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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NO. 86268913

MARK: BANANA BOAT



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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: Eveready Battery Company, Inc.

CORRESPONDENT'S REFERENCE/DOCKET NO:

56772-131697

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EXAMINING ATTORNEY'S APPEAL BRIEF

INTRODUCTION

Eveready Battery Company, Inc. (hereinafter, "applicant") has appealed the trademark examining attorney's final refusal based on the requirement under Section 6 of the Trademark Act that applicant disclaim the wording "BANANA" because such a term merely describes an ingredient, quality, characteristic, function, feature, purpose, or use of applicant's goods and/or services, 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).

STATEMENT OF THE CASE

On May 1, 2014, applicant filed the present application for the standard character mark "BANANA BOAT" for "Air fragrancing preparations; Room fragrances" in International Class 3. In a First Priority Action/Examiner's Amendment dated July 25, 2014, applicant was required to disclaim the wording "BANANA" because the wording merely described a characteristic of applicant's goods and the examining attorney entered a claim of ownership for applicant's prior registrations. On January 7, 2015, a Final Office Action was issued regarding the disclaimer requirement. Applicant filed a Notice of Appeal on June 22, 2015.

ISSUE

The wording "BANANA" is merely descriptive of applicant's goods necessitating a disclaimer requirement under 15 U.S.C. §§1052(e)(1), 1056(a).

ARGUMENT

Applicant must disclaim the wording "BANANA" because it merely describes an ingredient, quality, characteristic, function, feature, purpose, or use of applicant's goods and/or services, 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).

An applicant may not claim exclusive rights to terms that others may need to use to describe their goods and/or services 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).

If applicant does not provide the required disclaimer, the USPTO may refuse to register the entire mark. See *In re Stereotaxis Inc.*, 429 F.3d 1039, 1040-41, 77 USPQ2d 1087, 1088-89 (Fed. Cir. 2005); TMEP §1213.01(b).

The dictionary evidence of record shows that a banana is a type of tropical fruit. Dictionary.com, search of "banana," <http://dictionary.reference.com/browse/banana?s=t> (July 25, 2014) [Attachment to the Priority Action dated July 25, 2014]

The evidence of record from the following third party websites shows that the wording "BANANA" is often used in connection with goods that are the same or similar to applicant's goods to describe the scent of the goods.

- Nature's Garden Wholesale Candle & Soap Supplies showing banana fragrance oil. [http://www.naturesgardencandles.com/candlemaking-soap-supplies/item/rf-618/-banana-\(true\)--fragrance-oil-.html](http://www.naturesgardencandles.com/candlemaking-soap-supplies/item/rf-618/-banana-(true)--fragrance-oil-.html) (accessed on July 25, 2014) [Attachment to the Priority Action dated July 25, 2014]
- Amazon® showing Banana Room Spray by Eclectic Lady. <http://www.amazon.com/Banana-Room-Spray-8-ounces/dp/B00KKLTT20> (accessed on July 25, 2014) [Attachment to the Priority Action dated July 25, 2014]
- 1803 Candles® showing banana walnut cake linen & room spray. <http://1803candles.com/banana-walnut-cake-linen-room-spray.html> (accessed on December 31, 2014) [Attachment to the Office Action dated January 7, 2015]
- Jane Bernard Aromatics Sensational Gifts showing coconut and banana room spray. <http://www.scentsationalgifts.com/browseproducts/Asquith---Somerset-Coconut-and-Banana-for-Home-Fragrance.html> (accessed on December 31, 2014) [Attachment to the Office Action dated January 7, 2015]

- Barn Candle Company showing room spray featuring "ripe banana."
<http://www.barncandles.com/store/p/370-Banana-Cream-Pie-Barn-Room-Spray.aspx?>
(accessed on December 31, 2014) [Attachment to the Office Action dated January 7, 2015]
- Jazz Candles showing room sprays featuring a banana blend.
<http://jazzcandles.com/product/ROOMSPRAYS/%20/TDM-RP> (accessed on December 31, 2014)
[Attachment to the Office Action dated January 7, 2015]
- Sassafras Hill showing room sprays featuring bananas.
<http://www.sassafrashill.com/store/WsDefault.asp?One=833> (accessed on December 31, 2014)
[Attachment to the Office Action dated January 7, 2015]
- Scentsy showing BananaBerry Room Spray. <http://scentbars.com/products/bananaberry-scentsy-room-spray> (accessed on December 31, 2014) [Attachment to the Office Action dated January 7, 2015]
- The Candleberry Co. showing a candle featuring a dominant nutty banana scent.
http://www.candleberry.com/scents/view-scent?name=Nanner_Nut_Bread#Nanner-Nut-Bread-26-oz-Jar-Candle (accessed on December 31, 2014) [Attachment to the Office Action dated January 7, 2015]

The evidence clearly establishes that the wording "BANANA" is used to describe a characteristic of the goods, namely, the scent of applicant's air fragrancing preparations and room fragrances.

Applicant argues that the wording "BANANA" does not merely describe a characteristic of applicant's goods because applicant is not using the wording to describe the scent of the goods.

It is unclear if applicant is now arguing that the goods are not in fact banana scented. Even if applicant is not or will not be providing banana scented air fragrancing preparations or room fragrances, the evidence shows that consumers would believe that the goods are banana scented. Accordingly, a disclaimer is still required because the wording merely describes an ingredient, quality, characteristic, function, feature, purpose, or use of applicant's goods and/or services that is both false and believable, and thus is an unregistrable component of the mark. See 15 U.S.C. §§1052(e)(1), 1056(a); *In re White Jasmine LLC*, 106 USPQ2d 1385, 1394-95 (TTAB 2013); TMEP §§1209.04, 1213.03(a). An applicant may not claim exclusive rights to an unregistrable component of a mark, such as matter that is deceptively misdescriptive of the goods and/or services. See 15 U.S.C. §1056(a); TMEP §1213.03(a), (b).

Applicant asserts that the examining attorney has improperly dissected the mark because the mark is a unitary phrase. Marks comprising more than one element must be considered as a whole and should not be dissected; however, a trademark examining attorney may consider the significance of each element separately in the course of evaluating the mark as a whole. See *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 1253, 103 USPQ2d 1753, 1756-57 (Fed. Cir. 2012) (reversing Board's denial of cancellation for SNAP! with design for medical syringes as not merely descriptive when noting that the Board "to be sure, [could] ascertain the meaning and weight of each of the components that ma[de] up the mark"); *In re Hotels.com, L.P.*, 573 F.3d 1300, 1301, 1304, 1306, 91 USPQ2d 1532, 1533, 1535, 1537 (Fed. Cir. 2009) (holding HOTELS.COM generic for information and reservation services featuring temporary lodging when noting that the Board did not commit error in considering "the word 'hotels' for genericness separate from the '.com' suffix").

Applicant argues that the wording "BANANA" does not merely describe a characteristic of applicant's goods because the mark BANANA BOAT is a unitary phrase that does not immediately or directly describe a characteristic of the goods.

A term or phrase is unitary if it consists of elements that create a single or have a distinct commercial impression independent of the constituent elements. TMEP §1213.05, (b). The test for determining whether a mark is unitary focuses on whether the elements of a mark are so integrated or merged together that they cannot be regarded as separable. TMEP §1213.05; see *In re Kraft, Inc.*, 218 USPQ 571, 573 (TTAB 1983) (citing *In re EBS Data Processing, Inc.*, 212 USPQ 964, 966 (TTAB 1981)). If the elements are considered separable, the matter is not unitary and must be disclaimed. See *In re Ginc UK Ltd.*, 90 USPQ2d 1472, 1477 (TTAB 2007) (holding ZOGGS TOGGS for clothing not unitary, affirming requirement for disclaimer of "toggs"); *In re Brown-Forman Corp.*, 81 USPQ2d 1284, 1288 (TTAB 2006) (holding GALA ROUGE for wine not unitary, affirming requirement for disclaimer of "rouge"); TMEP §1213.05(b)(iv), (g), (g)(i).

In the instant application, the words BANANA and BOAT are separated by a space and do not create a single commercial impression independent of the constituent elements. The evidence establishes that banana scented air and room fragrances are common and that consumers would associate the wording "BANANA" with the scent of the goods.

Applicant argues that the mark as a whole refers to types of boats, i.e., recreational boats or boats that are banana shaped and do not describe applicant's goods because boats are not known for having any

particular scent. Applicant concludes that the mark is therefore arbitrary and should be treated as a unitary phrase. As detailed above, the mark is not unitary and the disclaimer requirement is only applicable to the wording "BANANA" and not "BOAT." While boats are not known for scent, the evidence shows that the wording "BANANA" is commonly used to refer to the scent of the applied-for goods. Further, the evidence establishes that the scent of air and room fragrance products is the primary feature of these goods such that consumers would specifically look to the description of the scent in making purchasing decisions. As used in connection with the goods, consumers are likely to view the wording "BANANA" as descriptive of the scent of the goods and not the shape or type of a boat.

Applicant further argues that the mark is unitary because the mark is famous and specifically asserts that the mark is highly recognized in connection with suncare products. Applicant has submitted no evidence that the mark has become distinctive or even well-known in connection with the applied-for goods. The determination of descriptiveness 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). The disclaimer requirement in the instant application is based on evidence that the wording "BANANA" is descriptive of air fragranting preparations and room fragrances and not whether the wording is descriptive of other types of goods associated with the mark.

Applicant points to third party registrations to show that the Office has taken positions that are contrary to the disclaimer requirement in the instant application with regard to the wording "BANANA" in two

registrations for similar goods (U.S. Trademark Registration No. 3,534,514 for room spray and U.S. Trademark Registration No. 2,048,367 for aromatic candles) [Attachments to the Applicant's Response dated December 18, 2014] The other three registrations cited by applicant are for goods that are not similar to applicant's air fragrancing preparations and room fragrances. (U.S. Trademark Registration No. 2,459,986 for cologne, U.S. Trademark Registration No. 2,319,762 for hair products and bath products, and U.S. Trademark Registration No. 2,925,265 for cosmetics) [Attachments to the Applicant's Response dated December 18, 2014] Also, it is important to note that during their argument regarding positions taken by the Office during examination of prior registrations, the applicant has not referred to any of the many registrations for scented products where the wording "BANANA" has been disclaimed. In particular, the applicant has not referred to the applicant's own prior registration for BANANA BOAT, U.S. Trademark Registration No. 1093524, which includes a disclaimer of the wording "BANANA" and which has been claimed as a prior registration in this application.

Moreover, prior decisions and actions of other trademark examining attorneys in registering other marks have little evidentiary value and are not binding upon the USPTO or the Trademark Trial and Appeal Board. TMEP §1207.01(d)(vi); see *In re Midwest Gaming & Entm't LLC*, 106 USPQ2d 1163, 1165 n.3 (TTAB 2013) (citing *In re Nett Designs, Inc.*, 236 F.3d 1339, 1342, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001)). Each case is decided on its own facts, and each mark stands on its own merits. See *AMF Inc. v. Am. Leisure Prods., Inc.*, 474 F.2d 1403, 1406, 177 USPQ 268, 269 (C.C.P.A. 1973); *In re Binion*, 93 USPQ2d 1531, 1536 (TTAB 2009).

Applicant argues that any doubt regarding the mark's descriptiveness should be resolved on applicant's behalf. E.g., *In re Merrill Lynch, Pierce, Fenner & Smith, Inc.*, 828 F.2d 1567, 1571 4 USPQ2d 1141, 1144

(Fed. Cir. 1987); *In re Grand Forest Holdings, Inc.*, 78 USPQ2d 1152, 1156 (TTAB 2006). However, in the present case, the evidence of record leaves no doubt that the mark is merely descriptive.

CONCLUSION

The examining attorney respectfully submits that the case law and the evidence of record support the finding that the wording "BANANA" is merely descriptive of the primary characteristic of the goods, i.e., the scent of air fragrancing preparations and room fragrances. For the foregoing reasons, the examining attorney requests that the Trademark Trial and Appeal Board affirm the requirement for a disclaimer of the wording "BANANA" under 15 U.S.C. §§1052(e)(1), 1056(a).

Respectfully submitted,

/Q Queen/

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