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BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	86025037
Applicant	Bhasin Enterprise Corporation
Applied for Mark	COOMI 47AG
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## I. INTRODUCTION

Applicant Bhasin Enterprise Corporation submits this reply brief to address the arguments made in Examining Attorney's Appeal Brief.

Applicant has applied to register the mark COOMI 47AG for goods in classes 14, 18, and 25. The Examining Attorney rejected the application for silver jewelry in class 14 on the ground that a disclaimer must be entered for the portion 47AG. The Examiner contended that 47AG is merely descriptive of silver jewelry because 47 is the atomic number for silver and AG is its chemical symbol.

It is well-accepted that mere descriptiveness requires that wording convey an immediate idea of the product's ingredients without needing imagination, thought, and perception to reach a conclusion. Thus, the relevant customers, purchasers for jewelry, would have to immediately translate 47AG to mean silver by its atomic number and chemical symbol in order for 47AG to be merely descriptive. Although chemists and chemistry students might surmise that 47AG is a combination of the atomic number and chemical symbol of silver, typical jewelry shoppers would not.

In the record for the application, the Examining Attorney submitted no probative evidence that for jewelry customers 47AG would convey an immediate idea that the jewelry is silver. Indeed, the only evidence submitted by the Examining Attorney was Internet advertisements that either were ambiguous or favored a conclusion that 47AG is not merely descriptive. Thus, the Examining Attorney submitted an Internet advertisement from [www.christofle.com](http://www.christofle.com) for a silver money clip that did not rely on the viewer to conclude that AG47 refers to silver, but provided an explicit statement that the viewer must flash back to chemistry class and the periodic table of elements to understand that AG47 relates to silver.

(Action No. 1, at 21.) Although the limitations of the few sources found by the Examining Attorney were pointed out in Applicant's appeal brief, the Examining Attorney has not responded to any of these points.

Because the Examining Attorney has been unable to provide evidence that jewelry purchasers would translate 47AG to mean silver without the use of imagination, thought, and perception, the requirement for a disclaimer should be reversed. Applicant's application should be allowed.

## II. ARGUMENT

### A. Only A Portion Of A Mark That Conveys An Immediate Idea Of The Ingredients Without Imagination Or Thought Would Be Merely Descriptive

In order for the portion 47AG of Applicant's mark to be merely descriptive, it would need to convey "an immediate idea of the ingredients... of the goods," without requiring "imagination, thought and perception to reach a conclusion." *DueProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 1251-52 (Fed. Cir. 2012). Moreover, this commercial impression that a mark conveys "must be viewed through the eyes of a consumer." *Id.* at 1253-54. The relevant consumers in this case would be purchasers or shoppers for jewelry, and they would have to immediately translate 47AG to mean silver by knowing that 47 is silver's atomic number and AG its chemical symbol for 47AG to be merely descriptive.

The Examining Attorney has argued that 47AG is a combination of two descriptive terms, 47 being the atomic number for silver and AG being the chemical symbol for silver. (Examining Attorney Appeal Br. 2.) The Examining Attorney has submitted an article from Wikipedia on silver and a printout from the website [www.education.jlab.org](http://www.education.jlab.org) listing the elements from the periodic table of elements. Although these are true scientific facts, this evidence is insufficient to meet the burden of establishing that 47AG would be merely descriptive by

providing jewelry shoppers the immediate idea without imagination, thought, and perception that the jewelry is silver.

The Examining Attorney has submitted no evidence that shoppers for jewelry know the atomic number of silver such that 47 would convey an immediate idea that the jewelry was silver. Atomic numbers and chemical symbols of the elements have no relevance to shopping decisions for consumers for jewelry. Although chemists and chemistry students may recall that 47 is the atomic number for silver and AG is its chemical symbol, it would take a significant exercise of imagination, thought, and perception for the typical jewelry shopper to conclude that 47AG indicates silver by its atomic number and chemical symbol.

**B. Evidence Regarding Insignificant Use Of 47AG Does Not Indicate That The Term Is Merely Descriptive**

Instead of probative evidence of the impressions of jewelry purchasers, the Examining Attorney refers to three uses of 47AG or AG47 in Internet advertisements that were raised in the office actions. However, the Examining Attorney fails to address the severe limitations of this evidence as pointed out by the Applicant, both in responses and in Applicant's Appeal Brief.

The Examining Attorney first points to an excerpt from a retail website [www.dejavu-thailand.com](http://www.dejavu-thailand.com) that referred to a clock by a description with the portion "47-ag." Although repeating to this evidence, the Examining Attorney fails to note that it is from a website directed to Thailand, not the United States. Indeed, the product is priced in a foreign currency, confirming that it is not directed to jewelry consumers in the United States, the only customer class relevant to whether 47AG is merely descriptive. Moreover, the ad does not clearly use "47-ag" to convey that the jewelry is silver. (See Action 1, at 19-20, Nov. 20, 2013.) Thus, this ad is at best ambiguous and not directed to customers in the United States.

A second reference relied upon by the Examining Attorney supports Applicant's argument that 47AG is not merely descriptive. The Examining Attorney has relied on an advertisement from [www.christofle.com](http://www.christofle.com) for a silver money clip using the number 47 and the letters Ag on the money clip. But an ad for the money clip contains probative evidence that this source that AG47 is at best suggestive and does not convey an immediate idea that the money clip is made of silver. In connection with the use of AG47 on the money clip, the website notes:

In keeping with their signature style, the co-founders of "La tete au cube" studio offer a collection of several delightfully offbeat trays.

These witty creations clearly affirm Christofle's DNA, inscribing it indelibly on a House icon.

In a flashback to chemistry class, Mendeleiv's periodic table of the elements leaves the chalkboard and reappears on two trays, this key chain that celebrate Christofle's fundamental element: Silver.

(Action No. 1, at 21.) If AG47 conveyed an immediate idea that the money clip was made of silver, there would have been no need for this explanation that one needed to flash back to chemistry class and consider the periodic table of elements to understand that 47 was the atomic number for silver. In short, this evidence conflicts with the Examining Attorney's argument that 47AG is merely descriptive.

The Examining Attorney also relied on a printout from the website [www.47AGcraft.com](http://www.47AGcraft.com) showing jewelry that was submitted with the final action. (Action No. 2 at 6-8, Feb. 19, 2014.) The Examiner had printed out pages from this website as of February 8, 2014. In a request for reconsideration after final action, Applicant inspected the same website and pointed out that, as of June 12, 2014, the website no longer advertised jewelry. Instead, the website was devoted exclusively to selling cases for i-Phones and tablets:

#### About us

47Ag Craft is bluit [sic, built] on 2011. We trade in a wide variety of case for phone and tablet. We offer the 3D case such as iphone 4s, phone 5/5s, Samsung note 2,

Galaxy II, Galaxy III, Galaxy IV with good quality and competitive price. 47AgCraft specializes in adding value in products with a special focus on the design.

(Resp. 7 June 24, 2014, at 7.) This statement entirely undercuts the Examining Attorney's argument that 47AgCraft indicates silver jewelry. Thus, this evidence is not relevant.

The Examining Attorney has not responded to any of these limitations of the evidence submitted, even though Applicant pointed out all of these deficiencies in its appeal brief. (Applicant's Br. 2-4, 7.) In sum, the Examining Attorney has failed to submit probative evidence that 47AG would be merely descriptive for typical purchases of jewelry.

**C. The *In Re E5 LLC* Case Does Not Support The Examining Attorney's Position**

Jewelry customers are not chemists or chemistry students who must know the atomic numbers and chemical symbols of the elements. Thus, the atomic number and chemical symbol of silver are not relevant to purchasers of jewelry, and there is no reason to expect they would use them to describe the ingredients of jewelry. To attempt to respond to this telling deficiency, the Examining Attorney has referred to the decision in *In re E5 LLC*, 103 U.S.P.Q.2d 1578 (T.T.A.B. 2012). The Examining Attorney contends that the Board held in the *E5* case that consumers would recognize CU as a chemical abbreviation for copper and affirmed a refusal to register a mark on the ground that its use of CU was deceptively misdescriptive.

There are three major differences between the evidence in the *E5* case and the present record, which makes the decision in that case unresponsive of the Examining Attorney's rejection. First and foremost, the mark in *E5* used only the chemical symbol CU, and not the atomic number of an element. Thus, there is no suggestion in that case that consumers would recognize the atomic number for an element to describe the presence of that element or would recognize a combination of the atomic number and the chemical symbol for the element as merely describing the presence of that element.

Second, the evidence of descriptiveness in *E5* was stronger and more probative than the evidence submitted by the Examining Attorney here. In the *E5* case, the Examining Attorney submitted over a dozen references "showing that CU is used to refer to the element copper." 103 E5, U.S.P.Q.2d at 1579-80. Moreover this evidence was confined to the use of CU in capital letters, and no doubt would have included much additional support for the chemical symbol in the form Cu. In comparison, the three references submitted by the Examining Attorney here are ambiguous at best. Indeed, as noted, the reference from [www.christofle.com](http://www.christofle.com) strongly supports a lack of mere descriptiveness for 47AG.

Third, the legal basis for rejection in *E5* that the mark containing the symbol CU would be deceptively misdescriptive for a dietary supplement without copper is fundamentally different from a determination that a mark is merely descriptive. Deceptively misdescriptive does not require that the description provide an immediate idea of the nature of the goods without imagination, thought, and perception. Indeed, the legal terms are quite different as set forth in the statute, one requiring mere descriptiveness, while deceptively misdescriptive requires only that the mark be misdescriptive. *See* 15 U.S.C. § 1052(e). We note that although the Examiner had also rejected the application on a disclaimer ground, the Board did not reach that requirement.

In sum, the *E5* decision does not support the Examining Attorney's requirement of a disclaimer for 47AG in Applicant's mark.

**III. CONCLUSION**

Based on the foregoing, Applicant respectfully requests that the Trademark Trial and Appeal Board reverse the Examining Attorney's requirement for a disclaimer of the wording 47AG for the goods in class 14 and allow the application.

Respectfully submitted,

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