

## Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	85707925
LAW OFFICE ASSIGNED	LAW OFFICE 109
MARK SECTION (no change)	
ARGUMENT(S)	
<p>In an Office Action dated July 15, 2013, the Examining Attorney made final her refusal to register Applicant's mark on the basis that Applicant must disclaim allegedly merely descriptive matter from its mark as a whole, pursuant to Section 6 of the Lanham Act. Applicant submits the following Request for Reconsideration in support of registration.</p> <p><b>I. <u>NO DISCLAIMER</u></b></p> <p>Applicant respectfully reasserts its position that its service mark "MY SCORE" constitutes a suggestive mark that is registrable without disclaimer of "SCORE," as sought by the Examining Attorney. Applicant brings to the attention of the Examining Attorney two of its co-pending applications, both of which have been substantively examined and approved for registration on the Principal Register without disclaimer of the term "SCORE":</p> <ul style="list-style-type: none"><li>· Application Serial No. 85/708,700 for MY SCORE YOUR MUSIC. OUR NETWORK. (Review prior to registration completed on December 16, 2013); and</li><li>· Application Serial No. 85/573,368 for MY SCORE YOUR MUSIC. OUR NETWORK. and Design (Notice of Allowance issued on November 12,</li></ul>	

2013).

Applicant's position and the Examining Attorney's prior determinations are supported by the suggestive meaning of the term "SCORE" within the context of Applicant's mark, as well as by the dictates of Trademark Office policy. T.M.E.P. § 1213.05(f).

Therefore, Applicant requests the Examining Attorney to withdraw her disclaimer requirement and move Applicant's mark to publication.

**A. Standard for Descriptiveness of a Component Term**

Marks and component terms of marks fall into one of five classifications including: (1) generic; (2) descriptive; (3) suggestive; (4) arbitrary; or (5) fanciful. Abercrombie & Fitch Co. v. Hunting World, Inc., 537 F.2d 4 (2d Cir. 1976). "Although these categories are meant to be mutually exclusive, they are spectrum-like and tend to merge imperceptibly from one to another." Vision Center v. Opticks, Inc., 596 F.2d 111 (5th Cir. 1979), cert. denied, 444 U.S. 1016 (1980); see also Accu Personnel, Inc. v. Accustaff, Inc., 823 F. Supp. 1161 (D. Del. 1993). Because of the sometimes subtle differences between classifications they are "frequently difficult to define and quite frequently difficult to apply." Vision Center v. Opticks, Inc., 596 F.2d at 115.

Generally, "a mark is entitled to greater protection the further it lies toward the arbitrary end of the spectrum and the farther it gets from the generic end." Taj Mahal Enterprises, Ltd. v. Trump, 742 F. Supp. 892 (D.N.J. 1990). Thus, the classification of a mark or a component term is of critical importance. If the mark or component term is found to be suggestive, arbitrary, or fanciful, it is, without more, entitled to trademark registration without disclaimer. See Two Pesos, Inc. v. Taco Cabana, Inc., 550 U.S. at 769.

Conversely, if the mark or component term is classified as either

generic or descriptive, the mark is not entitled to registration without disclaimer absent the acquisition of secondary meaning in the market. See First Bank v. First Bank System, Inc., 84 F.3d 1040 (8th Cir. 1996).

A suggestive term is one which requires a consumer to employ at least some degree of thought, imagination, and perception to determine the nature of the goods or services connected to it. In re Gyulay, 820 F.2d 1216, 1217 (Fed. Cir. 1987). In other words, if "imagination, thought or perception is required to reach a conclusion on the nature of the goods," then it is a suggestive term entitled to protection without disclaimer. Id. (quoting In re Quik-Print Copy Shops, Inc., 616 F.2d 523 (C.C.P.A. 1980)); see also General Mills, Inc. v. Kellogg Co., 824 F.2d 622 (8th Cir. 1987).

An alternate test to the "imagination" test is whether others in the same business would generally need the word to adequately describe their product or service. "[However] [t]he need to use a term because it is generic or highly descriptive should be distinguished from the desire to use it because it is attractive." Union Nat'l Bank of Texas, Laredo, Texas, 909 F.2d at 848.

The case, In re Application of ABCOR DEVELOPMENT CORPORATION, 588 F.2d 811 (C.C.P.A. 1978), sets forth a general explanation of the differences between merely descriptive marks and suggestive marks that also applies to component terms:

Generally speaking, if the mark imparts information directly, it is descriptive. If it stands for an idea which requires some operation of the imagination to connect it with the goods, it is suggestive.

Id. at 814 (citing Union Carbide Corp. v. Ever-Ready, Inc., 531 F.2d 366, cert. denied, 429 U.S. 830 (1976)). As clarified in the T.M.E.P., however, "a designation does not have to be devoid of all meaning in

relation to the goods and services to be registrable." T.M.E.P. § 1209.01(a); see also HQ Network Sys. v. Executive Headquarters, 755 F. Supp. 1110 (D. Mass. 1991) (finding mark "'HEADQUARTERS COMPANIES' is on the cusp between being descriptive and being suggestive. It is, if you will, a suggestive mark with descriptive elements").

Understanding that a suggestive mark may, too, carry a certain meaning or significance, is crucial to the case at hand. Emanating from the aforementioned wealth of case law, it is clear that the standard for descriptiveness for purposes of a disclaimer requirement necessitates a basis of significance and immediacy.

**B. "SCORE" Is Not Descriptive Under the Appropriate Standard.**

Applicant respectfully submits that, based on the standard established by the foregoing rules and case law, the MY SCORE mark is an ideal example of a unitary suggestive mark. The Examining Attorney does not provide a convincing basis for the disclaimer requirement, and relies solely on the assertion that the term "SCORE" merely describes a feature of the applicant's services. The Examining Attorney's attempt to tie "scores" to Applicant's services fails because her statement that "scores" are equivalent to "sheet music," as found in Applicant's recitation of services, is inaccurate. Moreover, Applicant's mark requires potential consumers to employ a certain amount of imagination, thought, and perception to intuit a characteristic of Applicant's services.

Applicant concedes that a "score" may be defined as a "copy of a musical composition in written or printed notation," but a musical composition is more than mere "sheet music." "Sheet music" is simply a record of, or a means to perform, a given piece of music, whether a simple scale or a song. In contrast, a "musical composition" is "a

musical work that has been created," not simply a record of, or means to perform, a series of musical notes. As a result, since the Examining Attorney's statement that a "score" is a written copy of a musical composition is not accurate, the Examining Attorney's further statement that "the wording merely describes a feature of the services in that the retail services feature 'printed or digital sheet music' or scores'" does not logically follow. Therefore, Applicant's mark, MY SCORE, is not descriptive of "on-line retail store services featuring printed or digital sheet music," but instead merely suggests the nature of Applicant's services.

Another way of explaining the above distinction between a "score" and "sheet music" is the difference in usage of such terminology. In conversation, a customer would commonly say, "I plan to purchase the "sheet music" for "My Heart Will Go On" by Celine Dion. In contrast, a customer would never make the statement, "I plan to purchase the "score" for "My Heart Will Go On" by Celine Dion. This comparison emphasizes the suggestive nature of Applicant's mark in connection with its services. Applicant's customers would never intend to purchase a "score"; this term merely suggests the nature of Applicant's services.

For the foregoing reasons, Applicant respectfully requests that the Examining Attorney withdraw the disclaimer requirement as to "SCORE" and allow Applicant's mark to proceed to publication.

## **II. CONCLUSION**

For the foregoing reasons, therefore, Applicant respectfully requests the Examining Attorney withdraw the disclaimer requirement and allow Applicant's mark to proceed to publication.

### **SIGNATURE SECTION**

**RESPONSE SIGNATURE**

/Timothy D. Pecsénye/

<b>SIGNATORY'S NAME</b>	Timothy D. Pecsénye
<b>SIGNATORY'S POSITION</b>	Attorney of record, Pennsylvania bar member
<b>SIGNATORY'S PHONE NUMBER</b>	215-569-5619
<b>DATE SIGNED</b>	01/13/2014
<b>AUTHORIZED SIGNATORY</b>	YES
<b>CONCURRENT APPEAL NOTICE FILED</b>	YES
<b>FILING INFORMATION SECTION</b>	
<b>SUBMIT DATE</b>	Mon Jan 13 17:43:27 EST 2014
<b>TEAS STAMP</b>	USPTO/RFR-38.98.220.16-20 140113174327272609-857079 25-50025a26dc2f1a2724edc7 99f2ccf66e2d7f539a6821255 3b4672cd356f6c7-N/A-N/A-2 0140113172138704801

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

Application serial no. **85707925** has been amended as follows:

### **ARGUMENT(S)**

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

In an Office Action dated July 15, 2013, the Examining Attorney made final her refusal to register Applicant's mark on the basis that Applicant must disclaim allegedly merely descriptive matter from its mark as a whole, pursuant to Section 6 of the Lanham Act. Applicant submits the following Request for Reconsideration in support of registration.

#### **I. NO DISCLAIMER**

Applicant respectfully reasserts its position that its service mark "MY SCORE" constitutes a suggestive mark that is registrable without

disclaimer of "SCORE," as sought by the Examining Attorney. Applicant brings to the attention of the Examining Attorney two of its co-pending applications, both of which have been substantively examined and approved for registration on the Principal Register without disclaimer of the term "SCORE":

- Application Serial No. 85/708,700 for MY SCORE YOUR MUSIC. OUR NETWORK. (Review prior to registration completed on December 16, 2013); and
- Application Serial No. 85/573,368 for MY SCORE YOUR MUSIC. OUR NETWORK. and Design (Notice of Allowance issued on November 12, 2013).

Applicant's position and the Examining Attorney's prior determinations are supported by the suggestive meaning of the term "SCORE" within the context of Applicant's mark, as well as by the dictates of Trademark Office policy. T.M.E.P. § 1213.05(f). Therefore, Applicant requests the Examining Attorney to withdraw her disclaimer requirement and move Applicant's mark to publication.

**A. Standard for Descriptiveness of a Component Term**

Marks and component terms of marks fall into one of five classifications including: (1) generic; (2) descriptive; (3) suggestive; (4) arbitrary; or (5) fanciful. Abercrombie & Fitch Co. v. Hunting World, Inc., 537 F.2d 4 (2d Cir. 1976). "Although these categories are meant to be mutually exclusive, they are spectrum-like and tend to merge imperceptibly from one to another." Vision Center v. Opticks, Inc., 596 F.2d 111 (5th Cir. 1979), cert. denied, 444 U.S. 1016 (1980); see also Accu Personnel, Inc. v. Accustaff, Inc., 823 F. Supp. 1161 (D. Del. 1993). Because of the sometimes subtle differences between classifications they are "frequently difficult to define and quite frequently difficult to apply." Vision Center v. Opticks, Inc.,

596 F.2d at 115.

Generally, "a mark is entitled to greater protection the further it lies toward the arbitrary end of the spectrum and the farther it gets from the generic end." Taj Mahal Enterprises, Ltd. v. Trump, 742 F. Supp. 892 (D.N.J. 1990). Thus, the classification of a mark or a component term is of critical importance. If the mark or component term is found to be suggestive, arbitrary, or fanciful, it is, without more, entitled to trademark registration without disclaimer. See Two Pesos, Inc. v. Taco Cabana, Inc., 550 U.S. at 769. Conversely, if the mark or component term is classified as either generic or descriptive, the mark is not entitled to registration without disclaimer absent the acquisition of secondary meaning in the market. See First Bank v. First Bank System, Inc., 84 F.3d 1040 (8th Cir. 1996).

A suggestive term is one which requires a consumer to employ at least some degree of thought, imagination, and perception to determine the nature of the goods or services connected to it. In re Gyulay, 820 F.2d 1216, 1217 (Fed. Cir. 1987). In other words, if "imagination, thought or perception is required to reach a conclusion on the nature of the goods," then it is a suggestive term entitled to protection without disclaimer. Id. (quoting In re Quik-Print Copy Shops, Inc., 616 F.2d 523 (C.C.P.A. 1980)); see also General Mills, Inc. v. Kellogg Co., 824 F.2d 622 (8th Cir. 1987).

An alternate test to the "imagination" test is whether others in the same business would generally need the word to adequately describe their product or service. "[However] [t]he need to use a term because it is generic or highly descriptive should be distinguished from the desire to use it because it is attractive." Union Nat'l Bank of Texas, Laredo, Texas, 909 F.2d at 848.

The case, In re Application of ABCOR DEVELOPMENT CORPORATION, 588 F.2d

811 (C.C.P.A. 1978), sets forth a general explanation of the differences between merely descriptive marks and suggestive marks that also applies to component terms:

Generally speaking, if the mark imparts information directly, it is descriptive. If it stands for an idea which requires some operation of the imagination to connect it with the goods, it is suggestive.

Id. at 814 (citing Union Carbide Corp. v. Ever-Ready, Inc., 531 F.2d 366, cert. denied, 429 U.S. 830 (1976)). As clarified in the T.M.E.P., however, "a designation does not have to be devoid of all meaning in relation to the goods and services to be registrable." T.M.E.P. § 1209.01(a); see also HQ Network Sys. v. Executive Headquarters, 755 F. Supp. 1110 (D. Mass. 1991) (finding mark "'HEADQUARTERS COMPANIES' is on the cusp between being descriptive and being suggestive. It is, if you will, a suggestive mark with descriptive elements"). Understanding that a suggestive mark may, too, carry a certain meaning or significance, is crucial to the case at hand. Emanating from the aforementioned wealth of case law, it is clear that the standard for descriptiveness for purposes of a disclaimer requirement necessitates a basis of significance and immediacy.

**B. "SCORE" Is Not Descriptive Under the Appropriate Standard.**

Applicant respectfully submits that, based on the standard established by the foregoing rules and case law, the MY SCORE mark is an ideal example of a unitary suggestive mark. The Examining Attorney does not provide a convincing basis for the disclaimer requirement, and relies solely on the assertion that the term "SCORE" merely describes a feature of the applicant's services. The Examining Attorney's attempt to tie "scores" to Applicant's services fails because her statement that "scores" are equivalent to "sheet music," as found in Applicant's

recitation of services, is inaccurate. Moreover, Applicant's mark requires potential consumers to employ a certain amount of imagination, thought, and perception to intuit a characteristic of Applicant's services.

Applicant concedes that a "score" may be defined as a "copy of a musical composition in written or printed notation," but a musical composition is more than mere "sheet music." "Sheet music" is simply a record of, or a means to perform, a given piece of music, whether a simple scale or a song. In contrast, a "musical composition" is "a musical work that has been created," not simply a record of, or means to perform, a series of musical notes. As a result, since the Examining Attorney's statement that a "score" is a written copy of a musical composition is not accurate, the Examining Attorney's further statement that "the wording merely describes a feature of the services in that the retail services feature 'printed or digital sheet music' or scores'" does not logically follow. Therefore, Applicant's mark, MY SCORE, is not descriptive of "on-line retail store services featuring printed or digital sheet music," but instead merely suggests the nature of Applicant's services.

Another way of explaining the above distinction between a "score" and "sheet music" is the difference in usage of such terminology. In conversation, a customer would commonly say, "I plan to purchase the "sheet music" for "My Heart Will Go On" by Celine Dion. In contrast, a customer would never make the statement, "I plan to purchase the "score" for "My Heart Will Go On" by Celine Dion. This comparison emphasizes the suggestive nature of Applicant's mark in connection with its services. Applicant's customers would never intend to purchase a "score"; this term merely suggests the nature of Applicant's services. For the foregoing reasons, Applicant respectfully requests that the

Examining Attorney withdraw the disclaimer requirement as to "SCORE" and allow Applicant's mark to proceed to publication.

## **II. CONCLUSION**

For the foregoing reasons, therefore, Applicant respectfully requests the Examining Attorney withdraw the disclaimer requirement and allow Applicant's mark to proceed to publication.

### **SIGNATURE(S)**

#### **Request for Reconsideration Signature**

Signature: /Timothy D. Pecsénye/ Date: 01/13/2014

Signatory's Name: Timothy D. Pecsénye

Signatory's Position: Attorney of record, Pennsylvania bar member

Signatory's Phone Number: 215-569-5619

The signatory has confirmed that he/she is an attorney who is a member in good standing of the bar of the highest court of a U.S. state, which includes the District of Columbia, Puerto Rico, and other federal territories and possessions; and he/she is currently the applicant's attorney or an associate thereof; and to the best of his/her knowledge, if prior to his/her appointment another U.S. attorney or a Canadian attorney/agent not currently associated with his/her company/firm previously represented the applicant in this matter: (1) the applicant has filed or is concurrently filing a signed revocation of or substitute power of attorney with the USPTO; (2) the USPTO has granted the request of the prior representative to withdraw; (3) the applicant has filed a power of attorney appointing him/her in this matter; or (4) the applicant's appointed U.S. attorney or Canadian attorney/agent has filed a power of attorney appointing him/her as an associate attorney in this matter.

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

Serial Number: 85707925

Internet Transmission Date: Mon Jan 13 17:43:27 EST 2014

TEAS Stamp: USPTO/RFR-38.98.220.16-20140113174327272

609-85707925-50025a26dc2f1a2724edc799f2c

cf66e2d7f539a68212553b4672cd356f6c7-N/A-

N/A-20140113172138704801