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## **I. INTRODUCTION**

On August 8, 2011, Applicant filed its Appeal Brief in support of the registration of Serial No. 77/713,799 for the mark “THE BLACK SERIES” in connection with “electric massage appliances, namely, hand-held massagers, massage mechanism for chairs, and foot spa massagers,” in International Class 10. On October 14, 2011, the newly assigned Examining Attorney filed her responsive appeal brief.

Applicant maintains that its application should be granted registration on the Principal Register, as the Examining Attorney has failed to provide sufficient evidence showing that the term “THE BLACK SERIES” is merely descriptive of Applicant’s goods and not entitled to registration on the Principal Register.

## **II. THE EXAMINING ATTORNEY’S BRIEF DOES NOT SUPPORT THE CONCLUSION THAT THE MARK “THE BLACK SERIES” IS MERELY DESCRIPTIVE OF APPLICANT’S GOODS**

### **A. Preliminary Matter - The Third Party Registrations and Specimens Submitted with Applicant’s Appeal Brief were Not Improper.**

The Examining Attorney objected to Applicant’s submission of additional third party registrations and specimens on appeal as improper. In its Request for Reconsideration, Applicant had submitted copies of numerous third party registrations and specimens, which had been taken from the Office’s electronic records. As discussed more fully below and in Applicant’s Appeal Brief, these registrations and specimens demonstrate that the Office has allowed the several marks to be registered on the Principal Register without a disclaimer of the term BLACK, despite the color of the goods shown in the respective specimens, or the term SERIES.

On Appeal, Applicant submitted additional third party registrations and specimens, also taken from the electronic records of the Office, as cumulative support for its position that a disclaimer should not be required for BLACK or SERIES.

Although Applicant is aware that the Board generally does not take judicial notice of third-party registrations when an applicant or examining attorney requests that such notice be taken during the course of an appeal, (Trademark Trial and Appeal Board Manual of Procedure (TBMP) § 1208.02), Applicant maintains that its reference to additional third party registrations and specimens on appeal is not improper in this case. These registrations and specimens were taken from the Office's electronic records, were available to the Office during the prosecution of this matter, and do not require any extraneous evidence or proof.

Furthermore, “[t]he Board generally takes a somewhat more permissive stance with respect to the admissibility and probative value of evidence in an *ex parte* proceeding than it does in an *inter partes* proceeding.” TBMP § 1208. The instant appeal is an *ex parte* proceeding. Accordingly, Applicant respectfully requests that the Board exercise its discretion to consider and take judicial notice of these third party registrations and specimens in support of Applicant's position a disclaimer should not be required for BLACK or SERIES.

**B. “BLACK” Is Not Merely Descriptive of Applicant's Goods**

The Examiner argues that “Applicant's massage devices *feature* the color BLACK and therefore the term is descriptive of the goods, in spite of evidence showing the goods in gray and light gray.” (emphasis added) The Examining Attorney further mischaracterizes the goods shown in the record as “appearing in the color black in a prominent and conspicuous fashion,” and states that this is sufficient to show that the “term BLACK describes a significant characteristic or feature of the goods.” The Examining Attorney states that it is important to note that “a mark may be merely descriptive even if it does not describe the ‘full scope and extent’ of the applicant's goods.” This point, however, does not dismiss the fact that the term must still describe at least one *significant* function, attribute or property, the operative word being *significant*. Applicant respectfully disagrees and traverses the Examining Attorney's characterization of these products and argument that BLACK therefore describes a significant characteristic or feature of the goods. The use of the color

black within certain products is not a significant characteristic or feature of the goods as evinced by the fact that evidence has been introduced that shows some goods in other colors as discussed below.

The record shows two out of three of Applicant's products are not black in color. With respect to the foot massager, the images in the record show that it is a gray product, with a dark gray base and light gray top surface. The top surface includes two rotating plates with 6 silver shiatsu massagers on each plate. Although the Examining Attorney did not comment on this product during the prosecution of this application despite having images of the product, the Examining Attorney is now placing undue emphasis on the rotating plates, which are dark or black in the "off" position and reddish-orange in the "on" position. Product advertisements show the product in the "on" position, to demonstrate the product's heating function. (Exhibit A)<sup>1</sup> The color of the rotating plates in the "off" position is not a significant feature of the product. Rather, the massaging and heating functions of the plates are significant and likely to have an effect on the consumer's decision to purchase the product.

Significantly, the Examining Attorney offers absolutely no evidentiary support for the argument that "the term BLACK would describe to the average purchaser of massage apparatuses that the goods contain the color BLACK," or that the relevant purchasing public would consider color to be a significant feature of Applicant's goods. Indeed, the Examining Attorney has failed to meet its burden of providing compelling evidence that establishes a significant number of the relevant public would readily view the term BLACK as being merely descriptive of Applicant's goods.

With respect to the meaning of the term BLACK, Applicant had submitted examples of various goods and services that utilize the term BLACK to create an association with luxury, quality and elegance. See May 17, 2011 Request for Reconsideration. In the Examining Attorney's Appeal

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<sup>1</sup> Applicant is submitting Exhibit A to address a new comment from the Examining Attorney, and respectfully requests that the Board consider and take judicial notice of the evidence submitted.

Brief, the Examiner stated that she was unpersuaded that the term BLACK denotes luxury in relation to Applicant's "more commonplace" goods, since "[l]uxury automobiles and mattresses unquestionably cost significantly more than applicant's massaging devices."

The Examining Attorney is mistaken. Applicant does not contend that the Applicant's goods are synonymous with luxury automobiles or mattresses. Rather, Applicant submits that the term BLACK is a metaphor for luxury, which must be understood in relation to the goods or services at hand. This is exemplified by the very examples cited by the Examining Attorney. A luxury automobile unquestionably costs significantly more than a luxury mattress, yet the term BLACK in relation to a mattress can still be perceived by the relevant purchasing public as a high-end luxury item. Likewise, in the instant case, the term BLACK is a metaphor to distinguish Applicant's elegantly designed premium quality massagers from competitor's massagers, which are sold at a lower price point. Although the Examining Attorney referred to the evidence in the record showing Applicant's handheld massager was priced at \$94.99 and significantly less expensive than a luxury automobile or mattresses, the Examining Attorney overlooked the very next pages in the record, which show competitors' hand-held massagers were priced significantly lower than Applicant's massager. See Exhibit J to May 17, 2011 Response to Office Action. Furthermore, the Examining Attorney offered no evidence to support her contention that the meaning of BLACK (i.e., as a metaphor for premium quality goods) would not convey to Applicant's goods.

**C. "SERIES" Is Not Merely Descriptive of Applicant's Goods.**

The Examining Attorney has mischaracterized Applicant's goods as constituting a series of products to support the argument that the term SERIES should be disclaimed. Applicant respectfully disagrees and traverses this argument.

According to the Examining Attorney's Appeal Brief, the term SERIES is defined as "a group or connected *succession* of similar or related things, *usually arranged in order*." (citations omitted) (emphasis added) The Examining Attorney contends that "Applicant's goods are a group of

connected massage apparatuses which can be construed as a SERIES. Specifically, applicant's SERIES is comprised of hand-held massagers, massage mechanism for chairs, and foot spa massagers. Thus, per the plain meaning of the term, the word SERIES merely describes a feature of applicant's goods." The Examining Attorney further argues that, "By virtue of the fact that the goods are varied in format, e.g., hand-held massagers, massage mechanisms for chairs, foot spa massages, but yet connected as being a group of massaging devices, all sold under the same name, the goods do in fact comprise a SERIES."

This logic is flawed and disregards the very definition cited by the Examiner. In the definition of the term "series" above, the operative concept is *succession* – i.e., things that are "usually arranged in order." The definition above is consistent with the definition of "series" previously submitted by Applicant: "a number of things or events of the same class coming one after another in spatial or temporal succession." See Exhibit N to May 17, 2011 Request for Reconsideration.

Here, the Examining Attorney is singularly focusing on the relatedness of Applicant's products to show that they are all massage appliances, without addressing the subject of *succession*. Indeed, 'series' typically implies the succession of the same item, e.g., the next version. Nothing in the application suggests or implies that Applicant's goods comprise a group of items that would constitute a series, nor suggest or imply any specific succession in product release. Further, the Examining Attorney has not offered any evidence showing any succession in relation to Applicant's products. Selling an identified type of item in association with the same trademark does not transform those items into a series of products.

In response to the Examiner's statement that "the goods are varied in format . . . but yet connected as being a group of massaging devices," Applicant maintains that the fact that the massagers are available in different formats – e.g., hand-held massagers, massage mechanisms for chairs, foot spa massages - does not create any spatial, temporal or other succession amongst these

products. The goods are sold separately and not as a set. Thus, it is highly unlikely that the relevant purchasing public would perceive these goods would be used in sequence to one another.

The Examining Attorney relies on the Office's disclaimer of "SERIES" in selected third party registrations, and cited three in the Examining Attorney's Appeal Brief: Registration No. 3776618, for the mark SOULSTICE SEMINAR, Registration No. 3556369, for the mark FETISH FANTASY SERIES, and Registration No. 3965168, for the mark EARTH SERIES.

The Examiner's reliance on these third party registrations is misplaced. For reasons set forth in Applicant's Appeal Brief, these third party registrations are distinguishable and provide no support for a disclaimer of SERIES in connection with Applicant's goods. As the Examining Attorney has not rebutted or even addressed Applicant's arguments, Applicant respectfully requests that the Board not take notice or consider the third party registrations offered by the Examiner in support of a disclaimer of SERIES in the context of Applicant's goods. With regard to the Examining Attorney's characterization of the identification of goods for the registrations for EARTH SERIES, METAL SERIES, WOOD SERIES and FIRE SERIES, the Examining Attorney omitted that the education services were "namely, providing classes, seminars, conferences and workshops in the fields of yoga, fitness, health, and massage therapy, including educational and training pre-certification courses for yoga instructors, and distributing course materials in connection therewith." The more relevant portion of this description is that the marks are associated with "classes, seminars, conferences and workshops." It is well understood that classes, seminars, conferences and workshops are typically taught in succession or in a series for a given topic. The mere fact that the educational services were in the fields of yoga, fitness, health and massage therapy in and of itself does not describe a 'series.'

**D. The Mark "THE BLACK SERIES," When Considered as a Whole Is Not Merely Descriptive of Applicant's Goods**

Applicant strongly disagrees with and traverses the Examining Attorney's argument that the mark "THE BLACK SERIES" is merely descriptive of Applicant's goods. The argument is

premised on the Examining Attorney's unsupported allegation that, "The examining attorney has established that in connection with the goods of record, the term BLACK describes the color of the goods and the term SERIES describes that the goods are part of a collection or group of massage devices. Thus, together the proposed mark, THE BLACK SERIES, merely describes that applicant's electric massage appliances, namely, hand-held massagers, massage mechanism for chairs, and foot spa massagers, feature the color BLACK and are a group or SERIES of massage apparatuses, sold under the same name."

As discussed above, Applicant maintains that the Examining Attorney has not established or provided any credible evidence to support its contention that the term BLACK is merely descriptive of a significant feature of Applicant's goods. Nor has the Examining Attorney demonstrated that Applicant's goods comprise a group of items that would constitute a series.

The mark "THE BLACK SERIES" is arbitrary as applied to Applicant's goods, or suggestive of the quality of goods at best. In no event, however, has the Office met its burden of establishing that a significant number of the relevant public would readily view "THE BLACK SERIES" as being merely descriptive of a significant aspect of Applicant's goods.

### **III. CONCLUSION**

Applicant respectfully requests that the Board reverse the Office's refusal of registration of the mark and to allow the application to proceed to publication.

In the alternative, Applicant takes the following alternative positions: (i) if on appeal the Board determines the term BLACK is merely descriptive, in the alternative, Applicant disclaims the term BLACK; (ii) if on appeal the Board determines the term SERIES is merely descriptive, in the alternative, Applicant disclaims the term SERIES; (iii) if on appeal the Board determines that either the term BLACK SERIES or THE BLACK SERIES is merely descriptive, in the alternative,

Applicant will accept amendment to the Supplement Register and requests that the application be amended to the Supplemental Register.

Respectfully submitted,

Dated: November 3, 2011

By Connie P. Limperis

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The Sharper Image MSG-C210 Quad Roller Dual-Massager by The Sharper Image

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Scalp Massager (Color May Vary) by Body Company

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\$2.99

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- Heads slowly rotate for invigorating shiatsu motion
- Choose traditional massage or optional heat therapy

**EXHIBIT A**

- Single button power and mode selector
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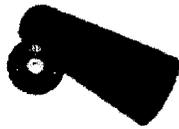
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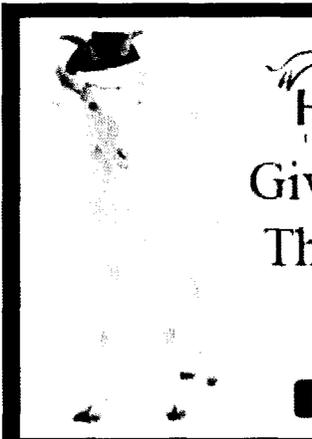
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