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Subject: U.S. TRADEMARK APPLICATION NO. 86265949 - BAJA TU SEGURO.COM - N/A - EXAMINER BRIEF

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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NO. 86265949

MARK: BAJA TU SEGURO.COM



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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: Cababie, Salvador

CORRESPONDENT'S REFERENCE/DOCKET NO:

N/A

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EXAMINING ATTORNEY'S APPEAL BRIEF

Applicant has appealed the trademark examining attorney's final requirement to disclaim the wording "BAJATUSEGURO.COM" in the mark under Trademark Act Section 2(e)(1) based on such wording being merely descriptive of Applicant's "insurance brokerage and reinsurance underwriting services offered via a global computer network" services in Class 36. 15 U.S.C. 1052(d), 1052(e)(1), 1056(a).

FACTS

On April 29, 2014, the applicant filed the application at issue to register the mark "BAJATUSEGURO.COM" and design alleging intent-to-use in commerce under Trademark Act Section 1(b) for "Insurance brokerage, Reinsurance underwriting" in Class 36.

On August 14, 2014, the examining attorney issued an Office Action requiring a disclaimer of the wording, "BAJATUSEGURO.COM", on the grounds that it is merely descriptive of a feature or characteristic of the applicant's services under Trademark Act Section 2(e)(1).

On February 14, 2015, the applicant responded to the requirement wherein Applicant argued against the requirement.

On February 17, 2015 Applicant simultaneously filed a revocation of attorney/appointment of attorney form and a response to the August 14, 2014 office action. Applicant indicated that the response dated February 14, 2015 "...was filed without authorization, and directly against explicit

instructions from Applicant to do no further work on this matter. Thus, the February 14, 2015 response should be disregarded.” Applicant argued for the registerability of the mark and amended the recitation of services.

As a result, on March 12, 2015, the examining attorney issued a Final Office Action stating that the disclaimer must be submitted because it is merely descriptive of the applicant’s services under Trademark Act Section 2(e)(1).

On September 11, 2015, in response to the Final Office Action, the applicant filed a Request for Reconsideration as well as a Notice of Appeal to the Trademark Trial and Appeal Board. In response, the Board acknowledged, then suspended the appeal and remanded the application to the examining attorney for a final determination of the applicant’s Request for Reconsideration.

On October 7, 2015, the examining attorney denied the applicant’s Request for Reconsideration. On October 9, 2015, the Board resumed the applicant’s September 11, 2015 appeal. The applicant filed its appeal brief on December 8, 2015.

ISSUE

The sole issue for consideration before the Board is whether the wording in the mark, “BAJATUSEGURO.COM”, is merely descriptive of a feature or characteristic of the applicant’s services under Trademark Act Section 2(e)(1) and must be disclaimed.

ARGUMENTS

- I. THE MARK, “BAJATUSEGURO.COM” IS MERELY DESCRIPTIVE OF A FEATURE OR CHARACTERISTIC OF THE APPLICANT’S SERVICES UNDER TRADEMARK ACT SECTION 2(e)(1).

Registration is refused because the applied-for mark “BAJATUSEGURO.COM” when translated, merely describes a feature or characteristic, of applicant’s services. Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1); see TMEP §§1209.01(b), 1209.03 et seq; In re Steelbuilding.com, 415 F.3d 1293, 1297, 75 USPQ2d 1420, 1421 (Fed. Cir. 2005) (citing Estate of P.D. Beckwith, Inc. v. Comm’r of Patents, 252 U.S. 538, 543 (1920)).

The determination of whether wording is merely descriptive is made in relation to an applicant’s services, not in the abstract. 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).

- A. WHEN PROPERLY TRANSLATED “BAJATUSEGURO.COM” IS DESCRIPTIVE OF A FEATURE OF APPLICANT’S SERVICES

The examining attorney has found ample evidence that demonstrates that the phrase BAJA TU SEGURO/BAJATUSEGURO.COM is properly translated as LOWER YOUR INSURANCE/LOWERYOURINSURANCE.COM and *not* DOWNLOAD YOUR INSURANCE as applicant argues. This evidence includes the following:

Google translate:

BAJA TU SEGURO is translated as LOWER YOUR INSURANCE

DOWNLOAD YOUR INSURANCE is translated as DESCARGAR SU SEGURO

www.spanishdict.com:

DOWNLOAD YOUR INSURANCE is translated as DESCARGAR SU SEGURO

BAJA TU SEGURO is translated as LOWER YOUR INSURANCE

www.freetranslation.com:

BAJA TU SEGURO is translated as LOW YOUR INSURANCE

Translation.babylon.com:

BAJA TU SEGURO is translated as LOW YOUR INSURANCE

DOWNLOAD YOUR INSURANCE is translated as DESCARGAR SU SEGURO

www.spanishcentral.com:

BAJA TU SEGURO is translated as LOWER YOUR INSURANCE

DOWNLOAD YOUR INSURANCE is translated as DESCARGAR SU SEGURO

www.imtranslator.com:

BAJA TU SEGURO is translated as IT LOWERS YOUR INSURANCE

DOWNLOAD YOUR INSURANCE is translated as DESCARGAR SU SEGURO

BING translate:

BAJA TU SEGURO is translated as LOWER YOUR INSURANCE

STIC Translation statement from USPTO translator Steve Spar:

BAJA TU SEGURO is translated as LOWER YOUR INSURANCE

The Applicant disagrees with the examining attorney's determination that the translation of BAJA TU SEGURO is translated to LOWER YOUR INSURANCE. Instead, Applicant maintains that the examining attorney has mistranslated the mark and that the proper translation of the mark is DOWNLOAD YOUR INSURANCE. In the Applicant's brief Applicant references T.M.E.P. § 1207.01(b)(vi)(B), and states that "[t]ranslation, however, does not happen in a vacuum. Certain words have different meanings depending on the context in which they are found." Applicant goes on to say "when determining the appropriate English translation of the foreign wording in the mark, an examining attorney should view the translations in the context of any significant features in the mark, such as design or wording elements, the identified goods and/or services in the application, the relevant marketplace, and the specimen." Applicant then erroneously argues that because of the inclusion of the wording ".COM" at the end of the mark and the amended recitation of services, ordinary purchasers are alerted to a

relationship to the internet, said relationship makes the “download” interpretation of the mark more plausible regardless of what the principle translation may be. The examining attorney disagrees.

Generic top-level domains (gTLDs), such as “.com” and “.net,” are generic locators for Internet website addresses and provide no meaningful source-identifying significance and are ubiquitous in the world today. See *Apple Computer v. TVNET.net, Inc.*, 90 USPQ2d 1393, 1397 (TTAB 2007); TMEP §§1215.01, 1215.02, 1215.09; cf. *In re Hotels.com, L.P.*, 573 F.3d 1300, 1301, 1304, 91 USPQ2d 1532, 1533, 1535 (Fed. Cir. 2009). Thus, a non-source-identifying gTLD is less significant in creating a commercial impression in the minds of consumers, and is generally given little weight in terms of commercial impression. See TMEP §1215.09. Furthermore, it goes without saying that those who sell goods or market services often times market themselves based upon the financial impact to the consumer. Put another way, telling consumers that your goods or services will cost less money/save money/lower costs is a ubiquitous advertising technique. One need only peruse advertisements (both print and online) to see this is a common advertising technique. It is far more plausible to understand the mark as LOWER YOUR INSURANCE because it makes sense in the context of marketing and advertising. To understand the mark as DOWNLOAD YOUR INSURANCE is an incongruous interpretation that the average consumer simply will not reach.

The foreign equivalent of a merely descriptive English word or term is also merely descriptive. *In re N. Paper Mills*, 64 F.2d 998, 998, 17 USPQ 492, 493 (C.C.P.A. 1933). Under the doctrine of foreign equivalents, marks with foreign words from modern languages are translated into English to determine descriptiveness. TMEP §1209.03(g); see *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772*, 396 F.3d 1369, 1377, 73 USPQ2d 1689, 1696 (Fed. Cir. 2005). The doctrine is applied when it is likely that an ordinary American purchaser would “stop and translate” the foreign term into its English equivalent. *Palm Bay*, 396 F.3d at 1377, 73 USPQ2d at 1696; cf. TMEP §1207.01(b)(vi)(A). The ordinary American purchaser refers to “all American purchasers, including those proficient in a non-English

language who would ordinarily be expected to translate words into English.” *In re Spirits Int’l, N.V.*, 563 F.3d 1347, 1352, 90 USPQ2d 1489, 1492 (Fed. Cir. 2009); see *In re Thomas*, 79 USPQ2d 1021, 1024 (TTAB 2006) (citing J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* §23:26 (4th ed. 2006), which states “[t]he test is whether, to those American buyers familiar with the foreign language, the word would denote its English equivalent.”). Generally, the doctrine is applied when the English translation is a literal and exact translation of the foreign wording. See *In re Oriental Daily News, Inc.*, 230 USPQ 637, 638 (TTAB 1986) (holding Chinese characters that mean ORIENTAL DAILY NEWS merely descriptive of newspapers); *In re Zazzara*, 156 USPQ 348, 348 (TTAB 1967) (holding PIZZA FRITTE, the Italian equivalent of “fried buns,” incapable for fried dough); TMEP §1209.03(g).

Under the doctrine of foreign equivalents, Spanish is a common, modern language and the doctrine is routinely applied to Spanish language marks. *In re Aquamar, Inc.*, 115 USPQ2d 1122, 1127 (TTAB 2015); *In re La Peregrina Ltd.*, 86 USPQ2d 1645, 1648 (TTAB 2008); see also *In re Perez*, 21 USPQ2d 1075, 1076-77 (TTAB 1991); *In re Am. Safety Razor Co.*, 2 USPQ2d 1459, 1460 (TTAB 1987). Spanish is the most commonly spoken language in the United States after English. *In re Aquamar, Inc.*, 115 USPQ2d at 1127 (citing Ryan, U.S. Census Bureau, Am. Cmty. Survey Reports, *Language Use in the United States: 2011* (2013), available at <http://www.census.gov/prod/2013pubs/acs-22.pdf>).

Based upon the evidence, BAJA TU SEGURO is properly translated as LOWER YOUR INSURANCE. Applicant’s argument that the average consumer knowledgeable in Spanish would translate the mark as DOWNLOAD YOUR INSURANCE is not persuasive given the weight of the evidence.

A mark is merely descriptive if “it immediately conveys knowledge of a quality, feature, function, or characteristic of [an applicant’s] goods or services.” *In re The Chamber of Commerce of the U.S.*, 675 F.3d 1297, 1300, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012) (quoting *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 963, 82 USPQ2d 1828, 1831 (Fed. Cir. 2007)); TMEP §1209.01(b); see *DuoProSS Meditech Corp.*

v. Inviro Med. Devices, Ltd., 695 F.3d 1247, 1251, 103 USPQ2d 1753, 1755 (Fed. Cir. 2012) (quoting *In re Abcor Dev. Corp.*, 588 F.2d 811, 814, 200 USPQ 215, 218 (C.C.P.A. 1978)).

In this instance Applicant's mark immediately conveys the notion that by using their insurance services one can lower (the cost) of their insurance. Given these facts this wording in Applicant's mark is clearly descriptive of the services and must be disclaimed.

B. APPLICANT'S MARK DOES NOT CREATE A DOUBLE ENTENDRE

Applicant goes on to argue that the mark creates an additional meaning, namely, DOWNLOAD YOUR INSURANCE. As seen from the evidence referenced above, Applicant's mark does not create a separate and distinct impression because Applicant's mark is not properly translated as DOWNLOAD YOUR INSURANCE. The phrase DOWNLOAD YOUR INSURANCE has been consistently translated as DESCARGAR SU SEGURO by the available online translation services.

Furthermore, even if it could be argued that DOWNLOAD YOUR INSURANCE is a viable translation of the mark, the mark would still be descriptive. In this instance, DOWNLOAD YOUR INSURANCE is simply a descriptive phrase that indicates that the insurance services feature an online component that can be downloaded. Generally, if the individual components of a mark retain their descriptive meaning in relation to the services, 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).

CONCLUSION

As illustrated by the evidence of record, the wording in the proposed mark, "BAJATUSEGURO.COM", is merely descriptive of a feature or characteristic of the applicant's services in Class 36. "BAJATUSEGURO.COM" describes the fact that one can lower ones insurance. Applicant provides "Insurance brokerage and reinsurance underwriting services offered via a global computer network" in Class 36. When presented with the mark "BAJATUSEGURO.COM", consumers would immediately know that they can lower their insurance through applicant's services. Accordingly, the trademark examining attorney respectfully requests that requirement for a disclaimer of the wording "BAJATUSEGURO.COM", under Trademark Act Section 2(e)(1) be affirmed.

Respectfully submitted,

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