

## Request for Reconsideration after Final Action

**The table below presents the data as entered.**

Input Field	Entered
<b>SERIAL NUMBER</b>	77819705
<b>LAW OFFICE ASSIGNED</b>	LAW OFFICE 102
<b>MARK SECTION (no change)</b>	
<b>ARGUMENT(S)</b>	
Please see the actual argument text attached within the Evidence section.	
<b>EVIDENCE SECTION</b>	
<b>EVIDENCE FILE NAME(S)</b>	
<b>ORIGINAL PDF FILE</b>	<a href="#">evi_381124254-223105714 . Office Action Response for Ser. No. 77819705 SCORED NOVELLA</a>
<b>CONVERTED PDF FILE(S) (8 pages)</b>	<a href="#">\\TICRS\EXPORT11\IMAGEOUT11\778\197\77819705\xml5\RFR0002.JPG</a>
	<a href="#">\\TICRS\EXPORT11\IMAGEOUT11\778\197\77819705\xml5\RFR0003.JPG</a>
	<a href="#">\\TICRS\EXPORT11\IMAGEOUT11\778\197\77819705\xml5\RFR0004.JPG</a>
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<b>ORIGINAL PDF FILE</b>	<a href="#">evi_381124254-223105714 . Exhibit 1 - Merriam-Webster Dictionary Definition of Scored.pdf</a>
<b>CONVERTED PDF FILE(S) (3 pages)</b>	<a href="#">\\TICRS\EXPORT11\IMAGEOUT11\778\197\77819705\xml5\RFR0010.JPG</a>
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<b>DESCRIPTION OF EVIDENCE FILE</b>	Argument and Exhibit 1: Merriam-Webster Dictionary definition of "scored."
<b>SIGNATURE SECTION</b>	
<b>RESPONSE SIGNATURE</b>	/LBR/
<b>SIGNATORY'S NAME</b>	Lindsay B. Rodman
<b>SIGNATORY'S POSITION</b>	attorney of record, NY bar member
<b>DATE SIGNED</b>	07/18/2011
<b>AUTHORIZED SIGNATORY</b>	YES
<b>CONCURRENT APPEAL NOTICE FILED</b>	YES
<b>FILING INFORMATION SECTION</b>	
<b>SUBMIT DATE</b>	Mon Jul 18 22:32:35 EDT 2011
<b>TEAS STAMP</b>	USPTO/RFR-38.112.4.254-20 110718223235517605-778197 05-4804ba5cd3a50f13fe816c 94f7535b217-N/A-N/A-20110 718223105714337

**Request for Reconsideration after Final Action  
To the Commissioner for Trademarks:**

Application serial no. **77819705** has been amended as follows:

**ARGUMENT(S)**

**In response to the substantive refusal(s), please note the following:**

Please see the actual argument text attached within the Evidence section.

## **EVIDENCE**

Evidence in the nature of Argument and Exhibit 1: Merriam-Webster Dictionary definition of "scored." has been attached.

### **Original PDF file:**

[evi\\_381124254-](#)

[223105714 . Office Action Response for Ser. No. 77819705 SCORED\\_NOVELLA.pdf](#)

**Converted PDF file(s)** (8 pages)

[Evidence-1](#)

[Evidence-2](#)

[Evidence-3](#)

[Evidence-4](#)

[Evidence-5](#)

[Evidence-6](#)

[Evidence-7](#)

[Evidence-8](#)

### **Original PDF file:**

[evi\\_381124254-223105714 . Exhibit 1 - Merriam-Webster Dictionary Definition of Scored.pdf](#)

**Converted PDF file(s)** (3 pages)

[Evidence-1](#)

[Evidence-2](#)

[Evidence-3](#)

## **SIGNATURE(S)**

### **Request for Reconsideration Signature**

Signature: /LBR/ Date: 07/18/2011

Signatory's Name: Lindsay B. Rodman

Signatory's Position: attorney of record, NY bar member

The signatory has confirmed that he/she is an attorney who is a member in good standing of the bar of the highest court of a U.S. state, which includes the District of Columbia, Puerto Rico, and other federal territories and possessions; and he/she is currently the applicant's attorney or an associate thereof; and to the best of his/her knowledge, if prior to his/her appointment another U.S. attorney or a Canadian attorney/agent not currently associated with his/her company/firm previously represented the applicant in this matter: (1) the applicant has filed or is concurrently filing a signed revocation of or substitute power of attorney with the USPTO; (2) the USPTO has granted the request of the prior representative to withdraw; (3) the applicant has filed a power of attorney appointing him/her in this matter; or (4) the applicant's appointed U.S. attorney or Canadian attorney/agent has filed a power of attorney appointing him/her as an associate attorney in this matter.

The applicant is filing a Notice of Appeal in conjunction with this Request for Reconsideration.

Serial Number: 77819705

Internet Transmission Date: Mon Jul 18 22:32:35 EDT 2011

TEAS Stamp: USPTO/RFR-38.112.4.254-20110718223235517

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant : J. Patrick Berry  
Serial No. : 77/819,705  
Mark : SCORED NOVELLA  
Examining Attorney : Dominic J. Ferraiuolo  
Law Office : 102  
Filed : September 3, 2009  
Our Ref. : 006910.4863

**RESPONSE TO FINAL OFFICE ACTION AND REQUEST FOR RECONSIDERATION**

To the Commissioner for Trademarks:

Applicant J. Patrick Berry (“Applicant”) respectfully responds to the Final Office Action dated January 18, 2011, requesting reconsideration and filing a notice of appeal. Applicant seeks to register SCORED NOVELLA in connection with the following goods and services in International Class 9: “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 Office Action maintains refusal of registration on the ground that Applicant’s mark is merely descriptive. Trademark Act Section 2(e)(1), 15 U.S.C. § 1052(e)(1); T.M.E.P. § 1209 et. seq.

The Office Action asserts that the term SCORED NOVELLA, taken as a whole, merely describes that the goods are musically scored types of literature—namely, a novella. Further, the Office Action seemingly asserts that marks incorporating dictionary definitions, regardless of the relative obscurity of the chosen definition, are descriptive. Applicant

respectfully submits that such arguments are misplaced and that SCORED NOVELLA is registrable. SCORED NOVELLA is not merely descriptive, as the combination of the terms “SCORED” and “NOVELLA” creates a unitary mark with a nondescriptive meaning in relation to the goods to be offered thereunder. Accordingly, Applicant respectfully requests that the Examining Attorney reconsider and withdraw the refusal to register.

**I. SCORED NOVELLA Is Suggestive, Not Merely Descriptive.**

There is often a thin line of demarcation between a suggestive term and a merely descriptive term. In re Grand Metropolitan Foodservice, Inc., 30 U.S.P.Q.2d 1974, 1976 (T.T.A.B. 1997). While a merely descriptive mark “immediately” describes the covered goods and services, a suggestive mark requires a “modicum” of imagination and thought. See BellSouth Corp. v. Plenum Tech. Corp., 14 U.S.P.Q.2d 1555, 1556 (T.T.A.B. 1990). The test for finding “mere” descriptiveness and the minimum burden for establishing suggestiveness reflect the policy of the Patent and Trademark Office favoring the registration of trademarks. See In re Conductive Sys., Inc., 220 U.S.P.Q. 84, 86 (T.T.A.B. 1983). The application of this standard to the facts at issue makes manifest that the applied-for mark is suggestive and registrable.

- A. The composite mark SCORED NOVELLA is suggestive because it conveys multiple commercial impressions.

When scrutinizing the mark SCORED NOVELLA as a whole, according to established standards, the mark is clearly not descriptive of “audio books, namely, pre-recorded CDs, audio cassettes and downloadable e-books, featuring fictional or non-fictional stories and music.” Rather, the mark is suggestive of Applicant’s goods. Specifically, SCORED NOVELLA conveys multiple different commercial impressions that consumers must sift through before coming to any meaningful conclusion about the precise nature of Applicant’s goods.

Certainly a multi-step reasoning process is necessary, and, even then, the effort is inconclusive. Even if the Office Action deems the individual terms “SCORED” and “NOVELLA” to be descriptive, a mark comprising a combination of merely descriptive components is registrable if the combination of terms creates a unitary mark with a unique, nondescriptive meaning. See T.M.E.P. § 1209.03(d); In re Shutts, 217 U.S.P.Q. 363 (T.T.A.B. 1983) (SNO-RAKE held not merely descriptive of a snow removal hand tool); Firestone Tire & Rubber Co. v. Goodyear Tire & Rubber Co., 186 U.S.P.Q. 557 (T.T.A.B. 1975); *aff’d* 189 U.S.P.Q. 384 (C.C.P.A. 1975) (BIASTEEL for steel belted bias tires held suggestive, not descriptive, as a composite term); In re Colonial Stores Inc., 394 F.2d 549, 157 U.S.P.Q. 382 (C.C.P.A. 1968) (SUGAR & SPICE held not merely descriptive of bakery products).

The composite mark SCORED NOVELLA is suggestive of Applicant’s goods because the combination creates a unique commercial expression that is not commonly used and fails to directly identify or indicate the products offered by Applicant. Indeed, music is not the first impression that comes to the typical consumer’s mind when faced with the term “SCORED.” For example, SCORED NOVELLA far more readily suggests that the novella has been “marked” with comments, lines, notations, or edits. SCORED NOVELLA also connotes the idea that the novella in question has been “rated,” perhaps by the publisher, or electronically by consumers themselves. While the Office Action attaches six examples in support of the position that “SCORED NOVELLA” is merely descriptive, in three of those examples the terms “SCORED” and “NOVELLA” are in different paragraphs or posts that have no relation to each other. Of the remaining three examples, all three provide the modifier “musically”, the significance of which will be discussed below. Yet even taking these three examples of the terms “SCORED” and “NOVELLA” in the same sentence, three examples fail to establish the

applied-for mark's descriptiveness. The lack of evidentiary support for the Office Action's position further bolsters Applicant's contention that the mark is suggestive.

Indeed, after initially encountering the composite mark SCORED NOVELLA, the consumer must then evaluate the meaning behind it. In addition to the examples provided above, SCORED NOVELLA could just as easily suggest a commercial impression of books containing sports- or competition-themed stories, or audio books containing more colorful stories about romantic success or even the drug culture. Alternatively, even in a musical context, SCORED NOVELLA may create a number of different commercial impressions. For example, the composite mark may suggest audio books containing stories of the lives of famous conductors, composers or musicians, or audio books concerning the creation of musical or movie scores. Thus, while the Office Action states that "[c]onsumers will not have to engage in any guesswork" to decipher Applicant's mark, the many examples of competing interpretations indicate otherwise

A mark is suggestive when one must exercise imagination, thought, or perception to reach a conclusion as to the nature of the product or services. In re Noble Co., 225 U.S.P.Q. 749, 750 (T.T.A.B. 1985); see also In re Quik-Print Copy Shops, Inc., 616 F.2d at 525, 205 U.S.P.Q. at 507 ("[A mark] is suggestive if imagination, thought, or perception is required to reach a conclusion as to the nature of the goods or services."). If a mark suggests a number of possible uses or characteristics of the goods and services, including one that is descriptive, see In re National Tea Co., 144 U.S.P.Q. 286, 287 (T.T.A.B. 1965) (NO BONES ABOUT IT not merely descriptive of ham), or contains elements that are so vague or elusive as applied to the goods or services that it is not possible to immediately understand the nature of the goods or services with which it is used, see Airco, Inc. v. Air Prods. & Chems., Inc., 196 U.S.P.Q. 832,

835 (T.T.A.B. 1977) (AIR-CARE not merely descriptive of maintenance program for hospital inhalation and breathing equipment), then the mark is not merely descriptive. Furthermore, a mark is still suggestive even if it indirectly informs the consumer about the products or services, as when the mark requires a multi-step thought process to determine the precise nature of the goods or services. See Healing the Children, Inc. v. Heal the Children, Inc. 22, U.S.P.Q.2d 1690, 1692 (W.D. Pa. 1992) (HEALING THE CHILDREN held suggestive of organization that coordinates medical teams that train local medical personnel in foreign countries and provide health care for children).

Here, SCORED NOVELLA clearly is not descriptive, but rather, suggestive, of “audio books, namely, pre-recorded CDs, audio cassettes and downloadable e-books, featuring fictional or non-fictional stories and music.” SCORED NOVELLA conveys many different commercial impressions resulting from the many definitions of “SCORED”, and consumers must engage in a multi-step reasoning process in which they must sift through the various commercial impressions before coming to any conclusion about the precise nature of Applicant’s goods. Accordingly, SCORED NOVELLA is merely suggestive of Applicant’s goods, and the mark is therefore registrable.

B. The term “SCORED” itself is suggestive due to its sheer number of meanings and connotations.

Contrary to the position taken in the Office Action, when considering the composite mark SCORED NOVELLA, it is likely that a consumer would believe that the term “SCORED” in some way refers to some significant aspect of the term “NOVELLA”, such as the plot, message, theme or characters of the novella. The Office Action, asserting that a mark that “merely combines descriptive words is not registrable if the individual components retain their descriptive meaning in relation to the goods and/or services,” offered two supporting cases

related to the designations THE BREATHABLE MATTRESS and GROUP SALES BOX OFFICE. The present matter, however, is not comparable with the cited examples, where only one possible meaning may be ascribed to each term in question.

Here, the term “SCORED” possesses so many alternative meanings that it is precluded from being merely descriptive in its present usage. See J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition § 11:26 at 11-49, 11-95 to 11-96 (4th ed. 1998) (“If a composite mark is not 100 percent descriptive, then the marks as a whole is not ‘merely’ descriptive. The word ‘merely’ also means that if a composite mark is not totally descriptive in all its parts, then, the mark as a whole is not ‘merely’ descriptive.”). Further, the multiple meanings of the term “SCORED” all evoke very different commercial impressions. (See the Merriam-Webster Dictionary listings attached hereto as Exhibit 1.) As a result of this plethora of competing definitions, no one meaning of the term “SCORED” can be immediately or directly ascribed to Applicant’s goods with the requisite precision to classify the combined term “SCORED NOVELLA” as “merely descriptive.” Given the numerous meanings of the term “SCORED” that consumers must sift through, Applicant’s mark is not merely descriptive, as consumers must make guesses or insert additional meaning into the phrase in order to understand the nature of Applicant’s goods.

Rather, use of the term “SCORED” in any instance is suggestive. The Office Action rejects Applicant’s argument that the many possible definitions of “SCORED” support classification of Applicant’s mark as suggestive, concluding that Applicant’s identified goods “are in fact ‘musically scored.’” However, the Office Action employs a scope-narrowing adverb: “musically”, as do two of the three relevant examples cited by the Office Action. The use of this modifier undermines the Office Action’s argument because Applicant makes no use of the word

“musically” in his proposed mark SCORED NOVELLA. Thus, the absence of the term “MUSICALLY” illustrates the suggestive character of Applicant’s mark, as consumers are not presented with the term “SCORED” in such a limited context.

**II. Any Doubt as to a Mark’s Registrability Must Be Resolved in Applicant’s Favor.**

It is well established that the Trademark Trial and Appeal Board has a policy of resolving doubts in the applicant’s favor in ex parte cases. See In re Gourmet Bakers, Inc., 173 U.S.P.Q. 565 (T.T.A.B. 1972)(descriptiveness rejection); 2 J. Thomas McCarthy, Trademarks and Unfair Competition, § 11:51 at 11-97 (4th ed. 1999) (“Because the line between merely descriptive and only suggestive terms is ‘so nebulous,’ the Trademark Board takes the position that doubt is resolved in favor of the applicant on the assumption that competitors have the opportunity to oppose the registration once published and to present evidence which is usually not present in ex parte examination.”).

Indeed, the Federal Circuit has recognized and approved this practice. See In re Maverty Media Group Ltd., 33 F.3d 1367, 1374, 31 U.S.P.Q.2d 1923, 1928 (Fed. Cir. 1994). To uphold the descriptiveness refusal would effectively resolve any doubt on this issue against Applicant, contrary to the policy of the Board and contrary to explicit guidelines established in In re Merrill, Lynch, Pierce, Fenner, and Smith, Inc., 828 F.2d 1567, 1571, 4 U.S.P.Q.2d 1141, 1144 (Fed. Cir. 1987) (“It is incumbent on the Board to balance the evidence of public understanding of the mark against the degree of descriptiveness encumbering the mark, and to resolve reasonable doubt in favor of the applicant, in accordance with practice and precedent.”). Accordingly, Applicant respectfully requests that the Examining Attorney follow this established policy and withdraw the refusal to register.

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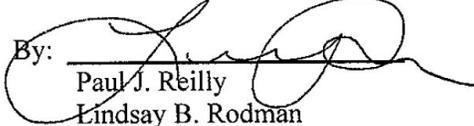
**CONCLUSION**

In view of the foregoing, Applicant respectfully requests that the Examining Attorney approve the mark for publication. Prompt and favorable action is requested.

Respectfully submitted,

BAKER BOTTS L.L.P

Dated: July 18, 2011

By: 

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Attorneys for Applicant



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scored

Subscr

## SCORE

Popularity



<sup>2</sup>SCORE *verb*

**scored** **scor·ing**

### Definition of SCORE

*transitive verb*

**1 a** : to keep a record or account of by or as if by notches on a tally : RECORD

**b** : to enter in a record

**c** : to mark with significant lines or notches (as in keeping account)

**2** : to mark with lines, grooves, scratches, or notches

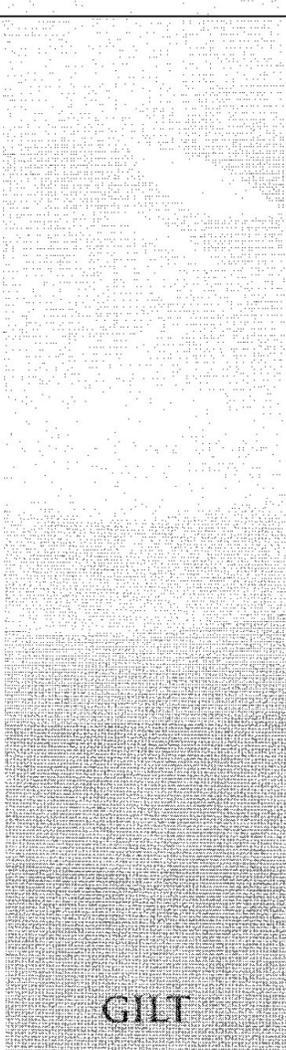
**3** : BERATE, SCOLD; *also* : DENOUNCE

**4 a** (1) : to make (a score) in a game or contest <*scored* a touchdown> <*scored* three points> (2) : to enable (a base runner) to make a score (3) : to have as a value in a game or contest : COUNT <a touchdown *scores* six points>

**b** (1) : ACHIEVE, ATTAIN <*scored* a dazzling success> (2) : ACQUIRE <help a traveler *score* local drugs — Poitor Koper> (3) : WIN 1 <*scored* free tickets over the radio>

**5** : to determine the merit of : GRADE

**6**



**a** : to write or arrange (music) for a specific performance medium

**b** : to make an orchestration of

**c** : to compose a score for (a movie)

*intransitive verb*

**1** : to keep score in a game or contest

**2** : to make a score in a game or contest

**3 a** : to gain or have the advantage

**b** : to be successful: as (1) : to succeed in having sexual intercourse (2) : to manage to obtain illicit drugs

**c** : <sup>3</sup>RATE

— **scor·er** *noun*

— **score points**

: to gain favor, status, or advantage

🔗 See score defined for English-language learners »

**Examples of SCORE**

She *scored* twice in the game.

Each correct answer *scores* two points.

In American football, a touchdown *scores* six points.

Who's going to *score* the game?

Judges will *score* the performances based on their artistic and technical features.

Which judges are *scoring* tonight?

**First Known Use of SCORE**

14th century

**Related to SCORE**

**Synonyms:** groove, scribe, seam

[+] more

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