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

Proceeding	85973494
Applicant	San Diego Private Bank
Applied for Mark	PRIVATE BUSINESS CAPITAL
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Date	01/20/2015

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

Serial No. 85973494  
Mark: PRIVATE BUSINESS CAPITAL  
Applicant: San Diego Private Bank  
Examining Attorney: Joanna M. Shanoski  
Law Office 104

**EX PARTE APPEAL**

**APPLICANT'S BRIEF**

Applicant and Owner SAN DIEGO PRIVATE BANK (hereinafter referred to as “Applicant”) of U.S. Trademark Application Serial No. 85/973,494 for the standard character word mark “PRIVATE BUSINESS CAPITAL” respectfully submits this brief in support of publication of Serial No. 85/973,494 for “PRIVATE BUSINESS CAPITAL”.

The Examining Attorney based her refusal of publication of PRIVATE BUSINESS CAPITAL on the proposition that the mark is descriptive of applicant’s services, describing a type of private lending or private loan. With all due respect to the Examining Attorney, this analysis appears to be based on a misapplication of the legal requirements for finding a mark to be merely descriptive of the applied-for services. PRIVATE BUSINESS CAPITAL cannot describe the function or purpose of Applicant’s banking and lending services with any degree of precision, because “private business capital” has a multiplicity of meaning. At most, Applicant’s mark suggests Applicant’s services of lending and banking, and does not immediately describe the function or purpose of those services. Because thought and imagination is required to understand the nature of Applicant’s services, the mark is suggestive, and therefore registrable on the Principal Register, or in alternative, on the Supplemental Register.

Applicant submitted arguments in its Request for Reconsideration filed on October 27, 2014, that there is a distinction in meaning between “wealth” and “investment” from the actual providing of services such as banking and lending. On November 12, 2014, the Examining Attorney issued her denial of Applicant’s Request for Reconsideration maintaining that there is a claimed common meaning of PRIVATE BUSINESS CAPITAL. Applicant believes that the Examining Attorney fails to appreciate a key distinction of

the meaning raised by Applicant in its submitted Request for Reconsideration and the Examiner's claimed "common meaning" of a private lending or a loan.

To be deemed merely, descriptive, a mark must directly provide the consumer with reasonably accurate knowledge of the characteristics of the product or service in connection with which it is used. If the information about the product or service is indirect or vague, then the mark is considered suggestive, not descriptive. See J. McCarthy, *McCarthy on Trademarks and Unfair Competition* §11.19, at 11-26 (4<sup>th</sup> ed. 1998)

Applying these principals, Applicant's mark is not descriptive. PRIVATE BUSINESS CAPITAL does not immediately convey to one encountering it the nature of Applicant's services. See TMEP §1209.01(a) ("a descriptive term... immediately tells something about the goods or services"). Applicant's mark is in fact suggestive because "imagination, thought, or perception is required to reach a conclusion on the nature of the goods or services." *In re Quik-Print Shops, Inc.* 616 F.2d 523, 525, 205 U.S.P.Q. 505, 507 (C.C.P.A. 1980).

The Examining Attorney bears the burden of showing that mark is merely descriptive of the relevant goods and services. *In re Merrill, Lynch, Pierce, Fenner, and Smith, Inc.*, 828 F.2d 1567, 4 U.S.P.Q. 1141, 1143 (Fed. Cir. 1987). The Examining Attorney has not met that burden.

The Examining Attorney first listed as cited evidence in her November 12, 2014 denial an internet link to "WGFinancing.com". This evidence does not convey the Examiner's claimed common meaning of private lending or loans. In fact, at the bottom of this webpage, it references "cash advances", and goes on to state "[s]pecializing in

alternative financing, not traditional loans”. Applicant finds this website evidence cited by the examiner to support the position that PRIVATE BUSINESS CAPITAL is not descriptive for applicant’s services.

The Examining Attorney next cited as evidence in her November 12, 2014 denial of the “Business Dictionary.com” page showing a definition for “gross private domestic investment”, not a definition for “private business capital”. The use of “private business capital” in this definition references investment, and does not even mention lending or loans, let alone banking services. Further, the definition actually supports the Applicant’s previously stated position to the examiner that a common meaning of PRIVATE BUSINESS CAPITAL equates to wealth, which as stated here can take the form of investment through the purchase of property or inventory.

The Examining Attorney cited as further evidence in her November 12, 2014 denial the “Real Clear Politics” article which only used the term PRIVATE BUSINESS CAPITAL in connection with investment. In fact, the word “investment” immediately followed PRIVATE BUSINESS CAPITAL in that article, and there was no mention of lending, loans, or banking services to indicate that there is a common meaning that equates to private lending or a loan.

Cited next as additional evidence by the Examining Attorney in her November 12, 2014 denial is an article titled “Good times and easy cash long gone in Wenzhou”. The only reference to “private business capital” was in the first line of the Article, stating “The credit crisis arising from a flood of loans advanced by underground banking services looms over Wenzhou, the mainland’s private business capital.” This article uses “private business

capital” as a play on words, insinuating that the Chinese mainland city of Wenzhou is a “capital” city in respect to the credit crisis.

As to the Examiner’s last cited internet link of evidence of “Fitzandcompany.com”, use of the PRIVATE BUSINESS CAPITAL was not even found on the page, leaving Applicant confused as to how it could be cited as evidence in support of the refusal.

The Examining Attorney does not meet her burden through the cited evidence to show that PRIVATE BUSINESS CAPITAL has any more common meaning with respect to Applicant's services. Instead, the Examining Attorney’s own evidence supports an ambiguity of meaning, demonstrating that PRIVATE BUSINESS CAPITAL is not merely descriptive with respect to Applicant's services. As the United States Court of Appeals for the Federal Circuit explained in *In re Hutchinson Technology Incorporated*, 852 F.2d 552, 555 (Fed. Cir. 1988); 7 U.S.P.Q.2D (BNA) 1490, 1492, 1493, a term that can have multiple meanings does not convey the sort of *immediate* understanding of the goods necessary to classify a mark as merely descriptive. The court found the term "technology" to be a very broad term, encompassing many categories of goods, and that the idea "technology" does not convey an immediate idea of the "ingredients, qualities, or characteristics of the goods" listed in the application: etched metal electronic components; flexible circuits; actuator bands for disk drives; print bands; increment disks; [and] flexible assemblies for disk drives. Thus, the term "technology" was not merely descriptive. Similarly, PRIVATE BUSINESS CAPITAL fails to provide *immediate* information about Applicant's services, and therefore is not merely descriptive with respect to those services.

## **SUPPLEMENTAL REGISTER**

Should the Trademark Trial and Appeal Board find the Applicant's application could not proceed on the Principal Register, Applicant requests that the Board allow the Application to proceed on the Supplemental Register to publication. Applicant would have filed an amendment to allege use seeking to amend to the Supplemental Register, however, the Examining Attorney's in her office action dated April 25, 2014 stated that "neither an amendment to proceed under Trademark Act Section 2(f) nor an amendment to the Supplemental Register can be recommended." Applicant is currently using the mark in commerce and would be ready to file an amendment to allege use to allow the mark to proceed to publication on either the Principal or Supplemental Register.

## **CONCLUSION**

The Examining Attorney has failed to meet her burden to demonstrate the Applicant's PRIVATE BUSINESS CAPITAL mark is merely descriptive. To the extent Applicant's PRIVATE BUSINESS CAPITAL mark be determined to fall within the "gray area" between obviously descriptive and suggestive marks, all doubts must be resolved in Applicant's favor. *In re Conductive Systems, Inc.*, 220 U.S.P.Q. 84, 86 (TTAB 1983) (where combination of two merely descriptive terms creates a mark that might be either descriptive or suggestive, doubts are to be resolved in favor of applicants; refusal reversed); *In re Pennwalt Corp.*, 173 U.S.P.Q. 317, 319 (TTAB 1972) (DRI-FOOT not merely descriptive for antiperspirant foot deodorant; doubts to be resolved in favor of publication; refusal reversed). Accordingly, Applicant respectfully requests that the Trademark Trial and Appeal Board overturn the refusal under Section 2(e)(1) and allow the application to

proceed to publication.

Respectfully submitted,

Dated: January 20, 2015

DE NOVO LEGAL, PC

By:

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