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Subject: U.S. TRADEMARK APPLICATION NO. 79144957 - ICE - I0455.20010U - Request for  
Reconsideration Denied - Return to TTAB - Message 1 of 7

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

**U.S. APPLICATION SERIAL NO.** 79144957

**MARK:** ICE



**CORRESPONDENT ADDRESS:**

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**GENERAL TRADEMARK INFORMATION:**

<http://www.uspto.gov/trademarks/index.jsp>

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**APPLICANT:** ICE IP S.A.

**CORRESPONDENT'S REFERENCE/DOCKET NO:**

I0455.20010U

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**REQUEST FOR RECONSIDERATION DENIED**

**ISSUE/MAILING DATE:** 11/6/2015

**INTERNATIONAL REGISTRATION NO. 1197874**

This Office action concerns applicant's response filed on October 16, 2015.

This application was refused under Trademark Act Section 2(a), 15 U.S.C. 1052(a), on the ground that it is deceptive.

Applicant was also required to enter a disclaimer of "ICE" on the ground that the word "ICE" is either descriptive of a feature of applicant's goods or, alternatively, deceptively misdescriptive of a feature of applicant's goods.

The trademark examining attorney issued a final Office action on October 1, 2014. On April 1, 2015, applicant responded by filing a notice of appeal to the Trademark Trial and Appeal Board (Board) and a request for reconsideration of the issues presented in the final Office action. The Board then suspended the appeal and remanded the application to the trademark examining attorney for consideration of the request.

Applicant's request indicated applicant's belief that the word "ICE" has acquired distinctiveness and thus a disclaimer of the word "ICE" is not required. The examining attorney indicated in a non-final Office action that "ICE" was generic in connection with applicant's goods or, alternatively, that applicant had failed to provide sufficient evidence that "ICE" had acquired distinctiveness.

Applicant's most recent response, which is considered a second request for reconsideration, provides further arguments and evidence against the Section 2(a) refusal and the disclaimer requirement. 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. §2.63(b)(3); TMEP §§715.03(a)(ii)(B), 715.04(a). The Section 2(a) refusal and the disclaimer requirement made final in the Office action dated October 1, 2014, are maintained and continue to be final. See TMEP §§715.03(a)(ii)(B), 715.04(a).

#### SECTION 2(a) REFUSAL – APPLIED-FOR MARK IS DECEPTIVE

Registration is refused because the applied-for mark consists of or includes deceptive matter in relation to the identified goods. Trademark Act Section 2(a), 15 U.S.C. §1052(a); see *In re Budge Mfg. Co.*, 857 F.2d 773, 8 USPQ2d 1259 (Fed. Cir. 1988); *In re Phillips-Van Heusen Corp.*, 63 USPQ2d 1047 (TTAB 2002); *In re Organik Techs., Inc.*, 41 USPQ2d 1690 (TTAB 1997); TMEP §1203.02.

A mark is deceptive if the following criteria are met:

- (1) The applied-for mark consists of or contains a term that misdescribes the character, quality, function, composition, or use of the goods.
- (2) Prospective purchasers are likely to believe that the misdescription actually describes the goods.
- (3) The misdescription is likely to affect a significant portion of the relevant consumers' decision to purchase the goods.

*See In re Budge*, 857 F.2d at 775, 8 USPQ2d at 1260; *In re White Jasmine LLC*, 106 USPQ2d 1385, 1391-92 (TTAB 2013); TMEP §1203.02(b); *see also In re Spirits Int'l, N.V.*, 563 F.3d 1347, 1353, 1356, 90 USPQ2d 1489, 1492-93, 1495 (Fed. Cir. 2009) (holding that the test for materiality incorporates a requirement that a "significant portion of the relevant consumers be deceived").

Based on evidence submitted in the previous Office actions, there is no doubt that, if the applied-for mark was "DIAMOND" or "DIAMONDS", it would be deceptive in connection with watches and jewelry that do not contain diamonds. *See, e.g., In re Boyle*, Serial No. 85741096 (TTAB Oct. 15, 2015), available at <http://ttabvue.uspto.gov/ttabvue/v?pno=85741096&pty=EXA&eno=25> (non-precedential) (DIAMONDS IN THE TROUGH and design deceptive in connection with "jewelry, namely, beaded bracelets and necklaces with and without crystals" that did not contain diamonds, and retail store services featuring the same). The evidence attached to this Office action further demonstrates that the misdescription is likely to affect a significant portion of watch and jewelry purchasers' decision to purchase such goods.

Thus, the only issue left to be resolved is whether the word "ICE", which is a slang term for diamonds, is also deceptive in connection with watches and jewelry that do not contain diamonds.

The examining attorney has previously attached a representative sample of dictionary entries, Internet evidence, and articles from the LexisNexis® database demonstrating that "ice" is a commonly-used slang term for diamonds. *See also*:

- The Online Slang Dictionary, <http://onlineslangdictionary.com/meaning-definition-of/ice> (defining "ice" as "diamond-containing jewelry")

- Yahoo! Answers, <https://answers.yahoo.com/question/index?qid=20100127215016AAu7kV8> (users stating that “ice” means “diamonds”)
- Nicole Perrin, *Nuthin’ but a Lit Thang, Baby: A Reader’s Guide to Rap Genius* (Jul, 2, 2013), <http://bookriot.com/2013/07/02/nuthin-but-a-lit-thang-baby-a-readers-guide-to-rap-genius/> (“While just about everyone knows at this point that ‘ice’ refers to diamonds ....”)
- Aucoin Hart Jewelers, <http://aucoinhart.com/education/diamond-education/ah-diamond/> (“Fancy shapes that are routinely rejected from an Aucoin Hart selection include diamonds that do not possess a discernibly crisp facet pattern (sometimes called “cracked ice”) ....”)
- Cindy Hartman, *Do You Keep Your Ice On Ice By .....???*, <http://www.hartmaninventory.com/blog/do-you-keep-your-ice-on-ice-by/> (“Do you keep your ice, or diamonds as they are more commonly known, in an ice cube tray or bin?”)
- Kelefa Sanneh, *Snowman Shirts’ Hidden Drug Message Raises Alarm* (Nov. 13, 2005), [http://www.utsandiego.com/uniontrib/20051113/news\\_1c13snowman.html](http://www.utsandiego.com/uniontrib/20051113/news_1c13snowman.html) (“Some listeners might be willing to accept Jeezy's deadpan explanation that he calls himself the snowman because of all his ice, or diamonds.”)
- Megan Ann Wilson, *Whisky, Style and Soul – Welcome to the Wiseroom*, <http://meganannwilson.tumblr.com/> (“And please, no watch should have more ‘ice’ than your drink. ‘Ice’ or diamonds on both watches and worn as jewelry are the worst investment you can make, a simple gold chain or watch lasts forever and shows you’re in it for the long haul unlike ice which is an immediate red flag.”)
- *Hey, Can I Get Some of That Ice?* (Feb. 3, 2005), <http://ericsnews.blogspot.com/> (“He gave a paralyzed teenager his ‘ice’ or diamonds, on his necklace.”)
- ShanOre, <https://www.shanore.com/blog/dot-cross-ts/> (“If you like ‘ice’ or diamonds then this necklace is the one for you.”)
- Mike Cecchini & John Saavedra, *Mr. Freeze: The Ice Cold Star of TV, Movies, and Video Games* (Feb. 26, 2014), <http://www.denofgeek.us/books-comics/mr-freeze/232879/mr-freeze-the-ice-cold-star-of-tv-movies-and-video-games> (“In true Batman villain fashion, he made heisting diamonds (or ‘ice’) his criminal profession, and he was behind bars by the end of his brief first adventure.”)
- *The 10 Best Lines From Rick Ross' "God Forgives, I Don't"*, <http://www.complex.com/music/2012/07/the-10-best-lines-from-rick-ross-god-forgives-i->

[dout/so-sophisticated](#) (“With a chain full of diamonds, or ‘ice,’ his status as a baller is brightly established.”)

- Megan Wilson, *Iman Shumpert’s Iced Out Grill* (Nov. 20, 2014), <http://www.hesuitshescores.com/nba-style-file-iman-shumperts-yellow-diamond-grill/> (“Diamonds (or ice) has fallen out of favour in recent years due to the cost and quite frankly, it’s often tacky.”)
- Brian Wikerson, *Is Rap Literature?*, <http://brianwikerson.tripod.com/briansonlineportfolio/id4.html> (“By saying this, Ali conveys the large number of diamonds, or ice, that he possesses.”)
- Sonix Electronix, [http://www.sonicelectronix.com/item\\_80425\\_SMS-Audio-Frosted-Headphone-Stand-SMS-STAND-FROSTED.html](http://www.sonicelectronix.com/item_80425_SMS-Audio-Frosted-Headphone-Stand-SMS-STAND-FROSTED.html) (“Seems everyone is rappin’ these days about money, and diamonds or ‘ice’. While we aren’t offering any diamonds here, we do happen to have newest addition to the SMS Audio by 50 Cent Arsenal.”)

Since “ICE” is a commonly-used slang term for diamonds, and since use of the word “DIAMONDS” in connection with watches and jewelry that do not contain diamonds is deceptive, the word “ICE”, when used in connection with applicant’s goods, is also deceptive.

Applicant’s main argument against the refusal is that consumers would not think its goods, which applicant alleges are sold for under \$100, contain diamonds. This argument is unpersuasive because, as the following evidence demonstrates, watches containing diamonds are sold for less than \$100:

- Jet, <https://jet.com/>
- World of Watches, <http://www.worldofwatches.com/>
- JC Penny, <http://www.jcpenney.com/>
- Belk, <http://www.belk.com/>
- Lord & Taylor, <http://www.lordandtaylor.com/>
- The Bradford Exchange Online, <http://www.bradfordexchange.com/>

- Dillard's, <http://www.dillards.com/>
- Newegg, <http://www.newegg.com/>
- Jomashop, <http://www.jomashop.com/>
- Walmart, <http://www.walmart.com/>

Furthermore, the following evidence demonstrates that diamond jewelry is offered for under \$100:

- Helzberg Diamonds, <https://www.helzberg.com/product/earrings+2118979.do?sortBy=bestSellersAscend&catId=2513&from=fn>
- Ice, <https://www.ice.com/giftguide/under-100/?sort=6&size=72&page=1&subcategories=Diamond%20Rings>
- Kay Jewelers, <http://www.kay.com/en/kaystore/diamonds---gemstones/stackable-ring-diamond-accent-sterling-silver/100020/100020.100021.100025>
- Zales, <http://www.zales.com/diamond-accent-fashion-band-sterling-silver/product.jsp?productId=4421798>

Applicant also argues that other marks containing the word “ICE” have been registered for similar goods. Such registrations do not control on the issue of deceptiveness, as neither the Trademark Examining Operation nor the Trademark Trial and Appeal Board are bound by past decisions of the Trademark Examining Operation. *In re Shapely, Inc.*, 231 USPQ 72, 75 (TTAB 1986). For example, the examining attorney is attaching ten (10) third-party registrations for marks containing the word “DIAMOND” or “DIAMONDS” used in connection with jewelry and/or watches. These marks all registered despite the fact that the identifications do not indicate that the goods contain diamonds and the Board has found use of the word “DIAMOND” or “DIAMONDS” in connection with jewelry and/or watches that do not contain diamonds to be deceptive. Therefore, applicant’s reliance on previously-registered marks containing the word “ICE” is misplaced.

Applicant also argues that it owns registrations for marks containing the word “ICE”. However, the mere reference to registrations does not make such registrations part of the record. *In re Promo Ink*, 78 USPQ2d 1301, 1304 (TTAB 2006); TBMP §1208.02; TMEP §710.03. To make registrations part of the record, an applicant must submit copies of the registrations, or the complete electronic equivalent from the USPTO’s automated systems, prior to appeal. *In re Jump Designs LLC*, 80 USPQ2d 1370, 1372-73 (TTAB 2006); *In re Ruffin Gaming*, 66 USPQ2d, 1924, 1925 n.3 (TTAB 2002); TBMP §1208.02; TMEP §710.03. Since applicant has not provided its registrations, they have not been considered.

Moreover, applicant’s reference to a published application is unpersuasive because an application shows nothing more than applicant is seeking registration for wording and has no persuasive value.

Applicant should also note that an application for a mark that was approved for publication or even a mark that has registered that was filed under the Madrid Protocol is of even less probative value due to the particularities associated with examining a request for extension of protection. Under §68(c) of the Trademark Act, 15 U.S.C. §1141h(c), and Article 5 of the Madrid Protocol, the USPTO must notify the International Bureau (“IB”) of any refusal entered in a Section 66(a) application within 18 months of the date the IB transmits the request for extension of protection to the USPTO. TMEP §1904.02(g). If the USPTO does not send a notification of refusal of the request for extension of protection to the IB within 18 months, the request for extension of protection cannot be refused. 15 U.S.C. §1141h(c)(4); Article 5(5); Common Reg. 17(2)(iv). If the USPTO sends a notification of refusal, no grounds of refusal other than those set forth in the notice can be raised more than 18 months after the date on which the IB forwards the request for extension of protection to the USPTO. 15 U.S.C. §1141h(c)(3). If, upon re-examination, the examining attorney determines a new ground of refusal exists, a second Office action raising this new ground may be issued only if time remains in the 18-month period. *See* TMEP §1904.03(a).

A request for extension of protection for Application Serial No. 79117436 was sent to the USPTO on July 10, 2012, meaning all refusals and requirements concerning that application had to be made by January 10, 2014. On January 10, 2014, the mark had not been approved for publication such that it could be reviewed by the USPTO’s *Official Gazette* reviewers to ensure that the examining attorney had not missed any outstanding issues, even issues of clear error. Thus, when that application was finally approved for publication on July 1, 2015, the USPTO could not require any further refusals or requirements be made, even if allowing the registration of the mark would constitute clear error.

The request for extension of protection of the applied-for mark was not received until April 10, 2014. Thus, the undersigned examining attorney also could not inform the examining attorney assigned to

Application Serial No. 79117436 of the missed deceptiveness issue because the time period for issuing all refusals and requirements had passed. As such, applicant's reliance on an application that was approved for publication is not probative because the USPTO may have had no choice under the relevant law but to approve that application for publication, despite the fact that doing so would constitute clear error. The USPTO will not continue to compound the error, however, by issuing another registration for a deceptive mark.

#### DISCLAIMER REQUIRED

Applicant must enter a disclaimer of the word "ICE" because "ICE" is a slang term for diamonds, and thus "ICE" is the name of a key feature or characteristic of applicant's goods. As such, the word "ICE" is generic and can never acquire distinctiveness.

If it is determined that "ICE" is not generic but is instead descriptive, applicant's evidence is insufficient to demonstrate that this highly descriptive has acquired distinctiveness, especially since third parties use the word "ICE" in their own marks for similar goods (which applicant's own evidence of third-party registrations demonstrates).

If applicant's goods do not contain diamonds, then use of the word "ICE" in connection with those goods, if it is determined not to be deceptive because it is not a material factor for consumers when purchasing the goods, is deceptively misdescriptive. Deceptively misdescriptive marks may be registered under Section 2(f); however, given the highly misdescriptive nature of the word "ICE" in connection with applicant's goods, applicant's evidence is insufficient to demonstrate that "ICE" has acquired distinctiveness.

Applicant should submit a disclaimer in the following standardized format:

**No claim is made to the exclusive right to use "ICE" apart from the mark as shown.**

TMEP §1213.08(a)(i); see *In re Owatonna Tool Co.*, 231 USPQ 493, 494 (Comm'r Pats. 1983).

Failure to comply with a disclaimer requirement can result in a refusal to register the entire mark. *See In re Stereotaxis Inc.*, 429 F.3d 1039, 1040-41, 77 USPQ2d 1087, 1088-89 (Fed. Cir. 2005); TMEP §1213.01(b).

CASE RETURNED TO TTAB FOR RESUMPTION OF APPEAL

Applicant's request has not resolved all the outstanding issues, nor does it raise a new issue or provide any new or compelling evidence with regard to the outstanding issues 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 for reconsideration is *denied*.

Applicant has filed a timely notice of appeal with the Board, and the Board will be notified to resume the appeal. *See* TMEP §715.04(a).

/Andrew Leaser/

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