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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	77819705
Applicant	J. Patrick Berry
Applied for Mark	SCORED NOVELLA
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

Applicant : J. Patrick Berry

Serial No. : 77/819,705

Mark : **SCORED NOVELLA**

Filed : September 3, 2009

Our Ref. : 006910.4853

Applicant : J. Patrick Berry

Serial No. : 77/834,679

Mark : **SCORED SHORT STORY**

Filed : September 25, 2009

Our Ref. : 006910.4862

Applicant : J. Patrick Berry

Serial No. : 77/834,681

Mark : **SCORED STORY**

Filed : September 25, 2009

Our Ref. : 006910.4863

Applicant : J. Patrick Berry

Serial No. : 77/834,686

Mark : **SCORED NOVEL**

Filed : September 25, 2009

Our Ref. : 006910.4864

**APPLICANT'S CONSOLIDATED APPEAL BRIEF**

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## I. STATEMENT OF THE CASE

### A. The Applications

Applicant, J. Patrick Berry (“Applicant”) seeks to register the marks SCORED NOVELLA, SCORED SHORT STORY, SCORED STORY and SCORED NOVEL for “[a]udio 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 (hereinafter collectively “Applicant’s Marks”). Applicant filed its application for SCORED NOVELLA on September 3, 2009, and the applications for SCORED SHORT STORY, SCORED STORY and SCORED NOVEL on September 25, 2009, based on an intent to use the marks in commerce.

### B. Prosecution History

On December 10, 2009, the Examining Attorney issued Office Actions in connection with each of the applications, indicating that a search of the Office records found no similar registered or pending marks which would bar registration under Trademark Act Section 2(d). Still, the Examining Attorney refused registration on the grounds that Applicant’s Marks are merely descriptive of Applicant’s goods, and required Applicant to amend the recitations of goods in each application.

On June 5, 2010, Applicant filed responses to the Office Actions, amending the recitations of goods and submitting arguments that the overall marks are, at the very least, suggestive, so as to overcome the refusals to register (hereinafter, the “June 5, 2010 Response”).

The Examining Attorney issued second non-final Office Actions on June 28,

2010, accepting the amendments to the recitation of goods, but maintaining the refusals to register each of the marks and requesting additional information about the nature of Applicant's goods.

On December 28, 2010, Applicant filed responses to the Office Actions, submitting additional information regarding the nature of Applicant's goods and setting forth additional arguments that each of the overall marks is suggestive, and not merely descriptive.

The Examining Attorney issued Office Actions on January 18, 2011 for the marks SCORED SHORT STORY, SCORED STORY and SCORED NOVEL, and another Office Action on February 5, 2011 for the mark SCORED NOVELLA, which made final the refusals to register each of the marks based on the Examining Attorney's conclusion that Applicant's Marks are merely descriptive of Applicant's goods (hereinafter, the "Jan/Feb 2011 Final Office Action").

On July 18, 2011, Applicant filed Notices of Appeal in connection with the applications and, at the same time, requested that the appeals be suspended pending the Examining Attorney's review of Applicant's simultaneously filed Requests for Reconsideration and Responses After Final Refusal To Register.

The Examining Attorney denied Applicant's Requests For Reconsideration on August 10, 2011 (hereinafter, the "August 10, 2011 RFR Denial").

Applicant hereby submits this appeal brief in support of registration of the marks SCORED NOVELLA, SCORED SHORT STORY, SCORED STORY and SCORED NOVEL.

## **II. SUMMARY OF THE ARGUMENT**

The overall composites, SCORED NOVELLA, SCORED SHORT STORY, SCORED STORY and SCORED NOVEL, are entitled to registration on the Principal Register,

as they are not merely descriptive of the applied-for goods. The overall marks in no way directly or immediately describe Applicant's audio book products. Rather, the marks convey multiple and different commercial impressions, most involving sports, games, competition, performance or accounting, and consumers must engage in a multi-step reasoning process before coming to any conclusion about the precise nature of Applicant's audio books. As such, the final refusals to register the marks are improper.

### III. ARGUMENT

#### A. Applicant's Marks Are Suggestive Of Applicant's Products, Not Descriptive

##### 1. The Legal Standards for Descriptiveness and Suggestiveness

A term is descriptive if it "directly conveys information concerning the function, characteristics, purpose or use of [the] product[s]" or services. Towers v. Advent Software, Inc., 913 F.2d 942, 944, 16 U.S.P.Q.2d 1039, 1040 (Fed. Cir. 1990) (emphasis added). See In re The Stroh Brewery Co., 34 U.S.P.Q.2d 1796, 1797 (T.T.A.B. 1994) ("As has been stated repeatedly, a term is merely descriptive 'if it forthwith conveys . . . an immediate idea of the ingredients, qualities or characteristics of the goods.'" (quoting In re Abcor Dev. Corp., 588 F.2d 811, 200 U.S.P.Q. 215, 218 (C.C.P.A. 1978)) (emphasis added); In re Application of Quik-Print Copy Shops, Inc., 616 F.2d 523, 525, 205 U.S.P.Q. 505, 507 (C.C.P.A. 1980) ("A mark is merely descriptive if it immediately conveys knowledge of the ingredients, qualities, or characteristics of the goods or services . . .") (emphasis added). As explained by Professor McCarthy:

Under the Lanham Act, as under the common law, one of the tests to determine whether a mark is "merely descriptive" is based upon what the mark would mean to the potential consumer when applied to the applicant's goods.

The word "merely" in the Act apparently means that if the mark clearly does not tell the potential customer only what the goods are, their functions, characteristics, use or ingredients, then the mark is not "merely descriptive."

2 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition § 11:51 at 11-95 to 11-96 (4th ed. 1998).

In other words, a term is merely descriptive of a product or service if it would immediately and directly convey the thought of the product or service to one seeing or hearing the term. In re Hutchinson Tech. Inc., 852 F.2d 552, 555, 7 U.S.P.Q.2d 1490, 1492 (Fed. Cir. 1988) (citations omitted). The words “immediately,” “directly” and “forthwith” used in the aforementioned cases illustrate the high standard that has been imposed for categorizing a mark as “merely descriptive.”

Additionally, 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, or if the composite has a bizarre or incongruous meaning as applied to the goods. 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).

On the other hand, a term is suggestive when one must exercise imagination, thought, or perception to reach a conclusion as to the nature of the products or services. In re Noble Co., 225 U.S.P.Q. 749, 750 (T.T.A.B. 1985); see also Quik-Print Copy Shops, 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”). There is often a thin line of demarcation between a suggestive mark and a merely descriptive one. In re Grand Metro.

Foodservice, Inc., 30 U.S.P.Q.2d 1974, 1976 (T.T.A.B. 1997). While a merely descriptive mark “immediately” describes a given product or service, a suggestive mark requires but a “modicum” of imagination and thought. BellSouth Corp. v. Planum Tech. Corp., 14 U.S.P.Q.2d 1555, 1556 (T.T.A.B. 1990).

**2. Applicant’s Marks Do Not Directly Or Immediately Convey Information About Applicant’s Products, And Therefore Are Not Merely Descriptive**

When scrutinizing the marks according to the established standards, SCORED NOVELLA, SCORED SHORT STORY, SCORED STORY and SCORED NOVEL are not merely descriptive of Applicant’s audio books. Viewed in the context of these products, Applicant’s Marks lack sufficient definitive meaning to meet the high standard of descriptiveness. Instead, Applicant’s Marks convey multiple commercial impressions with respect to the products covered by the marks, and consumers must engage in a multi-step reasoning process before coming to any conclusion about the precise nature of those products, presupposing that any firm conclusion is or can be reached at all.

**a. Applicant’s Marks Create A Number Of Commercial Impressions**

Applicant’s Marks are suggestive based, in part, on the fact that the marks convey multiple and varied commercial impressions that consumers must consider. 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. For example, Applicant’s Marks may suggest audio books containing sports- or competition-themed stories. Alternatively, Applicant’s Marks may connote audio books containing prose which have been evaluated and to which a ranking or grade has been assigned or can be assigned by the consumer. Or, Applicant’s Marks may

suggest audio books containing prose that are somehow delineated (*i.e.*, scored) into a series of shorter works.

Indeed, as noted in Applicant's June 5, 2010 Response, the term "scored" has, at the very least, nine possible meanings, all of which evoke very distinct commercial impressions. The most commonly understood definitions for the term "scored" involve either (i) sports, games, competitive success or performance evaluation, or (ii) accounting of debt. (See Applicant's June 5, 2010 Response, Exhibit 1.) Dictionary.com Unabridged—whose content is based on Random House, Inc.'s Random House Dictionary—cites the primary definition for "score" as "the record of points or strokes made by the competitors in a game or match." (See id.) Applicant submits that at least sixteen of Dictionary.com's definitions relate to the measurement of sports, games, competitive success or performance evaluation (see id. nos. 1-4, 10, 16-20, 27, 28, 31-33, 36), while at least eight of the definitions concern accounting or indebtedness (see id. nos. 6-9, 24-26, 35.). Dictionary.com identifies only two music-related definitions for "score" out of thirty-two total definitions. (See id. nos. 15, 21.) Similarly, the musical definitions for "score" and "scored" found in Houghton Mifflin Company's The American Heritage Dictionary of the American Language are far outnumbered by definitions relating to sports, competitive success, performance evaluation or accounting of debt. (See id.)

Given the numerous sports, competition or accounting-related definitions for the term "score," no one meaning of the term "scored" can be immediately or directly ascribed to Applicant's audio books with the requisite precision necessary to classify Applicant's Marks as merely descriptive. Consumers must sift through numerous possible meanings for the term "scored" and must make guesses or insert additional meaning into the phrase in order to understand the nature of Applicant's goods. As such, each of the marks as a whole is, at the very

least, suggestive of Applicant's audio books.

**b. Consumers Do Not Associate "Scored"  
With "Musically Scored"**

The Examining Attorney has rejected the numerous definitions for the term "scored" on the grounds that they are abstract meanings in relation to Applicant's goods, and that consumers are likely to associate or identify the term "scored" as meaning "musically scored." In support of this argument, the Examining Attorney has submitted copies of web pages and/or web sites located through a Google search, which allegedly "show the wording 'musically scored' is in fact used to identify attributes, features, characteristics, elements and/or type of content of these goods." (Jan/Feb 2011 Final Office Action.) Further, the Examining Attorney has proffered Internet evidence relating to audio books specifically, and contends that "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." (August 10, 2011 RFR Denial (emphasis added).)

As an initial matter, the Examining Attorney's supporting evidence found through his Google search does not include the Google search results page itself, nor does the Examining Attorney clearly identify the specific search terms he employed. (See *id.*) Assuming, however, that the Examining Attorney conducted a Google search for the phrase "musically scored," the search results nevertheless fail to establish that consumers are likely associate or identify the word "scored" with music. The evidence either makes no connection between "scored" and music in the context of audio books, or shows that use of the term "musically" must be used in order to make the explicit connection between "scored" and music. In fact, the Examining Attorney has proffered no evidence even suggesting, much less proving, that consumers are likely to immediately think of music or musical scores upon encountering the designation

SCORED NOVELLA, SCORED SHORT STORY, SCORED STORY or SCORED NOVEL in connection with Applicant's goods. Rather, the Examining Attorney's "evidence" primarily consists of references to the terms "scored" and "musically scored" in completely different and inapplicable contexts.

The Examining Attorney's first Google search result, from the website at merriam-webster.com, lists exemplary dictionary definitions for the term "score," which include: (i) to keep an accounting (including, by notches), (ii) to berate or scold, (iii) to make (a score) in a game or contest, (iv) to achieve or attain, or (v) to determine the merit of. None of the definitions depicted on that page relate to music.

The second Google search result, a Facebook page for Salmon Arm Photographer, discusses that the photographer's services include publishing photographs to musically scored DVDs. This evidence bears no relation to audio books. Even in the context of DVDs, the phrase "musically scored" is necessary to convey that the photographs are coupled with music.

The third Google search result is from the website at eastwestbookshop.com. The advertised product is a meditation user guide (i.e., a print book) that is sold with a CD that features guided meditations; neither is an audio book. Still, the bookshop must specify that the guided meditations are "musically scored" rather than just "scored." The fact that the bookshop must provide this explanation underscores that consumers do not immediately interpret or perceive the term "scored" as "musically scored" or related to music.

The fourth Google search result, from the website at remarkablelives.com, offers video documentary services and products. The business uses professional lighting, video, audio and digital post-production editing equipment to create a DVD containing a biographical documentary, saved on a DVD, that is "musically scored." Again, there is no audio book

component to the services or products, and even if there were, the company would use the phrase “musically scored,” not simply “scored.”

The fifth Google search result, from the website at [broadwayworld.com](http://broadwayworld.com), advertises a live theatrical performance by Odds Bodkin, a performance storyteller, author, musician and educator who tells stories self-accompanied on twelve-string guitars, electric guitar, Celtic harp, grand piano, pipes, drums, African sanza and Indian sitar. Mr. Bodkin does not sell audio books, but rather is a performance artist who has also released musical CDs to highlight his “musically scored” work.

The sixth Google search result, from the website at [appolicious.com](http://appolicious.com), features a mobile application for Apple’s iPhone device. The application is not an audio book, but rather is a multimedia software application created exclusively for the iPhone. This “book iPhone app” is also expressly marketed as “(musically) scored.”

The final Google search result, from the website at [mcall.com](http://mcall.com), advertises a weekly audio podcast of the public radio show “This American Life.” Even in the context of a public radio show, consumers are expressly advised that the prose is “musically scored.”

The Examining Attorney has submitted only two pieces of evidence at all related to “audio books.” (See August 10, 2011 RFR Denial.) Still, this Internet material is no more instructive than the Google search results. Each of these products explicitly advertises that the audio book is “musically scored” rather than simply “scored,” because consumers encountering the term “scored” in connection with audio books will likely need additional information, or thought and imagination, to reach a conclusion as to the nature of the goods.

The Examining Attorney’s supporting evidence makes manifest that the general public does not immediately and directly associate “scored” with music in the context of audio

books. Instead, the modifier “musically” must be used to convey this association. As such, the applied-for marks do not immediately and directly describe Applicant’s products, and therefore do not rise to the level of mere descriptiveness.

**3. Any Doubt Resolved In Applicant’s Favor**

Any doubt with respect to the issue of descriptiveness should be resolved in Applicant’s behalf. In re Grand Metro. Foodservice, Inc., 30 U.S.P.Q.2d 1974 1976 (T.T.A.B. 1994). In fact, the policy of the Patent and Trademark Office is to resolve any doubt as to descriptiveness in favor of the applicant. In re Women’s Publ’g Co., 23 U.S.P.Q.2d 1876, 1878 (T.T.A.B. 1992), citing In re Merrill Lynch, Pierce, Fenner & Smith, Inc., 828 F.2d 1567, 1571, 4 U.S.P.Q.2d 1141, 1144 (Fed. Cir. 1987). The Board, after citing the above principle from In re Merrill Lynch, noted the following reason for resolving doubt in favor of the applicant and publishing the mark:

Our decision is assisted by the fact that we have no information that anyone will be damaged by the registration of the mark but that anyone who would be injured will have an opportunity to file a notice of opposition and to develop a factual record upon which any question of descriptiveness could be adjudicated with more confidence than it can be on the basis of a priori assumptions.

In re Waverly Inc., 27 U.S.P.Q.2d 1620, 1624 (T.T.A.B. 1993) (citing In re Distrib. Codes, Inc., 199 U.S.P.Q. 508, 511 (T.T.A.B. 1978)); see 2 McCarthy, supra, § 11:51 at 11-97 (“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.”).

Given the foregoing, it is reasonable and fair for the USPTO to withdraw the refusals to register SCORED NOVELLA, SCORED SHORT STORY, SCORED STORY and

SCORED NOVEL on the basis that the marks are not merely descriptive, but rather are suggestive as used in connection with the applied-for goods.

**IV. CONCLUSION**

In light of the foregoing, Applicant respectfully requests that the Board reverse the Examining Attorney's refusals to register Applicant's marks, SCORED NOVELLA, SCORED SHORT STORY, SCORED STORY and SCORED NOVEL, and approve the applications for publication.

Respectfully submitted,

BAKER BOTTS L.L.P.

Dated: November 10, 2011

By: \_\_\_\_\_

  
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