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Mailed:
April 3, 2012

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re J. Patrick Berry

Serial Nos. 77819705, 77834679, 77834681 and 77834686

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for J. Patrick Berry.

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Before Seeherman, Kuhlke and Bergsman, Administrative
Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

This is a consolidated appeal involving four applications filed by J. Patrick Berry ("applicant"). On October 6, 2011, applicant requested that the appeals be consolidated because the marks at issue are substantially similar, the goods are the same, and registration has been refused on the same basis. The Board consolidated the appeals prior to briefing.

Applicant is seeking to register the marks SCORED NOVELLA (Serial No. 77819705), SCORED SHORT STORY (Serial No. 77834679), SCORED STORY (Serial No. 77834681) and SCORED NOVEL (Serial No. 77834686), 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." Application Serial No. 77819705 was filed on September 3, 2009; the other three applications were filed on September 25, 2009. All of the applications are based on Section 1(b) of the Trademark Act, asserting an intent to use the marks in commerce.

Registration has been refused pursuant to Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), on the ground that applicant's marks are merely descriptive of his identified goods. Specifically, the examining attorney contends that the marks immediately convey to purchasers that the literary form that is the subject of the audio book is musically scored.

Applicant and the examining attorney filed consolidated appeal briefs, and applicant filed a consolidated reply brief.¹

¹ Although we have considered applicant's reply brief, we must say that many of the arguments made in it are not appropriate for a reply brief, which is supposed to respond to arguments made by the examining attorney in his brief. For example, in his main brief applicant appears to have accepted that the second word in each of his marks is descriptive, and concentrated his arguments on the word SCORED: "A consumer of audio books may believe that

We affirm the refusal as to all four applications.

A term is deemed to be merely descriptive of goods or services, within the meaning of Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), if it forthwith conveys an immediate idea of an ingredient, quality, characteristic, feature, function, purpose or use of the goods or services. In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215, 217-18 (CCPA 1978). A term need not immediately convey an idea of each and every specific feature of the applicant's goods or services in order to be considered to be merely descriptive; rather, it is sufficient that the term describes one significant attribute, function or property of the goods or services. In re H.U.D.D.L.E., 216 USPQ 358 (TTAB 1982); In re

the term 'scored' in some way refers to some significant aspect of the term 'novella,' 'short story,' 'story' or 'novel,' such as the plot, message, theme or main characters of Applicant's audio books." Brief, p. 5. That is certainly the way that the examining attorney (and, we must add, this Board) interpreted applicant's position in his main brief; in fact, the examining attorney stated, "Applicant does not argue that the wordings 'novella', 'short story', 'story' and 'novel' are not merely descriptive of its [sic] goods, namely the literary content or literary form of the subject matter featured on the audio books." Examiner's brief, unnumbered p. 3. However, in his reply brief applicant contends that "'NOVELA,' 'SHORT STORY,' 'STORY' and 'NOVEL' may offer some information about Applicant's products, but this does not render them descriptive. ... In fact, the dictionary definitions in the record further illustrate that the terms, even standing alone, do not directly describe Applicant's goods." Reply brief, p. 10. Applicant goes on, in his reply brief, to discuss various meanings for the word "novel" and the supposed ambiguity of the word "story."

MBAssociates, 180 USPQ 338 (TTAB 1973). Whether a term is merely descriptive is determined not in the abstract, but in relation to the goods or services for which registration is sought, the context in which it is being used on or in connection with the goods or services, and the possible significance that the term would have to the average purchaser of the goods or services because of the manner of its use; that a term may have other meanings in different contexts is not controlling. *In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979). In other words, the question is not whether someone presented only with the mark could guess the products listed in the description of goods. Rather, the question is whether someone who knows what the products are will understand the mark to convey information about them. *In re Tower Tech, Inc.*, 64 USPQ2d 1314, 1316-1317 (TTAB 2002); *In re Patent & Trademark Services Inc.*, 49 USPQ2d 1537, 1539 (TTAB 1998); *In re Home Builders Association of Greenville*, 18 USPQ2d 1313, 1317 (TTAB 1990); *In re American Greetings Corp.*, 226 USPQ 365, 366 (TTAB 1985).

Dictionary definitions of "novella," "short story," "story" and "novel" show that these are literary forms:

Novella: "story with a compact and pointed plot" and "a work of fiction intermediate in length and complexity between a short story and a novel."

Short story: "an invented prose narrative shorter than a novel usually dealing with a few characters and aiming at unity of effect and often concentration on the creation of mood rather than plot"

Story: "3a. a fictional narrative shorter than a novel; *specifically*: SHORT STORY b: the intrigue or plot of a narrative or dramatic work"

Novel: "a fictional prose narrative of considerable length, typically having a plot that is unfolded by the actions, speech, and thoughts of the characters: 'Uncle Tom's Cabin is a very bad novel' (James Baldwin)." ²

The examining attorney has submitted dictionary definitions of "score," the most pertinent of which is "to write or arrange (music) for a specific performance medium."

In addition, applicant has submitted definitions for the word "score" taken from Dictionary.com, and based on the Random House Dictionary, © 2010, including the following:

15. *Music*. [noun]

² The first three definitions are from Merriam-Webster Online dictionary, www.merriam-webster.com, and were made of record by the examining attorney. In the application for SCORED NOVEL, the examining attorney submitted the definition for "novel" when it is used as an adjective. We take judicial notice of the definition for "novel" as a noun, taken from The American Heritage Dictionary of the English Language, 1970. The Board may take judicial notice of dictionary definitions. *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983). We point out that applicant was well aware of this definition of "novel," and treated "novel" as having this meaning even in his first response, i.e., the response submitted after the examining attorney made the adjective definition of record. For example, applicant made the statement, "Considering the composite mark SCORED NOVEL, it is likely that a consumer would believe that 'SCORED' in some way refers to some significant aspect of the 'NOVEL', such as the plot, or even the central message, theme or characters of the novel, rather than connoting

- a. a written or printed piece of music with all the vocal and instrumental parts arranged on staves, one under the other.
- b. the music itself.
- c. the music played as background to or part of a movie, play, or television presentation.

21. *Music*. [verb]

- a. to orchestrate.
- b. to write out in score.
- c. to compose the music for (a movie, play, television show, etc.)³

In addition, the examining attorney has submitted Internet evidence showing that audio books are advertised as being "musically scored":⁴

Pocahontas: Musically Scored (Audiobook)
www.alibris.com

Valentine by Audio Dove
Audiobook
...

the use of background music in conjunction with the novel."
Filed June 5, 2010.

³ There are 37 definitions listed for "score" in the submission from Dictionary.com, including as a noun, a verb used with an object and a verb used without an object, and informal and slang definitions.

⁴ Applicant notes that the examining attorney did not submit the Google search results page through which he presumably found the Internet evidence, or identify the specific search terms he employed. To the extent that applicant believes that this is a requirement, it is not. Internet web pages will be considered as long as there is information from which the URL can be ascertained, whether that information appears on the webpage or is supplied with an accompanying Office action or response. It is also preferable that the date the webpage was downloaded be supplied, although the absence of such information does not make the evidence unacceptable, it may simply affect its probative value. In this connection, we note that definitions from Dictionary.com submitted by applicant do not bear a date, but we accord them full probative weight since the copyright information on the webpages themselves show that the definitions were taken from a recent print dictionary.

Featuring the works of the most famous authors in Classical Literature, including William Shakespeare, William Butler Yeats, Robert Frost, James Joyce, Emily Dickinson, Edgar Allan Poe, Carl Sandburg and others. Coupled with the talents of celebrity performers, this musically scored presentation is unlike anything else available.

www.barnesandnoble.com

Gullivers [sic] Travels by Jonathan Swift
Audiobook

...

This is an audio book titled Gulliver's Travels by Jonathan Swift and read by Joel Grey. There is one Cassette for an approximate running time of 45 minutes. It is musically scored.

www.bonanza.com

A musically scored CD of Melea['s] six newest stories

www.astory4u.com

It is clear that the second word in each mark, NOVELLA, SHORT STORY, STORY, NOVEL, describes the literary form of the audio book. When the word SCORED is combined with the word identifying a type of literary form, and the marks are used for audio books featuring stories and specially adapted music that pairs the narrative with different variations of music based on the desired interpretation of the audio book, consumers will immediately understand that the audio book is of a novella, or short story, or story, or novel (depending on the literary form described by the second word in the particular mark) that has been musically scored. Thus, each

of the marks is merely descriptive of the identified audio book.

Applicant argues that, because the word "scored" can have multiple meanings, the marks are suggestive and therefore registrable. "A consumer of audio books may believe that the term 'scored' in some way refers to some significant aspect of the term 'novella,' 'short story,' 'story' or 'novel,' such as the plot, message, theme or main characters of Applicant's audio books." Brief, p. 5. For example, because two of the dictionary definitions of "score" are "the record of points or strokes made by the competitors in a game or match" and "the total points or strokes made by one side, individual, play, game, etc.,"⁵ applicant asserts that the marks would suggest audio books containing sports- or competition-themed stories.

We are not persuaded by this argument. As previously noted, the question of mere descriptiveness of a mark is determined by the context in which it is being used and the possible significance that the term would have to the average purchaser of the goods or services because of the manner of its use or intended use. The fact that a term may have other meanings in different contexts is not

⁵ Dictionary.com, based on the Random House Dictionary, © 2010, <http://dictionary.reference.com>, submitted June 5, 2010.

controlling. See *In re Polo International Inc.*, 51 USPQ2d 1061 (TTAB 1999) (the term DOC in mark DOC-CONTROL for computer software for document management would be understood as "document" despite dictionary meaning of "doctor"). Applicant's goods are "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." The pairing of different variations of music to go with the spoken narrative, thus, is a significant characteristic of the goods.⁶ When the marks SCORED NOVELLA, SCORED SHORT STORY, SCORED STORY and SCORED NOVEL are viewed in connection with such goods, consumers will immediately understand that the

⁶ Applicant asserts that "the Examining Attorney has not identified any evidence that even infers, let alone proves, his claim that the 'musically scored' feature of an audio book (or lack thereof) is highly likely to be a major decisional factor in the consumer's decision of whether or not to purchase Applicant's audio book products." Reply brief, p. 5. It appears that applicant is attempting to add a requirement of materiality to the test for showing that a mark is merely descriptive. However, applicant has not pointed to any case law that states that an examining attorney must show that to be merely descriptive a mark must describe a feature that is "highly likely to be a major decisional factor in the consumer's decision" to purchase. Applicant's identification of goods, namely, that the audio books contain a spoken narrative which is paired with different variations of music based on the desired interpretation of the audio book, is sufficient to show that having a score is a significant characteristic of the goods.

word SCORED in the mark refers to audio books that have been musically scored, and that each mark as a whole describes audio books of a particular literary form and which have a musical score.

We recognize that if imagination, thought or perception is required in order to reach a conclusion on the nature of the goods, then the mark is suggestive. In re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987). However, if one meaning of a mark clearly and directly conveys to consumers information about the nature of the goods, and one interpretation would require mental gymnastics, consumers will view the mark as conveying the readily understood meaning. Thus, although "score" or "scored" has several different definitions, including definitions having to do with sports, performance evaluation, accounting or indebtedness, it is not reasonable to expect that consumers will "sift through numerous possible meanings for the term 'scored' and ... make guesses or insert additional meaning into the phrase in order to understand the nature of Applicant's goods," as applicant argues in contending that his marks are suggestive. Brief, p. 6. For example, consumers seeing the mark SCORED NOVEL for an audio book that pairs the narrative with music based on the narrative, will understand the mark as describing an audio book of a

novel which is accompanied by musical scoring, rather than first think that SCORED is a term used to indicate a point in a game, and from that make a guess as to whether the content of the novel that is the subject of the audio book has something to do with games or sports. In fact, although applicant accuses the examining attorney of failing to consider the marks in their entirety, it is applicant that appears to be doing that, by looking to the word SCORED per se and the meaning that this word may have by itself, instead of looking at the word in the context of the entire mark involved in each appeal. Whether or not the word SCORED, when used in connection with a story about sports, may have the meaning of a points scored in a game, when the term is combined with the descriptive term for a literary form, such as SCORED SHORT STORY, and used for an audio book having a musical accompaniment that is paired with the narrative, the word SCORED will be understood as referring to the literary format that is the subject of the audio book, and SCORED SHORT STORY will be viewed as describing an audio book containing a short story with a musical score.

Applicant also argues that his marks have an incongruity that prevents them from being merely descriptive because movies contain musical scores, but books do not. Although actual books are read, and therefore there is no

auditory component to them, the goods at hand are audio books, and by definition they have an auditory component. Because audio books can have a score to go with the narration and, in fact, the evidence shows that there are audio books with musical scores that are advertised as such, consumers will not view the mark as incongruous.

Applicant also contends that, while "musical score" or "musically scored" may have a meaning to consumers, when "scored" is viewed without the modifier "musically" it would not have such an association. We acknowledge that the Internet evidence, as detailed above, uses the phrase "musically scored" and not "scored" per se in advertising the particular audio books. However, given the dictionary definition of "score"/"scored," which shows that this term has a meaning in connection with music even if the word "music" or "musically" is not used in conjunction with it, and given that applicant's audio books feature "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," consumers will readily understand that applicant's marks, used in the context of these goods, describe the musical scoring of the particular novella, short story, story or novel.

We have considered all of applicant's arguments, including those not specifically addressed herein, but find them unpersuasive. Based on the evidence of record, we find that applicant's marks SCORED NOVELLA, SCORED SHORT STORY, SCORED STORY and SCORED NOVEL, used 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," immediately and directly convey information about a characteristic of the audio books, namely that the audio books are musically scored works of the literary form named in the particular mark.

Decision: The refusals of registration as to the four applications are affirmed.