

ESTTA Tracking number: **ESTTA440821**

Filing date: **11/14/2011**

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

Proceeding	85013287
Applicant	Source Interlink Magazines, LLC
Applied for Mark	SURFER
Correspondence Address	SCOTT J SPOONER SOURCE INTERLINK MAGAZINES LLC 831 SOUTH DOUGLAS STREET EL SEGUNDO, CA 90245-4928 UNITED STATES trademark@sorc.com
Submission	Appeal Brief
Attachments	SURFER-appealbrief-11-14-11.pdf (2 pages)(21323 bytes)
Filer's Name	Scott J. Spooner
Filer's e-mail	trademark@sorc.com, elizabeth.valenciano@sorc.com
Signature	/Scott J. Spooner/
Date	11/14/2011

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

Applicant: Source Interlink Magazines, LLC

Serial No.: 85/013287

Filed: April 13, 2010

Mark: SURFER

Examiner: Tracy L. Cross

APPEAL BRIEF

I. Introduction

Source Interlink Magazines, LLC (“Applicant”) hereby appeals the Examiner’s final decision refusing to register the mark SURFER (Serial No. 85/013287) in International Class 025 for “Fleece pullovers; Footwear; Headbands; Headwear; Hooded sweat shirts; Jackets; Jogging pants; Shorts; Sports pants; T-shirts; Wrist bands” (the “Application”). The Examiner refused to register the mark SURFER on the Principal Register on the ground that such mark is descriptive. Applicant respectfully requests that the Board reconsider the final refusal and instead permit the registration of SURFER in Class 25.

II. Argument

For the reasons set forth below, Applicant submits that the Examiner erred in refusing to allow the Application to proceed to registration.

A. The Mark is Not Descriptive.

A term is descriptive if it describes with some particularity an immediate idea of the ingredients, qualities, or characteristics of the goods (or services). See In re Entemann’s Inc., 15 USPQ2d 1750 (T.T.A.B. 1990). In this instance, the mark SURFER does not describe a feature or characteristic of the apparel on which the mark will be placed. The apparel on which the mark will be placed is not for use in connection with surfing and is not designed for surfers. Anyone can wear this apparel in any context and for any reason. The apparel is not designed to be worn while surfing nor is the apparel manufactured with the interests of surfers in mind. Accordingly, the mark SURFER as used on the relevant goods does not constitute a descriptive mark.

B. The Mark is Arbitrary.

The mark SURFER more properly should be deemed an arbitrary mark. An arbitrary mark is a mark that, when used with the goods or services in issue, neither suggests nor describes any ingredient, quality, or characteristic of those goods or services. McGregor-Doniger, Inc. v.

Drizzle, Inc., 599 F.2d 1126 (2nd Cir. 1979). The concept of arbitrariness means that the ordinary meaning of the word mark is applied to the goods or services in a totally arbitrary and non-descriptive sense. See McCarthy on Trademarks, §11:11 (Distinctiveness of Marks). For example, the common word “apple” when applied to personal computers constitutes an arbitrary use of the word “apple” as it has no connection to the characteristics or ingredients of the personal computers. When used on or in association with the apparel in question, the mark SURFER constitutes an arbitrary mark in the same way that “apple” constitutes an arbitrary mark when used in association with personal computers.

C. Other Examiners Have Found That SURFER is Not Descriptive.

Other PTO examiners have concluded that SURFER is non-descriptive when the mark is used on goods having no connection to the sport or surfing or the surfing industry generally. Applicant has received a Notice of Allowance on the following applications for the mark SURFER including one application specifically in Class 025 for apparel:

- (1) U.S. Serial No. 85/017584 in Class 009 for Watches;
- (2) U.S. Serial No. 85/017441 in Class 009 for Eyewear;
- (3) U.S. Serial No. 85/013301 in Class 018 for Sling bags; and
- (4) U.S. Serial No. 85/017452 in Class 025 for Children's and infant's apparel, namely, t-shirts, one-piece garments, short sets, sweat suits, shirt and pant sets, shorts, pants, dresses, jumpers, hooded sweatshirts, sweat pants, overalls, sleepwear, pajamas, cloth bibs, hats, rompers, socks, booties, and shoes.

III. Conclusion

For the foregoing reasons, Applicant submits that the mark SURFER as used on the apparel in question is not descriptive and is therefore eligible for registration on the Principal Register.