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MS09002USITM - EXAMINER BRIEF

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**UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)**

**APPLICATION SERIAL NO.** 77713799

**MARK:** THE BLACK SERIES



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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:** MerchSource, LLC

**CORRESPONDENT'S REFERENCE/DOCKET NO:**

MS09002USITM

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**EXAMINING ATTORNEY'S APPEAL BRIEF**

The applicant has appealed the Trademark Examining Attorney's final refusal to register the mark, THE BLACK SERIES, on the grounds that the mark is merely descriptive when used in association with the identified goods under Section 2(e)(1) of the Trademark Act, 15 U.S.C. Section 1052(e)(1).

**I. FACTS**

On April 14, 2009, the applicant filed the present application seeking to register the mark, THE BLACK SERIES, for "electric massage appliances, namely, hand-held massagers, massage mechanism for chairs, and foot spa massagers." On June 30, 2009, the examining attorney entered a disclaimer of the term SERIES, by examiner's amendment

agreed to by applicants counsel. The application was approved for publication and a Notice of Allowance issued on November 10, 2009. A Statement of Use was filed on February 22, 2010, and on April 23, 2010, the examining attorney issued a Section 2(e)(1) descriptiveness refusal upon review of the specimens of use. Applicant provided arguments against the refusal on October 25, 2010, and on November 17, 2010, the examining attorney issued a final descriptiveness refusal. On May 17, 2011, applicant filed a Request for Reconsideration, including a withdrawal of its disclaimer of the term SERIES. The disclaimer was withdrawn and the examining attorney denied the Request for Reconsideration by action on June 7, 2011.

The case is now before the Board on appeal of the examining attorney's final refusal to register the proposed mark on the Principal Register, under Section 2(e)(1) of the Trademark Act. The application was reassigned to the undersigned examining attorney at brief stage.

## **II. ISSUE ON APPEAL**

Whether the mark at issue, THE BLACK SERIES, is merely descriptive when used in connection with electric massage appliances, namely, hand-held massagers, massage mechanism for chairs, and foot spa massagers.

### **A. Preliminary Matter- Objection to Newly Introduced Evidence**

Applicant introduced third-party registrations and specimens related thereto, in “Exhibit A” and “Exhibit B” of its appeal brief. The examining attorney objects to any reference to and arguments based on this evidence, as applicant did not properly and timely make this evidence of record. The evidentiary record in an application should be complete prior to the filing of an ex parte appeal to the Trademark Trial and Appeal Board. TBMP §1207.01; 37 CFR §2.142(d). Thus, the evidence should not be considered part of the record. *See In re Huntry Pelican, Inc.*, 219 USPQ 1202, 1204 n.5 (TTAB 1983); *In re Delbar Products, Inc.*, 217 USPQ 859, 861 (TTAB 1981). *In re Duofold Inc.*, 184 USPQ 284 (TTAB 1984). The examining attorney respectfully requests that the Board not take judicial notice of the evidence, nor consider it as part of applicant’s arguments in support of registration.

### **III. ARGUMENT**

Applicant’s proposed mark, THE BLACK SERIES, is merely descriptive within the meaning of the applicable law, Section 2(e)(1) of the Trademark Act, 15 U.S.C. Section 1052(e)(1), when used in connection with electric massage appliances, namely, hand-held massagers, massage mechanism for chairs, and foot spa massagers.

A mark is merely descriptive if it describes an ingredient, quality, characteristic, function, feature, purpose or use of the specified goods. 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). 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 proposed mark, THE BLACK SERIES, merely describes that applicant’s massage devices feature the color BLACK and are part of a SERIES or group of massage apparatuses.

**A. The term BLACK is descriptive in relation to the goods of record**

Applicant’s massage devices feature the color BLACK and therefore the term is descriptive of the goods. The record demonstrates that the term BLACK refers to a color. Specifically, “black” is defined as “being of the color black, producing or reflecting comparatively little light and having no predominant hue.” (Denial of Request for Reconsideration at pg. 21). In the initial descriptiveness refusal, issued on April 23, 2010, the examining attorney included a screen shot of applicant’s goods offered for sale online. The image clearly shows the applicant’s massage mechanism for chairs as being

an almost entirely black apparatus which fits into a chair and has a control device which is largely black, except for a silver background surrounding the control buttons.

(Outgoing Office Action of April 23, 2010, at pg. 2). Applicant concedes that the massage mechanism for chairs is shown in black, but it argues that the other devices appear in a combination of gray and light gray. However, page 2 of the October 25, 2010 Response to Office action shows images of the handheld massager and foot massager as having gray bodies with what appear to be large black circular massage surfaces.

In view of the images of record, which shows the goods appearing in the color black in a prominent and conspicuous fashion, the evidence is sufficient to show that the term BLACK describes a significant characteristic or feature of the goods. *See In re H.U.D.D.L.E.*, 216 USPQ 358, 359 (TTAB 1982); and *In re MBAssociates*, 180 USPQ 338, 339 (TTAB 1973). Thus, the term BLACK would describe to the average purchaser of massage apparatuses that the goods contain the color BLACK and the significance of the term is accordingly descriptive under the relevant law. *See generally In re Polo International Inc.*, 51 USPQ2d 1061, 1062 (TTAB 1999); and *In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979).

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.” *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). Thus it is not necessary that the goods be completely, or even predominantly black, in order for the term to describe the goods.

Applicant argues that the term black has connotations that are unrelated to color, and as such is not descriptive of the goods. Specifically, applicant argues that the term BLACK is suggestive of the quality of the goods, namely, that they are of “elegant design and premium quality,” (Applicant’s Brief at pg.10). In support of its position, applicant points to usage of the term BLACK in connection with expensive luxury goods such as the Mercedes-Benz® “AMG Black Series” automobile, and mattress maker Simmons’® luxury line of mattresses called the “Beautyrest Black Collection”. Applicant should note, however, that each case must be decided on its own merits, based on the evidence of record, and therefore the existence of third-party marketing campaigns which use the term BLACK to denote luxury is not persuasive in the case at hand. *See generally In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564 (Fed. Cir. 2001).

Assuming, *arguendo*, that the marketplace has established an alternate suggestive meaning of the term BLACK in relation to luxury goods, such meaning does not convey to applicant’s more commonplace goods. Luxury automobiles and mattresses unquestionably cost significantly more than applicant’s massaging devices. To that end, the examining attorney notes the screen shot attached at page 2 of the final refusal of November 17, 2010, showing the massage mechanism for chairs for sale for \$26.23 and the screen shot attached at page 40 of applicant’s May 17, 2011 Request for

Reconsideration, showing the applicant's handheld massager for sale for \$94.99.

Accordingly, applicant's contention that the term BLACK suggests that the goods are luxury goods synonymous with luxury automobiles or mattresses, is not persuasive.

**B. The term SERIES is descriptive in relation to the goods of record**

The term SERIES is defined as "a group or connected succession of similar or related things, usually arranged in order."<sup>1</sup> 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 current record also includes 6 third-party registrations for various goods and services in which the term SERIES has been disclaimed. A closer look at three of these registrations may be illustrative.

Registration No. Registration No. 3776618, for the mark SOULSTICE SEMINAR SERIES, for goods identified as "training manuals for peri-operative massage therapy." The wording "seminar series" has been disclaimed.

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<sup>1</sup> The Board may take judicial notice of dictionary definitions. *Notre Dame du Lac v. J.C. Gourmet Food Imports*, 213 USPQ 594, 596 (TTAB 1982), *aff'd*, 217 USPQ 505 (Fed. Cir. 1983). See Dictionary.com citing Collins English Dictionary - Complete & Unabridged 10th Edition. HarperCollins Publishers, search of "series," <http://dictionary.reference.com/browse/series> (08 Oct. 2011).

Registration No. 3556369, for the mark FETISH FANTASY SERIES, for goods identified as “handcuffs; metal legcuffs in the nature of handcuffs for restraining legs; metal clamps,” “electric and non-electric massage apparatus and instruments, namely, instruments for massaging or vibrating portions of the face and body and pacifiers for massaging the lips,” a wide range of adult sexual aids as well as “chairs, stools, furniture.” The wording “fetish” and “series” has been disclaimed.

Registration No. 3965168, for the mark EARTH SERIES, for educational services in the fields of yoga, fitness, health and massage therapy. The wording “series” has been disclaimed.

While third party registrations are not conclusive on the question of descriptiveness, for procedural purposes, a disclaimer, whether made in the application as filed or in a subsequent amendment, may be construed as conceding that the matter to which it pertains is not inherently distinctive. TMEP §§ 1212 and 1213

Applicant argues that the term SERIES is not descriptive because there is nothing in the application to suggest that the goods comprise a group that would constitute a series. The examining attorney disagrees. 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.

**C. The entire mark, THE BLACK SERIES, is descriptive in relation to the goods of record**

It is well settled that 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 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.

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.”).

Furthermore, 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. Contrary to applicant’s arguments, the wording THE BLACK SERIES, does not suggest that the goods are high-quality, higher-end consumer products. Per the plain meaning of the composite terms, and the combination of the terms as a whole, the proposed mark merely describe the goods of record.

#### **IV. CONCLUSION**

For the foregoing reasons, the refusal to register the proposed mark under Section 2(e)(1) of the Trademark Act, 15 U.S.C. Section 1052(e)(1), should be affirmed

Respectfully submitted,

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