

ESTTA Tracking number: **ESTTA602469**

Filing date: **05/05/2014**

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

Proceeding	85753010
Applicant	US Digital Media, Inc.
Applied for Mark	EAR BUD BAG
Correspondence Address	CAREY BRANDT ANTHONY VENABLE, CAMPILLO, LOGAN & MEANEY, P.C. 1938 E OSBORN RD PHOENIX, AZ 85016-7234 UNITED STATES pto_cba@vclmlaw.com
Submission	Appeal Brief
Attachments	2014-05-05 Appeal Brief.pdf(379044 bytes)
Filer's Name	Carey Brandt Anthony
Filer's e-mail	pto_cba@vclmlaw.com
Signature	/Carey Brandt Anthony/
Date	05/05/2014

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

In re Application of:

US Digital Media, Inc.

Serial No.: 85/753010

Filed: October 12, 2012

Mark: EAR BUD BAG

Law Office: 113

Examiner: N. Gretchen Ulrich

Appeal No.

Commissioner of Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

APPELLANT'S BRIEF

This is an appeal from the final rejection of the Examiner dated September 10, 2013 for the above mark.

TABLE OF CONTENTS

DESCRIPTION OF THE RECORD3

STATEMENT OF ISSUES4

RECITATION OF FACTS5

ARGUMENT6

A. Because Applicant’s composite mark requires imagination as to the nature of Applicant’s goods, it is not descriptive, but rather suggestive.....6

B. Applicant’s composite mark is not a mere combination of descriptive words; it is a composite that creates a new and unique commercial impression.6

C. Because Applicant’s composite mark will not inhibit competition for similar services or otherwise limit the freedom of the public to use the language, none of the usual descriptive-mark concerns are present.7

DESCRIPTION OF THE RECORD

The intent-to-use application, Serial No. 85/753010, was filed on October 12, 2012, for the mark, “EAR BUD BAG,” in International Class 009. The listing of goods included: “Ear bud accessory, namely, ear bud case in International Class 009.”

On February 18, 2013, the Examiner rejected the mark under Trademark Act Section 2(e), 15 U.S.C. §1052(d), alleging the mark was merely descriptive. The Examiner also required the Applicant to submit specific information regarding the identified goods.

The Applicant responded to the Examiner’s rejections in a response dated August 19, 2013. In response to the Examiner’s merely descriptive, the Applicant submitted substantive arguments to respond to the Examiner’s rejection. The Applicant also submitted the information requested by the Examiner regarding the listing of goods.

The Examiner issued a final rejection of the mark, “EAR BUD BAG,” in International Class 009, in an Office Action dated September 10, 2013. In the Office Action, the Examiner maintained and made final the merely descriptive refusal under Section 2(e).

STATEMENT OF ISSUES

The Examiner's rejection of Applicant's mark, "EAR BUD BAG," pursuant to 15 U.S.C. §1502(e) is considered improper.

RECITATION OF FACTS

The facts are as stated in the Description of the Record.

ARGUMENT

A. Because Applicant's composite mark requires imagination as to the nature of Applicant's goods, it is not descriptive, but rather suggestive.

The more imagination that is required on the customer's part to understand a direct description of the product or service from the trademark, the more likely the term is suggestive, not descriptive.¹ Suggestive terms require the customer to use thought, imagination, or perception to connect the mark with the product.² Descriptive terms directly convey to the customer the ingredients, qualities, or characteristics of the product.³ Under this imagination test, the question is how immediate and direct is the thought process from the mark to the particular characteristic of the product.⁴ If a multi-stage reasoning process is required to determine attributes of the product, the term is suggestive and not descriptive.⁵

Here, the mark EAR BUD BAG requires thought, imagination, or perception to connect the mark with an ear bud case. The mark EAR BUD BAG is suggestive because it requires a mental leap from the mark to the product. The term EAR BUD BAG does not conjure up in the customer's mind Applicant's product. Specifically, an ear bud case is not the immediate mental image produced by the term EAR BUD BAG. A definite mental leap is required between the term EAR BUD BAG and Applicant's products. As such, the mark EAR BUD BAG is at least suggestive. Thus, the composite EAR BUD BAG mark is not merely descriptive and should be allowed on the principal register.

B. Applicant's composite mark is not a mere combination of descriptive words; it is a composite that creates a new and unique commercial impression.

It is not uncommon for a combination of two or more admittedly descriptive elements to be joined to create a non-descriptive composite mark.⁶ That is, the commercial impression of a composite mark may be arbitrary or suggestive even though its separate parts are

¹ See *Educational Development Corp. v. Economy Co.*, 562 F.2d 26, 29 (10th Cir. 1977).

² *Id.*

³ *Id.*

⁴ *AMF Inc. v. Sleekcraft Boats*, 599 F.2d 341, 349 (9th Cir. 1979).

⁵ See, *Rodeo Collection, Ltd. v. West Seventh*, 812 F.2d 1215, 1218 (9th Cir. 1987).

⁶ *Q-Tips, Inc. v. Johnson & Johnson*, 206 F.2d 144 (3rd cir. 1953), cert. denied 346 U.S. 867 (1953).

descriptive.⁷ For example, the Federal Circuit did not consider SUPERWATERFINISH to be so highly descriptive as to be incapable of registration for paper goods even though the mark was (1) composed of three descriptive words, (2) the term “WATER FINISH” admittedly had a well-known meaning in the paper industry and (3) the term “SUPER” did not in any way change the inherent meaning of the term “WATER FINISH.”⁸ Together, the mere combination of these three descriptive words was held non-descriptive.⁹

When two or more descriptive terms are combined, the critical question is whether the combination of terms evokes a new and unique commercial impression.¹⁰ The relevant commercial impression is that of the mark “in its entirety” and not the commercial impressions of its dissected parts.¹¹ If a new and unique commercial impression is created, the mark is capable of functioning as a trademark and entitled to registration on the principal register.¹²

In this case, Applicant seeks to register the mark EAR BUD BAG. Applicant’s mark is even more distinctive for an ear bud carrying case than SUPERWATERFINISH was for paper having a super water finish. Applicant’s mark is not merely the combination of descriptive terms. By inspection, the mark applied for creates a new and unique commercial impression when used in connection with ear bud carrying cases. Thus, the mark is inherently capable of functioning as a trademark and entitled to registration on the principal register.

C. Because Applicant’s composite mark will not inhibit competition for similar services or otherwise limit the freedom of the public to use the language, none of the usual descriptive-mark concerns are present.

Merely descriptive marks are not initially eligible for the principal register for two reasons: (1) to prevent the owner of a mark from inhibiting competition in the sale of particular goods; and (2) to maintain freedom of the public to use the language involved, thus

⁷ *Id.*

⁸ *In re Chesapeake Corp. of Virginia*, 420 F.2d 754 (C.C.P.A. 1970); *accord, Minnesota Mining & Mfg. Co. v. Johnson & Johnson*, 454 F.2d 1179 (C.C.P.A. 1972) (J. Baldwin concurring) (SKINVISIBLE for transparent adhesive tape not merely descriptive); *Firestone Tire & Rubber Co. v. Goodyear Tire & Rubber Co.*, 186 U.S.P.Q. 557 (T.T.A.B. 1975), *aff’d*, 189 U.S.P.Q. 348 (C.C.P.A. 1976)(BIASTEEL for steel belted bias tires held only suggestive).

⁹ *In re Chesapeake Corp. of Virginia*, 420 F.2d at 756.

¹⁰ TMEP 1209.03(d).

¹¹ *Estate of P.D. Beckwith, Inc. v. Comm’r of Patents*, 252 U.S. 538, 546 (1920)(the “anti-dissection rule”).

¹² *Id.*

avoiding the possibility of harassing infringement suits by the registrant against others who use the mark when advertising or describing their own products.¹³ Those concerns are not present here.

In this case, Applicant seeks to register the composite mark EAR BUD BAG. Moreover, registration on the principal register will never provide Applicant with the right to exclude others from using the terms “EAR,” “BUD” or “BAG.” Applicant will only gain the right to prevent others from using the unitary composite mark “EAR BUD BAG” or something confusingly similar in association with similar goods. Therefore, allowing this mark will not offend the major reasons for not protecting merely descriptive marks because the applicant will gain no rights to use the constituent elements apart from the composite arrangement.

Although unnecessary, Examiner could simply require a disclaimer apart from the mark as shown. The Federal Circuit has explained that the Lanham Act’s disclaimer requirement strikes a statutory balance between two competing trademark principles. The Act permits one to register a composite mark containing unregistrable components while at the same time preventing the applicant from claiming the exclusive rights to the disclaimed portions apart from the composite as a whole.¹⁴ While it is obviously not possible to disclaim all of a mark and still register it, it is possible to disclaim all the separate components of a composite mark and still have a registrable whole of the composite itself.¹⁵

In sum, when Applicant’s mark is viewed in its unitary whole, Applicant’s mark creates a distinct commercial impression. For these reasons, Applicant respectfully requests that its mark be allowed registration on the principal register.

¹³ See *In re Abcor Dev. Corp.*, 588 F.2d 811, 813 (CCPA 1978) (“The major reasons for not protecting such [merely descriptive] marks are: (1) to prevent the owner of a mark from inhibiting competition in the sale of particular goods; and (2) to maintain freedom of the public to use the language involved, thus avoiding the possibility of harassing infringement suits by the registrant against others who use the mark when advertising or describing their own products.”).

¹⁴ *Dena Corp. v. Belvedere Int’l, Inc.*, 950 F.2d 1555 (Fed. Cir. 1991).

¹⁵ *United States Steel Corp. v. Vasco Metals Corp.*, 394 F.2d 1009 (C.C.P.A. 1968).

SUMMARY

For the reasons stated above, Applicant requests that its mark, "EAR BUD BAG" be allowed to register on the Principal Register. Applicant's mark is not merely descriptive or generic. Thus, Applicant's mark, "EAR BUD BAG" should be allowed to register on the Principal Register.

Respectfully submitted,

Date: May 5, 2014

/Carey Brandt Anthony/
Carey Brandt Anthony
Venable, Campillo, Logan & Meaney, P.C.
Attorneys for Applicant
1938 E. Osborn Road
Phoenix, Arizona 85016
(602) 631-9100

CERTIFICATE OF TRANSMISSION

I hereby certify that this correspondence is being sent via the Electronic System for Trademark Trials and Appeals.

on May 5, 2014

By: /Carey Brandt Anthony/