

This Opinion is not a  
Precedent of the TTAB

Mailed: July 8, 2015

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board  
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*In re Wild Candy Pty. Ltd.*  
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Serial No. 79123938  
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William J. Seiter of Seiter Legal Studio,  
for Wild Candy Pty. Ltd.

David Yontef, Trademark Examining Attorney, Law Office 108,  
Thomas G. Howell, Managing Attorney.

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Before Taylor, Bergsman and Greenbaum,  
Administrative Trademark Judges.

Opinion by Greenbaum, Administrative Trademark Judge:

Wild Candy Pty. Ltd. (“Applicant”) seeks registration on the Principal Register of the mark SNEEZING BABY PANDA (in standard characters) for the following goods and services:

Facial tissues impregnated with cosmetic lotions featuring aloe vera and eucalyptus plant extracts, cosmetics and perfume, in International Class 3;

Pharmaceutical products and preparations, namely, pharmaceutical preparation for skin care, anti-infectives and pharmaceutical preparations and substances for the treatment of viral, metabolic, endocrine, musculoskeletal, cardiovascular, cardiopulmonary, genitourinary, sexual

dysfunction, oncological, hepatological, ophthalmic, respiratory, neurological, gastrointestinal, hormonal, dermatological, psychiatric and immune system related diseases and disorders, in International Class 5;

Digital media, namely, pre-recorded CDs, DVDs, video cassettes, digital video discs, digital versatile discs and high definition digital discs featuring audio and visual content in the nature of exposed cinematograph films, theatrical performances and music; electronic games, namely, electronic game software, electronic game programs and downloadable electronic games via the Internet and wireless devices, in International Class 9;

Paper, cardboard, and goods made from these materials, not included in other classes, namely, printed posters; photographs; stationery; printed instructional and teaching material except apparatus in the field of animals, nature and the environment; books, namely, children's books, comic books, coloring books, series of fiction books, series of non-fiction books in the field of animals, nature and the environment and educational books and coffee table books featuring animals, nature and the environment; brochures about animals, nature and the environment; publications, namely, magazines, hand-outs and workbooks in the field of animals, nature and the environment; printed event programs and souvenir programs concerning animals, nature and the environment; face and facial tissues of paper, in International Class 16;

Mugs; beverage glassware; porcelain and earthenware not included in other classes, namely, sculptures, statues and works of art; containers for household and kitchen use; hair combs, in International Class 21;

Clothing, namely, t-shirts, sweat shirts and jackets; footwear; headgear, namely, hats and caps, in International Class 25;

Games and playthings, namely, plush dolls, stuffed toy animals and board games; toys, namely, electronic learning toys, infant toys and hand-held units for playing electronic games for use with external display screen or monitor; gymnastic and sporting articles not included in

other classes, namely, gymnastic apparatus, balls for sports and protective supports for shoulders and elbows, in International Class 28;

Chocolate; chocolate confectionary; boiled sweets; chocolate sweets; sugar sweets; non-medicated chewing sweets; non-medicated gum sweets; non-medicated sweets; peppermint sweets, in International Class 30;

Promotion of theatrical performances, concerts, cinematograph films and musical works for others, in International Class 35; and

Production of cinematograph films, television programs and documentary films; entertainment, namely, live music concerts and orchestra performances; electronic publication services, namely, digital video, audio, and multimedia publishing services regarding cinematograph films, theatrical performances and music; electronic publication of text and graphic works of others on CD, DVD and on-line featuring animals, nature and the environment; entertainment services, namely, theatrical and musical floor shows provided at performance venues, in International Class 41.<sup>1</sup>

The Trademark Examining Attorney has refused registration of Applicant's mark for the goods identified in Classes 9, 16, 21, 25 and 28 and the services identified in Classes 35 and 41 (1) under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), on the ground that Applicant's mark is merely descriptive of the identified goods and services, and (2) pursuant to Trademark Rule 2.61(b), 37 CFR § 2.61(b), on the ground that Applicant failed to comply with the requirement to submit documents about those goods and services. Neither refusal applies to the goods identified in Classes 3, 5 and 30.

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<sup>1</sup> Application Serial No. 79123938 was filed on September 13, 2012, based upon a request for extension of protection filed under Section 66(a) of the Trademark Act, 15 U.S.C. § 1141(f).

In addition, the Examining Attorney has refused registration for the goods in Classes 21 and 28 pursuant to Trademark Rule 2.61(b) on the ground that Applicant did not adequately respond to, or comply with, the requirement to disclose the meaning or significance of the applied-for mark with respect to those goods.<sup>2</sup>

When the refusals were made final, Applicant appealed and twice requested reconsideration. After the Examining Attorney denied both requests, the appeal was resumed. We affirm the refusal based on Section 2(e)(1) for the goods in Classes 9, 16, 21 and 28, and the services in Class 41. We reverse the refusal based on Section 2(e)(1) for the goods in Class 25 and the services in Class 35. We also reverse both refusals made pursuant to Trademark Rule 2.61(b).

## I. Background

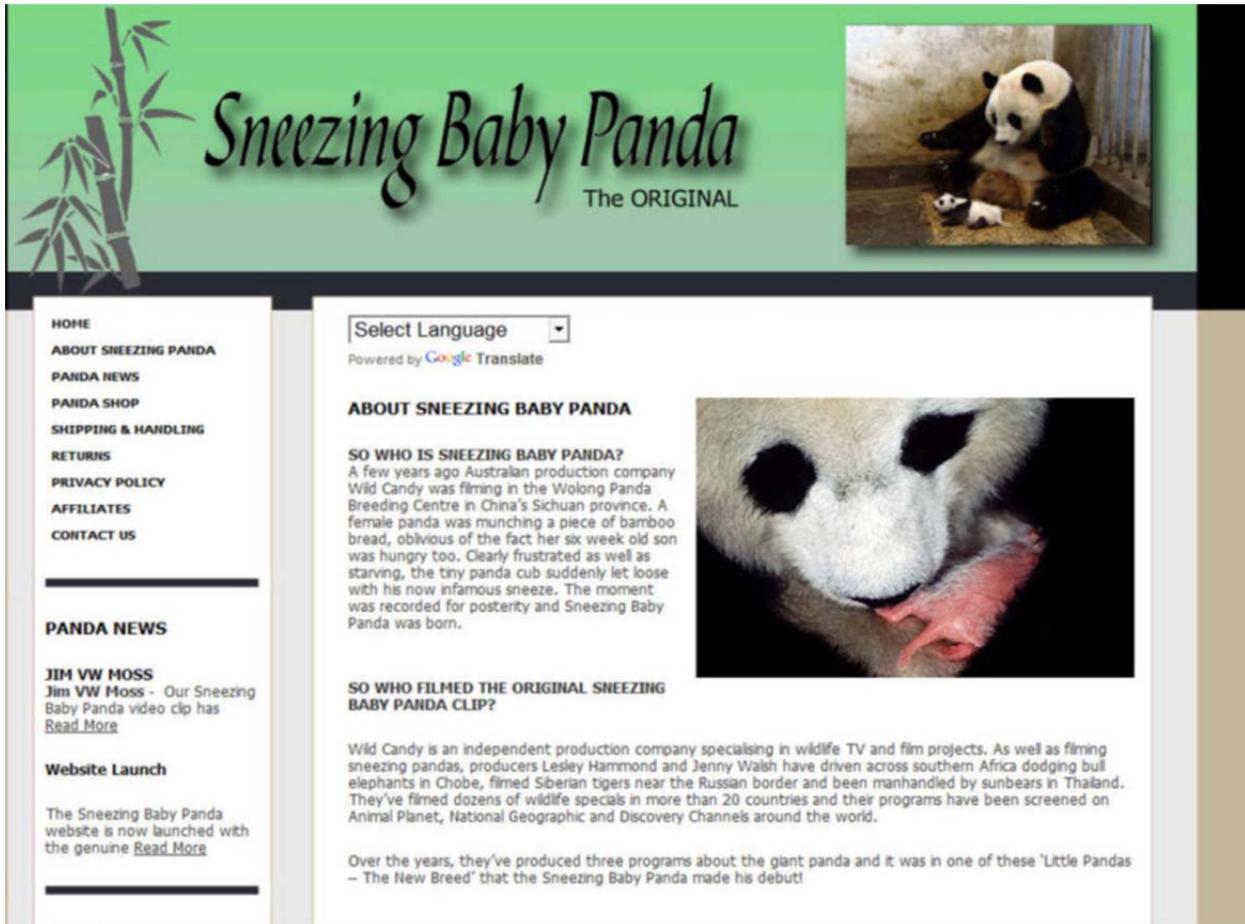
Applicant is an Australian independent film production company specializing in documentary films and television programs featuring wildlife. Applicant explains that when it was filming in the Wolong Panda Breeding Center in China's Sichuan province several years ago, Applicant filmed a mother panda eating bamboo while her panda cub sprawled at her feet. "Clearly frustrated as well as starving, the tiny panda cub suddenly let loose with his now infamous sneeze," which startled his mother. "The moment was recorded for posterity and Sneezing Baby Panda was born."<sup>3</sup> The following screenshot from Applicant's website

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<sup>2</sup> This requirement originally applied to Classes 3, 5, 21, 28 and 30, but was withdrawn as to Classes 3, 5 and 30 in the November 14, 2013 Office Action.

<sup>3</sup> May 1, 2013 Response to Office Action.

<sneezingbabypanda.com> provides background information about Applicant, the video clip, and the sneezing baby panda star of the video clip:<sup>4</sup>



Applicant produced a television program named “Little Pandas – The New Breed” which featured the video clip of the mother panda and her cub (Applicant refers to this video clip as the “Film Footage”). Applicant states that it is “the exclusive copyright owner of the Film Footage, and has licensed the Film Footage in the United States and elsewhere.” However, according to Applicant, an unrelated third-party “unlawfully reproduced” the video clip from Applicant’s television program and “unlawfully uploaded [it] onto the Internet,” and the video clip has

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<sup>4</sup> January 29, 2013 Office Action.

since “gone viral.”<sup>5</sup> On its website, Applicant describes the panda as “one of the most iconic critters on the Internet! A member of the exclusive 100 million views club and still climbing at 120,000 hits a day!”<sup>6</sup>

Applicant currently offers for sale on its website t-shirts featuring a freeze-frame of the mother and baby pandas from the video clip.<sup>7</sup>



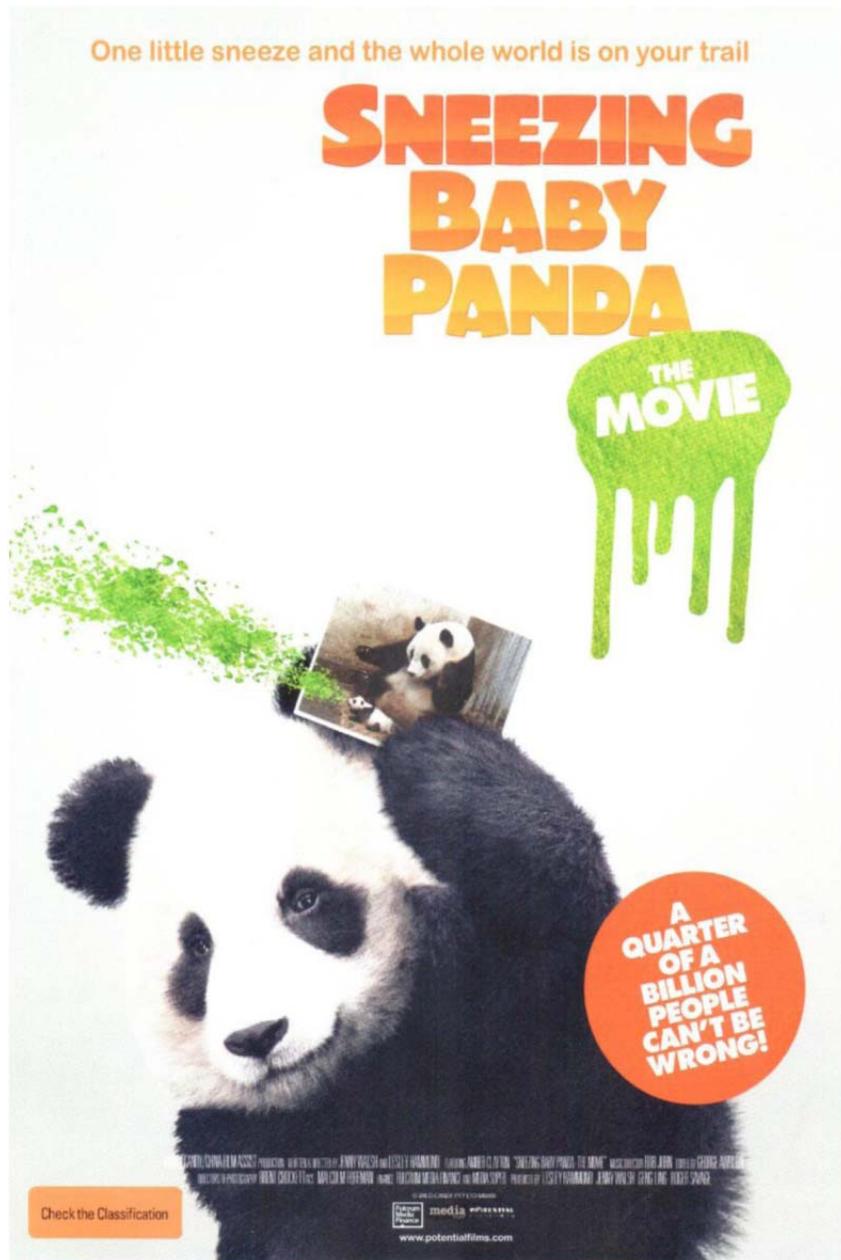
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<sup>5</sup> May 1, 2013 Response to Office Action.

<sup>6</sup> January 29, 2013 Office Action. *See also* the *TAP Milwaukee* website (jsonline) displaying an excerpt of a news article published in the *Journal Sentinel* (June 30, 2011) (“Sneezing Baby Panda turned a big ‘a-choo’ into international stardom when his video clip went viral and more than 106 million visitors watched him do his snort.”); *Know Your Meme* website (knowyourmeme.com) (“Sneezing Baby Panda is a viral video uploaded to YouTube on November 6th, 2006 that depicts a mother panda at the Wolong Panda Breeding Centre munching on bamboo while her baby cub sleeps at her feet. Out of nowhere, the baby sneezes, startling the mother for a second before she returns to her food. As of August 2013, the video was been [sic] viewed more than 162.7 million times and was named #10 on the Urlesque’s 100 Most Iconic Internet Videos in April 2009.”). October 11, 2013 Response to Office Action.

<sup>7</sup> January 29, 2013 Office Action.

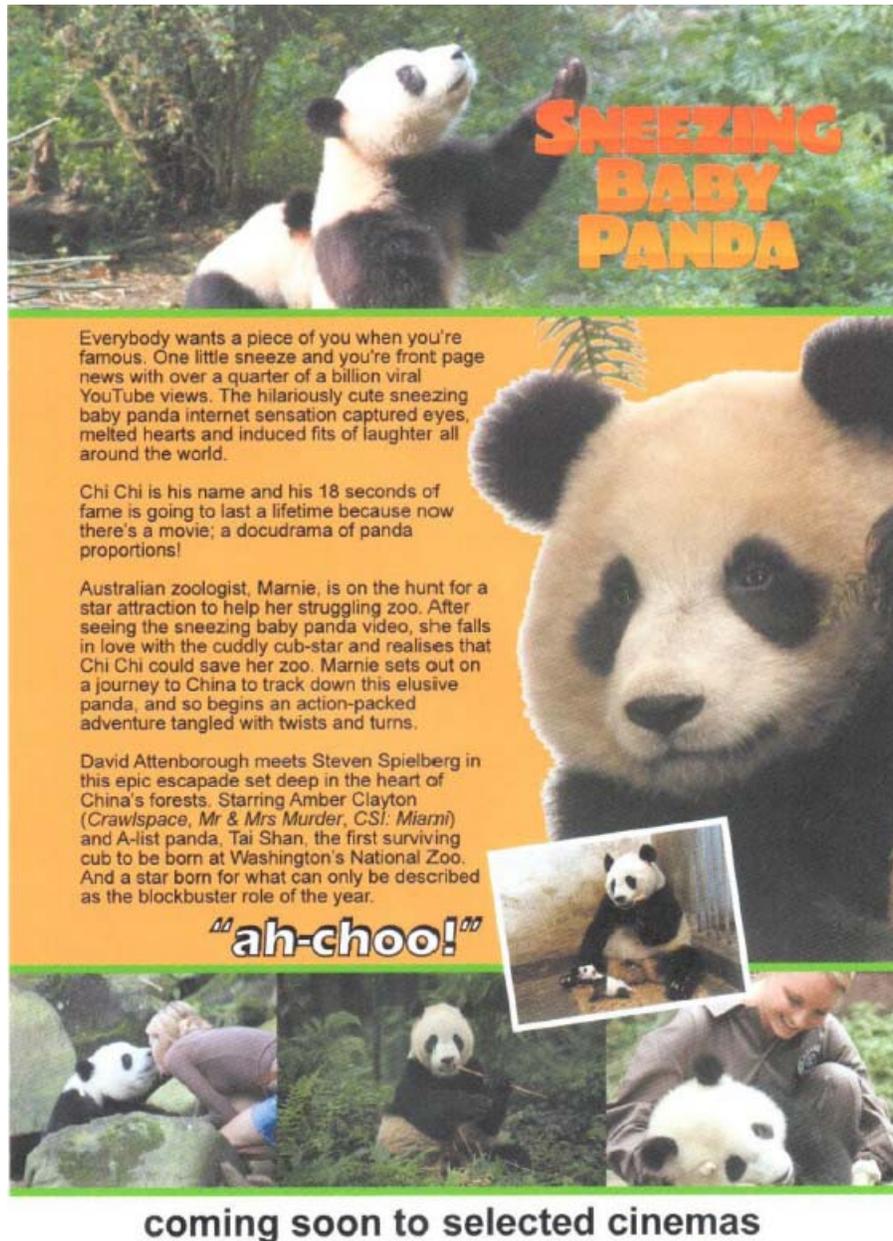
In 2014, Applicant expected to release in the United States its feature film named “Sneezing Baby Panda: The Movie.”<sup>8</sup>



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<sup>8</sup> April 15, 2014 Response to Office Action.

Applicant’s promotional material refers to “[t]he hilariously cute sneezing baby panda [I]nternet sensation” who “captured eyes, melted hearts and induced fits of laughter all around the world.”<sup>9</sup>



Applicant hopes to capitalize on the fame of “Sneezing Baby Panda” through licensing, merchandising and marketing plans in the United States and elsewhere.

<sup>9</sup> *Id.*

Applicant explained that these plans include a “children’s environmentally themed television series with Sneezing Baby Panda as one of the series characters, plus electronic games and mobile device apps in a similar vein.” Applicant refers to these licensing and marketing efforts as evidence of Applicant’s “good faith intent to use ‘Sneezing Baby Panda’ as a trademark in the U.S., and [to] demonstrate that Applicant’s intended use of the trademark transcends the use of ‘Sneezing Baby Panda’ as a single film title.”

## II. Trademark Rule 2.61(b) Requirements

Trademark Rule 2.61(b), 37 CFR § 2.61(b) provides that “[t]he Office may require the applicant to furnish such information, exhibits, affidavits or declarations, and such additional specimens as may be reasonably necessary to the proper examination of the application.” If the applicant does not comply with a requirement for additional information or to disclose the meaning or significance of the mark with respect to the identified goods and services, the examining attorney may refuse registration on that basis. *See* TBMP § 814 (January 2015).

### A. Requirement for Documents – Classes 9, 16, 21, 25, 28, 35 and 41

Throughout prosecution of this application, the Examining Attorney has required Applicant to provide

fact sheets, instruction manuals, brochures, samples of advertisements or promotional materials for the identified goods and services and a photograph of the identified goods.

If these materials are unavailable, applicant should submit similar documentation for goods and services of the same type, explaining how its own product or services

will differ. If the goods and services feature new technology and no information regarding competing goods and services is available, applicant must provide a detailed factual description of the goods and services.

Factual information about the goods must make clear how they operate, salient features, and prospective customers and channels of trade. For the services, the factual information must make clear what the services are and how they are rendered, salient features, and prospective customers and channels of trade. Conclusory statements will not satisfy this requirement for information.<sup>10</sup>

The document requirement pertains only to Classes 9, 16, 21, 25, 28, 35 and 41. However, the Examining Attorney initially issued this requirement in the same Office Action in which he issued what appears to be an independent requirement for an acceptable identification of goods and services in several classes, including Classes 9, 16, 25, 28 and 35.<sup>11</sup> In its May 1, 2013 Response to Office Action, Applicant satisfied the requirement for an acceptable identification of goods and services. Thus, to the extent the Examining Attorney required the documents to better understand the particular nature of goods and services in Classes 9, 16, 25, 28 and 35, the requirement is moot.

We further find that the basis for the document requirement with respect to any of the goods and services in Classes 9, 16, 21, 25, 28, 35 and 41 is unclear. In its May 1, 2013 Response to Office Action, Applicant provided background information about the video clip, explained its use of SNEEZING BABY PANDA on t-shirts and

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<sup>10</sup> January 29, 2013 Office Action. The Examining Attorney repeated this requirement nearly verbatim in the next three Office Actions.

<sup>11</sup> The requirement for an acceptable identification of goods and services did not pertain to Classes 21 or 41.

its intention to expand use of SNEEZING BABY PANDA on other merchandise that is “not intended to be limited in subject matter to pandas ... but rather will feature animals generally, nature and the environment,” and argued that SNEEZING BABY PANDA “is capable of distinguishing [its] goods and services from the goods and services of competitors.” Applicant provided with its October 11, 2013 Request for Reconsideration several Internet printouts that feature and discuss the popularity of the video clip, and in its April 15, 2014 Request for Reconsideration, explained its licensing and marketing efforts regarding the upcoming movie and possible children’s television series, as well as electronic games and a mobile application.

In the November 14, 2013 Office Action, the Examining Attorney complained that “most of the Internet printouts submitted by applicant do not contain any new information regarding the nature of the identified goods and services” nor do they “shed any light on the nature of the identified goods and services.” However, the “nature of the identified goods and services” in Classes 9, 16, 21, 25, 28, 35 and 41 is clear. For example, none of the identified goods or services includes technical matter that would require Applicant to submit anything to allow the Examining Attorney to properly examine the application. If the Examining Attorney was trying to ascertain whether any of Applicant’s goods or services would be related to pandas in general, or to the sneezing baby panda featured in the video clip, Applicant’s

responses to the other Trademark Rule 2.61 requirement, discussed below, resolved this issue as to the Class 21 and 28 goods.<sup>12</sup>

Under these circumstances, we find that it was incumbent upon the Examining Attorney to have explained with specificity why he needed additional information. *See* TMEP § 814 (“The examining attorney must explain why the information is needed, if the reason is not obvious.”). The Examining Attorney did not do so. We therefore reverse the refusal to register Applicant’s mark as to Classes 9, 16, 21, 25, 28, 35 and 41 on the ground that Applicant failed to comply with the Trademark Rule 2.61 requirement to provide additional information.

B. Meaning or Significance – Classes 21 and 28

With respect to the requirement that Applicant disclose the meaning of SNEEZING BABY PANDA or whether SNEEZING BABY PANDA has any significance in relation to the goods identified in Classes 21 and 28, the Examining Attorney asked the following five questions:<sup>13</sup>

1. Do any of the goods feature images and/or information of a sneezing baby panda?
2. Do any of the goods feature images and/or information of a panda?
3. Do any of the goods take the form/shape of a sneezing baby panda?
4. Do any of the goods take the form/shape of a panda?

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<sup>12</sup> We note that the Examining Attorney never required Applicant to disclose the meaning or significance of SNEEZING BABY PANDA for the goods identified in Classes 9, 16 or 25, or for the services identified in Classes 35 or 41.

<sup>13</sup> January 29, 2013 Office Action.

5. Are any of the identified goods intended for use with a panda?

Although Applicant did not respond specifically to the five questions in its May

1, 2013 Response to Office Action, Applicant provided the following information:

In response to the Examining Attorney's request for additional information about the applied for goods and services, Applicant respectfully submits that its applied for goods and services, as amended, do not necessarily have to do with pandas, but rather may feature animals generally, nature and the environment. Additional information about the Applicant has been provided hereinabove, much of which has been made of record by the Examining Attorney in his office action.

Applicant also explained the following:

Applicant has used the applied for mark in Australia and elsewhere since the broadcast of the television program, and owns and operates the website [www.sneezingbabypanda.com](http://www.sneezingbabypanda.com) referenced by the Examining Attorney. Currently only t-shirts bearing the mark are available for purchase online, but Applicant intends to extend the range of merchandise available for purchase in the United States and elsewhere. Such merchandise is not intended to be limited in subject matter to pandas, but rather, will feature animals generally, nature and the environment.

The registration of the applied for mark by Applicant will not preclude others from making descriptive fair use of the term "Sneezing Baby Panda" to describe Applicant's Film Footage. That said, however, Applicant's exclusive ownership of the Film Footage and extensive and substantially exclusive use of the mark SNEEZING BABY PANDA throughout Australia, the United States, and worldwide, means that the mark is capable of distinguishing Applicant's applied for goods and services from the goods and services of competitors. Indeed, given the fame of the Film Footage and its association with Applicant as the film maker, there is no reason why another trader would wish to use the same mark on the

same or similar goods or services unless with improper motive.

Then, in its October 11, 2013 Request for Reconsideration, Applicant responded to each of the five questions as follows: “The goods may or may not do so.” We read this equivocal language as an admission that the goods “will” feature images of or information about, or take the form or shape of a panda or a sneezing baby panda. We therefore reverse the refusal to register Applicant’s mark in Classes 21 and 28 on the ground that Applicant failed to comply with the Trademark Rule 2.61(b) requirement to disclose the meaning of or significance of SNEEZING BABY PANDA with respect to the identified Class 21 and 28 goods. *Cf. In re Cheezwhse.com, Inc.*, 85 USPQ2d 1917 (TTAB 2008) (affirming refusal to register based on applicant’s failure to comply with Trademark Rule 2.61(b) when applicant completely ignored the examining attorney’s requirement to provide information regarding the geographic origin of applicant’s goods).

### III. Section 2(e)(1)

#### A. Applicable Law

The test for determining whether a mark is merely descriptive is whether it immediately conveys information concerning a significant quality, characteristic, function, ingredient, attribute or feature of the product or service in connection with which it is used, or intended to be used. *In re Chamber of Commerce of the U.S.*, 675 F.3d 1297, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012). *See also In re Oppedahl & Larson LLP*, 373 F.3d 1171, 71 USPQ2d 1370, 1371 (Fed. Cir. 2004), *quoting Estate of P.D. Beckwith, Inc. v. Comm’r*, 252 U.S. 538, 543 (1920) (“A mark is merely

descriptive if it ‘consist[s] merely of words descriptive of the qualities, ingredients or characteristics of the goods or services related to the mark.’). The determination of whether a mark is merely descriptive must be made “in relation to the goods [or services] for which registration is sought, 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.” *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 82 USPQ2d 1828, 1831 (Fed. Cir. 2007) (citing *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215 (CCPA 1978)). It is not necessary, in order to find a mark merely descriptive, that the mark describe each feature of the goods or services, only that it describe a single, significant ingredient, quality, characteristic, function, feature, purpose or use of the goods or services. *Chamber of Commerce of the U.S.*, 102 USPQ2d at 1219; *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987).

The question is not whether someone presented only with the mark could guess the products or services listed in the description of goods or services. Rather, the question is whether someone who knows what the goods or services are will understand the mark to convey information about them. *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 103 USPQ2d 1753, 1757 (Fed. Cir. 2012), quoting *In re Tower Tech, Inc.*, 64 USPQ2d 1314, 1316-1317 (TTAB 2002). See also *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).

Where a mark consists of multiple words, the mere combination of descriptive words does not necessarily create a nondescriptive word or phrase. *In re Phoseon Tech., Inc.*, 103 USPQ2d 1822, 1823 (TTAB 2012); *In re Associated Theatre Clubs Co.*, 9 USPQ2d 1660, 1662 (TTAB 1988). If each component retains its merely descriptive significance in relation to the goods or services, the combination results in a composite that is itself merely descriptive. *Oppedahl*, 71 USPQ2d at 1371. However, a mark comprising a combination of merely descriptive components is registrable if the combination of terms creates a unitary mark with a nondescriptive meaning, or a double entendre with one meaning being non-descriptive, or if the composite has an incongruous meaning as applied to the goods or services. *See In re Colonial Stores Inc.*, 394 F.2d 549, 157 USPQ 382 (CCPA 1968) (SUGAR & SPICE for “bakery products”); *In re Shutts*, 217 USPQ 363 (TTAB 1983) (SNO-RAKE for “a snow removal hand tool having a handle with a snow-removing head at one end, the head being of solid uninterrupted construction without prongs”).

B. Evidence and Argument – Classes 9, 16, 21, 25, 28, 35 and 41

The Examining Attorney contends that SNEEZING BABY PANDA is merely descriptive of the identified goods and services because they may take the form or shape of, or feature images or information about, a sneezing baby panda.

In traversing the refusal, Applicant argues that SNEEZING BABY PANDA is suggestive rather than descriptive of its identified goods and services. Applicant’s main position is best described in its own words:

The bulk of Applicant’s goods and services in Classes 9, 16, 21, 25, 28, 35 and 41, as amended, have nothing

intrinsically to do with pandas, though some of those goods and services have to do with animals, nature and the environment. Therefore, the mark should not be regarded as merely descriptive.

As is obvious from the amended identification of goods and services, the goods and services of Applicant may be anchored in the Movie as well as the Film Footage, promoting the mark “Sneezing Baby Panda” as an indicator of source, but those goods and services, on the face of the identification, do not consist of the Film Footage itself, even though some of those goods and services may derive from it, nor does Applicant aim to protect “Sneezing Baby Panda” as a trademark merely by use of the term in the title of the Movie.

It is crystal clear from the Examining Attorney’s remarks, Applicant’s submissions, and the evidence of record that there is one, and only one, “Sneezing Baby Panda.” The mark “Sneezing Baby Panda” is not a term descriptive of pandas or baby pandas in general. The Examining Attorney and Applicant agree that “Sneezing Baby Panda” refers to one unique baby panda at one point in time, the panda cub who let loose with his famous sneeze memorialized in the Film Footage. “Sneezing Baby Panda,” soon to be the star of the Movie, has a unique referent. As pointed out in previous responses, the subject matter content of some of Applicant’s goods or services may or may not include pandas, but they may also have to do with other species of animals, nature and the environment, and the unique referent “Sneezing Baby Panda” is intended to be used by Applicant as a source indicator for its family of goods and services so branded. Therefore, the mark should not be regarded as merely descriptive, and the Examining Attorney’s comments should be reviewed in this context.<sup>14</sup>

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<sup>14</sup> App. Br. pp. 14-15, 9 TTABVUE 18-19. Citations to Applicant’s and the Examining Attorney’s briefs in this opinion also include citations to the TTABVUE docket entry number, and the electronic page number where the argument appears. TTABVUE is the Board’s electronic docketing system.

Again, the unique one-off baby panda referenced by the mark “Sneezing Baby Panda” is intended to be used as a source indicator for the applied for goods and services, in the nature of a mascot or flag bearer.<sup>15</sup>

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While the term “Sneezing Baby Panda” may be regarded as descriptive of the Film Footage or the Movie, in the sense that it is the title of a copyrighted work, and the title is closely associated with Applicant as the maker of the Film Footage and the Movie, the trademark “Sneezing Baby Panda” describes Applicant as the source of its applied for goods and services, akin to the way a mascot might identify a sports team, but it does not describe those goods or services.<sup>16</sup>

The language limiting many of the printed publications in the Class 16 identification of goods to “animals, nature and the environment” is worded broadly enough to include a sneezing baby panda as the subject matter of the publications. It is well-settled that a term which merely describes the subject matter of a publication is merely descriptive of the publication, for purposes of Section 2(e)(1). *See, e.g., In re Waverly Inc.*, 27 USPQ2d 1620 (TTAB 1993) (MEDICINE merely descriptive of journal); *In re Women's Publishing Co., Inc.*, 23 USPQ2d 1876 (TTAB 1992) (DECORATING DIGEST merely descriptive of magazine). Similarly, the various types of pre-recorded “digital media” ... “featuring audio and visual content in the nature of exposed cinematograph films” and “theatrical performances” listed in the Class 9 identification of goods are not limited to particular subject matter. We therefore read this identification to include, for example, pre-recorded high

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<sup>15</sup> App. Br. p. 17, 9 TTABVUE 21.

<sup>16</sup> App. Br. p. 18, 9 TTABVUE 22.

definition digital discs featuring films and theatrical performances about a sneezing baby panda. As with the Class 16 printed publications, SNEEZING BABY PANDA is merely descriptive of Applicant's Class 9 pre-recorded digital media because the proposed mark merely describes the subject matter of the identified goods.

Likewise, the services in Class 41, which include "production of cinematograph films, television programs and documentary films" and "entertainment services, namely, theatrical and musical floor shows provided at performance venues," are not limited to particular subject matter, and therefore could include, for example, television programs and theatrical performances about a sneezing baby panda. SNEEZING BABY PANDA therefore also is merely descriptive of the identified services. *See In re Conus Communications Co.*, 23 USPQ2d 1717 (TTAB 1992) (ALL NEWS CHANNEL found generic for a television channel broadcasting all news); *In re Weather Channel, Inc.*, 229 USPQ 854 (TTAB 1986) (THE WEATHER CHANNEL found generic for a television transmission whose subject matter exclusively concerns the weather).

Further, as noted above, Applicant has admitted that the goods identified in Class 21, which includes sculptures and statuettes, and in Class 28, which includes stuffed toy animals, will take the form or shape of a sneezing baby panda. Accordingly, SNEEZING BABY PANDA merely describes a significant feature of the identified goods in Classes 21 and 28.

In sum, SNEEZING BABY PANDA describes at least one aspect of some of the goods identified in Classes 9, 16, 21 and 28, and some of the services identified in

Class 41. Because SNEEZING BABY PANDA is merely descriptive of some of the goods identified in Classes 9, 16, 21 and 28, and some of the services identified in Class 41, we must hold it to be merely descriptive of all of the goods and services identified in those classes. *Chamber of Commerce of the U.S.*, 102 USPQ2d at 1219 (“A mark need not be merely descriptive of all recited goods or services in an application. A descriptiveness refusal is proper ‘if the mark is descriptive of any of the [goods or services] for which registration is sought.’”), quoting, *In re Stereotaxis Inc.*, 429 F.3d 1039, 77 USPQ2d 1087, 1089 (Fed. Cir. 2005) (citations omitted). We are persuaded, based on the record, that when applied to Applicant’s goods in Classes 9, 16, 21 and 28, and services in Class 41, that the wording SNEEZING BABY PANDA immediately describes, without conjecture or speculation, a significant characteristic or feature of such goods and services, namely, that they feature information about, or take the form or shape of, a sneezing baby panda. Nothing requires the exercise of imagination, cogitation, mental processing or gathering of further information in order for prospective customers of Applicant’s identified goods and services to perceive readily the merely descriptive significance of the wording SNEEZING BABY PANDA as it pertains to these goods and services.

However, we reach the opposite conclusion with respect to the clothing identified in Class 25,<sup>17</sup> and the promotional services identified in Class 35, which clearly indicate that they are provided for others. Although we are not without doubt as to whether SNEEZING BABY PANDA may have descriptive meaning in either of

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<sup>17</sup> The clothing identified in Class 25 may reflect some ornamental use of the mark SNEEZING BABY PANDA. However, that issue is not before us.

those fields, we resolve that doubt in favor of Applicant.<sup>18</sup> *In re Merrill Lynch, Pierce, Fenner, and Smith Inc.*, 828 F.2d 1567, 4 USPQ2d 1141, 1144 (Fed. Cir. 1987).

Applicant does not dispute that a sneezing baby panda will be the subject matter of at least some of the digital media and various printed publications identified in Classes 9 and 16, or the films, television programs and theatrical productions identified in Class 41. And, as noted above, Applicant has admitted that the goods identified in Class 21, which include statues and sculptures, and the goods identified in Class 28, which includes stuffed toy animals, will take the form or shape of a sneezing baby panda. Indeed, Applicant specifically states “[a]s pointed out in previous responses, the subject matter content of some of Applicant’s goods or services may or may not include pandas ....”<sup>19</sup> However, Applicant’s main argument is that even if the goods and services pertain to pandas, “they may also have to do with other species of animals, nature and the environment, and the unique referent “Sneezing Baby Panda” is intended to be used by Applicant as a source indicator for its family of goods so branded.”<sup>20</sup>

That such goods and services may also feature other animals, nature and the environment does not transform the otherwise merely descriptive significance of the mark SNEEZING BABY PANDA into a non-merely descriptive mark when used on or in connection with the involved goods and services. Rather, because SNEEZING

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<sup>18</sup> We observe nonetheless that on a different record, such as might be adduced by a competitor in the field in an opposition proceeding, we might reach a different conclusion.

<sup>19</sup> App. Br. p. 15, 9 TTABVUE 19.

<sup>20</sup> *Id.*

BABY PANDA is merely descriptive for some of the goods and services in the aforementioned classes, as previously stated, we must hold it to be merely descriptive for all of the goods and services identified in those classes. *Chamber of Commerce of the U.S.*, 102 USPQ2d at 1219; *Stereotaxis*, 77 USPQ2d at 1089.

Applicant also contends that “the title is closely associated with Applicant as the maker of the Film Footage and the Movie ...”<sup>21</sup> and “[a]s is obvious from the amended identification of goods and services, the goods and services of Applicant may be anchored in the Movie as well as the Film Footage, promoting the mark ‘Sneezing Baby Panda’ as an indicator of source ...”<sup>22</sup> However, there is no evidence that “the title is closely associated with Applicant” other than Applicant’s claim in its brief and on its own website. Indeed, none of the other evidence of record mentions Applicant at all, let alone identifies Applicant as the source of the video clip.

To the extent Applicant is raising a “secondary source” argument or positing that SNEEZING BABY PANDA has acquired distinctiveness for any of its identified goods and services based on the movie and video clip, neither principal applies here. “Secondary source” arguments usually are raised in response to a refusal that the proposed mark is used in a merely ornamental fashion and therefore does not function as a mark, pursuant to Sections 1, 2 and 45 of the Trademark Act. That refusal is entirely different from the Section 2(e)(1) refusal here at issue. Further, Applicant has not amended its application to seek

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<sup>21</sup> App. Br. p. 18, 9 TTABVUE 22.

<sup>22</sup> App. Br. p. 15, 9 TTABVUE 19.

registration based on acquired distinctiveness pursuant to Section 2(f) of the Trademark Act, 15 U.S.C. § 1052(f).

In reaching our conclusion that SNEEZING BABY PANDA is merely descriptive of the goods identified in Classes 9, 16, 21 and 28, and the services identified in Class 41, we are cognizant of the dissent's opinion, which relies on *In re WNBA Enterprises LLC*, 70 USPQ2d 1153, 1156 (TTAB 2003). We distinguish that case, and do not find it persuasive here.

In *WNBA*, the Board found that “in the same manner that ‘ORLANDO MIRACLE’ is inherently distinctive when used in connection with the applicant’s entertainment services, namely, its basketball team, the mark is inherently distinctive when used in connection with applicant’s printed publications that feature information pertaining to the sport of basketball and featuring applicant’s basketball team.” The dissent argues that SNEEZING BABY PANDA is Applicant’s service mark, identifying its film production services, and reasons that this is a similar circumstance to *WNBA*. Thus, the dissent contends that Applicant’s intended use of SNEEZING BABY PANDA for the various collateral goods is not merely descriptive. However, this case differs from *WNBA* in that ORLANDO MIRACLE does not describe anything about the “entertainment services in the nature of presentations of women's basketball games” identified in that registration except that the basketball team is located in Orlando (which has been disclaimed as geographically descriptive). The word MIRACLE is arbitrary when used in conjunction with the identified entertainment services. It follows that if ORLANDO

MIRACLE is arbitrary with respect to the entertainment services, it also is arbitrary for the collateral merchandise, including printed materials about that team. By contrast, as discussed above, the designation SNEEZING BABY PANDA is merely descriptive of the subject matter of the films, television programs and theatrical productions with which it is intended to be used.

Finally, we note Applicant's argument that "its compound mark 'Sneezing Baby Panda' is not descriptive, because the combination of terms, composed of three two-syllable words, possesses a special rhythmic quality creating a unitary mark."<sup>23</sup> We do not find this argument persuasive. Even assuming, for the sake of argument, that SNEEZING BABY PANDA is unitary, as discussed above, the entirety of the phrase is merely descriptive for the goods identified in Classes 9, 16, 21 and 28 and the services identified in Class 41, and therefore remains unregistrable. *See, e.g., In re Boston Beer Co. L.P.*, 198 F.3d 1370, 53 USPQ2d 1056 (Fed. Cir. 1999) (laudatory unitary phrase THE BEST BEER IN AMERICA for beer and ale unregistrable).

**Decision:** The refusal to register Applicant's mark SNEEZING BABY PANDA pursuant to Section 2(e)(1) is affirmed as to Classes 9, 16, 21, 28 and 41 and reversed as to Classes 25 and 35. In addition, the refusals to register pursuant to Section 2.61 are reversed. As noted, this appeal did not involve the goods identified in Classes 3, 5 and 30. Applicant's mark accordingly will proceed to registration in Classes 3, 5, 25, 30 and 35.

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<sup>23</sup> App. Br. p. 19, 9 TTABVUE 23.

**Dissent By:**

Bergsman, J., dissenting.

The basis for the merely descriptive refusal is that the goods and services at issue feature images and/or information about a sneezing baby panda.<sup>24</sup> However, under the circumstances of this case, SNEEZING BABY PANDA is Applicant's service mark, not a descriptive term. Our holding in *In re WNBA Enterprises LLC*, 70 USPQ2d 1153, 1156 (TTAB 2003) is on point.

However, in the same manner that "ORLANDO MIRACLE" is an inherently distinctive trademark when it is used in conjunction with applicant's entertainment services, it is an inherently distinctive trademark for applicant's publications. "ORLANDO MIRACLE" is not merely descriptive of applicant's publications because it does not name the subject matter of them. To the contrary, whereas the subject matter of applicant's publications can be characterized as news about applicant's entertainment services, "ORLANDO MIRACLE" is the mark by which applicant identifies the source of the publications, in the same manner that it is the mark under which applicant renders its services. It is not the name of applicant's goods or applicant's services, nor is it a term which merely describes them.

Likewise, SNEEZING BABY PANDA is the mark by which Applicant identifies and intends to identify the source of its goods and services; it is not a term that merely describes them. Specifically, there is nothing inherent in the term SNEEZING BABY PANDA that conveys a significant quality, characteristic, function, ingredient, attribute or feature of the product or service in connection with which it is intended to be used. *See In re Colonial Stores, Inc.*, 157 USPQ at 384

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<sup>24</sup> 11 TTABVUE 10.

“One of the tests to determine whether a given mark is ‘merely descriptive’ under the Act is based upon what it would mean to the potential consumer when applied to applicant’s goods.”). For example, consumers encountering SNEEZING BABY PANDA brand “publications, namely, magazines, hand-outs and workbooks in the field of animals, nature and the environment” or “television programs and documentary films” will perceive SNEEZING BABY PANDA as a trademark, not a descriptive term, because when the terms of the mark are considered as a whole, they form a unique expression that without some analysis suggests that the content of Applicant’s goods and services may include a sneezing baby panda. In other words, consumers must make a mental leap from the mark to the product. The immediate impression evoked by the mark stimulates an association with the Internet video sensation created by Applicant. As such, on the record before us, the mark, along with the favorable suggestion which it evokes, functions as a trademark and not as a term which merely describes the goods and services.

The cases relied on by the Trademark Examining Attorney and the majority for the proposition that a mark that describes the subject matter of a television or similar entertainment program is merely descriptive of the program are inapplicable because SNEEZING BABY PANDA is an arbitrary phrase that does not describe any quality, characteristic, function, feature, purpose or use of the specified goods or services. For example, the Trademark Examining Attorney relies on *In re Conus Commc’ns Co.*, 23 USPQ2d 1717 (TTAB 1992), where the Board held that the term ALL NEWS CHANNEL is generic for a television channel

broadcasting all news because a viewer seeing that term would understand it as the apt descriptive language for a type of television channel. “The words chosen by applicants as their mark generically describe their broadcasting and production services of which the entire subject matter is the news.” *Id.* at 1719. The Trademark Examining Attorney also cites to THE WEATHER CHANNEL which was held to be a generic term for a television transmission whose subject matter exclusively concerns the weather. *In re Weather Channel, Inc.*, 229 USPQ 854 (TTAB 1986).

In the case before us, SNEEZING BABY PANDA is an arbitrary term that identifies Applicant’s creation. Thus, SNEEZING BABY is not merely descriptive.

To hold to the contrary would lead to the inequitable result that this applicant, as well as the owners of countless registrations for other marks covering their primary goods or services, could not register their marks in connection with printed materials relating to their primary goods or services without resorting to a claim of acquired distinctiveness under Section 2(f) of the Act.

*In re WNBA Enterprises LLC*, 70 USPQ2d at 1156.

In view of the foregoing, the mark SNEEZING BABY PANDA is not merely descriptive of the goods and services identified in the application and the refusal to register under Section 2(e)(1) of the Trademark Act should be reversed.