

From: Sue Aucoin <odie@c...>
Date: Mon Jan 15, 2001 9:48pm
Subject: Re: NEW: CROCHETTED MINI`S

In wee-teds@egroups.com, "L.Hesen" lhesen@w... wrote:
> I have new mini`s on my site. This time not made from mini-fabric,
but from many tiny stitches and fine thread. My special designed
crochet mini`s. I hope you all take a look.

Hi Berta!
I've just been to your web site! You make thread bears, sewn bears
and you also knit? You are very talented and your bears are great! I
must confess...I'm a little worried about having thread bear
competition :). Congratulations on having one sent to Korea!!! If you
would like, You can see my thread bears on ebay (threadbaredesigns)
Sue Aucoin

TRADEMARK ISSUES – Open Letter

Note: It is the purpose of this Open Letter to give the straight facts of the history of Thread Bears®, from the aspect of why a Cancellation procedure was brought against the eleven year old Trademark, by a group of Teddy Bear Artists and Collectors, supporting the opinion that this ‘Mark’ is no longer functioning as a Mark.

When the Open Letter was first written, the facts were put down to ‘flesh out’ the outline format of the Time Line. It was decided that, without copying & pasting in the documents from the court filings, these too would look like opinions rather than facts.

Without the actual documents, this Open Letter would be much shorter: if you prefer, you may read just the italicized, blue-colored text and understand why this action was proposed. If you’d like to read when, where and why these actions were taken, please read the enclosed documents along with the text.

The FULL history of this Mark, from 1997, can be found online at the url lower on this page, ending in its Case Number.....#75245684. Thank You

In the matter of the use of the phrase ‘thread bear(s)’, there may have been some recent errors made: one of the personal Code of the Ethics by which this editor has lived is -

*Admit to mistakes
Apologize
Ask what will make it right*

If I erred it was not intentional; it was not done to injure anyone.

Several artists have been accused of slander and theft and in the past, have chosen to use legal system channels and lawful procedure to respond to these points. By not responding in kind: directly and in public, this has made the erroneous points _appear_ to some to be true: the untruths were not directly responded to but were answered through the Counsel retained to represent the side opposing the trademarking of the phrase/term thread bear(s); neither direct response nor dialog was appropriate at the time.

At all times throughout the past 5 years, both sides have been advised by the USPTO (United States Patent and Trademark Office):

Applicant may wish to hire a specialist attorney to assist in prosecuting this application because of the technicalities involved. The Office cannot aid in the selection of a trademark attorney. 37 C.F.R. §2.11. Applicant may wish to consult the Yellow Pages for a listing of attorneys specializing in trademark or intellectual property law, or seek guidance from its local Bar Association attorney-referral service.

Now is the time to present some of the many, many basic facts, available for all to research for themselves on the USPTO site, to show that the side opposing the trademarking of the phrase thread bears as always dealt in fact, not opinion.

<http://tportal.uspto.gov/external/portal/tow?SRCH=Y&isSubmitted=true&details=&SELECT=US+Serial+No&TEXT=75245684#>

There are three main reasons why these actions were taken; ISSUES One through Three:

- 1 - it is felt by many artists that the phrase has come to represent the generic, descriptive term for these designs and creations,*
- 2 - after much research it was found that there are indeed allowances in the USPTO law for canceling Marks that no longer function as Marks, i.e., they no longer identify an __Individual__ Company producing these, among the myriad other producers of the same products, but now stand for a type or 'Class of Goods', searchable through every online search engine, in applications for competitions and trade show exhibit space, in advertising, auctions, websites, blogs, etc..., and*
- 3 - it is felt that there are problems with the signing of a document, which the new, 2003 owners have signed, attesting to the length of time that the "...Mark has been in use..." for a set number of years, but those years were performed by the original owner, not the present owners.*

ISSUE #1 -

Since it was first coined by whoever thought of it, more than a dozen years ago, this juxtapositioning of two common words has turned from the 'Mark' of a company (there is not much evidence to support the original owner's use of it as his true Mark: products yet remaining available carry tags using Our Secret, Ltd. as the Company Name, on the manufactured bears his company produced) into the term used by most individuals to search for, think of, collect and wish to label when selling.

From reading his application in 1997 after 11 years in business (1986 through 1997), it is 'believed' that he trademarked this title as a 'component part' of his bears, i.e., they were sewn together with thread, thus - Thread Bears. Indeed, on the application itself, it can be read that the term was to be applied to not just the items themselves (large, sewn, accessorized, fabric bears) but to all of the peripheral materials to bear the Mark: containers, advertising, packaging, promotional materials, etc... (Some of the documents, such as the first here, will be presented more than once, to point out different facts.)

Trade Mark Application
Our Secret, Ltd.
Page 2

The Mark was first used on the Goods on July 1, 1986, and first used on the Goods in interstate commerce on July 1, 1986, and is now in use in such commerce.

The Mark is used by applying the Mark to the Goods, containers for the Goods, displays associated with the Goods, tags or labels affixed to the Goods, and promotional matters.

The USPTO countered with this request for clarification:

It is not necessary that a term describe all of the purposes, functions, characteristics or features of a product in order to be considered merely descriptive; it is enough if the term describes one significant function, attribute or property. *In re H.U.D.D.L.E.*, 216 USPQ 358 (TTAB 1982); *In re MBAssociates*, 180 USPQ 338 (TTAB 1973). As the applicant's specimens clearly indicate, the applicant is using the mark in connection with toy bears which are manufactured, in part, through the use of thread. Consequently, use of the term THREAD BEARS in this context immediately calls to mind an important physical aspect of the applicant's toy bears. Because the mark is so highly descriptive, if not generic of these goods, the examining attorney is compelled to refuse registration under §2(e)(1) of the Trademark Act.

Although the examining attorney has refused registration, the applicant may respond to the refusal to register by submitting evidence and arguments in support of registration.

The one ingredient in the manufacturing process—sewing the fabric bears together with thread—was enough to satisfy the question of why they were being termed 'Thread Bears'. However, two other major obstacles remained:

On the initial application (by Matt Walsh/Our Secret., Ltd.) the USPTO raised 2 Substantive Reasons for Refusal, denying issuance of this Mark:

Trademark Act, Section 2(e) - Merely Descriptive, and

Trademark Act, Section 2(e) - Acquired Distinctiveness.

These are their findings for denial: on record as Office Outgoing Action 24 June 1997 –

II. THE PROPOSED MARK IS MERELY DESCRIPTIVE

The examining attorney refuses registration on the Principal Register because the proposed mark merely describes the applicant's textile soft sculpture figures and dolls. Trademark Act Section 2(e)(1), 15 U.S.C. Section 1052(e)(1); TMEP section 1209 *et seq.*

A mark is merely descriptive under Trademark Act Section 2(e)(1), 15 U.S.C. 1052(e)(1), if it describes an ingredient, quality, characteristic, function, feature, purpose or use of the relevant goods or services. *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987); *In re Bed & Breakfast Registry*, 791 F.2d 157, 229 USPQ 818 (Fed. Cir. 1986); *In re*



Document Description: **Offc Action Outgoing**

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MetPath Inc., 223 USPQ 88 (TTAB 1984); *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979); TMEP section 1209.01(b).

The determination of whether or not a mark is merely descriptive must be made not in the abstract but, rather, in relation to the goods or services for which registration is sought; the context in which the mark is used, or intended to be used, in connection with those goods or services; and the possible significance which the mark would have, because of that context, to the average purchaser of the goods or services in the market place. See *In re Omaha National Corp.*, 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987); *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215 (CCPA 1978); *In re Venture Lending Associates*, 226 USPQ 285 (TTAB 1985).

It is not necessary that a term describe all of the purposes, functions, characteristics or features of a product in order to be considered merely descriptive; it is enough if the term describes one significant function, attribute or property. *In re H.U.D.D.L.E.*, 216 USPQ 358 (TTAB 1982); *In re MBAssociates*, 180 USPQ 338 (TTAB 1973). As the applicant's specimens clearly indicate, the applicant is using the mark in connection with toy bears which are manufactured, in part, through the use of thread. Consequently, use of the term THREAD BEARS in this context immediately calls to mind an important physical aspect of the applicant's toy bears. Because the mark is so highly descriptive, if not generic of these goods, the examining attorney is compelled to refuse registration under §2(e)(1) of the Trademark Act.

Although the examining attorney has refused registration, the applicant may respond to the refusal to register by submitting evidence and arguments in support of registration.

III. ACQUIRED DISTINCTIVENESS

Alternatively, in light of the applicant's use of the mark for a significant time, the applicant may amend to seek registration under Trademark Act Section 2(f), 15 U.S.C. Section 1052(f), based on acquired distinctiveness. If the applicant chooses to do so by using the statutory suggestion of five years of use as proof of distinctiveness, the applicant should submit a claim of distinctiveness that reads as follows, if accurate.

The mark has become distinctive of the goods through the applicant's substantially exclusive and continuous use in commerce for at least the five years immediately before the date of this statement.

The applicant must provide this statement supported by an affidavit or a declaration under 37 C.F.R. Section 2.20. 37 C.F.R. Section 2.41(b); TMEP section 1212.05(d). Accordingly, after the claim of distinctiveness, the applicant should insert the following declaration signed by Mr. Matthew D. Walsh or another officer of the applicant.

The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001, and that such willful false statements may jeopardize the validity of the application or any resulting

In Response to the Examiner's Refusal by Walsh/Our Secret., Ltd.:

§ 1209.01, yet also recognizing that "the factual situations in which mere descriptiveness must be resolved are too varied to lend themselves to resolution under any rigid formula" under the analysis set forth in In re Omaha National Corp., 819 F.2d 1117,1119, 2 USPQ2d 1859, 1861 (Fed. Cir. 1987), applicant submits for the Examiner's consideration that the combination of words in the Mark is registrable because the juxtaposition of the words is inventive and evokes a unique commercial impression. Further, the Mark has a variety of meanings and suggestions. In re Vaughan Furniture Co., 24 USPQ2d 1068 (TTAB 1992). In addition, the Mark does not immediately tell customers what the goods associated with the Mark are; rather, the Mark requires the exercise of imagination, thought, and perception by the consumer. In re Hutchinson Technology, 852 F.2d 552, 7 USPQ2d 1490 (Fed. Cir. 1988).

Merely Descriptive

The Examiner entered a refusal of registration on the Principal Register because the Mark is merely descriptive. However, the Examiner also stated that Applicant may respond to the refusal to register by submitting evidence and arguments in support of registration. In response, applicant notes that the Trademark Act § 2(e) provides for rejection of registration of a mark which is *merely* descriptive, not descriptive. While acknowledging the significance of the cases cited by the Examiner in support of the Examiner's rejection, applicant suggests that descriptiveness must be considered in connection with the specific goods, the context in which the Mark is used in the market place, and the significance that the Mark in that particular market context is likely to have on a consumer. In re Engineering Says, Corp., 2 USPQ2d 1075 (TTAB 1985). Although a mark may impart information about the physical characteristics of the goods, that does not render the mark incapable of functioning as a trademark. In re DC Comics, Inc., 689 F.2d 1042, 215 USPQ 394, 396 (CCPA 1982). In applying the tests for determining whether a mark is merely descriptive as provided in TMEP

§ 1209.01, yet also recognizing that "the factual situations in which mere descriptiveness must be resolved are too varied to lend themselves to resolution under any rigid formula" under the analysis set forth in In re Omaha National Corp., 819 F.2d 1117, 1119, 2 USPQ2d 1859, 1861 (Fed. Cir. 1987), applicant submits for the Examiner's consideration that the combination of words in the Mark is registrable because the juxtaposition of the words is inventive and evokes a unique commercial impression. Further, the Mark has a variety of meanings and suggestions. In re Vaughan Furniture Co., 24 USPQ2d 1068 (TTAB 1992). In addition, the Mark does not immediately tell customers what the goods associated with the Mark are; rather, the Mark requires the exercise of imagination, thought, and perception by the consumer. In re Hutchinson Technology, 852 F.2d 552, 7 USPQ2d 1490 (Fed. Cir. 1988).

The Examiner agreed with these arguments against objections on Section 2(e) and withdrew it. The supporters of canceling this Mark, and presently continuing to use it (lower-case, descriptively, generically) believe that this Mark has again become Descriptive, just as it has become generic, as put forth in findings in Issue 2.

ISSUE #2 -

Though all arguments against on Section 2(e) Merely Descriptive were originally denied, this Section 2(f) was made part of the ORIGINAL Mark Registration in 1997 and continues affixed to this day.

In 1998 - "Sec. 2(F), second column, below, on Original Registration" –

Int. Cl.: 28

Prior U.S. Cls.: 22, 23, 38 and 50

Reg. No. 2,146,208

United States Patent and Trademark Office

Registered Mar. 24, 1998

TRADEMARK PRINCIPAL REGISTER

THREAD BEARS

OUR SECRET, LTD. (NEW MEXICO CORPORATION)
1701 BROADWAY, NE
ALBUQUERQUE, NM 87102

FOR: DOLLS AND SOFT SCULPTURE FIGURES MADE OF TEXTILES, IN CLASS 28 (U.S. CLS. 22, 23, 38 AND 50).

FIRST USE 7-1-1986; IN COMMERCE 7-1-1986.

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "BEARS", APART FROM THE MARK AS SHOWN.

SEC. 2(F).

SER. NO. 75-245,684, FILED 2-21-1997.

NICHOLAS ALTREE, EXAMINING ATTORNEY

- *yet in 2003, with new owners: See "Sec. 2(F), second column, below" –*

PETERSEN, EMMA LEE (UNITED STATES INDIVIDUAL)
217 CUPPER
KINGSMAN, AZ 86401 AND
AUCOIN, SUSAN LYNN (UNITED STATES INDIVIDUAL)
2728 LILLIE
KINGMAN, AZ 86401

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "BEARS", APART FROM THE MARK AS SHOWN.

SEC. 2(F).

FOR: DOLLS AND SOFT SCULPTURE FIGURES MADE OF TEXTILES, IN CLASS 28 (U.S. CLS. 22, 23, 38 AND 50).

FIRST USE 7-1-1986; IN COMMERCE 7-1-1986.

SER. NO. 75-245,684, FILED 2-21-1997.

Here are 2 independent law source websites and the Google reference page to search for more references of the meaning of these 2 designations: "2(e) and 2(f)."

They are cited for explanation of Sections 2(e) and (f), both somewhat tied but needing different burdens-of-proof to overcome.

TM Act, Section 2(e) and (f) - Google Search -

[http://www.google.com/search?client=safari&rls=en&q=TM+Act,+Section+2\(e\)+and+\(f\)&ie=UTF-8&oe=UTF-8](http://www.google.com/search?client=safari&rls=en&q=TM+Act,+Section+2(e)+and+(f)&ie=UTF-8&oe=UTF-8)

<http://www4.law.cornell.edu/uscode/15/1052.html>

Trademark Act Section 2(f)

The Director may accept as prima facie evidence that the mark has become distinctive, as used on or in connection with the applicant's goods in commerce, proof of substantially exclusive and continuous use thereof as a mark by the applicant in commerce for the five years before the date on which the claim of distinctiveness is made.

<http://www.bitlaw.com/source/tmep/1212.html>:

The purpose and significance of secondary meaning may be described as follows:

A term which is descriptive ... may, through usage by one producer with reference to his product, acquire a special significance so that to the consuming public the word has come to mean that the product is produced by that particular manufacturer. 1 Nims, Unfair Competition and Trademarks at §37 (1947). This is what is known as secondary meaning.

The crux of the secondary meaning doctrine is that the mark comes to identify not only the goods but the SOURCE of those goods. To establish secondary meaning, it MUST BE SHOWN that the primary significance of the term in the minds of the consuming public is NOT the product but the Producer (citations omitted). This may even be an anonymous producer, since consumers often buy goods without knowing the personal identity or actual name of the manufacturer.

1212 Acquired Distinctiveness or Secondary Meaning

There are three basic types of evidence that may be used to establish acquired distinctiveness under §2(f):

- (1) A claim of ownership of one or more prior registrations on the Principal Register of the same mark for goods or services that are the same as or related to those named in the pending application (see 37 C.F.R. 2.41(b); TMEP §§1212.04 et seq.);
- (2) A statement verified by the applicant that the mark has become distinctive of the applicant's goods or services by reason of substantially exclusive and continuous use in commerce by the applicant for the five years before the date when the claim of distinctiveness is made (see 37 C.F.R. 2.41(b); TMEP §§1212.05 et seq.);
- (3) Actual evidence of acquired distinctiveness (see 37 C.F.R. 2.41(a); TMEP §§1212.06 et seq.).

Walsh/Our Secret, Ltd. used an affidavit to satisfy #2 - having used the 'Trade Name' for 9 years 'Use in Commerce' as proof to overcome Section 2(e), Merely Descriptive. Only one was needed.

As read above: Secondary meaning - See "Google AdWords Trademark Team", email below, from the largest, common, marketplace business conducting independent research and concluding the same. From Defendants' 'Answer' in the Cancellation proceedings, 7 August 2006:

Due to this cancellation attempt... we can not continue to protect our mark because it is now considered a 2(F). It is not us that is allowing the misuse at this time.. but the USPTO. See evidence #13A (Google's response). Others in connection with making

From an email to Google in 2006:

Emma Petersen

From: "Google AdWords Trademark Team" <ads-trademarks@google.com>
To: <lips@citlink.net>
Sent: Wednesday, July 19, 2006 3:39 PM
Subject: [#66274692] Google AdWords Trademark Complaint - "Thread Bears"

Hello Emma,

Thank you for sending us your trademark complaint letter, dated July 17, 2006. Please note that we will not be able to process for your trademark "Thread Bears" at this time because your trademark has been marked 2(F) by the US Patent and Trademark Office. This means that there are potentially descriptive or generic uses of your term. Descriptive and generic terms are free for all to use, and therefore we cannot monitor or prevent all instances of this term. However, if you believe that certain advertisers are using this term in its trademark sense, please send us these specific instances and we will investigate accordingly. Please note, that we can only investigate the specific URLs that you send us and not any others.

Best Regards,
Ilana
Google AdWords Trademark Team

In every-day speech, "2(f)" means that the word or phrase/term must meet a very strict set of codes to attain and retain 'Acquired Distinctiveness'. If not, it can have secondary meanings.

As such, words that do not have a solitary, singular, SPECIFIC meaning in a Mark, can be considered to have Generic meanings.

Here is what Ms Jessie N Roberts, Administrator for Trademark Classification and Practice, said about the phrase/term thread bear in the application for another Mark by SA/EP, Thread Teds by Thread Bears™, in discussing the need to uphold a Final Office Action: the disclaimers for both 'thread ted's AND 'thread bears':

MEMORANDUM:

DATE:

TO: Tasneem Hussain
Examining Attorney
Law Office 105

FROM: Jessie N. Roberts
Administrator for Trademark
Classification and Practice

SUBJECT: Letter of Protest concerning Application Serial No. 78553324

The above-referenced Letter of Protest contains the following objection:

The term "thread bear" is generic for these collectable bears, dolls and animals. It is noted that this applicant has a prior incontestable registration for the term "thread bear." However, the issue of genericness can be raised at any time even if an incontestable registration exists for the term.

NOTE - The Declaration of Incontestability (referenced here - posted later in Issue #3) was never finalized after the owner/name mix-up, but J N Roberts states that even that doesn't give a Mark protection ONCE it becomes the common, descriptive and/or generic phrase/term for something.

This is the Second point on which the opposers to thread bears functioning as a Mark agree:

Explanation of Generic Terms

As previously discussed in the February 2, 2006 Office Action, generic terms are terms that the relevant purchasing public understands primarily as the common or class name for the goods or services. *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 57 USPQ2d 1807 (Fed. Cir. 2001); *In re American Fertility Society*, 188 F.3d 1341, 51 USPQ2d 1832 (Fed. Cir. 1999); *In re Merrill Lynch, Pierce, Fenner & Smith, Inc.*, 828 F.2d 1567, 4 USPQ2d 1141 (Fed. Cir. 1987); *H. Marvin Ginn Corp. v. Int'l Ass'n of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528 (Fed. Cir. 1986). Generic terms are by definition incapable of indicating a particular source of the goods or services, and cannot be registered as trademarks; doing so "would grant the owner of the mark a monopoly, since a competitor could not describe his goods as what they are." *In re Merrill Lynch*, 828 F.2d at 1569, 4 USPQ2d at 1142.

A two-part test is used to determine whether a designation is generic:

- (1) What is the class or genus of goods or services at issue?
- (2) Does the relevant public understand the designation primarily to refer to that class or genus of goods or services?

See *H. Marvin Ginn Corp. v. International Ass'n of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528 (Fed. Cir. 1986); TMEP §1209.01(c)(i).

Here, the genus of goods at issue is miniature bears made out of thread. Applicant has already disclaimed the descriptive and/or generic words "THREAD TEDS" and "BEARS." Applicant is the owner of the prior U.S. Registration No. 2146208 where the applicant disclaimed the generic word "BEARS" and claimed acquired distinctiveness under Trademark Act Section 2(f) for the word "THREAD" in order to register the identical goods on the Principal Register.

However, the previously attached evidence demonstrated that the term "THREAD BEARS" has become the recognized and commonly used name for small, crocheted, sewn, or felted bears, dolls, and animals. (See evidence attached to Letter of Protest). In this case, applicant's goods are known as "THREAD BEARS" in the collectable bear industry. As such, the combination of words is generic and the term "THREAD BEARS" must be disclaimed.

The evidence attached demonstrates the use of the term "THREAD BEARS" for collectable sewn bears used by many individuals and entities as the generic term for these items. As demonstrated by the attached materials obtained from applicant's website located at www.beadwrangler.com/creature.htm, the word "thread bears" is a commonly used phrase to identify goods such as those sold by applicant. For example, please note the following excerpt:

You will find several websites for thread crocheted bears and patterns. Search the internet using the words "thread bears", "crocheted teddy bears," "crocheted miniature bears" and you will find many links and web rings.

Although applicant claims that the wording "THREAD BEARS" is not generic, the evidence attached indicates otherwise. Because the relevant public understands the designation "THREAD BEARS" primarily to refer to that genus of goods that are collectable sewn bears, the term is generic and must be disclaimed apart from the mark.

Unlike what SA/EP have written elsewhere, from the examples of Google and the USPTO's own research it can be seen that the posting of a half a dozen legally accepted letters of Opposition into filed court documents are hardly enough to sway the entire USPTO into thinking that they had enough influence to turn the phrase into a generic one, just by entering their personal opinions.

This just does not make sense. See Google AdWords again, above:

The purpose of a trademark is that when people think of Thread Bears they should automatically associate the Source of the goods with that Mark. That is how a properly used trademark functions. Often the actual owner of the mark is unknown, but when collectors hear, for example., Steiff®, they know which company produced those bears, with their well-known characteristics and markings.

With seeing these miniature teddies, crocheted from thread, described as thread bears by one and all, there is little wonder that the term came to be associated in most bear crocheters' and collectors' minds as thread bears.

Eventually SA/EP too added another word between those two, just as they have asked all of us to do, in their subsequent 'policing' requests, by mid- to late 2007.

SA/EP have stated to the USPTO that the term became generic through Letters of Protest filed against another Mark they have applied for and by a competing artist, a group of her friends and an online Yahoo group.

This is untrue, as seen by the independent research conducted by Google (of which the opposers knew nothing until SA/EP entered it as case file evidence) emailed to Emma Petersen and the research conducted by the USPTO (three search reports below.)

A huge jump in popularity came for the term through the concerted though unintentional efforts of all designers, creators and collectors, SA/EP among them, in the periods between these USPTO search summary reports: 1997, 2005 and 2007:

http://tmpportal.uspto.gov/external/PA_1_0_LT/OpenSrvl...age=1&rowNum=25&rowCount=29&formattedDate=

Document Description: **XSearch Search Summary**
Mail / Create Date: **23-Jun-1997**

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*** User: EX996524 ***

STMT NUMBER	TOTAL MARKS	LIVE VIEWED	DEAD VIEWED	SEARCH
01	1716	0	0	:thre:
02	3748	0	0	:bear: ^ :bare:
03	8	8	0	1 & 2 ~dead/ld
04	7	2	5	PHONSCH threadbear ^ thread bear ^ threadb thread bears

TERMINAL SESSION STARTED 06/23/97 9:48 A.M. (EASTERN TIME)
TERMINAL SESSION FINISHED 06/23/97 10:00 A.M. (EASTERN TIME)
ELAPSED TIME THIS SESSION 0 HRS AND 12 MIN

Document Description: **XSearch Search Summary**
Mail / Create Date: **24-Aug-2005**

*** User:thussain ***

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02	27619	N/A	0	0	0:04	*t{v}d*[bi,ti] and live[ld]
03	2742	N/A	0	0	0:01	(*bear* or *bare*{bi,ti] and live[ld]
04	1495	N/A	0	0	0:02	030114[dc] and live[ld]
05	1565	N/A	0	0	0:02	030126[dc] and live[ld]
06	5907	N/A	0	0	0:02	260108[dc] and live[ld]
07	12	0	12	9	0:01	1 and 2
08	279	N/A	1	1	0:01	3 and 4
09	5	0	5	4	0:01	1 and 3
10	148	0	48	25	0:01	2 and 3
11	10	0	10	10	0:01	4 and 5 and 6
12	372	0	2	372	0:01	4 and 5
13	33	0	33	33	0:01	5 and 6
14	35	0	35	35	0:01	4 and 6
15	220	0	66	36	0:03	1 and 028[cc]

Session started 8/24/05 2:38:16 PM
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Session duration 62 minutes 32 seconds
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Sent to TIGRS as Serial Number: 78553324

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Document Description: XSearch Search Summary						
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02	19541	N/A	0	0	0:03	*ted*[bi,ti] and live[id]
03	2779	N/A	0	0	0:01	(*bear* or *bare*) [bi,ti] and live[id]
04	1	0	1	1	0:01	1 and 2 and 3
05	16	0	16	12	0:01	1 and (2 3)
06	142	0	142	90	0:01	2 and 3
07	1489	N/A	0	0	0:03	030114[dc] and live[id]
08	1645	N/A	0	0	0:04	030126[dc] and live[id]
09	6166	N/A	0	0	0:02	260108[dc] and live[id]
10	9	0	1	9	0:01	7 and 8 and 9
11	409	N/A	0	0	0:01	7 and (8 9)
12	251	0	2	251	0:04	11 and 028[cc]
13	35	0	2	35	0:01	8 and 9
Session started 2/13/07 10:37:39 AM						
Session finished 2/13/07 10:41:46 AM						
Total search duration 0 minutes 25 seconds						
Session duration 4 minutes 7 seconds						
Default NEAR limit=1ADJ limit=1						
Sent to TIGRS as Serial Number: 78553324						

In the Cancellation process, the USPTO received literally hundreds of examples taken from ‘persons-unknown-to-the-opposers’ online - random samplings found while browsing, of individuals using the term thread bears.

This is important for two reasons, first, it is the combination of __everyone, including SA/EP__ that turned this term into a common/generic one.

And secondly, we contacted the individuals _after_ their work (auction, class, pattern/kit, bear, etc..) was finished online, and not one of these had been contacted by SA/EP, about the thread bear issues (not to use, their ownership, pulling their auctions off eBay. etc...) Again, a capricious, inconstant policing of the Mark which continues today, as there are sellers online now who have never heard of SA/EP, never heard of the Mark issues and never heard of Thread Bears®.

There are also illegal copies of patterns online now, designed and sold by SA/EP, where the site owners are illegally displaying the patterns for all to reprint and use for free. It is possible to remove them, though it does involve much paperwork and follow-up. SA/EP were told about one site in particular. It is still online; it’s assumed they took no action in removing this flagrant misuse of their own work (denying themselves of revenues) which has been pointed out to SA/EP.

The above charts show how 2 common words __which once were unique and held a certain image__ have become, through use, common and therefore generic names for something. This is a clear directive from the USPTO: Marks are __not__ static. Use can change them over time and, if applicable, can make a Mark open to change in status or open to Cancellation – J N Roberts filing. This is nothing that a “few select artists or an online Yahoo group accomplished, but by the efforts of all, embracing this new field of creating and collecting.

SA/EP have looked to lay blame anywhere instead of accepting a fact that the rest of us have, that this Mark has __always__ carried the 2(f) designation, (Original Mark was issued with it affixed, posted in Issue #2) even to the USPTO themselves, in an ‘Answer’ to the Cancellation filing:

Due to this cancellation attempt... we can not continue to protect our mark because it is now considered a 2(F). It is not us that is allowing the misuse at this time.. but the USPTO. See evidence #13A (Google's response). Others in connection with making

There is little wonder that the term came to be associated in most bear crocheters' and collectors' minds as thread bears. E.g., The online Yahoo! Group, Thread Animals, receives dozens of applications from prospective members weekly. Most of them include the word thread bear. These individuals are unknown to members of the group: new applicants found the group by using that term in an online search engine like Google or in Yahoo's own search function.

Individuals using the term on numerous websites, search engines, artists, collectors, magazines... were all using the phrase thread bears as descriptive terms (as were the Applicants themselves) on their patterns, website, advertising, auctions, etc..... and the applicants continued to do so for months even after the Cancellation notice was filed, from July 2006 into mid-2007, claiming that it was their right to use it in this manner because they own the Mark and it still described their products. They have admitted so in their filed Answer to our correctly worded Petition of Cancellation, 7 August 2006. It just cannot be both ways, a proper Mark and a description!

When one company -

- ~ produces a line of patterns and calls them thread bear patterns*
- ~ encourages others to create their own renditions of the patterns*
- ~ calls their products (bears and patterns) thread bears (lower case, adjective/noun format) on their website, patterns, emails and in auctions until 2007, 4 years after having received the Trade Mark (on the same 'informative' website) and more than 8 months after the Cancellation Filing began, where this was pointed out*
- ~ does not have the company name (Thread Bears®) as the foremost TITLE in view at all times*
- ~ has several trade marks and no one of these is afforded more importance than the others in print anywhere (Updates to website in late 2008 have finally modified this)*
- ~ begins policing the mark only after the USPTO and opposers' attorney points out, in court documents, that there has been no concerted effort at policing*
- ~ places a small notice on their eBay About ME page, relaying information about Thread Bears© mark and uses and considers that a 'Public Notice' they're mistaken*
- ~ doesn't police their mark with consistency and constantly; laxness allows the mark to go unfettered in the public's mind.*

SA/EP's statement about constant and continuing policing the Mark: from the Cancellation 'Answer' filing:

We had informed others about our trademark Thread Bears in the place we do business in 2004 and earlier on our website using registration symbols. (See Our eBay ME page

The place of business mentioned was the eBay Me page. SA/EP have said they do not attend the teddy bear venues of trade shows, conventions and the like and are not known to be on bear chat groups. With rare exception, except within the circle of their dedicated collectors, the larger bear community does not know them.

The Mark was not associated with their company as their eBay ID was/is threadybears, as was their website url, which carried several trade names—each for different pages, with none predominant.

The plaintiff (there must always be one figurehead in any movement...) was Berta Heslen-Minten. From the earliest days of both companies working online to promote crocheted bears; both were teaching,

through pattern and kit development and classes taught. Hundreds, perhaps even thousands of the first collectors, became working artists themselves, through the instruction gained from those who developed this miniature world. This obviously increases the work force and dilutes the known collector base. One must actively seek out new ways to attract collectors, not just jealously guard the names known to them. Where there were once a few sellers (and the early bears were crude compared to the average bear today!) this work then garnered hundreds of dollars. Then the revenues dropped as the competition increased; there were more and more bear makers becoming artists in their own right. That is the time to work HARDER, not lick one's wounds and look to blame someone.

There are many products in the shape of a bear, online at this very moment, with the words thread bear in the title (on websites, auctions, advertisements, on eBay...) There are websites with thread bear(s) in the title and peppered throughout their sites. There are other companies calling themselves combinations of the words thread bears. There are even websites illegally offering copied patterns, designed by Thread Bears®, which have been pointed out to them. It does take paperwork filing to eliminate these 'leaks', yet the patterns remain online. As do all of the other places mentioned here. That is not constant, across-the-board 'policing' of a Mark.

These individuals do not know that SA/EP hold a Registered Trademark in the name of Thread Bears®. They have never even heard of the conflicts over this term; they're simply doing what they like to do and calling it/themselves 'thread bear(s)'.

If there is any concerted effort at harassing anyone and attempting to absorb her well-known trade name into another Mark for themselves, it is being done to Berta H-Minten and ThReAdTeDs® (Benelux Registration) not by her, with the application for 'Thread Teds by Thread Bears™'.

No one can spoil another's business; one does that to themselves. Those who keep working, who are willing to work within the confines of very difficult conditions and situations, keep developing new techniques, keep advertising, keep selling, develop new patterns, search out new resources, combine different Art formats, always stay ahead as a cutting edge developer rather than as a copier or a follower of trends—these are the keys to success. Taking oneself out of the marketplace over a perceived injury will be like slogging through quicksand to regain the level of past attention and income; memories are short in the collecting world. An absence of six months is like starting all over again.

In 2005, several artists felt strongly enough about the decision to go through with filing for a Cancellation of this Mark, to argue the case through the law system with the aid of an Intellectual Property attorney, and it was done on Principle - for the good of the entire crocheting thread bear world. It was decided to discontinue going to a full court case and bring this before a Judge in a process called a Summary Judgment instead. The mark will stand as is. However, we are still not prevented from using the two words as a generic, descriptive phrase, as in - lower case, due to the long-standing Trademark Act, Section 2(f) in the Mark. The named individuals in the SA/EP website news letter will never use it in a situation which would even imply that they are the Thread Bears® company: that WOULD be Trademark Infringement, under the clause of 'Confusion as to Source of Goods', and will refrain from using it in public until after all three Mark applications have been finalized in the USPTO: Thread Bears®, ThReAdTeDs® and Thread Teds by Thread Bears™.

While Thread Bears® does now have the ability to pull eBay auctions through its VeRO program, and we will always defend everyone's right to correctly use their Trademarks, we would advise those wishing to use the phrase/term thread bear(s) to use their own judgment and discretion in where to place it. This is one of the key factors in this decision: until all 3 cases concerning this issue have been finalized in the laws of the United States, the USPTO, the posting above by J N Roberts and the Office Final Action are what we base our knowledge, information and decisions on:

THIS IS A FINAL ACTION

This FINAL OFFICE ACTION responds to applicant's communication filed on December 14, 2006 in which the applicant argued against the requirement for the disclaimer of the wording "THREAD BEARS". The examining attorney has carefully considered the applicant's arguments but has found them unpersuasive. For the reasons below, the requirement for the disclaimer of the wording "THREAD BEARS" is maintained and now made FINAL. 37 C.F.R. §2.64(a).

Disclaimer

Applicant has previously disclaimed the descriptive wording "THREAD TEDS" and "BEARS" apart from the mark. Applicant must now however disclaim the generic wording "THREAD BEARS" apart from the mark as shown because it is the common name for the applicant's goods as cited in the application, namely, "Collectables in the nature of Bears, Dolls and Animals, all the forgoing jointed and crocheted, sewn, felted and soft sculpted from various fibers and materials." Trademark Act Section 6, 15 U.S.C. §1056; TMEP §§1213 and 1213.03(a). Please note, **the disclaimed wording remains part of the mark and the appearance of the applied-for mark will not change.**

ISSUE #3 -

When SA/EP filed the form for Declaration of Incontestability on 8 April 2003, they were using a form more properly filled out by the original owner - Walsh/Our Secret, Ltd.

http://tmportal.uspto.gov/external/PA_1_0_LT/OpenServletWindow

Document Description: PR-Section 15
Mail / Create Date: 06-Jun-2005

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<TRADEMARK/SERVICEMARK INFORMATION>
 <MARK> Typed words Thread Bears ✓
 <REGISTRATION NUMBER> 2146208 ✓
 <SERIAL NUMBER> 75245684
 <REGISTRATION DATE> 03/24/1998 ✓

Adjustment date: 07/08/2004 CFITZGER
 05/09/2003 K6IBBONS 00000108 2146208
 01 FC:6208 -200.00 OP

<OWNER INFORMATION>
 <NAME> Emma Lee Petersen
 <STREET> 217 Copper
 <CITY> Kingman
 <STATE> AZ
 <COUNTRY> USA
 <ZIP/POSTAL CODE> 86401
 <E-MAIL ADDRESS> lips@citlink.net

07/08/2004 CFITZGER 00000001 2146208
 01 FC:6205 100.00 OP
 02 FC:6206 100.00 OP

<OWNER INFORMATION>
 <NAME> Susan Lynn Aucoin
 <STREET> 2728 Lillie
 <CITY> Kingman
 <STATE> AZ
 <COUNTRY> USA
 <ZIP/POSTAL CODE> 86401
 <E-MAIL ADDRESS> odie@citlink.net

<GOODS AND SERVICES INFORMATION>
 <ALL GOODS AND/OR SERVICES IN EXISTING REGISTRATION> Yes

~ The owner has used the mark in commerce for five consecutive years after the date of registration, or the date of publication under Section 12(c), and is still using the mark in commerce on or in connection with all goods and/or services listed in the existing registration.

/2003-K6IBBONS 00000108 2146208
 :6208 200.00 OP

<FEE INFORMATION>
 <TOTAL FEES PAID> 200
 <NUMBER OF CLASSES> 1

<LAW OFFICE INFORMATION>
 <E-MAIL ADDRESS FOR CORRESPONDENCE> lips@citlink.net

http://www3.uspto.gov/cgi-bin/teas/V1.22/PostReg/getF7?USPTO-653788100-2003040817... 4/8/2003

When SA/EP filled their names into the form, the USPTO returned it, saying they are not the current owners of Record:

http://tportal.uspto.gov/external/PA_1_0_LT/OpenServl...Page=1&rowNum=12&rowCount=29&formattedDate=

Document Description: **Offc Action Outgoing**
Mail / Create Date: **09-Jul-2003**

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UNITED STATES PATENT AND TRADEMARK OFFICE

REGISTRATION NO: 2,146,208		
REGISTRANT: Our Secret, Ltd.		July 9, 2003
CORRESPONDENT ADDRESS: EMMA LEE PETERSEN 217 COPPER KINGMAN, AZ 86401		RETURN ADDRESS: Commissioner for Trademarks 2900 Crystal Drive Arlington, VA 22202-3514 TMPostRegistration@uspto.gov
MARK: THREAD BEARS		
CORRESPONDENT'S REFERENCE/DOCKET NO: N/A		
CORRESPONDENT EMAIL ADDRESS: N/A		

Please provide in all correspondence:

1. Registration date, registration number, mark and registrant's name.
2. Date of this Office Action.
3. Examiner's name and Post Registration Division.
4. Your telephone number and e-mail address.

POST REGISTRATION OFFICE ACTION

A full year later SA/EP sent in the Abstract of Title Assignment and 21 months later applied to have the names corrected as the Mark's Owners.

(It was just 3 weeks later that, while continuing to use the lower-case form of adjective/noun of thread bears, themselves, they began sending a few dozen, select, inconstant emails to artists (of the hundreds using the term online), telling them to not use the term and caused eBay.com to pull auctions off-inline, without warning in some cases, claiming Trademark Infringement. This was the first "wide-spread" notice sent out to the bear world that they were having problems with its use. It may have appeared to SA/EP to be a Public Notice but the number of individuals who read the notice on their website is extremely low. The number of emails sent out—for free, so claim of diminished revenue for this Policing is not a valid point—was extremely low, considering the percentage of individuals using the phrase/term.)

Document Description: **Unclassified-Other**
Mail / Create Date: **21-Jun-2004**

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wysiwyg://114/http://uspto-a-ptasx-2.uspto.gov/ahdstaff/q.jsp?db=tm&mo=2146208

Trademark Assignment Abstract of Title

Total Assignments: 1

Serial #: 75245684 **Filing Dt:** 02/21/1997 **Reg #:** 2146208 **Reg. Dt:** 03/24/1998

Registrant: Our Secret, Ltd.

Mark: THREAD BEARS

Assignment: 1

Reel/Frame: 2872/0142 **Received:** 12/03/2003 **Recorded:** 04/10/2003 **Mailed:** 06/17/2004 **Pages:** 4

Conveyance: ASSIGNS THE ENTIRE INTEREST

Assignor:

MATT, WALSH

Exec Dt: 03/10/2003

Entity Type: CORPORATION

Citizenship: NEW MEXICO

Assignees: PETERSEN, EMMA LEE

217 CUPPER

KINGMAN, ARIZONA 86401

AUCOIN, SUSAN LYNN

2728 LILLIE

KINGMAN, ARIZONA 86401

Entity Type: INDIVIDUAL

Citizenship: UNITED STATES

Entity Type: INDIVIDUAL

Citizenship: UNITED STATES

Correspondent: EMMA LEE PETERSON

217 COPPER

KINGMAN, AZ 86401

Search Results as of: 6/21/2004 4:18:16 P.M.

If you have any comments or questions concerning the data displayed, contact OPR / Assignments at 703-308-9723
Web interface last modified: Oct. 5, 2002

Document Description: Paper Correspondence Incoming
Mail / Create Date: 31-Jan-2005

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SN # 75245684
RQ# 2146208
11

To whom it may concern;

I am filing for a new certificate of registration for the trademark Thread Bears. Also to have the name changed on the data base. The current name is :
Our secrets , LTD.

We received an assignment and it has been registered in our names;

Petersen, Emma
217 Copper
Kingman, Arizona 86401
and

Aucoin, Susan
2728 Lillie
Kingman, Arizona 86401

We do not have the original certificate so I am inclosing a copy of the assignment and the letter that has the recordation date : 04/10/2003.

*But in going back to the wording on the Declaration by SA/EP and this by Walsh/Our Secret. Ltd., the 'same Five-Year span' is used to cover 'very' different time periods.
28 July 1997:*

CLAIM OF ACQUIRED DISTINCTIVENESS

Alternatively, the Examiner has indicated that in light of applicant's use of the Mark for a significant time, the applicant may amend the application to seek registration under Trademark Act § 2(f), 15 U.S.C. § 1052(f), based on acquired distinctiveness.

In support of applicant's claim of acquired distinctiveness, applicant states that the Mark has become distinctive of the goods through the applicant's substantially exclusive and continuous use in commerce of the Mark for at least the five years immediately before the date of this statement. >

pru

The wording in the text is true (the Mark was in the possession of the original owner) for the period of time from 1986 - 1997, when the Mark was first applied for. It is unknown if Our Secret, Ltd. was still using it in commerce in the five years prior to signing the Declaration; though SA/EP affirmed that this was the truth under oath, in a Response/Answer filed in the Cancellation proceedings, yet they also claimed:

Issue #10

We neither admit nor deny this statement. We are without information of how Our Secret Ltd. conducted business.

But in the second paragraph (Claim of Acquired Distinctiveness) Walsh/Our Secret, Ltd. has sworn, on 28 July 1997, that he was using the Mark “substantially, exclusively and continuously in commerce for at least Five Years __immediately before__ the date of this statement.”

These two time periods just do not match up when scrutinized. Five years before SA/EP’s affirmation of Five Years of Use in Commerce would push back their use from 2003 to 1998! When one falsehood is allowed to slip through a huge bureaucracy, it’s a shell game. And illegal.

The artist community has chosen not to pursue this discrepancy, as a case in criminal courts would cost many thousands of dollars. Our point has been made and we can rest with that.

These are just three of the points in the very extensive, complicated case which we presented to the USPTO. It was not done rashly or in a hurry but considered and for the good of all who crochet or wish to use those two common words - thread bear(s). The Judge chosen to read the Pleadings and decide on the case, chose to retain the Mark as it is. (Without changes, we ascertain that the Trademark Act, Section 2(f) still stands.)

ThReAdTeDS® and Thread Teds by Thread Bears™ applications are still before the USPTO. Win or lose, we do know that we would not feel right unless we truly followed this through to the end, not with idle words – “to the full extent of the law” - but with action. We can hold our heads up proudly, knowing that we’ve done our best.

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