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**UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)**

**U.S. APPLICATION SERIAL NO.** 85206022

**MARK:** TOWEL & TOWEL



**CORRESPONDENT ADDRESS:**

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THE TRADEMARK COMPANY

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**GENERAL TRADEMARK INFORMATION:**

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

**TTAB INFORMATION:**

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

**APPLICANT:** COLAKEL, KEMAL

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

N/A

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**EXAMINING ATTORNEY'S APPEAL BRIEF**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant: Kemal Colakel : BEFORE THE  
Trademark: TOWEL & TOWEL : TRADEMARK TRIAL  
Serial No: 85206022 : AND  
Attorney: Matthew H. Swyers, Esq. : APPEAL BOARD  
Address: The Trademark Company : ON APPEAL  
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The applicant has appealed the trademark examining attorney's final refusal to register the mark TOWEL & TOWEL in stylized form which will be used on "Bath towels; Beach towels; Children's towels; Compressed towels; Curtains and towels; Face towels; Face towels of textiles; Football towels; Golf towels; Hand towels; Hand towels of textile; Hand-towels made of textile fabrics; Hooded towels; Household linen, including face towels; Japanese cotton towels (tenugui); Kitchen towels; Large bath towels; Moisture absorbent microfiber textile fabrics for use in the manufacture of athletic apparel, namely, shirts, pants, shorts, jackets, bags, towels and athletic uniforms; Quilts of towels; Tea towels; Terry towels; Towel sets; Towel sheet; Towelling coverlets; Towels; Towels; Towels made of textile materials; Towels that may be worn as a dress or similar garment; Turkish towel" in International Class

24. The examining attorney refuses registration on the Principal Register because the applied-for mark merely describes the goods. Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1); TMEP §1209 *et seq.*

### **ISSUE**

The sole issue on appeal is whether the applicant's mark, TOWEL & TOWEL, is merely descriptive of the applicant's goods under Trademark Act §2(e)(1).

### **FACTS**

On December 30, 2010, applicant sought to register the applied-for mark, TOWEL & TOWEL in stylized form, for "Bath towels; Beach towels; Children's towels; Compressed towels; Curtains and towels; Face towels; Face towels of textiles; Football towels; Golf towels; Hand towels; Hand towels of textile; Hand-towels made of textile fabrics; Hooded towels; Household linen, including face towels; Japanese cotton towels (tenugui); Kitchen towels; Large bath towels; Moisture absorbent microfiber textile fabrics for use in the manufacture of athletic apparel, namely, shirts, pants, shorts, jackets, bags, towels and athletic uniforms; Quilts of towels; Tea towels; Terry towels; Towel sets; Towel sheet; Towelling coverlets; Towels; Towels; Towels made of textile materials; Towels that may be worn as a dress or similar garment; Turkish towel" in International Class 24. On March 28, 2011, an office action was issued in which registration was refused under Trademark Act §2(e)(1) on the grounds that the mark is merely descriptive of the goods.

On September 27, 2011, applicant filed a response to the office action traversing the refusal. The refusal to register under Trademark Act §2(e)(1) was made final on November 4, 2011. A Request for Reconsideration was filed by the applicant on May 4, 2012. The final refusal to register was maintained and continued on July 7, 2012 and this appeal ensued.

### **ARGUMENTS**

A mark is merely descriptive if it describes an ingredient, quality, characteristic, function, feature, purpose, or use of an applicant's goods. TMEP §1209.01(b); *see, e.g., DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 1251, 103 USPQ2d 1753, 1755 (Fed. Cir. 2012) (quoting *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 1173, 71 USPQ2d 1370, 1371 (Fed. Cir. 2004)); *In re Steelbuilding.com*, 415 F.3d 1293, 1297, 75 USPQ2d 1420, 1421 (Fed. Cir. 2005) (citing *Estate of P.D. Beckwith, Inc. v. Comm'r of Patents*, 252 U.S. 538, 543 (1920)).

The applied-for mark in this case is TOWEL & TOWEL, in stylized form, for use on a variety of different types of towels, specifically "Bath towels; Beach towels; Children's towels; Compressed towels; Curtains and towels; Face towels; Face towels of textiles; Football towels; Golf towels; Hand towels; Hand towels of textile; Hand-towels made of textile fabrics; Hooded towels; Household linen, including face towels; Japanese cotton towels (tenugui); Kitchen towels; Large bath towels; Moisture absorbent microfiber textile fabrics for use in the manufacture of athletic apparel, namely, shirts, pants, shorts, jackets, bags, towels and athletic uniforms; Quilts of towels; Tea towels; Terry towels; Towel sets; Towel sheet;

Towelling coverlets; Towels; Towels; Towels made of textile materials; Towels that may be worn as a dress or similar garment; Turkish towel.”

Because the goods are towels, the word “towel” is descriptive of the goods. A mark comprised of a repeated descriptive term may be merely descriptive where no new or different commercial impression results from the repetition. *See In re Tires, Tires, Tires, Inc.*, 94 USPQ2d 1153 (TTAB 2009) (holding TIRES TIRES TIRES generic for retail tire store services); *In re Litehouse, Inc.*, 82 USPQ2d 1471, 1474-75 (TTAB 2007) (holding CAESAR! CAESAR! merely descriptive for salad dressing); *In re Disc Jockeys, Inc.*, 23 USPQ2d 1715, 1716 (TTAB 1992) (holding DJDJ merely descriptive for disc jockey services for parties – “[n]othing new or different is imparted by the simple repetition of the descriptive expression DJ”); TMEP §1209.03(t).

Applicant has inserted an ampersand between the words TOWEL and TOWEL. However, adding punctuation marks to a descriptive term will not ordinarily change the term into a non-descriptive one. *In re Vanilla Gorilla, L.P.*, 80 USPQ2d 1637, 1639 (TTAB 2006) (holding 3-0’S merely descriptive of car wheel rims); *In re Samuel Moore & Co.*, 195 USPQ 237, 240 (TTAB 1977) (holding SUPERHOSE! merely descriptive of hydraulic hose); *see DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 1253-54, 103 USPQ2d 1753, 1757-58 (Fed. Cir. 2012) (holding the Board failed to support findings that SNAP!, where the exclamation point appeared broken in half, was not merely descriptive of medical syringes using snap-off plungers); TMEP §1209.03(u).

In this case, the addition of the ampersand to the repeated wording does not make the mark any less descriptive. In *In re Seaman & Associates Inc.*, 1 U.S.P.Q.2d 1657, 1659 (TTAB 1986), it was held that the use of an ampersand in the mark "PRODUCT ACCEPTANCE & RESEARCH" did not render the descriptive terms distinctive. The Board stated that:

“The phrase, for example, HOME PAINTING AND MAINTENANCE should not be registrable merely because there is some redundancy in the description, that is, that "home painting" may be considered to be subsumed within the broader category "maintenance." Rather, applicant's mark is composed of terms which lose no descriptive significance in the combination. See, for example, *In re Harcourt Brace Jovanovich, Inc.*, 222 U.S.P.Q. 820 (TTAB 1984) (LAW & BUSINESS held unregistrable on the Supplemental Register) and *In re National Shooting Sports Foundation, Inc.*, 219 U.S.P.Q. 1018 (TTAB 1983) (SHOOTING, HUNTING, OUTDOOR TRADE SHOW AND CONFERENCE held common descriptive name of applicant's services of conducting and arranging trade shows in the hunting, shooting and outdoor sports products field).”

The applied-for mark shows the wording in stylized lettering. However, the degree of stylization in this case is not sufficiently striking, unique or distinctive so as to create a commercial impression separate and apart from the unregistrable components of the mark. See *In re Sambado & Son Inc.*, 45 USPQ2d 1312 (TTAB 1997); *In re Bonni Keller Collections Ltd.*, 6 USPQ2d 1224 (TTAB 1987). Here, the stylization consists only of presenting the wording in the mark in lower case letters in a simple font. The Board has

stated that “[a] display of descriptive, generic or otherwise unregistrable matter is not registrable on the Principal Register unless the stylization of the words or the accompanying design features of the asserted mark create an impression on purchasers separate and apart from the impression made by the words themselves.” *In re Am. Academy of Facial Plastic & Reconstructive Surgery*, 64 U.S.P.Q.2d 1748, 1753 (TTAB 2002). In this case, there is nothing in the simple font which creates an impression “separate and apart” from the impression made by the words TOWEL & TOWEL.

Applicant argues that the mark is suggestive of the goods, not descriptive, because the combination of “TOWEL & TOWEL” can conjure up numerous other images and because there is no immediate connection between the mark and the towels.

On page 6 of the appeal brief, applicant argues that the phrase TOWEL & TOWEL as a whole “can also reference a store that sells many items related to bath products, and other home goods” and therefore, the consumer “would still not know what types of goods or services are provided and what its functions are.” However, “[w]hether consumers could guess what the product [or service] is from consideration of the mark alone is not the test.” *In re Am. Greetings Corp.*, 226 USPQ 365, 366 (TTAB 1985). The question is not whether someone presented only with the mark could guess what the goods are, but “whether someone who knows what the goods and[or] services are will understand the mark to convey information about them.” *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 1254, 103 USPQ2d 1753, 1757 (Fed. Cir. 2012) (quoting *In re Tower Tech, Inc.*, 64 USPQ2d 1314, 1316-17 (TTAB 2002)); *In re Franklin Cnty. Historical Soc’y*, 104 USPQ2d 1085, 1087 (TTAB 2012).

In the Response to Office Action submitted by the applicant on September 27, 2011, applicant stated that

“The word “towel” is a self explanatory word that identifies the good(s). Using ‘&’ (and) symbol in the mark of “towel & towel” is a very unique way to tell customers they will be able to find, choose, compare and make a purchase of many towel goods. It suggests a family of products that are being sold based on their relationship to one another.”

In other words, the mark TOWEL & TOWEL tells the consumer that they can find and purchase different towels.

A mark is suggestive if some imagination, thought, or perception is needed to understand the nature of the goods described in the mark; whereas a descriptive term immediately and directly conveys some information about the goods. *See DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 1251-52, 103 USPQ2d 1753, 1755 (Fed. Cir. 2012) (quoting *In re Abcor Dev. Corp.*, 588 F.2d 811, 814, 200 USPQ 215, 218 (C.C.P.A. 1978)); *In re Steelbuilding.com*, 415 F.3d 1293, 1297, 75 USPQ2d 1420, 1422 (Fed. Cir. 2005); TMEP §1209.01(a). In this case, contrary to applicant’s argument, no “imagination, thought or perception” is required to understand the nature of the goods described in the mark. A consumer presented with the mark TOWEL & TOWEL in relation to applicant’s goods, towels, would clearly understand the meaning of the mark in this case, as the mark would be used on a different types of towels.

Applicant has included a list of third-party registrations in the appeal brief to demonstrate that the word “towel” in other trademarks has not prevented other trademarks from being registered. The Trademark Trial and Appeal Board generally does not take judicial notice of third-party registrations. *In re Ruffin Gaming LLC*, 66 USPQ2d 1924, 1925 n.3 (TTAB 2002); *In re Carolina Apparel*, 48 USPQ2d 1542, 1543 n.2 (TTAB 1998); TBMP §§1208.02, 1208.04; TMEP §710.03; see Fed. R. Evid. 201; 37 C.F.R. §§2.122(a), 2.142(d).

Applicant has included only a list of these registrations, not the copies or electronic equivalent of the registrations. The mere submission of a list of registrations or a copy of a private company search report 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 third party 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.

Accordingly, the trademark examining attorney requests that the Board disregard the third-party registrations identified by applicant in its appeal brief.

Furthermore, the fact that third-party registrations exist for marks allegedly similar to applicant's mark is not conclusive on the issue of descriptiveness. See *In re Scholastic Testing Serv., Inc.*, 196 USPQ 517, 519 (TTAB 1977); TMEP §1209.03(a). An applied-for mark that is merely descriptive does not become registrable simply because other seemingly similar marks appear on the register. *In re Scholastic Testing Serv., Inc.*, 196 USPQ at 519; TMEP §1209.03(a).

It is well settled that each case must be decided on its own facts and the Trademark Trial and Appeal Board is not bound by prior decisions involving different records. See *In re Nett Designs, Inc.*, 236 F. 3d 1339, 1342, 57 USPQ2d 1564, 1566 ( Fed. Cir. 2001); *In re Lean Line, Inc.*, 229 USPQ 781, 783 (TTAB 1986); TMEP §1209.03(a). The question of whether a mark is merely descriptive is determined based on the evidence of record at the time each registration is sought. *In re theDot Commc'ns Network LLC*, 101 USPQ2d 1062, 1064 (TTAB 2011); TMEP §1209.03(a); see *In re Nett Designs, Inc.*, 236 F.3d at 1342, 57 USPQ2d at 1566.

Even if the registrations listed by the applicant are considered, they do not demonstrate that the applicant's mark is not descriptive. Aside from MULTITOWEL, No. 4167708, and YOUR SOURCE FOR TOWELS, No. 3954848, where the word "towel" is part of a unitary phrase, the other the third party registrations cited by the applicant support a finding that the wording is descriptive of the goods, because the word "towel" is disclaimed or, in the case of the mark SILVERTOWEL, the mark is registered on the Supplemental Register. Third-party registrations featuring goods the same as or similar to applicant's goods are probative evidence on the issue of descriptiveness where the relevant word or term is disclaimed, registered under Trademark Act Section 2(f) based on acquired distinctiveness, or registered on the Supplemental Register. See *Inst. Nat'l des Appellations D'Origine v. Vintners Int'l Co.*,

958 F.2d 1574, 1581-82, 22 USPQ2d 1190, 1196 (Fed. Cir. 1992); *In re Box Solutions Corp.*, 79 USPQ2d 1953, 1955 (TTAB 2006); *In re Finisar Corp.*, 78 USPQ2d 1618, 1621 (TTAB 2006).

### **CONCLUSION**

The applicant's mark TOWEL & TOWEL in stylized form is merely descriptive of the applicant's goods. For the foregoing reasons, the examining attorney respectfully requests that the refusal to register on the basis of §2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), for the reason TOWEL & TOWEL is merely descriptive of the goods be affirmed.

Respectfully submitted,

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