

Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	85013287
LAW OFFICE ASSIGNED	LAW OFFICE 109
MARK SECTION (no change)	
ARGUMENT(S)	
<p>The Examiner has issued a final refusal to register on the Principle Register the mark SURFER on the ground that such mark is descriptive. For the reasons set forth below, Applicant Source Interlink Magazines, LLC (“Applicant”) respectfully requests that the Examiner reconsider the final refusal and instead permit the registration of SURFER in Class 25.</p> <p>1. <u>The Mark is Not Descriptive.</u> 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 <u>In re Entemann’s Inc.</u>, 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 reason. The apparel is not designed to be worn while surfing nor is the apparel manufactured with the interests of surfers in mind.</p> <p>2. <u>The Mark is Arbitrary.</u> 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. <u>McGregor-Doniger, Inc. v. Drizzle, Inc.</u>, 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 <u>McCarthy on Trademarks</u>, §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.</p> <p>3. <u>Other Examiners Have Found That SURFER is Not Descriptive.</u> Applicant has received a Notice of Allowance on the following applications for the mark SURFER including one application specifically in Class 025 for apparel:</p> <p>(a) U.S. Serial No. 85/017584 in Class 009 for Watches;</p> <p>(b) U.S. Serial No. 85/017441 in Class 009 for Eyewear;</p> <p>(c) U.S. Serial No. 85/013301 in Class 018 for Sling bags; and</p> <p>(d) 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</p>	

sweatshirts, sweat pants, overalls, sleepwear, pajamas, cloth bibs, hats, rompers, socks, booties, and shoes.

Conclusion: Therefore, 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.

SIGNATURE SECTION

RESPONSE SIGNATURE

/Scott J. Spooner/

SIGNATORY'S NAME

Scott J. Spooner

SIGNATORY'S POSITION

Vice President, Corporate Counsel - Intellectual Property

DATE SIGNED

08/08/2011

AUTHORIZED SIGNATORY

YES

CONCURRENT APPEAL NOTICE FILED

YES

FILING INFORMATION SECTION

SUBMIT DATE

Mon Aug 08 17:13:46 EDT 2011

TEAS STAMP

USPTO/RFR-69.163.52.62-20
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0808170902902183

Request for Reconsideration after Final Action To the Commissioner for Trademarks:

Application serial no. **85013287** has been amended as follows:

ARGUMENT(S)

In response to the substantive refusal(s), please note the following:

The Examiner has issued a final refusal to register on the Principle Register the mark SURFER on the ground that such mark is descriptive. For the reasons set forth below, Applicant Source Interlink Magazines, LLC ("Applicant") respectfully requests that the Examiner reconsider the final refusal and instead permit the registration of SURFER in Class 25.

1. 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 reason. The apparel is not designed to be worn while surfing nor is the apparel manufactured with the interests of surfers in mind.

2. 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.

3. Other Examiners Have Found That SURFER is Not Descriptive. Applicant has received a Notice of Allowance on the following applications for the mark SURFER including one application specifically in Class 025 for apparel:

- (a) U.S. Serial No. 85/017584 in Class 009 for Watches;
 - (b) U.S. Serial No. 85/017441 in Class 009 for Eyewear;
 - (c) U.S. Serial No. 85/013301 in Class 018 for Sling bags; and
 - (d) 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.
- Conclusion: Therefore, 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.

SIGNATURE(S)

Request for Reconsideration Signature

Signature: /Scott J. Spooner/ Date: 08/08/2011

Signatory's Name: Scott J. Spooner

Signatory's Position: Vice President, Corporate Counsel - Intellectual Property

The signatory has confirmed that he/she is not represented by either an authorized attorney or Canadian attorney/agent, and that he/she is either (1) the applicant or (2) a person(s) with legal authority to bind the applicant; and if an authorized U.S. attorney or Canadian attorney/agent previously represented him/her in this matter, either he/she has filed a signed revocation of power of attorney with the USPTO or the USPTO has granted the request of his/her prior representative to withdraw.

The applicant is filing a Notice of Appeal in conjunction with this Request for Reconsideration.

Serial Number: 85013287

Internet Transmission Date: Mon Aug 08 17:13:46 EDT 2011

TEAS Stamp: USPTO/RFR-69.163.52.62-20110808171346171

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