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Subject: U.S. TRADEMARK APPLICATION NO. 77819705 - SCORED NOVELLA -
006910.xxxx - EXAMINER BRIEF

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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

APPLICATION SERIAL NO. 77819705

MARK: SCORED NOVELLA

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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>

EXAMINING ATTORNEY'S APPEAL BRIEF

Applicant appeals the trademark examining attorney's final refusals to register the applied-for-marks SCORED NOVELLA, serial no. 77819705, SCORED SHORT STORY, serial no. 77834679, SCORED STORY, serial no. 77834681, and SCORED NOVEL, serial no. 77834686, each for the same goods, respectively "Audio books, namely, pre-recorded CDs, audio cassettes and downloadable e-books, featuring fictional or non-fictional stories and music specially adapted such that the customized spoken narrative is paired with different variations of music based on the desired interpretation of the audio book" in International Class 9, on the grounds that each mark is merely descriptive of the goods under of §2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1) and therefore ineligible for registration on the Principal Register.

FACTS

Applicant, Doreen L. Costa, applied to register the four above-mentioned marks for "Audio books, namely, pre-recorded CDs, audio cassettes and downloadable e-books, featuring fictional or non-fictional stories and music specially adapted such that the customized spoken narrative is paired with different variations of music based on the desired interpretation of the audio book" in International Class 9. For similar reasons, all of the marks were deemed merely descriptive and refused registration in first as well as final office actions. Finding subsequent arguments unpersuasive, all of applicant's requests for reconsideration were denied. Applicant filed notices of appeal in each case

and by way of motion, sought to consolidate matters on October 6, 2011. The Board granted applicant's motion and the consolidated appeal now follows.

ARGUMENT

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). 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).

In addition, "[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).

Taking these well-settled principals into account and for the reasons discussed below, the applied-for-marks SCORED NOVELLA in standard character, SCORED SHORT STORY in standard character, SCORED STORY in standard character and SCORED NOVEL in standard character, each for “Audio books, namely, pre-recorded CDs, audio cassettes and downloadable e-books, featuring fictional or non-fictional stories and music specially adapted such that the customized spoken narrative is paired with different variations of music based on the desired interpretation of the audio book” in International Class 9, will be in each case immediately understood and perceived by intended consumers and purchasers as describing and identifying the literary content and/or literary form featured on the audio books as specified in each mark, namely “novella”, “short story”, “story” and “novel”, is musically scored, and rendering these marks when viewed as a whole, merely descriptive of the goods.

Applicant does not argue that the wordings “novella”, “short story”, “story” and “novel” are not merely descriptive of its goods, namely the literary content or literary form of the subject matter featured on the audio books. Dictionary definitions of the terms “novella”, “short story”, “story” and “novel” attached to the office actions dated December 10, 2009 provide support for the refusals to register by showing their meanings describe and identify a specific descriptive type of literary form or content featured on the

goods in issue. Applicant also does not argue that its goods are not in fact musically scored, but only that its intended purchasers will not immediately perceive the wording “scored” as describing and identifying that the goods are musically scored. Applicant instead argues that the wording “scored” as it appears in each of the applied-for-marks conveys multiple commercial impressions and that the consumers for its goods will engage in a multi-step reasoning process before coming to any conclusion about the precise nature of its audio books.

However, applicant’s arguments are made in the abstract and not in relation to the goods and the standards for assessing descriptiveness from the perspective of consumers or purchasers of these goods. As stated in the author’s comment from *McCarthy On Trademarks and Unfair Competition*, §11:21 (4th ed. 2011), “[T]he hypothetical potential customer should be assumed to have that amount of basic knowledge about the product that most people would have from news and advertising.” This Board has held that “[T]he question is not whether someone presented only with the mark could guess what the products and services are. Rather, the question is whether someone who knows the products and services will understand the mark to convey information about them.” *In re BetaBatt, Inc.*, 89 U.S.P.Q.2d 1152, 2008 WL 5232795 (T.T.A.B. 2008) (“DEC” is a descriptive abbreviation of the descriptive term “direct energy conversion” for batteries using nuclear decay of radioactive isotopes.). *Accord: In re Patent & Trademark Services Inc.*, 49 U.S.P.Q.2d 1537, 1998 WL 970180 (T.T.A.B. 1998) (descriptiveness is not to be determined by asking “whether one can guess, from the mark itself, considered in a vacuum, what the goods or services are . . .”); *In re Styleclick.com*, 58 U.S.P.Q.2d 1523,

2001 WL 245735 (T.T.A.B. 2001) (“[W]hether consumers could guess what the product and/or service is from consideration of the mark alone is not the test.”).

In this case, a reasonably informed buyer will be highly likely to immediately understand that “scored” in the applied-for-marks means applicant’s goods are “musically scored” because the goods are in fact musically scored and this is highly likely to be a major decisional factor in whether or not to purchase applicant’s goods. Consumers and purchasers will most likely be highly motivated to purchase or to not purchase applicant’s goods based upon whether or not they want to purchase audio books with a musical score or without a musical score. Based upon this purchasing or sales context, the meaning of the wording “scored” as it appears in each of the applied-for-marks is highly likely to be immediately perceived by consumers and purchasers of the goods in issue as describing and identifying a significant and main feature of applicant’s goods, namely that the goods are “musically” scored. When combined with a merely descriptive term for the literary content or literary form of the subject matter of the audio books, as in the applied-for-marks SCORED NOVELLA, SCORED SHORT STORY, SCORED STORY and SCORED NOVEL, these marks as a whole are merely descriptive of features of applicant’s goods.

Therefore, the combination of the merely descriptive wording “scored” with each of the merely descriptive wordings “novella”, “short story”, “story” and “novel” in each of the applied-for-marks is, when viewed as a whole, merely descriptive of applicant’s goods because this wording merely describes that the goods are musically scored and

identifies the specific literary form or literary content of applicant's audio books. Viewed as a whole, there is no other meaning likely to be ascribed to the applied-for-marks by consumers or purchasers because the goods are in fact musically scored audio books featuring either a "novella", "short story", "story" or "novel". Consumers and purchasers are highly likely to base their decision to purchase or to not purchase applicant's audio books upon consideration of the musically "scored" component or feature of these goods.

Applicant, however, argues that a consumer of its audio books may believe that "scored" refers to some significant aspect of the term "novella", "short story", "story" or "novel", such as the plot, message, theme or main characters, or suggests audio books containing sports or competition-themed stories, or audio books containing prose to which a ranking or grade has been assigned or can be assigned by the consumers, as well as other arguments about the meaning of the term "scored" in the context of its musically scored audio books. However, it is clear that these arguments are made in the abstract and not in relation to the goods in issue. Applicant offers in support of its arguments only dictionary definitions of the wording "scored" that shows its meaning in contexts other than "musically scored" and results of an online search for goods that are "scored" that do not reference audio books.

The evidence made of record by the examining attorney shows that consumers and purchasers of audio books are highly likely to encounter the wording "scored" in the context of "musically scored" when shopping for audio books. The term "scored" is used in the context of musically scored audio books in connection with advertising,

promotion and offers to purchase audio books, to describe and identify for consumers and purchasers audio books that are musically scored. For example, the attachment at page 2 of the office action dated August 10, 2011 from www.bonanza.com shows that “*Gulliver’s Travels*” by Jonathan Swift offered as an audio book is advertised and promoted for sale to consumers and purchasers as “musically scored”. The attachment at page 4 of the office action dated August 10, 2011 from www.alibris.com offers consumers and purchasers “*Pocahontas: Musically Scored (Audiobook)*”. The attachment at page 5 of the office action dated February 5, 2011 from www.astory4u.com advertises musically scored versions of written stories by an author. The attachment at page 19 of the office action dated February 5, 2011 from www.eastwestbookshop.com advertises new and forthcoming books, including books on CD, as musically scored. The attachment at page 24 of the office action dated February 5, 2011 from www.remarkablelives.com offers musically scored biographies to consumers and purchasers.

Employing the standard used by this Board in *In re BetaBatt, Inc.*, 89 U.S.P.Q.2d 1152, 2008 WL 5232795 (T.T.A.B. 2008), namely “whether someone who knows the products and services will understand the mark to convey information about them”, it is clear from the evidence as cited above that consumers and purchasers of audio books are highly likely to immediately perceive that “scored” means “musically scored” and identifies a main feature of applicant’s goods. Further, the use of the descriptive wording “scored” as it appears as a whole in each of the applied-for-marks, namely SCORED NOVELLA in standard character, SCORED SHORT STORY in standard character,

SCORED STORY in standard character and SCORED NOVEL in standard character, each for “Audio books, namely, pre-recorded CDs, audio cassettes and downloadable e-books, featuring fictional or non-fictional stories and music specially adapted such that the customized spoken narrative is paired with different variations of music based on the desired interpretation of the audio book” in International Class 9, will be immediately understood and perceived by intended consumers and purchasers of these goods as describing and identifying that the literary content and/or literary form of the audio books as specified by each mark, namely “novella”, “short story”, “story” and “novel”, is musically scored. Therefore, the standard character marks SCORED NOVELLA, SCORED SHORT STORY, SCORED STORY and SCORED NOVEL are merely descriptive when viewed as a whole of the goods.

CONCLUSION

For the foregoing reasons, the refusal to register under §2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), on the grounds that the applied-for-marks are merely descriptive of applicant’s goods, should be affirmed.

Respectfully submitted,

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