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Subject: U.S. TRADEMARK APPLICATION NO. 85935569 - LEFT NUT BREWING CO. - 43302-104 -
EXAMINER BRIEF

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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NO. 85935569

MARK: LEFT NUT BREWING CO.



CORRESPONDENT ADDRESS:

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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: Left Nut Brewing Company, Inc.

CORRESPONDENT'S REFERENCE/DOCKET NO:

43302-104

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EXAMINING ATTORNEY'S APPEAL BRIEF

Applicant: Left Nut Brewing Company, Inc.: BEFORE THE

Trademark: LEFT NUT BREWING CO.: TRADEMARK TRIAL

Serial No: 85935569: AND

Attorney: Peter E. Morgan: APPEAL BOARD

Address: Briskin Cross & Sanford LLC: ON APPEAL

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EXAMINING ATTORNEY'S APPEAL BRIEF

The applicant has appealed the trademark examining attorney's refusal to register the mark "LEFT NUT BREWING CO." in standard characters for beers, in Class 32, on the ground that the applied-for mark consists of or includes immoral or scandalous matter, within the meaning of Trademark Act Section 2(a), 15 U.S.C. §1052(a); *see* TMEP §1203.01.

FACTS

On May 17, 2013, the applicant filed an application on the Principal Register based on Section 1(b) intent to use for "LEFT NUT BREWING CO." in standard characters for beers, in Class 32. On September 5, 2013, the examining attorney issued a non-final office action refusing registration because the mark consists of or includes immoral or scandalous matter within the meaning of Trademark Act Section 2(a). In addition, the examining attorney listed earlier filed Application Serial No. 85912726 as a potential likelihood of confusion cite and required a disclaimer of "BREWING CO.". On March 4, 2014, the applicant filed a response in which it argued against the Section 2(a) refusal, argued against the potential likelihood of confusion of earlier filed Application Serial No. 85912726, and submitted the disclaimer of "BREWING CO.". On March 5, 2014, the examining attorney suspended the application pending the disposition of earlier filed U.S. Application Serial No. 85912726, accepted the disclaimer, and continued the Section 2(a) refusal. On September 8, 2014, the examining attorney issued a final refusal based on Section 2(a) and withdrew U.S. Application Serial No. 85912726 as a potential likelihood of confusion cite, as it had been abandoned. On March 9, 2015, the applicant filed an appeal

and a request for reconsideration. On March 12, 2015, the examining attorney denied the request for reconsideration. The Board then resumed the appeal.

ARGUMENT

THE PROPOSED MARK “LEFT NUT BREWING CO.” CONTAINS THE SCANDALOUS TERM “LEFT NUT”.

For a mark to be “scandalous,” the evidence must show that the mark would be considered shocking to the sense of decency or propriety, giving offense to the conscience or moral feelings, or calling out for condemnation. *In re Fox*, 702 F.3d 633, 635, 105 USPQ2d 1247, 1248 (Fed. Cir. 2012) (quoting *In re Mavety Media Grp. Ltd.*, 33 F.3d 1367, 1371, 31 USPQ2d 1923, 1925 (Fed. Cir. 1994)); see TMEP §1203.01.

A mark is scandalous when the evidence demonstrates that a substantial composite of the general public (although not necessarily a majority) would consider the mark to be scandalous in the context of contemporary attitudes and the relevant marketplace. See *In re Fox*, 702 F.3d 633, 635, 105 USPQ2d 1247, 1248 (Fed. Cir. 2012) (quoting *In re Mavety Media Grp. Ltd.*, 33 F.3d 1367, 1371, 31 USPQ2d 1923, 1925-26 (Fed. Cir. 1994)); *In re The Boulevard Entm’t, Inc.*, 334 F.3d 1336, 1340, 67 USPQ2d 1475, 1477 (Fed. Cir. 2003); TMEP §1203.01. To consider the views only of a subset of the public who consume applicant’s goods and/or services is inappropriate. *In re Manwin/RK Collateral Trust*, 111 USPQ2d 1311, 1315 (TTAB 2014).

I. DICTIONARY DEFINITIONS ARE SUFFICIENT TO SHOW THAT THAT THE TERM “LEFT NUT” IS VULGAR

A. MULTIPLE DICTIONARIES, INCLUDING STANDARD DICTIONARIES, CLEARLY SHOW THAT “LEFT NUT” IS VULGAR

Evidence that a mark is vulgar is sufficient to establish that the mark is scandalous within the meaning of Trademark Act Section 2(a). *In re Fox*, 702 F.3d 633, 635, 105 USPQ2d 1247, 1248 (Fed. Cir. 2012) (citing *In re The Boulevard Entm’t, Inc.*, 334 F.3d 1336, 1340, 67 USPQ2d 1475, 1477 (Fed. Cir. 2003)); see *In re Michalko*, 110 USPQ2d 1949, 1951 (TTAB 2014); TMEP §1203.01.

Dictionary definitions alone may be sufficient to show that a term is vulgar if multiple dictionaries, including at least one standard dictionary, uniformly indicate that the term’s meaning is vulgar, and the applicant’s use of the term is clearly limited to that vulgar meaning. See *In re The Boulevard Entm’t, Inc.*, 334 F.3d at 1341, 67 USPQ2d at 1478 (holding 1-800-JACK-OFF and JACK-OFF scandalous where all dictionary definitions of “jack-off” were considered vulgar); *In re Michalko*, 110 USPQ2d at 1953 (holding ASSHOLE REPELLENT scandalous where multiple dictionary definitions of “asshole” were considered vulgar); TMEP §1203.01.

In this case, the applicant seeks registration of LEFT NUT BREWING CO. for beers, in Class 32. The evidence from the following dictionaries shows the term “LEFT NUT” is a vulgar term meaning left testicle. Therefore, the applicant’s proposed mark contains scandalous matter.

LEFT is defined as:

on the side of your body that is to the west if you are facing north

“left” Macmillan Dictionary (2010) <http://www.macmillandictionary.com> Retrieved 03/12/2015. See attachment to the 03/12/15 Office action.

NUT is defined as:

Vulgar Slang A testicle.

“nut” Yahoo! Education (2009) <http://education.yahoo.com> Retrieved 09/05/2013. See attachment to the 09/05/2013 Office action no. 1.

vulgar : [TESTIS](#)

“nut” Merriam-Webster (2010) <http://www.merriam-webster.com/>. Retrieved 09/05/2013. See attachment to the 09/05/2013 Office action no. 1.

(often pl.; **vulgar** slang) a testicle.

“nut” Wordsmyth (2013) <http://www.wordsmyth.net> Retrieved 09/05/2013. See attachment to the 09/05/2013 Office action no. 1.

SLANG the testicles: a **vulgar** usage

“nut” Webster’s New World College Dictionary (2010) <http://www.yourdictionary.com> Retrieved 09/08/2014. See attachment to the 09/08/2014 final refusal.

Vulgar Slang A testicle.

“nut” The American Heritage® Dictionary of the English Language, 5th edition (2013) <http://www.yourdictionary.com> Retrieved 09/08/2014. See attachment to the 09/08/2014 final refusal.

Urban Dictionary defines “LEFT NUT” as:

1. n. a part of one's anatomy that one would sacrifice to experience something exceptional

I'd give my friggin' left nut to see that shit!

6. the left testicle

“left nut” Urban Dictionary (2013) <http://www.urbandictionary.com> Retrieved 09/05/2013 See attachment to 09/05/2013 Office action no. 1.

The applicant objects to the use of Urban Dictionary as an evidentiary source. However, articles from the online Urban Dictionary® (urbandictionary.com) may be used to support a refusal or requirement, provided that an applicant has an opportunity to rebut such evidence. *See In re Star Belly Stitcher, Inc.*, 107 USPQ2d 2059, 2062 n.3 (TTAB 2013); TBMP §1208.03. In this case, the applicant has had the opportunity to rebut the evidence, arguing that Urban Dictionary contains some other definitions of “LEFT NUT” as well. The Urban Dictionary evidence should be considered, along with the other corroborating evidence of vulgarity from other dictionaries and websites.

B. APPLICANT’S USE OF “LEFT NUT” IS LIMITED TO ITS VULGAR MEANING

The dictionary definition evidence from multiple dictionaries, including standard dictionaries with definitions of “LEFT” and “NUT”, clearly shows that “LEFT NUT” has a vulgar meaning. The applicant argues that the mark is “ambiguous and not clearly vulgar”. Applicant’s brief, page 8. In support of its argument that the mark is ambiguous, the applicant refers to “nuttness” to describe flavor of foods and beverages, including beer, as well as referring to other meanings of “nut”, such as “fanatic”, “buff”, or “connoisseur”. Applicant’s brief, pages 14-15. The applicant contends that the meaning must be taken “in the context of the relevant mark as applied only to the claimed goods”. Applicant’s brief, page 14. However, there is no requirement in Trademark Act Section 2(a) that a mark’s vulgar meaning be the “only relevant meaning--or even the most relevant meaning.” *In re Fox*, 702 F.3d 633, 638, 105 USPQ2d 1247, 1250 (Fed. Cir. 2012) (holding the mark scandalous for chocolate lollipops in the shape of a rooster where, in the context of the goods, the mark had the non-scandalous meaning “rooster lollipop” in addition to the scandalous meaning “fellatio”). As long as a “substantial composite of the general public” would perceive the mark, in context, to have a vulgar meaning, “the mark as a whole ‘consists of or comprises . . . scandalous matter’” under Section 2(a). *In re Fox*, 702 F.3d at 638, 105 USPQ2d at 1250 (quoting 15 U.S.C. §1052(a) (emphasis added)); *In re The Boulevard Entm’t, Inc.*, 334 F.3d 1336, 1340, 67

USPQ2d 1475, 1477 (Fed. Cir. 2003). Thus, the trademark examining attorney need only prove the existence of one vulgar meaning to a substantial composite of the general public to justify a Section 2(a) refusal. *Id.*

Furthermore, the wording at issue is not "NUT" or "NUTTINESS", which on their own could refer to flavor or something else, but "LEFT NUT", which has no such meaning. The term "LEFT NUT" is a unitary term that must be considered as a whole. When "LEFT NUT" is considered as a unit, the meaning is clearly limited to the vulgar meaning referring to the left testicle. The wording "LEFT NUT" implies that there is a right nut, reinforcing that a substantial composite of the general public will perceive "LEFT NUT" as a vulgar term describing the left testicle of the testes, which consists of a left testicle and a right testicle.

II. INTERNET WEBSITE EVIDENCE SHOWS THE VULGARITY OF THE TERM "LEFT NUT"

In addition, excerpts from the following websites reinforce that "LEFT NUT" is a vulgar term understood by the substantial composite of the public to refer to the left testicle. These excerpts were attached to the 03/12/2015 Office action as a representative sample.

<http://www.theonion.com> ("The DMV Can Suck My **Left Nut**") Retrieved 03/12/15. See attachment to the 03/12/15 denial of request for reconsideration.

<http://www.huffingtonpost.com> ("Grab Your **Left Nut** for Luck") Retrieved 03/12/15. See attachment to the 03/12/15 denial of request for reconsideration.

<http://ask.metafilter.com> ("Should I Get a 2nd Opinion On My Sore **Left Nut**?...Would it be worth my while to get a second opinion about my sore left testicle?") Retrieved 03/12/15. See attachment to the 03/12/15 denial of request for reconsideration.

<http://www.epictv.com> ("Top Five Things You'd Give Your **Left Nut** to Do") Retrieved 03/12/15. See attachment to the 03/12/15 denial of request for reconsideration.

<http://www.barstoolsports.com> ("I Would Give My **Left Nut** to Play Ball and Party With This Year's Phillies Phantasy Camp Roster...Take my testical...") Retrieved 03/12/15. See attachment to the 03/12/15 denial of request for reconsideration.

<https://www.bungie.net> ("What game would you give your **left nut** (or ovary) to see remastered?") Retrieved 03/12/15. See attachment to the 03/12/15 denial of request for reconsideration.

<http://www.metrolyrics.com> ("Grab your **left nut**, make your right one jealous") Retrieved 03/12/15. See attachment to the 03/12/15 denial of request for reconsideration.

<http://www.talkingaboutmenshealth.com> ("I'd give my **left nut** if I could...chances are pretty slim that we'd actually have to sacrifice a testicle") Retrieved 03/12/15. See attachment to the 03/12/15 denial of request for reconsideration.

<http://www.someecards.com> ("Hey **left nut**?...What right nut?...Who's the penis between us?") Retrieved 03/12/15. See attachment to the 03/12/15 denial of request for reconsideration.

<http://bsgossip.com> ("Lance Armstrong Exchanged **Left Nut** for Steroids"...the former champion traded his **left nut** in exchange for steroids...mailed him his left testicle through Fed Ex") Retrieved 03/12/15. See attachment to the 03/12/15 denial of request for reconsideration.

The applicant states that "the examining attorney did not make such evidence part of the record or allow Applicant to respond to the same prior to the appeal". Applicant's brief, page 4. However, the examining attorney made the evidence of record in the 03/12/2015 denial of the request for reconsideration. Also, in a request for reconsideration, the examining attorney is permitted to introduce additional evidence directed to the issue for which reconsideration is sought. TBMP §1207.04; see *In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1200-01 (TTAB 2009); *In re Giger*, 78 USPQ2d 1405, 1406-07 (TTAB 2006); TMEP Section 715.03. The representative sample of internet website evidence above clearly shows that the term "LEFT NUT" will be understood by the public to be a vulgar term referring to a left testicle.

III. THE EXISTENCE OF PRIOR REGISTRATIONS DOES NOT JUSTIFY REGISTRATION OF ANOTHER SCANDALOUS MARK

The applicant also argues that the standard applied to the applicant in determining whether the mark is scandalous is arbitrary in light of the "many instances of nut-related marks to which the applicant has previously drawn the examining attorney's attention and which pervade the registry". Applicant's brief, page 9. The applicant also points out that other anatomical terms, such as "Save the Tas-Tas," have been registered. Applicant's brief, page 15. However, trademark examining attorneys are not bound by the actions of past examining attorneys in prior registrations, even if the registrations have some characteristics similar to the application at issue; each case is decided on its own merits. *In re Manwin/RK Collateral Trust*, 111 USPQ2d 1311, 1315 (TTAB 2014) (citing *In re Nett Designs, Inc.*, 236 F.3d 1339, 1342, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001)). The mark at issue in this case contains the clearly scandalous term "LEFT NUT", as shown by dictionary and internet website evidence. The

existence of third-party registrations that may be equally immoral or scandalous, or more immoral or scandalous, is not justification for the registration of another immoral or scandalous mark. “Even if all of the third-party registrations should have been refused registration ... such errors do not bind the USPTO to improperly register Applicant’s marks.” *In re Shinnecock Smoke Shop*, 571 F.3d 1171, 91 USPQ2d 1218, 1221 (Fed. Cir. 2009), citing *In re Boulevard Entm’t Inc.*, 67 USPQ2d at 1480. See *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001) (“Even if some prior registrations had some characteristics similar to [applicant’s] application, the PTO’s allowance of such prior registrations does not bind the board or this court.”).

CONCLUSION

For the foregoing reasons, the examining attorney respectfully requests that the Board affirm the refusal to register the mark “LEFT NUT BREWING CO.” on the basis that it is scandalous within the meaning of Trademark Section 2(a).

Respectfully submitted,

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