

**THIS OPINION IS NOT A
PRECEDENT OF THE TTAB**

Hearing: November 28, 2012

Mailed: February 19, 2013

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re VOX Media Inc.

Serial No. 85085395

Michael A. Grow, Douglas R. Bush, Jason J. Mazur and Anthony D. Peluso of Arent Fox LLP for VOX Media Inc.

Alain J. Lapter, Trademark Examining Attorney, Law Office 108 (Andrew Lawrence, Managing Attorney).

Before Holtzman, Lykos and Greenbaum, Administrative Trademark Judges.

Opinion by Lykos, Administrative Trademark Judge:

VOX Media Inc. (“applicant”) filed an application to register the mark displayed below



for “on-line journals, namely, blogs featuring sports; providing information in the field of sports” in International Class 41.¹ The description of the mark is as follows: “The mark consists of the wording 'MMA FIGHTING.COM' in stylized letters.”

The Trademark Examining Attorney refused registration of applicant’s mark under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), on the ground that the mark is merely descriptive of applicant’s identified services. During *ex parte* prosecution, applicant conceded that the wording in its mark is merely descriptive and disclaimed "MMA FIGHTING.COM" apart from the mark as shown. Thus, the sole issue on appeal is whether the stylization of applicant’s mark renders it inherently distinctive.² For the reasons explained below, we find that this element

¹ Application Serial No. 85085395, filed June 15, 2010 pursuant to Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a). The application alleges December 17, 2009 as the date of first use anywhere and in commerce.

² During *ex parte* prosecution, applicant claimed acquired distinctiveness of the mark under Trademark Act Section 2(f) based on five years substantially exclusive and continuous use of the mark in commerce. The examining attorney correctly noted that applicant’s allegation of five years use in commerce preceded applicant’s asserted date of first use of the mark in commerce by several years, and that applicant could clarify this discrepancy by amending the dates of use or providing evidence of use in commerce dating back five years. In addition, the examining attorney required actual evidence of acquired distinctiveness (e.g., sales figures, advertising expenditures), finding that the applied-for mark is highly descriptive of applicant’s services. Applicant responded by disclaiming the entirety of the wording in the mark without providing any actual evidence in support of its Section 2(f) claim. The examining attorney made final the refusal to register the mark pursuant to Section 2(e)(1), finding that applicant’s evidence of acquired distinctiveness was insufficient, and the degree of stylization was not significant to “carry” the mark with the wording disclaimed. Although applicant did not expressly withdraw its amendment to Section 2(f) during *ex parte* prosecution, applicant did not address the issue of acquired distinctiveness in either its request for reconsideration or its appeal brief. However, at oral hearing, counsel for applicant clarified that applicant seeks to register the mark on the Principal Register without a claim as to Section 2(f). We therefore deem the amendment to Section 2(f) withdrawn.

does not render applicant's mark inherently distinctive, and therefore affirm the examining attorney's refusal to register under Section 2(e)(1).

Before discussing the substantive merits of this appeal, we address a procedural matter. On March 1, 2012, applicant filed with the Trademark Examining Operations ("TMEO") a motion to amend the description of the mark to the following: "The mark consists of the wording 'MMA FIGHTING.COM' in stylized letters, and the letters 'MMA' are stylized to resemble the fingers and knuckles of clenched fists, the columns of an arena or coliseum, and the sharp edges of blades or knives." It was improper for applicant to file the motion with the TMEO. Because jurisdiction had been restored to the Board following the examining attorney's denial of applicant's request for reconsideration, applicant should have filed a request for remand with the Board with the requisite showing of good cause. *See* TBMP § 1209.04 (3d ed. rev. 2012). Accordingly, applicant's motion is denied.

In any event, applicant's description of the mark is not binding upon our determination since "[a] mark's meaning is based on the impression actually created by the mark in the minds of consumers, not on the impression that the applicant states the mark is intended to convey." TMEP § 808.02 (Oct. 2012) (giving the examining attorney the discretion to decide when to defer to the applicant's phrasing of a description of the mark).

We turn now to the substantive merits of this appeal. Applicant argues that the "eye-catching stylization" of the mark's wording creates a distinctive commercial impression apart from the disclaimed wording. More specifically, applicant argues

that the letters “MMA” evoke “a great deal of imagery” (Applicant’s Brief, p. 8) to represent the following:

The white portion of the letter “A” is clearly a thumb with the thumbnail showing. The white portions of the M are clearly the fingers of two clenched fists. The black portions also resemble the columns of an arena or temple. And the black portions also resemble blades such as those used in a box cutter, utility knife, or Samurai sword.

Applicant’s Brief, p. 5. Applicant also points to several registered third-party marks as evidence that its mark is equally if not more stylized, and therefore inherently distinctive. In addition, applicant analogizes to the case law regarding double entendres to argue that because applicant’s mark is subject to various interpretations, it is inherently distinctive. The examining attorney, however, maintains that applicant’s mark is not inherently distinctive because applicant has merely used a non-traditional font, and has not replaced any letters or words with a design element.

It is well settled that when words which are merely descriptive, and hence unregistrable, are presented in a distinctive design, the design may render the mark as a whole registrable, provided that the words are disclaimed under Section 6 of the Trademark Act. *See In re Venturi, Inc.*, 197 USPQ 714 (TTAB 1977); *In re Jackson Hole Ski Corp.*, 190 USPQ 175 (TTAB 1976) (“*Jackson Hole*”). The proper inquiry here is whether the stylization of the lettering creates “a separate and inherently distinctive commercial impression apart from the word itself, such that the mark as a whole is not merely descriptive.” *In re Sadoru Group, Ltd.*, 105 USPQ2d 1484, 1485 (TTAB 2012) (“*Sadoru Group*”). Both applicant and the

Serial No. 85085395

examining attorney discuss various cases in support of their respective positions. See for example *Jackson Hole; In re Bonni Keller Collections, Ltd.*, 6 USPQ2d 1224 (TTAB 1987) (“*Bonni Keller*”); *In re Miller Brewing Co.*, 226 USPQ 666 (TTAB 1985) (“*Miller Brewing*”); and *In re Clutter Control, Inc.*, 231 USPQ 588 (TTAB 1986). The cases upon which applicant relies are either factually and legally dissimilar from the present case or inapposite. For example, in the *Jackson Hole* case, applicant applied to register the mark shown below



with a disclaimer of the wording JACKSON HOLE. The examining attorney refused registration of the mark as primarily merely geographically descriptive. The Board reversed the refusal to register, agreeing with the applicant’s position that “its mark consists not only of the mere geographical designation but also of the letters ‘JH’ displayed in a distinctive and prominent fashion so as to create a commercial impression in and of themselves...” *Jackson Hole*, 190 USPQ at 176. In particular, applicant persuasively argued

that the letters “JH” are twice the size of the other letters; that unlike any of the other letters, they are partly joined together, creating the visual impression of a monogram; and that they are set down from the rest of the letters, which positioning has the effect of highlighting the “JH” couplet.

Id. The underlying logic of *Jackson Hole* is not present in the mark before us. The letters in applicant’s mark are not arranged in a manner that creates a separate

and inherently distinctive commercial impression similar to the “JH” monogram. In addition, as the examining attorney further explains in her brief:

Using the reasoning in the JACKSON HOLE case, a mark may be registrable if the stylized font offsets a portion of a mark giving that portion of a mark a uniquely distinct commercial impression apart from the rest of the mark. The highlighted JH portion, unlike the MMA portion in the mark at issue herein, was not descriptive as applied to the services.

Another case applicant relies upon, *Miller Brewing, supra*, is inapposite here because it involved a different legal posture. In that case, the Board found that the subject mark was not inherently distinctive but registrable on the Principal Register only upon a showing of acquired distinctiveness under Section 2(f). In other words, the issue was “whether the evidence submitted by applicant is sufficient to show that applicant's configuration of ‘LITE’ does in fact function as a trademark.” *Miller Brewing*, 226 USPQ at 669 (finding that “applicant has used the mark for more than ten years, and applicant's sales and advertising of goods bearing the mark have been massive.”). By contrast, in the case before us, applicant does not seek registration under Section 2(f); rather the question here is whether the stylization of applicant’s mark is inherently distinctive.

While acknowledging that inquiries of this type are subjective and fact specific, in this case, we also disagree with applicant’s reliance on *Bonni Keller*. In that case the Board found that the presentation of the mark

La Lingerie


was “rather ordinary” and nondistinctive. *Bonni Keller*, 6 USPQ2d at 1227. Applicant compares its mark to the LA LINGERIE mark to argue that it is “more fanciful, eye catching and imaginative.” *Id.* We disagree. We acknowledge that the lettering in applicant’s mark is displayed in a stylized font with sharp, angular lines. However, we do not find that the stylization resembles, as applicant asserts, two punching fists, or calls to mind “the columns of an arena or coliseum” or “blade or knives.” Applicant’s Brief, p. 8. In addition, applicant has not taken into account the Board’s determinations involving the following marks which were found to be insufficiently stylized and therefore not inherently distinctive as summarized in *Sadoru Group, supra*:

microwdenier



Serial No. 85085395

See In re Guilford Mills, Inc., 33 USPQ2d 1042 (TTAB 1994); *In re Project Five, Inc.*, 209 USPQ 423 (TTAB 1980).

Moreover, the recently registered  marks applicant points to (Registration Nos. 2924607, 2717743, 2711602, 2381677, and 332475) all contain a separate and distinct design element depicting a stylized compact disc and therefore are factually dissimilar. Simply put, we do not find that the level of stylization in applicant's mark creates a separate and inherently distinctive commercial impression apart from the wording itself.

As to applicant's analogy to the case law regarding double entendres, we do not find that persuasive here. Those cases pertain to words or expressions capable of more than one meaning, not designs. Accordingly, they are not on point.

The determination regarding whether stylization is sufficient to carry a mark is "in the eyes of the beholder," *Jackson Hole*, 190 USPQ at 176, and "a necessarily subjective one." *Bonni Keller*, 6 USPQ2d at 1227. We find that the impression conveyed by applicant's mark is not separate from the disclaimed wording in the mark. Accordingly, we do not find the mark as a whole to be inherently distinctive.

Decision: The refusal to register under Section 2(e)(1) is affirmed.