceive of more specific and detailed recitation. The specimen, as offered must simply tailor to this recitation and show that in fact these goods exist and use the mark for branding in a way recognizable in the Appellant's industry.

Appellant's Industry

We all wish we could afford the services of Gordon Ramsey. Sadly, few can and in the food industry, many processes are automated or simplified to help reduce costs. As explained, retail surfaces where food is purchased now offers "In-Store Bakery Goods." Appellant introduced evidence this market now exceeds \$13,000,000,000 a year. While high-end stores have expert bakers on staff, many don't. These stores have two options, buy the baked goods directly from a vendor (like Starbucks®) or hire bakers and what is called 'decorators' to help create these products. Reproduced below is the image entered by Appellant as evidence showing what a nice bakery display can look like:



But walking into the kitchen area of these in-store bakeries reveals a different world. First, bakers rarely have advance training or a capable of generating new fresh ideas on products for the display. These bakers teach young ‘decorators’ how to ice donuts, decorate them, and fill products with fillings and other preparations. Also introduced in the record was the specimen of several of Appellant’s goods sold in white pales.

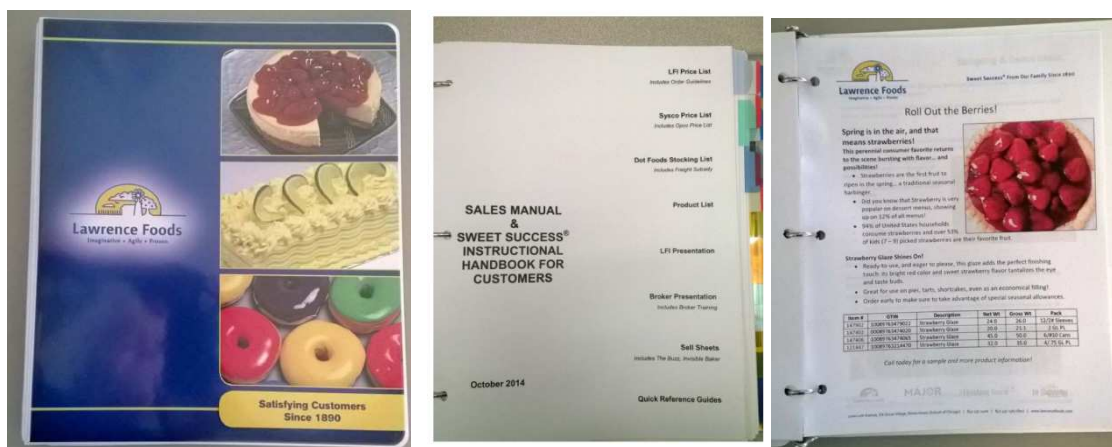


POMOLENE®, GLAZE 'N GLOSS®, and DIP N DRY®

As one can imagine, sitting between a wall of these large pales and filling machines, it is difficult for bakers and decorators to flow with creativity. The Appellant’s instruction handbook is designed to create merchandising ideas and concepts to drive sales. Linked with these are sales sheets and promotional materials which allows bakers to manage costs. Said differently,

Appellant's instructional handbooks serve as the Robert Ervine in Restaurant Impossible® on the Cooking Channel. Bakers and their help must be guided, using a tool.

For this reason, Appellant has multiple "instruction handbook of merchandising ideas and cost control instruction for bakery goods and products" which are given to clients. These are generally plasticized binders for use around these in-store bakeries. Specimens C and D clearly show what are these "instruction handbooks"



October 20, 2014 Specimen D

As part of the evidence given to the Examiner of this handbook, multiple pages from the handbook have been given.

Issue I: Failure to Show Use on Identified Goods

On July 1, 2015, after filing three requests for reconsideration, the Examiner issues a new final rejection which provides in part:

Registration is refused because the specimen of record does not show the applied-for mark in use in commerce in connection with the goods specified in International Class 016 in the statement of use. Trademark Act Sections 1 and 45, 15 U.S.C. §§1051, 1127; 37 C.F.R. §§2.34(a)(1)(iv), 2.56(a); In re Chengdu AOB Info. Tech. Co., 111 USPQ2d 2080, 2081-82 (TTAB 2011); TMEP §§904, 904.07(a), 1301.04(d), (g)(i). Specifically, the applicant shows use of the mark SWEET SUCCESS on what appears to be a one-page insert from applicant's "sales manual." According to the applicant, various pages of the "sales manual" are re-printed on a regular basis to coincide with the current product line. While it

is applicant's position that the insert is considered an "instructional handbook," the examiner disagrees. A "handbook" is defined as "a small book that gives information about a subject or instructions about how to use something." See attached definition from <http://www.macmillandictionary.com/dictionary/british/handbook>.

Assuming applicant's insert is one of the "quick reference guides" identified in the manual index, the only instruction that appears on the page is for ordering the product. The insert specifically instructs the customer to "Call today for a sample and more product information!" Accordingly, relevant consumers would not view this specimen as a "handbook" per se, but as mere advertising for a seasonal strawberry glaze product. An application based on Trademark Act Section 1(a) must include a specimen showing the applied-for mark in use in commerce for each international class of goods and/or services identified in the statement of use. 15 U.S.C. §1051(a)(1); 37 C.F.R. §§2.34(a)(1)(iv), 2.56(a); TMEP §§904, 904.07(a); see *In re Gulf Coast Nutritionals, Inc.*, 106 USPQ2d 1243, 1247 (TTAB 2013).

Even after pages and pages of background, explanation, and trade industry information simply does not agree that Appellant's binder is an "instructional handbook." The Examiner explains: "Accordingly, relevant consumers would not view this specimen as a "handbook" per se, but as mere advertising for a seasonal strawberry glaze product." This statement is unsupported by any evidence. Faced with this absurdity, the Appellant was forced to file the current appeal with the Board.

The Trademark Manual of Examining Procedures (TMEP) is rather clear on the Examiner's capacity to dismiss what Appellant calls this binder. "It is the responsibility of the applicant and the applicant's attorney to determine whether an assertion of use in commerce is supported by the relevant facts. The validity of an applicant's assertion of use in commerce generally does not arise in ex parte examination. The examining attorney will normally accept the applicant's verified claim of use in commerce without investigation into whether the use referred to constitutes "use in commerce.'" TMEP §901.04.

The Examiner argues the binder is not an instructional handbook only based on a dictionary definition of “handbook.” Appellant’s evidence includes four registered marks over a span of 30+ years during which these books were called instructional handbooks. The evidence include multiple pages. Most importantly, the recitation as filed is not simply for “handbooks” but is for “instruction handbook of merchandising ideas and cost control instruction for bakery goods and products.” As shown by the evidence, Appellant’s SWEET SUCCESS handbook is perfectly aligned with this recitation.

Since the current class is for goods (i.e. IC 016), Section 45 of the Trademark Act, 15 U.S.C. §1127 defines “use in commerce” as:

The term “use in commerce” means the bona fide use of a mark in the ordinary course of trade, and not made merely to reserve a right in a mark. For purposes of this Act, a mark shall be deemed to be in use in commerce-- (1) on goods when— (A) it is placed in any manner on the goods or their containers or the displays associated therewith or on the tags or labels affixed thereto, or if the nature of the goods makes such placement impracticable, then on documents associated with the goods or their sale, and (B) the goods are sold or transported in commerce,” TMEP §901.01 citing portions of 15 U.S.C. §1127.

For over 30 years, Appellant has used multiple trademarks in association with its “Instruction Handbook of Merchandising Ideas and Cost Control Instruction for Bakery Goods and Products.” Each time it has called the books the same way. The dissection by the Examiner of how Appellant’s trade is conducted is unsupported by any evidence. In this case, the Examining Attorney second guesses Appellant’s naming of these handbooks.

Issue II: Goods In Trade

After 10 years of prosecution of hundreds of marks, Appellant’s counsel had never seen the first rejection ground. The second ground is equally as rare. The Examiner argues as a whole, handbooks are not “goods in trade.” Appellant has fully briefed this argument during the

prosecution and the Examiner simply refused to understand the nature of the instructional handbooks of Appellant.

Once again, the TBMP is rather clear, “if the specimen, identification of goods, or other evidence in the record indicate that the applicant uses the proposed mark only on items incidental to conducting its own business, as opposed to items intended to be used by others, the examining attorney must refuse registration...” TBMP §1202.06(b) (emphasis added). So the Examiner must first prove the instructional handbooks are used by the Appellant to conduct its own business and these handbooks are not used by others. No evidence is entered by the Examiner in support of this fact. As demonstrated by the Evidence of the Appellant, these instructional handbooks serve only to in-store bakers.

The above underline portion of the TBMP is missing from the Office Action. The TMEP §1202.06(a) gives valid examples of goods considered in trade that are not sold to customers. For example, calendars with a utilitarian function and purpose that has been regularly distributed in commerce for several years to promote an applicant's plastic film constitutes goods in trade. *In re United Merchants & Mfrs., Inc.*, 154 USPQ 625 (TTAB 1967). The same way, ball point pens used to promote applicant's tools are goods in trade, where they have a utilitarian function and purpose. *In re Snap-On Tools Corp.*, 159 USPQ 254 (TTAB 1968). The goods to be “goods in trade” when given as promotional items must have a utility of their own. A calendar or a ball pen branded are goods in trade, surely the instructional handbook has a useful function of instructing the user. Once again, the full recitation of the goods clearly describes the utility function. Appellant tried in vain to explain to the Examiner how the handbooks are useful and have utilitarian purposes.

What is key to the Board is how the Examiner's second rejection is also based on no evidence. The fact Appellant has used these handbooks for 30+ years, has branded them and continues the branding of SWEET SUCCESS is evidence these books are an integral part of the Appellant's business model and branding. These goods are not promotional, they help customers empower their staff.

Issue III: The Four Specimens

The third and final ground of rejection is one of "digitally altered specimen created after the statement of use deadline." On November 26, 2013, the Notice of Allowance issued. It gave Appellant six months (or until May 26, 2014) to enter a statement of use. On March 4, 2014 (months before the deadline), the Appellant entered a specimen of use (Specimen A). On April 25, 2014 (also a month before the deadline), the Appellant entered a second specimen of use (Specimen B). Both the entry of Specimen A and Specimen B was timely. The two other specimens entered (Specimens C and D) simply illustrate other pages of the handbook and include Specimen B as timely submitted.

The Examiner argues that since the index page of the handbook given in October 2014 was created after the expiration of the statement, it is untimely. When both Specimen A and Specimen B were created and submitted, they both were part of binders. The fact that Appellant offered a picture of the cover and of the index is unrelated to the specimen requirement. The page of Specimen A, and B (which is part of the Specimen C and D) includes the applied for mark.

Special Request to the Board

Appellant is confused as to the motivation of the Office. Appellant filed for a fifth trademark for its "instructional handbooks" this time for one named SWEET SUCCESS™. The

mark is used as it always has. The instructional handbooks named THE FINISHING TOUCH® have been around for more than three decades. Other instructional handbooks of this Appellant are called ELEGANT AND EASY® or are branded with the mark LAWRENCE FOODS®. Appellant has been around for generations. It's choice of marks is not whimsical and while Certificates have dates of first use, this Appellant will not mind if this Board offer guidance out of this situation. What is important is for SWEET SUCCESS™ to issue alongside Appellant's other marks so bakers can use THE FINISHING TOUCH® handbooks, ELEGANT AND EASY® handbooks, and now SWEET SUCCESS® handbooks.

Appellant's counsel has tried in vain to adapt its own instructional manual in a way which the Examiner would enjoy simply to avoid this Appeal. This has been unsuccessful. Appellant has tried in vain to explain how these handbooks are used by in-store bakers. Appellant herein asks this Board to help push this application to allowance.

Appellant herein reaffirms all of the arguments presented below during this long prosecution. These arguments are incorporated therein. The mark SWEET SUCCESS, like Appellant's four fully registered marks must be registered. Appellant believes that the Board should overturn the rejection and allow this mark.

Respectfully submitted,

VEDDER PRICE P.C.

Dated: August 31, 2015

222 N. LaSalle St., Suite 2600
Chicago, Illinois 60601
(312) 609-7745

/Alain Villeneuve/

Alain Villeneuve, Reg. No. 63,228