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# UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NO. 86041474

MARK: NECKLETTE



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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:** Creations By Sherry Lynn, LLC

**CORRESPONDENT'S REFERENCE/DOCKET NO:**

N/A

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## **EXAMINING ATTORNEY'S APPEAL BRIEF**

Applicant: Creations by Sherry Lynn, LLC : BEFORE THE

Trademark: NECKLETTE : TRADEMARK TRIAL

Serial No.: 86041474 : AND

Attorney: Christine Washington, Esq. : APPEAL BOARD

Address: Christine C. Washington: ON APPEAL

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## TRADEMARK EXAMINING ATTORNEY'S APPEAL BRIEF

The applicant has appealed the Examining Attorney's final refusal to register the mark NECKLETTE under Section 2(e)(1) of the Trademark Act.

FACTS

On August 22, 2013, the applicant, filed an application for the mark NECKLETTE for use with “Jewelry, namely, bracelets, wristbands and necklaces that also provides notification to the wearer of a pending medical related task; jewelry, namely, magnetic necklaces; necklaces” under Section 1(a).

On December 8, 2013, the assigned Trademark Examining Attorney issued a descriptive refusal of the mark NECKLETTE under Section 1052(e)(1) of the Trademark Act. The examining attorney argued that the mark describes a hybrid of jewelry that functions as both a necklace and a bracelet. The examining attorney provided evidence from different websites to show the descriptive use of necklettes in the jewelry industry. Based on the applicant’s jewelry goods and the supporting evidence, the examining attorney concluded that the mark NECKLETTE was descriptive of the applicant’s goods. The examining attorney also issued an advisory, that in addition to being descriptive, the mark appeared to be generic for the applicant’s goods.

On July 11, 2014, the application abandoned for failure to respond.

On August 15, 2014, the applicant filed a petition to revive and responded to the office action.

On August 16, 2014, the application was revived from abandonment.

In its response, the applicant argued that the mark is not descriptive because it is not a word in the dictionary, has more than one meaning, and is merely suggestive. The applicant argued that NECKLETTE is not descriptive because it is not an accepted word in the dictionary. The applicant argued that NECKLETTE has more than one meaning because it could be a “concatenation” of a necklace and bracelet, a hair tie or a scarf. Because of these different meanings, the applicant argued that NECKLETTE is suggestive because a consumer would have to follow a multi-state reasoning process to determine what the mark identifies. To support its arguments, the applicant provided evidence from dictionary.com to show “no results” for the word NECKLETTE and webpages that show NECKLETTE referring to a hair tie and a scarf.

On September 6, 2014, the examining attorney issued a final office action and maintained the descriptive refusal under Section 2(e)(1) based on the identification of goods and the evidence in the final office action showing how NECKLETTE refers to the goods identified.

On November 24, 2014, the applicant filed an Appeal of the Final Refusal and a Request for Reconsideration. On December 15, 2014, the Request for Reconsideration was Denied. On May 5, 2015, the applicant filed a Request to Remand to Consider Additional Evidence. On May 29, 2015, the Request was Denied.

The applicant now contends on appeal that:

1. The mark is not descriptive.
2. The mark is suggestive.
3. The mark is a double entendre.

#### ARGUMENTS

1. The mark NECKLETTE is descriptive of the applicant's goods.

The applicant has filed a use application and seeks to register the mark NECKLETTE for use with "Jewelry, namely, bracelets, wristbands and necklaces that also provides notification to the wearer of a pending medical related task; jewelry, namely, magnetic necklaces; necklaces". The examining attorney has refused registration of the mark under Section 2(e)(1) of the Trademark Act because the mark merely describes the feature of the applicant's jewelry. Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1); *see* TMEP §§1209.01(b), 1209.03 *et seq.*

The determination of whether a mark is merely descriptive is made in relation to an applicant's goods and/or services, not in the abstract. *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 1254, 103 USPQ2d 1753, 1757 (Fed. Cir. 2012); *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, e.g., In re Polo Int'l Inc.*, 51 USPQ2d 1061, 1062-63 (TTAB 1999) (finding DOC in DOC-CONTROL would refer to the "documents" managed by applicant's software rather than the term "doctor" shown in a dictionary definition); *In re Digital Research Inc.*, 4 USPQ2d 1242, 1243-44 (TTAB 1987) (finding CONCURRENT PC-

DOS and CONCURRENT DOS merely descriptive of “computer programs recorded on disk” where the relevant trade used the denomination “concurrent” as a descriptor of a particular type of operating system).

“Whether consumers could guess what the product [or service] is from consideration of the mark alone is not the test.” *In re Am. Greetings Corp.*, 226 USPQ 365, 366 (TTAB 1985).

The evidence shows that the mark NECKLETTE describes the applicant’s goods which are comprised of various types of necklaces and bracelets that may also provide medical information.

The applicant contends that its jewelry is “never worn as bracelets or necklaces”. The applicant also contends that its jewelry does not “drape” down like a traditional necklace but merely fastens magnetically to clothing.

However, in relation to the jewelry identified, the examining attorney’s website evidence from etsy.com, Nina Nguyen designs, foxyoriginals.com, pininterest.com, JCK marketplace and paperbeads.org, all indicate that a “necklette” is a hybrid jewelry that can be worn as a necklace or a bracelet around the neck or around the wrist. To be worn as a necklace or a bracelet, the goods would have to fasten around a neck or a wrist.

For purposes of how a necklace or a bracelet is worn, the examining attorney asks that the Board take judicial notice of the dictionary definitions of a “necklace” and a “bracelet” from the Merriam Webster online dictionary. A “necklace” is a “piece of jewelry worn around the neck”. A “bracelet” is a piece of jewelry worn around the wrist.

The evidence from the websites attached to the brief further reinforces that a “necklette” is a piece of jewelry that can be worn as both a necklace or a bracelet around the neck or a wrist. In particular, the foxyoriginals.com webpage shows a necklace and a pink stamp inside the display window that says “converts to a bracelet”.

The applicant contends that its goods fasten to clothing, not around a neck or a wrist. However, the identification of goods does not assert this contention. Thus, in relation to the goods the applicant identified, the website evidence shows that the applicant’s jewelry satisfies the definition of a necklette because the applicant’s jewelry is identified as both necklaces and bracelets, and more specifically, as goods that can be worn as either a necklace or a bracelet.

The evidence shows that consumers would understand that a “necklette” is jewelry, that can fasten around a neck or wrist and the applicant’s own website specimen shows that its goods are bracelets, wristbands and necklaces and some can be worn as both.

Terms that describe the function or purpose of a product or service may be merely descriptive. TMEP §1209.03(p); *see, e.g., In re Hunter Fan Co.*, 78 USPQ2d 1474, 1477 (TTAB 2006) (holding ERGONOMIC merely descriptive of ceiling fans); *In re Wallyball, Inc.*, 222 USPQ 87, 89 (TTAB 1984) (holding WALLYBALL merely descriptive of sports clothing and game equipment); *In re Orleans Wines, Ltd.*, 196 USPQ 516, 517 (TTAB 1977) (holding BREADSPRED merely descriptive of jams and jellies).

Therefore the examining attorney finds that the mark NECKLETTE is descriptive of the hybrid feature of the applicant's jewelry because the evidence shows that others in the jewelry industry identify jewelry that doubles as both a necklace or a bracelet, as a "necklette." Thus registration is refused under the Trademark Act §2(e)(1), 15 U.S.C. 1052(e)(1).

2. The mark NECKLETTE is not suggestive of the applicant's goods.

Applicant mistakenly argues that the mark is suggestive and contends that the mark "hints" at the use and application of the goods. However, the examining attorney finds that the nature and purpose of the goods as identified, fits directly with the dictionary definitions of a "necklace" and a "bracelet" which are attached to this brief. Moreover, the website evidence, which is also attached, shows that a "necklette" is a hybrid of both a necklace and a bracelet.

On the website for Foxy Originals, the page states, "Use the double-toggle closures to remove a length of chain, easily converting necklace to bracelet for two great looks in one." On the website for JCK Marketplace, the page states that the Melody Carnelian Necklette "[i]s a versatile hybrid that may be

worn as a necklace or bracelet.” On the website for Nina Nguyen, the page not only shows pictures of how the jewelry can be worn as a necklace or a bracelet, the page also states, “Nina crafted a timeless hybrid between a necklace and a bracelet – called a Necklette – that can be worn....as one long strand, double wrapped as a necklace or wound around the wrist as a bracelet.” On the Pinterest website which also refers to Nina Nguyen’s “wisteria collection”, the page states that “Nina is introducing the Necklette – a fabulous hybrid between a beautiful bold necklace and bracelet for fashion forward versatility.” Even on the website for Paper Beads, Jewelry Made from Recycled Paper, the article refers to “...the Necklette – a necklace with magnetic closure that can be easily converted into a bracelet.”

This website evidence, shows that others in the jewelry industry refer to jewelry that can be worn as a necklace or a bracelet, as a “necklette.” Thus the mark is not suggestive. NECKLETTE describes the goods identified.

Descriptiveness is considered in relation to the relevant goods and/or services. *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 1254, 103 USPQ2d 1753, 1757 (Fed. Cir. 2012). “That a term may have other meanings in different contexts is not controlling.” *In re Franklin Cnty. Historical Soc’y*, 104 USPQ2d 1085, 1087 (TTAB 2012) (citing *In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979)); TMEP §1209.03(e).

The applicant also mistakenly argues that the mark is a double entendre because it has multiple meanings that do not refer to jewelry. However, the other meanings are not applicable here because they are not used in the context of the jewelry identified. The determination of whether a mark is

merely descriptive is made in relation to an applicant's goods and/or services, not in the abstract.

*DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 1254, 103 USPQ2d 1753, 1757 (Fed. Cir. 2012); *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, e.g., In re Polo Int'l Inc.*, 51 USPQ2d 1061, 1062-63 (TTAB 1999) (finding DOC in DOC-CONTROL would refer to the "documents" managed by applicant's software rather than the term "doctor" shown in a dictionary definition); *In re Digital Research Inc.*, 4 USPQ2d 1242, 1243-44 (TTAB 1987) (finding CONCURRENT PC-DOS and CONCURRENT DOS merely descriptive of "computer programs recorded on disk" where the relevant trade used the denomination "concurrent" as a descriptor of a particular type of operating system).

"Whether consumers could guess what the product [or service] is from consideration of the mark alone is not the test." *In re Am. Greetings Corp.*, 226 USPQ 365, 366 (TTAB 1985).

Based on the goods identified and the website evidence attached, NECKLETTE is not suggestive.

NECKLETTE is descriptive of the applicant's jewelry.

3. The Applicant submitted new evidence at the time of appeal.

The examining attorney objects to the applicant's submission of new evidence for the suffix, "lette" and for the registered marks, CAMIETTE for camisoles and LEMONETTE for lemon-flavored salad dressing.

TMEP §710.01(c). While preserving her objection, the examining attorney finds that the applicant's evidence to infer that the applicant's goods are a "diminutive" version of a necklace, and the applicant's

evidence to show that similar marks are registered, are not only irrelevant to the applicant's jewelry goods, but the evidence is untimely because it has been submitted at the time of appeal. The record must be complete prior to the appeal. TMEP §710.01(c).

Nevertheless, the examining attorney has provided evidence with this brief to show that a "necklette" is a hybrid between a small necklace or bracelet, and the applicant's goods are necklaces, at least in part. "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.

#### CONCLUSION

For all of the foregoing reasons, the Trademark Examining Attorney requests that the Trademark Trial and Appeal Board affirm the descriptive refusal of NECKLETTE under §1052(e)(1) of the Trademark Act.

Respectfully submitted,

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