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Subject: U.S. TRADEMARK APPLICATION NO. 85792870 - QUARRIER - 80027.0006 - EXAMINER BRIEF

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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NO. 85792870

MARK: QUARRIER



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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: Golden Software, Inc.

CORRESPONDENT'S REFERENCE/DOCKET NO:

80027.0006

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EXAMINING ATTORNEY'S APPEAL BRIEF

FACTS

The applicant has appealed the examining attorney's final refusal to register the mark QUARRIER for "computer aided manufacturing (CAM) software for production planning and inventory management for the aggregate industry, namely, CAM software for production scheduling and equipment

optimization.” Registration is refused pursuant to Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1) because the mark is merely descriptive. This appeal follows the Examining Attorney’s final refusal under Section 2(e)(1).

ARGUMENT

A mark is merely descriptive if it describes an ingredient, quality, characteristic, function, feature, purpose, or use of an applicant’s goods. TMEP §1209.01(b); *see, e.g., In re TriVita, Inc.*, 783 F.3d 872, 874, 114 USPQ2d 1574, 1575 (Fed. Cir. 2015) (quoting *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 1173, 71 USPQ2d 1370, 1371 (Fed. Cir. 2004)); *In re Steelbuilding.com*, 415 F.3d 1293, 1297, 75 USPQ2d 1420, 1421 (Fed. Cir. 2005) (citing *Estate of P.D. Beckwith, Inc. v. Comm’r of Patents*, 252 U.S. 538, 543 (1920)).

A mark is suggestive if some imagination, thought, or perception is needed to understand the nature of the goods described in the mark; whereas a descriptive term immediately and directly conveys some information about the goods. *See Stoncor Grp., Inc. v. Specialty Coatings, Inc.*, 759 F.3d 1327, 1332, 111 USPQ2d 1649, 1652 (Fed. Cir. 2014) (citing *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 1251-52, 103 USPQ2d 1753, 1755 (Fed. Cir. 2012)); TMEP §1209.01(a).

Determining the descriptiveness of a mark is done in relation to an applicant’s goods, the context in which the mark is being used, and the possible significance the mark would have to the average purchaser because of the manner of its use or intended use. *See In re The Chamber of Commerce of the U.S.*, 675 F.3d 1297, 1300, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012) (citing *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 963-64, 82 USPQ2d 1828, 1831 (Fed. Cir. 2007)); TMEP §1209.01(b). Descriptiveness of a mark is not considered in the abstract. *In re Bayer Aktiengesellschaft*, 488 F.3d at 963-64, 82 USPQ2d at 1831.

“A mark may be merely descriptive even if it does not describe the ‘full scope and extent’ of the applicant’s goods or services.” *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 1173, 71 USPQ2d 1370, 1371 (Fed. Cir. 2004) (citing *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 1346, 57 USPQ2d 1807, 1812 (Fed. Cir. 2001)); TMEP §1209.01(b). It is enough if a mark describes only one significant function, attribute, or property. *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 *In re Oppedahl & Larson LLP*, 373 F.3d at 1173, 71 USPQ2d at 1371.

A mark that describes an intended user or group of users of a product or service is merely descriptive. *E.g.*, *In re Planalytics, Inc.*, 70 USPQ2d 1453 (TTAB 2004) (holding GASBUYER merely descriptive of intended user of risk management services in the field of pricing and purchasing natural gas); *In re Camel Mfg. Co.*, 222 USPQ 1031 (TTAB 1984) (holding MOUNTAIN CAMPER merely descriptive of intended users of retail and mail order services in the field of outdoor equipment and apparel); see TMEP §1209.03(i).

The dictionary evidence submitted by both the examining attorney with each office action and the applicant in its responses shows that a “quarrier” is a “quarryman” or a person who works in or who manages a quarry. When one considers the context in which the applicant’s mark is being used or is intended to be used and the possible significance the mark would have to the average purchaser because of the manner of its use or intended use, the descriptive nature of the mark is immediately apparent. The applicant’s software is used in the aggregate industry which would include quarries. The relationship between the aggregate industry and quarries was shown through evidence submitted by the examining attorney in her office action dated April 29, 2015. This evidence shows that the aggregate industry relies on quarries for the excavation of various types of aggregates. For example, the CEMEX article discusses how rock, sand and gravel quarries operate for the extraction of aggregates.

Consumers within the aggregate industry who work within quarries would readily understand the term “quarrier” to refer to individuals who work in quarries. The applicant has not indicated during the course of the prosecution of this application that its goods are not for use in the quarry industry. The proposed mark describes the intended user or group of users of the applicant’s software. This results in the mark being merely descriptive as a matter of law.

The argument made by the applicant that the mark is at most suggestive is not persuasive. The applicant states that “it is evident that the mark QUARRIER does not instantaneously invoke the Applicant’s goods.” Applicant’s Brief at 7. The applicant agrees that quarrier is someone who works at a stone quarry and a “quarry” is an open excavation site for obtaining stone, slate or limestone. Based upon these definitions, the applicant concludes that it cannot be “instantaneously evident” that the applicant’s goods are computer-aided software. The applicant goes on to argue that even though the software is for use in the aggregate industry, imagination is still required “to associate the mark QUARRIER with software.” Applicant’s Brief at 7. The applicant further contends that the software cannot physically perform the functions that a quarrier would perform since it “cannot physically excavate stone as a quarrier. . .” Applicant’s Brief at 7. This argument is not persuasive. The mark is not suggestive. The mark need not refer directly to the goods themselves. The mark is descriptive because it immediately and without the need to resort to imagination describes the user or group of users of the applicant’s software. This characteristic is sufficient to support a finding that the mark is descriptive.

The applicant also argues that competitors would not have a need to use “quarrier” to describe software similar to the applicant’s and that a number of competitors currently offer similar software without the need to use “quarrier.” The applicant claims “quarrier” to be a term that is not commonly used.

Once again, this argument is not persuasive. The fact that an applicant may be the first or only user of a merely descriptive designation does not necessarily render a word or term distinctive, as in this case, where the evidence shows that the term “quarrier” is merely descriptive of a person who works at a quarry. See *In re Phoseon Tech., Inc.*, 103 USPQ2d 1822, 1826 (TTAB 2012); *In re Sun Microsystems, Inc.*, 59 USPQ2d 1084, 1087 (TTAB 2001); TMEP §1209.03(c). The fact that competitors have not chosen to use this term in connection with goods similar to those of the applicant does not lessen its descriptiveness. Further, even if the term “quarrier” is not commonly used, it is, nevertheless, a term found within modern day dictionaries and a term that those who work in the quarry industry and to whom the goods are aimed would immediately recognize as referring to an individual who works in a quarry. Thus, the term describes the users of the applicant’s goods and this renders the mark descriptive.

The applicant’s argument that the office has registered a similar mark is not persuasive. Applicant’s Brief at 8. The fact that third-party registrations exist for marks allegedly similar to applicant’s mark is not conclusive on the issue of descriptiveness. See *In re Scholastic Testing Serv., Inc.*, 196 USPQ 517, 519 (TTAB 1977); TMEP §1209.03(a). An applied-for mark that is merely descriptive does not become registrable simply because other seemingly similar marks appear on the register. *In re Scholastic Testing Serv., Inc.*, 196 USPQ at 519; TMEP §1209.03(a). It is well settled that each case must be decided on its own facts and the Trademark Trial and Appeal Board is not bound by prior decisions involving different records. See *In re Nett Designs, Inc.*, 236 F. 3d 1339, 1342, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001); *In re Datapipe, Inc.*, 111 USPQ2d 1330, 1336 (TTAB 2014); TMEP §1209.03(a). The question of whether a mark is merely descriptive is determined based on the evidence of record at the time each registration is sought. *In re theDot Commc’ns Network LLC*, 101 USPQ2d 1062, 1064 (TTAB 2011); TMEP §1209.03(a); see *In re Nett Designs, Inc.*, 236 F.3d at 1342, 57 USPQ2d at 1566.

Finally, the applicant's argument that the mark is not descriptive because the examining attorney has not submitted any evidence that "quarrier" is used to describe software fails. Applicant's Brief at 8. This type of evidence is not required. The examining attorney has clearly established that a quarrier is someone who works at a quarry. A mark is descriptive if it describes the user of an applicant's product. The applicant's software is for use by those who work in a quarry and the applicant has not submitted any arguments or evidence to the contrary. Thus, the mark is descriptive.

CONCLUSION

The mark describes an intended user or group of users of the applicant's goods and is, as a result, merely descriptive. Accordingly, based upon the reasons set forth above, the refusal to register the applicant's mark because it is merely descriptive under Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1) should be affirmed.

Respectfully submitted,

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