

This Opinion is not a
Precedent of the TTAB

Mailed: August 27, 2014

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re US Digital Media, Inc.

Serial Nos. 85752995 and 85753010

Carey Brandt Anthony of Venable, Campillo, Logan & Meaney, P.C. for US Digital Media, Inc.

Marynelle W. Wilson, Trademark Examining Attorney, Law Office 113 (Odette Bonnet, Managing Attorney).¹

Before Seeherman, Cataldo and Shaw,
Administrative Trademark Judges.

Opinion by Cataldo, Administrative Trademark Judge:

US Digital Media, Inc. (“Applicant”) filed applications to register as marks on the Principal Register BUD BAG and EAR BUD BAG (in standard characters) for goods identified as “ear bud accessory, namely, ear bud case” in International Class 9.²

¹ Both applications originally were examined by a different Examining Attorney, and subsequently were reassigned to the above Examining Attorney for briefing.

² Application Serial Nos. 85752995 and 85753010, both filed on October 12, 2012, based upon Applicant’s assertion of a bona fide intent to use the mark in commerce.

The Trademark Examining Attorney issued a final refusal of registration to both applications under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), on the ground that Applicant's proposed marks, when used in connection with Applicant's goods, are merely descriptive thereof.³ Applicant appealed. Applicant and the Examining Attorney filed briefs.

Proceedings Consolidated

When, as here, Applicant has filed *ex parte* appeals to the Board in two co-pending applications, and the cases involve common issues of law or fact, the Board, upon request by the Applicant or Examining Attorney or upon its own initiative, may order the consolidation of the appeals for purposes of briefing, oral hearing, and/or final decision. TBMP § 1214 (2014). *See also, e.g., In re Anderson*, 101 USPQ2d 1912, 1915 (TTAB 2012) (Board *sua sponte* consolidated two appeals); *In re Country Music Association, Inc.*, 100 USPQ2d 1824, 1827 (TTAB 2011) (same); *In re Bacardi & Co. Ltd.*, 48 USPQ2d 1031, 1033 (TTAB 1997) (Board *sua sponte* considered appeals in five applications together and rendered single opinion). Accordingly, the Board consolidates these appeals. References to the record refer to Application Serial No. 85752995 unless otherwise indicated.

³ We observe that while the Examining Attorney advised Applicant in her February 18, 2013 Office Action that its proposed marks may be generic, that issue is not before us.

We further observe that Applicant noted in its briefs (p. 8) that the Examining Attorney could have required a disclaimer as to some portion of the applied-for marks. However, apparently because the Examining Attorney viewed the marks in their entirety as merely descriptive, she made no such requirement and that issue also is not before us.

Mere Descriptiveness

A mark is deemed to be merely descriptive of goods or services, within the meaning of Section 2(e)(1), if it forthwith conveys an immediate idea of an ingredient, quality, characteristic, feature, function, purpose or use of the goods or services. *In re Chamber of Commerce of the United States of America*, 675 F.3d 1297, 102 USPQ2d 1217 (Fed. Cir. 2012); *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 82 USPQ2d 1828 (TTAB 2007); and *In re Abcor Development*, 588 F.2d 811, 200 USPQ 215, 217-18 (CCPA 1978). A mark need not immediately convey an idea of each and every specific feature of an applicant's goods or services in order to be considered merely descriptive; rather, it is sufficient that the mark describes one significant attribute, function or property of the goods or services. *In re H.U.D.D.L.E.*, 216 USPQ 358 (TTAB 1982); and *In re MBAssociates*, 180 USPQ 338 (TTAB 1973).

Whether a mark is merely descriptive is determined not in the abstract, but in relation to the goods or services for which registration is sought, the context in which it is being used on or in connection with the goods or services, and the possible significance that the mark would have to the average purchaser of the goods or services because of the manner of its use. *In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979). "The question is not whether someone presented with only the mark could guess what the goods or services are. Rather, the question is whether someone who knows

what the goods or services are will understand the mark to convey information about them.” *In re Tower Tech Inc.*, 64 USPQ2d 1314, 1316-17 (TTAB 2002).

In support of the refusal of registration, the Examining Attorney has made of record the following dictionary definitions of “earbud” – “a small earphone worn in the ear for use with audio devices”⁴ and “bag” – a container of flexible material, such as paper, plastic, or leather, that is used for carrying or storing items.”⁵ In addition, we hereby grant the Examining Attorney’s request in her brief to take judicial notice of the following definition of “bud” – “an earbud.”⁶

The examining attorney further has made of record evidence from commercial and informational internet websites in which terms comprising the proposed marks are used to describe the goods identified in the involved applications. The following examples are illustrative (emphasis supplied by Examining Attorney):

Abstract coin purse, money bag, or **earbud bag**.
Great pouch for gym bag, knapsack or for jogging. \$8.00

⁴ February 18, 2013 Office Action.

⁵ September 10, 2013 Office Action.

⁶ The American Heritage Dictionary of the English Language, 5th ed. (2014). The Board may take judicial notice of dictionary definitions, including those in online dictionaries which exist in printed format. *In re Premiere Distillery, LLC*, 103 USPQ2d 1483, 1484 (TTAB 2012); *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.*, 213 USPQ 594 (TTAB 1982), *aff’d*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

(loveitsomuch.com)⁷

Survivor's Prep Boards.

Condor Urban Go Bag

The main compartment is huge. There is zippered netting on the flap part for storage. There is a "map" compartment on the back. The main part is really nice and roomy. This is also the place a water bladder is intended to go. It uses the **ear bud bag** holes (there is a separate MP3 player pouch) to route the hose.

(survivorsprepboard.com)⁸

Earphones and **Earbuds**

Earbuds, **buds**, earphones...whatever you call them, in-ear headphones have become the standard for active listening since the invention of the portable MP3 player. At Skullcandy, we separate them into two categories: **buds**, which sit just inside the ear and allow some ambient noise to filter in, and in-ears, which fit deep into the ear canal and isolate the listener from the outside world.

(skullcandy.com)⁹

Single Earphones by Far End Gear

These single **bud** earphones make it safe and convenient to run on the trails and be aware of other trail users including hungry bears. The headphone mixes both channels of sound from a stereo audio device into a single ear.

(trailrunnernation.com)¹⁰

1-BUD Single-Ear Stereo Earphones w/ 3.5mm Plug and 3 sizes of rubber eartips – for MP3 Players, Tablets, and all Apple iPod, iPhone and iPad Models – Black

This little single **bud** is perfect for when I need to hear something, as well as for occasionally listening to music without tuning out my surroundings.

(amazon.com)¹¹

⁷ February 18, 2013 Office Action.

⁸ *Id.*

⁹ *Id.*

¹⁰ September 10, 2013 Office Action.

¹¹ *Id.*

Based upon the dictionary definitions submitted by the Examining Attorney, we find “bud” to be a synonym for “ear bud” and the plain meaning of BUD BAG or EAR BUD BAG to be a container, or “bag”, for storing and carrying “ear buds” or “buds.” In addition, the internet evidence submitted by the Examining Attorney shows the term “ear bud bag” or “earbud bag” is used to describe a container for ear buds or buds. As noted above, Applicant’s goods are identified as an “ear bud accessory, namely, ear bud case”. The evidence of record clearly establishes that third parties use the term “bud” as a synonym for “ear bud” and also use the term “ear bud bag” to describe cases used to store and carry ear buds. Thus, the evidence of record establishes that Applicant’s mark merely describes the identified goods.

Where each component term comprising a mark retains its merely descriptive significance in relation to the goods or services, the combination results in a composite that is itself merely descriptive. *See, e.g. DuoProSS Meditech Corp. v. Inviro Medical Devices, Ltd.*, 695 F.3d 1247, 103 USPQ2d 1753 (Fed. Cir. 2012) (SNAP SIMPLY SAFER merely descriptive for medical devices); and *In re Oppedahl & Larson LLP*, 71 USPQ2d 1379, 1372 (Fed. Cir. 2004) (PATENTS.COM merely descriptive of computer software for managing a database of records that could include patents for tracking the status of the records by means of the Internet). In this case, the evidence of record establishes that Applicant’s proposed marks, comprised of the descriptive terms EAR BUD or BUD and BAG, merely describes Applicant’s

goods. Even if Applicant is the first user of the terms BUD BAG or EAR BUD BAG in connection with its goods, it is well settled that such does not entitle Applicant to the registration thereof where, as here, the term has been shown to immediately convey only a merely descriptive significance in the context of Applicant's goods. *See, e.g., In re National Shooting Sports Foundation, Inc.*, 219 USPQ 1018, 1020 (TTAB 1983); and *In re Mark A. Gould, M.D.*, 173 USPQ 243, 245 (TTAB 1972).

We find that the terms BUD BAG and EAR BUD BAG “immediately convey[s] knowledge of a quality, feature, function, or characteristic of the goods or services with which it is used.” *In re Bayer Aktiengesellschaft*, 82 USPQ2d at 1831, citing *In re Gyulay*, 820 F.2d 1216, 1217, 3 USPQ2d 1009 (Fed. Cir. 1987).

Decision: The refusal to register is affirmed as to both applications.