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Subject: U.S. TRADEMARK APPLICATION NO. 86025037 - COOMI 47AG - BHASIN 10.0- - EXAMINER BRIEF

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# UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

<b>U.S. APPLICATION SERIAL NO.</b> 86025037  <b>MARK:</b> COOMI 47AG	
<b>CORRESPONDENT ADDRESS:</b> CHARLES P KENNEDY  LERNER DAVID LITTENBERG KRUMHOLZ & MENTL  600 SOUTH AVE W STE 2  WESTFIELD, NJ 07090-1497	<b>GENERAL TRADEMARK INFORMATION:</b> <a href="http://www.uspto.gov/trademarks/index.jsp">http://www.uspto.gov/trademarks/index.jsp</a>  <b>TTAB INFORMATION:</b> <a href="http://www.uspto.gov/trademarks/process/appeal/index.jsp">http://www.uspto.gov/trademarks/process/appeal/index.jsp</a>
<b>APPLICANT:</b> Bhasin Enterprise Corporation	
<b>CORRESPONDENT'S REFERENCE/DOCKET NO:</b>  BHASIN 10.0-  <b>CORRESPONDENT E-MAIL ADDRESS:</b>  trademarkadmin@ldlkm.com	

## EXAMINING ATTORNEY'S APPEAL BRIEF

Applicant, Bhasin Enterprise Corporation, has appealed the final refusal to register the mark COOMI 47AG for silver jewelry, in Class 14. Registration is refused pursuant to Trademark Act Section 2(e)(1), 15 U.S.C. Section 2(e)(1), because the applicant has failed to provide a disclaimer of the descriptive term 47AG.

## **FACTS**

On July 31, 2013, the applicant filed a multi-class application for the mark COOMI 47AG for goods in International Classes 14, 18 and 25. In a combined Examiner's Amendment/Priority Action, the wording "jewelry" in Class 14 was amended to "silver jewelry," and a requirement for a disclaimer of the descriptive term "47AG" was set forth in the Priority Action portion of the action, for Class 14 only. Following applicant's failure to provide the requested disclaimer, the examining attorney issued a final refusal. Thereafter, the request for reconsideration was denied. This appeal followed.

## **ARGUMENT**

**THE TERM "47AG" IS MERELY DESCRIPTIVE OF SILVER JEWELRY,  
AND THE REQUIREMENT FOR A DISCLAIMER  
PURSUANT TO TRADEMARK ACT SECTION 6 IS PROPER.**

Trademark Act Section 6(a), 15 U.S.C. §1056(a), requires the disclaimer of "an unregistrable component of a mark otherwise registrable." Wording that merely describes an ingredient, quality, characteristic, function, feature, purpose, or use of an applicant's goods or services, is an unregistrable component of a mark.

Applicant must disclaim the wording "47AG" in Class 14 because it merely describes an ingredient, quality, characteristic, function, feature, purpose, or use of applicant's goods, and thus is an

unregistrable component of the mark. See 15 U.S.C. §§1052(e)(1), 1056(a); *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 1251, 103 USPQ2d 1753, 1755 (Fed. Cir. 2012) (quoting *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 1173, 71 USPQ2d 1370, 1371 (Fed. Cir. 2004)); TMEP §§1213, 1213.03(a). Specifically, the wording is a combination of two descriptive terms for silver, 47 being the atomic number for silver and AG being the chemical symbol for silver.

Evidence was attached to the first Office action and supplemented in the final action, showing the descriptive meaning of each term. For example, in an article from Wikipedia.com about “silver” the chemical symbol AG and the atomic number 47 are immediately set forth in the first sentence of the description about this chemical element. Further in the article, jewelry is set forth as one of the many uses of its precious metal properties. In a printout from the web site <http://education.ilab.org>, listing the elements of The Periodic Table of Elements, the information about the element silver clearly sets forth both the atomic number 47 and the chemical symbol AG for silver. Further information about the history and use of the element include a reference to its usage for jewelry.

Generally, if the individual components of a mark retain their descriptive meaning in relation to the goods, the combination results in a composite mark that is itself descriptive and not registrable. *In re Phoseon Tech., Inc.*, 103 USPQ2d 1822, 1823 (TTAB 2012); TMEP §1209.03(d); see, e.g., *In re King Koil Licensing Co.*, 79 USPQ2d 1048, 1052 (TTAB 2006) (holding THE BREATHABLE MATTRESS merely descriptive of beds, mattresses, box springs, and pillows where the evidence showed that the term “BREATHABLE” retained its ordinary dictionary meaning when combined with the term “MATTRESS” and the resulting combination was used in the relevant industry in a descriptive sense); *In re Associated Theatre Clubs Co.*, 9 USPQ2d 1660, 1663 (TTAB 1988) (holding GROUP SALES BOX OFFICE merely descriptive of theater ticket sales services, because such wording “is nothing more than a combination

of the two common descriptive terms most applicable to applicant's services which in combination achieve no different status but remain a common descriptive compound expression").

Only where the combination of descriptive terms creates a unitary mark with a unique, incongruous, or otherwise nondescriptive meaning in relation to the goods and/or services is the combined mark registrable. See *In re Colonial Stores, Inc.*, 394 F.2d 549, 551, 157 USPQ 382, 384 (C.C.P.A. 1968); *In re Positec Grp. Ltd.*, 108 USPQ2d 1161, 1162-63 (TTAB 2013).

In this case, both the individual components and the composite result are descriptive of applicant's goods and do not create a unique, incongruous, or nondescriptive meaning in relation to the goods. Specifically, the combination describes a feature of the applicant's goods, because it immediately describes the material composition of the jewelry.

In addition to the evidence showing that the individual terms have a descriptive meaning in relation to silver, evidence was attached showing that the combined wording retains its descriptive meaning in relation to the identified goods. For example, an excerpt from a retail web site *Deja vu* was attached and shows use of "47-ag" in connection with a metal alloy jewelry disc, and a printout from the *Christofle* web site was attached which shows the reverse AG47 in connection with a silver money clip. Acknowledgment of the usage of "47" and "AG" as a nod to chemistry class was set forth in the description of the goods and the terms were set forth in a way reminiscent of the chemical symbol chart.

Further evidence was attached to the final action in response to the applicant's argument that purchasers are not aware that 47 is the atomic number for silver or that AG is the chemical symbol. In addition, a printout from the web site [www.47agcraft.com](http://www.47agcraft.com) was attached showing use of "47AG" by that retailer to identify its silver jewelry, refuting Applicant's statement that it

is the only user of the term in relation to silver jewelry. In addition, the applicant was advised that even if it were the first and only user of “47AG” in relation to silver jewelry, the wording would still be merely descriptive, because it immediately describes the material composition of the applicant’s silver jewelry. *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).

Applicant argues that “customers for jewelry are not chemists or chemistry students who must know the atomic numbers and chemical symbols of the elements.” (Brief at page 6). However, the evidence of record shows that both 47 and AG are descriptive terms in relation to silver. In a similar case, *In re E5 LLC*, 103 USPQ2d 1578 (TTAB 2012), the Trademark Trial and Appeal Board affirmed a Section 2(a) refusal of a mark containing the chemical symbol CU for dietary supplements. In that case, the Board held that consumers would recognize CU as the chemical abbreviation for copper and affirmed the requirement to indicate the goods contained copper in the identification of goods. As in this case, that applicant argued that the chemical symbol on the periodic table would not be understood by consumers to mean copper. However, the Board disagreed, finding that copper is a common ingredient in dietary supplements, and that purchasers would understand the term in context to refer to that chemical element.

The *E5 case* is particularly relevant in this instance. As shown in the evidence of record, 47 and AG both refer to silver, and silver is a very common and significant composition for jewelry. When viewed in relation to silver jewelry, consumers will immediately understand that the terms used in combination identify the material composition of the jewelry.

Applicant also states that the examining attorney has not submitted a single article or advertisement that uses the term 47AG to describe the silver content of jewelry. This argument is without merit. While usage of the combination in connection with silver jewelry is not widespread, the

evidence of record does show uses of such combinations in relation to jewelry. As stated above, as an example, an excerpt from the web site [www.47AGcraft.com](http://www.47AGcraft.com), was attached to the final Office action, showing use of 47AG for silver jewelry. Further, an excerpt showing usage of the inverse term AG47 for silver money clips was also included and is relevant to the consideration of how consumers will perceive this term.

An applicant may not claim exclusive rights to terms that others use or may need to use to describe their goods in the marketplace. *See Dena Corp. v. Belvedere Int'l, Inc.*, 950 F.2d 1555, 1560, 21 USPQ2d 1047, 1051 (Fed. Cir. 1991); *In re Aug. Storck KG*, 218 USPQ 823, 825 (TTAB 1983). A disclaimer of unregistrable matter does not affect the appearance of the mark; that is, a disclaimer does not physically remove the disclaimed matter from the mark. *See Schwarzkopf v. John H. Breck, Inc.*, 340 F.2d 978, 978, 144 USPQ 433, 433 (C.C.P.A. 1965); TMEP §1213.

### **CONCLUSION**

In view of Applicant's failure to provide the required disclaimer, registration of the entire mark is refused. *See In re Stereotaxis Inc.*, 429 F.3d 1039, 1041, 77 USPQ2d 1087, 1089 (Fed. Cir. 2005); TMEP §1213.01(b).

Respectfully submitted,

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