

**To:** M & W INDUSTRIAL EQUIPMENT CORP.([kurt@inet-pc.com](mailto:kurt@inet-pc.com))  
**Subject:** U.S. Trademark Application Serial No. 97120737 - FORKLIFTTRADER.COM  
**Sent:** August 24, 2022 07:36:12 PM EDT  
**Sent As:** [tmng.notices@uspto.gov](mailto:tmng.notices@uspto.gov)

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**Attachments**

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**United States Patent and Trademark Office (USPTO)  
Office Action (Official Letter) About Applicant's Trademark Application**

**U.S. Application Serial No.** 97120737

**Mark:** FORKLIFTTRADER.COM

**Correspondence Address:**

M & W INDUSTRIAL EQUIPMENT CORP.  
1610 PEARL STREET  
WAUKESHA WI 53186 UNITED STATES

**Applicant:** M & W INDUSTRIAL EQUIPMENT CORP.

**Reference/Docket No.** N/A

**Correspondence Email Address:** [kurt@inet-pc.com](mailto:kurt@inet-pc.com)

**NONFINAL OFFICE ACTION**

**The USPTO must receive applicant's response to this letter within six months of the issue date below or the application will be abandoned.** Respond using the Trademark Electronic Application System (TEAS). A link to the appropriate TEAS response form appears at the end of this Office action.

**Issue date:** August 24, 2022

The referenced application has been reviewed by the assigned trademark examining attorney. Applicant must respond timely and completely to the issue(s) below. 15 U.S.C. §1062(b); 37 C.F.R. §§2.62(a),

2.65(a); TMEP §§711, 718.03.

## **SEARCH**

The trademark examining attorney has searched the USPTO database of registered and pending marks and has found no conflicting marks that would bar registration under Trademark Act Section 2(d). 15 U.S.C. §1052(d); TMEP §704.02.

## **SUMMARY OF ISSUES:**

- Descriptive
- Unacceptable Specimen
- Description of the Mark

## **SECTION 2(e)(1) REFUSAL - MERELY DESCRIPTIVE**

Registration is refused because the applied-for mark merely describes a feature, ingredient, characteristic, purpose, function, intended audience of applicant's goods and/or services. Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1); *see* TMEP §§1209.01(b), 1209.03 *et seq.*

A mark is merely descriptive if it describes an ingredient, quality, characteristic, function, feature, purpose, or use of an applicant's goods and/or services. TMEP §1209.01(b); *see, e.g., In re TriVita, Inc.*, 783 F.3d 872, 874, 114 USPQ2d 1574, 1575 (Fed. Cir. 2015) (quoting *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 1173, 71 USPQ2d 1370, 1371 (Fed. Cir. 2004)); *In re Steelbuilding.com*, 415 F.3d 1293, 1297, 75 USPQ2d 1420, 1421 (Fed. Cir. 2005) (citing *Estate of P.D. Beckwith, Inc. v. Comm'r of Patents*, 252 U.S. 538, 543 (1920)). However, the determination of whether a mark is merely descriptive is made in relation to an applicant's goods and/or services, not in the abstract. *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 1254, 103 USPQ2d 1753, 1757 (Fed. Cir. 2012); *In re The Chamber of Commerce of the U.S.*, 675 F.3d 1297, 1300, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012); TMEP §1209.01(b). “Whether consumers could guess what the product [or service] is from consideration of the mark alone is not the test.” *In re Am. Greetings Corp.*, 226 USPQ 365, 366 (TTAB 1985).

In this case, applicant has applied to register the mark FORKLIFTTRADER.COM, in connection with the following goods: fork lift trucks.

As demonstrated by the attached dictionary evidence, the term "trader" is defined as a merchant. Please see the attached evidence. In addition, applicant's identification indicates that the goods are fork lift trucks. The non-source-identifying generic top-level domain (gTLD) “.com” merely indicates an Internet address for use by commercial, for-profit organizations. *See, e.g., Booking.com B.V. v. USPTO*, 915 F.3d 171, 185 (4th Cir. 2019), *aff'd*, 140 S. Ct. 2298, 2304, 2020 USPQ2d 10729, at \*2 (2020) (“Where the proposed mark is a composite that includes .com, we clarify that . . . .com does not itself have source-identifying significance when added to [a second-level domain] like booking.”); *In re 1800Mattress.com IP LLC*, 586 F.3d 1359, 1364, 92 USPQ2d 1682, 1685 (Fed. Cir. 2009); *In re Oppedahl & Larsen LLP*, 373 F.3d 1171, 1175-77, 71 USPQ2d 1370, 1373-74 (Fed. Cir. 2004); *see also* TMEP §§1209.03(m), 1215.01. As such here, the wording, FORKLIFTTRADER.COM merely describes the goods because it immediately conveys information about them, namely, that they originate from a commercial enterprise as in a merchant that provides fork lifts. In addition, the attached evidence from applicant's website further confirms the descriptive significance as describing a

merchant/dealer specializing in forklifts. Please see the attached evidence.

Generally, where the individual components of a mark retain their descriptive meaning in relation to the goods as here, the combination results in a composite mark that is itself descriptive and not registrable. *In re Fat Boys Water Sports LLC*, 118 USPQ2d 1511, 1516 (TTAB 2016) (citing *In re Tower Tech, Inc.*, 64 USPQ2d 1314, 1317-18 (TTAB 2002)); TMEP §1209.03(d); *see, e.g., DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 1255, 103 USPQ2d 1753, 1758 (Fed. Cir. 2012) (holding SNAP SIMPLY SAFER merely descriptive for various medical devices, such as hypodermic, aspiration, and injection needles and syringes); *In re Fallon*, 2020 USPQ2d 11249, at \*12 (TTAB 2020) (holding THERMAL MATRIX merely descriptive of a heat-responsive, malleable liner that is an integral component of an oral dental appliance).

Only where the combination of descriptive terms creates a unitary mark with a unique, incongruous, or otherwise nondescriptive meaning in relation to the goods and/or services is the combined mark registrable. *See In re Omniome, Inc.*, 2020 USPQ2d 3222, at \*4 (TTAB 2019) (citing *In re Colonial Stores, Inc.*, 394 F.2d 549, 551, 157 USPQ 382, 384 (C.C.P.A. 1968); *In re Shutts*, 217 USPQ 363, 364-65 (TTAB 1983)); *In re Positec Grp. Ltd.*, 108 USPQ2d 1161, 1162-63 (TTAB 2013).

In this case, both the individual components and the composite result are descriptive of applicant's goods and do not create a unique, incongruous, or nondescriptive meaning in relation to the goods.

It is noted that applicant's applied-for mark includes stylization and common border. However, descriptive significance is not obviated. Background designs in composite marks consisting of common geometric shapes, such as circles, ovals, squares, triangles, diamonds, and other geometric designs, are generally not regarded as marks for goods and/or services absent a showing of distinctiveness in the design alone. *In re Anton/Bauer Inc.*, 7 USPQ2d 1380, 1381 (TTAB 1988) (citing *In re Raytheon Co.*, 202 USPQ 317 (TTAB 1979)); TMEP §1202.11; *see also Seabrook Foods, Inc. v. Bar-Well Foods Ltd.*, 568 F.2d 1342, 1344, 196 USPQ 289, 291 (C.C.P.A. 1977). Moreover, stylized descriptive or generic wording is registrable only where the stylization creates a commercial impression separate and apart from the impression made by the wording itself. *See In re Cordua Rests., Inc.*, 823 F.3d 594, 606, 118 USPQ2d 1632, 1639-40 (Fed. Cir. 2016); *In re Northland Aluminum Prods., Inc.*, 777 F.2d 1556, 1561, 227 USPQ 961, 964 (Fed. Cir. 1985); TMEP §1209.03(w). Common and ordinary lettering with minimal stylization, as in this case, is generally not sufficiently striking, unique, or distinctive as to make an impression on purchasers separate from the wording. *See In re Sadoru Grp., Ltd.*, 105 USPQ2d 1484, 1487 (TTAB 2012). Here, neither the common background nor stylization creates a distinctive impression separate from the wording and thus, the descriptive significance is not obviated.

Applicant should note the following additional ground for refusal.

**UNACCEPTABLE SPECIMEN OF USE -- Advertising for goods is not an acceptable specimen.**

Registration is also refused because the specimen appears to be mere advertising and does not properly show the applied-for mark as actually used in commerce in International Class(es) 12. 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, 904.04(b), 904.07(a). An application based on Trademark Act Section 1(a) must include a specimen showing the applied-for mark as actually used in commerce for each international class of goods identified in the application or amendment to allege 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).

Specifically, applicant submitted an excerpt from applicant's website showing use of the mark with respect to applicant's merchant services. The mark does not appear to identify particular forklifts but the service providing used forklift sales and rentals.

Advertising is not acceptable as a specimen for goods. *See In re Yarnell Ice Cream, LLC*, 2019 USPQ2d 265039, at \*15-16 (TTAB 2019) (quoting *In re Siny Corp.*, 920 F.3d 1331, 1336, 2019 USPQ2d 127099, at \*2-3 (Fed. Cir. 2019)); *see also Avakoff v. S. Pac. Co.*, 765 F.2d 1097, 1098, 226 USPQ 435, 436 (Fed. Cir. 1985); TMEP §904.04(b), (c). Advertising includes online advertising banners appearing on search-engine results pages or in social media, advertising circulars and brochures, price lists, and business cards. *See* TMEP §904.04(b).

**Examples of specimens.** Specimens for goods include a photograph of (1) the actual goods bearing the mark; (2) an actual container, packaging, tag or label for the goods bearing the mark; or (3) a point-of-sale display showing the mark directly associated with the goods. *See* 37 C.F.R. §2.56(b)(1), (c); TMEP §904.03(a)-(m). A webpage specimen submitted as a display associated with the goods must show the mark in association with a picture or textual description of the goods and include information necessary for ordering the goods. TMEP §904.03(i); *see* 37 C.F.R. §2.56(b)(1), (c). Any webpage printout or screenshot submitted as a specimen must include the webpage's URL and the date it was accessed or printed on the specimen itself, within the TEAS form that submits the specimen, or in a verified statement under 37 C.F.R. §2.20 or 28 U.S.C. §1746 in a later-filed response. *See* 37 C.F.R. §2.56(c); TMEP §§904.03(i), 1301.04(a).

**Response options.** Applicant may respond to this refusal by satisfying one of the following for each applicable international class:

(1) Submit a different specimen (a verified “[substitute](#)” specimen) that (a) was in actual use in commerce at least as early as the filing date of the application or prior to the filing of an amendment to allege use and (b) shows the mark in actual use in commerce for the goods identified in the application or amendment to allege use. A “verified substitute specimen” is a specimen that is accompanied by the following statement made in a signed affidavit or supported by a declaration under 37 C.F.R. §2.20: “The substitute (or new, or originally submitted, if appropriate) specimen(s) was/were in use in commerce at least as early as the filing date of the application or prior to the filing of the amendment to allege use.” The substitute specimen cannot be accepted without this statement.

(2) Amend the filing basis to [intent to use under Section 1\(b\)](#) (which includes withdrawing an amendment to allege use, if one was filed), as no specimen is required before publication. This option will later necessitate additional fee(s) and filing requirements, including a specimen.

For an overview of the response options referenced above and instructions on how to satisfy these options using the online Trademark Electronic Application System (TEAS) form, see the [Specimen webpage](#).

Although applicant's mark has been refused registration, applicant may respond to the refusal(s) by submitting evidence and arguments in support of registration. If applicant responds to the refusal(s), applicant must also respond to the requirement(s) set forth below.

## **DESCRIPTION OF THE MARK**

Applicant must submit an amended description of the mark that agrees with the mark on the drawing. 37 C.F.R. §2.37; *see* TMEP §§808.01, 808.02. The current description is inconsistent with the mark on the drawing and thus is inaccurate. 37 C.F.R. §2.37; *see* TMEP §§808.01, 808.02. Descriptions must be accurate and identify only those literal and design elements appearing in the mark. *See* 37 C.F.R. §2.37; TMEP §§808.02, 808.03(d).

The following description is suggested, if accurate: **The mark consists** of the red **stylized** text "ForkliftTrader" that is white color outlined. Around the white outline is a black line outline. To the right of this text is a black oval that is outlined with white. Around this white is also a black line outline. In the middle of the black oval is stylized **white text ".com."**

## **RESPONDING TO THIS OFFICE ACTION**

**Response guidelines.** For this application to proceed, applicant must explicitly address each refusal and/or requirement in this Office action. For a refusal, applicant may provide written arguments and evidence against the refusal, and may have other response options if specified above. For a requirement, applicant should set forth the changes or statements. Please see [“Responding to Office Actions”](#) and the informational [video “Response to Office Action”](#) for more information and tips on responding.

If applicant responds to the refusal(s), applicant must also respond to the requirement(s) set forth below. Please call or email the assigned trademark examining attorney with questions about this Office action. Although an examining attorney cannot provide legal advice, the examining attorney can provide additional explanation about the refusal(s) and/or requirement(s) in this Office action. *See* TMEP §§705.02, 709.06.

Applicant is further advised that the USPTO does not accept emails as responses to Office actions; however, emails can be used for informal communications and are included in the application record. *See* 37 C.F.R. §§2.62(c), 2.191; TMEP §§304.01-.02, 709.04-.05.

**How to respond.** [Click to file a response to this nonfinal Office action.](#)

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## **RESPONSE GUIDANCE**

- **Missing the response deadline to this letter will cause the application to [abandon](#).** The response must be received by the USPTO before midnight **Eastern Time** of the last day of the response period. TEAS maintenance or [unforeseen circumstances](#) could affect an applicant's ability to timely respond.
- **[Responses signed by an unauthorized party](#)** are not accepted and can **cause the application to [abandon](#)**. If applicant does not have an attorney, the response must be signed by the individual applicant, all joint applicants, or someone with [legal authority to bind a juristic applicant](#). If applicant has an attorney, the response must be signed by the attorney.
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## Definition of trader

- 1 : a person whose business is buying and selling or barter: such as
  - a : MERCHANT
  - b : a person who buys and sells (something, such as stocks or commodities futures) in search of short-term profits
- 2 : a ship engaged in the coastal or foreign trade

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### Synonyms for *trader*

#### Synonyms

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### Examples of *trader* in a Sentence

// She is a stock *trader*.

// early explorers and fur *traders*

#### Recent Examples on the Web

// For Elon Musk, his relationship with the *trader* is essential to maintaining a steady supply for his gigafactories.

— Vivienne Walt, *Fortune*, 5 Aug. 2022

// The London *trader* and brokerage has agreed to sell its financial-services division, ED&F Man Capital Markets, which has 450 employees and made more than \$235 million in revenue last year, to crosstown rival Marex Group.

— *WSJ*, 1 Aug. 2022

// Russian media have speculated that Griner could be exchanged for prominent Russian arms *trader* Viktor Bout, who is imprisoned in the United States, and that Paul Whelan, an American imprisoned in Russia for espionage, may also figure in an

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— Vladimir Isachenkov, *Anchorage Daily News*, 27 July 2022

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1566, in the meaning defined at [sense 1](#)

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**Share *trader***



**Time Traveler for *trader***

**T** The first known use of *trader* was in 1566

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## More Definitions for *trader*

**trader** **noun**  
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### Kids Definition of *trader*

- 1 : a person who trades
- 2 : a ship engaged in commerce

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trad-er<sup>ˈdɛr</sup> (trɪˈdɛr)

n.

1. One that trades; a dealer; a gold trader; a trader in bonds.
2. Nautical A ship employed in foreign trade.

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FORKLIFTS**  
FOR RENT OR PURCHASE



**FORKLIFT  
PARTS**  
ALL MAKES, MODELS, YEARS



**FINANCING  
AVAILABLE**



(262) 547-6637

1610 Pearl St., Waukesha, WI 53186

Mon - Fri 8am - 5pm

Sat - Sun Closed

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[Policies](#)

#### USED FORKLIFTS

FOR SALE

#### FORKLIFT PARTS

FOR SALE

Manufacturers

Rental Prices

Sell Us Your Forklift

Financing

Freight Shipping

Get Forklift Certified

How to Choose a Lift

Troubleshooting Guide

Service Areas

Contact Us



Have a question? Text us here!

Text us!



### WE BUY FORKLIFTS!

Don't settle for scrap pricing, we'll make an offer on lifts of any condition. If you're replacing or liquidating your old forklift fleet, make sure you're getting as much for your old equipment as possible.

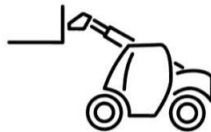
Contact Forklift Trader to sell your used forklifts

## WE'LL MAKE YOU AN OFFER DON'T SCRAP IT!

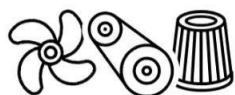
WE'RE ALWAYS LOOKING TO BUY ELECTRIC, PROPANE AND DIESEL FORKLIFTS OF ALL BRANDS

Our entire inventory is made up of [used lift trucks](#) that were restored and brought back to life by our expert mechanics. If you're replacing your lift with something new, get in touch with us. We'll assess the condition of your old forklift and make you an offer.

CONTACT US TO SELL YOUR LIFT



**75+ USED  
FORKLIFTS**  
FOR RENT OR PURCHASE



**FORKLIFT  
PARTS**  
ALL MAKES, MODELS, YEARS



**FINANCING  
AVAILABLE**

### Frequently Asked Questions

+ How do I maximize the trade-in value of my forklift?

+ How much is an old forklift worth?

+ Is there a blue book for forklifts?

+ What can you do with an old forklift?

+ Do forklifts have titles?

+ What is the most common forklift size?

+ Do you need a certification to operate a forklift?

+ Do you need recertification to drive forklifts?



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 Text us!

## United States Patent and Trademark Office (USPTO)

### USPTO OFFICIAL NOTICE

Office Action (Official Letter) has issued  
on August 24, 2022 for  
**U.S. Trademark Application Serial No. 97120737**

A USPTO examining attorney has reviewed your trademark application and issued an Office action. You must respond to this Office action in order to avoid your application abandoning. Follow the steps below.

- (1) **[Read the Office action](#)**. This email is NOT the Office action.
- (2) **Respond to the Office action by the deadline** using the Trademark Electronic Application System (TEAS). Your response must be received by the USPTO on or before 11:59 p.m. **Eastern Time** of the last day of the response period. Otherwise, your application will be **[abandoned](#)**. See the Office action itself regarding how to respond.
- (3) **Direct general questions** about using USPTO electronic forms, the USPTO **[website](#)**, the application process, the status of your application, and whether there are outstanding deadlines to the **[Trademark Assistance Center \(TAC\)](#)**.

After reading the Office action, address any question(s) regarding the specific content to the USPTO examining attorney identified in the Office action.

### GENERAL GUIDANCE

- **[Check the status](#) of your application periodically** in the **[Trademark Status & Document Retrieval \(TSDR\)](#)** database to avoid missing critical deadlines.
- **[Update your correspondence email address](#)** to ensure you receive important USPTO notices about your application.
- **[Beware of trademark-related scams](#)**. Protect yourself from people and companies that may try to take financial advantage of you. Private companies may call you and pretend to be the USPTO or may send you communications that resemble official USPTO documents to trick you. We will never request your credit card number or social security number over the phone. And all official USPTO correspondence will only be emailed from the domain “@uspto.gov.” Verify the correspondence originated from us by using your Serial Number in our database, **[TSDR](#)**, to confirm that it appears under the “Documents” tab, or contact the **[Trademark Assistance Center](#)**.

- **Hiring a U.S.-licensed attorney.** If you do not have an attorney and are not required to have one under the trademark rules, we encourage you to hire a U.S.-licensed attorney specializing in trademark law to help guide you through the registration process. The USPTO examining attorney is not your attorney and cannot give you legal advice, but rather works for and represents the USPTO in trademark matters.