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Subject: U.S. TRADEMARK APPLICATION NO. 85707925 - MY SCORE - 072363-00001 - EXAMINER BRIEF

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# UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

**U.S. APPLICATION SERIAL NO.** 85707925

**MARK:** MY SCORE



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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:** J.W. Pepper & Son, Inc.

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

072363-00001

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## **EXAMINING ATTORNEY'S APPEAL BRIEF**

The applicant has appealed the Trademark Examining Attorney's final requirement for a disclaimer of the descriptive term "SCORE" under Trademark Act §6, 15 U.S.C. §1056.

## PROCEDURAL HISTORY

On August 20, 2012, the applicant, J.W. Pepper & Son, Inc., applied to register the mark MY SCORE on the Principal Register for services identified as “on-line retail store services featuring printed or digital sheet music.” In an Office Action dated December 20, 2012, the examining attorney required the applicant to enter a disclaimer of the descriptive term “SCORE” apart from the mark as a whole. In a Response filed June 20, 2013, the applicant declined to provide the disclaimer and submitted arguments along with a request that the requirement be withdrawn. In a Final Office Action on July 15, 2013, the examining attorney made final the requirement for disclaimer. On January 13, 2014, applicant submitted a Request for Reconsideration and noted this Appeal. The Request for Reconsideration was denied in an action dated January 26, 2014.

## ARGUMENT

Under Trademark Act Section 6(a), 15 U.S.C. Section 1056(a), the Office may require a disclaimer of an unregistrable component of a mark. Trademark Act Section 2(e), 15 U.S.C. Section 1052(e), bars the registration of a mark which is merely descriptive of the goods. Therefore, the Commissioner may require the disclaimer of a portion of a mark which, when used in connection with the identified goods and services, is merely descriptive. An applicant may not claim exclusive rights to terms that others may need to use to describe their goods and/or services in the marketplace. *See Dena Corp. v. Belvedere Int'l, Inc.*, 950 F.2d 1555, 1560, 21 USPQ2d 1047, 1051 (Fed. Cir. 1991); *In re Aug. Storck KG*, 218 USPQ 823, 825 (TTAB 1983).

The applicant's mark is MY SCORE for "on-line retail store services featuring printed or digital sheet music." Applicant has conceded that "score" may be defined as a "copy of a musical composition in written or printed notation." Applicant's Brief ("Brief") at 10, in reference to definition from the online *Merriam Webster Dictionary*, attached to December 20, 2012 Office action ([www.merriam-webster.com/dictionary/score](http://www.merriam-webster.com/dictionary/score)). Despite the applicant's later contradictory statement regarding that conceded definition (Brief at 11), the fact remains that the term SCORE is directly linked to music in various forms. Applicant has claimed essentially that the "distinction between a 'score' and 'sheet music'," renders the term SCORE only suggestive and therefore obviates the disclaimer requirement. *Id.* However, this overlooks the fact that the disclaimer requirement looks to *descriptiveness* of a term, not necessarily the implication that a term is generic. That is, the concern is whether a term describes a feature, characteristic, purpose and the like, of the applicant's goods or services not whether that term identifies a category of those goods or services. The requirement here is for disclaimer of SCORE not because it is generic but because it is descriptive in connection with applicant's online retail store services featuring sheet music.

There is ample support on record for the proposition that online sheet music retailers, applicant J.W. Pepper among them, identify musical scores directly in connection with printed or digital sheet music. The following examples, excerpted in part from the Final action dated July 15, 2013, show that musical scores are expected features of online retail stores featuring printed and digital sheet music:

We're your online **sheet music source** for music books, music sheets, songbooks, **music scores**, choral sheet music and more! Sheet Music Plus ([www.sheetmusicplus.com](http://www.sheetmusicplus.com)).

Our mail order form is designed to accommodate full **score** purchases only. If you wish to purchase individual parts, please call in your order. Free Flight Music (<http://www.freeflightmusic.com/buy-sheet-music-online.php>).

Download sheet music plus arrangements; Printable **sheet music scores** for piano, orchestra, choir and many classical instruments. Sheet Music Archive (<http://www.sheetmusicarchive.net/index.cfm>).

**Scores** the New MP3s? **Sheet music** sales online for artists. Article in *Create Digital Music* (<http://createdigitalmusic.com/2009/05/scores-the-new-mp3s-sheet-music-sales-online-for-artists/>).

PlaybillStore.com carries more than 70 Broadway musical piano/vocal **scores** from the Hal Leonard and Alfred Publishing catalogs. Vocal **scores** contain the complete vocal **score** of the show - including reprises and choral parts - in the original keys as performed by the original casts on Broadway. Playbill Store (<http://www.google.com/#q=purchase+music+scores+online&ei=dlrkUY-xE8P54AOCiYDAAQ&start=20&sa=N&bav=on.2,or.&fp=f9a20f279162cec5&biw=1274&bih=752>).

Any descriptiveness analysis hinges on consideration of the context of the identified goods or services. *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 1254, 103 USPQ2d 1753, 1757 (Fed. Cir. 2012); *In re The Chamber of Commerce of the U.S.*, 675 F.3d 1297, 1300, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012); TMEP §1209.01(b); *see, e.g., In re Polo Int'l Inc.*, 51 USPQ2d 1061, 1062-63 (TTAB 1999) (finding DOC in DOC-CONTROL would refer to the “documents” managed by applicant’s software rather than the term “doctor” shown in a dictionary definition); *In re Digital Research Inc.*, 4 USPQ2d 1242, 1243-44 (TTAB 1987) (finding CONCURRENT PC-DOS and CONCURRENT DOS merely descriptive of “computer programs recorded on disk” where the relevant trade used the denomination “concurrent” as a descriptor of a particular type of operating system). As the present context broadly is *music*, and more narrowly, online stores featuring said music, the term SCORE is highly descriptive relative to these services. The question is not whether someone presented only with the mark could guess what the goods and/or services 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). Thus here, applicant’s prospective customers, namely, those who would purchase printed or digital sheet music, will understand the term SCORE to convey information about applicant’s online retail store services featuring sheet music. Again, record evidence including captures from websites of Edition-Peters, Boosey & Hawkes, Music-Scores.com, Free Flight Music, Sheet Music Archive and Playbill Store as well as of applicant J.W. Pepper confirm this consumer understanding. Final action, July 15, 2013, attachment pages 2-31. In addition, numerous institutions such as the University of Hartford and the UCLA Library make musical scores available for purchase or download via dedicated websites.

Hartford promotes its “Music scores online,” “digitized scores” and a “music score library containing tens of thousands of scores in the public domain.” Final action at attachment pages 13-16. UCLA offers “Music scores and sheet music online.” Final action at attachment pages 18-20.

Therefore, and without engaging in what applicant terms “mental leaps,” the relevant consumer can be considered familiar with applicant’s services and would immediately see the term SCORE as descriptive relative to the identified services. Brief at 5.

Far from being the “minor, miniscule, or deeply shrouded” features applicant characterizes, musical scores figure prominently in the applicant’s own retail site and as such the term SCORE immediately and directly identifies a *significant* characteristic of those goods and services. Brief at 8, *citing In re Gyulay*, 820 F.2d 1216, 1220 (Fed. Cir. 1987). It is notable that a search of the J.W. Pepper website using the keyword “score” returned **14,650** results and once again emphasizes the relationship between applicant’s online retail store services and scores. Final action, July 15, 2013, attachment page 4. The

following excerpt from applicant's "MY SCORE" service page serves as the best evidence that the term "SCORE" immediately and directly conveys information about the applicant's identified services featuring digital or printed *music*. These excerpts were made of record January 26, 2014:

With your **My Score** registration you receive:

Industry standard, black and white, printed editions of your works

e-Print/Digital delivery

Your own composer page link on [jwpepper.com](http://jwpepper.com)

A profile page with your bio, photo, links, recordings, video and sample pages...

...We'll take it from there. Guaranteed.

Professionally **printed music**

Same-day shipping for most orders

Secure delivery of **digital files**

Secure payment options for customers

Sales tax collection and reporting

Payment options such as purchase orders and bids...

#### **...Common Formats**

To achieve best printed results, we'll work with you to determine the best size and format for your **composition**.

#### Choral Sizes

Octavo            Standard octavo size, folded and bound

Choral Book    Cover stock with saddle stitched pages

Vocal **Score**    11 x 17 size, folding and binding

Instrumental Music, **Score** and Parts

8 1/2 x 11 Standard, collated in **score** order

9 x 12 Standard, collated in **score** order

9 x 14 Oversized, collated in **score** order(**Score** will be coil bound)

11 x 17 Oversized, collated in **score** order(**Score** will be coil bound)

12 x 18 Oversized, collated in **score** order(**Score** will be coil bound)

Spine Spines standard on full instrumental sets

J.W. Pepper & Son, [www.jwpepper.com/sheet-music/my\\_score/ms\\_getstarted.jsp](http://www.jwpepper.com/sheet-music/my_score/ms_getstarted.jsp) (Emphasis added).

Applicant has argued that the “Examining Attorney...failed to properly resolve all doubts as to registration in applicant’s favor.” Brief at 5. However, the evidence of record leaves *no* doubt that the term SCORE is merely descriptive in the context of the listed services. Therefore, no such resolution in applicant’s favor is appropriate. *In re Merrill Lynch, Pierce, Fenner & Smith, Inc.*, 828 F.2d 1567 4 USPQ2d 1141 (Fed. Cir. 1987); *In re Grand Forest Holdings, Inc.*, 78 USPQ2d 1152 (TTAB 2006).

In citing the existence of applicant’s companion (now registered) mark “MY SCORE YOUR MUSIC. OUR NETWORK” for the same services, applicant argues that it is “inappropriate for the Trademark Office to require J.W. Pepper to disclaim the word ‘SCORE’ from its suggestive service mark, MY SCORE.” Brief at 12. The applicant’s theory is that since that mark was registered without disclaimer of SCORE, the instant mark should be similarly treated for consistency’s sake. *Id.* While as a policy matter consistency in action among *like* circumstances is an acknowledged goal of examination, uniformity of action under highly distinguishable circumstances is certainly not. The applicant’s proffered mark in Registration No.

4,471,837 is *not* the same mark as the one at issue here. The mark in that registration is a slogan, and therefore a disclaimer of the individual term was unnecessary. TMEP §1213.05(b)(i). Moreover, each case is decided on its own facts, and each mark stands on its own merits. *See AMF Inc. v. Am. Leisure Prods., Inc.*, 474 F.2d 1403, 1406, 177 USPQ 268, 269 (C.C.P.A. 1973); *In re Binion*, 93 USPQ2d 1531, 1536 (TTAB 2009).

In addition, the third-party registrations of record further discount applicant's argument that the term SCORE is only suggestive in the context of music-related goods and services. Final action at attachment pages 39-57. For, it has long been held that third-party registrations featuring goods and/or services the same as or similar to applicant's goods and/or services *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).

Applicant cites a Federal Circuit decision for the proposition that "the Patent and Trademark Office should have a strong preference for allowing for full registration of a mark," extrapolating that the "rule is to protect the owner of trademarks by allowing them to register their marks, not to make them disclaim matter." *In re Four Seasons Hotel, Ltd.*, 987 F.2d 1565 (Fed. Cir. 1993). In stark contrast to the instant case, however, the Federal Circuit panel in *Four Seasons* was reviewing a challenge to the TTAB's decision to affirm an examining attorney's refusal under Section 2(d) for likelihood of confusion. The primary focus of the Court there was the consent agreement of record and the TTAB's decision to assign that agreement less value than the Federal Circuit deemed adequate. In reversing the refusal to register, the Federal Circuit reminded "the TTAB that 'reliance on its own views...rather than the views

of the parties in question, contravenes the scope and intent of this court's precedent..." *In re Four Seasons Hotel, Ltd.*, 987 F.2d 1565 at 1569, citing, *Amalgamated Bank v. Amalgamated Trust & Sav. Bank*, 842 F.2d 1270, 1275, 6 USPQ2d 1305, 1308 (Fed. Cir. 1988). The issue in the present case is the descriptiveness of "score" not a likelihood of confusion analysis, and thus the focus must remain on the competitive need to keep available descriptive terms versus registration of such terms. After all, two major reasons for not protecting descriptive marks are (1) to prevent the owner of a descriptive mark from inhibiting competition in the marketplace and (2) to avoid the possibility of costly infringement suits brought by the trademark or service mark owner. *In re Abcor Dev. Corp.*, 588 F.2d 811, 813, 200 USPQ 215, 217 (C.C.P.A. 1978); TMEP §1209. Businesses and competitors should be free to use descriptive language when describing their own goods and/or services to the public in advertising and marketing materials. See *In re Styleclick.com Inc.*, 58 USPQ2d 1523, 1527 (TTAB 2001).

### **CONCLUSION**

The term SCORE in the applicant's proposed mark merely describes a feature of the identified services, namely, that applicant's online retail store services in the field of sheet music feature musical scores. As this term is directly descriptive of the identified services, it must be disclaimed apart from the mark as a whole.

For the foregoing reasons, the examining attorney respectfully requests that the final requirement for a disclaimer be affirmed.

Respectfully submitted,

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