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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)  
OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION

APPLICATION SERIAL NO. 77713799

MARK: THE BLACK SERIES



CORRESPONDENT ADDRESS:

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

APPLICANT: MerchSource, LLC

CORRESPONDENT'S REFERENCE/DOCKET NO:

MS09002USITM

CORRESPONDENT E-MAIL ADDRESS:

TMDocketing@eclipsegrp.com

**REQUEST FOR RECONSIDERATION DENIED**

**ISSUE/MAILING DATE: 6/7/2011**

The trademark examining attorney has carefully reviewed applicant's request for reconsideration and is denying the request for the reasons stated below. *See* 37 C.F.R. §2.64(b); TMEP §§715.03(a), 715.04(a). The refusal made final in the Office action dated November 17, 2010 are maintained and continue to be final. *See* TMEP §§715.03(a), 715.04(a).

In the present case, applicant's request has not resolved all the outstanding issue(s), nor does it raise a new issue or provide any new or compelling evidence with regard to the outstanding issue(s) in the final Office action. In addition, applicant's analysis and arguments are not persuasive nor do they shed new light on the issues. Accordingly, the request is denied.

Registration was refused because the applied-for mark, THE BLACK SERIES for "*Electric massage appliances, namely, hand-held massagers, massage mechanism for chairs, and foot spa massagers,*" merely describes a feature or characteristic of applicant's goods. Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1); *see* TMEP §§1209.01(b), 1209.03 *et seq.*

A term is merely descriptive if it conveys an immediate idea of the ingredients, qualities, or characteristics of the identified goods. *See In re Steelbuilding.com*, 415 F.3d 1293,

1297, 75 USPQ2d 1420, 1422 (Fed. Cir. 2005); *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 1346, 57 USPQ2d 1807, 1812 (Fed. Cir. 2001).

Furthermore, the determination of whether a mark is merely descriptive is considered in relation to the identified goods, 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).

The term “black” is defined as “being of the color black, producing or reflecting comparatively little light and having no predominant hue.” *See attached dictionary definition.* Here, as evidenced by the attached Internet articles, the goods are clearly black in color. Thus, the term “BLACK” conveys an immediate idea of a feature or characteristic of the identified goods, specifically the black color of the goods.

Applicant argues that “the term BLACK is suggestive of the quality of the goods, *i.e.*, elegant design and premium quality.” Applicant has also submitted various pieces of evidence showing use by third parties of the term “black” to suggest high quality. However, as noted above, descriptiveness is considered in relation to the relevant goods. The fact that a term may have different meanings in other contexts is not controlling on the question of descriptiveness. *In re Chopper Indus.*, 222 USPQ 258, 259 (TTAB 1984); *In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979); TMEP §1209.03(e). Here, the fact that the goods are black in color is a significant factor in a descriptiveness determination. It is also noted that there is no evidence to support applicant’s contention that the term “black” suggests high quality in relation to its own goods.

Applicant further argues that, based on a particular definition of the term “significant,” the color black in this case is not likely to be a significant feature of the goods. However, “a mark may be merely descriptive even if it does not describe the ‘full scope and extent’ of the applicant’s goods or services.” *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 1173, 71 USPQ2d 1370, 1371 (Fed. Cir. 2004) (citing *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 1346, 57 USPQ2d 1807, 1812 (Fed. Cir. 2001)); TMEP §1209.01(b). It is enough if the term describes only one significant function, attribute or property. *In re Oppedahl*, 373 F.3d at 1173, 71 USPQ2d at 1371; TMEP §1209.01(b). As evidenced by the attached dictionary definition, the term “significant” can also mean “important or noticeable.” *See attached.* It is likely that one of the *first* features a consumer will perceive is a product’s color. The color of a product is highly *noticeable* and is therefore significant. Because the term “BLACK” identifies a significant feature of applicant’s goods, it is considered merely descriptive of the goods.

To support its contention, applicant submitted various third-party registrations for marks incorporating the term “BLACK” on the Principal Register with no disclaimer. The specimens of use for these marks also show goods that are black or partially black in color. For the following reasons, these third-party registrations are not analogous in this situation and have no bearing on the determination of the descriptiveness of applicant’s mark.

- ❖ **U.S. Registration No. 2857989 (BLACK DIAMOND)** – the phrase “black diamond” refers minerals or lumps of coal (*see attached*); because the goods are “*Plastic combs for the professional hairdressing industry*,” the phrase is arbitrary as applied to the goods and not descriptive
- ❖ **U.S. Registration No. 2968269 (BLACK LETTER LINES)** – the phrase “black letter” refers to a particular ornamental typeface (*see attached*); because the goods are “*beverageware*,” the phrase is arbitrary as applied to the goods and not descriptive
- ❖ **U.S. Registration No. 3023344 (BLACK MAGIC)** – the phrase “black magic” is defined as “magic practices for evil purposes or in league with supposed evil spirits; witchcraft” (*see attached*); because the goods are various types of cleaners for automobiles, the phrase is arbitrary as applied to the goods and not descriptive
- ❖ **U.S. Registration No. 3610879 (BLACK GRANITE)** – the phrase “black granite” refers to gabbro, a particular type of igneous rock (*see attached*); because the goods are “*camping cookware*,” the phrase is arbitrary as applied to the goods and not descriptive
- ❖ **U.S. Registration No. 3695503 (BLACK WIDOW)** – the phrase “black widow” refers to a type of poisonous spider (*see attached*); because the goods are “*golf cleat brushes*,” the phrase is arbitrary as applied to the goods and not descriptive
- ❖ **U.S. Registration No. 3755442 (BLACK TIE)** – as applicant explains in its argument, the phrase “black tie” is “commonly understood as referring to semi-formal clothing;” because the goods are decorative display items, glassware and goods made of crystal, the phrase is arbitrary as applied to the goods and not descriptive

In response to applicant’s contention that dissection is inappropriate in determining descriptiveness, it is noted that in determining the descriptiveness of a term or mark comprising more than one element, it is permissible to consider the significance of each element separately in the course of evaluating the term or mark as a whole. *See In re Hotels.com, L.P.*, 573 F.3d 1300, 1301, 1304, 1306, 91 USPQ2d 1532, 1533, 1535, 1537 (Fed. Cir. 2009) (holding HOTELS.COM generic for information and reservation services featuring temporary lodging when noting that the Board did not commit error in considering “the word ‘hotels’ for genericness separate from the ‘.com’ suffix”); *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 1174-75, 71 USPQ2d 1370, 1372 (Fed. Cir. 2004) (holding PATENTS.COM merely descriptive of computer software for managing

and tracking the status of database records when noting that “the PTO may [separately] consider the meaning of ‘patents’ and the meaning of ‘.com’ with respect to the goods identified in the application.”); *In re Save Venice N.Y., Inc.*, 259 F.3d 1346, 1352, 59 USPQ2d 1778, 1782 (Fed. Cir. 2001) (holding a mark primarily geographically deceptively misdescriptive for a variety of goods when noting that “[i]t is not erroneous, however, for the examiner to consider the significance of each element within the composite mark in the course of evaluating the mark as a whole.”). Thus, applicant’s argument that the combination of “BLACK” with “THE” and “SERIES” for “electric massage appliances, namely, hand-held massagers, massage mechanism for chairs, and foot spa massagers” creates a distinct commercial impression is not persuasive.

As to the descriptiveness of the term “SERIES,” applicant argues that “nothing in the application suggests or implies that this general identification of goods comprise a group of items that would constitute a series, nor suggest or imply any specific succession in product release. They are simply electric massage appliances.” However, third-party registrations featuring the same goods as applicant’s goods are probative evidence on the issue of descriptiveness where the relevant word or term is disclaimed, registered under Trademark Act Section 2(f) based on a showing of acquired distinctiveness, or registered on the Supplemental Register. *See Sweats Fashions, Inc. v. Pannill Knitting Co.*, 833 F.2d 1560, 1564-65, 4 USPQ2d 1793, 1797 (Fed. Cir. 1987); *In re Box Solutions Corp.*, 79 USPQ2d 1953, 1955 (TTAB 2006); *In re Finisar Corp.*, 78 USPQ2d 1618, 1621 (TTAB 2006). Here, attached are third-party registrations all containing the term “SERIES” for massage appliances and massage related services, all with the wording “SERIES” disclaimed.

Generally, a mark that merely combines descriptive words is not registrable if the individual components retain their descriptive meaning in relation to the goods 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, 1052 (TTAB 2006) (holding THE BREATHABLE MATTRESS merely descriptive of beds, mattresses, box springs and pillows where the evidence showed that the term “BREATHABLE” retained its ordinary dictionary meaning when combined with the term “MATTRESS” and the resulting combination was used in the relevant industry in a descriptive sense); *In re Associated Theatre Clubs Co.*, 9 USPQ2d 1660, 1663 (TTAB 1988) (holding GROUP SALES BOX OFFICE merely descriptive of theater ticket sales services because such wording “is nothing more than a combination of the two common descriptive terms most applicable to applicant's services which in combination achieve no different status but remain a common descriptive compound expression”).

Only where the combination of descriptive terms creates a unitary mark with a unique, incongruous, or otherwise nondescriptive meaning in relation to the goods is the combined mark registrable. *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 goods and do not create a unique, incongruous or nondescriptive meaning in relation to the goods.

Specifically, the term “THE” is not distinctive and does not add any source-identifying significance. *See, e.g., In re The Place, Inc.*, 76 USPQ2d 1467, 1468 (TTAB 2005) (holding THE GREATEST BAR merely descriptive for restaurant and bar services); *In re Weather Channel, Inc.*, 229 USPQ 854, 856 (TTAB 1985) (holding THE WEATHER CHANNEL merely descriptive for weather information services and television programming relating to weather); *In re The Computer Store, Inc.*, 211 USPQ 72, 74-75 (TTAB 1981) (holding THE COMPUTER STORE merely descriptive for retail outlets featuring computers). The term “BLACK” merely describes a feature of the goods, namely, the color. The term “SERIES” has consistently been held by the Office to be descriptive of massage appliances and of services featuring massage. The phrase “THE BLACK SERIES” does not create a unique, incongruous or nondescriptive meaning in relation to the goods; it merely describes them. Accordingly, the request for reconsideration is denied.

### **Option – Amend to Supplemental Register**

Applicant may respond to the refusal by amending the application to seek registration on the Supplemental Register. *See* 15 U.S.C. §1091; 37 C.F.R. §§2.47, 2.75(a); TMEP §§801.02(b), 816. Amending to the Supplemental Register does not preclude applicant from submitting evidence and arguments against the refusal(s). TMEP §816.04.

### **Proper Response**

The filing of a request for reconsideration does not extend the time for filing a proper response to a final Office action or an appeal with the Trademark Trial and Appeal Board (Board), which runs from the date the final Office action was issued/mailed. *See* 37 C.F.R. §2.64(b); TMEP §§715.03, 715.03(a), (c).

If time remains in the six-month response period to the final Office action, applicant has the remainder of the response period to comply with and/or overcome any outstanding final requirement(s) and/or refusal(s) and/or to file an appeal with the Board. TMEP §715.03(a), (c). However, if applicant has already filed a timely notice of appeal with the Board, the Board will be notified to resume the appeal when the time for responding to the final Office action has expired. *See* TMEP §715.04(a).

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**significant**  
*adjective* (IMPORTANT) UK **ˌsɪɡ.nɪ.fɪ.kənt** US **ˌsɪɡ.nɪf.ɪ.kənt**

**Definition** **Definition**

**important or noticeable**

*There has been a significant increase in the number of women students in recent years.*

*The talks between the USA and the USSR were very significant for the relationship between the two countries.*

(Definition of significant (IMPORTANT) from the Cambridge Advanced Learner's Dictionary)



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### Definition of black

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**black** (blăk) [say](#)

**ADJECTIVE:**  
black-er, black-est

- Being of the color black, producing or reflecting comparatively little light and having no [pigment](#) dominant hue.
- Having little or no light: *a black, moonless night.*
- often **Black**
- very dark in color: *non black son; black, wavy hair.*
- Soiled, as from soot, dirty: *feet black from playing outdoors.*
- Evil, wicked: *the pirates' black deeds.*
- Cheerless and depressing, gloomy: *black thoughts.*
- Being or characterized by morbid or grimly satiric humor: *a black comedy.*
- Marked by anger or sullenness: *gave me a black look.*
- Attended with disaster; calamitous: *a black day; the stock market crash on Black Friday.*
- Deserving of, indicating, or incurring censure or dishonor: *"Man ... has written one of his blackest records as a destroyer on the oceanic islands" (Rachel Carson).*
- Wearing clothing of the darkest visual hue: *the black knight.*
- Served without milk or cream: *black coffee.*
- Appearing to emanate from a source other than the actual point of origin. Used chiefly of intelligence operations: *black propaganda; black radio transmissions.*
- Disclosed, for reasons of security, only to an extremely limited

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  - Massager includes adjustable straps for a custom fit on most chairs
  - Convenient handheld control pad for ease of use
  - Multiple programmable massage zones
  - Includes four powered built-in rollers
  - Adjustable head rest
  - AC power adapter
  - Measures 18.5 inches long x 18 inches wide x 33 inches deep
  - Model number: 123101

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- Vibrating back massager relieves muscle aches and back pains with ease
- Device offers multiple programmable massage modes and intensity controls
- Massager includes adjustable straps for a custom fit on most chairs
- Convenient handheld control pad for ease of use
- Multiple programmable massage zones
- Includes four powered built-in rollers
- Adjustable head rest
- AC power adapter
- Measures 18.5 inches long x 18 inches wide x 33 inches deep
- Model number: 123101

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- Four powerful, built-in massage motors
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Product Description  
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