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UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 77/145880

MARK: ECOLOGICAL PAVER SYS

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GENERAL TRADEMARK INFORMATION:
http://www.uspto.gov/main/trademarks.htm

TTAB INFORMATION:
http://www.uspto.gov/web/offices/dcom/ttab/index.html

APPLICANT: Advanced Pavement Technology Inc.

CORRESPONDENT'S REFERENCE/DOCKET NO:
10117t00060
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EXAMINING ATTORNEY'S APPEAL BRIEF

The applicant has appealed the Trademark Examining Attorney's refusal to register the mark ECOLOGICAL PAVER SYSTEMS in standard character for "[p]aving contractor services." The refusal was issued under Section 2(e)(1) of the Trademark Act, 15 U.S.C. Section 1052(e)(1), finding that the mark is merely descriptive within the meaning of the Act.

FACTS

On April 2, 2007, the applicant filed an application based on an intent to use under Section 1(b) for the mark ECOLOGICAL PAVER SYSTEMS for "[p]aving contractor services." On July 25, 2007, the Examining Attorney issued an Office action refusing registration for a 2(d) likelihood of confusion. In addition, a requirement for a disclaimer

of “paver systems” was issued. On January 28, 2008, the applicant filed a response to the Office action, which presented arguments against the substantive refusal and provided a disclaimer.

On April 3, 2008, the Examining Attorney issued an Office action to supersede the previous Office action. Registration was refused under Section 2(e)(1) of the Trademark Act for descriptiveness. On October 3, 2008, the applicant filed a response to the Office action, which presented arguments against the 2(e)(1) refusal. On October 31, 2008, the Examining Attorney issued a Final action on the descriptiveness issue. Applicant subsequently filed a Notice of Appeal.

The issue on appeal is whether applicant’s mark is descriptive in relation to the identified services.

ARGUMENT

WHEN VIEWED IN THE CONTEXT OF APPLICANT’S IDENTIFIED SERVICES, THE MARK, ECOLOGICAL PAVER SYSTEMS, IS MERELY DESCRIPTIVE OF A CHARACTERISTIC, FEATURE, FUNCTION OR PURPOSE OF APPLICANT’S SERVICES AND WOULD BE REGARDED BY CONSUMERS AS PROVIDING PAVER SERVICES FEATURING ENVIRONMENTALLY-FRIENDLY AND SOUND PAVING PRODUCTS.

A mark is merely descriptive if it describes an ingredient, quality, characteristic, function, feature, purpose or use of the specified goods and/or services. TMEP §1209.01(b); *see In re Steelbuilding.com*, 415 F.3d 1293, 1297, 75 USPQ2d 1420, 1421 (Fed. Cir. 2005); *In re Gyulay*, 820 F.2d 1216, 1217-18, 3 USPQ2d 1009, 1010 (Fed. Cir. 1987). Moreover, a

mark that identifies a group of users to whom an applicant directs its goods and/or services is also merely descriptive. TMEP §1209.03(i); *see In re Planalytics, Inc.*, 70 USPQ2d 1453, 1454 (TTAB 2004).

Further, the determination of whether a mark is merely descriptive is considered in relation to the identified goods and/or services, not in the abstract. *In re Abcor Dev. Corp.*, 588 F.2d 811, 814, 200 USPQ 215, 218 (C.C.P.A. 1978); TMEP §1209.01(b); *see, e.g., In re Polo Int'l Inc.*, 51 USPQ2d 1061 (TTAB 1999) (finding DOC in DOC-CONTROL would be understood to refer to the "documents" managed by applicant's software, not "doctor" as shown in dictionary definition); *In re Digital Research Inc.*, 4 USPQ2d 1242 (TTAB 1987) (finding CONCURRENT PC-DOS merely descriptive of "computer programs recorded on disk" where relevant trade used the denomination "concurrent" as a descriptor of a particular type of operating system). "Whether consumers could guess what the product is from consideration of the mark alone is not the test." *In re Am. Greetings Corp.*, 226 USPQ 365, 366 (TTAB 1985).

Two major reasons for not protecting descriptive marks are (1) to prevent the owner of a descriptive mark from inhibiting competition in the marketplace and (2) to avoid the possibility of costly infringement suits brought by the trademark or service mark owner. *In re Abcor Dev. Corp.*, 588 F.2d 811, 813, 200 USPQ 215, 217 (C.C.P.A. 1978); TMEP §1209. Businesses and competitors should be free to use descriptive language when describing their own goods and/or services to the public in advertising and marketing materials. *See In re Styleclick.com Inc.*, 58 USPQ2d 1523, 1527 (TTAB 2001).

In the present case, applicant seeks registration of the mark ECOLOGICAL PAVER SYSTEMS for "paving contractor services." The mark is descriptive because it immediately conveys that applicant's services utilize paving systems that incorporate environmentally conscious or friendly methods and/or products. The term and concept is recognized by consumers seeking and businesses providing such services.

THE TERM "ECOLOGICAL" IS DESCRIPTIVE IN APPLICANT'S MARK WHEN VIEWED IN PROPER CONTEXT OF THE IDENTIFIED SERVICES

Applicant argues that "none of the dictionary definition for 'ecological' provided […] are at all descriptive of the services sought for registration." Further, applicant argues that "none of the definitions say anything about environmentally friendly methods or products." Therefore, applicant argues that "at a minimum, a multi-stage reasoning process […] is required to discern the nature of the services associated with the mark."

The Examining Attorney disagrees. On page 16 of the 4/3/2008 Office action in TICRS, the definition for the noun form of ecological, namely ecology, by American Heritage Dictionary states that it is "[t]he study of the detrimental effects of modern civilization on the environment, with a view toward prevention or reversal through conservation." "ecological." *The American Heritage® Dictionary of the English Language, Fourth Edition*. Houghton Mifflin Company, 2004. 03 Apr. 2009. <Dictionary.com http://dictionary.reference.com/browse/ecological>. As the focus is to prevent *detrimental effects* on the environment, the Examiner's paraphrasing of the meaning was reasonable in substituting the more commonplace term of environmentally friendly

instead of consistently reiterating that applicant's services feature paver systems that recognize "detrimental effects of modern civilization on the environment, with a view toward prevention or reversal through conservation." The term conveys that use of the services is friendly rather than unfriendly or "detrimental" to the environment. Therefore, the Examining Attorney believes that the applicant's argument is inaccurate and unpersuasive. The term is descriptive in relation to the identified services. In the present case, the term ecological means that the paving systems prevent or reverse detrimental effects on the environment.

THE WORDING "PAVING SYSTEMS" IS DESCRIPTIVE IN APPLICANT'S MARK WHEN VIEWED IN PROPER CONTEXT OF THE IDENTIFIED SERVICES

Applicant concedes that the "paving systems" portion of the mark is descriptive in relation to the services as evidenced by their disclaimer of the wording.

THE TERM "ECOLOGICAL PAVER SYSTEMS" IS DESCRIPTIVE OF THE IDENTIFIED SERVICES

A mark that merely combines descriptive words is not registrable if the individual components retain their descriptive meaning in relation to the goods and/or services and the combination results in a composite mark that is itself descriptive. TMEP §1209.03(d); *see, e.g., In re King Koil Licensing Co. Inc.*, 79 USPQ2d 1048 (TTAB 2006) (holding THE BREATHABLE MATTRESS merely descriptive of "beds, mattresses, box springs and pillows"); *In re Associated Theatre Clubs Co.*, 9 USPQ2d 1660, 1662 (TTAB 1988) (holding GROUP SALES BOX OFFICE merely descriptive of theater ticket sales services). Such a mark is registrable only if the composite creates a

unitary mark with a unique, incongruous, or otherwise nondescriptive meaning in relation to the goods and/or services. *See, e.g., In re Colonial Stores, Inc.*, 394 F.2d 549, 551, 157 USPQ 382, 384 (C.C.P.A. 1968).

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

The Examining Attorney believes that the refusal of registrability was not controlled by merely the dictionary definitions of the words, as asserted by Applicant, but also supported by usage of the term in the marketplace. Ecological paver systems are a type of paver system newly sought out by consumers seeking environmentally friendly and sustainable alternatives to paver systems that often had ill-effects on the environment.

The applicant argues that pages 11 and 13 of the April 3, 2008 Office action in TICRS are not descriptive use but rather "careless by the copy writer in paraphrasing of the Applicant's use of the mark." The Examining Attorney disagrees. The headline for the first article reads "Paving success with stormwater: ecological paving systems can grow green profits for producers." Both articles later use the phrase in a descriptive manner as part of a paragraph to extol the benefits of such goods. It is unreasonable to assume that such use in two different articles could be chalked up to "careless" copy writing.

In addition, the evidence submitted from a “green” website featuring a resource sheet of companies in various industries that offer “green” or environmentally friendly building options lists applicant’s field as featuring “[e]cological [p]avers, [p]avers [c]leaning, [s]ealing, [m]aintenance, [p]aver [s]tones.” The evidence is persuasive because it shows use of the term “ecological pavers” as part of a descriptive listing of the numerous services believed to be offered by applicant. Consumers viewing the term would reasonably believe ecological pavers to be another type of paver for which applicant could provide such type of pavers (in contrast to the also listed “paver stones”) in conjunction with various paving related services. *See pages 2-3 of 04/03/08 Office action in TICRS*.

Further, the applicant argues that evidence submitted by the Examiner shows “obscure use” because it was “buried” in “meeting minutes” from a city’s council meeting and should not be considered persuasive. *See page 7 of the 04/03/2008 Office action in TICRS.* The Examining Attorney disagrees. The evidence is persuasive because it shows knowledge of the term and use of the term by exactly the type of consumers most likely to utilize the services. Use of the term by a city’s mayor is clearly reflective of a consumer in the marketplace, namely, a municipality that sought out a specific type of paver system, namely, an ecological paver for improvements to city spaces. The evidence clearly shows use of the term in relation to environmentally friendly or “sound” measures for paving. The ecological pavers were a desirable and known concept to the consumer such that their utilization marked an “accomplishment” of an administration.

Therefore, the term is descriptive of a type of paver system for which use in the marketplace is shown in the evidence.

In addition, the applicant finds the Wikipedia article and the LexisNexis articles insufficient in number to assert that the term is a "part of the lexicon of the marketplace." The applicant neither argues that the information in the Wikipedia article and the LexisNexis articles is inaccurate nor attempts to rebut any specific issues with the entry or articles. Rather, the applicant finds fault in the limited number of articles, and therefore believes that the articles should be viewed as unpersuasive. The Examining Attorney disagrees. The Examining Attorney believes the evidence cited is representative of results that were found in searching.

Further, ecological paver systems are a part of new technology and an emerging industry such that large numbers of stories and cites are not yet available. The previously mentioned articles support the emerging nature of the market and thus the term. *See page 11 of 04/03/2008 Office action in TICRS*. Further, as mentioned in the third LexisNexis article:

> This ecological paver system allows water filtration through the base, reduces runoff and allows for development cost savings due to a reduction in storm sewers and drainage infrastructure. Though it is new to North America, it comes backed by a decade of scientific research in Germany.

See "13 of 100 documents" in the 10/31/2008 Final action in TICRS. Although the aforementioned article is from a Canadian business magazine, the information is probative on the issue of descriptiveness and likely to be viewed by the American

business community. The article is written in English and is likely to be of interest worldwide. *In re Remacle*, 66 USPQ2d 1222 (TTAB 2002). Growing concern for ecologically friendly and sustainable products and services such as pavers and paving services is global in nature, as supported by international forums on the issue. *See "6 of 100 documents" in 10/31/2008 Final action in TICRS, which reports on a global conference in San Francisco*. Therefore companies providing such services and American consumers seeking information on such services would likely search for information outside the United States.

For the above reasons, the mark is descriptive in relation to the applicant's services.

CONCLUSION

The applicant's mark ECOLOGICAL PAVER SYSTEMS is merely descriptive under Section 2(e)(1) because it immediately describes a characteristic, feature, function, or purpose of the services. The paving contractor services feature environmentally friendly or sustainable pavement elements. For the foregoing reasons, the refusal to register on the basis of Trademark Act Section 2(e)(1), 15 U.S.C. Section 1052(e)(1) should be affirmed.

Respectfully submitted,

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