

ESTTA Tracking number: **ESTTA598965**

Filing date: **04/16/2014**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	85707925
Applicant	J.W. Pepper & Son, Inc.
Applied for Mark	MY SCORE
Correspondence Address	TIMOTHY D. PECSENYE BLANK ROME LLP 1 LOGAN SQ FL 8 PHILADELPHIA, PA 19103-6998 UNITED STATES pecsenye@blankrome.com, mhomyk@blankrome.com
Submission	Appeal Brief
Attachments	MY SCORE brief.pdf(761739 bytes)
Filer's Name	Matthew A. Homyk
Filer's e-mail	mhomyk@blankrome.com
Signature	/matthew a homyk/
Date	04/16/2014

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APPLICANT: J.W. Pepper & Son, Inc.
SERIAL NO.: 85/707,925
SERVICE MARK: MY SCORE
FILING DATE: August 20, 2012
CLASS: 35
To: Hon. Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

BRIEF OF APPLICANT IN SUPPORT OF REGISTRATION

BLANK ROME LLP
One Logan Square
Philadelphia, PA 19103
(215) 569-5619

Attorneys for Applicant,
J.W. Pepper & Son, Inc.

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STATEMENT OF ISSUES FOR REVIEW

Did the Examining Attorney err in requiring a disclaimer of the allegedly descriptive term, "SCORE," ignoring clearly established legal precedent that all doubts concerning registration are to be resolved in Applicant's favor?

STATEMENT OF THE CASE

This action arises from the final requirement that Applicant disclaim the allegedly descriptive term "SCORE" from its mark as a whole. The Examining Attorney's requirement is made pursuant to Section 6(a) of the Lanham Act, on the basis that the "SCORE" portion of Applicant's mark, MY SCORE, is essentially allegedly merely descriptive under Section 2(e)(1) of the Lanham Act.

Applicant, J.W. Pepper & Son, Inc. ("J.W. Pepper") objects to the Examining Attorney's disclaimer requirement. To be sure, J.W. Pepper's mark is entitled to registration in its entirety without disclaimer.

PROCEEDINGS AND DISPOSITION BELOW

J.W. Pepper applied for registration of its mark, MY SCORE, on August 20, 2012. In response, the Examining Attorney required that J.W. Pepper disclaim exclusive rights to the "SCORE" portion of its mark, by office action dated December 20, 2012. To overcome this requirement, J.W. Pepper filed a timely response to the office action on June 20, 2013, including arguments against the disclaimer requirement.

The Examining Attorney again required the disclaimer of "SCORE" by office action dated July 15, 2013, making final the disclaimer requirement. J.W. Pepper filed a request for reconsideration on January 13, 2014, as well as a notice of ex parte appeal filed concurrently on the same date. On January 13, 2014, the Trademark Trial and Appeal Board (hereinafter "T.T.A.B.") mailed notification to J.W. Pepper's counsel that J.W. Pepper's request for reconsideration was acknowledged, and that the case was being remanded to the Examining Attorney for review.

The Examining Attorney responded to the request for reconsideration on January 26, 2014, maintaining the final disclaimer requirement. On February 15, 2014, the T.T.A.B. notified J.W. Pepper that its appeal was resumed with sixty days in which to file its brief herein.

STATEMENT OF FACTS

J.W. Pepper is a well-established sheet music retailer, with over 750,000 titles in its catalog. On August 20, 2012, J.W. Pepper sought to register its mark, MY SCORE, with the United States Patent and Trademark Office. On or about December 20, 2012, however, J.W. Pepper received an office action requiring that it disclaim as allegedly descriptive the term "SCORE."

J.W. Pepper responded to the disclaimer requirement by filing a response on June 20, 2013, in which it submitted arguments against the disclaimer requirement, and explained that all doubts concerning registration should be resolved in applicant J.W. Pepper's favor.

Despite J.W. Pepper's arguments, the Examining Attorney rejected J.W. Pepper's position in a second office action mailed July 15, 2013. J.W. Pepper filed a request for reconsideration on January 13, 2014, submitting appropriate written arguments against disclaimer and information about J.W. Pepper's own MY SCORE YOUR MUSIC. OUR NETWORK application, which had been approved for registration on the Principal Register without disclaimer for the same services.

Ignoring J.W. Pepper's arguments and evidence of its MY SCORE YOUR MUSIC. OUR NETWORK application, the Examining Attorney rejected J.W. Pepper's plea for reconsideration. The

Examining Attorney determined that "SCORE describes a primary feature (or item) of the online music stores in that the stores offer musical scores for sale or download." This appeal marks the culmination of the foregoing prosecution history.

SUMMARY OF ARGUMENT

This appeal centers on the improper disclaimer requirement of an allegedly descriptive element in Applicant's mark. Specifically, this appeal focuses on the Examining Attorney's erroneous position that "SCORE" is descriptive and unregistrable without disclaimer.

In order to reach her erroneous conclusions, the Examining Attorney overlooked several arguments proffered by J.W. Pepper against the disclaimer requirement. The Examining Attorney engaged in mental leaps when construing the term "SCORE," but made a conclusion of descriptiveness instead of the proper conclusion of suggestiveness. The Examining Attorney further failed to acknowledge evidence submitted by J.W. Pepper, including J.W. Pepper's Application Serial No. 85/708,700 for "MY SCORE YOUR MUSIC. OUR NETWORK.," which has now registered without disclaimer on the Principal Register for the same services in International Class 35. See, U.S. Reg. No. 4,471,837. As such, the Examining Attorney failed to properly resolve all doubts as to registration in favor of J.W. Pepper.

By insisting on disclaimer of the "SCORE" portion of J.W. Pepper's mark, the Examining Attorney also studiously ignored the basic purpose of trademark law: to protect the investment of producers in their marks and to eliminate confusion among potential consumers. Denial of registration will not preclude J.W. Pepper from using its mark, nor will it serve the public interest. Only by permitting publication and subsequent public comment on the mark will the goals of the Lanham Act be met. Thus, it must be the market -- and not the PTO -- that is to be the true arbiter of the registrability of the "SCORE" portion of J.W. Pepper's mark MY SCORE.

ARGUMENT

I. NO DISCLAIMER

In this case, the Examining Attorney has requested that J.W. Pepper disclaim the allegedly descriptive word "SCORE" apart from the mark as shown. While J.W. Pepper has responded on two occasions arguing that its mark constitutes a suggestive mark that is registrable without disclaimer of "SCORE," the Examining Attorney ultimately made final her original disclaimer requirement. As a result, J.W. Pepper appeals to the T.T.A.B. to reverse the disclaimer requirement. In the final analysis, the question presented here is fundamental: Did the Examining Attorney err in requiring a disclaimer of the allegedly descriptive term "SCORE," ignoring clearly established legal

precedent that all doubts concerning registration are to be resolved in Applicant's favor?

A. "SCORE" Portion of MY SCORE Is Not Merely Descriptive

There is no support for disclaimer of "SCORE" from J.W. Pepper's composite mark. In her Office Actions, the Examining Attorney required that Applicant enter a disclaimer of exclusive rights to the wording "SCORE" on the ground that such wording is allegedly merely descriptive of the recited services. Relying on dictionary definitions for "SCORE," together with inapposite references to music scores from Applicant's website and third-party websites, the Examining Attorney ignored J.W. Pepper's own Application Serial No. 85/708,700 for MY SCORE YOUR MUSIC. OUR NETWORK., which had been approved for registration as of the date of Applicant's Request for Reconsideration, and engaged in mental leaps that are the hallmark of a suggestive trademark.

1. The Standard for Descriptiveness

The Examining Attorney does not provide a convincing basis for the disclaimer requirement. An understanding and appreciation for descriptiveness, however, is essential to the case at hand.

In addressing the subject of descriptive wording, in the case In re Gyulay, 820 F.2d 1216 (Fed. Cir. 1987), the Federal Circuit recognized the language of the Trademark Trial and Appeal Board establishing that descriptiveness refusals are

relevant when "the mark merely describes a significant characteristic of the goods." 820 F.2d at 1217 (emphasis added). It is understood that this language applies to descriptiveness-based disclaimer requirements, and a key word in this language is the word significant. Indeed, the relevant characteristic in the determination of descriptiveness must be significant. It cannot logically be a minor, miniscule, or deeply shrouded characteristic. This is a fundamental point not to be overlooked.

The language of the Federal Circuit continues as follows: "Whether a given mark is suggestive or merely descriptive depends on whether the mark 'immediately conveys . . . knowledge of the ingredients, qualities, or characteristics of the goods . . . with which it is used', or whether 'imagination, thought, or perception is required to reach a conclusion on the nature of the goods.' In re Quik-Print Copy Shops, Inc., 616 F.2d 523, 525, 205 U.S.P.Q. (BNA) 505, 507 (C.C.P.A. 1980). The categories are in actuality 'central tones in a spectrum . . . and are frequently difficult to apply.'" Id. at 1217 (citation omitted). It is clear, therefore, that a mark or portion thereof must immediately convey knowledge to support a request to disclaim that portion. The commercial impression cannot be a time-consuming, tenuous, or pensive connection -- it must be immediate.

The case, In re Application of ABCOR Development Corp., 588 F.2d 811 (C.C.P.A. 1978), sets forth a general explanation of the differences between merely descriptive marks and suggestive marks:

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) (3rd ed. 2002); 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.

As such, where a mark or portion thereof neither immediately conveys knowledge about a characteristic of the recited services, nor is that characteristic significant from the relevant consumer's viewpoint, the mark or portion must be found to fail to satisfy the legal standard for descriptiveness

and, accordingly, must be held registrable without the necessity for a disclaimer.

2. "SCORE" Is Not Descriptive Under the Appropriate Standard

Applicant respectfully submits that, based on the standard established by the foregoing rules and case law, its service mark is an ideal example of an entirely suggestive mark, from which no disclaimer should be required.

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; however, 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.

3. Applicant's Principal Registration

Through prior submissions, and as alluded to earlier in this Brief, J.W. Pepper has emphasized that its prior registration for MY SCORE YOUR MUSIC. OUR NETWORK., U.S. Reg. No. 4,471,837, supports J.W. Pepper's position 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.

While Applicant recognizes that past determinations of the Trademark Office are not officially determinative of pending prosecutions, J.W. Pepper's own registration, MY SCORE YOUR MUSIC. OUR NETWORK., U.S. Reg. No. 4,471,837 for "on-line retail store services featuring printed or digital sheet music," does not disclaim the word "SCORE" and is nevertheless instructive here. J.W. Pepper's use of "SCORE" in connection with "on-line retail store services featuring printed or digital sheet music" is not merely descriptive. It is simply part of suggestive source-identifier, and has proved its role as a part of the unique source identifier MY SCORE YOUR MUSIC. OUR NETWORK.

While J.W. Pepper recognizes that each case must be decided based on the evidence before the Trademark Office, the P.T.O. has always maintained that consistency in examination is an important, if not crucial role of the Trademark Office. See In re Litehouse Inc., 82 U.S.P.Q.2d 1471 (T.T.A.B. 2007) (Court

encourages the PTO to achieve a uniform standard for assessing registrability of marks); see also In re Rodale Inc., 80 U.S.P.Q.2d 1696, 1700 (T.T.A.B. 2006) (Board recognized that consistency in examination is a goal of the Office); and In re Finisair Corp., 78 U.S.P.Q.2d 1618, 1621 (T.T.A.B. 2006) (Board recognized that uniform treatment during examination is a goal of the PTO).

B. Examining Attorney Improperly Failed To View All Evidence In The Light Most Favorable To Applicant

A trademark or service mark is statutorily defined as "[a]ny word, name, symbol, or device, or any combination thereof . . . used by a person . . . to identify and distinguish his or her goods . . . from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown." 15 U.S.C. § 1127 (2001). "[T]he primary function of a trademark is to identify and distinguish the goods or services of one source from those sold by all others." Bell South Corp. v. Data National Corp., 60 F.3d 1565, 1569 (Fed. Cir. 1995). "In order to be registered a mark must be capable of distinguishing the Applicant's goods from those of others." Two Pesos, Inc. v. Taco Cabana, Inc., 505 U.S. 763, 768, reh'g denied, 505 U.S. 1244 (1992).

It follows that the two principal concerns of trademark law, both of which promote competition, are: (i) to protect

consumers against confusion and monopoly; and (ii) to protect the investment of producers in their trade names in which goodwill may have accrued. Union Nat'l Bank of Texas, Laredo, 909 F.2d at 843-44; see also Park 'N Fly, Inc. v. Dollar Park 'N Fly, Inc., 469 U.S. 189, 198 (1985) ("[T]rademarks foster competition and the maintenance of quality by securing to the producer the benefits of the good reputation.")

Under such circumstances, the Patent and Trademark Office should have a strong preference for allowing for full registration of a mark where "[d]enial of registration does not deny the owner the right to use the mark, and thus will not serve to protect the public from confusion." In re Four Season Hotel, Ltd., 987 F.2d 1565, 1566 (Fed. Cir. 1993). Put another way, the Trademark Office's rule is to protect the owner of trademarks by allowing them to register their marks, not to make them disclaim matter. Id.

This principle is why the strong weight of authority leans toward registration. In fact, the Court of Customs and Patent Appeals has long cautioned against the overzealous policy of the Trademark Examining Operation, as evidenced in the case In re Nat'l Distillers & Chem. Corp., when it observed that:

[I]n speaking of the law enacted to protect trademark owners, there is considerable risk of error in pursuing a policy under which the administrative agency deems itself to be guarding the public interest whenever it refuses to register. It properly guards

those interests only when such refusal truly furthers those interests. They are not furthered by denying registration to an established, widely used trademark.

In re Nat'l Distillers & Chem. Corp., 297 F.2d 941, 953 (C.C.P.A. 1962). Thus, as applied here, the clear weight of authority is to resolve the doubt in J.W. Pepper's favor and publish the mark for opposition without disclaimer. After all, "any person who believes that he would be damaged by the registration will have an opportunity . . . to oppose the registration of the mark and to present evidence," In re Gourmet Bakers, Inc., 173 U.S.P.Q. 565, 565 (T.T.A.B. 1972).

As the Federal Circuit stated in the case, In re Merrill Lynch, Pierce, Fenner, & Smith, Inc., 828 F.2d 1567, 1571 (Fed. Cir. 1987), "[i]t is incumbent on the Board to balance the evidence of public understanding of the mark against the degree of descriptiveness encumbering the mark, and to resolve reasonable doubt in favor of the applicant, in accordance with practice and precedent." In its reasoning, the Court relied upon the case, In re Application of Aid Labs., Inc., 221 U.S.P.Q. 1215, 1216 (T.T.A.B. 1983), which held the mark PEST PRUF to be suggestive of a possible end result of use of identified goods, and not merely descriptive, for animal shampoo with insecticide, thereby resolving doubt in favor of the applicant. "Where there is doubt on the matter, the doubt should be resolved in applicant's behalf and the mark should be published in

accordance with Section 12(c) of the [Lanham] Statute for purposes of opposition." Id.; see also In re The Gracious Lady Service, Inc., 175 U.S.P.Q. 380, 382 (T.T.A.B. 1972) ("It is recognized that there is a large gray area in determining the descriptiveness of a mark, and where reasonable men may differ, it has been the practice to resolve such doubt in an applicant's behalf and publish the mark for opposition purposes"); and In re Entenmann's Inc., 15 U.S.P.Q.2d 1750, 1751 n.2 (affirming decision under Section 2(e)(1) but recognizing "that in ex parte cases involving a refusal to register on the basis of mere descriptiveness, it is the practice of this Board to resolve doubts in the favor of the applicant and pass the mark to publication").

J.W. Pepper respectfully requests the T.T.A.B. to remand this case to the Examining Attorney with instructions to withdraw the disclaimer requirement, in keeping with the general public policy favoring registration. In re Bush Brothers & Co., 12 U.S.P.Q. 2d 1058, 1059 (Fed. Cir. 1989) (DELUXE for canned pork and beans found capable of functioning as a trademark). The term "SCORE" is clearly a suggestive and registrable component of Applicant's mark, such that disclaimer is inappropriate.

CONCLUSION

For the foregoing reasons, Applicant, J.W. Pepper & Son, Inc., respectfully requests that the T.T.A.B. reverse the Examining Attorney's disclaimer requirement for the "SCORE" portion of the mark, and remand the case to the Examining Attorney for approval for publication without a disclaimer.

Respectfully submitted,

J.W. Pepper & Son, Inc.

Dated: April 16, 2014

By: 

Timothy D. Pecsénye
Matthew A. Homyk
BLANK ROME LLP
One Logan Square
Philadelphia, PA 19103
(215) 569-5619