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

APPLICATION SERIAL NO. 77819705

MARK: SCORED NOVELLA

CORRESPONDENT ADDRESS:
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BAKER BOTTS L.L.P.
30 ROCKEFELLER PLZ STE 4340
NEW YORK, NY 10112-4498

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

APPLICANT: J. Patrick Berry

CORRESPONDENT'S REFERENCE/DOCKET NO:
006910.xxxx
CORRESPONDENT E-MAIL ADDRESS:
nytmdpt@bakerbotts.com

REQUEST FOR RECONSIDERATION DENIED

ISSUE/MAILING DATE: 8/10/2011

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 requirement(s) and/or refusal(s) made final in the Office action dated February 5, 2011 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.

Applicant argues that the wording "SCORED" in the applied-for-mark is suggestive because there are different meanings that a consumer for these goods must evaluate in order to determine its meaning in relation to the goods, namely "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". Applicant states that "a consumer would believe that the term "SCORED" refers to some significant aspect of the term "NOVELLA", such as the plot, message, theme or

characters of the novella. Applicant does not dispute the finding in the refusal to register that the wording "NOVELLA" is in fact merely descriptive of the literary form of the goods. A copy of an online dictionary definition of the term "NOVELLA" was attached to the office action dated December 10, 2009 in support of the refusal to register. Rather, Applicant takes the position that the wording "SCORED" possesses so many alternative meanings that it is precluded from being merely descriptive in its present usage.

However, 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).

"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).

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.").

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/or services 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 and/or services 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 and/or services. Applicant's arguments as a whole comprise and are constituted of statements that, supported only by evidence in the form of dictionary definitions, show that in various contexts "scored" possesses different meanings, such as keeping score at a baseball game. This reasoning contradicts the premise well-supported by case law that descriptiveness is determined in relation to the goods and not in the abstract as represented by Applicant's arguments. Here, the wording "SCORED" must be attributed its meaning in the context of goods that are in fact, as specified in the identification of goods, musically scored. This feature of the goods, that the goods are in fact musically scored, renders Applicant's arguments that the wording "SCORED" has so many other possible meanings that it is non-descriptive in this case impotent in the context of the applied-for-mark SCORED NOVELLA in standard character, since the goods are in fact musically scored.

The fact that the goods feature a musical score accompanying the novella and are therefore in fact musically "scored" is highly likely to be one of the dominant, primary or main reasons why the intended consumers and purchasers are likely to consider buying or purchasing the goods. However, Applicant's arguments fail to address this issue. The evidence attached to the office action dated February 5, 2011, contrary to Applicant's conclusions regarding the same, shows that consumers are offered various types of audio books that are advertised as musically scored. Therefore, the wording "SCORED" in fact immediately conveys a significant feature of the audio books to consumers and purchasers and is highly likely to be a significant consideration in purchasing such goods versus, for example, audio books that do not feature a musical score. It is the provision of a musically scored audio book product that appears to be in fact a main selling point of such goods, including Applicant's audio books, in this case, offered in the literary and musical form of a "SCORED NOVELLA".

Copies of web pages and/or web sites from a search of the online search engine Google.com are attached to this office action that show the wording "SCORED" used descriptively for audio books. For example, a listing of audio books for sale from http://www.bonanza.com/listings/Gullivers-Travels-by-Jonathan-Swift-Audiobook/1746241 advertises "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." A listing of audio books for sale at http://www.alibris.com/booksearch.detail?invid=8164570202&browse=1&qwork=5177761&qsort=&page=1 advertises Pocahontas: Musically Scored (Audiobook). A listing of audio books for sale at http://www.barnesandnoble.com/w/valentine-audio-dove/1002318096 advertises "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." The evidence of record clearly supports finding, in this case, that the wording "SCORED", in relation to audio books that are musically scored, merely describes this feature of the goods directly and immediately to consumers and purchasers of such goods, and further, that the wording "SCORED NOVELLA" as a whole merely describes an audio book that offers a novella "scored" with music. Therefore, the final refusal to register on the grounds that the applied-for-mark as a whole is merely descriptive of the goods under Trademark Act Section 2(e)(1), is maintained.

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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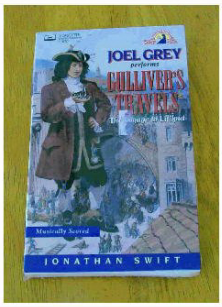

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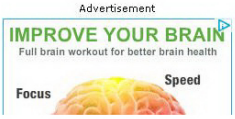

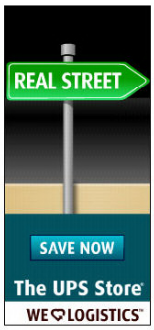

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